

CHAPTER 1200
EX PARTE APPEALS

1201 PROPRIETY OF APPEAL	3
1201.01 READINESS OF CASE FOR APPEAL	3
1201.02 PREMATURE FINAL	5
1201.03 PREMATURE APPEAL	6
1201.04 COMPLIANCE WITH REQUIREMENTS NOT SUBJECT OF APPEAL	7
1201.05 APPEAL VERSUS PETITION	8
1202 FILING AN APPEAL	11
1202.01 IN GENERAL	11
1202.02 TIME FOR APPEAL	12
1202.03 NOTICE OF APPEAL	14
1202.04 APPEAL FEE	15
1202.05 MULTIPLE CLASS APPLICATIONS	16
1203 APPEAL BRIEFS	17
1203.01 FORM OF BRIEF	17
1203.02 TIME FOR FILING BRIEF	19
1203.02(a) <i>Applicant's Main Brief</i>	19
1203.02(b) <i>Trademark Examining Attorney's Brief</i>	21
1203.02(c) <i>Applicant's Reply Brief</i>	23
1203.02(d) <i>Extension of Time for Filing Brief</i>	23
1203.02(e) <i>Material Submitted with Briefs</i>	24
1203.02(f) <i>Cases Which May Be Cited</i>	24
1203.02(g) <i>Waiver of Claim or Requirement in Brief</i>	25
1204 EFFECT OF REQUEST FOR RECONSIDERATION OF FINAL ACTION	25
1205 AMENDMENT OF APPLICATION DURING APPEAL	28
1205.01 IN GENERAL	28
1205.02 REQUEST TO DIVIDE	31
1206 AMENDMENT TO ALLEGE USE; STATEMENT OF USE	32
1206.01 AMENDMENT TO ALLEGE USE	32
1206.02 STATEMENT OF USE	34
1207 SUBMISSION OF EVIDENCE DURING APPEAL	34
1207.01 GENERAL RULE--EVIDENCE SUBMITTED AFTER APPEAL UNTIMELY	34
1207.02 REQUEST TO REMAND FOR ADDITIONAL EVIDENCE	35
1207.03 EVIDENCE CONSIDERED DUE TO ACTIONS OF NONOFFERING PARTY	38
1207.04 EVIDENCE FILED WITH TIMELY REQUEST FOR RECONSIDERATION	39

Chapter 1200
EX PARTE APPEALS

1207.05 SUBMISSION OF EVIDENCE UPON REMAND FOR NEW REFUSAL _____	39
1207.06 LETTER OF PROTEST EVIDENCE _____	40
1208 TREATMENT OF EVIDENCE _____	41
1208.01 EVIDENCE FROM NEXIS DATABASE OR PUBLICATIONS _____	43
1208.02 THIRD-PARTY REGISTRATIONS _____	44
1208.03 INTERNET MATERIAL _____	45
1208.04 JUDICIAL NOTICE _____	46
1209 REMAND _____	47
1209.01 UPON BOARD'S OWN INITIATIVE _____	47
1209.02 UPON REQUEST BY TRADEMARK EXAMINING ATTORNEY _____	51
1209.03 UPON GRANTED LETTER OF PROTEST _____	52
1209.04 UPON REQUEST BY APPLICANT _____	53
1210 APPROVAL FOR PUBLICATION DURING APPEAL _____	54
1211 ABANDONMENT DURING APPEAL _____	54
1212 CANCELLATION OR ASSIGNMENT OF CITED REGISTRATION _____	55
1213 SUSPENSION OF APPEAL _____	55
1214 CONSOLIDATION _____	58
1215 ALTERNATIVE POSITIONS _____	59
1216 ORAL HEARING _____	60
1217 FINAL DECISION _____	63
1218 REOPENING (AMENDMENT, ETC., AFTER FINAL DECISION) _____	64
1219 REVIEW OF FINAL DECISION _____	66
1219.01 BY REQUEST FOR RECONSIDERATION _____	66
1219.02 BY APPEAL _____	66

Chapter 1200
EX PARTE APPEALS

1201 Propriety of Appeal

1201.01 Readiness of Case for Appeal

15 U.S.C. § 1070 [Section 20 of the Trademark Act] 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 CFR § 2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) the requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see § 2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement 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. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 CFR § 2.64(a) *On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by § 2.63(b).*

37 CFR § 2.64(b) *During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action. The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Director, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three months after the date of the final action. Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.*

37 CFR § 2.141 Ex parte appeals from the Examiner of Trademarks. *Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, 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. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

Chapter 1200 EX PARTE APPEALS

37 CFR § 2.146(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under §§ 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.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 CFR § 2.63(b).² An applicant may, pursuant to 37 CFR § 2.64(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 mailing date of the final action, but does not file a notice of appeal within that time period, if the request for reconsideration fails to persuade the examining attorney, and the examining attorney does not issue a new final refusal, the application will be deemed abandoned.³

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

¹ See Section 12(b) of the Act; 15 U.S.C. § 1062(b); 37 CFR § 2.64(a); and TMEP §§ 713, 714.03.

² See 37 CFR § 2.64(a), and TMEP § 715.01. See also Section 20 of the Act, 15 U.S.C. § 1070, and TMEP § 1501.

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

⁴ See *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); and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985); 37 CFR § 2.141; and TMEP § 1501.

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

⁶ See *In re Hechinger Investment Co. of Delaware Inc.*, *supra*; and *In re Citibank, N.A.*, *supra*; Section 20 of the Act; 15 U.S.C. § 1070; 37 CFR §§ 2.64(a) and 2.141; and TMEP § 1501.

Chapter 1200
EX PARTE APPEALS

1201.02 Premature Final

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 trademark 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.⁷

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.⁸ 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.⁹ As stated in TMEP § 714.03:

No requirement may be made final, even if it is a repeated requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.

Examples of new issues that would preclude the issuance of a final action until applicant has had an opportunity to respond are amendments to the drawing,¹⁰ and amendments to the Supplemental Register or to assert acquired distinctiveness.¹¹ However, if the amendment is

⁷ See Section 12(b) of the Act, 15 U.S.C. § 1062(b); 37 CFR § 2.64(a); and TMEP §§ 714.01 and 1501.

⁸ See TMEP § 714.01. See also *In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1154 (TTAB 1992), and *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986).

⁹ See TMEP § 714.03. See also *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).

¹⁰ See *In re Abolio y Rubio S.A.C.I. y G.*, *supra*.

¹¹ See *In re Audio Book Club Inc.*, 52 USPQ2d 1042, 1043 n.2 (TTAB 1999) and TMEP § 714.05 *et seq.*

Chapter 1200 EX PARTE APPEALS

irrelevant to an outstanding refusal or is merely cumulative, it is not deemed to raise a new issue.¹²

If an applicant believes that a refusal to register, or the insistence upon a requirement, has been made final prematurely, 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 CFR § 2.146.¹³

The prematureness of a final action is not a ground for appeal to the Board.¹⁴ However, if it comes to the attention of the Board, when an appeal has been filed from a final refusal to register or a final requirement, that the final action was issued prematurely, the Board normally will decline to institute the appeal and will forward the case 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 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.

1201.03 Premature Appeal

An application is ripe for appeal when the trademark 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.¹⁵ All grounds and/or requirements must be repeated in order for the second refusal to be considered as final.¹⁶ If, in response to a final Office action, applicant files a request for reconsideration that raises a new

¹² See *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 § 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, 714.05(a), and 714.05(a)(i);

¹³ See TMEP § 714.06.

¹⁴ See TMEP § 714.06.

¹⁵ See TBMP § 1201.01 (Readiness of Case for Appeal) and authorities cited therein.

