

The Office proposes to reword the heading for § 2.113 to specify that notification of cancellation proceedings is to the parties.

The Office proposes to revise § 2.113 to divide it into paragraphs (a), (b), (c) and (d) for clarity; to clarify the definitions of “attorney” and “authorized representative” by reference to §§ 10.1(c) and 10.14(b), respectively; and to indicate that, if no attorney or other authorized representative is appointed by a party, notification will be sent to that party’s domestic representative, or, if there is no domestic representative for that party, notification will be sent to the party.

The Office proposes to amend § 2.118 to delete reference to a party residing abroad and his representative in the United States in order to clarify that when any notice sent by the Office to a registrant is returned to the Office, notice may be given by publication in the Official Gazette, regardless of whether that registrant resides in the United States or elsewhere.

The Office proposes to amend § 2.123(g)(1) to require that depositions be in written form, but to delete reference to specific requirements that may vary depending upon the media used for submission. Requirements for submissions are specified in proposed § 2.126.

The Office proposes to add new § 2.126, entitled “Form of submissions to the Trademark Trial and Appeal Board,” which includes paragraphs (a) through (d). Paragraphs (a) through (c) provide that submissions may be made to the Board on paper, CD-ROM, or electronically, as permitted by the rules contained in this part or Board practice; and specify the requirements for each type of submission. Paragraph (d) specifies the requirements for making a submission to the Board that is confidential in whole or in part.

The Office proposes to amend § 2.127(a) to delete the specifications for filing on paper a brief in support of, or response to, a motion, referring, instead to § 2.126.

The Office proposes to amend § 2.128(b) to require that briefs be in written form; and to delete the specifications for filing a brief on paper, referring, instead to § 2.126.

The Office proposes to amend both the heading and the body of § 2.130 to change “Examiner of Trademarks” to “trademark examining attorney.” The Office proposes to revise § 2.130 to provide that, during an inter partes proceeding, only applications under section 1 or section 44 of the Act may be remanded, at the request of the

trademark examining attorney, for consideration of facts which appear to render the mark unregistrable.

The Office proposes to amend § 2.131 to change the term “examiner” to “trademark examining attorney”; and to limit the applicability of this section to inter partes proceedings involving applications under sections 1 and 44 of the Act.

The Office proposes to revise § 2.142(a) and (b)(2) to state that notices of appeal and briefs must be filed in written form, as prescribed in § 2.126, and to delete the specifications for filing a brief on paper.

The Office proposes to amend § 2.145(b)(3) to indicate that notices of appeal to the U.S. Court of Appeals for the Federal Circuit be sent to the Office of the General Counsel, with a duplicate copy addressed to the Board.

The Office proposes to amend § 2.145(c)(3) to indicate that any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding who files a notice with the Office as provided in section 21(b) of the Act, must address that notice to the Office of the General Counsel.

The Office proposes to amend § 2.145(c)(4) to indicate that, in order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.

The Office proposes to amend § 2.146(c) to delete reference to a petition to revive as an example of a situation where an affidavit or declaration is required in support of a petition. This is a technical correction to the rule. Effective October 30, 1999, § 2.66 was amended to delete the requirement for an affidavit or declaration in a petition to revive based on unintentional delay. An unverified statement is sufficient. See notices at 64 FR 48900 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). However, § 2.146(c) still requires a verified statement in other situations where facts are to be proven on petition. For example, if the petition arises from the loss or misplacement of a document submitted to the Office, it should be accompanied by the affidavit or declaration of the person who mailed the document, attesting to the date of submission and identifying the document filed with the petition as a true copy of the document previously filed. TMEP § 1705.03.

The Office proposes to amend § 2.146(i) to change the standard for a showing of due diligence for petitions in

which the petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired due to the loss or mishandling of papers. Currently, the rule requires that to be considered diligent, petitioners must check the status of pending matters within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected. The Office proposes to shorten the time period from one year to six months. A showing of due diligence would require that a petitioner check the status of a pending application every six months between the filing date of the application and issuance of a registration; check the status of a registration every six months after filing an affidavit of use or excusable nonuse under section 8 or 71 of the Act or a renewal application under section 9 of the Act until the petitioner receives notice that the affidavit or renewal application has been accepted; and request corrective action where necessary.

Third parties are harmed by the removal and later reinsertion of an application or registration in the Office database. To minimize this problem, the Office proposes to adopt stricter time limits for the filing of petitions to revive or reinstate abandoned applications and cancelled or expired registrations.

The Office proposes to revise § 2.151 to add a reference to section 71 of the Act, which requires periodic affidavits of use or excusable nonuse to maintain a registration based on an extension of protection of an international registration.

The Office proposes to add a new § 2.171(b), stating that when ownership of a registration has changed with respect to some but not all of the goods and/or services, the registrant(s) may file a request that the registration be physically divided into two or more separate registrations, upon payment of the required fee for each new separate registration created by the division.

Rule Making Requirements

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

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

Regulatory Flexibility Act: The Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business