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DEPARTMENT OF TRANSPORTATION

Federal Aviation Administration

14 CFR Part 71

[Airspace Docket No. 98–AGL–41]

Modification of Class E Airspace; Bowman, ND

AGENCY: Federal Aviation Administration (FAA), DOT.

ACTION: Final rule.

SUMMARY: This action modifies Class E airspace at Bowman, ND. A Global Positioning System (GPS) Standard Instrument Approach Procedure (SIAP) to Runway (Rwy) 29 has been developed for Bowman Municipal Airport. Controlled airspace extending upward from 700 feet above ground level (AGL) is needed to contain aircraft executing the approach. This action increases the existing controlled airspace to the northeast, east, and southeast, for Bowman Municipal Airport.

EFFECTIVE DATE: 0901 UTC, December 03, 1998.

FOR FURTHER INFORMATION CONTACT: Michelle M. Behm, Air Traffic Division, Airspace Branch, AGL–520, Federal Aviation Administration, 2300 East Devon Avenue, Des Plaines, Illinois 60018, telephone (847) 294–7568.

SUPPLEMENTARY INFORMATION:

History

On Tuesday, June 23, 1998, the FAA proposed to amend 14 CFR part 71 to modify Class E airspace at Bowman, ND (63 FR 34136). The proposal was to add controlled airspace extending upward from 700 feet AGL to contain Instrument Flight Rules (IFR) operations in controlled airspace during portions of the terminal operation and while transiting between the enroute and terminal environments.

Interested parties were invited to participate in this rulemaking proceeding by submitting written comments on the proposal to the FAA. No comments objecting to the proposal were received. Class E airspace designations for airspace areas extending upward from 700 feet or more above the surface of the earth are published in paragraph 6005 of FAA Order 7400.9E date September 10, 1997, and effective September 16, 1997, which is incorporated by reference in 14 CFR 71.1. The Class E airspace designation listed in this document will be published subsequently in the Order.

The Rule

This amendment to 14 CFR part 71 modifies Class E airspace at Bowman, ND, to accommodate aircraft executing the proposed GPS Rwy 29 SIAP at Bowman Municipal Airport by increasing the existing controlled airspace to the northeast, east, and southeast, for the airport. The area will be depicted on appropriate aeronautical charts.

The FAA has determined that this regulation only involves an established body of technical regulations for which frequent and routine amendments are necessary to keep them operationally current. Therefore, this regulation—(1) is not a ''significant rule'' under DOT Regulatory Policies and Procedures (44 FR 11034; February 26, 1979); and (3) does not warrant preparation of a Regulatory Evaluation as the anticipated impact is so minimal. Since this is a routine matter that will only affect air traffic procedures and air navigation, it is certified that this rule will not have a significant economic impact on a substantial number of small entities under the criteria of the Regulatory Flexibility Act.

List of Subjects in 14 CFR Part 71

Airspace, Incorporation by reference, Navigation (air).

Adoption of the Amendment

In consideration of the foregoing, the Federal Aviation Administration amends 14 CFR part 71 as follows:

PART 71—DESIGNATION OF CLASS A, CLASS B, CLASS C, CLASS D, AND CLASS E, AIRSPACE AREAS; AIRWAYS; ROUTES; AND REPORTING POINTS

1. The authority citation for part 71 continues to read as follows:

Authority: 49 U.S.C. 106(g), 40103, 40113, 40120; E.O. 10854. 24 FR 9565, 3 CFR, 1959–1963 Comp., p. 389.

§ 71.1 [Amended]

2. The incorporation by reference in 14 CFR 71.1 of the Federal Aviation Administration Order 7400.9E, Airspace Designations and Reporting Points, dated September 10, 1997, and effective September 16, 1997, is amended as follows:

Paragraph 6005 Class E airspace areas extending upward from 700 feet or more above the surface of the earth.

* * * * *

AGL ND E5 Bowman, ND [Revised]

Bowman Municipal Airport, ND
(Lat. 46° 11′ 13″ N, long. 103° 25′ 41″ W

That airspace extending upward from 700 feet above the surface within a 7.0-mile radius of Bowman Municipal Airport and that airspace extending upward from 1,200 feet above the surface bounded by a line beginning at lat. 46° 26′ 00″ N, long. 103° 38′ 00″ W, to lat. 46° 48′ 00″ N, long. 102° 53′ 00″ W, to lat. 46° 20′ 00″ N, long. 102° 53′ 00″ W, to lat. 45° 39′ 00″ N, long. 103° 00′ 00″ W, to lat. 45° 43′00″ N, long. 103° 43′ 00″ W, to lat. 45° 48′ 00″ N, long. 103° 54′ 00″ W, to lat. 46°17′ 30″ N, long. 103° 48′ 15″ W, to the point of beginning, excluding Federal Airways, the Hettinger, ND Dickinson, ND, and Baker, MT, Class E airspace areas.

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Issued in Des Plaines, IL. on August 25, 1998.

David B. Johnson,

Acting Manager, Air Traffic Division.

[FR Doc. 98–24132 Filed 9–8–98; 8:45 am]

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 3

[Docket No. 970428100–8199–03]

RIN 0651–AA87

iscellaneous Changes to Trademark Trial and Appeal Board Rules

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Patent and Trademark Office (PTO) is amending the rules governing practice before the Trademark Trial and Appeal Board (Board). The amendments provide for the opening and the length of the discovery period; specify that the automatic disclosure provisions of the Federal Rules of Civil Procedure do not apply to Board proceedings; state that the Board will not hold any person in contempt or award any expenses to any party; specify requirements for briefs on motions; enlarge the time for filing a response to a motion for summary judgment; specify the time for filing motions under Rule 56(f) of the Federal Rules of Civil Procedure (motions for discovery to enable parties to respond to motions for summary judgment); and specify the time for filing motions to compel and motions to test the sufficiency of an answer or objection to a request for admission. In addition, the amendments clarify the rules, conform the rules to current practice, simplify practice, and correct cross-references.

DATES: *Effective Date:* These rule amendments will be effective October 9, 1998.

Applicability Dates: Two of the provisions of amended § 2.120(a) (the provisions that the Board will specify the opening date for discovery and that the discovery period will be set for a period of 180 days), will not apply in cases in which a trial order has been issued by the Board prior to October 9, 1998. The provision of amended § 2.120(e)(1) that a motion to compel must be filed prior to the commencement of the first testimony period, as originally set or as reset, will apply only in those cases in which trial dates, beginning with the closing date for the discovery period, are set or reset on or after October 9, 1998. Similarly, the provision of amended § 2.120(h)(1) that a motion to determine the sufficiency of an answer or objection to a request for admission must be filed prior to the commencement of the first testimony period, as originally set or as reset, will apply only in those cases in which trial dates, beginning with the closing date for the discovery period, are set or reset on or after October 9, 1998.

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

SUPPLEMENTARY INFORMATION: A Notice of Proposed Rulemaking was published in the **Federal Register** (62 FR 30802) on June 5, 1997, and in the Official Gazette of the Patent and Trademark Office (1199 TMOG 88) on June 24, 1997. The purpose of the proposed rule amendments was to improve practice and expedite proceedings in inter partes cases before the Board, codify and clarify certain practices of the Board, and correct certain cross-references to citations of the Trademark Act of 1946 and the Code of Federal Regulations.

In response to a request for written comments, thirty-four written comments were received. Many of the comments suggested that a public hearing be scheduled. As a result, the PTO gave notice in the November 4, 1997 **Federal Register** (62 FR 59640), and in the November 25, 1997 Official Gazette (1204 TMOG 88), of a public hearing on the proposed rules, and reopened the comment period. At the same time, the PTO announced that it was withdrawing two of the rule amendments proposed in the June 5, 1997 Notice of Proposed Rulemaking. Those withdrawn amendments were to §§ 2.120(d)(2) and 2.120(h) to limit the number of requests for production of documents and requests for admission, respectively, which may be served in an inter partes proceeding before the Board.

At the public hearing, held on December 17, 1997, seven witnesses testified. The written and oral comments represent the views of 29 individuals and law firms and five trademark law associations, namely, the Intellectual Property Law Section of the American Bar Association, the American Intellectual Property Law Association, the Intellectual Property Law Section of The District of Columbia Bar, the New York Intellectual Property LawAssociation, and the International Trademark Association. A number of rule amendments suggested in the written and oral comments, though meritorious, cannot be adopted at this time because they are outside the scope of the present rulemaking. Some of these suggestions are discussed below; others, particularly suggestions not directed specifically to one of the proposed rule amendments, are not.

Background to Rule Amendments

In recent years there has been a rapid growth in the number of new proceedings filed with the Board, coupled with a marked increase in the number of motions and other papers filed in each inter partes case. As a result, the Board's workload has increased dramatically. Many of the inter partes rule amendments proposed in the Notice of Proposed Rulemaking were specifically designed to help reduce the Board's backlog of pending motions and cases ready for final decision, stem perceived abuses of the rules, and promote expeditious prosecution and defense of cases. These proposed amendments involved substantial changes in Board inter partes practice. For example, amendments were proposed to (1) lengthen the discovery and trial periods, as well as the time for responding to motions and requests for discovery; (2) concomitantly limit the situations in which extensions of these times would be granted; (3) limit the number of requests for production of documents and things and requests for admission which one party could serve upon another in a proceeding; (4) further limit the number of interrogatories which one party could serve upon another; (5) require that interrogatories, requests for production of documents and things, and requests for admission be served in sufficient time for responses to fall due prior to the close of the discovery period; and (6) specify that the filing of a summary judgment motion would not toll the time for the moving party to respond to outstanding discovery requests but would toll the time for the nonmoving party to do so.

A significant number of the individuals and organizations which offered written or oral comments on the proposed rules strongly objected to these substantial changes. Accordingly, the PTO is not going forward with them at this time. Instead, the PTO is going forward only with those proposed rule amendments which involve modest changes in Board practice, or which serve to clarify the rules, codify current practice, or correct cross-references in the rules. The Board is considering other measures to deal with its increased workload, including a pilot program to make greater use of telephone conferences in determining pending interlocutory matters and motions. However, the PTO will continue to monitor carefully the problems which gave rise to the Notice of Proposed Rulemaking, and may propose and adopt additional changes in the rules governing Board inter partes practice if necessary.

