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Sent: Friday, May 27, 2016 12:35 PM
To: TTABFRNotices <TTABFRNotices@USPTO.GOV>
Cc: Lorna Soderberg <lsoderberg@ipo.org>; Mark Lauroesch <mllauroesch@ipo.org>
Subject: IPO Letter in Response to Federal Register Notice on Proposed TTAB Rules

Please accept the attached letter from the Intellectual Property Owners Association in response to the USPTO's request for comments on the "Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice; Proposed Rules" (81 Fed. Reg. 64).

All my best,
Vanessa

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May 27, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Mail Stop CFO
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Cheryl Butler

Via email: TTABFRNotices@uspto.gov

**Re: IPO Comments on “Miscellaneous Changes to Trademark Trial
and Appeal Board Rules of Practice; Proposed Rules,” 81 Fed. Reg. 64
(April 4, 2016)**

Dear Director Lee:

Intellectual Property Owners Association (IPO) submits the following comments on the United States Patent and Trademark Office’s request for comments on the “Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice; Proposed Rules” (81 Fed. Reg. 64).

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO’s membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans 43 countries. IPO advocates for effective and affordable IP ownership rights and provides a wide array of services to members, including supporting member interests relating to legislative and international issues; analyzing current intellectual property issues; information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

IPO appreciates the USPTO’s effort to allow stakeholders the opportunity to provide comments on the proposed Trademark Trial and Appeal Board Rules of Practice. IPO’s comments are directed to the proposed rules on the notice provisions in both opposition and cancellation proceedings, the contents of petitions for cancellation, electronic filing, discovery, suspension, and requests for admission.

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1. Proposed Rule § 2.105(b)(2) Notification to Parties of Opposition Proceeding

Proposed Rule § 2.105(b)(2) states:

The Board shall forward a copy of the notice to opposer, as follows:

(2) If the opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless opposer designates in writing another correspondence address.

To avoid confusion surrounding whether the opposer has appointed a domestic representative in connection with the opposition (as opposed to appointment of a domestic representative in the application or registration that might be involved in the opposition proceeding), Proposed Rule § 2.105(b)(2) should be clarified as shown with strikethrough and underscore below:

If the opposer is not represented by an attorney in the opposition, but opposer **has filed with the Board an appointment of** ~~appointed~~ a domestic representative **in the opposition proceeding**, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless opposer designates in writing another correspondence address.

The same clarifying changes should be made to Proposed Rule § 2.113(b)(2), which is the analogous rule for cancellation petitions. Specifically, Proposed Rule § 2.113(b)(2) should be amended as shown with strikethrough and underscore below:

If the petitioner is not represented by an attorney in the cancellation proceeding, but petitioner **has filed with the Board an appointment of** ~~appointed~~ a domestic representative **in the cancellation proceeding**, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless petitioner designates in writing another correspondence address.

2. Proposed Rule § 2.112 Contents of Petition for Cancellation

Proposed Rule § 2.112(a) states:

The petition for cancellation must . . . indicate, to the best of petitioner's knowledge, the name and address, and a current email address(es), of . . . any attorney, as specified in §§ 11.14(a) and (c) of this Chapter, reasonably believed by petitioner to be a possible representative of the owner in matters regarding the registration.

The standard "to the best of petitioner's knowledge" is vague and purports to impose a burden on petitioner. The rule should instead state that the petitioner must provide information about any

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attorney reasonably believed to be a possible representative only when petitioner has actual knowledge of that information. If the proposed rule is not amended to incorporate an “actual knowledge” standard, then the proposed rule should provide some parameters for the due diligence, if any, that a petitioner must undertake to comply with the proposed rule’s requirement that the petitioner “must” provide this information about attorneys who might be a “possible representative” of the owner. The rule should clearly state that the petitioner need not provide the names of related or parent companies, or attorneys for such related or parent companies, even though such entities might be a “possible representative” of the owner. Likewise, the rule should make clear that the petitioner is not required to research information that is already in the Trademark Office records, because such information is as readily available to the TTAB as it would be to the petitioner, specifically:

- Name and email address of any attorney(s) whose name appears in the PTO’s file wrapper/registration file for the registration(s);
- Name and email address of any attorney(s) whose name appears in the Assignments Branch records; and
- Name and email address of attorneys listed in other applications/registrations owned by the same entity.

a. Domestic Representative.

