

June 3, 2016

TTABFRNotices@uspto.gov

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Re: Comments to Proposed Rule by the Patent and Trademark Office on 04/04/2016 entitled "Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice."**

Merchant & Gould applauds the United States Patent and Trademark Office on its proposed changes to the Rules for practicing before the Trademark Trial and Appeal Board. We believe they will help increase the efficiency of Board proceedings, particularly with respect to the presentation of evidence.

However, we are very concerned regarding the new proposed requirement in 37 C.F.R. § 2.120(c)(2) that a party must inform all adverse parties whenever an officer, director, managing agent, or other person who consents to testify on its behalf is present within the United States. Specifically, the Office proposed amending § 2.120(c)(2) to add the following obligation:

- "Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, the party must inform every adverse party of such presence and such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery."

The comments published with the Rule state the following:

- "Parties would also be subject to a requirement to inform adverse parties when prospective witnesses located outside the United States are expected to be present in the United States. This obligation would continue through discovery (as well as during trial if the witness could be called to testify), subject to the Board's determination of whether the party has been reasonable in meeting this obligation."

The requirement to notify the opposing side regarding travel plans to the United States imposes an immense burden on foreign parties and their counsel and is unlikely to increase the efficiency of Board proceedings. As proposed, the requirement is for all of an entity's officers, directors, managing agents, or other persons who consent to testify on its behalf. The proposal is not limited to persons who have knowledge of the proceedings or to persons identified as potential witnesses. The comment broadens it further by stating that the obligation would continue through trial. For a large foreign corporation with numerous officers, directors, and managers, complying would be extremely difficult and expensive.

Additionally, we note that the proposed disclosure obligation implicates many privacy issues, particularly in other countries. Travel may be taken for many reasons, including confidential business travel, vacation travel, or private medical related travel. Even if one could keep track of the whereabouts of all officers, directors and managing agents, parties may not be free to collect that information, let alone share it with every adverse party without violating privacy laws.

Accordingly, we recommend that the Office not adopt the proposed change to § 2.120(c)(2).

Respectfully submitted,

MERCHANT & GOULD P.C.

A handwritten signature in black ink, appearing to read 'S. Johnston', with a long horizontal flourish extending to the right.

Scott W. Johnston