

# A Quick Look at the New Trademark Trial and Appeal Board Rules

## Intellectual Property Alert

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The Trademark Trial and Appeal Board (TTAB) will implement new rules on January 14, 2017, that will apply to all *inter partes* proceedings (oppositions, cancellations, concurrent use) and *ex parte* appeals that are pending on, or filed after, January 14, 2017. Among the many changes, a few are notable:

### 1. Discovery and Pretrial Procedures

The number of Requests for Production of Documents and Requests for Admissions will be capped at 75 each. The number of Interrogatories will remain at 75. The new rules will be more consistent with the Federal Rules of Civil Procedure (FRCP) and reflect the idea of “proportionality” in discovery.

One of the most significant changes in the discovery rules is that parties must serve discovery requests early enough so that responses can be provided, and all discovery will be completed, by the close of discovery. This rule is designed to provide efficiency in discovery and remove uncertainty about the completion of discovery, as the parties can no longer wait until the last day of the discovery period to serve discovery requests.

### 2. Testimony

Submission of witness testimony will become significantly easier under the new rules. Prior to the rule changes, the parties were allowed to offer testimony only through live depositions unless otherwise agreed by the parties. Under the new rules, the parties can unilaterally submit witness testimony by affidavit. If, however, the opposing party wishes to cross-examine the affiant, an in-person deposition will be required.

While this change may make offering witness testimony less costly and more convenient for the parties, thereby also making the trial procedure more efficient, this change does not make the TTAB procedure more consistent with the FRCP and is somewhat surprising in the wake of the Supreme Court’s 2015 ruling in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293 (2015), which held that a result in a TTAB proceeding can be binding in federal court: “[s]o long as the other ordinary elements of issue preclusion are met, when the usages adjudicated by the Trademark Trial and Appeal Board are materially the same as those before a district court, issue preclusion should apply.”

### 3. Service and Electronic filing

Under the new rules, all filings with the TTAB must be submitted electronically through its Electronic System for Trademark Trials and Appeals (ESTTA), unless excused via Petition to Director of

the USPTO. Although electronic filing is currently widely used, the new rules will make it mandatory and uniform. In addition, all TTAB filings and other papers must be served between parties by email (service by mail will no longer be allowed). Because extra time for responses served by mail is no longer necessary, the Board is removing the five additional days for responses served by mail.

Further, the new rules will shift the responsibility of serving a notice of opposition or petition for cancellation from the plaintiff to the Board. The Board will serve the complaint via a link to the Board's electronic case filing system, Trademark Trial and Appeal Board Inquiry System (TTABVUE). This will result in cost savings on serving complaints and other papers, and will increase efficiency. If there are any technical difficulties or extraordinary circumstances, the parties may agree to alternate methods of communication or exchange of documents.

### **Conclusion**

The new rules will likely streamline many aspects of the Board proceedings. However, because the deadlines for discovery are set earlier in the proceedings, discovery-related costs may be front-loaded and may be incurred before the parties can settle or resolve issues through motion practice.