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Part II

## Department of Commerce

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Patent and Trademark Office

37 CFR Part 2

Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice; Proposed Rules

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Part 2**

[Docket No. PTO-T-2009-0030]

RIN 0651-AC35

**Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Notice of Proposed Rulemaking.

**SUMMARY:** The United States Patent and Trademark Office (“USPTO” or “Office”) proposes to amend the Trademark Rules of Practice (“Trademark Rules” or “Rules”), in particular the rules pertinent to practice before the Trademark Trial and Appeal Board (“Board”), to benefit the public by providing for more efficiency and clarity in inter partes and ex parte proceedings. Certain amendments are being proposed to reduce the burden on the parties, to conform the rules to current practice, to update references that have changed, to reflect technological changes, and to ensure the usage of standard, current terminology. The proposed rules will also further strategic objectives of the Office to increase the end-to-end electronic processing.

**DATES:** Comments must be received by June 3, 2016 to ensure consideration.

**ADDRESSES:** The Office prefers that comments be submitted via electronic mail message to *TTABFRNotices@uspto.gov*. Written comments also may be submitted by mail to Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451, attention Cheryl Butler; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Cheryl Butler; or by electronic mail message via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site, <http://www.regulations.gov>, for additional instructions on providing comments via the Federal eRulemaking Portal. Written comments will be available for public inspection on the Office’s Web site at <http://www.uspto.gov>, on the Federal eRulemaking Portal, and at the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia.

**FOR FURTHER INFORMATION CONTACT:** Cheryl Butler, Trademark Trial and Appeal Board, by email at

*TTABFRNotices@uspto.gov*, or by telephone at (571) 272-4259.

**SUPPLEMENTARY INFORMATION:**

*Executive Summary: Purpose:* The proposed amendments to the rules emphasize the efficiency of electronic filing, which is already utilized by most parties in Board proceedings. In particular, it is proposed that all submissions will be filed through the Board’s online filing system, the Electronic System for Trademark Trials and Appeals (“ESTTA”) (available at <http://www.uspto.gov>), except in certain limited circumstances.

To simplify proceedings, the Office proposes to resume service requirements for notices of opposition, petitions for cancellation, and concurrent use proceedings, and proposes to require parties to serve all other submissions and papers by email. The proposed amended rules promote other efficiencies in proceedings, such as imposing discovery limitations, and allowing parties to take testimony by affidavit or declaration, with the option for oral cross-examination. It is being proposed that the proportionality requirement implemented in the 2015 amendments to the Federal Rules of Civil Procedure be expressly incorporated into the Board’s proposed amended rules, which in-part adapt to recent changes to the Federal Rules of Civil Procedure, while taking into account the administrative nature of Board proceedings.

Other proposed amended rules address the Board’s standard protective order and codify recent case law, including the submission of internet materials. Recognition of remote attendance at oral hearings is proposed to be codified, and new requirements for notification to the Office and the Board when review by way of civil action is taken are proposed in order to avoid premature termination of a Board proceeding. The proposed amendments also make minor changes to correct or update certain rules so that they clearly reflect current Board practice and terminology.

*Costs and Benefits:* This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

References below to “the Act,” “the Trademark Act,” or “the statute” refer to the Trademark Act of 1946, 15 U.S.C. 1051 *et seq.*, as amended. References to “TBMP” refer to the June 2015 edition of the Trademark Trial and Appeal Board Manual of Procedure.

**Background***Reasons for Proposed Rule Changes*

The last major set of rule changes at the Board took effect in 2007; the time is ripe for changes that will assist stakeholders in achieving more efficient practice before the Board. In the years since 2007, technology changes have allowed Board operations to move much closer toward the goal of realizing a fully integrated paperless filing and docketing system. In addition, many stakeholders have embraced use of the Board’s Accelerated Case Resolution (“ACR”) procedures, which has provided the Board with insight as to the effectiveness of the various procedures to which users of ACR have agreed, and which can be leveraged to benefit all parties involved in Board proceedings. The Federal Rules of Civil Procedure have changed in ways that are appropriate for codification into Board rules at this time, and the Board rules must be updated to reflect precedential decisions of the Board and the courts.

The revised rules would apply to every pending case and every new case commenced on or after the effective date of the rulemaking. Any issues that may arise concerning the transition to the revised rules for cases pending as of the effective date of the rules would be addressed by the Board and the parties on a case-by-case basis, allowing for flexibility to respond to the unique needs in each case, particularly with respect to scheduling matters.

*Electronic Filing*

The Board’s electronic filing system, ESTTA, came online in 2002. Since that time electronic filings with the Board have steadily increased. Today well over 95 percent of filings are submitted via ESTTA. In addition, during this time, the Board has effectively communicated with parties through email for notices, orders, and decisions when the party has provided an email address, and since 2006, the Board institution order has included a link to the case file in TTABVUE, the Board’s database of electronic case files. In view of this trend, and to further streamline proceedings, the proposed rules require that all filings be made through ESTTA and provide that the Board will send its notices, orders, and decisions via email. Eastern Time continues to control the timeliness of filing dates.

ESTTA already requires plaintiffs commencing a trial proceeding to select relevant grounds for opposition and cancellation, enhancing the accuracy of notice pleading, and under the proposed rules defendants would be required to

inform the Board of any other related proceeding that serves as, or in essence could be viewed as, a counterclaim. In addition, under the proposed rules plaintiffs in a cancellation proceeding would have to include the name and address, including an email address, of any attorney reasonably believed by the plaintiff to be a possible representative of the owner in matters regarding the registration. Cancellation plaintiffs often are privy to such information and have traditionally provided it to the Board. The proposed rules codify this practice; the goal of this requirement is simply to assist in locating current owners of registrations, so that each cancellation case will involve the real parties in interest. To be clear, any attorney so identified is not considered counsel of record for the defendant until and unless either a power of attorney is filed or an appearance is made by the attorney in the proceeding.

The proposed rules codify that any notification of non-delivery of the Board's electronic notice of institution may also prompt additional notice of commencement of the case by publication in the USPTO Official Gazette. The Board would continue its practice of using other appropriate and available means to contact a party to ensure the real party in interest is notified of the proceeding. These changes recognize and embrace the shift by stakeholders from paper filing to electronic filing.

The Board would continue to accept paper filing of a notice of opposition or petition for cancellation in the rare circumstances when filing through ESTTA is not possible; however, parties attempting to commence a proceeding through a paper filing would have to concurrently file, to the attention of the Board, a petition to the Director with a showing that either ESTTA was unavailable due to technical problems or extraordinary circumstances are present. This procedure for paper filing would be required for all filings (e.g., motions, testimony, and notices of reliance) with the Board.

In the event of more serious circumstances that could affect the Office's filing systems, such as the disruption of Office systems in December 2015, the Board will be flexible in making accommodation for such an event.

#### *Service and Electronic Communication*

In 2007, the USPTO amended the rules to require each plaintiff to serve the complaint on the defendant. This was a change from long-standing practice where the Board served the complaint on the defendant with the

notice of institution. The proposed rules now shift the responsibility for serving the complaint back to the Board.

However, in keeping with the progress toward complete use of electronic communication, the Board would not forward a paper copy of the complaint but rather would serve the complaint in the form of a link to TTABVue in the notice of institution. In addition, recognizing that the correspondence address for a registered extension of protection under the Madrid Protocol, 15 U.S.C. 1141i, is the international registration holder's designated representative, the Board would forward the notice of institution to the registrant's designated representative.

Under the 2007 rules, parties are allowed (and encouraged) to stipulate to electronic service between the parties for all filings with the Board. Over the last few years, this has become the common practice, and the USPTO proposes to codify that practice by requiring service between parties by email for all filings with the Board and any other papers served on a party not required to be filed with the Board (e.g., disclosures, discovery, etc.). The proposed rules nonetheless allow for parties to stipulate otherwise, to accommodate other methods of communication that may promote convenience and expediency (for example, a file hosting service that provides cloud storage, delivery of a USB drive, etc.). In addition, in the event service by email is not possible due to technical problems or extraordinary circumstances, and there is no stipulation to other methods, the party would have to include a statement with its submission or paper explaining why service by email was not possible, and the certificate of service would have to reflect the manner in which service was made. The statement is meant to assist the Board in ascertaining whether a repeating problem exists that may be alleviated with Board guidance. The statement is not intended to provide fertile ground for motion practice. In any event, methods of service of discovery requests and responses and document production remain subject to the parties' duty to cooperate under the Federal Rules of Civil Procedure and the Trademark Rules and are to be discussed during the settlement and discovery planning conference. Parties may avail themselves of Board participation in these conferences to ensure the most expeditious manner of service is achieved.

In view of service by email, the additional five days previously added to a prescribed period for response, to account for mail delays, would be

removed. The response period for a motion would be initiated by its service date and would run for 20 days, except that the response period for summary judgment motions would remain 30 days. Similarly, no additional time would be available for the service of discovery responses.

#### *Streamlining Discovery and Pretrial Procedure*

The proposed rules adopt amendments to the Federal Rules of Civil Procedure by codifying the concept of "proportionality" in discovery. In addition, the proposed rules codify the ability of parties to stipulate to limit discovery by shortening the period, limiting requests, using reciprocal disclosures in lieu of discovery, or eliminating discovery altogether. To align further with the Federal Rules, the proposed rules explicitly include reference to electronically stored information ("ESI") and tangible things as subject matter for discovery. The Board continues to view the universe of ESI within the context of its narrower scope of jurisdiction, as compared to that of the federal district courts. The burden and expense of e-discovery will weigh heavily in any consideration. See *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1909 (TTAB 2011). The inclusion of ESI in the rule simply recognizes that many relevant documents are now kept in electronic form.

Under the proposed amendments, motions to compel initial disclosures must be filed within 30 days after the deadline for initial disclosures.

The proposed rules limit the number of requests for production of documents and requests for admissions to 75, the same as the current limitation on interrogatories, and remove the option to request additional interrogatories. In addition, the proposed rules allow for each party that has received produced documents to serve one comprehensive request for admission on the producing party, whereby the producing party would authenticate all produced documents or specify which documents cannot be authenticated. These proposed limitations on discovery simply recognize general practice and are meant to curtail abuse and restrain litigation expense for stakeholders. In view of the Board's narrow jurisdiction, the need to move for additional requests would be unlikely; however, the Office can revisit this issue based on comments from stakeholders.

Many commenced trial cases are quickly settled, withdrawn, or decided by default, and many others involve

cooperative parties who engage in useful settlement and discovery planning conferences. For more contentious cases, involvement of a Board Interlocutory Attorney in the conference is encouraged, and the proposed rules codify the ability of the Interlocutory Attorneys to sua sponte participate in a discovery conference when they consider it useful. In addition, the circumstances under which telephone conferences with Interlocutory Attorneys can be sought by a party or initiated by the Interlocutory Attorney would be broadened to encompass any circumstances in which they “would be beneficial.”

Under the proposed rule changes, discovery must be served early enough in the discovery period that responses will be provided and all discovery will be complete by the close of discovery. This includes production of documents, which would have to be produced or inspected by the close of discovery.

Under the proposed rules, discovery disputes would have to be resolved promptly following the close of discovery. The current deadline for filing motions to compel is merely prior to the commencement of the first trial period. Under the proposed revisions, however, motions to compel discovery or to determine the sufficiency of responses to requests for admissions must be filed prior to the deadline for the plaintiff's pretrial disclosures for the first testimony period. These revisions are intended to avoid the expense and uncertainty that arise when discovery disputes erupt on the eve of trial. These changes would also ensure that pretrial disclosures would be made and trial preparation would be engaged in only after all discovery issues have been resolved. In addition, the Board would be able to reset the pretrial disclosure deadline and testimony periods after resolving any motions relating to discovery and allowing time for compliance with any orders requiring additional responses or production.

Parties would also be subject to a requirement to inform adverse parties when prospective witnesses located outside the United States are expected to be present in the United States. This obligation would continue through discovery (as well as during trial if the witness could be called to testify), subject to the Board's determination of whether the party has been reasonable in meeting this obligation.

