

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

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

RIN 0651-AC35

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

**SUMMARY:** The United States Patent and Trademark Office (“USPTO” or “Office”) is amending the Trademark Rules of Practice (“Trademark Rules” or “Rules”), in particular the rules pertinent to practice before the Trademark Trial and Appeal Board (“Board”), to benefit the public by providing for more efficiency and clarity in inter partes and ex parte proceedings. Certain amendments are directed to reducing the burden on the parties, to conforming the rules to current practice, to updating references that have changed, to reflecting technologic changes, and to ensuring the usage of standard, current terminology. This final rule also furthers strategic objectives of the Office to increase end-to-end electronic processing.

**DATES:** This rule is effective January 14, 2017.

**FOR FURTHER INFORMATION CONTACT:** Cheryl Butler, Trademark Trial and Appeal Board, by email at [TTABFRNotices@uspto.gov](mailto:TTABFRNotices@uspto.gov), or by telephone at (571) 272-4259.

**SUPPLEMENTARY INFORMATION:**

*Executive Summary: Purpose:* The amendments to the rules emphasize the efficiency of electronic filing, which is already utilized by most parties in Board proceedings. In particular, all submissions will be filed through the Board’s online filing system, the Electronic System for Trademark Trials and Appeals (“ESTTA”) (available at <http://www.uspto.gov>), except in certain limited circumstances. To simplify proceedings, the Office is resuming service requirements for notices of opposition, petitions for cancellation, and concurrent use proceedings, and is requiring parties to serve all other submissions and papers by email. The amended rules promote other efficiencies in proceedings, such as imposing discovery limitations, and allowing parties to take testimony by affidavit or declaration, with the option for oral cross-examination. The proportionality requirement

implemented in the 2015 amendments to the Federal Rules of Civil Procedure is expressly reflected in the Board’s amended rules, which in part adapt to recent changes to the Federal Rules of Civil Procedure while taking into account the administrative nature of Board proceedings.

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

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

References below to “the Act,” “the Trademark Act,” or “the statute” refer to the Trademark Act of 1946, 15 U.S.C. 1051 *et seq.*, as amended. References to “TBMP” refer to the June 2016 edition of the Trademark Trial and Appeal Board Manual of Procedure.

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

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

*Electronic Environment**Filing*

The amended rules require all filings be made through ESTTA, except examining attorney filings in ex parte appeals which are filed through the Office’s internal electronic system.

*Service and Electronic Communication*

In 2007, the USPTO amended the rules to require each plaintiff to serve the complaint on the defendant. This was a change from long-standing practice where the Board served the complaint on the defendant with the notice of institution. The rules now shift the responsibility for serving the complaint back to the Board. However, in keeping with the progress toward complete electronic communication, the Board will not forward a paper copy of the complaint, but rather will serve the complaint in the form of a link to, or web address for the Board’s electronic case file system (“TTABVUE”) in the notice of institution.

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

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

this final rule. The response period for a motion is initiated by its service date and runs for 20 days, except that the response period for summary judgment motions remains 30 days. Similarly, no additional time is available for the service of discovery responses.

#### *Streamlining Discovery and Pretrial Procedure*

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

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

The amended rules limit the number of requests for production of documents and requests for admissions to 75, the same as the current limitation on interrogatories, with the option to move for additional requests for good cause. In addition, the rules allow for each party that has received produced documents to serve one comprehensive request for admission on the producing party, whereby the producing party would authenticate specific produced documents or specify which of those documents cannot be authenticated. These limitations on discovery simply recognize general practice and are meant to curtail abuse and restrain litigation expense for stakeholders.

Many trial cases are quickly settled, withdrawn, or decided by default, and many others involve cooperative parties who engage in useful settlement and discovery planning conferences. For more contentious cases, parties may request involvement of a Board Interlocutory Attorney in the conference, and this final rule codifies

the ability of the Interlocutory Attorneys to sua sponte participate in a discovery conference when they consider it useful. In addition, the circumstances under which telephone conferences with Interlocutory Attorneys can be sought by a party or initiated by the Interlocutory Attorney are broadened to encompass any circumstance in which they “would be beneficial.”

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

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

In 2007, the rules were amended to make the Board’s standard protective order applicable in all proceedings, during disclosure, discovery, and trial, though parties have been able to agree to alternative orders, subject to Board approval. This has worked well, and this final rule clarifies that the protective order is automatically applicable in all inter partes proceedings, subject to specified exceptions. Parties continue to have the flexibility to move forward under an alternative order by stipulation or motion approved by the Board. This final rule also codifies practice and precedent that the Board may treat as not confidential material that cannot reasonably be considered confidential, notwithstanding party designations. See *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402–03 (TTAB 2010).

Since 2007, several types of consented motions for extensions and suspensions have been granted automatically by the Board’s electronic filing system and this final rule codifies this practice, while

retaining the ability of Board personnel to require that certain conditions be met prior to approval. Thus, the practice by which some consented motions to extend or suspend are not automatically approved and are reviewed and processed by a Board paralegal or attorney continues. In addition, non-dispositive matters can be acted on by paralegals, and the rules clarify that orders on motions under the designation, “By the Trademark Trial and Appeal Board,” have the same legal effect as orders by a panel of three judges.

To clarify the obligations of the parties and render the status and timeline for a case more predictable, this final rule provides that a trial proceeding is suspended upon filing of a timely, potentially dispositive motion.

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

The existing rule for convening a pretrial conference because of the complexity of issues is amended so that it is limited to exercise only by the Board, upon the Board’s initiative.

#### *Efficient Trial Procedures*

For some time now, parties have had the option to stipulate to ACR, which can be adopted in various forms. A common approach is for parties to stipulate that summary judgment cross motions will substitute for a trial record and traditional briefs at final hearing and the Board may resolve any issues of fact that otherwise might be considered subject to dispute. Other approaches adopted by parties utilizing the efficiencies of the ACR process have included agreements to limit discovery, agreements to shorten trial periods or the time between trial periods, stipulations to facts or to the admissibility of documents or other evidence, and stipulations to proffers of testimony by declaration or affidavit. These types of efficiencies are codified through this final rule by specifically providing for such stipulations and, most significantly, by allowing a unilateral option for trial testimony by affidavit or declaration subject to the right of oral cross-examination by the adverse party or parties. Parties also continue to be able to stipulate to rely

on summary judgment materials as trial evidence.

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

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

Under the rule changes, a party must file any motion to use a discovery deposition at trial along with its pretrial disclosures. Also, an adverse party is able to move to quash a notice of testimony deposition if the witness was not included in the pretrial disclosures, and an adverse party is able to move to strike testimony presented by affidavit or declaration if the witness was not included in the pretrial disclosure.

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

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

an electronic submission must be clear and legible.

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

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

#### *Remand Procedures/Appeal Procedures*

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

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

The amended rules align more closely the terminology of § 2.130 pertaining to the Board referring applications involved in inter partes proceedings back to the Trademark Examining Operation upon request with that of § 2.142(d) and (f)(6) remanding applications involved in ex parte appeals back to the Trademark Examining Operation. This is not a change to the substance of the existing rule.

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

Correlative to electronic filing and communication, the Board also has made it possible for parties, examining attorneys, and members of the Board to attend hearings remotely through video conference. This final rule codifies that option.

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

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

Requirements for filing appeals of Board decisions are restructured to align with the rules governing review of Patent Trial and Appeal Board decisions. Further, all notices of appeal to the United States Court of Appeals for the Federal Circuit must be filed with the USPTO's Office of General Counsel and a copy filed with the Board via ESTTA. When a party seeks review of a Board inter partes decision by commencing a civil action, the amendments clarify that a notice of such commencement must be filed with the Board via ESTTA to avoid premature termination of the Board proceeding during pendency of the civil action. The amendments further require that both a notice and a copy of the complaint for review of an ex parte decision by way of civil action are to be filed with the USPTO's Office of General Counsel with a copy to be filed with the Board via ESTTA. In addition, requests to extend the time for filing an appeal, or commencing a civil action, are to be filed as provided in 37 CFR 104.2 and addressed to the attention of the Office of the Solicitor, and a copy should be filed with the Board via ESTTA.

#### *Public Participation*

The Board began in 2015 looking ahead to the implementation of changes in the Federal Rules of Civil Procedure then scheduled to take effect in December 2015. The Board also looked back on its multi-year campaign to

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

#### **Proposed Rule and Request for Comments**

A proposed rule was published in the **Federal Register** on April 4, 2016, at 81 FR 19295–19324. The Office received comments from five intellectual property organizations, two law firms, and 10 attorneys. These comments are posted on the Office's Web site at <http://www.uspto.gov/trademark/trademark-updates-and-announcements/comments-miscellaneous-changes-ttab-rules-practice>, and are addressed below.

The Office received many positive comments in favor of several rule changes and appreciates the public support. To streamline this final rule, such comments expressing support are not individually set forth and no specific responses to such comments are provided. In addition, comments and responses that apply more generally to issues and multiple rules are presented under the heading General Comments and Responses, while other comments and responses are interwoven into the Discussion of Rule Changes to provide context for those comments. Comments outside the scope of this rulemaking have been considered even if not specifically addressed herein.

#### **General Comments and Responses**

##### *Electronic Filing*

*Comment:* One commenter noted that no ESTTA form exists for a combined notice of opposition and petition for cancellation, and suggested that either ESTTA should be enhanced to accommodate this filing, or an exception for paper filing with no fee should be permitted.

*Response:* In view of the extremely small number of combined complaints, no ESTTA enhancement will be undertaken in the near future to accommodate this type of filing. Rather, a comparable outcome can be achieved by electronically filing separately a notice of opposition and a petition for cancellation and simultaneously requesting consolidation. The fee amount remains unchanged, as the combined filing did not provide any avoidance or reduction of fees per party or class sought to be opposed or cancelled. See TBMP section 305.02. Although the commenter noted the additional expense of requesting consolidation, the expense should be relatively minimal. Therefore, no exception to the requirement to file by ESTTA will be made for a combined filing, and prior case law allowing for this type of combined notice of opposition and petition for cancellation is superseded by the mandatory online filing requirement.

To facilitate proper handling, the motion for consolidation in this situation should be included in the same filing with the petition for cancellation, the institution of which will be processed by Board personnel rather than automatically instituted, as with most oppositions. The attached pleading should include a prominent reference to the motion to consolidate. This procedure will help bring the requested consolidation to the Board's attention more promptly.

##### *Service by the Board*

*Comment:* Although all commenters who addressed the proposal supported the Board's resumption of its pre-2007 practice of serving the complaint, some commenters shared concerns about the manner of service. The proposed rules provided that, in all cases except those challenging a registered extension of protection under the Madrid Protocol, if the parties had provided email addresses to the Office, the Board would serve the complaint in the form of an email notice with a link to the appropriate entry in TTABVue. Commenters articulated worry that the proposed method of serving the complaint may not sufficiently convey

to pro se parties the seriousness of the proceeding or the importance of timely responding to the complaint. Some commenters expressed apprehensions that parties might mistake the email notice for a trademark-related solicitation, and therefore disregard it. Also regarding Board service of complaints by email, several commenters conveyed apprehensions that service emails may not reach the intended recipient either because of spam filtering or outdated email contact information. One commenter suggested informing applicants and registrants of the possibility of this type of email notification.

