

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%

Moderating filings in FY20

- 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%

Year to date declines in FY21

- Ex parte appeals (1,797) +3%
- Extensions to oppose (8,219) -13%
- Oppositions (3,152) -6%
- Petitions to cancel (1,216) -2.8%

Surge in trial cases impacted motions

- Motions requiring resolution a rollercoaster
- Inventory rose almost 50% in FY19 alone
- Average pendency above goal FY18-FY20
- But inventory reduced by 12% in FY20, with none over 12 weeks old at end of fiscal year
- Another 15% reduction YTD in FY21 and pendency goal met in both Q1 and Q2

Surge in cases maturing to RFD

- Appeals and trials becoming RFD declined slightly in FY17 (-1.2%) and in FY18 (-4.3%)
- Trial cases as percentage of all cases RFD increased in FY18 (27.2%) and FY19 (30.9%)
- Total cases RFD in FY19 +14.5% over FY18
- FY20 stabilized: total cases RFD -8.5% and trial cases as percentage at 23.2%

Pendency goals met YTD in FY21

- Motion decision pendency at 10.1 weeks
- Appeal decision pendency at 7.7 weeks
- Trial decision pendency at 10 weeks
- Inventory of motions, cases RFD stable
- Aware of possible increases from TM surge

TTAB fee changes

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

COVID-19 Prioritized Review

Priority handling of applications

- For applications involved in COVID-19 prioritized examination in Trademarks
- Expedited review of any ex parte appeals
- Interlocutory attorney participation in discovery conference for oppositions
- Board monitoring these applications, but parties may call to ensure priority review

TTAB IT tips

TTAB IT issues–addresses/email

- Problem: ESTTA filing receipts and other notifications returned to TTAB as SPAM.
- Fix: Set SPAM filters to accept mail from estta@uspto.gov (for party primary email) or esttanoreply@uspto.gov (for secondary (CC) email).



TTAB IT issues–new counsel

- For new counsel appearance, do not rely only on a “general filing.” **Use ESTTA correspondence update form as well.**
- 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.)
- 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.**

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).

Pretrial Conference pilot

Pretrial conference pilot

- Survey taken of TTAB attorneys and judges on goals, processes
- Internal review of survey responses underway
- If deployed, would focus on cases with indications they are likely to create large or unwieldy records
- Would focus parties' approach to trial and consideration of stipulations

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 at TTAB
- Expungement or re-examination decisions will be appealable by registrant to the TTAB
- TTAB decisions on such appeals may be appealed to the Federal Circuit, but not to district courts