In 2007, the rules were amended to make the Board's standard protective order applicable in all proceedings, during disclosure, discovery, and trial, though parties have been able to agree

to alternative orders, subject to Board approval. This has worked well, and the proposed rules clarify that the protective order is imposed in all inter partes proceedings. Parties would continue to have the flexibility to move forward under an alternative order by stipulation or motion approved by the Board. The proposed rules also codify practice and precedent that the Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding party designations. See *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402–03 (TTAB 2010).

Since 2007, several types of consented motions for extensions and suspensions have been granted automatically by the Board's electronic filing system and the proposed rules codify this practice, while retaining the ability of Board personnel to require that certain conditions be met prior to approval. Thus, the practice by which some consented motions to extend or suspend are not automatically approved and would be reviewed and processed by a Board paralegal or attorney would continue. In addition, non-dispositive matters could be acted on by paralegals, and the proposed rules clarify that orders on motions under the designation, “By the Trademark Trial and Appeal Board,” have the same legal effect as orders by a panel of three judges.

To clarify the obligations of the parties and render the status and timeline for a case more predictable, the proposed rules provide that a trial proceeding is suspended upon filing of a timely potentially-dispositive motion.

As with the timing of motions relating to discovery disputes that remain unresolved by the parties at the close of discovery, referenced above, motions for summary judgment also would have to be filed prior to the deadline for plaintiff's pretrial disclosures for the first testimony period. This would avoid disruption of trial planning and preparation through the filing, as late as on the eve of trial, of motions for summary judgment.

The existing rule for convening a pretrial conference because of the complexity of issues is proposed to be limited to exercise only by the Board, upon the Board's initiative.

#### *Efficient Trial Procedures*

For some time now parties have had the option to stipulate to ACR, which can be adopted in various forms. A common approach is for parties to stipulate that summary judgment cross motions will substitute for a trial record and traditional briefs at final hearing

and the Board may resolve any issues of fact that otherwise might be considered subject to dispute. Other approaches adopted by parties utilizing the efficiencies of the ACR process have included agreements to limit discovery, agreements to shorten trial periods or the time between trial periods, stipulations to facts or to the admissibility of documents or other evidence, and stipulations to proffers of testimony by declaration or affidavit. These types of efficiencies would be codified by specifically providing for such stipulations and, most significantly, by allowing a unilateral option for trial testimony by affidavit or declaration subject to the right of oral cross examination by the adverse party or parties. Parties also would continue to be able to stipulate to rely on summary judgment materials as trial evidence.

The proposed rules would codify two changes in recent years, effected by case law and practice, expanding the option to submit certain documents by notice of reliance. First, the proposed rules codify existing law that pleaded registrations and registrations owned by any party may be made of record via notice of reliance by submitting therewith a current printout of information from the USPTO electronic database records showing current status and title. The rules currently allow for such printouts to be attached to the notice of opposition or petition for cancellation; the proposed change specifically also allows for such printouts to be submitted under notice of reliance. Second, the proposed rules codify that internet materials also may be submitted under a notice of reliance, as provided by *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010).

To alleviate any uncertainty, the proposed rules add a subsection to the requirements for a notice of reliance, specifically, to require that the notice indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the proposed rule explicitly states any failure of a notice of reliance to meet this requirement would be considered a curable procedural defect. This codifies the holding of *FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 USPQ2d 1234, 1237 (TTAB 2014).

Under the proposed rule changes, a party must file any motion to use a discovery deposition at trial along with its pretrial disclosures. Also, an adverse party would be able to move to quash a notice of testimony deposition if the witness was not included in the pretrial

disclosures, and an adverse party would be able to move to strike testimony presented by affidavit or declaration if the witness was not included in the pretrial disclosure.

Similar to the above-referenced proposal in regard to taking discovery from witnesses otherwise located outside the United States but who may be present in the United States during discovery, the proposed rules also provide that a party will have to inform adverse parties when it knows a prospective trial witness otherwise located outside the United States will be within the jurisdiction of the United States during trial.

In response to *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009), the proposed rules make clear that while the file history of the subject application or registration is of record, statements in affidavits or declarations in the file are not evidence.

The Board has seen an increase in testimony deposition transcripts that do not include a word index, and the proposed rules would require a word index for all testimony transcripts. For ease of review, deposition transcripts also would have to be submitted in full-sized format, not condensed with multiple pages per sheet. More broadly, the proposed rules would make clear that it is the parties' responsibility to ensure that all exhibits pertaining to an electronic submission must be clear and legible.

The proposed rules codify case law and Board practice under which the Board may sua sponte grant judgment for the defendant when the plaintiff has not submitted evidence, even where the plaintiff has responded to the Board's show cause order for failure to file a brief but has either not moved to reopen its trial period or not been successful in any such motion. *Gaylord Entertainment Co. v. Calvin Gilmore Productions, Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000).

To alleviate confusion and codify case law, the proposed rules clarify that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief and that briefs exceeding the page limit may not be considered by the Board. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753–54 (TTAB 2013) (Appropriate evidentiary objections may be raised in appendix or separate paper rather than in text of brief.), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2013) (mem.).

#### *Remand Procedures/Appeal Procedures*

Certain aspects of ex parte appeals procedure are clarified in the proposed amendments. Under the proposed rules, evidence shall not be submitted after the filing of the notice of appeal and may only be added to the record when attached to a timely request for reconsideration or via a request for remand. This is not a change to the substance of the existing rule, but is designed to address a recurring error by applicants during ex parte appeal.

Reply briefs in ex parte appeals would be limited to 10 pages. To facilitate consideration and discussion of record evidence, citation to evidence in all the briefs for the appeal, by the applicant and examining attorney, would be to the documents in the electronic application record by docket entry date and page number.

The proposed rules provide that, if during an inter partes proceeding the examining attorney believes certain facts render an applied-for mark unregistrable, the examining attorney should formally request remand of the application to the Trademark Examining Operation rather than simply notify the Board.

#### *Other Clarification of Board Practice and Codification of Case Law*

Correlative to electronic filing and communication, the Board also has made it possible for parties, examining attorneys, and members of the Board to attend hearings remotely through video conference. The proposed rules codify that option.

In 2.106(a) and 2.114(a) the proposed rules codify case law and practice to make it clear that when no answer has been filed, all other deadlines are tolled. If the parties have continued to litigate after an answer is late-filed, it would generally be viewed as a waiver of the technical default.

The proposed rules provide that a Notice of Opposition to an application under Trademark Act § 66(a) must identify the goods and services opposed and the grounds for opposition on the ESTTA cover sheet and may not be amended to expand the opposition to cover goods or services beyond those referenced on the ESTTA cover sheet. These amendments codify the holding of *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561–62 (TTAB 2011). In addition, the rules would clarify that after the close of the time period for filing a Notice of Opposition, the notice may not be amended to add a joint opposer.

Requirements for filing appeals of Board decisions are restructured to align

with the rules governing review of Patent Trial and Appeal Board decisions. Further, all notices of appeal to the United States Court of Appeals for the Federal Circuit must be filed with the USPTO's Office of General Counsel and a copy filed with the Board via ESTTA. When a party seeks review of a Board inter partes decision by commencing a civil action, the proposed amendments clarify that a notice of such commencement must be filed with the Board via ESTTA to avoid premature termination of the Board proceeding during pendency of the civil action. The proposed amendments further require that both a notice and a copy of the complaint for review of an ex parte decision by way of civil action are to be filed with the USPTO's Office of General Counsel with a copy to be filed with the Board via ESTTA.

#### *Public Participation*

The Board began 2015 looking ahead to the implementation of changes in the Federal Rules of Civil Procedure then scheduled to take effect in December 2015. The Board also looked back on its multi-year campaign to promote the use of Accelerated Case Resolution, to determine lessons learned, and to identify ways to leverage the benefits of ACR into all Board trial cases. For these and other reasons, it became clear that the timing was right to consider updating the Board's rules. On January 29, 2015, the Board held an ESTTA Users Forum, directed to issues and matters involving electronic filing. On February 19, 2015, the Board held a Stakeholder Roundtable concerning matters of practice and received comments and suggestions from various organizations representing intellectual property user groups, including inside counsel, outside counsel, and mark owners and applicants. That February roundtable involved discussion of many of the provisions that are now included in the proposed rule package. The Board also engaged in significant stakeholder outreach throughout 2015, alerting users in locations across the country about the issues that they could expect to be addressed in prospective rulemaking. Finally, the Board engaged the Trademark Public Advisory Committee on process and procedure changes under consideration, on multiple occasions during the year. All of these events have enriched the process through which the Board has developed proposed rule changes and served as a precursor to the continuing discussion with stakeholders that the Office seeks through this Notice of Proposed Rulemaking.

## Discussion of Proposed Rules Changes

The Office proposes to make the following amendments:

### Interferences and Concurrent Use Proceedings

#### *Preliminary to Interference*

The Office proposes to amend § 2.92 to incorporate a nomenclature change from “Examiner of Trademarks” to “examining attorney.”

#### *Adding Party to Interference*

The Office proposes to amend § 2.98 to incorporate a nomenclature change from “examiner” to “examining attorney.”

#### *Application To Register as a Concurrent User*

The Office proposes to amend § 2.99(c) and (d) to change “notification” to “notice of institution” or “notice,” and to specify that the notice will be transmitted via email.

The Office proposes to revise § 2.99(d)(1) to remove the service requirement for applicants for concurrent use registration and to specify that the notice of institution will include a web link or web address for the concurrent use proceeding.

The Office proposes to amend § 2.99(d)(2) to clarify that an answer to the notice of institution is not required by an applicant or registrant whose application or registration is acknowledged in the concurrent use application.

The Office proposes to amend § 2.99(d)(3) to clarify that a user who does not file an answer when required is in default, but the burden of providing entitlement to registration(s) remains with the concurrent use applicant(s).

The Office proposes to amend § 2.99(f)(3) to incorporate a nomenclature change from “examiner” to “examining attorney.”

## Opposition

### *Filing an Opposition*

The Office proposes to amend § 2.101(a) and (b) to remove the opposer’s requirement to serve a copy of the notice of opposition on applicant.

The Office proposes to amend § 2.101(b)(1) to require that oppositions be filed through ESTTA. The proposed amendment continues the existing unconditional requirement that an opposition to an application based on Section 66(a) of the Trademark Act must be filed through ESTTA, but provides that an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form in

the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The proposed amendment codifies the use of electronic filing.

The Office proposes to amend § 2.101(b)(2) to require that a paper opposition to an application must be accompanied by a Petition to the Director under § 2.146(a)(5), with the required fees and showing, and to add that timeliness of the submission will be determined in accordance with §§ 2.195 through 2.198.

The Office proposes to amend § 2.101(c) by moving the content of paragraph (d)(1) to the end of paragraph (c).

The Office proposes to amend § 2.101(d) by removing paragraphs (1), (3), and (4), but retaining the content in paragraph (d)(2) in an undesignated paragraph, and providing that an ESTTA opposition cannot be filed absent sufficient fees and a paper opposition accompanied by insufficient fees may not be instituted, but a potential opposer may resubmit the opposition with the required fee if time remains. The proposed revisions are intended to simplify the rules pertaining to insufficient fees.

The Office proposes to amend § 2.101(d)(4) to rename it as § 2.101(e) and clarify that the filing date of an opposition is the date of electronic receipt in the Office of the notice of opposition and required fee and to add that the filing date for a paper filing, where permitted, will be determined in accordance with §§ 2.195 through 2.198.

### *Extension of Time for Filing an Opposition*

The Office proposes to amend § 2.102 to omit references to “written” requests for extensions of time, as it is unnecessary in view of the requirement in § 2.191 that all business be conducted in writing.

The Office proposes to amend § 2.102(a)(1) to require that requests to extend the time for filing an opposition be filed through ESTTA. The proposed amendment continues the existing requirement that an opposition to an application based on Section 66(a) of the Act must be filed through ESTTA, but provides that an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The Office proposes to amend § 2.102(a)(2) to require that a paper request to extend the opposition period must be accompanied by a Petition to the Director under § 2.146(a)(5), with

the required fees and showing, and to add that timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

The Office proposes to amend § 2.102(b) to clarify that an opposition filed during an extension of time must be in the name of the person to whom the extension was granted except in cases of misidentification through mistake or where there is privity.

