

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **TTAB's 2017 AMENDED RULES OF PRACTICE**

Honorable David Mermelstein

Trademark Trial and Appeal Board Judge

January 12, 2017

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# Topical Overview

- ESTTA: Enhancements in place
- TTAB's Notice of Final Rulemaking (NFRM)
- Trademark Fee Adjustment

# ESTTA Enhancements: Deployed April 2016

- Complaint: additional grounds listed on form
- Option to view attachment before submission
- Filing receipt now transmitted to filer and adversary where email of record
- Save feature to allow users to circulate for pre-filing review
- A modified general filing form for motions not included in available list of motions
- Amendment to registration: declaration as required under 37 CFR § 2.173 added to ESTTA form for motion to amend registration
- Pre-filing checklist



# **ESTTA Enhancements: Deployed January 2017**

- **Elimination of service statement for initial complaints**

# TTAB's Amended Rules of Practice

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# Notice of Final Rulemaking

- 81 FR 69950
- Published in Federal Register October 7, 2016
- Effective date: January 14, 2017
- Notice of Proposed Rulemaking
  - 81 FR 19296
  - Published in Federal Register April 4, 2016

# In Effect Before January 14, 2017

- Changes in Federal Rules of Civil Procedure from December 2015
- Revised TTAB Standard Protective Order (as of June 24, 2016)
  - Automatically imposed in *inter partes* proceedings
  - Parties may modify by stipulation but subject to Board approval
  - Changes include:
    - Update to explicitly include disclosures (required and supplemental)
    - 3 to 2 tiers of designations:
      - Confidential
      - Confidential – Attorneys' Eyes Only (Trade Secret/Commercially Sensitive)
    - Inclusion of personal health, medical and financial information in Confidential-Attorneys' Eyes Only tier
    - Clawback provision



# Objectives of Amending the Rules

- Further USPTO Strategic Objective
  - Move towards fully integrated paperless filing and docketing system
  - Promote efficiency by mandating electronic filing
- Provide Efficiencies
  - Technological
  - Scheduling
- Promote Clarity
  - Conform to current practices
  - Use standard, current terminology
  - Update changed references

# Significant Changes Since NPRM

## Eliminated:

- Proposed petition requirement for paper filings other than initial complaints, answers and extensions of time to oppose
- Proposed requirement that petitioner inform Board of any attorney reasonably believed to represent respondent
- Proposed requirement that petitioner inform Board of any attorney reasonably believed to represent respondent
- Proposed requirement to notify adverse parties when foreign witness would be present in U.S.

## Retained:

- Interrogatories limited to 75 [37 CFR § 2.120(d)]

## Added:

- RFPs limited to 75 [37 CFR § 2.120(e)]
- RFAs limited to 75 [37 CFR § 2.120(i)]

Motions to file additional interrogatories, RFPs, and RFAs allowed on showing of good cause

# Final Rule: Filing and Service

- File only through ESTTA unless prevented by technical problems or extraordinary circumstances:
  - Paper filings for initial complaints, answers and extensions of time to oppose
    - Require Petition to Director and fee
    - Require showing of technical problems or extraordinary circumstances
    - See 37 CFR §§ 2.101(b)(1) - (3); 2.102(a)(1) - (2); 2.106(b)(1); 2.111(c)(2); 2.114(b)(1)
  - All other paper filings
    - Do not require a Petition to Director
    - Require showing of technical problems or extraordinary circumstances
    - See 37 CFR § 2.126(b)
- Extensions of time to oppose and notices of opposition against Section 66(a) applications **MUST** be filed through ESTTA without exception. See 37 CFR §§ 2.101(b)(3) and 2.102(a)(1)

# Final Rule: Paper Filing - Technical Problems

- **ESTTA is unavailable**
  - USPTO will cross-check time and duration to confirm unavailability
  - Users are encouraged to check USPTO System Status
- **Problems at filer's end**
  - Must describe in detail

