provisions do not constitute major Federal actions within the meaning of section 102(2)(C) of the National Environmental Policy Act (42 U.S.C. 4332(2)(C)).

4. Paperwork Reduction Act

This rule does not contain information collection requirements that require approval by OMB under the Paperwork Reduction Act (44 U.S.C. 3507 *et seq.*).

5. Regulatory Flexibility Act

The Department of the Interior has determined that this rule will not have a significant economic impact on a substantial number of small entities under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*). The State submittal that is the subject of this rule is based upon counterpart Federal regulations for which an economic analysis was prepared and certification made that such regulations would not have a significant economic effect upon a substantial number of small entities. Accordingly, this rule will ensure that existing requirements previously promulgated by OSM will be implemented by the State. In making the determination as to whether this rule would have a significant economic impact, the Department relied upon the data and assumptions for the counterpart Federal regulations.

6. Unfunded Mandates

This rule will not impose a cost of $100 million or more in any given year on any governmental entity or the private sector.

List of Subjects in 30 CFR Part 934

Intergovernmental relations, Surface mining, Underground mining.

Dated: May 29, 1997.

Richard J. Seibel,

Regional Director, Western Regional Coordinating Center.

[FR Doc. 97–14728 Filed 6–4–97; 8:45 am]

BILLING CODE 4310–05–M

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 3

[Docket No. 970428100–7100–01]

RIN 0651–AA87

Miscellaneous Changes to Trademark Trial and Appeal Board Rules

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office (PTO) proposes to amend its rules governing practice before the Trademark Trial and Appeal Board (Board) to expedite inter partes proceedings. These proposed changes enlarge the time periods for discovery, testimony, and response to motions, and concomitantly limit the circumstances in which extensions may be obtained. In addition, they impose strict limitations on the number of written discovery requests which one party may serve upon another party in a proceeding. Other proposed inter partes rule amendments clarify the rules, conform the rules to current practice, simplify practice, and correct cross-references. Finally the PTO proposes to amend 37 CFR 2.76(a), 2.76(g), and 2.76(h), which affect practice in ex parte appeals to the Board, to conform these rules to current practice.

DATES: Written comments must be received on or before August 4, 1997 to ensure consideration. An oral hearing will not be conducted.

ADDRESSES: Written comments may be sent by mail addressed to Assistant Commissioner for Trademarks, Box TTAB—No Fee, 2900 Crystal Drive, Arlington, Virginia 22202–3513, marked to the attention of Ellen J. Seeherman. Written comments may also be sent by facsimile transmission to (703) 308–9333, marked to the attention of Ellen J. Seeherman. Written comments will be available for public inspection in Suite 900, on the 9th Floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia 22202–3513.

FOR FURTHER INFORMATION CONTACT: Ellen J. Seeherman, Administrative Trademark Judge, Trademark Trial and Appeal Board, by telephone at (703) 308–9300, extension 206, or by mail marked to her attention and addressed to Assistant Commissioner for Trademarks, Box TTAB—No Fee, 2900 Crystal Drive, Arlington, Virginia 22202–3513 or by facsimile transmission marked to her attention and sent to (703) 308–9333.

SUPPLEMENTARY INFORMATION: This notice of proposed rulemaking is designed to improve practice and expedite proceedings in inter partes cases before the Trademark Trial and Appeal Board (Board). In addition, the proposed amendments codify and clarify certain practices of the Board and correct certain references to citations of the Trademark Act and the Code of Federal Regulations.

The proposed amendments, and the reasons for the amendments, are discussed below.

The Board's workload has increased dramatically in the last several years because of a rapid growth in the number of inter partes and ex parte proceedings filed with the Board. Along with this increase in the number of proceedings, there has been a marked increase in the number of motions and other papers filed in each inter partes case. It appears to the Board that this proliferation of papers has been due, in large part, to the fact that in recent years, many attorneys practicing before the Board in inter partes cases have taken an increasingly aggressive approach by filing every possible motion that may be filed and by responding to every paper filed to the point of sur-reply and sur-sur-reply briefs. It also appears that some of the papers filed are part of a strategy to bury the adverse party with paper, so that it becomes too expensive for that party to proceed with the case, and the party is forced to settle or capitulate. Whatever the reason, in many cases the number of papers filed goes far beyond what is reasonably needed for a Board proceeding. The filing of these papers causes needless work and expense for the parties and the Board. Moreover, the rapid growth in the number of papers filed has caused substantial delays in all phases of the Board's work, including the resolution of motions and the final determination of proceedings.

A number of the rule amendments proposed in this notice, namely, the proposed amendments to §§ 2.120(a), 2.120(d)(1), 2.120(d)(2), 2.120(e), 2.120(h), 2.121(a)(1), 2.121(c), 2.127(a), 2.127(b), 2.127(d), and 2.127(e)(1), are designed to address these problems by changing certain Board practices relating to discovery, testimony periods, and motions. In addition, § 2.120(a) is proposed to be amended to clarify Board discovery practice in the wake of the December 1, 1993 amendments to the Federal Rules of Civil Procedure.

Other amendments proposed in this notice serve to clarify the rules, conform the rules to current Board practice, simplify practice, and correct certain cross-references in the rules. The rules affected by these proposed amendments are §§ 2.76(a), 2.76(g), 2.76(h), 2.85(e), 2.87(c), 2.101(d)(1), 2.102(d), 2.111(b), 2.111(c)(1), 2.117(a), 2.117(b), 2.119(d), 2.120(g)(1), 2.121(d), 2.122(b)(1), 2.122(d)(1), 2.123(b), 2.123(f), 2.125(c), 2.127(f), 2.134(a), and 2.146(e)(1).

Proposed Amendments Relating to Discovery

It is the experience of the Board that a large number of motions and requests are filed in connection with discovery. Many of these filings relate to repeated requests for extensions of time,

specifically, extensions of the discovery period and the time to respond to discovery requests.

Moreover, at present, the Board sets the closing date for the taking of discovery, with the date set being 90 days after the date of the initial trial order. However, discovery in Board proceedings opens at the times specified in Rules 30, 33, 34, and 36 of the Federal Rules of Civil Procedure as they read prior to the December 1, 1993 amendments to those rules. *See* ''Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings,'' 1159 TMOG 14 (February 1, 1994). Thus, interrogatories, requests for production of documents and things, and requests for admission may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition for cancellation is filed in an opposition proceeding, and after the mailing by the Board of the notice of institution in an interference or concurrent use proceeding), and upon the defendant with or after service of the complaint by the Board. Discovery depositions generally may be taken by any party after commencement of the proceeding, except that the Board's permission must be obtained first in certain specified situations. Further, the Board still follows the practice embodied in Rules 33(a), 34(b), and 36(a) of the Federal Rules of Civil Procedure, as they read prior to the December 1, 1993 amendments, that a defendant may serve responses to interrogatories, requests for production of documents and things, and requests for admission either within 30 days after service of a discovery request (35 days if service of the request for discovery is made by first-class mail, ''Express Mail,'' or overnight courier—*see* § 2.119(c)), or within 45 days after service of the complaint upon it by the Board, whichever is later. These practices relating to the opening of discovery and the time for the service of discovery responses by the defendant are complicated, and unpopular with practitioners.

In order to simplify the opening of discovery, and reduce the number of motions to extend the discovery period and the time to respond to discovery requests, it is proposed to amend § 2.120(a) to provide that the Board will specify the opening and closing dates for the taking of discovery, and that the discovery period will be set for a period of 180 days. The section is also proposed to be amended to include a provision that responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 40 days from the date of service of such discovery requests.

Because of the proposed enlargements of the discovery and response periods, it is also proposed to limit the circumstances in which extensions will be granted. Specifically, § 2.120(a) is proposed to be amended to provide that extensions of the discovery period will be granted only upon stipulation of the parties approved by the Board, while the time to respond to interrogatories, requests for production of documents and things, and requests for admission may be extended only upon stipulation of the parties or upon motion showing extraordinary circumstances granted by the Board. (The Board, of course, retains its inherent power to sua sponte reset, and thereby extend, the discovery period and response times.) In addition, the section is proposed to be amended to include a provision (now found, in somewhat different form, in § 2.121(a)(1)), that 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, and that ''the discovery period will be rescheduled only upon stipulation of the parties approved by the Board, and testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances approved by the Board.'' The quoted portion is somewhat different from its counterpart in present § 2.121(a), but is consistent with the provisions of § 2.121(a)(1) as proposed to be amended. Because of the proposed amendment of § 2.120(a) to include provisions governing discovery response periods and extensions thereof, it is believed that § 2.120(a), rather than § 2.121(a)(1), which governs the scheduling and rescheduling of testimony periods, is the most logical place for the provision now proposed to be moved.

The enlargement of the discovery period and of the time to respond to discovery requests, and the concomitant limitations on the situations in which extensions of these times will be granted, will reduce the number of extension requests filed, reduce delays in the service of discovery responses, and expedite proceedings before the Board.

Another proposed change to § 2.120(a) clarifies Board discovery practice in the wake of the December 1, 1993 amendments to the Federal Rules of Civil Procedure. Section 2.116(a) provides that, except as otherwise provided, and wherever applicable and appropriate, procedure and practice in Board inter partes proceedings shall be governed by the Federal Rules of Civil Procedure. Section 2.120(a) provides, in part, that the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference, and concurrent use registration proceedings except as otherwise provided in § 2.120; and that the opening of discovery is governed by the Federal Rules of Civil Procedure. Thus, where the Board has its own rule concerning a particular matter of practice or procedure, that rule governs; if there is no Board rule concerning the matter, the Federal Rules of Civil Procedure apply, where applicable and appropriate.