The Office proposes to amend § 2.102(c)(1) to clarify that a sixty-day extension is not available as a first extension of time to oppose. The Office proposes to amend § 2.102(c)(3) to clarify that only a sixty-day time period is allowed for a final extension of the opposition period.

The Office proposes to add new § 2.102(d), which clarifies that the filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the notice of opposition and that the filing date for a paper filing, where permitted, will be determined in accordance with §§ 2.195 through 2.198.

### *Contents of Opposition*

The Office proposes to amend § 2.104(a) to specify that ESTTA requires the opposer to select relevant grounds for opposition, and the accompanying required statement supports and explains the grounds. The proposed amendment codifies current Office practice.

The Office proposes to add new § 2.104(c) to clarify that with respect to an opposition to an application filed under Section 66(a) of the Trademark Act, both the ESTTA cover sheet and accompanying statement must identify the goods and/or services opposed and the grounds for opposition and such an opposition may not be amended to include goods, services, or grounds beyond those set forth in the cover sheet. The proposed amendment conforms with Section 68(c)(3) of the Act, is consistent with the proposed amendment to § 2.107(b), and codifies current case law and practice.

### *Notification to Parties of Opposition Proceeding(s)*

The Office proposes to amend § 2.105(a) to remove the service requirement for opposers and to specify that the notice of institution constitutes service and will include a web link or web address to access the electronic proceeding record.

The Office proposes to amend §§ 2.105(b) and (c) to provide that it will effect service of the notice of opposition at the email or correspondence address

of record for the parties, their attorneys, or their domestic representatives.

#### *Answer*

The Office proposes to amend § 2.106(a) to add that default may occur after the time to answer is reset and that failure to file a timely answer tolls all deadlines until the issue of default is resolved. The proposed amendment codifies current Office practice and is consistent with the Office's proposed amendment to § 2.114(a).

The Office proposes to amend § 2.106(b)(1) to specify that a reply to an affirmative defense shall not be filed.

The Office proposes to amend § 2.106(b)(2)(i) to add a requirement that an applicant subject to an opposition proceeding must promptly inform the Board of the filing of another proceeding between the same parties or anyone in privity therewith.

The Office proposes to amend § 2.106(b)(2)(iv) to clarify that the Board may sua sponte reset the times for pleading, discovery, testimony, briefs, or oral argument.

#### *Amendment of Pleadings in an Opposition Proceeding*

The Office proposes to amend § 2.107(a) to add that an opposition proceeding may not be amended to add a joint opposer.

The Office proposes to amend § 2.107(b) to clarify that, with respect to an opposition to an application filed under Section 66(a) of the Trademark Act, pleadings may not be amended to add grounds for opposition or goods or services beyond those set forth in the cover sheet, or to add a joint opposer. The proposed amendment conforms with Section 68(c)(3) of the Act, is consistent with the proposed amendment to § 2.104(c), and codifies current case law and practice.

#### **Cancellation**

##### *Filing a Petition for Cancellation*

The Office proposes to amend § 2.111(a) and (b) to remove the petitioner's requirement to serve a copy of the petition to cancel on registrant.

The Office proposes to amend § 2.111(c)(1) to require that a petition to cancel a registration be filed through ESTTA. The proposed amendment provides that a petition to cancel may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The Office proposes to amend § 2.111(c)(2) to require that a paper petition to cancel a registration must be accompanied by a Petition to the Director under

§ 2.146(a)(5), with the required fees and showing, and to add that timeliness of the submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198. The proposed amendments codify the use of electronic filing.

The Office proposes to delete § 2.111(c)(3) and add a new § 2.111(d), which provides that a petition for cancellation cannot be filed via ESTTA absent sufficient fees and a paper petition accompanied by insufficient fees may not be instituted. The proposed revisions are intended to simplify the rules pertaining to insufficient fees.

The Office proposes to amend § 2.111(c)(4) to renumber it as § 2.111(e), which clarifies that the filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee and adds that the filing date for a paper petition for cancellation, where permitted, is the date identified in § 2.198.

##### *Contents of Petition for Cancellation*

The Office proposes to amend § 2.112(a) to add that the petition for cancellation must indicate, to the best of petitioner's knowledge, a current email address(es) of the current owner of the registration and of any attorney, as specified in §§ 11.14(a) and (c) of this Chapter, reasonably believed by the petitioner to be a possible representative of the owner in matters regarding the registration.

The Office proposes to further amend § 2.112(a) to specify that ESTTA requires the petitioner to select relevant grounds for cancellation, and the required accompanying statement supports and explains the grounds. The proposed amendment codifies current Office practice.

##### *Notification of Cancellation Proceeding*

The Office proposes to amend § 2.113(a) to remove the service requirement for petitioners and to specify that the notice of institution constitutes service and will include a web link or web address to access the electronic proceeding record.

The Office proposes to amend §§ 2.113(b) and (c) to provide that it will effect service of the petition for cancellation at the email or correspondence address of record for the parties, their attorneys, or their domestic representatives. The Office further proposes to amend § 2.113(c) to insert subheadings (1), (2), and (3) for clarity and to provide in newly designated paragraph (3) that, in the case of a registration issued under 15

U.S.C. 1141(i), notice will be sent to the international registration holder's designated representative and constitutes service.

The Office proposes to amend § 2.113(d) to remove "petition for cancellation" and to provide that the courtesy copy of the notice of institution that shall be forwarded to the alleged current owner of the registration will include a web link or web address to access the electronic proceeding record.

#### *Answer*

The Office proposes to amend § 2.114(a) to add that default may occur after the time to answer is reset and that failure to file a timely answer tolls all deadlines until the issue of default is resolved. The proposed revision codifies current Office practice and is consistent with the Office's proposed amendment to § 2.106(a).

The Office proposes to amend § 2.114(b)(1) to add that a pleaded registration is a registration identified by number by the party in the position of plaintiff in an original or counterclaim petition for cancellation.

The Office proposes to amend § 2.114(b)(2)(i) to add a requirement that a party in the position of respondent and counterclaim plaintiff must promptly inform the Board of the filing of another proceeding between the same parties or anyone in privity therewith.

The Office proposes to amend § 2.114(b)(2)(iii) to clarify that the Board may sua sponte reset the period for filing an answer to a counterclaim. The Office proposes to amend § 2.114(b)(2)(iv) to clarify that the Board may sua sponte reset the times for pleading, discovery, testimony, briefs, or oral argument.

The Office proposes to amend § 2.114(c) to add that counterclaim petitions for cancellation may be withdrawn without prejudice before an answer is filed.

#### **Procedure in Inter Partes Proceedings**

##### *Federal Rules of Civil Procedure*

The Office proposes to amend § 2.116(e) to add that the submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions, during the testimony period corresponds to the trial in court proceedings. The proposed revision codifies current Office practice and is consistent with proposed amendments relating to declarations and affidavits.

The Office proposes to amend § 2.116(g) to clarify that the Board's standard protective order, which is available on the Office's Web site, is automatically imposed throughout all

inter partes proceedings. The Office proposes to further amend § 2.116(g) to add that the Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding a party's designation. The proposed revisions codify current case law and Office practice.

#### *Suspension of Proceedings*

The Office proposes to amend § 2.117(c) to clarify that the Board may suspend proceedings sua sponte and retains discretion to condition approval of consented or stipulated motions to suspend on the provision by parties of necessary information about the status of settlement talks or discovery or trial activities.

#### *Undelivered Office Notices*

The Office proposes to amend § 2.118 to add notification of non-delivery in paper or electronic form of Board notices and to delete the time period prescribed by the Director.

#### *Service and Signing*

The Office proposes to incorporate the word "submissions" throughout § 2.119 to codify the use of electronic filing. The proposed amendment codifies the use of electronic filing.

The Office proposes to amend § 2.119(a) to remove the service requirements for notices of opposition and petitions to cancel, consistent with proposed amendments to §§ 2.101(a) and (b) and 2.111(a) and (b).

The Office proposes to amend § 2.119(b) to require that all submissions filed with the Board and any other papers served on a party be served by email, unless otherwise stipulated or service by email cannot be made due to technical problems or extraordinary circumstances.

The Office proposes to amend § 2.119(b)(3) to revise the manner of service on a person's residence by stating that a copy of a submission may be left with some person of suitable age and discretion who resides there. The proposed amendment is consistent with both the Patent Rules of Practice and the Federal Rules of Civil Procedure.

The Office proposes to amend § 2.119(b)(6) to remove the requirement for mutual agreement by the parties for service by other forms of electronic transmission and to remove service by notice published in the *Official Gazette*.

The Office proposes to amend § 2.119(c) to remove the provision adding five days to the prescribed period for action after service by the postal service or overnight courier. All fifteen-day response dates initiated by a

service date would be amended to twenty days.

The Office proposes to amend § 2.119(d) to add that no party may serve submissions by means of the postal service if a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States.

#### *Discovery*

The Office proposes to amend § 2.120(a)(1) to add the concept of proportionality in discovery, in conformance with the 2015 amendments to the Federal Rules of Civil Procedure, and to reorganize portions of the text for clarity.

The Office proposes to amend § 2.120(a)(2) to add headings for subparts (i) through (v) and to reorganize portions of the text for clarity.

The Office proposes to amend renumbered § 2.120(a)(2)(i) to specify that a Board Interlocutory Attorney or Administrative Trademark Judge will participate in a discovery conference when the Board deems it useful. The proposed revision codifies current Office practice.

The Office proposes to amend renumbered § 2.120(a)(2)(iii) to add that the Board may issue an order regarding expert discovery either on its own initiative or on notice from a party of the disclosure of expert testimony.

The Office proposes to amend renumbered § 2.120(a)(2)(iv) to add that parties may stipulate that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. The proposed amendment codifies some of the stipulations successfully used by parties in ACR procedures and other proceedings incorporating ACR-type efficiencies. The Office proposes to further amend § 2.120(a)(2)(iv) to clarify that extensions of the discovery period granted by the Board will be limited. The Office proposes to further amend § 2.120(a)(2)(iv) to require that an expert disclosure deadline must always be scheduled prior to the close of discovery.

The Office proposes to amend § 2.120(a)(3) to require that discovery requests be served early enough in the discovery period that responses will be due no later than the close of discovery, and when the time to respond is extended, discovery responses may not be due later than the close of discovery. The proposed amendment is intended to alleviate motion practice prompted by

responses to discovery requests served after discovery has closed.

The Office proposes to amend § 2.120(b) to require that any agreement by the parties as to the location of a discovery deposition shall be made in writing.

The Office proposes to amend the title of § 2.120(c) to clarify that it applies to foreign parties within the jurisdiction of the United States. The Office proposes to amend § 2.120(c)(2) to require that a party must inform every adverse party whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf present within the United States.

The Office proposes to amend § 2.120(d) to remove motions for leave to serve additional interrogatories. The Office proposes to revise § 2.120(d) such that it addresses only interrogatories, deleting subsections (1) and (2). Provisions relating to requests for production are moved to revised § 2.120(e), and §§ 2.120(f) through (k) are renumbered in conformance.

The Office proposes to amend § 2.120(e) to limit the total number of requests for production to seventy-five and to provide a mechanism for objecting to requests exceeding the limitation parallel to § 2.120(d). The Office proposes to further amend § 2.120(e) to clarify that the rule applies to electronically stored information as well as documents and tangible things; to provide that the time, place, and manner for production shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties; and to delete that production will be made at the place where the documents and things are usually kept.

The Office proposes to amend renumbered § 2.120(f)(1) to clarify that the rule applies to electronically stored information as well as documents and tangible things. The Office proposes to further amend § 2.120(f)(1) to require that a motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosures. The Office proposes to further amend § 2.120(f)(1) to require that a motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period, rather than the commencement of that period. The Office proposes to further amend § 2.120(f)(1) to clarify that the request for designation pertains to a witness. The Office proposes to further amend § 2.120(f)(1) to require a showing from the moving party that the party has



made a good faith effort to resolve the issues presented in the motion.

The Office proposes to amend renumbered § 2.120(f)(2) to clarify that when a motion to compel is filed after the close of discovery, the parties need not make pretrial disclosures until directed to do so by the Board.

