



THINK FORWARD

TTAB Rule Changes Effective January 14, 2017

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On January 14, 2017, the Trademark Trial and Appeal Board (“TTAB”) implemented numerous amendments to its Trademark Rules of Practice. These rule changes impact all active opposition and cancellation proceedings. The United States Patent and Trademark Office’s (“USPTO”) goal in effecting these amendments is to “benefit the public by providing for more efficiency and clarity in inter partes and ex parte proceedings.” We discuss several of these important rule changes below.

Electronic Filing

Most parties to opposition and cancellation proceedings already use the TTAB’s online filing system, the Electronic System for Trademark Trials and Appeals (“ESTTA”), for filing. The new rules stipulate that all submissions must be made through ESTTA, except in certain limited circumstances. Moreover, parties must serve all filings with the TTAB via email, and must electronically serve all other papers not required to be filed with the TTAB to the other party (e.g., discovery). The new rules will allow parties to stipulate as to another method of service if desired, particularly to accommodate other efficient ways to share information, such as an online file site. In light of these changes, the practice of adding an additional five days to response periods to account for mail delays has been eliminated.

Notably, the TTAB will now be responsible for serving the defendant the complaint, as opposed to the plaintiff, and will send the defendant an email with a link to the proceedings on the Trademark Trial and Appeal Board Inquiry System (also known as TTABVUE). The TTAB will send the email to the authorized email address listed in the contact information for the domestic representative or current owner of the application. Thus, it is important that all ownership and contact information for applications and registrations is up-to-date.

Opposition and Cancellation Proceeding Procedures

The new rules are designed to streamline discovery and pretrial procedures in opposition and cancellation proceedings, as well as reflect the new Federal Rules of Civil Procedure standard regarding the concept of proportionality in discovery. Requests for production of documents and requests for admissions in discovery are now limited to 75, the same as the current limitation on interrogatories. Moreover, discovery must be served early enough in the discovery period that all responses will be provided and all discovery completed by the close of the period. It is therefore important to have a discovery plan in place well before the discovery period begins so that the process can be completed quickly and effectively.

Additionally, parties now have the option of unilaterally deciding whether trial testimony is taken by affidavit or declaration, or by oral testimony. If a party opts for written testimony, such testimony will be subject to oral cross-examination by the adverse party.

Fee Increases

The USPTO also initiated a number of fee changes that will impact fees relating to the prosecution of applications and registrations at the PTO as well as TTAB proceedings. For example, the fees to electronically file a single-class trademark application have increased to \$400 (from \$325), while the fee to electronically file an extension of time to file a statement of use will decrease from \$150 to \$125. The fees for filing a petition to cancel or a notice of opposition have increased from \$300 to \$400 per class. Notably, there will now be a fee to file certain extensions of time to file a notice of opposition – there will be a \$100 fee to file a 60-day extension after a previous grant of a 30-day extension, and a \$200 fee to file an extension after a previous grant of a 90-day extension.

In summary, these rule changes should create more efficiency in TTAB proceedings and may impact brand owners' adversarial and filing strategies. Please note that the above summary does not include a complete list of all changes to TTAB procedures and USPTO fee changes.

Contact Us

If you have any questions or wish to discuss how these rule changes affect your trademark portfolio or enforcement plans, please contact a member of the [Brinks Trademarks and Unfair Competition Practice Group](#).