*Response:* With regard to cancellations, at this juncture, the Board intends to serve by U.S. mail, pending system enhancements to facilitate email service. In anticipation of a future move toward email service of complaints in cancellation proceedings, the Office will supplement its existing efforts to emphasize to registrants the importance of maintaining correct and current email address information with the Office and taking steps to ensure that Office emails are not blocked by servers or spam filters, or diverted to junk mail folders. See, e.g., the USPTO Web page entitled "Don't Miss Important E-Mails from the USPTO: Add the USPTO to your 'Safe Senders' list," which includes instructions to ensure that USPTO emails reach the recipient. In addition, the Office plans to implement the suggestion made by one commenter that the Office specifically notify registration owners when they receive their registration certificates that the Current Owner Address information in the USPTO's Trademark Status and Document Retrieval ("TSDR") database, including the email address, may be used for service.

Turning to oppositions, the rules provide that notice of the opposition will be sent to the "email or correspondence address" of the appropriate recipient, as specified in the rules. Applicants would receive notices by email only if email communication has been authorized. Having authorized email communication, the recipient should be aware that this may include official USPTO correspondence requiring a timely response. Moreover, applicants who have authorized email during the examination of their applications likely will be accustomed to receiving important email notices from the Office, including Office Actions that required a timely response to avoid abandonment of the application. Thus, notice of an opposition to which they must respond will be similar. As all of the USPTO

electronic systems are enhanced and email communication is more widely authorized, the rule allows the Board the flexibility to increase the proportion of notices sent only by email. As a reminder, § 2.18(b)(1) requires applicants, registrants, and parties to proceedings to promptly notify the Office of any change in physical address or email address.

The Office also plans to continue its efforts to educate the public about trademark solicitations and how to distinguish them from USPTO communications. See, e.g., the USPTO Web page entitled “WARNING: Non-USPTO Solicitations That May Resemble Official USPTO Communications” and the educational video on the USPTO Web site entitled “TM Newsflash 16: Solicitation Alert.” Also, the Office continues to work with enforcement agencies on fraudulent solicitations, including those that recipients are misled into believing come from the USPTO. The Office has been successfully using email communication in many aspects of Board proceedings and for other trademark-related communications, and will use this experience to make its email service of the notice of opposition as effective as possible.

*Comment:* Some commenters noted that the USPTO’s databases contain multiple fields for address and email address information, and sought clarification as to what address and email information would be used for service by the Board.

*Response:* As noted above, at this juncture, in cancellation proceedings, the Board intends to serve by U.S. mail, pending system enhancements to facilitate email service at a later date. The Office plans to effect service using the “Current Owner Information” field or, if one has been appointed, the “Domestic Representative Information” field in the USPTO’s TSDR database. For opposition proceedings, the terminology “email or correspondence address of record” in the rule refers to “correspondence address” as it is used throughout the Rules of Practice in Trademark Cases (e.g., §§ 2.18, 2.21, 2.22, 2.23) and the addition of “email” merely highlights that an email correspondence address may be used when authorized.

*Comment:* Other commenters inquired about any procedures the Board might follow prior to entry of default judgment when the Board served the complaint by email.

*Response:* Where there is no authorized email address, the Board continues to mail both the institution notice and the notice of default to the

appropriate physical address. Where there is an authorized email address, the notice of default will go to that same email address. When the Board serves the institution notice in an opposition proceeding using an authorized email address but receives a notification that the email was undeliverable, Board staff investigate other possible addresses for forwarding the institution notice; if no other address is found, the Board effects service by publication in the Official Gazette. In addition, the Office encourages trademark owners to exercise due diligence in monitoring the status of their registrations online through the USPTO database.

*Comment:* One commenter proposed clarifying language in §§ 2.105(b)(2) and 2.113(b)(2) to provide that a plaintiff’s domestic representative will be served with a copy of the notice of the opposition or the cancellation proceeding only if appointed as the domestic representative in the Board proceeding.

*Response:* The proposed amendment of these rules only pertained to adding email as a possible correspondence address. The rule language for which clarification is sought by the commenter is longstanding, and there has been no confusion as a result of the wording. The current terminology “opposer has appointed” and “petitioner has appointed” refers to the parties’ roles in the Board proceeding, and therefore contemplates an appointment in the proceeding. Therefore, no changes are made in response to the comment.

#### *Effective Date Applicable for Pending Cases*

*Comment:* Some commenters expressed concern with the application of the new rules to all pending cases and requested assurance that the Board will remain flexible in granting extension of the discovery and trial periods to accommodate issues that may arise; for example, docketing issues regarding discovery, email service, and timing. The rules call for electronic service of documents between parties and remove the additional five days added to deadlines when parties choose to serve by mail.

*Response:* The Board has accommodated these concerns by publishing this final rule well in advance of the effective date. This allows time for the parties to take appropriate actions in cases pending on the publication date and prepare their docketing for the new rules. In view of the delayed effective date, the Board does not anticipate many scheduling or other difficulties as a result of the new rules; however, the Board may entertain

scheduling issues that still arise in cases pending prior to the publication date as a result of the final rules where appropriate. To the extent issues arise despite the delayed effective date, parties are encouraged to resolve issues by stipulation. With regard to service, under the new rules parties may stipulate to any type of service, including by mail, and the extra five days previously provided by § 2.119(c) are already built into the response time period.

#### *Evidentiary Rulings*

*Comment:* One commenter suggested that one judge should rule on evidentiary issues and decide whether the panel of judges should see the evidence, so that judges ruling on the final decision have not seen evidence that has been stricken.

*Response:* The Board has not observed any detrimental effect of having the same panel rule on the evidentiary objections and the final decision. The panel assigned at final decision reviews the complete record, which would include any determinations made on evidentiary objections. As the Board has noted, Rule 403 of the Federal Rules of Evidence “assumes a trial judge is able to discern and weigh the improper inferences that a jury might draw from certain evidence, and then balance those improprieties against probative value and necessity . . . [as well as] exclude those improper inferences from his mind in reaching a decision.” *Ava Ruha Corp. v. Mother’s Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1579 (TTAB 2015) (quoting *Gulf States Utils. Co. v. Ecodyne Corp.*, 735 F.2d 517, 510 (5th Cir. 1981)). To the extent that the comment is directed to procedural concerns, those are already handled by interlocutory decisions. Parties should make sure that curable defects are brought up early so that the objections may be considered. Those objections that are substantive in nature go to the weight of the evidence, which is routinely handled by judges. See *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007). This would also not be an efficient way of handling objections that are raised during testimony depositions in particular and in responses to affidavits, as many of these objections are not maintained in the briefs. Thus, such rulings would be premature.

#### *Grammar/Nomenclature*

*Comment:* One commenter provided various comments to add commas, and change “may not” to “will not” or “shall not” etc., and to continue to use

the term Examiner as it is used in various other Trademark Rules.

*Response:* The comma placement and use of “may” versus “will” or “shall” are purposeful and remain. With regard to retention of the term “Examiner,” the phraseology of choice for the Board in the amendments is “trademark examining attorney” or “examining attorney,” consistent with terminology in Board procedure.

#### *Counting Dates*

*Comment:* One commenter expressed concern that the Rules and the TBMP do not explain whether in inter partes proceedings the initial day triggering the time period is to be counted, and whether the action is due on the final day or on the day after the final day of the specified period. The commenter indicated that it would be helpful if either the rules or the manual explained the inclusion/exclusion of the first and last days of the period, similar to Rule 6(a)(1) of the Federal Rules of Civil Procedure.

*Response:* The Board has a longstanding practice that follows Rule 6(a)(1) of the Federal Rules of Civil Procedure pursuant to § 2.116 that has not presented problems. There is no foreseeable need to specify in the rules how to count days. To do so could require changing other rules beyond those proposed for amendment by the NPRM.

#### *Creating Efficiencies*

*Comment:* One commenter questioned whether speeding up proceedings is an advantage. As previous statistics show, well over 90% of TTAB cases are withdrawn, settled, or defaulted and do not require a final decision. A major advantage of the slower paced proceedings is the time provided to permit resolution of the dispute without significant financial investment. With this in mind, the proposed rules designed to speed up the process are of questionable value.

*Response:* Parties may continue to stipulate or request extensions or suspensions. The Board will continue its practice of being flexible to facilitate concurrent settlement of the Board case and other issues, which may involve use matters and other jurisdictions. However, the Board also recognizes, as do many parties, that deadlines facilitate settlement discussions. Where the parties seek speedier and more cost effective resolution, the new rules provide tools to support that goal.

#### *Discovery Sanctions*

*Comment:* One commenter expressed concern that the Board’s proposed rules

provide no additional sanctions, and thus will not prevent parties from abusing discovery.

*Response:* Although it is not the Board’s practice to award monetary sanctions, the Board has available a full range of other sanctions, including judgment. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000). The Board will continue its practice of active case management and the imposition of appropriate sanctions.

#### *Withdrawal of Application Without Prejudice*

*Comment:* Two commenters suggested that applicants be able to withdraw an application without consent and without prejudice prior to the filing of an answer in oppositions before the Board. According to the comments, there are many reasons why a party may prefer not to litigate unrelated to the substantive merits of the case. Because of the claim-preclusive effect (in subsequent Board cases) of such a judgment, well positioned opposers are enabled to take advantage of applicants with limited financial resources to force them to surrender their rights with no chance to obtain trademark registration if circumstances change.

*Response:* This subject is outside the scope of the current rulemaking. The Office notes this is a longstanding practice, but the Office may consider it in a future rulemaking. Currently, applicants may abandon an application without prejudice during the publication and extension of time periods prior to the filing of a notice of opposition. *See* TBMP section 218.

#### *Judicial Notice of USPTO Records*

*Comment:* One commenter suggested that the Board take judicial notice of USPTO records, and, in particular, allow parties to introduce registrations into the record by only the registration number, rather than by the inclusion of the full content of the registration in document form.

*Response:* The Board considered this option but decided not to adopt it at this time. The USPTO has an obligation to preserve a complete written record of Board proceedings that contains all of the evidence presented by the parties in documentary form for a variety of purposes, including possible judicial review. *See* 15 U.S.C. 1071(a)(3) (the United States Court of Appeals for the Federal Circuit may request that the USPTO forward to the court the original or certified copies of the documents in the record). The official record of a Board proceeding must be complete, accurate, and reliable, especially

because in direct appeals to the Federal Circuit the court’s review of the Board’s decision is confined to the four corners of the administrative record. Although parties can enter pleaded registration and application numbers into ESTTA when they submit a pleading, which automatically populates the party caption field in TTABVUE with links to the USPTO’s trademark file for the specified registration or application number, unlike subject applications and registrations which are by rule automatically part of the record, the provision of the link to the trademark file does not make it of record in the Board proceeding. Moreover, the registration and application numbers in the party caption field may or may not be comprehensive because some pleaded registration and application numbers are only referenced in the attached pleading, which does not prepopulate the party caption field in TTABVUE. The burden of creating a complete evidentiary record by introducing in documentary form information contained in the USPTO’s trademark file records is most appropriately borne by the party wishing to introduce such evidence rather than by the Board. Finally, parties are reminded that it is important for them to review their pleaded registrations to make sure the owner name and any assignments are up to date. As the USPTO plans for enhancements to its electronic systems and databases, user requests for a more streamlined approach for introducing USPTO records into evidence in a Board proceeding will be considered.

#### *Create Central Online Docket for Dates and Deadlines*

*Comment:* One commenter requested that the Board, through either ESTTA or TTABVUE, provide a central online docket where the parties and the Board can access a definitive list of dates and deadlines in inter partes matters, which would be updated automatically to reflect the current status of the proceeding.

