

Thursday, November 10, 2016

From the Source: A Discussion with the TTAB About Changes to Its Rules

Presenters:

Cheryl Butler, USPTO Trademark Trial and Appeal Board, *Senior Counsel & TBMP Editor*

Michael Webster, USPTO Trademark Trial and Appeal Board, *Interlocutory Attorney*

Moderators:

Uli Holubec, Senior Legal Editor, *Practical Law Intellectual Property & Technology*

Michael Chiappetta, Senior Legal Editor, *Practical Law Intellectual Property & Technology*

UNITED STATES
PATENT AND TRADEMARK OFFICE



The intelligence, technology and human expertise
you need to find trusted answers.



the answer company™

THOMSON REUTERS®

Topical Overview

- ESTTA Enhancements in place
- TTAB's Notice of Final Rulemaking
- Trademark Fee Adjustment

ESTTA Enhancement: Deployed April 2016

- Complaint: additional grounds listed
- Option to view attachment before submission
- Transmission of filing receipt to filer and adversary where email of record
- Save feature to allow users to circulate for pre-filing review
- Pre-filing checklist

TTAB'S AMENDED RULES OF PRACTICE

Notice of Final Rulemaking

- 81 FR 69950
- Published in Federal Register October 7, 2016
- Effective date: January 14, 2017

Already in Effect

- Changes in Federal Rules of Civil Procedure from December 2015
- Revised TTAB Standard Protective Order
- Automatically imposed in *inter partes* proceedings

Objectives of Amending the Rules

- Further USPTO Strategic Objective
 - Increase electronic filing
- Provide Efficiencies
 - Technological
 - Scheduling
- Promote Clarity
 - Conform to current practices
 - Use standard, current terminology
 - Update changed references

Significant Changes Since NPRM

- Proposed petition requirement for paper filings other than initial pleadings eliminated
- Proposed requirement that petitioner inform Board of any attorney reasonably believed to represent respondent eliminated
- Proposed requirement to notify adverse parties when foreign witness would be in U.S. jurisdiction eliminated
- Motions to file additional (75+) interrogatories, RFPs, and RFAs permitted (must show good cause)

Final Rule: Filing and Service

- File only through ESTTA
- Paper filings for initial pleadings, answers, and extensions of time to oppose
 - Require Petition to Director and fee
 - Require showing of technical problems or extraordinary circumstances
- All other paper filings
 - Do not require a petition
 - Require showing of technical problems or extraordinary circumstances

Final Rule: Paper Filing - Technical Problems

- ESTTA is unavailable
 - USPTO will check time and duration (USPTO System Status, ebiz)
- Problems at filer's end
 - Filer must describe the problem in detail

Final Rule: Paper Filing - Extraordinary Circumstances

- Relevant facts and accompanying evidence
 - Disasters
 - Fire
 - Hurricanes, snowstorms
 - Extended power outages
 - Medical emergencies
- Remember: no waiver or suspension of a requirement of the Trademark Act

Final Rule: Filing and Service

- No further need for plaintiff to serve complaint on defendant
 - No certificate of service required with the filing of the complaint
- Board will issue notice of institution and serve complaint with TTABVUE link/address

Final Rule: Electronic Service

- Serve answer and all other filings by email
 - Make sure your email and street addresses are up-to-date
- Parties may agree to alternative means
 - Parties expected to facilitate electronic communication with Board and each other
- Absent agreement, service by alternative means (e.g., First Class Mail, hand delivery) requires explanation for Board and adversary

Final Rule: Procedure

- Suspension
 - Board may suspend proceedings *sua sponte*
 - Board has discretion to condition approval of consented suspension on providing necessary information about status of settlement talks, discovery, or trial activities
 - Proceeding *is* suspended upon the filing of a potentially dispositive motion
 - Proceeding *is* suspended for certain 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
 - No longer an additional 5 days for mail service
 - All 15-day response and reply deadlines initiated by a service date are amended to 20 days
 - Summary judgment motions: response time remains 30 days; reply is amended to 20 days
 - Responses to written discovery: remain 30 days in accordance with Fed. R. Civ. P. 33, 34, & 36

Final Rule: Discovery

- Expressly adopts proportionality in process and procedure
- Initial disclosure and expert disclosure deadlines remain the same
- Must serve discovery early enough to allow for responses (including production or inspection) during discovery period

Final Rule: Discovery

- Limits on discovery requests
 - 75 Interrogatories, Requests for Admission, and Requests for Production
 - But may move for good cause to exceed limits
 - One comprehensive RFA to authenticate specific documents produced by adverse party
- Discoverable items include ESI as well as documents and tangible things

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
- Expert disclosure deadline must always be scheduled before discovery closes

Final Rule: Motions

- Motion to compel initial disclosures due 30 days after deadline for initial disclosures
- Discovery motions must be filed before deadline for plaintiff to make pretrial disclosures
- Motion to compel discovery must be filed prior to the deadline for the first pretrial disclosure
 - Once deadline passes, proceeding is considered in “trial”
 - Subsequent resetting of first pre-trial disclosure does not reset the time to file a motion to compel

