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Trademark Trial and Appeal Board: Significant Early Proceeding Rule Changes

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Early in the Proceeding Rule Changes

- Direct Service of Initial Pleadings.
- Notice by Publication in Official Gazette.
- Standard Protective Order.
- Discovery Conference Requirement.
- Initial Disclosure Requirement.

Service of Initial Pleadings

Direct Service Approach for Oppositions

Rule: 37 CFR §§ 2.101(a), (b), (d)(4) – Adds the opposer's obligation to serve a copy of the notice of opposition on the applicant or its attorney of record or domestic representative of record in the USPTO and include proof of service with the notice of opposition. Furthermore subsection (b) requires an opposer to notify the Board within 10 days of receipt of any returned service copy.

Rule: 37 CFR §§ 2.105(a), (c) – Under subsection (a) the Board may serve notice of the Opposition by e-mail when a party has provided the Office with an e-mail address. Under subsection (c) the Board is not required to serve a copy of the notice of opposition and exhibits on applicant.

Service of Initial Pleadings

Direct Service Approach for Cancellations

Rule: 37 CFR §§ 2.111(a), (b), (c)(4) - Adds the petitioner's obligation to serve a copy of the petition for cancellation on the owner of the registration or the owner's domestic representative of record in the USPTO and include proof of service with the petition. Furthermore subsection (b) requires a petitioner to notify the Board within 10 days of receipt of any returned service copy.

Rule: 37 CFR §§ 2.113(a), (c), (e) - Under subsection (a) the Board may serve notice of the petition for cancellation by e-mail when a party has provided the Office with an e-mail address. Under subsection (c) the Board is not required to serve a copy of the petition for cancellation and exhibits on applicant. Subsection (e) is removed that had allowed petitioner time to correct an informality in the petition.

Service of Initial Pleadings

Housekeeping Changes

Rule: 37 CFR § 2.119(a) – Deletes references to initial pleadings being an exception to the service requirement.

Rule: 37 CFR § 2.119(b)(6) – Adds option for parties to agree to use fax or e-mail for service.

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Service of Initial Pleadings

Comments

- The Board believes the initiation of *inter partes* proceedings will be more efficient because initial pleadings will be served directly on defendants.
- The Board believes the direct service approach will promote efficiency because the parties often have direct contact prior to filing a Board proceeding.
- The Board believes the direct service approach and direct contact is vital to settlement and ensuring cooperation in the early stages of a proceeding.
- The attorney designated as the attorney of record for the prosecution of an application is also the attorney for a Board proceeding until the appropriate revocation papers are filed with the Board or new attorney is appointed.
- Concurrent use proceedings also require service of copies of the concurrent use application on the excepted parties (“promptly” after Board’s Institution Order).
- The notice of failure of service to the Board must include a new address discovered through independent or voluntary investigation.

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Service of Initial Pleadings

Summary of New Direct Service Approach

WHO: Owner of Record, Attorney of Record, or Domestic Representative.

WHAT: Oppositions and Cancellations (Including Exhibits).

WHERE: Correspondence Address listed in TARR.

WHEN: On or Before Date of Filing Opposition or Cancellation; For Concurrent Use Proceeding, "Promptly" After Board Order.

HOW: Personal Service or by Mail
E-Mail or Fax (But Only by Stipulation).

WHY: Increase Efficiency of Commencement
Few Objected During Comment Period
Reduction of Use of Board Resources.

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Notice by Publication in Official Gazette

Rule: 37 CFR § 2.118 – Adds the Board may publish notice of a proceeding in the Official Gazette in any inter partes proceeding.

Comments

- The Board may send notice of the commencement of an inter partes proceeding by e-mail if e-mail communication has been authorized when filing an application, the filing of a paper through ESTTA includes an e-mail address, or the registration file includes the authorization of e-mail communication. However, any undelivered notice may result in notice by publication in the Official Gazette.

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Standard Protective Order

Universal Applicability of Board's Standard Protective Order for Treatment of Confidential Information

Rule: 37 CFR § 2.116(g) – The Board's standard protective order is applicable to all inter partes proceedings, unless the parties agree to, and the Board approves, a different protective order, or the Board approves a motion to use a different protective order.

The Board's standard protective order is available at the following Web address:

http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm

This Rule was effective as of August 1, 2007.

