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Sent: Friday, June 03, 2016 9:32 AM

To: TTABFRNotices <TTABFRNotices@USPTO.GOV>

Subject: ABA-IPL Section comments on proposed changes to TTAB Rules of Practice

Please see the attached comments from Theodore Davis, Chair, American Bar Association Section of Intellectual Property Law, in response to the U.S. Patent and Trademark Office request for comments on proposed changes to the Trademark Trial and Appeal Board Rules of Practice.

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The Hon. Mary Boney Denison
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P.O. Box 1451
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Via electronic mail to: TTABFRNotices@uspto.gov

Re: Notice of Proposed Rulemaking: Miscellaneous Changes to Trademark
Trial and Appeal Board Rules of Practice; Proposed Rules

Dear Commissioner Denison:

I write on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") in response to the United States Patent and Trademark Office's request for comments concerning the proposed changes to the Trademark Trial and Appeal Board's Rules of Practice. The American Bar Association is the largest voluntary professional association in the world, and its Section is the largest intellectual property entity with approximately 20,000 members. The views expressed in this letter are presented on behalf of the Section. They have not been approved by the House of Delegates or Board of Governors of the American Bar Association and, accordingly, they should not be construed as representing the views of the Association.

The Section greatly appreciates the opportunity to respond to the Notice of Proposed Rulemaking (NPRM). As a stakeholder organization representing intellectual property law practitioners who practice frequently before the TTAB, our membership has taken an active interest in the Office's proposed rule changes.

The Section largely supports the proposed changes, particularly as they update the rules to comport with more appropriate nomenclature and modern technology. Our concerns regarding specific rules changes are highlighted below.

ANALYSIS

1. Interferences and Concurrent Use Proceedings

Proposed Changes to Rules 2.92; 2.98; 2.99

The Section notes all but three of the proposed changes in this category reflect nomenclature changes, such as changing the term “Examiner” to “examining attorney” in Rules 2.92, 2.98, and 2.99(f)(3). Other changes designed to provide clarity to existing practice do not raise concerns among the membership, as in proposed Rule 2.99(d)(3), which would change “*the applicant(s) will remain with the burden of proving entitlement to registration(s)*” to “*the burden of proving entitlement to registration(s) will remain with the concurrent use applicant(s).*”

While the Section generally applauds the shifting of the burden of service from the parties to the TTAB, the Section is concerned the Board’s proposed means of service might not actually provide sufficient notice to all parties of a matter that could result in the loss of trademark rights. The Section is concerned the service of only a notice of institution with a web link or web address to the proceeding record as outlined in Rule 2.99(d)(1) may not permit *pro se* parties to understand the seriousness of the matter or to take sufficient actions in response to preserve their rights. In addition, email, like other technologies, can be fickle, and there is no guarantee of delivery. For example, an email could be incorrectly routed to a spam folder without notification to the sender.

2. Opposition

Proposed Changes to Rules 2.101; 2.102; 2.105; 2.106; 2.107

A. Codifications/Clarifications of Existing Rules and Practice

The Section generally supports the proposed rule changes for oppositions that merely codify or clarify existing practice. For example, the Section supports amending Rule 2.102(c)(1) to clarify that a sixty-day extension is not available as a first extension of time to oppose. Nor does the Section find problematic the proposal to amend Rule 2.107(b) to clarify that, with respect to an opposition to an application filed under Section 66(a), pleadings may not be amended to add grounds for opposition or goods or services beyond those set forth in the cover sheet, or to add a joint opposer.

B. Filings of Oppositions, Extensions of Time to Oppose, and Effective Filing Date(s)

The Section largely agrees with the Office’s proposed amendments to Rules 2.101(b) and 2.102(a) requiring that oppositions and extensions of time in which to file an opposition be filed via ESTTA, unless ESTTA is unavailable due to technical problems or when

extraordinary circumstances are present. However, the Section is concerned with attendant amendments that would require a party filing by paper simultaneously to file a Petition to the Director along with a filing fee. While the Section understands the Office is constantly striving to improve its technological capacity, the respectfully submits that requiring an additional fee in the event of the unavailability of the electronic filing system is premature in light of some continuing downtime and accessibility concerns of the Office's present IT system. Accordingly, the Section recommends the Office ensure that petitions to file on paper due to technical problems will be granted liberally and that there will be no fees for filing such a petition, at least for the present. Towards that end, the Section encourages the Office to develop and publish a waiver procedure such that no fee would be required at the time of the filing of the Petition to the Director.