The December 1, 1993 amendments to the Federal Rules of Civil Procedure substantially changed discovery procedures in civil actions. The amended rules included provisions which, inter alia, mandated automatic disclosure, scheduling conferences, conferences to discuss settlement and to develop a plan for discovery, and transmission to the court of a written report outlining the discovery plan. Moreover, under the amended Federal Rules, the commencement of discovery hinged upon completion of the mandated discovery plan conference. The PTO concluded that the application of these provisions in inter partes proceedings before the Board would increase the complexity and cost of the proceedings and be unduly burdensome to the parties and the Board. Therefore, in a notice published in the *Official Gazette,* the Commissioner stated that these provisions were not appropriate for, and would not be applicable in, Board proceedings. *See* ''Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings,'' 1159 TMOG 14 (February 1, 1994). The Commissioner also stated that the PTO would, in due course, publish a notice of proposed rulemaking to amend, as might be necessary, the trademark rules governing practice and procedure in inter partes proceedings before the Board. Accordingly, § 2.120(a) is proposed to be amended to specify that the provisions of the Federal Rules relating to automatic disclosure, scheduling conferences, conferences to discuss settlement and to develop a discovery plan, and transmission to the court of a written report outlining the discovery plan, do not apply to Board proceedings, and that the Board will specify the opening and closing dates

for the taking of discovery. In addition, the first sentence of the section, which specifies that the provisions of the Federal Rules of Civil Procedure shall apply in opposition, cancellation, interference, and concurrent use registration proceedings, except as otherwise provided in § 2.120, is proposed to be amended to include the prefatory words ''Wherever appropriate.'' The proposed amendment is consistent with an analogous provision in § 2.116(a), and makes it clear that even when there is no provision in § 2.120 relating to a particular discovery matter, the provisions of the Federal Rules of Civil Procedure relating to that matter apply only if they are appropriate for Board proceedings.

Another of the proposed amendments to § 2.120(a) would require that interrogatories, requests for production of documents and things, and requests for admission be served in sufficient time for responses to fall due prior to the close of the discovery period, and that discovery depositions be noticed and taken prior to the close of the discovery period. It is believed that the proposed 180-day discovery period will allow more than sufficient time for the service of discovery requests to be made early enough in the discovery period so that responses to such requests will fall due prior to the close of discovery. Moreover, as indicated hereafter, § 2.120(e) is proposed to be amended to provide that a motion to compel discovery must be filed within 30 days after the close of the discovery period, as originally set or as reset. The proposed requirement that discovery requests be served in sufficient time for responses to fall due prior to the close of discovery will enable the propounding party to file a motion to compel, if such a motion is deemed necessary, within 30 days after the close of the discovery period. Litigants should note that if they agree to an extension of time to respond to discovery requests, such that the responses would be due shortly before or after the due date for any motion to compel, then they should also stipulate to reschedule the closing date of the discovery period, if the propounding party wishes to preserve its time to file a motion to compel.

The Board has observed that parties misuse the discovery process for purposes of harassing their adversaries, resulting in numerous motions to compel and motions for protective orders. Section 2.120(d) was amended effective November 16, 1989, to restrict to 75 (counting subparts) the total number of interrogatories a party may serve, in a proceeding, upon another party. The final rule notice was published in the **Federal Register** on August 22, 1989, at 54 FR 34886 and in the *Patent and Trademark Office Official Gazette* of September 12, 1989, at 1106 TMOG 26. It is the Board's experience that, despite that limitation, parties continue to serve interrogatories, as well as other written discovery requests, which are irrelevant, unnecessary, and/or harassing. In view thereof, and given the restricted scope of Board proceedings, and the availability of the discovery deposition as an alternate and/or additional discovery device, it is the Board's belief that the total number of discovery requests which one party may serve upon another party in a proceeding should be limited to 25 interrogatories (counting subparts), 15 requests for production of documents and things (counting subparts), and 25 requests for admission (counting subparts). Sections 2.120(d)(1), 2.120(d)(2), and 2.120(h) are proposed to be amended to state such limitations. Moreover, because it is believed that 25 interrogatories are an adequate number for a proceeding before the Board, the motion procedure for obtaining leave to serve interrogatories in excess of the limit set forth in § 2.120(d)(1) is proposed to be deleted. Similarly, no such procedure is proposed to be provided for requests for production of documents and things and requests for admission. The provisions proposed to be added to §§ 2.120(d)(2) and 2.120(f), including provisions governing the action which may be taken by a party served with discovery requests which it believes to be excessive in number, parallel those of § 2.120(d)(1), as proposed to be amended. It is believed that the proposed limitations on the number of interrogatories, document production requests, and requests for admission that may be served will reduce the number of motions to compel filed, since the parties presumably will use the more limited number of discovery requests for only relevant and appropriate inquiries, and not for purposes of harassment. A reduction in the number of motions to compel filed will serve to expedite proceedings.

The first sentence of § 2.120(h), which provides that requests for admission shall be governed by Rule 36 of the Federal Rules of Civil Procedure, except that the Board does not have authority to award any expenses to any party, is proposed to be deleted. The sentence suggests that the only provision in Federal Rule 36 which does not apply in Board proceedings is that pertaining to the awarding of expenses. However, there are also other provisions in Rule 36 which do not apply in Board proceedings. For example, the provision of Rule 36(a), that without leave of court or written stipulation, requests for admission may not be served before the time specified in Rule 26(d) of the Federal Rules of Civil Procedure, is not applicable in Board proceedings. *See* ''Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure in Trademark Trial and Appeal Board Inter Partes Proceedings,'' *supra*. Moreover, § 2.120(a), as proposed to be amended, specifies that wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference, and concurrent use registration proceedings, except as otherwise provided in § 2.120. Further, §§ 2.120(g)(1) and 2.127(f), as proposed to be amended, provide that the Board will not hold any person in contempt or award any expenses to any party. Accordingly, the first sentence of § 2.120(h) is proposed to be deleted because it is redundant and confusing.

Section 2.120(h) is also proposed to be amended to provide that a motion to test the sufficiency of an answer or objection to a request for admission must be filed within 30 days after the close of the discovery period, as originally set or as reset. In addition, the section is proposed to be amended to specify that when a party files a motion to test the sufficiency of an answer or objection to a request for admission, the case will be suspended by the 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 specified in the Board's suspension order. These proposed provisions correspond to similar provisions proposed to be added to § 2.120(e), which governs motions to compel discovery. It is the intention of the Board, when setting trial dates in cases arising under these rules as proposed to be amended, to schedule an interval of 60 days between the closing date of the discovery period and the opening date of the first testimony period. The motion to compel and the motion to test the sufficiency of an answer or objection to a request for admission deal with pre-trial matters and should, therefore, be filed and determined prior to trial. The proposed provisions governing the time for filing these motions and the suspension of proceedings pending the determination thereof, coupled with the Board's intention to schedule an interval of 60 days between the close of the discovery period and the opening of the first

testimony period, will provide for a more orderly administration of the proceeding and allow parties more certainty in scheduling testimony. Moreover, the proposed amendment to § 2.120(a) to set the discovery period for 180 days, and to require that discovery requests be served in sufficient time for responses to the requests to fall due prior to the close of the discovery period, will enable the propounding party to file a motion to compel or a motion to test the sufficiency of an answer or objection to a request for admission, if such a motion is deemed necessary, within 30 days after the close of the discovery period.

Section 2.120(h) is proposed to be further amended to provide that 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 respond to any outstanding discovery requests or to appear for any noticed deposition. The proposed provision corresponds to similar provisions proposed to be added to § 2.120(e), with respect to motions to compel, and to § 2.127(d), with respect to motions for summary judgment, and is explained in greater detail in our discussion of the proposed amendments to the latter rule.

Finally, because of the length and complexity of § 2.120(h), as proposed to be amended, the present paragraph is proposed to be redesignated as (h)(2) and revised; the provisions governing the proposed limitation on the number of requests for admission which may be served by one party upon another are proposed to be included in a new paragraph designated (h)(1); and the proposed provisions relating to the suspension of proceedings when a motion to test the sufficiency of an answer or objection to a request for admission is filed are proposed to be included in a new paragraph designated (h)(3).

Section 2.120(e) is proposed to be amended to provide that a motion to compel discovery must be filed within 30 days after the close of the discovery period, as originally set or as reset; that when a party files a motion to compel discovery, the case will be suspended by the 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 specified in the Board's suspension order; and that the filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. These proposed provisions correspond to similar provisions proposed to be added to § 2.120(h). The latter proposed provision also corresponds to a similar provision proposed to be added to § 2.127(d) and is explained in greater detail in our discussion of the proposed amendments to that rule.

Proposed Amendments Relating to Testimony Periods

It has come to the attention of the Board that trial is sometimes delayed because an adverse party feels compelled to stipulate to reschedule or extend testimony periods, knowing that to oppose such a request and await the Board's decision on the contested motion will create a greater delay than if the party were to consent to the rescheduling or extension. In order to remedy this problem, the third sentences in §§ 2.121(a)(1) and 2.121(c) are proposed to be amended to provide that testimony periods may be rescheduled (§ 2.121(a)(1)), or extended (§ 2.121(c)), only by stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board, and that if such a motion is denied, the testimony periods will remain as set. At the same time, § 2.121(c) is proposed to be amended to lengthen the testimony period for the plaintiff and defendant to present their cases in chief from 30 to 60 days, and to lengthen the period for the plaintiff to present evidence in rebuttal from 15 to 30 days. The enlargement of testimony periods should, in general, eliminate the number of extension requests filed by parties and expedite the disposition of proceedings. Moreover, the enlargement of the testimony periods should lessen any inconvenience to the parties from the elimination of the ''good cause'' standard for obtaining extensions of time.