*Response:* The suggestion falls outside the scope of the current rulemaking. However, this suggestion, which previously has been made in other venues for public comment on Board electronic systems, will be considered as the USPTO plans for enhancements to its electronic systems and databases.

## Discussion of Rule Changes

### Interferences and Concurrent Use Proceedings

#### *Preliminary to Interference*

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

*Comment:* Some commenters do not want this change because “examiner” is used in other parts of the Trademark Rules and “examining attorney” increases the length of briefs.

*Response:* While the Trademark Rules continue to use the term “examiner” in some locations, the Board desires consistency within its rules of procedure and has retained these amendments.

#### *Adding Party to Interference*

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

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

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

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

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

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

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

## Opposition

### *Filing an Opposition*

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

The Office is amending § 2.101(b)(1) to require that oppositions be filed by the due date in paragraph (c) through ESTTA. The amendment codifies the use of electronic filing.

The Office is amending § 2.101(b)(2) to provide that an opposition against an application based on Sections 1 or 44 of the Trademark Act may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The amendment also requires that a paper opposition to an application must be accompanied by a Petition to the Director under § 2.146 with the required fees and showing, and to add that timeliness of the submission will be determined in accordance with §§ 2.195 through 2.198.

The Office is amending § 2.101(b) by adding a new paragraph (b)(3) that continues the existing unconditional requirement that an opposition to an application based on Section 66(a) of the Trademark Act must be filed through ESTTA.

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

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

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

*Comment:* One commenter expressed concerns about attorney docketing systems in light of the proposed amendments to § 2.101(d) and (e) regarding the filing date of an opposition filed electronically versus one filed on paper.

*Response:* While the filing date of an opposition may depend on the method of filing, the filing date never complicates attorney docketing systems because the due date for an answer and subsequent proceeding deadlines are set by the Board’s institution order and are not a function of the filing date.

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

The Office is amending § 2.102 to omit references to “written” requests for extensions of time, as it is unnecessary in view of the requirement in § 2.191

that all business be conducted in writing.

The Office is amending § 2.102(a)(1) to require that requests to extend the time for filing an opposition be filed through ESTTA by the opposition due date in paragraph 2.101(c). The amendment continues the existing requirement that an opposition to an application based on Section 66(a) of the Act must be filed through ESTTA, but provides that an opposition against an application based on Sections 1 or 44 of the Act may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The Office is amending § 2.102(a)(2) to require that a paper request to extend the opposition period must be accompanied by a Petition to the Director under § 2.146, with the required fees and showing, and to add that timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

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

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

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

*Comment:* One commenter sought clarification regarding the Office’s method of notifying an applicant of an extension of time to oppose, suggesting email notification in cases where the applicant has authorized email communication.

*Response:* Currently, the notices to applicants of extensions of time to oppose are delivered by postcards that are automatically generated. The Office intends to implement email notification of applicants who have authorized email communication in the future, but the transition requires system enhancements that cannot be made in the very near future.

### Contents of Opposition

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

The Office is adding new § 2.104(c) to clarify that with respect to an opposition to an application filed under Section 66(a) of the Trademark Act, the goods and/or services opposed and the grounds for opposition are limited to those set forth in the ESTTA cover sheet. The amendment conforms with Section 68(c)(3) of the Act, is consistent with the amendment to § 2.107(b), and codifies current case law and practice.

*Comment:* One commenter suggested that the rules state that in situations where a party's ESTTA cover sheet is inconsistent with the accompanying pleading, the ESTTA cover sheet would be considered controlling. Another commenter suggested the opposite proposing that the rules specify that in such situations, the pleading would be considered controlling.

*Response:* The ESTTA cover sheet is considered part of the complete opposition pleading. See *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (“Since ESTTA’s inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board”). Proposed § 2.104(c) regarding the inability to add goods, services, or grounds beyond those set forth in the ESTTA cover sheet pertained only to oppositions to applications under Trademark Act section 66(a), 15 U.S.C. 1141f(a) (Madrid Protocol applications), and the final rule clarifies that for such oppositions only, the ESTTA cover sheet controls the scope of the opposition. Use of ESTTA has been and continues to be mandatory for the filing of either extensions of time to oppose or notices of opposition against Madrid Protocol applications. The requirement to use ESTTA for such filings enables the Office to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization (IB) of oppositions and the grounds therefor against Madrid Protocol applications. So, because the grounds for opposition indicated on the ESTTA cover sheet are used for the automatic electronic transmission of the requisite notice to the IB, they cannot be changed, even in circumstances where the attached complaint differs from the cover sheet.

However, with respect to oppositions against applications under Trademark Act sections 1 and 44, 15 U.S.C. 1051 and 1126, the concerns with Madrid Protocol applications and notification to the IB do not apply. Therefore, the scope of an opposition need not necessarily be limited to what is set forth in the ESTTA cover sheet, and the complete opposition pleading may inform the scope. Because the primary purpose of the pleadings is to give fair notice of the claims asserted, a complaint may be amended in accordance with Rule 15 of the Federal Rules of Civil Procedure.

*Comment:* One commenter suggested clarifications in § 2.104(c) to add the prohibition against amending to add joint opposers, found in § 2.107(b), to the statement regarding the prohibition against adding opposed goods, services, and grounds not in the ESTTA cover sheet.

*Response:* This suggested addition is not included in the final rule, but § 2.104(c) has been revised in light of the comment by removing references to amendments for pleadings, which are addressed in § 2.107(b). Section 2.104 concerns the contents of the incoming notice of opposition and the ESTTA cover sheet, and § 2.104(c) codifies the distinction that oppositions to Madrid Protocol applications are limited to the goods, services, or grounds set forth in the ESTTA cover sheet. By contrast, in oppositions to applications under Sections 1 or 44(e) of the Act, the ESTTA cover sheet does not control, and the goods, services, or grounds in the accompanying statement may be considered. With opposers, regardless of the basis of the opposition application, the opposers identified in the ESTTA cover sheet determine the fees paid through ESTTA. Any additional opposers named only in the accompanying statement, for whom no fees have been paid, will not be part of the proceeding, regardless of the filing basis of the opposed application. See *Syngenta Crop Protection Inc. v. Bio-Check LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (second opposer named in the notice of opposition but not on the ESTTA cover sheet, for whom no fee was paid, not party to the proceeding). Therefore, because no distinction exists in the treatment of joint opposers omitted from the ESTTA cover sheet but included in the accompanying statement, it was deemed inappropriate to include a reference to joint opposers in § 2.104(c), which is otherwise directed to a distinction for oppositions to Madrid Protocol applications.

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

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

*Comment:* One commenter suggested changing “mailing date of the notice” to “date the Board sends the notice” in § 2.105(a) and the corresponding rule in § 2.113(a) because the proposed rules provide that the Board may serve the notice by email.

*Response:* The phrase “mailing date” in these rules refers to the date that appears on the order, whether generated by ESTTA or manually by Board staff, and therefore the Office has retained that phrasing.

The Office is amending § 2.105(b) and (c) to provide that it will effect service of the notice of opposition at the email or correspondence address of record for the parties, their attorneys, or their domestic representatives.

### Answer

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

The Office is amending § 2.106(b)(1) to require that answers be filed through ESTTA, but provides that they may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. An answer filed on paper must be accompanied by a Petition to the Director under § 2.146, with the required fees and showing. The amendment codifies the use of electronic filing.

The Office is amending renumbered § 2.106(b)(2) to specify that a reply to an affirmative defense shall not be filed.

The Office is amending renumbered § 2.106(b)(3)(i) to add a requirement that an applicant subject to an opposition proceeding must promptly inform the Board of the filing of another proceeding between the same parties or anyone in privity therewith.

The Office is amending renumbered § 2.106(b)(3)(iv) to clarify that the Board may sua sponte reset the times for pleading, discovery, testimony, briefs, or oral argument.



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

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

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

*Comment:* A few commenters suggested clarifications or exceptions to the proposed prohibition in § 2.107 against the addition of joint opposers to an opposition proceeding after the close of the time period for filing an opposition. For example, commenters proposed that adding a joint opposer be permitted for assignees and successors in interest to the opposer in appropriate circumstances.

*Response:* Although assignees or successors may be joined or substituted as party plaintiffs during a proceeding, even when they are “joined,” they are not considered joint opposers. See TBMP section 512. Rather, they stand in the shoes of the assignor or predecessor. The assignor or predecessor may be retained as a party for the limited purpose of facilitating discovery, but the assignee is the party in interest at that point, and no additional fees are charged to add a party, as would be required with a true joint opposer. In view thereof, adding the term “joint opposer” in the rule does not prohibit the joining or substituting of assignees or successors, and therefore the commenter’s suggestion is not adopted.

### **Cancellation**

#### *Filing a Petition for Cancellation*

The Office is amending § 2.111(a) and (b) to remove the petitioner’s requirement to serve a copy of the petition to cancel on registrant.

The Office is amending § 2.111(c)(1) to require that a petition to cancel a registration be filed through ESTTA. The Office is amending § 2.111(c)(2) to provide that a petition to cancel may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The amendment also requires that a paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146, with the required fees and showing, and to add

that timeliness of the submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198. The amendments codify the use of electronic filing.

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

The Office is redesignating § 2.111(c)(4) as § 2.111(e), which clarifies that the filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee and adds that the filing date for a paper petition for cancellation, where permitted, will be determined in accordance with §§ 2.195 through 2.198.

#### *Contents of Petition for Cancellation*

The Office is amending § 2.112(a) to add that the petition for cancellation must indicate, to the best of petitioner’s knowledge, a current email address(es) of the current owner of the registration.

*Comment:* Commenters noted concerns with the proposed rule requiring that the petition for cancellation include “to the best of petitioner’s knowledge,” contact information for the current owner as well as “any attorney reasonably believed by the petitioner to be a possible representative of the owner in matters relating to the registration.” While no commenters objected to providing known contact information, many sought clarification or revised rule language to make clear that no obligation exists for the petitioner to conduct due diligence or any research. Several other commenters objected to this requirement when the necessary contact information for service already appears in the USPTO database and one commenter objected to providing information about possible owners where there is a domestic representative in the record.

*Response:* The final rule language retains the current requirement that the name and address of the current owner must be included, “to the best of petitioner’s knowledge.” This standard has been in the rule for some time, and has not created problems for petitioners. Based on the objections and concerns expressed by commenters, the proposed addition regarding information about possible attorneys is not included in the final rule. Plaintiffs are still encouraged to provide information about a new owner even if there is a listed domestic

representative, as the domestic representative of the prior owner may not be aware of the change. Also, plaintiffs are encouraged to provide current contact information for attorneys or, in the case of registrations under Section 66(a) of the Act, current contact information for the designated representative for the international registration, which may not be in the USPTO database. Providing such information facilitates the Board’s location and service of the proper parties in order to avoid defaults that may subsequently be set aside and thus prolong the process.

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

#### *Notification of Cancellation Proceeding*

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

The Office is amending § 2.113(b) and (c) to provide that it will effect service of the petition for cancellation at the email or correspondence address of record for the parties, their attorneys, or their domestic representatives. The Office is further amending § 2.113(c) to create new paragraphs (c)(1) and (2) for clarity.

*Comment:* One commenter inquired why the Office proposed that for cancellations filed against registered extensions of protection under the Madrid Protocol (Madrid registrations), service would be effected on the international registration holder’s designated representative rather than on the owner, as with other registrations. One commenter suggested eliminating the word “only” before “to the domestic representative” in proposed § 2.113(c)(2).

