CHAPTER 900
REVIEW OF DECISION OF BOARD

901 Appeals--In General

15 U.S.C. § 1071 [Section 21(a)(1) of the Trademark Act] Review of Director's or Trademark Trial and Appeal Board's Decision

(a)*(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.*

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

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(b)*(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).*

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

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37 CFR § 2.145 Appeal to court and civil action.

(a) Appeal to U.S. Court of Appeals for the Federal Circuit. *An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. . . .*

* * * *

(c) Civil Action.

(1) Any person who may appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. Such civil action must be commenced within the time specified in paragraph (d) of this section.

(2) Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(3) 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 may file a notice with the Director within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.

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(d) Time for appeal or civil action.

(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or § 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons

and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

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901.01 Avenues of Appeal

A party to a Board proceeding who is dissatisfied with the decision of the Board is provided, under the Act, with two possible (mutually exclusive) remedies. The dissatisfied party may either:

(1) Appeal to the United States Court of Appeals for the Federal Circuit, which will review the decision from which the appeal is taken on the record before the USPTO, or

(2) Have remedy by civil action (in a United States District Court), in which the court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear."[1]

[1] *See* Section 21 of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145. *See also CAE Inc. v. Clean Air Engineering Inc.,* 60 USPQ2d 1449, 1458 (7th Cir. 2001) (choice of appealing to Federal Circuit on closed record of Board proceedings or a federal district court with the option of presenting additional evidence and raising additional claims); *Spraying Systems Co. v. Delavan Inc.,* 975 F.2d 387, 24 USPQ2d 1181, 1183 (7th Cir. 1992) (appeal to district court is in part an appeal and in part a new action); and *Alltrade Inc. v. Uniweld Products Inc.,* 946 F.2d 622, 20 USPQ2d 1698, 1703 (9th Cir. 1991) (where winning and losing party each appealed to different district court; discussion of appealability of those aspects of a ruling with which "winning" party is dissatisfied, and dismissal, stay or transfer of second-filed appeal).

In an inter partes proceeding, if a dissatisfied party chooses to file an appeal to the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file notice that it elects to have the appeal dismissed, and to have further proceedings conducted instead by way of civil action.[2] Within 30 days after the filing of a notice of election by an adverse party, the appellant must commence a civil action for review of the Board's decision, failing which the Board's decision will govern further proceedings in the case.[3]

For a discussion of forum selection considerations, see Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board,* 75 Trademark Rep. 323, 400-405 (1985).

901.02 What May be Appealed

901.02(a) Final Decision Versus Interlocutory Decision

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a final dispositive ruling that ends litigation on the merits before the Board.[4]

Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable.[5]

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[2] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145(c)(3).

[3] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145(d)(3).

[4] *See R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 1005, 204 USPQ 195, 197 (CCPA 1979) (the word "decision" in the statute means "final decision") and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) (same).

[5] *See Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (where Board granted partial summary judgment dismissing allegation of misuse of registration symbol but denied summary judgment on other potentially dispositive ownership and consent issues, appeal was premature since appealed issues did not result in a disposition of the case). *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 n.2 (Fed. Cir. 1988) (ordinarily denial of summary judgment is interlocutory and not appealable except where, as in this case, the decision was a final decision of dismissal [i.e., the Board, in effect, entered judgment in favor of nonmoving party]); *Parker Brothers v. Tuxedo Monopoly, Inc.*, 757 F.2d 254, 226 USPQ 11, 11 (Fed. Cir. 1985) (order denying summary judgment was interlocutory and thus non-final and non-appealable); and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) ([Director] is without jurisdiction to certify an order to the Federal Circuit and court is without jurisdiction to hear it).

Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board.[6]

On the other hand, if the Board resolves a merits issue prior to final hearing, but other merits issues remain, that is, the litigation is still before the Board as a whole, the Board's decision on the merits issue is interlocutory, rather than final, for purposes of judicial review. For example, in a case in which there is a counterclaim, if the Board grants summary judgment only as to the counterclaim, the case is not ripe for appeal until there has been a final decision with respect to the original claim; similarly, if the Board grants summary judgment only as to the original claim, the case is not ripe for appeal until there has been a final decision with respect to the counterclaim.[7] When the Board, prior to final hearing, issues a decision resolving one or more, but not all, of the merits issues in a case before it, it is the usual practice of the Board to include in its decision the following statement: "This decision is interlocutory in nature. Appeal may be taken within two months after the entry of a final decision in the case."[8]

When an appeal is taken from a decision of the Board, it is the court to which an appeal is taken, not the Board, which determines whether the involved decision is appealable, that is, whether the court has jurisdiction to entertain the appeal.[9]

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[6] *See, e.g., Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1711 (Fed. Cir. 1991) (decision denying reconsideration of Board's order dismissing opposition for failure to prosecute was reviewable); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1477 (Fed. Cir. 1990) (decision granting summary judgment was reviewable); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, *supra* (denial of motion for summary judgment where it resulted in judgment against moving party was reviewable); *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 422 (CCPA 1976) (decision granting motion to dismiss for failure to state a claim is reviewable); and *Williams v. Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744, 745 (CCPA 1975) (decision denying petitioner's 60(b) motion to vacate earlier decision granting respondent's uncontested motion for summary judgment was reviewable).

