Chapter 1200 EX PARTE APPEALS

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1201 Propriety of Appeal

1201.01 Readiness of Case for Appeal

Trademark Act § 20, 15 U.S.C. § 1070 ***Appeal from examiner to Trademark Trial and Appeal Board.*** *An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.*

37 C.F.R. § 2.63(b) ***Final refusal or requirement.*** *Upon review of a response, the examining attorney may state that the refusal(s) to register, or the requirement(s), is final.*

(1) *If the examining attorney issues a final action that maintains any substantive refusal(s) to register, the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal(s) to register, and comply with any outstanding requirement(s),maintained in the final action; or*

(ii) *An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142.*

(2) *If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement(s) maintained in the final action;*

(ii) *An appeal of the requirement(s) to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142;* or

(iii) *A petition to the Director under § 2.146 to review the requirement(s), if the subject matter of the requirement(s) is procedural, and therefore appropriate for petition.*

(3) *Prior to the expiration of the time for filing an appeal or a petition, the applicant may file a request for reconsideration of the final action that seeks to overcome any substantive refusal(s) and/or comply with any outstanding requirement(s). Filing a request for reconsideration does not stay or extend the time for filing an appeal or petition. The Office will enter amendments accompanying requests for reconsideration after final action if the amendments comply with the rules of practice in trademark cases and the Act.*

37 C.F.R. § 2.141 ***Ex parte appeals from action of trademark examining attorney.***

(a) *An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an*

appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

37 C.F.R. § 2.146(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

On the first or any subsequent reexamination or reconsideration of an application for registration of a trademark, the examining attorney may state that the refusal of the registration or the insistence upon a requirement is final. [Note 1.] When the examining attorney states that his or her action is final, the applicant's response is limited to an appeal to the Board, or to compliance with any requirement, or to a petition to the Director if a petition is permitted by 37 C.F.R. § 2.63(b). [Note 2.] An applicant may, pursuant to 37 C.F.R. § 2.63(b), file a request for reconsideration, but the submission of such a request does not automatically extend the applicant's time for filing a notice of appeal. Thus, if an applicant submits a request for reconsideration within the six-month time period from the issue date of the final action, but does not file a notice of appeal within that time period, and if the request for reconsideration fails to persuade the examining attorney, and if the examining attorney does not issue a new final refusal, the application will be deemed abandoned. [Note 3.]

An applicant may consider a second refusal on the same ground(s), or a repeated requirement, as final for purposes of appeal. [Note 4.] All grounds and/or requirements must be repeated in order for the second refusal to be considered as final. [Note 5.]

Thus, an application is ripe for appeal when the examining attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or from a repeated requirement. [Note 6.] However, an Office action that repeats one or more grounds for refusal or requirements but also raises a new ground or requirement may not be considered as final for purposes of appeal. *See* TBMP § 1201.02.

NOTES:

1. *See* Trademark Act § 12(b), 15 U.S.C. § 1062(b); 37 C.F.R. § 2.63(b); TMEP § 714 and TMEP § 714.03.

2. *See* 37 C.F.R. § 2.63(b); TMEP § 715.01. *See also* Trademark Act § 20, 15 U.S.C. § 1070, and TMEP § 1501 and TMEP § 1702.

3. *In re GTE Education Services*, 34 USPQ2d 1478, 1480 (Comm'r 1994).

4. *See In re Roberts* , 87 USPQ2d 1474, 1478 (TTAB 2008); *In re MediaShare Corp.* , 43 USPQ2d 1304, 1305 n.2 (TTAB 1997); *In re Hechinger Investment Co. of Delaware Inc.* , 24 USPQ2d 1053, 1054 n.2 (TTAB 1991); *In re Citibank, N.A.* , 225 USPQ 612, 613 (TTAB 1985). *See also* 37 C.F.R. § 2.141; TMEP § 1501.

5. *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

6. *See In re Harley* , 119 USPQ2d 1755, 1757 (TTAB 2016) (advisory statement made by examining attorney is not a refusal to register and not subject to appeal); *In re Roberts* , 87 USPQ2d 1474, 1478 (TTAB 2008); *In re Hechinger Investment Co. of Delaware Inc.* , 24 USPQ2d 1053, 1054 n.2 (TTAB 1991); *In re Citibank, N.A.* , 225 USPQ 612, 613 (TTAB 1985). *See also* Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.63(b); 37 C.F.R. § 2.141; TMEP § 1501.

1201.02 Premature Final

Trademark Act § 12(b), 15 U.S.C. § 1062(b) *If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.*

A refusal of registration or an insistence upon a requirement may be made final by the examining attorney only on the first or any subsequent reexamination or reconsideration of an application; a refusal or requirement may not be made final in a first action. [Note 1.]

An action should not be stated to be final until the applicant has had at least one opportunity to reply to each ground of refusal, and each requirement, asserted by the examining attorney. [Note 2.] Moreover, a final action should not be issued until all matters but for those that are to be the subject of the final action have been resolved, and a clear issue has been developed between the examining attorney and the applicant with respect to each remaining ground of refusal or requirement. [Note 3.] As stated in TMEP § 714.03:

No refusal or requirement may be made final, even if it is a repeated refusal or requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or repeated requirement in a second or subsequent action, any previously issued refusals or requirements may not be made final, but instead should be maintained.

However, it is not considered a new refusal if the examining attorney has a different rationale for a previously made refusal or requirement. [Note 4.]

Examples of new issues that would preclude the issuance of a final action until the applicant has had an opportunity to respond are amendments to the drawing, [Note 5.] and amendments to the Supplemental Register or to assert acquired distinctiveness. [Note 6.] However, if the amendment is irrelevant to an outstanding refusal or is merely cumulative, it is not deemed to raise a new issue. [Note 7.]

If an applicant believes that a refusal to register, or the insistence upon a requirement, has been made final prematurely, the applicant may raise the matter by request to the examining attorney for reconsideration or by contacting the managing attorney or senior attorney in the examining attorney's law office. If the examining attorney does not withdraw the finality, the applicant may file a petition under 37 C.F.R. § 2.146. [Note 8.] If, prior to hearing from the examining attorney, managing attorney or senior attorney, or prior to a decision on a petition, an applicant chooses to file a notice of appeal in order to preserve its rights to an appeal, the applicant should advise the Board that it believes that the final action is premature or that there is a pending petition on this issue. If the notice of appeal is filed electronically through ESTTA, the applicant should also file through ESTTA, using the "file a document in a Board proceeding" menu, and checking the box for "Other Motions/Papers," an additional paper advising the Board that the final action is premature or that there is a pending petition on this issue. In the rare circumstance that the notice of appeal is submitted as a paper filing, the applicant should so advise the Board in the notice of appeal. See TBMP § 1202.03 regarding the filing of a notice of appeal.

That a final action is premature is not a ground for appeal to the Board. [Note 9.] However, if it comes to the attention of the Board, when an appeal has been filed, that the final action was issued prematurely, the

Board will vacate the institution order and will forward the application to the examining attorney for appropriate action. That action is generally that the finality of the examining attorney's action is withdrawn and a new nonfinal action is issued. The Board letter will generally indicate that if the examining attorney finds, upon consideration of the applicant's response to the new nonfinal action, that the application is in condition for publication (or for registration, if the application seeks registration on the Supplemental Register), the applicant may request a refund of the previously submitted appeal fee; and that if the examining attorney ultimately issues a new final action, and the applicant wishes to appeal, a new notice of appeal should be filed, in which the applicant requests that the previously submitted appeal fee should be applied to the appeal.

NOTES:

1. *See* Trademark Act § 12(b), 15 U.S.C. § 1062(b); 37 C.F.R. § 2.63(b); TMEP § 714.01 and TMEP § 1501.

2. TMEP § 714.01. *See also In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1154 (TTAB 1992); *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1769 (TTAB 2016) (examining attorney "instead of just denying the request for reconsideration" should have "issued a new final Office action") (quoting *Petition Decision* (Comm'r June 22, 2015)).

3. TMEP § 714.03. *See also In re Dietrich*, 91 USPQ2d 1622, 1624 (TTAB 2009) (to the extent examining attorney attempted to reject Trademark Act § 2(f) claim for the first time in appeal brief, rejection untimely and not considered); *In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (ground for refusal first raised in examining attorney's appeal brief given no consideration).

4. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007). *See also In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1144 n.21 (TTAB 2016) (examining attorney's argument about evidence of copying not waived because, while not specifically addressed in Office action, examining attorney nonetheless wrote that "the evidence and arguments provided are not sufficient to support the claim" of acquired distinctiveness).

5. *See In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1154 (TTAB 1992).

6. *See In re Audio Book Club Inc.*, 52 USPQ2d 1042, 1043 n.2 (TTAB 1999). *See also* TMEP § 714.05 *et seq. But see In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (new nonfinal action not necessary when application was refused on Principal Register as functional and application amended to Supplemental Register).

7. *See In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (amendment to Supplemental Register in response to a refusal of registration on ground of functionality does not raise a new issue); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (amendment to the Supplemental Register in response to a refusal of registration under Trademark Act § 2(a) does not raise a new issue); *In re GTE Education Services*, 34 USPQ2d 1478, 1480 (Comm'r 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for same reason as the original specimens). *See also* TMEP § 714.05, TMEP § 714.05(a), TMEP § 714.05(a)(i) and TMEP § 714.05(a)(ii).

8. *See* TMEP § 714.06.

9. *See* TMEP § 714.06.

1201.03 Premature Appeal

An application is ripe for appeal when the examining attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or a repeated requirement; an appeal from a first refusal or requirement is premature. *See* TBMP § 1201.01. All grounds and/or requirements must be repeated in order for the second refusal to be considered as final. [Note 1.] If, in response to a final Office action, the applicant files a request for reconsideration that raises a new issue, and does not timely file a notice of appeal, the applicant may not then file an appeal until a final Office action issues with respect to the new issue. [Note 2.]

The Board has no jurisdiction to entertain a premature appeal. Thus, if an appeal is filed prematurely, the Board, in a written order, will notify the applicant that the appeal was filed prematurely, refund the fee and forward the application to the examining attorney for further appropriate action. The examining attorney will normally treat the premature notice of appeal as an incomplete response under 37 C.F.R. § 2.65(a) and allow the applicant time to submit a complete response. If the applicant has also filed a request for reconsideration or an appeal brief, the request for reconsideration or brief may be treated as a response. [Note 3.] In the event that the examining attorney ultimately issues a final action, or a second refusal on the same ground(s) or a repeated requirement, and the applicant wishes to appeal, the applicant should file a new notice of appeal and a new appeal fee.

NOTES:

1. *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

2. *In re Virshup*, 42 USPQ2d 1403, 1404 (TTAB 1997) (after final refusal on Principal Register, applicant amended to Supplemental Register; applicant's appeal of initial refusal on Supplemental Register held premature).

3. *In re Virshup*, 42 USPQ2d 1403, 1404 (TTAB 1997).

1201.04 Compliance With Requirements Not Subject of Appeal

37 C.F.R. § 2.142(c) *All requirements made by the examining attorney and not the subject of appeal shall be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance.*

All requirements that have been made by the examining attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal. If an applicant that files an appeal to the Board fails to comply with such a requirement, the refusal to register may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal. [Note 1.]

NOTES:

1. *See* 37 C.F.R. § 2.142(c); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(c) to add that the statement of issues in a brief should note that the applicant has complied with all requirements made

by the examining attorney and not the subject of appeal."). *See In re Brack*, 114 USPQ2d 1338, 1343 (TTAB 2015) (refusal affirmed on requirement to submit signed and verified application, propriety of refusal under Section 2(d) not reached); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Cord Crafts Inc.*, 11 USPQ2d 1157, 1157 n.2 (TTAB 1989); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371, 373 (TTAB 1978). *Cf. In re Walker-Home Petroleum, Inc.*, 229 USPQ 773, 774 (TTAB 1985), and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985).

1201.05 Appeal versus Petition

37 C.F.R. § 2.63(b) *Upon review of a response, the examining attorney may state that the refusal(s) to register, or the requirement(s), is final.*

(1) *If the examining attorney issues a final action that maintains any substantive refusal(s) to register, the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal(s) to register, and comply with any outstanding requirement(s),maintained in the final action; or*

(ii) *An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142.*

(2) *If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement(s) maintained in the final action;*

(ii) *An appeal of the requirement(s) to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; or*

(iii) *A petition to the Director under § 2.146 to review the requirement(s), if the subject matter of the requirement(s) is procedural, and therefore appropriate for petition.*

(3) *Prior to the expiration of the time for filing an appeal or a petition, the applicant may file a request for reconsideration of the final action that seeks to overcome any substantive refusal(s) and/or comply with any outstanding requirement(s). Filing a request for reconsideration does not stay or extend the time for filing an appeal or petition. The Office will enter amendments accompanying requests for reconsideration after final action if the amendments comply with the rules of practice in trademark cases and the Act.*

(4) *Filing a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response, pursuant to § 2.65(a).*

(c) *If a petition to the Director under § 2.146 is denied, the applicant will have six months from the date of issuance of the Office action that repeated the requirement(s), or made it final, or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement(s). A requirement that is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 C.F.R. § 2.146 ***Petition to the Director.***

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

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

(2) *in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director;*

(3) *to invoke the supervisory authority of the Director in appropriate circumstances;*

(4) *in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations;*

(5) *in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

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

An action taken on a matter arising during the ex parte prosecution of an application for registration may, depending on the nature of the matter and the posture of the case, be reviewable only by appeal to the Board, or only by petition to the Director or by either appeal or petition. The following discussion contains general guidelines for determining whether a matter is appealable or petitionable.

An appeal to the Board may be taken from any final action, second refusal to register on the same ground(s), or repeated requirement issued by the examining attorney during the ex parte prosecution of an application for registration, whether the matter involved in the examining attorney's action is substantive or procedural in nature, except that a formal requirement which was the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board. [Note 1.] TBMP § 1201.01.

Substantive questions arising during the ex parte prosecution of an application, including, but not limited to, issues arising under Trademark Act § 2, Trademark Act § 3, Trademark Act § 4, Trademark Act § 5, Trademark Act § 6, and Trademark Act § 23, 15 U.S.C. § 1052, 15 U.S.C. § 1053, 15 U.S.C. § 1054, 15 U.S.C. § 1055, 15 U.S.C. § 1056, and 15 U.S.C. § 1091, are considered to be appropriate subject matter for appeal to the Board (after issuance of a final action, or a second refusal on the same ground(s)), *see* TBMP § 1201.01, but not for petition to the Director. [Note 2.]

A wide variety of matters are petitionable. Petition may be taken to the Director in the following situations:

(1) From any repeated or final formal requirement made by the examining attorney, during the ex parte prosecution of an application, if (i) the requirement is repeated, but the examining attorney's action is not made final and the subject matter of the requirement is appropriate for petition to the Director; [Note 3.] or (ii) the examining attorney's action is made final and is limited to subject matter appropriate for petition to the Director. [Note 4.] If the petition is denied, the applicant will have six months from the date of the Office action which repeated the requirement or made it final, or 30 days from the date of the Director's decision on the petition, whichever is later, to comply with the requirement. A formal requirement that was the subject of a petition to the Director may not thereafter be the subject of an appeal to the Board. [Note 5.]

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or Part 2 of 37 C.F.R. (i.e., the rules of practice in trademark cases) specifies that the matter is to be determined directly or reviewed by the Director. [Note 6.] Insofar as applications for registration are concerned, this includes petitions to review the denial of requests for extensions of time to file statements of use under 37 C.F.R. § 2.89(g), petitions to review the actions of Post Registration examiners under Trademark Act § 7, Trademark Act § 8, and Trademark Act § 9, 15 U.S.C. § 1057, 15 U.S.C. § 1058, and 15 U.S.C. § 1059, and petitions to record a document in the Trademark Assignment Recordation Branch. [Note 7.]

(3) To invoke the supervisory authority of the Director in appropriate circumstances. [Note 8.] Under this provision, an applicant generally may petition to the Director for relief from, inter alia, a nonfinal refusal

to register based on a procedural matter, i.e., an alleged failure of the applicant to comply with a technical requirement of the rules of practice governing trademark cases; or an alleged failure of the examining attorney to act in accordance with those rules and/or proper practice thereunder. [Note 9.]

(4) In any case not specifically defined and provided for by Part 2 of 37 C.F.R. (i.e., the rules of practice in trademark cases). [Note 10.] Under this provision, an applicant may petition the Director with respect to any situation, not covered by the rules, from which the applicant seeks relief.

(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 which is not also a requirement of the Act of 1946. [Note 11.]

However, petition may not be taken to the Director on a question of substance arising during the ex parte prosecution of an application; nor may petition be taken from a final action of the examining attorney, except that an applicant may petition for relief from an action making a formal requirement final if the action is limited to subject matter appropriate for petition to the Director (i.e., involves questions such as the applicant's alleged failure to comply with one or more of the technical requirements of the rules of practice in trademark cases, rather than a question of substance). [Note 12.]

On appeal, the Board will review only the correctness of a substantive refusal to register, and will not consider the procedural issue of whether the issuance of or failure to issue a substantive refusal was a "clear error." *See* TMEP § 706.01 regarding "clear error." Moreover, an applicant may not challenge by petition the Office's determination of clear error regarding questions of substance, which would include questions arising under Trademark Act §§ 2, 3, 4, 5, 6 and 23. *See* TMEP § 706.01. [Note 13.]

The Board will not consider a matter that is appropriate only for petition. For example, the Board will not review requirements for an amendment to the classification of goods or services; the issue of proper classification is procedural, not substantive, in nature and may only be reviewed upon petition. [Note 14.] Although the issue of an acceptable identification of goods or services may be decided by the Board on appeal, or by petition, a petition may provide an applicant with more flexibility. [Note 15.] For further examples of matters that are appealable and those that are petitionable, see TMEP § 1704.

NOTES:

1. *See* Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.63(b), 37 C.F.R. § 2.63(c), and 37 C.F.R. § 2.141. *See also* *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1770 (TTAB 2016) (Board will not revisit issue that was the subject of petition decided by the Director); *In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

2. *See* 37 C.F.R. § 2.146(b); TMEP § 1704; *In re The Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778, 1781 (Comm'r 1995); *In re Mission Pharmacal Co.*, 33 USPQ2d 1060, 1061 (Comm'r 1993); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393, 1393 (Comm'r 1993); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990); *In re Hart*, 199 USPQ 585, 586-87 (Comm'r 1978); *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978).

3. See, in this regard, 37 C.F.R. § 2.146(b), and the preceding paragraph.

4. *See* 37 C.F.R. § 2.63(b) and 37 C.F.R. § 2.146(a)(1); *In re The Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778, 1781 (Comm'r 1995) (proper signatory for an application and statement of use filed by a partnership); *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978) (requirement for a more particular identification of goods).

5. *See* 37 C.F.R. § 2.63(c). *See also In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

6. 37 C.F.R. § 2.146(a)(2).

7. *See* TMEP § 1702, TMEP § 1703 and TMEP § 1704.

8. *See* 35 U.S.C. § 2 and 37 C.F.R. § 2.146(a)(3).

9. *See, e.g., In re Mission Pharmacal Co.*, 33 USPQ2d 1060, 1061 (Comm'r 1993) (whether examining attorney acted properly in issuing final Office action); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393, 1393 (Comm'r 1993) (whether examining attorney properly suspended application); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990) (whether examining attorney properly refused to allow amendment of drawing to correct an allegedly obvious typographical error); TMEP § 1702 and TMEP § 1703. For further information concerning the matters that are petitionable under this provision, see TMEP § 1707.

10. *See* 37 C.F.R. § 2.146(a)(4).

11. 37 C.F.R. § 2.146(a)(5). For information concerning the meaning of the words "extraordinary situation" *see* TMEP § 1708.

12. *See* 37 C.F.R. § 2.63(b), 37 C.F.R. § 2.146(a), and 37 C.F.R. § 2.146(b); *In re Dermahose Inc.*, 82 USPQ2d 1793, 1796 n.5 (TTAB 2007) (examining attorney's refusal to accept Statement of Use because the signer of the declaration was not the person making the statements in the declaration reviewable by appeal or petition); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990); *In re Hart*, 199 USPQ 585, 586-87 (Comm'r 1978); *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978); TMEP § 1702 and TMEP § 1704.

13. *See In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1264 (TTAB 2015) (applicant's sole recourse to challenge a refusal that was issued during examination of a statement of use under the clear error standard is by appealing the merits of the final refusal to the Board), *reversed and remanded on other grounds*, slip op. No. 16-1094 (Fed. Cir. January 4, 2017). This case expressly overruled those portions of *In re Jump Designs LLC*, 80 USPQ2d 1370, 1373-74 (TTAB 2006) and *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997) to the extent that they suggest the applicant could petition the Director for a review of a clear error determination.

14. *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013).

15. *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357-58 (TTAB 2013) (petition may afford broader scope of possible relief because Director has more flexibility in this area).

1202 Filing an Appeal

1202.01 In General

Trademark Act § 20, 15 U.S.C. § 1070 ***Appeal from examiner to Trademark Trial and Appeal Board.*** *An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.*

37 C.F.R. § 2.141 ***Ex parte appeals from action of trademark examining attorney.***

(a) *An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

(b) *The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.*

37 C.F.R. § 2.142(a) *Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of the final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal in written form, as prescribed in § 2.126, and paying the appeal fee.*

An appeal to the Board from an examining attorney's final action, second refusal on the same ground(s), or repeated requirement, is taken by timely filing, *see* TBMP § 1202.02, in the Office both a notice of appeal and the prescribed appeal fee. [Note 1.] *See* TBMP § 1202.04. If the notice of appeal and fee are not timely filed, the application will be deemed to have been abandoned, and the Board cannot entertain the appeal unless the applicant successfully petitions the Director to revive the application. [Note 2.]

All requirements that have been made by the examining attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance. [Note 3.] If an applicant that files an appeal to the Board fails to comply with such a requirement, the refusal to register may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal. *See* TBMP § 1201.04.

If an application contains multiple classes, and a final refusal or requirement pertains to some, but not all, of the classes in the application, the applicant has the option of (i) filing an appeal for the application as a whole (paying the appeal fee only for the classes for which it wishes to appeal), or (ii) filing a request to divide the application to sever those classes for which there has been no final requirement or refusal and filing an appeal only for the class(es) to which the final refusal or requirement pertains. In the former case, the application will not be published for opposition (or a registration will not issue in the case of an application on the Supplemental Register) for those classes for which no refusal or requirement was made final until after the appeal is decided. Similarly, if a final refusal or requirement pertains to some but not all of the goods or services in a single class, the applicant has the option of filing a request to divide the application to sever those goods or services from that class. If no request to divide the application is filed, the application may not proceed to publication (or, in the case of an application on the Supplemental Register, to registration) for those goods or services for which no refusal or requirement has been made, until after the appeal is decided. If a request to divide the application is filed, *see* TBMP § 1205.02, the classes, or the goods or services within a class, for which there is no final requirement or refusal which have been divided out of the application will proceed to publication or registration, as appropriate, and an appeal will be instituted for the remaining classes for which an appeal has been filed. If goods or services have been divided out of

a single class, an appeal will be instituted for the application with the remaining goods or services in that class. *See* TBMP § 1202.05 .

If an application contains multiple classes and the applicant wishes to appeal a final refusal or requirement in some but not all of the classes, the applicant should indicate in the notice of appeal the classes in which the refusal or requirement is being appealed. Any remaining classes for which there is a final refusal or requirement that is not the subject of the appeal will be deemed abandoned. [Note 4.] However, if the applicant has also filed a request for reconsideration for those classes, after instituting the appeal with respect to the classes which are the subject of the appeal, the Board will remand the application to the examining attorney to consider the request for reconsideration. If the examining attorney is not persuaded by the request for reconsideration, the classes for which no appeal has been filed will be deemed abandoned unless the examining attorney issues a nonfinal Office action or a new final refusal (thereby giving the applicant additional time to file a notice of appeal with respect to these classes).

NOTES:

1. *See* 37 C.F.R. § 2.6(a)(18). *See also* Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.141 and 37 C.F.R. § 2.142(a); TMEP § 1501.

2. *See* Trademark Act § 12(b), 15 U.S.C. § 1062; 37 C.F.R. § 2.65(a); 37 C.F.R. § 2.66. *See also* TMEP § 718.02, TMEP § 1501.04, TMEP § 1714, and TMEP § 1714.01(a).

3. 37 C.F.R. § 2.142(c).

4. *See In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1745 n.1 (TTAB 2007) (applicant did not appeal requirement to delete Class 28 goods, and Board treated Class 28 goods as deleted from application).

1202.02 Time for Appeal

An appeal to the Board may be taken from any final action, second refusal on the same ground(s), or repeated requirement issued by the examining attorney during the ex parte prosecution of an application for registration, except that a formal requirement which was the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board. [Note 1.] *See* TBMP § 1201.01 and TBMP § 1201.05.

An appeal to the Board must be filed within six months from the date of the action from which the appeal is taken. [Note 2.] If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. *See* TBMP § 1202.01.

A notice of appeal to the Board must be filed through ESTTA in the manner prescribed in 37 C.F.R. § 2.126(a). For more information regarding filing via ESTTA, see TBMP § 110. However, if ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 3.] Examining attorney submissions need not be filed through ESTTA because they are filed through USPTO internal electronic systems. [Note 4.] *See* TBMP § 106.03, TBMP § 107, TBMP § 110, and TBMP § 1202.03. In the rare circumstances paper filing is necessary, 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 the filing of an appeal to the Board. [Note 5.] TBMP § 111.01 and TBMP § 111.02.

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence. [Note 6.] TBMP § 1204. However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate). [Note 7.] TBMP § 1201.05. If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. [Note 8.] Thus, if an applicant that has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant must file an appeal prior to the expiration of the six-month period following issuance of the final action.

If an appeal is late-filed, but the applicant timely filed some other response to the appealed action, such as an amendment or request for reconsideration, the Board will issue a written action informing the applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the examining attorney for appropriate action with respect to the document that was timely filed. An applicant may petition the Director to revive an application for failure to file a timely appeal, as an appeal is considered a response to an Office action. [Note 9.] However, the unintentional delay standard of 37 C.F.R. § 2.66(a) (revival of abandoned applications) does not apply to applications that were abandoned due to an incomplete response after a final Office action. A request for reconsideration that is not accompanied by a notice of appeal is considered an incomplete response. Therefore, if an applicant files a request for reconsideration but fails to timely file a notice of appeal, and the examining attorney denies the request for reconsideration, it is the Director's practice to deny a petition to revive in such circumstances. [Note 10.] If an applicant files a petition to revive for the purpose of filing an appeal, the notice of appeal must be filed through ESTTA. However, the petition to revive should be filed through TEAS, and should include a statement that a notice of appeal is being filed with the Board. In the rare circumstances the petition and notice of appeal are filed as paper submissions, the notice of appeal should be filed with the Board, but the petition to revive, which is filed with the Director, should indicate that a notice of appeal is being filed with the Board.