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Standard Protective Order

Universal Applicability of Board's Standard Protective Order for Treatment of Confidential Information

Comments

- Board will reference in institution Order.
- Parties still free to modify order by agreement, subject to Board approval.
- Parties still free to move for modified protective order if standard order provides insufficient protection.
- Board believes this will decrease existing motion practice.
- Board may sanction breaches during proceeding.
- Board may sanction or discipline attorneys after proceeding too.
- Board not sure it has power to order parties to enter contract that binds them after conclusion of proceeding.
- Standard Order requires parties to return all protected information disclosed during proceeding, unless agreement otherwise.

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Pretrial Discovery Conference/Initial Disclosures

Rule: 37 CFR § 2.120(a) – Separated into three subsections:

(1) Federal Rules of Civil Procedure for pretrial discovery conference and initial disclosures are applicable to Board proceedings. The Board will set the dates for these procedures in its Institution Order. The rules may be amended by stipulation, motion, or Board order.

(2) Pretrial discovery conference must occur before the opening of the discovery period. Initial disclosures must be made within 30 days after the opening of the discovery period. No requirement that the parties submit a written report of the discovery conference, unless required by the Board or if the parties agree to depart from the rules or Federal Rules of Civil Procedure.

(3) A party must make its initial disclosures before serving discovery.

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Pretrial Discovery Conference/Initial Disclosures

Applicable FRCP 26(1) Disclosures

- (A) The name and, if known, the address and telephone number of each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses, unless solely for impeachment, identifying the subjects of the information.

- (B) A copy of, or a description by category and location of, all documents, electronically stored information, and tangible things that are in the possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses, unless solely for impeachment.

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Pretrial Discovery Conference/Initial Disclosures

Comments

- The parties pretrial discovery conference may be in person or by other means.
- A Board professional will not participate, unless a request is made that a Board professional participate.
- A request that a Board professional participate in the conference may not be made earlier than the filing of the answer and no later than 10 days prior to the opening of discovery.
- There is no obligation to disclose every witness, document, or thing that may contain discoverable information, but only every witness, document, and thing containing discoverable information that the party may rely on to support its claim or defense.
- The specificity of the initial disclosures is an issue that must be discussed during the pretrial discovery conference. Furthermore, the parties may agree to more extensive disclosures than those required by the rules, or decide which disclosures are not required.

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Pretrial Discovery Conference/Initial Disclosures

Comments

- The discovery period will remain at 180 days, which leaves 150 days to conduct discovery after the initial disclosures are made.
- In addition to the inability to serve discovery prior to making the required initial disclosures, a party may not move for summary judgment until the initial disclosures are made, unless the party is moving on the grounds of res judicata, collateral estoppel, or lack of jurisdiction.
- The Board believes the disclosure process will promote settlement and make the discovery process more efficient by eliminating unfair surprise and increasing the fair disposition of claims and defenses.
- The Board believes the disclosure process will also eliminate paper work that is otherwise necessary to determine the basic facts of a case.
- The initial disclosure obligations should be easier to meet in Board proceedings because the Board's jurisdiction is limited to the right to obtain or retain a registration and the claims available are not as broad as in district court.

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Pretrial Discovery Conference

Adoption of Pretrial Discovery/Settlement Conference

WHO:	Counsel for Parties; Board Member or Interlocutory Attorney, if Requested.
WHAT:	Discuss specificity of information to be Provided Under Rule 26(a)(1)(A) and (B). Discuss Settlement Possibility. Discuss Other Items Identified by Board.
WHERE:	In person or "by other means."
WHEN:	No later than thirty (30) days after Answer.
HOW:	May Request Board Participation by Telephone or via ESTTA.
WHY:	"Obviate" need to use traditional discovery for "basic information."

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Initial Disclosures

Adoption of Disclosure Model

WHO: Both Parties Must Serve on Each Other.

WHAT: Only Requires Disclosures Set Forth in Fed. R. Civ. P. 26(a)(1)(A) and (B).

WHEN: No Later Than Thirty (30) Days After the Opening of Discovery Period.

WHY: Decrease in Cost and Time Associated with Seeking Core Information Regarding the Existence and Location of Witnesses and Documents.

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THANK YOU!

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