¹⁶ *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

Chapter 1200 EX PARTE APPEALS

issue, and does not file a notice of appeal, applicant may not then file an appeal until a final Office action issues with respect to the new issue.¹⁷

The Board has no jurisdiction to entertain a premature appeal. Thus, if an appeal is filed prematurely, the Board, in a written action, will notify applicant that the appeal was filed prematurely and forward the application to the trademark examining attorney for further appropriate action. The examining attorney will normally treat the premature notice of appeal as an incomplete response under 37 CFR § 2.65(b) and allow applicant time to submit a complete response. If applicant has also filed a request for reconsideration or an appeal brief, the request for reconsideration or brief may be treated as a response.¹⁸ 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 applicant wishes to appeal, applicant should file a new notice of appeal, and request that the appeal fee previously submitted be applied to the new appeal. If, on the other hand, no new appeal is ever filed in the case, applicant may request that the appeal fee submitted with the premature appeal be refunded.

1201.04 Compliance With Requirements Not Subject of Appeal

37 CFR § 2.142(c) *All requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal.*

Prior to the filing of an appeal, the applicant should comply with all requirements that the trademark examining attorney, has made, but which are not the subject of appeal. If an applicant who files an appeal to the Board fails to comply with a requirement not the subject of appeal, the refusal to register may be affirmed by the Board as to that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal.¹⁹

¹⁷ *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).

¹⁸ *In re Virshup*, *supra*.

¹⁹ See 37 CFR § 2.142(c); *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); and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984). 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).

NOTE: A possible alternative approach for use in situations where informalities that are not the subject of the appeal have not been resolved, suggested in *In re Variable Speech Control Co.*, 209 USPQ 431, 433 (TTAB 1980), of including in the Board's decision on the appealed issues a recommendation that no registration be granted to applicant until the informalities have been resolved, is no longer appropriate. This is because (1) the current 37 CFR § 2.142(c), adopted thereafter, provides that 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 (2) it is now settled that once the Board decides an appeal, the examining attorney is without jurisdiction to take further action in the case, nor may the Board, in its decision on the appealed issues, remand the case for further action on a matter not before it in the appeal. See *In re*

Chapter 1200 EX PARTE APPEALS

Thus, an applicant may not defer compliance with an outstanding requirement, such as the submission of a proper drawing or declaration to support substitute specimens, until after the Board rules on any substantive grounds for refusal.

1201.05 Appeal Versus Petition

37 CFR § 2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) the requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see § 2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement 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. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 CFR § 2.64(a) *On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by § 2.63(b).*

37 CFR § 2.146(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 §§ 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.

Hamilton Bank, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 397 n.2 (TTAB 1982); and TBMP §§ 1202.01 (Readiness of Case for Appeal) and 1217 (Final Decision).

Chapter 1200 EX PARTE APPEALS

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 trademark 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.²⁰

Substantive questions arising during the ex parte prosecution of an application, including, but not limited to, issues 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 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)),²¹ but not for petition to the Director.²²

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 trademark 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;²³ or (ii) the examining attorney's action is made final and is limited to subject matter appropriate for petition to the Director.²⁴ If the petition is denied, the applicant will have six months from the date

²⁰ See Section 20 of the Act, 15 U.S.C. § 1070; 37 CFR §§ 2.63(b), 2.64(a), and 2.141; *In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986); and TBMP § 1201.01 (Readiness of Case for Appeal).

²¹ See TBMP § 1201.01

²² See 37 CFR § 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., Inc.*, 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); and *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978).

²³ See, in this regard, 37 CFR § 2.146(b), and the preceding paragraph.

²⁴ See 37 CFR §§ 2.63(b) and 2.146(a)(1); *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997) (question of whether examining attorney's failure to issue substantive refusal during initial, pre-Statement-of-Use examination was clear error is procedural and reviewable on petition to Director; Board's decision on appeal is limited to the correctness of underlying substantive refusal; applicant that wishes to challenge procedural propriety must file petition after issuance of final refusal); *In re The Du Pont Merck Pharmaceutical Co.*, *supra* (proper signatory for an application and Statement of Use filed by a partnership); and *In re Stenographic Machines, Inc.*, *supra* (requirement for a more particular identification of goods).

Chapter 1200 EX PARTE APPEALS

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.²⁵

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or Part 2 of 37 CFR (*i.e.*, the rules of practice in trademark cases) specifies that the matter is to be determined directly or reviewed by the Director.²⁶ 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 CFR § 2.89(g), petitions to review the actions of Post Registration examiners under 15 U.S.C. §§ 1057, 1058 and 1059, and petitions to record a document in the Assignment Services Division of the Office.²⁷

(3) To invoke the supervisory authority of the Director in appropriate circumstances.²⁸ 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.²⁹

(4) In any case not specifically defined and provided for by Part 2 of 37 CFR (*i.e.*, the rules of practice in trademark cases).³⁰ Under this provision, an applicant may petition the Director with respect to any situation, not covered by the rules, from which applicant seeks relief.³¹

²⁵ See 37 CFR § 2.63(b). See also *In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

²⁶ See 37 CFR § 2.146(a)(2).

²⁷ See TMEP §§ 1702, 1703 and 1704.

²⁸ See 35 U.S.C. § 2 and 37 CFR § 2.146(a)(3).

²⁹ See, for example, *In re Mission Pharmacal Co., Inc.*, 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); and TMEP §§ 1702 and 1703. For further information concerning the matters that are petitionable under this provision, see TMEP § 1707.

³⁰ See 37 CFR § 2.146(a)(4).

³¹ See TMEP § 1708

Chapter 1200 EX PARTE APPEALS

(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 1946.³²

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).³³

For examples of matters that are appealable and those that are petitionable, see TMEP §§ 1703 and 1704.

1202 Filing an Appeal

1202.01 In General

15 U.S.C. § 1070. *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 CFR § 2.141 Ex parte appeals from the Examiner of Trademarks. *Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, 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. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

37 CFR § 2.142(a) *Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of 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.*

³² See 37 § 2.146(a)(5). For information concerning the meaning of the words "extraordinary situation" see TMEP § 1708.

³³ See 37 CFR §§ 2.63(b), 2.64(a), 2.146(a), and 2.146(b); *In re Tetrafluor Inc.*, *supra*; *In re Hart*, *supra*; *In re Stenographic Machines, Inc.*, *supra*; and TMEP §§ 1702 and 1704.

Chapter 1200 EX PARTE APPEALS

An appeal to the Board from a trademark examining attorney's final action, second refusal on the same ground(s), or repeated requirement, is taken by timely³⁴ filing in the Office both a notice of appeal *and* the prescribed appeal fee.³⁵ 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 applicant successfully petitions the Director to revive the application.³⁶

All requirements that have been made by the trademark examining attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal.³⁷ 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.³⁸

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 filing an appeal for the application as a whole, or filing a request to divide the application to sever those classes for which there has been no final requirement or refusal. 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 the appeal is decided. If a request to divide the application is filed,³⁹ the classes 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.⁴⁰

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 trademark examining attorney during the *ex parte* prosecution of an application for registration, except that a formal requirement which was

³⁴ See TBMP § 1202.02 (Time for Appeal).

³⁵ See 37 CFR § 2.6(a)(18) and TBMP § 1202.04 (Appeal Fee). See also Section 20 of the Act, 15 U.S.C. § 1070; 37 CFR §§ 2.141 and 2.142(a); and TMEP § 1501.

³⁶ See Section 12(b) of the Act, 15 U.S.C. § 1062; 37 CFR §§ 2.64(a), 2.65(a), and 2.66; and TMEP §§ 718.02, 718.05, 1501.04, 1714 and 1714.01(a).

