

# Chapter 900 REVIEW OF DECISION OF BOARD

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## **901 Appeals--In General**

*Trademark Act § 21, 15 U.S.C. § 1071 Review of Director's or Trademark Trial and Appeal Board's Decision.*

(a) *Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure.*

(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 1058 or section 71 of this title, 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.

**(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure.**

(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 1051(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(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.

\* \* \* \*

**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 Office, addressed to the Office of General Counsel, according to part 104 of this chapter, 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.

\* \* \* \*

**(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.

\* \* \* \*

### 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 (“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.” [Note 1.]

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. [Note 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. [Note 3.]

The Federal Circuit is often referred to in Board decisions as “our primary reviewing court.” [Note 4.]

#### NOTES:

1. Trademark Act § 21, [15 U.S.C. § 1071](#); [37 CFR § 2.145](#). See *Shammas v. Focarino*, 784 F.3d 219, 114 USPQ2d 1489, 1490 (4th Cir. 2015) (dissatisfied trademark applicant may seek review of an adverse ruling on his trademark application either by appealing the ruling to the Court of Appeals for the Federal Circuit or by commencing an action in a federal district court), *cert. denied sub nom. Shammas v. Hirschfeld*, \_\_\_ S. Ct. \_\_\_, No. 15-563, 2016 WL 854226 (Mar. 7, 2016); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (choice of appealing TTAB decision in inter partes case to Federal Circuit on closed record of Board proceedings or a federal district court with the option of presenting additional evidence; *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); *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); *Product Source International, LLC v. Nahshin*, 112 F. Supp. 3d 383 (E.D. Va. 2015) (applicant who is dissatisfied with final decision of TTAB has choice of appealing the decision to the Court of Appeals for the Federal Circuit or a remedy by civil action in district court).

2. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 CFR § 2.145\(c\)\(3\)](#).

3. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 CFR § 2.145\(d\)\(3\)](#).

4. *In re Thor Tech*, 90 USPQ2d 1634, 1637 (TTAB 2009); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1024 (TTAB 2009); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, n.2 (TTAB 2008); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005), *aff'd* 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

## 901.02 What May Be Appealed

### 901.02(a) Final Decision Versus Interlocutory Decision

The only type of Board decision that may be appealed, whether to the United States Court of Appeals for the Federal Circuit (“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. [Note 1.]

Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. [Note 2.]

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. [Note 3.]

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. [Note 4.] 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, the Board may 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.” [Note 5.]

When an appeal is taken from a decision of the Board, it is the court to which an appeal is taken, not the Board, that determines whether the involved decision is appealable, that is, whether the court has jurisdiction to entertain the appeal. [Note 6.]

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. [Note 7.]

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 filing a petition to the Director. [Note 8.] See [TBMP § 905](#). A party may also file a request with the Board for reconsideration of such an order or decision. See [TBMP § 518](#).

The mandamus procedure may not be used as a substitute for the appeal procedure specified in Trademark Act § 21, [15 U.S.C. § 1071](#). [Note 9.]

#### NOTES:

1. 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”); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm’r 1986).

2. 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 disposition of case); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USQP2d 1106, 1115 n.12 (TTAB 2011) (order denying motion for summary judgment as to one of three cancellation proceedings is interlocutory in nature and not yet appealable); *Hewlett Packard v. Vudu, Inc.*, 92 USPQ2d 1630, 1633 n.5 (TTAB 2009) (Board granted partial summary judgment on only one class of goods and pointed out that order was interlocutory, citing *Copeland’s Enterprises*). 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, 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.*, 225 USPQ 1222 (TTAB 1984), appeal dismissed, 757 F.2d 254, 226 USPQ 11, 11 (Fed. Cir. 1985) (order denying summary judgment was interlocutory and thus non-final and non-appealable); *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).

3. See, e.g., *3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015) (judgment entered under Trademark Rule 2.135 for abandoning application after commencement of opposition was reviewable); *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.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev’d*, 853 F.2d 888, 7 USPQ2d 1628, 1630 n.2 (Fed. Cir. 1988) (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); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USQP2d 1106, 1115 n.11 (TTAB 2011) (order granting summary judgment as to two of three cancellation proceedings is a final decision of the Board which may be appealed); *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1970), *aff’d*, 510 F.2d 963, 184 USPQ 744, 745 (CCPA 1975) (reviewing decision denying petitioner’s Fed. R. Civ. P. 60(b) motion to vacate earlier decision granting respondent’s motion for summary judgment).

4. See *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589, 1594 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). See also *Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (appeal of order granting partial summary judgment was premature).

5. See, e.g., *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 n.17 (TTAB 1998); *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589, 1594 n.4 (TTAB 1992).

6. 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); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) (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.*, 946 F.2d 622, 20 USPQ2d 1698, 1701 (9th Cir. 1991).

7. See *Questor Corp. v. Dan Robbins & Associates, Inc.*, 599 F.2d 1009, 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); *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).

8. See *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).

9. See *Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 646 (CCPA 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).

