



## American Intellectual Property Law Association

August 26, 2022

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
ATTN: Chief Judge Gerald Rogers  
VIA E-MAIL – [TTABFeedback@uspto.gov](mailto:TTABFeedback@uspto.gov)

### **Re: Comments of the AIPLA on Proposed Final Pretrial Conference Pilot and Order**

Chief Judge Rogers:

Thank you for requesting the American Intellectual Property Law Association (AIPLA) to provide comments on the proposed pilot program for instituting a Final Pretrial Conference requirement in certain Trademark Trial and Appeal Board (“TTAB”) opposition and cancellation proceedings. AIPLA generally supports the implementation of a Final Pretrial Conference for cases with unusually large records or complex issues and is pleased to provide its comments concerning the proposed pilot program and form of Final Pretrial Conference Order.

AIPLA is a national bar association of approximately 7,000 members that include trademark attorneys and trademark owners, as well as other IP professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of trademark, patent, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that allow trademark stakeholders to protect their marks in an efficient, reasonable, and cost-effective manner.

1. ***Overall comment about the proposed pilot program.*** AIPLA supports the pilot program to give the TTAB an opportunity to evaluate its potential effectiveness. AIPLA recognizes the burden placed on TTAB Administrative Judges and staff when cases with large, unfocused, and unwieldy records are presented for decision. Not only are such cases likely to be more difficult

to evaluate and decide, but the costs for the litigants in those cases is likely higher, and the time required to be devoted to such cases by the TTAB is likely to affect the efficient resolution of other cases by extending the pendency of those cases from final submission to the issuance of a decision. For these reasons, AIPLA supports the TTAB in studying and evaluating ways to make these cases more efficient.

At the same time, AIPLA recognizes the burden and expense imposed upon the parties by the final pretrial order requirements in federal court litigation. Federal court practitioners understand that the preparation and submission of a final pretrial order is a substantial undertaking that is often very expensive for the litigants, especially in large or hotly contested cases. Because TTAB opposition and cancellation proceedings are intended to be streamlined proceedings not rising to the level of full-blown federal court litigation, AIPLA recommends caution in adopting identical or nearly identical pretrial order requirements as exist under federal court procedures. AIPLA provides more specific comments about the form of the Final Pretrial Conference Order (FPC Order) below.

2. ***Final Pretrial Conference Logistics.*** The explanation regarding the pilot found on the TTAB web page states the Final Pretrial Conference will be presided over by the Interlocutory Attorney assigned to the case and one Administrative Judge who will serve on the panel deciding the case. AIPLA agrees with this approach and believes it is likely to assist the parties and their counsel in presenting a more focused case.

It also states the Final Pretrial Conference will take place sometime after the close of discovery but before the usual deadline for the plaintiff's pretrial disclosures,<sup>1</sup> with the FPC Order to replace the pretrial disclosures otherwise required under Rule 2.121(a). Under current practice, the plaintiff's pretrial disclosures are due 45 days after the close of discovery. The TTAB's proposed schedule would not give the parties much time to meet and confer and prepare the FPC Order prior to the Final Pretrial Conference. The parties typically have a longer period of time in federal court cases because there is usually time built into the schedule for the filing of dispositive motions between the close of discovery and the submission of the final pretrial order. If the form FPC Order, as currently proposed, is adopted for the pilot, then AIPLA

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<sup>1</sup> The third paragraph in the Background section describing the pilot on USPTO's webpage begins, "At the end of discovery, most federal district courts conduct a Final Pretrial Conference (FPC)." This is not technically correct because these conferences are usually held months after the close of discovery, not at the very end of discovery. To be more precise, the TTAB may wish to modify its language here, such as by saying, "Some time after the end of discovery, . . . ."

recommends the parties have at least 60 days to prepare and submit the FPC Order given the voluminous information required. The Final Pretrial Conference could be scheduled within one to two weeks after submission of the FPC Order.

Under current practice, certain motions, such as a motion to compel discovery and motion for summary judgment, are due the day before the date of pretrial disclosures. Because the FPC Order would be in lieu of pretrial disclosures, will the deadline for these motions be tied to the filing of the FPC Order? We suggest that the TTAB clarify how the selection of a case for the pilot will affect the deadline for these motions.

