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Sent: Thursday, May 26, 2016 12:56 PM
To: TTABFRNotices <TTABFRNotices@USPTO.GOV>
Subject: Comments to Proposed Rulemaking - RIN 0651-AC35

Dear Sir or Madam,

On April 4, 2016, the USPTO published a Notice of Proposed Rulemaking in the Federal Register (81 Fed. Reg. 19296), proposing to make Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice and soliciting comments, which I provide herein. While I am affiliated with Emerson Thomson Bennett, LLC, these comments represent my personal views.

1. One proposal is to amend “examiner” to “examining attorney” in several rules. I oppose this change for several reasons. First, various rules currently recite “examiner.” E.g., §§2.61, 2.76(a), 2.146(a)(1), 2.165. These rules were not proposed to be amended. Therefore, the rules will be inconsistent if some refer to an “examining attorney” and others just to “examiner.” Second, one factor of good writing is brevity. “Examiner” is shorter than “examining attorney.” Where page limits are imposed (e.g., §§2.127, 2.128, 2.142), the shorter title is preferable to the longer one. It is understood that the examiners are trademark attorneys, but “examiner” is an accurate description of their roles in examining trademark applications, so I do not see the need to lengthen the title.
2. Another proposal is to require all filing by ESTTA and to require a petition with fees for any paper filing. §§2.101(b)(2), 2.102(a)(2), 2.111(c)(2), 2.126(b). I agree with the proposal requiring electronic filing. I would also agree with a requirement to submit a petition and pay fees if a filer is able to file electronically but chooses not to. However, I oppose the requirement to pay fees if the filer is not able to file electronically due to factors not under the filer’s control, especially if ESTTA is unavailable. ESTTA is not under a filer’s control but rather under the USPTO’s control. It does not seem fair to require the filer to pay for a condition that is under the USPTO’s control.
3. Another proposal is to prohibit parties from recording telephone conferences with the Board. §2.120(j)(3). What is the Board’s reason for this prohibition? TBMP 542 and 802.06 do not explain either. Without explanation for this proposed rule change, I oppose it because an audio recording of a conference eases the burden on the participating party from taking detailed notes instead of focusing on participating in the discussion.
4. Several proposed rules state that something “may not” happen. Because “may” usually indicates that something could or could not happen, “may not” is generally disfavored because of its ambiguity. Specifically, “may not” could mean either a) that something is prohibited from happening, or b) that something might not or might happen. The specific meaning is clear from context in some rules. E.g., §§2.101(b)(1), 2.102(a)(1) (is prohibited from). But in other rules, the meaning is unclear. E.g., §§2.101(d), 2.123(j), 2.128(b) (might or might not at the Board’s discretion, or is prohibited from?). To avoid this possible ambiguity, I propose using “will not,” “shall not,” or “cannot” instead of “may not.” E.g., §2.106(b)(1) (“shall not”), 2.111(d) (“cannot”).

5. Somewhat related to the preceding issue is the difference in wording between §2.106(b)(1) (“A reply to an affirmative defense *shall not* be filed.”) and §2.114(b)(1) (“A reply to an affirmative defense *need not* be filed.”) (emphases added). Is the difference intended? If not, I recommend using “shall not” to prohibit the filing of a reply to an affirmative defense.
6. Several proposed rules recite a list of items without a comma before the “and” or “or” before the last item in the list. E.g., §§2.112(a) (“he, she or it”), 2.116(e) “notices of reliance, declarations and affidavits”). I suggest adding a comma before “and” and “or” when reciting a list of items. E.g., 2.120(e) (“time, place, and manner”), 2.123(f)(1)(iv) (“place, day, and hour”), 2.145(a)(1) (“interference, opposition, or cancellation”). The added comma will add clarity.
7. Another proposal is to amend §2.122(b)(2) to exclude statements made in an affidavit or declaration in the file of an application or registration from evidence unless otherwise established. There is no explanation for this change, other than to state that it is in response to *Cold War Museum v. Cold War Air Museum*. If statements were originally made under oath in a submitted declaration or affidavit, why should those statements not be considered as evidence before the Board? Any hearsay concerns would be addressed by the Federal Rules of Evidence. Without a better explanation by the USPTO, I oppose this change. I would further revise the rule to remove the sentence about specimens in the file being not in evidence unless re-introduced during the testimony period as I see no reason for a re-introduction of something that is already in the record and that was originally submitted under oath.
8. Various rules refer to deadlines set in days. E.g., §§2.113(a) (30 days), 2.121(e) (15 days). §2.196 specifies that calendar days are intended, and TMEP 310 gives two examples of calculating time. However, neither the rule, TMEP, nor TBMP (see 112) seem to explain whether the initial day triggering the time period is to be counted, and whether the action is due on the final day or on the day after the final day of the specified period. It would be helpful if either the rules or the manuals explained the inclusion/exclusion of the first and last days of the period, similar to Fed. R. Civ. P. 6(a)(1).
9. The second sentence of proposed §2.120(a)(1) includes a list of items separated by commas. This list appears to really be one list, the components of which are sometimes lists of their own. For clarity, I suggest replacing some commas with semicolons where appropriate (if my understanding of the intention of the rule is correct). E.g., “The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to required disclosures~~[,]~~; the conference of the parties to discuss settlement and to develop a disclosure and discovery plan~~[,]~~; the scope, proportionality, timing and sequence of discovery~~[,]~~; protective orders~~[,]~~; signing of disclosures and discovery responses~~[,]~~; and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter partes proceeding or subsequent scheduling order.” (proposed deletions in brackets, additions underlined).
10. The last sentence of proposed §2.122(a) seems to be redundant to §2.120(k)(7). Is there a reason why both are required? §2.122(a) seems shorter and broader, so §2.120(k)(7) seems unnecessary.
11. Another proposal is to amend §2.120(e) to limit the total number of requests for production to 75 (including subparts). Fed. R. Civ. P. 34(a) (which applies in TTAB proceedings, §2.120(a)(1))

allows a party to serve “a request . . . (1) to produce . . . (A) any designated documents or electronically stored information . . .” Per Fed. R. Civ. P. 34(b)(1), “[t]he request: (A) must describe with reasonable particularity each item or category of items to be inspected” Because Fed. R. Civ. P. does not numerically limit requests for production (other than the general proportionality limits), there is no real need to distinguish between a “request for production” and “items or categories of items” described in the request for production and sought to be produced or inspected. However, because proposed §2.120(e) sets a limit of 75, the USPTO should confirm that each requested item or category of items counts towards the limit (i.e., counts as a subpart), rather than allowing up to 75 separate requests, each of which can list an unlimited number of items or categories of items.

12. The last sentence of proposed §2.120(g) (and existing §2.120(f)) states that if a motion for a protective order is denied, the Board may compel discovery. This tracks Fed. R. Civ. P. 26(c)(2). I suggest that the USPTO amend §2.120(f) (motion for an order to compel discovery) to include a mirror provision (analogous to Fed. R. Civ. P. 37(a)(5)(B)) – i.e., if the motion to compel is denied, the Board may issue a protective order. This would make the provisions for motions to compel and motions for protective order symmetrical.

Other than the above comments, I agree with the proposed rule amendments, especially the ones intended to limit the burden of discovery and attendant costs.

Regards,



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