Mail outlines to: CC:PA:LPD:PR (REG–131739–03), room 5203, Internal Revenue Service, POB 7604, Ben Franklin Station, Washington, DC 20044. Submissions may be hand delivered Monday through Friday between the hours of 8 a.m. and 4 p.m. to CC:PA:LPD:PR (REG–131739–03), Courier's Desk, Internal Revenue Service, 1111 Constitution Avenue, NW., Washington, DC. Alternatively, taxpayers may submit outlines electronically via the Federal eRulemaking Portal at *http://www.regulations.gov* (IRS and *notice.comment@irscounnsel.treas.gov* (REG–131739–03).

FOR FURTHER INFORMATION CONTACT: Concerning submissions of comments, the hearing, and/or to be placed on the building access list to attend the hearing Treena Garrett, (202) 622–7180 (not a toll-free number).

SUPPLEMENTARY INFORMATION: The subject of the public hearing is the notice of proposed rulemaking (REG–131739–03) that was published in the **Federal Register** on Monday, July 18, 2005 (70 FR 41165).

The rules of 26 CFR 601.601(a)(3) apply to the hearing. Persons who have submitted written or electronic comments and wish to present oral comments at the hearing must submit an outline of the topics to be discussed and the amount of time to be devoted to each topic (signed original and eight (8) copies) by February 15, 2006.

A period of 10 minutes is allotted to each person for presenting oral comments. After the deadline for receiving outlines has passed, the IRS will prepare an agenda containing the schedule of speakers. Copies of the agenda will be made available, free of charge, at the hearing. Because of access restrictions, the IRS will not admit visitors beyond the immediate entrance area more than 30 minutes before the hearing starts. For information about having your name placed on the building access list to attend the hearing, see the **FOR FURTHER INFORMATION CONTACT** section of this document.

Guy R. Traynor,

Federal Register Liaison, Publications and Regulations Branch, Legal Processing Division, Associate Chief Counsel, Procedures and Administration.

[FR Doc. E6–352 Filed 1–13–06; 8:45 am]

BILLING CODE 4830–01–P

DEPARTMENT OF THE TREASURY

Internal Revenue Service

26 CFR Part 301

[REG–150088–02]

RIN 1545–BB96

Miscellaneous Changes to Collection Due Process Procedures Relating to Notice and Opportunity for Hearing Upon Filing of Notice of Federal Tax Lien; Hearing Cancellation

AGENCY: Internal Revenue Service (IRS), Treasury.

ACTION: Cancellation of notice of public hearing on proposed rulemaking.

SUMMARY: This document cancels a public hearing on proposed regulations relating to a taxpayer's right to a hearing under section 6320 of the Internal Revenue Code of 1986 after the filing of a notice of Federal tax lien (NFTL).

DATES: The public hearing originally scheduled for January 19, 2006, at 10 a.m., is cancelled.

FOR FURTHER INFORMATION CONTACT: Robin R. Jones of the Publications and Regulations Branch, Legal Processing Division, Associate Chief Counsel (Procedure and Administration), at (202) 622–7180 (not a toll-free number).

SUPPLEMENTARY INFORMATION: A notice of proposed rulemaking and notice of public hearing that appeared in the **Federal Register** on September 16, 2006 (70 FR 54681), announced that a public hearing was scheduled for January 19, 2005, at 10 a.m., in the IRS Auditorium, Internal Revenue Service, 1111 Constitution Avenue, NW., Washington, DC. The subject of the public hearing is under section 6320 of the Internal Revenue Code. The public comment period for these regulations expired on December 29, 2005.

The notice of proposed rulemaking and notice of public hearing, instructed those interested in testifying at the public hearing to submit a request to speak and an outline of the topics to be addressed. As of Monday, January, 9, 2006, no one has requested to speak. Therefore, the public hearing scheduled for January 19, 2006, is cancelled.

LaNita VanDyke,

Federal Register Liaison Officer, Publications and Regulations Branch, Legal Processing Division, Associate Chief Counsel, Procedure and Administration.

[FR Doc. E6–365 Filed 1–13–06; 8:45 am]

BILLING CODE 4830–01–P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 2

[Docket No. 2003–T–009]

RIN 0651–AB56

Miscellaneous Changes to Trademark Trial and Appeal Board Rules

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) proposes to amend its rules to require plaintiffs in Trademark Trial and Appeal Board (Board) inter partes proceedings to serve on defendants their complaints or claims; to utilize in Board inter partes proceedings a modified form of the disclosure practices included in the Federal Rules of Civil Procedure; and to delete the option of making submissions to the Board in CD–ROM form. In addition, certain amendments clarify rules, conform the rules to current practice, and correct typographical errors or deviations from standard terminology.

DATES: Comments must be received by March 20, 2006 to ensure consideration.

ADDRESSES: Submit comments by electronic mail (e-mail) to *AB56Comments@uspto.gov.* Written comments may be submitted by mail to: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313–1451, attention Gerard F. Rogers; or by hand delivery to Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Gerard F. Rogers.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (*http://www.regulations.gov*) for additional instructions on providing comments via the Federal eRulemaking Portal.

FOR FURTHER INFORMATION CONTACT: Gerard F. Rogers, Trademark Trial and Appeal Board, by telephone at (571) 272–4299, by e-mail to *gerard.rogers@uspto.gov,* or by facsimile at 571–273–0059.

SUPPLEMENTARY INFORMATION: The Office proposes to increase the efficiency of the processes for commencing inter partes cases, in light of the Board's deployment in recent years of electronic filing options and the increased availability and use of facsimile and e-

mail as methods of communication between parties involved in inter partes cases. Also, the Office proposes to increase the efficiency by which discovery and pre-trial information is exchanged between parties to inter partes cases, by adopting a modified form of the disclosure practice that is uniformly followed in the federal district courts. These practices have been found in the courts to enhance settlement prospects and to lead to earlier settlement of cases; and for cases that do not settle, disclosure has been found to promote greater exchange of information, leading to increased procedural fairness and a greater likelihood that cases eventually determined on their merits are determined on a fairly created record. Finally, in addition to the foregoing non-substantive changes to the rules, the Office proposes minor modifications necessary to make corrections or updates to certain rules and conform those rules to current practice.