[7] *See Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589, 1594 and n.4 (TTAB 1992) (decision granting opposer's motion for summary judgment on counterclaim and denying opposer's motion for partial summary judgment in the opposition was not appealable) and *Interlocutory Decisions by the Trademark Trial and Appeal Board*, 1123 TMOG 36 (February 19, 1991). *See also Copelands' Enterprises Inc. v. CNV Inc.*, *supra* at 1565 (appeal of order granting partial summary judgment was premature).

[8] *See, e.g., Institut National Des Appellations d'Origine v. Brown-Forman Corp.,* 47 USPQ2d 1875, 1896 n.17 (TTAB 1998); *Interlocutory Decisions by the Trademark Trial and Appeal Board, supra*, and *Procter & Gamble Co. v. Sentry Chemical Co., supra* at 1594 n.4.

[9] *See R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 204 USPQ 195, 197 n.3 (CCPA 1979) (following Board's denial of motion for summary judgment on issue of res judicata, Board's attempt to "certify" an interlocutory decision as appealable given no effect in Court's determination of whether it had jurisdiction over the appeal), and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, *supra* ([Director] has no statutory authority to "certify" interlocutory orders of the Board for appeal). *See also*, *with respect to jurisdiction to entertain an appeal*, *Alltrade Inc. v. Uniweld Products Inc.*, *supra*.

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case.[10]

A party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely petition to the Director.[11] A party may also file a request with the Board for reconsideration of such an order or decision.[12]

The mandamus procedure may not be used as a substitute for the appeal procedure specified in Section 21 of the Act, 15 U.S.C. § 1071.[13]

901.02(b) Judgment Subject to Establishment of Constructive Use

In an inter partes proceeding before the Board, no final judgment will be entered in favor of an applicant under Section 1(b) of the Act, 15 U.S.C. § 1051(b), before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Section 7(c) of the Act, 15 U.S.C. §1057(c).[14] Rather, in those cases where the Board finds that a Section 1(b) applicant is entitled to prevail only if it establishes constructive use, the Board will enter judgment in favor of that applicant, subject to the applicant's establishment of constructive use.[15] If, after entry of that judgment, the Section 1(b)

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[10] *See Questor Corp. v. Dan Robbins & Associates, Inc.,* 199 USPQ 358 (TTAB 1978), *aff'd sub nom.*, 202 USPQ 100, 104 (CCPA 1979) (denial of motion to strike deposition as untimely filed was a purely procedural issue not a decision sufficiently related to the merits of the appealable issues); and *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971) (Board's decision to deny applicant's motion to amend description of services not logically related to the "jurisdiction-giving issues" in the case*, i.e.*, the issues of likelihood of confusion and laches, and not reviewable).

[11] *See Palisades Pageants, Inc. v. Miss America Pageant, supra; and* TBMP § 905 (Petition to the Director), and authorities cited therein.

[12] *See* TBMP § 518 (Motion for Reconsideration).

[13] *See Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 646 (CCPA 1979), *cert. denied*, 442 U.S. 917, 202 USPQ 159 (1979) (stating that this is particularly true where the issue involves jurisdictional questions that Board is competent to decide and that are reviewable in the regular course of appeal).

[14] *See* Sections 21(a)(4) and 21(b)(1) of the Act, 15 U.S.C.§§ 1071(a)(4) and 1071(b)(1).

[15] *See* 37 CFR § 2.129(d). *See also Larami Corp. v. Talk To Me Programs Inc.,* 36 USPQ2d 1840, 1844 (TTAB 1995) (constructive use provision of Section 7(c) interpreted differently in Board cases involving right to register and civil actions, such as infringement action, involving a party's right to use a mark); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

applicant files an acceptable statement of use, and obtains a registration, thus establishing its constructive use, final judgment will be entered in behalf of the Section 1(b) applicant. If, on the other hand, the Section 1(b) applicant fails to establish constructive use, that is, fails to file an acceptable statement of use and obtain a registration, judgment will instead be entered in favor of the adverse party.

When the Board enters judgment in favor of a Section 1(b) applicant subject to that party's establishment of constructive use, the time for filing an appeal or commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use.[16]

902 Appeal to Court of Appeals for the Federal Circuit

902.01 Notice of Appeal

15 U.S.C. § 1071(a)(2) [Section 21(a)(2) of the Trademark Act] *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

37 CFR § 2.145 Appeal to court and civil action.

(a) Appeal to U.S. Court of Appeals for the Federal Circuit. *An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:*

(1) In the Patent and Trademark Office give written notice of appeal to the Director (see paragraphs (b) and (d) of this section);

(2) In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.

(b) Notice of appeal.

(1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Director, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this

[16] *See* 37 CFR § 2.129(d) and *Zirco Corp. v. American Telephone and Telegraph Co.*, *supra.*

section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(2) In inter partes proceedings, the notice must be served as provided in § 2.119.

(3) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel as provided in § 104.2.

37 CFR § 104.2 Address for mail and service; telephone number.

(a) *Mail under this part should be addressed to:*

General Counsel, United States Patent and Trademark Office
P.O. Box 15667
Arlington, VA 22215.

