



## USPTO Proposes Amendments to Streamline TTAB Procedure

On Monday, April 4, 2016, the United States Patent and Trademark Office (“USPTO”) issued proposed amendments to the Trademark Rules of Practice aimed at streamlining proceedings before the Trademark Trial and Appeal Board (“TTAB”) that include significant changes to discovery protocol, electronic filing requirements, and the presentation of trial evidence.

The proposed amendments are intended to reduce the burden on parties litigating before the TTAB, increase efficiency, conform the rules to current practice and changes to the Federal Rules of Civil Procedure, and adapt to technological changes that have influenced litigation practice. Key changes include mandated electronic filing, the ability to submit trial testimony by declaration or affidavit (subject to cross examination), and new limitations and timeframes for discovery intended to promote efficient and fair resolution of disputes before the Board.

The proposed amendments are summarized below.

### E-Filing

**Mandatory Electronic Filing.** All filings must be made through the ESTTA, the Board’s electronic case filing system. Paper filings will be permitted in rare

circumstances where filing through ESTTA is not possible, and parties will be required to submit proof that electronic filing was not possible due to technical problems or extraordinary circumstances.

**Email Notice.** The Board will send all notices, orders, and decisions via email, making it all the more important that applicants and their attorneys maintain updated correspondence information.

### Service

**Board Service of Notices of Opposition and Petitions for Cancellation.** Rather than require each plaintiff to serve the complaint on the defendant, the Board will have responsibility for serving a Notice of Opposition or Petition for Cancellation on defendants. In keeping with the shift toward complete use of electronic communication, the Board will serve the complaint by linking to the notice of institution in TTABVUE, the online docket for TTAB proceedings.

**Required Email Service.** The proposed rules require that all submissions filed with the Board and any other papers be served by email, unless service cannot be made due to technical problems or extraordinary circumstances.

**Expanded Electronic Service Options.** In addition to electronic service, which became permitted under the 2007 rules, the Board will permit parties to stipulate to accommodate other methods of communication that may promote convenience and expediency, such as by use of a “file hosting service that provides cloud storage” or delivery of a USB drive, etc.

**End of the Mailbox Rule.** In light of the transition to electronic service, the additional five days previously added to the prescribed period for a response—intended to account for mail delay—will no longer be in effect. Thus, the response period for a motion would be 20 days, with the exception of summary judgment motions, which would have a response period of 30 days from service. No additional time will be permitted for service of discovery responses.

## Discovery

**Adoption of FRCP Proportionality Requirements.** The proposed rules adopt amendments to the Federal Rules of Civil Procedure by codifying the concept of “proportionality” in discovery.

**Ability to Stipulate to Discovery Limitations.** Parties may stipulate to limit discovery by shortening the discovery period, limiting requests, and reciprocal disclosures in lieu of discovery, or “eliminating discovery altogether.”

**Recognition of ESI.** Electronically discoverable information (“ESI”) will be explicitly referenced in the rules, in recognition of the fact that many relevant documents are now kept in electronic form and to clarify that the discovery rules apply equally to ESI.

**Limitations on Discovery Requests.** The number of requests for production of documents and requests for admission will be limited to 75 each, the same as the current limitation on interrogatories. There will no longer be an option to request leave to serve additional interrogatories.

**Streamlined Authentication Requests.** In an effort to curtail discovery abuse, the proposed rules allow for each party that has received produced documents to serve one

*comprehensive request* for admission on the producing party, whereby the producing party would authenticate all produced documents or specify which documents cannot be authenticated.

**Fair Play for Foreign Parties.** A party must inform every adverse party whenever a foreign party has or will have an officer, director, managing agent, or other person who consents to testify on its behalf present in the United States during the relevant discovery period.

**Time to Serve Discovery Requests.** Discovery must be served early enough in the discovery period that responses will be provided. All discovery, including production of documents, must be completed by the close of discovery.

**Timing of Motions to Compel.** Previously, the deadline for motions to compel was simply before the first trial period commenced. The amendments will require motions to compel discovery or to determine the sufficiency of responses to requests for admission to be filed prior to the deadline for the plaintiff’s pretrial disclosures for the first testimony period.

## Confidentiality

**Automatic Imposition of Standard Protective Order.** The proposed amendments clarify that the Board’s Standard Protective Order is *automatically* imposed in all *inter partes* proceedings. A copy of the standard protective order is available on the [USPTO website](#).

**Board Discretion Concerning Treatment of Confidential Information.** The Board may treat as not confidential material that “cannot reasonably be considered confidential,” notwithstanding a party’s designation.

## Suspension

**Discretion to Suspend Proceedings.** The Board may suspend proceedings *sua sponte* and has discretion to condition approval of consented or stipulated motions to suspend on the provision by parties of necessary information about the status of settlement talks or discovery or trial activities.

## Dispositive Motions

**Timing for Summary Judgment Motions.** Motions for summary judgment must be filed prior to the deadline for plaintiff's pretrial disclosures for the first testimony period.

## Trial Procedures

**Notices of Reliance.** The proposed rules codify existing law that pleaded registrations and registrations owned by any party may be made of record via a notice of reliance. Internet materials may also be submitted under a notice of reliance under the proposed rules. Notices of reliance must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure of a notice of reliance to meet this requirement would be considered a curable procedural defect.

**Use of Depositions.** Any motion to use a discovery deposition at trial must be filed with the party's pretrial disclosures. All depositions must also include a word index and must be submitted in full-size, not condensed, format.

**Evidence Not Disclosed in Pretrial Disclosures.** An adverse party would be permitted to move to quash a notice of deposition testimony if it was not included in the pretrial disclosure or move to strike testimony presented by affidavit or declaration that was not included in the pretrial disclosure.

**Evidentiary Objections and Page Limits.** The rules clarify that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief and that briefs exceeding the page limit may not be considered by the Board.

**Use of Testimony by Declaration or Affidavit.** Parties may submit witness testimony by affidavit or declaration, subject

to the right of any adverse party to take and bear the expense of oral cross-examination of that witness. The offering party must make witnesses testifying by declaration or affidavit available to their adversary.

**Motion for Oral Examination of Deponent.** A party may file a motion for oral examination of a witness who has been noticed for deposition by written questions.

**Involuntary Dismissal for Failure to Take Testimony.** If a plaintiff has not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant *sua sponte*, even where the plaintiff has responded to the Board's show cause order for failure to file a brief but has either not moved to reopen its trial period or not been successful in any such motion.

## Other Changes

**Teleconferencing.** Parties, examining attorneys, and members of the Board may attend hearings remotely through video conference.

**New Matter Suggested by the Trademark Examining Attorney.** If, during an inter partes proceeding involving an application, the examining attorney believes certain facts render the mark unregistrable, the examining attorney should formally request remand of the application rather than simply notifying the Board.

The rules, if approved, would apply to every currently pending and new case commenced after the effective date of the final rulemaking.

Comments to the proposed amendments will be accepted until June 3, 2016, and may be submitted via electronic mail to [TTABFRNotices@uspto.gov](mailto:TTABFRNotices@uspto.gov). The full Notice is available [here](#).

## Lawyer Contacts

if you have any questions about the proposed amendments or would like our assistance in submitting comments to the Patent and Trademark Office, please contact your principal Firm representative or one of the lawyers listed below. General email messages may be sent using our "Contact Us" form, which can be found at [www.jonesday.com/contactus/](http://www.jonesday.com/contactus/).

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