³⁷ See 37 CFR § 2.142(c).

³⁸ See TBMP § 1201.04 (Compliance with Requirements Not Subject of Appeal) and authorities cited therein.

³⁹ See 37 CFR § 2.87 and TBMP § 1205.02 (Request to Divide).

⁴⁰ See TBMP § 1202.05 (Multiple Class Applications).

Chapter 1200 EX PARTE APPEALS

the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board.⁴¹

An appeal to the Board must be filed within six months from the date of the action from which the appeal is taken.⁴² 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.⁴³

The notice of appeal to the Board (unlike other correspondence to be filed with the Board) may be filed by facsimile transmission, as well as by any of the ordinary methods for filing correspondence intended for the Board, including electronically through ESTTA in the manner prescribed in 37 CFR § 2.126(c).⁴⁴ The certificate of mailing and certificate of transmission procedures described in 37 CFR § 2.197, and the "Express Mail" procedure described in 37 CFR § 2.198, are available for the filing of an appeal to the Board.⁴⁵

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.⁴⁶ 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).⁴⁷ If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response⁴⁸ to the final refusal has been filed during the

⁴¹ See TBMP §§ 1201.01 (Readiness of case for Appeal) and 1201.05 (Appeal vs. Petition) and authorities cited therein. See also TMEP § 1501.

⁴² See Section 12(b) of the Act, 15 U.S.C. § 1062, and 37 CFR § 2.142(a).

⁴³ See TBMP § 1202.01 and authorities cited therein

⁴⁴ See 37 CFR §§ 2.195 and 2.126 (Form of Submissions to the Trademark Trial and Appeal Board), and TBMP §§ 107 (How and Where to File Papers and Fees) and 1202.03 (Filing an Appeal - Notice of Appeal).

⁴⁵ See 37 CFR §§ 2.197 and 2.198, and TBMP §§ 110 (Certificate of Mailing/Transmission) and 111 ('Express Mail' Procedure). It is noted that the examining operation has eliminated the Express Mail procedure, see TMEP § 305.03. However, because the notice of appeal is filed with the Board, rather than the examining operation, the Express Mail procedure is available for such filings.

⁴⁶ See 37 CFR § 2.64(b) and TBMP § 1204 (Effect of Request for Reconsideration). See also TMEP §§ 715.02 and 715.03(a), and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984).

⁴⁷ See 37 CFR §§ 2.63(b) and 2.64(a), and TBMP § 1201.05 (Appeal vs. Petition). See also 37 CFR § 2.64(b), and TMEP §§ 715.03 and 715.03(c).

⁴⁸ See 37 CFR § 2.64(a), and TMEP § 715.01.

Chapter 1200 EX PARTE APPEALS

six months following issuance of the final action, the application will be abandoned.⁴⁹ Thus, if an applicant who 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 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 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.⁵⁰

1202.03 Notice of Appeal

A notice of appeal is a simple statement indicating that applicant appeals from the decision of the trademark examining attorney refusing registration; reasons for appeal need not be given. 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, applicant's name, the serial number and filing date of the application, and the involved mark. 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.

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.⁵¹ 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.

The notice of appeal must be filed in written form and must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.126.⁵²

⁴⁹ See 37 CFR §§ 2.64 and 2.142(a), and TMEP § 715.03(a).

⁵⁰ See 37 CFR § 2.66(a) and TMEP § 1714 *et seq.*

⁵¹ Cf. 37 CFR § 2.119(e), and TBMP § 106.02 (Signature of Submissions).

⁵² See TBMP § 106.03 (Form of Submissions).

Chapter 1200 EX PARTE APPEALS

The Board has no printed form for use in filing a notice of appeal. However, as an aid to applicants, the Office has prepared a suggested format for a notice of appeal. A notice of appeal need not follow the suggested format, as long as it includes the necessary information. The suggested format for a notice of appeal can be found in the Appendix of Forms to this manual.

If applicant files a request for reconsideration or amendment along with the notice of appeal, or at the time of filing the notice of appeal applicant had filed a request for reconsideration or amendment which is still pending before the examining attorney, the applicant should indicate this in its notice of appeal so that the Board can obtain the request for reconsideration prior to instituting the appeal.⁵³ However, the request for reconsideration or amendment should not be combined in the body of the notice of appeal.

1202.04 Appeal Fee

37 CFR § 2.85(e) Where the amount of the fee received on filing an appeal in connection with an application or on an application for renewal is sufficient for at least one class of goods or services but is less than the required amount because multiple classes in an application or registration are involved, the appeal or renewal application or petition for cancellation will not be refused on the ground that the amount of the fee was insufficient if the required additional amount of the fee is received in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office, or if action is sought only for the number of classes equal to the number of fees submitted.

37 CFR § 2.141 Ex parte appeals from the Examiner of Trademarks.

Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, 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. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

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.⁵⁴ 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.⁵⁵ In such circumstance, however, the applicant may file a

⁵³ See TBMP §§ 1204 (Effect of Request for Reconsideration of Final Action) and 1205 (Amendment of Application During Appeal).

⁵⁴ 37 CFR § 2.141.

⁵⁵ See TBMP § 1202.01 (Filing an Appeal in General) and authorities cited therein.

Chapter 1200 EX PARTE APPEALS

petition to revive.⁵⁶ 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 upon petition to the Director.⁵⁷

The amount of the fee required for an ex parte appeal to the Board is specified in 37 CFR § 2.6(a)(18). If an application in which an appeal is filed has more than one class of goods and/or services⁵⁸ the required fee must be paid for each class in which appeal is taken.⁵⁹ 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.⁶⁰ 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.⁶¹

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 applicant has not specified the class or classes to which the submitted fee applies, the Board will issue a written notice allowing 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.⁶²

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.⁶³ In the former case, the classes for which an appeal has not been taken remain part of the file. After a decision on the appeal is

⁵⁶ See generally, TMEP § 1714. See also § 1704.01(f)(ii).

⁵⁷ See *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r 1996).

⁵⁸ See 37 CFR § 2.86(b)).

⁵⁹ See 37 CFR § 2.6(a)(18).

⁶⁰ See 37 CFR § 2.141, and TMEP § 1403.05(a).

⁶¹ See TBMP § 1202.05 (Multiple Class Applications).

⁶² See 37 CFR §§ 2.85(e) and 2.141.

⁶³ See 37 CFR § 2.87 and TBMP § 1205.02 (Request to Divide).

Chapter 1200 EX PARTE APPEALS

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.

If the final refusals or requirements do not apply to all the classes in a multiple class application, an appeal fee is required only 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.

1203 Appeal Briefs

It should be noted that if the ground or one of the grounds for refusal is likelihood of confusion with a registered mark, it is suggested, before 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.⁶⁴

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

1203.01 Form of Brief

37 CFR § 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. 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 the text on one side only of each sheet;*
- (2) A paper submission must be 8 to 8.5 inches (20.3 to 21.5 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;*

⁶⁴ See TBMP § 1212 (Cancellation or Assignment of Cited Registration).

Chapter 1200
EX PARTE APPEALS

(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 or CD-ROM concurrently with the paper submission, and comply with the requirements for a paper or CD-ROM submission.

(b) Submissions may be made to the Trademark Trial and Appeal Board on CD-ROM where the rules in this part or Board practice permit. A CD-ROM submission must identify the parties and case number and contain a list that clearly identifies the documents and exhibits contained thereon. This information must appear in the data contained in the CD-ROM itself, on a label affixed to the CD-ROM, and on the packaging for the CD-ROM. Text in a CD-ROM submission must be in at least 11-point type and double-spaced. A brief filed on CD-ROM must be accompanied by a single paper copy of the brief. A CD-ROM submission must be accompanied by a transmittal letter on paper that identifies the parties, the case number and the contents of the CD-ROM.