### **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 Trademark Act § 1(b), [15 U.S.C. § 1051\(b\)](#), before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Trademark Act § 7(c), [15 U.S.C. § 1057\(c\)](#). [Note 1.] Rather, in those cases where the Board finds that a § 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. [Note 2.] If, after entry of that judgment, the § 1(b) 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 § 1(b) applicant. If, on the other hand, the § 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 § 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. [Note 3.]

**NOTES:**

1. Trademark Act § 21(a)(4) and Trademark Act § 21(b)(1), [15 U.S.C. § 1071 \(a\) \(4\)](#) and [15 U.S.C. § 1071\(b\)\(1\)](#).
2. [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 § 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); *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).
3. See [37 CFR § 2.129\(d\)](#). *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991).

**901.03 Motions For Relief From Final Judgment During Appeal**

When a party files a Fed. R. Civ. P. 60(b) motion for relief from final judgment contemporaneously with, or during the pendency of an appeal, the Board has jurisdiction to entertain the motion. If the Board determines that the motion is to be denied, the Board will enter the order denying the motion. Any appeal of the denial may be consolidated with the appeal of the underlying order. If the Board is inclined to grant the Fed. R. Civ. P. 60(b) motion, it will issue a short memorandum so stating. The movant may then request a limited remand from the appellate court so that the Board can rule on the motion. [Note 1.]

**NOTES:**

1. See *Home Products International v. U.S.*, 633 F.3d 1369, 1378 n.9 (Fed. Cir. 2011); *3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015); *Pramil S.R.L. v. Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009).

**902 Appeal To Court Of Appeals For The Federal Circuit****902.01 Notice Of Appeal**

*Trademark Act § 21(a)(2), 15 U.S.C. § 1071(a)(2)* When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States 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 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 according to part 104 of this chapter, with a duplicate copy mailed or served by hand on the Trademark Trial and Appeal Board.*

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

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

Office of the General Counsel  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

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

Office of the General Counsel,  
10B20, Madison Building East,  
600 Dulany Street,  
Alexandria, Virginia 22314

*(c) The Office of the General Counsel may be reached by telephone at 571-272-7000 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. [Note 1.]

Specifically, the original notice of appeal must be filed in the USPTO, within the time required by [37 CFR § 2.145\(d\)](#). [Note 2.] See [TBMP § 902.02](#). The certificate of mailing and certificate of transmission procedures described in [37 CFR § 2.197](#), and the Priority Mail Express® procedure described in [37 CFR § 2.198](#), 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. [Note 3.] A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the notice of appeal. [Note 4.] 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](#). [Note 5.] See [TBMP § 113](#). The written notice, if mailed to the USPTO (rather than hand-delivered to the Office of the General Counsel), must be addressed to Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. [Note 6.]

For appeals of ex parte decisions, the applicant should select the ESTTA button “Appeal to CAFC”; for appeals of inter partes decisions, the appellant should select the button “Other Motions/Papers.”

For information concerning the ways (i.e., by hand delivery, first-class mail, electronic filing, 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 § 2.190](#), [37 CFR § 2.195](#), [37 CFR § 2.197](#), [37 CFR § 2.198](#), and [37 CFR § 2.145\(b\)\(3\)](#).

For further information concerning how to file a notice of appeal, contact the Office of the Solicitor in the USPTO at (571) 272-9035.

Three copies of the notice of appeal must be filed in the Court of Appeals for the Federal Circuit and the appeal fee required by the rules of the Court must be paid to the Court. **Please 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. [Note 7.] 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. [Note 8.]

#### NOTES:

1. [37 CFR § 2.145\(a\)](#) and [37 CFR § 2.145 \(b\)](#); Fed. Cir. R. 15. (The Federal Circuit Rules and Forms can be found on the Court's website at: [www.cafc.uscourts.gov](http://www.cafc.uscourts.gov)).
2. Trademark Act § 21(a)(2), [15 U.S.C. § 1071\(a\)\(2\)](#); [37 CFR § 2.145\(a\)](#) and [37 CFR § 2.145\(b\)\(1\)](#).
3. [37 CFR § 2.145\(b\)\(1\)](#).
4. [37 CFR § 2.145\(b\)\(1\)](#).
5. See [37 CFR § 2.145\(b\)\(2\)](#).
6. See [37 CFR § 104.2](#).
7. See [37 CFR § 2.145\(a\)](#).
8. See the website for the Court of Appeals for the Federal Circuit at: [www.cafc.uscourts.gov](http://www.cafc.uscourts.gov).

#### 902.02 Time For Filing Notice Of Appeal, Cross-Appeal

*Trademark Act § 21(a)(2), [15 U.S.C. § 1071\(a\)\(2\)](#) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States 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\(d\)](#) 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 (“Federal Circuit”) is two months from the date of the Board decision which is the subject of the appeal. [Note 1.] When the two-month period includes February 28, an additional day is added. [Note 2.] Likewise, if the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 3.] When the Board enters judgment in favor of a Trademark Act §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. [Note 4.]