The Office proposes to amend renumbered § 2.120(g) to conform to Federal Rule of Civil Procedure 26(c).

The Office proposes to amend renumbered § 2.120(i) to limit the total number of requests for admission to seventy-five and to provide a mechanism for objecting to requests exceeding the limitation parallel to §§ 2.120(d) and (e). The Office proposes to further amend § 2.120(i) to permit a party to make one comprehensive request for an admission authenticating documents produced by an adverse party.

The Office proposes to amend renumbered § 2.120(i)(1) to require that any motion to test the sufficiency of any objection, including a general objection on the ground of excessive number, must be filed prior to the deadline for pretrial disclosures for the first testimony period, rather than the commencement of that period. The Office proposes to further amend § 2.120(i)(1) to require a showing from the moving party that the party has made a good faith effort to resolve the issues presented in the motion.

The Office proposes to amend renumbered § 2.120(i)(2) to clarify that when a motion to determine the sufficiency of an answer or objection to a request for admission is filed after the close of discovery, the parties need not make pretrial disclosures until directed to do so by the Board.

The Office proposes to amend renumbered § 2.120(j)(1) to state more generally that the Board may schedule a telephone conference whenever it appears that a stipulation or motion is of such nature that a telephone conference would be beneficial. The Office proposes to amend § 2.120(j)(2) to remove provisions allowing parties to move for an in-person meeting with the Board during the interlocutory phase of an inter partes proceeding and the requirement that any such meeting directed by the Board be at its offices. The Board proposes to add new § 2.120(j)(3) to codify existing practice that parties may not make a recording of the conferences referenced in §§ 2.120(j)(1) and (2).

The Office proposes to amend renumbered § 2.120(k)(2) to change the time for a motion to use a discovery deposition to when the offering party makes its pretrial disclosures and to

clarify that the exceptional circumstances standard applies when this deadline has passed.

The Office proposes to amend renumbered § 2.120(k)(3)(i) to clarify that the disclosures referenced are initial disclosures, to remove the exclusion of disclosed documents, and to incorporate a reference to new § 2.122(g).

The Office proposes to amend renumbered § 2.120(k)(3)(ii) to add that a party may make documents produced by another party of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the proposed amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating documents produced by an adverse party.

The Office proposes to amend renumbered § 2.120(k)(7) to add an authenticated produced document to the list of evidence that may be referred to by any party when it has been made of record.

#### *Assignment of Times for Taking Testimony and Presenting Evidence*

The Office proposes to amend § 2.121(a) to clarify that evidence must be presented during a party's testimony period. The Office proposes to further amend § 2.121(a) to add that the resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. These amendments codify current Office practice.

The Office proposes to amend § 2.121(c) to add that testimony periods may be shortened by stipulation of the parties approved by the Board or may be extended on motion granted by the Board or order of the Board. The Office proposes to further amend § 2.121(c) to add that the pretrial disclosure deadlines associated with testimony periods may remain as set if a motion for an extension is denied. These amendments codify current Office practice.

The Office proposes to amend § 2.121(d) to add that stipulations to reschedule the deadlines for the closing date of discovery, pretrial disclosures, and testimony periods must be submitted through ESTTA with the relevant dates set forth and an express statement that all parties agree to the new dates. The proposed amendment codifies the use of electronic filing.

The Office proposes to amend § 2.121(e) to add that the testimony of a

witness may be either taken on oral examination and transcribed or presented in the form of an affidavit or declaration, as provided in proposed amendments to § 2.123.

The Office proposes to further amend § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The proposed amendment codifies current Office practice.

The Office proposes to further amend § 2.121(e) to add that when testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike, as provided in §§ 2.123 and 2.124. The proposed amendment aligns the remedy for undisclosed testimony by affidavit or declaration with the remedy for undisclosed deposition testimony.

#### *Matters in Evidence*

The Office proposes to amend § 2.122(a) to clarify the title of the subsection and to specify that parties may stipulate to rules of evidence for proceedings before the Board. The Office proposes to further amend § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The proposed amendments codify current Office practice.

The Office proposes to amend § 2.122(b)(2) to clarify the title of the subsection and to clarify that statements made in an affidavit or declaration in the file of an application for registration or in the file of a registration are not evidence on behalf of the applicant or registrant and must be established by competent evidence.

The Office proposes to amend § 2.122(d)(2) to add a cross-reference to new § 2.122(g) and to specify that a registration owned by a party may be made of record via notice of reliance accompanied by a current printout of information from the electronic database records of the Office showing the current status and title of the registration. The proposed amendment codifies current case law and Office practice.

The Office proposes to amend § 2.122(e) to designate a new paragraph (e)(1), clarify that printed publications must be relevant to a particular proceeding, and add a cross-reference to new § 2.122(g).

The Office proposes to add new § 2.122(e)(2) permitting admission of internet materials into evidence by notice of reliance and providing requirements for their identification. The proposed amendment codifies current case law and Office practice.

The Office proposes to add new § 2.122(g) detailing the requirements for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The proposed amendment codifies current case law and Office practice.

#### *Trial Testimony in Inter Partes Cases*

The Office proposes to amend § 2.123(a)(1) to permit submission of witness testimony by affidavit or declaration, subject to the right of any adverse party to take and bear the expense of oral cross-examination of that witness, as provided in proposed amendments to § 2.121(e), and to add that the offering party must make that witness available. The proposed amendment is intended to promote efficient trial procedure.

The Office proposes to further amend § 2.123(a)(1) to move to § 2.123(a)(2) a provision permitting a motion for deposition on oral examination of a witness in the United States whose testimonial deposition on written questions has been noticed.

The Office proposes to further amend § 2.123(a)(2) to add that the party which has proffered a witness for testimonial deposition on written questions must inform every adverse party when it knows that such witness will be within the jurisdiction of the United States during such party's testimony period. The proposed amendment is consistent with the proposed amendment to § 2.120(c)(2) and is intended to promote efficient trial procedure by facilitating the use of deposition on oral examination instead of written questions when permissible.

The Office proposes to amend § 2.123(b) to remove the requirement for written agreement of the parties to submit testimony in the form of an affidavit, as provided in proposed amendments to § 2.123(a)(1), and to clarify that parties may stipulate to any relevant facts.

The Office proposes to amend § 2.123(c) to remove the option of identifying a witness by description in a notice of examination and to clarify

that such notice shall be given to adverse parties before oral depositions.

The Office proposes to further amend § 2.123(c) to add that, when a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 10 days from the date of service of the affidavit or declaration and completed within 20 days from the date of service of the notice of election.

The Office proposes to further amend § 2.123(c) to add that the Board may extend the periods for electing and taking oral cross-examination and, when necessary, shall suspend or reschedule proceedings in the matter to allow for the orderly completion of the oral cross-examination(s) that cannot be completed within a testimony period.

The Office proposes to amend § 2.123(e)(1) to specify that a witness must be sworn before providing oral testimony. The Office proposes to further amend § 2.123(e)(1) to move from § 2.123(e)(3) the provision that cross-examination is available on oral depositions. The Office proposes to further amend § 2.123(e)(1) to add that, where testimony is proffered by affidavit or declaration, cross-examination is available for any witness within the jurisdiction of the United States, as provided in proposed amendments to § 2.123(a)(1).

The Office proposes to amend § 2.123(e)(2) to remove provisions permitting depositions to be taken in longhand, by typewriting, or stenographically and to specify that testimony depositions shall be recorded.

The Office proposes to amend § 2.123(e)(3) to delete the provision that cross-examination is available on oral depositions, which the Office proposes to move to § 2.123(e)(1), and to insert subheadings (i) and (ii) for clarity.

The Office proposes to amend § 2.123(e)(4) to specify that the rule regarding objections pertains to oral examination.

The Office proposes to amend § 2.123(e)(5) to clarify that the rule regarding witness signature relates to the transcript of an oral deposition.

The Office proposes to amend § 2.123(f)(2) to require that deposition transcripts and exhibits shall be filed in electronic form using ESTTA. If the weight or bulk of an exhibit prevents its uploading to ESTTA, it shall be transmitted in a separate package, including an explanation as to why it could not be submitted electronically. The proposed amendment codifies the use of electronic filing.

The Office proposes to amend § 2.123(g)(1) to add that deposition

transcripts must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet). The Office proposes to amend § 2.123(g)(3) to add that deposition transcripts must contain a word index, giving the pages where the words appear in the deposition.

The Office proposes to remove § 2.123(i), which permits inspection by parties and printing by the Office of depositions after they are filed in the Office. Subsections 2.123(j) through (l) are renumbered §§ 2.123(i) through (k) in conformance.

The Office proposes to amend renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office proposes to further amend renumbered § 2.123(j) to provide that objections may not be considered until final hearing.

#### *Depositions Upon Written Questions*

The Office proposes to add new § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board.

The Office proposes to amend § 2.124(d)(1) to clarify that the procedures for examination on written questions apply to both direct testimony and cross-examination. The Office proposes to further amend § 2.124(d)(1) to specify procedure for cross-examination by written questions of a witness who has provided testimony by affidavit or declaration.

The Office proposes to add new § 2.124(d)(3) to provide that service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).

#### *Filing and Service of Testimony*

The Office proposes to amend § 2.125 to renumber paragraphs (a) through (e) to (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period.

The Office proposes to amend renumbered § 2.125(b) to add a cross-reference to § 2.124 and to clarify that the subsection applies to testimony depositions, including depositions on written questions.

The Office proposes to amend renumbered § 2.125(f) to permit sealing of a part of an affidavit or declaration.

### *Form of Submissions to the Trademark Trial and Appeal Board*

The Office proposes to amend § 2.126 to renumber paragraph (a) to (b) and to add new paragraph (a) to require that submissions to the Board shall be made via ESTTA. The proposed amendment codifies the use of electronic filing.

The Office proposes to add new § 2.126(a)(1) to require that text in an electronic submission must be filed in at least 12-point type and double-spaced. The proposed amendment is consistent with the proposed amendment to § 2.126(b)(1).

The Office proposes to add new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The proposed amendment codifies the use of electronic filing.

The Office proposes to amend renumbered § 2.126(b) to permit submissions in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The Office proposes to further amend renumbered § 2.126(b) to require that submissions in paper form must be accompanied by a Petition to the Director under § 2.146(a)(5), with the required fees and showing.

The Office proposes to amend renumbered § 2.126(b)(1) to require that text in a paper submission must be filed in at least 12-point type. The proposed amendment is consistent with the proposed amendment to § 2.126(a)(1).

The Office proposes to remove the subsection previously designated § 2.126(b).

The Office proposes to amend § 2.126(c) to provide that submissions to the Board that are confidential in whole or part must be submitted using the “Confidential” selection available in ESTTA or, where appropriate, under a separate paper cover. The Office proposes to further amend § 2.126(c) to clarify that a redacted copy must be submitted concurrently for public viewing.

### *Motions*

The Office proposes to amend § 2.127(a) to reflect that all response dates initiated by a service date are twenty days. The Office proposes to further amend § 2.127(a) to add that the time for filing a reply brief will not be reopened.

The Office proposes to amend § 2.127(b) to reflect that all response dates initiated by a service date are twenty days.

The Office proposes to amend § 2.127(c) to add that conceded matters and other matters not dispositive of a proceeding may be acted on by a Paralegal of the Board or by ESTTA and that motions disposed of by orders entitled “By the Trademark Trial and Appeal Board” have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board. The proposed amendments codify current Office practice.

The Office proposes to amend § 2.127(d) to clarify that a case is suspended when a party timely files any potentially dispositive motion.

The Office proposes to amend § 2.127(e)(1) to require that a motion for summary judgment must be filed prior to the deadline for pretrial disclosures for the first testimony period, rather than the commencement of that period. The Office proposes to further amend § 2.127(e)(1) to change references to Rule 56(f) to 56(d) in conformance with amendments to the Federal Rules of Civil Procedure. The Office proposes to further amend § 2.127(e)(1) to reflect that the reply in support of a motion for summary judgment is due twenty days after service of the response. The Office proposes to further amend § 2.127(e)(1) to add that the time for filing a motion under Rule 56(d) and a reply brief will not be reopened.