(b) *Service by hand should be made during business hours to the:*

Office of the General Counsel
Crystal Park Two Suite 905
2121 Crystal Drive
Arlington, Virginia.

(c) *The Office of the General Counsel may be reached by telephone at 703-308-2000 during business hours.*

A party taking an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board must give written notice thereof both to the Director and to the Court of Appeals for the Federal Circuit, and pay to the Court the fee required by the Court's rules.[17]

Specifically, the original notice of appeal must be filed in the USPTO, within the time required by 37 CFR § 2.145(d) (*see* TBMP § 902.02).[18] The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for filing a notice of appeal. The notice must specify the party or parties taking the appeal and designate the decision or part thereof appealed from. However, reasons for appeal need not be given.[19] A copy of the decision being appealed, and a copy of any

[17] *See* 37 CFR §§ 2.145(a) and 2.145(b), and Fed. Cir. R. 15. (The Federal Circuit Rules and Forms can be found on the Court's website at: www.fedcir.gov.)

[18] *See* Section 21(a)(2) of the Act, 15 U.S.C. § 1071(a)(2); 37 CFR §§ 2.145(a) and 2.145(b)(1).

[19] *See* 37 CFR § 2.145(b)(1).

decision on reconsideration thereof, should be attached to the notice of appeal.[20] If the appeal is taken from a decision of the Board in an inter partes proceeding, a copy of the notice must be served on every other party to the proceeding, in the manner prescribed in 37 CFR § 2.119 (*see* TBMP § 113).[21] The written notice, if mailed to the USPTO (rather than hand-delivered to the Office of the General Counsel), must be addressed to General Counsel, United States Patent and Trademark Office, P.O. Box 15667, Arlington, VA 22215.[22]

For information concerning the ways (i.e., by hand delivery, first-class mail, etc.) in which a notice of appeal may be filed in the USPTO, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the USPTO, see 37 CFR §§ 1.1(a)(3), 1.6, 1.8, 1.10, and 2.145(b)(3); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990) (NOTE: the 1990 Official Gazette notice must be read in light of subsequent rule amendments--for example, the 37 CFR § 1.8 certificate procedures are now applicable to a notice of appeal from a decision of the Board, but were not in 1990).

For further information concerning how to file a notice of appeal, contact the Office of the General Counsel in the USPTO.

Three copies of the notice of appeal must be filed in the Court of Appeals for the Federal Circuit (NOTE: while 37 CFR § 2.145(a) requires the filing of only one copy of the notice with the Federal Circuit, Fed. Cir. R. 15(a)(1) requires that three copies of the notice be filed with the Federal Circuit), and the appeal fee required by the rules of the Court must be paid to the Court.[23] A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the copy of the notice.[24]

902.02 Time for Filing Notice of Appeal, Cross-Appeal

15 U.S.C. § 1071(a)(2) [Section 21(a)(2) of the Trademark Act] *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

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[20] *See Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[21] *See* 37 CFR § 2.145(b)(2).

[22] *See* 37 CFR §§ 1.1(a)(3)(i) and 104.2.

[23] *See* 37 CFR § 2.145(a).

[24] *See* Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). *See also* the website for the Court of Appeals for the Federal Circuit at: www.fedcir.gov.

37 CFR § 2.145(d) Time for appeal or civil action.

(1) *The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires* ***(i)*** *14 days after service of the notice of appeal or the summons and complaint; or* ***(ii)*** *two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.*

(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

37 CFR § 2.145(e) Extensions of time to commence judicial review. *The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit is two months from the date of the Board decision which is the subject of the appeal.[25] When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. § 1051(b), applicant subject to that party's establishment of constructive use (*see* TBMP § 901.02(b)), the time for filing an appeal runs from the date of the entry of judgment subject to establishment of constructive use.[26]

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[25] *See* Section 21(a)(2) of the Act, 15 U.S.C. § 1071(a)(2); 37 CFR § 2.145(d)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[26] *See* 37 CFR § 2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§ 2.127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for filing an appeal expires two months after action on the request.[27]

In an inter partes case, the time for filing a notice of cross-appeal expires (1) 14 days after service of the notice of appeal, or (2) two months from the date of the Board decision which is the subject of the appeal, whichever is later.[28]

The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for filing a notice of appeal or a notice of cross-appeal.

If a written request to extend the time for appeal is filed before the expiration of the appeal period, the Director may grant the request on a showing of good cause. If the request is not filed until after the expiration of the appeal period, the Director may grant the request only on a showing that the failure to act was the result of excusable neglect.[29] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor.[30]

It is the Director, not the Board, who determines whether a notice of appeal has been timely filed. If the Director determines that a notice of appeal was not timely, the Director notifies the Clerk of the Federal Circuit thereof. The Clerk in turn issues an order to the appellant to show cause why the appeal should not be dismissed, and refers appellant's response to the Court.[31]

An appellant which has received an order to show cause from the Clerk of the Federal Circuit may file a request under 37 CFR § 2.145(e) for an extension of time to file an appeal, accompanied by a showing that the late filing of the notice of appeal was the result of excusable neglect. The request should be filed in the Office of the Solicitor, which will notify the Clerk of the court of the Director's decision on the request.

