

# Chapter 900 REVIEW OF DECISION OF BOARD

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## **901 Appeals—In General**

**Trademark Act § 21** , 15 U.S.C. § 1071 *Appeal to courts.*

(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 of this title or section 1141k of this title,, an applicant for renewal, or a registrant subject to an ex parte expungement proceeding or an ex parte reexamination proceeding, 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 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. ...

**(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, except for a registrant subject to an ex parte expungement proceeding or an ex parte reexamination proceeding, 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) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(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. 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.

(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.

**37 C.F.R. § 2.145 Appeal to court and civil action.**

**(a) For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.**

(1) An applicant for registration, a registrant in an ex parte expungement or reexamination proceeding, any party to an interference, opposition, or cancellation, 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 or section 71 of the Act, or filed an application for renewal under section 9 of the Act, and is dissatisfied with the decision of the Director (§§ 2.165 and 2.184 and § 7.40 of this chapter), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request

*reconsideration before filing any such appeal; however, any request to reconsider the decision must be made before filing a notice of appeal.*

(2) *In all appeals under section 21(a), the appellant must take the following steps:*

(i) *File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA;*  
and

(iii) *Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.*

(3) ***The following requirements must also be satisfied:***

(i) *The notice of appeal shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.*

(ii) *In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.*

\* \* \* \*

(b) ***For a notice of election under section 21(a)(1) to proceed under section 21(b) of the Act.***

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

(2) *If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:*

(i) *File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA;*  
and

(iii) *Serve the notice of election as provided in § 2.119.*

(c) ***For a civil action under section 21(b) of the Act.***

(1) *Any person who may appeal to the United States Court of Appeals for the Federal Circuit (paragraph (a) of this section), except for a registrant subject to an ex parte expungement or reexamination proceeding, may have remedy by civil action under section 21(b) of the Act. It is unnecessary to request reconsideration before filing any such civil action; however, any request to reconsider the decision must be made before filing a civil action.*

(2) *Any applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act must serve the summons and complaint pursuant to Rule 4(i) of the Federal Rules of Civil Procedure with the copy to the Director addressed to the Office of the General Counsel as provided in § 104.2 of this chapter. A copy of the complaint must also be filed with the Trademark Trial and Appeal Board via ESTTA.*

(3) *The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.*

(d) **Time for appeal or civil action.**

(1) **For an appeal under section 21(a).** *The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) **For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

(3) **For a civil action under section 21(b).** *A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(4) **Time computation.**

(i) *If a request for rehearing or reconsideration or modification of the Board 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 no later than sixty-three (63) days after action on the request.*

(ii) **Holidays.** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, 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 the District of Columbia pursuant to § 2.196.*

\* \* \* \*

**Please Note:** Effective January 14, 2017, [37 C.F.R. § 2.145](#) was reorganized and reworded to improve the clarity and structure of the rule and to align the provisions with the analogous rules governing judicial review of Patent Trial and Appeal Board decisions in 37 C.F.R. part 90. For a detailed summary of the amendments, see MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69969-70 (Oct. 7, 2016).

Effective December 18, 2021, 37 C.F.R. § 2.145 was amended to implement provisions of the Trademark Modernization Act of 2020 (TMA). For a detailed summary of the amendments, see CHANGES TO IMPLEMENT PROVISIONS OF THE TRADEMARK MODERNIZATION ACT OF 2020, 86 Fed. Reg. 64300, 64320 (Nov. 17, 2021).

## 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. [Note 1.] 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 2.]

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 3.] 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 4.]

The Federal Circuit is often referred to in Board decisions as “our primary reviewing court.” [Note 5.]

## NOTES:

1. *Snyder's Lance, Inc. v. Frito Lay North America, Inc.*, 991 F.3d 512, 2021 USPQ2d 318, at \*16 (4th Cir. 2021) (“[A] party seeking review of a subsequent Trademark Board decision may seek review in either the Federal Circuit or the district court, even if the Trademark Board's initial decision was reviewed by the Federal Circuit.”); *Gillette Co. v. “42” Products Ltd.*, 435 F.2d 1114, 168 USPQ 197, 199-200 (9th Cir. 1970) (where dissatisfied party seeking appeal of unfavorable decision of Board on remand was not the dissatisfied party who filed the earlier appeal to the Court of Patent Appeals, party was not foreclosed from appealing to the district court by way of civil action).

2. Trademark Act § 21, [15 U.S.C. § 1071](#); [37 C.F.R. § 2.145](#). See *Snyder's Lance, Inc. v. Frito Lay North America, Inc.*, 991 F.3d 512, 2021 USPQ2d 318, at \*2 (4th Cir. 2021) (“Under the Lanham Act, [plaintiffs] could seek review of the Trademark Board's 2014 decision in either the Federal Circuit (pursuant to 15 U.S.C. § 1071(a)) or a district court (pursuant to § 1071(b)).”); *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*, 136 S. Ct. 1376, (2016); *Jean Alexander Cosmetics, Inc. v. L'Oreal USA, Inc.*, 458 F.3d 244, 80 USPQ2d 1470, 1479 (3d Cir. 2006) (discussing prevailing party's ability to appeal Board decision), *cert. denied*, 127 S. Ct. 1878 (2007); *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); *RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591 (E.D. Va. 2019) (a party to an opposition proceeding dissatisfied with the result of a TTAB decision may either appeal that decision to the Federal Circuit or commence a de novo civil action in a federal district court where it is permitted to conduct discovery and submit new evidence and testimony), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Combe Inc. v. Dr. August Wolff GmbH & Co.*, 382 F. Supp. 3d 429, 443 (E.D. Va. 2019) (in a § 1071(b) action, “the parties to the action have the right to admit the PTO record as well as any new evidence not presented to the PTO that is admissible under the Federal Rules of Evidence and Civil Procedure”), *aff'd*, 851 F. App'x. 357 (4th Cir. 2021); *Product Source International, LLC v. Nahshin*, 112 F. Supp. 3d 383, 387 (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).

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

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

5. See, e.g., *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at \*5 (TTAB 2019) (“Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit ...”), *cancellation order vacated by default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *In re Ocean Technology, Inc.*, 2019 USPQ2d 450686, at \*5 (TTAB 2019) (“The Board and our primary reviewing court (the Federal Circuit and its predecessor the Court of Customs and Patent Appeals)...”); *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, 1506 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 set forth in Fed. R. App. P. 21 and Fed. Cir. R. 21 may not be used as a substitute for the appeal procedure specified in Trademark Act § 21, [15 U.S.C. § 1071](#). [Note 9.]

