

Miscellaneous Changes to Trademark Trial and Appeal Board Rules 81 Fed. Reg. 69950 (October 7, 2016), Summary by Rule Number

| Rule(s) | Subject(s) |
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| All | Effective January 14, 2017 for all cases (including cases pending prior to 1/14/17) |
| Global | <p>ADDS: reserved rules §§ 2.94, 2.95, 2.97, 2.102(e), 2.103(e), 2.143</p> <p>UPDATES: as necessary renumbering, cross references to the Trademark Rules of Practice and the Federal Rules of Civil Procedure.</p> <p>AMENDS: “paper” to “submissions”; “examiner” to “examining attorney”; “notification” to “notice of institution” or “notice”; “e-mail” to “email”; “Patent and Trademark Office” to “United States Patent and Trademark Office”; “his” to “his or her” or “its”; “him” to “the witness”</p> <p>DELETES: as necessary the word “written”</p> <p>AMENDS: response and reply briefing deadlines for motions from 15 to 20 days</p> <p>AMENDS: “Assignment Services Division” to “Assignment Recordation Branch”</p> |
| Concurrent Proceedings | Use |
| 2.99(d)(1), (2) and (3) | <p>ADDS: In (d)(1) the rule now provides that the Board’s notice of institution will include a web link or web address to the concurrent use application proceeding in the Board’s database of electronic case files (TTABVUE). DELETES: In (d)(1) the requirement for a concurrent use applicant (plaintiff) to serve the concurrent use application on the</p> |

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| | applicant, registrant or user specified as a concurrent user (defendant). AMENDS: The wording in (d)(2) and (3) is amended to add clarity. |
| Opposition | |
| 2.101(a) and (b) | DELETES: The requirement for a plaintiff to serve the complaint and provide proof of service thereof. |
| 2.101(b)(1), (2) and (3) | ADDS: All notices of opposition must be filed through ESTTA. Paper filing of the notice of opposition against Section 1 or 44 applications only allowed when ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. Paper filings must be accompanied by a Petition to the Director under § 2.146 with fees therefor. Oppositions against Section 66(a) applications MUST be filed through ESTTA - no exceptions. |
| 2.101(c) | AMENDS: (d)(1) is redesignated as last sentence in (c). |
| 2.101(d) | AMENDS: (d)(2) is redesignated as (d). CLARIFIES: Oppositions filed in ESTTA cannot be filed without proper fee. ADDS: Paper opposition not accompanied by required fee sufficient to pay in full for each named party opposer for each class opposed may not be instituted. DELETES: Hierarchy of instituting opposition with insufficient fees. |
| 2.101(e) | AMENDS: (d)(4) is redesignated as (e). ADDS: Filing date is date of electronic receipt of the notice of opposition. DELETES: Requirement for proof of service to receive filing date. ADDS: Paper filing date determined in accordance with §§ 2.195-2.198. |
| 2.102(a)(1) and (2) | ADDS: Request for extension of time to file notice of opposition must be filed through ESTTA. Paper filing of a request to extend time to oppose Section 1 or 44 applications only allowed when ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. Paper filings must be accompanied by a Petition to the Director under § 2.146 with fees therefor. AMENDS: Moves sentence that provides that requests to extend opposition period against Section 66(a) applications MUST be filed through ESTTA, no exceptions, from § 2.102(a)(2) to § 2.102(a)(1). |
| 2.102(b) | AMENDS: The word “should” is replaced with “must.” |