(c) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the Web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.

37 CFR § 2.142(b)(2) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetic index of cited cases. 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 brief filed in an ex parte appeal to the Board must conform to the requirements of 37 CFR § 2.142(b)(2) as well as the general requirements for submissions to the Board specified in 37 CFR § 2.126.

Only one copy of the brief should be submitted. The twenty-five pages allowed for an appeal brief does not refer to any exhibits attached to the brief. However, material that was not previously made of record should not be submitted with the appeal brief.⁶⁵ Also, the appeal brief is placed in the application file, so papers that are already in the file should not, as a matter of course, be resubmitted as exhibits to the brief. 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

⁶⁵ See TBMP §§ 1203.02(e) (Material Submitted with Briefs) and 1207.01 (Evidence Submitted After Appeal Untimely – General Rule).

Chapter 1200 EX PARTE APPEALS

will rarely grant a motion for leave to exceed the twenty-five page limit.⁶⁶ If an applicant files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal.

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.⁶⁷ An appeal brief should include an alphabetic index of cited cases⁶⁸ but need not include the formal requirements, such as a table of contents and description of the record, of a trial brief.⁶⁹

For further information concerning the form and contents of the trademark examining attorney's appeal brief, in particular, see TMEP § 1501.02.

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 CFR § 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 examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall 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 examiner.

An applicant's main brief in an ex parte appeal to the Board must be filed within 60 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; therefore, 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

⁶⁶ See *In re Psynosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (applicant's request for a waiver in order to include an additional 10 pages denied; applicant's attempt to submit discussion as an appendix to brief treated by Board as an attempt to circumvent the Board's order denying the waiver, and sanctions imposed).

⁶⁷ Cf. TMEP § 302.03.

⁶⁸ See 37 CFR § 2.142(b)(2).

⁶⁹ Cf. 37 CFR § 2.128.

Chapter 1200 EX PARTE APPEALS

such filing.⁷⁰ If no brief is filed, the appeal will be dismissed.⁷¹ If the brief is filed late, 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.

If the appeal is dismissed for failure to file a timely brief, applicant's recourse is to file a petition to the Director under the provisions of 37 CFR § 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.⁷² 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 applicant has failed to file an appeal brief or has filed its appeal brief late. The petition to revive procedure provided in 37 CFR § 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 CFR § 2.66(a) does not apply to the determination of whether a late-filed brief will be accepted.

If a notice of appeal (accompanied by the required fee) is filed with a certificate of mailing by first-class mail pursuant to 37 CFR § 2.197, 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 applicant's main brief.⁷³

If an applicant that 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, and the examining attorney has not yet considered the request for reconsideration when the appeal is filed, or if applicant files a request for reconsideration along with the notice of appeal, the file of the application, with the appeal and the request for reconsideration, will be forwarded to the Board. However, because papers may become separated, if applicant files a request for reconsideration along with the notice of appeal, it should indicate in the notice of appeal that a request for reconsideration is being filed contemporaneously. The

⁷⁰ *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

⁷¹ *See* 37 CFR § 2.142(b)(1).

⁷² *See* TMEP § 1706.

⁷³ *See* 37 CFR § 2.197.

Chapter 1200 EX PARTE APPEALS

Board will acknowledge receipt of the appeal and request, suspend further proceedings (including 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 request. Because proceedings in the appeal are automatically 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 CFR § 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.⁷⁴

If, upon the examining attorney's consideration of the request for reconsideration, all refusals and requirements are not withdrawn, and a new final refusal to register is issued (either in the examining attorney's action on the request for reconsideration, or in a subsequent action)⁷⁵ the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief. 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. The examining attorney should so notify the applicant either in a written action or by telephone.⁷⁶

1203.02(b) Trademark Examining Attorney's Brief

When the applicant's main appeal brief has been received by the Board and entered in the application file, the Board sends the file to the trademark examining attorney. Within 60 days after the date of the Board's written action forwarding the file 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.⁷⁷ The examining attorney must also send a copy of his or her brief to the applicant.⁷⁸ If the examining attorney's brief is late

⁷⁴ See *In re Live Earth Products Inc.*, *supra*. See also TBMP § 1204 (Effect of Request for Reconsideration of Final Action).

⁷⁵ See TBMP § 1205 for procedure when request for reconsideration contains an amendment.

⁷⁶ TMEP § 715.04.

⁷⁷ See 37 CFR § 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' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984); TMEP § 1501.02; and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984). See also *In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

⁷⁸ See 37 CFR § 2.142(b)(1). See also *In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475, 1476 n.3 (Fed. Cir. 1993).

Chapter 1200 EX PARTE APPEALS

filed, the Board may exclude it in the absence of an adequate explanation for the late filing.⁷⁹

If the examining attorney, having received the application for preparation of his or her appeal brief, is persuaded, by applicant's appeal brief, that 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 by telephone.⁸⁰ 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. The appeal will then go forward on the remaining ground(s)/requirement(s). 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.⁸¹

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 a written request that the application be remanded to him or her for further examination.⁸² If the request is denied, the Board will reset the examining attorney's time in which to file an appeal brief.⁸³ 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

⁷⁹ See *In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, *supra*.

⁸⁰ See TMEP § 1501.03.

⁸¹ See TBMP § 1203.02(g) (Waiver of Claim or Requirement in Brief).

⁸² See TMEP § 1501.02. See also *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). For information concerning requests for remand, see TBMP § 1209.02 (Remand Upon Request by Examining Attorney), and TMEP §§ 1504.05 and 1504.05(a).

⁸³ See *In re Miller Brewing Co.*, *supra*.

Chapter 1200 EX PARTE APPEALS

response clause; the application should be returned to the Board; and the Board will resume proceedings with respect to the appeal and allow 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.

1203.02(c) Applicant's Reply Brief

Within 20 days from the mailing date of the trademark 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.⁸⁴ However, the filing of a reply brief is not mandatory.

If the applicant files a reply brief, the Board will notify the trademark examining attorney. If the examining attorney, having read the applicant's reply brief, is persuaded thereby that 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 advise the Board (by e-mail to the Board's administrator) that the application is being approved for publication (or registration) as soon as possible after being notified of the reply brief in order to avoid the possibility of the Board's scheduling an oral argument or drafting a decision. The examining attorney should also notify the applicant by telephone.⁸⁵

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 applicant's reply brief.⁸⁶

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.⁸⁷ The determination of good cause will be based upon all relevant

⁸⁴ See 37 CFR § 2.142(b)(1); *In re Gena Laboratories, Inc.*, 230 USPQ 382, 383 n.4 (TTAB 1985); and *In re Randall & Hustedt*, 226 USPQ 1031, 1033 n.2 (TTAB 1985). Cf. *In re Gale Hayman Inc.*, 15 USPQ2d 1478, 1478 n.3 (TTAB 1990).

⁸⁵ See TMEP § 1501.03.

⁸⁶ See TMEP § 1501.02(a).

⁸⁷ See *In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985). See also *In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984).

Chapter 1200 EX PARTE APPEALS

circumstances, including the length of time of any previously granted extensions. 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.

1203.02(e) Material Submitted with Briefs

The record in the application should be complete prior to the filing of an appeal.⁸⁸ Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered.⁸⁹ 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 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.⁹⁰

1203.02(f) Cases Which May Be Cited

Decisions that are designated by the Board "citable as precedent" or "for publication in full" are citable as precedent. Decisions that are not so designated, or that are designated

⁸⁸ 37 CFR § 2.142(d).