NOTES:

1. *See* TMEP § 1501.

2. *See* Trademark Act § 12(b), 15 U.S.C. § 1062; 37 C.F.R. § 2.142(a).

3. *See* 37 C.F.R. § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("Such explanations must include the specific facts underlying the inability to file by ESTTA, rather than a mere conclusory statement that technical problems or extraordinary circumstances prevented the use of ESTTA.").

4. *See* 37 C.F.R. § 2.142(b)(2). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(b)(2) to exempt examining attorney submissions from the ESTTA requirement because they are filed through the Office's internal electronic systems.").

5. *See* 37 C.F.R. § 2.197; 37 C.F.R. § 2.198. Many documents that are filed in connection with the prosecution of an application, including the application itself and an amendment to allege use, may not be filed using the "Priority Mail Express" procedure. *See* TMEP § 305.03. However, the "Priority Mail Express®" procedure is available for filing a notice of appeal.

6. *See* 37 C.F.R. § 2.63(b). *See also* TMEP § 715.02 and TMEP § 715.03.

7. *See* 37 C.F.R. § 2.63(b); TMEP § 715.03 and TMEP § 715.03(c).

8. *See* 37 C.F.R. § 2.63(b) and 37 C.F.R. § 2.142(a). *See also* TMEP § 715.03(a).

9. *See* 37 C.F.R. § 2.66(a) and TMEP § 1714 *et seq.*

10. See TMEP § 1501 regarding notices of appeal, TMEP § 715.03 *et seq.* regarding requests for reconsideration, and TMEP § 1714.01(f)(ii) regarding situations in which the unintentional delay standard does not apply.

1202.03 Notice of Appeal

A notice of appeal is the document by which an applicant appeals from the decision of the examining attorney refusing registration. A notice of appeal must be filed through ESTTA, found at https://estta.uspto.gov. [Note 1.] *See* TBMP § 106.03and TBMP § 110. Under "File a New Proceeding" choose "Appeal of Refusal to Register" from the drop-down menu, and enter the application serial number; the relevant information will then automatically appear in the form. ESTTA provides the applicant with immediate confirmation of the filing; generates the Board's order instituting the appeal immediately; and provides the applicant the date by which it must file its appeal brief.

If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 2.] See TBMP § 106.03 and TBMP § 1202.02 and the rules and TMEP sections cited therein regarding certificate of mailing and certificate of mailing via Priority Mail Express® procedures. The paper version of the notice of appeal should bear at its top the wording "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application in which the appeal is being filed, namely, the applicant's name, the serial number and filing date of the application, and the involved mark. The notice of appeal need consist only of a simple statement indicating that the applicant appeals from the refusal of registration; reasons for appeal need not be given. If the application has multiple classes, and the appeal is not for all the classes in the application, the applicant should indicate in the notice of appeal the class(es) for which the appeal is taken. *See* TBMP § 1202.05. Only one copy of the notice of appeal should be submitted.

A notice of appeal need not be verified, and it may be signed by the applicant or its attorney or other authorized representative. An electronic signature will be accepted. [Note 3.] *See* TBMP § 106.02. The Board will accept a notice of appeal that is signed by an attorney, even if he or she is not the attorney of record, i.e., there is no power authorizing him or her to act for the applicant. Moreover, the Board will accept a notice of appeal signed by the applicant itself, even if the applicant had appointed an attorney to act for it. However, the Board will continue to correspond only with the attorney of record or, if the applicant has not appointed an attorney, with the applicant itself. **Please Note:** The Trademark Operation will not accept any document, including a request for reconsideration filed along with a notice of appeal, if it is signed by the applicant or an attorney if a different attorney had been appointed to act for the applicant, and the power has not been revoked. [Note 4.]

Although the notice of appeal must be signed, an unsigned notice of appeal will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the

Board. [Note 5.] *See* TBMP § 106.02. The same is true of other unsigned papers filed in an application during an ex parte appeal to the Board. For further information concerning signature of submissions, see TBMP § 106.02.

If the applicant files a request for reconsideration or amendment (including an amendment to allege use) along with the notice of appeal, or at the time of filing the notice of appeal the applicant had filed a request for reconsideration or amendment which is still pending before the examining attorney, the applicant should indicate this by checking the box on the ESTTA form indicating that it has filed a request for reconsideration. The request for reconsideration itself should be filed through TEAS. In the rare circumstances a notice of appeal is filed as a paper submission, the applicant should include in the notice of appeal a statement that a request for reconsideration has been or is being filed; if the request for reconsideration is filed at the same time as the notice of appeal, it should accompany the notice of appeal but not be in the body of the notice of appeal. If the written explanation for paper filing is acceptable, the Board will institute the appeal, suspend proceedings, and remand the application to the examining attorney to consider the request for reconsideration or amendment. *See* TBMP § 1204 and TBMP § 1205.

If the applicant believes that the time is not yet ripe for the filing of a notice of appeal, but has received a final Office action and chooses to file a notice of appeal to preserve its rights, *see* TBMP § 1201.02, the applicant should advise the Board that it believes the final Office action is premature and, if the applicant has filed a petition on this issue, it should so inform the Board. When the notice of appeal is filed electronically through ESTTA, the applicant, after the appeal has been instituted and the electronic system has been updated, (normally 24 hours after the filing of the notice of appeal), should file through ESTTA, using the "document in a Board proceeding" menu, and checking the box for "Other Motions/Papers," an additional paper advising the Board that the final action is premature or that there is a pending petition on this issue. In the rare circumstance when the notice of appeal is submitted as a paper filing, the applicant should advise the Board in the notice of appeal of its belief that the final action is premature, or that it has filed a petition.

NOTES:

1. *See* 37 C.F.R. § 2.126(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69966, 69970 (Oct. 7, 2016) ("The Office is amending § 2.195(d)(3) by deleting the option of filing notices of ex parte appeal by facsimile. This is a conforming amendment to align § 2.195(d)(3) with the final rules requiring that all filings with the Board be through ESTTA.").

2. *See* 37 C.F.R. § 2.126 for general requirements for submissions to the Board. *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("Such explanations must include the specific facts underlying the inability to file by ESTTA, rather than a mere conclusory statement that technical problems or extraordinary circumstances prevented the use of ESTTA.").

3. *See* 37 C.F.R. § 2.193(a)(2); TMEP § 611.01(c).

4. *See* TMEP § 601.02, TMEP § 604.01 and TMEP § 611.05 *et seq.*

5. *Cf.* 37 C.F.R. § 2.119(e).

1202.04 Appeal Fee

37 C.F.R. § 2.141 ***Ex parte appeals from action of trademark examining attorney.***

(a) *An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

(b) *The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.*

Because filing through ESTTA is mandatory, fees are collected at the time of filing. However, the following addresses circumstances where fees accompanying paper filings are, in whole or in part, deficient. An ex parte appeal to the Board is taken by timely filing in the Office both a notice of appeal and the prescribed appeal fee for each class for which the appeal is taken. [Note 1.] If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. *See* TBMP § 1202.01. In such circumstance, however, the applicant may file a petition to revive. [Note 2.] Further, if a party fails to timely file an appeal fee but has previously given a general authorization to charge all fees that may become due during the pendency of an application to a deposit account, such authorization will be accepted, provided that the deposit account contains sufficient funds. [Note 3.]

The amount of the fee required for an ex parte appeal to the Board is specified in 37 C.F.R. § 2.6(a)(18). If an application in which an appeal is filed has more than one class of goods and/or services [Note 4.] the required fee must be paid for each class in which appeal is taken. [Note 5.] If an appeal is taken in, and an appeal fee is submitted for fewer than all of the classes in the application, the class or classes in which the appeal is taken should be specified. [Note 6.] If the final requirement or refusal does not pertain to all classes in the application, the appeal fee need be submitted only for those classes for which a final requirement or refusal has issued. TBMP § 1202.05.

If an applicant timely submits a fee sufficient to pay for an appeal in at least one class, but the fee submitted is less than the required amount because multiple classes in an application are involved, and the applicant has not specified the class or classes to which the submitted fee applies, the Board will issue a written notice allowing the applicant until a set time in which to submit the required fee or to specify the class or classes appealed. If the required fee is not submitted, or the specification made, within the time set in the notice, the fee submitted will be applied to the classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which sufficient fees have been submitted. [Note 7.]

NOTES:

1. 37 C.F.R. § 2.141.

2. *See generally,* TMEP § 1714. *See also* TMEP § 1704.

3. 37 C.F.R. § 2.208(b).

4. *See* 37 C.F.R. § 2.86 and 37 C.F.R. § 2.141(b).

5. 37 C.F.R. § 2.6(a)(18).

6. *See* 37 C.F.R. § 2.141(b) and TMEP § 1403.06.

7. 37 C.F.R. § 2.141(b).

1202.05 Multiple Class Applications

If an application contains multiple classes, and the final refusal or requirement pertains to some but not all of the classes, an applicant may choose to file an appeal for the application as a whole, or it may choose to file a request to divide the application. [Note 1.] See TBMP § 1205.02 regarding requests to divide. In the former case, the classes for which an appeal has not been taken remain part of the application. After a decision on the appeal is rendered, the classes that were not part of the appeal (and those classes for which the refusal or requirement was reversed) will be published for opposition or, in the case of an application on the Supplemental Register, will proceed to registration. If a request to divide is filed along with a notice of appeal, the appeal will be suspended until action is taken on the request to divide. Those classes for which there is no final requirement or refusal, and which have been divided out, will immediately proceed to publication or, in the case of an application on the Supplemental Register, to registration, and will not be delayed pending a decision on the appeal.

Similarly, if a final refusal or requirement pertains to some but not all of the goods or services listed in a single class, the applicant may either file an appeal for the class as a whole, or request that the goods or services for which no final refusal or requirement has been made be divided out of the application, in effect creating two applications for a single class of goods or services. If no request to divide is filed, after the appeal is decided, the application containing those goods or services for which no refusal or requirement was made (as well as the other goods or services in the class if the refusal was reversed) will be published for opposition or, in the case of an application on the Supplemental Register, will proceed to registration. If the goods or services for which no refusal or requirement was made were divided out of the parent application and into a child application, the child application will immediately proceed to publication or, in the case of an application on the Supplemental Register, to registration. *See* TBMP § 1205.02.

If the final refusals or requirements do not apply to all the classes in a multiple class application, an appeal fee is required only for those classes for which the appeal is taken, that is, those classes for which a final refusal or requirement is made. This is true whether or not the applicant requests that the application be divided.

If the applicant decides to file an appeal for fewer than all the classes in the application for which final refusals or requirements have issued, the applicant should indicate in the notice of appeal the classes for which the appeal is taken. See TBMP § 1202.04 regarding insufficient appeal fees for all classes in the application to which final refusals or requirements pertain.

NOTES:

1. *See* 37 C.F.R. § 2.87.

1203 Appeal Briefs

If the ground or one of the grounds for refusal is likelihood of confusion with a registered mark, it is suggested, before the applicant and the examining attorney file their respective briefs, that they check the records of the Office to ascertain whether the cited registration has been cancelled or has expired.

For information about requesting suspension pending a determination as to whether a cited registration has been cancelled or has expired, see TBMP § 1213. See TBMP § 1212 regarding cancellation or assignment of a cited registration.

1203.01 Form of Brief

37 C.F.R. § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:*

(1) *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*

(2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*

(3) *If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*

(4) *A paper submission must not be stapled or bound;*

(5) *All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);*

(6) *Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

(c) *To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(f) must be submitted using the "Confidential" selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.*

37 C.F.R. § 2.142(b)(2) *Briefs must meet the requirements prescribed in § 2.126, except examining attorney submissions need not be filed through ESTTA. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A*

reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety. Unless authorized by the Board, no further briefs are permitted.

37 C.F.R. § 2.142(b)(3) *Citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.*

A brief filed in an ex parte appeal to the Board must conform to the requirements of 37 C.F.R. § 2.142(b)(2) as well as the general requirements for submissions to the Board specified in 37 C.F.R. § 2.126, including that the brief be double spaced. [Note 1.]

Only one copy of the brief should be submitted. The twenty-five page limit for an appeal brief and the ten page limit for a reply brief do not refer to any exhibits attached to the briefs. However, appendices or exhibits to a brief may not be used to avoid the page limitation. [Note 2.] Material that was not previously made of record should not be submitted with the appeal brief. *See* TBMP § 1203.02(e) and TBMP § 1207.01. Also, the appeal brief is associated with the application file, so papers that are already in the application should not, as a matter of course, be resubmitted as exhibits to the brief. [Note 3.] Most appeal briefs are far less than the twenty-five pages allowed by the rule and, given the limited issues and record in an appeal, the Board will rarely grant a motion for leave to exceed the twenty-five page limit or ten page limit in the case of a reply brief. [Note 4.] If an applicant files a brief that exceeds the twenty-five page limit or a reply brief that exceeds the ten-page limit without prior leave of the Board, the brief will not be considered. If the deadline for filing a brief has not passed, applicant may file a conforming substitute brief together with a motion to accept its substitute brief. The failure to file a conforming appeal brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal. [Note 5.] In such a situation, the examining attorney will still file his or her brief, and the applicant may file a reply brief, although the reply brief must be limited to arguments that reply to the arguments made in the examining attorney's brief; it may not be used as a substitute for a main brief, and any arguments that are not properly the subject of a reply brief will not be considered.

The brief should indicate that it is an appeal brief, and include information identifying the application in which it is filed, namely, the applicant's name, the serial number and filing date of the application, and the mark sought to be registered. [Note 6.] When referring to the record, the applicant and examining attorney should cite to the prosecution history for the application, currently the TSDR database. Citation format should be by date, name of the paper under which the evidence was submitted and the page number in the electronic record, for example: November 4, 2013 Office Action, TSDR p. 2. The Examining Attorney and applicant may cite to the TSDR record in .pdf format, but must indicate that they are doing so in their brief. [Note 7.] Where appropriate, reference to the TTABVUE entry and page number, e.g., 1 TTABVUE 2, should also be used. [Note 8.] Case citation should include a citation to The United States Patent Quarterly (USPQ) if the case has appeared in that publication. *See* TBMP § 101.03 and TBMP § 1203.02(f). [Note 9.] The brief need not include the formal requirements, such as a table of contents and description of the record, of a trial brief. [Note 10.] If such items are included, however, they will count as part of the twenty-five page limit.

If a great deal of evidence has been submitted during the examination/prosecution of the application, in the respective briefs, the applicant and the examining attorney are encouraged to highlight the most probative evidence. [Note 11.]

The content of the brief should not include a proposed amendment, a request for remand, or a request for an oral hearing. [Note 12.] Such requests should be filed by separately captioned papers or the Board might not consider them. *See* TBMP § 1205.01, TBMP § 1207.02 and TBMP § 1216.

For further information concerning the form and contents of the examining attorney's appeal brief, in particular, see TMEP Appendix A.

Briefs must be filed through ESTTA. [Note 13.] If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, briefs may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 14.]

NOTES:

1. In some instances, an examining attorney appeal brief may mistakenly appear to exceed the 25-page limitation in TTABVUE, the Board's online docketing system. *See, e.g., In re Sela Products LLC*, 107 USPQ2d 1580, 1585 (TTAB 2013) (examining attorney appeal brief complied with page limitation). *Cf. In re Cordua Restaurants LP*, 110 USPQ2d 1227, 1229 n.2 (TTAB 2014) ("The Board notes that applicant's appeal brief was single-spaced. Trademark Rule 2.126(b) 37 C.F.R. § 2.126(b) requires all briefs submitted to be double-spaced."), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). *But see In re University of Miami*, 123 USPQ2d 1075, 1077 n.2 (TTAB 2017) (Board exercised its discretion to consider applicant's appeal brief and reply that were not double-spaced because it appeared that they would fall within the applicable page limits had they been double-spaced).

2. *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (applicant's attempt to submit discussion as an appendix to brief treated by Board as an attempt to circumvent the Board's order denying waiver of page limitation, and sanctions imposed); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (appendices may not be used as a subterfuge to avoid the page limitation).

3. *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief copies of the same exhibits submitted with responses is discouraged); *In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) ("It is of far more utility to the Board for the applicant and examining attorney to provide citations directly to the record and, when there are a large number of attachments to an Office action or response, to the specific page number where the attachment may be found."); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (no need to attach additional copies to appeal brief of materials already of record; examining attorney's objections to the duplicative exhibits is overruled because striking the materials already of record would be pointless), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires Board to determine whether attachments had been properly made of record); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary).

4. *See In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (applicant's request for a waiver in order to include an additional 10 pages denied).

5. *See In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (Board refused to consider applicant's 29-page brief).

6. *Cf.* TMEP § 302.03(a).

7. *Cf. In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1797 n.5 (TTAB 2017) (Board in its opinion cited to the TSDR record in .pdf format).

8. 37 C.F.R. § 2.142(b)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is adding new § 2.142(b)(3) to specify that citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record. The amendment is intended to facilitate review of record evidence by the applicant, the examining attorney, the Board, and the public.").

9. *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).

10. *Cf.* 37 C.F.R. § 2.128(b).

11. *See In re Michalko*, 110 USPQ2d 1949, 1951-52 (TTAB 2014) ("Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.") (citing this section)); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011) (attachment to brief of hundreds of pages of exhibits already of record not helpful; instead it would have been helpful to identify, by date of submission and page number in Office's TDR database, the material being referenced in the brief); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011) (Board would be very critical if examining attorney were to submit an inordinate number of registrations); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("The Board frowns equally upon an applicant or examining attorney submitting hundreds of pages of evidence in the hope that as the Board wades through it we will find something that is probative. When they believe that it is necessary to submit a significant amount of such material, it is incumbent on the applicant and the examining attorney to specify in their briefs those pieces of evidence that they believe are most persuasive of their respective positions, so that the Board can consider that evidence in particular."); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1585 n.5 (TTAB 2007) ("submitting a large number of third-party registrations without highlighting particularly relevant ones in the appeal brief is not helpful").

12. *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1859 (TTAB 2014) ("To the extent applicant seeks to request remand for such consideration by the examining attorney, burying this request in its reply brief is not sufficient for the Board to treat it as a request for remand."); *In re Future Ads LLC*, 103 USPQ2d 1571, 1573 (TTAB 2012) (claim of acquired distinctiveness raised for first time in reply brief should have been made in a separate request for remand); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010) (request for remand should be filed by a separate paper, appropriately captioned "Request for Remand," rather than by a request buried within a paragraph in the middle of a brief).

13. *See* 37 C.F.R. § 2.126(a).

14. *See* 37 C.F.R. § 2.126(b). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("Such explanations must include the specific facts underlying the inability to file by ESTTA, rather than a mere conclusory statement that technical problems or extraordinary circumstances prevented the use of ESTTA.").

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 C.F.R. § 2.142(b)(1) *The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examining attorney shall, within sixty days after the brief of appellant is sent to the examining attorney, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.*

An applicant's main brief in an ex parte appeal to the Board must be filed within sixty days from the date of appeal, or within an extension of time for that purpose. The time for filing the brief is set by rule; filing the notice of appeal through ESTTA automatically generates an acknowledgment; however, in the rare circumstances a notice of appeal is filed in paper with the required written explanation, although the Board attempts to send the applicant an acknowledgement of the receipt of the notice of appeal which indicates the date the brief is due, the failure to receive such acknowledgement does not affect the deadline for such filing. [Note 1.] If no brief is filed, the appeal will be dismissed. [Note 2.] If the brief is filed late, the applicant will be allowed an opportunity to submit an explanation for the late filing; in the absence of an adequate explanation, the appeal will be dismissed. The determination of whether to accept the brief will depend on the circumstances, including the length of time after the due date that the brief is filed, and the reason for the delay.

If the appeal is dismissed for failure to file a timely brief and no timely request to vacate the dismissal has been filed, the applicant's recourse is to file a petition to the Director under the provisions of 37 C.F.R. § 2.146(a)(3). Because such a petition invokes the supervisory authority of the Director, it is determined under the clear error/abuse of discretion standard, that is, whether the Board has committed clear error or abused its discretion in its determination not to accept the late-filed brief. [Note 3.] The applicant should not file a petition to the Director until it has first filed with the Board a request/motion to accept the late-filed brief, and that request/motion has been denied.

Further, a petition to revive is not available when an applicant has failed to file an appeal brief or has filed its appeal brief late. The petition to revive procedure provided in 37 C.F.R. § 2.66(a) applies only to situations in which the applicant did not timely respond to an Office action or notice of allowance. The filing of an appeal brief is not a response to an Office action. Thus, the "unintentional delay" standard of 37 C.F.R. § 2.66(a) does not apply to the determination of whether a late-filed brief will be accepted. [Note 4.]

In the rare circumstances a notice of appeal (accompanied by the required fee) is filed in paper with the required written explanation and with a certificate of mailing by first-class mail pursuant to 37 C.F.R. § 2.197, or the Priority Mail Express® procedure described in 37 C.F.R. § 2.198, the date of mailing specified in the certificate will be used for determining the timeliness of the notice of appeal. However, the actual date of receipt of the notice of appeal in the Office will be used for all other purposes, including the running of the time for filing the applicant's main brief. [Note 5.] TBMP § 111.01 and TBMP § 111.02.

The following applies to situations in which an applicant files a notice of appeal when it has also filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, and the examining attorney has not yet considered the request for reconsideration when the appeal is filed, or when the applicant files a request for reconsideration along with the notice of appeal. When the applicant files its notice of appeal through ESTTA, it should check the box that indicates that a

request for reconsideration is also being filed. ESTTA will electronically generate the order acknowledging receipt of the appeal and request, suspend further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, and remanding the application to the examining attorney for consideration of the request. The request for reconsideration should be filed through TEAS. In the rare circumstances the notice of appeal is a paper submission, the notice of appeal should indicate, in the body of the appeal, that there is a pending request for reconsideration; if a request for reconsideration is being filed contemporaneously with the paper submission of the notice of appeal, it should accompany the notice of appeal. When the written explanation for paper filing is acceptable, proceedings in the appeal will automatically be suspended when a request for reconsideration is pending; the applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 C.F.R. § 2.142(b)(1), even if the Board has not issued its order suspending proceedings prior to the date the appeal brief would otherwise be due. Nor does the applicant need to verify with the Board that the due date for its brief will be changed if necessary. [Note 6.] *See* TBMP § 1204.

If, upon the examining attorney's consideration of the request for reconsideration, all refusals and requirements are not withdrawn, and a new final refusal or action maintaining the finality of a prior Office action is issued (either in the examining attorney's action on the request for reconsideration, or in a subsequent action), the six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal if instituted will be resumed; and the applicant will be allowed time in which to file its appeal brief. *See* TBMP § 1205 for the procedure when the request for reconsideration contains an amendment. If the examining attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. [Note 7.]

NOTES:

1. *In re Live Earth Products Inc.* , 49 USPQ2d 1063, 1064 (TTAB 1998). *See also* 37 C.F.R. § 2.126(b); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("In these situations, parties should consider any such paper filing accepted unless the Board indicates otherwise. … The Board will review the explanation accompanying the paper filing in its consideration of the filing, and submissions that do not meet the technical problems or extraordinary circumstances showing will not be considered.").

2. 37 C.F.R. § 2.142(b)(1)

3. *See* TMEP § 1706.

4. *See* TMEP § 1714.01(f)(i)(E).

5. *See* 37 C.F.R. § 2.197; 37 C.F.R. § 2.198. Many documents that are filed in connection with the prosecution of an application, including the application itself and an amendment to allege use, may not be filed using the "Priority Mail Express" procedure. *See* TMEP § 305.03. However, the "Priority Mail Express®" procedure is available for filing a notice of appeal.

6. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

7. *See* TMEP § 715.04.

1203.02(b) Trademark Examining Attorney's Brief

When the applicant's main appeal brief has been received by the Board, the Board sends the application to the examining attorney for preparation of a brief. Within 60 days after the date of the Board's written order forwarding the application to the examining attorney, or within an extension of time for the purpose, the examining attorney must file an appeal brief answering the applicant's main brief. [Note 1.] The examining attorney must also send a copy of his or her brief to the applicant. [Note 2.] If the examining attorney's brief is late-filed, the Board may exclude it in the absence of an adequate explanation for the late filing. [Note 3.] An examining attorney's failure to file a brief will not result in the application being approved; the Board will simply decide the appeal without the benefit of the brief.

If the examining attorney, having received the application for preparation of his or her appeal brief, is persuaded by the applicant's appeal brief that the applicant is entitled to the registration sought, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should notify the applicant and Board by telephone or email. [Note 4.] If there is more than one ground of refusal or requirement and the examining attorney determines that one ground or requirement is no longer tenable, the examining attorney should state in his or her appeal brief that the refusal or requirement has been withdrawn. [Note 5.] The appeal will then go forward on the remaining ground(s)/requirement(s). **Please Note:** Even if the examining attorney does not specifically state in the appeal brief that the refusal or requirement has been withdrawn, the Board may treat the refusal/requirement to have been withdrawn if no mention is made of it in the brief. *See* TBMP § 1203.02(g).

On the other hand, the examining attorney, having received the application for preparation of his or her appeal brief, may decide that registration should be refused on an additional ground, or that a new requirement should be made, or that the application should be suspended. In that event, the examining attorney, during the time for and instead of preparing an appeal brief, should send to the Board, with a copy to the applicant, a written request that the application be remanded to him or her for further examination. For information concerning requests for remand, see TBMP § 1209.02 and TMEP § 1504.05. [Note 6.] However, an examining attorney need not request remand in order to make a new argument or change the rationale for a refusal or requirement, as that is not considered to be a new refusal or requirement. [Note 7.] If a request for remand is denied, the Board will reset the examining attorney's time in which to file an appeal brief. [Note 8.] However, if the examining attorney submits a request for remand in order to make a new refusal or requirement, it is the general practice of the Board to grant such a request. *See* TBMP § 1209.02. If the request is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the examining attorney for further examination in accordance with the request for remand. If, during the course of the further examination, the application is ultimately approved for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. If the examining attorney refuses registration on a new ground, or makes a new requirement, and the new refusal or requirement is ultimately made final, the new final action should not include a six-month response clause; the application should be returned to the Board; and the Board will resume proceedings with respect to the appeal and allow the applicant 60 days in which to submit a supplemental appeal brief directed to the new issue or issues, following which the application will be returned to the examining attorney for preparation of his or her appeal brief.

NOTES:

1. 37 C.F.R. § 2.142(b)(1); *In re Wells Fargo & Co.*, 231 USPQ 106, 107 n.2 (TTAB 1986); *In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188 n.3 (TTAB 1984); TMEP § 1501.02. *See also In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

2. 37 C.F.R. § 2.142(b)(1). *See In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475, 1476 n.3 (Fed. Cir. 1993).