It will also be important for the parties in litigation selected for this pilot to receive notice of that selection as early in the proceedings as possible. While it may be possible for the TTAB to identify cases early on that have exhibited contentious motion practice, AIPLA questions how the TTAB will identify other cases likely to have large, unfocused, and unwieldy records prior to the close of discovery if there has been little or no such motion practice. To the extent there may be other objective criteria, such as cases involving a certain number of applications, or registrations, or asserted claims, it may be helpful for the TTAB to explain those criteria in the website description of the pilot and the initial case scheduling order.

The TTAB may also wish to direct the parties to discuss whether they consider their case appropriate for inclusion in the pilot at their initial discovery conference and agree to opt into the procedure, or otherwise to provide the parties the option to request participation in the pilot at some time prior to the close of discovery. However, if the parties do not stipulate to be included in the pilot, and only one party requests inclusion of the case in the pilot, the TTAB should not include the case if it appears the requesting party seeks a tactical advantage in doing so (such as forcing the other party to incur the additional expense as a means to leverage a dismissal or settlement of the case).

3. ***FPC Order.*** The proposed form of FPC Order is comprehensive and goes beyond what is required in some federal district courts. Because TTAB proceedings are intended to be streamlined and more economical than federal district court litigation, AIPLA recommends that the TTAB consider adopting a more streamlined order. Specific comments on certain sections of the proposed order are provided below:

**Sections III and IV – Nature of the Case; Issues to Be Tried** - While AIPLA understands the goal of attempting to have the parties agree upon a neutral, non-argumentative

summary of the case and an agreed statement of issues to be tried, this is often difficult in contested cases. Frequently, the parties cannot agree upon a neutral statement, or even on what issues are to be tried. For this reason, the parties in federal court litigation often present separate statements of the case and issues. AIPLA suggests that a more practical approach would be to have the parties identify the claims and defenses they believe should be tried. Based on these statements, a discussion can take place at the Final Pretrial Conference to try to achieve consensus.

**Section V – Parties’ Contentions and Disputed Issues** - AIPLA does not support a requirement to include proposed finding of fact and conclusions of law in the FPC Order. Requiring the parties to list all proposed factual findings and conclusions of law at this stage would be premature, unduly burdensome, and may unfairly prejudice one or both parties. Moreover, arbitrarily limiting the parties to no more than 30 statements seems inappropriate before the issues are determined. The number of marks, claims, and defenses involved may require more. Further, because testimony will not yet have been submitted, certain facts or issues may not yet be clear in the record. This requirement would also impose substantial additional expense on the parties, which might be avoided if the parties settle the dispute after going through the Final Pretrial Conference process. To the extent the TTAB believes a particular case would benefit from the submission of proposed findings of fact and conclusions of law, AIPLA submits it would be more productive and efficient if these are filed *after* the close of the testimony periods and *before* the plaintiff’s opening brief is due.

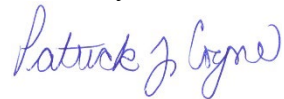
**Sections X, XI, XVI, and XVII – Witnesses** - These sections governing the parties’ fact and expert witnesses could be consolidated, and each party’s witness list could be attached as a separate exhibit to the FPC Order containing the information required about each witness.

**Sections XII, XIII, and XIV – Exhibits** - Similarly, these sections concerning the parties’ exhibits could be consolidated, and each party’s exhibit list could be attached as a separate exhibit to the FPC Order. For this purpose, additional time is required for the parties to exchange, compile, and enumerate their exhibits, eliminate duplicates, and state objections. The summary under Section XIII suggests that a party may delay providing the other party with a copy of its exhibits until 5 business days before the plaintiff’s opening trial period. That makes little sense if the parties have already conferred about exhibits and would likely invite unnecessary motions and objections. AIPLA suggests that a deadline be set after the close of

discovery for the parties to exchange both their initial trial exhibit lists and copies of the exhibits (if not already produced in discovery). This deadline should be sufficiently prior to the deadline to submit the FPC Order to afford the parties enough time to review them for objections and make any adjustments to their own exhibits based upon what is initially disclosed by the other party. AIPLA recommends at least 30 days after the close of discovery for the initial exchange. To the extent any party seeks to introduce and use any exhibit after the FPC Order is filed (other than for impeachment), it should be required either to obtain the agreement of the other party or an order from the TTAB allowing its submission for good cause.

Thank you for the opportunity to provide these comments and suggestions, and we are pleased to respond to any questions you may have.

Sincerely,

A handwritten signature in blue ink that reads "Patrick J. Coyne". The signature is written in a cursive, flowing style.

Patrick J. Coyne  
President  
American Intellectual Property Law Association