Issues not presented to or passed on by the Board, and raised for the first time on appeal to the Federal Circuit, are generally, absent exceptional circumstances, considered waived. [Note 10.]

## NOTES:

1. See *Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564-65 (Fed. Cir. 1989) (en banc) (Federal Circuit may review only final decisions of TTAB); *R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 204 USPQ 195, 197 (CCPA 1979) (the word “decision” in the statute means “final decision”); *Prospector Capital Partners, Inc. v. DTTM Operations LLC*, 123 USPQ2d 1832, 1834-35 (TTAB 2017) (Petitioner’s request seeking judicial review of the Board’s interlocutory order is premature); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm’r 1986) (term “decision” has repeatedly been held to mean “final decision”).

2. See *Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (en banc) (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); *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at \*12 n.70 (TTAB 2020) (finding that opposer had standing to oppose was jurisdictional, not a final adjudication of the merits, and not appealable); *Prospector Capital Partners, Inc. v. DTTM Operations LLC*, 123 USPQ2d 1832, 1836 (TTAB 2017) (Board’s dismissal of petition to cancel allowing petitioner to file amended petition to remedy identified defects is interlocutory in nature and non-final; Board does not have the authority to order a “transfer” of the proceeding to district court for judicial review); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 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., *Fred Beverages, Inc. v. Fred's Capital Management Co.*, 605 F.3d 963, 94 USPQ2d 1958, 1959 (Fed. Cir. 2010) (after judgment entered granting petition to cancel sought against single class of multi-class registration, decision denying motion for leave to amend to seek cancellation against additional classes 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); *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); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 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 *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at \*12 n.70 (TTAB 2020) (finding that opposer had standing to oppose was jurisdictional, not a final adjudication of the merits, and not appealable); *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) (en banc) (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). *Snyder's Lance, Inc. v. Frito Lay North America, Inc.*, 991 F.3d 512, 2021 USPQ2d 318, at \*16 (4th Cir. 2021) ("[A] party seeking review of a subsequent Trademark Board decision may seek review in either the Federal Circuit or the district court, even if the Trademark Board's initial decision was reviewed by the Federal Circuit."); *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698, 1701 (9th Cir. 1991); *Truck-Lite Co., LLC v. Grote Industries, Inc.*, 2019 USPQ2d 119235, at \*9 (W.D.N.Y. 2019) (for judicial economy, court exercised its discretion and applied pendent personal jurisdiction where the anchor claims are a combination of federal and state law claims and the pendent claim is a federal claim seeking de novo review of a TTAB decision, since all of the claims derive from a common nucleus of operative facts).

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). *See also In re Tam*, slip op. 16-121 unpublished (Fed. Cir. March 30, 2016) (applicant’s petition for writ of mandamus to instruct Director to publish his application denied, no clear abuse of discretion in Director’s suspension of the matter pending possible further proceedings).

10. *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at \*3-4 (Fed. Cir. 2019) (party waived issue by not raising it in the Board proceeding; “[g]enerally, federal appellate courts do not consider issues ‘not passed upon below’ or entertain arguments not presented to the lower tribunal”).

### **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 C.F.R. § 2.129\(d\)](#). *See also RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1809 n.50, 1816 (TTAB 2018) (judgment entered in favor of applicant subject to establishment of constructive use; Board decision contingent on registration, if and when registration is issued appropriate action is taken to terminate the proceeding), *aff’d*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Kraft Group LLC v. William A. Harpole*, 90 USPQ2d 1837, 1842 (TTAB 2009) (judgment in favor of applicant subject to establishment of constructive use); *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 C.F.R. § 2.129\(d\)](#); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018), *aff’d*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *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 C.F.R. § 2.145](#) *Appeal to court and civil action.*

(a) ***For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.***

(1) *An applicant for registration, a registrant in an ex parte expungement or reexamination proceeding, any party to an interference, opposition, or cancellation, 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 or section 71 of the Act, or filed an application for renewal under section 9 of the Act, and is dissatisfied with the decision of the Director (§§ 2.165 and 2.184 and § 7.40 of this chapter), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration before filing any such appeal; however, any request to reconsider the decision must be made before filing a notice of appeal.*

(2) *In all appeals under section 21(a), the appellant must take the following steps:*

(i) *File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA;*  
*and*

(iii) *Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.*

(3) ***The following requirements must also be satisfied:***

(i) *The notice of appeal shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.*

(ii) *In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.*

**37 C.F.R. § 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

*(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 C.F.R. § 2.145\(d\)](#). [Note 2.] See [TBMP § 902.02](#). The certificate of mailing procedure described in [37 C.F.R. § 2.197](#), and the Priority Mail Express® procedure described in [37 C.F.R. § 2.198](#), are available for filing a notice of appeal with the Director. However, the notice of appeal filed with the Board must be through ESTTA. 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 or order 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 C.F.R. § 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.]

Notices of appeal must be filed with the Board through ESTTA. For appeals of ex parte decisions, the applicant or registrant should select the ESTTA button "Appeal to CAFC"; for appeals of inter partes decisions, the appellant should select the button "Review of Order or Decision of the Board." For information on ESTTA filing of notices of appeal in civil actions see [TBMP § 903.01](#).

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 with the Director, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the Director, see 37 C.F.R. § 104.2, [37 C.F.R. § 2.190](#), [37 C.F.R. § 2.195](#), [37 C.F.R. § 2.197](#), and [37 C.F.R. § 2.198](#).

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

For filing notices of appeal in the Court of Appeals for the Federal Circuit, appellants must comply with the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for 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.]

The Federal Circuit Rules and Forms can be found on the Court's website at: [www.cafc.uscourts.gov](http://www.cafc.uscourts.gov).

Note that effective July 1, 2020, the Federal Circuit has adopted amendments to Federal Circuit Rules of Practice and the Federal Circuit Attorney Discipline Rules. These amendments apply to all cases and documents filed or pending on or after July 1, 2020 unless otherwise ordered.

