

September 29, 2010

Mr. John Farmer, Chair
Trademark Public Advisory Committee
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

The Honorable Gerard F. Rogers
Acting Chief Administrative Trademark Judge
Trademark Trial and Appeal Board
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

RE: Comments on the TTAB's Accelerated Case Resolution "Plug and Play" Proposal

Dear Mr. Farmer and Judge Rogers:

The American Intellectual Property Law Association ("AIPLA") appreciates the opportunity to offer comments regarding the United States Patent and Trademark Office's ("USPTO") Trademark Trial and Appeal Board's ("TTAB") proposed "plug and play" option for Accelerated Case Resolution ("ACR").

AIPLA is a national bar association with more than 16,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA fully supports the TTAB's efforts to implement ACR, including "plug and play" options to make ACR easier to use and encourage participation. You have kindly invited our comments, suggestions, and ideas on possible "plug and play" options for ACR. To that end, AIPLA conducted a survey of our Trademark Law Committee members to gather input and gain ideas for ACR "plug and play" options.

A. Proposed ACR "Plug and Play" General Guidelines

As a general proposal, AIPLA supports a voluntary system that allows parties to elect among various "plug and play" ACR options through ESTTA. AIPLA favors an ACR procedure that allows either party to request ACR through ESTTA, indicating that the adverse party has consented to the procedure. Alternatively, both parties may independently elect ACR through

ESTTA. If both parties independently elect ACR, and choose the same track or option, then ESTTA may generate an automatic schedule. If both parties elect ACR through ESTTA, but choose a different track or option (discussed below), then the TTAB may promptly convene a telephone conference (e.g., within ten (10) days of the filing date of the ACR requests) to discuss an appropriate ACR track with the parties. AIPLA submits that both parties must stipulate to proceed under ACR, and agree to the particular track or options, and the TTAB should not impose ACR on any unwilling party.

Under ACR “plug and play,” AIPLA proposes that the parties agree to service of all papers by email, or by overnight courier if documents are too large for email transmission. In addition, the parties should be allowed to extend or suspend the ACR schedule for good cause shown, including settlement discussions, by filing a stipulation through ESTTA, subject to approval by the TTAB. For any unconsented motion to extend or suspend an ACR case (e.g., in view of a civil action or other proceeding between the parties), the moving party should first meet and confer with the adverse party before seeking leave from the TTAB to have the motion determined by telephone conference hearing. The parties may also submit stipulations of undisputed facts and evidence at any time before the deadline for plaintiff’s main trial brief.

In addition, the parties should maintain the right to make all substantive arguments and evidentiary objections in their trial briefs as currently allowed under the Trademark Rules, TBMP § 707, and Fed. R. Evid. The parties may, however, be precluded from filing a separate appendix of objections with their trial briefs. Under the proposed ACR “plug and play” options below, the parties waive the right to file a request for reconsideration of a TTAB final decision. However, the TTAB’s final determination of an ACR case may be appealed to the Court of Appeals for the Federal Circuit or by civil action as currently allowed under 37 C.F.R. § 2.145.

B. Proposed ACR “Plug and Play” Tracks or Options

1. The Fast Track: Summary Judgment Style Briefs and Declaration Testimony

The parties may elect this fast track through ESTTA before the opening of the discovery period. Under this track, the parties would opt out of the standard disclosure/discovery/trial model in favor of an expedited summary judgment style proceeding. This option contemplates summary judgment style trial briefs within the page limitations currently allowed for such motions (e.g., twenty-five (25) page main brief and ten (10) page reply brief), and declaration testimony, including exhibits, from one or two witnesses. There would be no discovery, deposition testimony, cross-examination, experts, notices of reliance, or oral hearing under this track. Further, the parties would agree that no other motions will be filed, except as indicated under the general guidelines above. Under this track, ESTTA may generate an automatic order/schedule setting the deadline for the plaintiff’s main trial brief sixty (60) days from the date of the order instituting ACR; defendant’s trial brief thirty (30) days thereafter; and plaintiff’s rebuttal trial brief due fifteen (15) days thereafter. Given the shorter trial briefs and limited record, the TTAB should issue a final decision within thirty (30) days after a reply brief is filed (or if no reply brief is filed, after defendant’s trial brief is filed).

2. The Fast Track: Summary Judgment Style Briefs, Declaration Testimony, and Notices of Reliance

The parties may elect this fast track through ESTTA before the opening of the discovery period. Under this track, the parties would opt out of the standard disclosure/discovery/trial model in favor of an expedited summary judgment style proceeding. This option contemplates summary judgment style trial briefs within the page limitations currently allowed for trial briefs (e.g., fifty-five (55) page main brief and twenty-five (25) page reply brief), and declaration testimony, including exhibits, from one or two witnesses. There is no discovery, deposition testimony, cross-examination, expert testimony, or oral hearing under this track. Further, the parties agree that no other motions will be filed, except as indicated under the general provisions above. The parties have the option of filing notices of reliance concurrently with their trial briefs. Under this track, ESTTA may generate an automatic order/schedule setting the deadline for the plaintiff’s main trial brief sixty (60) days from the date of the order; defendant’s trial brief thirty (30) days thereafter; and plaintiff’s rebuttal trial brief due fifteen (15) days thereafter. The TTAB would issue a final decision within sixty (60) days after a reply brief is filed (or if no reply brief is filed, after defendant’s trial brief is filed).