3. *See In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188, 188 n.3 (TTAB 1984).

4. *See* TMEP § 1501.03.

5. *See* TMEP § 1501.03.

6. 37 C.F.R. § 2.142(f)(6); TMEP § 1501.02. *Cf. In re Dietrich*, 91 USPQ2d 1622, 1624 (TTAB 2009) (to the extent examining attorney attempted to reject Trademark Act § 2(f) claim for the first time in appeal brief, rejection untimely and not considered); *In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (ground for refusal first raised in examining attorney's appeal brief given no consideration).

7. *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007). *Cf. In re Future Ads LLC*, 103 USPQ2d 1571, 1573 (TTAB 2012) (while examining attorney need not limit arguments made in appeal brief to those raised in Office actions, using the evidence for a totally different purpose not hinted at in the Office actions was unfair based on circumstances of case).

8. *See In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

1203.02(c) Applicant's Reply Brief

Within 20 days from the issue date of the examining attorney's appeal brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief that shall not exceed ten pages in length in its entirety. [Note 1.] However, the filing of a reply brief is not mandatory.

The reply brief should not include a proposed amendment, a request for remand, or a request for an oral hearing, within the body of the brief. [Note 2.] Such requests should be filed by separately captioned submissions. *See* TBMP § 1205.01, TBMP § 1207.02 and TBMP § 1216.

If the applicant files a reply brief, the Board will notify the examining attorney. If the examining attorney, having read the applicant's reply brief, is persuaded thereby that the applicant is entitled to the registration sought, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should notify the applicant and Board by telephone or email. [Note 3.]

There is no provision in the rules for the filing by the examining attorney of a written response to the applicant's reply brief. However, if the applicant requests an oral hearing, the examining attorney may respond orally, at the oral hearing, to arguments raised in the applicant's reply brief. [Note 4.] Unless instructed or ordered by the Board, supplemental briefs filed after an oral hearing will not be considered. [Note 5.] For further information regarding oral hearings, see TBMP § 1216.

NOTES:

1. *See* 37 C.F.R. § 2.142(b)(1), 37 C.F.R. § 2.142(b)(2); *In re Gena Laboratories, Inc.*, 230 USPQ 382, 383 n.4 (TTAB 1985); *In re Randall & Hustedt*, 226 USPQ 1031, 1033 n.2 (TTAB 1985). *Cf. In re Gale Hayman Inc.*, 15 USPQ2d 1478 n.3 (TTAB 1990). *See also* MISCELLANEOUS CHANGES TO

TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(b)(2) to … add [ ] that a reply brief from an appellant shall not exceed ten pages in length and that no further briefs are permitted unless authorized by the Board.").

2. *See In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1859 (TTAB 2014) ("To the extent applicant seeks to request remand for such consideration by the examining attorney, burying this request in its reply brief is not sufficient for the Board to treat it as a request for remand."). TMEP § 1501.03.

3. *See* TMEP § 1501.03.

4. *See* TMEP § 1501.02(c). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69960, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(b)(2) to … add [ ] that a reply brief from an appellant shall not exceed ten pages in length and that no further briefs are permitted unless authorized by the Board.").

5. *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1778 n.3 (TTAB 2017) (Board refused to consider unauthorized supplemental brief filed after oral hearing), *on appeal*, No. 17-2392 (Fed. Cir. August 3, 2017).

1203.02(d) Extension of Time for Filing Brief

An extension of time for filing an appeal brief in an ex parte appeal to the Board may be granted by the Board upon written request showing good cause for the requested extension. [Note 1.] The determination of good cause will be based upon all relevant circumstances, including the length of time of any previously granted extensions and the reason(s) for the requested extension(s). Thus, a reason such as the press of other business, which may be sufficient to show good cause for a first extension of thirty days, may not be sufficient for a second extension of time. Depending on the totality of the circumstances, good cause has been found when there has been an appointment of a new attorney, illness, the need to get instructions from a foreign applicant, and attempting to negotiate a consent agreement. If a request is found not to be sufficient to warrant an extension, the Board may allow applicant a limited period of time, such as ten days, in which to file the appeal brief, or may grant the requested extension, but advise that no further extensions will be granted absent a showing of extraordinary circumstances.

NOTES:

1. *See In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985). *See also In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188, 188 n.3 (TTAB 1984).

1203.02(e) Material Submitted with Briefs

The record in the application should be complete prior to the filing of an appeal. [Note 1.] *See* TBMP § 1207.01. It is not necessary to attach as exhibits to a brief evidence that is already in the application because the appeal brief is associated with the application. Such evidence should not, as a matter of course, be resubmitted as exhibits to the brief. *See* TBMP § 1203.01.

Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered. [Note 2.] *See* TBMP § 1207.01. However, if the examining attorney, in his or her brief, discusses the exhibits attached to the applicant's brief without objecting to them, or if the applicant

discusses, in its reply brief, exhibits attached to the examining attorney's brief without objection, they will be deemed to have been stipulated into the record and will be considered. *See* TBMP § 1207.03.

Evidentiary references made in briefs but not supported by timely submissions may not be considered. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.142(d).

2. *See In re Minerva Associates, Inc.*, 125 USPQ2d 1634, 1636 n.9 (TTAB 2018) (applicant's copy of specimen filed in its co-pending application attached to appeal brief not considered); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (copy of patent excerpt submitted with appeal brief not considered); *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of registrations with appeal brief sustained); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013) (copies of documents pertaining to district court litigation submitted with applicant's appeal brief not considered); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (exhibits attached to applicant's supplemental brief not considered; noted that evidence could have been submitted during the period of further examination after remand); *In re City of Houston*, 101 USPQ2d 1534, 1536-37 (TTAB 2012) (copies of third-party registrations submitted for first time with reply brief are untimely and will not be considered, but list of such registrations submitted during examination will be considered for whatever limited probative value it has), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re District of Columbia*, 101 USPQ2d 1588, 1591-92 (TTAB 2012) (third-party registrations submitted for first time with appeal brief are not considered), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011) (materials submitted with reply brief, after two requests for remand were denied, were not of record and, because reply brief discussed materials at length, reply brief also not considered); *In re Brouwerij Bosteels*, 96 USPQ2d 1414 (TTAB 2010) (exhibits attached to applicant's supplemental reply brief not considered); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1322 (TTAB 2010); *In re Quantum Foods Inc.*, 94 USPQ2d 1375, 1377 n.2 (TTAB 2010) (page from applicant's website submitted with appeal brief not considered); *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009) (third-party registrations and excerpt from registrant's website submitted with supplemental appeal brief not considered); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (submissions with reply brief not considered); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 n.3 (TTAB 2008) (previously unsubmitted materials attached to applicant's brief not considered); *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062, 1063 n.2 (TTAB 2008) (exhibits submitted for first time with applicant's appeal brief and declaration attached to reply brief not considered); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007) (entry from online encyclopedia submitted for first time with reply brief untimely and not of record); *In re Genitope Corp.*, 78 USPQ2d 1819 n.3 (TTAB 2006) (materials from applicant's website submitted for first time with examining attorney's brief not considered); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (declaration by applicant's president submitted for first time with applicant's appeal brief not considered); *In re Promo Ink*, 78 USPQ 1301, 1303-04 (TTAB 2006); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Couture*, 60 USPQ2d 1317, 1319 n.3 (TTAB 1999); *In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001) ("By attempting to introduce evidence with its reply brief, applicant has effectively shielded this material from review and response by the Examining Attorney"; material submitted with reply brief not considered); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1446 n.2 (TTAB 2000) (although applicant had properly submitted copies of third-party registrations, additional registrations listed in applicant's brief, which were not commented on by examining attorney in her brief, not considered); *In re Polo International Inc.*, 51 USPQ2d 1061,1062 n.2 (TTAB 1999) (typed list of third-party registrations submitted with applicant's brief which were objected to by

examining attorney, not considered); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1703 n.2 (TTAB 1998) (third-party registrations submitted with reply brief not considered); *In re North American Free Trade Association*, 43 USPQ2d 1282, 1287 n.9 (TTAB 1997) (letter submitted with applicant's brief was not made of record during prosecution, and therefore not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (copy of unpublished case submitted with applicant's reply brief not considered).

Cf. In re Osterberg, 83 USPQ2d 1220, 1221 n.2 (TTAB 2007) ("clean" version, with nonmaterial edits, of declaration submitted during examination that was attached as exhibit to appeal brief considered because the two versions of the declaration substantially the same); *In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1922 n.1 (TTAB 2004) (although applicant submitted new evidence with its brief, subsequently examining attorney was granted remand of application, and therefore examining attorney had opportunity to consider this evidence and respond thereto; exhibit was considered of record).

3. *See In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120 (TTAB 2012) (applicant withdrew references in brief to third-party registrations it inadvertently failed to attach to responses during examination; applicant's footnote reference to a journal not considered because it was being offered for its evidentiary value on evidence not properly introduced).

1203.02(f) Cases Which May Be Cited

Prior to January 23, 2007, the Board's policy had been that decisions which were not designated as "citable as precedent" or "for publication in full" were not citable authority. [Note 1.] Since January 23, 2007, the Board has permitted citation to any Board decision, although a decision designated as not precedential is not binding upon the Board. [Note 2.] *See* TBMP § 101.03.

When cases are cited in a brief, the case citation should include a citation to the USPQ if the case has appeared in that publication. [Note 3.] *See* TBMP § 101.03 andTBMP § 801.03.

NOTES:

1. *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001); *In re Polo International Inc.*, 51 USPQ2d 1061, 1063 n.3 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992).

2. *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (Jan. 23, 2007). *See In re Morrison & Foester LLP*, 110 USPQ2d 1423, 1427, n.6 (TTAB 2014) ("Although parties may cite to non-precedential decisions, the Board does not encourage the practice.); *In re the Procter & Gamble Co.*, 105 USPQ2d 1119, 1120-21 (TTAB 2012) (citation to non-precedential opinions permitted but not encouraged; non-precedential decisions not binding on the Board).

3. *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).

1203.02(g) Waiver of Claim or Requirement in Brief

If an applicant, in its appeal brief, does not assert an argument made during prosecution, it may be deemed waived by the Board. [Note 1.] Similarly, if an applicant, in its appeal brief, complies with a requirement and the examining attorney does not discuss the requirement, or if the examining attorney does not discuss a ground for refusal in his or her brief, the requirement or refusal may be deemed withdrawn. *See* TBMP

§ 1203.02(b). [Note 2.] However, if an applicant seeks to comply with a requirement, the better practice is to request remand rather than simply offering the amendment as part of its brief. *See* TBMP § 1205.

NOTES:

1. *See In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.2 (TTAB 2001) (applicant did not, in its appeal brief, pursue claim of inherent distinctiveness, and therefore the claim was not considered by Board). *See also In re Harley*, 119 USPQ2d 1755, 1758 (TTAB 2016) (Applicants' failure to address refusals is a basis for affirming the examining attorney's refusal on all grounds); *In re E5 LLC*, 103 USPQ2d 1578, 1579 n.1 (TTAB 2012) (during prosecution, applicant argued that mark was unitary but did not maintain argument in its appeal brief). *Cf. In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1852 n.31 (TTAB 2012) (applicant mentioned claim of acquired distinctiveness in original appeal brief but not again in supplemental appeal brief; because the examining attorney addressed the point in supplemental brief, Board considered the claim).

2. *See In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1512 n.2 (TTAB 2001) (requirement for translation deemed moot because applicant, in its appeal brief, offered translation, and examining attorney, in her appeal brief, did not address issue).

1204 Effect of Request for Reconsideration of Final Action

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence. [Note 1.] However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate). [Note 2.] TBMP § 1201.02 and TBMP § 1201.05. If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. [Note 3.] TBMP § 1202.02. Thus, if an applicant which has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant also must file an appeal prior to the expiration of the six-month period following issuance of the final action.

When an applicant files, in response to a final action or a second refusal on the same ground(s), or a repeated requirement, both a request for reconsideration and an appeal, the request for reconsideration should be made by separate submission and should specify the reasons why the applicant believes reconsideration is warranted. The request for reconsideration should not be combined in the body of the notice of appeal. When the notice of appeal is filed through ESTTA, the applicant should check the box stating that a request for reconsideration has been filed. The request for reconsideration should be filed separately through TEAS. In the rare circumstances the notice of appeal is a paper submission, the applicant should indicate, in the notice of appeal, that a request for reconsideration has also been filed. *See* TBMP § 1202.03.

A request for reconsideration filed more than six months from a final action is treated by the Board as a request for remand. *See* TBMP § 1209.04. Further, once briefing has begun, a request for reconsideration, even if filed within six months of a final action, is treated as a request for remand. As with a request for reconsideration, a request for remand should not be combined with the applicant's appeal brief, but should be made by a separate document. [Note 4.]

When an applicant which has filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, also files a timely appeal through ESTTA and checks the

"request for reconsideration" box on the ESTTA form, the system will automatically generate an order instituting the appeal, suspending further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, and remanding the application to the examining attorney for consideration of the request.

In the rare circumstances the applicant files its notice of appeal as a paper submission and also files a request for reconsideration, or has a request for reconsideration pending, the notice of appeal should indicate this. When the written explanation for paper filing is acceptable, a Board paralegal will then send the applicant an order, to the same effect as the order automatically generated when the notice of appeal is filed through ESTTA. However, because the order is not automatically generated, it will not issue immediately. Where an applicant has timely filed both a notice of appeal on paper and a request for reconsideration, but has not heard from the Board within sixty days with regard to the appeal and reconsideration request, the applicant should not file its appeal brief. [Note 5.] Rather, it may assume that the Board will institute the appeal, if the written explanation for the paper filing is acceptable, and then suspend proceedings and remand the application to the examining attorney, so that the due date for the appeal brief will be reset in the event that the examining attorney denies the request for reconsideration. [Note 6.] The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary. [Note 7.] TBMP § 1203.02(a). However, the applicant may wish to make a status inquiry with the Board if it has not received an institution and suspension order within sixty days of the filing of the notice of appeal.

If the request for reconsideration raises a new issue, the examining attorney must give the applicant an opportunity to respond before issuing a new final refusal and returning the application to the Board. New issues are typically raised by a request for reconsideration which amends the application to seek registration under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f), or to seek registration on the Supplemental Register, or to amend the identification of goods or services, if a requirement for an acceptable identification of goods or services was not the subject of the final Office action. See TBMP § 1201.02 for examples of new issues that would preclude the issuance of a final action. [Note 8.] If the examining attorney believes that the outstanding issue(s) can be resolved, the examining attorney may contact the applicant and attempt to work out a resolution. [Note 9.]

In the rare circumstance when an applicant files its notice of appeal and a request for reconsideration at the same time by a paper submission, the examining attorney occasionally may act on the request for reconsideration before the Board can institute the appeal and remand the application. In that event, if the notice of appeal filed in paper form is accepted, the Board will institute the appeal after the examining attorney acts on the request for reconsideration. Depending on the action the examining attorney has taken, the Board will either remand the application to the examining attorney (generally to await the applicant's response to a nonfinal Office action) or, if the examining attorney has denied the request for reconsideration, will proceed with the appeal, and allow the applicant 60 days from the issue date of the Board order in which to file its appeal brief. [Note 10.] The date for filing the appeal brief is reset in this situation because the applicant, at the time it filed its notice of appeal and request for reconsideration, had the expectation that the Board would follow its normal procedure and suspend proceedings in the appeal. [Note 11.]

If, after suspension and remand for consideration by the examining attorney of a timely request for reconsideration, the examining attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. The applicant will receive notification of the approval for publication when the Office issues a computer-generated notice of publication. The applicant may also ascertain the status of the application by checking the TSDR database. If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and a new final refusal to register or action maintaining the finality of a prior Office action is issued (either in the examining attorney's action on the request for reconsideration, or in a subsequent action), the six-month

response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and the applicant will be allowed time in which to file its appeal brief. The examining attorney must, prior to returning the application to the Board to resume proceedings in the appeal, issue a written Office action apprising the applicant of that fact, indicating the examining attorney's withdrawal and maintenance of any refusals or requirements and acceptance of any amendments; it is not sufficient to make a note in the application file and return the application to the Board. The new final Office action does not give the applicant an automatic right to file a request for reconsideration, as is the case with a first final Office action; a request for reconsideration may only be filed during the period between issuance of a final action and expiration of the time for filing an appeal therefrom, and because an appeal had previously been filed, any request for further consideration of the application by the examining attorney must be by a request for remand, for which good cause must be shown. *See* TMEP § 715.04(b). [Note 12.]

If an appeal is late-filed, but the applicant timely filed a request for reconsideration, the Board will issue an order informing the applicant of the lateness of its appeal, stating that the late appeal cannot be entertained by the Board, and forwarding the application to the examining attorney for consideration of the request for reconsideration. *See* TBMP § 1202.02.

A timely request for reconsideration of an appealed action may be accompanied by an amendment and/or by additional evidence. *See* TBMP § 1207.04. The evidentiary record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal normally will be given no consideration by the Board. [Note 13.] *See* TBMP § 1207. The Board will regard additional evidence a proper part of the record on appeal if it is submitted, together with a request for reconsideration, before the expiration of the six-month response period, even if it is submitted after the notice of appeal is filed. [Note 14.] However, if the examining attorney denies a request for reconsideration filed with a notice of appeal, a second request for reconsideration will be treated as a request for remand even if it is filed within six months of the final Office action, and therefore additional evidence filed with the second request will become part of the record only if the request for remand is granted upon a showing of good cause. *See* TBMP § 1207.02 and TBMP § 1209.04.

If the examining attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new action, the examining attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought. [Note 15.] Unless the action is a nonfinal action, the applicant may not submit additional evidence, even in response to evidence submitted by the examining attorney. If the applicant wishes to submit additional evidence, it must file a request for remand. [Note 16.] TBMP § 1207.02 and TBMP § 1209.04.

For more information about requests for reconsideration filed after issuance of a final action but before filing of a notice of appeal, see TMEP § 715.03. For more information about requests for reconsideration filed in conjunction with a notice of appeal, see TMEP § 715.04. For more information about requests for remand, see TBMP § 1209.02.

NOTES:

1. *See* 37 C.F.R. § 2.63(b). *See also* TMEP § 715.03; *In re Petroglyph Games, Inc.* , 91 USPQ2d 1332, 1334 (TTAB 2009) (new evidence may be filed with request for reconsideration). Requests for consistency review under the Consistency Initiative do not impact the time to file an appeal or serve to suspend the appeal. In addition, although the request is entered into the application TSDR record, the Office will not respond directly to the request and any evidence submitted with such request will not be considered. See **www.uspto.gov** for further information on the Consistency Initiative.

2. *See* 37 C.F.R. § 2.63(b). *See also* TMEP § 715.03 and TMEP § 715.03(c).

3. *See* 37 C.F.R. § 2.63(b). *See also* TMEP § 715.03.

4. *See In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 (TTAB 1984).

5. Should the applicant file an appeal brief in this situation, the Board will normally remand the application to the examining attorney to consider the request for reconsideration and, if the refusal of registration is maintained or a new final refusal issues, will upon resumption of proceedings in the appeal give the applicant an opportunity to submit a supplemental appeal brief directed to any arguments or evidence in the examining attorney's action. *Cf. In re Husqvarna Aktiebolag*, 91 USPQ2d 1436, 1437 (TTAB 2009) (because Board was not aware of applicant's request for reconsideration which was filed two days before notice of appeal, the order instituting the appeal allowed applicant sixty days to file its appeal brief; examining attorney, unaware of either notice of appeal or appeal brief, issued nonfinal Office action, and subsequently another final refusal, and returned application to Board for resumption of appeal; applicant requested that it be permitted to file second brief, and Board accepted it as operative brief).

6. For information concerning the actions that an examining attorney may take in response to a request for reconsideration of a final action, see TMEP § 715.04, TMEP § 715.04(a) and TMEP § 715.04(b). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992).

7. *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

8. *See* TMEP § 714.05. *See also In re Adlon Brand Gmbh & Co. KG*, 120 USPQ2d 1717, 1725 (TTAB 2016) ("Neither Applicant's new evidence and arguments regarding the outstanding refusal under Section 2(e)(4), submitted with its request for reconsideration, nor the Examining Attorney's submission of additional evidence regarding the same refusal, provided in response to that request, raised a new issue such as to make appropriate a nonfinal Office Action that would have allowed a six-month response period.") (citations omitted).

9. *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1358 13 (TTAB 2013) (Board encourages "open and frank discussion" between applicant and the examining attorney to resolve issue of identification and classification of goods).

10. If an applicant files its notice of appeal through ESTTA and indicates it is filing a request for reconsideration, the appeal will be instituted and the application remanded immediately. However, occasionally the examining attorney will not be aware that an appeal has been filed when he or she acts on the request for reconsideration. Whether the appeal is filed through ESTTA or on paper, if the examining attorney is not aware that a notice of appeal has been filed when he or she acts on the request for reconsideration, the Board will take action on the appeal as indicated above. Because the applicant has already filed a notice of appeal, the applicant may ignore any comment by the examining attorney about filing a notice of appeal made in the denial of a request for reconsideration.

11. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998).

12. Cf. TMEP § 716.02(b) regarding issuance of a new nonfinal Office action when no appeal has been filed.

13. *See* 37 C.F.R. § 2.142(d).

14. *See In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1598 n.4 (TTAB 1999); *In re Corning Glass Works*, 229 USPQ 65, 66 n.5 (TTAB 1985), and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 n.3 (TTAB 1984).

15. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009). *Cf. In re Hughes Furniture Industries Inc.*, 114 USPQ2d 1134, 1135-36 (TTAB 2015) (request for remand to comply with particular requirement did not give examining attorney right to submit evidence in support of refusal that was not subject of remand request).

16. *See* 37 C.F.R. § 2.142(d); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009).

1205 Amendment of Application During Appeal

1205.01 In General

If, within six months following the issuance of a final action, or a second refusal on the same ground(s), or a repeated requirement, an applicant files both an amendment to its application and an ex parte appeal to the Board, and the examining attorney has not yet acted on the amendment when the appeal is filed, the applicant should check the box on the ESTTA notice of appeal form indicating that it has filed a request for reconsideration. In the rare circumstances the notice of appeal is filed as a paper submission, the applicant should indicate in its notice of appeal that it has also filed an amendment, or if it is being filed contemporaneously with the notice of appeal, the amendment should be submitted along with the notice of appeal. *See* TBMP § 1202.03 and TBMP § 1204.

The Board will acknowledge receipt of the amendment and appeal, institute the appeal and suspend further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, *see* TBMP § 1203.02(a), and remand the application to the examining attorney for consideration of the amendment. The Board's remand letter will also include instructions to the examining attorney with respect to the further actions that may and/or should be taken by the examining attorney in conjunction with the examining attorney's consideration of the amendment. [Note 1.] TBMP § 1204. If the examining attorney believes that the outstanding issue(s) can be resolved, the examining attorney may contact the applicant and attempt to work out a resolution. Although the examining attorney may submit evidence with respect to any issues relevant to the amendment, the examining attorney may not assert a new refusal or requirement or submit evidence unrelated to the amendment or material submitted therewith unless the examining attorney files with the Board a request under 37 C.F.R. § 2.142(f)(6) for remand to assert the new refusal or requirement or submit additional evidence, and the request is granted. [Note 2.] *See* TBMP § 1209.02.

When an applicant files a notice of appeal through ESTTA and checks the box that it has filed a request for reconsideration, an order will be electronically generated that institutes the appeal, suspends proceedings in it, and remands the application to the examining attorney for consideration of the amendment/request for reconsideration. Although the notice of appeal is filed through ESTTA, if the applicant is filing an amendment/request for reconsideration contemporaneously with the filing of the notice of appeal, that document should be filed through TEAS, through which responses to Office actions are electronically filed.

In the rare circumstances the notice of appeal is filed by a paper submission, and the applicant has also timely filed an amendment, but has not heard from the Board within sixty days with regard to the appeal and amendment, the applicant should not file its appeal brief. Rather, it may assume that the Board will institute the appeal if the written explanation for paper filing is acceptable, and then suspend proceedings

and remand the application to the examining attorney, so that the due date for the appeal brief will be reset in the event that the amendment does not place the application in condition for publication (or registration, in the case of an application on the Supplemental Register). The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary. [Note 3.] TBMP § 1203.02(a). However, the applicant may wish to make a status inquiry with the Board if it has not received an institution and suspension order within sixty days of the filing of the notice of appeal.

If the examining attorney is persuaded, on the basis of the amendment, that the applicant is entitled to the registration sought, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should notify the applicant and the Board by telephone or email that the amendment has been accepted and the application has been approved. [Note 4.] The applicant will also receive notification that the application has been approved for publication when the Office issues a computer-generated notice of publication; in addition, the applicant may ascertain the status of the application by checking the TSDR database.

If the examining attorney, after consideration of the amendment, accepts the amendment but adheres to the final refusal to register, either because there are other grounds for refusal or requirements which have not been satisfied, or because the amendment, while acceptable, does not obviate the requirement/refusal, the examining attorney should issue a written action to that effect. That is, the Office action should indicate that the amendment has been accepted, and also indicate what refusals/requirements remain. The six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and the applicant will be allowed time in which to file its appeal brief. If the examining attorney refuses to accept the amendment, and the amendment raises a new issue, the examining attorney must allow the applicant an opportunity to respond before issuing a final refusal and returning the application to the Board. Therefore, the first Office action that considers and refuses the amendment must be a nonfinal action, and must include the six-month response clause. See TBMP § 1201.02 and TMEP § 714.05 *et seq.* and TMEP § 715.04(b) regarding amendments which raise new issues.

If an applicant that has filed a timely appeal to the Board files an amendment to its application more than six months after the issuance of the final action, or the second refusal on the same ground(s), or the repeated requirement from which the appeal was taken, the Board will treat the amendment as a request for remand. *See* TBMP § 1209.04. The Board will also treat as a request for remand an amendment filed after the filing of a notice of appeal, even if filed within six months of the final action, if the examining attorney had previously acted on an amendment or request for reconsideration after the filing of the notice of appeal. Similarly, if the amendment is filed along with the applicant's appeal brief or thereafter, even if filed within six months of the final action, the Board will treat the submission as a request for remand. *See* TBMP § 1204. The amendment must accompany the request for remand. Both the request and the amendment should be submitted through ESTTA. The amendment should not be filed separately through TEAS.

