

TRADEMARK UPDATE

November 7, 2007

SIGNIFICANT TRADEMARK TRIAL AND APPEAL BOARD RULES CHANGES IMPLEMENTED

Recent changes to the rules of practice before the United States Patent and Trademark Office (“PTO”) Trademark Trial and Appeal Board (the “TTAB” or “Board”) affect both those trademark owners who are challenging or planning to challenge the registration of a mark as well as those who are planning to file or currently have pending applications to register a United States trademark.

BACKGROUND

The TTAB is the administrative tribunal of the PTO empowered to determine the right to registration of a trademark in the United States. It has jurisdiction over appeals taken from the PTO and over certain adversary proceedings, including oppositions to trademark registrations and petitions to cancel trademark registrations. Proceedings before the TTAB are governed by the Lanham Act, 15 U.S.C. §§ 1051 et seq., the rules of practice in trademark cases (the “Trademark Rules of Practice”), found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations (“CFR”), the rules pertaining to assignments in trademark cases, found in Parts 3 and 7 of the CFR, and the rules relating to representation of others before the PTO, found in Part 10 of the CFR. Adversary proceedings before the TTAB are largely governed by the Federal Rules of Civil Procedure.

The recent amendments will, in some respects, bring the Trademark Rules of Practice more closely in line with the Federal Rules of Civil Procedure and are meant to increase the efficiency of the processes for commencing inter partes cases, to take account of the electronic filing options now available, and to increase the efficiency of the exchange of discovery and other pretrial information. Other changes to the Trademark Rules of Practice relate to concurrent use proceedings and minor modifications necessary to make corrections or updates. This Update is meant to highlight the more significant rules changes applicable to opposition and cancellation proceedings. It is not exhaustive and is not meant as a substitute for legal advice.



MAJOR CHANGES TO THE TRADEMARK RULES OF PRACTICE GOVERNING OPPOSITION AND CANCELLATION PROCEEDINGS

- **Service of the Complaint**

Under the amended rules the onus is on the plaintiff in an opposition or cancellation proceeding to serve copies of his or her complaint directly on the defendant(s) concurrently with filing that complaint, together with proof of service, with the TTAB. 37 CFR §§ 2.101 & 2.111. Such service may be made by, among other means, United States mail. 37 CFR § 2.119(b)(4). If a service copy is returned as undeliverable, the plaintiff must notify the Board within 10 days of receipt of the returned service copy. 37 CFR §§ 2.101(b) & 2.111(b).

In an opposition proceeding, service must be made on the applicant or the applicant's attorney or domestic representative of record, as applicable, at the correspondence address of record in the PTO. 37 CFR § 2.101(a) & (b). In a cancellation proceeding, service must be made upon the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the PTO. 37 CFR § 2.111(a) & (b).

This amendment is applicable to cases commenced on or after November 1, 2007.

- **Standard Protective Order In Place**

Pursuant to 37 CFR 2.116(g), the TTAB's standard protective order is applicable during disclosure, discovery and at trial in all opposition and cancellation proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board.

This amendment is applicable to cases pending or commenced on or after August 31, 2007, except those pending cases that already had a protective order in place.

- **Requirement That Parties Conduct Rule 26(f) Conference**

Pursuant to 37 CFR 2.120(a)(1), the provisions of Federal Rule of Civil Procedure 26 relating to the conference of the parties to discuss settlement and to develop a disclosure and discovery plan are now applicable to Board proceedings in modified form. The TTAB will specify the deadline for a discovery conference and the trial order setting those deadlines and dates will be included with the notice of institution of the proceeding served by the Board.

Pursuant to 37 CFR § 2.120(a)(2), the parties' discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Fed. R. Civ. P. 26(f) and any subjects set forth in the TTAB's institution order. A TTAB Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party.

The parties are not required to prepare or transmit to the TTAB a written report outlining the discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by the Trademark Rules of Practice or any applicable Federal

Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.

This amendment is applicable to cases commenced on or after November 1, 2007.

- **Initial Disclosures**

Pursuant to 37 CFR 2.120(a)(1), the provisions of Federal Rule of Civil Procedure 26 relating to initial disclosures are now applicable to Board proceedings in modified form. The Board will specify the deadline within the discovery period for making initial disclosures and the trial order setting that deadline will be included with the notice of institution of the proceeding.

Pursuant to 37 CFR § 2.120(a)(2), initial disclosures must be made no later than thirty days after the opening of the discovery period.

Pursuant to 37 CFR § 2.120(a)(3), a party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board.

This amendment is applicable to cases commenced on or after November 1, 2007

- **Changes to Rules Governing Certain Motions**

Amendments to 37 CFR §§ 2.120(e), 2.120(f), 2.120(g), 2.120(h), 2.123(e)(3) and 2.127(e)(1) & (e)(2) affect the rules governing motions to compel, motions for protective orders, motions for sanctions, motions to test sufficiency, motions to strike testimony, and summary judgment motions, respectively. In addition, 37 CFR § 2.127(a) clarifies the rule regarding page limitations on written briefs.

These amendments are applicable to cases commenced on or after November 1, 2007, except for the amendment to 37 CFR § 2.127(a), which applies to all cases pending or commenced on or after August 31, 2007.

- **Identification of Expert Witnesses**

Pursuant to 37 CFR § 2.120(a)(1), the provisions of Federal Rule of Civil Procedure 26 relating to expert disclosures are now applicable to TTAB proceedings in modified form. The TTAB will specify the deadline for making expert disclosures and the trial order setting that deadline will be included with the notice of institution of the proceeding.

Pursuant to 37 CFR § 2.120(a)(2), disclosure of expert testimony must occur in the manner and sequence provided in Fed. R. Civ. P. 26(a)(2), unless alternate directions have been provided by the TTAB in an institution order or any subsequent order. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the TTAB may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.

This amendment is applicable to cases commenced on or after November 1, 2007.

- **Pre-Trial Disclosure of Witnesses**

Pursuant to 37 CFR 1.21(e), no later than 15 days prior to the opening of each testimony period, the party scheduled to present evidence must disclose the name, telephone number and address of each witness expected to testify or who may testify if needed. The disclosure must also include general identifying information about the witnesses, such as the witness's relationship to any party, occupation and job title and a summary or list of subjects on which the witness is expected to testify and a summary or list of the types of documents and things that may be introduced as exhibits during the testimony of the witness. If the party does not plan to take testimony from any witness, the party must so state in the pretrial disclosure. If a party fails to make the required pretrial disclosures, any adverse party may move to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods.

This amendment is applicable to cases commenced on or after November 1, 2007.

CONCLUSION

It is unclear what practical effect these changes will have on the conduct of opposition and cancellation proceedings and the manner in which the TTAB will interpret these rules is yet to be determined. It is the Board's expressed intention that these rules changes will enhance settlement prospects and lead to earlier settlement of cases and, for cases that do not settle, will result in increased procedural fairness. At a minimum, it appears that the changes will result in the need for increased attention to additional deadlines and the exchange of more information earlier in the proceedings.

QUESTIONS OR ASSISTANCE?

If you have any further questions, please contact Patrick M. Fahey, at 860-251-5824 or Susan S. Murphy at 860-251-5707.