Background

I. Commencement of Proceedings

The current process by which a plaintiff in a Board proceeding files notice of its complaint (or claim of right to a concurrent use registration) requires the plaintiff to prepare as many copies of its complaint (or claim of right) as there will be defendants in the action. The plaintiff is then required to file the requisite copies with the original, for subsequent forwarding to the defendants. Occasionally, before the Board can forward the copies to the defendants, the plaintiff will have to engage in additional correspondence with the Board, to provide the Board with updated correspondence address information the plaintiff has uncovered in its investigation of the defendant's application, registration or mark, particularly in cancellation and concurrent use proceedings.

Under the practice envisioned by the proposed rules, the initiation of a Board proceeding would become more efficient, because a plaintiff would be able to serve its copies directly on defendants. Use of a direct service approach recognizes that plaintiffs and defendants often are in contact prior to a plaintiff's filing of its complaint or claim, and also recognizes that continuation of such direct communication is vital both for promoting possible settlement of claims and for ensuring cooperation and procedural efficiency in the early stages of a proceeding.

(Plaintiffs in Board proceedings include an opposer that files a notice of opposition against an application, a petitioner that files a petition for cancellation of a registration, and a concurrent use applicant whose concurrent use application sets forth details about the concurrent use applicant's claim of entitlement to a concurrent use registration.)

In recent years, the Board has deployed its ESTTA system, the Electronic System for Trademark Trials and Appeals, so that virtually all filings a party may need to submit to the Board can be submitted electronically. In addition, more and more parties to Board proceedings are choosing to utilize fax or e-mail options for communicating with each other during an inter partes proceeding, either in lieu of using the mail or in combination with use of the mail.

Under the proposed rules changes, an opposer or petitioner would file its complaint with the Board and be required to concurrently serve a copy of its complaint (notice of opposition or petition for cancellation), including any exhibits, on the owner of record, or when applicable the attorney or domestic representative therefor, of the defending application or registration. A concurrent use applicant, however, would not have to serve copies of its application on any defending applicant, registrant or common law mark owner until notification of commencement of the concurrent use proceeding was issued by the Board, as discussed below.

A plaintiff would be expected to serve the owner of record according to Office records, or the domestic representative of the owner of record, as well as any party the plaintiff believed had an ownership interest (*e.g.*, an assignee or survivor of merger that had not recorded the document of transfer in the Office but was known to the plaintiff) at the correspondence address known to the plaintiff. The plaintiff would have to inform the Board of any service copies returned as undeliverable. As for a concurrent use applicant, current practice requires such party to provide, for forwarding by the Board, as many copies of its application as are necessary to forward one to each person or entity listed in the concurrent use application as an exception to the concurrent use applicant's rights. By these proposed changes to the trademark rules, the concurrent use applicant would directly serve the copies of its application on the excepted parties after notification by the Board that the concurrent use application was free of any opposition and the concurrent use proceeding therefore had been instituted. The concurrent use applicant would bear the same service obligations as an opposer or petitioner.

The Board would, after an opposition or petition was filed, or a concurrent use application was published for opposition and free of any opposition, send notice to all parties to the proceeding, noting the filing of the complaint, or publication of the concurrent use application, and setting via such notice the due date for an answer, and the discovery and trial schedule. Notification from the Board may be sent by e-mail when a party has provided an e-mail address. This would include a plaintiff providing an e-mail address when filing by ESTTA or with its complaint, an applicant that authorized the Office to communicate with it by e-mail when it filed its application, and any registrant whose registration file record includes such authorization.

A plaintiff may not serve its complaint or concurrent use application on a defendant by e-mail unless the defendant has agreed with the plaintiff to accept such service, notwithstanding that the defendant may have authorized the Office to communicate with it by e-mail.

Whenever a plaintiff has a service copy of a complaint or claim returned as undeliverable, it would have to inform the Board within 10 days of the return and, if known, any new address information for the defendant whose service copy was returned to the plaintiff. Any undelivered notice from the Board of the commencement of a proceeding may result in notice by publication in the Official Gazette, available via the Office's Web site (*http://www.uspto.gov*), for any proceeding.

II. Adoption of Disclosure

In 1993, significant amendments to the Federal Rules of Civil Procedure (federal rules) implemented a system requiring parties litigating in the federal courts to disclose certain information and/or documents and things without waiting for discovery requests. Individual district courts were permitted to opt out of the mandatory disclosure regime.

In 2000, the federal rules were further amended, with elimination of the option for individual courts to opt out of mandatory disclosure among the most significant changes.

By notice issued January 15, 1994 (and published in the Official Gazette at 1159 TMOG 14), the Board announced its decision not to follow many of the 1993 changes to the federal rules, including the disclosure regime established by Federal Rule 26. The Board subsequently amended the Trademark Rules of Practice (trademark

rules) in 1998. The original notice issued September 29, 1998 (and was published at 1214 TMOG 145) and a correction notice issued October 20, 1998 (and was published at 1215 TMOG 64). While it did not adopt a disclosure practice as an element of these amendments, the Board noted that it would monitor recurring procedural issues in Board cases and might propose and adopt additional changes to practice in the future.

Empirical study has shown that disclosure has been successful in the courts:

> In general, initial disclosure appears to be having its intended effects. Among those attorneys who believed there was an impact, the effects were most often of the type intended by the drafters of the 1993 amendments. Far more attorneys reported that initial disclosure decreased litigation expense, time from filing to disposition, the amount of discovery, and the number of discovery disputes than said it increased them. At the same time, many more attorneys said initial disclosure increased overall procedural fairness, the fairness of the case outcome, and the prospects of settlement than said it decreased them.

