

From: Vincent Garlock [<mailto:vgarlock@aipla.org>]

Sent: Friday, June 03, 2016 9:44 AM

To: TTABFRNotices <TTABFRNotices@USPTO.GOV>

Subject: AIPLA's Comments on Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice

Dear Sir/Madam

On behalf of our President, Denise DeFranco, please find attached AIPLA's Comments on Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice. 81 Fed. Reg. 19296 (April 4, 2016).

Thank you in advance for your consideration of these comments.

Regards,

Vince Garlock

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June 3, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
Attention: Cheryl Butler

Via email: TTABFRNotices@uspto.gov

Re: AIPLA Comments on Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice, 81 Fed. Reg. 19296 (April 4, 2016)

Dear Under Secretary Lee:

The American Intellectual Property Law Association is pleased to present its views in response to the request for public comment on proposed changes to Trademark Trial and Appeal Board Rules of Practice. 81 Fed. Reg. 19295 (April 4, 2016).

The American Intellectual Property Law Association (AIPLA) is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA favors, in principle, the United States Patent and Trademark Office (USPTO) Trademark Trial and Appeal Board (TTAB or Board) proposed changes to the Trademark Trial and Appeal Rules of Practice (Federal Register Volume 81, Number 64 (Monday, April 4, 2016)) which endeavor to encourage greater efficiency and clarity in *inter partes* and *ex parte* Board proceedings.

AIPLA appreciates the time and effort of the Board in developing the recommended changes and is of the opinion that overall, the proposal meets the stated objective —to promote clarity and efficiency TTAB proceedings. In particular, AIPLA supports the requirement that all documents filed with the Board be through its Electronic System for Trademark Trials and Appeals (“ESTTA”) filing system. That said, AIPLA does have some reservations and additional comments concerning some of the specific rule proposals, as noted below.

1. Requirement to use ESTTA exclusively for Board filings. The Rules would require all documents to be filed electronically with the TTAB through the ESTTA electronic system. In general, AIPLA supports a requirement for electronic filing of all documents in Board proceedings. However, AIPLA is concerned whether ESTTA is robust enough for all filings (e.g., particularly large files and color exhibits) and how technical problems will be addressed. The USPTO experienced a significant system crash that negatively impacted the electronic filing systems for applications (TEAS) and Board proceedings (ESTTA) from December 22-28, 2015. Other technical problems are likely to arise from time to time in the future such that alternative means of paper filings should be permitted. Further, AIPLA understands that the Department of Commerce is considering consolidation of its IT systems for all agencies, including the USPTO. In the event of such a consolidation, it may be technically challenging to implement a requirement for exclusive electronic filing for all matters before the Board.

AIPLA therefore recommends that petitions to allow paper filings outside of ESTTA be liberally granted with a showing of technical difficulties (either at the USPTO or for the filer). The Director should waive all petition fees in the event of USPTO technical difficulties.

2. Service in *Inter Partes* proceedings. The proposed Rules shift service to the Board (akin to the pre-2007 rules). AIPLA supports the change to Rule 2.105(c) which requires the Board to prepare and serve an institutional notice of an opposition upon applicant's counsel, applicant's domestic representative, or applicant if no counsel or domestic representative is appointed.

3. Notification to the Board regarding known counsel, domestic representative, Section 66 cancellation proceedings. The Rules require that petitioners identify known counsel at the time of filing a cancellation petition. AIPLA generally supports the proposed Rule 2.112(a), requiring a cancellation plaintiff to notify the Board of known counsel representing the defendant registrant. However, AIPLA is concerned that this could be interpreted to apply a due diligence standard to affirmatively research and seek out counsel for the defendant registrant. Specifically, the “to the best of petitioner's knowledge standard” is too vague. AIPLA does not support any duty of due diligence or research, only a requirement to disclose counsel if the petitioner has affirmative knowledge of representation in the cancellation matter, such as through a prior exchange of communications with opposing counsel regarding the trademark that would be the subject of the cancellation proceeding. Further, the petitioner should not have to provide information that is in the USPTO records if the subject registration has an attorney of record listed within the Trademark Status & Document Retrieval (“TSDR”) database. Nor should the petitioner be required to perform a search for other applications/registrations owned by the same entity to see whether other attorneys appear in the record who might be “a possible representative of the owner.”

With regard to proposed Rule 2.113(c)(2), the Board will send the institutional notice only to the domestic representative at the email or correspondence address of record for the domestic representative in the TSDR records. AIPLA recommends that the petitioner be excused from providing additional or duplicative information about possible owners/attorneys in a petition for cancellation where there is a domestic representative in the TSDR record.

Under proposed Rule 2.113(c)(3), the Board is required to send the institutional notice to the “international registration holder's designated representative.” In such a case, AIPLA recommends that the petitioner be excused from providing additional or duplicative information about possible owners/attorneys in the petition for cancellation if there is a designated representative in the TSDR record.

4. Limitations on Discovery. The proposed Rules limit discovery from the current Rules. Under proposed Rule 2.120(a)(2)(iv), AIPLA is concerned that the proposed rule may be used to limit the number of discovery period extensions beyond current practice. Parties rely heavily on their ability to extend out these discovery deadlines. It is in large part due to the Board's current flexibility that most proceedings end in some kind of settlement. AIPLA recommends a liberal application of extension requests in discovery.