⁸⁹ See *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 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 no considered); and TBMP § 1207.01 (Evidence Submitted After Appeal Untimely – General Rule).

⁹⁰ See TBMP § 1207.03 (Evidence Considered Due to Actions of Nonoffering Party).

Chapter 1200 EX PARTE APPEALS

for publication only in digest form, are not citable authority and will not be considered by the Board.⁹¹

1203.02(g) Waiver of Claim or Requirement in Brief

If applicant, in its appeal brief, does not assert a claim made during prosecution, it may be deemed waived by the Board.⁹² Similarly, if 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 brief, the requirement or refusal may be deemed withdrawn.⁹³ However, the better practice, if applicant seeks to comply with a requirement, is to request remand rather than simply offering the amendment as part of its brief.⁹⁴

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.⁹⁵ 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).⁹⁶ If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response⁹⁷ to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned.⁹⁸ Thus, if

⁹¹ *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001); *In re Polo International Inc.*, *supra* at 1063, n.3 (TTAB 1999) (non-precedential case disregarded); and *In re Caterpillar Inc.*, *supra* (decisions which are not designated for publication are not citable as precedent, even if a complete copy of the unpublished decision is submitted). *See also* TBMP § 101.03 (Decisional Law).

⁹² *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).

⁹³ *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). *See also* TBMP § 1203.02(b) (Trademark Examining Attorney's Brief).

⁹⁴ *See* TBMP § 1205 (Amendment of Application During Appeal).

⁹⁵ *See* 37 CFR § 2.64(b). *See also* TMEP § 715.03, and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984).

⁹⁶ *See* 37 CFR §§ 2.63(b) and 2.64(a) & (b); TBMP §§ 1201.02 (Premature Final) and 1201.05 (Appeal vs. Petition); and TMEP §§ 715.03 and 715.03(c).

⁹⁷ *See* 37 CFR § 2.64(a), and TMEP § 715.01.

⁹⁸ *See* 37 CFR §§ 2.64 and 2.142(a), TMEP § 715.03 and TBMP § 1202.02 (Time for Appeal).

Chapter 1200 EX PARTE APPEALS

an applicant who 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.

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 applicant believes reconsideration is warranted. The request for reconsideration should not be combined in the body of the notice of appeal; however, the applicant should indicate, in the notice of appeal, that a request for reconsideration has also been filed, so that the Board will be alerted to obtain that submission prior to instituting the appeal.⁹⁹

A request for reconsideration filed more than six months from the final refusal is treated by the Board as a request for remand.¹⁰⁰ A request for reconsideration or request for remand should not be combined with the applicant's appeal brief.¹⁰¹

If 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, and the examining attorney has not yet considered the request for reconsideration when the appeal is filed, the file of the application, with the appeal and the request for reconsideration, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and request, suspend further proceedings (including 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 request. Where an applicant has timely filed both a notice of appeal 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. Rather, it may assume that the Board will institute the appeal, 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.¹⁰² The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary.¹⁰³

⁹⁹ See TBMP § 1202.03 (Notice of Appeal).

¹⁰⁰ See TBMP § 1209.04 (Remand Upon Request by Applicant).

¹⁰¹ See *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 (TTAB 1984).

¹⁰² For information concerning the actions that an examining attorney may take in response to a request for reconsideration of a final action, see TMEP §§ 715.03(a), 715.03(b) and 715.04. See also *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992).

¹⁰³ *In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998); and TBMP § 1203.02(a) (Applicant's Main Brief).

Chapter 1200 EX PARTE APPEALS

In particular, 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 file to the Board. New issues are typically raised by a request for reconsideration which amends the application to seek registration under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), or to seek registration on the Supplemental Register, or to amend the identification of goods, if a requirement for an acceptable identification of goods was not the subject of the final Office action.¹⁰⁴ If the examining attorney believes that the outstanding issue(s) can be resolved, the examining attorney may contact applicant and attempt to work out a resolution.

Occasionally when an applicant files its notice of appeal and a request for reconsideration at the same time, the papers become separated, and the examining attorney acts on the request for reconsideration before the Board can institute the appeal and remand the application. In that event, 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 applicant 60 days from the mailing date of the Board action in which to file its appeal brief. 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.¹⁰⁵

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. However, the examining attorney should notify the applicant by telephone.¹⁰⁶ 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 from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief. The examining attorney must, prior to returning the file to the Board to resume proceedings in the appeal, issue a written Office action apprising applicant of that fact, indicating

¹⁰⁴ See TMEP § 714.05 and TBMP § 1201.02 for examples of new issues that would preclude the issuance of a final action.

¹⁰⁵ See *In re Live Earth Products Inc.*, *supra*.

¹⁰⁶ See TMEP § 715.04.

Chapter 1200

EX PARTE APPEALS

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 file and return the file to the Board.

If an appeal is late filed, but applicant timely filed a request for reconsideration, the Board will issue an action informing 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.¹⁰⁷

A timely request for reconsideration of an appealed action may be accompanied by an amendment and/or by additional evidence. 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.¹⁰⁸ 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.¹⁰⁹

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 final or nonfinal action, the examining attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought. 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.¹¹⁰

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, applicant files both an amendment to its application and an

¹⁰⁷ See TBMP § 1202.02 (Time for Appeal).

¹⁰⁸ See 37 CFR § 2.142(d). See also TBMP § 1207 (Submission of Evidence During Appeal).

¹⁰⁹ See Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984), and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310 (1983). See also *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1598 n.4 (TTAB 1999); *In re Corning Glass Works*, 229 USPQ 65, 65 n.5 (TTAB 1985), and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 n.3 (TTAB 1984).

¹¹⁰ See 37 CFR § 2.142(d); TBMP §§ 1207.02 (Request to Remand for Additional Evidence) and 1209.04 (Remand Upon Request by Applicant).

Chapter 1200 EX PARTE APPEALS

ex parte appeal to the Board, and the examining attorney has not yet acted on the amendment when the appeal is filed, the file of the application, with the amendment and the appeal, will be forwarded to the Board. However, because of the possibility that papers may be separated, applicant should indicate in its notice of appeal that it has also filed an amendment with the notice of appeal.¹¹¹ The Board will acknowledge receipt of the amendment and appeal, suspend further proceedings (including applicant's time for filing its appeal brief,¹¹² with respect to the appeal, and remand the application to the trademark 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.¹¹³ Further, if the examining attorney believes that the outstanding issue(s) can be resolved, the examining attorney may contact applicant and attempt to work out a resolution. The examining attorney may not, however, 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 CFR § 2.142(f)(6) for remand to assert the new refusal or requirement or submit additional evidence, and the request is granted.

Where an applicant has timely filed both a notice of appeal and 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, 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 Registration). The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary.¹¹⁴

If the examining attorney is persuaded, on the basis of the amendment, that 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 by telephone.¹¹⁵

¹¹¹ See TBMP §§ 1202.03 (Notice of Appeal) and 1204 (Effect of Request for Reconsideration of Final Action).

¹¹² See TBMP § 1203.02(a) (Applicant's Main Brief)

¹¹³ For information concerning the actions which may be taken by the examining attorney upon consideration of the amendment see TMEP §§ 715.03(a), 715.03(b) and 715.04; and TBMP § 1204 (Effect of Request for Reconsideration of Final Action). 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); and *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986).

¹¹⁴ *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998) and TBMP § 1203.02(a) (Applicant's Main Brief).

¹¹⁵ See TMEP §§ 715.04 and 1501.05.

