

## **CHAPTER 900 REVIEW OF DECISION OF BOARD**

901 Appeals--In General

902 Appeal to Court of Appeals for the Federal Circuit

903 Appeal by Civil Action

904 Access to Record During Appeal

905 Petition to Commissioner

## REVIEW OF DECISION OF BOARD

### 901 Appeals--In General

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

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

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

*(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1(b)*

## REVIEW OF DECISION OF BOARD

*before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).*

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

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

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

*(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction*

## REVIEW OF DECISION OF BOARD

*and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.*

### **37 CFR §2.145 Appeal to court and civil action.**

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

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

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

**(b) Notice of appeal.** *(1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Commissioner, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.*

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

*(3) The notice, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.*

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

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

## REVIEW OF DECISION OF BOARD

*(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in §2.119.*

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

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

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

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

## REVIEW OF DECISION OF BOARD

*specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

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

### 901.01 Avenues of Appeal

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

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

(2) Have remedy by civil action (in a United States District Court), in which the court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear." *See* Section 21 of the Act, 15 U.S.C. §1071, and 37 CFR §2.145. *See also* *Spraying Systems Co. v. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181 (7th Cir. 1992), and *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

In an inter partes proceeding, if a dissatisfied party chooses to file an appeal to the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file notice that it elects to have the appeal dismissed, and to have further proceedings conducted instead by way of civil action. *See* Section 21(a)(1) of the Act, and 37 CFR §2.145(c)(3). Within 30 days after the filing of a notice of election by an adverse party, the appellant must commence a civil action for review of the Board's decision, failing which the Board's decision will govern further proceedings in the case. *See* Section 21(a)(1) of the Act, and 37 CFR §2.145(d)(3).

## REVIEW OF DECISION OF BOARD

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

### 901.02 What May be Appealed

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

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a final dispositive ruling that ends litigation on the merits before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. *See Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989). *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); *Parker Brothers v. Tuxedo Monopoly, Inc.*, 757 F.2d 254, 226 USPQ 11 (Fed. Cir. 1985); and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424 (Comm'r 1986).

Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board. *See, for example, Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (decision on 37 CFR §2.132(a) motion to dismiss); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) (decision on motion for summary judgment); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (decision on motion for summary judgment); *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976) (decision on motion to dismiss); and *Williams v. Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (decision on FRCP 60(b) motion to vacate).

On the other hand, if the Board resolves a merits issue prior to final hearing, but other merits issues remain, that is, the litigation is still before the Board as a whole, the Board's decision on the merits issue is interlocutory, rather than final, for purposes of judicial review. For example, in a case in which there is a counterclaim, if the Board grants summary judgment only as to the counterclaim, the case is not ripe for appeal until there has been a final decision with respect to the original claim; similarly, if the Board grants summary judgment only as to the

## REVIEW OF DECISION OF BOARD

original claim, the case is not ripe for appeal until there has been a final decision with respect to the counterclaim. *See Interlocutory Decisions by the Trademark Trial and Appeal Board*, 1123 TMOG 36 (February 19, 1991), and *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589 (TTAB 1992). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989). When the Board, prior to final hearing, issues a decision resolving one or more, but not all, of the merits issues in a case before it, it is the usual practice of the Board to include in its decision the following statement: "This decision is interlocutory in nature. Appeal may be taken within two months after the entry of a final decision in the case." *See, for example, Interlocutory Decisions by the Trademark Trial and Appeal Board, supra*, and *Procter & Gamble Co. v. Sentry Chemical Co., supra*.

When an appeal is taken from a decision of the Board, it is the court to which an appeal is taken, not the Board, which determines whether the involved decision is appealable, that is, whether the court has jurisdiction to entertain the appeal. *See R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 204 USPQ 195 (CCPA 1979) (Board's attempted "certification" of interlocutory decision as appealable given no effect in Court's determination of whether it had jurisdiction over the appeal), and *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424 (Comm'r 1986) (Commissioner has no statutory authority to "certify" interlocutory orders of the Board for appeal). *See also*, with respect to jurisdiction to entertain an appeal, *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case. *See Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979), and *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790 (CCPA 1971), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971).