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| 2.102(c)(1), (2) and (3) | ADDS: A sixty-day extension is not available as a first extension of time to oppose. After extensions totaling 90 days, and only one final request for a 60-day extension of the opposition period based upon written consent, stipulation or a showing of extraordinary circumstances, no other time period will be allowed. |
| 2.102(d) | ADDS: New subsection providing filing date is date of electronic receipt of the extension request or for paper filing determined in accordance with §§ 2.195-2.198. |
| 2.104(a) | ADDS: Clarifies that ESTTA requires selection of relevant grounds, and the required accompanying statement (complaint) supports and explains the grounds. |
| 2.104(c) | ADDS: New subsection provides that oppositions to Section 66(a) applications are limited to the goods, services and grounds set forth on ESTTA cover sheet. |
| 2.105(a) | DELETES: Requirement that plaintiff provide proof of service of the complaint on defendant. ADDS: The notice of institution sent by the Board will include a web link or web address to access the electronic proceeding record in the Board's database of electronic case files (TTABVUE), and that notice constitutes service of the notice of opposition on the applicant. |
| 2.105(b)(1), (2) and (3); 2.105(c)(1), (2) and (3) | ADDS: Notice will be sent to the email or correspondence address of record for opposers and applicants. |
| 2.106(a) | ADDS: Default may occur after the time to answer is reset, and the failure to file a timely answer tolls all deadlines, including the discovery conference. |
| 2.106(b)(1), (2) and (3) | ADDS: New subsection (1) requires that answers must be filed through ESTTA and paper filing is allowed only when ESTTA is unavailable due to technical problems or extraordinary circumstances are present. Paper filing must be accompanied by a Petition to the Director under § 2.146 with the fees therefor. AMENDS: Specifies in redesignated subsection (2) that a reply to an affirmative defense shall not be filed, and new subsection (3) requires an applicant to promptly inform the Board of the filing of another related proceeding. Subsection (3)(iv) clarifies that the Board may reset times as it may deem necessary. |
| 2.107(a) | ADDS: An opposition against a Section 1 or 44 application may not be amended to add a joint opposer. |

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| 2.107(b) | ADDS: An opposition against a Section 66(a) application may not be amended to add a joint opposer and the grounds, goods, services, and named opposers are limited to those identified in the ESTTA cover sheet. |
| <i>Cancellation</i> | |
| 2.111(a) and (b) | DELETES: The requirement for plaintiff to serve the complaint on the defendant and to provide proof of service thereof. |
| 2.111(c)(1) and (2) | ADDS: A petition for cancellation must be filed through ESTTA. Paper filing is only allowed when ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present. Paper filing must be accompanied by a Petition to the Director under § 2.146 with the fees therefor. Timeliness of paper petition will be determined in accordance with §§ 2.195-2.198. DELETES: Hierarchy of instituting cancellation with insufficient fees. |
| 2.111(d) | ADDS: New subsection (d) requires fees for each party and each class for which cancellation is sought. Clarifies that ESTTA requires all fees, but paper petition not accompanied by a fee sufficient to pay in full for each named petitioner for each class sought to be cancelled may not be instituted. |
| 2.111(e) | ADDS: New subsection (e) provides that the filing date of a petition is the date of electronic receipt of the petition and required fee. Filing date for paper petitions will be determined in accordance with §§ 2.195-2.198. |
| 2.112(a) and (b) | ADDS: Requirement to provide current email address(es) of the current owner of the registration to the best of petitioner's knowledge. Clarifies that ESTTA requires petitioner to select relevant grounds, and the required accompanying statement supports and explains the grounds. |
| 2.113(a) | DELETES: Service requirement for petitioners. ADDS: The notice will include a web link or web address to access the electronic proceeding record and constitutes service to the registrant of the petition. |
| 2.113(b) and (c) | ADDS: Notice will be sent to the email or correspondence address of record for petitioners and registrants or domestic representatives. |

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| 2.113(d) | ADDS: Courtesy copies sent to party alleged by petition to be current owner will include the web link or web address to access the electronic proceeding record. |
| 2.114(a) | ADDS: Default may occur after the time to answer is reset, and the failure to file a timely answer tolls all deadlines, including the discovery conference. |
| 2.114(b)(1), (2) and (3) and (c) | ADDS: New subsection (1) requires answer to be filed through ESTTA. Paper filing is only allowed when ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, and must be accompanied by a Petition to the Director under § 2.146 with the fees therefor. AMENDS: Subsection (2) specifies that a reply to an affirmative defense shall not be filed, and clarifies that pleaded registrations include registrations identified in counterclaims. ADDS: In subsection (3) requires party in position of respondent and counterclaim plaintiff to inform the Board of another proceeding involving the claim. ADDS: Board may reset various deadlines as it may deem necessary. ADDS: Includes counterclaims to rule governing withdrawals of petitions for cancellation in subsection (c). |
| <i>Procedure in Inter Partes Proceedings</i> | |
| 2.116(e) and (g) | ADDS: Includes submission of notices of reliance, declarations and affidavits in the list of items submitted during testimony period which correspond to trial in court proceedings. AMENDS: Clarifies that standard protective order is automatically imposed in <i>inter partes</i> proceedings. ADDS: Board may treat as not confidential improperly designated material. |
| 2.117(c) | ADDS: Board may <i>sua sponte</i> suspend proceedings and suspensions may be automatically approved by ESTTA, but Board has discretion to condition approval of consented suspension request on providing information about the status of settlement talks, discovery activities, or trial activities. |
| 2.118 | ADDS: Notification of non-delivery of Office notice in electronic form will also prompt additional notice by publication. |
| 2.119(a) and (b) | ADDS: All submissions and papers in <i>inter partes</i> cases, except for notices of opposition or petitions to cancel must be served by email unless otherwise stipulated. If not possible because of technical problems or extraordinary circumstances and there |

