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To: TTABFRNotices <TTABFRNotices@USPTO.GOV>

Subject: Miscellaneous Changes to Trademark Trial and Appeal Board Rules Published in 81 Fed. 64

**United States Patent and Trademark Office
Trademark Trial and Appeal Board**

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

Attn: Cheryl Butler

Re: Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice Published in 81 Fed. Reg. 64

We have considered the proposed amendments to the Trademark Trial and Appeal Board Rules and their background discussion. We think these amendments will largely serve to provide for more efficiency and clarity, particularly in inter partes proceedings.

However, we have the following concerns:

(1) Sec. 2.120(i) Requests for Admissions

No limit should be placed on the number of requests for admissions because (a) they serve to narrow the issues, (b) the Federal Rules of Civil Procedure set no such limit, (c) responding to requests for admissions is far less burdensome than responding to interrogatories or requests for documents, and (d) a 75-limit would prejudice, e.g., an opposer, attacking an ITU or Section 44 application with numerous goods, from serving two-subpart requests for each product for admissions that applicant had no bona fide intent when it filed, and has no document reflecting such an intent.

(2) Sec. 2.123 Trial testimony in inter partes cases

The proposed amendment should require that the affidavit or declaration contain facts admissible in evidence. The current proposed amendment not only lacks such a requirement but undercuts it by permitting testimony by declaration "pursuant to Sec. 2.20". This would cause parties to include inadmissible evidence in their declarations. For Sec. 2.20 permits the signatory to make statements "on information and belief" that "are believed to be true." Hence, a declarant employed by an opposer for one year could state opposer's mark has been used for 20 years because declarant was so informed by another employee with personal knowledge. But this would be inadmissible hearsay.

We suggest that this proposed amendment be revised to require that the affidavit or declaration "must set out facts that would be admissible in evidence", and show that the affiant or declarant is "competent to testify on the matters stated." These are two of the requirements FRCP 56 imposes for a summary judgment motion. They should apply as well to testimony in inter partes cases.

We understand that objections may be made to the competency of the declarant, or to the competency, relevancy or materiality of testimony (Proposed Rule 2.123(j)). But the proposed rule,

as now worded, would increase the submission of inadmissible evidence and objections thereto, resulting in delays, and burdens on the Board, and working against the Board's objectives of providing clarity and efficiency to the public.

Sincerely,

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