A party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely petition to the Commissioner. *See* TBMP §905, and authorities cited therein. A party may also file a request with the Board for reconsideration of such an order or decision. *See* TBMP §518.



## REVIEW OF DECISION OF BOARD

The mandamus procedure may not be used as a substitute for the appeal procedure specified in Section 21 of the Act. *See Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641 (CCPA 1979), *cert. denied*, 442 U.S. 917, 202 USPQ 159 (1979).

### **901.02(b) Judgment Subject to Establishment of Constructive Use**

In an inter partes proceeding before the Board, no final judgment will be entered in favor of an applicant under Section 1(b) of the Act, 15 U.S.C. §1051(b), before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Section 7(c) of the Act, 15 U.S.C. §1057(c). See Sections 21(a)(4) and 21(b)(1) of the Act. Rather, in those cases where the Board finds that a Section 1(b) applicant is entitled to prevail only if it establishes constructive use, the Board will enter judgment in favor of that applicant, subject to the applicant's establishment of constructive use. *See* 37 CFR §2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991). If, after entry of that judgment, the Section 1(b) applicant files an acceptable statement of use, and obtains a registration, thus establishing its constructive use, final judgment will be entered in behalf of the Section 1(b) applicant. If, on the other hand, the Section 1(b) applicant fails to establish constructive use, that is, fails to file an acceptable statement of use and obtain a registration, judgment will instead be entered in favor of the adverse party.

When the Board enters judgment in favor of a Section 1(b) applicant subject to that party's establishment of constructive use, the time for filing an appeal or commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use. *See* 37 CFR §2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

## **902 Appeal to Court of Appeals for the Federal Circuit**

### **902.01 Notice of Appeal**

*15 U.S.C. §1071(a)(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within*

## REVIEW OF DECISION OF BOARD

*such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.*

### **37 CFR §2.145 Appeal to court and civil action.**

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

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

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

**(b) Notice of appeal.** *(1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Commissioner, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.*

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

*(3) The notice, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.*

A party taking an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board must give written notice thereof both to the Commissioner and to the Court of Appeals for the Federal Circuit, and pay to the Court the fee required by the Court's rules. *See 37 CFR §§2.145(a) and 2.145(b).*

Specifically, the original notice of appeal must be filed in the PTO, within the time required by 37 CFR §2.145(d) (*see* TBMP §902.02). *See* Section 21(a)(2) of the Act, 15 U.S.C. §1071(a)(2); 37 CFR §§2.145(a) and 2.145(b)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). The certificate of mailing and certificate of transmission procedures described in 37

## REVIEW OF DECISION OF BOARD

CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for filing a notice of appeal. The notice must specify the party or parties taking the appeal and designate the decision or part thereof appealed from. However, reasons for appeal need not be given. *See* 37 CFR §2.145(b)(1), and *Appeals to the Federal Circuit From PTO, supra*. A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the notice of appeal. *See Appeals to the Federal Circuit From PTO, supra*. If the appeal is taken from a decision of the Board in an inter partes proceeding, a copy of the notice must be served upon every other party to the proceeding, in the manner prescribed in 37 CFR §2.119 (*see* TBMP §113). *See* 37 CFR §2.145(b)(2).

For information concerning the ways (i.e., by hand delivery, first-class mail, etc.) in which a notice of appeal may be filed in the PTO, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the PTO, *see* 37 CFR §§1.6, 1.8, 1.10, and 2.145(b)(3); *Waiver of Certificate of Mailing Requirement Under 37 CFR 1.10*, 1174 TMOG 92 (May 16, 1995); *Filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit in the Patent and Trademark Office*, 1113 TMOG 29 (April 17, 1990); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990) (NOTE: the two 1990 *Official Gazette* notices must be read in light of subsequent rule amendments--for example, the 37 CFR §1.8 certificate procedures are now applicable to a notice of appeal from a decision of the Board, but were not in 1990). For further information concerning how to file a notice of appeal, contact the Office of the Solicitor in the PTO.