Because Proposed Rule § 2.113(c)(2) states that the Board will send the [institution] notice “**only** to the domestic representative at the email or correspondence address of record for the domestic representative,” (emphasis added), the petitioner should be excused from providing the required information about possible attorneys in the petition for cancellation in these cases.

b. Registrations Issued under 66(a).

Because Proposed Rule § 2.113(c)(e) states that for registrations that are extensions of protection of an international registration, the Board will send the [institution] notice “to the international registration holder’s designated representative”, the petitioner should be excused from providing the required information about possible attorneys in the petition for cancellation in these cases.

Further commenting on Proposed Rule § 2.112(a), the Background section of the Federal Register notice (p. 19297, first column), states:

[A]ny attorney so identified [by the plaintiff as a possible representative of the owner] is not considered counsel of record for the defendant until and unless either a power of attorney is filed or an appearance is made by the attorney in the proceeding.

The Background section further states:

[T]he goal of this requirement is simply to assist in locating current owners of the registrations, so that each cancellation case will involve the real parties in interest.

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With respect to the proposed requirement for petitioners to provide the Board with the name, address, and a current email address of “an attorney reasonably believed by the petitioner to be a possible representative of the owner in matters regarding the registration,” we request clarification as to what the Board will do with this information. The final rules should also clarify in what circumstances this information will be used by the Board.

The Background section of the notice (p. 19297, first column) states that “any attorney so identified [by the petitioner as a possible representative of the owner] is not considered counsel of record for the defendant until and unless either a power of attorney is filed or an appearance is made by the attorney in the proceeding.” It follows that sending the notice to such an attorney does not constitute service of the cancellation petition on the registrant. If that is the correct reading, the final rules should so state.

The proposed rules are silent as to the consequences of sending the notice to an attorney identified through these means. If the proposed rule is adopted, the final rule should clarify that notices sent to attorneys because they have been identified by the petitioner under this § 2.112 will include an explanation that that is the reason why they are receiving the notice, will state that the notice does not constitute service on the party, and will state that the attorney is not considered counsel of record until and unless either a power of attorney is filed or an appearance is made by the attorney in the proceeding. To alleviate the burden imposed on an attorney who receives such a notice but is not a representative of the owner, such a notice should state that the attorney need not take any action with respect to the notice if he or she is not a representative of the owner. It would be helpful if the final rules also stated whether any presumptions will flow from an attorney’s failure to acknowledge the notice.

3. Proposed Rule § 2.113 Notification of Cancellation Proceeding

Proposed Rule § 2.113(a) states that when a petition for cancellation has been properly filed, the Board shall prepare a notice of institution and further states that:

If a party has provided the Office with an email address, the notice will be transmitted via email. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.

Proposed Rule § 2.113(c) then provides further details of the persons in the position of respondent to which the notice shall be sent. Specifically, Proposed Rule § 2.113(c)(1) states that the notice shall be sent to the party shown by the records of the Office to be the current owner of the registration(s). Proposed Rule § 2.113(c)(2) states that the notice shall be sent to the domestic representative if one is appointed. Finally, Proposed Rule § 2.113(c)(3) states that the notice will be sent to the international registration holder’s designated representative. This latter subparagraph then reiterates that the sending of the notice constitutes service on the respondent, which is the only subparagraph to so reiterate. Because Proposed Rule § 2.113(a) states that the notice constitutes service, we request clarification as to why this is reiterated in Proposed Rule § 2.113(c)(3) but not in subparagraphs (c)(1) or (c)(2).

In § 2.113(c)(1) (service on the party), we request that the final rules clarify to which email address or street address the notice will be sent, when there is inconsistent information listed in the

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“Current Owner Information” field in the “Trademark Status & Document Retrieval” (TDSR) database versus the “Correspondence Address” field. We request clarification of which of these fields is the operative field from which the email address or street address will be drawn. We note that the “Current Owner Information” field is automatically updated when a change affecting ownership is recorded with the Assignments Branch, whereas the “Correspondence Address” field is not automatically updated by such a filing.