# Final Rule: Paper Filing - Extraordinary Circumstances

- Relevant facts and accompanying evidence
  - Disasters
    - Fire
    - Hurricanes, snowstorms
  - Extended power outages
  - Medical emergencies
- Remember: Commissioner is not empowered to waive or suspend a requirement of the Trademark Act

# Final Rule: Filing and Service

- **Plaintiff no longer required to serve complaint on defendant**
  - Proceeding commenced by filing in the Office a timely complaint with required fee
  - See 37 CFR §§ 2.101(a) - (b) and 2.111(a) - (b)
- **Board will issue notice of institution and serve complaint on adverse party with TTABVue link/address**
  - See 37 CFR §§ 2.105(a); 2.113(a)

# Final Rule: Electronic Service

- **Except for initial complaint, all documents and filings must be served by email unless parties stipulate to alternative means**
  - Make sure your email and street addresses are up-to-date
  - Parties expected to facilitate electronic communication with Board and each other
- **Absent agreement, documents served by alternative means (e.g., First Class Mail, hand delivery) must be accompanied by written explanation**
- **See 37 CFR §§ 2.119(a) and (b)**

# Final Rule: Procedure

- Suspension

- Board may suspend proceedings *sua sponte* - 37 CFR § 2.117(c)
- Has discretion to condition approval of consented suspension on providing necessary information about status of settlement talks, discovery, or trial activities - 37 CFR § 2.117(c)
- Proceeding *is* suspended upon the *filing* of a potentially dispositive motion - 37 CFR § 2.127(d)
- Proceeding is suspended for other motions (e.g., compel) when suspension order is *mailed*
  - No change from prior practice
  - Board retains ability to manage its docket



# Final Rule: Time

- **Response Times**

- Additional 5 days for acting within prescribed period no longer allowed - 37 CFR § 2.119(c)
- All 15-day response and reply deadlines for briefing a motion are amended to 20 days - 37 CFR § 2.127(a)
- Summary judgment motions: time for response or filing of motion under Fed. R. Civ. P. 56(d) remains at 30 days; reply is amended to 20 days - 37 CFR § 2.127(e)(1)
- Responses to written discovery: remain 30 days in accordance with Fed. R. Civ. P. 33, 34 & 36 - 37 CFR § 2.120(a)(3)

# Final Rule: Discovery

- Expressly adopts proportionality in process and procedure - 37 CFR § 2.120(a)(1)
- Initial disclosure and expert disclosure deadlines remain the same
- Must serve discovery early enough so that responses (including production or inspection) will be due no later than the close of discovery - 37 CFR § 2.120(a)(3)

# Final Rule: Discovery

- **Limits on discovery requests**
  - 75 Interrogatories, 75 Requests for Admission, and 75 Requests for Production
    - 37 CFR § § 2.120(d), (e) & (i)
  - May move for good cause to exceed limits
    - 37 CFR § § 2.120(d), (e) & (i)
  - One comprehensive RFA to authenticate specific documents produced by adverse party
    - 37 CFR § 2.120(i)
- **Discoverable items include ESI as well as documents and tangible things - 37 CFR § § 2.120(e) & (f)**

# Final Rule: Discovery

- No per se “cap” on number of extensions of discovery period
- But extensions should be limited
- If too many extensions are requested, Board may condition further extensions upon a required showing, or may deny further extensions entirely – Cf. 37 CFR § 2.117(c)
- Expert disclosure deadline must always be scheduled prior to the close of discovery - 37 CFR § 2.120(a)(2)(iv)

# Final Rule: Motions

- Motion to compel initial disclosures due 30 days after deadline for initial disclosures - 37 CFR § 2.120(f)(1)
- Motion to compel discovery or to test sufficiency of responses to RFAs must be filed prior to the deadline for the first pretrial disclosure - 37 CFR § § 2.120(f)(1) & (i)(1)
  - Once deadline passes, any subsequent resetting of first pretrial disclosure deadline will not reset the time to file a motion to compel

