

# Adding Value at the TTAB



**Fordham Law School IP Institute  
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**Chief Administrative Trademark Judge  
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# Trial Cases – Trending Up

	FY09	FY10	FY11	FY12	FY13
<b>Cancellations Filed</b>	1,392	↓1,374	↓1,362	↑1,463	↑1,513
<b>Ending balance</b>	1,518	↓1,456	↑1,520	↑1,533	↑1,629
<b>Extensions Filed</b>	17,305	↓15,424	↑16,420	↑16,946	↓16,939
<b>Oppositions Filed</b>	5,307	↓4,513	↑4,985	↑5,160	↑5,278
<b>Ending balance</b>	6,125	↓5,453	↑5,466	↑5,496	↑5,662
<b>Total Positions*</b>	73	73	65	73	73
<b>ATJs/Attorneys</b>	17/15	17/16	16/13	19/12	22/14



# Trial v. Appeal Decisions

Category	FY10	FY11	FY12	FY13
Oppositions	109	98	108	101
Cancellations	26	23	27	36
Appeals	321	331	399	538
Total	457	452	534	676
% Trial	29.5%	26.8%	25.3%	20.3%



# Calls for Change

- Managing the Board's Increasing Workload: The Creative Use of Sanctions Alan S. Cooper (*Trademark Reporter* 1998).
- A Legal Strategist's Guide to Trademark Trial and Appeal Board Practice (Ethics, Rule 11 and Other Sanctions Motions) Cooper (2010 ABA IP Section)



# Calls for Change

- Playing the Numbers: A Quantitative Look At Section 2(d) Cases Before The Trademark Trial and Appeal Board John M. Murphy 94 *Trademark Reporter* 800 (July-August 2004)
- TTAB Delay: A 'Qualitative' View Anthony Fletcher 95 *Trademark Reporter* 583 (May-June 2005)
- <http://thettablog.blogspot.com/2005/06/recommended-reading-two-tmr-articles.html>



# Calls for Change

- Too many extensions? Too much discovery? Not enough value?
- A more recent view from the INTA Bulletin (March 1, 2013 Vol. 68 No. 5) is titled The Value Equation of Trademark Oppositions: A Multinational Comparison of Costs and Perceived Benefits by Paul F. Kilmer
- Admitted “small scale” of study and wide “divide” of opinions on whether U.S. oppositions a “preferred” forum, author says, warrant more study/analysis.



# Pick up the Phone!

- August 1998 institution of pilot program to broaden use of phone conferences in trial cases; permanent expansion in May 2000.
- <http://www.uspto.gov/web/offices/com/sol/og/1998/week33/patphon.htm>
- <http://www.uspto.gov/trademarks/process/appeal/pattele.jsp>



# Create a Protective Order

- May 2000 release of standard protective order, for adoption by parties or deployment by Board, as needed.
- <http://www.uspto.gov/web/offices/com/sol/og/2000/week25/patagre.htm>
- <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>
- <http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmnt.jsp>





# Leverage the Internet

- November 2002 deployment of ESTTA for electronic filing of documents with the Board
- <http://www.uspto.gov/news/pr/2002/02-72.jsp>
- <http://www.uspto.gov/ebc/estta/>

