

Trademark Trial and Appeal Board (TTAB) update

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UNITED STATES
PATENT AND TRADEMARK OFFICE



New case filings – cumulative increases FY17-FY19

- Ex parte appeals Up 6.8%
- Extensions to oppose Up 7.6%
- Oppositions Up 18.3%
- Petitions to cancel Up 31.3%

Attorney achievements in FY20

- Increased motion decisions issued by 7%
- Increased motions resolved by 8.6%
- Pendency above FY19 but stabilized
- Reduced inventory of pending motions by 12% (242 to 213) with none over 12 weeks old at end of fiscal year

ATJ achievements FY20

- Second consecutive annual increase in cases decided (+11.3% in FY19 and +12% in FY20)
- Second consecutive year deciding 200 or more trial cases
- FY20 average pendency appeals—11.7 weeks (By quarters: 15.6 - 16.1 - 9.3 - 9)
- FY20 average pendency trial cases—17.7 weeks (By quarters: 22.8 - 19 - 13.8 - 14.6)

Moderating filings in FY20/FY21

- Ex parte appeals (3,487) +4.6%
- Extensions to oppose (18,893) -7.8%
- Oppositions (6,712) -3.5%
- Petitions to cancel (2,501) +3.1%
- Similar patterns in Q1 FY21

Pendency goals met Q1/FY21

- Motion decision pendency at 9.8 weeks
- Appeal decision pendency at 8.2 weeks
- Trial decision pendency at 11.2 weeks
- Inventory of motions, cases RFD stable

Fee increases as of January 2

- Petition to cancel, notice of opposition increased by \$200 per class
- Appeal increased by \$25 per class
- Extension of time to oppose increased by \$100 per application for initial 90-day extension or second extension for 60 days; increased \$200 per application for final 60-day extension (still no fee for initial 30-day extension)

New TTAB fees as of January 2

- Second or any subsequent extension to file appeal brief—\$100 per application
- Appeal brief—\$200 per class
- Request for oral hearing—\$500 per proceeding

TTAB IT tips

TTAB IT issues–new counsel

- New counsel “appears” by filing answer, or a consent motion, or revocation/power of attorney as a “general filing.” **Use ESTTA correspondence update form as well.**
- Attorneys need to update correspondence and bar information with TTAB for application/registration in Board proceeding. **Don’t rely on “roll over” from a TEAS filing.**
- Check ESTTA box noting client is represented, to be taken to screen for updating correspondence and bar information. (Only non-U.S. domiciled parties forced to that screen.)

TTAB IT issues–addresses/email

- Problem: Most returned Board email comes from address(es) not in any TTAB records.
- Fix: **Avoid auto-forwarding to unlisted email addresses. Instead, list the address as a secondary (CC) email using ESTTA change of address form.**
- Problem: ESTTA filing receipts and other notifications often returned as SPAM.
- Fix: ESTTA email comes from estta@uspto.gov (for party primary email) or esttanoreply@uspto.gov (for secondary (CC) email)–set SPAM filters accordingly.



TTAB IT–use the Reading Room

- TTAB Reading Room replaced e-FOIA webpage on August 1.
- Search final decisions and precedential decisions/orders.
- Search by date, issue involved, other criteria, or by text.
- URL: <https://e-foia.uspto.gov/Foia/TTABReadingRoom.jsp>
- Provide feedback via TTABFeedback@uspto.gov (suggestions will be considered for future releases).

Expedited cancellation pilot

Expedited cancellation pilot

- 205 cases identified from March 2018 to March 2020
- Board involved in 114 discovery conferences; 134 cases terminated without need of decision; 28 others in suspension for settlement at end of pilot
- 21 cases proceeded by ACR, 15 of these via MSJ model
- Abandonment most common claim in all cancellations (34%)
- Default rate in cancellations is 44%; but 49% with claim of nonuse or abandonment; and 60% when abandonment the only claim

Trademark Modernization Act (TMA)

TMA 2020: appeals

- Decisions by the Director on whether to institute an expungement or re-examination proceeding are final and not reviewable
- Decisions in ex parte expungement or ex parte re-examination proceedings will be appealable to the TTAB
- TTAB decisions on such appeals may be appealed to the Federal Circuit, but not to district courts