

From: Josh King [<mailto:jking@king-iplaw.com>]

Sent: Monday, April 04, 2016 11:41 PM

To: TTABFRNotices <TTABFRNotices@USPTO.GOV>

Cc: Jamie Horner <Jhorner@king-iplaw.com>

Subject: FW: Trademark: Federal Register Publication of Notice of Proposed Rulemaking Relating to Miscellaneous Changes to TTAB Rules of Practice

Dear Patent and Trademark Office:

I am submitting this comment in response to email below and to the notice of proposed rulemaking relating to miscellaneous changes to the Trademark Trial and Appeal Rules of Practice.

Regarding the proposed change to authentication of documents, codified in proposed new rule Sec. 2.120(i), Discovery, I have underlined the objectionable section below:

(i) Requests for admission. The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts. If a party upon which requests for admission have been served believes that the number of requests for admission exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the requests for admission, serve a general objection on the ground of their excessive number. However, independent of this limit, a party may make one comprehensive request for admission of any adverse party that has produced documents for an admission authenticating such documents, or specifying which documents cannot be authenticated.

This proposal is a horrible idea for at least two reasons.

1) Even in simple cases, the number of pages of documents that may be produced can be several thousand, and in complex cases such as cases with survey evidence, proof of secondary meaning, or allegations of genericness, can exceed 100,000, sometimes even more than a million. The burden on a producing party to have to list each and every page/document and whether it is authenticated would be hugely burdensome and indeed could cost hundreds of thousands of dollars. That is antithetical to the purpose of these proposed changes which is to streamline the rules, making them easier and more cost-effective. A much better rule, and the one I've seen followed in district court practice, is to allow a recipient of documents to identify all documents it wants authenticated and then require the producing party to respond to those specific documents.

2) In situations where the recipient is the only party seeking to use a given document, the rule switches the burden of proof for the right to use the document from the recipient to the producing party: Since the producing party has no idea which of the numerous documents produced are

actually useful to the recipient, the producing party decide for the recipient, and therefor on the recipient's behalf, whether such documents are actually authentic or not. This is certainly antithetical to the purposes of these proposed rule changes, and may well violate the Constitution.

Of course, please let me know if you have any questions.

Very truly yours,

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From: USPTO News [<mailto:noreply@enews.uspto.gov>]
Sent: Monday, April 4, 2016 6:25 PM
To: Josh King <jking@king-iplaw.com>
Subject: Trademark: Federal Register Publication of Notice of Proposed Rulemaking Relating to Miscellaneous Changes to TTAB Rules of Practice

On April 4, 2016, the USPTO issued a notice of proposed rulemaking relating to miscellaneous changes to the Trademark Trial and Appeal Rules of Practice in the Federal Register. There is a 60-day comment period for the notice, which was published at 81 FR 19295 and is available at: www.gpo.gov/fdsys/pkg/FR-2016-04-04/html/2016-06672.htm .

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