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[27] *See* 37 CFR § 2.145(d)(1).

[28] *See* 37 CFR § 2.145(d)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[29] *See* 37 CFR § 2.145(e), and *Appeals to the Federal Circuit From PTO*, *supra*.

[30] *See Appeals to the Federal Circuit From PTO, supra*.

[31] *See* Fed. Cir. R. 15(b)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

902.03 Appeal to Federal Circuit Waives Appeal by Civil Action

A party which takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board thereby waives its right to have remedy by way of civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b).[32]

However, in an inter partes case, if an adverse party, in response to the notice of appeal to the Federal Circuit, files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case.[33]

902.04 Notice of Election to Have Review by Civil Action

15 U.S.C. § 1071(a)(1) [Section 21(a)(1) of the Trademark Act] *An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.*

37 CFR § 2.145(c)(3) *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 may file a notice with the Director within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.*

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[32] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act), and 37 CFR § 2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act). *Cf.* Section 21(b)(1) of the Act, 15 U.S.C. § 1071(b)(1) (party dissatisfied with decision of Board may, unless appeal has been taken to the Federal Circuit, have remedy by civil action), and TBMP § 903.05 (Information Concerning Times Specified in 37 CFR § 2.145)

[33] *See* TBMP §§ 901.01 (Avenues of Appeal) and 902.04 (Notice of Election).

* * * *

(d)(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

When a defeated party in an inter partes proceeding before the Board takes an appeal to the United States Court of Appeals for the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file a notice with the Director electing to have all further proceedings conducted by way of civil action, under Section 21(b) of the Act, 15. U.S.C. § 1071(b), seeking review of the decision which was the subject of the appeal.[34] The certificate of mailing and certificate of transmission procedures described in 37 CFR § 1.8, and the "Express Mail" procedure described in 37 CFR § 1.10, are available for filing a notice of election. A copy of the notice must be served on every other party to the proceeding, in the manner prescribed in 37 CFR § 2.119 (*see* TBMP § 113).[35] A copy of the notice must also be filed with the Federal Circuit.[36]

If an adverse party files a notice electing to have further proceedings conducted by way of civil action under Section 21(b) of the Act, the appeal to the Federal Circuit will be dismissed, (see Fed. Cir. R. 15(e)) and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case.[37] Any cross-action must be filed within 14 days after service of the summons and complaint in the civil action.[38]

902.05 Information Concerning Times Specified in 37 CFR § 2.145

37 CFR §2.145(d)(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of*

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[34] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1), and 37 CFR § 2.145(c)(3).

[35] *See* 37 CFR § 2.145(c)(3).

[36] *See* Fed. Cir. R. 15(e).

[37] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1), and 37 CFR § 2.145(d)(3).

[38] *See* 37 CFR § 2.145(d)(3).

Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

In 37 CFR § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for filing an appeal falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for filing an appeal is extended to the next day which is not a Saturday, Sunday, or Federal holiday.[39]

902.06 Certified List

15 U.S.C. § 1071(a)(3) [Section 21(a)(3) of the Trademark Act] *The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.*

When notice is filed in the USPTO of an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the Director sends to the Federal Circuit a statement indicating whether the notice of appeal was considered timely filed, and a certified list of the documents comprising the record in the USPTO, i.e., a certified copy of the list of docket entries on the file jacket containing the USPTO record of the proceeding accompanied by a copy of the decision appealed.[40] A copy of the certified list is mailed by the USPTO to every party to the proceeding.[41]

When the Federal Circuit receives the notice of appeal and the certified list, the Court dockets the appeal, and gives notice to all parties of the date of docketing.[42] The appellant's time in which to file its initial brief runs from the date of service of the certified list or the date of docketing the appeal, whichever is later. Because an appeal is not docketed until after the

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[39] 37 CFR § 2.145(d)(2).

[40] *See* Section 21(a)(3) of the Act, 15 U.S.C. § 1071(a)(3); Fed. Cir. R. 15(b)(1) and 17(b)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[41] *See* Fed. Cir. R. 17(c) and *Appeals to the Federal Circuit From PTO, supra*.

[42] *See* Fed. Cir. R. 15(b)(1), and *Appeals to the Federal Circuit From PTO*, *supra.*

certified list is served in appeals from Board decisions, the appellant's time for filing its brief normally runs from the date of docketing.[43]

902.07 Appeal Briefs, Appendix, etc.

For information concerning other matters of practice and procedure during an appeal to the United States Court of Appeals for the Federal Circuit from a Board decision, including information concerning motions, briefs, the appendix to the briefs, oral argument, etc., see Federal Circuit Rules and Appeals to the Federal Circuit From PTO, 1120 TMOG 22 (November 13, 1990).

For information concerning the appendix to the briefs, in particular, see Fed. Cir. R. 30 and 32, and Appeals to the Federal Circuit From PTO, supra at 25. All of the information is also available on the court's website at www.fedcir.gov.