Thomas E. Willging, Donna Stienstra, John Shapard & Dean Miletich, *An Empirical Study of Discovery and Disclosure Practice Under the 1993 Federal Rule Amendments,* 39 B.C.L. Rev. 525, 534–35 (May 1998).

The Office has conducted a thorough review of the empirical study and available articles and reports on the subject of disclosure. The Office has concluded from such review that use of disclosure in Board proceedings, in a modified form of that used in the courts, would enhance the possibility of parties settling a Board proceeding and doing so sooner. In addition, disclosure will, if parties do not settle the case, promote more efficient discovery and trial, reduce incidents of unfair surprise, and increase the likelihood of fair disposition of the parties' claims and defenses. In large part, disclosure would serve as a substitute for a certain amount of traditional discovery and a more efficient means for exchange of information that otherwise would require the parties to serve traditional discovery requests and responses thereto.

The Board's standard protective order would be applicable to all cases and the Board notice of the commencement of a proceeding would so indicate (and would note the availability of the standard protective order on the Office's Web site or in hard copy form, by request made to the Board). The applicability of this standard protective order would not make all submissions confidential, as parties would still have to utilize its provisions as necessary. As under current practice, parties would be free to agree to modify the standard protective order. Absent approval of a stipulation to vary the terms of the standard protective order, approved by the Board, the parties would have to abide by it.

The parties may agree to use e-mail to communicate with each other and for forwarding of service copies.

1. The Schedule for Cases Under Disclosure

The Board's notice of the commencement of the proceeding (commonly referred to as the institution order) will set forth disclosure-related deadlines, as illustrated below.

The institution order will set forth specific dates for the various phases in a case. Since each deadline or phase is measured from the date of the institution order, the parentheticals explain the total number of days, as measured from that date, until each deadline:

Due date for an answer—40 days from the mailing date of institution order. (Institution date plus 40 days.)

Deadline for a discovery conference—30 days from the date the answer is due. (Institution date plus 70 days.)

Discovery opens—30 days after the date the answer is due. (Institution date plus 70 days.)

Deadline for making initial disclosures—30 days from the opening of the discovery period. (Institution date plus 100 days.)

Expert disclosure—90 days prior to close of discovery (the mid-point of the 180-day discovery period). (Institution date plus 160 days.)

Discovery closes—180 days from the opening date of the discovery period. (Institution date plus 250 days.)

Pre-Trial disclosures—30 days after the close of the discovery period. (Institution date plus 280 days.)

Plaintiff's 30-day testimony period—closes 90 days after the close of discovery. (Institution date plus 340 days.)

Defendant's 30-day testimony period—closes 60 days after the close of plaintiff's testimony period. (Institution date plus 400 days.)

Plaintiff's 15-day rebuttal testimony period—closes 45 days from close of defendant's testimony period. (Institution date plus 445 days.)

Under this schedule, discovery generally opens after the discovery conference, unless the parties defer their discovery conference to the deadline date, in which case discovery would open concurrently with the conference.

The deadline for making initial disclosures is similar to that of Federal Rule 26(a)(1), except that disclosure under the federal rule is measured from the actual date of, not the deadline for, the discovery conference. Plus, the Board approach provides a longer period for making disclosures than is provided under the federal rules. This will accommodate the possibility of motions to suspend for settlement talks, which are quite common in Board proceedings.

The length of the discovery period is the same as under current Board practice, i.e., 180 days. Disclosures would be made no later than 30 days into that period and the parties would have another 150 days for any necessary additional discovery. The trial schedule, with its 60-day break between discovery and trial and 30-day breaks between the respective testimony periods, is also the same as under current Board practice.

Because disclosure is tied to claims and defenses, in general, a defendant's default or the filing of various pleading motions under Federal Rule 12 would effectively stay the parties' obligation to conference and make initial disclosures. An answer must be filed and issues related to the pleadings resolved before the parties can know the extent of claims and defenses and, therefore, the extent of their initial disclosure obligations.

The Board anticipates it will be liberal in granting extensions or suspensions of time to answer, when requested to accommodate settlement talks, or submission of the dispute to an arbitrator or mediator. However, if a motion to extend or suspend for settlement talks, arbitration or mediation is not filed prior to answer, then the parties will have to proceed, after the filing of the answer, to their discovery conference, one point of which is to discuss settlement. It is unlikely the Board will find good cause for a motion to extend or suspend for settlement when the motion is filed after answer but prior to the discovery conference, precisely because the discovery conference itself provides an opportunity to discuss settlement.

The parties' discovery conference may be in person or by other means. A Board professional, i.e., an Interlocutory Attorney or an Administrative Trademark Judge, will participate in the conference upon the request of any party; but if the parties propose to meet in person, participation by a Board professional would be by telephone, by arrangement of the parties. A request for the participation of a Board professional may only be made after answer is filed but in no event later than 10 days prior

to the deadline for conducting the discovery conference. If neither party requests participation of a Board professional in the discovery conference, the Board will assume that the parties have met on their own, in person or by other means, no later than the prescribed deadline. The parties would not have to file a disclosure/discovery plan with the Board, following their discovery conference, unless they were seeking leave to alter standard deadlines/obligations; or unless they were so directed by a participating Board professional.

There is no Federal Rule 16(b) scheduling conference/order. The Board's institution order will already have set a schedule for the case.

Disclosure deadlines and obligations may be modified upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a stipulation or motion is denied, dates may remain as set. The Board is likely to employ rather strict time frames for filing such stipulations or motions and may routinely employ phone conferences when any request to alter disclosure obligations or deadlines is made by unilateral rather than consented motion.

2. The Interplay of Disclosure and Discovery

A party may not seek discovery through traditional devices until after it has made its disclosures. A party may not move for summary judgment except on claim or issue preclusion grounds until after it has made its disclosures.