Three copies of the notice of appeal must be filed in the Court of Appeals for the Federal Circuit (NOTE: while 37 CFR §2.145(a) requires the filing of only one copy of the notice with the Federal Circuit, Federal Circuit Rule 15(a)(1) requires that three copies of the notice be filed with the Federal Circuit), and the appeal fee required by the rules of the Court must be paid to the Court. *See* 37 CFR §2.145(a). A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the copy of the notice. *See Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

### **902.02 Time for Filing Notice of Appeal, Cross-Appeal**

## REVIEW OF DECISION OF BOARD

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

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

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

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

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

## REVIEW OF DECISION OF BOARD

*civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit is two months from the date of the Board decision which is the subject of the appeal. *See* Section 21(a)(2) of the Act, 15 U.S.C. §1071(a)(2); 37 CFR §2.145(d)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. §1051(b), applicant subject to that party's establishment of constructive use (*see* TBMP §901.02(b)), the time for filing an appeal runs from the date of the entry of judgment subject to establishment of constructive use. *See* 37 CFR §2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§2.127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for filing an appeal expires two months after action on the request. *See* 37 CFR §2.145(d)(1).

In an inter partes case, the time for filing a notice of cross-appeal expires (1) 14 days after service of the notice of appeal, or (2) two months from the date of the Board decision which is the subject of the appeal, whichever is later. *See* 37 CFR §2.145(d)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

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

If a written request to extend the time for appeal is filed before the expiration of the appeal period, the Commissioner may grant the request upon a showing of good cause. If the request is not filed until after the expiration of the appeal period, the Commissioner may grant the request only upon a showing that the failure to act was the result of excusable neglect. *See* 37 CFR §2.145(e), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor. *See Appeals to the Federal Circuit From PTO, supra.*

## REVIEW OF DECISION OF BOARD

It is the Commissioner, not the Board, who determines whether a notice of appeal has been timely filed. If the Commissioner determines that a notice of appeal was not timely, the Commissioner notifies the Clerk of the Federal Circuit thereof. The Clerk in turn issues an order to the appellant to show cause why the appeal should not be dismissed, and refers appellant's response to the Court. *See* Federal Circuit Rule 15(b)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

An appellant which has received an order to show cause from the Clerk of the Federal Circuit may file a request under 37 CFR §2.145(e) for an extension of time to file an appeal, accompanied by a showing that the late filing of the notice of appeal was the result of excusable neglect. The request should be filed in the Office of the Solicitor, which will notify the Clerk of the Commissioner's decision on the request. A decision by the Commissioner granting the request will discharge the order to show cause. *See Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990).

### **902.03 Appeal to Federal Circuit Waives Appeal by Civil Action**

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

However, in an inter partes case, if an adverse party, in response to the notice of appeal to the Federal Circuit, files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. *See* TBMP §§901.01 and 902.04.

## REVIEW OF DECISION OF BOARD

### 902.04 Notice of Election to Have Review by Civil Action

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

*37 CFR §2.145(c)(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in §2.119.*

*37 CFR §2.145(d)(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

When a defeated party in an inter partes proceeding before the Board takes an appeal to the United States Court of Appeals for the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file a notice with the Commissioner electing to have all further proceedings conducted by way of civil action, under Section 21(b) of the Act, 15. U.S.C. §1071(b), seeking review of the decision which was the subject of the appeal. See Section 21(a)(1) of the

## REVIEW OF DECISION OF BOARD

Act, 15 U.S.C. §1071(a)(1), and 37 CFR §2.145(c)(3). The certificate of mailing and certificate of transmission procedures described in 37 CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for filing a notice of election. A copy of the notice must be served upon every other party to the proceeding, in the manner prescribed in 37 CFR §2.119 (*see* TBMP §113). *See* 37 CFR §2.145(c)(3). A copy of the notice must also be filed with the Federal Circuit. *See* Federal Circuit Rule 15(e).

If an adverse party files a notice electing to have further proceedings conducted by way of civil action under Section 21(b) of the Act, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. *See* Section 21(a)(1) of the Act, and 37 CFR §2.145(d)(3). Any cross-action must be filed within 14 days after service of the summons and complaint in the civil action. *See* 37 CFR §2.145(d)(3).

