

UNITED STATES PATENT AND TRADEMARK OFFICE

TTAB REPORT ON COMMENTS FOR NPRM

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Chief Administrative Trademark Judge  
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Deputy Chief Administrative Trademark Judge  
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Administrative Trademark Judge  
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KAREN KUHLKE  
11 Administrative Trademark Judge

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14 Chief Clerk

15 Outside Participants:

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## 1 P R O C E E D I N G S

2 (1:12 p.m.)

3 MS. BUTLER: Good afternoon, I'm Cheryl  
4 Butler and welcome and thank you for sharing your  
5 busy afternoon with us as we report out on the  
6 comments to the TTAB's proposed changes in its  
7 rules of practice. And I also want to thank  
8 everybody for being patient. We have -- we were  
9 waiting for some people to get through security  
10 and I think they're still on their way up but  
11 we'll just have them join us a few minutes late.

12 Now before we begin, I have two  
13 announcements. Today the 2016 update of the TBMP  
14 was posted online at the TTAB's homepage. It is  
15 available in the searchable electronic version.  
16 We are working on getting the pdfs posted but we  
17 ran into an unexpected but small problem this  
18 morning that we're trying to resolve. So if you  
19 see the pdf link is not active when you go there.

20 And also today the updated and amended  
21 standard protective order goes into effect. It is  
22 also available on the TTAB's homepage. The

1 retired order will remain posted and eventually  
2 will be found under an archive link that we have  
3 not provided yet. As you are aware, there are  
4 some exceptions to the effectiveness of the  
5 amended protected order in certain cases but  
6 that's also information is also available online  
7 on that.

8 Well, the journey that led us here today  
9 began at least in 2007 with the amended rules of  
10 practice by which the TTAB adopted a disclosure  
11 practice, encouraged electronic filing and I'd  
12 like to mention at that time ESTTA was not very  
13 old having first come online December of 2002. We  
14 also encouraged the communications between the  
15 parties electronically and we offered a modified  
16 schedule for disclosure and to accommodate  
17 settlement and the communications between the  
18 parties.

19 Well since then, the federal rules of  
20 civil procedure were amended more than once and  
21 the TTAB's practices and processes have evolved.  
22 Many things worked well. I know participation of

1 Board attorneys in discovery conferences and phone  
2 conferences on contested matters is welcome and  
3 people enjoy the active case management and  
4 appreciate it very much.

5 We increased the flexibility on  
6 introducing evidence and we have found a sort of  
7 right-sizing of how long Board proceedings take.  
8 So unrelated to the comments we received for this  
9 NPRM, we often get comments that the Board  
10 proceedings take about the right amount of time  
11 for most people most of the time. And we even get  
12 comments, well, I wasn't expecting that  
13 determination quite this quickly. So I think that  
14 all bodes very, very well.

15 And in the meantime, we have also seen  
16 efficiencies that we attribute to accelerated case  
17 resolution which includes the parties' willingness  
18 to work together and creatively while advocating  
19 their adverse positions on the substance of the  
20 controversy between them. And as always happens  
21 in life, some things do not work as well as we had  
22 hoped and they resulted in some unintended

1 consequences.

2           We arrived at a point where it made  
3 sense to propose amended rules, to reflect the  
4 efficiencies involved in technology, the  
5 continuing efficiencies and in communications, and  
6 to expressly incorporate certain aspects of the  
7 federal rules which we think by expressly  
8 incorporating them will emphasize their importance  
9 as well and to conform to current practices and  
10 terminology.

11           Credit goes to so many. Starting a few  
12 years ago the TTAB judges, attorneys, paralegals,  
13 information specialists, IT specialists and data  
14 analytic specialists contributed their thoughtful  
15 ideas and their hard work. And we sought the  
16 perspectives of those who practiced before us and  
17 the input of other USPTO units.

18           We started a few years ago as well with  
19 a large team of people working on the proposals we  
20 were looking at and the team became smaller and it  
21 became even smaller as we went ahead to write the  
22 NPRM that you have a chance to look at and comment

1 on.

2           So well, what is a report out? After  
3 all, you've read the proposals and the comments  
4 and you've come to some conclusions. So we want  
5 to let you know that we are purposely considering  
6 the comments so we do not have responses now. But  
7 we instead have summarized and categorized the  
8 comments particularly those with the most common  
9 themes. And we may ask for some clarification and  
10 for some examples and I do want to say in  
11 addition, that we did receive comments concerning  
12 subject matters that were not within scope of our  
13 proposals. And while we're not able to consider  
14 those suggestions for the purposes of this  
15 proposed rule package, they certainly will be  
16 retained and considered at least informally as we  
17 go forward.

18           Now for some logistics. If you wish to  
19 speak, please say your name. And if you are  
20 representing a stakeholder group, the name of the  
21 group and please remember to turn your mic on when  
22 you're speaking and turn your mic off when you are

1 not. And we can remind each other because I know  
2 I will forget, too.

3 If you are online, please send your  
4 questions or points through the chat feature and  
5 not through the Q and A feature. And if you're  
6 having technical difficulties or later encounter  
7 technical difficulties or get an IM or a text  
8 message from somebody you know who's having  
9 technical difficulties, please have them call the  
10 help desk at 571- 272-9000.

11 So I'd like to introduce the judges who  
12 did the major lift in putting the NPRM together  
13 and who will lead us in the report out. To my  
14 right, if I got my -- I always get my right and  
15 left backwards, is Karen Kuhlke. Karen had to  
16 learn a new language called RegText and it  
17 definitely involves asterix as you can see in the  
18 NPRM. And she was also instrumental in putting  
19 together the background portion of the NPRM.

20 Susan Hightower is to her right and  
21 Susan helped us keep organized and used her former  
22 skills as a journalist putting together the

1 discussion of the proposed rules and the NPRM in a  
2 clear way.

3           And to her right is Cynthia Lynch.  
4 Cynthia became a judge less than a year ago and we  
5 immediately enlisted her to work on the proposed  
6 rules because of her experience at the trademark  
7 operation in rulemaking and her ability to make  
8 sense of the Paperwork Reduction Act  
9 considerations. Thank you.

10           And before I turn it over to Cynthia,  
11 who will start first, I also would like to  
12 introduce over here to my left Denise DelGizzi who  
13 is our Chief Clerk of the Board. Denise continues  
14 to provide input and guidance on the processes  
15 within the office that make things work smoothly  
16 behind the scenes.

17           With that said, Cynthia, I go to the  
18 first slide for you, is that correct? I think I'm  
19 in charge of that.

