

## §2.144

## 37 CFR Ch. I (7-1-08 Edition)

the application to the examiner for further examination. If the request is granted, the examiner 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 After the additional ground for refusal of registration has been withdrawn or made final, the examiner shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

(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.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34901, Aug. 22, 1989; 68 FR 55768, Sept. 26, 2003; 72 FR 42263, Aug. 1, 2007]

### §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.

[54 FR 29554, July 13, 1989]

### §2.145 Appeal to court and civil action.

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

(1) In the Patent and Trademark Office give written notice of appeal to the

Director (see paragraphs (b) and (d) of this section);

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

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

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

(3) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel, according to part 104 of this chapter, with a duplicate copy mailed or served by hand on the Trademark Trial and Appeal Board.

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

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

(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an *inter partes* proceeding may file a notice with the Office, addressed to the Office of the General Counsel, according to part 104 of this chapter, within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in §2.119.

(4) In order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to

section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.

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

(i) 14 days after service of the notice of appeal or the summons and complaint; or

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

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

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

(e) *Extensions of time to commence judicial review.* The Director may extend the time for filing an appeal or commencing a civil action (1) for good

cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

[47 FR 47382, Oct. 26, 1982, as amended at 53 FR 16414, May 9, 1988; 54 FR 29554, July 13, 1989; 54 FR 34901, Aug. 22, 1989; 58 FR 54503, Oct. 22, 1993; 68 FR 14337, Mar. 25, 2003; 68 FR 55769, Sept. 26, 2003]

#### PETITIONS AND ACTION BY THE DIRECTOR

##### § 2.146 Petitions to the Director.

(a) Petition may be taken to the Director:

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

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

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

(4) In any case not specifically defined and provided for by this part of title 37 of the Code of Federal Regulations;

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

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

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in