Chapter 1200 EX PARTE APPEALS

If the examining attorney, after consideration of the amendment filed after appeal, 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 from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and 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 applicant an opportunity to respond before issuing a final refusal and returning the file of 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.¹¹⁶

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.¹¹⁷ Such a request will be granted upon a showing of good cause. Good cause will be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods in response to a requirement for an acceptable identification, or when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register or an amendment to assert a Section 2(f) claim (15 U.S.C. § 1052(f)) in order to avoid or overcome a refusal under Sections 2(e)(1), 2(e)(2) or 2(e)(4) of the Trademark Act, 15 U.S.C. §§ 1052(e)(1), 1052(e)(2) or 1052(e)(4). If the 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, if, for example, the amendment was filed in bad faith, or would serve no useful purpose. 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, from those given by the Board for an amendment filed within six months after that date.

If an appeal is late filed, but applicant timely filed an amendment to its involved application, the Board will issue a written action informing applicant of the lateness of its appeal; stating that the

¹¹⁶ See TBMP § 1201.02 (Premature Final) and TMEP § 714.05 regarding amendments which raise new issues.

¹¹⁷ See TBMP § 1209.04 (Remand Upon Request by Applicant).

Chapter 1200 EX PARTE APPEALS

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 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.¹¹⁸ 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 paper), 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.¹¹⁹

An application that has been considered and decided on appeal may be amended, if at all, only in accordance with 37 CFR § 2.142(g).¹²⁰

1205.02 Request to Divide

An applicant may submit a request to divide the application to divide out goods or classes prior to, with or after the filing of a notice of appeal.¹²¹ An applicant may wish to submit such a request in a situation where a refusal to register 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. If an applicant submits a request to divide along with a notice of appeal, the Board will institute the appeal, suspend proceedings in it, and forward the file to the ITU/Divisional Unit of the Office for action on the request to divide. If a request to divide is pending at the time a notice of appeal is submitted, the Board will await receipt of the divided applications after the ITU/Divisional Unit has acted on the request to divide, and then institute the appeal.

In either situation, after the request to divide has been processed, the Board receives both the original file (parent application) and the new file created by the division (child application). If the appeal applies to only one of the files, the Board will institute the appeal with respect to that

¹¹⁸ See above discussion.

¹¹⁹ 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).

¹²⁰ For further information concerning amendment after decision on appeal, see TBMP § 1218 and TMEP § 1501.06.

¹²¹ See generally, TMEP § 1110 regarding requests to divide.

Chapter 1200 EX PARTE APPEALS

file, and allow the applicant 60 days in which to submit its appeal brief. If the appeal applies to both files, the Board will resume action in the appeals with respect to both files. In the latter situation, the Board may consolidate the appeals.

If the appeal applies to only one of the files, and if applicant had previously submitted a request for reconsideration or an amendment with respect to this file, the Board will suspend action on the appeal and remand the application to the examining attorney, in the same procedure that is followed for any request for reconsideration or amendment.¹²² The remaining file will be forwarded to the examining attorney for further action, as appropriate. Such action may be approval of the application for publication, or for consideration of a request for reconsideration or amendment. However, unless the examining attorney issues a new final action with respect to that application, applicant may not subsequently submit a notice of appeal.

If a request to divide is submitted after an appeal is instituted, the Board will determine whether to suspend action on the appeal and forward the file 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.

1206 Amendment to Allege Use; Statement of Use

1206.01 Amendment to Allege Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. § 1051(c), may be filed in an intent-to-use application, *i.e.*, an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), at any time between the filing of the application and the date the trademark examining attorney approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), after the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).¹²³ Thus, because an *ex parte* appeal occurs prior to the approval of a mark for publication, an amendment to allege use filed during the pendency of an *ex parte* appeal to the Board is timely.¹²⁴

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, the file of the application,

¹²² See generally, TBMP §§ 1204 (Effect of Request for Reconsideration of Final Action) and 1205 (Amendment of Application During Appeal).

¹²³ See 37 CFR § 2.76(a). See also *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1991).

¹²⁴ See 37 CFR § 2.76(a) and TMEP §§ 1104.03 and 1104.07.

Chapter 1200 EX PARTE APPEALS

with the appeal and the amendment to allege use, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and amendment to allege use, suspend further proceedings (including 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. That is, 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.¹²⁵ Applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 CFR § 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). However, because papers may become separated, if applicant files an amendment to allege use along with the notice of appeal, it should indicate in the notice of appeal that an amendment to allege use is being filed contemporaneously.¹²⁶ 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, by telephone or e-mail, if e-mail communications have been authorized.¹²⁷ 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, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.¹²⁸

If an applicant which has filed a timely appeal to the Board files an amendment to allege use, in the application which is the subject of the appeal, 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 applicant, the amendment to allege use will be moot.

¹²⁵ *See in this regard*, TBMP § 1205 (Amendment of Application During Appeal).

¹²⁶ *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.

¹²⁷ *See* TMEP § 1104.07.

¹²⁸ *See* TMEP § 1104.07.

Chapter 1200 EX PARTE APPEALS

1206.02 Statement of Use

A statement of use under Section 1(d) of the Act, 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application, *i.e.*, an application under Section 1(b) of the Act, 15 U.S.C. § 1051(b), prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. § 1063(b)(2).¹²⁹

A notice of allowance is not issued in an intent-to-use application (for which no amendment to allege use under Section 1(c) of the Act, 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.¹³⁰

Therefore, a statement of use filed during an ex parte appeal to the Board is premature. A premature statement of use will not be considered.¹³¹ Instead, the premature statement of use will be returned to applicant and the fee will be refunded.

1207 Submission of Evidence During Appeal

1207.01 General Rule--Evidence Submitted After Appeal Untimely

37 CFR § 2.142(d) The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request 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. Additional evidence filed after appeal normally will be given no consideration by the Board.¹³²

¹²⁹ See 37 CFR § 2.88(a).

¹³⁰ See Section 13(b)(2) of the Act, 15 U.S.C. § 1063, and 37 CFR § 2.81(b). See also TMEP § 1109.04 and TBMP § 219 (Amendment to Allege Use).

¹³¹ See 37 CFR § 2.88(a).

¹³² See 37 CFR § 2.142(d). See also *In re Trans Continental Records Inc.*, 62 USPQ2d 1541 (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, 1689 n.2 (TTAB 1998), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (evidence

Chapter 1200 EX PARTE APPEALS

However, 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.¹³³ 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.¹³⁴

1207.02 Request to Remand for Additional Evidence

If an applicant or trademark 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.¹³⁵

submitted with reply brief not considered); *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 (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, 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, 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, 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 Bros., Inc.*, 218 USPQ 181, 183 (TTAB 1983); and *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 (Fed. Cir. 1986), and *In re Volvo White Truck Corp.*, 16 USPQ2d 1417 (TTAB 1990).

¹³³ See *In re Bed & Breakfast Registry*, *supra* at 820 (if only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came).

¹³⁴ See also TBMP § 1208.01 (Evidence from NEXIS Database or Publications). *But see In re Psygnosis Ltd.*, *supra* (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).

¹³⁵ See 37 CFR § 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, 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, 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); and *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982).

Chapter 1200 EX PARTE APPEALS

A request under 37 CFR § 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.¹³⁶ 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.¹³⁷ 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.¹³⁸

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.¹³⁹ 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 Section 2(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

¹³⁶ See *In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984), and *In re Carvel Corp.*, *supra*.

¹³⁷ See *In re Big Wrangler Steak House, Inc.*, *supra*; *In re Bercut-Vandervoort & Co.*, *supra*; *In re Chung, Jeanne & Kim Co.*, *supra*; *In re Mayer-Beaton Corp.*, *supra*; *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, *supra*; *In re Jeep Corp.*, *supra*; and *In re Historic Wharf's Associates, Inc.*, 222 USPQ 92, 93 n.1 (TTAB 1984).