The number of interrogatories will be limited to reflect the fact that core information (as discussed below) will be disclosed and interrogatories will not be needed to obtain this information.

Initial disclosure should be much more limited in Board cases than it is in civil actions. For a variety of reasons related to the unique nature of Board proceedings, the extent of initial disclosure can be more limited than in the courts while still promoting the goals of increased fairness and efficiency.

One reason is that the Board's jurisdiction is limited to determining the right of a party to obtain, or retain, a registration, and the extent of available claims and defenses that may be advanced is not nearly as broad as in the district courts. In addition, the Board recognizes the existence of other issues relatively unique to Board proceedings, for example, that a high percentage of applications involved in oppositions are not based on use of the applied-for mark in commerce, but rather, on intent to use, on a foreign registration or on an international registration. Further, certain precepts that govern analysis of issues raised by claims or defenses in typical Board cases effectively limit the Board's focus. For example, in a case under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), the Board focuses only on goods or services recited in identifications, and on a mark as registered or applied-for, irrespective of many actual marketplace issues.

Federal Rule 26(a)(1) requires initial disclosure as a means of obviating the need to use traditional discovery to obtain ''core information'' about a party's claims or defenses. The federal rule is written very generally to account for the wide variety of types of cases tried in the federal district courts; even under the federal rule, however, a party is not obligated under initial disclosure to disclose every fact, document or thing that is considered discoverable about its claim or defense, but merely the ''information that the disclosing party may use to support its claims or defenses.'' Further, disclosure focuses on exchange of ''core information'' and does not substitute for comprehensive discovery.

In inter partes proceedings before the Board, parties will generally be found to have met their initial disclosure obligations if they provide information about the following, as applicable in any particular case:

Origin of any mark on which the party relies, including adoption or creation of the mark and original plans for use of the mark;

Dates of use of any marks, registered or not, on which the party's claims or defenses rely;

The extent of past or current use, if any, or plans for future use of any marks on which claims or defenses rely, including use by the party or by licensees;

Evidence of actual confusion possessed by a party in regard to the involved marks;

The party's awareness of third-party use or registration of marks that are the same or very similar for goods or services the same as or closely related to the involved marks and goods or services;

The extent of use by the party, if any, in a non-trademark manner of words or designs asserted by that party to be non-distinctive;

A party's awareness of use of involved words or designs by third parties when the party is asserting that such words or designs are non-distinctive;

Classes of customers for the party's involved goods or services, including information on the technical expertise or knowledge employed by customers in making purchasing decisions;

Channels of trade for the party's involved goods or services;

Methods of marketing and promoting the party's involved goods or services;

Surveys or market research conducted by the party in regard to any involved mark on which it will rely;

Information regarding other Board proceedings, litigation, or controversies in which the party has been involved, which were related to the involved marks or, if applicable, assertedly non-distinctive matter;

The names of individual officials or employees of a party, and contact information therefor, who are known to have the most extensive knowledge of subjects on which disclosure is made; and

General descriptions of and the probable locations of non-privileged documents and things maintained by the party or its attorneys related to the subjects on which disclosure is made.

The Board recognizes that the language used herein to describe subjects for which there must be initial disclosure, unless inapplicable in a particular case, may be subject to dispute. Parties are expected, however, to read the descriptions in light of the intended goals for disclosure and in a reasonable manner, and without engaging in artificial attempts to limit disclosure through arcane interpretation.

The Board also recognizes that the specificity of information released by a party to comply with its disclosure obligations may be subject to dispute. This is, however, one of the issues that must be anticipated and discussed by the parties during their discovery conference. In addition, the parties are free to discuss additional subjects for which disclosure should be made, or subjects which they do not believe should require disclosure because they are insignificant or not in genuine dispute.

Finally, the Board recognizes that a disclosure obligation may be met, in regard to some subjects, by providing summary information, round numbers, or representative samples. To emphasize, initial disclosure is not intended to substitute for all discovery, but rather, to prompt routine disclosure of core information that a party may use to support a claim or defense. Any adverse party is free to take discovery on subjects that will undermine a claim or defense.

Written disclosures may be used in support of or in opposition to a motion for summary judgment and may, at trial, be introduced by notice of reliance. Disclosed documents also may be used to support or contest a motion for summary judgment but, at trial, they may be introduced by notice of reliance only if otherwise appropriate for such filing. In essence, initial disclosures will be treated like responses to written discovery.

3. Expert Disclosure and Pre-trial Disclosure

A party's plan to use experts must be disclosed no later than 90 days prior to the close of discovery, so that any adverse party will have an opportunity to take necessary discovery. However, if the expert is retained early and an adverse party has inquired about experts through discovery, the party may not delay revealing the expert until the deadline for disclosure of experts. Also, the Board recognizes that there may be cases in which a party retains an expert after the deadline for expert disclosure. In such cases, disclosure must be made promptly when the expert is retained.

Pretrial disclosure will require disclosure of the identity of witnesses that a party expects to present, or may present if the need arises. For each witness, general summaries or descriptions of the subjects on which the witness will testify and the documents or things to be introduced during the deposition must be disclosed. These disclosures must be made 30 days prior to the opening of trial. A party may object to improper or inadequate pre-trial disclosures and may move to strike the testimony of a witness for lack of proper pre-trial disclosure.

Pretrial disclosure of plans to file notices of reliance is not required. The notice of reliance is a device for introduction of evidence that is unique to Board proceedings. There are established practices covering what can be introduced, how it must be introduced, and for objecting to, or moving to strike, notices or material attached thereto. There is less opportunity for surprise or trial by ambush with notices of reliance, because they are most often used to introduce discovery responses obtained from an adversary, or printed publications in general circulation, or government documents generally available to all parties.

