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DEPARTMENT OF COMMERCE

[3510-16-P]

United States Patent and Trademark Office

37 CFR Part 2

[Docket No. PTO-T-2016-0053]

RIN 0651-AD13

**Miscellaneous Changes to Trademark Trial and Appeal Board Rules of Practice;
Correction**

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule; correction.

SUMMARY: The United States Patent and Trademark Office published in the Federal Register on October 7, 2016 a final rule, which will become effective on January 14, 2017, revising the Rules of Practice before the Trademark Trial and Appeal Board. This document corrects errors in certain cross-references, clarifies the manner of testimony taken in a foreign country and the process in depositions upon written questions, and reincorporates the time frames for cross appeals and cross actions in that rule.

DATES: This rule is effective January 14, 2017, and applies to all proceedings pending on or after the effective date.

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

SUPPLEMENTARY INFORMATION: The USPTO issues this final rule to correct inadvertent errors in certain cross-references in §§ 2.124(f) and 2.126(c), to clarify the manner of testimony taken in a foreign country in § 2.123(a)(2), to clearly incorporate cross-examination in the process of depositions upon written questions in § 2.124(d)(1), and to reincorporate explicit timing requirements for cross-appeals and cross-actions in § 2.145(d)(1) and (3) of its October 7, 2016 final rule revising the Trademark Trial and Appeal Board Rules of Practice. (81 FR 69950) (published under RIN 0651-AC35).

The first sentence of § 2.123(a)(2) is clarified to separate motions to take depositions upon written questions by oral examination from testimony by affidavit or declaration. To implement this clarification, the phrase “A testimonial deposition” is replaced with “Testimony” and the clause “by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness” is moved to clearly delineate it.

The first sentence of § 2.124(d)(1) should cross reference paragraphs (b)(1) and (2) rather than only (b). A paragraph was added to § 2.124(b) which operated to renumber that section, and the cross reference was not updated. In addition, in the first, third and sixth sentences, further clarification was needed to clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.

The second sentence of § 2.124(f) should cross reference § 2.125(c) rather than § 2.125(b). A paragraph was added to § 2.125, which operated to renumber that section, and the cross reference was not updated.

The first sentence of § 2.126(c) should cross reference § 2.125(f) rather than § 2.125(e). A paragraph was added to § 2.125, which operated to renumber that section, and the cross reference was not updated.

The October 7, 2016 final rule amended the timing requirements for appeals and civil actions, but inadvertently omitted the timing requirement for cross-actions from § 2.145(d)(3). Therefore, this correction revises the last sentence in § 2.145(d)(3) to reincorporate the timing requirement for cross-actions. Also, this correction revises § 2.145(d)(1) concerning cross-appeals to have consistency between § 2.145(d)(3) and (d)(1).

This correcting rule may be issued without prior notice and opportunity for comment as the corrections are nonsubstantive and being implemented to avoid inconsistencies and confusion with the rule issued on October 7, 2016. The USPTO corrects the errors as discussed below.

In FR Doc. 2016-23092, published on October 7, 2016 (81 FR 69950), make the following corrections:

§ 2.123 [Corrected]

1. On page 69981, column 2, in paragraph (a)(2) of § 2.123, the first sentence is corrected to read “Testimony taken in a foreign country shall be taken: by deposition

upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness.”

§ 2.124 [Corrected]

2. On page 69982, column 3, in paragraph (d)(1) of § 2.124:

i. The cross reference to “paragraph (b)” is corrected to read “paragraphs (b)(1) and (2)”;

ii. The term “direct testimony” is corrected to read “direct examination” in both instances;

iii. In the third sentence the phrase “or service of a testimony affidavit or declaration,” is added before the phrase “any adverse party may serve cross questions upon the party who proposes to take the deposition”; and

iv. In the sixth sentence the phrase “or who earlier offered testimony of the witness by affidavit or declaration” is added after the phrase “any party who served cross questions may serve recross questions upon the party who proposes to take the deposition”.

3. On page 69983, column 1, in paragraph (f) of § 2.124, the cross reference to “§ 2.125(b)” is corrected to read “§ 2.125(c)”.

§ 2.126 [Corrected]

4. On page 69983, column 3, in paragraph (c) of § 2.126, the cross reference to “§ 2.125(e)” is corrected to read “§ 2.125(f)”.

§ 2.145 [Corrected]

5. On page 69987, column 2, in paragraph (d)(1) of § 2.145, the last sentence is removed and added in its place is “In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.”

6. On page 69987, column 2, in paragraph (d)(3) of § 2.145, this final sentence is added “In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.”

Dated: December 6, 2016.

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

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