Similarly, the Section has some concerns with the proposed amendments to Rules 2.101(d) and (e). On the one hand, they would peg the filing date of an opposition to the date of electronic receipt in the USPTO of the notice of opposition; on the other, however, they would peg the filing date for a paper filing, where permitted, to the mailbox rule. The effect of these changes is to remove the standard five-day period associated with service by postal service or courier. Some Section members expressed concern the change would complicate attorney docketing systems, if the change applies to ongoing proceedings and would prefer that the Board only apply these proposed changes in cases instituted after the effective date of the new rules.

C. Service of Notice of Opposition

The Office proposes to amend Rules 2.101(a) and (b) and 2.105(b) and (c) to shift the burden of service of the notice of opposition from the opposer to the TTAB. The changes would also specify that the Board's notice of institution constitutes service. The notice would include a web link or web address to access the electronic proceeding record, which contains the notice of opposition itself. Under the proposed amendments to Rule 2.105, the Office would allow the Board to serve the notice of institution at the email or correspondence addresses of record for the parties, their attorneys, or their domestic representatives.¹

The Section has some questions and concerns about this proposal. First, the Section is concerned that service by the Office of only a link to the record would not actually provide sufficient notice to all parties of a matter that could result in the loss of a trademark application. Moreover, it is not clear how service will be accomplished or who will ultimately be served because of the "or" language in the rulemaking explanation:

¹ The proposed amendment to Rule 2.105(a) includes a deadline of "not less than thirty days from the mailing date of the notice." The same phrase also appears in the proposed amendment to Rule 2.113(a). Given that the proposed rules provide that the Board will send its notice by email, the Section would suggest changing "mailing date of the notice" to "date the Board sends the notice" in both places. Because the same phrase also appears in the proposed amendment to rule 2.113(a), the Section suggests the same change to that rule.

“the email *or* correspondence address” and “the parties, their attorneys, *or* their domestic representatives.”

Finally, the Section is concerned about the possible effects of the new service processes on default procedures. For example, would the USPTO be required to send “follow-up” service for a notice of institution? If a party were originally served via email and defaults, would the notice of default also be emailed, or would service of the notice of default be accomplished by an alternate means?

D. Recommendations

The Section recommends the Board consider additional rule changes and technology updates pertaining to oppositions, beyond what is included in the current proposal. First, the Section respectfully requests the USPTO to consider allowing an applicant to withdraw an application without consent after a notice of opposition has been filed, but before any answer or other response has been filed, without prejudice. Currently, both default and withdrawal without consent result in judgment against an applicant with prejudice. Because of the claim-preclusive effect of such a judgment, this enables well-positioned opposers to take advantage of applicants with limited financial resources to force them to surrender their rights with no chance to obtain trademark registration if circumstances change.

Second, the Section respectfully requests the USPTO to amend Rule 2.104(a) further to make clear the ESTTA form is administrative, rather than substantive, and that in the event of any discrepancy between the ESTTA form and the contents of the pleadings, the pleadings control.

Third, the Section respectfully requests the TTAB, through either ESTTA or TTABVUE, to provide a central online docket where the parties and the Board can access a definitive list of dates and deadlines in *inter partes* matters, which would be updated automatically to reflect the current status of the proceeding.

3. Cancellation

Proposed Changes to Rules 2.111; 2.112; 2.113; 2.114

A. Service of Petition to Cancel

The Section largely favors the proposed changes to Rule 2.111 to shift the burden of service in a cancellation proceeding from the Petitioner to the TTAB. As discussed in the interferences/concurrent use and opposition sections above, however, the Section is concerned with amendments to Rule 2.113(c) providing that the TTAB will serve registrants with a notice of institution with a link to the TTABVUE record. In the

Section's view, a short email with a link to the record may not sufficiently impress upon registrants the serious nature of the cancellation proceeding at hand and thus may not serve as effective notice of the potential loss of valuable rights.