*Response:* Upon further review, the Office has withdrawn the proposal to serve cancellations filed against Madrid registrations differently, and the final rule sets forth consistent procedures for the service of cancellations, regardless of the basis of the registration. However, for Madrid registrations, the Board will endeavor to forward a courtesy copy of the notice to the international registration holder’s designated representative. Regarding the suggested deletion of “only” from § 2.113(c)(2), the word has been retained to reflect

that service will be through the domestic representative's address rather than the current owner's address. However, the Office retains the discretion to send courtesy copies to whomever the Office deems appropriate.

*Comment:* One commenter inquired about the inconsistency among § 2.113(c)(1), (2), and (3) where not every section included an explicit statement that service of the institution order constitutes service.

*Response:* The inconsistency has been eliminated by the deletion of § 2.113(c)(3). The Office is amending § 2.113(d) to remove "petition for cancellation" and to provide that the courtesy copy of the notice of institution that shall be forwarded to the alleged current owner of the registration will include a web link or web address to access the electronic proceeding record.

#### *Answer*

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

The Office is amending § 2.114(b)(1) to require that answers be filed through ESTTA, but provides that they may be filed in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. An answer filed on paper must be accompanied by a Petition to the Director under § 2.146, with the required fees and showing. The amendment codifies the use of electronic filing.

The Office is amending renumbered § 2.114(b)(2) to clarify that a reply to an affirmative defense shall not be filed. The Office is further amending § 2.114(b)(1) to add that a pleaded registration is a registration identified by number by the party in the position of plaintiff in an original or counterclaim petition for cancellation.

*Comment:* One commenter questioned why there is a difference between the wording in proposed § 2.106(b)(1), now in renumbered § 2.106(b)(2), which uses "shall not" and the wording in § 2.114(b)(2), which uses "need not." The commenter suggested § 2.114(b)(2) be amended to "shall not."

*Response:* The Office has adopted the suggested change.

The Office is amending renumbered § 2.114(b)(3)(i) to add a requirement that a party in the position of respondent and counterclaim plaintiff must promptly inform the Board of the filing

of another proceeding between the same parties or anyone in privity therewith.

The Office is amending renumbered § 2.114(b)(3)(iii) to clarify that the Board may sua sponte reset the period for filing an answer to a counterclaim. The Office is amending renumbered § 2.114(b)(3)(iv) to clarify that the Board may sua sponte reset the times for pleading, discovery, testimony, briefs, or oral argument.

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

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

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

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

The Office is amending § 2.116(g) to clarify that the Board's standard protective order, which is available on the Office's Web site, is automatically applicable throughout all inter partes proceedings, subject to specified exceptions. The Office is further amending § 2.116(g) to add that the Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding a party's designation. The revisions codify current case law and Office practice.

*Comment:* One commenter expressed concern with the proposed amendment to § 2.116(g) providing that the Board may treat information and documents which it determines cannot reasonably be considered confidential as not confidential, notwithstanding a party's designation. It was suggested that the Board provide prior notice, and an opportunity to respond, before reclassifying confidential (and highly confidential or trade secret/commercially sensitive) information or documents. Further, the commenter requested confirmation that the applicable Standard Protective Order is the one currently provided on the USPTO Web site.

*Response:* The purpose of the rule is to codify existing practice to treat improperly designated material that is public information as public. This is narrowly applied and only done when necessary to articulate the Board decision. See, e.g., *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014). The

applicable Standard Protective Order is available on the USPTO Web site, TTAB home page, and is clearly labeled with its effective date. The prior Standard Protective Order is also available, labeled as "retired," with a retirement date.

##### *Suspension of Proceedings*

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

##### *Undelivered Office Notices*

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

##### *Service and Signing*

The Office is incorporating the word "submissions" throughout § 2.119 to codify the use of electronic filing.

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

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

*Comment:* Commenters generally approved of the proposed requirement in § 2.119 that parties in Board proceedings serve each other by email unless they agree to an alternative service method, or unless technical problems or extraordinary circumstances prevent email service. However, some requested clarification about how to address service of voluminous documents for which email might be impractical. Others sought further guidance as to what types of situations might qualify for the exception to email service, even in the absence of agreement between the parties on an alternative method.

*Response:* The Board encourages parties to agree on an effective alternative method of service, such as file hosting services, if email is not practical. In cases where the parties anticipate voluminous productions, for example, this would be a worthwhile issue to discuss at the discovery conference, with Board participation if

the parties deem it necessary. The parties are reminded that under the 2015 amendments to the Federal Rules of Civil Procedure there is a focus on party cooperation in the discovery process which includes service of discovery responses.

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

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

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

*Comment:* Some commenters expressed various concerns that the proposed rules call for electronic service of documents between parties and remove the additional five days, provided by the previously existing § 2.119(c), which were added to deadlines when parties choose to serve by first class mail, Priority Mail Express® and overnight courier.

*Response:* Under the amended rules, parties may stipulate to any type of service, including by mail. The extra five days provided for in former § 2.119(c) are already built into the response time period.

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

#### *Discovery*

The Office is amending § 2.120(a)(1) to add the use of proportionality in process and procedure in discovery, in conformance with the 2015 amendments to the Federal Rules of Civil Procedure, and to reorganize portions of the text for clarity.

The Office is amending § 2.120(a)(2) to add headings for paragraphs (a)(2)(i) through (v) and to reorganize portions of the text for clarity.

The Office is amending renumbered § 2.120(a)(2)(i) to specify that a Board

Interlocutory Attorney or Administrative Trademark Judge will participate in a discovery conference when the Board deems it useful. The revision codifies current Office practice.

*Comment:* One commenter stated with regard to the proposed revisions to § 2.120(a)(2)(i) that it would be useful to have an Interlocutory Attorney or Administrative Trademark Judge consistently available by phone to actively intervene and manage discovery disputes, motion practice, and overly contentious proceedings. The commenter also stated that it would be useful for the Board to issue short minute orders memorializing phone conferences, and to issue orders precluding parties from filing papers without prior leave in overly contentious cases.

*Response:* The Board notes that each of these comments may be satisfied under the existing rules.

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

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

*Comment:* Several commenters expressed concern over the amendment to § 2.120(a)(2)(iv) expressly providing that "limited extensions of the discovery period may be granted upon stipulation or the parties approved by the Board, upon motion granted by the Board. . . ." Commenters commended the Board's flexibility in its proceedings and urged continued flexibility, noting that trademark constituents chose to litigate before the Board over district court because of the Board's flexibility and that the majority of the Board's cases settle because of the Board's flexible schedule and forum, which encourages settlement. Among the recommendations made by commenters were: That the language be removed; that the Board remain liberal in granting requests to extend the discovery period;

that, in view of the amendment to § 2.120(a)(2)(v) requiring all discovery to be served and completed during the discovery period, the Board remain flexible in granting extensions of the discovery period to allow the parties to be able to complete discovery during the discovery period and supplement discovery as required by Rule 26(e) of the Federal Rules of Civil Procedure, as well as to accommodate settlement, especially in view of the acknowledgement that the majority of Board cases settle; and that the Board take a more active role in case management and in exercising its authority to control the disposition of cases.

*Response:* The Board appreciates the commenters' recognition of the flexibility provided by its proceedings. The amendment to § 2.120(a)(2)(iv) reflects existing Board practice, allowing for active case management while meeting the needs of the parties. It imposes neither a numerical limit on extensions of the discovery period nor a stricter standard for granting an extension.

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

*Comment:* Many commenters expressed general support for the amendment requiring that all discovery requests must be served early enough in the discovery period so that all responses will be due no later than the close of the discovery period. One commenter expressed its view that the amendment will facilitate the orderly conclusion of fact discovery and should reduce the frequency of motions to re-open discovery following a party's receipt of a deficient discovery response after the close of discovery. Some commenters, reciting that the stated intent of the amendment is to alleviate motion practice prompted by responses to discovery requests served after discovery has closed, sought clarification of how the proposed rule will alleviate motions practice, noting that the objective may not be accomplished where a party refuses to provide responses and the adversary must bring a motion to compel. One commenter inquired how the amended rule will impact the parties' ongoing obligation to supplement discovery as

required under Rule 26(e) of the Federal Rules of Civil Procedure.

*Response:* The amendment has no impact on current Board practice concerning the ability of parties to seek extensions of the discovery period. The Board anticipates that the amendment will alleviate motion practice by avoiding the uncertainty created by discovery disputes arising after the discovery period has closed where responses have not been served. As observed by one commenter, there will be fewer motions to reopen discovery based on responses received after discovery closed. Similarly, there will be fewer motions to extend the trial schedule because a party is awaiting responses to discovery requests after the close of the discovery period, or has received allegedly insufficient responses after the close of the discovery period. Instead the focus of any dispute will be on the sufficiency of the responses at issue. The amendment also has no effect on a party's duty to supplement discovery as required under Rule 26(e) of the Federal Rules of Civil Procedure.

*Comment:* Two comments were submitted concerning the effect of the proposed amendment to § 2.120(a)(3).

*Response:* The amendment has no impact on current Board practice concerning the ability of parties to seek extensions of the discovery period. The Board anticipates that the amendment will alleviate motion practice by avoiding the uncertainty created by discovery disputes arising after the discovery period has closed where responses have not been served. Instead, the focus of any dispute will be on the sufficiency of the responses at issue.

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

The Office is amending the title of § 2.120(c) to clarify that it applies to foreign parties within the jurisdiction of the United States.

*Comment:* Several comments addressed a proposed amendment to § 2.120(c)(2) requiring that a party must inform every adverse party when a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf present within the United States. One commenter stated that some of its members believed the change would be positive and eliminate the need to seek this information by interrogatory. The remaining commenters, however, expressed concerns about the proposed amendment. The concerns generally related to practicality, particularly for large foreign parties; scope, because the

proposed amendment was not limited to individuals with knowledge relevant to the Board proceeding; and privacy, both for parties collecting travel information and counsel conveying it to adverse parties.

*Response:* In response to the commenters' concerns, the proposed addition to § 2.120(c)(2) of the clause "the party must inform every adverse party of such presence" has been eliminated. The Board notes, however, that parties retain the ability to request such information through interrogatories.

The Office is revising § 2.120(d) such that it addresses only interrogatories, deleting paragraphs (d)(1) and (2). Provisions relating to requests for production are moved to revised § 2.120(e), and § 2.120(f) through (k) are renumbered in conformance.

The Office is amending § 2.120(e) to limit the total number of requests for production to seventy-five and to provide a mechanism for objecting to requests exceeding the limitation parallel to § 2.120(d).

The Office is further amending § 2.120(e) to clarify that the rule applies to electronically stored information as well as documents and tangible things; to provide that the time, place, and manner for production shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties; and to remove the provision that production will be made at the place where the documents and things are usually kept.

*Comment:* One commenter asked that the rules reflect the prominence of electronic production by requiring production of responsive documents, rather than retaining the option to make documents available for inspection, and requiring parties to produce documents electronically when possible.

*Response:* The rule incorporates by reference, and is consistent with, Rule 34 of the Federal Rules of Civil Procedure. Parties may agree to other manners of production of documents, ESI, and tangible things. The Board encourages electronic production whenever possible and reminds the parties that production of ESI, which is generally limited in Board proceedings, is a subject for discussion at the discovery conference. See *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1909 (TTAB 2011).

