UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

February 7, 2017

IN RE:
Sulzer Mixpac AG

SERIAL NO. **86576579**

APPEAL RECEIVED: **02/07/2017**

BRIEF DUE: **n/a**

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ESTTA799852

NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD ("BOARD") RULES OF PRACTICE **EFFECTIVE JANUARY 14, 2017**

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website: http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab
- The final rule: http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf
- The correction to the final rule: http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf

- A chart summarizing the affected rules and changes: http://www.uspto.gov/sites/default/files/documents/2017Rulechangehighlights.pdf

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.

The appeal and appeal fee in the above-entitled application were received on the date indicated above. Applicant has checked the request for reconsideration box on the ESTTA form, thereby indicating that it has filed or is filing today a request for

reconsideration of the final refusal to register. Applicant should notify the Board immediately if it has not filed a timely request for reconsideration and does not intend to do so.

A request for reconsideration, which may or may not include an amendment, must be filed with the Trademark Examining Operation, and may be filed via TEAS, using the Response to Office Action form.[1]

In view of the filing of the request for reconsideration/amendment, the appeal is hereby instituted, but action on the appeal is suspended and the application is remanded to the examining attorney to consider the request for reconsideration/amendment.

If registrability is found on the basis of the request for reconsideration/amendment, the appeal will be moot. In the event the refusal of registration is maintained, and assuming that the request for reconsideration/amendment does not raise a new issue, the application will be returned to the Board, proceedings in the appeal will be resumed, and applicant will be allowed time in which to file an appeal brief. If the request for reconsideration/amendment raises a new issue, the examining attorney may not issue a final refusal until the applicant has been given an opportunity to respond. Upon issuance of a final refusal, proceedings in the appeal will be resumed, and applicant will be allowed time in which to file an appeal brief. An Amendment to Allege Use will be treated in the same manner as any amendment; if registrability

[1] (To maintain their status, TEAS Plus applicants must use TEAS for filing a request for reconsideration.)

is found on the basis of the AAU, the appeal will be moot; if the AAU raises a new issue, the examining attorney may not make a refusal final until applicant has been given an opportunity to respond.

Request to Divide

If, in addition to filing a notice of appeal and request for reconsideration/amendment, applicant has also filed a request to divide the application, the appeal is instituted, proceedings are suspended, and the application is remanded to the examining attorney. The examining attorney should forward the application to the ITU/Divisional Unit of the Office to act on the request to divide. After the request to divide is processed, the examining attorney should consider the request for reconsideration/amendment. If registrability is found on the basis of the request for reconsideration/amendment, the appeal will be moot. If the refusal of registration is maintained,[2] the divided file containing classes for which an appeal has been filed should be returned to the Board, and the Board will then resume proceedings in the appeal and allow applicant time to file an appeal brief. The file for which no appeal has been taken should be treated by the examining attorney in the same manner as any request for reconsideration/amendment where there has been no appeal.

[2] If the request for reconsideration/amendment raises a new issue, a final Office action may not issue until the applicant has had an opportunity to respond).