The Section generally agrees with proposed changes encouraging electronic filing. Nevertheless, as noted above, the Section favors preserving the right to paper-file a petition to cancel without a fee in circumstances where ESTTA is unavailable. Moreover, under the proposed change to Rule 2.111(c)(2), a petitioner who needs to file on paper would be required to submit a Petition to the Director with the attendant petition fee. Indeed, if the reason for the paper filing is the outage of the electronic filing system, the Section recommends a process by which a filer could apply for a waiver of the fee at the time of filing.

B. Additional Proposed Changes

The Section generally favors the changes to Rule 2.112 to comport with current Office practice. Furthermore, the Section does not object to the proposed amendment to Rule 2.112(a) requiring the petitioner provide "to the best of petitioner's knowledge" the relevant contact information for the registrant or its attorneys, but disfavors the imposition of any additional duty on the registrant to go beyond the information publically available in the USPTO's records. In some cases, the filing of a petition to cancel represents the opening of a dialogue between the petitioner and the respondent. Under these circumstances, the petitioner might not have additional contact information for respondent at the outset of the cancellation proceeding, and might be restricted to public records, which may have been incorrect at the time of filing or became incorrect after the passage of time.

4. Procedures in Inter Partes Proceedings

Proposed Changes to Rules: 2.119; 2.120; 2.122; 2.123; 2.126; 2.127

A. Electronic Service and Attendant Deadlines

The Section largely agrees with the Board's proposal to amend Rule 2.119(b) and (c) to require that all submissions filed with the TTAB and any other papers served on a party be served by email, unless otherwise stipulated or service by email cannot be made due to technical problems or extraordinary circumstances. The Section concurs with the requirement to seek leave for service on paper if necessary without a prescribed fee. It also agrees with the proposals, for cases files after the effective date of the new rules, to eliminate the additional five days provided when service is effected by mail and to extend 15-day deadlines to 20 days. Ultimately, the Section believes eliminating the deadline dichotomy between electronic and paper service will streamline attorney docketing procedures.

B. Proposed Discovery Request Limits

The Section also generally favors the following amendments to Rule 2.120(e) that (i): limit discovery requests to 75 each; (ii) permit a party to make a single comprehensive request for an admission authenticating documents or specifying which documents cannot be authenticated; and (iii) allow another party to make documents of record by notice of reliance where they were produced by another party with an admission or stipulation that the documents are authentic. These changes seem consistent with the view that the scope of discovery in TTAB proceedings should not be as expansive as it is in federal court litigation.

However, the Section respectfully recommends amendments to the rules to provide clearly that the parties may seek leave to serve more than 75 requests to admit and requests for production of documents (as well as interrogatories) upon a showing of good cause. For example, parties might justifiably need to exceed 75 requests in a consolidated opposition or cancellation proceeding involving more than one application or registration. In the Section's view, this "safety valve" is particularly important in light of the possible issue-preclusive effect of TTAB decisions in subsequent infringement proceedings after *B & B Hardware v. Hargis*, 135 S. Ct. 1293 (2015), a circumstance that merits giving the parties a fair opportunity to take discovery in proceedings before the TTAB.

C. Proposed Discovery and Motions Deadlines

The Section agrees with amendments to Rule 2.120(a) to mandate that all interrogatories, requests to admit and document requests be served in such a manner to require responses to be due before the close of discovery. In the Section's view, this requirement would facilitate the orderly conclusion of fact discovery and should reduce the frequency of motions to re-open discovery following a party's receipt of a deficient discovery response after the close of discovery.

However, the Section is concerned with proposed amendments to Rule 2.120(f) that require motions to compel initial disclosures to be made within 30 days after the disclosures deadline. While the Section understands the goal of encouraging parties promptly to file motions to compel initial disclosures, parties often engage in settlement negotiations early in a proceeding. It therefore is not unusual for a party to neglect to serve initial disclosures while settlement negotiations are ongoing. While the Section appreciates the Board would prefer that the parties file a motion to suspend in such cases, it seems inequitable to allow a party to fail to serve initial disclosures if the opposing party neglects to file a motion to compel within 30 days. Instead, the Section recommends revising the rule further to extend this mandatory motion period to be sixty (60) days after the deadline to serve initial disclosures.