If a request for rehearing, reconsideration, or modification of the Board’s decision is filed within the time specified in [37 CFR § 2.127\(b\)](#), [37 CFR § 2.129\(c\)](#), or [37 CFR § 2.144](#), or within any extension of time granted thereunder, the time for filing an appeal expires two months after action on the request. [Note 5.] When the two-month period includes February 28, an additional day is added. [Note 6.] Likewise, if the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 7.] Because the Board’s rules do not permit a second or subsequent request for reconsideration, only a timely first request for reconsideration or modification will toll the time for filing an appeal.

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. [Note 8.]

The certificate of mailing and certificate of transmission procedures described in [37 CFR § 2.197](#), and the Priority Mail Express® procedure described in [37 CFR § 2.198](#), 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. [Note 9.] A request for an extension of time to file an appeal should be directed to the attention of the Office of the

Solicitor at the following address:

Office of the Solicitor  
Mail Stop 8  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

It is the Director, through the Office of the Solicitor in the Office of the General Counsel, 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. [Note 10.]

An appellant that 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.

**NOTES:**

1. Trademark Act § 21(a)(2), [15 U.S.C. § 1071\(a\)\(2\)](#); [37 CFR § 2.145\(d\)\(1\)](#).
2. [37 CFR § 2.129 \(d\)\(2\)](#).
3. [37 CFR § 2.129 \(d\)\(2\)](#).
4. [37 CFR § 2.129\(d\)](#); *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).
5. [37 CFR § 2.145\(d\)\(1\)](#).
6. [37 CFR § 2.129 \(d\)\(2\)](#).
7. [37 CFR § 2.129 \(d\)\(2\)](#).
8. [37 CFR § 2.145\(d\)\(1\)](#).
9. [37 CFR § 2.145\(e\)](#).
10. *See* Fed. Cir. R. 15(b)(1)(B).

### 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 Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#). [Note 1.] See [TBMP § 903.05](#).

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 that 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. See [TBMP § 901.01](#) and [TBMP § 902.04](#).

#### NOTES:

1. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#) (party which appeals to the Federal Circuit thereby waives its right to proceed under Trademark Act § 21(b)); [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 Trademark Act § 21(b)). Cf. Trademark Act § 21(b)(1), [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).

### 902.04 Notice Of Election To Have Review By Civil Action

*Trademark Act Section 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#) 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 1058 or section 71 of this title, 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 Office, addressed to the Office of the General Counsel, according to part 104 of this chapter, 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.*

\* \* \* \*

*(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 USPTO electing to have all further proceedings conducted by way of civil action, under Trademark Act § 21(b), [15 U.S.C. § 1071 \(b\)](#) seeking review of the decision that was the subject of the appeal. [Note 1.] As with a notice of appeal, the notice of election, if delivered by mail to the USPTO, must be addressed to Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The certificate of mailing and certificate of transmission procedures described in [37 CFR § 2.197](#), and the Priority Mail Express® procedure described in [37 CFR § 2.198](#), 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](#). [Note 2.] See [TBMP § 113](#). A copy of the notice must also be filed with the Federal Circuit. [Note 3.]

If an adverse party files a notice electing to have further proceedings conducted by way of civil action under Trademark Act § 21(b), the appeal to the Federal Circuit will be dismissed, (Fed. Cir. R. 15(e)) and the party that 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. [Note 4.] Any cross-action must be filed within 14 days after service of the summons and complaint in the civil action. [Note 5.]

#### NOTES:

1. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 CFR § 2.145\(c\)\(3\)](#).
2. [37 CFR § 2.145\(c\)\(3\)](#).
3. Fed. Cir. R. 15(e).
4. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 CFR § 2.145\(d\)\(3\)](#).
5. [37 CFR § 2.145\(d\)\(3\)](#).

#### 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 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. [Note 1.]

#### NOTES:

1. [37 CFR § 2.145\(d\)\(2\)](#).

## 902.06 Certified List

*Trademark Act § 21(a)(3), [15 U.S.C. § 1071\(a\)\(3\)](#) 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 United States 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 United States 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, via the Office of the Solicitor, 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 containing the USPTO record of the proceeding. [Note 1.] The Office of the Solicitor mails a copy of the certified list to every party to the proceeding. [Note 2.]

When the Federal Circuit receives the notice of appeal and the certified list, the Court docketes the appeal, and gives notice to all parties of the date of docketing. [Note 3.] 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 certified list is served in appeals from Board decisions, the appellant's time for filing its brief normally runs from the date of docketing. [Note 4.]

### NOTES:

1. Trademark Act § 21(a)(3), [15 U.S.C. § 1071\(a\)\(3\)](#); Fed. Cir. R. 15(b)(1) and 17(b)(1).
2. Fed. Cir. R. 17(c).
3. Fed. Cir. R. 15(b)(1).
4. Fed. Cir. R. 31(a).

## 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 the Federal Circuit Rules on the Court's website at [www.cafc.uscourts.gov](http://www.cafc.uscourts.gov).

For information concerning the appendix to the briefs, in particular, see Fed. Cir. R. 30 and 32.