### 902.05 Information Concerning Times Specified in 37 §CFR 2.145

*37 CFR §2.145(d)(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.*

In 37 CFR §2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for filing an appeal falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for filing an appeal is extended to the next day which is not a Saturday, Sunday, or Federal holiday. *See* 37 CFR §2.145(d)(2).

### 902.06 Certified List



## REVIEW OF DECISION OF BOARD

When notice is filed in the PTO of an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the Commissioner sends to the Federal Circuit a statement indicating whether the notice of appeal was considered timely filed, and a certified list of the documents comprising the record in the PTO, i.e., a certified copy of the list of docket entries on the file jacket containing the PTO record of the proceeding (*cf.* TBMP §120.01), accompanied by a copy of the decision appealed.. *See* Section 21(a)(3) of the Act, 15 U.S.C. §1071(a)(3); Federal Circuit Rules 15(b)(1) and 17(b)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). A copy of the certified list is mailed by the PTO to every party to the proceeding. *See* Federal Circuit Rule 17(c) and *Appeals to the Federal Circuit From PTO*, *supra*.

When the Federal Circuit receives the notice of appeal and the certified list, the Court docketes the appeal, and gives notice to all parties of the date of docketing. *See* Federal Circuit Rule 15(b)(1), and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). The appellant's time in which to file its initial brief runs from the date of service of the certified list or the date of docketing the appeal, whichever is later. Because an appeal is not docketed until after the certified list is served in appeals from Board decisions, the appellant's time for filing its brief normally runs from the date of docketing. *See* Federal Circuit Rule 31(a), and *Appeals to the Federal Circuit From PTO*, *supra*.

### **902.07 Appeal Briefs, Appendix, etc.**

For information concerning other matters of practice and procedure during an appeal to the United States Court of Appeals for the Federal Circuit from a Board decision, including information concerning motions, briefs, the appendix to the briefs, oral argument, etc., *see* Federal Circuit Rules, and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22 (November 13, 1990). For information concerning the appendix, in particular, *see* Federal Circuit Rules 30 and 32, and *Appeals to the Federal Circuit From PTO*, *supra*, at page 25.

### **902.08 Special Provisions for Ex Parte Cases**

## REVIEW OF DECISION OF BOARD

If an applicant in an ex parte case takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the applicant thereby waives its right to proceed by way of civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b). *See* Section 21(a)(1) of the Act, 15 U.S.C. §1071(a)(1), and 37 CFR §2.145(c)(2).

On appeal to the Federal Circuit in an ex parte case, the Commissioner files a brief in support of the Board's decision. *See* Section 21(a)(3) of the Act, 15 U.S.C. §1071(a)(3).

### 903 Appeal by Civil Action

#### 903.01 Notice of Civil Action

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

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

#### 903.02 Parties to Civil Action

*15 U.S.C. §1071(b)(2) The Commissioner shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the*

## REVIEW OF DECISION OF BOARD

*complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.*

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

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

When a party to a Board inter partes proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, the Commissioner shall not be made a party to the civil action. However, the clerk of the court in which the civil action is filed must notify the Commissioner of the filing of the complaint, and the Commissioner has the right to intervene in the action. *See* Section 21(b)(2) of the Act, 15 U.S.C. §1071(b)(2).

The suit may be instituted against the party in interest as shown by the records of the PTO at the time of the decision of which review is sought, but any party in interest may become a party to the action. *See* Section 21(b)(4) of the Act, 15 U.S.C. §1071(b)(4).

When an applicant in an ex parte proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, a copy of the complaint

## REVIEW OF DECISION OF BOARD

must be served on the Commissioner (who is a party to the proceeding). *See* Section 21(b)(3) of the Act, 15 U.S.C. §1071(b)(3).