III. Removal of Option To Make Submissions on CD–ROM

The Office proposes to remove from Trademark Rule 2.126, 37 CFR 2.126, the option to file submissions in CD–ROM form. CD–ROMs present technical problems for the ESTTA/TTABIS systems and have rarely been utilized by parties.

IV. Change to Rule on Briefing of Motions

The Office proposes to amend Trademark Rule 2.127, 37 CFR 2.127, to clarify that a table of contents, index of cases, description of record, statement of the issues, recitation of facts, argument and summary, whichever a party may choose to employ, all count against the limit of 25 pages for a brief in support of a motion or in response to a motion and the limit of 10 pages for a reply brief.

Discussion of Specific Rules

The Office proposes to make the following amendments:

[2.99(b) to (d)]

The Office proposes to revise § 2.99(b), (c) and (d)(1) by shifting applicant's time to furnish copies of applicant's application, specimens and drawing until after the Board's notification of the proceeding; and to indicate that the Office may transmit the notification of proceedings via e-mail to any party that has provided an e-mail address.

[2.101(a), (b) and (d)]

The Office proposes to revise § 2.101(a) to specify that proof of service on applicant at the correspondence address of record must be included with the filing of the notice of opposition.

The Office proposes to revise § 2.101(b) to define the phrase ''correspondence address of record''; and to specify the steps opposer should take if opposer believes that the correspondence address of record is not accurate, or if the service copy of the notice of opposition is returned as undeliverable to opposer.

The Office proposes to revise § 2.101(d)(4) to add to the requirements for receiving a filing date for the notice of opposition the inclusion of proof of service on applicant at the correspondence address of record.

[2.105(a) and 2.105(c)]

The Office proposes to revise § 2.105(a) to cross-reference rules concerning proper form and proper service; and to indicate that the Office may transmit the notification of proceedings via e-mail to any party that has provided an e-mail address.

The Office proposes to revise § 2.105(c) introductory text to shift to plaintiffs the responsibility for service of the complaint directly on defendants, rather than through the Board.

[2.111(a) to (c)]

The Office proposes to revise § 2.111(a) to specify that proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record must be included with the filing of the petition to cancel, along with the required fee.

The Office proposes to revise § 2.111(b) to define the phrase ''correspondence address of record'; and to specify the steps petitioner should take if petitioner believes that the correspondence address of record is not accurate, or if the service copy of the petition to cancel is returned as undeliverable to petitioner.

The Office proposes to revise § 2.111(c)(4) to add to the requirements for receiving a filing date for the petition to cancel the inclusion of proof of service on the owner of record or on the owner's domestic representative of record, at the correspondence address of record.

[2.113(a) and (c)]

The Office proposes to revise § 2.113(a) to clarify that the answer must be filed by the respondent; and to indicate that the Office may transmit the notification of proceedings via e-mail to any party that has provided an e-mail address.

The Office proposes to revise § 2.113(c) to shift to plaintiffs the responsibility for service of the complaint directly on defendants, rather than through the Board.

[2.113(e)] [remove]

The Office proposes to remove § 2.113(e) to conform the rule to the existing practice whereby the Office no longer advises petitioners of defective petitions to allow for correction of defects.

[2.116(g)] [add]

The Office proposes to add new paragraph (g) to § 2.116. Proposed § 2.116(g) provides that the Board's standard protective order, available via the Office's Web site or upon request made to the Board, is applicable to all inter partes proceedings, unless the parties agree to, and the Board approves, an alternative protective order, or unless a motion by a party to enter a specific protective order is granted by the Board.

[2.118]

The Office proposes to revise § 2.118 to extend its coverage to applicants as well as registrants, so as to allow for service of additional notice of a proceeding, by publication in the Official Gazette, when a notice mailed to an applicant is returned as undeliverable.

[2.119(a) and (b)]

The Office proposes to revise § 2.119(a) by changing ''Patent and Trademark Office'' to ''United States

Patent and Trademark Office;'' by making the singular ''notice of appeal'' the plural ''notices of appeal;'' and by striking out the list of filings that are exceptions to the general requirement that a party to a Board proceeding serve its filings on its adversary. The last of these changes will accommodate the Board's shift to service by plaintiffs on defendants, rather than through the Board, at the commencement of a proceeding.

The Office proposes to revise § 2.119(b) by adding subsection (6), which will allow parties to meet their service obligations by utilizing fax or e-mail, upon agreement of the parties.

[2.120(a), (d) through (j)]

The Office proposes to revise § 2.120(a)(1) to include detailed provisions regarding the requirements for a discovery conference and for initial and expert disclosures in lieu of discovery.

The Office proposes to revise § 2.120(d)(1) to limit the number of interrogatories a party may serve to 25; and to clarify that a motion or stipulation of the parties to allow interrogatories in excess of the limit requires approval of the Board.

The Office proposes to revise § 2.120(e) so that provisions regarding a motion for an order to compel will apply to discovery and disclosures in lieu of discovery.

The Office proposes to revise § 2.120(f) so that provisions regarding a motion for a protective order will apply to discovery and disclosures in lieu of discovery.

The Office proposes to revise § 2.120(g) so that provisions regarding a motion for sanctions may apply to a party's non-participation in the discovery conference, to a party's failure to comply with its disclosure obligations, and to its failure to comply with its discovery obligations; and to specify a deadline for filing a motion for sanctions for failure of a party to participate in the discovery conference.

The Office proposes to revise § 2.120(h)(2) to specify that the filing of a motion to test the sufficiency of responses to requests for admissions shall not toll the time for a party to comply with disclosure obligations, to respond to outstanding discovery requests, or to appear for a noticed deposition.

The Office proposes to revise § 2.120(i) to clarify the language in paragraph (i)(1), to conform titles used in paragraph (i)(2) to existing titles, and to specify that the existing provision through which the Board may require parties to attend a conference at the Board's offices can involve discovery or disclosure issues.