## 902.08 Special Provisions for Ex Parte Cases

*Trademark Act § 21(a)(3), [15 U.S.C. § 1071\(a\)\(3\)](#) In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States 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 Section 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 Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#). [Note 1.]

On appeal to the Federal Circuit in an ex parte case, the Director, via the Office of the Solicitor, files a brief in support of the Board's decision. [Note 2.]

Questions regarding the determination of the contents of the appendix pursuant to Fed. Cir. R. 30(b) should be directed to the Office of the Solicitor.

In situations where the original appellee in an appeal of an inter partes case does not appear, the USPTO may move and the Federal Circuit may grant leave for the Director to participate to defend the Board's decision. In such cases, the Court may substitute the Director as appellee and revise the caption of the appeal to reflect its ex parte nature. [Note 3.]

#### NOTES:

1. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 CFR § 2.145\(c\)\(2\)](#).
2. Trademark Act § 21(a)(3), [15 U.S.C. § 1071\(a\)\(3\)](#).
3. *In re Bose Corp.*, 580 F.3d. 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009) (upon motion by Director, USPTO was substituted by Court for appellee that did not appear).

## 903 Review By Civil Action

### 903.01 Notice Of Civil Action

**[37 CFR § 2.145\(c\)\(4\)](#)** *In order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.*

A party which commences a civil action, under Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#) seeking review of a decision of the Board should file written notice thereof with 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. [Note 1.] That is, if the Board is unaware of the commencement of the civil action, the Board will treat its own decision as final, and will take steps, based on such judgment, to close out the proceeding file and give effect to its judgment. See [TBMP § 806](#). It is preferable for the party to notify the Board through ESTTA. When review is sought by way of a civil action in district court, the applicant should select the ESTTA button "Appeal to District Court" for an ex parte appeal. For an inter partes decision, the party should select the ESTTA button "Other Motions/Papers."

#### NOTES:

1. See [37 CFR § 2.145\(c\)\(4\)](#).

## 903.02 Parties To And Service Of Civil Action

**Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure.**

\* \* \* \*

(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 United States 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. [Note 1.]

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. [Note 2.]

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 USPTO Director (who is a party to the proceeding). [Note 3.] 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.” It is preferable for the party to also notify the Board through ESTTA. When review is sought for an ex parte decision, the party should select the ESTTA button “Appeal to District Court.” Under Fed. R. Civ. P. 4(i), copies of the complaint and summons must be served in a timely manner on the USPTO Director, the U.S. Attorney for the district where the action is brought, and the Attorney General of the United States. Service of the summons and complaint on the USPTO Director must be made to the Office of General Counsel. [Note 4.]

### NOTES:

1. Trademark Act § 21(b)(2), [15 U.S.C. § 1071\(b\)\(2\)](#).
2. Trademark Act § 21(b)(4), [15 U.S.C. § 1071\(b\)\(4\)](#).
3. Trademark Act § 21(b)(3), [15 U.S.C. § 1071\(b\)\(3\)](#).
4. See [37 CFR § 104.2](#).

## 903.03 Place Of Civil Action

**Trademark Act § 21(b)(4), [15 U.S.C. § 1071\(b\)\(4\)](#) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States 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 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 Eastern District of Virginia 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 Trademark Act § 21(b), [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 Eastern District of Virginia has jurisdiction. [Note 1.]

In ex parte cases, for purposes of venue under [28 U.S.C. § 1391\(e\)](#), the USPTO resides in the Eastern District of Virginia. [Note 2.]

#### NOTES:

1. Trademark Act § 21(b)(4), [15 U.S.C. § 1071\(b\)\(4\)](#). See, e.g., *Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96, 68 USPQ2d 1225, 1228 (D.D.C. 2003) (U.S. District Court of the District of Columbia has jurisdiction where defendants reside in plurality of districts not within the same state) *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); *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). **Please Note:** At the time these cases were decided, [15 U.S.C. § 1071\(b\)\(4\)](#) expressly provided for jurisdiction in the United States District Court for the District of Columbia. The statute was subsequently amended to provide jurisdiction in the United States District Court for the Eastern District of Virginia.

*Compare* 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).

2. See [35 U.S.C. § 1\(b\)](#) (“The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law.”). The USPTO’s headquarters are located in Alexandria, Virginia, which is in the Eastern District of Virginia.

### 903.04 Time For Filing Civil Action, Cross-Action

*Trademark Act § 21(b)(1), 15 U.S.C. § 1071(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. . . .

#### [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. \* \* \* \**

(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 Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#), is two months from the date of the Board decision of which review is sought. [Note 1.] When the two-month period includes February 28, an additional day is added. [Note 2.] Likewise, if the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 3.] A civil action is commenced by the filing of a complaint with the court. [Note 4.] When the Board enters judgment in favor of a Trademark Act § 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. [Note 5.]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in [37 CFR § 2.127\(b\)](#), [37 CFR § 2.129\(c\)](#), or [37 CFR § 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. [Note 6.] When the two-month period includes February 28, an additional day is added. [Note 7.] Likewise, if the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 8.] Because the Board's rules do not permit a second or subsequent request for reconsideration, only a timely first request for reconsideration or modification will toll the time for commencing a civil action. 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. [Note 9.]