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| | is no stipulation, serving party must show by written explanation accompanying the submission or paper that email service was attempted but could not be made. |
| 2.119(c) | DELETES: In view of email service, the additional five days added to a prescribed period. (All response dates initiated by a service date are twenty days as noted in Global changes.) |
| 2.119(d) | ADDS: Priority Mail Express option is not available to any party if a party to an <i>inter partes</i> proceeding is not domiciled in the United States and is not represented by an attorney located in the United States. |
| 2.120(a)(1) | ADDS: Expressly adopts proportionality in process and procedure in discovery. |
| 2.120(a)(2)(i), (2)(iii) and 2(iv) | ADDS: Option for Board to <i>sua sponte</i> participate in discovery conference. Option for Board to <i>sua sponte</i> issue an order regarding expert discovery. Nonexhaustive list of items to which parties may stipulate. Permits limited extensions of the discovery period, but requires that expert disclosure deadline must always be scheduled prior to the close of discovery. |
| 2.120(a)(3) | ADDS: All discovery requests must be served early enough in the discovery period so that responses will be due no later than the close of discovery. |
| 2.120(e) | ADDS: Requests for production are limited to 75 with the option to move for additional requests upon a showing of good cause. If party believes requests exceed allowed number, the party shall serve a general objection as to excessive number. Clarifies that discoverable items include electronically stored information as well as documents and tangible things. |
| 2.120(f)(1) and (2) | ADDS: Clarifies that discoverable items include electronically stored information as well as documents and tangible things. Motion to compel initial disclosures must be filed within 30 days after the deadline therefor. Motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period. When motion to compel is filed after discovery has closed, parties need not make pretrial disclosures until directed to do so by the Board. |
| 2.120(h) | AMENDS: 2.120(g) (sanctions) redesignated as 2.120(h). |

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| 2.120(i) | ADDS: Requests for admission are limited to 75 with the option to move for additional requests upon a showing of good cause. If party believes requests exceed allowed number, the party shall serve a general objection as to excessive number. Party may make one comprehensive request for admission for authenticating specific documents produced by an adverse party or specifying which of those documents cannot be authenticated. |
| 2.120(i)(1) and (2) | ADDS: A motion to test sufficiency of a response or objection must be filed prior to the deadline for pretrial disclosures for the first testimony period. When the motion is filed after discovery has closed, parties need not make pretrial disclosures until directed to do so by the Board. |
| 2.120(j)(1), (2) and (3) | ADDS: Circumstances when Board may convene a telephone conference for consideration of stipulation or motion broadened to whenever Board determines it would be beneficial. AMENDS: Convening pretrial conference due to complexity of issues is limited to exercise only by Board, on Board's initiative and on such terms as the Board may order. ADDS: Parties may not make a recording of the conferences. |
| 2.120(k) | AMENDS: 2.120(j) (use of discovery deposition, answer to interrogatory, admission or written disclosure) redesignated as 2.120(k). |
| 2.120(k)(2), (3)(ii) and (7) | AMENDS: Timing for motion to use discovery deposition is changed from the time of the offer of the deposition in evidence to when making pretrial disclosures. ADDS: Documents obtained through disclosure or under Rule 34 of the Fed. R. Civ. P. may be made of record under admission or stipulation from the producing party that authenticates the documents. Authenticated produced document added to list of discovery responses made of record. |
| 2.121(a) | ADDS: The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. |
| 2.121(c) | ADDS: In addition to being extended, testimony periods may be shortened. When a motion to extend the testimony period is denied, associated pretrial disclosure deadlines may remain as set. |