The Office proposes to amend § 2.127(e)(2) to add that if a motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion shall be considered at trial as trial evidence, which may be supplemented by additional evidence during trial. The proposed revision codifies an approach used by parties in proceedings incorporating ACR-type efficiencies at trial.

### *Briefs at Final Hearing*

The Office proposes to amend § 2.128(a)(3) to add that, when the Board issues a show cause order for failure to file a brief and there is no evidence of record, if the party responds to the order showing good cause why judgment should not be entered based on loss of interest but does not move to reopen its testimony period based on demonstrable excusable neglect, judgment may be entered against the plaintiff for failure to take testimony or submit evidence. The proposed amendment codifies current case law and practice and is consistent with TBMP § 536 (2015).

The Office proposes to amend § 2.128(b) to add that evidentiary objections may be set out in a separate appendix that does not count against the briefing page limit. The proposed

amendment codifies current case law and practice and is consistent with TBMP § 801.03. The Office proposes to further amend § 2.128(b) to add that briefs exceeding the page limits may not be considered by the Board, and this also codifies existing practice.

### *Oral Argument; Reconsideration*

The Office proposes to amend § 2.129(a) to clarify that all statutory members of the Board may hear oral argument. The Office proposes to further amend § 2.129(a) to add that parties and members of the Board may attend oral argument in person or, at the discretion of the Board, remotely. The proposed amendment codifies current Office practices and is consistent with the Office’s proposed amendments to § 2.142(e)(1).

The Office proposes to amend § 2.129(b) to add that the Board may deny a request to reset a hearing date for lack of good cause or if multiple requests for rescheduling have been filed.

The Office proposes to amend § 2.129(c) to reflect that all response dates initiated by a service date are twenty days.

### *New Matter Suggested by the Trademark Examining Attorney*

The Office proposes to amend § 2.130 to add that if during an inter partes proceeding involving an application the examining attorney believes certain facts render the mark unregistrable the examining attorney should formally request remand of the application rather than simply notify the Board.

### *Involuntary Dismissal for Failure To Take Testimony*

The Office proposes to amend § 2.132(a) to clarify that, if a plaintiff has not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant sua sponte. The Office proposes to further amend § 2.132(a) to reflect that all response dates initiated by a service date are twenty days. The Office proposes to amend further § 2.132(a) to clarify the standard for the showing required not to render judgment dismissing the case is excusable neglect.

The Office proposes to amend § 2.132(b) to limit evidence to Office records showing the current status and title of a plaintiff’s pleaded registrations. The Office proposes to further amend § 2.132(b) to reflect that all response dates initiated by a service date are twenty days. The Office proposes to further amend § 2.132(b) to clarify that the Board may decline to render

judgment on a motion to dismiss until all testimony periods have passed.

#### *Surrender or Voluntary Cancellation of Registration*

The Office proposes to amend § 2.134(b) to clarify that the subsection is applicable to extensions of protection in accordance with the Madrid Protocol.

#### *Status of Application on Termination of Proceeding*

The Office proposes to amend § 2.136 to specify when a proceeding will be terminated by the Board and the status of an application on termination of an opposition or concurrent use proceeding.

### **Appeals**

#### *Time and Manner of Ex Parte Appeals*

The Office proposes to amend § 2.142 to incorporate a nomenclature change from “examiner” to “examining attorney.”

The Office proposes to amend § 2.142(b)(2) to add that a reply brief from an appellant shall not exceed ten pages in length and that no further briefs are permitted unless authorized by the Board.

The Office proposes to add new § 2.142(b)(3) to specify that citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record. The proposed amendment is intended to facilitate review of record evidence by the applicant, the examining attorney, the Board, and the public.

The Office proposes to amend § 2.142(c) to add that the statement of issues in a brief should note that the applicant has complied with all requirements made by the examining attorney and not the subject of appeal.

The Office proposes to amend § 2.142(d) to clarify that evidence shall not be submitted after a notice of appeal is filed. The proposed amendment more directly states the existing rule. The Office proposes to further amend § 2.142(d) for clarity, including by specifying that an appellant or examining attorney who desires to introduce additional evidence after an appeal is filed must submit a request to the Board to suspend the appeal and remand the application for further examination.

The Office proposes to amend § 2.142(e)(1) to clarify that all statutory members of the Board may hear oral argument. The Office proposes to further amend § 2.142(e)(1) to add that

appellants, examining attorneys, and members of the Board may attend oral argument in person or, at the discretion of the Board, remotely. The proposed amendment codifies current Office practice and is consistent with the Office’s proposed amendments to § 2.129(a).

The Office proposes to amend § 2.142(e)(2) to add that a supervisory or managing attorney may designate an examining attorney to present oral argument and to delete the provision that the examining attorney designated must be from the same examining division.

The Office proposes to amend § 2.142(f)(1) to change the time for further examination of an application on remand from thirty days to the time set by the Board.

#### *Appeal to Court and Civil Action*

The Office proposes to amend § 2.145 by reorganizing the subjects covered and rewording some provisions to improve the clarity and structure of the rule and to align the provisions with the analogous rules governing judicial review of Patent Trial and Appeal Board decisions in 37 CFR part 90.

From a restructuring standpoint, certain proposed amendments result in existing provisions being moved to a different subsection of the rule. Specifically, provisions regarding appeals to the U.S. Court of Appeals for the Federal Circuit, which currently appear in subparts (a) and (b), are proposed to be grouped together under subpart (a). Provisions regarding the process provided for in Section 21(a)(1) of the Act, whereby an adverse party to a Federal Circuit appeal of an inter partes Board decision may file notice of its election to have proceedings conducted by way of a civil action, are proposed to be moved from subpart (c), which concerns civil actions, to revised subpart (b), with the subheading “For a notice of election under section 21(a)(1) to proceed under section 21(b) of the Act.”

Substantively, throughout § 2.145, the Office proposes to remove specific references to times for taking action or other requirements that are specified in the Act or another set of rules (e.g., Federal Rules of Appellate Procedure) and replace them with references to the applicable section of the Act or rules that set the time or requirements for the specified action. These changes will help ensure that parties consult the applicable statute or rule itself and avoid the need for the USPTO to amend its regulations if the applicable provision of the statute or rule changes.

The Office also proposes to amend the provisions in § 2.145 that require copies of notices of appeal, notices of election, and notices of civil action to be filed with the Trademark Trial and Appeal Board to specify that such notices must be filed with the Board via ESTTA. These proposed amendments codify the use of electronic filing and enhance the Office’s ability to handle properly applications, registrations, and proceedings while on review in federal court.

Regarding amendments to the requirements for appeals to the Federal Circuit, the Office proposes to amend § 2.145(a) to add subsections (1)–(3). The Office proposes to move the language currently in § 2.145 (a) to new (a)(1) and to amend it, in accordance with Section 21(a) of the Act, to include that a registrant who has filed an affidavit or declaration under Section 71 of the Trademark Act and is dissatisfied with the decision of the Director may appeal. The Office proposes to further amend § 2.145(a)(1) to add that it is unnecessary to request reconsideration before filing an appeal of a Board decision, but a party requesting reconsideration must do so before filing a notice of appeal. Proposed §§ 2.145(a)(2) and (3) specify the requirements contained in current §§ 2.145(a) and (b) for filing an appeal to the Federal Circuit.

Regarding amendments to the requirements for filing a civil action in district court in § 2.145(c), the Office proposes to add in § 2.145(c)(1) an amendment corresponding to the amendment to § 2.145(a)(1) that it is unnecessary for a party to request reconsideration before filing a civil action seeking judicial review of a Board decision, but a party requesting reconsideration must do so before filing the civil action. The Office proposes to replace current § 2.145(c)(2) with a provision that specifies the requirements for serving the Director with a complaint by an applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act. The proposed amendment, which references Federal Rule of Civil Procedure 4(i) and § 104.2, is intended to facilitate proper service of complaints in such actions on the Director. The Office proposes to replace current § 2.145(c)(3) with a modified version of the provision currently in § 2.145(c)(4), to specify that the party who commences a civil action for review of a Board decision in an inter partes case must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in district

court. The addition of a time frame for filing the notice of the civil action with the Board, and explicitly stating that the notice must identify the civil action with particularity, is necessary to ensure that the Board is timely notified when parties seek judicial review of its decisions and to avoid premature termination of a proceeding.

The Office proposes to amend § 2.145(d) regarding time for appeal or civil action by restructuring the subsections by the type of action (*i.e.*, (1) for an appeal to the Federal Circuit, (2) for a notice of election, or (3) for a civil action) and to add a new subsection (d)(4)(i) regarding time computation if a request for reconsideration is filed. The Office proposes to move the time computation provision currently in (d)(2) regarding when the last day of time falls on a holiday to new subsection (d)(4)(ii) and to omit the addition of one day to any two-month time that includes February 28. The Office also proposes to change the times for filing a notice of appeal or commencing a civil action from two months to sixty-three days (*i.e.*, nine weeks) from the date of the final decision of the Board. The proposed amendment aligns the times for appeal from Board action with those for the Patent Trial and Appeal Board in Part 90 of Title 37 of the Code of Federal Regulations and is intended to simplify calculation of the deadlines for taking action.

The Office proposes to amend § 2.145(e) to specify that a request for extension of time to seek judicial review must be filed as provided in § 104.2 and addressed to the attention of the Office of the Solicitor, to which the Director has delegated his or her authority to decide such requests, with a copy filed with the Board via ESTTA. The proposed amendment is intended to facilitate proper filing of and timely action upon extension requests and to avoid premature termination of a Board proceeding.

### General Information and Correspondence in Trademark Cases

#### Addresses for Trademark Correspondence With the United States Patent and Trademark Office

The Office proposes to amend §§ 2.190(a) and (c) to reflect a nomenclature change from the Assignment Services Division to the Assignment Recordation Branch. The Office proposes to amend § 2.190(b) to direct that documents in proceedings before the Board be filed through ESTTA. The proposed amendment codifies the use of electronic filing.

#### Business To Be Transacted in Writing

The Office proposes to amend § 2.191 to direct that documents in proceedings before the Board be filed through ESTTA. The proposed amendment codifies the use of electronic filing.

#### Rulemaking Considerations

*Administrative Procedure Act:* The changes in this rulemaking involve rules of agency practice and procedure and/or interpretive rules. *See National Organization of Veterans' Advocates v. Secretary of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (Rule that clarifies interpretation of a statute is interpretive.); *Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (Rules governing an application process are procedural under the Administrative Procedure Act.); *Inova Alexandria Hospital v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (Rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims.).

Accordingly, prior notice and opportunity for public comment for the rule changes are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. *See Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). However, the Office chose to seek public comment before implementing the rule to benefit from the public’s input.

*Regulatory Flexibility Act:* Under the Regulatory Flexibility Act (RFA) (5 U.S.C. 601 *et seq.*), whenever an agency is required by 5 U.S.C. 553 (or any other law) to publish a notice of proposed rulemaking (NPRM), the agency must prepare and make available for public comment an Initial Regulatory Flexibility Analysis, unless the agency certifies under 5 U.S.C. 605(b) that the proposed rule, if implemented, will not have a significant economic impact on a substantial number of small entities. 5 U.S.C. 603, 605.

For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that this rule will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b).

The proposed rules involve changes to rules of agency practice and

procedure in matters before the Trademark Trial and Appeal Board. The primary changes are to codify certain existing practices, increase efficiency and streamline proceedings, and provide greater clarity as to certain requirements in Board proceedings. The proposed rules do not alter any substantive criteria used to decide cases.

The proposed rules will apply to all persons appearing before the Board. Applicants for a trademark are not industry specific and may consist of individuals, small businesses, non-profit organizations, and large corporations. The USPTO does not collect or maintain statistics in Board cases on small- versus large-entity applicants, and this information would be required in order to determine the number of small entities that would be affected by the proposed rules.