20           MS. LYNCH: Okay, great.

21           MS. BUTLER: Is this the one we want to  
22 start with?

1 MS. LYNCH: We can do that. I think  
2 this is really just a slide kind of giving you an  
3 overview of what the volume of comments were and  
4 generally who they were from and the fact that the  
5 first bullet there deals with the formal comments  
6 that we received. And the second bullet shows you  
7 that there were also informal comments that were  
8 made in the media, in blogs, in newsletters and  
9 we're aware of many of those, too.

10 So we're going to talk about some of the  
11 more robust areas of comment, in particular, ones  
12 that we got a lot of comments on and certainly one  
13 of the biggest was electronic filing or ESTTA.  
14 The proposed rules mandate electronic filing in  
15 Board proceedings and kind of interestingly, I  
16 thought, this was something that was really -- we  
17 got almost, I would say, unanimous support for the  
18 general proposition that electronic filing and  
19 Board proceedings as the norm sounded perfectly  
20 fine.

21 And in addition to many comments  
22 explicitly stating general support, we did not

1 have any commenter who objected to that as the, at  
2 least, the default rule. I think it reflects a  
3 recognition that in the world we're in today as  
4 opposed to those of us who have been at or around  
5 the PTO for many years and this wasn't always the  
6 case. People really recognized that it's a  
7 win-win all the way around for electronic filing  
8 at least when it's working smoothly, which leads  
9 me to the next slide on some of the concerns  
10 because although certainly there was general  
11 support, there were concerns expressed.

12 One set of concerns revolved around  
13 ESTTA itself and what are some of the perceived  
14 limitations with ESTTA. So one of the areas of  
15 concern really dealt with the size limitation for  
16 attachments in ESTTA. And then, there was a  
17 concern about in situations where there are  
18 voluminous attachments or something that might  
19 exceed the size limitation, would an exception be  
20 made and what, you know, are the circumstances of  
21 that exception.

22 I think that some of the considerations

1 that we would like everybody to keep in mind are  
2 that the size limitations that's in ESTTA which is  
3 53 megabytes is pretty substantial. Also we have  
4 some really good technical tips that can be found  
5 through the links within ESTTA that help make the  
6 most of the size limitation that is available.

7           So for example, avoiding color  
8 attachments which take of lot of size and are  
9 going to be translated into black and white  
10 anyway, so using, you know, some of those tips to  
11 help maximize the size limitation that's there.  
12 And then, another thing to keep in mind is that if  
13 all else fails, there is the option to break  
14 filings into multiple or break attachments into  
15 multiple filings in order to work around the size  
16 limitation.

17           Although we certainly are considering  
18 the concerns and comments that were raised in this  
19 regard, there also is a reality that if a paper  
20 filing exception is made for that kind of  
21 situation, it does really just shift the burden to  
22 the PTO to scan the voluminous paper filing and

1 put it into the system. So you know, at some  
2 point the burden is going to fall on someone. So  
3 if we can arrange for the electronic filing on the  
4 front end, we're certainly looking to do that.

5 So in addition to the file size  
6 limitation, another area of concern about a  
7 perceived ESTTA limitation was it's not configured  
8 to accept multimedia attachments. So we had some  
9 comments about that and suggestions that perhaps  
10 ESTTA be enhanced to accept multimedia  
11 attachments. Again, I think those comments and  
12 concerns will be taken into consideration.

13 Right now it's my understanding that  
14 it's relatively infrequent that we have that type  
15 of evidence, the decisions of the Board are  
16 typically done on the written record and although  
17 I think they sometimes are submitted by other  
18 media, my understanding is that's not a frequent  
19 request that we're running across.

20 Last I think just on this slide I wanted  
21 to mention that we did have some concerns  
22 expressed about the provision and the rules

1 regarding the ESTTA cover sheet versus pleadings  
2 that may be inconsistent with the ESTTA cover  
3 sheet in Section 66A or Madrid protocol cases that  
4 are being opposed. And so, I wanted to mention  
5 that use of ESTTA has been mandatory for filings  
6 for either extensions of time to oppose or notices  
7 of opposition in 66A cases. And the requirement  
8 has been in place because that facilitates our  
9 ability to fulfill our obligations under the  
10 Treaty to notify the International Bureau at WIPO  
11 about the notices of opposition and the grounds  
12 for opposition.

13 And so the reason for the provision that  
14 is in the proposed rule sort of codifying that the  
15 grounds for opposition in the ESTTA cover sheet  
16 are going to control is again just to facilitate  
17 that accurate and timely notification that happens  
18 automatically and electronically when we transmit  
19 that data to the International Bureau at WIPO.

20 I was going to move on next and talk a  
21 little bit about the technical difficulties or  
22 extraordinary circumstances exception to

1 electronic filing but were there any questions or  
2 comments about the prior issues that I just  
3 covered about the size limitations or about  
4 multimedia?

5 MS. KUHLMKE: I was going to just jump in  
6 real quickly. So that I'm sure most people know  
7 to understand what our obligation is as the  
8 Agency, those electronic files are the official  
9 record of the file. So for example, MP3s or video  
10 you want to send in a commercial, it's very  
11 difficult for us to consider that part of the  
12 official file of the record and make it available  
13 to the public. So it's another reason in terms of  
14 the large paper filings that you're trying to scan  
15 and get to us, this is why we must then scan it in  
16 if you send it to us in paper and it must be in  
17 electronic form. That's it.

18 MS. LYNCH: Thanks. Anyone else? Okay.  
19 Well, so the other big area of concern in the  
20 comments with our mandatory electronic filing, I  
21 will say the proposed rules already built in an  
22 exception to the mandatory rule for situations

1 where and I'll quote the proposed rule language,  
2 "When ESTTA is unavailable due to technical  
3 problems or when extraordinary circumstances are  
4 present."

5           So in that scenario we were allowing for  
6 a paper filing but the paper filing had to be  
7 accompanied by a petition setting out what the  
8 technical difficulty is, what the extraordinary  
9 circumstances were that justified the exception.  
10 So we have some commenters who objected to the  
11 petition requirement across the board and felt  
12 that that was too burdensome. There were others  
13 who were okay with the petition requirement but  
14 not okay with a fee being charged for the  
15 petition.

16           And then, one commenter pointed out that  
17 for at least one filing which was a combined  
18 opposition and petition to cancel, there is no  
19 designated ESTTA form and that paper filing would  
20 therefore be necessary and why should any  
21 extraordinary measures be required in a scenario  
22 like that.

1           I guess just to unpack some of the  
2 concern a little bit and there were definitely  
3 folks who alluded to this or mentioned it in their  
4 comments, we occasionally have system outages and  
5 we had one that took place in December. And in  
6 fact, I think we even referred to that in the  
7 notice of proposed rulemaking and acknowledged  
8 that, you know, that is a situation where we  
9 occasionally do have ESTTA unavailable due to our  
10 own technical difficulties.