The Office proposes to revise § 2.120(j)(3) and (5) through (8) to provide that disclosures and disclosed documents shall be treated in essentially the same manner as information and documents obtained through discovery requests; and to remove a reference to a past practice of the Board whereby it would return to parties filings related to discovery that should not have been filed with the Board.

[2.121(a) and (d)]

The Office proposes to revise § 2.121(a) to provide for a deadline for pre-trial disclosures and for testimony periods.

The Office proposes to revise § 2.121(d) to account for the resetting of the pre-trial disclosure deadline and testimony periods.

[2.121(e)] [add]

The Office proposes to add § 2.121(e) to explain what is required of a party making pre-trial disclosures.

[2.122(d)]

The Office proposes to revise § 2.122(d)(1) to conform to existing practice by removing the requirement for an opposer or petitioner to file two copies when making a pleaded registration of record with a notice of opposition or petition for cancellation.

[2.123(e)]

The Office proposes to revise § 2.123(e)(3) to provide that a party may object to improper or inadequate pre-trial disclosures and may move to strike the testimony of a witness for lack of proper pre-trial disclosure.

[2.126(a)]

The Office proposes to revise § 2.126(a)(6) to reflect the proposed removal of § 2.126(b).

[2.126(b)] [remove]

The Office proposes to remove § 2.126(b), which allows a party to make submissions on CD-ROM.

[2.127(a), (c) and (e)]

The Office proposes to revise § 2.127(a) to clarify the provisions relating to briefing of motions and to conform them to existing practice.

The Office proposes to revise § 2.127(c) to update titles and to correct a typographical error.

The Office proposes to revise § 2.127(e) to provide that a party may not file a motion for summary judgment before it has made its initial disclosures; and to provide that a party may submit disclosures and disclosed documents when briefing a motion for summary judgment.

[2.129(a)]

The Office proposes to revise § 2.129(a) to update titles.

[2.133(a) and (b)]

The Office proposes to revise §§ 2.133(a) and (b) to conform to current practices related to amendment of an application or registration involved in an inter partes proceeding.

[2.142(e)]

The Office proposes to revise § 2.142(e)(1) to update titles.

[2.173(a)]

The Office proposes to revise § 2.173(a) to conform to current practices related to amendment of a registration involved in an inter partes proceeding.

[2.176]

The Office proposes to revise § 2.176 to conform to current practices related to amendment of a registration involved in an inter partes proceeding.

Rulemaking Requirements

I. Executive Order 13132

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

II. Executive Order 12866

This rulemaking has been determined not to be significant for purposes of Executive Order 12866 (Sept. 30. 1993).

III. Regulatory Flexibility Act

The United States Patent and Trademark Office (Office) is amending its rules in 37 CFR Part 2 governing initiation of inter partes proceedings at the Trademark Trial and Appeal Board (Board) and the prosecution and defense of such proceedings, and making corrections or modifications that conform rules to current practice. There are no new fees or fee changes associated with any of the proposed rules.

The changes in this proposed rule involve interpretive rules, or rules of agency practice and procedure, and prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). Because prior notice and an opportunity for public comment are not required for the changes in this proposed rule, a Regulatory Flexibility

Act analysis is also not required for the changes proposed in this rule. *See* 5 U.S.C. 603. Nevertheless, the Office is publishing this notice of proposed rulemaking in the **Federal Register** and in the Official Gazette of the United States Patent and Trademark Office, in order to solicit public participation with regard to this rule package.

The primary changes in this rule are: (1) plaintiffs will serve certain papers (complaints or claims of right to a concurrent use registration) directly on defendants, and (2) parties will exchange core information supporting their claims or defenses and identify expert witnesses to be used during Board proceedings, as part of the discovery phase, and will disclose the identity of witnesses the party expects to call during a pre-trial phase.

These proposed rules will not have a significant economic impact on large or small entities. With regard to the first change, very little (if any) additional cost is associated with the rules because plaintiffs must currently serve these papers on the Office, which, in turn, serves the papers on the defendants. Changing the recipient of the papers will not have a significant economic impact on any party to a Board proceeding. With regard to the second change, very little (if any) additional cost is associated with these rules because under current Board procedures, parties are obligated to provide almost all of this information, when requested through discovery. This rule simply affects when the information is exchanged and eliminates the need for a party to incur expenses associated with preparing requests for the information.

The proposed rules also contemplate many instances in which parties may avoid disclosure obligations otherwise provided for by the rules. For example, if a case is suspended to allow the parties to discuss settlement, as occurs in the vast majority of Board cases, no disclosure would be required during settlement talks. In addition, parties can stipulate, subject to approval of the Board, that disclosure is not necessary in a particular case and can specify their own plans for exchanging information.

IV. Paperwork Reduction Act

The proposed amendments to the Trademark Trial and Appeal Board Rules do not impose any collection of information requirements within the meaning of the Paperwork Reduction Act of 1995 (44 U.S.C. 3501, *et seq.*) (PRA). Accordingly, the PRA does not apply to these proposed amendments.

List of Subjects in 37 CFR Part 2

Administrative practice and procedure, Trademarks.

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

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

2. Revise § 2.99(b), (c) and (d)(1) to read as follows:

§ 2.99 Application to register as concurrent user.

* * * * *

(b) If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80.

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

(d)(1) The applicant for concurrent use registration will be required to serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application for registration, within ten days from the date of the Board's notification.

* * * * *

3. Revise § 2.101(a), (b) and (d)(4) to read as follows:

§ 2.101 Filing an opposition.

(a) An opposition proceeding is commenced by filing in the Office a timely opposition, with proof of service on the applicant at the correspondence address of record, and the required fee.