3. Limited Discovery Track: Summary Judgment Style Briefs, Declaration Testimony, and Limited Written Discovery

The parties may elect this track through ESTTA before the opening of the discovery period. Under this track, the parties would opt out of the standard disclosure/discovery/trial model in favor of an expedited summary judgment style proceeding with limited written discovery. This option contemplates summary judgment style trial briefs within the page limitations currently allowed for trial briefs (e.g., fifty-five (55) page main brief and twenty-five (25) page reply brief), and declaration testimony, including exhibits, from one or two witnesses. The parties are allowed one round of limited written discovery, including twenty (20) interrogatories, ten (10) requests for admissions, and ten (10) document requests. The parties are allowed the same time frames to respond to outstanding discovery requests as currently allowed under the rules. Further, the parties may file discovery-related motions as allowed under the current rules. For all discovery-related motions, however, the moving party must meet and confer and comply with the good faith effort requirements under the rules to narrow the issues or resolve the dispute. If the discovery dispute is not resolved, then the moving party must contact the TTAB Interlocutory Attorney via telephone or ESTTA to request telephone disposition of the discovery dispute. The TTAB will not suspend proceedings for resolution of any discovery dispute. However, the TTAB may reset the ACR schedule to accommodate any orders or rulings on such motions. The parties agree that no other procedural motions will be filed, except as indicated under the general provisions above. There is no other discovery, deposition testimony, cross-examination, expert testimony, or oral hearing under this track. ESTTA may generate an automatic order/schedule setting the deadline for limited discovery; plaintiff’s main trial brief is due sixty (60) days after the close of discovery; defendant’s trial brief is due thirty (30) days thereafter; and plaintiff’s rebuttal trial brief is due fifteen (15) days thereafter. The TTAB will issue a final decision within sixty (60) days after a reply brief is filed (or after defendant’s trial brief is filed, if no reply trial brief is filed).

4. Limited Discovery and Testimony Track: Summary Judgment Style Briefs, Declaration Testimony, and Other Discovery and Trial Options

The parties may elect this track through ESTTA at any time before the opening of plaintiff’s testimony period as originally set or reset. Under this track, the parties may opt out of the standard disclosure/discovery/trial model in favor of an expedited summary judgment style proceeding with preset options. This track contemplates summary judgment style trial briefs within the page limitations currently allowed for trial briefs (e.g., fifty-five (55) page main brief and twenty-five (25) page reply brief). It also contemplates that the parties may have engaged in full round of discovery and discovery depositions before opting for ACR. If discovery has not opened, however, the parties may choose to forgo discovery or elect one round of limited written discovery (with the possibility of discovery motions) as set forth in track 3 above. The parties agree that no other procedural motions will be filed, except as indicated under the general provisions above. If the parties have already conducted discovery, and discovery has closed, the TTAB will set the briefing schedule. The parties may submit declaration testimony of one or two witnesses, including exhibits, and notices of reliance concurrently with their trial briefs. There is no other discovery, deposition testimony, cross-examination, or expert testimony under this track. The parties reserve the right to request an oral hearing concurrently with their main trial brief. ESTTA may generate an automatic order/schedule setting the limited discovery (if any) and briefing schedule similar to track 3 above. The TTAB will issue a final decision within sixty (60) days after a reply brief is filed (or after defendant’s trial brief is filed, if no reply trial brief is filed) or after an oral hearing is held.

5. Custom Track

The parties may elect the custom track through ESTTA at any time before the opening of plaintiff’s testimony period as originally set or reset. Under the custom track, the parties and the TTAB have the flexibility to formulate an alternative ACR track tailored to a particular case. The parties are free to agree to whatever arrangements they believe will accomplish their goals, subject to approval of the TTAB. For example, the parties may agree to conduct traditional discovery, and submit declaration testimony in lieu of live depositions under an accelerated schedule. Alternatively, the parties may also agree to build off of an existing track. For example, the parties may choose Track 3 plus 1 deposition per side. Similarly, the parties may stipulate to limited written discovery and deposition(s), declaration testimony of a set number of witnesses, and possible cross-examination by live deposition of any witness. The parties electing the custom track should file a stipulation detailing their proposed plan before opening of plaintiff’s testimony period as originally set or reset. Further, the TTAB may convene a telephone conference to discuss any proposed modifications to the stipulation and/or schedule. Under this track, the TTAB will issue a final decision within ninety (90) days after a reply brief is filed (or after defendant’s trial brief is filed, if no reply trial brief is filed) or an oral hearing is held.

AIPLA appreciates the opportunity to comment on this important proposal. Please contact us if you would like us to provide more details on any aspect discussed above.

Respectfully,

A handwritten signature in black ink that reads "Alan J. Kasper". The signature is written in a cursive style with a large initial 'A' and 'K'.

Alan J. Kasper
President