Discussion of Specific Rules and Response to Comments

The comments, if any, on a specific rule and the response to the comments are provided with the discussion of the specific rule. Comments in support of

proposed rule changes generally have not been reported.

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

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

Section 2.76(h), which provides that an amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication or expiration of the six-month response period after issuance of a final action, is amended to delete the phrase ''or expiration of the six-month response period after issuance of a final action.'' As a result of the rule amendment, an amendment to allege use may be withdrawn during the pendency of an appeal. This amendment, too, codifies current practice.

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

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

Section 2.87(c) also now provides that a request to divide an application may be filed ''at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication or the date of expiration of the six-month response period after issuance of a final action.'' Similarly, this section now provides that a request to divide an application under section 1(b) of the Act may be filed with a statement of use or ''at any time between the filing of a statement of use and the date the Trademark Examining Attorney approves the mark for registration or the date of expiration of the six-month response period after issuance of a final action.'' The section is amended to delete the phrase ''or the date of expiration of the six-month response period after issuance of a final action'' from the two places where it occurs in this section. Under the amended rule, a request to divide may be filed more than six months after the issuance of a final action, as a result of which the request to divide may be filed during the pendency of an appeal. While this amendment was not included in the notice of proposed rulemaking, it corresponds to the amendment to §§ 2.76(a), (g) and (h), discussed above, and is advantageous to applicants. With this amendment, an applicant may divide out from its application those classes or that portion of the goods or services in a class to which no final refusal or requirement pertains. The divided out application will immediately go forward to publication or registration, as appropriate, and will avoid the delays related to briefing and deciding the issues involved in the appeal.

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

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

Section 2.111(b), which now includes a cross-reference to ''section 14(c) or (e)'' of the Act, is amended to correct the cross-reference to ''section 14(3) or (5)''.

Section 2.111(c)(1) now includes a cross-reference to ''§ 2.6(1) and 2.85(e)''. The section is amended to correct the cross-reference ''§ 2.6(1)'' to ''§ 2.6(a)(16)''. The section is further amended to delete the cross-reference to § 2.85(e) in view of the amendment to that section.

Section 2.117(a) now provides that whenever it shall come to the attention of the Board ''that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action.'' The quoted portion of the section is amended to read ''that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.'' The amendment clarifies the rules and codifies the Board's current practice on suspension of proceedings, which is that a Board proceeding may be suspended if any of the parties is engaged in a civil action or another Board proceeding which may have a bearing on the proceeding.

Comment: One comment suggested that § 2.117(a) conclude with the phrase ''or the Board proceeding'' to correspond to the previous change in that section. That comment also suggested that the rule be modified to allow a third party who has a pending application, or who is a party in a proceeding which has been suspended pending the outcome of the pending case, to apprise the Board of the impact of the suspension on the third party.

Response: The first suggestion has been adopted. The suggested modification to allow third parties to advise the Board about the impact on them of a suspension order goes beyond the scope of the amendment as originally proposed. Moreover, no purpose would be served by allowing third parties to file such impact statements. The Board suspends proceedings when a decision in a civil action or another Board proceeding may

have a bearing on the issues in the pending case. That effect would not be altered by any adverse impact which suspension of the proceeding might have upon a third party.

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

Comment: One comment suggested modifying the rule to provide that the filing of a potentially dispositive motion automatically suspends proceedings. The comment notes that the suggested modification would save the Board the paperwork involved in issuing a suspension order, and would avoid uncertainty for the parties as to what they should do until the suspension order is received.

Response: The suggested provision is not properly a part of this section, which relates to suspension in view of a civil action or another Board proceeding. Accordingly, the suggestion is discussed in connection with the amendments to § 2.127, which concerns motion practice.

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

Section 2.120(a) now provides, in pertinent part, that ''The provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section.'' The section is amended to preface this provision with the words ''Wherever appropriate,'' and to specify that the provisions of the Federal Rules of Civil Procedure relating to automatic disclosure, scheduling conferences, conferences to discuss settlement and to develop a plan for discovery, and transmission to the court of a written report outlining the discovery plan, do not apply to Board proceedings. The amendment clarifies the rule, and codifies current Board practice, as expressed in a notice published in the Official Gazette in 1994, namely, ''Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings,'' 1159 TMOG 14 (February 1, 1994).

Comments: Two comments suggested that all reliance on the Federal Rules of Civil Procedure be severed because, according to the comments, so few of the Federal Rules are still applicable to Board practice.

Response: The PTO believes that this suggestion goes beyond the scope of the proposed rulemaking. In addition, the PTO is not inclined to adopt it because the Board follows a substantial number of the Federal Rules and is guided by court decisions interpreting these rules. Examples of the Federal Rules followed by the Board include those governing pleadings, motions to dismiss, amendments of pleadings, acceptable discovery, summary judgment, and relief from judgment.

Section 2.120(a) also now provides that the Board will specify the closing date for the taking of discovery, and that the opening of discovery is governed by the Federal Rules of Civil Procedure. The section is amended to, inter alia, state that the Board will specify the opening (as well as the closing) date for the taking of discovery; and delete the provision that the opening of discovery is governed by the Federal Rules of Civil Procedure.

Under current Board practice, discovery opens at the times specified in Rules 30, 33, 34 and 36 of the Federal Rules of Civil Procedure as they read prior to the December 1, 1993 amendments to those rules. See ''Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings,'' 1159 TMOG 14 (February 1, 1994). Thus, interrogatories, requests for production of documents and things, and requests for admission may be served upon the plaintiff after the proceeding commences, and upon the defendant with or after service of the complaint by the Board. Discovery depositions generally may be taken by any party after commencement of the proceeding, except that the Board's permission must be obtained first in certain specified situations. Further, the Board still follows the practice embodied in Rules 33(a), 34(b), and 36(a) of the Federal Rules of Civil Procedure, as they read prior to the December 1, 1993 amendments, that a defendant may serve responses to interrogatories, requests for production of documents and things, and requests for admission either within 30 days after service of a discovery request (35 days if service of the request for discovery is made by first-class mail, ''Express Mail,'' or overnight courier—see § 2.119(c)), or within 45 days after service of the complaint upon it by the Board, whichever is later. These practices relating to the opening of discovery and the time for the service of discovery responses by the defendant are complicated, and have been unpopular with practitioners. The specified amendments to the section will simplify the opening of discovery.

Comments: One organization suggested a provision allowing discovery requests to be served after the filing of a proceeding, with responses to be due 40 days after the mailing by the Board of the notice of institution. One attorney disagreed with the proposal that the Board set the date for the opening of discovery. This attorney asserted that discovery might be necessary to prepare an answer, and that the later opening of the discovery period would inhibit parties who wanted to be diligent in initiating discovery. Another organization agreed with the proposal that the Board set the opening date for discovery, but suggested that the trial order be issued with the notice of institution because discovery might be necessary to properly prepare an answer. One attorney suggested including a provision in the rules to make it clear, in those cases where a proceeding was initiated prior to the effective date of this final rule and was suspended, that the former rules apply unless the parties to the proceeding are expressly notified otherwise.

Response: The suggestion for a provision allowing discovery requests to be served after the filing of a proceeding, with responses to be due 40 days after the mailing of the notice of institution, has not been adopted. If the suggested provision were adopted, a defendant could be served with discovery requests before it had even been notified of the filing of the proceeding, with the result that the defendant would be surprised and confused. Further, because early served requests might not bear a proceeding number, they would create an administrative burden for the Board, which would have to respond to inquiries regarding the existence, number, and status of the proceeding.

The suggestion that the trial order, which would set the opening of

discovery, be sent with the notice of institution of the proceeding has been adopted. It is believed that a defendant will not be prejudiced if it does not have the plaintiff's discovery responses prior to the time it must file its answer, because a defendant may move to amend its answer based upon information obtained through discovery. With respect to the suggestion for including in the rules a specific provision concerning applicability of the amended rules in cases initiated prior to the final rule and then suspended, it is believed that the information concerning the effective date of the rule amendments, as set forth at the beginning of this notice, is sufficient.

Section 2.120(a) is further amended to provide that the discovery period will be set for a period of 180 days, and that the parties may stipulate to a shortening of that period.

Comments: Two comments believed that the 180-day discovery period would unduly lengthen proceedings. Another comment said that the proposal would shorten the current discovery period and suggested that the discovery period be 270 days. One comment suggested providing that the period could be shortened on a showing of good cause, for example, if the applicant had not yet used its mark, while the parties would have to justify any enlargement, even one that was stipulated, of the discovery period. That comment also suggested a provision that extensions of the discovery period would be denied if a non-party files a notice that the proceeding is delaying its application.

Response: As indicated above, the PTO has adopted a suggestion that the trial order setting the opening and closing dates for the discovery period be mailed with the notice of institution of the proceeding. With the adoption of this suggestion, the proposed 180-day discovery period will result in a discovery period that is generally the same as that under present practice. Under current practice, discovery in essence opens for the defendant upon the commencement of the proceeding and opens for the plaintiff upon the Board's service of the complaint and the notice of institution. Often, the defendant does not know that a complaint has been filed until it receives this mailing from the Board. The discovery period currently closes 90 days after the mailing of the trial order, which is not done until the defendant's answer has been filed and processed by the Board. The amount of time that currently elapses between the mailing by the Board of the notice of institution (with a copy of the complaint for the defendant) and the issuance of a trial order averages approximately 90 days, with the discovery period set to close 90 days after the issuance of the trial order. Thus, setting the discovery period for 180 days in a trial order which forms part of the institution letter will not, in general, either lengthen or shorten the current discovery period. The suggestion that the discovery period be enlarged to 270 days has not been adopted because all other comments received indicated that a 180-day discovery period was either acceptable or too long.