The burdens, if any, to all entities, including small entities, imposed by these rule changes will be minor and consist of additional responsibilities and procedural requirements on parties appearing before the Board. Two possible sources of burden may come from the proposed requirement that all submissions will be filed through the Board’s online filing system, the Electronic System for Trademark Trials and Appeals (“ESTTA”), except in certain limited circumstances, and the requirement that service between parties be conducted by email for all filings with the Board and any other papers. For impacted entities that do not have the necessary equipment and internet service, this may result in additional costs to obtain this ability or to petition to file on paper. However, the USPTO does not anticipate this requirement to impact a significant number of entities impacted by this rule as well over 95 percent of filings are already submitted electronically, and it is common practice among parties to use electronic service for all filings with the Board.

In most instances the rule changes will lessen the burdens on parties, including small entities. For example, the Office proposes shifting away from the parties to itself the obligation to serve notices of opposition, petitions for cancellation, and concurrent use proceedings. Moreover, the proposed rules provide for the option of electronic service of other documents among the parties to a proceeding, thereby eliminating the existing need to arrange for the mailing or hand delivery of these documents. Also, the Office proposes making discovery less onerous for the parties by imposing limitations on the volume of discovery, incorporating a proportionality requirement, and allowing parties to present direct

testimony by affidavit or declaration. The proposed rules also keep burdens and costs lower for the parties by permitting remote attendance at oral hearings, thereby eliminating the need for travel to appear in person. Overall, the proposed rules will have a net benefit to the parties to proceedings by increasing convenience, providing efficiency and clarity in the process, and streamlining the procedures. Therefore, this action will not have a significant economic impact on a substantial number of small entities.

*Executive Order 12866:* This rule has been determined not to be significant for purposes of Executive Order 12866.

*Executive Order 13563 (Improving Regulation and Regulatory Review):* The Office has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule changes; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

*Executive Order 13132:* This rule does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

*Congressional Review Act:* Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing any final rule, the Office will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rule are not expected to result in an annual effect on the economy of 100 million dollars or more,

a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of U.S.-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rule change is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

*Unfunded Mandate Reform Act of 1995:* The Unfunded Mandates Reform Act (2 U.S.C. 1501 *et seq.*) requires that agencies prepare an assessment of anticipated costs and benefits before issuing any rule that may result in expenditure by State, local, and tribal governments, in the aggregate, or by the private sector, of \$100 million or more (adjusted annually for inflation) in any given year. This rule will have no such effect on State, local, and tribal governments or the private sector.

*Paperwork Reduction Act:* The Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This proposed rule involves information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549). The collections of information involved in this rulemaking have been reviewed and previously approved by OMB under control numbers 0651–0054. This proposed rule, if adopted, would shift a greater portion of paper filings to electronic filings. However, this rulemaking would not add any additional information requirements or fees for parties before the Board, and therefore, it would not materially change the information collection burdens approved under the OMB control number 0651–0054. If the proposed rule is adopted, the Office will submit a change worksheet to the information collection to recognize the greater shift of filings to an electronic format and enter any related adjustments. Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to, a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects

##### 37 CFR Part 2

Administrative practice and procedure, Trademarks.

For the reasons given in the preamble and under the authority contained in 15 U.S.C. 1113, 15 U.S.C. 1123, and 35 U.S.C. 2, as amended, the Office proposes to amend part 2 of title 37 as follows:

#### PART 2—RULES OF PRACTICE IN TRADEMARK CASES

■ 1. The authority citation for 37 CFR part 2 continues to read as follows:

**Authority:** 15 U.S.C. 1113, 15 U.S.C. 1123, 35 U.S.C. 2, Section 10(c) of Pub. L. 112–29, unless otherwise noted.

■ 2. Revise § 2.92 to read as follows:

##### § 2.92 Preliminary to interference.

An interference which has been declared by the Director will not be instituted by the Trademark Trial and Appeal Board until the examining attorney has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.

■ 3. In § 2.98 revise the second sentence to read as follows:

##### § 2.98 Adding party to interference.

\* \* \* If an application which is or might be the subject of a petition for addition to an interference is not added, the examining attorney may suspend action on the application pending termination of the interference proceeding.

■ 4. In § 2.99 revise paragraphs (c), (d)(1), (d)(2), (d)(3), and (f)(3) to read as follows:

##### § 2.99 Application to register as concurrent user.

\* \* \* \* \*

(c) If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notice of institution to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). The notice for each defendant shall state the name and address of the plaintiff and of the plaintiff’s attorney or other authorized representative, if any, together with the serial number and filing date of the application. If a party has provided the Office with an email address, the notice will be transmitted via email.

(d)(1) The Board’s notice of institution will include a web link or web address for the concurrent use application proceeding contained in Office records.

(2) An answer to the notice is not required in the case of an applicant or registrant whose application or

registration is acknowledged by the concurrent use applicant in the concurrent use application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.

(3) If an answer, when required, is not filed, judgment will be entered precluding the defaulting user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the burden of proving entitlement to registration(s) will remain with the concurrent use applicant(s).

\* \* \* \* \*

(f) \* \* \*

(3) A true copy of the court decree is submitted to the examining attorney; and

\* \* \* \* \*

■ 5. Revise § 2.101 to read as follows:

**§ 2.101 Filing an opposition.**

(a) An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, but must be signed by the opposer or the opposer's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for oppositions filed through ESTTA under paragraphs (b)(1) or (2) of this section.

(1) An opposition to an application must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

(2) A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146(a)(5), with the fees therefor and the showing required under paragraph (b)(1) of this section. Timeliness of the paper submission will

be determined in accordance with §§ 2.195 through 2.198.

(c) The opposition must be filed within thirty days after publication (§ 2.80) of the application being opposed or within an extension of time (§ 2.102) for filing an opposition. The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6).

(d) An otherwise timely opposition cannot be filed via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition. A paper opposition that is not accompanied by the required fee sufficient to pay in full for each named party opposer for each class in the application for which registration is opposed may not be instituted. If time remains in the opposition period as originally set or as extended by the Board, the potential opposer may resubmit the opposition with the required fee.

(e) The filing date of an opposition is the date of electronic receipt in the Office of the notice of opposition, and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.

■ 6. Amend § 2.102 by revising:

■ a. Paragraphs (a), (b), (c)(1), and (c)(2);

■ b. Add a new second sentence after the first sentence in paragraph (c)(3);

■ c. Add new paragraph (d), and;

■ d. Add and reserve paragraph (e) to read as follows:

**§ 2.102 Extension of time for filing an opposition.**

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file a request with the Trademark Trial and Appeal Board to extend the time for filing an opposition. The request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.

(1) A request to extend the time for filing an opposition to an application must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on

Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

(2) A paper request to extend the opposition period for an application based on Section 1 or 44 of the Act must be filed by the due date set forth in § 2.101(c) and be accompanied by a Petition to the Director under § 2.146(a)(5), with the fees therefor and the showing required under paragraph (a)(1) of this section. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

(b) A request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time must be in the name of the person to whom the extension was granted, except that an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) \* \* \*

(1) A person may file a first request for (i) either a thirty-day extension of time, which will be granted upon request, or (ii) a ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.

(2) If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.

(3) \* \* \* No other time period will be allowed for a final extension of the opposition period. \* \* \*

(d) The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.

(e) Fees. [Reserved]

■ 7. Add and reserve § 2.103 to read as follows:

**§ 2.103 [Reserved]**

■ 8. Amend § 2.104 by revising paragraph (a), and adding new paragraph (c) to read as follows:

**§ 2.104 Contents of opposition.**

(a) The opposition must set forth a short and plain statement showing why

the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition. ESTTA requires the opposer to select relevant grounds for opposition. The required accompanying statement supports and explains the grounds.

\* \* \* \* \*

(c) An opposition to an application filed under Section 66(a) of the Act must identify the goods and/or services opposed and the grounds for opposition on the ESTTA cover sheet as well as in the accompanying statement. Opposition to a Section 66(a) application may not be amended to include goods, services or grounds beyond those set forth in the ESTTA cover sheet.

■ 9. Revise § 2.105 to read as follows:

**§ 2.105 Notification to parties of opposition proceeding(s).**

(a) When an opposition in proper form (see §§ 2.101 and 2.104) has been filed with the correct fee(s), and the opposition has been determined to be timely and complete, the Trademark Trial and Appeal Board shall prepare a notice of institution, which shall identify the proceeding as an opposition, number of the proceeding, and the application(s) involved; and the notice shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. If a party has provided the Office with an email address, the notice will be transmitted via email. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service of the notice of opposition to the applicant.

(b) The Board shall forward a copy of the notice to opposer, as follows:

(1) If the opposition is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notice to the attorney transmitting the opposition or to the attorney designated in the power of attorney, provided that the person is an "attorney" as defined in § 11.1 of this chapter, at the email or correspondence address for the attorney.

(2) If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless opposer designates in writing another correspondence address.

(3) If opposer is not represented by an attorney in the opposition, and no domestic representative has been appointed, the Board will send the

notice directly to opposer at the email or correspondence address of record for opposer, unless opposer designates in writing another correspondence address.

(c) The Board shall forward a copy of the notice to applicant, as follows:

(1) If the opposed application contains a clear indication that the application is being prosecuted by an attorney, as defined in § 11.1 of this chapter, the Board shall send the notice described in this section to applicant's attorney at the email or correspondence address of record for the attorney.

(2) If the opposed application is not being prosecuted by an attorney but a domestic representative has been appointed, the Board will send the notice described in this section to the domestic representative, at the email or correspondence address of record for the domestic representative, unless applicant designates in writing another correspondence address.

(3) If the opposed application is not being prosecuted by an attorney, and no domestic representative has been appointed, the Board will send the notice described in this section directly to applicant, at the email or correspondence address of record for the applicant, unless applicant designates in writing another correspondence address.

■ 10. Amend § 2.106 by revising paragraphs (a) and (b) to read as follows:

**§ 2.106 Answer.**

(a) If no answer is filed within the time initially set, or as may later be reset by the Board, the opposition may be decided as in case of default. The failure to file a timely answer tolls all deadlines, including the discovery conference, until the issue of default is resolved.

(b)(1) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense shall not be filed. When a defense attacks the

validity of a registration pleaded in the opposition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number by the party in the position of plaintiff in an original notice of opposition or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the applicant must promptly inform the Board, in the context of the opposition proceeding, of the filing of the other proceeding.

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated by the Board within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

\* \* \* \* \*

■ 11. Revise § 2.107 to read as follows:

**§ 2.107 Amendment of pleadings in an opposition proceeding.**

(a) Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed, or to add a joint opposer.



(b) Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add grounds for opposition or goods or services beyond those identified in the notice of opposition, or to add a joint opposer. The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.

■ 12. Revise § 2.111 to read as follows:

**§ 2.111 Filing petition for cancellation.**

(a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee.

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for petitions submitted electronically via ESTTA. The petition for cancellation may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases, the petition for cancellation and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) A petition to cancel a registration must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a petition to cancel may be filed in paper form as provided in paragraph (c)(2) of this section.

(2) A paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146(a)(5), with the fees therefor and the showing required under paragraph (c)(1) of this section. Timeliness of the paper submission, if relevant to a ground asserted in the petition to

cancel, will be determined in accordance with §§ 2.195 through 2.198.

(d) The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration(s) for which cancellation is sought (see § 2.6). A petition cannot be filed via ESTTA unless the petition is accompanied by a fee that is sufficient to pay in full for each named petitioner to seek cancellation of the registration(s) in each class specified in the petition. A petition filed in paper form that is not accompanied by a fee sufficient to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought may not be instituted.

(e) The filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date of a petition for cancellation is the date identified in § 2.198.

■ 13. Revise § 2.112 to read as follows:

**§ 2.112 Contents of petition for cancellation.**

(a) The petition for cancellation must set forth a short and plain statement showing why the petitioner believes he, she or it is or will be damaged by the registration, state the ground for cancellation, and indicate, to the best of petitioner's knowledge, the name and address, and a current email address(es), of the current owner of the registration, and of any attorney, as specified in §§ 11.14(a) and (c) of this Chapter, reasonably believed by the petitioner to be a possible representative of the owner in matters regarding the registration. ESTTA requires the petitioner to select relevant grounds for petition to cancel. The required accompanying statement supports and explains the grounds.

(b) When appropriate, petitions for cancellation of different registrations owned by the same party may be joined in a consolidated petition for cancellation. The required fee must be included for each party joined as a petitioner for each class sought to be cancelled in each registration against which the petition for cancellation has been filed.