11           So some of our commenters really just  
12 wanted assurances that if situations like those  
13 arise, that they could file on paper without any  
14 fee and without a particularly burdensome  
15 procedure being required. As I mentioned, there  
16 are a subset of the commenters wanted to avoid the  
17 petition process altogether and were advocating  
18 maybe a procedure where they could just make a  
19 statement in whatever the paper filing was about  
20 why they were filing on paper. Perhaps have it be  
21 foregone that the paper would be accepted rather  
22 than having what they consider some uncertainty

1 associated with whether the paper filing would be  
2 accepted.

3           Then I think we had commenters who were  
4 interested in exploring or having clarification  
5 that when the technical difficulties were not on  
6 the PTO's end but rather were on the filer's end  
7 would that be a situation where an exception would  
8 be granted? Would they have to be charged a fee?  
9 And certainly some of the commenters felt that  
10 they also should have a very flexible liberal  
11 exceptions made and, again, you know, not have to  
12 pay a fee if they were experiencing technical  
13 difficulties.

14           I think, you know, we'll carefully  
15 consider all the points made by the commenters  
16 about these situations. As I said, we mentioned  
17 and acknowledge that certainly we're aware we do  
18 have system outages at some time and we want to  
19 make it as predictable and easy on our users when  
20 we do encounter those kinds of situations. So  
21 it's certainly something that we're going to  
22 continue to look at when we formulate the final

1 rule.

2 Is there anyone who had additional  
3 comments or any questions about that area of  
4 comment?

5 MS. RICKETTS: You had mentioned the  
6 inability to file a combined opposition and  
7 cancellation, that that was not available. That  
8 wasn't one of the things that you then revisited  
9 in saying that that would be taken into  
10 consideration.

11 MS. LYNCH: Oh, yes.

12 MS. RICKETTS: The fact that it's plan  
13 not available in ESTTA.

14 MS. LYNCH: Right. Yes, no, we'll  
15 definitely be taking account of that and making  
16 some kind of provision for it either in ESTTA or  
17 in the final rules. Anyone else? Okay.

18 MS. BUTLER: All right, thank you,  
19 Cynthia.

20 MS. LYNCH: I'm still --

21 MS. BUTLER: Oh, you still have another  
22 to go.

1 MS. LYNCH: I'm still going yeah.

2 MS. BUTLER: Oh my goodness, all right  
3 then.

4 MS. LYNCH: So moving on from electronic  
5 filing to the next -- another major area of  
6 comment. We've called this embracing the  
7 electronic world but dealt with board service of  
8 the complaint and email notification of orders  
9 issued during a proceeding. Again, in general,  
10 the public reaction to the Board going back to its  
11 pre-2007 practice of handling service of the  
12 complaint was overwhelmingly positive and we had  
13 not a single commenter who wanted the burden to  
14 remain on the plaintiff to have to handle the  
15 service. Not surprising.

16 And also we had no objection to the  
17 codification of our existing practice of emailing  
18 orders that issue throughout the course of the  
19 proceeding. I'll mention that ESTTA filers may  
20 enter multiple email addresses in their filings  
21 and any orders are then sent to all of the emails  
22 addresses that are provided. And I think there's

1 guidance within ESTTA on this practice and  
2 encouraging the parties to ensure that the email  
3 address information that they are giving us is  
4 accurate and remains current.

5           Next slide. This was not an area  
6 without concerns. So I'll talk a little bit about  
7 what some of those were. Email notification of  
8 the institution of proceedings. This is already  
9 done with oppositions when an applicant has  
10 authorized email. But in looking at doing this  
11 more expansively and potentially doing this with  
12 cancellation proceedings, we did have some  
13 concerns expressed about whether email  
14 notification and I think this was particularly a  
15 concern for pro se parties, whether an email  
16 notification sufficiently conveys the seriousness,  
17 the gravity of this proceeding and the fact that  
18 they are going to need to take action to defend  
19 their rights.

20           Another area of concern with this was  
21 just the very practical concern about delivery of  
22 the email and the fact that email delivery, as we

1 know, may fail for a number of reasons including  
2 spam filters, for example and that it is somewhat  
3 difficult to verify the receipt of email. Now  
4 sometimes we have email that's returned as  
5 undeliverable but I think the points being made by  
6 commenters are we may have some instances where  
7 the email actually doesn't reach its recipient but  
8 it's not returned to us as undeliverable. It's  
9 lost in cyberspace. So that was an area of  
10 concern.

11           Also and this is something that the PTO  
12 has struggled with in other areas as well, I think  
13 we all know that many of our users at the PTO are  
14 subject to a barrage of solicitations relating to  
15 their applications or registrations and that there  
16 have been some situations where the solicitations  
17 really resemble and are designed to resemble USPTO  
18 communications. And so that can be a cause for  
19 confusion and to the extent that parties and  
20 clients have maybe been given the advice to, you  
21 know, really watch out for these, that they may  
22 mistake an email that is legitimately from the PTO

1 notifying them about the institution of  
2 proceedings for one of these solicitations.

3 I will mention that I think the Agency  
4 has tried to do what it can in terms of warning  
5 folks but at the same time, making sure that they  
6 do pay attention to the communications that are  
7 legitimately coming from the Agency. But one of  
8 the suggestions that we received was to look at  
9 maybe putting some specific information that would  
10 go along with the registration certificate when it  
11 issues for registration owners, that email  
12 communication might be used to inform them about a  
13 challenge to their registration down the road. So  
14 that's also something we'd be looking at.

15 We had requests for clarification about  
16 the default procedures. So if email notification  
17 were used and there appeared to be a default, you  
18 know, what procedures, if any, would we be taking  
19 before entering judgment and, you know, would that  
20 involve any non-email communication.

21 And then, I think I'm ready to move to  
22 the next slide. As I mentioned, the real concern

1 in this area seemed to rest probably more strongly  
2 regarding petitions to cancel. Our proposed rules  
3 provided that the Board service of the complaint  
4 could be effected by email when the party had  
5 provided an email address for communication with  
6 the PTO and that the service would consist of  
7 sending an email with a link to TTAB view to look  
8 at the petition. A copy of the institution notice  
9 would also go to the petitioner by email if an  
10 address had been provided.

11 So there were some commenters looking  
12 for further clarification regarding which email  
13 addresses or which addresses would be used for  
14 this purpose. And they really highlighted the  
15 usefulness on our end of using terminology that  
16 matches the terminology that appears in our  
17 publicly available USPTO databases so that if  
18 users want to go in and see what address would be  
19 used, is it the current address is it accurate  
20 that they're able to tell clearly from the  
21 language in the rule or some explanatory language  
22 on the rule notice which data fields basically we

1 would be using.