¹³⁸ See also *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984); and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310 (1983).

¹³⁹ See *In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001); and *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 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).

Chapter 1200 EX PARTE APPEALS

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 to the file 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 Section 2(d) of the Act, 15 U.S.C. § 1052(d)¹⁴⁰ is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, 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.¹⁴¹

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 CFR § 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 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. However, the examining attorney should so notify the applicant by telephone.¹⁴² 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 from the action; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.

¹⁴⁰ See, for example, *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985), and *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

¹⁴¹ 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).

¹⁴² See TMEP § 715.04.

Chapter 1200 EX PARTE APPEALS

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 (with no six-month response clause) relating to the new evidence to be submitted therewith. After the examining attorney's new action has been issued, the application should be returned to the Board; proceedings with respect to the appeal will be resumed; applicant will be allowed an opportunity to submit, if it so desires, responsive evidence; and further appropriate action with respect to the appeal will be taken. If 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.

1207.03 Evidence Considered Due to Actions of Nonoffering Party

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence¹⁴³ 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.¹⁴⁴ In such a situation, the Board may consider evidence submitted by the nonoffering party to rebut the untimely evidence.¹⁴⁵

Copies of third-party registrations that are submitted with an applicant's brief may be considered in certain circumstances, even if the examining attorney objects to the registrations or does not discuss them in the examining attorney's brief. 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 applicant that a listing is insufficient to make such registrations of record at a point when the applicant could

¹⁴³ See TBMP § 1207.02 (Request to Remand for Additional Evidence).

¹⁴⁴ See, for example, *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); Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984); and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310 (1983).

See also *In re Wells Fargo & Co.*, 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Weather Channel, Inc.*, 229 USPQ 854, 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); and *In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 n.2 (TTAB 1983).

¹⁴⁵ See *In re Development Dimensions International, Inc.*, *supra*. Cf. *In re Northland Aluminum Products, Inc.*, 221 USPQ 1110, 1112 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Chapter 1200 EX PARTE APPEALS

cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form.¹⁴⁶

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. There is no need, in such a situation, for a 37 CFR § 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.¹⁴⁷

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. 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.¹⁴⁸

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 CFR § 2.142(f) (*i.e.*, *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),¹⁴⁹ or under 37 CFR § 2.142(f)(6) (*i.e.*, 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

¹⁴⁶ See TBMP § 1208.02 (Third-Party Registrations), *including discussion of evidentiary value of such listings*. See also *In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945 n.4 (TTAB 2000) (applicant provided list of third-party registration numbers in its response; because examining attorney did not object and made no mention of the marks, they were deemed to be of record).

¹⁴⁷ See TBMP § 1204 (Effect of Request for Reconsideration of Final Action) and authorities cited therein.

¹⁴⁸ See 37 CFR § 2.142(d), TBMP §§ 1207.01 (Evidence Submitted After Appeal Untimely) and 1207.02 (Request to Remand for Additional Evidence).

¹⁴⁹ See TBMP § 1209.01 (Remand Upon Board's Own Initiative).

Chapter 1200 EX PARTE APPEALS

of the applicant unregistrable),¹⁵⁰ and (2) the examining attorney, upon remand, does, in fact, issue a new refusal to register or requirement.¹⁵¹ If no new refusal or requirement is made, and the examining attorney instead returns the file to the Board, no additional evidence may be submitted.¹⁵²

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 Commissioner for Trademarks, a "letter of protest," that is, a letter that recites the facts and which is accompanied by supporting evidence. The Administrator for Trademark Identifications, Classifications and Practice ("Administrator") will determine whether the information should be given to the trademark examining attorney for consideration.¹⁵³ 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 file for appeal.¹⁵⁴

Proceedings in an ex parte appeal will not be suspended pending determination by the Commissioner for Trademark's Office 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 CFR § 2.142(d), to suspend the appeal and remand the application for further examination.¹⁵⁵

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.¹⁵⁶ 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.¹⁵⁷

¹⁵⁰ See TBMP § 1209.02 (Upon Request by Trademark Examining Attorney).

¹⁵¹ See *In re Bank America Corp.*, 229 USPQ 852, 853 n.4 (TTAB 1986).

¹⁵² See *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 n.3 (TTAB 1986).

¹⁵³ See TBMP § 215 (Effect of Letter of Protest) and authorities cited therein.

¹⁵⁴ *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999).

¹⁵⁵ For information concerning a request for remand for additional evidence see TBMP § 1207.02.

¹⁵⁶ See TBMP § 1207.02 (Request to Remand for Additional Evidence).

¹⁵⁷ For information concerning good cause for a remand for additional evidence, see TBMP § 1207.02.

Chapter 1200 EX PARTE APPEALS

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 and are not self-authenticating.¹⁵⁸

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. 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. The reason for this more relaxed approach in ex parte cases is that in an ex parte proceeding, there is no cross-examination of witnesses or any compelling need for the strict safeguards required in an inter partes proceeding.¹⁵⁹

For example, the Board is somewhat more lenient in its approach in the consideration of surveys in ex parte proceedings than inter partes proceedings.¹⁶⁰ Also, the affidavit or 37 CFR § 2.20 declaration is an established method for the introduction of evidence in an ex parte proceeding.¹⁶¹ In an inter partes proceeding, however, evidence may not be offered in affidavit or 37 CFR § 2.20 declaration form except by agreement of the parties.¹⁶²

¹⁵⁸ *In re Urbano, supra* (documents of limited evidentiary value because no affidavits or other evidence establishing foundation, and no information establishing authenticity or source).

¹⁵⁹ *See In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10 & 1924 n.18 (TTAB 1996) (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); and Daniel L. Skoler, *TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities*, 73 Trademark Rep. 310, 315 (1983). *See also In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993).

¹⁶⁰ *In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996); and *In re Pillsbury Co.*, 174 USPQ 318, 320 (TTAB 1972).

¹⁶¹ *See, for example*, 37 CFR § 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); and *In re Original Red Plate Co.*, 223 USPQ 836, 838 (TTAB 1984).

¹⁶² *See* 37 CFR § 2.123(b), and TBMP § 703.01(b) (Form of Testimony) and cases cited therein.

Chapter 1200 EX PARTE APPEALS

It is the better practice to provide evidence as to sales figures and the like by affidavit or declaration. However, representations by applicant's counsel may, in certain circumstances, be accepted.¹⁶³ Affidavits or declarations may have probative value even if they are form documents, or are prepared by applicant's attorney.¹⁶⁴

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.¹⁶⁵

*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 trademark examining attorney, see the cases cited in the note below.*¹⁶⁶

¹⁶³ See *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997) (examining attorney never objected to attorney's representations, and figures uncontradicted by other information).

¹⁶⁴ See *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); and *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 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); and *In re EBSCO Industries Inc.*, *supra* (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).

¹⁶⁵ 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).

¹⁶⁶ *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), and *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.").

But see *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923, 1928 (Fed. Cir. 1994) ("...the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under §1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public.").

Chapter 1200 EX PARTE APPEALS

1208.01 Evidence from NEXIS Database or Publications

Applicant or the trademark examining attorney may submit articles or excerpts from articles taken from periodicals or the NEXIS database as evidence.¹⁶⁷ 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.¹⁶⁸ Accordingly, stories from newswires or foreign publications are of minimal evidentiary value because it is not clear that such stories have appeared in any publication available to the consuming public.¹⁶⁹ Wire service stories are competent to show how their authors used particular terms, but since they are circulated primarily to newspapers, they are not assumed to have influenced the attitudes of prospective customers.¹⁷⁰

It is not necessary that all NEXIS articles retrieved by a search be submitted and, indeed, the Board discourages such submissions where they are unnecessarily redundant or not probative. Examining attorneys should not submit articles or excerpts that are not relevant.¹⁷¹ However,

¹⁶⁷ *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998).