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 USPTO 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 USPTO may grant the request only on a showing that the failure to act was the result of excusable neglect. [Note 10.] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor at the following address:

Mail Stop 8  
Office of the Solicitor  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**NOTES:**

1. Trademark Act § 21(b)(1), [15 U.S.C. § 1071 \(b\) \(1\)](#) (60 days); [37 CFR § 2.145\(d\)\(1\)](#) (two months). *See also Tovaritch Spirits International S.A. v. Luxco Inc.*, 100 USPQ2d 1543, 1545 (E.D. Mo. 2011) (clear that the time a party has to appeal a TTAB decision is two calendar months, not sixty days).
2. [37 CFR § 2.145\(d\)\(2\)](#).
3. [37 CFR § 2.145\(d\)\(2\)](#).
4. [Fed. R. Civ. P. 3](#).
5. [37 CFR § 2.129\(d\)](#); *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).
6. [37 CFR § 2.145\(d\)\(1\)](#).
7. [37 CFR § 2.145 \(d\) \(2\)](#).
8. [37 CFR § 2.145 \(d\) \(2\)](#).
9. [37 CFR § 2.145\(d\)\(1\)](#).
10. [37 CFR § 2.145\(e\)](#).

**903.05 Information Concerning Times Specified In 37 CFR § 2.145**

[37 C.F.R. §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 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. [Note 1.]

**NOTES:**

1. [37 CFR § 2.145\(d\)\(2\)](#).

## 903.06 Civil Action Precluded By Appeal To Federal Circuit

In a proceeding before the Board, a party that 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. [Note 1.] See [TBMP § 902.03](#).

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. See [TBMP § 901.01](#) and [TBMP § 902.04](#). [Note 2.]

### NOTES:

1. Trademark Act § 21(b)(1), [15 U.S.C. § 1071\(b\)\(1\)](#). Cf. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#) (party which appeals to the Federal Circuit thereby waives its right to proceed under Trademark Act § 21(b)); [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 Trademark Act § 21(b)).
2. See *Belmora LLC v. Bayer Consumer Care AG*, 115 USPQ2d 1032, 1036 (E.D. Va 2015) (Belmora filed notice of appeal of Board's decision to Federal Circuit; Bayer then filed a notice of election to have review by civil action), *vacated and remanded*, \_\_\_ F.3d \_\_\_, No. 15-1335, 2016 WL 1135518 (4th Cir. Mar. 23, 2016).

## 903.07 Special Provisions For Ex Parte Cases

*Trademark Act § 21(b)(3), [15 U.S.C. § 1071\(b\)\(3\)](#) 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. In suits brought hereunder, the record in the United States 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 United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.*

When an applicant in an ex parte case seeks review of a decision of the Board by way of civil action under Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#), it must effect service on the USPTO Director pursuant to Fed. R. Civ. P. 4(i) (“Serving the United States and its Agencies, Corporations, Officers, or Employees.”), and “all the expenses of the proceeding,” including but not limited to expert witness fees, copying, travel, and expenses for personnel time spent in defense of the action, 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. [Note 1.] Under Fed. R. Civ. P. 4(i), copies of the complaint and summons must be served in a timely manner on the USPTO Director, the U.S. Attorney for the district where the action is brought, and the Attorney General of the United States. Service of the summons and complaint on the USPTO Director must be made to the Office of General Counsel as indicated in 37 C.F.R. § 104.2.

**NOTES:**

1. Trademark Act § 21(b)(3), [15 U.S.C. § 1071\(b\)\(3\)](#). See *Shammas v. Focarino*, 784 F.3d 219, 224 (4th Cir. 2015) (“We . . . conclude[e] that the imposition of all expenses on a plaintiff in an ex parte proceeding, regardless of whether he wins or loses . . . [constitutes] . . . an unconditional compensatory charge imposed on a dissatisfied applicant who elects to engage the PTO in a district court proceeding. And we conclude that this compensatory charge encompasses the PTO’s salary expenses for the attorneys and paralegals who represent the Director.”), *cert. denied sub nom Shammas v. Hirschfeld*, No. 15-563, 2016 WL 854226 (Mar. 7, 2016).

**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 USPTO will retain the record of the case. 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. [Note 1.]

During an appeal to the Federal Circuit from a decision of the Board in an ex parte case, the subject application file is retained by the USPTO.

Non confidential papers filed with the Board may be viewed online at any time through the publicly available TTABVUE system, accessible at [www.ttabvue.uspto.gov/ttabvue](http://www.ttabvue.uspto.gov/ttabvue). The TTABVUE database contains most Board proceedings since 2001. You may call the Board to arrange for inspection of older, non-confidential Board files. For further information regarding the inspection and copying of older paper files, see [TBMP § 120.01](#).

Any portions of the record that 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. [Note 2.]