2 Just as an example, in our TSDR system  
3 we have current owner information field. We also  
4 have an attorney/correspondence field and then,  
5 within that there may be correspondent information  
6 and there may be attorney information. So really  
7 just commenters were looking for clarification and  
8 transparency about what we would be using and  
9 doing this type of email service.

10 Another big area was identifying known  
11 counsel for the respondent and the provision in  
12 our proposed rules that plaintiffs in cancellation  
13 proceedings would have to include the name,  
14 address and email address of any attorney. And  
15 I'll quote the proposed rule language again,  
16 "Reasonably believed by the petitioner to be a  
17 possible representative of the owner in matters  
18 regarding the registration."

19 The goal of the requirement was to  
20 assist the Board in locating and notifying the  
21 proper party and this often occurs, you know, this  
22 type of provision of owner information often

1 already occurs in our current practice and we were  
2 looking to put it in the rule. We had some folks  
3 who were concerned about the way the  
4 responsibility was phrased. In general, I don't  
5 think there was an objection from anyone that if  
6 there is known counsel that they had a problem  
7 with providing that information to the office.  
8 But there was a concern whether there was any  
9 intent on our part to impose a due diligence  
10 requirement to have parties go out and research  
11 who might be possible counsel for the owner.

12 So they were suggesting alternate rule  
13 language for that or at least some clarification  
14 in the final rule notice that this was just for  
15 the purpose of identifying counsel who were  
16 already known.

17 We also had some suggestions that in  
18 situations where our proposed rules were already  
19 providing that the service would go to, for  
20 example, a domestic representative already, you  
21 know, current and shown in our database, or in  
22 cases of Madrid-based registrations where the

1 designated representative through the IB would be  
2 used, that in those cases, the filer ought to be  
3 excused from having to provide any other contact  
4 information or attorney information.

5 We also had some concerns expressed kind  
6 of on the end of the attorney who might be  
7 identified as a possible representative of the  
8 owner but who is, in fact, not representing the  
9 owner in matters relating to the registration at  
10 that time and seeking clarification about what, if  
11 any, their responsibilities would be, what actions  
12 should they take.

13 I think the notice of proposed  
14 rulemaking already recognized that there might be  
15 those scenarios and that we were not in any way  
16 assuming that this person was the attorney for the  
17 owner until the attorney appeared. But clearly  
18 there could be situations, and I think this was  
19 the focus of concern of the commenters where the  
20 attorney is receiving a notice and isn't, again,  
21 representing the client and wants to know what to  
22 do.

1           Are there comments or questions about  
2 any of these areas before I move on to the next  
3 one? Okay, I'm actually on it, yeah.

4           And then, the last area that I was going  
5 to talk about is service between the parties. So  
6 another aspect of promoting electronic  
7 communication that is included in the rules was  
8 that service of documents between parties and  
9 Board proceedings would be by email.

10           This is largely reflective of current  
11 practice but, again, would become mandatory and  
12 just as with the electronic filing with the  
13 office, we really didn't have any general  
14 objections to this as the default rule. So it was  
15 a pretty positive response to email as the default  
16 form of service.

17           But there were concerns. The proposed  
18 rule had already built in an exception for  
19 circumstances where service by email was attempted  
20 but couldn't be made due to technical problems or  
21 extraordinary circumstances. In this scenario the  
22 party who was then serving on paper or by some

1 other method would just include a statement as to  
2 why in that filing.

3           So there was no petition involved here  
4 but we did have requests to clarify or perhaps  
5 provide examples of when this exception to email  
6 service might apply. One area that seemed to be  
7 of particular concern was again back to voluminous  
8 documents and situations where the documents being  
9 served might be so voluminous that email service  
10 might present a problem because of size  
11 limitations.

12           MR. HUDIS: Cynthia?

13           MS. LYNCH: Uh-huh?

14           MR. HUDIS: As I read the proposed rules  
15 changes, there was a provision for service by  
16 other means.

17           MS. LYNCH: Right, the parties -- yes,  
18 absolutely. But default with email the parties  
19 could always agree to service by an alternative  
20 means and then, the exception was there even where  
21 the parties hadn't agreed on an alternative method  
22 of service but for some reason the serving party

1 ran into some inability to serve by email, this  
2 exception was provided to go ahead, you know, I  
3 guess unilaterally and explain why it wasn't  
4 possible there and served by another method.

5 MR. HUDIS: Yeah, the typical situations  
6 where you have voluminous attachments, let's say  
7 to a motion, you can't serve by email because the  
8 attachments won't get through the person's email  
9 server because it's too large and then, you do an  
10 ftp file transfer. That's the other means.

11 MS. LYNCH: All right.

12 MR. HUDIS: All right, so the way I  
13 understood the proposed rule, you could do that  
14 even in the absence of agreement, right?

15 MS. LYNCH: I think, you know, I guess  
16 without getting into specific --

17 MR. HUDIS: Well, Susan --

18 MS. LYNCH: -- specific opinions and  
19 interpretations --

20 MR. HUDIS: Susan's shaking her head yes  
21 so I was trying to --

22 MS. LYNCH: Yeah, I mean, we were

1 certainly saying that if you provided an  
2 explanation of why the email service wasn't  
3 possible and I think the fact that the service by  
4 email wouldn't go through, sounds like it would  
5 qualify that you would be able to just give that  
6 explanation. Now ideally, you and your opponent  
7 would have a discussion about it, you know,  
8 perhaps at the outset of the case if you  
9 anticipated having service of voluminous documents  
10 and agree on an alternative method.

11 But yeah, if that hadn't happened or  
12 wasn't possible then the option is there to do it  
13 without agreement.

14 MS. KUHLLKE: I'm going to jump in real  
15 quickly. That dovetails into another comment that  
16 has more to do with the application of the rules  
17 to pending cases. So one of the comments was what  
18 if we had agreed to service by mail, right? Well,  
19 that's fine because the rule contemplates  
20 stipulating to any type of service that you want.  
21 So if that agreement is already in your case, the  
22 pending case, then you will continue serving each

1 other by mail.

2 MS. LYNCH: And then, just one reminder  
3 here that we wanted to plug was that regardless of  
4 alternative methods that might be agreed on, we  
5 were not providing for the additional five days of  
6 service by mail. And the idea there was that when  
7 we went to 20 days for responding to a motion that  
8 some extra time is already built in.

9 If there are not comments or questions  
10 about anything I've gone over here, I did have one  
11 question for you all about a little bit of a  
12 different topic. So was there anything on this  
13 subject before I move on?