Those portions of §§ 2.121(a)(1) and 2.121(c) which refer to the rescheduling or extension of testimony periods ''by order of the Board'' are proposed to be deleted to clarify that a party may not simply make a motion that the Board order the resetting of testimony periods. That is, parties may move to reschedule or extend testimony periods only upon consent, or upon motion showing extraordinary circumstances. The Board still retains its authority to sua sponte reschedule or extend testimony periods.

As indicated above, under the heading ''Proposed Amendments Relating to Discovery,'' the last sentence of § 2.121(a)(1), which now provides that 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, and that 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, is proposed to be moved to the end of § 2.120(a), as proposed to be amended. It is believed that § 2.120(a), as proposed to be amended, is the most logical place for this sentence. In addition, the latter part of the sentence is proposed to be revised to read ''the discovery period will be rescheduled only upon stipulation of the parties approved by the Board, and testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.'' The proposed revision of the latter part of the sentence is consistent with the third sentence of § 2.121(a)(1), as proposed to be amended.

Proposed Amendments Relating to Motion Practice

Section 2.127(a) is proposed to be amended to clarify Board practice with respect to the filing of reply briefs and additional papers in support of or in opposition to motions. The rule as now written makes no reference to such papers. As a result, parties often file reply briefs on motions, sur-reply briefs, responses to sur-reply briefs, and motions for leave to file, as well as motions to strike, such papers. It has been the Board's experience that reply briefs may be helpful in deciding a motion, but that additional papers generally consist of reargument. Moreover, the filing of such additional papers often escalates as each party wishes to have the last word. The result is needless expense to the parties, additional work for the Board, and delays in rendering decisions. Accordingly, the rule is proposed to be amended to provide for the filing of a reply brief, if desired, within 15 days from the date of service of the brief in response to the motion; and to specify that the time for filing a reply brief will not be extended, and that additional papers in support of or in opposition to a motion will be given no consideration. The proposed time limit for the filing of a reply brief on a motion applies to all types of motions except motions for summary judgment. Section 2.127(e)(1), which governs the time for filing a motion for summary judgment, is proposed to be amended, as indicated hereafter, to allow 30 days for this purpose in the case of a reply brief on a motion for summary judgment.

Section 2.127(a) is also proposed to be amended to enlarge the time for responding to a motion from 15 to 30

days. The proposed time limit applies to all types of motions except motions for summary judgment. Section 2.127(e)(1) is proposed to be amended to allow 60 days for the filing of a brief in response to a motion for summary judgment.

Concomitantly, § 2.127(a) is proposed to be amended to provide that extensions of time for filing a brief in opposition to a motion will be granted only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board, and that, ''if such a motion for an extension is denied, the time for responding to the motion remains as specified under this section.'' A similar provision is proposed to be included in § 2.127(e)(1) regarding extensions of time for filing a brief in opposition to a motion for summary judgment. It is believed that 30 days (or 60 days in the case of a summary judgment motion) is a sufficient time to respond to a motion. Moreover, this enlargement of the response time, coupled with the requirement that extension requests be made with consent or show extraordinary circumstances, and the accompanying provision leaving the time for responding to a motion unchanged if a motion to extend is denied, will reduce the number of extension requests filed, expedite the disposition of proceedings, and prevent parties from using the delays inherent in the filing and deciding of motions to enlarge their time to respond to motions.

Section 2.127(a) is proposed to be further amended to impose a page limit for briefs and reply briefs on motions, namely, 25 pages for briefs in support of and in opposition to motions, and 10 pages for reply briefs, and to specify form requirements for such briefs. It is believed that the proposed page limitations are more than sufficient for parties to adequately argue motions in proceedings before the Board.

Section 2.127(b) is proposed to be amended to change the specification of the time period for filing a request for reconsideration or modification of an order or decision on a motion from ''thirty days'' to ''one month.'' The proposed amendment conforms the time period with that specified in § 2.129(c), which governs requests for reconsideration or modification of a decision after final hearing.

Certain modifications are proposed to be made to the rules governing summary judgment motions. It appears that in some cases, parties that have been served with discovery requests, and know that it is Board policy to suspend proceedings once a summary judgment motion has been filed, move for summary judgment in an effort to avoid having to make timely response to the discovery requests. Accordingly, the PTO proposes to amend § 2.127(d), which concerns suspension of proceedings when a potentially dispositive motion has been filed, to specify that the filing of a summary judgment motion shall not toll the time for the moving party to respond to any outstanding discovery requests or to appear at a noticed discovery deposition, but that it shall toll the time for the nonmoving party to respond to outstanding discovery requests or to appear at a noticed deposition. The nonmoving party's time to respond is proposed to be tolled because a party which files a motion for summary judgment is, by its motion, asserting that it needs no further evidence to demonstrate that it is entitled to judgment. The proposed amendment will eliminate the noted abuse of the summary judgment procedure. Moreover, it may also reduce the number of motions for discovery filed pursuant to Rule 56(f) of the Federal Rules of Civil Procedure because parties opposing motions for summary judgment will be able to receive responses to outstanding discovery requests prior to the time for responding to the summary judgment motion.

The first sentence of § 2.127(d), which provides, in essence, that when any party files a potentially dispositive motion, the case will be suspended by the Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane thereto, is proposed to be amended by adding to the end thereof the phrase ''except as otherwise specified in the Board's suspension order.'' The proposed amendment clarifies the rule.

Section 2.127(e)(1), which governs the time for filing a motion for summary judgment, is proposed to be amended to specify that a motion for summary judgment may not be filed until notification of the proceeding has been sent to the parties by the Board. This proposed amendment codifies current Board practice, as set forth in *Nabisco Brands Inc.* v. *Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993). In Board opposition and cancellation proceedings, as under the Federal Rules, the proceeding commences with the filing of the complaint, i.e., the notice of opposition or the petition for cancellation. *See* §§ 2.101(a) and 2.111(a). However, in Board proceedings, formal service of the complaint upon the defendant is made by the Board, not by the plaintiff. Further, the Board does not serve the complaint upon the defendant until after the Board has first examined the complaint to determine whether it has been filed in proper form, with the required fee, and, then, if so, has (1) obtained the application or registration file which is the subject of the proceeding, (2) set up a proceeding file with an assigned proceeding number, and (3) entered information concerning the proceeding in the electronic records of the PTO. Thus, there is a time gap between the filing of a notice of opposition or petition for cancellation and the issuance of the Board's action notifying the defendant of the filing of the proceeding, notifying both parties of the institution of the proceeding, and forwarding a copy of the complaint to defendant. Although a plaintiff may send a courtesy copy of the complaint to the defendant, the defendant does not know that the complaint has been filed in proper form, and that the proceeding has been instituted by the Board, unless and until it receives from the Board the notice of institution along with a copy of the complaint. Accordingly, the Board considers a motion for summary judgment filed prior to the issuance of the notice of institution to be premature. Moreover, the filing of a motion for summary judgment prior to the Board's formal institution of the proceeding may cause administrative difficulties for the Board, particularly where the Board has not yet assigned a proceeding number to the case.

Section 2.127(e)(1) is proposed to be further amended to add new provisions governing the time for filing papers in response to a motion for summary judgment, as well as the time for filing a reply brief thereon. Specifically, the section is proposed to be amended to provide that a motion under Rule 56(f) of the Federal Rules of Civil Procedure (that is, a motion by the nonmoving party for discovery necessary to enable it to respond to the motion for summary judgment), if filed, shall be filed within 30 days from the date of service of the motion for summary judgment; that the time for filing a Rule 56(f) motion will not be extended; that if no Rule 56(f) motion is filed, a brief in response to the motion for summary judgment shall be filed within 60 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 showing extraordinary circumstances granted by the Board; that, if such a motion for an extension is denied, the time for responding to the motion for summary judgment will remain as specified in the section; that a reply brief, if filed, shall be filed within 30

days from the date of service of the brief in response to the motion; that the time for filing a reply brief will not be extended; and that no further papers in support of or in opposition to a motion for summary judgment will be considered by the Board. With two exceptions, these proposed provisions parallel certain of the provisions of § 2.127(a), as proposed to be amended. The first exception is the provision relating to a Rule 56(f) motion. No parallel provision is proposed to be included in § 2.127(a) because a Rule 56(f) motion may be filed only in response to a motion for summary judgment, and § 2.127(a) contains provisions relating to the filing of motions in general. The second exception is the length of time proposed to be allowed for filing a brief in response to a motion for summary judgment, and for filing a reply brief. These proposed times are 60 days and 30 days, respectively. In the case of other types of motions, the times proposed in § 2.127(a) are 30 days and 15 days. The additional time is proposed to be allowed in the case of summary judgment motions because the gathering of evidence to respond to such a motion, or to support a reply brief, is time-consuming, and because the summary judgment motion is potentially dispositive in nature. It is believed that 60 days is a sufficient time to respond to a motion for summary judgment, and that this enlargement of the response time, coupled with the requirement that extension requests be made with consent or show extraordinary circumstances, and the accompanying provision leaving the time for responding to the summary judgment motion unchanged if a motion to extend is denied, will reduce the number of extension requests filed, and expedite the disposition of proceedings.

Corrections of Cross-References

Sections 2.101(d)(1), 2.111(c)(1), 2.122(d)(1) and 3.41, as now written, all contain cross-references to subsections of § 2.6. Subsections of § 2.6 were renumbered by a notice of final rulemaking published in the **Federal Register** on December 24, 1991, at 56 FR 66670 (amended at 57 FR 38196, August 21, 1992) and in the *Official Gazette* on December 24, 1991, at 1133 TMOG 61 (amended at 1141 TMOG 40, August 18, 1992). Accordingly, these sections are proposed to be amended to correct the cross-references to subsections of § 2.6.