The Office is amending renumbered § 2.120(f)(1) to clarify that the rule applies to ESI as well as documents and tangible things. The Office is further amending § 2.120(f)(1) to require that a

motion to compel initial disclosures must be filed within thirty days after the deadline therefore and include a copy of the disclosures. The Office is further amending § 2.120(f)(1) to require that a motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period, rather than the commencement of that period. The Office is further amending § 2.120(f)(1) to clarify that the request for designation pertains to a witness. The Office is further amending § 2.120(f)(1) to require a showing from the moving party that the party has made a good faith effort to resolve the issues presented in the motion.

*Comment:* In the proposed amendment to § 2.120(f)(1), one commenter requested an enlargement of the time for filing motions to compel initial disclosures from 30 to 60 days.

*Response:* Parties have many options for changing the timing of initial disclosures and any resulting motions to compel, including stipulated extensions, waiver, or suspension for settlement discussions. The Board does not discern a benefit to parties by extending this deadline further into the 180-day discovery period. The amendment to § 2.120(f) facilitates preserving essentially three months of the six-month discovery period for service of written discovery, in order that responses can be served before the close of discovery. Extending the deadline for a motion to compel initial disclosures to 60 days from the due date of the disclosure will further erode the remaining discovery period.

*Comment:* Commenters who addressed the amendments to § 2.120(f) and (i) requiring that motions to compel expert testimony disclosures be filed prior to the close of discovery and that motions to compel discovery and to test the sufficiency of any objection be filed prior to the deadline for pre-trial disclosures for the first testimony period approved of the changes.

*Response:* The changes encourage efficiency in the schedule. The parties will focus on discovery during the assigned period and be able to resolve any disputes or outstanding discovery matters before trial. Once pretrial disclosures are served, the parties will focus on trial matters, or settlement, if appropriate.

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

*Comment:* One commenter asked that § 2.120(f)(2) be amended to clarify whether a case is automatically deemed

suspended on the filing of a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery.

*Response:* By comparison, an amendment to § 2.127(d) specifies that a case “is suspended” when a party timely files a potentially dispositive motion. Motions to compel under § 2.120(f)(2), however, present different considerations, including the requirement of a showing of good-faith effort to resolve the issues presented in the motion. In order to retain its discretion in managing discovery, the Board does not amend § 2.120(f)(2) commensurately with § 2.127(d). While suspension in this situation occurs only upon issuance of a suspension order, ordinarily such suspension is effective as of the date of the filing of the motion to compel.

*Comment:* One commenter suggested that the USPTO amend § 2.120(f) (motion for an order to compel discovery) to include a mirror provision (analogous to Rule 37(a)(5)(B) of the Federal Rules of Civil Procedure)—*i.e.*, if the motion to compel is denied, the Board may issue a protective order. This would make the provisions for motions to compel and motions for protective order symmetrical.

*Response:* There is no need to issue a protective order as the purpose is already served by the order denying the motion to compel.

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

The Office is amending renumbered § 2.120(i) to limit the total number of requests for admission to 75 and to provide a mechanism for objecting to requests exceeding the limitation parallel to § 2.120(d) and (e).

*Comment:* Several commenters addressed the proposed amendments to § 2.120(e) and (i) limiting requests for production and admission to 75, and the proposed amendment to § 2.120(d) to delete motions for leave to serve additional interrogatories beyond the existing limit of 75. Some commenters expressed support for the proposed limits, stating that they would be sufficient and beneficial in most cases, with some requesting that motions for leave to propound more than 75 requests in unusual cases be permitted. However, several commenters objected to the proposed limit on requests for admission. Some commenters also asked for clarification regarding how the requests for production and admission will be counted under the proposed amendments.

*Response:* Requests for admission will be counted reflecting the form

articulated in Rule 36(a)(2) of the Federal Rules of Civil Procedure: “Each matter must be separately stated.” Requests for production will be counted in the same manner as interrogatories, that is, each subpart will count as a separate request. The Board has revised the proposed amendments to § 2.120(d), (e), and (i) to permit motions to serve more than 75 interrogatories, requests for production, and requests for admission on a showing of good cause. With respect to the latter, examples that may support a showing of good cause include cases involving foreign parties from whom oral discovery may be unavailable, or requests intended to narrow the issues in dispute in proceedings involving multiple marks and applications or registrations with lengthy identifications of goods and services.

The Office is further amending renumbered § 2.120(i) to permit a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party, or specifying which of those documents cannot be authenticated.

*Comment:* Two comments addressed a proposed amendment to § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating documents produced by an adverse party. One commenter favored the proposed amendment, while the other expressed concern that it would shift the burden of proof for the right to use the document from the recipient to the producing party.

*Response:* The proposed amendment has been revised in the final rule to clarify that the party propounding a comprehensive request for admission must identify each document for which it seeks authentication. Specifically, the first sentence of Rule 36(a)(2) of the Federal Rules of Civil Procedure, requiring that “[e]ach matter must be separately stated,” will not apply to this single comprehensive request for an admission authenticating documents produced by an adverse party.

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

The Office is amending renumbered § 2.120(i)(2) to clarify that when a

motion to determine the sufficiency of an answer or objection to a request for admission is filed after the close of discovery, the parties need not make pretrial disclosures until directed to do so by the Board.

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

*Comment:* One commenter asked for the reason supporting the proposed amendment to § 2.120(j)(3), which states that parties may not make a recording of the conferences referenced in § 2.120(j)(1) and (2).

*Response:* The amendment codifies existing Board practice, promotes candid discussion during conferences, and protects the privacy of the parties.

The Office is amending renumbered § 2.120(k)(2) to change the time for a motion to use a discovery deposition to when the offering party makes its pretrial disclosures and to clarify that the exceptional circumstances standard applies when this deadline has passed.

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

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

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

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

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

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

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

The Office is amending § 2.121(e) to add that the testimony of a witness may be either taken on oral examination and transcribed or presented in the form of an affidavit or declaration, as provided in amendments to § 2.123.

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

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

### *Matters in Evidence*

The Office is amending § 2.122(a) to clarify the heading of the paragraph and to specify that parties may stipulate to rules of evidence for proceedings before the Board. The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence

has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice.

*Comment:* One commenter viewed the last sentence of § 2.122(a) as redundant with § 2.120(k)(7) and suggested retaining the sentence in § 2.122(a) and deleting it from § 2.120(k)(7) as unnecessary.

*Response:* The language in § 2.120(k)(7) is longstanding and the Office is retaining it for consistency and to avoid any confusion as to the implications of a potential deletion of that language from that section.

The Office is amending § 2.122(b) to clarify the heading of the paragraph and to clarify that statements made in an affidavit or declaration in the file of an application for registration or in the file of a registration are not testimony on behalf of the applicant or registrant and that matters asserted in the files of applications and registrations are governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part of title 37 of the Code of Federal Regulations.

*Comment:* One commenter supported the specification that statements in affidavits or declarations submitted in connection with an application during ex parte examination are not considered evidence. However, one commenter requested clarification as to why § 2.122(b)(2) excludes statements made in an affidavit or declaration in the file of an application or registration from evidence, and requested that the rule about specimens not being in evidence unless reintroduced be deleted.

*Response:* Section 2.122(b) provides that the subject application or registration file is automatically of record; however, the existing rule also provides that the dates of first use and specimens are not evidence. The final rule has been amended to provide that statements made in affidavits and declarations in a subject application or registration file are not testimony. Matter residing in an application or registration file reflects an applicant or registrant having met certain requirements or having overcome certain refusals during the ex parte prosecution of an application or maintenance of a registration. Although part of the record of the proceeding, such material constitutes hearsay (except for statements falling under Fed. R. Evid. 801(d)), further compounded by the fact that the affidavits or

declarations were not subject to contemporaneous cross-examination. Now that testimony by affidavit or declaration is unilaterally available, it is necessary to clearly distinguish material residing in an application or registration from testimony introduced in the proceeding. Self-authenticating exhibits (e.g., printed publications, internet printouts with the URL and date) attached to affidavits or declarations in applications or registrations may have evidentiary value for what they show on their face. The final rule has been further amended to clarify that while application and registration materials are "of record," they are subject to the Federal Rules of Evidence, Federal Rules of Civil Procedure, Title 28 of the United States Code, and the provisions of this part of title 37 of the Code of Federal Regulations.

The Office is amending § 2.122(d)(1) to replace "printout" with "copy." The Office is amending § 2.122(d)(2) to add a cross-reference to new § 2.122(g) and to specify that a registration owned by a party may be made of record via notice of reliance accompanied by a current copy of information from the electronic database records of the Office showing the current status and title of the registration. These amendments codify current case law and Office practice.

*Comment:* One commenter suggested replacing the word "printout" with "download" for making registrations of record under § 2.122(d). In addition, the commenter questioned whether the wording "current status of and current title to" in § 2.122(d)(1) and (2) has a different meaning from the wording "current status and title of" in § 2.122(d)(1) and (2).

*Response:* Currently, a registration is not considered of record when the number is input into the ESTTA form. To make a registration of record, a copy of the electronic database records of the Office must be attached to the pleading. The word "download" does not encompass all possible manners in which a copy may be attached. The Board amended § 2.122(d) by replacing the word "printout" with the word "copy" to broaden the manner in which a registration may be attached to include, for example, printouts or downloads. The Office has retained the slightly different wording in § 2.122(d)(1) and (2) but the wording does not have different meanings.

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

The Office is adding new § 2.122(e)(2) permitting admission of internet

materials into evidence by notice of reliance and providing requirements for their identification. The amendment codifies current case law and Office practice.

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

*Comment:* One commenter suggested that the requirement in § 2.122(g) to indicate generally the relevance of proffered evidence and associate it with one or more issues, specify that the offering party should indicate the relevance of each document or group of documents within each exhibit, and that the omissions may be cured without reopening the testimony period.

*Response:* While this suggestion reflects language from Board cases, the final rule provides sufficient guidance and accommodates broader potential circumstances, to allow for flexibility and not encourage motion practice.

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

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

*Comment:* Several commenters approved of the unilateral option, some noting that many already submit testimony by affidavit as a form of ACR which reduces costs; however, some commenters expressed a desire to be able to submit video depositions as testimony.

*Response:* The Board has never accepted video testimony and has not experienced any detrimental effect. The current online filing system is not able to accept video testimony; however, this possibility may be considered in subsequent rulemakings as TTAB's online systems are enhanced.

*Comment:* One commenter expressed concern in light of the preclusive effect of Board decisions that affidavit/

declaration testimony is less like a district court proceeding.

*Response:* The general concept of issue preclusion already applies to summary judgment decisions in district courts, which are often presented on testimony by affidavit or declaration. See 18 Charles Alan Wright et al., Fed. Prac. & Proc. Juris. section 4419 (2d ed. 2016). The same is true of Board decisions granting summary judgment. In addition, the option for stipulated ACR has been available for several years and also results in final decisions made on a record based on affidavit or declaration testimony. The new procedure retains what the Supreme Court focused on in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015): That testimony be under oath and subject to cross-examination. The ability to elect cross-examination of the witness in the new unilateral procedure maintains the fairness and weightiness of Board proceedings.

*Comment:* Several commenters expressed concern with the cost-shifting of cross-examination because it puts the burden on the party seeking cross-examination to pay the costs for traveling to the adversary's place of business, and that it is generally unfair and detrimental.

*Response:* Even with oral testimony depositions, the party cross-examining the witness must pay its own travel expense and its own attorney expenses. The proffering party has had and will retain the expense of producing its witness. The final rule adds no burden on these points. The provision that the party seeking oral cross-examination must bear the expense of oral cross-examination is intended to cover the expense of the court reporter. Any redirect and recross is to be taken at the same time, with the party that originally sought cross-examination bearing the cost of the court reporter. The goal of the final rule is to minimize the ability of a party seeking cross-examination to thwart the other party's efforts to rein in the cost of litigation by opting for testimony by affidavit or declaration.