**NOTES:**

1. Trademark Act § 21(a)(3), [15 U.S.C. § 1071\(a\)\(3\)](#); Fed. Cir. R. 17(a).

2. Fed. Cir. R. 17(d) and 17(e).

**904.02 Access During Review 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. [Note 1.]

During a civil action seeking review of a decision of the Board in an ex parte case, the subject application file is retained by the USPTO. The USPTO files a certified copy of the administrative record with the court.

Non confidential papers filed with the Board may be viewed online at any time through the publicly available TTABVUE system, accessible at [www.ttabvue.uspto.gov/ttabvue](http://www.ttabvue.uspto.gov/ttabvue). The TTABVUE database contains most Board proceedings since 2001. You may call the Board to arrange for inspection of older, non-confidential TTAB files. For further information regarding the inspection and copying of older paper files, see [TBMP § 120.01](#).

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.

1. See [15 U.S.C. § 1071\(b\)\(3\)](#). (“[T]he record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses ... as the court imposes. ...”)

## 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 sections 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 requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of affidavits or declarations in accordance with § 2.20, signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.*

(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. 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. No further document relating to the petition shall be filed.*

(2) *A petition from an interlocutory order of the Trademark Trial and Appeal Board must 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 must 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 must be served on every adverse party pursuant to § 2.119.*

(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 that 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. See [TBMP § 901.02\(a\)](#).

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. See [TBMP § 901.02\(a\)](#).

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), and does not put an end to the litigation before the Board, by timely petition to the Director. [Note 1.]

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\(a\)](#). [Note 2.] See [TBMP § 113](#).

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 two months from the mailing date of the action from which relief is requested. [Note 3.]

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. [Note 4.] However, the Board may in its discretion suspend proceedings in an inter partes case pending determination of a petition to the Director.

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. [Note 5.]

An oral hearing will not be held on a petition to the Director except when considered necessary by the Director. [Note 6.]

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

#### NOTES:

1. *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); *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*, 193 USPQ 729 (TTAB 1976), *pet. to Comm'r denied*, 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); *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 Trademark Act §§ 2, 3, 4, 5, 6, and 23, 15 U.S.C. §§ 1052, 1053, 1054, 1055, 1056, and 1091, are not considered to be appropriate subject matter for petition to the Director).

2. [37 CFR § 2.146\(e\)\(2\)](#).

3. [37 CFR § 2.146\(d\)](#).

4. [37 CFR § 2.146\(g\)](#). *See In re Docrate Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 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).

5. [37 CFR § 2.146\(c\)](#). *See, e.g., 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).

6. [37 CFR § 2.146\(f\)](#).

#### 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 Trademark Act § 17, [15 U.S.C. § 1067](#), any party dissatisfied with the Board's decision may seek review of the decision either by appealing to the United States Court of Appeals for the Federal Circuit or by filing a civil action in a federal district court. [Note 1.]

**NOTES:**

1. Trademark Act § 21, [15 U.S.C. § 1071](#).

**906.01 Appeal To Federal Circuit Or Review By Civil Action**

In an appeal to the Federal Circuit, the case proceeds on the closed administrative record and no new evidence is permitted. [Note 1.] 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, in inter partes cases, to raise additional claims. [Note 2.]

**Questions of fact.** In a district court civil action under Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#), the district court's standard of review for agency factfinding depends on whether new evidence is introduced on a disputed issue of fact. If new evidence is introduced on a disputed question of fact, the district court "must make de novo factual findings that take account of both the new evidence and the administrative record before the PTO" on the issue about which the new evidence is offered. [Note 3.] In cases where no new evidence is adduced on a disputed factual issue, the district court applies the same deferential APA substantial evidence standard in reviewing the TTAB fact findings on that issue as would the Federal Circuit reviewing the same issue. [Note 4.] In inter partes cases where additional legal causes of action have been pled, the district court will make its own factual findings as to those additional claims. [Note 5.]

The degree of deference that the reviewing courts must afford 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). [Note 6.] 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. [Note 7.]

The Supreme Court did not decide which of the two standards of review under APA § 706(2), 5 U.S.C. §§ 706(2)(A) and (E), the "arbitrary, capricious" test under APA §§ 706(2) and 706(2)(A) or the "substantial evidence" test under § 706(2)(E), should be applied. [Note 8.] 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. [Note 9.] A number of circuit courts of appeals have also indicated that "substantial evidence" review is appropriate. [Note 10.]

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. [Note 11.] Considered to be less deferential than the "arbitrary, capricious" standard of the APA, "substantial evidence" requires a stricter judicial review of agency fact-finding. [Note 12.] 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." [Note 13.] 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." [Note 14.] "Where two different conclusions may be warranted based on the evidence of record, the Board's decision to favor one conclusion over the other is the type of decision that must be sustained by this court as supported by substantial evidence." [Note 15.] Substantial evidence is "'more than a mere scintilla' and 'such relevant evidence as a reasonable mind would accept as adequate' to support a conclusion." [Note 16.]