### 903.03 Place of Civil Action

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

Generally, a civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b), may be brought in any Federal district court which has jurisdiction over the person. However, if there are adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia has jurisdiction. *See* Section 21(b)(4), 15 U.S.C. §1071(b)(4); *Del-Viking Productions Inc. v. Estate of Johnson*, 31 USPQ2d 1063 (W.D.Pa. 1994); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 405-407 (1985). *Cf. Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991), and *Chocoladefabriken Lindt & Sprungli Aktiengesellschaft v. Rykoff-Sexton Inc.*, 24 USPQ2d 1236 (S.D.N.Y. 1992).

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

*15 U.S.C. §1071(b)(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced*

## REVIEW OF DECISION OF BOARD

*within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Commissioner to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).*

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

\* \* \*

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

The time for commencing a civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b), is two months from the date of the Board decision of which review is sought. See Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1); 37 CFR §2.145(d)(1); and *Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). A civil action is commenced by the filing of a complaint with the court. See FRCP 3. When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. §1051(b), applicant subject to that party's establishment of

## REVIEW OF DECISION OF BOARD

constructive use (*see* TBMP §901.02(b)), the time for commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use. *See* 37 CFR §2.129(d), and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§2.127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for commencing a civil action expires two months after action on the request. *See* 37 CFR §2.145(d)(1).

In an inter partes case, the time for filing a cross-action expires (1) 14 days after service of the summons and complaint, or (2) two months from the date of the Board decision which is the subject of the civil action, whichever is later. *See* 37 CFR §2.145(d)(1).

If a written request to extend the time for commencing a civil action is filed before the expiration of the period for commencing a civil action, the Commissioner may grant the request upon a showing of good cause. If the request is not filed until after the expiration of the period for commencing a civil action, the Commissioner may grant the request only upon a showing that the failure to act was the result of excusable neglect. *See* 37 CFR §2.145(e). *Cf. Appeals to the Federal Circuit From PTO*, 1120 TMOG 22, 24 (November 13, 1990). A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor. *Cf. Appeals to the Federal Circuit From PTO, supra*.

### 903.05 Information Concerning Times Specified in 37 CFR §2.145

**37 CFR §2.145(d)(2)** *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.*

In 37 CFR §2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-

## REVIEW OF DECISION OF BOARD

month period which includes February 28). If the last day of the time allowed for commencing a civil action falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for commencing a civil action is extended to the next day which is not a Saturday, Sunday, or Federal holiday. *See* 37 CFR §2.145(d)(2).

### 903.06 Civil Action Precluded by Appeal to Federal Circuit

In a proceeding before the Board, a party which is dissatisfied with the decision of the Board may have remedy by way of civil action, unless an appeal to the United States Court of Appeals for the Federal Circuit has been taken. *See* Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1). *Cf.* Section 21(a)(1) of the Act, 15 U.S.C. §1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act); 37 CFR §2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act); and TBMP §902.03.

However, in an inter partes case, if an appeal has been taken to the Federal Circuit, and a party adverse to the appellant files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. *See* TBMP §§901.01 and 902.04.

### 903.07 Special Provisions for Ex Parte Cases

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

## REVIEW OF DECISION OF BOARD

*testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.*

When an applicant in an *ex parte* case seeks review of a decision of the Board by way of civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b), all the expenses of the proceeding must be paid by the applicant which brought the suit, whether the final decision is in favor of the applicant or not, unless the court finds the expenses to be unreasonable. *See* Section 21(b)(3) of the Act, 15 U.S.C. §1071(b)(3).

### **904 Access to Record During Appeal**

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

During an appeal to the United States Court of Appeals for the Federal Circuit, from a decision of the Board in an *inter partes* case, the Board retains the original PTO record of the case. However, when it deems necessary, the Federal Circuit may, upon motion or sua sponte, order transmission (via the Office of the Solicitor) of the original or certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal. *See* Section 21(a)(3) of the Act, 15 U.S.C. §1071(a)(3), and Federal Circuit Rule 17(a).

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the Federal Circuit amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the Court's order. *See* Federal Circuit Rules 17(d) and 17(e).

