



New Trademark Trial and Appeal Board (TTAB) Rules of Practice, intended to provide more efficiency in proceedings and to harmonize the TTAB's rules and technological advances, have been amended and go into effect on Jan. 14, 2017. The rule changes were [proposed in April 2016](#) and after considering public comments a [Notice of Final Rulemaking](#) was published in the Federal Register early this month.

The new rules will be applicable to all proceedings, including those filed before Jan. 14, 2017, and pending on that date. The new rules will apply to inter partes proceedings (oppositions, cancellations, concurrent use) and ex parte appeal proceedings. The changes include, among other things:

- Allowing submission of testimony by declaration (subject to the other party's ability to cross-examine the declarant via live deposition)
- Limiting the number of discovery requests allowed
- Shortening the window for discovery

The new rules also include eliminating the need for parties to serve notices of opposition or petitions to cancel on one another, which will now be handled by the board electronically.

ALLOWING FOR TESTIMONY BY DECLARATION

Prior to the rule changes, submission of testimony in TTAB proceedings was only allowed by deposition unless otherwise agreed to by the parties. The new changes, however, allow for the option of introducing testimony by declaration—a less costly and usually more convenient way of introducing evidence. This change aligns with the express purpose of the amendments, which is to promote efficient trial procedure. It also comes in the wake of the Supreme Court's 2015 B&B Hardware decision, which held TTAB findings, may, under the right circumstances, have preclusive effect on subsequent court actions. Thus, given the potential long lasting effect of Board decisions, evidence submission has heightened importance, and should be more thorough.

NARROWING THE PERIOD OF DISCOVERY

The new rules also significantly impact discovery procedures, limiting requests for admissions and document production requests to 75 (the limit currently in place only for interrogatories) and requiring that all discovery, including production, have taken place during the six-month discovery period. Parties will no longer be allowed to serve discovery requests on opposing parties up to the last day of the six-month period, knowing the responses would be due past the deadline. Instead, all discovery requests must be served thirty days prior to the end of the discovery period. With the tightened window, firms and practitioners must be particularly mindful to commence discovery early to comply with the shortened window for requests.

The TTAB is expected to publish a revised version of the [Trademark Trial and Appeal Board Manual of Procedure](#) early in 2017 to reflect the practice changes implemented by the new rules. The USPTO has published a [chart summarizing all of the rule changes](#).

CONCLUSION

The new rules, which are too numerous and varied to fully address here, are on the whole sensible and likely to streamline board proceedings. Nevertheless, potential pitfalls remain. If you have questions or comments about the new rules, including about opposition and cancellation proceedings under the new rules and changes to the timing relating to the "discovery" process and discovery disputes, please contact one of the attorneys listed below.



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