The suggestion that the section be amended to provide that one party may move to shorten the discovery period has not been adopted. With respect to the example given in the comment, although an opposer may not need substantial discovery from an applicant who has not yet made use of its mark, that applicant may need discovery with respect to the opposer's use. The suggestions for provisions that the parties would have to justify any extension of the discovery period, and that an extension of the discovery period would be denied if a non-party files a notice that the proceeding is delaying his application, are not adopted. The PTO received numerous comments to the effect that extensions of the discovery period were useful in facilitating settlement, and it is the Board's experience that the vast majority of proceedings are settled prior to trial. Although the Board retains its inherent right to deny motions for extensions of time, even if the parties stipulate to the extension, it is believed that it would cause an undue burden on the parties to require them to justify each consented extension of time. The suggestion that a non-party have the right to prevent an extension of the discovery period is beyond the scope of the proposed rules and cannot be considered.

Section 2.120(a) was proposed to be further amended to require that interrogatories, requests for production of documents and things, and requests for admission be served in sufficient time for responses to fall due prior to the close of the discovery period, and that discovery depositions be noticed and taken prior to the close of the discovery period.

Comments: Five comments disagreed with this proposal. There was concern that the proposed amendment would increase expenses early in the proceedings and by so doing have a negative effect on settlement. It was also suggested that discovery would become more dependent on depositions, again increasing expenses for the parties. In addition, there was concern that the proposed amendment would create difficulties with respect to follow-up discovery, particularly in connection with requests for admission, which are most useful late in the discovery process. One organization also said that the proposal might create an incentive for a mischievous party to wait until the last 30 days of the discovery period to offer up its most damaging documents so that there would be no opportunity for follow-up discovery.

One attorney suggested a modification regarding the service of discovery requests so that, when discovery requests are served by overnight courier, five additional days would not be added to the time for responding to such discovery requests, which is the case under present § 2.119(c). Another attorney suggested that § 2.120(a) be amended to specify that documents to be served by the parties may be served by fax, and that facsimile signatures are acceptable for all purposes.

Response: The proposal to require that interrogatories, requests for production of documents and things, and requests for admission be served in sufficient time that responses will fall due prior to the close of the discovery period is withdrawn. The section is instead amended to specify that ''discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.'' The amendment codifies current practice.

The suggestion to amend § 2.119(c) to eliminate the five additional days to respond to discovery requests when service of the requests is made by overnight courier goes beyond the scope of the proposed rules, and therefore cannot be considered. But see the final rule notice entitled ''Amendment of Trademark Rules Governing Inter Partes Proceedings, and Miscellaneous Amendments of Other Trademark Rules,'' published in the **Federal Register** on August 22, 1989, at 54 FR 34886, 34891–34892, and in the Official Gazette on September 12, 1989, at 1106 TMOG 26, 31 (rejecting a suggestion to amend § 2.119(c) to provide for the addition of only one day, rather than five, to the prescribed time for taking action when service is made by ''Express Mail'' or overnight courier). The suggestion to allow service of documents by facsimile is also beyond the scope of the proposed rules.

Section 2.120(a) was proposed to be amended to specify that extensions of the discovery period will be granted

only upon stipulation of the parties approved by the Board.

Comments: Thirteen comments, including those of each of the organizations, disagreed with the proposed amendment. Some of the comments pointed out that there may be genuine business reasons, such as holidays in foreign countries, change of management, and the time required to translate materials and locate documents which may have been archived decades ago, as to why discovery cannot be completed within the time set. Several comments said the proposal would lend itself to abuse, for example, if one side can complete taking discovery in 180 days but the other cannot; it was also suggested that the proposed amendment would promote the practice of ambushing opponents through dilatory conduct and obstreperous tactics. It was also felt that the elimination of extensions of the discovery period absent consent would eliminate flexibility, which was considered a principal advantage of Board proceedings. Most of the comments suggested that the standard for granting an extension remain good cause. Some of those commenting were willing to accept a modification of the current good cause basis for an extension, as long as the basis for extensions was not limited only to stipulation. For example, two comments suggested that extensions be allowed upon a showing of extraordinary circumstances; one attorney suggested that extensions of up to two months be granted for good cause; and an organization suggested keeping the good cause standard but specifying that both parties' discovery obligations would continue while the motion is pending, and that sanctions would be levied against a party abusing the extension process.

One attorney also commented that the Board should specify in the rules, rather than merely indicating in the preamble to the notice of proposed rulemaking, that the Board may reset the discovery period if necessary. Another attorney suggested that provision be made for a party to move for sanctions without first filing a motion to compel to avoid a situation where a party is deprived of follow-up discovery because its adversary is recalcitrant. The example given involved a party which serves discovery promptly, the adversary responds on the last day permitted with evasive answers and objections, weeks of correspondence to resolve the issues ensue, followed by a motion to compel. The attorney suggested that even though the motion to compel is granted, the moving party would be deprived of an opportunity to take follow-up discovery.

Response: It is clear that most of those commenting want the standard for obtaining extensions to remain good cause and that most of those who suggested a more restricted standard than good cause did so as an alternative to limiting extensions only to situations involving consent. In view of the comments, the proposal to amend the section to provide that extensions of the discovery period will be granted only on stipulation of the parties is withdrawn. The section is instead amended to provide that the discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

The amended rule codifies the current practice of allowing extensions of the discovery period upon motion showing good cause. However, the Board is mindful of the comments that abuses of the extension process must be curbed. Therefore, the Board will scrutinize carefully any such motions and will consider, in determining whether good cause has been shown, the diligence of the moving party during the discovery period.

Moreover, the rule is amended to specifically state that, if a motion for an extension is denied, the discovery period may remain as set or reset. While the Board has always had the discretion to do this, the explicit statement of this fact in the rules will alert parties to the potential consequences if a motion to extend does not show good cause, and will put them on notice that the Board will not tolerate abuses of the rules. It is hoped that this will avoid some of the games-playing mentioned in the comments, in which a party files a motion for an extension as a strategic move to obtain a delay until the Board decides the motion, even if the requested extension is denied.

With respect to the suggestion that the rule be amended to explicitly state that the Board may reset the discovery period if necessary, it is believed that this is unnecessary, and would, because such a provision is not present in the other rules regarding the setting of time periods, lead to confusion. For example, there is no specific provision that, if a motion to dismiss is filed and the motion is subsequently denied, the Board will reset the time for the defendant to file an answer, although it is Board practice to do so.

The suggestion that a party be permitted to move for sanctions without first filing a motion to compel has not been adopted. The reason cited as the basis for the suggestion is the need to avoid a situation where a party is deprived of follow-up discovery because its adversary is recalcitrant. However, it is the practice of the Board, when granting a motion to compel in such situations, to reset the discovery period, at the request of the moving party, so as to restore (at least for that party) that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion. See Trademark Trial and Appeal Board Manual of Procedure (403.04 (''TBMP''). Thus, there is no need for the suggested amendment.

Section 2.120(a) was proposed to be amended to provide that responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 40 days from the date of service of such discovery requests, and to specify that the time to respond may be extended only upon stipulation of the parties or upon motion showing extraordinary circumstances approved by the Board.

Comments: Two organizations and one attorney believed that 30 days was a sufficient time to respond to discovery requests, and both the attorney and one of the organizations thought that the Board's practice should follow the 30-day time period provided by the Federal Rules of Civil Procedure. One organization expressed the concern that this proposal, combined with the proposal to eliminate extensions of the discovery period absent stipulation of the parties, would put too much pressure on the parties to serve discovery requests early in the discovery period, which could have an adverse effect on settlement.

Nine comments disagreed with the proposal to amend the section to provide that the time to provide responses to interrogatories, requests for production of documents and things, and requests for admission may be extended only upon stipulation of the parties or upon motion showing extraordinary circumstances. Several comments expressed the view that this proposal would eliminate flexibility, which was felt to be a principal advantage of Board proceedings. There were concerns that the proposal would favor ITU applicants or those who are discovery-proof; prejudice the party relying on an old, widely used and promoted mark; and encourage harassing discovery. The comments also pointed out that there could be legitimate, but ordinary, business reasons why extensions might be necessary, such as situations where requests have to be translated for foreign entities, businesses which close for

vacation, and small businesses which do not have the resources to compile answers within 40 days. There was also concern that the proposal would result in parties giving incomplete responses to meet the deadline.

Response: The proposal to amend the section to specify that the time to respond to interrogatories, requests for production of documents and things, and requests for admission may be extended only upon stipulation of the parties or upon motion showing extraordinary circumstances is withdrawn. The section is instead amended to specify that 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. In view thereof, there is no longer a need to enlarge the period for providing responses to these requests. Accordingly, the proposal to enlarge the time to serve responses to 40 days from the date of service of the discovery requests is also withdrawn, and the section is amended to specify that discovery responses must be served within 30 days from the date of service of the discovery requests. The period for responding will thus remain consistent with that provided under the Federal Rules of Civil Procedure.

Section 2.120(a) was proposed to be further amended to include provisions currently found in § 2.121(a)(1), in somewhat different form. Specifically, the section was proposed to be amended to provide that the resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; that the discovery period will be rescheduled only upon stipulation of the parties approved by the Board; and that testimony periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board. The latter parts of this proposed amendment are withdrawn, for the reasons discussed above in connection with the withdrawal of the proposal to allow extensions of the discovery period only upon stipulation of the parties, and below in connection with the withdrawal of the proposal to amend §§ 2.121(a)(1) and 2.121(c) to allow the rescheduling or extension of testimony periods only upon stipulation of the parties or a showing of extraordinary circumstances. Only the first portion of the proposed amendment is included in the amended section.

Thus, the section is amended to specify that the resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods, and that such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The new provisions are the same as those currently found at the end of § 2.121(a)(1). It is believed that § 2.120(a), rather than § 2.121(a)(1), which governs the scheduling and rescheduling of testimony periods, is the most logical place for these provisions.

Section 2.120(d)(1) now provides, in pertinent part, that the total number of written interrogatories which a party may serve upon another party in a proceeding shall not exceed 75, counting subparts, except that the Board, in its discretion, may allow additional interrogatories upon motion showing good cause, or upon stipulation of the parties. The section was proposed to be amended to lower the interrogatory number limit from 75, counting subparts, to 25, counting subparts, and to delete the references to a motion for leave to serve additional interrogatories.