A request for remand to consider an amendment will be granted upon a showing of good cause. Good cause will generally be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods or services in response to a requirement for an acceptable identification, when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register or an amendment to assert a Trademark Act § 2(f) claim (15 U.S.C. § 1052(f)) in order to avoid or overcome a refusal under Trademark Act § 2(e)(1), Trademark Act § 2(e)(2) or Trademark Act § 2(e)(4), 15 U.S.C. § 1052(e)(1), 15 U.S.C. § 1052(e)(2) or 15 U.S.C. § 1052(e)(4), or when the examining attorney consents to remand for consideration of the amendment. [Note 5.] However, whether good cause will be found will depend, in part, on the stage of the appeal at the time the amendment is filed, including the reason given for the delay. [Note 6.] If the request for remand is granted, the Board will suspend proceedings with respect to the appeal and remand the application to the examining attorney for consideration

of the amendment. The Board's remand letter will also include instructions to the examining attorney with respect to the further actions that may and/or should be taken by the examining attorney in conjunction with the examining attorney's consideration of the amendment.

Remand in an ex parte appeal is a matter of discretion with the Board, and the Board may refuse to remand for consideration of an amendment filed more than six months after the date of the action from which the appeal was taken, or an amendment filed after the examining attorney had, after the filing of a notice of appeal, acted on a request for reconsideration or an amendment. In such cases remand may be refused if, for example, the amendment was filed in bad faith, or would serve no useful purpose. [Note 7.] Further, if remand is made, the Board's instructions to the examining attorney concerning the handling of the amendment, and further action in connection therewith may differ for an amendment filed more than six months after the date of the action from which the appeal was taken and those given by the Board for an amendment filed within six months after that date. For example, if an amendment is filed at the point the examining attorney's brief is due, the Board may direct the examining attorney that if the amendment is not acceptable the examining attorney should simply indicate this in the appeal brief, or if the amendment is acceptable but does not overcome the refusal, the examining attorney may include in the appeal brief argument and evidence directed to the amendment, while the applicant may address this in the reply brief. [Note 8.]

If an appeal is late-filed, but the applicant timely filed an amendment to its involved application, the Board will issue a written action informing the applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the examining attorney for appropriate action with respect to the amendment.

If, at the time the applicant files its appeal brief, it also wishes to amend its application in order to, for example, attempt to comply with a final requirement or to overcome a final refusal, the proper procedure is to file a request for remand and a request to suspend proceedings in the appeal pending the Board's decision on the request for remand. However, occasionally an applicant will include an amendment as part of its brief. If this amendment is noted by the Board (and frequently it will not be noted if it is not made by a separate submission), the Board will treat the proposed amendment as a request for remand, and consider whether good cause has been shown in determining the request. If the Board does not note the request, but the examining attorney, upon reviewing applicant's appeal brief, considers the amendment and allows it, the amendment will be entered. In such a circumstance, the preferred practice is for the examining attorney to specifically state in his or her brief that he/she has accepted the amendment; however, if the examining attorney makes no reference to the amendment and merely treats the application as having been amended, the Board will treat the amendment as having been accepted. [Note 9.] If the examining attorney, upon noting the proposed amendment in the applicant's brief, believes that the amendment raises a new issue or that further examination would be required as a result of the amendment, the examining attorney should contact the Board and advise that the brief contains an amendment that should be considered as a request for remand.

An application that has been considered and decided on appeal may be amended, if at all, only in accordance with 37 C.F.R. § 2.142(g). For further information concerning amendment after decision on appeal, see TBMP § 1218 and TMEP § 1501.06.

NOTES:

1. For information concerning the actions which may be taken by the examining attorney upon consideration of the amendment, *see* TMEP § 715.04, TMEP § 715.04(a) and TMEP § 715.04(b). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992); *In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1153-54 (TTAB 1992); *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986).

But see In re Integrated Embedded, 120 USPQ2d 1504, 1510-12 (TTAB 2016) (applicant advised of option to amend to Supplemental Register during prosecution of application but did not do so; reservation of a right does not constitute an amendment in the alternative).

2. *See In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1135-36 (TTAB 2015) (application was remanded to consider applicant's proposed disclaimer, it was not permissible for examining attorney to submit evidence in support of refusal that was not the subject of remand request).

3. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

4. *See* TMEP § 715.04 and TMEP § 1501.05.

5. *In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1135 (TTAB 2015) (applicant's seeking to comply with requirement for disclaimer constituted good cause).

6. *See, e.g., In re Thomas White International Ltd.*, 106 USPQ2d 1158, 1160 n.2 (TTAB 2013) ("at this late juncture applicant would not be able to show good cause" for a proposed amendment made in its appeal brief to expand the goods to cover related services after applicant previously deleted services from the application).

7. *See In re Big Pig Inc.*, 81 USPQ2d 1436, 1437-38 (TTAB 2006) (applicant's request for remand after filing of reply brief denied; because proposed claim of ownership of a registration was irrelevant, and clarification of the nature of its typed drawing was unnecessary, applicant failed to show good cause).

8. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 n.2 (TTAB 2010).

9. *See In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1512 n.2 (TTAB 2001) (one ground for refusal was requirement for translation of mark; because applicant offered translation in appeal brief and examining attorney did not address the issue in his brief, Board treated requirement as moot).

1205.02 Request to Divide

An applicant may submit a request to divide the application to divide out goods or services within a class, or entire classes prior to, with, or after the filing of a notice of appeal. [Note 1.] An applicant may wish to submit such a request in a situation where a refusal to register or requirement applies only to certain classes in a multi-class application or to certain goods or services within a class in either a single-class or multi-class application. *See* TBMP § 1202.05.

Procedures for when a request to divide is filed within six months of the issuance of the appealed final refusal or requirement (i.e., prior to or with the notice of appeal) are discussed below. If a request to divide is submitted after an appeal is instituted, the request should be filed with the Board through ESTTA, rather than directed to the examining attorney or filed through the TEAS system. In ESTTA, the applicant should "identify paper" by checking the "Other Motions/Papers" box and identifying the paper as a request to divide. The Board will determine whether to suspend action on the appeal and forward the application to the ITU/Divisional Unit, or defer the processing of the request to divide and continue proceedings in the appeal. Such a determination will be based on such factors as the reason for the request to divide (e.g., if the division will result in the withdrawal of the refusal as to certain of the classes) and the stage of the appeal.

Filing a request to divide with the Board must be through ESTTA. If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 2.]

NOTES:

1. See generally 37 C.F.R. § 2.87 and TMEP § 1110 regarding requests to divide.

2. *See* 37 C.F.R. § 2.126.

1205.02(a) Request to Divide When Notice of Appeal is Submitted Electronically

When an applicant submits a notice of appeal through ESTTA, and submits at the same time or has pending a request to divide, the applicant should not check the "request for reconsideration" box on the ESTTA form unless it has pending or is contemporaneously filing a request for reconsideration/amendment. The request to divide is not considered to be either a request for reconsideration or an amendment. The applicant should file the notice of appeal through ESTTA and the contemporaneously or previously filed request to divide through TEAS. The applicant will receive an electronically generated order instituting the appeal, and requesting the applicant to contact the Board paralegal to whom the application has been assigned so that appropriate action can be taken on the request to divide, depending on the circumstances. If the notice of appeal is limited to the classes which the applicant seeks to have divided out of the application, the appeal will be instituted for those classes, proceedings in the appeal will be suspended, and the Board will forward the application to the ITU/Divisional Unit of the Office for action on the request to divide. After the request to divide has been processed, the application for which no appeal has been filed will be forwarded to the examining attorney for appropriate action, while the application to which the appeal applies will be returned to the Board. The Board will then resume proceedings in the appeal with respect to that application, and allow the applicant 60 days in which to submit its appeal brief. If the notice of appeal applies to classes in each of the divided applications, both applications will be returned to the Board, which will resume proceedings in the appeal with respect to both applications, and allow the applicant 60 days in which to submit its appeal briefs. [Note 1.] The Board may also consolidate the appeals. *See* TBMP § 1214.

If the applicant has pending or is simultaneously filing a request for reconsideration/amendment with the request to divide and the notice of appeal, the applicant should check the appropriate box on the ESTTA form. The electronically generated order instituting the appeal will suspend proceedings in the appeal and remand the application to the examining attorney to consider both the request for reconsideration/amendment and the request to divide. The examining attorney will then forward the application and the request to divide to the ITU/Divisional Unit of the Office for action on the request to divide. After the request to divide has been processed the applications will be sent to the examining attorney, who will then decide the request for reconsideration/amendment in the same procedure that is followed for any request for reconsideration or amendment. *See* TBMP § 1204 and TBMP § 1205. If registrability is not found on the basis of these documents, the examining attorney will return to the Board the application or applications containing the class or classes for which the appeal has been instituted. As for the application containing the classes for which no timely appeal was filed, unless the examining attorney issues a new final action with respect to that application, the applicant may not subsequently submit a notice of appeal.

NOTES:

1. However, the applicant may not subsequently submit a notice of appeal for any classes for which it had not previously filed a timely notice of appeal.

1205.02(b) Request to Divide When Notice of Appeal is Submitted on Paper due to ESTTA Technical Problems or Extraordinary Circumstances

The following information applies in the rare circumstances when a notice of appeal is filed as a paper submission, because ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, and a request to divide is also filed. An applicant that files a request to divide or that has pending a request to divide at the time it files its notice of appeal should advise the Board of the request to divide in the notice of appeal.

If the applicant files with the notice of appeal or has pending at the time the appeal is filed only a request to divide, the Board will institute the appeal if the written explanation for paper filing is acceptable, suspend proceedings in it, and forward the application to the ITU/Divisional Unit of the Office for action on the request to divide. If the appeal applies to only one of the applications resulting from the division, then after the request to divide has been processed the application for which no appeal has been filed will be forwarded to the examining attorney for appropriate action, while the application to which the appeal applies will be returned to the Board. The Board will then resume proceedings in the appeal with respect to that application, and allow the applicant 60 days in which to submit its appeal brief. If the appeal applies to both applications, the Board will resume action in the appeals with respect to both applications. In the latter situation, the Board may consolidate the appeals.

If the applicant files a request to divide as well as a request for reconsideration/amendment with its notice of appeal (or if these requests are pending with the examining attorney at the time the notice of appeal is filed), the Board will institute the appeal if the written explanation for paper filing is acceptable, suspend proceedings in it, and remand the application to the examining attorney to arrange for processing of the request to divide and then to decide the request for reconsideration/amendment in the same procedure that is followed for any request for reconsideration or amendment. *See* TBMP § 1204 and TBMP § 1205. If registrability is not found on the basis of these documents, the examining attorney will return to the Board the application or applications containing the class or classes for which the appeal has been instituted. As for the application containing the class or classes for which no timely appeal was filed, unless the examining attorney issues a new final action with respect to that application, the applicant may not subsequently submit a notice of appeal.

1206 Amendment to Allege Use; Statement of Use

1206.01 Amendment to Allege Use

An amendment to allege use under Trademark Act § 1(c), 15 U.S.C. § 1051(c), may be filed in an intent-to-use application, i.e., an application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), at any time between the filing of the application and the date the examining attorney approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under Trademark Act § 1(d), 15 U.S.C. § 1051(d), after the issuance of a notice of allowance under Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2). [Note 1.] Thus, an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely. [Note 2.] As a result, an applicant with an intent-to-use based application that wishes to attempt to overcome a refusal by amending its application to the Supplemental Register may, if use has commenced during the course of the appeal, file an amendment to allege use.

If an applicant that has filed an amendment to allege use during the six-month response period following issuance of a final action also files a timely appeal, and the examining attorney has not yet acted on the amendment to allege use when the appeal is filed, or if the applicant files an amendment to allege use along

with the notice of appeal, the amendment to allege use will be handled by the Board in the same manner as any other amendment filed during the six-month response period following issuance of a final action. *See* TBMP § 1205.

When the notice of appeal is filed through ESTTA, the applicant should check the box stating that a request for reconsideration has been filed. *See* TBMP § 1202.03. If the applicant has not previously filed the amendment to allege use, at the same time it files its notice of appeal it should file the amendment to allege use through TEAS. The filing of the notice of appeal through ESTTA, coupled with the checking of the request for reconsideration box, will electronically generate an order instituting the appeal, suspending action on it, and remanding the application to the examining attorney to consider the amendment to allege use. Filing the notice of appeal via ESTTA is required. [Note 3.]

In the rare circumstances the applicant files its notice of appeal through a paper submission, because ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, it should indicate in the notice of appeal that it has pending, or is contemporaneously filing, an amendment to allege use. [Note 4.] If the written explanation for paper filing is acceptable, the Board will acknowledge receipt of the appeal and amendment to allege use, suspend further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the examining attorney for consideration of the amendment to allege use. The applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 C.F.R. § 2.142(b)(1), even if the Board has not issued its order suspending proceedings prior to the date the appeal brief would otherwise be due. Nor does the applicant need to verify with the Board that the due date for its brief will be changed if necessary. *See* TBMP § 1203.02(a).

If, in the course of examination of the amendment to allege use, the application is approved for publication (or for registration, in the case of an application amended to seek registration on the Supplemental Register), or becomes abandoned, the appeal will be moot. The examining attorney should so notify the applicant and the Board, by telephone or email. [Note 5.] If the examining attorney, after consideration of the amendment to allege use, adheres to the final refusal to register, or ultimately issues a new final refusal to register, which may include a refusal based on information in the amendment to allege use, the six-month response clause should be omitted from the paper; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. [Note 6.]

If an applicant that has filed a timely appeal to the Board files an amendment to allege use more than six months after issuance of the appealed action, the Board may, in its discretion, suspend proceedings with respect to the appeal and remand the application to the examining attorney for consideration of the amendment to allege use. Alternatively, the Board may continue proceedings with respect to the appeal, thus deferring examination of the amendment to allege use until after final determination of the appeal. If the final determination of the appeal is adverse to the applicant, the amendment to allege use will be moot.

NOTES:

1. *See* 37 C.F.R. § 2.76(a). *See also In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1991).

2. *See* 37 C.F.R. § 2.76(a); TMEP § 1104.03 and TMEP § 1104.07.

3. *See* 37 C.F.R. § 2.126(a); *see also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69966 (October 7, 2016) ("The Office is amending § 2.126 to renumber paragraph (a) and (b) and to add new paragraph (a) to require that submissions to the Board must be made via ESTTA. The amendment codifies the use of electronic filing.").

4. *See* 37 C.F.R. § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69966 (October 7, 2016) (discussing the procedure for paper filings). For information concerning examination by the examining attorney of an amendment to allege use filed in conjunction with a notice of appeal, see TMEP § 1104.07.

5. *See* TMEP § 1104.07.

6. *See* TMEP § 1104.07.

1206.02 Statement of Use

A statement of use under Trademark Act § 1(d), 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application, i.e., an application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), prior to the issuance of a notice of allowance under Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2). [Note 1.]

A notice of allowance is not issued in an intent-to-use application (for which no amendment to allege use under Trademark Act § 1(c), 15 U.S.C. § 1051(c), has been timely filed and accepted) unless and until the application is approved for publication, and then published in the Official Gazette for opposition; no timely opposition is filed or all oppositions filed are dismissed; and no interference is declared. [Note 2.] *See* TBMP § 219.

Therefore, a statement of use filed during an ex parte appeal to the Board generally is premature. A premature statement of use will not be considered. [Note 3.] Instead, the premature statement of use will be returned to the applicant and the fee will be refunded.

NOTES:

1. *See* 37 C.F.R. § 2.88(a).

2. *See* Trademark Act § 13(b)(2), 15 U.S.C. § 1063; 37 C.F.R. § 2.81(b); TMEP § 1109.04.

3. *See* 37 C.F.R. § 2.88(a).

1207 Submission of Evidence During Appeal

1207.01 General Rule — Evidence Submitted After Appeal Untimely

37 C.F.R. § 2.142(d) *The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.*

The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. [Note 1.] *See* TBMP § 1203.02(e).

However, if the applicant or the examining attorney submits excerpts from articles during examination, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed. [Note 2.] If the nonoffering party wishes to have the entire article considered, the better practice is to submit

the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief, the Board need not remand the application, and may instead consider the article as part of the record. [Note 3.] *See also* TBMP § 1208.01.

If evidence that was previously unavailable comes to the applicant's or examining attorney's attention after an appeal is filed, the proper procedure is to submit a request to the Board to suspend the appeal and remand the application. [Note 4.] *See* TBMP § 1209.02 and TBMP § 1209.04.

NOTES:

1. 37 C.F.R. § 2.142(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(d) to clarify that evidence should not be filed with the Board after a notice of appeal is filed. The amendment more directly states the prohibition.").

See also In re Jimmy Moore LLC, 119 USPQ2d 1764, 1767 (TTAB 2016) (copy of patent excerpt submitted with appeal brief not considered); *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of registrations with appeal brief sustained); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013) (copies of documents pertaining to district court litigation submitted with applicant's appeal brief not considered); *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (new evidence submitted with reply brief is "untimely and therefore not part of the record for this case"); *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (printouts submitted with reply brief not considered); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (exhibits attached to applicant's supplemental brief not considered; noted that evidence could have been submitted during the period of further examination after remand); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011) (materials submitted with reply brief, after two requests for remand were denied, were not of record and, because reply brief discussed materials at length, reply brief also not considered); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1990-91 (TTAB 2011) (documents from file of cited registration submitted with applicant's appeal brief are late-filed and not considered; examining attorney's objection sustained); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n.32, 1769 (TTAB 2011) (applicant has responsibility to make sure that the record is complete prior to filing a notice of appeal); *In re Trans Continental Records Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002) (materials from web search engines submitted with appeal brief not considered); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1191 n.2 (TTAB 2000); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999); *In re Posthuma*, 45 USPQ2d 2011, 2012 n.2 (TTAB 1998) (third-party registration attached to appeal brief not considered); *In re Wada*, 48 USPQ2d 1689 n.2 (TTAB 1998) (evidence submitted with reply brief not considered), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379, n.3 (TTAB 1998) (third-party registrations first submitted with appeal brief not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (new material attached to appeal and reply briefs, and submitted at oral hearing and subsequent to hearing untimely and not considered); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992); *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1884 n.5 (TTAB 1988); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 n.2 (TTAB 1987); *In re Gold's Gym Enterprises Inc.*, 3 USPQ2d 1716 n.2 (TTAB 1987); *In re International Environmental Corp.*, 230 USPQ 688, 690 (TTAB 1986); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 n.3 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 46 n.1 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 n.1 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333, 336 n.3 (TTAB 1984); *In re Pierre Fabre S.A.*, 221 USPQ 1210, 1212 n.2

(TTAB 1984); *In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 n.2 (TTAB 1983); *In re Gagliardi Brothers, Inc.*, 218 USPQ 181, 183 (TTAB 1983); *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982).

Cf. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986); *In re Volvo White Truck Corp.*, 16 USPQ2d 1417, 1419 n.4 (TTAB 1990).

2. *See In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986) (if only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came).

3. *But see In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1597-98 (TTAB 1999) (if, after appeal, an applicant attempts to submit a full printout of articles from the NEXIS database which were revealed in an examining attorney's search, but which were not introduced by the examining attorney, such articles are considered to be additional evidence and therefore untimely).

4. 37 C.F.R. § 2.142(d); *see* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is further amending § 2.142(d) for clarity, including by specifying that an appellant or examining attorney who desires to introduce additional evidence after an appeal is filed should submit a request to the Board to suspend the appeal and remand the application for further examination."); *see also In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 n.4 (TTAB 2010) (registration that issued after notice of appeal and submitted with appeal brief not considered, applicant could have filed a request for remand).

1207.02 Request to Remand for Additional Evidence

If an applicant or examining attorney wishes to introduce additional evidence after an appeal has been filed, the applicant or examining attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. [Note 1.]

A request under 37 C.F.R. § 2.142(d) to suspend and remand for additional evidence must be filed prior to the rendering of the Board's final decision on the appeal. [Note 2.] In addition, the request must include a showing of good cause therefor (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. [Note 3.] The length of the delay in making the request after the reason for the remand becomes known, or the point in the appeal process at which the request for remand is made, will be considered in the determination of whether good cause exists. Generally, the later in the appeal proceeding that the request for remand is filed, the stronger the reason that must be given for good cause to be found. [Note 4.]

Examples of circumstances that have been found to constitute good cause for a remand for additional evidence include the following:

(1) The evidence was not previously available. [Note 5.] Even if the evidence was not previously available, good cause may not be found if the newly available evidence is merely cumulative in nature. Thus, if the examining attorney requests remand in order to submit an article which was published subsequent to the filing of the appeal, but which is of substantially the same nature as articles previously made of record, the request may be denied. Nor can the examining attorney use the subsequent publication of a single article to make of record articles which were previously available. Similarly, if the applicant requests remand to make of record its most recent monthly sales or advertising figures in support of a Trademark Act § 2(f), 15 U.S.C. § 1052(f), claim, the request may be denied. There is a point at which prosecution or examination must come to an end.

(2) A new attorney for the applicant, or a new examining attorney, has taken over the case and wishes to supplement the evidence of record. The transfer of a case from one firm member to another is not considered by the Board to constitute good cause for a remand under the "new attorney" rationale. However, the transfer of the case from in-house counsel to an outside firm is treated as a new attorney taking over the case. Similarly, a different examining attorney being assigned the application is treated as a new attorney taking over the case.

(3) The applicant and examining attorney have agreed to the remand.

In addition, because a consent agreement offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability [Note 6], the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.

If a request to remand for additional evidence is granted, the nonrequesting party may submit additional evidence in response to the evidence submitted with the request. [Note 7.] However, depending on the stage of the appeal, the Board may direct that any responsive evidence be submitted with a supplemental brief. [Note 8.]

When an applicant's request to suspend and remand for additional evidence is granted, and the application is remanded to the examining attorney for further examination, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), or adhere to the action from which the appeal was taken. The examining attorney may also issue a new nonfinal action asserting any new refusal or requirement necessitated by the new evidence. The examining attorney may not, however, assert a new refusal or requirement unrelated to the new evidence unless the examining attorney files with the Board a request under 37 C.F.R. § 2.142(f)(6) for remand to assert the new refusal or requirement, and the request is granted. If the examining attorney is persuaded, on the basis of the new evidence, that the applicant is entitled to the registration sought, and approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. The applicant will receive notification that the application has been approved for publication when the Office issues a computer-generated notice of publication; in addition, the applicant may ascertain the status of the application by checking the TSDR database. If the examining attorney, after consideration of the new evidence, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.

When an examining attorney's request to suspend and remand for additional evidence is granted, the Board, in its action granting the request, will allow the examining attorney time in which to issue an Office action relating to the new evidence to be submitted therewith and, depending on the circumstances, will either direct the examining attorney to issue a nonfinal action so that the applicant can respond with argument and evidence, or to issue an Office action omitting the six-month response clause and return the application to the Board. If the applicant's appeal brief has already been filed, applicant will be allowed an opportunity, if it so desires, to file a supplemental brief directed to the new evidence submitted by the examining attorney.

NOTES:

1. *See* 37 C.F.R. § 2.142(d). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992); *In re Wells Fargo & Co.*, 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 940 n.6 (TTAB 1985); *In re Mayer-Beaton*

Corp., 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 n.3 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 46 n.1 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 n.1 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333, 336 n.3 (TTAB 1984); *In re Consolidated Foods Corp.*, 218 USPQ 184, 186 n.2 (TTAB 1983); *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (request for remand under 37 C.F.R. § 2.142(d) is appropriate procedure; 37 C.F.R. § 2.122(e) for inter partes proceedings is inapplicable).

2. *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984).

3. *See In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) (applicant's request for remand, included in applicant's brief, denied, explaining that proper procedure "was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause."); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (applicant's request for remand denied for failure to show good cause); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 940 n.6 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363, 636 n.3 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); and *In re Historic Wharf's Associates, Inc.*, 222 USPQ 92, 93 n.1 (TTAB 1984).

4. *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (denial of request for remand made after appeal briefs filed); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (request for remand denied for failure to show good cause so late in the appeal). *See also In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991).

5. *See In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 n.2 (TTAB 1998) (applicant's request for remand made in its appeal brief in order to allow examining attorney to consider additional third-party registrations denied because such evidence could have been submitted earlier in the prosecution).

6. *See, e.g., In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

7. *See In re Northland Aluminum Products, Inc.*, 221 USPQ 1110, 1112 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). *Cf. In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 (TTAB 1983).

8. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 n.2 (TTAB 2010).

1207.03 Evidence Considered Due to Actions of Nonoffering Party

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence, *see* TBMP § 1207.02, may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record. [Note 1.] In such a situation, the Board may consider evidence submitted by the nonoffering party to rebut the untimely evidence. [Note 2.]

Third-party registrations may not be made of record by merely listing them in response to an Office Action. "It is well-established that in order to make third-party registrations properly of record, 'applicant should submit copies of the registrations themselves, or the electronic equivalent thereof' from the USPTO's electronic databases. ..." [Note 3.]

If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise the applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to the admissibility of the list. [Note 4.] See TBMP § 1208.02 regarding third-party registrations, including discussion of evidentiary value of such listings.

NOTES:

1. *See, e.g., In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (because the examining attorney addressed applicant's registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they were of record); *In re Sadoru Group Ltd.*, 105 USPQ2d 1484, 1485, 1489 n.6 (TTAB 2012) (examining attorney stated she did not object to consideration of untimely evidence accompanying applicant's brief); *In re Heeb Media LLC*, 89 USPQ2d 1071, 1072 (TTAB 2008) (examining attorney pointed out untimeliness of evidence attached to applicant's brief, but considered it and relied on it, and therefore Board treated it as of record); *In re Litehouse Inc.*, 82 USPQ2d 1471, 1475 n.2 (TTAB 2007) (third-party registrations submitted for first time with applicant's appeal brief considered because examining attorney did not object in her brief and instead presented arguments in rebuttal of this evidence); *In re Homeland Vinyl Products Inc.*, 81 USPQ2d 1378, 1381 n.5 (TTAB 2006) (declarations submitted for first time with applicant's appeal brief treated of record because examining attorney did not object and addressed the evidence on the merits); *In re Rodale Inc.*, 80 USPQ2d 1696, 1699 n.4 (TTAB 2006) (Board considered summary of applicant's prior registrations presented for the first time in its appeal brief because the examining attorney did not object and also presented substantive arguments regarding the registrations); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006) (examining attorney, after noting that evidence submitted with applicant's appeal brief was untimely, specifically stated in her brief that she did not object to it); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 n.5 (TTAB 2001) ("evidence" of sales mentioned for first time in applicant's brief and thus not timely submitted, but because in her brief examining attorney treated the information as though of record, Board did also); *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999) (third-party registrations submitted with examining attorney's brief considered of record because applicant did not object and discussed the evidence on its merits in reply brief); *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 n.2 (TTAB 1990); *In re Dana Corp.*, 12 USPQ2d 1748, 1749 n.8 (TTAB 1989); *In re Pencils Inc.*, 9 USPQ2d 1410, 1411 (TTAB 1988).