The Section particularly agrees with the proposed amendments to Rules 2.120(f) and (i) mandating that motions to compel expert testimony disclosures must be filed prior to the close of discovery and that motions to compel discovery and to test the sufficiency of any objection must be filed prior to the deadline for pre-trial disclosures for the first testimony period. Such changes encourage efficiency in the discovery and testimony periods.

Finally, the Section agrees with the proposed amendments to Rule 2.127(e) to mandate the filing of motions for summary judgment between the start of the first testimony period and before the deadline for pretrial disclosures within the first testimony period. In the Section's view, this change also promotes proceeding efficiencies.

D. Written Testimony

The Section generally agrees with the proposed amendments to Rule 2.123(a) and (e) to allow for the taking of testimony by affidavit or declaration so long as the right to cross-examination is preserved. Several Section members already stipulate to submission of direct testimony by declaration subject to the right to live cross-examination as a form of accelerated case resolution and find that written testimony reduces costs and conflicts associated with scheduling direct testimony depositions.

E. Foreign Parties

The Section is concerned with the proposed amendments to Rules 2.120(c) and to 2.123(a) that would require foreign parties to inform adverse parties when relevant agents or testimonial witnesses happen to be in the United States during the discovery or testimonial periods. Some in our membership believe such a change would be positive and eliminate the need to serve an interrogatory asking an opposing foreign party to identify dates in which their 30(b)(6) or other identified foreign witnesses will be present in the United States during the discovery and testimony periods. Overall, the Section believes these requirements improperly place counsel in the position of informing on their clients and that existing procedures for seeking discovery and testimony of foreign parties are sufficient.²

F. Evidentiary Record

Many changes appear to comport with existing Board practice and the Section generally supports these. Notably, these include the proposed changes to Rule 2.121(e) that the live or written testimony of witnesses not included in pretrial disclosures or improperly identified therein can be quashed or stricken. The Section also generally supports Rule 2.122(d), which specifies that, while the entirety of a subject application or registration's

² This change could incentive counsel to advise foreign parties not to meet with them when in the US, or not to travel to the US for conferences and other business.

file history is of record, statements in affidavits or declarations therein are not considered evidence.

Finally, the Section generally supports proposed changes to Rule 2.127(e) to allow for the stipulation that evidence submitted in the course of a denied summary judgment motion can be relied on at trial as such a stipulation would seem to promote efficiency. That said, the Section wishes to clarify its objection to required stipulations on this issue as unnecessarily inflexible.

G. Notice of Reliance

The Section appreciates and agrees with the proposed amendments to 2.122(d) that allow for the submission of pleaded registrations and registrations owned by any party via Notice of Reliance. However, the Section notes the proposed rules suggest attaching “an original or photocopy of the registration” or “a current printout of information from the electronic database records of the Office” showing current status and title. Given the Office’s focus on electronic filing, the Section believes the rule should eliminate the term “printout” and substitute “download.”³

The Section agrees with the proposed amendments to Rule 2.122(e) allowing for the submission of internet materials via Notice of Reliance, which comports with existing Board practice.

Similarly, the Section agrees with the proposed amendments to Rule 2.122(e) imposing a duty upon parties to indicate generally the relevance of proffered evidence and associate it with one or more issues in the proceeding, where failure to comply with this duty would be a curable defect. However, the Section believes the revised rules could provide more guidance to parties beyond "indicat[ing] generally the relevance of the evidence and associate it with one or more issues in the proceeding." For example, the revised rule could provide that "the offering party should generally indicate the relevance of the evidence, including that of each document or group of documents within each exhibit."⁴ Moreover, while the Section agrees the failure to indicate general relevance should be curable, the Section believes the rule could further specify that the omission may be cured *without* reopening the testimony period of the offering party.⁵

³ In addition, the proposed rule suggests the original or photocopy should show "both the current status of and current title to the registration" but the printout should show "the current status and title." Rule 2.122(d)(1) & (d)(2). It is unclear why these are worded differently and whether they are intended to have different meanings.