Comments: Twenty comments asserted that limiting the number of interrogatories that could be served upon a party to 25, counting subparts, was too restrictive, while thirteen comments stated that parties should be permitted to file a motion for leave to serve additional interrogatories. Those commenting believed that 25 interrogatories was not a sufficient amount to obtain necessary discovery. As a result, it was feared that parties would serve overly broad interrogatories, which would lead to more motions to compel. The comments also asserted that the proposed limit would force parties into taking more depositions, and thus increase the cost of litigating an inter partes proceeding before the Board. Further, the comments noted that depositions are generally not a viable alternative when the adversary is a foreign entity.

Response: The proposed amendments to lower the number of interrogatories which a party may serve upon another party and to eliminate the provision for a motion for leave to serve additional interrogatories are withdrawn.

Section 2.120(d)(2), which now includes only a provision concerning the place for production of documents and things, was proposed to be amended to limit the number of requests for production of documents and things which a party may serve upon another party to 15, counting subparts, except upon stipulation of the parties.

Comments: For reasons similar to those given in connection with the objections to lowering the number of interrogatories a party could serve upon another party in a proceeding, twenty-three comments disagreed with the proposal to limit to 15 the number of document production requests that a party could serve.

Response: The proposed amendment has been withdrawn, as set forth in the notice of hearing and reopening of comment period on the proposed rules, namely, ''Miscellaneous Changes to Trademark Trial and Appeal Board Rules,'' 62 FR 59640 (Nov. 4, 1997), 1204 TMOG 88 (Nov. 25, 1997).

Section 2.120(e), which governs motions to compel discovery, was proposed to be amended to, inter alia, redesignate the present paragraph as (1), and to amend that paragraph to insert, after the first sentence, a new sentence specifying that a motion to compel must be filed within 30 days after the close of the discovery period, as originally set or as reset.

Comments: Two comments expressed the concern that under the wording of the proposed amendment, motions to compel could not be filed until after the close of the discovery period. It was suggested that instead of stating that the motion must be filed ''within'' 30 days after the close of the discovery period, the language be changed to ''no later than'' 30 days after the close of the discovery period. Another comment, while agreeing that it is appropriate to require that motions be filed within a specified time, suggested that there should be flexibility to extend this date.

Response: The PTO agrees that parties should be allowed to file motions to compel during the discovery period. However, the suggested language has not been adopted because of changes made to proposed § 2.120(a). Specifically, § 2.120(a) was proposed to be amended to require, inter alia, that interrogatories, requests for production of documents and things, and requests for admission be served in sufficient time for answers to fall due prior to the close of discovery. However, as a result of comments received on the proposed amendment, it has been withdrawn, and § 2.120(a) instead has been amended to codify the Board's current practice that discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admissions must be served, on or before the closing date of the discovery period. In the case of written discovery requests served on the last day of the discovery period, responses would not fall due until 30 days after the close of the discovery

period (or 35 days if service of the requests was made by mail—See § 2.119(c)). In view thereof, a requirement that motions to compel be filed no later than 30 days after the close of discovery is no longer appropriate.

Nevertheless, the PTO still believes that a motion to compel (as well as a motion to test the sufficiency of an answer or objection to a request for admission) deals with pre-trial matters and should be filed and determined prior to trial. Therefore, § 2.120(e) is amended to state, in relevant part of redesignated paragraph (e)(1), ''The motion must be filed prior to the commencement of the first testimony period as originally set or as reset.'' Under the amended rule, motions to compel can be filed at any time during the discovery period, and up to the commencement of the first testimony period, as originally set or as reset. The Board, when setting trial dates in cases arising under these rules as amended, intends to schedule an interval of 60 days between the closing date of the discovery period and the opening date of the first testimony period. Accordingly, there will be adequate time to file a motion to compel prior to the opening of the first testimony period even with respect to those discovery requests served on the last day of the discovery period.

Section 2.120(e) is also amended to add a new paragraph, designated (e)(2), specifying, inter alia, that when a party files a motion for an order to compel discovery, the case will be suspended by the Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension letter.

Comments: One organization suggested that the filing of a motion to compel (or a motion to test the sufficiency of an answer or an objection to a request for admission) should automatically suspend proceedings, so that the parties would not have to wait to receive the Board's suspension order. Two comments suggested that the rule should be more specific as to the manner of suspension, and explicitly state that, when the motion is resolved, discovery will be resumed and the moving party will be given more time for discovery if the motion is granted. A law firm commented that the proposed change ''would be unnecessary if we keep the discovery at 270 days'' and suggested that suspension should occur only if the motion is not decided within 45 days of filing the motion so that there would be pressure on the Board to decide discovery matters promptly.

Response: The suggestion that the rule should be modified to provide that the filing of a motion to compel will automatically suspend proceedings has not been adopted. The Board must review the motion to ascertain, for example, whether it is timely and meets the minimal requirements for a motion to compel. Proceedings should not be suspended when a motion to compel is not timely or does not meet the minimal requirements for such a motion. Further, if the mere filing of a motion to compel resulted in an automatic suspension of proceedings, parties might be encouraged thereby to file such a motion merely as a strategic move to gain time and/or delay proceedings. The PTO believes that the better practice is for the Board to retain control over the running of the suspension period.

As for the suggestion that the rule specify that the Board will provide additional time for discovery if a motion to compel is granted, the determination of whether discovery dates will be reset varies from situation to situation. For example, if the moving party serves its discovery requests so late in the discovery period that responses will not be due until after the close of the discovery period, that party will not be entitled to time for serving additional discovery requests even if its motion to compel is granted. On the other hand, the moving party may serve its discovery requests early enough in the discovery period that there will be time for follow-up discovery if the adverse party serves timely responses, but the adverse party may not respond, or may serve responses which are insufficient, and the propounding party may be forced to file a motion to compel. In this situation, the Board, at the request of the propounding party, will reset the discovery period to put that party back in the position it would have been in if it had received timely and proper responses. See TBMP § 403.04. Because the relief to be granted in connection with a motion to compel (or a motion to test the sufficiency of an answer or an objection to a request for admission) in any given case is highly dependent on the particular facts of that case, the Board must have discretion to determine what relief is appropriate.

The comment that the proposed change ''would be unnecessary if we keep the discovery at 270 days'' is not understood, because under present practice the discovery period, absent extensions, would rarely amount to 270 days. As for the suggestion that suspension should occur only if a motion to compel is not decided by the Board within 45 days of its filing, thus keeping pressure on the Board, this suggested modification would seem to work a hardship not on the Board, but on the parties. In view of the time allowed under the applicable rules for filing a brief in opposition to a motion, as well as the time involved in the processing of mail within the PTO, a motion to compel is not likely to be determined within 45 days of filing. If a motion to compel is filed shortly before the commencement of the plaintiff's testimony period, and the case is not suspended until 45 days or more after the filing of the motion to compel, the testimony periods would go forward, and the parties would be left in a state of uncertainty as to what action, if any, should be taken. A motion to compel (like a motion to test the sufficiency of an answer or objection to a request for admission) deals with pre-trial matters and should, therefore, be filed and determined prior to trial. The new provisions governing the time for filing a motion to compel and the Board's suspension of proceedings pending the determination of the motion, coupled with the Board's intention to schedule an interval of 60 days between the close of the discovery period and the opening of the first testimony period, will provide for a more orderly administration of the proceeding and allow parties more certainty in scheduling testimony. Accordingly, the suggested modification has not been adopted.

Section 2.120(e) is further amended to provide, in the new paragraph (e)(2), that the filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

Comments: One attorney suggested that the entire proceeding (including the time for responding to outstanding discovery requests or for appearing at noticed discovery depositions) should be suspended, or it might create an unfair advantage for the non-moving party. That person was concerned that the non-moving party could serve the same discovery requests as the moving party, and that, even if the Board denied the motion to compel or placed limitations on the required responses, the moving party would have had to respond fully while the non-moving party would not. Another commented that with this amendment a prompt decision on the motion to compel is critical, and suggested telephone conferences to decide the motion.

Response: The suggested modification has not been adopted. The Board does not believe that the amended rule prejudices the party filing a motion to compel. Because the signature of a party

or its attorney to a request for discovery constitutes a certification by the party or its attorney that the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. See TBMP § 402.02 and cases cited therein. Thus, if the non-moving party serves the same discovery requests as the moving party, the non-moving party will ordinarily be required to respond to the requests. Moreover, to the extent that the moving party believes that any of the discovery requests served on it are inappropriate, it may object to those requests when it serves its responses. As for the suggestion that telephone conferences be used to decide motions to compel, as indicated previously, the Board is undertaking a pilot program to make greater use of telephone conferences in determining pending interlocutory matters and motions.

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

It is believed that the adoption of a rule authorizing the Board to impose a sanction in the form of compensatory expenses and/or compensatory attorney fees would result in an increase in the number of papers and motions filed in proceedings before the Board. For this reason, and in order to harmonize § 2.120(g)(1) with § 1.616, § 2.120(g)(1) is amended to substitute a statement that the Board ''will not'' hold any person in contempt or award any expenses to any party, for the statement that the Board ''does not have authority'' to hold any person in contempt or award any expenses to any party. Section 2.127(f), which now states in pertinent part that the Board ''does not have authority to hold any persons in contempt, or to award attorneys' fees or other expenses to any party,'' is amended in the same manner.

Comments: Five comments suggested that the rule be amended not only to indicate that the Board has authority to award expenses as a sanction, but also to provide that the Board will exercise this sanctioning power. They stated that awarding expenses would be an effective tool for combating improper motions and other abuses by parties and their attorneys. One organization, while approving of the proposed amendment not to award monetary sanctions, urged the Board to make more effective use of the sanctioning powers it will exercise by using its power more often and publishing decisions in which sanctions are imposed.

Response: As indicated above, it is believed that the adoption of a rule authorizing the Board to impose a sanction in the form of compensatory expenses and/or compensatory attorney fees would result in the filing of many motions for such sanctions (as well as a large number of associated papers concerning the appropriate amount for such expenses and/or fees), thus increasing the workload of the Board. Accordingly, this suggestion has not been adopted. However, the Board plans to follow the suggestion that it use its other sanctioning powers more often, and that it publish more decisions in which it enters sanctions. It is hoped that these steps will make practitioners aware of the Board's lack of tolerance for abuses and lead to a curtailment of abuses.