14 Okay. We had one comment that was  
15 specifically about Rule 2.101 and I guess I'm  
16 looking for a little input or clarification about  
17 it because we were a bit confused or looking for  
18 maybe examples of how the concern might play out.  
19 So this rule is about the filing date of an  
20 opposition and concern about on the one hand, the  
21 filing date for an electronically filed opposition  
22 being the date that it was received in the office

1 and on the other hand, a -- when an exception for  
2 paper filing might be used that, you know, a  
3 different if a certificate is used with the  
4 opposition that a different filing date for the  
5 opposition might apply and that this could cause  
6 complications for attorney docketing systems.

7 Our thought was that because the answer  
8 date is going to be set by the Board and there  
9 would not be a mailbox rule applying there, we  
10 weren't sure how the concern with docketing  
11 systems might play out and we're wondering if any  
12 of you had, you know, clarification, input or  
13 examples for us. I'm seeing no? I'm seeing blank  
14 looks. Okay. Okay.

15 Well, I think that is all for me and  
16 then, I'm going to turn it over to Susan Hightower  
17 to talk about some of the other areas where we had  
18 robust comments.

19 MS. HIGHTOWER: Thank you, Cynthia, and  
20 I just wanted to start out with a quick apology  
21 for the coughing this afternoon. I'm starting to  
22 think that I'm going to take a summer cold home

1 with me when I fly back to Austin this afternoon.  
2 So but in the meantime, I just wanted to talk a  
3 little bit about some of the comments concerning  
4 proposed changes to the rules governing discovery.

5 And the first one is a proposed change  
6 to Rule 2.120(a) 23 that would require that  
7 discovery requests be served early enough that the  
8 responses will be due no later than the close of  
9 discovery as originally set or reset. And I think  
10 that generally we had positive or no expressions  
11 of concern to this but next slide. I think for  
12 some commenters when this rule particularly was  
13 read in conjunction with the proposed change to  
14 Rule 2.120(a) 24, which adds some language  
15 regarding limited extensions of the discovery  
16 period, I think that some concerns were expressed  
17 as to whether the TTAB would be changing its  
18 practice or was contemplating in the proposed  
19 rules changing the practice of granting reasonable  
20 extensions of the discovery period.

21 And I think, you know, we're certainly  
22 reviewing those comments expressing those concerns

1 and wanted to clarify that there's no such change  
2 contemplated. I mean, the language in either of  
3 those rules was not intended to change the current  
4 practice of reasonable -- the availability of  
5 reasonable extension. Jonathan?

6 MR. HUDIS: We're all attorneys on this  
7 panel. Could we get that in writing?

8 MS. HIGHTOWER: Was the Chief Judge  
9 moving towards his microphone?

10 MR. ROGERS: Well, I was just going to  
11 add that I don't think an alternative to excising  
12 the word limited from that rule would be to allow  
13 unlimited extensions. So obviously there needs to  
14 be some mutual understanding about what is  
15 reasonable in a Board proceeding. And I think the  
16 insertion of the word in the notice of proposed  
17 rulemaking was really intended just to indicate  
18 that our existing practice already contemplates  
19 limited extensions and not to signal that we would  
20 either be changing the standard of review for  
21 extension requests or imposing any kind of  
22 numerical limit.

1           So it really was not intended to  
2     indicate any kind of change in practice but just  
3     to kind of articulate what the nature of the  
4     practice already is. But we can certainly revisit  
5     the language.

6           MS. HIGHTOWER: And there was one other  
7     point that we wanted to make here was that the  
8     proposed rule changes don't impact the duty to  
9     supplement. There was one question I think one  
10    comment on that point. So if we wanted to move on  
11    to the next slide.

12           The next proposed rule changes I'll  
13    touch on the comments were the proposals to limit  
14    to 75, the requests for production and request for  
15    admission, that's in Rules 2.120(e) and (i). And  
16    I think the positive comments were that many of  
17    the commenters thought that this number would be  
18    sufficient in most cases. And next slide, Cheryl?

19           There were some concerns expressed,  
20    however, whether this would be a workable limit  
21    and particularly with respect to the requests for  
22    admission, some commenters encouraged that motions

1 to propound more requests be permitted on a  
2 showing of good cause both for requests for  
3 admission and for requests for production and to  
4 restore or retain that provision in Rule 2.120(d)  
5 for interrogatories.

6 This, I think the comments said that the  
7 requests for admission using more can sometimes be  
8 helpful in the case where multiple marks are  
9 involved in a proceeding or there are particularly  
10 long identifications of goods and services. So  
11 those are comments that we'll certainly be  
12 considering.

13 And there was one other area to touch on  
14 here, too, I think with Rule 2.120(i). We did  
15 have some comments regarding whether that would  
16 permit one comprehensive request for admission as  
17 to document authenticity. And there were some  
18 comments as to whether -- what the effect of that  
19 would be, would there be any concern about burden  
20 shifting. And we'll certainly be considering ways  
21 to address those comments in the rules or perhaps  
22 with examples in the TBMP. So moving on to the

1 next slide.

2 We -- I think that there were no  
3 concerns expressed regarding these two provisions.  
4 They're parallel for the proposed amendments to  
5 Rule 2.120(f)(1) which would require motions to  
6 compel discovery to be filed before the deadline  
7 for pretrial disclosures for the first testimony  
8 period. That obviously moves up from the  
9 commencement of that period as the rule currently  
10 exists.

11 And similarly for motions for summary  
12 judgment in Rule 2.127(e)(1), those two would have  
13 to be filed before the deadline for pretrial  
14 disclosures for the first trial period instead of  
15 the commencement of that period. I think there  
16 was only -- okay, there was only one stakeholder  
17 group that suggested enlarging the time for in  
18 Rule 2.120(f)(1), we've proposed changing the  
19 motions -- changing the timing for filing a motion  
20 to compel initial disclosures, that would have to  
21 be filed under the proposed rules within 30 days  
22 of the deadline for initial disclosures and the

1 stakeholder group proposed enlarging that to 60  
2 days. So we'll certainly be considering that as  
3 well.

4 So those were -- that was my limited  
5 area of comments in the discovery rules before  
6 moving on to Judge Kuhlke.

7 MR. HUDIS: Susan?

8 MS. HIGHTOWER: Are there any further  
9 questions?

10 MR. HUDIS: Could we just repeat those?  
11 So motion to compel initial disclosures currently  
12 is proposed 30 days after deadline?

13 MS. HIGHTOWER: Correct.

14 MR. HUDIS: Expert disclosures? When's  
15 that deadline?

16 MS. KUHLKE: I think it's part of that  
17 (inaudible) pretrial disclo -- it's pretrial --

18 MS. HIGHTOWER: It doesn't -- there's no  
19 proposed --

20 MS. KUHLKE: -- (inaudible), yeah.

21 MS. HIGHTOWER: Uh-huh. It is to be  
22 clear for the audience if didn't you hear that,

1 there's no proposed change regarding the timing of  
2 the expert disclosure deadline.

