Trademark Trial and Appeal Board (TTAB) update

Gerard Rogers
TTAB Chief Judge
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
- Prove 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.