Section 2.111(b) is proposed to be amended to correct cross-references to subsections of Section 14 of the Trademark Act, 15 U.S.C. 1064. The subsections were renumbered by the Trademark Law Revision Act of 1988 (Title 1 of Pub. L. 100–667, 102 Stat. 3935 (15 U.S.C. 1051)).

Section 2.119(d), which governs the appointment of domestic representatives by foreign parties involved in inter partes proceedings before the Board, provides, in pertinent part, that the mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding ''unless qualified under § 10.14(a), or qualified under paragraph (b) or (c) of § 10.14 and authorized under § 2.17(b).'' The section is proposed to be amended to delete the reference to domestic representatives who are qualified under § 10.14(c). As indicated in § 2.119(d), a domestic representative must be a person ''resident in the United States.'' Persons who are qualified under § 10.14(c) are not residents of the United States and therefore cannot be domestic representatives.

Section 2.134(a) is proposed to be amended to correct the cross-reference to Section 7(d) of the Act of 1946. That section of the Act was renumbered as ''7(e)'' by the Trademark Law Revision Act of 1988.

Other Proposed Amendments

Section 2.76(a) now provides, in pertinent part, that an application under § 1(b) of the Act (i.e., an intent-to-use application) may be amended to allege use of the mark in commerce under § 1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication or the date of expiration of the six-month period after issuance of a final action; and that thereafter, an allegation of use may be submitted only as a statement of use after issuance of a notice of allowance. The section is proposed to be amended to eliminate the time limit for filing an amendment to allege use after issuance of a final action.

The purpose of the time limit for filing an amendment to allege use after issuance of a final action was to avoid the submission of extraneous papers which would disrupt the appeal process. However, the time limit had a detrimental effect not foreseen by the PTO. In many instances, where an intent-to-use application was on appeal from a final refusal on the ground of mere descriptiveness, for example, and no acceptable amendment to allege use had yet been filed, the owner of the application would seek, after the expiration of the six-month period following issuance of the final refusal, to overcome the refusal to register by amending its application to the Supplemental Register. However, an intent-to-use application cannot be amended to the Supplemental Register until an acceptable amendment to allege use or a statement of use has been filed. See 37 CFR § 2.75(b). Thus, although an amendment to the Supplemental Register might have obviated the refusal of registration, such an amendment could not be approved because the intent-to-use applicant was prohibited by the time limit of § 2.76(a) from contemporaneously filing an amendment to allege use.

In order to remedy the situation, the Assistant Commissioner for Trademarks, by notice published in the *Official Gazette,* waived the portion of § 2.76(a) which prohibited the filing of an amendment to allege use more than six months after issuance of a final refusal. *See* ''Waiver of Trademark Rule 2.76(a),'' 1156 TMOG 12 (November 2, 1993). The proposed rule change merely incorporates in the rule the more liberal practice set forth in the *Official Gazette* notice.

Similarly, § 2.76(g), which concerns the correction of an amendment to allege use which does not meet the minimum requirements for such an amendment, and § 2.76(h), which concerns withdrawal of an amendment to allege use, are proposed to be amended to delete the ''expiration of the six-month response period after issuance of a final action'' time limit.

Section 2.85(e) specifies the consequences for the payment of an insufficient fee, with respect to an application or registration having multiple classes, for certain types of filings, including a petition for cancellation. The section is proposed to be amended to delete the reference to an insufficient fee for a petition for cancellation, because this situation is covered, in greater detail, by § 2.111(c)(1). Further, in view of this proposed amendment, § 2.111(c)(1) is proposed to be amended to delete the cross-reference to § 2.85(e).

Section 2.87(c), which now provides, in pertinent part, that a request to divide an application may be filed during an opposition, upon motion granted by the Board, is proposed to be amended to also specify that a request to divide may be filed during a concurrent use or an interference proceeding, upon motion granted by the Board. The proposed change corrects an oversight in the rule and codifies current Office practice.

Section 2.102(d) now provides that a party filing a request for an extension of time to oppose must submit an original plus two copies. The section is proposed to be amended to eliminate the requirement for the filing of the

''original'' and two copies, and substitute a requirement that the request be submitted in triplicate. The Board has no need for an original, and the proposed change codifies current Office practice.

Section 2.117(a), as now written, provides that, when parties to a case pending before the Board are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action. The section is proposed to be amended to codify the Board's current policy of suspending proceedings whenever either or both of the parties are involved in a civil action or Board proceeding which may have a bearing on the proceeding.

Section 2.117(b) now provides that when there is pending, at the time when the question of suspension of proceedings is raised, a motion which is potentially dispositive of the case, the motion may be decided before the question of suspension is considered. The section is proposed to be amended to clarify that the Board may decide the potentially dispositive motion before the question of suspension is considered, regardless of the order in which they were raised. The proposed change codifies current Office practice.

Section 2.120(g)(1), which governs the imposition of sanctions when a party fails to comply with an order of the Board relating to discovery, now includes the phrase ''the Board does not have authority to hold any person in contempt or to award any expenses to any party.'' The phrase is proposed to be amended to read ''the Board will not hold any person in contempt or award any expenses to any party.'' The Board has long taken the position that it does not have authority to award expenses or attorney fees. *See MacMillan Bloedel Ltd.* v. *Arrow-M Corp.,* 203 USPQ 952, 954 (TTAB 1979); *Fisons Ltd.* v. *Capability Brown Ltd.,* 209 USPQ 167, 171 (TTAB 1980); *Anheuser-Busch, Inc.* v. *Major Mud & Chemical Co.,* 221 USPQ 1191, 1195 n. 9 (TTAB 1984); *Luehrmann* v. *Kwik Kopy Corp.,* 2 USPQ2d 1303, 1305 n.4 (TTAB 1987); *Fort Howard Paper Co.* v. *G.V. Gambina Inc.,* 4 USPQ2d 1552, 1554 (TTAB 1987); *Nabisco Brands Inc.* v. *Keebler Co.,* 28 USPQ2d 1237, 1238 (TTAB 1993). *Cf. Driscoll* v. *Cebalo,* 5 USPQ2d 1477, 1481 (Bd. Pat. Int. 1982), *aff'd in part, rev'd in part,* 731 F.2d 878, 221 USPQ 745 (Fed. Cir. 1984); *Clevenger* v. Martin, 1 USPQ2d 1793, 1797 (Bd. Pat. App. & Int. 1986). However, in 1995 the PTO, by final rule notice published in the **Federal Register** of March 17, 1995, at 60 FR 14488, and in the *Official Gazette* of April 11, 1995, at 1173 TMOG 36, amended Patent Rule 1.616, 37 CFR § 1.616, which concerns the imposition of sanctions in proceedings before the Board of Patent Appeals and Interferences (Patent Board), to provide for the imposition of a sanction in the form of compensatory expenses and/or compensatory attorney fees. 37 CFR 1.616(a)(5) and 1.616(b). The notice of final rulemaking acknowledged the foregoing decisions but concluded, based on a detailed analysis of the Commissioner's authority to issue regulations imposing sanctions, that the Commissioner has the authority to promulgate a rule authorizing imposition of compensatory monetary sanctions. It is believed that the adoption of a rule authorizing the Board to impose a sanction in the form of compensatory expenses and/or compensatory attorney fees would result in an increase in the number of papers and motions filed in proceedings before the Board. In view thereof, and in order to harmonize § 2.120(g)(1) with § 1.616, § 2.120(g)(1) is proposed to be amended to substitute a statement that the Board ''will not'' hold any person in contempt or award any expenses to any party, for the statement that the Board ''does not have authority'' to hold any person in contempt or award any expenses to any party. Section 2.127(f), which now states in pertinent part that the Board ''does not have authority to hold any person in contempt, or to award attorneys' fees or other expenses to any party,'' is proposed to be amended in the same manner.

Section 2.121(d), which now requires that a stipulation or consented motion for the rescheduling of testimony periods or of the closing date for discovery be submitted in one original and as many photocopies as there are parties, is proposed to be amended to eliminate the requirement that parties file the ''original'' as well as copies of stipulations and consented motions. Instead, the proposed rule requires that the stipulation or consented motion be submitted in a number of copies equal to the number of parties to the proceeding plus one copy for the Board. The Board has no need for an original, and the proposed change codifies current Office practice.

Section 2.122(b)(1), which now provides, in pertinent part, that the file of each application or registration specified in ''a declaration of interference'' forms part of the record of the proceeding without any action by the parties, is proposed to be amended to clarify the rule by substituting the word ''notice'' for the word ''declaration.'' A declaration of an interference is issued by the Commissioner upon the granting of a petition filed pursuant to § 2.91. An interference proceeding declared by the Commissioner does not commence until the Examining Attorney has determined that all of the subject marks are registrable; all of the marks have been published in the *Official Gazette* for opposition; and the Board mails a ''notice of interference'' notifying the parties that the interference proceeding is thereby instituted. In the interim between the Commissioner's declaration of an interference and the institution of the proceeding by the Board, some of the applications mentioned in the declaration of interference may become abandoned for one reason or another. When the Board institutes the proceeding, it is only the surviving applications which are specified in the notice of interference, and it is only those application files which form part of the record of the proceeding without any action by the parties.

Section 2.123(b) now provides, in pertinent part, that by agreement of the parties, the testimony of any witness may be submitted in the form of an affidavit by that witness, and that the parties may stipulate what a particular witness would testify to if called, or may stipulate the facts in the case. The section is proposed to be amended to clarify that such agreement or stipulation must be in writing.