*Comment:* Some commenters requested that the final rule clearly provide that affidavit/declaration testimony be duly sworn under penalty of perjury and that the testimony and introduction of evidence in a testimony affidavit or declaration are subject to the Federal Rules of Evidence, *i.e.*, only contain facts admissible in evidence. It was noted in particular that § 2.20 allows for statements on information and belief. Finally, one commenter queried whether the unilateral option for testimony by affidavit or declaration

might increase the number of cases proceeding through trial and thereby impact Board pendency.

*Response:* The Office has adopted language in the final rule directed to the concerns expressed regarding affidavit testimony by explicitly requiring that the affidavit or declaration pursuant to § 2.20 be made in conformance with the Federal Rules of Evidence. Regarding the concern raised about affidavit or declaration testimony being "duly sworn" and under penalty of perjury, the testimony affidavit is a sworn statement, while the declaration permits a comparable alternative unsworn statement. See 28 U.S.C. 1746. Either option is under penalty of perjury, and statements in Board proceedings are subject to 18 U.S.C. 1001. With regard to concern over the pendency of Board proceedings, the experience with ACR proceedings provides some insight. Recently, ACR cases, where affidavit or declaration testimony is commonly used, accounted for one in six final decisions in fiscal year 2014. During this same time period, the Board did not see an increase in pendency for final decisions. Even in cases that were not counted as ACR cases, the parties frequently agreed to use testimony by affidavit or declaration. Despite the increasing use of affidavit or declaration testimony, overall pendency has decreased the last four fiscal years in a row.

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

*Comment:* Related to the similar issue in § 2.120(c), some concern has been expressed that the requirement in § 2.123(a)(2) that the proffering party must inform every adverse party when it knows its foreign witness will be within the jurisdiction of the United States during such party's testimony period, improperly places counsel in the position of informing on their clients and incentivizes counsel to advise foreign parties not to meet in the United States or not to travel to the United States for conferences and other business, and that existing procedures for seeking discovery and testimony of foreign parties are sufficient.

*Response:* In response to the expressed concerns, this requirement has been deleted. It is noted that parties may continue to request such information during discovery in the form of an interrogatory that is subject to the duty to supplement.

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

The Office is amending § 2.123(c) to remove the option of identifying a witness by description in a notice of examination and to clarify that such notice shall be given to adverse parties before oral depositions.

The Office is further amending § 2.123(c) to add that, when a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election.

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

*Comment:* Proposed § 2.123(c) provided that the notice to take a cross-examination deposition must be served on the adverse party and filed with the Board “within 10 days from the date of service of the affidavit or declaration and completed 20 days from the date of service of the notice of election.” One commenter expressed concern that the time periods are too short to permit sufficient time to review declaration and affidavit testimony and accompanying exhibits, confer with clients and witnesses, determine whether a cross-examination deposition is necessary, and notice such cross-examination deposition, especially where numerous testimony declarations with voluminous exhibits are served on the same date and/or at the end of the assigned testimony period. The commenter recommended allowing at least 20 days from the date of service of the affidavit or declaration testimony to serve a notice of a cross-examination testimony deposition, and at least 30 days from the date of service of the notice to complete such depositions.

*Response:* The Office has adopted the suggestion to increase the time frames to accommodate scheduling considerations raised by the commenter. The notice to take a cross-examination deposition must be served on the adverse party and filed with the Board “within 20 days from the date of service of the affidavit or declaration and completed 30 days

from the date of service of the notice of election.”

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

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

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

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

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

The Office is amending § 2.123(f)(2) to require that deposition transcripts and exhibits shall be filed in electronic form using ESTTA. If the nature of an exhibit, such as CDs or DVDs, precludes electronic transmission via ESTTA, it shall be submitted by mail. The amendment codifies the use of electronic filing.

The Office is amending § 2.123(g)(1) to add that deposition transcripts must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet). The Office is amending § 2.123(g)(3) to add that deposition transcripts must contain a word index, listing the pages where the words appear in the deposition.

*Comment:* One commenter requested clarification to the form for exhibits attached to affidavit or declaration testimony.

*Response:* The Office has not set out in the final rule any specific requirements regarding the form of exhibits. The Board and the parties have experience with such submissions in connection with summary judgment motions and ACR procedures as described in the TBMP at sections 528.05(b) and 702.04, which do not specify requirements for the form of exhibits, and this has not created problems. Notably, documents

submitted under an affidavit or declaration but not identified therein cannot be considered as exhibits. The parties are encouraged to be guided by the form requirements set out for exhibits to depositions in § 2.123(g)(2) and the mailing requirements for certain exhibits set out in § 2.123(f)(2).

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

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

#### *Depositions Upon Written Questions*

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

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

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

#### *Filing and Service of Testimony*

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

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

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



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

The Office is amending § 2.126 to renumber paragraph (a) as (b) and to add new paragraph (a) to require that submissions to the Board must be made via ESTTA. The amendment codifies the use of electronic filing.

*Comment:* Commenters who addressed the proposal to mandate the electronic filing of all submissions to the Board via ESTTA generally expressed approval, although a few commenters requested ESTTA enhancements to increase the permissible file size limits for attachments and to allow multimedia submissions. Several commenters asked that an exception to the ESTTA filing requirement be made for voluminous and multimedia submissions.

*Response:* While the Office continually strives to improve its electronic systems, the requested ESTTA enhancements cannot be made in the near future. The lack of these features, however, need not prevent effective electronic filing. ESTTA currently permits a filing to include multiple PDF attachments totaling less than 53 MB, which more than suffices for the vast majority of filings. ESTTA's "Tips for Attaching Large PDF Files," available from a help link within ESTTA, provide useful recommendations to minimize attachment file size. If, despite following best practices, file size remains a concern, an ESTTA submission may be divided into separate filings. While some commenters noted that such a procedure is more burdensome for a filer than simply submitting via paper, a paper filing would impose a similar or greater burden on the Office to receive and route the papers, to scan and upload them into the electronic official record, and to store and later destroy the papers in accordance with the Office's document retention policy. The Office deems it most appropriate that on the rare occasion when a single ESTTA filing cannot accommodate all the attachments, the effort of separating the attachments into multiple filings should rest with the filer. This is because the filer has the greatest opportunity to minimize the need for attachments, as well as to ensure that its expectations for image quality and color of the submissions are met.

Turning to multimedia, ESTTA currently is not configured to accept such submissions, and the Office does not anticipate an ESTTA enhancement to accept multimedia in the near future. Board proceedings are conducted

exclusively on the written record. While the Office acknowledges that some commenters have suggested the Board consider accepting video depositions, under the current requirements and practice, such submissions are not permitted, thus rendering it unnecessary to make an electronic filing exception for that purpose. Multimedia files such as specimens for sound or motion marks, having been submitted through the Trademark Electronic Application System (TEAS), may be included in the electronic official record in ex parte appeals. The need to submit multimedia evidence in Board inter partes proceedings infrequently arises when a party submits video or audio evidence, such as commercials. The Board will continue its current practice of accepting DVDs or CDs for this limited purpose, and the submission of such exhibits will be exempt from the requirement to file using ESTTA. When making such a submission of exhibits, parties are advised to include in the accompanying ESTTA filing a "placeholder" exhibit page to indicate the CD or DVD exhibit, and to mail the CD or DVD to the Board. If in the future the Board's electronic filing system can be enhanced to allow the submission of multimedia material, similar to TEAS, the Board will revisit its acceptance of CDs or DVDs.

*Comment:* Numerous commenters expressed concerns about the interpretation and implementation of the proposed exception to allow paper filings "when ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present." Some commenters expressed only their desire that such petitions be liberally granted and that the Office provide guidance as to the types of circumstances that would qualify as extraordinary. Other commenters sought a waiver of the usual petition fee for this type of petition. Still others objected to the requirement for a petition at all, which they claimed creates unwelcome uncertainty as to whether the paper filing would be accepted. They contended that the Office should guarantee acceptance of a paper filing accompanied merely by a statement of the reason for the paper filing.

*Response:* To balance the interest in promoting electronic filing with the concerns expressed by commenters, the final rule maintains the proposed petition requirement for notices of opposition, extensions of time to oppose, petitions to cancel, and answers thereto not filed through ESTTA, but no longer includes the petition requirement for other types of filings not made through ESTTA. Paper pleadings

increase the burden on the Board because they require more manual processing than most other types of paper filings. Therefore, the Board has maintained the petition requirement for pleadings and extensions of time to oppose to encourage electronic filing from the outset, with the expectation that parties who initially file electronically will continue to do so throughout the proceeding. For notices of opposition and petitions to cancel, if the petition to file on paper is granted, the Board's institution orders will address the schedule and deadlines. For answers filed on paper, the pendency of the petition to file on paper will not act as a stay of proceedings, see § 2.146(g), and parties should adhere to the trial schedule. Petitions to file on paper are subject to § 2.146, including the requirement for verified facts under § 2.146(g). Paper filings not accompanied by the requisite petition will not be considered.

For other paper filings, the final rule requires a showing by written explanation accompanying the filing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances justify the paper filing. Such explanations must include the specific facts underlying the inability to file by ESTTA, rather than a mere conclusory statement that technical problems or extraordinary circumstances prevented the use of ESTTA. No fee is required. In these situations, parties should consider any such paper filing accepted unless the Board indicates otherwise. Thus, for any filing to which the opposing party would respond, for purposes of the response deadline, the opposing party should proceed as if the paper submission were accepted at the time of its filing and respond accordingly. The Board will review the explanation accompanying the paper filing in its consideration of the filing, and submissions that do not meet the technical problems or extraordinary circumstances showing will not be considered.

The Office intends to continue its flexible, reasonable approach in handling the unusual occasions when USPTO technical problems render ESTTA unavailable. For example, in situations where verifiable issues with USPTO systems prevented electronic filing in the past, the Office's practices have included waiving non-statutory deadlines and waiving petition fees associated with matters concerning the USPTO's technical problems. These and other measures may be taken by the Office as appropriate in the future to avoid negatively impacting prospective

filers in the event of USPTO technical problems. However, the precise impact of technical problems varies depending on the specific facts, and the Office cannot reasonably provide advance guidance about all possibilities.

The same holds true regarding the types of situations that would qualify as extraordinary circumstances. Because the assessment would depend on the specific facts, the Office deems it appropriate to address particular situations on a case-by-case basis as they arise.

*Comment:* Some commenters requested assurances that the paper filing exception could apply in the event of technical difficulties on the filer's end.

*Response:* The exception for extraordinary circumstances may apply to situations where no USPTO technical problems exist, but the filer experiences an extraordinary situation making ESTTA unavailable to the filer. Such extraordinary circumstances might, in appropriate situations, include certain types of technical problems at the filer's location or with the filer's systems.

The Office is adding new § 2.126(a)(1) providing that text in an electronic submission must be filed in at least 11-point type and double-spaced. The amendment is consistent with the amendment to § 2.126(b)(1). The final rule retains the 11-point type size from the existing rule.

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

The Office is amending renumbered § 2.126(b) to permit submissions in paper form in the event that ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. The Office is further amending renumbered § 2.126(b) to require that all submissions in paper form except extensions of time to file a notice of opposition, notices of opposition, petitions to cancel, or answers thereto, must include a written explanation of such technical problems or extraordinary circumstances.