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board and must serve a copy of the opposition, including any exhibits, on the attorney for the applicant of record or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, utilizing the correspondence address of record. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record. If the opposer believes that the applicant of record or correspondence address of record is not accurate or current, the opposer should serve an additional copy of the opposition and exhibits on any party, or the party's attorney or domestic representative, that the opposer has reason to believe may be the correct applicant, or its successor-in-interest, and must also include with its opposition proof of such service. If any service copy of the opposition is returned to the opposer as undeliverable, the opposer should notify the Board within ten days. The opposition need not be verified, but must be signed by the opposer or the opposer's attorney, as specified in § 10.1(c) of this chapter, or other authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.192(c)(1(iii) are required for oppositions filed under paragraphs (b) (1) or (2) of this section.

* * * * *

(d) * * *

(4) The filing date of an opposition is the date of receipt in the Office of the opposition, with proof of service on the applicant of record, at the correspondence address of record, and the required fee, unless filed in accordance with § 2.198.

4. Revise § 2.105(a) and the introductory text of paragraph (c) to read as follows:

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

(a) When an opposition in proper form (see §§ 2.101 and 2.104), with proof of service in accordance with § 2.101(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.

* * * * *

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

* * * * *

5. Revise § 2.111(a), (b) and (c)(4) to read as follows:

§ 2.111 Filing petition for cancellation.

(a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record.

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, at the correspondence address of record. The petitioner must include with the petition for cancellation proof of service, pursuant to § 2.119, on the owner of record, or on the owner's domestic representative of record, at the correspondence address of record. If the petitioner believes that the owner of record, the domestic representative of record, or the correspondence address of record is not accurate or current, the petitioner should serve an additional copy of the petition and exhibits on any party, or the representative therefor, that the petitioner has reason to believe may be the correct owner or successor-in-interest and must also include with its petition proof of such service. If any service copy of the petition for cancellation is returned to the petitioner as undeliverable, the petitioner should notify the Board within ten days.

(c) * * *

(4) The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation, with proof of service on the owner of record, or on the owner's domestic representative of record, at the correspondence address of record, and with the required fee, unless filed in accordance with § 2.198.

6. Remove § 2.113(e) and revise § 2.113 (a) and (c) to read as follows:

§ 2.113 Notification of cancellation proceeding.

(a) When a petition for cancellation has been filed in proper form (see §§ 2.111 and 2.112), the Trademark Trial and Appeal Board shall prepare a notification which shall identify the title and number of the proceeding and the registration(s) involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed by the respondent. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.

* * * * *

(c) The Board shall forward a copy of the notification to the respondent (see § 2.118). The respondent shall be the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration(s).

* * * * *

7. Add § 2.116(g) to read as follows:

§ 2.116 Federal Rules of Civil Procedure.

* * * * *

(g) The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order. The standard protective order is available at the Office's Web site, or upon request, a copy will be provided. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board.

8. Revise § 2.118 to read as follows:

§ 2.118 Undelivered Office notices.

When a notice sent by the Office to any registrant or applicant is returned to the Office undelivered, additional notice may be given by publication in the Official Gazette for the period of time prescribed by the Director.

9. Revise § 2.119(a) and add paragraph (b)(6) to read as follows:

§ 2.119 Service and signing of papers.

(a) Every paper filed in the United States Patent and Trademark Office in inter partes cases, including notices of appeal, must be served upon the other parties. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) * * *

(6) Electronic transmission when mutually agreed upon by the parties.

* * * * *

10. Revise paragraphs (a)(d)(1), (e), (f), (g), (h)(2), (i), (j)(3) and (j)(5) through (8) to read as follows:

§ 2.120 Discovery.

(a) *In general.* (1) Wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings 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 applicable to Board proceedings in modified form, as noted in these rules and further explained in documents posted on the Web site of the Office. The Trademark Trial and Appeal Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included with the notice of institution of the proceeding.

(2) The discovery conference shall occur no later than the opening of the discovery period. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than 10 days prior to the deadline for the conference. The discovery period will be set for a period of 180 days. Initial disclosures shall be made no later than 30 days after the opening of the discovery period. Expert disclosure shall occur no later than 90 days prior to the close of the discovery period or, if the expert is retained after the deadline for disclosure of experts, promptly upon retention of the expert. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure

deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a stipulation or motion for modification is denied, disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.

(3) A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or upon a motion granted by the Board, or by order of the Board. Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. 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.

(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 twenty-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, approved by the Board. 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 exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.

* * * * *

(e) Motion for an order to compel disclosure or discovery. (1) If a party fails to make required initial disclosures or expert disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party entitled to disclosure or seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. A motion to compel disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed prior to the commencement of the first testimony period as originally set or as reset. A motion to compel discovery 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 copying. A motion to compel disclosure or discovery 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 but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion for an order to compel disclosure or 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 disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

(f) Motion for a protective order. Upon motion by a party obligated to make disclosures or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.

(g) Sanctions. (1) If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award 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. A motion for sanctions to be imposed against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.

(2) If a party fails to make required disclosures, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section. If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a)

of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

(h) * * *

(2) 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 comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

(i) Telephone and pre-trial conferences. (1) Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that its approval or resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, address the stipulation or resolve the motion by telephone conference.

(2) Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a disclosure, discovery or pre-trial conference.

(j) * * *

(3)(i) Disclosures but not disclosed documents, a discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the written disclosure, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

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

* * * * *

(5) Disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the receiving or inquiring party except that, if fewer than all of the disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional disclosures or discovery responses listed in the disclosing or responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional disclosures or responses.

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

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

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

11. Revise paragraphs (a) and (d), and add paragraph (e), to read as follows:

§ 2.121 Assignment of times for taking testimony.

(a) The Trademark Trial and Appeal Board will issue a trial order setting a deadline for required pre-trial disclosures and 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. The deadline for pre-trial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule the pre-trial disclosure deadline and testimony periods is denied, the deadline and testimony periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of the pre-trial disclosure deadline and testimony periods without action by any party.

* * * * *

(d) When parties stipulate to the rescheduling of the deadline for pre-trial disclosures and testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of the deadline for pre-trial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board.