#### NOTES:

1. [37 C.F.R. § 2.145\(a\)](#); Fed. Cir. R. 15.
2. Trademark Act § 21(a)(2), [15 U.S.C. § 1071\(a\)\(2\)](#); [37 C.F.R. § 2.145\(d\)](#).
3. [37 C.F.R. § 2.145\(a\)\(3\)](#).
4. [37 C.F.R. § 2.145\(a\)\(3\)](#).
5. See [37 C.F.R. § 2.145\(a\)\(3\)\(ii\)](#).
6. See 37 C.F.R. § 104.2.
7. See [37 C.F.R. § 2.145\(a\)\(2\)\(iii\)](#).
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 C.F.R. § 2.145\(d\)](#) Time for appeal or civil action.

(1) **For an appeal under section 21(a).** The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(2) **For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.** The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.

(3) **For a civil action under section 21(b).** A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint

or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(4) **Time computation.**

(i) *If a request for rehearing or reconsideration or modification of the Board 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 no later than sixty-three (63) days after action on the request.*

(ii) **Holidays.** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, 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 the District of Columbia pursuant to § 2.196.*

37 C.F.R. § 2.145(e) **Extension of time.**

(1) *The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:*

(i) *Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or*

(ii) *Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.*

(2) *The request must be filed as provided in § 104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.*

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit ("Federal Circuit") is sixty-three (63) days from the date of the Board decision which is the subject of the appeal. [Note 1.] 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 2.] 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 3.]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in [37 C.F.R. § 2.127\(b\)](#), [37 C.F.R. § 2.129\(c\)](#), or [37 C.F.R. § 2.144](#), or within any extension of time granted thereunder, the time for filing an appeal expires sixty-three (63) days after action on the request. [Note 4.] 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 5.] 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) 63 days from the date of the Board decision which is the subject of the appeal, whichever is later. [Note 6.]

The certificate of mailing procedure described in [37 C.F.R. § 2.197](#), and the Priority Mail Express® procedure described in [37 C.F.R. § 2.198](#), are available for filing a notice of appeal or a notice of cross-appeal with the Director. However, the notice of appeal filed with the Board must be through ESTTA.

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 7.] A request for an extension of time to file an appeal should be addressed to the attention of the Office of the General Counsel, as provided in 37 C.F.R. § 104.2, and directed to the attention of the Solicitor. *See* [37 C.F.R. § 2.145\(e\)\(2\)](#).

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 8.]

An appellant that has received an order to show cause from the clerk of the Federal Circuit may file a request under [37 C.F.R. § 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 General Counsel and directed to the attention 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 C.F.R. § 2.145\(d\)\(1\)](#). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018) ("The time for filing an appeal or for commencing a civil action will run from the date of this decision."), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021).
2. [37 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#).
3. [37 C.F.R. § 2.129\(d\)](#); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021). *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).
4. [37 C.F.R. § 2.145\(d\)\(4\)](#).
5. [37 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#).
6. [37 C.F.R. § 2.145\(d\)\(1\)](#).
7. [37 C.F.R. § 2.145\(e\)](#).
8. *See* Fed. Cir. R. 15(b)(2).

### 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 § 903.06](#).



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. [Note 2.] 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 C.F.R. § 2.145\(b\)\(1\)](#) (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). See *Snyder's Lance, Inc. v. Frito Lay North America, Inc.*, 991 F.3d 512, 2021 USPQ2d 318, at \*16 (4th Cir. 2021) (“[A] party seeking review of a subsequent Trademark Board decision may seek review in either the Federal Circuit or the district court, even if the Trademark Board’s initial decision was reviewed by the Federal Circuit.”).

2. [37 C.F.R. § 2.145\(b\)\(2\)](#), [37 C.F.R. § 2.145\(d\)\(2\)](#).

### 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 of this title or section 1141k of this title, an applicant for renewal, or a registrant subject to an ex parte expungement proceeding or an ex parte reexamination proceeding, 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 C.F.R. § 2.145\(b\)\(2\)](#) *If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:*

- (i) *File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*
- (ii) *File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA; and*
- (iii) *Serve the notice of election as provided in § 2.119.*

\* \* \* \*

(d)(2) **For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

\* \* \* \*

When a defeated party in an inter partes proceeding before the Board takes an appeal to the United States Court of Appeals for the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file a notice with the Director as provided in 37 C.F.R. § 104.2 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 Director, 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 procedure described in [37 C.F.R. § 2.197](#), and the Priority Mail Express® procedure described in [37 C.F.R. § 2.198](#), are available for filing a notice of election. A copy of the notice must be filed with the Board through ESTTA and be served on every other party to the proceeding, in the manner prescribed in [37 C.F.R. § 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 C.F.R. § 2.145\(b\)\(2\)](#).
2. [37 C.F.R. § 2.145\(b\)\(2\)\(ii\)](#) and [37 C.F.R. § 2.145\(b\)\(2\)\(iii\)](#).
3. Fed. Cir. R. 15(e).
4. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 C.F.R. § 2.145\(d\)\(2\)](#).
5. [37 C.F.R. § 2.145\(d\)\(3\)](#).

#### 902.05 Information Concerning Times Specified In 37 C.F.R. § 2.145

[37 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#) **Holidays.** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, 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 the District of Columbia pursuant to § 2.196.*

In [37 C.F.R. § 2.145](#) (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days. 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 C.F.R. § 2.145\(d\)\(2\)\(ii\)](#).

## 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 sends a copy of the certified list to every party to the proceeding. [Note 2.]

When the Federal Circuit receives the notice of appeal, the Court docket the appeal, and gives notice to all parties of the date of docketing, assigned appeal number, and the short case name. [Note 3.] The appellant's time in which to file its initial brief runs from the date of service of the certified list or index pursuant to Federal Circuit Rule 17(c). [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)(3).
4. Fed. Cir. R. 31(a)(1)(B). For information concerning briefing schedules in consolidated cases in which more than one set of parties has appealed, see Fed. Cir. R. 31(a)(1)(D).

## 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 C.F.R. § 2.145\(b\)\(1\)](#) *Any applicant or registrant in an ex parte case who takes an appeal to the United States 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.] A registrant involved in an ex parte expungement or reexamination proceeding may appeal a decision of the Board only to the United States Court of Appeals for the Federal Circuit. [Note 2.]

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 3.]

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 4.]

#### NOTES:

1. Trademark Act § 21(a)(1), [15 U.S.C. § 1071\(a\)\(1\)](#); [37 C.F.R. § 2.145\(b\)\(1\)](#).
2. Trademark Act § 21(b)(1); [15 U.S.C. § 1071\(b\)\(1\)](#).
3. Trademark Act § 21(a)(3), [15 U.S.C. § 1071\(a\)\(3\)](#).
4. *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 C.F.R. § 2.145\(c\)\(3\)](#) *The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.*

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 no later than five business days after filing the complaint in the district court. The notice to the Board must be filed through ESTTA. 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](#). When review of a decision in ex parte appeal is sought by way of a civil action in district court, the applicant should select the ESTTA button “Appeal to District Court.” For review of an inter partes decision, the party should select the ESTTA button “Review of Order or Decision of the Board.”