Proposed Rule 2.120(i) limits requests for admission to 75. AIPLA strongly objects to this limitation. While this proposed rule may sound reasonable in theory, it negates an effective discovery tool, particularly for long goods and services descriptions in registrations granted under Sections 44 and 66 based on foreign registrations and applications. Further requests for admissions can be useful in lieu of taking a deposition of a foreign individual and can help streamline and narrow written discovery. AIPLA recommends removing the limitation on the number of requests for admission considering that the number of goods/services identified within an application subject to an opposition proceeding or a registration subject to a cancellation proceeding can be unlimited.

5. Opposer to select grounds for opposition/ESTTA cover sheets in Section 66 oppositions.

Proposed Rule 2.104(c) requires identification of the goods and/or services opposed and the grounds supporting an opposition “on the ESTTA cover sheet *as well as in the* accompanying statement.” in Section 66(a) oppositions. Amendments will not be allowed regarding the inclusion of goods/services or grounds not in the cover sheet. To avoid any doubt, AIPLA requests a clarifying statement that “the ESTTA cover sheet controls” (or language parallel to Rule 2.107(b)).

Further, AIPLA recommends that Rule 2.104(c) be amended, consistent with proposed Rule 2.107(b), to prohibit amendments that add “joint opposers” if not identified on the ESTTA cover sheet.

While AIPLA supports the general prohibition against a late addition of joint opposers, there are certain circumstances where adding a joint opposer is currently allowed, and which should continue to be allowed under the revised rules. The proposed modification to Rule 2.107(b) to include the phrase “or to add a joint opposer” creates a discrepancy in the Rules in the circumstances where the original Opposer, after commencing the opposition against a 66(a) application, assigns all of its rights in a mark upon which it has based the opposition. Currently, if a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted for the originally named party if the assignment occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or if the defendant raises no objection to substitution. Otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence. See TBMP § 512.01. As written, the

proposed amendment would preclude the assignee from being added as a “joint opposer.” If the original Opposer/assignor has no interest in the assigned marks, and the assignee of the mark cannot be substituted or added as a “joint opposer,” a case can be made that the original Opposer lacks standing to pursue the action. Conversely, even if the case were not dismissed for lack of standing, if the assignee is not a party to the action, it may be more difficult for the defendant to conduct discovery. The amended Rule should be clarified and supplemented to instruct the parties explicitly how cases in this posture will be handled by the TTAB.

6. Termination of proceedings. Proposed Rule 2.136 pertains to termination of proceedings. AIPLA is concerned that the rule change fails to address a problem where in some cases, a registration issues following receipt of a notice of termination of a Board proceeding even when the proceeding has been decided adversely to the applicant. AIPLA recommends that the proposed rule address this problem by requiring all termination orders to specify whether registration is refused.

7. Citation to the record. Proposed Rule 2.142(b)(3) pertains to a new citation form when citing documents in the record within a brief. AIPLA recommends that the rule be amended to include an example of a preferred citation format.

8. Remote attendance at hearings. Proposed Rule 2.142(e) pertains to remote attendance at hearings at the Board's discretion. AIPLA supports the change to the rule, and recommends that such discretion be liberally granted with a presumption that remote participation will be granted where counsel, an examining attorney, or participating member of the Board are located 100 miles or more from the oral hearing location.

9. Ex parte appeals/timing and fee amounts. AIPLA recommends that the proposed rules consider an option for paying a reduced fee for filing an *ex parte* appeal brief in lieu of a fee increase in FY17¹ for filing a Notice of Appeal. This would impact at least Rule 2.142 (currently not amended by the proposed rule change). Such a suggestion was first posed by AIPLA in its comments to the proposed trademark fee increase in its November 10, 2015 letter (page 3, paragraph D) to Under Secretary and Director Lee. Paragraph D is reproduced here:

D. AIPLA Opposes a Fee Increase for an Electronically Filed Notice of *Ex Parte* Appeal and Instead Recommends a Fee of \$100 Per Class Upon Submission of Applicant's Brief.

¹ On May 27, 2016, the USPTO announced its fee increase, after receipt of comments from the public hearing held by the Trademark Public Advisory Committee (“TPAC”) on November 3, 2015 and from a request for written comments pertaining to the proposed changes. The May 27, 2016 fee proposal doubles the fee for filing an *Ex Parte* Appeal and there is no proposed separate fee for filing an *ex parte* appeal brief. AIPLA will comment on the fee proposal separately, but continues to encourage the USPTO to consider a two-tiered fee approach where the fees are apportioned between an initial low cost fee for filing a Notice of *Ex Parte* Appeal and a second fee for submitting an *ex parte* appeal brief to the TTAB.

AIPLA opposes a fee increase for an electronically-filed *ex parte* Notice of Appeal. *In lieu of this fee increase, AIPLA recommends that the USPTO consider instituting an additional fee during ex parte appeals at the time the applicant's opening brief is submitted.* Many applicants file a Notice of Appeal in conjunction with a Request for Reconsideration to preserve the right to appeal in the event the Examining Attorney denies reconsideration. Frequently, however, the appeal does not go forward. Accordingly, imposing a higher fee for every Notice of Appeal seems unwarranted and may have an adverse impact on customers, especially considering that these fees would be imposed on a per class basis. [Emphasis added.]

If the USPTO were to adopt the AIPLA proposal, the TTAB Rules, particularly Rule 2.142, would need to be revised accordingly.

AIPLA once again acknowledges the effort by the USPTO to amend these rules of practice and we thank you for allowing AIPLA the opportunity to provide comments on the proposed changes. Please feel free to contact us in the event you have any questions regarding these comments.

Sincerely,



Denise W. DeFranco
President
American Intellectual Property Law Association