Section 2.123(f) now provides, in pertinent part, that the officer certifying a testimony deposition shall, without delay, forward the evidence, notices, and paper exhibits to the Commissioner of Patents and Trademarks. This section is proposed to be amended to state that either the officer or the party taking the testimony deposition, or its attorney or other authorized representative, should forward this material to the Commissioner. The proposed amendment makes it clear that once the officer has certified the deposition, sealed the evidence in an envelope or package, and inscribed thereon a certificate giving the number and title of the case, the name of each witness, and the date of sealing, either the officer or the party taking the deposition, or its attorney or other authorized representative, may file the deposition. That is, if the officer sends the envelope or package to the party taking the deposition, or to its attorney or other authorized representative, the party, or its attorney or other authorized representative, need not return the envelope or package to the officer for filing with the PTO, but rather may send it directly to the PTO. Concomitant with this proposed amendment, the title of

§ 2.123(f), which now reads ''Certification and filing by officer,'' is proposed to be amended to read ''Certification and filing of deposition.''

Section 2.123(f) is proposed to be further amended to eliminate the present requirement that the material be forwarded to the Commissioner of Patents and Trademarks ''without delay.'' The proposed amendment conforms the section to current Board practice. While the Board prefers that testimony depositions be submitted promptly, and such depositions are normally filed with the Board at the same time that they are served on the adverse party or parties to the proceeding, it is Board practice to accept transcripts of testimony depositions at any time prior to the rendering of a final decision on the case. The proposed amendment does not affect the requirement of § 2.125(a) that one copy of the testimony transcript, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, be served on each adverse party within thirty days after completion of the taking of that testimony.

Similarly, § 2.125(c), which now provides that certified transcripts of testimony depositions, and exhibits thereto, are to be filed promptly with the Board, is proposed to be amended to delete the requirement for prompt filing with the Board. The proposed amendment conforms the section to current Board practice.

Section 2.127(f) now provides, in part, that the Board ''does not have authority'' to hold any person in contempt, or to award attorneys' fees or other expenses to any party. The rule is proposed to be amended to provide instead that the Board ''will not'' hold any person in contempt, or award attorneys' fees or other expenses to any party. This proposed provision corresponds to a similar provision in § 2.120(g)(1), as proposed to be amended, and is explained in more detail in our discussion of § 2.120(g)(1) above, under this same heading.

Section 2.146(e)(1), as now written, provides for the filing of a petition to the Commissioner from the denial of a request for an extension of time to file a notice of opposition. This section is proposed to be amended to provide also that an applicant may petition the Commissioner from a decision granting such a request. The proposed amendment codifies current practice and clarifies the rule.

Discussion of Specific Rules

Section 2.76(a) now provides, in relevant part, that an amendment to allege use may be filed in an application under Section 1(b) of the Act ''at any time between the filing of the application and the date the examiner approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action.'' The section is proposed to be amended to delete the phrase ''or the date of expiration of the six-month response period after issuance of a final action.'' The proposed amendment reflects current practice, as stated in ''Waiver of Trademark Rule 2.76(a),'' 1156 TMOG 12 (November 2, 1993).

Section 2.76(g) provides, in relevant part, that if an amendment to allege use does not meet the minimum requirements specified in § 2.76(e), the deficiency may be corrected provided the mark has not been approved for publication or the six-month response period after issuance of a final action has not expired; and that if an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication or prior to expiration of the six-month response period after issuance of a final action, the amendment will not be examined. The section is proposed to be amended to delete the phrases ''or the six-month response period after issuance of a final action has not expired'' and ''or prior to the expiration of the six-month response period after issuance of a final action.'' The proposed amendment reflects current practice.

Section 2.76(h), which provides that an amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication or expiration of the six-month response period after issuance of a final action, is proposed to be amended to delete the phrase ''or expiration of the six-month response period after issuance of a final action.'' The proposed amendment reflects current practice.

Section 2.85(e) pertains to the filing of certain specified papers, including a petition for cancellation, with a fee which is insufficient because multiple classes in an application or registration are involved. The section is proposed to be amended to delete the references to a petition for cancellation, because the matter of an insufficient fee for a petition to cancel a registration having multiple classes is covered, in greater detail, in § 2.111(c)(1).

Section 2.87(c), which specifies that a request to divide an application may be filed, inter alia, ''during an opposition, upon motion granted by the Trademark Trial and Appeal Board,'' is proposed to be amended to insert, after the words ''during an opposition,'' the additional words ''or concurrent use or interference proceeding.'' The proposed amendment codifies current practice and corrects an oversight in the rule.

Section 2.101(d)(1), which now includes a cross-reference to ''§ 2.6(1),'' is proposed to be amended to correct the cross-reference to ''§ 2.6(a)(17).''

Section 2.102(d), which now provides that every request to extend the time for filing a notice of opposition should be submitted ''in triplicate (original plus two copies),'' is proposed to be amended to delete the words ''(original plus two copies).'' The proposed amendment eliminates the requirement to file ''original'' extension of time requests. The Board has no need for the original.

Section 2.111(b), which now includes a cross-reference to ''section 14(c) or (e)'' of the Act, is proposed to be amended to correct the cross-reference to ''section 14(3) or (5)''. The subsections of Section 14 of the Act were renumbered by the Trademark Law Revision Act of 1988.

Section 2.111(c)(1), which now includes a cross-reference to ''§ § 2.6(1) and 2.85(e),'' is proposed to be amended to correct the first cross-reference to § 2.6(a)(16) and to delete the cross-reference to § 2.85(e).

Section 2.117(a) now provides that whenever it shall come to the attention of the Board ''that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action.'' The section is proposed to be amended to insert the words ''a party or'' before the word ''parties,'' insert the words ''or a Board proceeding'' after the first appearance of the words ''civil action,'' and substitute the words ''have a bearing on'' for the words ''be dispositive of.'' The proposed amendments clarify the rule and codify current practice.

Section 2.117(b) now provides that ''Whenever there is pending, at the time when the question of the suspension of proceedings is raised, a motion which is potentially dispositive of the case, the motion may be decided before the question of suspension is considered.'' The section is proposed to be amended to read ''Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered, regardless of the order in which the motions were filed.'' The proposed amendment clarifies the rule and codifies current practice.

Section 2.119(d) provides, in pertinent part, that the mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under paragraphs (b) or (c) of § 10.14(c) and authorized under § 2.17(b). The section is proposed to be amended to delete the reference to § 10.14(c). That section refers to nonresidents, who cannot be domestic representatives. The proposed amendment corrects an inadvertent error in the rule.

Section 2.120(a) now provides that the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference, and concurrent use registration proceedings except as otherwise provided in § 2.120; that the Board will specify the closing date for the taking of discovery; and that the opening of discovery is governed by the Federal Rules of Civil Procedure. The section is proposed to be amended to (1) preface the first sentence with the qualifying words ''Wherever appropriate, the''; (2) include a new sentence stating that the provisions of the Federal Rules of Civil Procedure relating to automatic disclosure scheduling conferences, conferences to discuss settlement and to develop a discovery plan, and transmission to the court of a written report outlining the discovery plan, are not applicable to Board proceedings; (3) state that the Board will specify the opening (as well as the closing) date for the taking of discovery; (4) delete the provision that the opening of discovery is governed by the Federal Rules of Civil Procedure; (5) specify that the discovery period will be set for a period of 180 days; (6) provide that interrogatories, requests for production of documents and things, and requests for admission must be served in sufficient time that responses will fall due prior to the close of the discovery period, and that discovery depositions must be noticed and taken prior to the close of the discovery period; (7) specify that extensions of the discovery period will be granted only upon stipulation of the parties approved by the Board, and that the parties may stipulate to a shortening of the discovery period; (8) provide that responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 40 days from the date of service of such discovery requests; (9) specify that the time to respond may be extended upon stipulation of the parties, or upon motion showing extraordinary circumstances approved by the Board; and (10) provide that 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, and that the discovery period will be rescheduled only upon stipulation of the parties approved by the Board, and testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.

Section 2.120(d)(1) now provides, in pertinent part, that 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 75, counting subparts, except that the Board, in its discretion, may allow additional interrogatories upon motion showing good cause, or upon stipulation of the parties; and that a motion for leave to file additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories, and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. The section is proposed to be amended to lower the interrogatory number limit from 75, counting subparts, to 25, counting subparts, and to delete the references to a motion for leave to serve additional interrogatories. However, the provision allowing additional interrogatories upon stipulation of the parties is proposed to be retained.

Section 2.120(d)(2), which now includes only a provision concerning the place for production of documents and things, is proposed to be amended to limit the number of requests for production of documents and things which a party may serve upon another party, in a proceeding, to 15, counting subparts. Specifically, the section is proposed to be amended to include new sentences providing that the total number of requests for production of documents and things 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 15, counting subparts, except upon stipulation of the parties; that if a party upon which requests for production of documents and things have been served believes that the number of requests served exceeds the limitation specified in the 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, serve a general objection on the ground of their excessive number; and that 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 requests which together are said to exceed the limitation, and must otherwise comply with the requirements of § 2.120(e). These proposed provisions parallel the provisions of § 2.120(d)(1), which limit the number of interrogatories which a party may serve upon another party in a proceeding.

Section 2.120(e), which governs motions to compel discovery, is proposed to be amended by redesignating the present paragraph as (e)(1), and amending that paragraph to insert, after the first sentence, a new sentence specifying that a motion to compel must be filed within 30 days after the close of the discovery period, as originally set or as reset. In addition, § 2.120(e) is proposed to be amended to include a new paragraph, designated (e)(2), specifying that when a party files a motion for an order to compel discovery, the case will be suspended by the 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 specified in the Board's suspension letter. The proposed new paragraph also provides that the filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

Section 2.120(g)(1), which now states, in pertinent part, that ''the Board does not have authority to hold any person in contempt or to award any expenses to any party,'' is proposed to be amended to state that ''the Board will not hold any person in contempt or award any expenses to any party.''