# Final Rule: Motions

- Filing potentially dispositive motion automatically suspends proceeding - 37 CFR § 2.127(d)
- Motions for summary judgment must be filed before deadline for plaintiff to make pretrial disclosures - 37 CFR § 2.127(e)(1)
  - Once deadline passes, any subsequent resetting of first pretrial disclosure deadline will not reset the time to file a motion for summary judgment
  - Parties may stipulate to an abbreviated trial
- These changes intended to avoid surprises on the eve of trial

# Final Rule: Trial

- **Testimony by affidavit or declaration**
  - 37 CFR §§ 2.123(a)
  - Subject to right of adverse party to take cross-exam
- **Deposition transcripts must be submitted one page per sheet and with a word index**
  - 37 CFR §§ 2.123(g)(1) and (3)
  - TTAB judges and attorneys *do* read the submissions
- **Standardized requirements for notices of reliance, including Internet evidence**
  - 37 CFR § 2.122(g)

# Final Rule: Trial

- **Notice of Reliance**
  - Internet materials - 37 CFR § 2.122(e)(2)
  - Current copy of information from USPTO databases
    - Pleaded registrations
    - Registrations (pleaded or unpleaded) owned by any party - 37 CFR § 2.122(d)(2)
    - Pending applications - 37 CFR § 2.122(e)
  - Indicate generally the relevance and associate with one or more issues - 37 CFR § 2.122(g)
- **File of subject application or registration**
  - Is of record without any action by the parties - 37 CFR § 2.122(e)
  - Statements in affidavits or declarations in file history record are not testimony - 37 CFR § 2.122(b)(2)



# Final Rule: Trial

- **Use of discovery deposition** - 37 CFR § 2.120(k)
  - Must file motion with pretrial disclosure - 37 CFR § 2.120(k)(2)
- **Witness not included in pretrial disclosure**
  - Move to quash notice of testimony deposition - 37 CFR § 2.121(e)
  - Move to strike if testimony presented by affidavit or declaration - 37 CFR § 2.121(e)

# Final Rule: Trial Briefs

- Evidentiary objections may be made in an appendix or by way of a separate statement of objections, neither of which is included in the page limit
- Briefs exceeding the page limit may not be considered by the Board
- See 37 CFR § 2.128(b)

# Ex Parte Appeals to the Board

- **Record must be complete - 37 CFR § 2.142(d)**
  - New evidence cannot be submitted after filing notice of appeal except:
    - Timely request for reconsideration [TBMP § 1207.04]
    - Request for remand granted
  - No change to substance of rule
  - Expressly addresses a recurring mistake made by applicants
- **37 CFR § 2.142(b)(2): Main brief limited to 25 pages. Explicitly notes that reply brief shall not exceed 10 pages**

# Final Rule: Judicial Review of TTAB Decisions

- **Rules are reorganized to align with PTAB**
  - Time for filing for judicial review= 63 days from Board's decision
- **Copies of notices of appeal, notices of election, and complaints should be filed with the Board via ESTTA**
  - Avoids premature termination of proceedings
- **Copies of notices of appeal must be served on every other party to the proceeding**
  - In ex parte proceedings, notices of appeal must be filed with the Director, addressed to the Office of General Counsel. If the review is by way of civil action, the summons and the complaint must be served on the Director.
  - In inter partes proceedings, notices of appeal and notices of election must be served on all parties and filed with the Director, addressed to the Office of General Counsel.
- **37 CFR § 2.145**

# Final Rule

- Enhances efficiency and clarifies process in trial and appeal cases
- Increases use of electronic filing
- Harmonizes rules with existing practice, case law and Federal Rules

# Final Rule

- Promotes proportional discovery completed during discovery period
- Distinguishes pre-trial activities from discovery and trial activities
- Introduces more flexibility for parties during trial