See also In re Wells Fargo & Co., 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Weather Channel, Inc.*, 229 USPQ 854 n.3 (TTAB 1985); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986); *In re Cotter & Co.*, 228 USPQ 202, 204 n.2 (TTAB 1985); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 946 n.6 (TTAB 1985); *In re Bee Pollen From England Ltd.*, 219 USPQ 163, 165 n.4 (TTAB 1983); *In re Development Dimensions International, Inc.*, 219 USPQ 161 n.2 (TTAB 1983).

2. *See In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983).

3. *In re City of Houston*, 101 USPQ2d 1534, 1536 n.5 (TTAB 2012) (evidentiary submissions "should be made prior to appeal or, if after appeal, pursuant to a remand of the matter to the examining attorney for further examination. Trademark Rule 2.142(d).") (quoting *In re Broadway Chicken Inc.*, 38 USPQ2d 1559,

1560 n.6 (TTAB 1996) (citing *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

4. *See In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) ("[T]he examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... 'for whatever limited probative value such evidence may have,'" (citing *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001))), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013). *See also In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945 n.4 (TTAB 2000); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (although applicant first submitted a copy of its own registration with its appeal brief, Board viewed examining attorney as having treated registration of record because applicant referenced it in argument made in two responses during prosecution and examining attorney addressed the argument and therefore considered the registration; nor did examining attorney object to the registration as untimely filed); *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002) (Board considered third-party registrations submitted with reply brief because applicant had submitted copies of Official Gazettes showing marks published for opposition during prosecution, and examining attorney did not advise applicant that copies of the registrations were necessary to make them of record). *Cf. In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1314-15 n.3 (TTAB 2011) (examining attorney was not required to advise applicant that reference to a third-party registration was insufficient to make such registration of record when reference was made for the first time in a request for reconsideration which was denied).

1207.04 Evidence Filed with Timely Request for Reconsideration

A timely request for reconsideration of an appealed action may be accompanied by additional evidence, which will thereby be made part of the evidentiary record in the application. [Note 1.] There is no need, in such a situation, for a 37 C.F.R. § 2.142(d) request to suspend and remand for additional evidence. Evidence submitted with a timely request for reconsideration of an appealed action, that is, a request filed during the six-month response period following issuance of the appealed action, is considered by the Board to have been filed prior to appeal, even if the notice of appeal was, in fact, filed earlier in the six-month response period than the request for reconsideration. *See* TBMP § 1204.

When a timely request for reconsideration of an appealed action is filed (with or without new evidence), the examining attorney may submit, with his or her response to the request, new evidence directed to the issue(s) for which reconsideration is sought. [Note 2.] However, the applicant may not submit additional evidence in response to any evidence submitted by the examining attorney unless the examining attorney's action is a nonfinal action to which a response may be filed. Otherwise, if the applicant wishes to submit additional evidence, it must file a request for remand. [Note 3.] *See* TBMP § 1207.01 and TBMP § 1207.02. This is the case even if the response is filed within six months of the final Office action. If the examining attorney denies a request for reconsideration after a notice of appeal is filed, a second request for reconsideration will be treated as a request for remand even if it is filed within six months of the final Office action. *See* TBMP § 1204, TBMP § 1207.02 and TBMP § 1209.04.

NOTES:

1. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009).

2. *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009) (evidence submitted in response to request for reconsideration that is filed with notice of appeal is part of the application record); *In re Giger*, 78 USPQ 1405, 1406-07 (TTAB 2006). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (may submit evidence in a request for reconsideration to a "subsequent final refusal").

3. *See* 37 C.F.R. § 2.142(d); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010).

1207.05 Submission of Evidence upon Remand for New Refusal

Additional evidence may be submitted, both by the examining attorney and by the applicant, if (1) an appealed application is remanded by the Board for further examination under 37 C.F.R. § 2.142(f)(1) (i.e., a sua sponte remand by the Board when it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable), *see* TBMP § 1209.01, or under 37 C.F.R. § 2.142(f)(6) (i.e., a remand by the Board upon written request by the examining attorney when it appears to the examining attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable), *see* TBMP § 1209.02, and (2) the examining attorney, upon remand, does, in fact, issue a new refusal to register or a new requirement. [Note 1.] If no new refusal or requirement is made, and the examining attorney instead returns the application to the Board, no additional evidence may be submitted. [Note 2.]

NOTES:

1. *See In re Bank America Corp.*, 229 USPQ 852, 853 n.4 (TTAB 1986).

2. *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 n.3 (TTAB 1986).

1207.06 Letter of Protest Evidence

A third party that has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy, a "letter of protest," that is, a letter that recites the facts and which is accompanied by supporting evidence. [Note 1.] The Deputy Commissioner will determine whether the information should be given to the examining attorney for consideration. *See* TBMP § 215. If the examining attorney issues an Office action that includes any materials submitted with the letter of protest, that material becomes part of the record of the application for appeal. [Note 2.]

Proceedings in an ex parte appeal will not be suspended pending determination by the Deputy Commissioner of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the examining attorney, having considered the supporting evidence submitted with the letter of protest, wishes to make that evidence of record in the application, that is, wishes to rely on the evidence to support the appealed refusal of registration, the examining attorney may file a written request with the Board, pursuant to 37 C.F.R. § 2.142(d), to suspend the appeal and remand the application for further examination. *See* TBMP § 1207.02 for information concerning a request for remand for additional evidence.

The request must be filed prior to the rendering of the Board's final decision on the appeal, and must be accompanied by the additional evidence sought to be introduced. *See* TBMP § 1207.02. In addition, the request must include a showing of good cause therefor, in the same manner as any other request to remand for additional evidence. *See* TBMP § 1207.02 for information concerning good cause for a remand for additional evidence.

Evidentiary value of material submitted by a third party through a letter of protest will depend on whether it meets evidentiary requirements for authentication or foundation, identified as to nature or source. [Note 3.]

NOTES:

1. *See In re Candy Bouquet International Inc.*, 73 USPQ2d 1883, 1884 n.2 (TTAB 2004); TMEP § 1715 *et seq.*

2. *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999).

3. *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (documents of limited evidentiary value because no affidavits or other evidence establishing foundation, and no information establishing authenticity or source).

1208 Treatment of Evidence

The Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an ex parte proceeding than it does in an inter partes proceeding. [Note 1.] That is, in an ex parte proceeding the Board tolerates some relaxation of the technical requirements for evidence and focuses instead on the spirit and essence of the rules of evidence. [Note 2.]

For example, the Board may be somewhat more lenient in its approach in the consideration of surveys in ex parte proceedings than inter partes proceedings. [Note 3.] Also, the affidavit or 37 C.F.R. § 2.20 declaration is an established method for the introduction of evidence in an ex parte proceeding without the option of cross examination. [Note 4.] In an inter partes proceeding, however, evidence offered in affidavit or 37 C.F.R. § 2.20 declaration form must be in conformance with the Federal Rules of Evidence and is subject to the right of any adverse party to elect and take cross examination of that witness. [Note 5.] TBMP § 703 (Taking and Introducing Testimony).

It is the better practice to provide evidence as to sales figures and the like by affidavit or declaration. However, representations by the applicant's counsel may, in certain circumstances, be accepted. [Note 6.] Affidavits or declarations may have probative value even if they are form documents, or are prepared by the applicant's attorney. [Note 7.]

However, while the evidentiary requirements in an ex parte record are less formal than in an inter partes context, documents submitted by a third party by letter of protest must still comply with inter partes evidentiary requirements of foundation and authentication to have evidentiary value. [Note 8.]

For information as to how the Court of Appeals for the Federal Circuit, in reviewing a decision of the Board on an ex parte appeal, evaluates the sufficiency of the evidence offered by the examining attorney, see the cases cited in the note below. [Note 9.]

NOTES:

1. *In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) ("…the Board does not, in ex parte appeals, strictly apply the Federal Rules of Evidence, as it does in inter partes proceedings.").

2. *See In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10, 1924 n.18 (TTAB 1996), *aff'd without opinion* (Fed. Cir. 1997) (Board allowed NEXIS evidence to show psychological effect of color blue, despite hearsay nature, recognizing the difficulty for examining attorney to establish such fact without relying on NEXIS evidence; Board also accepted sufficiency of evidence showing features of applicant's trade dress were common, recognizing that USPTO's limited resources constrain an examining attorney's ability to acquire

photographs of interiors of retail establishments); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996); *In re Murphy Door Bed Co.*, 223 USPQ 1030, 1032 n.9 (TTAB 1984). *See also In re Berman Brothers Harlem Furniture Inc.*, 26 USPQ2d 1514, 1515 (TTAB 1993).

3. *Compare In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016 (TTAB 2017) and *In re Country Music Association Inc.*, 100 USPQ2d 1824 (TTAB 2011) *with In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996); *In re Pillsbury Co.*, 174 USPQ 318, 320 (TTAB 1972).

4. *See, e.g.*, 37 C.F.R. § 2.41(b); *In re Manco Inc.*, 24 USPQ2d 1938, 1941 n.8 (TTAB 1992); *In re Bauhaus Designs Canada Ltd.*, 12 USPQ2d 2001, 2004 (TTAB 1989); *In re Motorola, Inc.*, 3 USPQ2d 1142, 1143 (TTAB 1986); *In re Peterson Manufacturing Co.*, 229 USPQ 466, 468 (TTAB 1986); *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986); *In re Gammon Reel, Inc.*, 227 USPQ 729, 731 (TTAB 1985); *In re Original Red Plate Co.*, 223 USPQ 836, 838 (TTAB 1984).

5. *See* 37 C.F.R. § 2.123(a)(1).

6. *See In re Pitney Bowes, Inc.*, 125 USPQ2d 1417, 1420 (TTAB 2018) (Board considered response to Office action signed by applicant's in-house counsel because response clarified the specimen's direct reference to the services that were at issue); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1276 (TTAB 2016) (although it is preferable for applicant to submit information in affidavit or declaration form with supporting documentation, Board considered representations of counsel because of supporting documentary evidence in the record); *In re First Craft Inc.*, 76 USPQ2d 1183, 1185 n.3 (TTAB 2005) (although it is better practice to present information in affidavit or declaration form with supporting documentation, Board considered representations by applicant's counsel because examining attorney did not object to their form and representations not contradicted by anything in the record); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997) (examining attorney never objected to attorney's representations, and figures not contradicted by other information). *Compare In re Teledyne Indus., Inc.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1466 n.11 (TTAB 2017) (the unsworn statement of applicant's counsel in an Office action response regarding the complexity and manufacturing cost of a VAWT design not considered); *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 1002 (TTAB 2013) (disregarding outside counsel's conclusory unverified statements regarding marketing of goods).

7. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1536 (Fed. Cir. 2009) (use of same words in 64 form declarations submitted to show a widely held view "does not eliminate all value of the evidence"); *In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396, 399 (CCPA 1972) (fact that affidavits were drafted by applicant's attorney and were practically identical in wording detracts little or nothing from their sufficiency to make out a prima facie case of trademark recognition); *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 n.15 (TTAB 1998) (fact that applicant's attorney assisted consumers in preparing statements--form letters--to show acquired distinctiveness does not make the submissions less honest or valid).

But see In re Lorillard Licensing Co., 99 USPQ2d 1312, 1318-20 (TTAB 2011) (Board did not find more that 6500 form declarations from "customers" and more than 4100 form declarations from dealers very probative of applicant's claim of acquired distinctiveness); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1984 (TTAB 2009) (Board viewed four form declarations with skepticism because they were contradicted by the weight of the record); *In re Audio Book Club Inc.*, 52 USPQ2d 1042, 1047 (TTAB 1999) (fact that 49 form letters were couched in legal terms and presumably drafted by applicant's counsel raises some questions as to whether signers understood the legal import of their statements); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1217 (TTAB 1998) (form statements that do not provide basic background information about the

declarants and their experience with applicant have limited probative value); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997) (declarations deserve little weight because there are questions as to whether they reflect views of the declarants since declarants filled in only their names and addresses in forms, and declarants failed to notice that drawing was missing from the declaration when the focus of the declaration was the configuration shown in the drawing). *See also In re Pharmavite LLC*, 91 USPQ2d 1778, 1782 (TTAB 2009) (conclusory statements in declaration that design functions as a mark, without evidentiary support, insufficient); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649 (TTAB 2008) (declarations offering nothing more than conclusory statement, without reasons, not persuasive).

8. *See In re Urbano*, 51 USPQ2d 1776, 1779 n.6 (TTAB 1999) (affidavit should have been submitted to identify and authenticate documents that are not clearly identified as to nature or source and are not self-authenticating).

9. *In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988) (Court, being mindful that the USPTO has limited facilities for acquiring evidence--it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits--concludes evidence of record is sufficient to establish a prima facie case of deceptiveness); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) ("... practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action.").

1208.01 Evidence from NEXIS Database, Printed Publications, or Online Publications

The applicant or the examining attorney may submit articles or excerpts from articles taken from periodicals or NEXIS and other similar databases as evidence. [Note 1.] Such material is evidence of how a term or mark may be perceived, rather than of the truth of the underlying information in the article. [Note 2.] The probative value of stories from newswires varies. They may be treated as having minimal evidentiary value when it is not clear that such stories have appeared in any publication available to the consuming public. In such cases, the wire service stories are competent to show how their authors used particular terms, but they are not necessarily assumed to have influenced the attitudes of prospective customers. [Note 3.] On the other hand, newswire stories have been considered as having an effect when there is reason to believe that the relevant consumers have been exposed to the articles. [Note 4.] As for articles from foreign publications, the probative value of such articles is evaluated on a case-by-case basis, with consideration given to the nature of the involved goods or services and the growing availability and use of the Internet as a resource for news. [Note 5.]

It is not necessary that all articles retrieved by a search of NEXIS or other databases be submitted and, indeed, the Board discourages such submissions where they are unnecessarily cumulative or not probative. [Note 6.] Examining attorneys and applicants should not submit articles or excerpts that are not relevant. [Note 7.] However, if an examining attorney submits a sample of articles, it should be representative of the articles retrieved by the search. [Note 8.] Further, if an examining attorney submits a very limited number of articles without indicating that it is a representative sample of a certain number of articles, the Board will assume that these are the only articles that support the examining attorney's position. [Note 9.]

If the applicant or the examining attorney submits excerpts from articles, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed. See TBMP § 1207.01 for general rule that evidence submitted after appeal is untimely. If only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came. [Note 10.] If the nonoffering party wishes to have the entire article considered, the better practice is to submit the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief, the Board need not remand the application,

and may instead consider the article as part of the record. However, if, after appeal, an applicant attempts to submit a full printout of articles which were revealed in an examining attorney's search, but which were not introduced by the examining attorney, such articles are considered to be additional evidence and therefore untimely. [Note 11.]

NOTES:

1. *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998).

2. *See In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1379 (TTAB 2006) (use of term in articles shows authors' belief that term is appropriate way to describe goods and that readers will understand the meaning of the term); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (use of term in articles, particularly those periodicals with a general circulation, reflects a perception that the public is familiar with the term and will readily understand it); *In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10 (TTAB 1996) (Board allowed use of NEXIS evidence to show psychological effect of color blue, despite applicant's hearsay objection, noting the difficulties for examining attorneys to establish this kind of fact, and although the evidence has a hearsay element, there is no bias in the evidence, which was not prepared for purposes of the case), *aff'd without opinion*, 114 F.3d 1207 (Fed. Cir. 1997). *Cf. In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1720-21 (TTAB 2016) (use of social media postings to show public exposure to and perception of surname).

3. *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1683 n.10 (TTAB 2006) (newswire stories do not have the same probative value as stories appearing in newspapers and magazines); *In re Classic Media Inc.*, 78 USPQ2d 1699, 1701 n.2 (TTAB 2006) (nothing to indicate that wire service report was distributed and thus has minimal probative value in that public's exposure to the use of the phrase in the wire report cannot be judged); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 n.7 (TTAB 2001) (newswire stories, presumably unpublished, and stories from foreign publications, not considered).

4. *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1268 (TTAB 2009) (Business Wire article considered); *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003) (given that newswire stories are likely to reach the public via the Internet, they now have more probative value than in the past, in this case the relevant public consisted of highly sophisticated medical doctors and researchers who would have access to newswire stories).

5. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern U.S. consumer impression of a proposed mark); *In re AOP LLC*, 107 USPQ2d 1644, 1649 n.3 (TTAB 2013) (submissions from the examining attorney made in languages other than English not considered); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 n.9 (TTAB 2011) (no basis to conclude U.S. consumers exposed to website for Australian brewery; those webpages not considered); *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003). *But see In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1307 n.3 (TTAB 2006) (article in London edition of Financial Times not evidence of goods/place association because nothing to show that London edition distributed in the United States); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1538 n.2 (TTAB 1998) (in the absence of evidence of the extent of circulation of foreign publications in the United States, they cannot serve to show the significance in this country of the designation at issue); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1931 (TTAB 1996) (in absence of evidence establishing substantial circulation of foreign publications in the United States, they are not competent to show significance of term to general U.S. public).

6. *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992) (it is not necessary that an examining attorney submit all stories found, especially where there are a large number of them). *Cf. In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245-46 (TTAB 2010) (Board criticized applicant for submitting over 300 pages of Internet material, much of which was duplicative or irrelevant).

7. *See In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1719 (TTAB 2016) (Board disregards duplicative articles); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("[I]t is important that applicants and examining attorneys carefully consider the materials retrieved by their Internet searches and make a judicious submission of the results."); *In re Couture*, 60 USPQ2d 1317, 1318 n.2 (TTAB 1999) (many excerpts were repetitive or used the searched term for services not related to the applicant's); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (articles which bear no relationship to applicant's goods are irrelevant). *See also In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1339 n.10 (TTAB 2009) (Board approved examining attorney's Internet search of involved mark that included limitation to goods at issue).

8. *See In re Trans Continental Records Inc.*, 62 USPQ2d 1541, 1544 (TTAB 2002) (although the examining attorney described the NEXIS articles which were submitted as a "sample," Board concerned by the fact that the NEXIS search retrieved 441 articles, and the first of the ten stories submitted was number 257). *See also In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 n.1 (TTAB 1992) (Board criticized examining attorney's submission of only 3 articles of the 18 retrieved and characterization of them as a "sampling"; "saying that the three articles are only a sampling of the evidence is not the same as saying that they are a 'representative sample' thereof").

9. *In re The Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 n.2 (TTAB 1989) (although NEXIS search uncovered 48 stories, examining attorney submitted only two excerpts; Board concluded that, because the examining attorney is presumed to have made the best case possible, the 46 stories not made of record did not support the examining attorney's position, and suggested that if there had been additional stories supporting the position the examining attorney should have submitted a larger number and indicated whether or not they were representative of the rest); *In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987) (examining attorney submitted 3 of 18 NEXIS articles retrieved; Board assumed that the three excerpts selected were the best support of the examining attorney's refusal to register available from that source).

10. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986).

11. *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1597-98 (TTAB 1999).

1208.02 Cited Registrations and Third-Party Registrations

In the context of an ex parte appeal of a Section 2(d) refusal, the file of the cited registration(s) is not automatically of record. [Note 1.] Rather, for the prosecution file history of a cited registration(s) to be considered, it must be timely introduced as evidence. [Note 2.]

With regard to third-party registrations, the Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party's registrations. However, the Board's well-established practice is not to take judicial notice of third-party registrations when an applicant or examining attorney requests that such notice be taken during the course of an appeal. [Note 3.] This practice also applies to registrations owned by the applicant or registrant that are not the subject of the appeal. [Note 4.]

37 C.F.R. § 2.142(d) provides that the record in an appeal must be complete prior to the filing of an appeal, *see* TBMP § 1203.02(e) and TBMP § 1207.01, and to allow the applicant or the examining attorney to, in effect, add to the record during the appeal would subvert the rule and require the Board to re-examine the application during the appeal, based on the expanded record. Thus, to make a third-party registration of record, or a registration owned by the applicant or registrant not the subject of the appeal, a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration. [Note 5.] Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record. [Note 6.] However, there are limited circumstances in which the Board will consider such listings. In particular, if an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have waived any objection to consideration of the list itself, for whatever probative value it may have. [Note 7.] TBMP § 1207.03. Similarly, if the examining attorney discusses the registrations in an Office action or brief, without objecting to them, the registrations will be treated as stipulated into the record. [Note 8.] See TBMP § 1207.03 regarding evidence considered due to actions of nonoffering party. However, the Board will not consider more than the information provided by the applicant. [Note 9.] Thus, if the applicant has provided only a list of registration numbers and/or marks, the list will have very limited probative value. [Note 10.]

An improper listing of third-party registrations will not be considered if the list is submitted at a point where the applicant cannot correct the format of the submission and if the examining attorney does not discuss the registrations or otherwise treat them as of record. [Note 11.]

Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed. [Note 12.] Further, the Board will not take judicial notice of status changes in third-party applications in terms of whether such applications eventually issued to registration. [Note 13.] Expired or cancelled third-party registrations generally are evidence only of the fact that the registrations issued. [Note 14.] The Board may choose not to consider expired or cancelled third-party registrations. [Note 15.]

NOTES:

1. *In re Sela Products LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013) ("there is no equivalent rule for ex parte proceedings that makes the file of a cited registration of record").

2. *In re Sela Products LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013) (had applicant submitted the registration file during the prosecution of the involved application the Board would have considered it).

3. *Compare In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1688 (Fed. Cir. 2010) (where applicant's expert identified a third-party's trademarks in her report before the agency, the court of appeals could take judicial notice of the registrations of the identified marks) *with* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (Oct. 7, 2016) (no judicial notice of USPTO records; "The official record of a Board proceeding must be complete, accurate, and reliable, especially because in direct appeals to the Federal Circuit the court's review of the Board's decision is confined to the four corners of the administrative record. … The burden of creating a complete evidentiary record by introducing in documentary form information contained in the USPTO's trademark file records is most appropriately borne by the party wishing to introduce such evidence rather than by the Board."). *See* Fed. R. Evid. 201(b)(2); *Group One, Ltd. v. Hallmark Cards*, 407 F.3d 1297, 1306 (Fed. Cir. 2005) (upholding district court's taking of judicial notice of the fact of a patent's reinstatement).

4. *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (Board declined to take judicial notice of registrations owned by applicant).

5. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). *See also In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of third-party registration with appeal brief sustained).

6. *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).

7. *See In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in continuing a refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) ("[T]he examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... 'for whatever limited probative value such evidence may have,'" (citing *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re District of Columbia*, 101 USPQ2d 1588, 1591 (TTAB 2012) (examining attorney's objection overruled where on remand applicant submitted copies of the third-party registrations it listed in its response to the first Office action), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 (TTAB 2011) (specific data provided by applicant considered because examining attorney did not advise applicant that a listing of registrations was insufficient when applicant had time to cure the defect). *See also In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (applicant listed particulars of third-party applications/registrations in response to first Office action, and because examining attorney did not advise applicant that the listing was insufficient to make applications/registrations of record at a point where applicant could have corrected the error, the list was considered on appeal); *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002) (Board considered third-party registrations submitted with reply brief because applicant had submitted copies of Official Gazettes showing marks published for opposition during prosecution, and examining attorney did not advise applicant that copies of the registrations were necessary to make them of record); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (examining attorney's objection, raised in appeal brief, to "mere listing" of registrations deemed waived because it was not interposed in response to applicant's reliance on such listing in its response to initial Office action, listing considered for whatever probative value it might have, with Board noting that the listing did not indicate whether registrations were on the Principal or the Supplemental Register). **Please Note:** The *Broyhill Furniture* case does not provide authority for submission (or consideration) of the full registrations on appeal. *See In re City of Houston*, 101 USPQ2d 1534, 1537 n.7 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

8. *See In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed applicant's registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they are of record); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999) (examining attorney did not object to listing of third-party registrations, rather he treated the registrations as if they were of record); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (examining attorney did not object to and treated as of record listings from a commercial trademark search report submitted by applicant during prosecution, so Board considered material).

9. *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (Board treated listing of particulars of third-party applications/registrations submitted by applicant as stipulated into record only to the extent that the specific data provided by applicant was considered); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (listing of registration information considered for whatever probative value it might have, with Board noting that the listing did not indicate whether registrations issued on the Principal or the Supplemental Register).

10. *See In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 n.6 (TTAB 2011) (Board considered TESS listings for whatever probative value they had); *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1380 (TTAB 2006).

11. *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1273-74 (TTAB 2012) (website references in applicant's request for reconsideration not considered because, even if examining attorney had advised applicant of the insufficiency, there was not time to cure it); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (even if copies of third-party registrations had been submitted with brief, they would have been untimely and would not be considered); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (listing of third-party registration information submitted with request for reconsideration not considered because at the time it filed the list applicant no longer had an opportunity to add to the record of the application and correct the evidentiary insufficiency of the submission); *In re Caserta*, 46 USPQ2d 1088, 1090 n.4 (TTAB 1998) (list of third-party registered marks from an unidentified source submitted with request for reconsideration, and objected to by examining attorney, not considered).

12. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

13. *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009).

14. *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006).

15. *See In re Hartz Hotel Services Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations submitted by applicant).

1208.03 Internet Material, Social Media and Multimedia Materials

Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings. It should be identified by the full address (url) for the web page, and the date it was downloaded, either by the information printed on the web page itself, or by providing this information in an Office action or an applicant's response. Providing only the link without the material attached is not sufficient to introduce it into the record. [Note 1.] Because website contents and search engine results are accessible by the consuming public (although search engine results may be retrieved only if members of the public enter the identical search strategy), they constitute evidence of potential public exposure. [Note 2.] Website evidence may also be used to show the translation of a word or term. [Note 3.] Material obtained from an applicant's website, or that of a third party, may provide information about, for example, products or services, customers, and channels of trade, although their probative value will vary depending on the facts of the particular case. Evidence from websites located outside the United States may have probative value depending on the circumstances, including whether it is likely that U.S. consumers have been exposed to the foreign website

[Note 4] and whether the website is in English (or has an optional English language version). [Note 5.] The nature of the goods or services may make it more likely that U.S. consumers will encounter foreign websites in the field in question [Note 6.] Cf. TBMP § 1208.01 regarding articles appearing in foreign publications.

A search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value. Such search results do not show use of a term or phrase as a heading, link or content on a website, or there may be insufficient text to show the context within which a term is used. [Note 7.] Use in a search summary may indicate only that the two words in an overall phrase appear separately in the website literature. [Note 8.] Nor does the fact that a search by an Internet search engine retrieves a large number of hits have probative value. [Note 9.] Likewise, search engine results consisting solely of images are problematic because they provide no indicia of what image is depicted. [Note 10.] The better practice is to provide a copy of the image from the originating website so as to provide evidentiary context. [Note 11.] The Board will not take judicial notice of Internet searches. [Note 12.]