The Office proposed to amend renumbered § 2.126(b)(1) to require that text in a paper submission must be filed in at least 12-point type. Consistent with § 2.126(a)(1), however, the final rule retains the 11-point type size from the existing rule.

The Office is removing the paragraph previously designated § 2.126(b).

The Office is amending § 2.126(c) to provide that submissions to the Board

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

#### *Motions*

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

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

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

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

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

*Comment:* Commenters who addressed the proposed amendment to § 2.127(e), requiring that any motion for summary judgment be filed before the deadline for pretrial disclosures, approved of the change.

*Response:* The change encourages efficiency in the schedule by providing that, once the due date for the first pretrial disclosure has arrived, the parties are focused on trial, or settlement, and neither party will be surprised, while preparing for trial after the due date for the first pretrial

disclosures, by the filing of a summary judgment motion by its adversary.

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

*Comment:* One commenter requested clarification that § 2.127(e)(2) does not require stipulations that summary judgment evidence be relied on at trial.

*Response:* The final rule states parties may stipulate to reliance on summary judgment evidence and does not contemplate requiring such stipulations; it only codifies an existing practice. To remove any ambiguity on this point, the Board has omitted from the final rule the word "shall," which was intended to be directed to the Board.

#### *Briefs at Final Hearing*

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

The Office is amending § 2.128(b) to add that evidentiary objections may be set out in a separate appendix that does not count against the briefing page limit. The amendment codifies current case law and practice and is consistent with TBMP section 801.03. The Office is further amending § 2.128(b) to add that briefs exceeding the page limits may not be considered by the Board, and this also codifies existing practice.

#### *Oral Argument; Reconsideration*

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

*Comment:* One commenter expressed support for the amendment to § 2.129(a),

and recommends that remote participation be granted where counsel, an examining attorney, or participating member of the Board is located 100 miles or more from the oral hearing location.

*Response:* The Office will liberally grant remote attendance, but retains discretion to account for any technological limitations.

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

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

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

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

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

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

The Office is amending § 2.132(b) to limit evidence to Office records showing the current status and title of a plaintiff's pleaded registrations. The Office is further amending § 2.132(b) to reflect that all response dates initiated by a service date are twenty days. The Office is further amending § 2.132(b) to clarify that the Board may decline to render judgment on a motion to dismiss until all testimony periods have passed.

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

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

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

The Office is amending § 2.136 to specify when a proceeding will be terminated by the Board and the status

of an application or registration on termination of an opposition, cancellation, or concurrent use proceeding.

*Comment:* One commenter expressed concern that the rule change to § 2.136 fails to address the problem where a registration issues following receipt of a notice of termination of a Board proceeding even when the proceeding has been decided adversely to the applicant. It is suggested that the proposed rule address this problem by requiring all termination orders to specify whether registration is refused.

*Response:* While the status entry "terminated" is recorded in the prosecution history of a proceeding file, the Office does not issue a "termination order," and final decisions already state if registration is refused. The commenter's scenario involves an internal processing issue, which the Office is addressing. While this occurs on occasion, the Office has a process to cancel an inadvertently issued registration. As a logical extension of the amendments clarifying the termination process for oppositions and concurrent use proceedings, the final rule has been further amended to include clarification of the process for cancellation proceedings and the status of registrations on termination of the proceedings.

#### **Appeals**

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

The Office is amending § 2.142 to incorporate a nomenclature change from "examiner" to "examining attorney" and to incorporate email as a possible manner of transmission from the examining attorney.

*Comment:* The directive in proposed § 2.142(b)(1) and (f)(4) that the examining attorney "shall mail a copy of the brief" seems inconsistent with the Board's move to electronic communications.

*Response:* The Trademark Examining Operation currently does not require electronic communication; however, examining attorneys mail briefs via email when authorized by the applicant. The Office has adopted changes to accommodate when examining attorneys communicate through email.

The Office is amending § 2.142(b)(2) to exempt examining attorney submissions from the ESTTA requirement because they are filed through the Office's internal electronic systems. In view of the shorter page limit for ex parte appeal briefs, the Office is also deleting the requirement that ex parte briefs contain an alphabetical index of cited cases.

Finally, the Office is adding that a reply brief from an appellant shall not exceed ten pages in length and that no further briefs are permitted unless authorized by the Board.

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

*Comment:* One commenter recommends that the final rule be amended to include an example of a preferred citation format.

*Response:* To remain flexible to accommodate technological change which could prompt different citation forms, the Office has not put examples in the final rule. The key is to provide a citation that allows the reader to easily find the referenced document. Citation format may be by date, description of filing, and page number (e.g., October 10, 2010 Office Action p. 2, or 10/10/10 Office Action at 2, or 10/10/10 Office Action, TSDR 2). Where appropriate, reference to the TTABVUE entry and page number, e.g., 1 TTABVUE 2, is also suggested. See TBMP sections 801.01 and 1203.01.

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

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

The Office is amending § 2.142(e)(1) to clarify that all statutory members of the Board may hear oral argument. The Office is further amending § 2.142(e)(1) to add that appellants, examining attorneys, and members of the Board may attend oral argument in person or, at the discretion of the Board, remotely. The amendment codifies current Office practice and is consistent with the Office's amendments to § 2.129(a).

The Office is amending § 2.142(e)(2) to add that a supervisory or managing attorney may designate an examining

attorney to present oral argument and to delete the provision that the examining attorney designated must be from the same examining division.

*Comment:* One commenter expressed concern that the proposed amendment to § 2.142(e)(2), allowing for inter-law office file swapping before oral argument, might be potentially prejudicial to applicants. The commenter's concern is that decision-making may be more circumspect if supervisory or managing attorneys were required to field the appeals generated within their own law offices, rather than be allowed to forward appeals to other law offices.

*Response:* The final rule recognizes the Office's discretion regarding staffing of cases, and is necessary to accommodate workflow and maintain pendency goals. The Office needs procedures that allow for the most efficient use of resources. The Office is amending § 2.142(f)(1) to change the time for further examination of an application on remand from thirty days to the time set by the Board.

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

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

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

Substantively, throughout § 2.145, the Office is removing specific references to times for taking action or other requirements that are specified in the Act or another set of rules (e.g., Federal Rules of Appellate Procedure) and replacing them with references to the applicable section of the Act or rules that set the time or requirements for the specified action. These changes will

help ensure that parties consult the applicable statute or rule itself and avoid the need for the USPTO to amend its regulations if the applicable provision of the statute or rule changes.

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

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

Regarding amendments to the requirements for filing a civil action in district court in § 2.145(c), the Office is adding in § 2.145(c)(1) an amendment corresponding to the amendment to § 2.145(a)(1) that it is unnecessary for a party to request reconsideration before filing a civil action seeking judicial review of a Board decision, but a party requesting reconsideration must do so before filing the civil action. The Office is replacing current § 2.145(c)(2) with a provision that specifies the requirements for serving the Director with a complaint by an applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act. The amendment, which references Federal Rule of Civil Procedure 4(i) and § 104.2, is intended to facilitate proper service of complaints in such actions on the Director. The Office is replacing current § 2.145(c)(3) with a modified version of the provision currently in § 2.145(c)(4), to specify that the party who commences a civil action for review of a Board decision in an inter partes case must file notice thereof

with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in district court. The addition of a time frame for filing the notice of the civil action with the Board, and explicitly stating that the notice must identify the civil action with particularity, is necessary to ensure that the Board is timely notified when parties seek judicial review of its decisions and to avoid premature termination of a proceeding.

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

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

*Comment:* One commenter expressed concern with the proposed amendment to § 2.145(e)(2) that an appellant from a Board decision file requests for an extension of time to seek judicial review both with the Office of the General Counsel and through ESTTA with the Board. The commenter recommended that the Office allow for service on the Board and the Solicitor's Office using the same ESTTA form.

*Response:* The need for an appellant to file with the Office of the General Counsel and with the Board through ESTTA also pertains to notices of appeal

and civil actions, in addition to extension requests. The concurrent filing is intended to facilitate prompt notice of appeals not only to the Office's General Counsel, but also on the Board to avoid premature termination of proceedings and inadvertent action on subject applications or registrations, which is in the best interest of the parties. As the Office plans to enhance its electronic systems, it will work toward a more streamlined process where a single submission will facilitate the necessary prompt notification to all interested areas of the office. In the meantime, the relatively minimal additional burden of dual notification is justified by its benefits.

### General Information and Correspondence in Trademark Cases

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

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

#### *Business To Be Transacted in Writing*

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

*Comment:* One commenter suggested that § 2.191 be revised to indicate that ESTTA filing is mandatory.

*Response:* The Office has adopted the suggestion.

#### *Receipt of Trademark Correspondence*

The Office is amending § 2.195(d)(3) by deleting the option of filing notices of ex parte appeal by facsimile. This is a conforming amendment to align § 2.195(d)(3) with the final rules requiring that all filings with the Board be through ESTTA.

### Rulemaking Considerations

*Administrative Procedure Act:* The changes in this rulemaking involve rules of agency practice and procedure and/or interpretive rules. See *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (Rule that clarifies interpretation of a statute is interpretive.); *Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (Rules governing an application process are procedural under the Administrative Procedure Act.); *Inova Alexandria Hosp.*

*v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (Rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims.).

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

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

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

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

The burdens, if any, to all entities, including small entities, imposed by these rule changes will be minor and consist of relatively minor additional responsibilities and procedural requirements on parties appearing before the Board. Two possible sources of burden may come from the requirement that all submissions be filed through the Board's online filing system, the Electronic System for Trademark Trials and Appeals (“ESTTA”), except in certain limited circumstances, and the requirement that service between parties be conducted by

email. For impacted entities that do not have the necessary equipment and internet service, this may result in additional costs to obtain this ability or for some types of filings, to petition to file on paper. However, the Office does not anticipate this requirement to impact a significant number of entities, as well over 95 percent of filings are already submitted electronically, and it is common practice among parties to use electronic service.

In most instances the rule changes will lessen the burdens on parties, including small entities. For example, the Office is shifting away from the parties to itself the obligation to serve notices of opposition, petitions for cancellation, and concurrent use proceedings. Moreover, the rules provide for email service of other documents among the parties to a proceeding, thereby eliminating the existing need to arrange for the mailing or hand delivery of these documents. Also, the Office is making discovery less onerous for the parties by imposing limitations on the volume of discovery, incorporating a proportionality requirement, and allowing parties to present direct testimony by affidavit or declaration. The rules also keep burdens and costs lower for the parties by permitting remote attendance at oral hearings, thereby eliminating the need for travel to appear in person. Overall, the rules will have a net benefit to the parties to proceedings by increasing convenience, providing efficiency and clarity in the process, and streamlining the procedures. Therefore, this action will not have a significant economic impact on a substantial number of small entities.

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

*Executive Order 13563 (Improving Regulation and Regulatory Review):* The Office has complied with Executive Order 13563 (Jan. 18, 2011).

Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule changes; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided online access to the rulemaking docket; (7) attempted

to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

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

*Congressional Review Act:* Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing any final covered rule, the Office will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rule are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of U.S.-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rule change is not covered because it is not expected to result in a major rule as defined in 5 U.S.C. 804(2).

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

*Paperwork Reduction Act:* The Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rule involves information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501–3549). The collections of information involved in this rulemaking have been reviewed and previously approved by OMB under control numbers 0651–0040

and 0651–0054. This rule will shift a greater portion of paper filings to electronic filings. However, this rulemaking does not add any additional information requirements or fees for parties before the Board, and therefore, it does not materially change the information collection burdens approved under the OMB control numbers 0651–0040 and 0651–0054.