902.08 Special Provisions for Ex Parte Cases

15 U.S.C. § 1071(a)(3) [Section 21(a)(3) of the Trademark Act] ... *In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.*

37 CFR § 2.145(c)(2) *Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under § 21(b) of the Act.*

If an applicant in an ex parte case takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the applicant thereby waives its right to proceed by way of civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b).[44]

On appeal to the Federal Circuit in an ex parte case, the Director files a brief in support of the Board's decision.[45]

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[43] *See* Fed. Cir. R. 31(a), and *Appeals to the Federal Circuit From PTO, supra*.

[44] *See* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1), and 37 CFR § 2.145(c)(2).

[45] *See* Section 21(a)(3) of the Act, 15 U.S.C. § 1071(a)(3).

903 Appeal by Civil Action

903.01 Notice of Civil Action

37 CFR § 2.145(c)(4) *A party to a proceeding before the Trademark Trial and Appeal Board which commences a civil action, pursuant to Section 21(b) of the Act, seeking review of a decision of the Board should file written notice thereof in the Patent and Trademark Office, addressed to the Board, within one month after the expiration of the time for appeal or civil action, in order to avoid premature termination of the Board proceeding.*

A party which commences a civil action, under Section 21(b) of the Act, 15 U.S.C. § 1071(b) seeking review of a decision of the Board should file written notice thereof in the USPTO, addressed to the Board, within one month after the expiration of the time for appeal or civil action. Failure to notify the Board of the commencement of the civil action may result in premature termination of the proceeding by the USPTO. *See* 37 CFR § 2.145(c)(4). That is, if the Board is unaware of the commencement of the civil action, it will treat the Board's decision as governing further proceedings in the case, and will take steps, based on the judgment entered in that decision, to close out the proceeding file and give effect to the judgment. *See* TBMP § 806.

903.02 Parties to and Service of Civil Action

15 U.S.C. § 1071(b) [Section 21(b) of the Trademark Act]

* * * *

(2) *The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.*

(3) *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. . . .*

(4) *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. . . .*

When a party to a Board inter partes proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, the Director shall not be made a party to the civil

action. However, the clerk of the court in which the civil action is filed must notify the Director of the filing of the complaint, and the *Director* has the right to intervene in the action.[46]

The suit may be instituted against the party in interest as shown by the records of the USPTO at the time of the decision of which review is sought, but any party in interest may become a party to the action.[47]

When an applicant in an ex parte proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, a copy of the complaint must be served on the Director (who is a party to the proceeding).[48] Service of a complaint on the Director is governed by Fed. R. Civ. P. 4(i), "Serving the United States, Its Agencies, Corporations, Officers, or Employees."[49]

903.03 Place of Civil Action

15 U.S.C. § 1071(b)(4) [Section 21(b)(4) of the Trademark Act] *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.*

Generally, a civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b), may be brought in any Federal district court which has jurisdiction over the person. However, if there are adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia has jurisdiction.[50]

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[46] *See* Section 21(b)(2) of the Act, 15 U.S.C. § 1071(b)(2).

[47] *See* Section 21(b)(4) of the Act, 15 U.S.C. § 1071(b)(4).

[48] *See* Section 21(b)(3) of the Act, 15 U.S.C. § 1071(b)(3).

[49] *See also* 37 CFR § 104.2.

[50] *See* Section 21(b)(4), 15 U.S.C. § 1071(b)(4); *Pro-Football Inc. v. Harjo,* 57 USPQ2d 1140, 1141-42 (D.D.C. 2000) (U.S. District Court of the District of Columbia has jurisdiction where defendants reside in plurality of districts not within the same state); *Del-Viking Productions Inc. v. Estate of Johnson*, 31 USPQ2d 1063, 1064 (W.D.Pa. 1994) (civil action improperly brought in Pennsylvania was transferred to U.S. District Court for the District of Columbia in view of existence of multiple adverse parties residing in different states); and Saul Lefkowitz

903.04 Time for Filing Civil Action, Cross-Action

15 U.S.C. § 1071(b)(1) [Section 21(b)(1) of the Trademark Act] *Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. . . .*

37 CFR § 2.145(d) Time for appeal or civil action.
(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§ 2.127(b), 2.129(c) or 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires ***(i)*** *14 days after service of the notice of appeal or the summons and complaint; or* ***(ii)*** *two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

* * * *

(e) Extensions of time to commence judicial review. *The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for commencing a civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b), is two months from the date of the Board decision of which review is sought.[51] A civil action is

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and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 405-407 (1985).

Cf. regarding application of "first to file" rule, Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698, 1703 (9th Cir. 1991) (district court erred in dismissing rather than staying second-filed suit), and*, regarding the transfer of an action to a different forum, Chocoladefabriken Lindt & Sprungli Aktiengesellschaft v. Rykoff-Sexton Inc.*, 24 USPQ2d 1236, 1238 (S.D.N.Y. 1992) (civil action filed in New York transferred to California where defendant's witnesses and relevant documents and records were located).

