DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. PTO–T–2010–0014]

RIN 0651–AC39

Trademark Technical and Conforming Amendments

AGENCY: United States Patent and Trademark Office,

Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office ("USPTO") is adopting as a final rule, with minor changes, an interim final rule amending the Rules of Practice in Trademark Cases and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Rules") to implement the Trademark Technical and Conforming Amendment Act of 2010. The interim final rule was published in the **Federal Register** on June 24, 2010. This final rule makes minor changes to the interim final rule to incorporate additional statutory language being implemented.

DATES: This rule is effective on November 8, 2011.

FOR FURTHER INFORMATION CONTACT:

Cynthia C. Lynch, Office of the Deputy Commissioner for Trademark Examination Policy, by telephone at (571) 272–8742.

SUPPLEMENTARY INFORMATION:

Background

On June 24, 2010, the USPTO published an interim final rule at 75 FR 35973 amending the Rules of Practice in Trademark Cases and the Madrid Rules to implement the Trademark Technical and Conforming Amendment Act of 2010 ("TTCAA"), Public Law 111–146, 124 Stat. 66 (2010). This legislation and the implementing rule harmonized the framework for submitting trademark registration maintenance filings to the USPTO by permitting holders of international registrations with an extension of protection to the United States under the Madrid Protocol ("Madrid Protocol

registrants") to file Affidavits or Declarations of Use or Excusable Nonuse at intervals identical to those for nationally issued registrations. In addition, all trademark owners may now cure deficiencies in their maintenance filings outside of the statutory filing period upon payment of a deficiency surcharge, specifically including when the affidavit or declaration was not filed in the name of the owner of the registration.

The interim final rule provided a 60-day comment period that ended August 23, 2010. No comments were received. For the reasons given in the interim final rule, the USPTO is adopting the interim final rule amending 37 CFR parts 2 and 7 as a final rule, with minor changes.

The rule is changed slightly for purposes of clarification. Specifically, 37 CFR 2.163(a), 2.164(a), and 7.39(c) are amended to reflect that deficiencies may be corrected after notification from the USPTO. These revisions reflect the amendments to Sections 8 and 71 of the Lanham Act, 15 U.S.C. 1058 and 1141k, providing that deficiencies may be corrected after notification of the deficiency.

Rule Making Considerations

This document adopts as a final rule, with minor procedural changes, the interim final rule that is already in effect. The changes from the interim rule contained in this final rule constitute interpretative rules or rules of agency practice and procedure and accordingly, are not subject to the requirements for prior notice and comment. *See* 5 U.S.C. 553(b)(3)(A). The rule changes relate solely to the procedures for maintaining a Federal trademark registration, and merely implement the TTCAA, so that the Rules of Practice in Trademark Cases and the Madrid Rules are consistent with the statutory revisions. Thus, prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). *See Cooper Techs. Co. v. Dudas* , 536 F.3d 1330, 1336–37, 87 USPQ2d 1705, 1710 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rule making for " 'interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.' " (quoting 5 U.S.C. 553(b)(A)), *Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (DC Cir. 2001) (rules governing an application process are "rules of agency organization, procedure, or practice" and are exempt from the Administrative Procedure Act's notice and comment requirement); *see also Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the APA apply)), and *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) ("[i]t is extremely doubtful whether any of the rules formulated to govern patent or trademark practice are other than 'interpretive rules, general statements of policy, * * * procedure, or practice.' ") (quoting C.W. Ooms, The United States Patent Office and the Administrative Procedure Act, 38 Trademark Rep. 149, 153 (1948)).

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 to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563. Specifically, the USPTO has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided online access to the rule making docket; (7) attempted to promote coordination, simplification and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq*.) is required for this final rule. *See* 5 U.S.C. 603.

Paperwork Reduction Act: This rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq*.) . The collection of information involved in this rule has been reviewed and previously approved by OMB under control number 0651–0051. Changes in this rule would not affect the information collection requirements associated with the information collection under OMB control number 0651–0051.

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 Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

Unfunded Mandates: The Unfunded Mandates Reform Act, at 2 U.S.C. 1532, requires that agencies prepare an assessment of anticipated costs and benefits before issuing any rule that may result in expenditure by State, local, and tribal governments, in the aggregate, or by the private sector, of $100 million or more (adjusted annually for inflation) in any given year. This rule would have no such effect on State, local, and

tribal governments or the private sector.

Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq*.), prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. However, this action is not a major rule as defined by 5 U.S.C. 804(2).

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 7

Administrative practice and procedure, Trademarks, International registration.

Accordingly, the interim final rule amending 37 CFR parts 2 and 7, which was published at 75 FR 35973 on June 24, 2010, is adopted as a final rule with the following changes:

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

■2. Revise § 2.163(a) to read as follows:

§ 2.163 Acknowledgment of receipt of affidavit or declaration.

* * * * *

(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected after notification from the Office if the requirements of § 2.164 are met.

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■3. Revise § 2.164(a) introductory text to read as follows:

§ 2.164 Correcting deficiencies in affidavit or declaration.

(a) If the affidavit or declaration is filed within the time periods set forth in section 8 of the Act, deficiencies may be corrected after notification from the Office, as

follows:

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PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

■4. The authority citation for 37 CFR Part 7 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

■5. Revise § 7.39(c) introductory text to read as follows:

§ 7.39 Acknowledgment of receipt of and correcting deficiencies in affidavit or declaration of use in commerce or excusable nonuse.

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(c) If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected after notification from the Office, as follows:

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Dated: November 1, 2011.

David J. Kappos,

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

[FR Doc. 2011–28890 Filed 11–7–11; 8:45 am]

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