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| 2.121(d) | ADDS: Stipulations to reschedule pretrial disclosure and trial dates must be filed through ESTTA with the relevant dates set forth and an express statement that all parties agree to the new dates. |
| 2.121(e) | ADDS: In rule for pretrial disclosures, clarifies that testimony of a witness may be taken upon oral examination or presented in the form of an affidavit or declaration. Expressly provides for motion to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures. Expressly provides for motion to strike when testimony presented by affidavit or declaration. |
| 2.122(a) | ADDS: Expressly recognizes evidentiary stipulations, and that evidence made of record by one party may be used by any party for any permitted purpose. |
| 2.122(b)(2) | ADDS: Expressly provides that statements made in an affidavit or declaration in application and registration files are not testimony, and establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be governed by the Fed. R. Evid., Fed. R. Civ. P., 28 U.S.C., 37 CFR. |
| 2.122(d)(2) | ADDS: Registrations may be made of record under testimony or notice of reliance by submitting a current copy of information from the Office's electronic database records. |
| 2.122(e)(2) | ADDS: Expressly provides for submission of internet materials under notice of reliance. |
| 2.122(g) | ADDS: New subsection sets out general requirements for notices of reliance. |
| 2.123(a)(1) and (2) | ADDS: Testimony may be submitted in the form of an affidavit or declaration subject to the right to oral cross examination if the witness is within the jurisdiction of the United States or cross examination by written questions if the witness is outside the jurisdiction of the United States. Testimony of witness noticed for deposition upon written questions may, upon motion, be taken by oral examination if witness is present in the United States. |
| 2.123(b) | DELETES: Option to stipulate to testimony by affidavit. |
| 2.123(c) | DELETES: Option to notice the oral deposition of a witness by description. ADDS: Process to elect and take oral cross-examination. |
| 2.123(e) | ADDS: Cross-examination is available for oral and affidavit/declaration testimony. |

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| 2.123(f)(2) | AMENDS: Process for filing testimony deposition transcripts is amended to require filing through ESTTA. Exhibits that by their nature (<i>e.g.</i> , DVDs) cannot be transmitted through ESTTA shall be submitted through mail by the party. |
| 2.123(g)(1) and (3) | ADDS: Deposition transcripts must be submitted in full-sized format and may not be condensed to multiple pages per sheet, and must include a word index. |
| 2.123(i) | DELETES: Provision for inspection of depositions by parties at the Board or printed for inspection. AMENDS: Remaining subsections are appropriately redesignated. |
| 2.123(j) | ADDS: Redesignated 2.123(j) includes declarations and affidavits as being subject to objections to admissibility and clarifies that such objections may not be considered until final hearing. |
| 2.124(b)(3), (d)(1) and (d)(3) | ADDS: New subsection (3) provides process for noticing cross-examination by written question of witness providing testimony by affidavit or declaration and subsection (d)(1) incorporates such cross-examination. New subsection (d)(3) mandates service of these written questions, responses and cross-examination questions be in accordance with § 2.119(b). |
| 2.125(a) and (f) | ADDS: New subsection (a) provides for filing and service of affidavit and declaration testimony. AMENDS: Redesignated subsection (f) permits sealing of a part of an affidavit or declaration. |
| 2.126(a) | ADDS: Requires all submissions be filed through ESTTA. Text must be in at least 11 point type and double-spaced. Exhibits must be submitted electronically as an attachment and must be clear and legible. |
| 2.126(b) | ADDS: Paper filing only allowed when ESTTA unavailable due to technical problems, or when extraordinary circumstances are present and must be accompanied by a written explanation of such technical problems or extraordinary circumstances. (Pleadings and extensions of time to oppose require a Petition.) Paper submissions that do not meet showing will not be considered. DELETES: Provision that provides ESTTA as merely an alternative for filing. |
| 2.127(a) | ADDS: Clarifies that the time for filing a reply brief not only will not be extended, but also will not be reopened. |