Examples of findings of fact include abandonment [Note 17]; functionality [Note 18]; descriptiveness [Note 19]; whether trade dress is product design [Note 20.]; whether an asserted mark is generic [Note 21]; whether the later version of a mark creates the same continuing commercial impression [Note 22]; and whether applicant had a bona fide intent to use the mark in commerce [Note 23].

**Conclusions of law.** While the Board’s findings of fact are reviewed for substantial evidence, conclusions of law are reviewed de novo. [Note 24]

Examples of legal conclusions that receive de novo review include whether the Board properly granted summary judgment or a motion to dismiss. [Note 25.] The U.S. Court of Appeals for the Federal Circuit treats the issue of likelihood of confusion as a question of law, based on underlying factual determinations. [Note 26.]

The Board’s interpretations of the Lanham Act are legal determinations, but under general principles of administrative law, courts have given deference to the Board’s reasonable interpretations of the statute the agency is charged with administering. [Note 27.] “Substantial deference” is given to the USPTO’s interpretation of its own regulations. [Note 28.]

**Collateral Estoppel effect.** In *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048 (2015), the Supreme Court held that issue preclusion can be based on a decision by the Trademark Trial and Appeal Board in a case in which the ordinary elements of issue preclusion are met. The District Court for the Eastern District of Virginia, citing *B&B Hardware*, gave preclusive effect to a TTAB decision that found the defendant had committed fraud. [Note 29.]

## NOTES:

1. Trademark Act § 21(a)(4), [15 U.S.C. § 1071\(a\)\(4\)](#).
2. See *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 109 USPQ2d 1291, 1295 (4th Cir. 2014) (when an inter partes TTAB decision is challenged by filing a civil action in district court, the parties have the right to submit further evidence and additional claims); *Autodesk, Inc. v. Lee*, 113 USPQ2d 1161, 1162 (E.D. Va. 2014) (where new evidence is submitted in civil action under § 1071(b), court “reviews the record de novo and acts as the finder of fact based on the entire record”), appeal withdrawn (4th Cir. Jan. 28, 2015); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 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).
3. See *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 109 USPQ2d 1291, 1295 (4th Cir. 2014) (“[W]here new evidence is presented to the district court on a disputed fact question, a de novo finding will be necessary to take such evidence into account together with the evidence before the board”) (internal citations omitted). See also *Kappos v. Hyatt*, 132 S. Ct. 1690, 1701, 102 USPQ2d 1337 (2012) (interpreting [35 U.S.C. § 145](#)). Although *Kappos v. Hyatt* concerned a district court civil action under [35 U.S.C. § 145](#) challenging the USPTO’s rejection of a patent application, the Court’s holding on this point applies to district court civil actions challenging refusals to register trademarks because of the relationship and similarities between [35 U.S.C. § 145](#) and [15 U.S.C. § 1071 \(b\)](#). Prior to 1962, the Lanham Act incorporated the patent review procedures in [35 U.S.C. § 145](#). In 1962, Congress revised [15 U.S.C. § 1071 \(b\)](#), to incorporate “with necessary changes in language, the various provisions of title 35 relating to such appeals and review.” See S. Rep. No. 87-2107 (1962), 1962 U.S.C.C.A.N. 2844, 2850.

4. See *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001)
5. See *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 109 USPQ2d 1291, 1295 (4th Cir. 2014) (“The district court has authority independent of the PTO to . . . decide any related matters such as infringement and unfair competition claims.”); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001).
6. See *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001); quoting *Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930 (1999).
7. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930, 1936 (TTAB 1999) (rejecting the argument that the “two paths” for review would create “an anomaly” in the standard of review). See *Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96, 68 USPQ2d 1225, 1239 (D.D.C. 2003) (district court review of Board decision is “commensurate with the ‘substantial evidence’ standard of review articulated in the APA.”), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *aff’d*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).
8. 5 U.S.C. §§ 706(2)(A) and (E). See *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1773 (Fed. Cir. 2000).
9. *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1576 (Fed. Cir. 2015) (Substantial evidence supports Board’s findings); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (Board’s factual determinations are reviewed for substantial evidence); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 88 (2015); *Coach Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1716 (Fed. Cir. 2012); *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000). See also *Aycock Engineering Inc. v. Airflite Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1304 (Fed. Cir. 2009) (“Substantial evidence is ‘more than a mere scintilla’ and ‘such relevant evidence as a reasonable mind would accept as adequate to support a conclusion.’ [internal cites omitted]”); *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) (“The substantial evidence standard requires the reviewing court to ask whether a reasonable person might find that the evidentiary record supports the agency’s conclusion.”).
10. See *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1459 (7th Cir. 2001). See also *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000).
11. *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1133 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016); *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000), (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.”); *Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930 (1999).
12. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000) (the “arbitrary, capricious” standard of review is the most deferential of the APA standards of review).
13. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000).
14. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000) (quoting *Consolo v. Federal Maritime Commission*, 383 U.S. 607, 620 (1966)).

15. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1836 (Fed. Cir. 2007) (citing *In re Jolley*, 308 F.3d 1317, 64 USPQ2d 1901, 1904 (Fed. Cir. 2002)).
16. *Coach Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1716 (Fed. Cir. 2012) (quoting *Consolidated Edison v. NLRB*, 305 U.S. 197, 229 (1938)); *see also Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (substantial evidence is more than a mere scintilla, but is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion); *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1829 (Fed. Cir. 2015); *In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012) (“Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence.”) (citation omitted).
17. *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).
18. *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002) (functionality is a question of fact).
19. *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990) (descriptiveness is a question of fact). *See also In re Chippendales USA*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) (“The issue of inherent distinctiveness is a factual determination made by the Board.”) (quoting *Hoover Co. v. Royal Appliances Mfg. Co.*, 238 F.3d 1357, 1359, 57 USPQ2d 1720 (Fed. Cir. 2001)); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“The Board’s placement of a mark on the fanciful-suggestive-descriptive-generic continuum is a question of fact, which this court reviews for substantial evidence.”); *In re Compagnie Generale Maritime*, 993 F.2d 841, 845, 26 USPQ2d 1652, 1654 (Fed. Cir. 1993) (“Whether a mark is primarily geographically descriptive or deceptively misdescriptive is a question of fact.”).
20. *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1397 (Fed. Cir. 2006) (similar to question of descriptiveness, issue of whether trade dress is product design is question of fact, as is inquiry into whether mark is unitary).
21. *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1829 (Fed. Cir. 2015).
22. *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1133 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016) (noting Supreme Court’s holding in *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907 (2015), in connection with a priority dispute, that “same continuing commercial impression” is a question of fact,” Federal Circuit no longer treats this question as a question of law subject to de novo review; therefore substantial evidence standard applies to continuing commercial impression in determining both priority and abandonment).
23. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1893 (Fed. Cir. 2015).
24. *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (Fed. Cir. Reviews Board’s legal conclusions de novo); *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1829 (Fed. Cir. 2015) (whether Board applied correct legal standard in assessing a mark for genericness is question of law that Court reviews de novo); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 88 (2015); *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1716 (Fed. Cir. 2012) (“We

review the Board's legal conclusions de novo ...) (citing *In re Pacer Tech.*, 338 F.3d 1348, 1349, 67 USPQ2d 1629 (Fed. Cir. 2003)); *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Glendale International Corp. v. USPTO*, 374 F. Supp. 2d 479, 75 USPQ2d 1139, 1143 (E.D. Va. 2005).

25. 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, and on grant of summary judgment, court must decide for itself whether moving party has shown that it is entitled to judgment as a matter of law); *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"); *Spraying Systems Co. v. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181, 1184 (7th Cir. 1992) (Board's grant of summary judgment is reviewed de novo).

26. See *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (conclusion regarding a likelihood of confusion is a question of law that the Federal Circuit reviews de novo, although underlying factual findings are reviewed for substantial evidence); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) ("The Board's legal conclusion receives plenary review, while the factors relevant to likelihood of confusion are reviewed for support by substantial evidence, in accordance with the criteria of the Administrative Procedure Act."); *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

27. See *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 159, 82 USPQ2d 1414, 1429 (2nd Cir. 2007) (under general principles of administrative law deference is due to the Board's interpretation of the statute the agency is charged with administering); *Star Industries Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 75 USPQ2d 1098, 1102 n.2 (2nd Cir. 2005); *International Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 66 USPQ2d 1705, 1719-20 (4th Cir. 2003); *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997) ("[T]his court defers to the agency's reasonable statutory interpretation."); *Eastman Kodak Co. v. Bell & Howell Document Management Prods., Co.*, 994 F.2d 1569, 26 USPQ2d 1912, 1915-16 (Fed. Cir. 1993) (applying *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984) to a decision of the Board, which is treated as if it were the "agency," and holding the Board's interpretation of an ambiguous provision of the trademark statute reasonable, rather than undertaking a de novo interpretation of law); *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 634, 29 USPQ2d 1231, 1243 (7th Cir. 1993) (affording *Chevron* deference to the Board's interpretation of the Lanham Act). *But see In re Save Venice New York Inc.*, 259 F.3d 1346, 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); *In re International Flavors & Fragrances, Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1515 (Fed. Cir. 1999).

28. See *Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1639 (Fed. Cir. 2003).

29. *Nationstar Mortgage, LLC v. Ahmad*, \_\_\_ F. Supp. 3d \_\_\_, No. 1:14-cv-1751, 2015 WL 9274920, at \*5 (E.D. Va. Dec. 17, 2015), (citing *Nationstar Mortgage, LLC v. Ahmad*, 112 UPQ2d 1361 (TTAB 2014)), appeal filed, No. 16-1422 (4th Cir. Apr. 14, 2016).

## 906.02 Petition To Director

In reviewing non-final rulings of the Board, the Director will exercise supervisory authority under [37 CFR § 2.146 \(a\)\(3\)](#) and reverse the Board's ruling only where there is a clear error or abuse of discretion. [Note 1.]

### NOTES:

1. 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); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r 1990).