1. **An FPC Would Impose Significant Burdens on the Parties and Its Use Should Be Limited.**

While the Board is authorized to determine a party's right to register a trademark with the federal government, the Board is not authorized to determine whether an entity has the right to use a trademark and is not authorized to issue injunctions halting use. The Board is also not authorized to determine questions of trademark infringement or unfair competition or to award monetary damages or attorney's fees. For a trademark-related order other than determining the right of federal registration, a party must proceed in federal or state court.

Given the limited nature of questions the Board has the power to decide, a TTAB proceeding may not necessarily require the discovery, evidence, and resources that would be needed to decide the additional questions which may be at issue in a district court proceeding. District court procedures intended to manage complex matters are not a perfect analogy for the Board and are likely to impose significant and unexpected pretrial burdens on the parties, who will also face the potential for waiving arguments, claims and defenses.

The Board recognizes that the pilot is not intended for every *inter partes* case that goes to trial, and that many TTAB cases are handled efficiently with small or modest records. IPO agrees that most TTAB cases are not complex and believes that a pretrial conference would be beneficial to the management of only a relatively small number of matters.

2. **The Criteria for Inclusion in Pilot Program Should Be Consistent with Trademark Rule 2.210(j)(2).**

Trademark Rule 2.120(j)(2) gives the Board authority to direct a pretrial conference "whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical . . ." 37 C.F.R. § 2.120(j)(2). IPO believes that situations where parties or counsel are unfamiliar with TTAB practice and could benefit from assistance to help them focus their claims are not "questions or issues . . . [that] have become so complex."

The proposed grounds for inclusion in the Pilot Program do not appear to be consistent with this Rule and indeed suggest that TTAB may have made some early conclusions about the merits of a particular matter prior to the FPC. As proposed, the Pilot Program will focus on cases in which:

> (A) there are a large number of claims/defenses that may be unwarranted or unlikely to be pursued successfully at trial; (B) the parties or counsel are unfamiliar with TTAB practice and could benefit from assistance to help them focus their claims, defenses, or factual and legal issues, or to understand the rules; or (C) early proceedings have been overly contentious, or have generated too many contested motions.

Determining whether a claim or defense is "unwarranted" is a decision on the merits, as is whether a claim or defense is "unlikely to be pursued successfully at trial." In addition, the concept of how many contested motions are "too many" is vague, since there is currently no limit in the Trademark Trial and Appeal Board Manual of Procedure on the number of motions a party can bring before the Board. Using "too many" motions as a criterion could serve to inhibit appropriate motion practice.

IPO suggests that the TTAB instead provide concrete, objective descriptions of criteria for inclusion in the pilot program that may make a proceeding complex and appropriate for inclusion in the pilot program, such as:

(a) Where the matter involves a large number of claims or defenses; or
(b) Where record reflects an inability of the parties to come to agreement on procedural questions.

3. **The Administrative Trial Judge Should Not Counsel Inexperienced Parties During FPC**

The TTAB's explanation of how the pilot program would work states that initial attention will be on cases in which, among other items, "the parties or counsel are unfamiliar with TTAB practice and could benefit from assistance to help them focus their claims, defenses, or factual and legal issues, or to understand the rules."

The TTAB is a neutral body that functions like a court for trademark matters at the USPTO, and the Board's administrative trademark judges are authorized to determine a party's right to register a trademark with the federal government.

IPO believes the TTAB should not provide coaching which would serve to benefit one party over another, such as assistance benefitting only inexperienced parties or counsel. It is appropriate for an ATJ to accept or reject all or portions of a draft FPC order and to recommend that unrepresented parties seek representation. However, IPO believes that a neutral trier of fact should not provide a party or its counsel with advice or instruction on proper pleading or introduction of evidence or other aspects of practice before the TTAB.

4. **An In-Person Conference Imposes Burdens on the Parties.**

Attending an in-person conference or conferences with an ATJ at the Board's offices in Alexandria, Virginia is likely to add significant cost and expense for parties. The cost burden of such appearances would have a disproportionate geographic impact on the significant number of trademark practitioners and parties not located within driving distance of the Board.

To reduce at least some of these additional expenses, IPO suggests that the Pilot Program require the parties to confer and propose a final joint pretrial order to the Board. Only to the extent that the Board determines that an in-person conference with an ATJ and the parties would be helpful in the management of the case should such a further conference be ordered.