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to, a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects in 37 CFR Part 2

Administrative practice and procedure, Trademarks.

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

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

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

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

■ 2. Revise § 2.92 to read as follows:

##### § 2.92 Preliminary to interference.

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

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

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

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

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

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

\* \* \* \* \*

(c) If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and

Appeal Board will send a notice of institution to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). The notice for each defendant shall state the name and address of the plaintiff and of the plaintiff's attorney or other authorized representative, if any, together with the serial number and filing date of the application. If a party has provided the Office with an email address, the notice may be transmitted via email.

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

(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is acknowledged by the concurrent use applicant in the concurrent use application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.

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

\* \* \* \* \*

(f) \* \* \*

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

\* \* \* \* \*

■ 5. Revise § 2.101 to read as follows:

##### § 2.101 Filing an opposition.

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

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

(1) An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.

(2) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

(3) An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

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

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

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

■ 6. Amend § 2.102 by:

- a. Revising paragraphs (a), (b), and (c)(1) and (2);
- b. Adding a sentence after the first sentence in paragraph (c)(3);
- c. Adding paragraph (d); and
- d. Adding and reserving paragraph (e).

The revisions and additions read as follows:

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

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

(1) A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c). In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

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

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

(c) \* \* \*

(1) A person may file a first request for:

(i) Either a thirty-day extension of time, which will be granted upon request; or

(ii) A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is

not available as a first extension of time to oppose.

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

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

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

(e) [Reserved]

#### **§ 2.103 [Added and Reserved]**

■ 7. Add and reserve § 2.103.

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

#### **§ 2.104 Contents of opposition.**

(a) The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition. ESTTA requires the opposer to select relevant grounds for opposition. The required accompanying statement supports and explains the grounds.

\* \* \* \* \*

(c) Oppositions to applications filed under Section 66(a) of the Act are limited to the goods, services and grounds set forth in the ESTTA cover sheet.

■ 9. Revise § 2.105 to read as follows:

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

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

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

(1) If the opposition is transmitted by an attorney, or a written power of

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

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

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

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

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

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

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

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

**§ 2.106 Answer.**

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

(b)(1) An answer must be filed through ESTTA. In the event that

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

(2) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense shall not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(3) of this section shall govern. A pleaded registration is a registration identified by number by the party in the position of plaintiff in an original notice of opposition or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.

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

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

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

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

\* \* \* \* \*

■ 11. Revise § 2.107 to read as follows:

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

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

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

■ 12. Revise § 2.111 to read as follows:

**§ 2.111 Filing petition for cancellation.**

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

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for petitions submitted electronically via ESTTA.



The petition for cancellation may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases, the petition for cancellation and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) A petition to cancel a registration must be filed through ESTTA.

(2) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a petition to cancel may be filed in paper form. A paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (c). Timeliness of the paper submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198.

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

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

■ 13. Revise § 2.112 to read as follows:

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

(a) The petition for cancellation must set forth a short and plain statement showing why the petitioner believes he, she or it is or will be damaged by the registration, state the ground for cancellation, and indicate, to the best of petitioner's knowledge, the name and address, and a current email address(es),

of the current owner of the registration. ESTTA requires the petitioner to select relevant grounds for petition to cancel. The required accompanying statement supports and explains the grounds.

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

■ 14. Revise § 2.113 to read as follows:

**§ 2.113 Notification of cancellation proceeding.**

(a) When a petition for cancellation in proper form (see §§ 2.111 and 2.112) has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notice of institution which shall identify the proceeding as a cancellation, number of the proceeding and the registration(s) involved; and shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a Web link or Web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.

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

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

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

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

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

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

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

■ 15. Revise § 2.114 to read as follows:

**§ 2.114 Answer.**

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

(b)(1) An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).

(2) An answer shall state in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the respondent is without knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure

shall be followed. A reply to an affirmative defense shall not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(3) of this section shall govern. A pleaded registration is a registration identified by number by the party in position of plaintiff in an original petition for cancellation, or a counterclaim petition for cancellation, or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.

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

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

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

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

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

registrant or the registrant's attorney or other authorized representative.

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

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

\* \* \* \* \*

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

\* \* \* \* \*

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

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

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

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

**§ 2.117 Suspension of proceedings.**

\* \* \* \* \*

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

■ 18. Revise § 2.118 to read as follows:

**§ 2.118 Undelivered Office notices.**

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

■ 19. Revise § 2.119 to read as follows:

**§ 2.119 Service and signing.**

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

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

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

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

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

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

(5) Transmission by overnight courier; or

(6) Other forms of electronic transmission.

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

of delivery to the overnight courier will be considered the date of service.

(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person residing in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this chapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a) of this chapter, or qualified under § 11.14(b) of this chapter and authorized under § 2.17(f).

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

■ 20. Revise § 2.120 to read as follows:

**§ 2.120 Discovery.**

(a) *In general.* (1) Except as otherwise provided in this section, and wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings. The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to required disclosures, the conference of the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, proportionality, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses,

and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter partes proceeding or subsequent scheduling order. The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included within the notice of institution of the proceeding.

(2)(i) The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Rule 26(f) of the Federal Rules of Civil Procedure and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference, or when the Board deems it useful for the parties to have Board involvement. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate. The discovery period will be set for a period of 180 days.

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

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

(iv) The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the

discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. If a stipulation or motion for modification is denied, discovery disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.

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

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

(b) *Discovery deposition within the United States.* The deposition of a natural person shall be taken in the Federal judicial district where the

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

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

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

(d) *Interrogatories.* The total number of written interrogatories which a party

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

(e) *Requests for production.* The total number of requests for production which a party may serve upon another party pursuant to Rule 34 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. If a party upon which requests have been served believes that the number of requests exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving responses and specific objections to the requests, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel

discovery, the motion must be accompanied by a copy of the set(s) of the requests which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (f) of this section. The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

(f) *Motion for an order to compel disclosure or discovery.* (1) If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically stored information, or tangible thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. A motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosure(s), if any, and a motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset. A motion to compel discovery shall include a copy of the request for designation of a witness or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents, electronically stored information, or tangible things that were not produced for inspection and copying. A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in

the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

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

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

(h) *Sanctions.* (1) If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply

with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure. A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.

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

(i) *Requests for admission.* The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. If a party upon which requests for admission have been served believes that the number of requests for admission exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the requests for admission, serve a general objection on the ground of their excessive number. However, independent of this limit, a party may make one comprehensive request for admission of any adverse party that has produced

documents for an admission authenticating specific documents, or specifying which of those documents cannot be authenticated.

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

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

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

(2) Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the

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

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

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

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

(3)(i) A discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written initial disclosure, which may

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(e) A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123. Pretrial disclosure of a witness under

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

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

**§ 2.122 Matters in evidence.**

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

(b) *Application and registration files.*

(1) The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.

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

during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant. Establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part.

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

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

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

(e) *Printed publications and official records.* (1) Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an

issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence.

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

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

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

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

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

deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness, or the parties so stipulate. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

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

(c) *Notice of examination of witnesses.* Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. Upon motion

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

\* \* \* \* \*

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

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

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

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



(ii) A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

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

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

(f) *Certification and filing of deposition.* (1) The officer shall annex to the deposition his or her certificate showing:

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

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

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

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

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

(2) If any of the foregoing requirements in paragraph (f)(1) of this section are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he or she has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the nature of an exhibit precludes electronic transmission via ESTTA, it shall be submitted by mail by the party taking the deposition, or its attorney or other authorized representative.

(g) *Form of deposition.* (1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. A deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each

question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).

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

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

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

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

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

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

■ 24. Amend § 2.124 by revising paragraphs (b)(2), (d)(1), and (f) and adding paragraphs (b)(3) and (d)(3) to read as follows:

**§ 2.124 Depositions upon written questions.**

\* \* \* \* \*

(b) \* \* \*

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

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

\* \* \* \* \*

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

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

\* \* \* \* \*

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

\* \* \* \* \*

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

\* \* \* \* \*

■ 25. Revise § 2.125 to read as follows:

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

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

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

been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.

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

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

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

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

■ 26. Revise § 2.126 to read as follows:

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

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

(1) Text in an electronic submission must be filed in at least 11-point type and double-spaced.

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

(b) In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written

explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:

(1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;

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

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

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

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

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

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

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

**§ 2.127 Motions.**

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

responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion. Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

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

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

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

(e)(1) A party may not file a motion for summary judgment until the party

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

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

\* \* \* \* \*

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

**§ 2.128 Briefs at final hearing.**

(a) \* \* \*

(3) When a party in the position of plaintiff fails to file a main brief, an

order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that plaintiff has lost interest in the case, judgment may be entered against plaintiff. If a plaintiff files a response to the order showing good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered against plaintiff for failure to take testimony or submit any other evidence.

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

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

**§ 2.129 Oral argument; reconsideration.**

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

reserve part of the time allowed for oral argument to present a rebuttal argument.

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives. The Board may, however, deny a request to reset a hearing date for lack of good cause or if multiple requests for rescheduling have been filed.

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

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■ 30. Revise § 2.130 to read as follows:

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

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

■ 31. Revise § 2.131 read as follows:

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

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

Upon remand, the trademark examining attorney shall reexamine the application in light of the matter referenced by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

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

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

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

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

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

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

\* \* \* \* \*

(b) After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted its involved registration to be cancelled under section 8 or section 71 of the Act of 1946, or has failed to renew its involved registration under section 9 of the Act of 1946, or has allowed its registered extension of protection to expire under section 70(b) of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation, failure to renew, or expiration should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

■ 34. Revise § 2.136 to read as follows:

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

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

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

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

\* \* \* \* \*

(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examining attorney shall, within sixty days after the brief of appellant is sent to the examining

attorney, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.

(2) Briefs must meet the requirements prescribed in § 2.126, except examining attorney submissions need not be filed through ESTTA. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety. Unless authorized by the Board, no further briefs are permitted.

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

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

(d) The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

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

(2) If the appellant requests an oral argument, the examining attorney who issued the refusal of registration or the

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

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

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

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

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

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

\* \* \* \* \*

(6) If, during an appeal from a refusal of registration, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examining attorney may, by written

request, ask the Board to suspend the appeal and to remand the application to the examining attorney for further examination. If the request is granted, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. After the additional ground for refusal of registration has been withdrawn or made final, the examining attorney shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

\* \* \* \* \*

**§ 2.143 [Added and Reserved]**

■ 36. Add and reserve § 2.143.

■ 37. Revise § 2.145 to read as follows:

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

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

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

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

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

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

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

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

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

(2) If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:

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

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

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

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

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

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

(d) *Time for appeal or civil action—*  
(1) *For an appeal under section 21(a).*

The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. Any notice of cross-appeal is controlled by Rule 4(a)(3) of the Federal Rules of Appellate Procedure, and any other requirement imposed by the Rules of the United States Court of Appeals for the Federal Circuit.

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

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

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

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

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

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

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

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

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

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

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

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

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

\* \* \* \* \*

■ 39. Revise § 2.191 to read as follows:

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

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

■ 40. Revise § 2.195(d)(3) to read as follows:

**§ 2.195 Receipt of trademark correspondence.**

\* \* \* \* \*

(d) \* \* \*

(3) Correspondence to be filed with the Trademark Trial and Appeal Board;

\* \* \* \* \*

Dated: September 19, 2016.

**Michelle K. Lee,**

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

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