

# LEGAL UPDATE

January 2017

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## NEW FEES AND RULES IMPLEMENTED BY THE USPTO AND TTAB

On January 14, 2017, significant rule changes will take effect that increase routine USPTO filing fees and impact practice before the Trademark Trial and Appeal Board (“TTAB”). These new rules will apply to all pending proceedings and applications, and constitute the most sweeping modifications to TTAB procedure since 2007, reflecting the USPTO’s objective of moving towards a fully integrated, paperless system.

This Legal Update highlights the most notable rule changes and includes an updated fee chart for filings made through ESTTA.

### Trademark Rules and Practice

The USPTO fee schedule will change as follows:

- Paper filings are now officially disfavored. The per class fee will rise from \$375 to \$600 for paper applications.
- Fees for electronically-filed applications will increase by \$75, resulting in a \$400 per class filing fee.
- Fees for filing Section 8 and Section 71 declarations will also increase, from \$100 to \$125.
- The fee for an ex parte appeal will increase from \$100 to \$200.
- Some fees, however, will decrease, including those associated with electronically-filed requests for extensions of time to file a statement of use, which will be reduced from \$150 to \$125 per class.

### TTAB's Amended Rules of Practice

The TTAB has made substantial changes to its rules of practice and fee schedule, including:

- **Extensions of Time to Oppose:** A new fee of \$100 for extensions of time to oppose will be required. Previously, the TTAB had not required a fee for such extensions. After receiving one or two extensions totaling 90 days, a person may file one final request for an extension of time for an additional 60 days with payment of a \$200 fee.
- **Filing Fees:** The fees for filing a petition to cancel or a notice of opposition have increased from \$300 to \$400 per class.
- **Only Electronic Filings and Service:** A litigant before the TTAB must now file solely through ESTTA unless there are extraordinary circumstances. Permission to file by paper must be requested by petition to the Director and demonstrate technical difficulties with ESTTA (which will be confirmed by the TTAB) or extraordinary circumstances, such as a disaster, extended power outage or medical emergency. Except for the initial complaint, all filings must be served by email unless parties stipulate to alternate means.
- **Service of Complaint:** A plaintiff is no longer required to serve the defendant with the complaint by first class mail. Instead, the proceeding is instituted upon the filing of the complaint and the Board will serve the complaint on the adverse party along with the scheduling order.
- **Opposing Section 66(a) Applications:** An opposition against an application based on a Madrid extension is limited to those goods, services and grounds set forth in the ESTTA cover sheet that is

automatically generated during electronic filing. The ESTTA cover sheet controls regardless of the allegations contained in the Notice of Opposition.

- **Changes to Briefing Schedules:** The Board has also changed response times as follows:
  - Five additional days for acting within the prescribed period are no longer permitted.
  - All 15-day response and reply deadlines for motions will increase to 20 days.
- **Proportionality:** The Board expressly adopted the proportionality in process and procedure requirements set forth in Rule 26 of the Federal Rules of Civil Procedure.
- **Suspension Pending Motion:** Filing a potentially dispositive motion now automatically suspends the proceeding.
- **Timing for Written Discovery:** Written discovery requests must be served so that the responses will be due no later than the close of discovery (i.e. a party can no longer wait until the last day of discovery to serve written discovery requests). A party served with discovery 30 days before the close of discovery must produce all responsive documents by the close of discovery. Additionally, the parties are precluded from stipulating to a later production of documents without approval by the Board of an extension to the discovery cut-off date.
- **Time for Filing Summary Judgment:** Motions for summary judgment must now be filed before deadline in order for the plaintiff to make pretrial disclosures, as opposed to the previously accepted method of the filing by the opening of the first testimony period.
- **Testimony by Declaration:** Testimony may be taken by affidavit or declaration, subject to the right of the adverse party to cross-examine.
- **Submission of Transcripts into Evidence:** Deposition transcripts must be submitted one page per sheet with a word index.

### Changes to USPTO / TTAB Fees for Filings Made Electronically, As of January 14, 2017

Description	Current Fee	New Rule Fee	Change
Filing an Application through TEAS Regular, per Class	\$325	\$400	\$75
Additional Processing Fee under §2.22(c) or §2.23(c), per Class (electronic)	\$50	\$125	\$75
Filing an Affidavit under §8 of the Act through TEAS, per Class	\$100	\$125	\$25
Filing an Affidavit under §71 of the Act through TEAS, per Class	\$100	\$125	\$25
Filing a Request under §1(d)(2) of the Act for a Six-Month Extension of Time for Filing a Statement of Use under §1(d)(1) of the Act through TEAS, per Class	\$150	\$125	\$25
Filing a Petition to Cancel through ESTTA, per Class	\$300	\$400	\$100
Filing a Notice of Opposition through ESTTA, per Class	\$300	\$400	\$100
Ex Parte Appeal to the TTAB Filed through ESTTA, per Class	\$100	\$200	\$100
Filing a Request for an Extension of Time to File a Notice of Opposition under §2.102(c)(1)(ii) or (c)(2) through ESTTA, per Application	n/a	\$100	n/a
Filing a Request for an Extension of Time to File a Notice of Opposition under §2.102(c)(3) through ESTTA, per Application	n/a	\$200	n/a

The changes discussed above reflect the most significant updates to the rules governing practice and filing fees for matters before the USPTO or the TTAB. If you have any questions regarding the new rules or other issues relating to practice before these agencies, please feel free to contact the [Intellectual Property Group](#) at Pryor Cashman.

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