What You Need to Know: Major Changes to the TTAB Rules of Practice

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On January 14, 2017, revised rules of procedure went into effect for all opposition and cancellation proceedings—both newly filed proceedings and those already pending before the Trademark Trial and Appeal Board (TTAB). Many of the revisions to the TTAB Rules of Practice, 37 C.F.R. §§ 2.91 et seq., add clarity by codifying case law and the TTAB’s practices. Other revisions, however, make significant changes to TTAB practice, some of which require that we rethink the approaches we have used in these proceedings. There are numerous revisions, including an expanded requirement of electronic filing, a requirement of service by e-mail, new limits on written discovery requests, earlier deadlines for the filing of many motions, and the presentation of trial testimony by declaration. Some of the most far-reaching changes are highlighted here—and all can be found in the Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice in the Federal Register.

Requirement of Electronic Filing
Most of us have been accustomed to relying on the TTAB’s online filing system, Electronic System for Trademark Trials and Appeals (ESTTA), exclusively or almost exclusively. But for most submissions, we also had the option of making a paper filing if we chose to do so. Under the revised rules, the option of paper filing is now virtually eliminated.

As before, filing through ESTTA is required, without exception, for a notice of opposition to a section 66 application or an extension of time to oppose a section 66 application.

With very narrow exceptions, electronic filing now is also mandatory for all other submissions. Filing of a pleading, request for extension of time to oppose, motion, brief, or other written document by paper rather than through ESTTA is permitted only if ESTTA is unavailable due to technical difficulties or when “extraordinary circumstances are present.” Any paper filing of an extension of time to oppose, notice of opposition, petition to cancel, or answer must be accompanied by a petition to the director of the U.S. Patent and Trademark Office (USPTO) establishing circumstances justifying a paper filing, and the required fees. Paper filings of any other submission must include a written explanation of the technical problems or extraordinary circumstances. Whether in a petition or written explanation, parties should be prepared to identify the underlying facts that led to an inability to file through ESTTA or the extraordinary circumstances, rather than making a conclusory statement of such problems or circumstances.
A separate exception exists for exhibits, such as CDs or DVDs, which cannot be submitted through ESTTA. The comments to the rules changes note that those materials may continue to be filed by mail.8

**Changes to Service Requirements**

Under the new rules, practitioners no longer need to serve a copy of a notice of opposition or petition to cancel. The TTAB will serve the applicant or registrant when it issues the order instituting the proceeding.9

For service of all other papers during the course of the opposition or cancellation, e-mail is the new norm. Under the revised rules, service must be made by e-mail unless the parties stipulate otherwise.10 Absent agreement, service other than by e-mail is permissible only if the serving party can show by written submission accompanying the paper or a subsequent, amended certificate of service that e-mail service was attempted but could not be made due to technical problems or exceptional circumstances.11

The comments accompanying the revised rules recognize that there may be instances where the materials being served are of a size that makes e-mail service impractical, such as in cases involving voluminous document production. The TTAB notes that parties have the right to agree to an alternative to e-mail and suggests that parties might want to address this in the initial discovery conference and agree to the use of a file hosting service or USB drives.12

**Changes to Deadlines for Motions**

A key change to the rules is new, earlier deadlines for the filing of a number of motions.

Previously, motions to compel initial disclosures or expert disclosures could be filed any time prior to discovery. The time to compel expert disclosures is unchanged, but motions to compel initial disclosures now must be filed within 30 days of when the initial disclosures were due.13

Other discovery motions, such as motions to compel discovery or to test the sufficiency of responses to requests to admit, must be filed prior to the first pretrial disclosure deadline, rather than prior to the opening of the first testimony period.14 Motions for summary judgment likewise must be filed prior to the first pretrial disclosure deadline.15

A motion to use a discovery deposition at trial, other than that of the adverse party, now is due with a party’s pretrial disclosures rather than during its testimony period.16

**Changes to Deadlines for Responses**

Given the requirement of e-mail service, the TTAB has eliminated the provision, formerly found at 37 C.F.R. § 2.119(c), adding five days when calculating the due date for responses to papers served by mail or overnight courier.17 Due dates for responses to motions, replies, and responses to written discovery depend solely on the date of service.
For motions other than summary judgment motions, the deadline for filing a response is now 20 days from the date of service rather than 15 days. Reply briefs are due 20 days after service of the response to a motion. The deadline to respond to a motion for summary judgment remains 30 days, as does the deadline for responding to written discovery requests.