Section 2.120(h), which concerns requests for admission, is proposed to be amended to redesignate the present paragraph as (h)(2); delete the first sentence, which reads ''Requests for admissions shall be governed by Rule 36 of the Federal Rules of Civil Procedure except that the Trademark Trial and Appeal Board does not have authority to award any expenses to any party.''; add to the beginning a new sentence reading ''Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed within 30 days after the close of the discovery period, as originally set or as reset.''; and revise the beginning of the second sentence, which now reads, ''A motion by a party to determine the sufficiency of an answer or objection to a request made

by that party for an admission shall * * *,'' to read ''The motion shall * * *.'' The section is proposed to be further amended to add a new paragraph, designated (h)(1), limiting the number of requests for admission which a party may serve upon another party, in a proceeding, to 25, counting subparts. Specifically, the proposed new paragraph provides that 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 25, counting subparts, except upon stipulation of the parties; that if a party upon which requests for admission have been served believes that the number of requests served exceeds the limitation specified in the 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, serve a general objection on the ground of their excessive number; and that if the inquiring party, in turn, files a motion to determine the sufficiency of the objection, the motion must be accompanied by a copy of the set(s) of requests for admission which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (h)(2) of the section. The proposed provisions parallel the provisions of § 2.120(d)(1), which limit the number of interrogatories which a party may serve upon another party in a proceeding. Finally, § 2.120(h) is proposed to be amended to add another new paragraph, designated (h)(3), which provides for the suspension of proceedings when a motion to determine the sufficiency of an answer or objection to a request for admission is filed. Specifically, the proposed new paragraph provides that when a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, the case will be suspended by the 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 specified in the Board's suspension order. The proposed new paragraph also provides that 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 respond to any outstanding discovery requests or to appear for any noticed discovery deposition. The provisions of proposed new § 2.120(h)(3) parallel the provisions of proposed new § 2.120(e) and § 2.127(d), as proposed to be amended.

Section 2.121(a)(1) is proposed to be amended by revising the third sentence, which now provides that 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,'' to provide that testimony periods may be rescheduled ''by stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.'' The sentence is proposed to be further amended to specify that ''if such a motion is denied, the testimony periods will remain as set.'' In addition, the last sentence of the section, which now reads ''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,'' is proposed to be deleted. The sentence is proposed to be added to § 2.120(a), with the latter part of the sentence being modified to read ''the discovery period will be rescheduled only upon stipulation of the parties approved by the Board, and testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.'' The proposed modification is consistent with the third sentence of § 2.121(a)(1), as proposed to be amended.

Section 2.121(c), which governs the length of the testimony periods, is proposed to be amended to enlarge the rebuttal testimony period from 15 to 30 days, and to enlarge all other testimony periods from 30 to 60 days. In addition, the last sentence of the section, which now provides that the periods may be extended ''by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board,'' is proposed to be amended to provide that the periods may be extended ''by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion showing extraordinary circumstances granted by the Board.'' The sentence is proposed to be further amended to specify that ''if such a motion is denied, the testimony periods will remain as set.'' The proposed amendments to this sentence parallel the proposed amendment to the third sentence of § 2.121(a)(1).

Section 2.121(d) now provides, in pertinent part, that when parties stipulate to the rescheduling of testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of testimony periods, a stipulation ''submitted in one original plus as many photocopies as there are parties'' will, if approved, be so stamped, signed, and dated, and the copies will be promptly returned to the parties. The section is proposed to be amended by revising the quoted section to read ''submitted in a number of copies equal to the number of parties to the proceeding plus one copy for the Board.''

Section 2.122(b)(1), which now provides, in pertinent part, that each application or registration file specified in a declaration of interference forms part of the record of the proceeding without any action by the parties, is proposed to be amended by substituting the word ''notice'' for the word ''declaration.''

Section 2.122(d)(1), which now includes a cross-reference to ''§ 2.6(n),'' is proposed to be amended to correct the cross-reference to ''§ 2.6(b)(4).''

Section 2.123(b) now provides, in its second sentence, that by agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit by such witness or witnesses. The sentence is proposed to be amended by inserting the word ''written'' between the words ''by'' and ''agreement.'' The third sentence of the section now provides that the parties may stipulate what a particular witness would testify to if called, or the facts in the case of any party may be stipulated. The sentence is proposed to be amended by inserting the words ''in writing'' after the word ''stipulate'' and after the word ''stipulated.''

Section 2.123(f) pertains to the certification and filing of a deposition by the officer before whom the deposition was taken. The third sentence of the second paragraph of the section now reads, ''Unless waived on the record by an agreement, he shall then, without delay, securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents and Trademarks.'' The sentence is proposed to be amended to delete the words ''without delay,'' to put a period after the word ''sealing,'' and to convert the remainder of the present sentence into a new sentence which reads, ''The officer or the party taking the deposition, or its attorney or other authorized representative, shall then

address the package and forward the same to the Commissioner of Patents and Trademarks.'' The fourth sentence of the paragraph now reads, ''If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted in a separate package marked and addressed as provided in this section.'' The sentence is proposed to be amended to insert, after the word ''transmitted,'' the phrase ''by the officer or the party taking the deposition, or its attorney or other authorized representative.'' Finally, in view of the proposed amendments to the third and fourth sentences, the title of the section, which now reads ''Certification and filing by officer,'' is proposed to be amended to read ''Certification and filing of deposition.''

Section 2.125(c), which now provides that one certified transcript (of a testimony deposition) and exhibits shall be filed ''promptly,'' with the Board, is proposed to be amended to delete the word ''promptly.''

Section 2.127(a), which governs the filing of briefs on motions, is proposed to be amended to (1) enlarge the time for filing a brief in response to a motion from 15 days to 30 days, and preface the time provision with the phrase ''Except as provided in paragraph (e)(1) of this section, a''; (2) delete, from the second sentence, a provision for extension of this time by ''order of the Board on motion for good cause'' and substitute a provision for an extension by ''stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board,'' with the added provision that, ''if such a motion for an extension is denied, the time for responding to the motion remains as specified under this section''; (3) add a new provision to specify that a reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion, and preface this new provision with the phrase ''Except as provided in paragraph (e)(1) of this section, a''; (4) specify that the time for filing a reply brief will not be extended, and that no further papers in support of or in opposition to a motion will be considered by the Board; (5) add form requirements for briefs, i.e., that they shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper; (6) add a page limitation for briefs, namely, 25 pages for a brief in support of or in response to a motion and 10 pages for a reply brief; and (7) specify that exhibits submitted in support of or in opposition to a motion shall not be deemed to be part of the brief for purposes of determining the length of the brief.

Section 2.127(b), which now provides, in pertinent part, that any request for reconsideration or modification of an order or decision issued on a motion must be filed within thirty days from the date thereof, is proposed to be amended to change the specification of the time period for requesting reconsideration or modification from ''thirty days'' to ''one month.''

Section 2.127(d) provides, in its first sentence, that when any party files a motion which is potentially dispositive of a proceeding, the case will be suspended by the 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. The sentence is proposed to be amended to add to the end of the sentence the phrase ''except as otherwise specified in the Board's suspension order.'' The section is proposed to be further amended to add, immediately after the first sentence, a new sentence providing that filing a summary judgment motion shall not toll the time for the moving party to respond to any outstanding discovery requests or to appear at a noticed discovery deposition, but it shall toll the time for the nonmoving party to serve such responses or to appear for such deposition.

Section 2.127(e)(1), which governs the time for filing a motion for summary judgment, is proposed to be amended to add, at the beginning of the section, a provision that a motion for summary judgment may not be filed until notification of the proceeding has been sent to the parties by the Board. In addition, the section is proposed to be amended to add to the end thereof provisions specifying that (1) a motion under Rule 56(f) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within 30 days from the date of service of the summary judgment motion; (2) the time for filing a motion under Rule 56(f) will not be extended; (3) if no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within 60 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 showing extraordinary circumstances granted by the Board and that, if such a motion for an extension is denied, the time for responding to the motion for summary judgment remains as specified under this section; (4) a reply brief, if filed, shall be filed within 30 days from the date of service of the brief in response to the motion; (5) the time for filing a reply brief will not be extended; and (6) no further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.

Section 2.127(f), which now states that ''The Board does not have authority to hold any person in contempt, or to award attorneys' fees or other expenses to any party,'' is proposed to be amended to state instead that ''The Board will not hold any person in contempt, or award attorneys'' fees or other expenses to any party.''

Section 2.134(a), which now includes a cross-reference to ''section 7(d)'' of the Act of 1946, is proposed to be amended to correct the cross-reference to ''section 7(e).''

Section 2.146(e)(1), which now provides for filing a petition to the Commissioner from the denial of a request for an extension of time to file a notice of opposition, is proposed to be amended to provide also for filing a petition from the grant of such a request. Specifically, the first sentence of the section now provides that a petition from the denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the denial of the request and shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. The sentence is proposed to be revised to read, ''A petition from the grant or denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the grant or denial of the request. A petition from the grant of a request shall be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant.'' In addition, the present third sentence of the section, which provides, in pertinent part, that the applicant may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, is proposed to be amended by revising the beginning of the sentence to read, ''The potential opposer or the applicant, as the case may be, may file a response within fifteen days * * *.''

Section 3.41, which now includes a cross-reference to ''§ 2.6(q),'' is proposed to be amended to correct the cross-reference to ''§ 2.6(b)(6).''

Environmental, Energy, and Other Considerations

The proposed rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 et seq.), Executive Order 12612, and the Paperwork Reduction Act of 1995 (PRA) (44 U.S.C. 3501 et seq.). The proposed changes have been determined to be not significant for purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that the proposed rule changes will not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal effect of this rule change is to improve practice and expedite proceedings in inter partes cases before the Board.