3 MR. HUDIS: And --

4 MS. KUHLKE: There's initial disclosures  
5 at the beginning.

6 MR. HUDIS: Right. Right, now  
7 discovery? Compelled discovery? That's --

8 MS. HIGHTOWER: To compel discovery?

9 MR. HUDIS: Yeah.

10 MS. HIGHTOWER: That's before the  
11 deadline for pretrial disclosures for the first  
12 testimony period.

13 MR. HUDIS: Uh-huh.

14 MS. HIGHTOWER: And it's in Rule  
15 2.120(f)(1).

16 MS. KUHLKE: All right, so that just  
17 pushes it up a little bit. Right now it's before  
18 trial opens.

19 MR. HUDIS: Two weeks.

20 MS. HIGHTOWER: Right.

21 MS. KUHLKE: In the new rules it'll be  
22 before pretrial disclosures are due.

1           MR. HUDIS:  And same thing with summary  
2 judgment?

3           MS. KUHLKE:  Correct.

4           MR. HUDIS:  Yeah.

5           MS. HIGHTOWER:  Right.  Just so you know  
6 I think probably most people have been in this  
7 situation where pretrial disclosures have already  
8 been served and then, a motion to compel or a  
9 motion for summary judgment comes after that time  
10 and that's what we're hoping to avoid with the  
11 proposed rule changes.  Are there any further  
12 questions regarding these topics?

13           MR. ROGERS:  I might just add, if I may,  
14 Susan has already addressed the fact that if there  
15 was concern about whether the requirement that  
16 discovery be completed during discovery meant that  
17 you wouldn't have to supplement after discovery.  
18 I don't think that that's true.

19                   Obviously we want discovery requests to  
20 be served and responses to be made during the  
21 discovery period but the duty to supplement  
22 continues to whatever point in time you might

1 discover that you need to supplement a previous  
2 response even if that's outside the discovery  
3 period.

4 MS. KUHLKE: All right, moving on to the  
5 trial portion. Pretty much the comments were  
6 quite positive about some of the changes to trial  
7 procedure, of course, as was mentioned by Cheryl  
8 at the beginning, many of the rules were developed  
9 hand-in-hand with stakeholders throughout the  
10 year. In particular, the rule 2.122(d)(2)  
11 codifying that you can put your registration in  
12 under notice of reliance by using the electronic  
13 database printout, that was just -- it's already  
14 practice. People do that today but we're now  
15 explicitly putting that into the rule.

16 And also codifying the cases Fujifilm  
17 and SAFER to point out specifically that you can  
18 put in Internet materials with the URL and the  
19 date under the notice of reliance. And also in  
20 122(g) to provide a little more information about  
21 what do we want to see in a notice of reliance.

22 Now one of the comments on that

1 particular rule was that we be even more specific  
2 about what we see on the notice of reliance in  
3 terms of identifying the relevance of the  
4 documents. The comment tracked a little more  
5 closely the language that we have in our case law  
6 Fujifilm and SAFER. I will say as we consider  
7 these comments, we have to weigh the value of  
8 specificity versus flexibility. And once you lock  
9 in into the CFR, right, it's a rule.

10           Whereas if we're putting something into  
11 the Board manual in terms of practice and what we  
12 want to see, we might be able to accommodate  
13 circumstances that come up that we can't  
14 anticipate right now. So just to understand those  
15 are some of the balancing acts that we go through  
16 as we're looking at comments and deciding whether  
17 or not we're going to make any changes.

18           All right, so let's go ahead to the next  
19 slide. Obviously, the biggest change for the  
20 trial procedure is adding in the ability to  
21 provide testimony by affidavit or declaration. Of  
22 course, a year ago as we were starting out on

1 changing the rules, we'd had a lot of experience  
2 with ACR, a lot of buy-in on that. Many folks  
3 enjoy being able to reduce the costs for their  
4 clients by submitting testimony by affidavit.

5 But coincidentally, a little case came  
6 along from the Supreme Court, B&B Hardware. So it  
7 did raise some concerns, important concerns, that  
8 we also focused on as we were developing the rules  
9 to make sure that we didn't back away from the  
10 quality and fairness of our procedure. And to  
11 make sure that people retain their due process  
12 rights, of course, we built in the ability to take  
13 cross-examination.

14 Let's go forward. So the ability to  
15 elect cross-examination. One of the concerns that  
16 came up on this, actually, maybe we'll have to go  
17 up. Do we have a concern yet? Oh, well, cost  
18 shifting comes up next.

19 First concern was that, and I --  
20 actually I also want to thank everyone for their  
21 comments. This is an important concern that the  
22 declaration, if you put in your testimony by

1 declaration, 2.20 allows for submitting  
2 information -- swearing to something based on  
3 information and belief. Of course, 602 of the  
4 federal rules of evidence, it's got to be personal  
5 knowledge. So we will be looking at some language  
6 to try and tighten that up and make sure that it  
7 is obviously coming in as testimony. It's got to  
8 be admissible into evidence.

9           Another concern, let's see, had to do  
10 with, oh, yeah, on -- it actually goes back to  
11 Rule 2.122 but ties in with 123. I'm sorry. We  
12 speak in code all the time. We clarified in 2.122  
13 that the statements in affidavits and declarations  
14 in the subject applications and registrations are  
15 not testimony, right? We needed to distinguish  
16 now that we're allowing testimony by affidavit  
17 that even though you've got an affidavit or dec in  
18 the subject application, let's say it was a 2F  
19 application and there's a declaration about how  
20 it's acquired distinctiveness or whatever. That  
21 the statements there are not considered evidence.

22           In the same way the rule currently says

1 the specimen of use or the dates of first use are  
2 not considered evidence. Yes, they're of record  
3 but they're essentially hearsay. So and those  
4 affidavits and declarations were not subject to  
5 cross-examination as well on top of everything  
6 else. So the rule was meant to simply clarify how  
7 does cold war apply here.

8 Any questions so far? I'm guessing the  
9 questions will be about cost shifting. So before  
10 we head to that, any questions about the process?  
11 There was a little concern about electing  
12 cross-examination and the timing and we'll be  
13 looking at that. They want a little more time to  
14 review the affidavits to determine if they wanted  
15 to elect cross-examination. Jonathan?

16 MR. HUDIS: Something the Board might  
17 want to consider. For example, if you have an  
18 expert witness, you want to take an examination of  
19 the expert. The parties notify the Board and the  
20 Board for the time of expert discovery, you put  
21 the case otherwise into suspension.

