

NYIPLA - TTAB Update

Mark Thurmon – Deputy Chief ATJ

July 18, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



FY 2019 TTAB staffing	FY 2018 EOY results	FY 2019 actual, target or projected	As of July 1, 2019	Variance
JUDGES and ATTORNEYS		(actuals)		
Administrative Trademark Judges	22	24	23	On target
Interlocutory Attorneys	17/1	14/2	14/2	

FY 2019 TTAB incoming filings	FY 2018 EOY results	FY 2019 actual, target or projected	As of July 1, 2019	Variance
TYPE OF FILING				
Notices of Appeal	3,223		2,484	+2.8%
Extensions of Time to Oppose	19,208		14,909	+3.5%
Notices of Opposition	6,496		5,011	+2.9%
Petitions to Cancel	2,253		1,773	+4.9%

Trends in new filings

Type of filing	FY16 (% +/- FY15)	FY17 (% +/- FY16)	FY18 (% +/- FY17)	By Quarters in FY19	Year to date as of July 1, 2019 (% +/- FY18)
Appeals	3,121 (+4.3%)	3,158 (+1.2%)	3,223 (+2%)	866; 747; 871	2,484 (+2.8%)
Extensions of time to oppose	19,055 (+11.2%)	18,490 (-3%)	19,208 (+3.9%)	4,672; 4,673; 5,564	14,909 (+3.5%)
Oppositions	5,881 (+11.2%)	6,156 (+4.7%)	6,496 (+5.5%)	1,599; 1,632; 1,780	5,011 (+2.9%)
Cancellations	1,848 (+4.8%)	2,101 (+13.7%)	2,253 (+7.2%)	565; 599; 609	1,773 (+4.9%)

FY 2019 TTAB performance measures	FY 2018 EOY results	FY 2019 actual, target or projected	As of July 1, 2019	Variance
PRODUCTION – DECISIONS				
Cases decided on merits	585		424	-3.4%
Precedential decisions issued	39	35-40	27	on target
Contested motions decided	1,318	(target)	896	-9.4%
Uncontested motions processed	32,807		27,426	+11.5%

FY 2019 TTAB performance measures	FY 2018 EOY Results	FY 2019 Actual, Target or Projected	As of July 1, 2019	Variance
<p>PENDENCY – Contested motions</p> <p>(1) Measured from ready-for decision until mailing; average of orders on contested motions, excluding precedents, issued during reporting period</p> <p>(2) Age of single oldest contested motion ready for decision at end of reporting period</p>	<p>9.4 weeks</p> <p>11.9 weeks</p>	<p>(targets)</p> <p>8-9 weeks (avg.)</p> <p>12 weeks or less</p>	<p>11 weeks</p> <p>23.3 weeks</p>	<p>above target</p> <p>above goal</p>
<p>INVENTORY – Contested motions ready for decision</p> <p>The number of cases with contested motions in which briefing was completed, becoming ready for decision, as of the end of the reporting period</p>	<p>165</p>	<p>Cases with motions 150-190 (target)</p>	<p>234</p>	<p>above target range</p>

FY 2019 TTAB performance measures	FY 2018 EOY results	FY 2019 actual, target or projected	As of July 1, 2019	Variance
<p>PENDENCY – Final decisions (cancellations, oppositions, ex parte appeals) Measured from ready for decision date until mailing for final decisions, excluding precedents, in appeals and trial cases during reporting period</p>	8.6 weeks	10-12 weeks (target)	12.9 weeks	above target range
<p>INVENTORY – Cases ready for final decision The number of pending appeals and trial cases in which briefing was completed, or in which briefing and arguments were completed, thus becoming ready for decision on the merits, as of the end of the reporting period</p>	Ex parte appeals 74 Oppositions 33 Cancellations 21 Concurrent Use 2 <u>Total:</u> 130	Total case inventory 130-170 (target)	Ex parte appeals 158 Oppositions 74 Cancellations 34 Concurrent Use 1 <u>Total:</u> 267	above target range