Proposed Rule § 2.113(c)(3) states that:

In the case of a registration issued under 15 U.S.C. 1141i [an extension of protection of an international registration], notice will be sent to the international registration holder’s designated representative. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service to respondent of the petition to cancel.

During the course of prosecution of an extension of protection of an international registration, an attorney authorized to practice before the USPTO might be entered in the record, or a domestic representative might be appointed, which produces at least two issues. The first issue is that there is a conflict between Proposed Rules § 2.113(c)(2) (if a domestic representative has been appointed, the notice will be sent “only” to the domestic representative) and Proposed Rule § 2.113(c)(3) (notice will be sent to the international registration holder’s designated representative).

The second issue is that if an attorney authorized to practice before the USPTO became the attorney of record during prosecution of the application(s) that matured to registration, or was entered in the record at the time of filing post-registration maintenance for the registration(s) against which the cancellation petition has been filed, then the name and contact information for the international registration holder’s designated representative might not appear in the Trademark TSDR database. It is unclear whether the Board intends to consult the database of the International Bureau of the World Intellectual Property Organization in order to obtain the name and contact information of the international registration holder’s designated representative.

Further, we request clarification why a different rule is proposed for notice in cases of registrations that are extensions of protection of an international registration from that for a registration that issued under Lanham Act § 1 or 44. The registrant is a “party” encompassed by § 2.113(c)(1). We would like to understand the reason for the differential treatment. If Proposed Rule § 2.113(c)(3) means that in addition to notice being sent to the party shown as the current owner in the records of the Office, it will also be sent to the international registration holder’s designated representative, then that should be clarified.

Proposed Rule § 2.113(c)(2) states that, when a domestic representative has been appointed, the Board will send the [institution] notice “**only** to the domestic representative at the email or correspondence address of record for the domestic representative” (emphasis added). Proposed Rule § 2.113(d) states, however, that “when the party alleged by the petitioner, . . . as the current owner of the registration(s) is not the record owner, a courtesy copy of the notice with a web link or web address to access the electronic proceeding record shall be forwarded to the alleged current owner. The alleged current owner might file a motion to be joined or substituted as respondent.”

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This suggests that in such instances, the Board will not send the notice “only” to the domestic representative, as stated in § 2.113(c)(2), because it will also send a courtesy copy of the notice to the alleged current owner, as stated in § 2.113(d). This should be clarified in the final rules.

4. Electronic filing – Multiple Proposed Rules

We do not support the requirement that documents filed on paper must be accompanied by a petition to the Director with the fee and the showing that is proposed in these rules. When technical difficulties force a party to file on paper, that paper filing almost always will be made on the last day of the deadline. Otherwise electronic filing would have been attempted again when the technical difficulties had been resolved. The petition procedure introduces unwelcome uncertainty as to whether the petition will be granted. Filing on the last day of a filing period does not mean that an attorney has not been diligent in endeavoring to meet the deadline. Clients do not always provide instructions in advance of the deadline.

5. Discovery – Proposed Rule § 2.120(a)(3)

The Board proposes to require that discovery be served in time to be answered before discovery closes. The “Background” section states that “the proposed amendment is intended to alleviate motion practice prompted by responses to discovery requests served after discovery has closed.” We would appreciate clarification of how the proposed change will alleviate motion practice.

6. Suspension – Proposed Rules §§ 2.120(f) and 2.127(d)

These proposed rules provide that when a party files certain motions, “the case will be suspended by the Board with respect to all matters not germane to the motion.” We propose that the language be revised to clarify whether the case is automatically deemed suspended upon the filing of such a motion (which we believe to be the intended meaning), or whether the case will be suspended only upon issuance of a suspension order.

7. Requests for Admission – Proposed Rule § 2.120(i).

We do not support the proposal to limit requests for admission to 75 because in some cases additional request will expedite resolution of the case.

We thank you for considering these comments and would welcome any further dialogue or opportunity to provide additional information to assist your efforts in developing the Trademark Trial and Appeal Board Rules of Practice.

Sincerely,



Mark W. Lauroesch
Executive Director