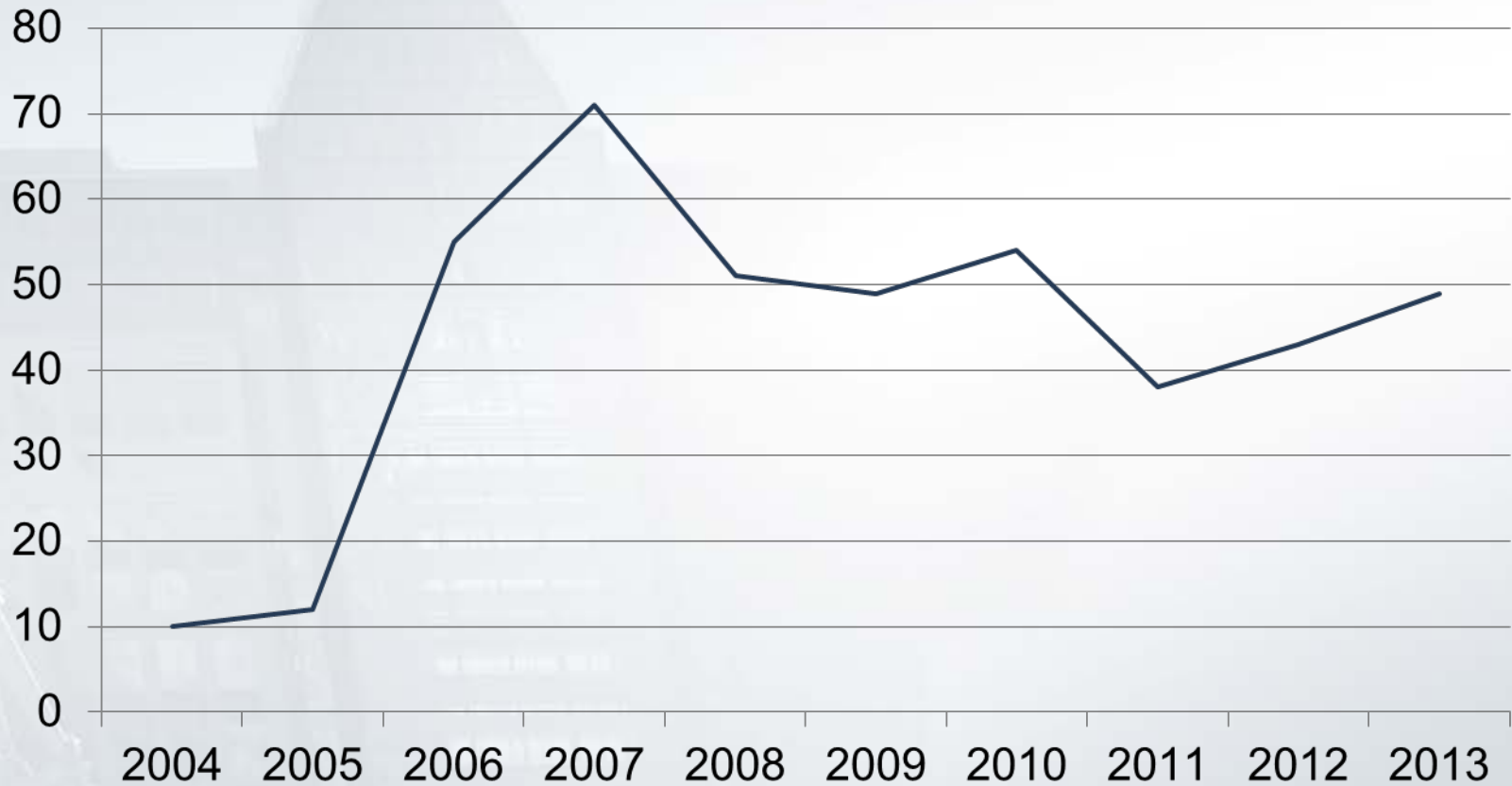


# Leverage the Internet

- Board has promoted use of email for party communications. 37 CFR §2.119(b)(6) (as of 2007).
- Board adapted the Notice of Reliance procedure to allow for easier introduction of material from Internet. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010).



# Issue More Precedents





# Revise TBMP—Frequently!

- Second edition from March 2004
- Third edition May 2011
- Annual Revisions in 2012 and 2013 (and soon in 2014!)
- Portion available for comment:  
<http://uspto-tbmp.ideascale.com/>
- Soon to be available in new format, more easily searched and updated



# Rulemaking – Trial Cases

- Outreach to stakeholders when amending TTAB rules in 2007
- The rules overall are a sweeping change to current practice before the Board and could adversely impact rights of both current trademark owners and applicants.

*--Law Firm Comment*

- [http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf)



# Rulemaking – Trial Cases

- From my perspective, they have worked quite well. Service is easy... the automatic protective order eliminated a great deal of stonewalling... the mandatory early conference forces the parties to talk about settlement... the mandatory initial disclosures are not too onerous... and the expert disclosure date doesn't impact too many cases.

*--Lawyer's E-Mail*



# Outreach Can Be Productive

- November 2011 Roundtable on processing times and performance measures.
- Intended to determine what information helps clients and counsel understand likely path of Board proceedings.
- [http://www.uspto.gov/trademarks/process/appeal/2011\\_Roundtable\\_Transcript\\_Final.pdf](http://www.uspto.gov/trademarks/process/appeal/2011_Roundtable_Transcript_Final.pdf)
- Led to new TTAB web page postings and dashboards.



# Outreach Can Be Productive

- November 2012 Roundtable on Accelerated Case Resolution (ACR) best practices.
- Board has been marketing ACR; but it was useful to hear feedback from the customers.
- <http://www.uspto.gov/trademarks/process/appeal/index.jsp> (see Stakeholder Outreach section)





# Sometimes the Answer is No

- April 2011 Request for Comments: Should the Board be more directly and/or more frequently involved in parties' settlement discussions?  
Answer: Not really, thank you.
- [http://www.uspto.gov/trademarks/process/appeal/76\\_FR\\_22678.pdf](http://www.uspto.gov/trademarks/process/appeal/76_FR_22678.pdf)



# Sometimes the Answer is No

- Will more parties agree to Accelerated Case Resolution (ACR) if there are set schedules to choose from (avoids the “too many” choices problem)?
- [http://www.uspto.gov/trademarks/process/appeal/TTAB\\_ACR\\_Options.jsp](http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp)
- Answer (again): Not really.



# TTAB Call for Change

- December 2013 Roundtable on reducing overall processing times in appeal and trial cases.
- Some resistance to significant changes, especially in trial cases.
- <http://www.uspto.gov/trademarks/process/appeal/index.jsp> (see Stakeholder Outreach section)
- Just a first step down a path toward investigating what makes for a value-added opposition.



# Suggestions?

- <http://uspto-tbmp.ideascale.com>
- [TTABdashboard@uspto.gov](mailto:TTABdashboard@uspto.gov)
- [ACRsuggestions@uspto.gov](mailto:ACRsuggestions@uspto.gov)

Thank you!