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

The section was proposed to be further amended to add a new paragraph, designated (h)(1), limiting the number of requests for admission which a party may serve upon another party, in a proceeding, to 25, counting subparts. Specifically, the proposed new paragraph provided that the total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed 25, counting subparts, except upon stipulation of the parties; that if a party upon which requests for admission have been served believes that the number of requests served exceeds the limitation specified in the paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the requests, serve a general objection on the ground of their excessive number; and that if the inquiring party, in turn, files a motion to determine the sufficiency of the objection, the motion must be accompanied by a copy of the set(s) of requests for admission which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (h)(2) of the section. The proposed provisions paralleled the provisions of § 2.120(d)(1), which limit the number of interrogatories which a party may serve upon another party in a proceeding.

Finally, § 2.120(h) was proposed to be amended to add another new paragraph, designated (h)(3), which provided for the suspension of proceedings when a motion to determine the sufficiency of an answer or objection to a request for

admission is filed. Specifically, the proposed new paragraph provided that when a party files a motion to determine the sufficiency of an answer or objection to a request made by that party for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The proposed new paragraph also provided that the filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. The provisions of proposed new § 2.120(h)(3) paralleled the provisions of proposed new § 2.120(e) and § 2.127(d).

Comments: Nineteen comments were received which objected to the proposed limit on requests for admission. The comments noted that requests for admission are useful in limiting issues for trial and for streamlining the introduction of documentary evidence. In addition, the comments raised objections similar to those made in response to the proposal to amend § 2.120(d)(1) to lower the number of interrogatories which one party may serve upon another in a proceeding.

Response: As a result of the comments received, the proposed amendment to limit requests for admission has been withdrawn. See the notice of hearing and reopening of comment period on the proposed rules, namely, ''Miscellaneous Changes to Trademark Trial and Appeal Board Rules,'' 62 FR 59640 (Nov. 4, 1997), 1204 TMOG 88 (Nov. 25, 1997) (stating the PTO's intention to withdraw this proposal). Accordingly, the rule is not being amended to include the proposed new first paragraph; the present paragraph will remain but is redesignated (h)(1), and the proposed paragraph (h)(3) is added but redesignated (h)(2). These amendments are described in more detail below.

Section 2.120(h), redesignated as (h)(1), is amended to delete the first sentence, which reads ''Requests for admissions shall be governed by Rule 36 of the Federal Rules of Civil Procedure except that the Trademark Trial and Appeal Board does not have authority to award any expenses to any party.'' The sentence suggests that the only provision in Federal Rule 36 which does not apply in Board proceedings is that pertaining to the awarding of expenses. However, there are also other provisions in Rule 36 which do not apply in Board proceedings. Moreover, § 2.120(a), as amended herein, specifies that whenever appropriate, the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference, and concurrent use registration proceedings, except as otherwise provided in § 2.120. Further, § § 2.120(g)(1) and 2.127(f), as amended herein, provide that the Board will not hold any person in contempt or award expenses to any party. Accordingly, the first sentence of § 2.120(h), redesignated herein as (h)(1), is being deleted because it is confusing and redundant.

It was proposed to amend the second sentence of the present paragraph (now redesignated as § 2.120(h)(1)) to add to the beginning of the paragraph a new sentence reading ''Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed within 30 days after the close of the discovery period, as originally set or as reset.'' For the reasons stated above in connection with § 2.120(e)(1), governing motions to compel, the paragraph is instead amended to include a new first sentence reading, ''Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed prior to the commencement of the first testimony period, as originally set or as reset.'' The amendment parallels a similar amendment to § 2.120(e).

Present § 2.120(h), redesignated as § 2.120(h)(1), is further amended to revise the beginning of the second sentence, which now reads, ''A motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission shall * * *,'' to read ''The motion shall * * *.''

Section 2.120(h) is amended to add a new paragraph, proposed to be designated as (h)(3) but, with the withdrawal of the proposal to limit requests for admission, now designated (h)(2). This new paragraph provides for the suspension of proceedings when a motion to determine the sufficiency of an answer or objection to a request for admission is filed. Specifically, the paragraph provides that 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, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The paragraph further provides that the filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. The amendment parallels a similar amendment to § 2.120(e). The comments submitted (and discussed above) in connection with the amendment to § 2.120(e) were considered also in connection with this amendment, with the same outcome.

Section 2.121(a)(1) now provides, inter alia, that testimony periods may be rescheduled ''by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.'' The sentence was proposed to be amended to provide that testimony periods may be rescheduled ''by stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.'' Similarly, § 2.121(c) now provides, inter alia, that testimony periods may be extended ''by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board.'' The sentence was proposed to be amended to provide that testimony periods may be extended ''by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion showing extraordinary circumstances granted by the Board.'' The proposed amendments would have eliminated extensions or rescheduling upon motion showing good cause.

Comments: Thirteen comments, including those from four organizations, disagreed with the proposal to eliminate the good cause standard for extending or rescheduling the testimony periods. The reasons given included that there could be many genuine business reasons, or unforeseen developments, why extensions would be necessary, but which would not rise to the level of extraordinary circumstances. Some of the comments suggested allowing one 30-day extension for good cause, or extensions for up to 2 months on a showing of good cause, or extensions on good cause with sanctions for abuse. Three attorneys from the same law firm suggested that the rule should provide for the grant of one extension as of right, and further extensions on a showing of good cause. One attorney suggested changing the pertinent sentence in § 2.121(a)(1) to read ''Testimony periods may be rescheduled or extended as provided for in 37 CFR 2.121(c)'' to avoid duplication. That same attorney also suggested providing for a non-party to object to a stipulated rescheduling or enlargement of testimony when the

proceeding is delaying an application by a non-party or delaying another proceeding in which the non-party has an interest.

Response: The proposal to amend §§ 2.121(a)(1) and 2.121(c) to eliminate the good cause standard for motions to reschedule or extend the testimony periods is withdrawn. As for the suggestion that one rescheduling or extension of the testimony periods be granted without any showing of cause, the Board does not believe this is warranted since the proposed amendments have been withdrawn. Moreover, once an inter partes proceeding commences, no other extensions of time are granted as of right. With respect to the suggestion to reword the pertinent sentence in § 2.121(a)(1) to refer to § 2.121(c), it is believed that the clarity offered in setting forth the bases for the rescheduling of testimony periods in § 2.121(a)(1) is helpful to the parties. The suggestion that a non-party be permitted to object to a rescheduling of the testimony periods is beyond the scope of the proposed rule amendment, and therefore cannot be considered at this time.

Section 2.121(a)(1) is amended to add a new sentence specifying that if a motion to reschedule testimony periods is denied, ''the testimony periods may remain as set.'' The Board has always had the discretion to leave the testimony periods as set when a motion to reschedule is denied. However, it is hoped that explicit statement of this fact in the rules will alert parties to the potential consequences if a motion to reschedule does not show good cause, and will put them on notice that the Board will not tolerate abuses of the rules.

Section 2.121(a)(1) now includes a last sentence reading, ''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.'' The section is amended by deleting this sentence, which has been added to § 2.120(a). It is believed that § 2.120(a), which governs, inter alia, extensions of time to respond to discovery requests, is the most logical place for the sentence.

Comment: One attorney suggested that the rule provide that if the discovery period is rescheduled, the start of the testimony period should be automatically reset without a party having to make a request or motion.

Response: Such a provision appears as the fourth sentence of present § 2.121(a)(1), and will remain in the amended rule as the last sentence of the paragraph.

Section 2.121(c), which governs the length of the testimony periods, was proposed to be amended to enlarge the rebuttal testimony period from 15 to 30 days, and to enlarge all other testimony periods from 30 to 60 days.

Comments: Four comments disagreed with this proposal, stating that the existing trial periods are adequate, that 60 days is rarely needed to complete testimony, and that most trials in trademark litigation are conducted in one to two weeks or less. It was also felt that enlarging the testimony periods would unduly lengthen inter partes proceedings.

Response: The proposal to lengthen the testimony periods was tied to the proposal to eliminate good cause extensions of these periods. Because the proposal to eliminate good cause extensions is withdrawn, the proposal to lengthen the testimony periods is also withdrawn.

Section 2.121(c), which now provides, inter alia, that the testimony periods may be extended ''by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board,'' was also proposed to be amended to provide that the periods may be extended ''by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion showing extraordinary circumstances granted by the Board.'' The proposed amendment paralleled a similar proposed amendment to § 2.121(a)(1), which governs, inter alia, the rescheduling of testimony periods. For the reasons stated in connection with the proposed parallel amendment to § 2.121(a)(1), the proposal is withdrawn.

Section 2.121(c) is amended to specify that if a motion to extend the testimony period is denied, ''the testimony periods may remain as set.''

Comments: One organization suggested that if the motion were denied, the testimony period should be reset to allow the amount of time which remained when the motion to extend was filed. Three attorneys, all from the same law firm, commented that if prior deadlines are to remain in effect when a motion to extend is denied, the Board needs new procedures to expedite the delivery of motion papers to the Board, and for deciding the motion.

Response: With respect to the first comment, the PTO believes it is important for the Board to retain discretion as to the rescheduling of testimony periods. There is a concern that, if testimony periods had to be reset to provide the amount of time which was remaining at the time a motion to extend was filed, a party might file a motion for extension as a strategic measure to obtain a delay until the Board decides the motion, even if the motion is ultimately denied. The Board has always had the discretion, if it denied a motion for an extension, to leave the testimony periods as set. It is hoped that specifically stating this fact in this section, as well as in § 2.121(a)(1), will alert parties to the potential consequences if a motion to extend does not show good cause, and will put them on notice that the Board will not tolerate abuses of the rules.

As for the need for new procedures to expedite the processing and determination of motions to extend, the telephone pilot program, discussed above, should prove helpful in expediting the rendering of such decisions.