# Final Rule

- **Board processes considered significant by Supreme Court remain unchanged:**
  - ✓ **Discovery, including depositions**
  - ✓ **Testimony under oath; cross-examination**
  - ✓ **Availability of oral argument**
  - ✓ **Option for de novo review in District Court**

# Final Rules – In Transition

- Advance notice: Publication of Notice of Final Rulemaking to effective date was set to allow litigants and applicants to prepare – almost 4 months
- Flexibility: Board attorneys/judges have discretion to apply/not apply particular rules in accord with circumstances and equities of cases *pending* when the final rules become effective



# Related Resources for Jan. 14

- Expect TBMP revision
- Expect additional IT enhancements
- Expect revised form orders
- Expect additional FAQ's

# TTAB home page updates

- Updated currently at the TTAB's home page:
  - Federal Register notice of final rule
  - Chart summarizing rule changes
  - New "Archives" section
  - Rule change FAQs (more coming soon)
  - [www.uspto.gov](http://www.uspto.gov)

# Trademark Fee Adjustment Notice of Final Rulemaking

TTAB Fee Increases and New Fees

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# TTAB Fee Changes

- **Ex parte appeal filing fee:**
  - first increase in 25 years
- **Opposition and cancellation filing fees:**
  - first increases in 15 years
- **New fees for certain extensions of time to oppose**

# Fees – General Information

- **NPRM: Trademark Fee Adjustment**
- **81 FR 33619**
- **Published May 27, 2016**
- **Anticipated effective date: January 14, 2017**

# Fees – Per Class Increases

- Per class filing fees for ESTTA filings increase by \$100
- Per class filing fees for paper filings increase by \$200 and require a petition to the director
  - Petition fees also required
  - Showing of technical difficulties or extraordinary circumstances required
- All fees are due upon filing

# Fees – New, Per Application

- **New fees for extensions of time to oppose are per application, not per class**
  - No charge for initial 30-day extension
  - \$100 (ESTTA) or \$200 (paper) next 60 days
  - \$200 (ESTTA) or \$300 (paper) last 60 days
- **Option to request 90 days in an initial extension remains available**
  - Fee required – attributed to the latter 60 days of the 90-day period requested
- **All fees are due upon filing**

# TTAB Fee Adjustment

Fee Code	Rule	Description	Fee	Fee
6401	2.6(a)(16)(i)	Filing a Petition to Cancel on <b>Paper</b> , per Class*	\$500	
7401	2.6(a)(16)(ii)	Filing a Petition to Cancel through <b>ESTTA</b> , per Class		\$400
6402	2.6(a)(17)(i)	Filing a Notice of Opposition on <b>Paper</b> , per Class*	\$500	
7402	2.6(a)(17)(ii)	Filing a Notice of Opposition through <b>ESTTA</b> , per Class		\$400
6403	2.6(a)(18)(i)	Ex Parte Appeal to the Trademark Trial and Appeal Board Filed on <b>Paper</b> , per Class*	\$300	
7403	2.6(a)(18)(ii)	Ex Parte Appeal to the Trademark Trial and Appeal Board Filed through <b>ESTTA</b> , per Class		\$200
New	2.6(a)(22)(i)	Filing a Request for an Extension of Time to File a Notice of Opposition under § 2.102(c)(1)(ii) or (c)(2) on <b>Paper</b> , * <b>per application</b>	\$200	
New	2.6(a)(22)(ii)	Filing a Request for an Extension of Time to File a Notice of Opposition under § 2.102(c)(1)(ii) or (c)(2)) through <b>ESTTA</b> , <b>per application</b>		\$100
New	2.6(a)(23)(i)	Filing a Request for an Extension of Time to File a Notice of Opposition under § 2.102(c)(3) on <b>Paper</b> , * <b>per application</b>	\$300	
New	2.6(a)(23)(ii)	Filing a Request for an Extension of Time to File a Notice of Opposition under § 2.102(c)(3) through <b>ESTTA</b> , <b>per application</b>		\$200

\*Paper filings also require an additional fee for a petition to the Director.



**Questions?**