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| 2.127(c) | ADDS: Conceded matters and other matters not potentially dispositive may be acted upon by a paralegal or by ESTTA, and motions disposed of By the Board have the same legal effect as a three-judge panel. |
| 2.127(d) | AMENDS: The wording “will be” is replaced with “is” such that the filing of potentially dispositive motions serves to automatically suspend proceedings with respect to all matters not germane to the motion. |
| 2.127(e)(1) and (2) | AMENDS: The deadline for filing summary judgment motions is moved up from prior to the commencement of the trial period to prior to the deadline for pretrial disclosures. ADDS: Clarifies that the time for filing a motion under 56(d) or a reply brief not only will not be extended, but also will not be reopened. ADDS: Parties may stipulate that summary judgment materials be considered at trial as trial evidence. |
| 2.128(a)(3) | ADDS: Clarifies procedure when the Board issues a show cause order for failure to file a brief and there is no evidence of record. If the party in the position of plaintiff responds to the order showing good cause why judgment should not be entered based on loss of interest, but does not move to reopen its testimony period based on demonstrable excusable neglect, judgment may be entered against plaintiff for failure to take testimony or submit evidence. |
| 2.128(b) | ADDS: Evidentiary objections may be set out in a separate appendix that does not count against the briefing page limit. Briefs exceeding the page limit may not be considered by the Board. |
| 2.129(a) and (b) | ADDS: At the discretion of the Board, parties and members of the Board may attend hearings remotely. The Board may deny a request to reset a hearing for lack of good cause or if multiple requests for rescheduling have been filed. |
| 2.130 | AMENDS: Clarifies that during an <i>inter partes</i> proceeding if facts appear which in the opinion of the examining attorney render the mark in the application unregistrable, the examining attorney should request a remand of the application from the Board. |
| 2.132(a) | ADDS: Board may <i>sua sponte</i> grant judgment where it is clear from the proceeding record that plaintiff has not taken testimony or offered other evidence. |

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| 2.134(b) | ADDS: Rule governing registrations canceled during proceeding now includes reference to Madrid registrations. |
| 2.136 | ADDS: Rule governing status of application on termination of a proceeding now also includes status of registrations on termination of a proceeding. |
| Appeals | |
| 2.142(b)(2) and (3) | ADDS: Clarifies that examining attorney briefs need not be filed through ESTTA. (Trademarks has its own electronic filing system.) Reply briefs are limited to 10 pages. DELETES: Requirement for alphabetical index of cited cases. ADDS: New subsection (3) requires that citations to evidence in briefs reference the electronic application record by date, the name of the paper, and the page number in the electronic record. |
| 2.142(c) | ADDS: Briefs should include reference to compliance with requirements not the subject of the appeal. |
| 2.142(d) | AMENDS: Clarifies that to enter evidence into the record after appeal, the applicant or examining attorney should request remand. |
| 2.142(e)(1) and (2) | ADDS: At the discretion of the Board, applicant, the examining attorney and members of the Board may attend hearings remotely. DELETES: Replacement examining attorney must be from the same examining division. |
| 2.145 | AMENDS: The provisions for seeking review of a Board decision are reorganized to align with the analogous rules governing judicial review of Patent Trial and Appeal Board decisions, including amending filing times from two months to 63 days. Times for taking action reference the applicable section of the Act or rules that set out time requirements. If requesting reconsideration of a decision, parties must do so before filing a notice of appeal. All notices of appeal and notices of election must be filed with the Office of the General Counsel and a copy with the Board via ESTTA. Parties seeking review of <i>ex parte</i> decisions by way of civil action must serve the summons and complaint on the Director addressed to the Office of the General Counsel and a copy of the complaint via ESTTA. Parties commencing a civil action for review of a Board <i>inter partes</i> decision must file a notice thereof with the Board via ESTTA and identify the case name, case number and court, and a copy of the complaint may be filed with the notice. Requests to extend time to seek review must be filed to the |

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| | attention of the Office of the Solicitor and copied on the Board via ESTTA. Filing all notices with the Board via ESTTA avoids premature termination of proceedings. |
| General Information and Correspondence | |
| 2.190(b) | ADDS: Provides online address for ESTTA. |
| 2.191 | ADDS: Mandates documents filed with the Board must be through ESTTA. |
| 2.195(d)(3) | DELETES: Ability to file notices of <i>ex parte</i> appeal by facsimile. |