■ 14. Revise § 2.113 to read as follows:

**§ 2.113 Notification of cancellation proceeding.**

(a) When a petition for cancellation in proper form (see §§ 2.111 and 2.112) has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notice of

institution which shall identify the proceeding as a cancellation, number of the proceeding and the registration(s) involved; and shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. If a party has provided the Office with an email address, the notice will be transmitted via email. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.

(b) The Board shall forward a copy of the notice to petitioner, as follows:

(1) If the petition for cancellation is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notice to the attorney transmitting the petition for cancellation or to the attorney designated in the power of attorney, provided that person is an "attorney" as defined in § 11.1 of this chapter, to the attorney's email or correspondence address of record for the attorney.

(2) If petitioner is not represented by an attorney in the cancellation proceeding, but petitioner has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless petitioner designates in writing another correspondence address.

(3) If petitioner is not represented by an attorney in the cancellation proceeding, and no domestic representative has been appointed, the Board will send the notice directly to petitioner, at the email or correspondence address of record for petitioner, unless petitioner designates in writing another correspondence address.

(c)(1) The Board shall forward a copy of the notice to the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration(s).

(2) If the respondent has appointed a domestic representative, and such appointment is reflected in the Office's records, the Board will send the notice only to the domestic representative at the email or correspondence address of record for the domestic representative.

(3) In the case of a registration issued under 15 U.S.C. 1141i, notice will be sent to the international registration holder's designated representative. The notice, which will include a web link or web address to access the electronic

proceeding record, constitutes service to respondent of the petition to cancel.

(d) When the party alleged by the petitioner, pursuant to § 2.112(a), as the current owner of the registration(s) is not the record owner, a courtesy copy of the notice with a web link or web address to access the electronic proceeding record shall be forwarded to the alleged current owner. The alleged current owner may file a motion to be joined or substituted as respondent.

■ 15. Revise § 2.114 to read as follows:

**§ 2.114 Answer.**

(a) If no answer is filed within the time initially set, or as may later be reset by the Board, the petition may be decided as in case of default. The failure to file a timely answer tolls all deadlines, including the discovery conference, until the issue of default is resolved.

(b)(1) An answer shall state in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the respondent is without knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number by the party in position of plaintiff in an original petition for cancellation, or a counterclaim petition for cancellation, or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded

promptly after the grounds therefor are learned. A counterclaim need not be filed if the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the party in position of respondent and counterclaim plaintiff must promptly inform the Board, in the context of the primary cancellation proceeding, of the filing of the other proceeding.

(ii) An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§ 2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated by the Board within which an answer to the counterclaim must be filed. Such response period may be reset as necessary by the Board, for a time period to be determined by the Board.

(iv) The times for pleading, discovery, testimony, briefs, or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

(c) The petition for cancellation or counterclaim petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, such petition or counterclaim petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.

■ 16. Amend § 2.116 by revising paragraphs (c) and (e) through (g) to read as follows:

**§ 2.116 Federal Rules of Civil Procedure.**

\* \* \* \* \*

(c) The notice of opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

\* \* \* \* \*

(e) The submission of notices of reliance, declarations and affidavits, as well as the taking of depositions, during the assigned testimony periods correspond to the trial in court proceedings.

(f) Oral hearing, if requested, of arguments on the record and merits corresponds to oral summation in court proceedings.

(g) The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes proceedings unless the parties, by

stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.

■ 17. Amend by revising § 2.117 paragraph (c) to read as follows:

**§ 2.117 Suspension of proceedings.**

\* \* \* \* \*

(c) Proceedings may also be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board. Many consented or stipulated motions to suspend are suitable for automatic approval by ESTTA, but the Board retains discretion to condition approval on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate.

■ 18. Revise § 2.118 to read as follows:

**§ 2.118 Undelivered Office notices.**

When a notice sent by the Office to any registrant or applicant is returned to the Office undelivered, including notification to the Office of non-delivery in paper or electronic form, additional notice may be given by publication in the Official Gazette.

■ 19. Revise § 2.119 and the heading to read as follows:

**§ 2.119 Service and signing.**

(a) Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, including notices of appeal to the courts, must be served upon the other party or parties. Proof of such service must be made before the submission will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of submissions filed with the Board and any other papers served on a party not required to be filed with the Board, must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or in a subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances, then service may be made in any of the following ways:

(1) By delivering a copy of the submission or paper to the person served;

(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by the Priority Mail Express® Post Office to Addressee service of the United States Postal Service or by first-class mail, which may also be certified or registered;

(5) Transmission by overnight courier;

(6) Other forms of electronic transmission.

(c) When service is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service.

(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person residing in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this subchapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send

correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a), or qualified under § 11.14(b) and authorized under § 2.17(f).

(e) Every submission filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned submission will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the notification of this defect by the Office.

■ 20. Revise § 2.120 to read as follows:

#### § 2.120 Discovery.

(a) *In general.* (1) Except as otherwise provided in this section, and wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings. The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to required disclosures, the conference of the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, proportionality, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter partes proceeding or subsequent scheduling order. The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included within the notice of institution of the proceeding.

(2)(i) The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Rule 26(f) of the Federal Rules of Civil Procedure and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference, or when the

Board deems it useful for the parties to have Board involvement. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate. The discovery period will be set for a period of 180 days.

(ii) Initial disclosures must be made no later than thirty days after the opening of the discovery period.

(iii) Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rules of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.

(iv) The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. If a stipulation or motion for modification is denied, discovery disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.

(v) The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating

Board Interlocutory Attorney or Administrative Trademark Judge.

(3) A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. Discovery depositions must be properly noticed and taken during the discovery period. Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

(b) *Discovery deposition within the United States.* The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree in writing. The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. (See 35 U.S.C. 24.)

(c) *Discovery deposition in foreign countries; or of foreign party within jurisdiction of the United States.* (1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders that

the deposition be taken by oral examination, or the parties so stipulate.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, the party must inform every adverse party of such presence and such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

(d) *Interrogatories.* The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts. If a party upon which interrogatories have been served believes that the number of interrogatories exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (f) of this section.

(e) *Requests for production.* The total number of requests for production which a party may serve upon another

party pursuant to Rule 34 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts. If a party upon which requests have been served believes that the number of requests exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving responses and specific objections to the requests, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the requests which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (f) of this section. The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

(f) *Motion for an order to compel disclosure or discovery.* (1) If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically stored information, or tangible thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. A motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosure(s), if any, and a motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset. A motion to compel discovery shall include a copy of the request for designation of a witness or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of

the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents, electronically stored information, or tangible things that were not produced for inspection and copying. A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion to compel is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.

(g) *Motion for a protective order.* Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.

(h) *Sanctions.* (1) If a party fails to participate in the required discovery

conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure. A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.

(2) If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section. If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section.

(i) *Requests for admission.* The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts. If a party upon which requests for admission have been served believes that the number of requests for admission exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the requests for admission, serve a general objection on the ground of their excessive number. However, independent of this limit, a party may make one comprehensive request for

admission of any adverse party that has produced documents for an admission authenticating such documents, or specifying which documents cannot be authenticated.

(1) Any motion by a party to determine the sufficiency of an answer or objection, including testing the sufficiency of a general objection on the ground of excessive number, to a request made by that party for an admission must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party showing that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.

(j) *Telephone and pretrial conferences.* (1) Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by one or both of the parties, schedule a telephone conference.

(2) Whenever it appears to the Trademark Trial and Appeal Board that

questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative, direct that the parties and/or their attorneys meet with the Board for a disclosure, discovery or pretrial conference on such terms as the Board may order.

(3) Parties may not make a recording of the conferences referenced in paragraphs (j)(1) and (j)(2) of this section.

(k) *Use of discovery deposition, answer to interrogatory, admission or written disclosure.* (1) The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.

(2) Except as provided in paragraph (k)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed when the party makes its pretrial disclosures, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, even though such deadline has passed, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.

(3)(i) A discovery deposition, an answer to an interrogatory, an

admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (k) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party that files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

(ii) A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.

(4) If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

(5) Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the

receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement, the Board, in its discretion, may refuse to consider the additional written disclosures or responses.

(6) Paragraph (k) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.

(7) When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(8) Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.

■ 21. Amend § 2.121 by revising the heading and paragraphs (a), (c) through (e) to read as follows:

**§ 2.121 Assignment of times for taking testimony and presenting evidence.**

(a) The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any

subsequent remaining periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.

\* \* \* \* \*

(c) A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be shortened or extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or may be extended upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods and their associated pretrial disclosure deadlines may remain as set.

(d) When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.

(e) A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit

or declaration, as provided in § 2.123. Pretrial disclosure of a witness under this subsection does not substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. A party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike, as provided in §§ 2.123 and 2.124.

■ 22. Amend § 2.122 by revising paragraphs (a) through (e), and adding paragraph (g), to read as follows:

**§ 2.122 Matters in evidence.**

(a) *Applicable Rules.* Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(b) *Application and registration files.*

(1) The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.

(2) The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not

evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant and must be established by competent evidence.

(c) *Exhibits to pleadings.* Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.

(d) *Registrations.* (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance in accordance with paragraph (g) of this section, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the Office showing the current status and title of the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

(e) *Printed publications and official records.* (1) Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice

of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence.

(2) Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.

\* \* \* \* \*

(g) *Notices of reliance.* The types of evidence admissible by notice of reliance are identified in paragraphs (d)(2), (e)(1), and (e)(2) of this section and § 2.120(k). A notice of reliance shall be filed during the testimony period of the party that files the notice. For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order.

■ 23. Amend § 2.123 by revising paragraphs (a) through (c), (e) through (k), and removing paragraph (l) to read as follows:

**§ 2.123 Trial testimony in inter partes cases.**

(a)(1) The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.

(2) A testimonial deposition taken in a foreign country shall be taken by

deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness, or the parties so stipulate. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination. The proffering party must inform every adverse party when it knows that such witness will be within the jurisdiction of the United States during such party's testimony period.

(b) *Stipulations.* If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.

(c) *Notice of examination of witnesses.* Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined.

Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 10 days from the date of service of the affidavit or declaration and completed within 20 days from the date of service of the notice of election. Upon motion for good cause by any party, or upon its own initiative, the Board may extend

the periods for electing and taking oral cross-examination. When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).

\* \* \* \* \*

(e) *Examination of witnesses.* (1) Each witness before providing oral testimony shall be duly sworn according to law by the officer before whom the deposition is to be taken. Where oral depositions are taken, every adverse party shall have a full opportunity to cross-examine each witness. When testimony is proffered by affidavit or declaration, every adverse party will have the right to elect oral cross-examination of any witness within the jurisdiction of the United States. For examination of witnesses outside the jurisdiction of the United States, see § 2.124.

(2) The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be recorded and transcribed, unless the parties present agree otherwise. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly expressed to the contrary.

(3) If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.

(i) A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).

(ii) A motion to strike the testimony of a witness for lack of proper or



adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of an oral examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

(5) When the oral deposition has been transcribed, the deposition transcript shall be carefully read over by the witness or by the officer to the witness, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.

(f) *Certification and filing of deposition.*

(1) The officer shall annex to the deposition his or her certificate showing:

(i) Due administration of the oath by the officer to the witness before the commencement of his or her deposition;

(ii) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his or her presence;

(iii) The presence or absence of the adverse party;

(iv) The place, day, and hour of commencing and taking the deposition;

(v) The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.

(2) If any of the foregoing requirements in paragraph (f)(1) of this section are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he or she has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the weight or bulk of an exhibit shall exclude it from such filing or prevent its uploading to ESTTA, it shall be transmitted by the party taking the deposition, or its attorney or other authorized representative, in a separate package marked and addressed as provided in this section, including an explanation as to why it could not be submitted electronically.

(g) *Form of deposition.* (1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. A

deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).

(2) Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.

(3) Each deposition must contain a word index and an index of the names of the witnesses, giving the pages where the words appear in the deposition and where witness examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.

(h) *Depositions must be filed.* All depositions which are taken must be duly filed in the Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

(i) *Effect of errors and irregularities in depositions.* Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.