(e) A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. Each party must

disclose the name and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general information about the witness, a summary of subjects on which the witness is expected to testify, and a general summary of the types of documents and things which may be introduced as exhibits during the testimony of the witness. Pre-trial disclosure of a witness under this subsection does not substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pre-trial disclosure. When a party fails to make required pre-trial disclosures, any adverse party or parties may have remedy by way of a motion to the Trademark Trial and Appeal Board to delay or reset testimony periods.

12. Revise § 2.122(d)(1) to read as follows:

§ 2.122 Matters in evidence.

* * * * *

(d) Registrations. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the 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).

* * * * *

13. Revise § 2.123(e)(3) to read as follows:

§ 2.123 Trial testimony in inter partes cases.

* * * * *

(e) * * *

(3) Every adverse party shall have full opportunity to cross-examine each witness. If pre-trial disclosures or the notice of examination of witnesses which is served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper pre-trial disclosure or proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

* * * * *

14. Remove § 2.126(b) and redesignate paragraphs (c) and (d) as paragraphs (b) and (c), respectively, and revise paragraph (a)(6) to read as follows:

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

(a) * * *

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

* * * * *

15. Revise § 2.127(a), (c), and (e) to read as follows:

§ 2.127 Motions.

(a) Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within 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 granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within fifteen 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. Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

* * * * *

(c) Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board or by an Interlocutory Attorney of the Board to whom authority so to act has been delegated.

* * * * *

(e)(1) A party may not file a motion for summary judgment until the party has made its initial disclosures. 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 30 days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion for summary judgment may remain as specified under this section. A reply brief, if filed, shall be filed within 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 for summary judgment will be considered by the Board.

(2) For purposes of summary judgment only, disclosures or disclosed documents, a discovery deposition, or an answer to an interrogatory, or a document or thing produced in response to a request for production, or an admission to a request for admission, will be considered by the Trademark Trial and Appeal Board if any party files, with the party's brief on the summary judgment motion, the written disclosures or disclosed documents, deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for production and the documents or things produced in response thereto, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an

admission was requested failed to respond thereto).

* * * * *

16. Revise § 2.129(a) to read as follows:

§ 2.129 Oral argument; reconsideration.

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

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17. Revise § 2.133 (a) and (b) to read as follows:

§ 2.133 Amendment of application or registration during proceedings.

(a) An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion approved by the Board.

(b) If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party.

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18. Revise § 2.142(e)(1) to read as follows:

§ 2.142 Time and manner of ex parte appeals.

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

* * * * *

19. Revise § 2.173(a) to read as follows:

§ 2.173 Amendment of registration

(a) A registrant may apply to amend a registration or to disclaim part of the mark in the registration. The registrant must submit a written request specifying the amendment or disclaimer and, if the registration is involved in an inter partes proceeding before the Trademark Trial and Appeal Board, the request must be filed by appropriate motion. This request must be signed by the registrant and verified or supported by a declaration under § 2.20, and accompanied by the required fee. If the amendment involves a change in the mark, the registrant must submit a new specimen showing the mark as used on or in connection with the goods or services, and a new drawing of the amended mark. The registration as amended must still contain registrable matter, and the mark as amended must be registrable as a whole. An amendment or disclaimer must not materially alter the character of the mark.

* * * * *

20. Revise § 2.176 to read as follows:

§ 2.176 Consideration of above matters.

The matters in §§ 2.171 to 2.175 will be considered in the first instance by the Post Registration Examiners, except for requests to amend registrations involved in inter partes proceedings before the Trademark Trial and Appeal Board, as specified in § 2.173(a), which shall be considered by the Board. If an action of the Post Registration Examiner is adverse, registrant may petition the Director to review the action under § 2.146. If the registrant does not respond to an adverse action of the Examiner within six months of the mailing date, the matter will be considered abandoned.

Dated: January 4, 2006.

Jon W. Dudas,

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

[FR Doc. 06–197 Filed 1–13–06; 8:45 am]

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ENVIRONMENTAL PROTECTION AGENCY

40 CFR Parts 60 and 61

[FRL–8013–3]

Delegation of New Source Performance Standards and National Emission Standards for Hazardous Air Pollutants for the States of Arizona, California, Hawaii, and Nevada

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA is proposing to approve updates for delegation of certain federal standards to state and local agencies in Region IX for delegation of New Source Performance Standards (NSPS), and National Emission Standards for Hazardous Air Pollutants (NESHAPs). This document is addressing general authorities mentioned in the regulations for NSPS and NESHAPs, proposing to update the delegations tables and clarifying those authorities that are retained by EPA.

DATES: Any comments on this proposal must arrive by February 16, 2006.

ADDRESSES: Send comments to Andy Steckel, Rulemaking Office Chief (AIR–4), U.S. Environmental Protection Agency, Region IX, 75 Hawthorne Street, San Francisco, CA 94105–3901, or e-mail to *steckel.andrew@epa.gov*, or submit comments at *http://www.regulation.gov*.

Please contact Cynthia G. Allen at (415) 947–4120 to arrange a time if inspection of the supporting information is desired.

FOR FURTHER INFORMATION CONTACT: Cynthia G. Allen at (415) 947–4120, U.S. Environmental Protection Agency, Region IX, Rulemaking Office (Air-4), 75 Hawthorne Street, San Francisco, CA 94105.

SUPPLEMENTARY INFORMATION: This proposal updates the delegation tables in 40 CFR parts 60 and 61, to allow easier access by the public to the status of local jurisdictions. In the Rules and Regulations section of this **Federal Register**, we are updating these delegations tables in a direct final action without prior proposal because we believe these delegations are not controversial. If we receive adverse comments, however, we will publish a timely withdrawal of the direct final rule and address the comments in subsequent action based on this proposed rule.

We do not plan to open a second comment period, so anyone interested in commenting should do so at this