[51] *See* Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1); 37 CFR § 2.145(d)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

commenced by the filing of a complaint with the court.[52] When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. § 1051(b), applicant subject to that party's establishment of constructive use (*see* TBMP § 901.02(b)), the time for commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use.[53]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§ 2 .127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for commencing a civil action expires two months after action on the request.[54]

In an inter partes case, the time for filing a cross-action expires (1) 14 days after service of the summons and complaint, or (2) two months from the date of the Board decision which is the subject of the civil action, whichever is later.[55]

If a written request to extend the time for commencing a civil action is filed before the expiration of the period for commencing a civil action, the Director may grant the request on a showing of good cause. If the request is not filed until after the expiration of the period for commencing a civil action, the Director may grant the request only on a showing that the failure to act was the result of excusable neglect.[56] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor.[57]

903.05 Information Concerning Times Specified in 37 CFR § 2.145

37 CFR § 2.145(d)(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of*

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[52] *See* Fed. R. Civ. P. 3.

[53] *See* 37 CFR § 2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

[54] *See* 37 CFR § 2.145(d)(1).

[55] *See* 37 CFR § 2.145(d)(1).

[56] *See* 37 CFR § 2.145(e). *Cf. Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

[57] *Cf. Appeals to the Federal Circuit From PTO, supra*.

Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

In 37 CFR § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for commencing a civil action falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for commencing a civil action is extended to the next day which is not a Saturday, Sunday, or Federal holiday.[58]

903.06 Civil Action Precluded by Appeal to Federal Circuit

In a proceeding before the Board, a party which is dissatisfied with the decision of the Board may have remedy by way of civil action, *unless* an appeal to the United States Court of Appeals for the Federal Circuit has been taken.[59]

However, in an inter partes case, if an appeal has been taken to the Federal Circuit, and a party adverse to the appellant files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case.[60]

903.07 Special Provisions for Ex Parte Cases

15 U.S.C. § 1071(b)(3) [Section 21(b)(3) of the Trademark Act] *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.*

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[58] 37 CFR § 2.145(d)(2).

[59] *See* Section 21(b)(1) of the Act, 15 U.S.C. § 1071(b)(1). *Cf.* Section 21(a)(1) of the Act, 15 U.S.C. § 1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act); 37 CFR § 2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act); and TBMP § 902.03 (Appeal to Federal Circuit).

[60] *See* TBMP §§ 901.01 (Avenues of Appeal) and 902.04 (Notice of Election).

When an applicant in an ex parte case seeks review of a decision of the Board by way of civil action under Section 21(b) of the Act, 15 U.S.C. § 1071(b), it must effect service on the agency pursuant to Fed. R. Civ. P. 4(i), and all the expenses, including expert witness fees and travel, of the proceeding must be paid by the applicant which brought the suit, whether the final decision is in favor of the applicant or not, unless the court finds the expenses to be unreasonable.[61]

904 Access to Record During Appeal

904.01 Access During Appeal to Federal Circuit

During an appeal to the United States Court of Appeals for the Federal Circuit, from a decision of the Board in an *inter partes* case, the original USPTO record of the case is kept at the Office of the Solicitor. However, when it deems necessary, the Federal Circuit may, on motion or sua sponte, order transmission (via the Office of the Solicitor) of the original or certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal.[62]

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the Federal Circuit amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the Court's order.[63]

During an appeal to the Federal Circuit from a decision of the Board in an *ex parte* case, the subject application file is kept at the Office of the Solicitor. Any request for access to the application should be directed to the Office of the Solicitor.

904.02 Access During Appeal by Civil Action

During a civil action seeking review of a decision of the Board in an *inter partes* case, the Board retains the original USPTO record of the case. The Board will release the original record for submission (via the Office of the Solicitor) to the court in which the civil action is pending only upon order of the court.

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[61] Section 21(b)(3) of the Act, 15 U.S.C. § 1071(b)(3).

[62] *See* Section 21(a)(3) of the Act, 15 U.S.C. § 1071(a)(3), and Fed. Cir. R. 17(a).

[63] *See* Fed. Cir. R. 17(d) and 17(e).

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the court amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the court's order.

During a civil action seeking review of a decision of the Board in an *ex parte* case, the subject application file is kept at the Office of the Solicitor. Any request for access to the application should be directed to the Office of the Solicitor.

905 Petition to the Director

37 CFR § 2.146 Petitions to the Director.
(a) *Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director; (3) to invoke the supervisory authority of the Director in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§ 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

(c) *Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the requisite fee (see § 2.6). Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits or declarations in accordance with § 2.20, and any exhibits, shall accompany the petition.*

(d) *A petition must be filed within two months of the mailing date of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter..*

(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 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.
(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board shall be filed within thirty days after the date of mailing of the order from which relief is requested. Any brief in response to the petition shall be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection shall be served on every adverse party pursuant to § 2.119(a).

(f) *An oral hearing will not be held on a petition except when considered necessary by the Director.*

(g) *The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§ 2.63(b) and 2.65 are applicable to an ex parte application.*

(h) *Authority to act on petitions, or on any petition, may be delegated by the Director.*

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a "final dispositive ruling that ends litigation on the merits" before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board.[64]

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case.[65]

In an inter partes proceeding, a party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board),

[64] *See* TBMP § 901.02(a) (Final Decision vs. Interlocutory Decision) and cases cited therein.