(j) *Objections to admissibility.* Subject to the provisions of paragraph (i) of this section, objection may be made to receiving in evidence any declaration, affidavit, or deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections may not be considered until final hearing.

(k) *Evidence not considered.* Evidence not obtained and filed in compliance with these sections will not be considered.

■ 24. Amend § 2.124 by revising paragraphs (b)(2), (d)(1), and (f), and

adding paragraphs (b)(3), (d)(3) to read as follows:

**§ 2.124 Depositions upon written questions.**

\* \* \* \* \*

(b)(1) \* \* \*

(2) A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the witness or the particular class or group to which he or she belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

(3) A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board.

\* \* \* \* \*

(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section, for the taking of direct testimony, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct testimony, any adverse party may serve cross questions upon the party who proposes to take the deposition. Any party who serves cross questions, whether in response to direct examination questions or under paragraph (b)(3) of this section, shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition, or who earlier offered testimony of the witness by affidavit or declaration, may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party

who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

\* \* \* \* \*

(3) Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).

\* \* \* \* \*

(f) The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(k). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.

\* \* \* \* \*

■ 25. Revise § 2.125 to read as follows:

**§ 2.125 Filing and service of testimony.**

(a) One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.

(b) One copy of the transcript of each testimony deposition taken in accordance with §§ 2.123 or 2.124, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails

to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.

(c) The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board. The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.

(d) One certified transcript and exhibits shall be filed with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.

(e) Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.

(f) Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of an affidavit or declaration or a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(h).

■ 26. Revise § 2.126 to read as follows:

**§ 2.126 Form of submissions to the Trademark Trial and Appeal Board.**

(a) Submissions shall be made to the Trademark Trial and Appeal Board via ESTTA.

(1) Text in an electronic submission must be filed in at least 12-point type and double-spaced.

(2) Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.

(b) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. Submissions in paper form must be accompanied by a Petition to the Director under § 2.146(a)(5), with the fees therefor and the showing required under this paragraph. A paper

submission, including exhibits and depositions, must meet the following requirements:

(1) A paper submission must be printed in at least 12-point type and double-spaced, with text on one side only of each sheet;

(2) A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;

(3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;

(4) A paper submission must not be stapled or bound;

(5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);

(6) Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.

(c) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(e) must be submitted using the "Confidential" selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.

■ 27. Amend § 2.127 by revising paragraphs (a) through (e) to read as follows:

**§ 2.127 Motions.**

(a) Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within

twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion. Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

(b) Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within twenty days from the date of service of the request.

(c) Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board, or by an Interlocutory Attorney or Paralegal of the Board to whom authority to act has been delegated, or by ESTTA. Motions disposed of by orders entitled "By the Trademark Trial and Appeal Board" have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board.

(d) When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

(e)(1) A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial and Appeal Board. A motion for summary judgment must be

filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. A motion under Rule 56(d) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(d) will not be extended or reopened. If no motion under Rule 56(d) is filed, a brief in response to the motion for summary judgment shall be filed within thirty days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion for summary judgment may remain as specified under this section. A reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion for summary judgment.

(2) For purposes of summary judgment only, the Board will consider any of the following, if a copy is provided with the party's brief on the summary judgment motion: Written disclosures or disclosed documents, a discovery deposition or any part thereof with any exhibit to the part that is filed, an interrogatory and answer thereto with any exhibit made part of the answer, a request for production and the documents or things produced in response thereto, or a request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion shall be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.

■ 28. Amend § 2.128 by revising paragraphs (a)(3) and (b) to read as follows:

**§ 2.128 Briefs at final hearing.**

(a)(1) \* \* \*

(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files

a response indicating that plaintiff has lost interest in the case, judgment may be entered against plaintiff. If a plaintiff files a response to the order showing good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered against plaintiff for failure to take testimony or submit any other evidence.

(b) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit. Any brief beyond the page limits and any brief with attachments outside the stated requirements may not be considered by the Board.

■ 29. Amend § 2.129 by revising paragraphs (a) through (c) to read as follows:

**§ 2.129 Oral argument; reconsideration.**

(a) If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. Parties and members of the Board may attend in person or, at the discretion of the Board, remotely. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized

representatives. The Board may, however, deny a request to reset a hearing date for lack of good cause or if multiple requests for rescheduling have been filed.

(c) Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within twenty days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.

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■ 30. Revise § 2.130 to read as follows:

**§ 2.130 New matter suggested by the trademark examining attorney.**

If, while an inter partes proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the examining attorney, render the mark in the application unregistrable, the examining attorney should request that the Board remand the application. The Board may suspend the proceeding and remand the application to the trademark examining attorney for an ex parte determination of the question of registrability. A copy of the trademark examining attorney's final action will be furnished to the parties to the inter partes proceeding following the final determination of registrability by the trademark examining attorney or the Board on appeal. The Board will consider the application for such further inter partes action as may be appropriate.

■ 31. Revise § 2.131 read as follows:

**§ 2.131 Remand after decision in inter partes proceeding.**

If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in light of the matter referenced by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an

appeal may be taken as provided by §§ 2.141 and 2.142.

■ 32. Amend § 2.132 by revising paragraphs (a) and (b) to read as follows:

**§ 2.132 Involuntary dismissal for failure to take testimony.**

(a) If the time for taking testimony by any party in the position of plaintiff has expired and it is clear to the Board from the proceeding record that such party has not taken testimony or offered any other evidence, the Board may grant judgment for the defendant. Also, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have twenty days from the date of service of the motion to show cause why judgment should not be rendered dismissing the case. In the absence of a showing of excusable neglect, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.

(b) If no evidence other than Office records showing the current status and title of plaintiff's pleaded registration(s) is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have twenty days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all testimony periods have passed. If judgment is not rendered on the motion to dismiss, testimony periods will be reset for the party in the position of defendant and for rebuttal.

\* \* \* \* \*

■ 33. Amend § 2.134 by revising paragraph (b) to read as follows:

**§ 2.134 Surrender or voluntary cancellation of registration.**

\* \* \* \* \*

(b) After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted its involved registration to be cancelled under section 8 or section 71 of the Act of 1946, or has failed to renew

its involved registration under section 9 of the Act of 1946, or has allowed its registered extension of protection to expire under section 70(b) of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation, failure to renew, or expiration should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

■ 34. Revise § 2.136 to read as follows:

**§ 2.136 Status of application on termination of proceeding.**

After the Board has issued its decision in an opposition or concurrent use proceeding, and after the time for filing any appeal of the decision has expired, or any appeal that was filed has been decided and the Board's decision affirmed, the proceeding will be terminated by the Board. On termination of an opposition or concurrent use proceeding, if the judgment is not adverse to the applicant, the application returns to the status it had before the institution of the proceeding. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.

■ 35. Amend § 2.142 by revising paragraphs (b), (c), (d), (e), and (f)(1) through (f)(4) and (f)(6) to read as follows:

**§ 2.142 Time and manner of ex parte appeals.**

\* \* \* \* \*

(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examining attorney shall, within sixty days after the brief of appellant is sent to the examining attorney, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.

(2) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index

of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety. Unless authorized by the Board, no further briefs are permitted.

(3) Citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.

(c) All requirements made by the examining attorney and not the subject of appeal shall be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance.

(d) Evidence shall not be submitted after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney must submit a request to the Board to suspend the appeal and to remand the application for further examination.

(e)(1) If the appellant desires an oral hearing, a request should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or the appellant's attorney or other authorized representative. Appellants, examining attorneys, and members of the Board may attend in person or, at the discretion of the Board, remotely.

(2) If the appellant requests an oral argument, the examining attorney who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examining attorney as designated by a supervisory or managing attorney, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.

(3) Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examining attorney. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.

(f)(1) If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examining attorney for further examination to be completed within the time set by the Board.

(2) If the further examination does not result in an additional ground for refusal of registration, the examining attorney shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.

(3) If the further examination does result in an additional ground for refusal of registration, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. If the ground for refusal is made final, the examining attorney shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

(4) If the supplemental brief of the appellant is filed, the examining attorney shall, within sixty days after the supplemental brief of the appellant is sent to the examining attorney, file with the Board a written brief answering the supplemental brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.

\* \* \* \* \*

(6) If, during an appeal from a refusal of registration, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examining attorney may, by written request, ask the Board to suspend the appeal and to remand the application to the examining attorney for further examination. If the request is granted, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. After the additional ground for refusal of registration has been withdrawn or made final, the examining attorney shall return the application to the Board, which shall resume proceedings in the appeal and

take further appropriate action with respect thereto.

\* \* \* \* \*

■ 36. Add and reserve § 2.143 to read as follows:

**§ 2.143 [Reserved]**

■ 37. Revise § 2.145 to read as follows:

**§ 2.145 Appeal to court and civil action.**

(a) *For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.* (1) An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration by the Board before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal.

(2) In all appeals under section 21(a), the appellant must take the following steps:

(i) File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;

(ii) File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA; and

(iii) Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.

(3) *Additional requirements.* (i) The notice of appeal shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(ii) In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.

(b) *For a notice of election under section 21(a)(1) to proceed under section 21(b) of the Act.* (1) Any applicant or registrant in an ex parte case who takes an appeal to the United States Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(2) If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a

defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:

(i) File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;

(ii) File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA; and

(iii) Serve the notice of election as provided in § 2.119.

(c) *For a civil action under section 21(b) of the Act.* (1) Any person who may appeal to the United States Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. It is unnecessary to request reconsideration by the Board before filing any such civil action; however, a party requesting reconsideration must do so before filing a civil action.

(2) Any applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act must serve the summons and complaint pursuant to Rule 4(i) of the Federal Rules of Civil Procedure with the copy to the Director addressed to the Office of the General Counsel as provided in § 104.2 of this chapter. A copy of the complaint must also be filed with the Trademark Trial and Appeal Board via ESTTA.

(3) The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.

(d) *Time for appeal or civil action.* (1) *For an appeal under section 21(a).* The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. Any notice of cross-appeal is controlled by Rule 4(a)(3) of the Federal Rules of Appellate Procedure, and any other requirement imposed by the Rules of the

United States Court of Appeals for the Federal Circuit.

(2) *For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.* The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.

(3) *For a civil action under section 21(b).* A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director.

(4) *Time computation.* (i) If a request for rehearing or reconsideration or modification of the Board decision is filed within the time specified in §§ 2.127(b), 2.129(c) or 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire no later than sixty-three (63) days after action on the request.

(ii) *Holidays.* The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to § 2.196.

(e) *Extension of time.* (1) The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

(i) Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or

(ii) Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.

(2) The request must be filed as provided in § 104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.

■ 38. Amend § 2.190 by revising paragraphs (a) through (c) to read as follows:

**§ 2.190 Addresses for trademark correspondence with the United States Patent and Trademark Office.**

(a) *Trademark correspondence.* In general. All trademark-related documents filed on paper, except documents sent to the Assignment Recordation Branch for recordation;

requests for copies of trademark documents; and certain documents filed under the Madrid Protocol as specified in paragraph (e) of this section, should be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313–1451. All trademark-related documents may be delivered by hand, during the hours the Office is open to receive correspondence, to the Trademark Assistance Center, James Madison Building—East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia 22314.

(b) *Electronic trademark documents.* An applicant may transmit a trademark document through TEAS, at <http://www.uspto.gov>. Documents that relate to proceedings before the Trademark Trial and Appeal Board shall be filed directly with the Board electronically through ESTTA, at <http://estta.uspto.gov>.

(c) *Trademark Assignments.* Requests to record documents in the Assignment Recordation Branch may be filed through the Office's Web site, at <http://www.uspto.gov>. Paper documents and cover sheets to be recorded in the Assignment Recordation Branch should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313–1450. See § 3.27 of this chapter.

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■ 39. Revise § 2.191 to read as follows:

**§ 2.191 Business to be transacted in writing.**

All business with the Office should be transacted in writing. The personal appearance of applicants or their representatives at the Office is unnecessary. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. The Office encourages parties to file documents through TEAS wherever possible, or through ESTTA for documents in proceedings before the Trademark Trial and Appeal Board.

Dated: March 18, 2016.

Michelle K. Lee,

*Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office.*

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