22 MS. KUHLKE: Uh-huh.

1           MR. HUDIS:  If a fact witness's  
2 affidavit or declaration is filed, particularly  
3 close to the end of the proponent's testimony  
4 period, you might want to consider the same  
5 vehicle is temporarily suspended proceedings.  So  
6 the parties aren't scurrying and equally the  
7 Board's docket isn't getting messed up.

8           MS. KUHLKE:  Yeah, I will tell you that  
9 is something that was considered prior to the  
10 notice of proposed rulemaking and we can go back  
11 and look at that possibility to set that as a  
12 suspension procedure rather than setting up the  
13 timing.  But we'll be -- we'll consider all of  
14 these different ideas.

15           Okay, so the cost shifting issue  
16 pertains to the situation where you elect to take  
17 cross-examination but at your expense.  The  
18 concern was putting that burden on the person  
19 wanting to take the cross-exam.  The other concern  
20 is the party trying to rein in costs of  
21 litigation, has submitted their testimony by  
22 affidavit and now all that effort to reduce the

1 costs is blown because now they've got to set up a  
2 deposition for cross-examination.

3           The expense we were really considering  
4 is the court reporter. We're not talking about  
5 you have to pay for that deponent to travel to  
6 your location. Your deponent, you're going to be  
7 deposing them either at their business or at their  
8 attorney's offices. So the travel expenses are  
9 not something that the person taking  
10 cross-examination are to take on.

11           And I have a question, Like, what other  
12 expenses are we being -- are we concerned about?  
13 You know, for us when we're thinking about it,  
14 we're saying you're going to be paying for the  
15 court reporter basically. But if there's anything  
16 else besides travel expense or that you would be  
17 paying for anyway, all right, to go to the  
18 deponent's place to cross-examine them.

19           And I will say when we drafted the rules  
20 that was a question that we had put out to  
21 stakeholders originally and the idea was let's  
22 have the folks taking cross- examination bear the

1 expense. So I have a sense there's a little bit  
2 of a -- maybe it's just a concern that this will  
3 unduly burden those who want to take cross-exam  
4 but it -- so if that's the case I'd like to hear  
5 from you all but the other option is to limit the  
6 number of affidavits that can come in by  
7 testimony. That's a concern. Because people --  
8 Jon's shaking his head but there had been concern  
9 expressed that oh now you can put in testimony by  
10 affidavit. We're going to have to look through  
11 and now we're going to have to pay for  
12 cross-examination of 20. It would inhibit parties  
13 from taking their option to cross-examine  
14 witnesses but I'm not hearing thundering hooves  
15 for limiting the number of testimony affidavits.  
16 No? Okay.

17 MR. ROGERS: If I could ask a question.  
18 There was one comment which we weren't quite sure  
19 about what it was getting at that related to  
20 testimony by affidavit or declaration. And it  
21 focused on whether there -- whether the Board had  
22 considered the possible impact on motion practice

1 or pendency of proceedings that might result from  
2 a shift from less testimony by a testimony  
3 deposition and more testimony by affidavit or  
4 declaration.

5 But we weren't quite sure what motion  
6 practice might occur with testimony by affidavit  
7 that could not occur with testimony depositions or  
8 what scenarios might play out that would have a  
9 significant impact on pendency. If anyone can  
10 think of any, we'd certainly like to take them  
11 into account but we weren't quite sure what that  
12 was getting at.

13 MS. KUHLMKE: Not quite. It's the last  
14 thing, folks are still asking for video testimony.  
15 At this point, as you know, we cannot -- ESTTA  
16 doesn't accept MP3 files. So we literally cannot  
17 do that, right, especially now that we're going to  
18 online filing. But we will be considering the  
19 comments.

20 So this is just codifying a practice but  
21 not everyone would avail themselves of it. If  
22 you've got a pretrial disclosure it doesn't list

1 -- it lists a witness that maybe had been  
2 requested during discovery and an improper  
3 pretrial disclosure is served. Folks would wait  
4 until the deposition was taken, attend cross-exam,  
5 right, with the objection and then file a motion  
6 to strike when they could have just filed a motion  
7 to quash the deposition.

8           Many do. Many take advantage of that.  
9 That's now explicitly in the rule to encourage  
10 people to go ahead and file the motion to quash  
11 rather than wait, let everyone spend the money and  
12 file a motion to strike.

13           I would say this was the most  
14 contentious part of the segment that I'm talking  
15 about. This is sort of related to letting us know  
16 about a registrant's attorney. This involves  
17 foreign deponents and the rule is adding the  
18 requirement that if you know that your client is  
19 in the United States to let the others -- the  
20 adverse party knows that they are within the US  
21 during say discovery or testimony period.

22           Some of the commenters expressed concern

1 that it would set them in a difficult position  
2 with their client and also that frankly they don't  
3 know. That there could be many, many officers of  
4 the foreign client that could be coming and going  
5 from the United States. And basically, it's just  
6 a difficult rule for them to comply with and what  
7 is their obligation. And I'm guessing that also  
8 expands to, you know, being members of the bar and  
9 what is your obligation in that scenario.

10 So we will certainly be looking at the  
11 language there and taking your comments into  
12 consideration. Is there any other -- here while  
13 we're in the room, any other comments about that?  
14 It cannot only be Jonathan.

15 MR. HUDIS: Somebody told me, who shall  
16 remain nameless, in that situation pretending that  
17 you're the three monkeys, see no evil, hear no  
18 evil, speak no evil. You know, especially if you  
19 have a client that's small in number. Just not  
20 communicating with your client so that you don't  
21 know whether they're in the United States and  
22 don't know, don't tell.

1 MS. KUHLKE: Which is not something, you  
2 know, we'd want the rules to encourage. We would  
3 like attorneys to be in communication with their  
4 clients so yeah.

5 MR. HUDIS: It was just an offhand  
6 comment that was given to me.

7 MS. KUHLKE: All right, let's go on.  
8 Let's go on to the next slide then.

9 MR. ROGERS: Judge Kuhlke, we just have  
10 a request from the Web listeners if we could all  
11 speak more directly into our microphones.

12 MS. KUHLKE: Okay.

13 MS. BUTLER: I'm moving it closer.  
14 There's a cable in the way.

15 MS. KUHLKE: Okay. So a lot of comments  
16 also came in about asking us to be flexible in  
17 applying the new rules and of course that is our  
18 intention as well. Let's just go on to the next  
19 slide.

20 But we do want to make clear that we've  
21 already had the experience of operating under two  
22 sets of rules and you all have had the experience

1 of litigating under two sets of rules and we don't  
2 want to do that this time around. We do want  
3 everything eventually to be set up under one set  
4 of rules going forward.