Section 2.121(d) now provides, in pertinent part, that when parties stipulate to the rescheduling of testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of testimony periods, a stipulation ''submitted in one original plus as many photocopies as there are parties'' will, if approved, be so stamped, signed, and dated, and the copies will be promptly returned to the parties. The section is amended by revising the quoted section to read ''submitted in a number of copies equal to the number of parties to the proceeding plus one copy for the Board.'' The Board does not need the original copy.

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

the applications mentioned in the declaration of interference may become abandoned for one reason or another. When the Board institutes the proceeding, it is only the surviving applications which are specified in the notice of interference, and it is only those application files which form part of the record of the proceeding without any action by the parties.

Section 2.122(d)(1) provides that a registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be made part of the record if the opposition or petition is accompanied ''by two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration.'' The section, which now includes a cross-reference to ''§ 2.6(n),'' is amended to correct the cross-reference to ''§ 2.6(b)(4).''

Comment: A suggestion was made to further amend this section to require that only one status and title copy of a registration be submitted with a notice of opposition. It was pointed out that only one copy of a registration is necessary when it is submitted with a notice of reliance, and it was believed that requiring that two be submitted with a notice of opposition was wasteful.

Response: A notice of opposition or petition to cancel, together with any exhibits thereto, must be submitted in duplicate. See §§ 2.104(a) and 2.112(a). This is because the Board places one of the copies in the Board's file of the proceeding, and the other copy is sent to the applicant or registrant with the notification of the institution of the proceeding. Thus, when a plaintiff wishes to make a pleaded registration of record by submitting a status and title copy of the registration with its complaint pursuant to § 2.122(d)(1), one copy of the registration must be submitted with each copy of the complaint. That is, both the complaint, and the status and title copy of the registration, must be submitted in duplicate. A party need only file one copy of a registration with a notice of reliance, on the other hand, because the party itself must separately serve a copy of the notice of reliance and the registration on each adverse party. It may be that the comment was occasioned by a belief that two copies of a pleaded registration must be submitted with each copy of the complaint, for a total of four copies of the registration. That is not the case. To the extent the comment is concerned about the expense of obtaining two status and title copies of a registration from the PTO, the Board does not require that two ''originals'' be submitted. The section is amended to make this clear by adding as a parenthetical the words ''originals or photocopies'' after the word ''copies'', so that the sentence will read, in pertinent part, ''* * * if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office * * *''

Section 2.122(d)(2), provides, inter alia, that a registration owned by any party to a proceeding may be made of record by filing a notice of reliance which is accompanied by a copy of the registration prepared and issued by the Patent and Trademark Office showing the current status of and current title to the registration. This section is amended to add, as a parenthetical after the word ''copy,'' the words ''original or photocopy'', so that the sentence will read, in pertinent part, ''* * * a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office * * *'' This change is consistent with the amendment to § 2.122(d)(1).

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

Section 2.123(f) pertains to the certification and filing of a deposition by the officer before whom the deposition was taken. The section now provides, in pertinent part, that the officer certifying a testimony deposition shall, without delay, forward the evidence, notices, and paper exhibits to the Commissioner of Patents and Trademarks. The section is amended to eliminate the requirement that this material be forwarded to the Commissioner ''without delay.'' The section is also amended to state that either the officer or the party taking the testimony deposition, or its attorney or other authorized representative, should forward this material to the Commissioner. Specifically, the third sentence of the second paragraph of the section now reads, ''unless waived on the record by an agreement, he shall then, without delay, securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents and Trademarks.'' The sentence is amended to delete the words ''without delay,'' to put a period after the word ''sealing,'' and to convert the remainder of the present sentence into a new sentence which reads, ''The officer or the party taking the deposition, or its attorney or other authorized representative, shall then address the package and forward the same to the Commissioner of Patents and Trademarks.'' The fourth sentence of the paragraph now reads, ''If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted in a separate package marked and addressed as provided in this section.'' The sentence is amended to insert, after the word ''transmitted,'' the phrase ''by the officer or the party taking the deposition, or its attorney or other authorized representative.'' Finally, in view of the amendments to the third and fourth sentences, the title of the section, which now reads ''Certification and filing by officer,'' is amended to read ''Certification and filing of deposition.'' To eliminate undesignated text, paragraph (f) has been redesignated.

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

associated materials to the party taking the deposition, or to its attorney or other authorized representative, the party, or its attorney or other authorized representative, need not return the envelope or package to the officer for filing with the PTO, but rather may send it directly to the PTO.

Section 2.125(c), which now provides that one certified transcript (of a testimony deposition) and exhibits shall be filed ''promptly,'' with the Board, is amended to delete the word ''promptly.'' The amendment corresponds to the amendment deleting the words ''without delay'' from § 2.123(f), and conforms § 2.125(c) to current Board practice.

Section 2.127(a), which governs the filing of briefs on motions, was proposed to be amended to enlarge the time for filing a brief in response to a motion (other than a motion for summary judgment which was covered separately in proposed § 2.127(e)(1)) from 15 days to 30 days.

Comments: Two comments stated that 30 days was too long a period and suggested that 15 or 20 days would be sufficient; a third comment, while not objecting to the enlargement of time, believed that the current time period was not too short.

Response: The proposal to enlarge the time to respond to a motion which is not a motion for summary judgment was tied to a proposal to amend § 2.127(a) to eliminate good cause extensions of this time. Because the proposal to eliminate good cause extensions is withdrawn, as indicated immediately hereafter, the proposal to lengthen the time to respond is also withdrawn.

Section 2.127(a) was proposed to be amended to delete, from the second sentence, a provision for extension of the time to respond to a motion by ''order of the Board on motion for good cause'' and substitute a provision for an extension by ''stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.''

Comments: Three comments suggested that the good cause standard be retained, one organization stating that sanctions should be imposed in cases involving abuse. Three attorneys from the same law firm suggested that a first extension of time be granted as of right, and that further extensions be granted upon a showing of good cause.

Response: Just as the proposals to eliminate good cause as a standard for motions to extend the discovery and discovery response periods (§ 2.120(a)), and motions to reschedule (§ 2.121(a)(1)) or extend (§ 2.121(c)) testimony periods, are withdrawn herein, so too the proposal to eliminate good cause as a standard for obtaining extensions of time to respond to a motion is withdrawn.

Section 2.127(a) is amended to provide that if a motion for an extension of time to file a brief in response to a motion is denied, the time for responding to the motion for summary judgment may remain as specified under this section.

Comment: Three attorneys from the same law firm commented that in view of this amendment, the Board will need some provision for quick processing of the motion papers and for expedited decisions.

Response: The telephone pilot program, discussed above, should prove helpful in expediting decisions on motions for extensions of time.

Section 2.127(a), which now makes no mention of reply briefs or further papers in support of or in opposition to motions, was proposed to be amended to (1) state that a reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion; (2) preface this new provision with the phrase ''Except as provided in paragraph (e)(1), a'' to make clear that this provision does not apply to reply briefs in support of summary judgment motions; and (3) specify that the time for filing a reply brief will not be extended, and that no further papers in support of or in opposition to a motion will be considered by the Board.

Comments: One organization disagreed with the proposal to amend the section to specify that the time to file a reply brief will not be extended. This organization stated that there was no reason why the circumstances that necessitate an extension of time to file a brief in opposition are less likely to be present when filing a reply brief. As for the prohibition against papers beyond a reply brief, four comments expressed the concern that the moving party will save new issues for its reply, and the party opposing a motion will be at a disadvantage because it will not be able to respond. A suggestion was made to adopt the rule that the reply be limited to rebuttal of points newly raised in the answering brief, and that issues not raised in the moving brief are waived. Another comment suggested that there should either be a provision in the section that no new issues raised in a reply brief will be considered, or the Board should allow for a surreply brief limited to any new issues raised in the reply.

Response: It is believed that extensions of time to file a reply brief need not be available in the same way that extensions to file a brief in opposition are available, because the circumstances surrounding the filing of a reply brief and a brief in opposition are different. Specifically, while the service of a motion may come as a surprise to a party, the moving party labors under no such obstacle. It must also be acknowledged that reply briefs are generally found to have little persuasive value; often they are a mere reargument of the points made in the main brief. It is the practice of the Board to consider a reply brief only when, in the Board's opinion, such a brief is warranted under the circumstances of a particular case, such as when the Board finds that a reply brief is necessary to permit the moving party to respond to new issues raised in the brief in opposition to the motion, or that the issue to be determined is complex or needs to be further clarified, or that certain arguments against the motion should be answered so as to assist the Board in arriving at a just decision on the motion. See TBMP § 502.03. Accordingly, the section is amended as proposed. However, to emphasize that the Board does not intend to encourage the filing of reply briefs, the sentence, ''The Board may, in its discretion, consider a reply brief,'' has been added to the section.

With respect to the concern that the moving party may ''save'' new issues for its reply brief, the Board is able to recognize what is proper material for a reply brief. However, it is believed that it is not necessary to include a specific provision that ''no new issues raised in a reply brief will be considered''; there are no such specific provisions in § 2.121(b)(1), which involves the rebuttal testimony period, and § 2.128(a)(1), which concerns a reply brief at final hearing.

Section 2.127(a) is further amended to (1) add form requirements for briefs, *i.e.*, that they shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper; (2) add a page limitation for briefs, namely, 25 pages for a brief in support of or in response to a motion and 10 pages for a reply brief; and (3) specify that exhibits submitted in support of or in opposition to a motion shall not be deemed to be part of the brief for purposes of determining the length of the brief.

Comments: One organization thought the page limits were too restrictive, and suggested 35 pages for main briefs and 15 for reply briefs; three comments suggested higher page limits for potentially dispositive motions; one attorney recommended 30- and 15-page limits for summary judgment motions; and an organization suggested a 40-page

limit for dispositive motions, pointing out that other courts have 45- and 50-page limits. Two organizations agreed with the proposed page limit, as long as the Board would grant leave to file longer briefs with a good cause showing, such as if there were multiple parties, consolidated proceedings, or multiple marks.