⁴ The precedential case codified in this rule change, *FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 U.S.P.Q.2d 1234 (T.T.A.B. 2014), involved a party’s introduction of an exhibit containing 628 pages of printouts from the party’s website. The party had indicated the exhibit was relevant to three specific *du Pont* factors, so it had arguably “generally” indicated the relevance of its evidence. In *FUJIFILM*, the Board declared the offering party “should have indicated which web page or group of web pages within each exhibit support each specific *du Pont* factor.”

⁵ Indeed, this was the directive given in *FUJIFILM*.

5. Ex Parte

Proposed Changes to Rules 2.142; 2.145

The Section generally supports the proposed nomenclature changes to Rule 2.142 and agrees with other formulaic changes to *ex parte* practice, for instance, streamlining page numbering in proposed Rule 2.142(b)(3). Other rule changes seem to track existing practice or take into account modern technology, such as proposed Rule 2.142(c), which directs the examining attorney to note in the statement of issues which requirements have been satisfied and are not subject to appeal. The Section also agrees with allowing remote attendance at oral hearings as set out in proposed Rule 2.142(e)(1). Nevertheless, the directive in proposed Rule 2.142(b)(1) and (f)(4) that the examining attorney "shall mail a copy of the brief" seems inconsistent with the Board's move to electronic communications.

Certain changes raise concern within the Section. For example, the proposed amendment to Rule 2.142(e)(2) allowing for inter-law office file swapping before oral argument might be potentially prejudicial to applicants. It likely would engender more circumspect decision-making if supervisory or managing attorneys were required to field the appeals generated within their own law offices, rather than be allowed to forward appeals to other law offices.

Additionally, the proposed amendment to Rule 2.145(e)(2) appears to require the applicant to request an extension of time to seek judicial review both by mail to the Office of the Solicitor and by ESTTA to the Board. It seems the onus should not be on the applicant to ensure that two arms of the same federal agency communicate in an expeditious manner. Instead, the Section respectfully suggests that the Office allow for service on the Board and the Solicitor's office using the same ESTTA form.

6. General Information and Correspondence in Trademark Cases

Proposed Changes to Rules 2.190; 2.191

The Section agrees with the Office's proposed nomenclature amendments in Rule 2.190 and notes that proposed Rule 2.191 comports with the Office's general efforts to ensure that all documents in TTAB proceedings be filed via ESTTA. The Section largely applauds, but reiterates that ESTTA and/or USPTO systems can be unavailable at times for various reasons (*e.g.*, maintenance or outage). Frequently users are not aware that ESTTA is not functioning properly until they attempt to upload a document. To that end, as discussed previously, the Section respectfully requests the Office to provide for paper

filing, without a fee, on the limited occasions when a user is not able to file electronically through ESTTA.⁶

CONCLUSION

In general, the Section appreciates the efforts of the Office and the Board to streamline *ex parte* and *inter partes* practice and to encourage all parties to communicate in as efficient and timely a manner as possible. However, it favors preserving the ability of parties to file by paper for those limited instances when electronic filing is not an option without incurring financial penalties for exercising this ability. Similarly, while the Section generally may not oppose the taking of testimony by affidavit, the Section stresses the need to safeguard the ability to cross-examine affiants.

The Section again thanks the Office for the opportunity to share the views of our members on these important changes to TTAB practice. If you have any questions or would like to discuss any of these comments, either I or another member of the leadership of the Section will gladly respond.

Very truly yours,



Theodore H. Davis, Jr.
Section Chair
American Bar Association
Section of Intellectual Property Law

cc: Cheryl Butler, USPTO

⁶ Revised Rule 2.191 (Business to be Transacted in Writing) provides that “The Office encourages parties to file documents through TEAS wherever possible, or through ESTTA for documents in proceedings before the Trademark Trial and Appeal Board.” Yet, page 19,307 of the NPRM states: “The Office proposes to amend § 2.191 to direct that documents in proceedings before the Board be filed through ESTTA. The proposed amendment codifies the use of electronic filing.” Rule 2.191 therefore should be revised to indicate that ESTTA filing is being mandated, not merely encouraged, in TTAB proceedings.