Applicants and examining attorneys should submit only relevant materials that are retrieved by an Internet search. The Board discourages submissions that are unnecessarily cumulative or not probative. [Note 13.] *See* TBMP § 1208.01. If a large number of web pages are submitted, it is preferable for the applicant and examining attorney to highlight in their briefs the most probative evidence. [Note 14.] *See* TBMP § 1203.01.

Definitions available from an online resource, including online dictionaries and translations, that are readily available and therefore capable of being verified are acceptable. [Note 15.] In general, evidence from online dictionaries that do not otherwise appear in printed format should be submitted prior to appeal so that the nonoffering party has an opportunity to check the reliability of the evidence and/or timely offer rebuttal evidence. [Note 16.] The Board will not take judicial notice of such material unless the online dictionary definitions are from references that are the electronic equivalent of a print dictionary or have regular fixed editions. [Note 17.] TBMP § 1208.04. The Board will consider evidence taken from Wikipedia so long as the nonoffering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. The better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia's sources. [Note 18.] Similarly, the Board will consider dictionary definitions taken from Urban Dictionary (urbandictionary.com), a collaborative online dictionary of slang terms, so long as the non-offering party has an opportunity to rebut that evidence by submitting other definitions. [Note 19.]

The Board also will consider Internet blog postings as well as individual comments thereto, and accord such evidence the appropriate probative value depending on its source of origin and its relationship to the issue at hand. [Note 20.] In addition, the Board will consider multimedia evidence [Note 21], including video files submitted during examination through TEAS. [Note 22.]

The Board may consider evidence obtained from social media sites such as Facebook, Twitter, and LinkedIn. [Note 23.]

NOTES:

1. *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017) ("Because the information displayed at a link's Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record."); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1462 n.8 (TTAB 2017) (providing only a web address or hyperlink is insufficient to make such materials of record); *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013) (same); *In re White*, 73 USPQ2d 1713, 1716 n.5 (TTAB 2004); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1682 n.9 (TTAB 2006)

(Board considered web pages that did not include web addresses because applicant did not object to them). *See also In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1143 n.13 (TTAB 2016) (Board considered still frame information about a video provided in witness declaration but not video itself because providing link to YouTube video does not suffice to introduce evidence into the record); *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (Board will not utilize web address to access site and consider whatever content appears).

2. *In re Mr. Recipe, LLC*, 1087 n.4 (TTAB 2016) (stories are probative of the perceptions of the authors and of the content received by the readers); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). *See, e.g., In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1829 (TTAB 2011) (printouts from web pages are not per se incompetent to show a term is generic).

3. *In re Nieves & Nieves, LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) ("We find that the articles from non-U.S. publications have some probative value in this case because it concerns the perception of the general U.S. public—the relevant consumers of the goods in the application—regarding the identity of a celebrity who lives and travels outside of the United States."); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 n.3 (TTAB 2008) (Board considered translation from www.babelfish.altavista.com); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006) (Board considered entries from WordReference.com Dictionnaire Francais-Anglais and Babel Fish Translation).

4. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (information originating on foreign websites that are accessible to the United States public may be relevant to discern U.S. consumer impression of a proposed mark); *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784, 1786 (TTAB 2013) (applicant's relevancy objection to evidence submitted by the examining attorney obtained from foreign websites overruled because evidence regarding the significance of the color black on floral packaging "would be difficult to locate"); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1681 n.7 (TTAB 2006) (web page from foreign source considered because case involved computer technology, and "it is reasonable to consider a relevant article regarding computer hardware" from an English-language website from another country); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (a consumer in the United States may turn to foreign websites when researching products they may wish to purchase); *In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (professionals in medicine, engineering, computers, telecommunications and other fields are likely to utilize all available resources, regardless of country of origin or medium, and the Internet is a resource that is widely available to these same professionals and to the general public in the United States). *Cf. Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2021 n.9 (TTAB 2014) ("Articles submitted by opposer from foreign publications (e.g., The Economist) have not been considered insofar as opposer did not provide evidence of U.S. circulation").

5. *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017) (as one factor, Board considered Canadian websites in English), *on appeal*, No. 17-2392 (Fed. Cir. August 3, 2017).

6. *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017) ("Potential consumers of Applicant's scientific research services and product testing services are likely to encounter the foreign websites as part of a search for companies that offer services related to the research, testing and development of products that are designed to improve one's health and well-being, particularly research that can be applied to indoor environments such as a workplace."), *on appeal*, No. 17-2392 (Fed. Cir. August 3, 2017).

7. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) ("Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations"); *In re Star Belly Stitcher, Inc.*, 107 USPQ2d

2059, 2062 n.4 (TTAB 2013) (Google search engine results had "limited probative value"; insufficient text to show context); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); *In re Innovative Cos.*, 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits is irrelevant); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1679 n.3 (TTAB 2006) (listings of search results from Google database of limited probative value because the excerpts are extremely truncated); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002) (results of search by Yahoo! search engine of little probative value, largely because insufficient text available to determine the nature of the information and, thus, its relevance). *But see In re Hotels.com L.P.*, 87 USPQ2d 1100, 1105 n.7 (TTAB 2008), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (although websites referenced in summary format, sufficient information in the summary to understand the context of usage).

8. *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

9. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013) (while Google search engine retrieved over 100,000 results, evidence was of "limited probative value"); *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1153 n.1 (TTAB 2008) (no probative weight given to fact that search using Google search engine retrieved 22,200 hits; further, "hit list" does not corroborate that there are 22,200 relevant references).

10. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (much of the 300 pages of Internet material submitted by applicant unhelpful because duplicative, or reference different terms, or for services in different fields or otherwise irrelevant).

11. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (criticizing applicant for not pointing out in brief specific Internet evidence believed to be most probative of its position when significant amount of material made of record: "it is incumbent on the applicant and the examining attorney to specify in their briefs those pieces of evidence that they believe are most persuasive of their respective positions, so that the Board can consider that evidence in particular").

12. *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006).

13. *In re Change Wind Corp.*, 123 USPQ2d 1453, 1463 n.9 (TTAB 2017).

14. *In re Change Wind Corp.*, 123 USPQ2d 1453, 1463 n.9 (TTAB 2017) ("The better practice is to use the image search result page to click through to the originating website and obtain a copy of the original image on the originating website in order to provide the context from which evidentiary points the party proffering the image wishes to make can be supported.").

15. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *See also In re Geller*, 751 F.3d 1355, 110 USPQ2d 1867, 1868 n.2 (Fed. Cir. 2014) (court, in noting that appellants do not contest the Board's reliance on an online dictionary definition of "terrorism," nonetheless pointed out that other more specific definitions could be found in various international treaties and national statutes but found that it was "certainly adequate for the purposes of this case."); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009) (Board considered definition from Encarta online dictionary, made of record by examining attorney).

16. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *Cf. In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009) (Internet evidence submitted with denial of request for reconsideration properly of record; if applicant wanted to challenge the evidence, it should have filed a request for remand); *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009) (if applicant wished to raise questions about probative value of online dictionary definition submitted with examining attorney's final office action he should have submitted guidelines for dictionary with a request for reconsideration).

17. *See In re Swatch Group Management Services AG*, 110 USPQ2d 1751, 1755, n.9 (TTAB 2014) ("In this case, the definition proffered is from the online dictionary found at <merriam-webster.com>, and we take notice of it"); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

18. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1959 n.3, (TTAB 2016) (applicant had ample opportunity to rebut Wikipedia evidence submitted by Examining Attorney but did not); *In re Hinton*, 116 USPQ2d 1051, 1053 n.10 (TTAB 2015) ("The Board gives guarded consideration to evidence taken from Wikipedia, bearing in mind the limitations inherent in this reference work, so long as the non-offering party has an opportunity to rebut the evidence by submitting other evidence that may call its accuracy into question."); *In re Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). *See also In re Swatch Group Management Services AG*, 110 USPQ2d 1751, 1754 n.4 (TTAB 2014) (Board considered Wikipedia evidence submitted with examining attorney's first office action which applicant had an opportunity to rebut); *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1382 n.2 (TTAB 2012) (Wikipedia evidence considered because examining attorney had opportunity to rebut the evidence); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 nn.4, 6, 7 (TTAB 2009) (considering Wikipedia evidence attached to Office action and applicant's response); *In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152, 1153, 1154 n.3 (TTAB 2006) (considering "illuminating" entry from Wikipedia submitted with Office action and subsequent update submitted by applicant).

19. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013) (Board considered entries obtained from the online Urban Dictionary because they were submitted early enough to afford applicant an opportunity to submit any alternative meanings or otherwise question the reliability of the definitions).

20. *See In re Geller*, 751 F.3d 1355, 110 USPQ2d 1867, 1870 (Fed. Cir. 2014) (the Board, in noting that "the probative value of the blog comments … is less than that of the articles themselves due to the anonymity of the authors," did not err in concluding that such comments shed light on the meaning of the term "Islamisation"); *In re Morrison & Foerster LLP*, 110 USPQ2d 1423, 1424 n.2 (TTAB 2014) ("These blog postings are from what appear to be well-established media sources with national circulation and public exposure as well as more obscure blogs for which we cannot ascertain the degree of exposure. As such, we are aware that many of the blogs may simply reflect the perception of a single author and not that of the general public.").

21. *In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1025 n.56 (TTAB 2017) (Board considered audio-visual materials containing television commercials in evaluating whether applicant's proposed single color mark had acquired distinctiveness).

22. *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1143 n.13 (TTAB 2016) (TEAS accepts multimedia evidence, including video files under 30 MB).

23. *See In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1720 (TTAB 2016) (Board considered social media evidence relating to individuals bearing the surname Adlon because "they illustrate the ways in which members of the public may be exposed to people who bear the surname ADLON.").

1208.04 Judicial Notice

The Board may take judicial notice of dictionary definitions, including definitions in technical dictionaries, translation dictionaries and online dictionaries which exist in printed format or that have regular fixed editions. [Note 1.] Definitions found in slang dictionaries are also appropriate for judicial notice. [Note 2.]

The Board may also take judicial notice of encyclopedia entries, census data, standard reference works and of commonly known facts. [Note 3.]

The Board will generally not take judicial notice of definitions or entries found only in online dictionaries or reference works not available in a printed format [Note 4.]; however, it will take judicial notice of definitions or entries from references that are the electronic equivalent of a print reference work or that have regular fixed editions. [Note 5.] The Board will not take judicial notice of dictionary definitions if it is not clear what the source of the material is. [Note 6.]

The Board normally does not take judicial notice of a term based on English spoken in another country, such as a dictionary definition reflecting "British English." [Note 7.] However, there are circumstances where information originating outside the United States but accessible within this country may be probative as to U.S. consumer impression of a proposed mark, and the Board may exercise its discretion to take judicial notice of such information. [Note 8.] The Board will not utilize a link or reference to a website's Internet address to consider content that may appear there. [Note 9.]

The Board's well-established practice is not to take judicial notice of third-party registrations when an applicant or examining attorney requests that such notice be taken during the course of an appeal. [Note 10.] *See* TBMP § 1208.02. There are several reasons for this practice. First, the record should be complete before the filing of any appeal to the Board. *See* 37 C.F.R. § 2.142(d); TBMP § 1203.02(e), TBMP § 1203.01, TBMP § 1207.01, and TBMP § 1208.02. Once an appeal has been filed, the proper way to seek to add evidence to the record is to file a written request with the Board to suspend the appeal and remand the application for further examination. *See* TBMP § 1207.02. Second, the proper way to make third-party registrations of record is not to list them, but to "submit copies of the registrations themselves, or the electronic equivalent thereof, from the USPTO's electronic databases." *See generally* TBMP § 1207.03. Third, and more fundamental, the Board's judicial notice practice, as well as these other practices, are designed to encourage applicants (and examining attorneys) to fully raise their arguments during prosecution, where they can be more efficiently resolved, and to avoid unnecessary or inefficient appeals.

For a full discussion of judicial notice, see TBMP § 704.12.

NOTES:

1. *In re Morinaga Nyuguo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016) (Board took judicial notice of the locations of Puyallup, Washington and Mount Rainer); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-1768 (TTAB 2016) (Board may take judicial notice of online dictionary definitions also available in printed form); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions); *In re Thomas White International Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013) (judicial notice

taken from dictionary existing in print format); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 (TTAB 2012) (judicial notice taken of definition from online dictionary stating it was from a specified print dictionary); *In re Premiere Distillery LLC*, 103 USPQ2d 1483, 1484 (TTAB 2012) (judicial notice taken of online dictionary reference based on Random House Dictionary); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1642 n.4 (TTAB 2011) (Board may take judicial notice of dictionaries, including online dictionaries which exist in print format); *In re Greenliant Systems, Inc.*, 97 USPQ2d 1078, 1080 n.5 (TTAB 2010) (same); *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010) (judicial notice taken of definitions from Random House Dictionary as accessed at the website www.dictionary.com); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009) (judicial notice taken of definitions in The Dictionary of Multimedia Terms & Acronyms, Illustrated Computer Dictionary for Dummies and The Computer Glossary); *In re Hotels.com, L.P.*, 87 USPQ2d 1100, 1103 (TTAB 2007) (definition from The American Heritage Dictionary of the English Language, retrieved from bartleby.com website), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 n.3 (TTAB 2008) (judicial notice taken of definition in Cassell's Spanish-English English-Spanish Dictionary); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1285 n.2 (TTAB 2006) (judicial notice taken of definition in Cassell's New French Dictionary); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957 (TTAB 2006) (judicial notice taken of definitions in Computer Desktop Encyclopedia and Dictionary of Computer and Internet Terms); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1653 n.8 (TTAB 2005) (definition from net.speak--the internet dictionary), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1568 n.7 (TTAB 2005) (judicial notice taken of translation in Cassell's Italian Dictionary); *In re Styleclick.com*, 58 USPQ2d 1523, 1525 (TTAB 2001) (definitions from computer dictionaries, i.e., net.speak—the internet dictionary, The Computing Dictionary and The Illustrated Dictionary of Microcomputers); *In re 3Com Corp.*, 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (judicial notice of definitions in technical reference works); *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1210 n.6 (TTAB 1999) (dictionary definition submitted with examining attorney's brief); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1537 (TTAB 1998) (well settled that dictionary listings comprise matter of which Board can take judicial notice); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (definitions from Webster's New Geographical Dictionary submitted with examining attorney's appeal brief); *In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 n.6 (TTAB 1997) (definition from Black's Law Dictionary); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 n.2 (TTAB 1988) (judicial notice of technical trade dictionaries such as IEEE Standard dictionary of Electric and Electronics Terms) *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

2. *In re Wilcher Corp.*, 40 USPQ2d 1929, 1933 n.4 (TTAB 1996).

3. *See, e.g.*, *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1205 n.10 & n.12 (TTAB 2017) (Board took judicial notice that "eszett" is the letter ß in the German alphabet from online translation dictionary Langenscheidt Dictionary at en.langenscheidt.com/german-english/eszett and separately that one origin of the surname WEISS is a German habitational name from Dictionary of American Family Names (Oxford University Press 2003)); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.3 (TTAB 2016) (Board may take judicial notice of information from encyclopedias); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 n.7 (TTAB 2016) (Board may take judicial notice of U.S. Census Report); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (Board took judicial notice that beer is often relatively inexpensive, subject to impulse purchase, and often ordered orally in a bar or restaurant); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 n.6 (TTAB 2015) (Board took judicial notice of the August 2013 United States Census Bureau's "Language Use in the United States: 2011" report, indicating that after English, Spanish is the most commonly spoken language in the United States, and over 12% of the United States population speaks Spanish); *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (Board took judicial notice

of two online government reports providing statistics of Internet use in the United States); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.24 (TTAB 2013) (judicial notice taken of entry for "tea" from Encyclopedia Britannica); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009) (judicial notice taken of listing in Computer Desktop Encyclopedia); *In re Tokutake Industry Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008) (census data); *In re Yeley*, 85 USPQ2d 1150, 1153 nn.10, 11 (TTAB 2007) (judicial notice taken of The Little Giant Encyclopedia of Names, and that some persons use initials in lieu of a given name); *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1291 (TTAB 2007) (common knowledge that places are often named after individuals); *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1923 n.2 (TTAB 2007) (judicial notice taken of entry for Baikal Lake in Encyclopedia International); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006) (Baton Rouge is the capital of Louisiana); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1566 n.5 (TTAB 2005) (Statistical Abstract of the United States regarding population of the United States; the population of the United States is a fact of which judicial notice can be taken); *In re Eddie Z's Blinds and Drapery Inc.*, 74 USPQ2d 1037, 1038 n.3 (TTAB 2005) (definition in McGraw Hill Computer Desktop Encyclopedia); *In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (judicial notice taken of Merriam-Webster's Geographical Dictionary and The Columbia Gazetteer of North America); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.5 (TTAB 2001) (judicial notice taken of The Encyclopedia of Furniture, The Complete Guide To Furniture Styles, and Seng Furniture Facts showing that Danish, Scandinavian and Mediterranean are styles of furniture); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 n.2 (TTAB 2001) (the National League is part of Major League Baseball); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 n.5 (TTAB 2001) (common knowledge that radio broadcasts may be heard in real-time on the Internet); *In re Dial-A-Mattress Operating Corp.*, 52 USPQ2d 1910, 1916 (TTAB 1999) toll-free telephone area codes such as "1-888" are used by numerous persons and businesses), *rev'd on other grounds*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (*In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1998) (judicial notice taken of Physician's Desk Reference and other PDR publications); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1704 n.3 (TTAB 1998) ("U.S." means the United States, and the United States is a geographic area with defined boundaries); *In re Perry Manufacturing Co.*, 12 USPQ2d 1751, 1752 (TTAB 1989) (New York is world-renowned center of culture and high fashion and people from throughout world go to New York to purchase latest styles in clothing, from haute couture to off-the-rack garments).

Compare, In re Brown-Forman Corp., 81 USPQ2d 1284, 1286 (TTAB 2006) (Board denied request for judicial notice that Moulin Rouge is a famous Parisian nightclub and that its name served as title of a film starring Nicole Kidman that was nominated for an Academy Award); *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006) (Board did not take judicial notice of Internet search); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1379 n.7 (TTAB 2006) (Board would not take judicial notice of "scholarly reviews" of an essay).

4. *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (on appeal, Board will not take judicial notice of definitions from Wikipedia or commercial websites that do not constitute dictionary definitions); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007) (Board would not take judicial notice of online encyclopedia); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *See also In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1447 n.3 (TTAB 2000).

5. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (judicial notice taken of definition from Merriam-Webster Online Dictionary and Thesaurus); *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (judicial notice taken of definition from Merriam-Webster Online Dictionary from www.merriam-webster.com); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (judicial notice taken of definition from Dictionary.com because from The Random House Unabridged Dictionary); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008)

(judicial notice taken of definition from Merriam-Webster Online Dictionary); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (judicial notice taken of definition from *Encarta Dictionary* because it is readily available in specifically denoted editions via the Internet and CD-ROM).

Please Note: the Board will consider definitions found only in online dictionaries if made of record during the prosecution of the application. *See* TBMP § 1208.03.

6. *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (on appeal, Board will not take judicial notice from excerpts that do not indicate source); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (judicial notice not taken of photocopies submitted with examining attorney's brief because neither the pages nor brief specified the dictionaries from which the copies were made).

7. *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n.2 (TTAB 2012) (Board declined to take judicial notice of term from Cambridge Dictionaries Online because definition stated it was "British English"). *Cf. In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1313 (TTAB 2014).

8. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) ("The probative value, if any, of foreign information sources must be evaluated on a case-by-case basis.").

9. *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n.3 (TTAB 2012) (Board did not take judicial notice of online dictionary definition because only the link to the website was provided). *Cf. In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (Board will not utilize web address to access site and consider whatever content appears).

10. *In re House Beer, LLC*, 114 USPQ2d 1073, 1075 (TTAB 2015) (Board does not take judicial notice of files of applications or registrations residing in the Office, including entries in file of cited registration); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (request in reply brief that Board take judicial notice of "thousands of registered marks incorporating the term NEW YORK for products and services that do not originate in New York state or city" denied), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 n.18 (TTAB 2011); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998); *In re Caserta*, 46 USPQ2d 1088, 1090 n.4 (TTAB 1998) (Board refused to take judicial notice of the characters listed in registrations and their manner of use); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (Oct. 7, 2016) (no judicial notice of USPTO records; "The official record of a Board proceeding must be complete, accurate, and reliable, especially because in direct appeals to the Federal Circuit the court's review of the Board's decision is confined to the four corners of the administrative record. … The burden of creating a complete evidentiary record by introducing in documentary form information contained in the USPTO's trademark file records is most appropriately borne by the party wishing to introduce such evidence rather than by the Board."). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-68 (TTAB 2016) (on appeal, Board denied request to take judicial notice of patent).

1208.05 Applicant's Own Materials

An applicant's materials, such as its website or advertisements describing its goods or services, or specimens showing use of its mark, may be considered. [Note 1.] This is the case even if the applicant files its application based on an intent-to-use or changes the basis of its application to intent-to-use. [Note 2.]

An applicant's submissions of expert reports [Note 3] and surveys [Note 4] are considered for their probative value.

NOTES:

1. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (as a matter of law, the Board "did not err by considering the explanatory text of the specimens in the descriptiveness inquiry"); *In re Emergency Alert Sols. Group, LLC*, 122 USPQ2d 1088, 1091 n.16, 1092 (TTAB 2017) (Board considered applicant's own webpage and specimen describing its services in affirming genericness refusal); *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1202 (TTAB 2017) (Board, in affirming surname refusal, considered applicant's website stating that WEISS is the surname of Applicant's founder and head watchmaker).

2. *In re Hunter Fan Co.*, 78 USPQ2d 1474, 1476 n.2 (TTAB 2006) (specimen submitted when application based on Trademark Act § 1(a) remains of record even though applicant later amended its application to Trademark Act § 1(b)); *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (examining attorney may introduce evidence that applicant's own literature supports descriptiveness of term despite the fact that application based on intent-to-use; fact that applicant has filed an intent-to-use application does not limit the examining attorney's evidentiary options or shield an applicant from producing evidence that it may have in its possession).

3. *See, e.g., In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1830-31 (TTAB 2011).

4. *See, e.g., In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1831-32 (TTAB 2011).

1208.06 Confidential Material

Submissions filed in ex parte examination and subsequent appeal proceedings cannot be filed under seal pursuant to a protective order unless so issued or ordered by any court or by the Board. 37 C.F.R. § 2.27(d), 37 C.F.R. § 2.27(e). [Note 1.]

NOTES:

1. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1962 n.6 (TTAB 2016) (consent agreement, in addition to supporting registration, provides the public with notice of the basis on which the USPTO allowed registration). *Compare Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 n.4 (TTAB 2011) (parties' confidential consent agreement referred to in general terms).

1209 Remand

1209.01 Upon Board's Own Initiative

37 C.F.R. § 2.142(f)

(1) *If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examining attorney for further examination to be completed within the time set by the Board.*

(2) *If the further examination does not result in an additional ground for refusal of registration, the examining attorney shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.*

(3) *If the further examination does result in an additional ground for refusal of registration, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. If the ground for refusal is made final, the examining attorney shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.*

(4) *If the supplemental brief of the appellant is filed, the examining attorney shall, within sixty days after the supplemental brief of the appellant is sent to the examining attorney, file with the Board a written brief answering the supplemental brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.*

(5) *If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section. If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.*

If, during an ex parte appeal to the Board, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may issue a written action suspending the appeal and remanding the application to the examining attorney for further examination with respect to that issue. [Note 1.] However, the Board normally will not remand an application for consideration of a requirement or ground for refusal if the examining attorney had previously made that requirement or refused registration on that ground and then withdrew it. [Note 2.]

The Board may also sua sponte remand an application to the examining attorney if, after examination and/or briefing has been completed, a decision in another case is rendered that is likely to have a bearing on the examining attorney's position. [Note 3.] Or the Board may remand an application for clarification of the issues on appeal, where, for example, the examining attorney and the applicant appear to be arguing different grounds of refusal.

The further examination must be completed within the time set by the Board, or within an extension of time for that purpose. [Note 4.]

If the examining attorney, upon consideration of the issue specified in the Board's remand letter, does not believe that the specified issue renders the mark of the applicant unregistrable, the examining attorney must promptly return the application to the Board with a written statement that further examination did not result in an additional requirement or ground for refusal of registration. [Note 5.] The Board will then resume proceedings with respect to the appeal, and take further appropriate action. The issues ultimately determined by the Board will be those that were the subject of the appeal; no consideration will be given to the issue that was the subject of the remand. [Note 6.]

If, on the other hand, the further examination does result in an additional requirement or ground for refusal of registration, the examining attorney and the applicant should proceed as specified in 37 C.F.R. § 2.61 through 37 C.F.R. § 2.63. [Note 7.] If the additional requirement or ground for refusal of registration is ultimately made final, the six-month response clause should be omitted from the Office action; the application

should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. Specifically, the Board will issue an order allowing the applicant 60 days from the date of the order in which to file a supplemental brief directed (solely) to the additional ground for refusal of registration. [Note 8.]

If the applicant fails to file a supplemental brief within the specified 60-day period, or during an extension of time for that purpose, the appeal may be dismissed. [Note 9.] If the applicant files a supplemental brief, the Board will forward the application to the examining attorney. Within 60 days after the date of the Board's written action forwarding the application to the examining attorney, or within an extension of time for that purpose, the examining attorney must file a written brief answering the supplemental brief of the applicant. If the examining attorney had not previously submitted an appeal brief, the written brief may answer not just the applicant's supplemental brief, but also its original appeal brief. [Note 10.] The examining attorney must also send a copy of his or her brief to the applicant. [Note 11.] If the examining attorney's brief is late-filed, the Board may exclude it in the absence of an adequate explanation for the late filing. [Note 12.] TBMP § 1203.02(b). Within 20 days from the date of the examining attorney's brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief. [Note 13.] The filing of a reply brief is not mandatory. If the applicant files a reply brief, the Board will notify the examining attorney so that it can be reviewed.

If an oral hearing on the appeal had been requested by the applicant prior to the remand of the application, but had not yet been held, the oral hearing will be set after the expiration of the applicant's time for filing a reply brief or, depending on the circumstances, a supplemental reply brief directed to the additional ground for refusal of registration. [Note 14.] If an oral hearing had been held prior to the remand, or had not previously been requested by the applicant, an oral hearing may be requested by the applicant by separate submission filed not later than 10 days after the due date for a reply brief on the additional ground for refusal of registration; the oral hearing will be set by the Board upon receipt of the request. [Note 15.]

If the examining attorney is persuaded by the applicant's supplemental brief and/or reply brief that the additional requirement or ground for refusal of registration should be withdrawn, the examining attorney should issue a written action withdrawing the requirement or additional ground, and return the application to the Board for resumption of proceedings in the appeal.