The PTO has determined that the proposed rule changes have no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

This rule involves the Petition to Cancel requirement which has not been previously approved by the OMB under the PRA. A request to collect this information has been submitted to OMB for review and approval. The reporting burden for this collection of information is estimated to be 20 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Comments are invited on: (a) whether the collection of information is necessary for proper performance of the functions of the agency; (b) the accuracy of the agency's estimate of the burden; (c) ways to enhance the quality, utility, and clarity of the information to be collected; and (d) ways to minimize the burden of the collection of information to respondents. This rule also involves information requirements associated with filing an Opposition to the Registration of a Mark, Amendment to Allege Use, and dividing an application. These requirements have been previously approved by the OMB under control number 0651–0009. Send comments regarding the burden estimate or any other aspects of the information requirements, including suggestions for reducing the burden, to the Assistant Commissioner for Trademarks, Box TTAB—No Fee, 2900 Crystal Drive, Arlington, VA 22202–3513, marked to the attention of Ellen J. Seeherman, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503 (Attention: PTO Desk Officer).

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information, subject to the requirements of the PRA, unless that collection of information displays a currently valid Office of Management and Budget (OMB) control number.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks.

For the reasons given in the preamble and pursuant to the authority contained in § 41 of the Trademark Act of July 5, 1946, as amended, the Patent and Trademark Office proposes to amend Part 2 and Part 3 of Title 37 of the Code of Federal Regulations by amending or revising §§ 2.76, 2.85, 2.87, 2.101, 2.102, 2.111, 2.117, 2.119, 2.120, 2.121, 2.122, 2.123, 2.125, 2.127, 2.134, 2.146 and 3.41, as set forth below. Additions are indicated by arrows and deletions by brackets.

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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

Authority: 15 U.S.C. 1123; 35 U.S.C. 6, unless otherwise noted.

1a. Section 2.76 is proposed to be amended by revising paragraphs (a), (g), and (h) to read as follows:

§ 2.76 Amendment to allege use.

(a) An application under section 1(b) of the Act may be amended to allege use of the mark in commerce under section 1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication [or the date of expiration of the six-month response period after issuance of a final action]. Thereafter, an allegation of use may be submitted only as a statement of use under § 2.88 after the issuance of a notice of allowance under section 13(b)(2) of the Act. If an amendment to allege use is filed outside the time period specified in this paragraph, it will be returned to the applicant.

* * * * *

(g) If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (e) of this section, applicant will be notified of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication [or the six-month response period after issuance of a final action has not expired]. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication [or prior to the expiration of the six-month response period after issuance of a final action], the amendment will not be examined.

(h) An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication [or expiration of the six-month response period after issuance of a final action].

2. Section 2.85 is proposed to be amended by revising paragraph (e) to read as follows:

§ 2.85 Classification schedules.

* * * * *

(e) Where the amount of the fee received on filing an appeal in connection with an application or on an application for renewal [or in connection with a petition for cancellation] is sufficient for at least one class of goods or services but is less than the required amount because multiple classes in an application or registration are involved, the appeal or renewal application [or petition for cancellation] will not be refused on the ground that the amount of the fee was insufficient if the required additional amount of the fee is received in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office, or if action is sought only for the number of classes equal to the number of fees submitted.

* * * * *

3. Section 2.87 is proposed to be amended by revising paragraph (c) to read as follows:

§ 2.87 Dividing an application.

* * * * *

(c) A request to divide an application may be filed at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action; or during an opposition >or concurrent use or interference proceeding<, upon motion granted by the Trademark Trial and Appeal Board.

Additionally, a request to divide an application under section 1(b) of the Act may be filed with a statement of use under § 2.88 or at any time between the filing of a statement of use and the date the Trademark Examining Attorney approves the mark for registration or the date of expiration of the six-month response period after issuance of a final action.

* * * * *

4. Section 2.101 is proposed to be amended by revising paragraph (d)(1) to read as follows:

§ 2.101 Filing an opposition.

* * * * *

(d)(1) 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(a)(17)< [2.6(1)]. If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

* * * * *

5. Section 2.102 is proposed to be amended by revising paragraph (d) to read as follows:

§ 2.102 Extension of time for filing an opposition.

* * * * *

(d) Every request to extend the time for filing a notice of opposition should be submitted in triplicate [(original plus two copies)].

6. Section 2.111 is proposed to be amended by revising paragraphs (b) and (c)(1) to read as follows:

§ 2.111 Filing petition for cancellation.

* * * * *

(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition 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)< [(c)] or >(5)< [(e)] of the Act. In all other cases the petition 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) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see § [§] >2.6(a)(16)< [2.6(1) and 2.85(e)]). If the fees submitted are insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.

* * * * *

7. Section 2.117 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 2.117 Suspension of proceedings.

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that >a party or< parties to a pending case are engaged in a civil action >or a Board proceeding< which may >have a bearing on< [be dispositive of] the case, proceedings before the Board may be suspended until termination of the civil action.

(b) Whenever there is pending >before the Board both a motion to suspend and< [, at the time when the question of the suspension of proceedings is raised,] a motion which is potentially dispositive of the case, the >potentially dispositive< motion may be decided before the question of suspension is considered >regardless of the order in which the motions were filed<.

* * * * *

8. Section 2.119 is proposed to be amended by revising paragraph (d) to read as follows:

2.119 Service and signing of papers.

* * * * *

(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, the party must designate by written document filed in the Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. In such cases, official communications of the Patent and Trademark 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 § 10.14(c) of this subchapter. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under [paragraph (b) or (c) of] § 10.14>(b)< and authorized under § 2.17(b).

* * * * *

9. Section 2.120 is proposed to be amended by redesignating current paragraphs (e) and (h) as (e)(1) and (h)(2), respectively; adding new paragraphs (e)(2), (h)(1), and (h)(3); and revising paragraphs (a), (d), and (g)(1) and redesignated paragraphs (e)(1) and (h)(2) to read as follows:

§ 2.120 Discovery.

(a) *In general.* >Wherever appropriate, the< [The] provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section. >The provisions of the Federal Rules of Civil Procedure relating to automatic disclosure, scheduling conferences, conferences to discuss settlement and to develop a discovery plan, and transmission to the court of a written report outlining the discovery plan, are not applicable to Board proceedings.< The Trademark Trial and Appeal Board will specify the >opening and< closing date>s for< the taking of discovery. >The discovery period will be set for a period of 180 days. Interrogatories, requests for production of documents and things, and requests for admission must be served in sufficient time that responses will fall due prior to the close of the discovery period. Discovery depositions must be noticed and taken prior to the close of the discovery period. Extensions of the discovery period will be granted only upon stipulation of the parties approved by the Board. The parties may stipulate to a shortening of the discovery period. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 40 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 showing extraordinary circumstances granted by the Board. 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; the discovery period will be rescheduled only upon stipulation of the parties approved by the Board, and testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.< [The opening of discovery is governed by the Federal Rules of Civil Procedure.]

* * * * *

(d) *Interrogatories; request for production.* (1) 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 >25< [seventy-five], counting subparts, except [that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or] upon stipulation of the parties. [A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories; and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served.] If a party upon which interrogatories have been served believes that the number of interrogatories served exceed>s< 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 interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.

(2) >The total number of requests for production of documents and things 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 15, counting subparts, except upon stipulation of the parties. If a party upon which requests for production of documents and things have been served believes that the number of requests served 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, 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 requests which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.< The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

(e) *Motion for an order to compel discovery.* >(1)< If a party 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 or thing, the party seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. >The motion must be filed within 30 days after the close of the discovery period, as originally set or as reset.< The motion shall include a copy of the request for designation 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 or things that were not produced for inspection and the documents or things that were not produced for inspection and copying. The motion must be supported by a written statement 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 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 for an order to compel discovery, the case will be 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 specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.<

* * * * *

(g) *Sanctions.* (1) If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board [does not have authority to] >will not< hold any person in contempt or [to] award any expenses to any party. The Board may impose against a party any of the sanctions provided by this subsection 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.

* * * * *

(h) *Request>s< for admission[s].* >(1)< [Requests for admissions shall be governed by Rule 36 of the Federal Rules of Civil Procedure except that the Trademark Trial and Appeal Board does not have authority to award any expenses to any party.] >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 25, counting subparts, except upon stipulation of the parties. If a party upon which requests for admission have been served believes that the number of requests served 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, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to determine the sufficiency of the objection, the motion must be accompanied by a copy of the

set(s) of requests for admission which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (h)(2) of this section.

(2) Any < [A] motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission >must be filed within 30 days after the close of the discovery 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 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.

>(3) When a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, the case will be 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 specified in the Board's suspension order. 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 respond to any outstanding discovery requests or to appear for any noticed discovery deposition.<

* * * * *

10. Section 2.121 is proposed to be amended by revising paragraphs (a)(1), (c) and (d) to read as follows:

§ 2.121 Assignment of times for taking testimony.

(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion >showing extraordinary circumstances< granted by the Board; >if such a motion is denied, the testimony periods will remain as set< [, or by order of the Board]. The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party. [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.]

* * * * *

(c) A testimony period which is solely for rebuttal will be set for >30< [fifteen] days. All other testimony periods will be set for >60< [thirty] days. The periods may be extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion >showing extraordinary circumstances< granted by the Board; >if such a motion is denied, the testimony periods will remain as set< [, or by order of the Board].

(d) When parties stipulate to the rescheduling of testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of 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, and submitted >in a number of copies equal to the number of parties to the proceeding plus one copy for the Board< [in one original plus as many photocopies as there are parties], will, if approved, be so stamped, signed, and dated, and >a copy< [the copies] will be promptly returned to >each of< the parties.

11. Section 2.122 is proposed to be amended by revising paragraphs (b)(1) and (d)(1) to read as follows:

§ 2.122 Matters in evidence.