5           The -- so in terms of the effective  
6 dates, there's concern about the impact on a  
7 pending case. Let's just take some scenarios.  
8 You are -- the rules go into effect, I don't know,  
9 let's be optimistic, September 15th. Your  
10 discovery is due on October -- discovery is  
11 closing October 14th. But you haven't propounded  
12 discovery yet. Are you out of luck? Do you have  
13 to go ask for an extension of the discovery  
14 period?

15           And that's the next bullet in terms of  
16 thinking about varying effective dates for certain  
17 provisions. So that it would be a rolling --  
18 various provisions would come online as sort of  
19 rolling effective dates let's call them. So let's  
20 say that discovery -- requiring that discovery be  
21 completed within the discovery period, doesn't  
22 become effective for say another 60 days. I'm

1 just throwing out hypotheticals.

2 That gives you enough time to go ahead  
3 and get up to speed with the rule, change your  
4 docketing procedures and not even have to ask for  
5 that extension. And that goes with some of the  
6 other timing. For example, filing a motion for  
7 summary judgment, you were gearing up. Pretrial  
8 disclosure period has passed but your trial hasn't  
9 opened yet. You were going to be filing a motion  
10 for summary judgment and now the new rules come  
11 into effect. That's another possible rolling  
12 effective date.

13 So that's all I have. If there are any  
14 questions?

15 MS. BUTLER: Okay, at this point, thank  
16 you everybody for summarizing the rules here and  
17 comments that came in here as well as just  
18 clarifications. And I'm turning it over to our  
19 Chief Judge for the looking ahead portion of our  
20 final portion of our report out.

21 MR. ROGERS: Well, looking ahead, of  
22 course, involves thinking about when the notice of

1 final rulemaking will issue and what the effective  
2 dates would be as Judge Kuhlke has already  
3 addressed. And you will recall that when we  
4 amended rules in 2007 there were certain  
5 provisions in the rules that went into effect on  
6 the date of publication of the notice of final  
7 rulemaking in the federal register and there will  
8 likely be provision in the current proposed  
9 rulemaking that will similarly take effect right  
10 away.

11 An example would be the reliance in the  
12 notice of proposed rulemaking on the amended  
13 federal rules of civil procedure and the reliance  
14 on the proportionality of the use of the process  
15 and the proportionality in discovery. These are  
16 essentially already applicable to Board  
17 proceedings because we haven't opted out of the  
18 amended federal rules as we've done occasionally  
19 in the past. And the NPRM addresses them not to  
20 make them applicable but to reinforce the fact  
21 that they are applicable.

22 So certainly we could consider a motion

1 to compel soon after the effective date of the  
2 notice of final rulemaking and review it under the  
3 concept of proportionality as articulated in the  
4 amended federal rules. But other provisions  
5 would, as Judge Kuhlke said, have later effective  
6 dates because we want to deal with timing concerns  
7 and we want to allow practitioners to amend their  
8 docketing systems to train their staff and to  
9 basically get ready to -- for life under the  
10 amended rules.

11 We certainly encourage people to be  
12 doing that preparation now and not wait for the  
13 actual publication of the notice of final  
14 rulemaking but inevitably we know that people will  
15 need to make changes. And so we will allow time  
16 for that.

17 We're also cognizant of the fact that in  
18 the management of discovery in particular and any  
19 other issues that might come up regarding motion  
20 practice prior to trial, our interlocutory  
21 attorneys will have to have a great deal of  
22 discretion to be flexible in the application of

1 various provisions of the rules. And we will  
2 certainly discuss with them as a group and discuss  
3 amongst ourselves, amongst the judges and the  
4 attorneys as many situations as we can think of  
5 that might require us to be flexible so that we  
6 are prepared to do that when cases come up that  
7 require flexibility. Because all of these rule  
8 changes are designed to enhance efficiency and to  
9 reduce costs and not to be punitive in any way in  
10 regard to the parties.

11 We also know that ultimately no matter  
12 how much we think about possible scenarios and  
13 address them in the notice of final rulemaking in  
14 the background section or in responses to comments  
15 or in the manual of procedure or in any internal  
16 discussions that we have among the judges and the  
17 attorneys about how and when we will need to be  
18 flexible, there will still be some scenario or set  
19 of circumstances that will arise that we will not  
20 have thought of. And we will have to address some  
21 of those through the issuance of precedential  
22 decisions and we certainly did that with the 2007

1 rulemaking where we had to issue some precedential  
2 decisions about the changed requirement that the  
3 plaintiff served the defendant and in various  
4 other areas.

5           So I think we can expect that we'll have  
6 to rely on precedential decisions to some extent  
7 even after all of the effective dates have passed  
8 and the final rulemaking is fully applicable.  
9 That's where we rely on practitioners to give us  
10 well thought out cogent arguments about how a  
11 scenario is not contemplated or that none of us  
12 ever thought of should be handled and should be  
13 addressed. And then, we'll handle them as best we  
14 can through precedential decisions.

15           And I just want to reiterate that in  
16 administering the final rules, the Board will  
17 administer the system but we don't really view it  
18 as just our system. It's really a system for mark  
19 owners and practitioners and applicants and it has  
20 to be a system that will work well for all of our  
21 stakeholders. So that's, I think, a guiding  
22 principle that we have behind the drafting of the

1 notice of final rulemaking and any steps that we  
2 take to implement it and interpret it after it's  
3 been published in the federal register. So we  
4 welcome your continuing participation and  
5 collaboration in that respect.

6 MS. BUTLER: And before you have a  
7 chance to think about leaving, we did get a  
8 question from the online audience. Here you go.

9 MS. KUHLMKE: All right. So the question  
10 is if a foreign party submits declaration  
11 testimony I assume the cross-examination will have  
12 to be by written questions. Will the TTAB suspend  
13 the testimony period for that process to unfold?  
14 And the answer is yes. The proposed rule in 123  
15 shoots you over to Rule 2.124 which governs  
16 depositions upon written questions and, yeah, we  
17 typically suspend when you're involved in that  
18 type of procedure.

19 So when I was looking for a file folder  
20 to just put some of my notes in this is literally  
21 the only thing that was left at the Board. So  
22 this is the test to see just how many long-timers

1 we have.

2 MS. BUTLER: Well, thank you again for  
3 joining us for the report out. I hope you found  
4 it useful and we look forward to speaking with you  
5 again. Thank you.

6 (Whereupon, the PROCEEDINGS were  
7 adjourned.)

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## 1 CERTIFICATE OF NOTARY PUBLIC

2 I, Carleton J. Anderson, III do hereby certify  
3 that the forgoing electronic file when originally  
4 transmitted was reduced to text at my direction;  
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14 Carleton J. Anderson, III

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