

From: [Fred W. Hathaway](#)
To: [TTABFRNotices](#)
Subject: Comments: New Rules for Streamlined TTAB Proceedings (82 FR 22517; Docket No.: PTO-T-2017-0012; Document No. 2017-09856)
Date: Friday, June 09, 2017 3:21:00 PM

Dear Sir/Madam:

In response to the request for comments,

1. Sanctions And/Or Requirement for Petitioner to Detail Investigation Efforts

To discourage the possible use of the streamlined proceedings to harass trademark owners, if the respondent's evidence of use to counter the petition is of a type that the petitioner should readily have found in a good faith search, then consideration might be given to making sanctions available against the petitioner (e.g., barring petitioner's right to file another cancellation proceeding on abandonment or other grounds for a period of time). Alternatively or additionally, the rules might require petitioners to attest to and set forth in some detail in the petition the actions they took an effort to determine whether the mark is in use, as of what dates, and for which goods/services in the registration.

2. Additional Grounds

Further to the interest of maintaining a more accurate Register, consideration might be given to including genericness and functionality, and lack of distinctiveness (if brought within five years of registration), as grounds that may be asserted in the streamlined proceedings. As with non-use abandonment, the evidence would mostly or fully be documentary in nature (third party uses, dictionary listings) and the respondent would have the opportunity to provide its own evidence of it challenging improper uses of the mark, distinguishing the uses submitted by petitioner, or minimizing them by showing other uses of the term as a mark or recognition by others that it is a mark. In other words, the evidence would be virtually the same as what Examining Attorney's rely on in making a refusal as to either descriptiveness or genericness.

3. Miscellaneous

If a petition for partial cancellation is filed as a result of a Section 2(d) citation against the petitioner's application, 1) must the petitioner include in its petition that the partial cancellation would remove the Section 2(d) rejection (see TBMP 309.3(d), and such statement might be necessary to establish standing), and 2) in the interest of streamlined proceedings will the Board then enter the proven limitation and leave it to the Examining Attorney to make a determination of whether the goods/services ultimately proven for cancellation would narrow the respondent's registration sufficiently to remove the Section 2(d) refusal? (Compare with TBMP 309.3(d) at f.n. 8 where Board makes determination on likelihood of confusion and limitation is not entered if it would not resolve likelihood of confusion.)

May a petitioner also petition under the streamlined proceeding rules for amendment of

respondent's registration to further specify the goods/services as to type, use, channels of trade, etc. (also in an effort to overcome a Section 2(d) rejection)? (TBMP 309.3(d), 15 USC 1068.)

Respectfully submitted,

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