* * * * *

(b) *Application files.* (1) The file of each application or registration specified in a >notice< [declaration] 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.

* * * * *

(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 two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see >§ 2.6(b)(4)< [§ 2.6(n)].

* * * * *

12. Section 2.123 is proposed to be amended by revising paragraphs (b) and (f) as follows:

§ 2.123 Trial testimony in inter partes cases.

* * * * *

(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. By >written< agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate >in writing< what a particular witness would testify to if called, or the facts in the case of any party may be stipulated >in writing<.

* * * * *

(f) *Certification and filing >of deposition< [by officer].* The officer shall annex to the deposition his certificate showing:

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

(2) 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 presence;

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

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

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

If any of the foregoing requirements are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then [, without delay,] securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing>. The officer or the party taking the deposition, or its attorney or other authorized representative, shall then< [,] address the package, and forward the same to the Commissioner of Patents and Trademarks. If the weight or bulk of

an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted >by the officer or the party taking the deposition, or its attorney or other authorized representative< in a separate package marked and addressed as provided in this section.

* * * * *

13. Section 2.125 is proposed to be amended by revising paragraph (c) to read as follows:

§ 2.125 Filing and service of testimony.

* * * * *

(c) One certified transcript and exhibits shall be filed [promptly] 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.

* * * * *

14. Section 2.127 is proposed to be amended by revising paragraphs (a), (b), (d), (e)(1) and (f) to read as follows:

§ 2.127 Motions.

(a) Every motion shall be made in writing, 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< [A] brief in response to a motion shall be filed within >30< [fifteen] 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 showing extraordinary circumstances granted by the Board; if such a motion for an extension is denied, the time for responding to the motion remains as specified under this section< [order of the Board on motion for good cause]. >Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within 15 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. No further papers in support of or in opposition to a motion will be considered by the Board. Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. The brief in support of the motion and the brief in response to the motion shall not exceed 25 pages in length; and a reply brief shall not exceed 10 pages in length. Exhibits submitted in support of or in opposition to the motion shall not be deemed to be 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< [thirty days] from the date thereof. A brief in response must be filed within >15< [fifteen] days from the date of service of the request.

* * * * *

(d) When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be 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 specified in the Board's suspension order. The filing of a summary judgment motion shall not toll the time for the moving party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition, but it shall toll the time for the nonmoving party to serve such responses or to appear for such deposition<. 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 motion for summary judgment may not be filed until notification of the proceeding has been sent to the parties by the Trademark Trial and Appeal Board.< A motion for summary judgment>, if filed,< should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter. >A motion under Rule 56(f) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within 30 days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(f) will not be extended. If no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within 60 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 showing extraordinary circumstances granted by the Board; if such a motion for an extension is denied, the time for responding to the motion for summary judgment remains as specified under this section. A reply brief, if filed, shall be filed within 30 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. No further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.<

* * * * *

(f) The Board [does not have authority to] >will not< hold any person in contempt, or [to] award attorneys' fees or other expenses to any party.

15. Section 2.134 is proposed to be amended by revising paragraph (a) to read as follows:

§ 2.134 Surrender or voluntary cancellation of registration.

(a) After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section >7(e)< [7(d)] of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

* * * * *

16. Section 2.146 is proposed to be amended by revising paragraph (e)(1) to read as follows:

§ 2.146 Petitions to the Commissioner.

* * * * *

(e)(1) A petition from the >grant or< denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the >grant or< denial of the request>. A petition from the grant of a request< [and] shall be served on the >attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request shall be served on the< attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by § 2.119(a). The >potential opposer or< the applicant>, as the case may be,< may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by § 2.119(a). No further paper relating to the petition shall be filed.

* * * * *

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

17. The authority citation for part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6.

17a. Section 3.41 is proposed to be revised to read as follows:

§ 3.41 Recording fees.

All requests to record documents must be accompanied by the appropriate fee. A fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of this chapter for patents and in >§ 2.6(b)(6)< [§ 2.6(q)] of this chapter for trademarks.

Dated: May 30, 1997.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

[FR Doc. 97–14711 Filed 6–4–97; 8:45 am]

BILLING CODE 3510–16–P

ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[MD 038–3009; FRL–5835–3]

Approval and Promulgation of Air Quality Implementation Plans; Maryland; 15% Rate-of-Progress Plan and Contingency Measures—Cecil County Nonattainment Area

AGENCY: Environmental Protection Agency (EPA).

ACTION: Notice of proposed rulemaking.

SUMMARY: EPA proposes to approve the State Implementation Plan (SIP) revision submitted by the State of Maryland for the Cecil County ozone nonattainment area to meet the 15 Percent Reasonable Further Progress Plan (RFP, or 15% plan), also known as rate-of-progress (ROP) requirements, of the Clean Air Act (CAA). EPA is proposing to approve Maryland's 15% plan for Cecil County because it meets the 15% plan requirements under the CAA, and is consistent with EPA policy and guidance. Emission reductions realized by Maryland's 15% plan for Cecil County are sufficient to fulfill Maryland's contingency measure obligation for the County. Therefore, EPA is also proposing approval of contingency measures for Cecil County, Maryland.

DATES: Comments on this proposed action must be postmarked by July 7, 1997.

ADDRESSES: Written comments may be mailed to David L. Arnold, Chief, Ozone/CO & Mobile Sources Section, Mailcode 3AT21, U.S. Environmental Protection Agency—Region III, 841 Chestnut Building, Philadelphia, Pennsylvania 19107. Copies of the documents relevant to this action are available for public inspection during normal business hours at the Air, Radiation, and Toxics Division, Environmental Protection Agency, Region III, 841 Chestnut Building, Philadelphia, Pennsylvania 19107; the Air and Radiation Docket and Information Center, Environmental Protection Agency, 401 M. Street, SW., Washington, D.C. 20460; and the Maryland Department of the Environment, 2500 Broening Highway, Baltimore, Maryland 21224.

FOR FURTHER INFORMATION CONTACT: Carolyn M. Donahue, (215) 566–2095, at the EPA Region III address above. Information may also be requested via e-mail at the following address: donahue.carolyn@epamail.epa.gov. Please note that while information may be requested via e-mail, only written comments can be accepted for inclusion in the docket.

SUPPLEMENTARY INFORMATION:

I. Background

Section 182(b)(1) of the CAA, as amended in 1990, requires ozone nonattainment areas classified as moderate and above to develop plans to reduce area-wide volatile organic compound (VOC) emissions by 15% from a 1990 baseline. These ''15% plans'' were to be submitted to EPA by November 15, 1993, with the reductions to occur by November 15, 1996. The CAA also sets limitations on the creditability of certain control measures towards the ROP requirements. Specifically, states cannot take credit for reductions achieved by Federal Motor Vehicle Control Program (FMVCP) measures (i.e., new car emissions standards) promulgated prior to 1990; or for reductions resulting from regulations promulgated prior to 1990 to lower the volatility (i.e., Reid vapor pressure (RVP)) of gasoline. Furthermore, the CAA does not allow credit towards RFP for post-1990 corrections to vehicle inspection and maintenance programs (I/M) or corrections to Reasonably Available Control Technology (RACT) rules, as these programs were required to be in place prior to 1990.

In addition, section 172(c)(9) of the CAA requires that contingency measures be included in the 15% plan, to be implemented if reasonable further progress is not achieved, or if the National Ambient Air Quality Standard (NAAQS) is not attained by the deadlines set forth in the CAA.

II. Maryland SIP Submittal for Cecil County

In Maryland, three nonattainment areas are subject to the CAA's 15% ROP requirements. These are the Baltimore nonattainment area, the Maryland portion of the Metropolitan Washington, DC nonattainment area, and Cecil County, which is part of the Philadelphia-Wilmington-Trenton nonattainment area. The Maryland Department of the Environment (MDE) submitted revisions to its SIP for all three nonattainment area, which EPA received on July 12, 1995. EPA is taking action today only on Maryland's 15% plan submittal and contingency measures for Cecil County. The 15% plan submittals for the Maryland portion of the Metropolitan Washington, DC nonattainment area and the Baltimore nonattainment area will be the subjects of other rulemaking notices.

III. Analysis of SIP Revision

Table 1 presents the calculations of the required reductions for the Cecil County nonattainment area 15% ROP plan.

TABLE 1.—CALCULATION OF REQUIRED REDUCTIONS FOR MARYLAND'S 15% PLAN FOR THE CECIL COUNTY NONATTAINMENT AREA

[Tons per day]

(1) 1990 Base Year Inventory	19.0
(2) Adjustments for FMVCP/RVP	2.4
(3) 1990 Adjusted Base Year Inventory [(1)–(2)]	16.6
(4) 15% Reduction Requirement [0.15×(3)]	2.49
(5) Expected Emissions Growth 1990–1996	0.7
(6) 3% Contingency Measures [0.03×(3)]	0.49
(7) Total Emissions Reductions Required [(4)+(5)+(6)]	3.68
(8) Total Reduction Claimed by Maryland from Creditable Measures	4.72

A. 1990 Base Year Emissions Inventory

The baseline from which states must determine the required reductions for 15% planning is the 1990 VOC base year emissions inventory. The inventory is broken down into several emissions source categories: stationary, area, on-road mobile sources, and off-road mobile sources. This emissions total is the basis for calculating emissions growth and the required 15% emissions reduction from the adjusted base year inventory. The 1990 adjusted base year inventory is derived from the 1990 base year inventory minus FMVCP/RVP reductions, RACT corrections and I/M corrections. Pursuant to the CAA, Maryland did not take credit for post-1990 RACT corrections or post-1990 I/M corrections because these programs were to be in place prior to 1990. Maryland submitted a formal SIP revision containing their official 1990 base year emission inventory on March