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

#### **904.02 Access During Appeal by Civil Action**



## REVIEW OF DECISION OF BOARD

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

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

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

### 905 Petition to the Commissioner

#### ***37 CFR §2.146 Petitions to the Commissioner.***

*(a) Petition may be taken to the Commissioner: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Commissioner; (3) to invoke the supervisory authority of the Commissioner 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 Commissioner.*

## REVIEW OF DECISION OF BOARD

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

*(d) A petition on any matter not otherwise specifically provided for shall be filed within sixty days from the date of mailing of the action from which relief is requested.*

*(e)(1) A petition from the denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the denial of the request and shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by §2.119(a). The applicant may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by §2.119(a). No further paper relating to the petition shall be filed.*

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

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

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

## REVIEW OF DECISION OF BOARD

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

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a "final dispositive ruling that ends litigation on the merits" before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board. *See* TBMP §901.02(a), and cases cited therein.

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case. *See* TBMP §901.02(a), and cases cited therein.

In an inter partes proceeding, a party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely petition to the Commissioner. *See* 37 CFR §2.146; *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (CCPA 1980); *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790 (CCPA 1971), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971); *Miss Nude Florida, Inc. v. Drost*, 198 USPQ 485 (Comm'r 1977); *Martin Marietta Corp. v. Lith-Kem Corp.*, 184 USPQ 492 (Comm'r 1974); *Aloe Creme Laboratories, Inc. v. Magic of Aloe, Inc.*, 182 USPQ 45 (Comm'r 1973); *Hudson Pharmaceutical Corp. v. Laboratorios Hosbon, S.A.*, 177 USPQ 707 (Comm'r 1973); *Johnson & Johnson v. Cenco Medical/Health Supply Corp.*, 177 USPQ 586 (Comm'r 1973); *Outdoor Sports Industries, Inc. v. Joseph & Feiss Co.*, 177 USPQ 533 (Comm'r 1973); and *Bayley's Restaurant v. Bailey's of Boston, Inc.*, 170 USPQ 43 (Comm'r 1971). For further information concerning which Board decisions are petitionable and which are appealable, see the foregoing decisions. *Cf.* 37 CFR 2.146(b) (questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under Sections 2, 3, 4, 5, 6, and 23 of the Act, 15 U.S.C. §§1052, 1053, 1054, 1055, 1056, and 1091, are not considered to be appropriate subject matter for petition to the Commissioner).

## REVIEW OF DECISION OF BOARD

A petition to the Commissioner from an interlocutory order or decision of the Board, in a Board inter partes proceeding, must be filed within 30 days after the mailing date of the order or decision from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within 15 days from the date of service of the petition. Petitions from an interlocutory order or decision of the Board, responses to such petitions, and any papers accompanying a petition or response, must be served on every adverse party in the manner prescribed in 37 CFR §2.119(a) (*see* TBMP §113). *See* 37 CFR §2.146(e)(2).

For information concerning a petition to the Commissioner from the denial, or from the granting, of a request for an extension of time to file a notice of opposition, *see* 37 CFR §2.146(e)(1), and TBMP §211.02.

A petition on any matter not otherwise specifically provided for must be filed within 60 days from the mailing date of the action from which relief is requested. *See* 37 CFR §2.146(d).

The mere filing of a petition to the Commissioner will not act as a stay in any ex parte appeal or inter partes proceeding pending before the Board. *See* 37 CFR §2.146(g); *In re Unistar Radio Networks Inc.*, 30 USPQ2d 1390 (Comm'r 1993); and *In re Rent A Boxx Moving Systems Inc.*, 25 USPQ2d 1399 (Comm'r 1992).

A petition to the Commissioner must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by 37 CFR §2.6. Any brief in support of the petition must be embodied in or accompany the petition. When facts are to be proved in ex parte cases, the proof, in the form of affidavits or declarations in accordance with 37 CFR §2.20, and any exhibits, must accompany the petition. *See* 37 CFR §2.146(c).

An oral hearing will not be held on a petition to the Commissioner except when considered necessary by the Commissioner. *See* 37 CFR §2.146(f).

For further information concerning petitions to the Commissioner, *see* 37 CFR §2.146. *Cf.* TMEP §§1701-1705.