Response: It is believed that 25 and 10 pages are sufficient for the main brief and reply brief, respectively, of any motion that arises in a Board inter partes proceeding. Because of the limited nature of Board proceedings, briefing for motions in such proceedings need not be as extensive as that in proceedings in court. Although the Board is of the firm opinion that all issues in a motion can be briefed in 25 pages for a main brief, and 10 pages for a reply brief, the rule does not specifically prohibit a motion for leave to file a longer brief upon a showing of good cause. The Board may include such a prohibition as part of a future rulemaking if it appears that parties are abusing such requests.

Section 2.127(b), which now provides, in pertinent part, that any request for reconsideration or modification of an order or decision issued on a motion must be filed within thirty days from the date of the order or decision, is amended to change the specification of the time period for requesting reconsideration or modification from ''thirty days'' to ''one month.'' The amended rule parallels § 2.129(c), which governs the time for filing a request for rehearing or reconsideration or modification of a decision issued after final hearing.

Section 2.127(d) now provides, in its first sentence, that when any party files a motion which is potentially dispositive of a proceeding, the case will be suspended by the Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion. The sentence is amended to add to the end of the sentence the phrase ''except as otherwise specified in the Board's suspension order.''

Comment: One organization suggested the section should be amended to provide that the filing of a potentially dispositive motion automatically suspends proceedings, without any action by the Board.

Response: The suggested modification has not been adopted. A variety of motions are potentially dispositive, including a motion for sanctions in the form of entry of judgment. Because of the number of situations in which a party may make a potentially dispositive motion, it is believed better for the Board to determine whether proceedings should be suspended based on the situation presented by the particular case.

Section 2.127(d) was also proposed to be amended to add a new sentence providing that the filing of a summary judgment motion shall not toll the time for the moving party to respond to any outstanding discovery requests or to appear at a noticed discovery deposition, but it shall toll the time for the nonmoving party to serve such responses or to appear for such deposition.

Comments: Three comments disagreed with this proposal. They stated that the moving party should not be forced to spend unnecessary time and money to provide discovery responses when the proceeding may be decided on the basis of the pending summary judgment motion. They believed that any discovery that is essential for the non-moving party can be obtained through an FRCP 56(f) motion. Another comment suggested that the non-moving party's obligation to respond to discovery not be tolled by the filing of a summary judgment motion, in that the moving party might require discovery if it were moving for partial summary judgment.

Response: Upon consideration of the comments regarding the tolling of time for responding to discovery, the proposal to amend § 2.127(d) to add the sentence, ''The filing of a summary judgment motion shall not toll the time for the moving party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition, but it shall toll the time for the nonmoving party to serve such responses or to appear for such deposition.'', is withdrawn.

Section 2.127(e)(1) presently provides that a motion for summary judgment should be filed prior to the commencement of the first testimony period, as originally set or as reset, and that the Trademark Trial and Appeal Board, in its discretion, may deny as untimely any motion filed thereafter. The section is amended to add, at the beginning of the section, a provision that a motion for summary judgment may not be filed until notification of the proceeding has been sent to the parties by the Board. The amendment codifies current Board practice, as set forth in *Nabisco Brands Inc.* v. *Keebler Co.,* 28 USPQ2d 1237 (TTAB 1993).

Comments: One comment suggested that parties should be allowed to file summary judgment motions with the pleadings. Another comment suggested that parties be permitted to file summary judgment motions up to the end of a party's testimony period.

Response: The suggestion that parties be allowed to file summary judgment motions with the pleadings has not been adopted. The Board considers a motion for summary judgment filed prior to the issuance of the notice of institution to be premature. Although the proceeding commences with the filing of the complaint, formal service of the complaint upon the defendant is made by the Board, not by the plaintiff. The Board does not serve the complaint upon the defendant until after the Board has first examined the complaint to determine whether it has been filed in proper form, with the required fee, and then, if so, has (1) obtained the application or registration file which is the subject of the proceeding, (2) set up a proceeding file with an assigned proceeding number, and (3) entered information concerning the proceeding in the electronic records of the PTO. Thus, there is a time gap between the filing of a notice of opposition or petition for cancellation and the issuance of the Board's action notifying the defendant of the filing of the proceeding, notifying both parties of the institution of the proceeding, and forwarding a copy of the complaint to the defendant. Although a plaintiff may send a courtesy copy of the complaint to the defendant, the defendant does not know that the complaint has been filed in proper form, and that the proceeding has been instituted by the Board, until it receives from the Board the notice of institution along with a copy of the complaint. Moreover, the filing of a motion for summary judgment prior to the Board's formal institution of the proceeding may cause administrative difficulties for the Board, particularly where the Board has not yet assigned a proceeding number to the case.

As for the suggestion that parties be permitted to file summary judgment motions up to the end of a party's testimony period, this is beyond the scope of the proposed amendment. Moreover, the suggested modification would defeat the concept of summary judgment, which is a procedure to dispose of a case before trial. Once a party's testimony period has opened, trial has begun. Accordingly, the suggested modification has not been adopted.

Section 2.127(e)(1) is further amended to add provisions specifying that (1) a motion under Rule 56(f) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within 30 days from the date of service of the summary judgment motion, and (2) the time for

filing a motion under Rule 56(f) will not be extended.

Comments: Three attorneys from one law firm asserted that this amendment would put extraordinary pressure on counsel, and suggested that there be a provision for extensions given the dispositive nature of a summary judgment motion. An organization raised a concern that when a motion to dismiss which is accompanied by affidavits and exhibits is treated as a summary judgment motion it would be difficult for the plaintiff to properly frame a Rule 56(f) motion without having the defendant's answer, and suggested that in such a case the defendant should be required to file its answer before the plaintiff must file a 56(f) motion.

Response: The PTO believes that 30 days is an adequate time for a party to review a summary judgment motion, determine whether it needs particular discovery in order to respond to the motion, and prepare a motion for such discovery, supported by an affidavit attesting to the reasons for the need for the discovery. With respect to the suggestion, in the motion to dismiss turned motion for summary judgment situation, that the defendant be required to file its answer before the plaintiff must file a 56(f) motion, the Board believes that the plaintiff will be adequately informed of the factual issues regarding the defendant's position by the summary judgment motion and accompanying materials, such that the plaintiff can frame a Rule 56(f) motion.

Section 2.127(e)(1) was also proposed to be amended to provide that if no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within 60 days from the date of service of the motion, unless the time is extended by stipulation of the parties approved by the Board, or upon motion showing extraordinary circumstances granted by the Board.

Comments: Two comments disagreed with the proposal to enlarge the period to respond to a summary judgment motion to 60 days, stating that 30 days was adequate. Three comments disagreed with the proposal to allow extensions of the time to file a brief only on consent or a showing of extraordinary circumstances: two suggested a good cause basis, while three comments, by attorneys from the same law firm, suggested that a first extension be allowed as of right, and additional extensions upon a showing of good cause.

Response: The proposal to amend this section to allow extensions of time to file a brief opposing a motion for summary judgment only on consent or a showing of extraordinary circumstances is withdrawn. The withdrawal of this proposal is consistent with the withdrawals herein of proposals to eliminate good cause as a standard for motions to extend the discovery and discovery response periods (§ 2.120(a)), motions to reschedule (§ 2.121(a)(1)) or extend (§ 2.121(c)) testimony periods, and motions to extend the time to respond to motions other than summary judgment motions (§ 2.127(a)). The Board practice of granting extensions based on a showing of good cause will continue, and the rule has been amended to specifically state that extensions may be had on this basis. However, the suggestion that a first extension should be granted as of right is not adopted. Once a proceeding has commenced there is no other situation where an extension of time may be obtained without providing any reason whatsoever. It is believed that a good cause standard will not place an undue burden on the parties. As for the proposal to allow 60 days for the filing of a brief in response to a motion for summary judgment, § 2.127(e)(1) is amended to provide instead that a brief in response to a motion for summary judgment shall be filed within 30 days from the date of service of the motion. The modification is made because of the decision to allow extensions upon a showing of good cause, and because of the comments regarding the time to respond to a summary judgment motion.

Section 2.127(e)(1) is further amended to provide that if a motion for an extension of time to file a brief in response to a motion for summary judgment is denied, the time for responding to the motion for summary judgment may remain as specified under this section.

Comment: Three attorneys, all of whom are from the same law firm, commented that in view of this amendment, new procedures are needed to expedite the delivery of the motion papers to the Board and for deciding the motion.

Response: The telephone pilot program, discussed above, should prove helpful in expediting decisions on motions for extensions of time.

Section 2.127(e)(1) now makes no mention of reply briefs or further papers in support of or in opposition to summary judgment motions. It was proposed to amend this section to provide that a reply brief, if filed, shall be filed within 30 days from the date of service of the brief in response to the motion; that the time for filing a reply brief will not be extended; and that no further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.

Comments: One comment suggested that 15 days was a sufficient time to file a reply brief. One organization disagreed with the proposed provision that the time to file a reply brief will not be extended. This organization stated that there was no reason why the circumstances that necessitate an extension of time to file a brief in opposition are less likely to be present when filing a reply brief. With regard to the prohibition against filing papers beyond a reply brief, one organization raised the concern that the party opposing a motion will be at a disadvantage if the moving party saves new issues for its reply. It suggested that either the rule be amended to provide that new issues raised in a reply brief will not be considered, or that provision be made for a surreply brief which is limited to any new issues raised in the reply.

Response: The suggestion that a reply brief, if filed, should be filed within 15 days from the date of service of the brief in response to the motion for summary judgment is adopted. The section is otherwise amended as proposed. The amended rule parallels that portion of amended § 2.127(a) which pertains to the time for filing reply briefs to other types of motions. With respect to the comment that extensions of time to file a reply brief should be available in the same way that extensions to file a brief in opposition are available, it is believed that the circumstances surrounding the filing of a reply brief and a brief in opposition to a summary judgment motion are different, such that extensions should be permitted in the latter situation and not in the former. Specifically, the service of a motion for summary judgment may come as a surprise to a party, and it may take some time to obtain documents and affidavits in order to show that genuine issues of material fact exist; on the other hand, the party who has moved for summary judgment would have gathered the necessary evidence, and have researched the law prior to filing its motion. It must also be acknowledged that reply briefs are generally found to have little persuasive value; often they are a mere reargument of the points made in the main brief, and as such serve no useful purpose. It is not the practice of the Board to consider a reply brief of that nature. Rather, the Board considers a reply brief only when, in the Board's opinion, such a brief is warranted under the circumstances of a

particular case. See, in this regard, the discussion herein of the amendment of § 2.127(a) to add matter relating to reply briefs for motions other than summary judgment motions. However, to emphasize that the Board does not intend to encourage the filing of reply briefs, the sentence, ''The Board may, in its discretion, consider a reply brief,'' has been added to the section.

