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To: TTABFRNotices <TTABFRNotices@USPTO.GOV>
Subject: Comments by Cowan Liebowitz & Latman P.C. on TTAB Proposed Rule Package Set Forth in 81 Fed. Reg. (4/4/2016)

Attached are our firm's comments both in Word and pdf formats.

Sincerely,

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Comments by Cowan Liebowitz and Latman, P.C. on TTAB Proposed Rule Package Set Forth in 81 Fed. Reg. (4/4/2016)

1. General comment about the rule package. The rule package in general appears well suited to further the stated goals of efficiency, clarity and streamlining of proceedings. The comments below reflect some areas that would benefit from further specification and/or modification.

2. Requirement to use ESTTA exclusively for Board filings with certain exceptions. While generally supporting the requirement of filing through ESTTA whenever possible and practical, we believe that there are some circumstances in which e-filing is either not possible, practical and/or cost efficient, that such circumstances should be further specified as exceptions to the rule and that there is an alternative to filing a Petition with the requisite fee that would be a fairer method of ensuring compliance with the rule in those situations.

The exception to e-filing through ESTTA as stated in proposed Rule 2.126 does not account for all circumstances in which an e-filing may not be possible or practical, including:

(i) Filing of a combined opposition and petition to cancel is permitted under TBMP 305.02, but the rule requires the filing to be done on paper as ESTTA is not able to accommodate electronic filing of a combined proceeding. The TBMP states:

> A party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant. Such single pleading is referred to as a "combined" opposition and petition to cancel.…Further, a combined complaint must be filed on paper; it may not be filed electronically because the Board's Electronic System for Trademark Trials and Appeals ("ESTTA") currently is not designed to accept a combined complaint. When such a pleading is filed, the Board will set up both an opposition and a cancellation proceeding file, each with its own identifying number, and each marked "Combined with _____" followed by the number of the other proceeding. The opposition is treated as the "parent" case, and both proceeding numbers are placed on all documents relating to the combined proceedings.

Until such time as ESTTA can accommodate a combined opposition and petition to cancel, such a filing should constitute an explicit exception to the e-filing requirement and to the requirement to file a Petition with a fee simultaneously since the necessity for the paper filing will be clear. The filer should not be put to the additional expense and duplicative effort of preparing and filing a separate opposition and cancellation in such circumstances, nor should the defendant be required to prepare and file separate answers. Moreover, the plaintiff should not have the further expense later in having to engage in motion practice in order to seek to consolidate the proceedings.

(ii) When ESTTA is down, as it was for several days in December 2015, the filer will need to file on paper. Although this contingency is mentioned in proposed Rule 2.126 as an

excusable situation, the filer is still required to file a simultaneous Petition with the requisite fee. A fairer alternative would be to require the filer to state in the paper filing itself that ESTTA was down and that is the reason for the paper filing without having to file a Petition that will increase the effort to be made by the filer in exigent circumstances and will add to a client's expense through no fault of its own. This statement could be accompanied by a declaration if the Board believes that is necessary to prevent any possible abuse.

(iii) Although the rule explicitly mentions the situation when ESTTA is down as a reason for filing on paper, it does not specify that outage on the filer's end is an exception to the requirement to e-file. This situation should also be explicitly recognized as an exception. The alternative procedure set forth in (b) above with a statement of the circumstances of the outage and the need to file on paper, potentially accompanied by a declaration, would be fairer as the circumstances would be beyond the filer's control and would not add more time and expense involved in filing a separate Petition.

(iv) Filing of trial testimony or motions (such as for summary judgment) with extensive exhibits can be very time consuming through ESTTA because of the limitations on the size of files that can be uploaded with the resulting need to break down such material into smaller segments, leading to attorneys' spending many hours uploading the material. This effort can be much more costly for clients than filing the material on paper would be and also may be difficult for pro se parties or solo practitioners. Such extensive filings could be recognized exception to the rule or, at a minimum, could be allowed on prior approval by the Board.

3. Requirement of e-mail service. Proposed Rule 2.119(b) requires email service for all documents filed in the Board or otherwise served on the other party unless the parties stipulate otherwise or, due to technical difficulties or other "extraordinary" circumstances, a party cannot do so. While this rule takes account of the vast majority of situations, where a party is non-responsive or uncooperative is not explicitly covered. As the explanation of the proposed rule acknowledges, there can be some situations, such as extensive document productions, in which another form of service would be more efficient and economical. A specification that an adverse party's unresponsiveness about, or unreasonably uncooperative refusals to agree to, alternative methods of service for such extensive material, would be helpful in clarifying what could be considered "extraordinary."

4. Limitation of discovery. Similar to the present limitation of the number of interrogatories, limitation of the number of document requests and of requests to admit under proposed Rule 2.120(e) and (i) should be beneficial in the vast majority of proceedings and should help to focus discovery and to avoid abuse. There may, however, be special situations that would merit allowing a greater number. Permitting a motion in such instances could meet this need in rare situations.

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