Final Rule: Motions

- Filing potentially dispositive motion automatically suspends proceeding
- Motions for summary judgment must be filed before deadline for plaintiff to make pretrial disclosures
 - Once deadline passes, proceeding is considered in “trial”
 - Subsequent resetting of first pre-trial disclosure does not reset the time to file a motion for summary judgment
 - Parties may stipulate to an abbreviated trial
 - No surprises on the eve of trial

Final Rule: Trial

- Testimony by affidavit or declaration
 - Right to take cross-exam
- Deposition transcripts must be submitted one page per sheet and with a word index
 - TTAB judges and attorneys *do* read the submissions
- Standardized requirements for notice of reliance, including internet evidence

Final Rule: Trial

- Notice of Reliance
 - Internet materials
 - Current copy of information from USPTO databases
 - Pleaded registrations
 - Registrations owned by any party
 - Indicate generally the relevance and associate with one or more issues
- File of subject application or registration
 - Is of record
 - Statements in affidavits or declarations in file history record are not testimony

Final Rule: Trial

- Use of discovery deposition
 - Must file motion with pretrial disclosure
- Witness not included in pretrial disclosure
 - Move to quash notice of testimony deposition
 - Move to strike if testimony presented by affidavit or declaration

Final Rule: Trial Briefs

- Evidentiary objections may be made in a separate appendix that is not included in the page limit
- Briefs exceeding the page limit may not be considered by the Board

Ex Parte Appeals to the Board

- Record must be complete
 - New evidence cannot be submitted after filing notice of appeal except:
 - Timely request for reconsideration
 - Request for remand granted
 - No change to substance of rule
 - Addresses a recurring error
- Reply briefs: page limit is 10 pages

Final Rule: Judicial Review of TTAB Decisions

- Rules are reorganized to align with PTAB
 - Filing times = 63 days
- 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.

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: Effective date 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 TTAB home page: www.uspto.gov
 - Federal Register notice of final rule
 - Chart summarizing rule changes
 - New “Archives” section
 - Rule change FAQ’s (more coming soon)

TRADEMARK FEE ADJUSTMENT NOTICE OF FINAL RULEMAKING

TTAB Fee Increases and New Fees

New Fees for TTAB filings

- *Ex parte* appeal filing fee includes first increase in 25 years
- Opposition and cancellation filing fees first increases in 15 years
- New fees for certain extensions of time to oppose
- Effective date: January 14, 2017

Fees – General Information

- Final Rule: Trademark Fee Adjustment
- 81 FR 72694
- Published October 21, 2016
- Based on:
 - Proposed Rule: Trademark Fee Adjustment
 - 81 FR 33619
 - Published May 27, 2016

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 Paper, per Class*	\$500	
7401	2.6(a)(16)(ii)	Filing a Petition to Cancel through ESTTA, per Class		\$400
6402	2.6(a)(17)(i)	Filing a Notice of Opposition on Paper, per Class*	\$500	
7402	2.6(a)(17)(ii)	Filing a Notice of Opposition through ESTTA, per Class		\$400
6403	2.6(a)(18)(i)	Ex Parte Appeal to the Trademark Trial and Appeal Board Filed on Paper, per Class*	\$300	
7403	2.6(a)(18)(ii)	Ex Parte Appeal to the Trademark Trial and Appeal Board Filed through ESTTA, 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 Paper,* per application	\$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 ESTTA, per application		\$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 Paper,* per application	\$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 ESTTA, per application		\$200

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



Questions

Relevant Practical Law Resources

- TTAB Proceedings Toolkit
 - Twenty-three resources to help counsel in the pleading, discovery, and trial stages of opposition and cancellation proceedings before the Trademark Trial and Appeal Board (TTAB). Includes Standard Documents and Practice Notes on Pleadings, Discovery, Oral Depositions, and Trials.

CLE Credit

CLE credit is available for: Arizona, California, Colorado, Georgia, Hawaii, Illinois, Indiana, Mississippi, Missouri, New Hampshire, New Jersey, New York, North Carolina, Oklahoma, Pennsylvania, Vermont, Washington

CLE credit is being sought for: Louisiana, Minnesota, Oregon, Tennessee, Texas, Virginia

CLE credit can be self-applied for in: Florida

To obtain your certificate of attendance for your use in CLE credit compliance, please fill out and submit the online form:

https://wlec.formstack.com/forms/pl_216500

Once we receive your request, we will process it within an average of two (2) weeks. **Your certificate will be archived on www.westlegaledcenter.com and instructions will be e-mailed to you on how to download your certificate from this location for your own records.**

If your requested state(s) allow the sponsor to report your CLE attendance, we will do so and pay the associated fees within 30 days of your course.

If you have questions, please contact accreditation@westlegaledcenter.com.