

New TTAB Rules Aim to Make Proceedings More Efficient

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The Trademark Trial and Appeal Board (TTAB) Rules of Practice changed on January 14, 2017 and are effective for all proceedings filed or pending on or after that date. The new rules involve many changes, including changes to filing and service procedures, response deadlines, discovery, trial procedure, and fees. The changes are meant to accelerate proceedings before the TTAB and to clarify and delineate the various components of those proceedings.

Electronic Filing: Many attorneys already use the Electronic System for Trademark Trials and Appeals (ESTTA) for initiating proceedings before the TTAB and for most other filings during the proceedings, but the new rules now make use of ESTTA mandatory, with exceptions for technical problems or extraordinary circumstances (*e.g.*, disasters, power outages, and medical emergencies). For Madrid Protocol applications, however, ESTTA must be used without exception.

Service and Communication: Plaintiffs in a TTAB proceeding no longer have to serve a copy of the complaint on the defendant. That responsibility is now shifted to the TTAB, which will serve the complaint via an HTML link sent to the defendant's email address listed in the Trademark Trial and Appeal Board Inquiry System (TTABVUE), although the petitioner in a cancellation proceeding must provide the TTAB with the current email of the respondent registration owner, to the best of the petitioner's knowledge. After a proceeding is commenced, all documents and filings (*e.g.*, motions and discovery requests) are to be served on a party by email, unless the parties stipulate to another method. If for some reason they cannot be served by email, documents may be served using another method, but must be accompanied by a written explanation as to why service by email was not possible. Because service by email is now required, the additional five days added to the response period for documents served by mail is eliminated.

Discovery: The new rules limit the number of requests for each of production of documents, requests for admission, and interrogatories to 75, which can be exceeded with a showing of good cause. Further, discovery must be served early enough for the opposing party to respond before the close of discovery (time for response remains 30 days); thus, parties can no longer serve discovery requests right up to the

close of discovery. The new rules also make it clear that the TTAB's standard protective order will automatically be entered.

Motions: Under the new rules, the response period for motions is now 20 days. The response deadline for summary judgment remains 30 days, but the time for summary judgment replies is changed to 20 days. Motions to compel initial disclosures are due 30 days after the deadline for initial disclosures, and motions to compel discovery or for summary judgment must be filed prior to the deadline for the plaintiff's pretrial disclosures. Further, the filing of a potentially dispositive motion automatically suspends the proceeding.

Trial: Witness testimony may now be submitted by affidavit instead of live deposition. In-person depositions are only necessary if the opposing party is to cross-examine the witness. Thus, a party is now able to present more evidence at trial with less of a burden. If a party does take a deposition and wants to submit the deposition transcript as evidence, it can no longer be condensed to multiple pages per sheet. Parties may also submit internet materials as evidence under a notice of reliance. The new rules state that briefs exceeding page limits may not be considered by the TTAB, but that evidentiary objections can be provided in a separate appendix, which does not count against the page limit.

Fees: Filing fees are being increased for both *ex parte* appeals and opposition and cancellation proceedings (\$200 per class for *ex parte* appeals and \$400 per class for oppositions and cancellations). There are also new fees imposed for filing extensions of time to oppose a trademark application. An initial 30-day extension is free of charge, but the next 60 days costs \$100, and a final 60 days costs \$200.

The new rules are meant to increase the use of electronic filing, enhance efficiency, and clarify the overall process in appeal, opposition, and cancellation proceedings. Because many attorneys already use electronic filing for initiation of proceedings and filing documents, and presumably more and more are converting to electronic filing, changes in these aspects of the rules may not have a significant impact on overall efficiency. Other changes, including service by email being the default and the TTAB's standard protective order being automatically applied, are likely to make a proceeding at least marginally more efficient as they remove issues that the parties must usually negotiate at the outset of a proceeding. Additionally, because deadlines for discovery and dispositive motions are moved earlier, parties may be

more motivated to have meaningful settlement discussions earlier in a case. If, however, settlement is not a priority for at least one of the parties, costs may be greater sooner.

The new rules are a positive advance for TTAB proceedings in that they provide greater clarity for the proceedings and help harmonize the rules with existing practice, case law, and the Federal Rules.