Changes Coming to Trademark Trial and Appeal Board Rules of Practice

By Jason W. Whitney | October 31, 2016

RELATED PRACTICES Patents, Trademark and Advertising, Intellectual Property

The United States Patent and Trademark Office has published its first major update to the rules for trademark trials and appeals in nearly a decade.

The final changes to the Trademark Trial and Appeal Board ("TTAB") Rules of Practice appear in the October 7, 2016 Federal Register (81 Fed. Reg. 69950) and are scheduled to go into effect on January 14, 2017. Unlike substantive rule changes that generally apply only to future proceedings, the procedural TTAB rule changes will apply to all active proceedings as of January 14, 2017, whether pending on or filed after the effective date.

The revisions to the TTAB rules affect many aspects of practice, from the period before oppositions or cancellations are filed though appeals of final TTAB decisions to the United States Court of Appeals for the Federal Circuit. View a chart analyzing some of the more significant rule changes.

The many revisions include:

Modified Service and Filing Requirements

- The revised TTAB rules revert to the longstanding, pre-2007 policy of having the TTAB, rather than the opposer or petitioner, serve notices of opposition and cancellation. The comments accompanying the rule change state that the TTAB intends to serve cancellation notices by U.S. mail "pending system enhancements to facilitate email service." 81 Fed. Reg. 69953. The TTAB will send opposition notices by email if an authorized email address has been provided. *Id*.

- The revised rules also adopt an across-the-board requirement for electronic filing and service on other parties. Thus, absent technical problems or extraordinary circumstances, documents must be filed with the TTAB through the Electronic System for Trademark Trials and Appeals. Similarly, email service on other parties is required unless otherwise agreed, with exceptions for technical problems or extraordinary circumstances.

Limitations on Discovery

- While the TTAB rules have long restricted the number of interrogatories a party may serve to 75, no such limits applied to requests for production or admission. But no longer: the new rules impose the same 75 number limit on requests for production and admission, which will force parties to carefully consider when and how many requests for production and admission to serve (including whether to serve additional discovery before the limit takes effect).

- The revised TTAB rules also curtail the period for serving discovery and the parties' ability to agree to discovery extensions. Under the new rules, discovery requests cannot be served up to the close of discovery, but must be served so that responses will be due on or before the

© 2026 Haynes and Boone, LLP

close of discovery. Likewise, the parties can no longer agree to extensions that move discovery response deadlines past the close of discovery.

New Rules and Requirements.

- The changes to the TTAB procedures incorporate a number of new rules and requirements. Among these is a rule permitting the TTAB to unilaterally disclose, without prior notice, confidential-designated material that the TTAB concludes "cannot reasonably be considered confidential," even if all parties agree that the material is confidential. While the comments accompanying the rule indicate that such disclosures will be "narrowly applied and only done when necessary to articulate the Board decision," 81 Fed. Reg. 69959, this limitation does not appear in the rule itself, leaving the door open to broader application.

- The revised TTAB rules additionally require cancellation petitions to identify "to the best of petitioner's knowledge" the name, address, and email address of respondent.

Given the significant number of revisions to the TTAB rules, both large and small, parties and practitioners will find the TTAB Rule Changes Summary useful in understanding and preparing for the changes taking effect on January 14, 2017.

© 2026 Haynes and Boone, LLP