

The Office is revising § 2.104(a) to remove the requirement that a duplicate copy of the opposition, including exhibits, be filed with an opposition.

The Office is rewording the heading for § 2.105 to specify that notification of opposition proceedings is to the parties.

The Office is revising § 2.105 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, notification will be sent to a party’s domestic representative, or, if there is no domestic representative, notification will be sent to the party.

The Office is redesignating § 2.107 as § 2.107(a); and revising it to limit this paragraph to oppositions against an application filed under section 1 or 44 of the Act; and to incorporate in the rule the existing Board practice which prohibits an opposer in a proceeding against an application filed under section 1 or 44 of the Act from adding to the goods or services in an opposition after the period for filing the opposition has closed.

The Office is adding a new § 2.107(b) to state that pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court; except that, once filed, such opposition may not be amended to add to the goods or services opposed, or to add to the grounds for opposition. Thus, opposer may not add an entirely new ground for opposition or add an additional claimed registration to a previously stated section 2(d) ground. An opposer may make amendments to grounds asserted in the notice of opposition, for example, for clarification.

The Office is revising § 2.111(b) to substitute “person” for “entity” to track the statutory language; to make the rule gender neutral; to clarify the definitions of “attorney” and “authorized representative” by reference to §§ 10.1(c) and 10.14(b), respectively; to clarify that a petition for cancellation must be signed; and to indicate that electronic signatures are required for electronically filed petitions for cancellation.

The Office is revising § 2.111(c) to divide it into four paragraphs; to state that the Office will not accept a petition for cancellation submitted through ESTTA that does not include fees to cover all named party petitioners and all classes; that the Office will not institute a cancellation proceeding if a petition for cancellation submitted on paper

does not include a fee sufficient to pay for one person for a petition for cancellation against at least one class; and that prior to instituting a cancellation proceeding, the Office will no longer correspond with the petitioner named in a petition for cancellation submitted on paper to permit submission of additional fees or designation of party petitioners and/or classes where a petition for cancellation is submitted with insufficient fees to pay for cancellation by all party petitioners and/or in all classes. The revision explains how the Office will apply a fee accompanying a paper submission that is insufficient to cover all classes and/or to cover all party petitioners.

The Office is amending § 2.112(a) to make the rule gender neutral and to remove the requirement that a duplicate copy of the petition for cancellation, including exhibits, be filed with the petition for cancellation.

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

The Office is revising § 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 is amending § 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 is amending § 2.121(d) to eliminate the requirement for multiple copies of a stipulated/consent motion to extend the discovery or testimony periods in view of the fact that the Board is no longer stamping copies as “approved” and returning the copies to the parties.

The Office is amending § 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 § 2.126.

The Office is adding 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 is amending § 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 is amending § 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 is amending both the heading and the body of § 2.130 to change “Examiner of Trademarks” to “trademark examining attorney.” The Office is revising § 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 is amending § 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 is revising § 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 is amending § 2.145(b)(3) to indicate that notices of appeal to the U.S. Court of Appeals for the Federal Circuit should be sent to the Office of the General Counsel, with a duplicate copy addressed to the Board.

The Office is amending § 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 is amending § 2.145(c)(4) to indicate that, in order to avoid premature termination of a Board 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.