With respect to the concern that the moving party may ''save'' new issues for its reply brief, the Board is able to recognize what is proper material for a reply brief. However, it is believed that it is not necessary to include a specific provision that ''no new issues raised in a reply brief will be considered''; there are no such specific provisions in § 2.121(b)(1), which involves the rebuttal testimony period, and § 2.128(a)(1), which concerns a reply brief at final hearing.

Section 2.127(f) now provides that ''the Board does not have authority to hold any person in contempt, or to award attorneys' fees or other expenses to any party.'' This section is amended, in conformity with amended § 2.120(g)(1), and for the reasons indicated in connection therewith, to state that ''the Board will not hold any person in contempt, or award attorneys' fees or other expenses to any party.''

Comments: The comments made with respect to the amendment to § 2.120(g)(1) are applicable to this amendment. Five comments concerning § 2.120(g)(1) suggested that the rule not only be amended to indicate that the Board has authority to award expenses as a sanction, but also that the rule be amended to provide that the Board will exercise this sanctioning power. They stated that awarding expenses would be an effective tool in combating improper motions and other abuses by parties and their attorneys.

Response: As indicated in the response to the comments regarding the amendment to § 2.120(g)(1), it is believed that the adoption of a rule authorizing the Board to impose a sanction in the form of compensatory expenses and/or compensatory attorney fees would result in the filing of many motions for such sanctions (as well as a large number of associated papers concerning the appropriate amount therefor), thus increasing the workload of the Board. Accordingly, this suggestion has not been adopted. However, the Board is adopting the suggestion that it use its other sanctioning powers more often, and that it publish more decisions in which it enters sanctions. It is hoped that these steps will make practitioners aware of the Board's lack of tolerance for abuses and lead to a curtailment of abuses.

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

Section 2.146(e)(1), which now provides for filing a petition to the Commissioner from the denial of a request for an extension of time to file a notice of opposition, is amended to provide also for filing a petition from the grant of such a request. Specifically, the first sentence of the section is revised to read, ''A petition from the grant or denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the grant or denial of the request. A petition from the grant of a request shall be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant.'' In addition, the present third sentence of the section, which provides, in pertinent part, that the applicant may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, is amended by revising the beginning of the sentence to read, ''The potential opposer or the applicant, as the case may be, may file a response within fifteen days * * *.'' The amendments to § 2.126(e)(1) codify current practice and clarify the rule.

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

Environmental, Energy, and Other Considerations

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

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

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

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

This rule involves collections of information subject to the requirements of the PRA. The rule involves the Petition to Cancel requirement. This requirement has been approved by the Office of Management and Budget (OMB) under OMB control number 0651–0040. The public reporting burden for this collection of information is estimated to be 45 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. This rule also involves information requirements associated with filing an Opposition to the Registration of a Mark, Amendment to Allege Use, and dividing an application. These requirements have been previously approved by the OMB under OMB control number 0651–0009. Send comments regarding the burden estimate or any other aspects of the information requirements, including suggestions for reducing the burden, to the Assistant Commissioner for Trademarks, Box TTAB-No Fee, 2900 Crystal Drive, Arlington, VA 22202–3513, marked to the attention of Ellen J. Seeherman, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, 725 17th Street, N.W. Washington, DC 20230 (Attention: PTO Desk Officer).

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks.

For the reasons given in the preamble, Part 2 and Part 3 of Title 37 of the Code of Federal Regulations are amended as set forth below.

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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

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

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

§ 2.76 Amendment to allege use.

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

* * * * *

(g) If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (e) of this section, applicant will be notified of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication, the amendment will not be examined.

(h) An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication.

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

§ 2.85 Classification schedules.

* * * * *

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

* * * * *

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

§ 2.87 Dividing an application.

* * * * *

(c) A request to divide an application may be filed at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board. Additionally, a request to divide an application under section 1(b) of the Act may be filed with a statement of use under § 2.88 or at any time between the filing of a statement of use and the date the Trademark Examining Attorney approves the mark for registration.

* * * * *

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

§ 2.101 Filing an opposition.

* * * * *

(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see § 2.6(a)(17). If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

* * * * *

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

§ 2.102 Extension of time for filing an opposition.

* * * * *

(d) Every request to extend the time for filing a notice of opposition should be submitted in triplicate.

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

§ 2.111 Filing petition for cancellation.

* * * * *

(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases the petition and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see 2.6(a)(16)). If the fees submitted are insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner until a set time in which to submit the required fees(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.

* * * * *

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

§ 2.117 Suspension of proceedings.

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

(b) Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.

* * * * *

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

§ 2.119 Service and signing of papers.

* * * * *

(d) If a party to an inter partes proceeding is not domiciled in the

United States and is not represented by an attorney or other authorized representative located in the United States, the party must designate by written document filed in the Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. In such cases, official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 10.14(c) of this subchapter. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under § 10.14(b) and authorized under § 2.17(b).

* * * * *

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

§ 2.120 Discovery.

(a) *In general.* Wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section. The provisions of the Federal Rules of Civil Procedure relating to automatic disclosure, scheduling conferences, conferences to discuss settlement and to develop a discovery plan, and transmission to the court of a written report outlining the discovery plan, are not applicable to Board proceedings.

The Trademark Trial and Appeal Board will specify the opening and closing dates for the taking of discovery. The trial order setting these dates will be mailed with the notice of institution of the proceeding. The discovery period will be set for a period of 180 days. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

* * * * *

(e) *Motion for an order to compel discovery.* (1) If a party fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. The motion must be filed prior to the commencement of the first testimony period as originally set or as reset. The motion shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

(2) When a party files a motion for an order to compel discovery, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

* * * * *

(g) *Sanctions.* (1) If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award any expenses to any party. The Board may impose against a party any of the sanctions provided by this subsection in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure.

* * * * *

(h) (1) Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed prior to the commencement of 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 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 made by that party for an admission, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a

party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition.

* * * * *

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

§ 2.121 Assignment of times for taking testimony.

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

* * * * *

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

(d) When parties stipulate to the rescheduling of testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, and submitted in a number of copies equal to the number of parties to the proceeding plus one copy for the Board, will, if approved, be so stamped, signed, and dated, and a copy will be promptly returned to each of the parties.

12. Section 2.122 is amended by revising paragraphs (b)(1), (d)(1) and (d)(2) to read as follows:

§ 2.122 Matters in evidence.

* * * * *

(b) *Application 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.

* * * * *

(d) *Registrations.* (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

(2) 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, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

* * * * *

13. Section 2.123 is amended by revising paragraphs (b) and (f) as follows:

§ 2.123 Trial testimony in inter partes cases.

* * * * *

(b) *Stipulations.* If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.

* * * * *

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

(i) Due administration of the oath by the officer to the witness before the commencement of his 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 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 seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing. The officer or the party taking the deposition, or its attorney or other authorized representative, shall then address the package, and forward the same to the Commissioner of Patents and Trademarks. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted by the officer or the party taking the deposition, or its attorney or other authorized representative, in a separate package marked and addressed as provided in this section.

* * * * *

14. Section 2.125 is amended by revising paragraph (C) to read as follows:

§ 2.125 Filing and service of testimony.

* * * * *

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

* * * * *

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

§ 2.127 Motions.

(a) Every motion shall be made in writing, shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board or the time is extended by stipulation of the parties approved by the Board, or

upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion may remain as specified under this section. The Board, may in its discretion, consider a reply brief. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion will be considered by the Board. Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. The brief in support of the motion and the brief in response to the motion shall not exceed 25 pages in length; and a reply brief shall not exceed 10 pages in length. Exhibits submitted in support of or in opposition to the motion shall not be deemed to be part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

(b) Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within 15 days from the date of service of the request.

* * * * *

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

(e)(1) A motion for summary judgment may not be filed until notification of the proceeding has been sent to the parties by the Trademark Trial and Appeal Board. A motion for summary judgment, if filed, should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter. A motion under Rule 56(f) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within 30 days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(f) will not be extended. If no motion under Rule 56(f) is filed, a brief in response to the motion for summary judgment shall be filed within 30 days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion for summary judgment may remain as specified under this section. The Board may, in its discretion, consider a reply brief. A reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.

* * * * *

(f) The Board will not hold any person in contempt, or award attorneys' fees or other expenses to any party.

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

§ 2.134 Surrender or voluntary cancellation of registration.

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

* * * * *

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

§ 2.146 Petitions to the Commissioner.

* * * * *

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

* * * * *

PART 3—RULES OF PRACTICE IN TRADEMARK CASES

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

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

19. Section 3.41 is revised to read as follows:

§ 3.41 Recording fees.

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

Dated: August 27, 1998.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

[FR Doc. 98–23680 Filed 9–8–98; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF VETERANS AFFAIRS

38 CFR Part 17

RIN 2900–AE64

Civilian Health and Medical Program of the Department of Veterans Affairs (CHAMPVA)

AGENCY: Department of Veterans Affairs.

ACTION: Final rule.

SUMMARY: This document amends the medical regulations concerning medical care for survivors and dependents of certain veterans. These regulations establish basic policies and procedures governing the administration of the Civilian Health and Medical Program of the Department of Veterans Affairs (CHAMPVA), including CHAMPVA claims processing procedures, benefits and services.

DATES: *Effective Date:* October 9, 1998.

FOR FURTHER INFORMATION CONTACT: Susan Schmetzer, Health Administration Center (formerly CHAMPVA Center), P.O. Box 65023, Denver, CO 80206–9023, telephone (303) 331–7552.