#### NOTES:

1. See [37 C.F.R. § 2.145\(c\)\(3\)](#).

### 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) and a copy must be filed with the Board through ESTTA. [Note 3.] When review is sought for an ex parte decision, the party should select the ESTTA button “Appeal to District Court.” 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.” 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.]

A registrant involved in an ex parte expungement or reexamination proceeding may appeal a decision of the Board only to the United States Court of Appeals for the Federal Circuit. [Note 5.]

#### 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\(b\)\(3\)](#), [37 C.F.R. § 2.145\(c\)\(2\)](#).
4. See [37 C.F.R. § 104.2](#); Fed. R. Civ. P. 4(i).
5. Trademark Act § 21(b)(1), [15 U.S.C. § 1071\(b\)\(2\)](#).

### 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), *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, except for a registrant subject to an ex parte expungement proceeding or an ex parte reexamination proceeding, 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 C.F.R. § 2.145](#)

##### (d) **Time for appeal or civil action.**

(1) **For an appeal under section 21(a).** *The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) **For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

(3) **For a civil action under section 21(b).** *A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

##### (4) **Time computation.**

(i) *If a request for rehearing or reconsideration or modification of the Board 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 no later than sixty-three (63) days after action on the request.*

(ii) **Holidays.** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, 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 the District of Columbia pursuant to § 2.196.*

##### (e) **Extensions of time.**

(1) *The Director, or the Director’s designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:*

(i) *Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or*

(ii) *Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.*

(2) *The request must be filed as provided in § 104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.*

The time for commencing a civil action under Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#), is sixty-three (63) days from the date of the Board decision of which review is sought. [Note 1.] 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 2.] A civil action is commenced by the filing of a complaint with the court. [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 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 4.]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in [37 C.F.R. § 2.127\(b\)](#), [37 C.F.R. § 2.129\(c\)](#), or [37 C.F.R. § 2.144](#), or within any extension of time granted thereunder, the time for commencing a civil action expires sixty-three (63) days after action on the request. [Note 5.] 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 6.] 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) sixty-three (63) from the date of the Board decision which is the subject of the civil action, whichever is later. [Note 7.]

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 8.] A request for an extension of time to file an appeal should be addressed to the Office of the General Counsel, as provided in 37 C.F.R. § 104.2, and directed to the attention of the Solicitor. *See* [37 C.F.R. § 2.145\(e\)\(2\)](#).

## NOTES:

1. Trademark Act § 21(b)(1), [15 U.S.C. § 1071\(b\)\(1\)](#) (not less than 60 days); [37 C.F.R. § 2.145\(d\)\(3\)](#) (63 days). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018) ("The time for filing an appeal or for commencing a civil action will run from the date of this decision."), *aff'd*, 377 F. Supp. 3d 588, (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021).

2. [37 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#).

3. Fed. R. Civ. P. 3.

4. [37 C.F.R. § 2.129\(d\)](#). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018) (judgment entered in favor of applicant subject to applicant's establishment of constructive use), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021). *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (same).

5. [37 C.F.R. § 2.145\(d\)\(4\)](#).

6. [37 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#).
7. [37 C.F.R. § 2.145\(d\)\(3\)](#).
8. [37 C.F.R. § 2.145\(e\)](#).

### 903.05 Information Concerning Times Specified In 37 C.F.R. § 2.145

[37 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#) **Holidays.** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, 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 the District of Columbia pursuant to § 2.196.*

In [37 C.F.R. § 2.145](#) (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days. 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 C.F.R. § 2.145\(d\)\(4\)\(ii\)](#).

### 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 C.F.R. § 2.145\(b\)\(1\)](#) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Trademark Act § 21(b)). See *Snyder's Lance, Inc. v. Frito Lay North America, Inc.*, 991 F.3d 512, 2021 USPQ2d 318, at \*16 (4th Cir. 2021) (“[A] party seeking review of a subsequent Trademark Board decision may seek review in either the Federal Circuit or the district court, even if the Trademark Board’s initial decision was reviewed by the Federal Circuit.”).
2. See *Belmora LLC v. Bayer Consumer Care AG*, 84 F. Supp. 3d 490, 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*, 819 F.3d 697 (4th Cir. 2016), *cert denied*,

137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp. 3d 477 (E.D. Va. 2018), *vacated and remanded on other grounds*, 987 F.3d 284, 2021 USPQ2d 126 (4th Cir. 2021), *cert. denied*, 142 S. Ct. 483 (2021).

### 903.07 Special Provisions For Ex Parte Civil Actions

**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.”). “All the expenses of the proceeding,” including but not limited to expert witness fees, copying, and travel, 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 and a copy of the notice of appeal must be filed with the Board through ESTTA as indicated in [37 C.F.R. § 2.145\(a\)\(2\)\(ii\)](#).

A registrant involved in an ex parte expungement or reexamination proceeding may appeal a decision of the Board only to the United States Court of Appeals for the Federal Circuit. [Note 2.]

#### NOTES:

1. Trademark Act § 21(b)(3), [15 U.S.C. § 1071\(b\)\(3\)](#). *See, e.g., Sandvik Aktiebolag v. Samuels*, 20 USPQ2d 1879, 1880 (D.D.C. 1991) (USPTO’s expert witness fees must be reimbursed); *Realvirt, LLC v. Lee*, 220 F. Supp. 3d 695 (E.D. Va. 2016), *vacated as to attorneys’ fees*, 734 F. App’x 754 (Fed. Cir. Aug. 14, 2018).