[65] *See* TBMP § 901.02(a) and cases cited therein.

and does not put an end to the litigation before the Board, by timely petition to the Director.[66]

A petition to the Director from an interlocutory order or decision of the Board, in a Board inter partes proceeding, must be filed within 30 days after the mailing date of the order or decision from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within 15 days from the date of service of the petition. Petitions from an interlocutory order or decision of the Board, responses to such petitions, and any papers accompanying a petition or response, must be served on every adverse party in the manner prescribed in 37 CFR § 2.119(a).[67]

For information concerning a petition to the Director from the denial, or from the granting, of a request for an extension of time to file a notice of opposition, see 37 CFR § 2.146(e)(1), and TBMP § 211.03.

A petition on any matter not otherwise specifically provided for must be filed within 60 days from the mailing date of the action from which relief is requested.[68]

The mere filing of a petition to the Director will not act as a stay in any ex parte appeal or inter partes proceeding pending before the Board.[69]

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[66] *See* 37 CFR § 2.146; *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (grant of summary judgment motion although essentially a procedural decision is appealable not petitionable in view of its substantial substantive effect); *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971) (whether Board abused discretion in denying motion to amend description of services was a matter to be determined by Commissioner, not the Court since not part of the central issue), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971); *Jack Lenor Larsen Inc. v. Chas. O. Larsen Co.*, 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (petition to Director seeking reopening of cancellation proceeding is inappropriate as petition because it seeks review of final decision of Board); *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent Inc.,* 60 USPQ2d 1703 (Comm'r 2000) (petition from Board's finding that registration issued inadvertently and to direct Board to dismiss opposition granted in view of defect in request for extension of time to oppose); *Kimberly Clark Corp. v. Paper Converting Industry Inc.,* 21 USPQ2d 1875 (Comm'r 1991) (decision denying motion to dismiss opposition as untimely filed reviewed by petition); *Miss Nude Florida, Inc. v. Drost*, 198 USPQ 485, 486 (Comm'r 1977) (Board's decision not to consider untimely evidence was critical factor leading to Board's final decision and to that extent was "logically related" to the central issue and therefore appropriate for appeal rather than petition); and *Johnson & Johnson v. Cenco Medical/Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973) (Board's decision granting motion to amend pleading to add new claim reviewable by petition).

Cf. 37 CFR § 2.146(b) (questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under Sections 2, 3, 4, 5, 6, and 23 of the Act, 15 U.S.C. §§ 1052, 1053, 1054, 1055, 1056, and 1091, are not considered to be appropriate subject matter for petition to the Director).

[67] *See* 37 CFR § 2.146(e)(2) and TBMP § 113 (Service of Papers).

[68] *See* 37 CFR § 2.146(d).

[69] *See* 37 CFR § 2.146(g). *See also In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Commr 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

A petition to the Director must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by 37 CFR § 2.6. Any brief in support of the petition must be embodied in or accompany the petition. When facts are to be proved in ex parte cases, the proof, in the form of affidavits or declarations in accordance with 37 CFR § 2.20, and any exhibits, must accompany the petition.[70]

An oral hearing will not be held on a petition to the Director except when considered necessary by the Director.[71]

For further information on petitions to the Director, see 37 CFR § 2.146. *Cf.* TMEP Chapter 1700.

906 Standards of Review of Board Decisions

As stated at the outset of this chapter, after the Board determines and decides "the respective rights of registration" under 15 U.S.C. § 1067, any party dissatisfied with the TTAB's decision may appeal either to the United States Court of Appeals for the Federal Circuit or to a federal district court.[72]

906.01 Appeal to Federal Circuit or by Civil Action

In an appeal to the Federal Circuit, the case proceeds on the closed administrative record and no new evidence is permitted.[73] In contrast, an appeal to the district court is both an appeal and a new action, which allows the parties to submit new evidence and raise additional claims.[74]

Questions of fact. The district court sits as the appellate reviewer of facts found by the Board and as the fact-finder with respect to new evidence and additional claims.[75] Both the Federal

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[70] *See* 37 CFR § 2.146(c). *See also, for example*, *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (respondent's petition did not specify which subsection of 2.146(a) provided basis for Director's review).

[71] *See* 37 CFR § 2.146(f).

[72] *See* 15 U.S.C. § 1071.

[73] 15 U.S.C. § 1071(a)(4).

[74] *See CAE Inc. v. Clean Air Engineering Inc.*, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (appeal from district court's review of Board's finding of no likelihood of confusion, and from district court's decision on added claims of infringement, unfair competition and dilution).

[75] *See CAE Inc., supra* at 1457.

