To: TTABFRNotices@uspto.gov

[Docket No. PTO-T-2009-0030]

June 2, 2016

Comments of the E-Trademarks listserv

This comment responds to the Notice of Proposed Rulemaking of the US Patent and Trademark Office dated April 4, 2016. In the Notice, the Trademark Trial and Appeal Board proposes a number of changes to the rules of practice before the TTAB.

The E-Trademarks listserv is a group including several hundred trademark practitioners. These practitioners draw upon substantial experience before the TTAB, in many cases more than a decade of experience. The twenty-eight practitioners whose signatures appear below have between them appeared in well over two thousand matters before the TTAB.

Proposed resumption by the TTAB of responsibility for carrying out service. It is recalled that prior to 2007, in opposition and cancellation proceedings, the TTAB took responsibility for carrying out service upon the defendant. In 2007 the TTAB promulgated a rule change shifting the service burden to the plaintiff. Now in 2016 the TTAB proposes once again to assume responsibility for carrying out service. This comment does not object to the TTAB assuming responsibility for carrying out service.

Proposed duty to provide email address for service. For anyone carrying out service, the natural question is "upon whom should I serve?" The TTAB proposes to amend the rule to add that the petition for cancellation must indicate, to the best of plaintiff's knowledge, a current email address of the current owner of the registration and of any attorney reasonably believed by the petitioner to be a possible representative of the owner in matters regarding the registration.

The proposed language recognizes (correctly) that in some cases the plaintiff may know of contact information of which the TTAB is unaware. For example the plaintiff may recently have been in direct communication with a representative of the defendant (such as an attorney or an individual at the defendant's company) whose name does not appear anywhere in the application file at the USPTO.

This comment recommends, however, that the rule should make clear that it does not impose any burden upon the plaintiff to carry out any investigation about contact information for the registrant. Likewise the rule should make clear that the plaintiff is not obligated to go on a hunt for an email address if the plaintiff only knows other contact information such as a postal mailing address. The rule should make clear that the only burden on the plaintiff is to disclose any email address or other contact information *already known to the plaintiff* that is not already of record in the application file. If the registrant has designated a domestic representative, then the TTAB should simply carry out service upon the domestic representative without expecting the plaintiff to hunt for some other contact information.

Proposed limit on Requests to Admit. The TTAB proposes to limit requests for admission to 75. This comment strongly objects to this proposed limitation. The proposed limitation would eviscerate an effective discovery tool, particularly in cases with Section-44 and Section-66 filing bases. Such cases can identify many hundreds of items of goods and/or services. The proposed limit would deviate

from federal court practice where there is no limit on such requests for admission. It should be appreciated that requests for admission promote the narrowing of issues and the simplification of the case for trial (or a summary judgment motion).

Respectfully submitted,

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