**Please Note:** The U.S. Supreme Court in *Peter v. NantKwest, Inc.*, \_\_\_U.S. \_\_\_, 140 S. Ct. 365, 2019 USPQ2d 474054, at \*7 (2019), *aff’g NantKwest, Inc. v. Iancu*, 898 F.3d 1177, 127 USPQ2d 1497 (Fed. Cir. 2018) (en banc), held that the USPTO, in a civil action under the similar expense payment provisions of 35 U.S.C. § 145, cannot recover the salaries of its legal personnel, and in effect, implicitly rejected the Fourth Circuit’s holding in *Shammas v. Focarino*, 784 F.3d 219, 114 USPQ2d 1489, 1492 (4th Cir. 2015), *cert. denied sub nom. Shammas v. Hirschfeld*, 136 S. Ct. 1376 (2016), that awarded legal fees under the expense payment provision of [15 U.S.C. § 1071\(b\)\(3\)](#). In *Hyatt v. Hirshfeld*, 16 F.4th 855, 858-866 (Fed. Cir. 2021), the Federal Circuit affirmed the district court’s denial of the USPTO’s request for expert witness fees, finding that the phrase “[a]ll the expenses of the proceedings” in 35 U.S.C. § 145 does not invoke expert witness fees with the clarity required to overcome the American Rule presumption against fee-shifting.

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

## **904 Access To Record During Appeal**

### **904.01 Access During Appeal To Federal Circuit**

Board file records are maintained electronically and may be accessed, even during an appeal, through TTABVUE. When it deems necessary, the Federal Circuit may, on motion or sua sponte, order transmission (via the Office of the Solicitor) of certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal. [Note 1.]

Application and registration file records are maintained electronically by the USPTO and may be accessed, even during an appeal, through TSDR.

Nonconfidential submissions 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. To inspect or copy one of the paper files, contact the National Archives and Records Administration, [www.archives.gov/research](http://www.archives.gov/research). 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**

Board file records are maintained electronically and may be accessed through TTABVUE. To the extent a certified copy is required, it will be transmitted (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.

Nonconfidential submissions 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. To inspect or copy one of the paper files contact the National Archives and Records Administration, [www.archives.gov/research](http://www.archives.gov/research). 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 district 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.



**NOTES:**

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 C.F.R. § 2.146 *Petitions to the Director.***

(a) *Petition may be taken to the Director in a trademark case:*

(1) *From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(a) and (b);*

(2) *In any case for which the Act of 1946, or Title 35 of the United States Code, or parts 2, 3, 6, and 7 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 parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations; or*

(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, or expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.*

(c)(1) *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 verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.*

(2) *A petition requesting reinstatement of a registration cancelled in whole or in part for failure to timely respond to an Office action issued in an expungement and/or reexamination proceeding must include a response to the Office action, signed in accordance with § 2.193, or an appeal.*

(d) *Unless a different deadline is specified elsewhere in this chapter, a petition under this section must be filed by not later than:*

(1) *Two months after the issue date of the action, or date of receipt of the filing, from which relief is requested; or*

(2) *Where the applicant or registrant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the action, or where no action was issued, the petition must be filed by not later than:*

(i) *Two months of actual knowledge of the abandonment of an application and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part;*

(ii) *Where the registrant has timely filed an affidavit of use or excusable non-use under Section 8 or 71 of the Act, or a renewal application under Section 9 of the Act, two months after the date of actual*



*knowledge of the cancellation/expiration of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired; or*

*(iii) Two months after the date of actual knowledge of the denial of certification of an international application under § 7.13 of this chapter and not later than six months after the trademark electronic records system indicates that certification is denied; or*

*(iv) Where an expungement or reexamination proceeding has been instituted under § 2.92, two months after the date of actual knowledge of the cancellation of goods and/or services in a registration and not later than six months after the date the trademark electronic record system indicates that the goods and/or services are cancelled.*

*(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed no later than fifteen days after the issue date of the grant or denial of the request. A petition from the grant of a request must 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 must 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 by not later than fifteen days after 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 may be filed.*

*(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed by not later than thirty days after the issue date of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, by not later than fifteen days after the date of service of the petition. Petitions and responses to petitions, and any documents 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(a) and (b) and 2.65(a) are applicable to an ex parte application.*

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

*(i) If the Director denies a petition, the petitioner may request reconsideration, if:*

*(1) The petitioner files the request by not later than:*

*(i) Two months after the issue date of the decision denying the petition; or*

*(ii) Two months after the date of actual knowledge of the decision denying the petition and not later than six months after the issue date of the decision where the petitioner declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the decision; and*

*(2) The petitioner pays a second petition fee under § 2.6.*

**37 C.F.R. § 2.147 *Petition to the Director to accept a paper submission.***

\* \* \* \*

***(b) Certain paper submissions timely filed before the date of a filing deadline .***

*(1) An applicant, registrant, or petitioner for cancellation may file a petition to the Director under this section, requesting acceptance of any of the following submissions that was timely submitted on paper and otherwise met the minimum filing requirements, but not processed or examined by the Office because it was not submitted electronically pursuant to § 2.21(a), § 2.23(a), or § 2.111(c)(1), and the applicant, registrant,*

*or petitioner for cancellation is unable to timely resubmit the document electronically by the deadline:* • \*  
\* \* \*

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\(a\)](#) (What May Be Appealed).

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 no later than 30 days after the issue 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, no later than 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 materials accompanying a petition or response, must be served on every adverse party in the manner prescribed in [37 C.F.R. § 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 C.F.R. § 2.146\(e\)\(1\)](#), and [TBMP § 211.03](#).

A petition on any matter not otherwise specifically provided for must be filed no later than two months after the issue 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 C.F.R. § 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 a verified statement, 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 C.F.R. § 2.146](#). Cf. [TMEP Chapter 1700](#). For information on filing a Petition to the Director to file on paper a petition to cancel on the fifth year anniversary date of the registration see [37 C.F.R. § 2.147\(b\)\(1\)](#).

**NOTES:**

1. See [37 C.F.R. § 2.146](#); *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (grant of summary judgment motion although essentially a procedural decision is appealable not petitionable in view of its substantial substantive effect); *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971) (whether Board abused discretion in denying motion to amend description of services was a matter to be determined by Commissioner, not the Court since not part of the central issue), *cert. denied*, 92 S. Ct. 269 (1971); *Jack Lenor Larsen Inc. v. Chas. O. Larsen Co.*, 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (petition to Director seeking reopening of cancellation proceeding is inappropriate as petition because it seeks review of final decision of Board); *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent Inc.*, 60 USPQ2d 1703 (Comm'r 2000) (petition from Board's finding that registration issued inadvertently and to direct Board to dismiss opposition granted in view of defect in request for extension of time to oppose); *Kimberly Clark Corp. v. Paper Converting Industry Inc.*, 21 USPQ2d 1875 (Comm'r 1991) (decision denying motion to dismiss opposition as untimely filed reviewed by petition); *Miss Nude Florida, Inc. v. Drost*, 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 C.F.R. § 2.146\(b\)](#) (questions of substance arising during the ex parte prosecution of applications, or expungement or reexamination of registrations, including, but not limited to, questions arising under Trademark Act §§ 2, 3, 4, 5, 6, 16A, 16B, and 23, 15 U.S.C. §§ 1052, 1053, 1054, 1055, 1056, 1066a, 1066b, and 1091, are not appropriate subject matter for Petition to the Director).