Circuit and the district court, in reviewing factual findings, will afford deference to those fact-findings.[76]

The degree of deference that the reviewing courts must afford the Board's findings of fact was decided by the U.S. Supreme Court in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). In that decision the Supreme Court held that the proper standard of judicial review of findings of fact made by the USPTO is not the traditional "clearly erroneous" standard of review but rather the "slightly more" deferential standard of the Administrative Procedure Act (APA), 5 U.S.C. § 706(2).[77] Thus, whether a party elects direct review by the Federal Circuit or initiates a new action in the district court, the APA standard of review should be applied to the Board's fact-finding.[78]

The Supreme Court did not decide which of the two standards of review under § 706(2) of the APA, the "arbitrary, capricious" test under § 706(2)(A) or the "substantial evidence" test under § 706(2)(E), should be applied.[79] Of the two tests, the Federal Circuit has determined that the "substantial evidence" standard is the appropriate standard of review for USPTO findings of fact.[80] A number of circuit courts of appeals have also indicated that "substantial evidence" review is appropriate.[81]

The substantial evidence standard requires the reviewing court to ask whether a reasonable person might accept that the evidentiary record supports the agency's conclusion.[82] Considered to be less deferential than the "arbitrary, capricious" standard of the APA, "substantial evidence"

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[76] *See In re Dr Pepper Co*., 836 F.2d 508, 5 USPQ2d 1207, 1209 (Fed. Cir. 1987) and *CAE Inc., supra* at 1458.

[77] *CAE Inc., supra* at 1458 *quoting Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930 (1999).

[78] *See Dickinson v. Zurko*, 50 USPQ2d at 1936 (rejecting the argument that the "two paths" for review would create "an anomaly" in the standard of review). *See also Pro-Football Inc. v. Harjo*, 57 USPQ2d 1140, 1142 (D.D.C. 2000) (district court review of Board decision is "a hybrid deferential treatment and de novo scrutiny"; deference given to findings of fact made by the Board and de novo review of legal conclusions).

[79] 5 U.S.C. §§ 706(2)(A) & (E). *See In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1773 (Fed. Cir. 2000).

[80] *See Gartside*, *supra* at 1775. *See also On-line Careline Inc. v. America Online Inc.,* 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); and *Recot, Inc. v. M.C. Becton,* 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

[81] *See CAE Inc., supra* at 1459 and *Gartside, supra* at 1773.

[82] *Dickinson v. Zurko*, *supra* 50 USPQ2d at 1935 and *Gartside, supra* at 1773, quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938) ("substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. ... Mere uncorroborated hearsay or rumor does not constitute substantial evidence.").

requires a stricter judicial review of agency fact-finding.[83] A review for substantial evidence "involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision."[84] Moreover, "the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence."[85]

Conclusions of law. While the Board's findings of fact are reviewed for substantial evidence, conclusions of law are reviewed de novo, without deference to the Board.[86]

906.02 Petition to Director

In reviewing non-final rulings of the Board, the Director will exercise supervisory authority under Trademark Rule 2.146(a)(3) and reverse the Board's ruling only where there is a clear error or abuse of discretion.[87]

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[83] *Dickinson v. Zurko*, *id.* and *In re Gartside, supra* at 1772 (the "arbitrary, capricious" standard of review is the most deferential of the APA standards of review).

[84] *Gartside, supra* at 1773.

[85] *Id., quoting Consolo v. Federal Maritime Comm'n,* 383 U.S. 607, 620 (1966).

[86] *See Herbko International Inc. v. Kappa Books Inc.,* 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) (conclusions of law are reviewed without deference); *In re International Flavors & Fragrances Inc.,* 183 F.3d 1361, 51 USPQ2d 1513, 1515 (Fed. Cir. 1999) (legal conclusions are reviewed de novo); and *Allied-Signal Inc. v. Allegheny Ludlum Corp.,* 29 USPQ2d 1039, 1043 (DC Conn 1993) (conclusions of law are reviewed de novo).

See also, regarding types of decisions and particular issues, In re California Innovations, Inc., 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003) (Board's interpretations of the Lanham Act are reviewed without deference); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) (determination of likelihood of confusion is a question of law); *Herbko International Inc. v. Kappa Books Inc., supra at* 1377 (grant of summary judgment is reviewed without deference and court must decide for itself whether moving party has shown that it is entitled to judgment as a matter of law); *In re Save Venice New York Inc.,* 59 USPQ2d 1778, 1781 (Fed. Cir. 2001) (validity of the Board's adaptation of the related goods test to geographic marks is a question of law that is reviewed de novo); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000) (ultimate question of whether a likelihood of confusion exists is a question of law, based on underlying factual determinations); *Sunrise Jewelry Mfg. Corp. v. Fred, S.A*., 175 F.3d 1322, 50 USPQ2d 1532, 1534 (Fed. Cir. 1999) (whether Board properly granted defendant's motion to dismiss is a question of law that is reviewed "independently"); and *Spraying Systems Co. v. Delavan Inc.,* 24 USPQ2d 1181, 1184 (7th Cir. 1992) (Board's grant of summary judgment is reviewed de novo). *In addition, see Valu Engineering Inc. v. Rexnord Corp.,* 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002) (functionality is a question of fact); *On-line Careline Inc. v. America Online Inc.,* 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000) (abandonment is a question of fact); and *Towers v. Advent Software Inc.,* 913 F.2d 942, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990) (descriptiveness is a question of fact).

[87] *See In re Sasson Licensing Corp.,* 35 USPQ2d 1510, 1511 (Comm'r 1995); *Huffy Corp. v. Geoffrey Inc.*. 18 USPQ2d 1240, 1242 (Comm'r 1990); and *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899 (Comm'r 1990).