The examining attorney may not, upon remand under 37 C.F.R. § 2.142(f)(1), make a requirement or refuse registration on a new ground not specified in the Board's remand letter. If the examining attorney, upon remand, wishes to make a requirement or refuse registration on a new ground not specified in the Board's remand letter, the examining attorney must file a request with the Board, pursuant to 37 C.F.R. § 2.142(f)(6), for jurisdiction to make a requirement or refuse registration on the new ground. Nor may the examining attorney, upon remand under 37 C.F.R. § 2.142(f)(1), submit evidence relating to a requirement or ground not specified in the Board's remand letter. [Note 16.] For information on informalities which are noted by the Board in its final decision, but for which remand was not considered necessary, see TBMP § 1217.

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP § 1207.05.

NOTES:

1. 37 C.F.R. § 2.142(f)(1). *See In re Opryland USA Inc.*, 1 USPQ2d 1409, 1411 (TTAB 1986); *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *In re Johanna Farms, Inc.*, 223 USPQ 459, 461 (TTAB 1984). *See also In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365, 1369 (Fed. Cir. 1988), *rev'g* 230 USPQ 77, 79 (TTAB 1986).

2. *In re Bed & Bars Ltd.*, 122 USPQ2d 1546, 1548 n.2 (TTAB 2017) ("the Board normally will not remand an application for consideration of a ground of refusal if the Examining Attorney … had previously refused registration on that ground and then withdrew the refusal").

3. *See In re Dekra e.V.*, 44 USPQ2d 1693, 1694-95 (TTAB 1997) (after briefs were filed, the Federal Circuit issued a decision with applicability to the case; Board remanded case to examining attorney to consider refusal in light of that decision). *See also In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1922 (TTAB 2004) (Board granted examining attorney's request for remand in view of Federal Circuit decision setting forth new standard for primarily geographically deceptively misdescriptive marks).

4. 37 C.F.R. § 2.142(f)(1).

5. *See* 37 C.F.R. § 2.142(f)(2). *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

6. *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

7. 37 C.F.R. § 2.142(f)(3).

8. 37 C.F.R. § 2.142(f)(3).

9. 37 C.F.R. § 2.142(f)(3).

10. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

11. 37 C.F.R. § 2.142(f)(4).

12. *Cf. In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188 n.3 (TTAB 1984).

13. 37 C.F.R. § 2.142(f)(4).

14. 37 C.F.R. § 2.142(f)(5).

15. 37 C.F.R. § 2.142(f)(5).

16. *See In re W.W. Henry Co.*, 82 USPQ2d 1213, 1213-14 (TTAB 2007) (because claimed date of first use and use in commerce is subsequent to application filing date, final decision allowed applicant to file either an amendment to the dates of use or an amendment to the basis for the application); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1545 n.1 (TTAB 1996) (in final decision, Board recommended that applicant, if it ultimately prevailed, amend description of mark to clearly set forth claim); *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing).

1209.02 Upon Request by Trademark Examining Attorney

37 C.F.R. § 2.142(f)(6) *If, during an appeal from a refusal of registration, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examining attorney may, by written request, ask the Board to suspend the appeal and to remand the application to the examining attorney for further examination. If the request is granted, the examining*

attorney and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. After the additional ground for refusal of registration has been withdrawn or made final, the examining attorney shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

If, during an ex parte appeal to the Board, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable, the examining attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. [Note 1.] Such a request may be filed at any point in the appeal prior to the Board's rendering a final decision, including at the point the examining attorney is to submit his or her appeal brief or supplemental appeal brief. [Note 2.]

Because the mandate of the USPTO is to register only eligible marks, an examining attorney's request for remand will generally be granted unless there is no valid basis for the request, e.g., remand is requested to require a disclaimer of a term which is not part of the mark. If the examining attorney's request for remand is granted, the Board will forward the application to the examining attorney for further examination in accordance with the request. In its action granting the request, the Board will allow the examining attorney a specified time in which to issue an Office action pursuant to the request. Thereafter, the examining attorney and applicant should proceed as provided in 37 C.F.R. § 2.61 through 37 C.F.R. § 2.64. [Note 3.]

If, upon remand, the examining attorney determines that registration should not be finally refused on the additional ground or that it is appropriate to withdraw the requirement mentioned in the request for remand, the examining attorney should issue a written Office action in which the six-month response clause is omitted and return the application to the Board; proceedings with respect to the appeal will be resumed and further appropriate action will be taken therein. [Note 4.] If the examining attorney determines, after considering applicant's response to the nonfinal Office action, that a final refusal on that ground should issue or that a requirement should be made final, the examining attorney should issue a new action, omitting the six-month response clause, which makes the refusal final as to both the additional ground and/or requirement and the ground(s) and/or requirements asserted in the previous final action. The application should then be returned to the Board, and proceedings in the appeal will be resumed. For information as to the further action taken by the Board, i.e., for information concerning the filing of supplemental briefs, and a request for oral hearing, see TBMP § 1209.01. [Note 5.]

The examining attorney may not, upon remand under 37 C.F.R. § 2.142(f)(6), make a requirement or refuse registration on a new ground not mentioned in the examining attorney's request for remand. If the examining attorney, upon remand, wishes to make a new requirement or refuse registration on a new ground not mentioned in the request for remand, the examining attorney must file a new request with the Board for jurisdiction to make a new requirement or refuse registration on the new ground. Nor may the examining attorney submit evidence that does not relate to the requirement or ground mentioned in the request for remand; thus, the examining attorney may not submit evidence that supports the grounds for refusal on which the appeal was originally filed.

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP § 1207.05.

NOTES:

1. 37 C.F.R. § 2.142(f)(6).

2. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998) (Board granted examining attorney's request for remand which was filed after submission of applicant's appeal brief and supplemental appeal brief in order to allow examining attorney to refuse registration on additional ground).

3. *See* 37 C.F.R. § 2.142(f)(6). *Cf.* 37 C.F.R. § 2.142(f)(3).

4. *See* 37 C.F.R. § 2.142(f)(6).

5. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

1209.03 Upon Granted Letter of Protest

A third party that has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy, a "letter of protest," that is, a letter that recites the facts and which is accompanied by supporting evidence. [Note 1.] TBMP § 1207.06. The Deputy Commissioner will determine whether the information should be given to the examining attorney for consideration. *See* TBMP § 215.

Proceedings in an ex parte appeal will not be suspended pending determination by the Deputy Commissioner of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the examining attorney, having considered the supporting evidence submitted with the letter of protest, believes that an issue not involved in the appeal may render the mark of the applicant unregistrable, the examining attorney may file a written request with the Board, pursuant to 37 C.F.R. § 2.142(f)(6), to suspend the appeal and remand the application for further examination.

For information concerning requests for remand for a new refusal or new requirement, and the further proceedings in the case if such a request is granted by the Board, see 37 C.F.R. § 2.142(f)(6), and TBMP § 1209.02.

NOTES:

1. *See* TMEP § 1715.

1209.04 Upon Request by Applicant

A request filed by an applicant to remand the application to the examining attorney that is filed within six months of the issuance of a final Office action is treated as a request for reconsideration, whether it is denominated as such, or is captioned as a request for remand. Requests for reconsideration are granted by the Board as a matter of right. *See* TBMP § 1204. However, if the examining attorney denies a request for reconsideration after the appeal is filed, a second request for reconsideration will be treated as a request for remand even if it is filed within six months of the final Office action. If the request is filed more than six months after the issuance of the final refusal (generally after the filing of the notice of appeal), it will be treated as a request for remand, whether it is captioned as such or is captioned as a request for reconsideration. *See* TBMP § 1202.04.

Requests for remand are generally filed by applicants because they wish to make additional evidence of record, or because they wish to amend the application. Applicants may also request remand so that the examining attorney can consider a refusal in light of a recently decided case or amended Trademark Rule.

[Note 1.] No matter what the purpose, the request for remand must include a showing of good cause. [Note 2.] In determining whether good cause has been shown, the Board will consider both the reason given and the point in the appeal at which the request for remand is made. For examples of circumstances that have been found to constitute good cause for a remand for the purpose of submitting additional evidence, see TBMP § 1207.02. For examples of what constitutes good cause for the purpose of amending an application, see TBMP § 1205.01.

If the applicant has not filed its appeal brief prior to filing the request for remand, it should not do so until the Board has acted on the remand request. If the request is denied, the Board will allow the applicant time in which to file its appeal brief. If the request for remand is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the examining attorney for consideration of the request for remand. The Board's order granting the remand and the directions to the examining attorney contained therein will depend on the nature of the remand request and the circumstances. If the request for remand is for the purpose of submitting additional evidence, see TBMP § 1207.02. If the request for remand is for the purpose of submitting an amendment to the application, see TBMP § 1205.01. The examining attorney may only consider the matter for which the application has been remanded. The examining attorney may not use the remand in order to submit evidence in connection with a refusal or requirement that is not the subject of the remand request. [Note 3.] To submit such evidence, the examining attorney would have to file separate request for remand. [Note 4.] *See* TBMP § 1207.02.

NOTES:

1. *But see In re Datapipe, Inc.*, 111 USPQ2d 1330, 1331 (TTAB 2014) (applicant's alternative request for remand to consider informal nonpublic examination guide denied).

2. *See In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002) (request for remand filed after notice of appeal in view of recent ruling by the Court of Appeals for the Federal Circuit). *Cf. In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) ("Applicant's brief on the case is not the appropriate avenue for raising an objection to examination procedures. If Applicant believed that the issuance of the June 8, 2014 Office Action was procedurally erroneous, or if Applicant desired more time to address the Examining Attorney's new evidence, Applicant's recourse was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause.") (citation omitted).

3. *In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015) (examining attorney's submission of evidence on likelihood of confusion refusal unacceptable when applicant's remand request was solely to comply with requirement for disclaimer).

4. 37 C.F.R. § 2.142(d). *See In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015) ("If, upon considering the request for remand the Examining Attorney wished to submit additional evidence regarding the Section 2(d) refusal (which was not affected by the disclaimer), the Examining Attorney should have filed with the Board her own request for remand for the purpose of submitting additional evidence in support of the likelihood of confusion refusal.").

1210 Approval for Publication During Appeal

The examining attorney may withdraw an appealed refusal to register, and approve the involved application for publication (or for registration, in the case of a Supplemental Register application), at any time prior to issuance of the Board's decision in the case. [Note 1.] *See, e.g.*, TBMP § 1203.02(b), TBMP § 1203.02(c),

TBMP § 1204, TBMP § 1205, and TBMP § 1207.02. When the examining attorney does so, the appeal becomes moot.

The examining attorney should notify the applicant and the Board by telephone or email that the application is being approved for publication (or registration). [Note 2.]

NOTES:

1. TMEP § 1501.03.

2. TMEP § 1501.03.

1211 Abandonment During Appeal

37 C.F.R. § 2.68 ***Express abandonment (withdrawal) of application.***

(a) ***Written document required.*** *An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (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)(2). A request for abandonment or withdrawal may not subsequently be withdrawn.*

(b) ***Rights in the mark not affected.*** *Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not affect any rights that the applicant may have in the mark set forth in the abandoned application in any proceeding before the Office.*

During an ex parte appeal to the Board, the applicant may expressly abandon its involved application by filing in the Office a written statement of abandonment or withdrawal of the application. The abandonment or withdrawal must be signed by the applicant or its attorney or other authorized representative. [Note 1.] A request for abandonment or withdrawal may not be subsequently withdrawn. [Note 2.]

The express abandonment, during an ex parte appeal to the Board, of the applicant's involved application will not, in any proceeding in the Office, affect any rights that the applicant may have in the mark that is the subject of the abandoned application. [Note 3.]

In contrast, after the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of its involved application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 3.] TBMP § 602.01 and TBMP § 603.

NOTES:

1. 37 C.F.R. § 2.68.

This amendment, effective February 17, 2015, is "intended to provide applicants, registration owners, and the public assurance of the accuracy of the status of applications or registrations after filings are received by the Office." MISCELLANEOUS CHANGES TO TRADEMARK RULES OF PRACTICE AND THE RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS, 80 Fed. Reg. 2303, 2307 (January 16, 2015).

3. 37 C.F.R. § 2.68. *See also Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ2d 1264, 1267 (1st Cir. 1987). *Cf. In re Honeywell Inc.*, 8 USPQ2d 1600, 1601-02 (TTAB 1988) (preclusive effect of prior final judgment arising out of an ex parte case); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1583 (TTAB 1987); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1301 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987).

4. 37 C.F.R. § 2.135.

1212 Cancellation or Assignment of Cited Registration

Often, in an ex parte appeal to the Board, the asserted ground (or one of the asserted grounds) for refusal of registration is Trademark Act § 2(d), 15 U.S.C. § 1052(d), that is, that applicant's mark so resembles a mark registered in the USPTO as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive.

If, during the pendency of an ex parte appeal involving a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), the cited registration is cancelled, or is assigned to the applicant, the appeal will be moot insofar as that issue is concerned. If the refusal to register on the basis of the cancelled or assigned registration is the only issue involved in the appeal, the Board will dismiss the appeal as moot, and the application will be sent to the examining attorney for approval for publication (or for registration, in the case of a Supplemental Register application). If the appeal involves additional issues, it will go forward solely on the additional issues.

When an application has been rejected under Trademark Act § 2(d), 15 U.S.C. § 1052(d), and the refusal to register has been appealed to the Board, it is recommended that the applicant periodically check the status of the cited registration. *See* TBMP § 1203. The applicant should immediately notify the Board if the applicant learns that the registration has expired or been cancelled, or if the registration is assigned to the applicant.

1213 Suspension of Appeal

Prior to the issuance of the Board's decision in an ex parte appeal, proceedings with respect to the appeal may be suspended by the Board upon written request by the applicant showing good cause for the requested suspension. [Note 1.] *Cf.* TBMP § 510. Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, are listed below:

(1) The applicant is involved in a civil action or a Board inter partes proceeding, that may be dispositive of the issue(s) involved in the appeal, or the applicant has filed a Petition to the Director that may have a bearing on the appeal—the Board may suspend pending final determination of the civil action or Board inter partes proceeding.

(2) Another application that involves the same issue is also on appeal to the Board—the Board may suspend pending final determination of the appeal in the other application.

(3) A registration cited as a reference, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), against applicant's mark is due, or will soon be due, for an affidavit of continued use (or excusable nonuse) under Trademark Act § 8 or Trademark Act § 71, 15 U.S.C. § 1058 or 15 U.S.C. § 1141k, [Note 2.] or for an application for renewal under Trademark Act § 9 or Trademark Act § 70, 15 U.S.C. § 1059 or 15 U.S.C. § 1141j. [Note 3.] The Board may suspend the appeal pending determination of whether the registration will continue in existence or will, instead, be cancelled or expire. If an applicant requests suspension based on the possibility that the cited registration may be cancelled for failure to file an affidavit of continued use,

the Board will grant such request if the Board acts on the request after the 5th anniversary of the issue date of the registration. If an applicant requests suspension based on the possibility that the cited registration will expire for failure to renew it, the Board will grant such request if the Board acts on the request after the 9th anniversary of the issue date or the renewal date for the registration.

If it comes to the attention of the examining attorney, in the case of a refusal based on likelihood of confusion with a registered mark (Trademark Act § 2(d), 15 U.S.C. § 1052(d)), that the grace period for filing an affidavit of continued use or an application for renewal for the cited registration has passed, and Office records do not indicate that such items have been submitted, the examining attorney may request remand so the application can be suspended pending final disposition of the cited registration. [Note 4.] In that situation, the Board will issue an order suspending the appeal and remanding the case to the examining attorney. If the cited registration is cancelled or expires, and that registration forms the only basis for refusal, the examining attorney will approve the application for publication (or for registration in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should so notify the applicant and the Board by telephone or email. If the Trademark Act § 2(d), 15 U.S.C. § 1052(d) refusal is only one of the issues of the appeal, the examining attorney should notify the Board that the refusal with respect to that registration has been withdrawn, and the Board will then resume proceedings in the appeal. If it is determined that an appropriate affidavit or renewal application was timely filed for the cited registration and has been accepted, the examining attorney should notify the Board, and return the application to the Board. The Board will then resume proceedings in the appeal.

If the grace period for filing the appropriate affidavit or renewal application for the cited registration has not yet expired, the examining attorney may request that the Board suspend proceedings in the appeal. In that case, the Board will issue an order advising the applicant the Board is suspending proceedings in the appeal, and giving the applicant the opportunity to inform the Board if it wishes the appeal to proceed without waiting for a determination as to whether the cited registration will be cancelled or will expire. If the applicant wishes the appeal to proceed, the cited registration will be treated as existing and valid. If the appeal is suspended, and if an appropriate affidavit or renewal application is filed and accepted for the cited registration, the examining attorney should notify the Board. The Board will then resume proceedings in the appeal.

The examining attorney may also request suspension if it comes to his or her attention that another application that involves the same issue is on appeal to the Board. In that circumstance, the examining attorney may also request that the appeals be consolidated. *See* TBMP § 1214.

A request by either the applicant or the examining attorney for suspension of proceedings before the Board in an ex parte appeal must be filed prior to the issuance of the Board's final decision in the case. For example, an applicant that has appealed a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d) (i.e., a refusal to register on the ground that the applicant's mark so resembles a registered mark as to be likely to cause confusion) may not wait until it receives the Board's decision on appeal and then, if the decision is adverse, file a petition to cancel the cited registration and request suspension of proceedings in the appeal pending the final determination of the cancellation proceeding. [Note 5.]

When proceedings have been suspended at the request of the applicant in an ex parte appeal to the Board, and the event for which proceedings have been suspended occurs, as, for example, when a civil action for which proceedings have been suspended has been finally determined, the applicant should file a submission notifying the Board thereof as soon as that knowledge comes to the applicant's attention. When an appeal has been suspended pending a determination of whether a cited registration will be cancelled or will expire, the applicant should monitor the status of the cited registration on a monthly basis and should advise the Board as soon as it ascertains either that the registration has been cancelled or has expired, or that the required document has been accepted by the USPTO.

The Board will then resume proceedings and take further appropriate action in the appeal. If the cited registration has been cancelled or has expired, and it was the only bar to registration, the appeal will be dismissed as moot. If the cited registration formed only one basis of the refusals or requirements on appeal, the Board will resume proceedings in the appeal with respect to the remaining issues.

In addition, the Board may sua sponte suspend action in the appeal. For example, when the refusal of registration, or one of the grounds of refusal, is based on Trademark Act § 2(d), 15 U.S.C. § 1052(d), and it appears that the cited registration will be cancelled for failure to file an affidavit of continued use or will expire for failure to renew, the Board will suspend action when an ex parte appeal has been assigned to a judge for final decision, and the due date for filing an affidavit or application for renewal of the cited registration falls on or before the date the case is assigned for decision. The due date is the anniversary date of the registration, and does not include the grace period. In this situation, the applicant will be advised that the Board is suspending proceedings in the appeal, and will be given the opportunity to inform the Board if it wishes the Board to render a decision without waiting to determine whether the cited registration will be cancelled or will expire. If the applicant wishes the Board to proceed with a decision, the cited registration will be treated as existing and valid.

The Board may also sua sponte suspend proceedings if the Board is aware of a pending civil action, an appeal of a Board decision, or a Board inter partes proceeding or another appeal that may be dispositive of or have a direct bearing on the issues in the appeal.

Proceedings in an ex parte appeal may also be suspended by the Board if the application is remanded to the examining attorney, as, for example, for (1) consideration of an amendment to the application, or (2) consideration of a request for reconsideration of a final action, or (3) assertion of a new ground of refusal, or (4) submission of additional evidence or (5) to consider the effect of a decision in another Board proceeding, appeal or civil action that may have a direct bearing on the issues in the appeal. *See* TBMP § 1202.02, TBMP § 1203.02(a), TBMP § 1203.02(b), TBMP § 1204, TBMP § 1205, TBMP § 1206.01, TBMP § 1207.02, TBMP § 1207.06, and TBMP § 1209. However, proceedings will not be suspended for consideration of a request for review under the USPTO Consistency Initiative. *See* TBMP § 1204.

NOTES:

1. *Cf.* 37 C.F.R. § 2.117.

2. A Trademark Act § 66(a), 15 U.S.C. § 1141f(a), registration is subject to the Trademark Act § 71 requirements for affidavits of continued use (or excusable nonuse). A Trademark Act § 71 affidavit is filed with the USPTO.

3. A renewal under Trademark Act § 70, 15 U.S.C. § 1141jrefers to a renewal of the international registration underlying a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) registration. A Trademark Act § 66(a) registration will be cancelled under Trademark Act § 70 for failure to renew the international registration on which it is based. Renewals of international registrations are filed directly with the International Bureau, not the USPTO. If the underlying international registration is not renewed, the International Bureau will notify the USPTO that the international registration has expired. The corresponding extension of protection to the United States will expire as of the expiration date of the international registration and the Trademark Act § 66(a) registration will be cancelled by the USPTO. *See* Trademark Act § 70, 15 U.S.C. § 1141j.

4. *See* TMEP § 716.02(e).

5. *See In re Vycom Electronics Ltd.*, 21 USPQ2d 1799, 1800 (Comm'r 1986).

1214 Consolidation

When an applicant has filed an ex parte appeal to the Board in two or more copending applications, and the cases involve common issues of law or fact, the Board, upon request by the applicant or examining attorney or upon its own initiative, may order the consolidation of the appeals for purposes of briefing, oral hearing, and/or final decision. [Note 1.] *Cf.* TBMP § 511. The Board may also consider two or more cases in one opinion even if they have not been consolidated. [Note 2.] Even if the Board renders its decisions on two appeals in a single opinion, the appeals will not necessarily be consolidated. [Note 3.]

Although cases consolidated prior to briefing may be presented on the same brief, they do not have to be. The applicant (and/or the examining attorney) may file a different brief in each case, if the applicant (and/or the examining attorney) so desires. When consolidated cases are to be presented on the same brief, the brief should bear the serial number of each consolidated application, and a copy of the brief should be submitted for each application.

NOTES:

1. *See, e.g., In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1085 (TTAB 2016) (Board consolidated appeals in two applications upon examining attorney's motion); *In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board sua sponte consolidated two appeals); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011) (same); *In re America Online Inc.*, 77 USPQ2d 1618, 1618 (TTAB 2006) (Board consolidated appeals in four applications upon applicant's motion); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997); (Board sua sponte considered appeals in five applications together and rendered single opinion); *In re Pebble Beach Co.*, 19 USPQ2d 1687, 1687 (TTAB 1991); *In re Del E. Webb Corp.*, 16 USPQ2d 1232, 1233 (TTAB 1990) (proceedings consolidated because issue in two appeals the same); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (applicant requested after hearing on one appeal that appeals be consolidated; Board granted and decided appeals in single decision); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659, 1662 n.7 (TTAB 1987); *In re Petersen Manufacturing Co.*, 2 USPQ2d 2032, 2033 (TTAB 1987) (four appeals consolidated for oral hearing and decision); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067, 1608 (TTAB 1983) (appeals consolidated for oral hearing and decision).

2. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion); *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009) (because appeals involved common questions of law and fact and records were practically identical, Board decided both in a single opinion); *In re Vertex Group LLC*, 89 USPQ2d 1694, 1695 (TTAB 2009) (because of virtually identical issues presented in appeals for two applications, Board issued single opinion); *In re Supply Guys Inc.*, 86 USPQ2d 1488, 1490 (TTAB 2008) (because issues and record similar, Board issued one opinion that addressed applicant's three applications); *In re Orange Communications Inc.*, 41 USPQ2d 1036, 1037-39 (TTAB 1996); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 (TTAB 1996) (because issues and record in each case essentially identical, Board rendered decision as to two applications in a single opinion, noting that applicant and examining attorney treated the cases as consolidated for purposes of briefs and oral hearing).

3. *In re Hudson News Co.*, 39 USPQ2d 1915, 1916 n.5 (TTAB 1996) (Board issued a single opinion in interest of judicial economy, but each appeal stands on its own merits), *aff'd without opinion* (Fed. Cir. 1997).

1215 Alternative Positions

Just as the examining attorney may refuse registration on alternative grounds (such as, that applicant's mark, as applied to its goods and/or services, is either merely descriptive or deceptively misdescriptive of them within the meaning of Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1)), so, too, the applicant may, in appropriate cases, take alternative positions with respect to a refusal to register. For example, where registration has been refused on the ground that the applicant's mark, as applied to its goods and/or services, is merely descriptive of them, the applicant may take the position that its mark is not merely descriptive, and, alternatively, assert a claim, under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f), that its mark has become distinctive of its goods and/or services in commerce. [Note 1.] *Cf.* TBMP § 309.03 and TBMP § 311.02(b). However, it is the applicant's responsibility to make clear that it is taking alternative positions. [Note 2.]

When an applicant asserts alternative positions, and is not willing to accept registration on the basis of its "fallback" position unless the Board determines, on appeal, that the applicant's primary position is not well taken, the applicant should make its wishes clear both to the examining attorney and to the Board. For example, when the applicant, in response to a refusal on the ground of mere descriptiveness, has asserted alternatively that its mark is not merely descriptive and that the mark has become distinctive through its use in commerce, but the applicant is not willing to accept a registration issued under Trademark Act § 2(f), 15 U.S.C. § 1052(f) on the basis of the claim of acquired distinctiveness unless the Board holds, on appeal from the refusal to register, that the mark is merely descriptive, the applicant should clearly state that its claim is "in the alternative." [Note 3.] Otherwise, if the examining attorney finds the applicant's claim of acquired distinctiveness to be persuasive (and there is no other outstanding ground for refusal to register), the examining attorney will approve the application for publication on that basis, and any registration issued to the applicant will be issued under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f). [Note 4.]

If, in an application that is the subject of an ex parte appeal to the Board, the applicant has asserted alternative positions (such as, that its mark is not merely descriptive of its goods and/or services, and that the mark has, in any event, become distinctive of its goods and/or services in commerce; or that its mark has become distinctive of its goods and/or services in commerce, and that the mark is, in any event, registrable on the Supplemental Register), the examining attorney should clearly state his or her position with respect to each of the applicant's alternative claims. [Note 5.]

NOTES:

1. *See, e.g., In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1419 (TTAB 2010); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1541 (TTAB 1992); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1808-09 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Engineering Systems Corp.*, 2 USPQ2d 1075, 1075 (TTAB 1986); *In re Seaman & Associates Inc.*, 1 USPQ2d 1657, 1657 (TTAB 1986); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986); *In re American Home Products Corp.*, 226 USPQ 327, 328 (TTAB 1985); TMEP § 1212.02(c).