2. [37 C.F.R. § 2.146\(e\)\(2\)](#).

3. [37 C.F.R. § 2.146\(d\)](#).

4. [37 C.F.R. § 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 C.F.R. § 2.146\(c\)\(1\)](#). 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 C.F.R. § 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 fact finding 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 Administrative Procedure Act (APA), 5 U.S.C. § 706(2), 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]; whether applicant had a bona fide intent to use the mark in commerce [Note 23]; whether a mark is merely descriptive or generic [Note 24]; priority/ownership [Note 25]; and factual findings on each relevant *DuPont* factor in the likelihood of confusion analysis [Note 26]; and factual findings of a false suggestion of a connection [Note 27].

**Conclusions of law.** While the Board’s findings of fact are reviewed for substantial evidence, conclusions of law are reviewed de novo. [Note 28.]

Examples of legal conclusions that receive de novo review include whether a multi-color mark as applied to product packaging can never be inherently distinctive [Note 29], whether the Board properly granted summary judgment or a motion to dismiss, whether it was proper for the Board to consider certain types of evidence, whether the correct legal standard was used in a genericness analysis, and whether preclusion applies to bar a particular action. [Note 30.] With regard to the likelihood of confusion analysis under a Section 2(d) claim, the U.S. Court of Appeals for the Federal Circuit reviews the factual findings on each relevant *DuPont* factor for substantial evidence, but reviews the Board’s weighing of the *DuPont* factors de novo as a legal determination. [Note 31.]

The Board’s interpretations of the Trademark 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 32.] “Deference” is generally given to the USPTO’s interpretation of its own regulations. [Note 33.]

**Collateral Estoppel effect.** In *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 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 an inter partes case in which the ordinary elements of issue preclusion are met. [Note 34.] Courts, citing *B&B Hardware*, have given preclusive effect to TTAB decisions that found fraud, [Note 35], and to TTAB decisions concerning priority and likelihood of confusion [Note 36].

**Application of Board’s Trial Rules:** The Board’s interpretation of its own rules and practice set forth in the TBMP is reviewed under the arbitrary, capricious, and abuse of discretion standard. [Note 37.] Examples include whether it was procedurally improper for the Board to grant a post-trial, unconsented motion to disclaim a term and whether evidence was properly of record. [Note 38.]

## 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 Board decision is challenged by filing a civil action in district court, the parties have the right to submit further evidence and additional claims); *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); *Interprofession Du Gruyère v. U.S. Dairy Export Council*, \_\_\_ F. Supp. 3d \_\_\_, 2021 BL 500810 at \*3 (E.D. Va. Dec. 15, 2021) (“In a § 1071(b) proceeding, the parties may introduce the record the TTAB relied on and may supplement that record with additional evidence.”), appeal docketed, No. 22-1041 (4th Cir. Jan. 11, 2022); *RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591 (E.D.



Va. 2019) (a party to an opposition proceeding dissatisfied with the result of a Board decision may commence a de novo civil action in a federal district court where it is permitted to conduct discovery and submit new evidence and testimony; additional claims included trademark infringement, unfair competition and false designation of origin), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Combe Inc. v. Dr. August Wolff GmbH & Co.*, 382 F. Supp. 3d 429, 443 (E.D. Va. 2019) (in a § 1071(b) action, “the parties to the action have the right to admit the PTO record as well as any new evidence not presented to the PTO that is admissible under the Federal Rules of Evidence and Civil Procedure”), *aff'd*, 851 F. App’x 357 (4th Cir. 2021); *Truck-Lite Co., LLC v. Grote Industries, Inc.*, 2019 USPQ2d 119235, at \*1-2 (W.D.N.Y. 2019) (in addition to seeking review of Board decision, nine additional claims added); *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); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 484 (E.D. Va. 2015) (“any new evidence submitted to the court on a disputed factual question is considered de novo”; in addition to appeal of Board decision, state and federal claims added), *vacated and remanded on other grounds*, 987 F.3d 284, 2021 USPQ2d 126 (4th Cir. 2021), *cert denied*, 142 S. Ct. 483 (2021).

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); *Interprofession Du Gruyère v. U.S. Dairy Export Council*, \_\_\_ F. Supp. 3d \_\_\_, 2021 WL 6286234, at \*2 (E.D. Va. Dec. 15, 2021) (“When new evidence is offered in a § 1071(b) proceeding, district courts ‘must make de novo factual findings that take account of both the new evidence and the administrative record.’”) (quoting *Kappos v. Hyatt*, 566 U.S. 431, 446 (2012)), *appeal docketed*, No. 22-1041 (4th Cir. Jan. 11, 2022); *RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591-92 (E.D. Va. 2019) (discussing de novo and substantial evidence standards of review in § 1071(b) proceedings), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 484 (E.D. Va. 2018) (“any new evidence submitted to the court on a disputed factual question is considered de novo”), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021), *cert denied*, 142 S. Ct. 483 (2021).

*See also Kappos v. Hyatt*, 132 S. Ct. 1690, 102 USPQ2d 1337, 1344 (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 RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591-92 (E.D. Va. 2019) (discussing substantial evidence standard of review in § 1071(b) proceedings), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 484 (E.D. Va. 2018) (“factual findings made by the Board which are untouched by new evidence presented to the court are reviewed under the substantial evidence standard mandated by the Administrative Procedure Act”), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021), *cert denied*, 142 S. Ct. 483 (2021). *See also CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001).

5. *See RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 595 (E.D. Va. 2019) (granting summary judgment for defendant on additional claims and affirming Board decision), *aff'd*, 986



F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 488 (E.D. Va. 2018) (dismissing parties additional claims on summary judgment and affirming Board decision), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021), *cert denied*, 142 S. Ct. 483 (2021). *See also 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, 119 S. Ct. 1816, 50 USPQ2d 1930, 1936 (1999) (rejecting the argument that the “two paths” for review would create “an anomaly” in the standard of review). *See RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 592 (E.D. Va. 2019) (“If no new evidence is admitted that relates to a disputed fact question, the reviewing court must apply the APA substantial evidence standard to the PTO’s findings of fact on that issue.”), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 483-84 (E.D. Va. 2018) (“[F]actual findings made by the Board which are untouched by new evidence presented to the court are reviewed under the substantial evidence standard mandated by the Administrative Procedure Act.”), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021), *cert denied*, 142 S. Ct. 483 (2021); *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 1769, 1773 (Fed. Cir. 2000).

9. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at \*3 (Fed. Cir. 2022) (“To the extent that the Board’s factual findings . . . are at issue, we review them for substantial evidence.”); *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (court reviews legal conclusions de novo and finding of fact for substantial evidence); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (court reviews factual findings for substantial evidence); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1576 (Fed. Cir. 2015) (same); *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 1769, 1775 (Fed. Cir. 2000). *But see Fred Beverages, Inc. v. Fred’s Capital Management Co.*, 605 F.3d 963, 94 USPQ2d 1958, 1960 (Fed. Cir. 2010) (“Where an agency departs from established precedent without a reasoned explanation, its decision will be vacated as arbitrary and capricious.”).

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 1769, 1775 (Fed. Cir. 2000).

11. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at \*3 (Fed. Cir. 2022) (“Substantial evidence ‘means only[] ‘such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.’”) (quoting *Biestek v. Berryhill*, 139 S. Ct. 1148, 1154 (2019)); *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930, 1937 (1999); *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at \*3 (Fed. Cir. 2019) (“Substantial evidence is “such relevant evidence [that] a reasonable

mind would accept as adequate to support a conclusion.”) (quoting *In re i.am.symbolic LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017)); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (Board’s factual findings reviewed for substantial evidence, which requires ‘such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.’) (quoting *Consolidated Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229-30 (1938); *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 1769, 1773 (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.”)).

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.”).

12. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769, 1773 (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 1769, 1773 (Fed. Cir. 2000).

14. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769, 1773 (Fed. Cir. 2000) (quoting *Consolo v. Federal Maritime Commission*, 383 U.S. 607, 620 (1966)).

15. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (“The [TTAB’s] finding[s] may be supported by substantial evidence even if two inconsistent conclusions can be drawn from the evidence.”) (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (citation omitted).”); *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. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (citing *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal quotation marks, citation, and subsequent history omitted)); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (quoting *Consolidated Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229-30 (1938)); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Consolidated Edison v. NLRB*, 305 U.S. 197, 229 (1938)); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017); *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)); *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *In re Mouffet*, 686 F.3d 1322, 103 USPQ2d 1219, 1224 (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. *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 2021 USPQ2d 1069, at \*12 (Fed. Cir. 2021) (“Whether a mark is descriptive is a question of fact that we review for substantial evidence.”); *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (“Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact.”) (quoting *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 102 USPQ2d 1753 (Fed. Cir. 2012)); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (“The Board’s determination that a mark is merely descriptive is a factual finding that is reviewed for support by substantial evidence.”); *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, 26 USPQ2d 1652, 1655 (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. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (“Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact.”) (citing *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 102 USPQ2d 1753 (Fed. Cir. 2012); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (whether the Board applied the correct legal standard in assessing a mark for genericness is a question of law to be reviewed de novo) (citing *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal citation and subsequent history omitted) and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (review of Board’s legal conclusions de novo and its factual determinations for substantial evidence).

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. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (“Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact.”) (citing *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 102 USPQ2d 1753 (Fed. Cir. 2012)); *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (same).

25. *Lyons v. American College of Veterinary Sports Medicine & Rehabilitation*, 859 F.3d 1023, 123 USPQ2d 1024, 1030 (Fed. Cir. 2017) (Board’s findings regarding disputed ownership of mark were supported by substantial evidence), *cert. denied*, 138 S. Ct. 366 (2017).

26. *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at \*2 (Fed. Cir. 2021) (“We review the Board’s factual findings on each relevant DuPont factor for substantial evidence, but we review the Board’s ... weighing of the DuPont factors de novo.”).

27. *Piano Factory Group, Inc. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 2021 USPQ2d 913, at \*12 (Fed. Cir. 2021) (“We review the Board’s factual findings on each of those three issues for substantial evidence.”).

28. *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at \*3 (Fed. Cir. 2019) (Federal Circuit reviews the Board’s legal conclusions de novo and its factual findings for substantial evidence) (citing *In re i.am.symbolic LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017)); *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (Federal Circuit reviews legal conclusions de novo and finding of fact for substantial evidence); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (whether the correct legal standard was applied in assessing a mark for genericness is a question of law to be reviewed de novo) (citing *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal citation and subsequent history omitted) and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (Federal Circuit reviews conclusions of law de novo); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (Board’s findings of fact are reviewed for substantial evidence; conclusions of law are reviewed de novo); *Lyons v. American College of Veterinary Sports Medicine & Rehabilitation*, 859 F.3d 1023, 123 USPQ2d 1024, 1026-27 (Fed. Cir. 2017) (same), *cert. denied*, 138 S. Ct. 366 (2017); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (Federal Circuit reviews Board’s legal conclusions 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).

29. *See In re Forney Indus., Inc.*, 955 F.3d 940, 2020 USPQ2d 10310, at \*3 (Fed. Cir. 2020) (“The correct standard to apply in determining inherent distinctiveness, however, is a legal question, which we review de novo”).

30. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1049 (Fed. Cir. 2018) (case remanded after de novo review because Board applied incorrect legal standard in assessing whether proposed marks are generic and by failing to assess the level of the proposed marks’ distinctiveness, both of which are legal determinations); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (Board did not err as matter of law by considering explanatory text of specimens in concluding that applicant’s “First Tuesday” mark in connection with lottery services and games is merely descriptive of applicant’s goods and services); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1171 (Fed. Cir. 2013) (“Whether preclusion applies to bar a particular action is an issue of law, which this court decides de novo.”); *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).

31. See *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at \*2 (Fed. Cir. 2021) ("We review the Board's factual findings on each relevant DuPont factor for substantial evidence, but we review the Board's ... weighing of the DuPont factors de novo."); *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at \*3 (Fed. Cir. 2019) ("Likelihood of confusion is a question of law based on underlying findings of facts. ... The Board's underlying findings of fact as to each DuPont factor are reviewed for substantial evidence.") (citing *In re Chatam International Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004)); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) ("Likelihood of confusion is a question of law based on underlying findings of fact.") (citing *In re Chatam International, Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004)); *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).