Trends – cases ready for decision

Final decisions on merits appeals and trial cases	FY16 (% +/- FY15)	FY17 (% +/- FY16)	FY18 (% +/- FY17)	By Quarters in FY19	Year to date as of July 1, 2019 (% +/- FY18)
Maturing to RFD (ready for decision) (appeals/trials)	687 (+11.3%) (529/158)	679 (-1.2 %) (517/162)	650 (-4.3%) (473/177)	191; 185; 201 (128/63); (126/59); (132/69)	577 (767) (+18.4%) (386/191)
Awaiting decision at end of period (appeals/trials)	83 (-25.9%) (56/27)	93 (+12%) (65/28)	130 (+39.8%) (74/56)	197; 213 (131/66); (129/84)	267 (+105.4%) (158/109)

FY 2019 TTAB performance measures	FY 2018 EOY results	FY 2019 actual, target or projected	As of July 1, 2019	Variance
<p>TOTAL PENDENCY Average total pendency, commencement to completion, excluding precedents</p> <p>Appeals (441 decided FY18; 286 to date in FY19)</p> <p>Trial cases (144 decided FY18; 138 in FY19)</p> <p>ACR trial cases (19 decided FY18; 19 decided in FY19 and 9 pending at end of June)</p>	<p>35.8 weeks</p> <p>140.3 weeks</p> <p>106.3 weeks</p>		<p>40 weeks</p> <p>148 weeks</p> <p>125.6 weeks</p>	<p>+11.7%</p> <p>+5.5%</p> <p>+18.2%</p>

Continuing interest in ACR

- Speed can be realized (though it is not a given)
- Imagine efficiencies ... and agree to them!
- Mutual informal exchanges of documents
- Limitations on discovery
- Broader use of Notices of Reliance
- Summary judgment-style trial
- Stipulations re: facts and authenticity of evidence
- Remember your burden(s) of proof

SPO comments

- Comment period extended to June 30, 2019
- Direct distribution to stakeholder IP groups
- Mixed results
- Overall – no clear call for change

Expanded call for input on SPO

- Six questions/subjects for comment
- Access by in house counsel to Attorneys' Eyes Only (trade secret or commercially sensitive) information/material?
 - 2 for, 2 against, 1 for middle path
- Three tiers or two, of confidentiality?
 - Keep 2 tiers – 4 votes
 - Go to 3 tiers – 1 vote

New cancellation proceeding?

- Request for Comments on “streamlined” process published 5/16/17 at 82 FR 22517
- Comments received from 13 individuals, firms, and stakeholder organizations
- Public meeting held September 25, 2017 to review comments and take further comments
- Links to request and comments in TTAB webpage Stakeholder Outreach section

Significant customer concerns

- Safeguarding due process, presumptions, and attaching to registrations
- Creating a fast, efficient proceeding, but still allowing for possible settlement talks
- Identifying “in-between” types of cases (e.g., no need if default judgment likely; unsuitable for cases in need of detailed fact-finding) – where’s the middle ground?

Pilot program – new name

- Expedited Cancellation program
- Instead of drafting NPRM on separate “streamlined” proceeding, TTAB has commenced a pilot program focusing on use of existing ACR tools in an “expedited” cancellation proceeding.
- See News and Notices section on TTAB webpage, with link to background, how it works, how to participate, program goals, and expected duration.

Pilot program – objectives

- Identify abandonment and non-use cancellation cases most suitable for some sort of “expedited” proceeding
- Discuss with parties application of ACR procedures that could be used most effectively in such proceedings
- Involve board attorney and judge participating in discovery conferences in cases that board identifies as suitable candidates

Pilot program – early results

- More than 135 cases found eligible to date
- Nearly 70 conferences held to date, and orders for conferences have been issued in multiple cases
- Parties in 12 cases agreed to use of some form of ACR; a number of others agreed to consider ACR as the case progressed, or to discuss the possible use of ACR with the assigned interlocutory attorney at a later conference.
- *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786 (TTAB 2018)

Pilot program – early findings

- Many uncontroversial cases result in default or early settlement.
- In many cases involving pleaded or asserted claims of ongoing use, petitioner wants to investigate or question the claimed use via discovery.
- Discovery is almost always desired in cases where the primary issue is excusable nonuse/intent to resume use.

Pilot program – early findings

- Cases involving no or limited discovery are better candidates for inclusion in pilot.
- Some parties are comfortable agreeing to cross-motions for summary judgment type of ACR, but are retaining the right to take some discovery.

Pilot program – future uses?

- Identify (1) possible changes to Trademark Rules to support a separate new expedited cancellation proceeding, (2) possible expansion of early intervention pilot into cases involving other issues, and (3) possible adaptation of current ACR procedures.

Thank you.
Questions? Comments?