See also for additional situations in which an applicant has taken alternative positions, *In re Beds & Bars Ltd.*, 122 USPQ2d 1546 (TTAB 2017) (applicant maintains mark not primarily merely a surname and alternatively requests to amend application to Supplemental Register); *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1138 (TTAB 2016) (applicant maintained design not ornamental and asserted acquired distinctiveness in the alternative); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012) (applicant clearly consented to entry of disclaimers only in the alternative because on appeal applicant maintained that the terms were not descriptive); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (applicant asserted that his mark was not primarily merely a surname and in the alternative that it had acquired distinctiveness);

In re Reed Elsevier Properties Inc., 77 USPQ2d 1649, 1652 (TTAB 2005), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1436 (TTAB 2005) ; *In re Lillian Vernon Corp.*, 225 USPQ 213, 213 (TTAB 1985) ; *In re Narwood Productions, Inc.*, 223 USPQ 1034, 1036 (TTAB 1984) ; *In re Anania Associates, Inc.*, 223 USPQ740, 740 n.1 (TTAB 1984); *In re Perfect Fit Industries, Inc.*, 223 USPQ92, 93 (TTAB 1984); *In re House of Windsor, Inc.*, 221 USPQ 53, 54 n.3 (TTAB 1983); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 (TTAB 1983); *In re Harrington*, 219 USPQ 854, 855 n.1 (TTAB 1983).

2. *See In re Heatcon, Inc.*, 116 USPQ2d 1366, 1369-70 (TTAB 2015) (applicant did not make amendment to Supplemental Register in the alternative); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012) (in request for reconsideration and on appeal, applicant clearly asserted alternative positions with respect to the disclaimer requirement); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001) (applicant did not assert Trademark Act § 2(f) claim in the alternative); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 n.2 (TTAB 1997) (Board found that applicant had abandoned its claim that its mark was inherently distinctive early in the prosecution and therefore Board refused to consider claim of inherent distinctiveness made in reply brief, or to view the claim of acquired distinctiveness as an alternative claim); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 n.2 (TTAB 1996) (applicant did not pursue its contention that the marks were inherently distinctive during prosecution, and Board found this claim to have been waived).

Cf. In re Thomas Nelson, Inc., 97 USPQ2d 1712, 1713 (TTAB 2011) (applicant maintained claim of acquired distinctiveness under Trademark Act § 2(f) in the alternative, but better practice would have been for examining attorney to have reviewed files of applicant's prior registrations to determine whether applicant had previously conceded the mark was merely descriptive).

But see In re Olin Corp., 124 USPQ2d 1327, 1329-30 (TTAB 2017) (although applicant never explicitly requested registration under Section 2(f), because the examining attorney "afforded applicant the benefit of doubt" by construing its arguments in response to the surname refusal as an apparent claim of acquired distinctiveness in the alternative, the Board treated the claim as such); *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1195 n.3 (TTAB 1998) (Board considered registrability on both Principal and Supplemental Registers even though applicant's amendment to the Supplemental Register was originally not made in the alternative, noting that examining attorney continued to refuse registration on both registers, and subsequent papers of both applicant and examining attorney, including request for reconsideration and decision on that request, discussed the amendment as being in the alternative); *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1419 n.7 (TTAB 2010) (although applicant did not expressly claim acquired distinctiveness in the alternative, Board treated the claim as such because it was filed after examining attorney requested a remand of the application to consider a new issue); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (although applicant did not couch his Trademark Act § 2(f) claim in the alternative when he argued against surname refusal, because applicant and examining attorney treated the claim as an alternative one Board did as well).

3. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1685 n.8 (Fed. Cir. 2010) (if applicant asserts mark is inherently distinctive and asserts acquired distinctiveness in the alternative, and if examining attorney accepts claim of acquired distinctiveness, examining attorney must give applicant option to either appeal refusal of inherent distinctiveness or accept registration under Trademark Act § 2(f)).

4. *See* TMEP § 1212.02(c).

5. *See* TMEP § 1212.02(c).

1216 Oral Hearing

37 C.F.R. § 2.142(e)

(1) *If the appellant desires an oral hearing, a request should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or the appellant's attorney or other authorized representative. Appellants, examining attorneys, and members of the Board may attend in person or, at the discretion of the Board, remotely.*

(2) *If the appellant requests an oral argument, the examining attorney who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examining attorney as designated by a supervisory or managing attorney, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.*

(3) *Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examining attorney. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.*

For general information concerning oral hearings in proceedings before the Board, see TBMP § 802. What follows below is information pertaining specifically to oral hearings in ex parte appeals to the Board.

An oral hearing is not mandatory in an ex parte appeal to the Board, but will be scheduled if a timely request therefor is filed by the applicant. [Note 1.] If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs. [Note 2.] In the vast majority of cases, an oral hearing is not requested. An examining attorney may not request an oral hearing. An oral hearing is particularly useful in ex parte cases involving complex issues or where the goods or services identified in the applicant's application (or a cited registration) are technical or unfamiliar, or where an issue on appeal is not clearly defined. In addition, the oral hearing sometimes provides an opportunity for the applicant and examining attorney to work out an agreement that results in approval of the application for publication (or for registration, in the case of a Supplemental Register application).

If the applicant desires an oral hearing in an ex parte appeal to the Board, the applicant should file a written request not later than 10 days after the due date for applicant's reply brief. The request should be a separate document, and not included in an applicant's brief, reply brief, or other submission filed with the Board. The request for oral hearing must be filed through ESTTA, which includes "Request for Oral Hearing" among the list of entries identifying the type of submission being filed. In the rare circumstances it is filed on paper, only one copy of such request should be submitted. The request should include three tentative dates and times for the oral hearing and whether applicant would like to appear at the oral hearing in person or by video conference. The Board will then send the applicant a notice specifying the date, time and location of the hearing. If the request for an oral hearing does not include tentative dates, the Board will issue an order requesting the applicant to provide possible dates between six and fourteen weeks beyond the mailing date of this order, and upon receipt will send the applicant a notice of hearing specifying the date, time, and location of the hearing. If there is no timely response to the Board's order the request for oral hearing will be considered waived, and the matter will be submitted for decision on the record and briefs. Ordinarily, hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Time).

Oral hearings typically are held at the offices of the Board but may be held elsewhere, in conjunction with conferences or continuing legal education programs. For hearings held at the offices of the Board, a party may request, and the Board in its discretion may allow, attendance via video connection from another

location. [Note 3.] A video hearing will be conducted in the same manner as if conducted entirely in the hearing room. An applicant should request a hearing by video conference in its written request for an oral hearing. An applicant that requests attendance at the oral hearing via video conferencing is responsible for arranging and paying for its video connection. The Board's order scheduling the hearing will specify the software that the Board uses for the video connection, and the applicant must use compatible technology. If Applicant plans to attend the hearing by video conference, it is Applicant's responsibility to contact a USPTO video conference technician at VTCOPS@uspto.gov no fewer than three (3) business days prior to the confirmed hearing date, setting forth the application serial number(s), the date and time of the hearing, and the type of equipment that Applicant plans to use. A USPTO video conference technician will arrange a test of the equipment that Applicant plans to use. The USPTO does not provide the means to participate by video conference. *See* TBMP § 802.03.

An oral hearing is held before a panel of at least three members of the Board (i.e., its statutory members, generally administrative trademark judges), who may appear via video or phone. [Note 4.] The time for oral hearing may be reset if the Board is prevented from holding the hearing at the specified time, or, so far as is convenient and proper, to meet the wishes of the applicant (or the applicant's attorney or other authorized representative) or the examining attorney. [Note 5.] If an applicant wishes to reschedule an oral hearing, it must file a written request through ESTTA stating the reasons for the request, whether the examining attorney has agreed to the rescheduling, and submit three non-consecutive dates and times. Applicant must follow-up the written request by telephoning the Board's Hearing and Decision Specialist (whose contact information appears on the scheduling order). In general, upon a request to reset a hearing date, Board practice is to reschedule the oral hearing. However, absent compelling circumstances or mutual agreement between the applicant and the examining attorney, the Board may not change a hearing date if the request for rescheduling is made within two weeks of the scheduled hearing date. Moreover, the Board may deny a request to reschedule if multiple requests, including stipulations and consented requests, to reschedule have been filed. Both the reason for the rescheduling request, and the time in advance of the hearing at which it is made, will be considered in determining whether the request is granted. [Note 6.]

If the applicant requests an oral hearing, the examining attorney who issued the Office action from which the appeal was taken, or another examining attorney who has been designated for the purpose by a supervisory or managing attorney, must appear at the hearing and present an oral argument. [Note 7.] If the examining attorney requires a rescheduling of the oral hearing, he or she should advise the Hearing and Decision Specialist of the Board, by telephone or email, not later than two weeks prior to the scheduled hearing date. If circumstances arise which prevent the examining attorney from providing such notice, another examining attorney should be designated by a supervisory or managing attorney to appear at the oral hearing. In the rare instances in which the applicant appears but the examining attorney does not, the oral hearing will be held without the examining attorney; only the applicant will present its oral argument.

The applicant is allowed 20 minutes for its oral argument, and the examining attorney is allowed 10 minutes. If the applicant so desires, it may reserve a portion of its 20 minutes to use for rebuttal argument. [Note 8.] There is no requirement that the applicant and the examining attorney use all of their allotted time. Often, an ex parte appeal to the Board is of such nature that oral arguments thereon may be presented in considerably less than the allotted time. On the other hand, if, because of the complexity or novelty of the issues, an applicant feels that it needs more than 20 minutes for oral argument, it should file a written request with the Board for additional time. [Note 9.] *Cf.* TBMP § 802.05. If the request is granted, the examining attorney will also be allowed additional time.

For information concerning audiotaping, visual aids, videoconferencing and the nature of an oral hearing before the Board, *see* TBMP § 802.06, TBMP § 802.07, TBMP § 802.03 and TBMP § 802.08, respectively.

The oral hearing is not an opportunity to present new evidence to the Board. Documents offered at the hearing that were not properly made of record will not be considered unless consented to by the nonoffering party, in which case they will be deemed to have been stipulated into the record. [Note 10.] Similarly, an applicant is not permitted to file a supplemental brief following an oral hearing unless instructed or ordered by the Board to do so. [Note 11.]

If an applicant decides, after submitting a request for oral hearing, that it no longer desires an oral hearing, it should submit a written waiver of the oral hearing request through ESTTA. The matter will then be taken off of the Board's oral hearing docket and scheduled to be decided on the record and the briefs.

Further inquiries regarding oral hearings may directed to TTABHearings@uspto.gov.

NOTES:

1. 37 C.F.R. § 2.142(e)(1).

2. 37 C.F.R. § 2.142(e)(2).

3. 37 C.F.R. § 2.142(e)(1). *See, e.g., In re Datapipe, Inc.*, 111 USPQ2d 1330, 1332 (TTAB 2014) (counsel for applicant appeared via videoconference at oral hearing).

4. *See* Trademark Act § 17, 15 U.S.C. § 1067; 37 C.F.R. § 2.142(e)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(e)(1) to clarify that all statutory members of the Board may hear oral argument. The Office is further amending § 2.142(e)(1) to add that appellants, examining attorneys, and members of the Board may attend oral argument in person or, at the discretion of the Board, remotely. The amendment codifies current Office practice and is consistent with the Office's amendments to § 2.129(a).").

5. 37 C.F.R. § 2.142(e)(1).

6. *See In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule hearing received three hours before the scheduled hearing because of "a sudden conflict of time" was denied; Commissioner [now Director] denied petition stating that Board has wide discretion in scheduling or rescheduling oral hearings).

7. *See* 37 C.F.R. § 2.142(e)(2).

8. 37 C.F.R. § 2.142(e)(3).

9. 37 C.F.R. § 2.129(a).

10. *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (exhibits in booklet submitted at oral hearing which had not previously been made of record were not considered).

11. *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1778 n.3 (TTAB 2017) (Board refused to consider unauthorized supplemental brief filed after oral hearing), *on appeal*, No. 17-2392 (Fed. Cir. August 3, 2017).

1217 Final Decision

For general information concerning final decisions in proceedings before the Board, see TBMP § 803. What follows below is information pertaining specifically to final decisions in ex parte appeals to the Board.

In determining an ex parte appeal, the Board reviews the appealed decision of the examining attorney to determine if it was correctly made. The Board need not find that the examining attorney's rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale. [Note 1.] Further, while the examining attorney may not raise a new ground for refusal of registration during appeal, except upon remand by the Board for the purpose, *see* TBMP § 1209, the examining attorney is not precluded from raising, during appeal, new arguments and/or additional case citations in support of a ground for refusal which was timely raised and is a subject of the appeal. [Note 2.]

If there is more than one refusal or requirement that is the subject of an appeal, the Board will normally consider all issues in the appeal, even if the decision on one issue would make a decision on a second issue moot or inconsistent. [Note 3.] However, in certain circumstances after the Board has affirmed one requirement or refusal it will not reach any further requirement or refusal. [Note 4.]

Because each class in a multi-class application is considered to be a separate application, the Board may affirm a refusal as to one class and reverse a refusal as to a different class. [Note 5.]

When the Board has issued its final decision in an ex parte appeal, the examining attorney is without jurisdiction to take any further action therein. [Note 6.] Similarly, the Board has no authority, either in its final decision on appeal or thereafter, to remand the case to the examining attorney for further examination. A case that has been considered and decided on appeal to the Board may be reopened only as provided in 37 C.F.R. § 2.142(g), as discussed below. [Note 7.] That is, while the Board, in its final decision in an opposition, concurrent use, or interference proceeding, may include a remand of the application (except a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application) [Note 8.] to the examining attorney for further examination with respect to a matter which appears to render the mark of an applicant unregistrable but which was not tried under the pleadings in the case, *see* TBMP § 515 [Note 9], the Board cannot include such a remand in its final decision in an ex parte appeal.

However, if, at final decision in an ex parte appeal, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may, without deciding the issue(s) on appeal, suspend the appeal and remand the application to the examining attorney for further examination. [Note 10.] *See* TBMP § 1209.01. Alternatively, if the issue not previously raised is an application defect that can easily be corrected by the applicant, the Board may elect to decide the issue(s) on appeal, and include in its decision a recommendation that applicant voluntarily correct the defect if it prevails on the appealed issue(s). [Note 11.] Further, when the Board issues a final decision in an appeal involving an intent-to-use application, it does not preclude the examining attorney from issuing a new refusal or requirement arising in the examination of the statement of use. [Note 12.]

NOTES:

1. *See In re Harley,* 119 USPQ2d 1755, 1758 (TTAB 2016) (applicants' failure to address refusals is a basis for affirming the examining attorney's refusal on all grounds); *In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 343 n.2 (TTAB 1985). *Cf. Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1009 (Fed. Cir. 1988); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221,

188 USPQ 485, 488 (CCPA 1976); *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426, 428 (CCPA 1975).

2. *See In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 342 n.2 (TTAB 1985).

3. *In re Morinaga Nyuguo Kabushiki Kaisha*, 120 USPQ2d 1738, 1748 (TTAB 2016) (Board affirmed refusal based on likelihood of confusion and reversed refusal based on geographic misdescriptiveness); *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1379 (TTAB 2015) (although finding that configuration was functional rendered requirement regarding drawing moot, Board addressed the drawing refusal "for completeness"); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (Board found applied-for phrase generic, but also found that if not generic, the phrase has not acquired distinctiveness); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1984 (TTAB 2009) (functionality refusal affirmed and in the alternative Board affirmed that configuration fails to function as a source-indicator and has not acquired distinctiveness); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (affirmance of refusal that mark is merely descriptive made the question of whether disclaimer applicant sought to enter moot; for purposes of deciding that issue, applicant's mark was assumed, arguendo, to be not merely descriptive); *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1921-22 (TTAB 2008) (requirement for product information affirmed; goods assumed, for purposes of determining refusals on grounds of geographic descriptiveness and deceptive geographic misdescriptiveness, to come from place named in mark and not to come from place named in mark, respectively); *In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007) (although Board found no trademark rights in the identified goods had been created, it also considered the refusal that the mark was not inherently distinctive and found that acquired distinctiveness was not shown, assuming arguendo that the identified goods were goods in trade); *In re Howard Leight Industries LLC*, 80 USPQ2d 1507, 1508 (TTAB 2006) (functionality refusal affirmed and in the alternative Board affirmed refusal on the ground that configuration is non-distinctive and has not acquired distinctiveness).

4. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (Board determined likelihood of confusion with respect to only one of the two cited registrations); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201-02 (TTAB 2009) (Board determined likelihood of confusion with respect to only one of the two cited registrations); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1702 (TTAB 2003) (affirmance of requirement for product information was sufficient basis to refuse registration; Board declined to reach merits of refusal based on mere descriptiveness because applicant's failure to submit required information hindered Board's ability to assess the latter refusal).

5. *In re Wielinski*, 49 USPQ2d 1754, 1760 (TTAB 1998) (affirming refusal to register only as to class 16 and reversing refusal to register as to all other classes); *In re Harry N. Abrams, Inc.*, 223 USPQ 832, 836 (TTAB 1984) (affirming refusal to register as to class 14 and reversing refusal to register as to all remaining classes).

6. *See, e.g., In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 n.2 (TTAB 1982); TMEP § 1501.06.

7. *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 397 n.2 (TTAB 1982).

8. An application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) may not be remanded under 37 C.F.R. § 2.131.

9. 37 C.F.R. § 2.131.

10. 37 C.F.R. § 2.142(f)(1).

11. *See In re W.W. Henry Co.*, 82 USPQ2d 1213, 1213-14 (TTAB 2007) (because claimed date of first use and use in commerce were subsequent to application filing date, final decision allowed applicant to file either an amendment to the dates of use or an amendment to the basis for the application); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1545 n.1 (TTAB 1996) (in final decision, Board recommended that applicant, if it ultimately prevailed, amend description of mark to clearly set forth claim); *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing); *In re Lativ Systems, Inc.*, 223 USPQ 1037 n.1 (TTAB 1984); *In re Wallyball, Inc.*, 222 USPQ 87, 88 n.2 (TTAB 1984).

12. *See* TMEP § 1109.07 *et seq.*; *In re Husqvarna Aktiebolag*, 91 USPQ2d 1436, 1439 (TTAB 2009) (when examining attorney examines statement of use, if the specimens fail to show that the mark is used for services as described by applicant, the examining attorney may refuse registration on this basis).

1218 Reopening (Amendment, Etc. After Final Decision)

37 C.F.R. § 2.142(g) *An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.*

Once an application has been considered and decided by the Board on appeal, applicant's course of action normally is limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom, either by way of an appeal to the Court of Appeals for the Federal Circuit, or by way of a civil action seeking review of the Board's decision. *See* TBMP § 1219. An application may not be "reopened," that is, an applicant may not amend its application, or submit additional evidence, at this stage, except in two very limited situations. [Note 1.] They are as follows:

(1) The application may be reopened by the Board for entry of a disclaimer under Trademark Act § 6, 15 U.S.C. § 1056; [Note 2.] and

(2) The application may be reopened upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated. [Note 3.]

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court may remand the application for further examination and the submission of additional evidence. [Note 4.]

NOTES:

1. *See* 37 C.F.R. § 2.142(g); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 n.15 (TTAB 2015) (once final decision issues, applicant cannot request suspension of appeal to seek cancellation of cited registration); *In re Brack*, 114 USPQ2d 1338, 1343 (TTAB 2015) (applicant's failure to comply with requirement to sign and verify application prior to appeal cannot be remedied after issuance of decision); *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013) ("the Board cannot re-write the application to reinstate an identification previously discarded by the applicant, nor can it re-open the application for amendment of the identification by applicant."); *In re Societe D'Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784, 1789 (TTAB 2003) (no authority to remand after decision on appeal for amendment to filing basis);

In re Hines, 32 USPQ2d 1376, 1377 (TTAB 1994) (reconsideration); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 n.3 (TTAB 1986).

2. 37 C.F.R. § 2.142(g); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1835 (TTAB 2011) (requirement for a disclaimer in part affirmed, applicant allowed time to submit disclaimer); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006) (requirement for disclaimer affirmed, but decision would be set aside if applicant submits disclaimer within 30 days); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1958 (TTAB 2006) (requirement for disclaimer affirmed, but applicant allowed 30 days to submit the disclaimer and decision affirming the requirement would be set aside); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374, 1379 (TTAB 2007) (requirement for disclaimer affirmed, but applicant allowed 30 days to submit required disclaimer and decision would be set aside); *In re Petite Suites Inc.*, 21 USPQ2d 1708, 1710 (Comm'r 1991) (Board has authority to remand application, after decision by Board on appeal, for entry of a disclaimer); *In re S. D. Fabrics, Inc.*, 223 USPQ 56, 57 n.1 (TTAB 1984) (Board accepts disclaimers after decision by Board on appeal where the disclaimer puts the application in condition for publication without the need for any further examination).

3. *See* 37 C.F.R. § 2.142(g); *In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1724 (TTAB 2016) (applicant cannot make a conditional request for remand based on the outcome of the Board's decision on appeal); *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016) (once final decision rendered request to amend to Supplemental Register not possible); *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013) ("the Board cannot re-write the application to reinstate an identification previously discarded by the applicant, nor can it re-open the application for amendment of the identification by applicant."); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1047 n.2 (TTAB 2002) (request in applicant's brief that if the refusals are maintained the application be amended to the Supplemental Register denied because application which has been decided on appeal will not be reopened); *In re Taverniti, SARL*, 228 USPQ 975, 976 (TTAB 1985) (since applicant's registration was not part of evidentiary record before Board when it decided case, registration can be given no consideration in the absence of a successful petition to the Commissioner [now Director] to reopen); *In re Taverniti, SARL*, 225 USPQ 1263, 1264 n.3 (TTAB 1985) (it has been practice of the Commissioner [now Director] to refuse to reopen, after final decision, for amendment to the Supplemental Register); *In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) (Board has no jurisdiction to remand an application, after final decision, for submission of new evidence; only the Commissioner [now Director] has authority, after final decision, to remand for the purpose of reopening the application; *In re S. D. Fabrics, Inc.*, 223 USPQ 56, 57 n.1 (TTAB 1984) (after a case has been decided on appeal, an amendment to the Supplemental Register may be accepted only by the Commissioner [now Director] upon petition, and Commissioner has in past denied petitions to reopen to amend to the Supplemental Register); *In re Dodd International, Inc.*, 222 USPQ 268, 270 (TTAB 1983) (Board denied request to reopen application, after final decision, for amendment to Supplemental Register, quoting 37 C.F.R. § 2.142(g)); *In re Vesper Corp.*, 8 USPQ2d 1788, 1789 n.3 (Comm'r 1988) (petitions to reopen are granted only when proposed amendment would place application in condition for publication, subject to updating search, and no other examination by examining attorney would be required); *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799, 1800 (Comm'r 1986) (petition to reopen to allow applicant to file and litigate petition to cancel cited registration denied); *In re Mack Trucks, Inc.*, 189 USPQ 642, 643 (Comm'r 1976) (petition to reopen for letter of consent and for amendment of identification of goods denied; applicant, having elected to proceed, prior to Board's decision, without letter of consent assumed the risk of an adverse decision by Board and does not establish sufficient cause to reopen; also, both the letter of consent and amendment would require further examination beyond an updating search); *Ex parte Simoniz Co.*, 161 USPQ 365, 366 (Comm'r 1969) (petition to reopen for amendment to Supplemental Register denied; applicant elected a course of action and had a hearing and an adjudication thereon); TMEP § 1501.06.

4. *See In re Spirits International N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1496 (Fed. Cir. 2009) (application remanded because Board applied incorrect standard for materiality in determining mark geographically deceptive); *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003) (remanded because Board applied standard that had been changed in interim); *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003) (remanded for Board to consider record in light of new test set out by Court); *In re Lowrance Electronics Inc.*, 14 USPQ2d 1251, 1251 (TTAB 1989).

1219 Review of Final Decision

1219.01 By Request for Reconsideration

37 C.F.R. § 2.144 ***Reconsideration of decision on ex parte appeal.*** *Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.*

For general information concerning requests for rehearing, reconsideration, or modification of a final decision of the Board, *see* TBMP § 543 and TBMP § 544. What follows below is information pertaining specifically to requests for rehearing, reconsideration, or modification of a final decision of the Board in an ex parte appeal.

An applicant that has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may file a request for rehearing, reconsideration, or modification of the decision. The applicant must file the request within one month from the date of the decision. The time for filing the request may be extended by the Board upon a showing of sufficient cause. [Note 1.]

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the examining attorney. [Note 2.] The examining attorney must file the request within one month of the date of the final decision, unless the time is extended by the Board upon a showing of sufficient cause. [Note 3.]

If a request for rehearing, reconsideration, or modification of the Board's final decision in an ex parte appeal is timely filed, applicant's time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire no later than sixty-three (63) days after action on the request. [Note 4.] An applicant need not request reconsideration before it files an appeal of the Board's final decision, but if an applicant requests reconsideration, it must do so before it files a notice of appeal. [Note 5.] For more information concerning the time for filing a notice of appeal of the Board's final decision in an ex parte appeal, see TBMP § 902.02.

NOTES:

1. 37 C.F.R. § 2.144.

2. *See In re Squaw Valley Development Co.*, 80 USPQ2d 1264, 1266 (TTAB 2006); *In re Ferrero S.p.A.*, 22 USPQ2d 1800, 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992) (in the absence of statutory or regulatory prohibition, Board has inherent authority to entertain examining attorney's request for reconsideration); TMEP § 1501.07.

3. *See In re Ferrero S.p.A.*, 24 USPQ2d 1061, 1062 n.1 (TTAB 1992); TMEP § 1501.07.

4. *See* 37 C.F.R. § 2.145(d)(4).

5. 37 C.F.R. § 2.145(a)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69969 (Oct. 7, 2016) ("The Office is further amending § 2.145(a)(1) to add that it is unnecessary to request reconsideration before filing an appeal of a Board decision, but a party requesting reconsideration must do so before filing a notice of appeal.").

1219.02 By Appeal

An applicant that has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may have remedy by way of an appeal to the United States Court of Appeals for the Federal Circuit, or by way of a civil action for review of the decision of the Board. [Note 1.] A copy of the notice of appeal must be filed with the Board via ESTTA. [Note 2.] It is unnecessary to request reconsideration of a final decision before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal. [Note 3.]

For information concerning the taking of an appeal from a final decision of the Board, see TBMP § 901, TBMP § 902, and TBMP § 903.

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence. *See* TBMP § 1218.

NOTES:

1. Trademark Act § 21, 15 U.S.C. § 1071; 37 C.F.R. § 2.145.

2. 37 C.F.R. § 2.145; MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69969 (Oct. 7, 2016) ("The Office also is amending the provisions in § 2.145 that require copies of notices of appeal, notices of election, and notices of civil action to be file with the Trademark Trial and Appeal Board to specify that such notices must be filed with the Board via ESTTA. These amendments codify the use of electronic filing and enhance the Office's ability to properly handle applications, registrations, and proceedings while on review in federal court.").

3. 37 C.F.R. § 2.145.