**Changes to Written Discovery**

All discovery is to be complete by the close of discovery. It no longer is possible to serve written discovery at the very end of the discovery period. Interrogatories, requests for production of documents, and requests for admission must be served early enough for the responses to be due prior to the close of discovery. In the comments, the TTAB indicates that this “includes production of documents, which have to be produced or inspected by the close of discovery.” The time to respond to written discovery requests can be extended, but the new due date must fall within the discovery period. An agreement to extend the due dates for discovery responses consequently may necessitate a motion to extend the close of discovery.

Previously, a party was limited to serving 75 interrogatories, including subparts, but could serve any number of document requests or requests for admission. The rules for document requests and requests for admission now largely mirror those for interrogatories.

Requests for production of documents are limited to 75, including subparts. Because document requests frequently are compound, practitioners will need to reevaluate the form of document requests they commonly serve in order to ensure that the requests do not run afoul of the new rule. As has been true with interrogatories, the TTAB may allow additional requests for production upon motion by a party for good cause shown or a stipulation of the parties approved by the TTAB. Any motion for leave must be filed prior to service of the requests that exceed the limit and must include copies of any previously served requests and the requests for which leave is sought. If a party upon whom requests for production have been served believes the requests exceed 75 in number, the party may serve a general objection on that basis, instead of responding to the specific requests.

Requests for admission also are limited to 75, including subparts. The new procedures for obtaining leave to serve more requests and for objecting to requests that exceed 75 in number track those discussed above for requests for production. There is one important difference that comes into play with requests for admission: the rules provide that independent of the limit on the number of requests for admission, a party may make one comprehensive request of an adverse party that has produced documents for an admission authenticating specific documents or specifying which of those documents cannot be authenticated.

**Introduction of Trial Testimony**

Parties now may introduce witness testimony at trial by affidavit or declaration in conformance with the Federal Rules of Evidence, subject to the right of an adverse party to take cross-examination.
A party must serve notice of its election to take a cross-examination deposition within 20 days of the date of service of the affidavit or declaration and bears the expense of the court reporter. The deposition must be completed within 30 days of the notice of election. Any redirect and re-cross shall be taken at the same time. For witnesses outside the United States, the cross-examination deposition will be by written question.

All witnesses presenting trial testimony, whether by deposition or by affidavit or declaration, must be identified in the pretrial disclosures by name. The option of identifying a deposition witness by description rather than by name has been deleted.

Parties continue to have the ability to introduce a variety of evidence by notices of reliance: registrations, printed publications, Internet materials, and discovery responses of the other party in the form of written disclosures, interrogatory answers, responses to request to admit or discovery deposition testimony. A party now also may introduce documents produced by the other side outside the foregoing categories if the party obtains an admission or stipulation of authenticity. For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. If a party fails to identify the relevance with sufficient specificity, it is a procedural defect for which the TTAB will set a cure period.

Conclusion
We can anticipate the development of case law later this year as issues arise regarding the application of the new rules.

Endnotes
3. Id. §§ 2.101(b)(1), .102(a)(1), .106(b)(1), .111(c)(1), .114(b)(1), .126(a), .127, .128(b).
4. Id. §§ 2.101(b)(2), .102(a)(1), .106(b)(1), .111(c)(2), .114(b)(1), .126(b), .127, .128(b).
5. Id. §§ 2.101(b)(2), .101(d), .102(a)(2), .106(b)(1), .111(c)(2), .111(d), .114(b)(1).
6. Id. §§ 2.126(b), .127, .128(b).
7. 81 Fed. Reg. at 69,966
8. Id.
9. 37 C.F.R. §§ 2.105(a), .113(a).
10. Id. § 2.119(b).
11. Id.
13. 37 C.F.R. § 2.120(f)(1).
14. Id. §§ 2.120(f)(1), (i)(1).
15. Id. § 2.127(e)(1).
16. Id. § 2.120(k)(2).
17. 81 Fed. Reg. at 69950-51, 69960.
18. Id. § 2.127(a).
19. Id. §§ 2.127(a), (e)(1).
20. Id. §§ 2.120(a)(3), .127(e)(1).
21. Id. § 2.120(a)(3).
23. 37 C.F.R. § 2.120(a)(3).
24. Id. § 2.120(e).
25. Id.
26. Id.
27. Id.
28. Id. § 2.120(i).
29. Id.
30. Id.
31. Id. § 2.123(a)(1).
32. Id. § 2.123(c); 81 Fed. Reg. at 69,964.
33. 37 C.F.R. § 2.123(c).
34. 81 Fed. Reg. at 69964.
35. Id. § 2.123(a)(1).
36. Id. § 2.121(e).
37. Id. § 2.120(k)(3)(ii).
38. Id. § 2.122(g).
39. Id.