32. 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), *cert. denied*, 126 S. Ct. 1570 (2006); *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), *cert. denied*, 124 S. Ct. 1052 (2004); *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, 29 USPQ2d 1241, 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).

33. Compare *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Board did not abuse its discretion in excluding appellant's evidence, where Board's evidentiary determination was based on the TBMP, citing cases where "we have affirmed the TTAB's determinations, specifically with regard to evidence admission, where they are clearly in line with the language of the TBMP"), *cert. denied*, 139 S. Ct. 1550 (2019) with *Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1639 (Fed. Cir. 2003) (substantial deference to USPTO's interpretation of its own regulation).

34. *Accord MaxLinear, Inc. v. CF Crespe LLC*, 880 F.3d 1373, 125 USPQ2d 1577, 1579 (Fed. Cir. 2018) ("B & B Hardware is particularly relevant here, as the Court held that 'issue preclusion should apply' to the final written decision of the Trademark Trial and Appeal Board ('TTAB'). ... The TTAB, at issue in

*B & B Hardware*, and [PTAB] in this case, are indistinguishable for preclusion purposes.”); *V.V.V. & Sons Edible Oils Limited v. Meenakshi Overseas, LLC*, 946 F.3d 542, 2019 USPQ2d 494448, at \*3-4 (9th Cir. 2019) (reversing district court’s finding of claim preclusion based on Board opposition proceeding, but noting the applicability of *B & B Hardware* to issues decided in Board proceedings and leaving it to the district court to consider whether plaintiff “should be precluded from litigating certain issues because of the TTAB judgment”); *Cesari S.r.L. v. Peju Province Winery L.P.*, No. 17-873, 2017 WL 6509004 (S.D.N.Y. Dec. 11, 2017) (court discusses issue and claim preclusion, and applies *B & B Hardware* to grant partial summary judgment on likelihood of confusion in infringement case). *Cf. Valvoline Licensing & Intellectual Property LLC v. Sunpoint International Group USA Corp.*, 2021 USPQ2d 785, at \*7-9 (TTAB 2021) (party not precluded from raising likelihood of confusion as a ground against registration of Applicant’s current application where party obtained complete relief requested on nonuse claim in prior proceeding and could not appeal finding on likelihood of confusion claim); *In re FCA US LLC*, 126 USPQ2d 1214, 1215-19 (TTAB 2018) (Board affirms likelihood of confusion refusal despite district court’s previous finding of no infringement; issue preclusion principles of *B & B Hardware* not applicable because USPTO was not a party to the infringement action and issues presented to district court in infringement action differ from issues in ex parte appeal. “As the Supreme Court said of the trademark registration process as compared to infringement litigation, ‘it is a separate proceeding to decide separate rights.’ *B & B Hardware*, 113 USPQ2d at 2056.”), *aff’d*, 778 F. App’x 962 (Fed. Cir. 2019); *CSL Silicones Inc. v. Midsun Group Inc.*, 170 F. Supp. 3d 304, 318-19 & n.12, (D. Conn. 2016) (issue preclusion not applicable under *B & B Hardware* because no issues were decided in the 2005 Board cancellation proceeding which was dismissed with prejudice following petitioner’s withdrawal of its cancellation petition; finding no claim preclusion due to change in transactional facts).

35. *Beasley v. Howard*, 14 F.4th 226, 2021 USPQ2d 960 (3d Cir. 2021) (affirming dismissal of fraud claim based on issue preclusion but finding that Section 43(a) claim was not precluded by prior Board proceedings); *Nationstar Mortgage, LLC v. Ahmad*, 155 F. Supp. 3d 585, 592-93 (E.D. Va. 2015) (citing *Nationstar Mortgage, LLC v. Ahmad*, 112 UPQ2d 1361 (TTAB 2014)), *appeal dismissed*, No. 16-1422 (4th Cir. July 13, 2016).

36. *Ashe v. The PNC Financial Services Group, Inc.*, 165 F.Supp.3d 357, 365 (D. Md. 2015), *aff’d*, 652 F. App’x 155 (4th Cir. 2016), *cert. denied*, 137 S. Ct. 1223 (2017). *See also Jean Alexander Cosmetics, Inc. v. L’Oreal USA, Inc.*, 458 F.3d 244, 80 USPQ2d 1470, 1479 (3d Cir. 2006) (finding issue preclusion as to independently sufficient alternative holding of no likelihood of confusion which was raised and litigated in Board proceeding); *Treadwell Original Drifters, LLC v. Original Drifters, Inc.*, No. 1:15-cv-580, 2016 WL 5899289, at \*6-7 (E.D. Va. Jan. 28, 2016) (issue preclusion found for party in privity on the issue of priority based on 2004 Board decision, but not based on 2009 or 2015 Board decisions), *aff’d*, 678 F. App’x 90 (4th Cir. 2017).

37. *Royal Crown Co. v. Coca-Cola Co.*, 823 F. App’x 960, 2020 USPQ2d 10881, at \*2 (Fed. Cir. 2020) (“The Board’s application of its own trial rules is reviewed for a determination of whether it is “arbitrary, capricious, [or] an abuse of discretion.”); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Board did not abuse its discretion in excluding appellant’s evidence, where Board’s evidentiary determination was based on the TBMP, citing cases where “we have affirmed the TTAB’s determinations, specifically with regard to evidence admission, where they are clearly in line with the language of the TBMP.”), *cert. denied*, 139 S. Ct. 1550 (2019).

38. *Royal Crown Co. v. Coca-Cola Co.*, 823 F. App’x 960, 2020 USPQ2d 10881, at \*3 (Fed. Cir. 2020) (Board’s granting Coca-Cola’s post-trial, unconsented-to motion was not arbitrary, capricious, and an abuse of discretion; “... the Board exercises its discretion to grant motions—for all kinds of amendments—in the appropriate circumstances, which usually align with general principles of administrative economy and vary



depending on the case.”); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Board did not abuse its discretion in excluding appellant’s evidence, where Board’s evidentiary determination was based on the TBMP, citing cases where “we have affirmed the TTAB’s determinations, specifically with regard to evidence admission, where they are clearly in line with the language of the TBMP.”), *cert. denied*, 139 S. Ct. 1550 (2019).

## **906.02 Petition To Director**

In reviewing non-final rulings of the Board, the Director will exercise supervisory authority under [37 C.F.R. § 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).