

Client Alert: Changes are Coming to Trademark Practice: New Fees and Rules

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UPDATE: TRADEMARK PRACTICE: SPECIMENS AND DECLARATIONS

On February 3, 2017, an update on the changes in trademark rules and procedures was published. To find out more about changes in trademark rules and procedures, [click here](#).

ORIGINAL ALERT:

After ten years with no change, on January 14, 2017, new filing fees in the Trademark Office and Trademark Trial and Appeal Board (Board) and revised rules of procedure before the Board for both new and pending cases will go into effect. Trademark owners should be aware of changes as they can affect the cost and timing of US trademark matters. While this alert does not include information about all of the coming adjustments, it provides insight into the goals of the Trademark Office and Board which can assist in developing strategies for filings and proceedings.

Filing Fees

Unsurprisingly, most fees are increasing. The most notable changes are newly instituted filing fees for requests for extensions of time to oppose a third party application. While, the first 30 day extension request is still free, the filing fee for a 60 day extension for good cause (after the first 30 day extension) and an initial 90 day extension for good cause are now both \$100 per application. A 60 day consented extension thereafter will be \$200 per application. These new filing fees may deter some frivolous extension filings, and filings by small companies and individuals, but are not likely to have a large impact on major players.

The sharpest increases are for paper filings when an electronic filing option is available. The initial paper filing fee for a one class trademark application is increasing from \$375 to \$600. The filing fees for new

electronic applications are also rising, from \$325 to \$400 per class. The per class filing fees for Notices of Opposition, Cancellations and Appeals are also going up \$100 per class. One filing fee is being reduced: the fee for a request of an extension of time to file a Statement of Use, from \$150 per class to \$125 per class.

Procedure

Impending changes to the rules of Board procedure will affect cost and timing of cases, including cases already in progress. When initially filing a case, the plaintiff will no longer need to serve the complaint on the defendant at all. Instead, the Board will serve the complaint on the defendant(s) via the email address of record. Other service copies must be served via email unless the parties agree otherwise. The parties may also agree to limit the scope of discovery and a new maximum of 75 of each Requests for Production and Requests for Admissions has been instituted. Both of these provisions may reduce the quantity of discovery documents and cost of discovery. Another potentially cost saving change is that parties will be able to attend hearings remotely via video conference. This may help reduce travel costs, especially for those located outside of the Washington, D.C. area.

Some of the new rules affect the timing of cases. For example, parties can mutually agree to shorten the time frame for discovery. Cases with relatively narrow claims can be accelerated using this new rule. The new rules also tighten the discovery schedule by requiring that discovery requests be served with enough time for responses to be provided before the close of discovery. Similarly, Motions for Summary Judgment may no longer be filed up until the trial start date but now must be filed before the plaintiff's pretrial disclosure deadline. These changes are intended to streamline cases and encourage parties to consider strategies with their attorneys earlier in the proceedings to meet the new deadlines.

If you are considering a new filing in the Trademark Office or before the Board or need assistance with a current application or proceeding, please feel free to contact an attorney in the Vorys trademark group.