¹⁶⁸ See *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) and *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).

¹⁶⁹ *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 n.7 (TTAB 2001) (newswire stories, presumably unpublished, and stories from foreign publications, not considered); *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); and *In re Wilcher Corp.*, 40 USPQ2d 1929, 1931 (TTAB 1996) (in absence of evidence establishing substantial circulation of foreign publications in U.S., they are not competent to show significance of term to general American public). Compare *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795, 1797 (TTAB 2003) (where the relevant public consisted of highly sophisticated medical doctors and researchers who would have access to news wire stories).

¹⁷⁰ See *In re Organik Technologies Inc.*, 41 USPQ2d 1690, 1691 n.3 (TTAB 1997) (newswire articles given minimal consideration as they are circulated primarily to newspapers whose editors select those stories of sufficient interest to publish; thus, such articles do not prove that the news release appeared as a story in any newspaper or magazine and are evidence only of the opinion of the author). See also *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Couture*, 60 USPQ2d 1317, 1318 n.2 (TTAB 1999); *In re Urbano*, 51 USPQ2d 1776, 1778 n. 3 (TTAB 1999); *In re Manco Inc.*, 24 USPQ2d 1938, 1939 n.4 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917, 1918-19 (TTAB 1986).

Compare *In re Cell Therapeutics, Inc.*, *supra* at 1798 (given that news wire stories are likely to reach the public via the Internet, they now have more probative value than in the past).

¹⁷¹ See *In re Couture*, *supra* (many excerpts were repetitive or used the searched term for services not related to the applicant's); and *In re Lamb-Weston Inc.*, *supra* (articles which bear no relationship to applicant's goods are irrelevant).

Chapter 1200 EX PARTE APPEALS

examining attorneys should not submit only those articles that support the Office's position, and deliberately not submit those which are helpful to the applicant.¹⁷²

If 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.¹⁷³ If only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came.¹⁷⁴ 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 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.¹⁷⁵

1208.02 Third-party Registrations

To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted.¹⁷⁶ Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record.¹⁷⁷ 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 applicant that the listing is insufficient to make the registrations of record at a point when applicant can correct the error, the examining attorney will be deemed to have stipulated the registrations into the record.¹⁷⁸

¹⁷² 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).

¹⁷³ See TBMP § 1207.01 for general rule that evidence submitted after appeal is untimely.

¹⁷⁴ *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986).

¹⁷⁵ *In re Psynosis Ltd.*, 51 USPQ2d 1594, 1597-98 (TTAB 1999).

¹⁷⁶ *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).

¹⁷⁷ *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) and *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).

¹⁷⁸ See *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

Chapter 1200 EX PARTE APPEALS

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.¹⁷⁹

However, the Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registrations numbers and/or marks, the list will have very limited probative value.

An improper listing of third-party registrations will not be considered if the list is submitted at a point where applicant cannot correct the format of the submission if the examining attorney does not discuss the registrations or otherwise treat them as of record.¹⁸⁰

Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed.¹⁸¹

1208.03 Internet Material

Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings.¹⁸² 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.¹⁸³

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. On the other hand, 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

to make them of record); and *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).

¹⁷⁹ See *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, and considered registrations as if they were of record) and *In re Dos Padres Inc.*, *supra* (listings from a commercial trademark search report submitted by applicant during prosecution). See also TBMP § 1207.03 (Evidence Considered Due to Actions of Nonoffering Party).

¹⁸⁰ *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).

¹⁸¹ *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

¹⁸² Compare use in inter partes proceedings, TBMP §§ 704.08 (Printed Publications) and 528.05(e) (Printed Publications and Official records).

¹⁸³ *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

Chapter 1200 EX PARTE APPEALS

not show use of a term or phrase as a heading, link or content on a website. Use in a search summary may indicate only that the two words in an overall phrase appear separately in the website literature.¹⁸⁴

Evidence from on-line dictionaries that do not otherwise appear in printed format must 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.¹⁸⁵ The Board will not take judicial notice of such material.¹⁸⁶

1208.04 Judicial Notice

The Board may take judicial notice of dictionary definitions.¹⁸⁷ Definitions found in slang dictionaries are also appropriate for judicial notice.¹⁸⁸

The Board may also take judicial notice of encyclopedia entries, standard reference works and of commonly known facts.¹⁸⁹

¹⁸⁴ *In re Fitch IBCA, Inc., supra.*

¹⁸⁵ *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) and *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

¹⁸⁶ *See* TBMP § 1208.04 (Judicial Notice).

¹⁸⁷ *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); and *In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 n.6 (TTAB 1997) (definition in *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); and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁸⁸ *In re Wilcher Corp.*, 40 USPQ2d 1929, 1933 n.4 (TTAB 1996).

¹⁸⁹ *See, for example, 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), *rev'd. on other grounds*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (toll-free telephone area codes

Chapter 1200 EX PARTE APPEALS

The Board will not take judicial notice of definitions found only in on-line dictionaries and not available in a printed format; however, it will consider them if made of record during the prosecution of the application.¹⁹⁰ Nor will the Board take judicial notice of third-party registrations or marks.¹⁹¹

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

1209 Remand

1209.01 Upon Board's Own Initiative

37 CFR § 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 examiner for further examination to be completed within thirty days.

(2) If the further examination does not result in an additional ground for refusal of registration, the examiner 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 examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. If the ground for refusal is made final, the examiner 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

such as “1-888” are used by numerous persons and businesses); *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); and *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).

¹⁹⁰ *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) and *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1447 n.3 (TTAB 2000).

¹⁹¹ *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998), *aff’d*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (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); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998); and *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).

Chapter 1200 EX PARTE APPEALS

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 examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall 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 examiner.

(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 trademark examining attorney for further examination with respect to that issue.¹⁹² Thus, the Board will not remand an application for consideration of a ground for refusal if the examining attorney had previously refused registration on that ground and then withdrew the refusal.

The Board may also *sua sponte* remand an application to the examining attorney if, after examination and/or briefing has been completed, a decision is rendered that is likely to have a bearing on the examining attorney's position.¹⁹³ 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 30 days from the date of remand, or within an extension of time for that purpose.¹⁹⁴

¹⁹² See 37 CFR § 2.142(f)(1). See also *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); and Gary D. Krugman, *TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals*, 74 Trademark Rep. 341 (1984). See, in addition, *In re Wella A.G.*, 230 USPQ 77, 79 (TTAB 1986) (but see *In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365, 1369 (Fed. Cir. 1988)).

¹⁹³ 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).

¹⁹⁴ See 37 CFR § 2.142(f)(1).

Chapter 1200 EX PARTE APPEALS

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 ground for refusal of registration.¹⁹⁵

If the examining attorney returns the remanded application to the Board with a written statement that further examination did not result in an additional ground for refusal of registration, the Board will resume proceedings with respect to the appeal, and take further appropriate action therein. 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.¹⁹⁶

If, on the other hand, the further examination does result in an additional ground for refusal of registration, the examining attorney and applicant should proceed as specified in 37 CFR §§ 2.61 through 2.64.¹⁹⁷ If the additional ground for refusal of registration is ultimately made final, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case 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 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.¹⁹⁸

If 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.¹⁹⁹ If applicant files a supplemental brief, the Board will send the application file, with applicant's supplemental brief entered therein, to the examining attorney. Within 60 days after the date of the Board's written action forwarding the file 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.²⁰⁰ The examining attorney must also send a copy of his or her brief to the applicant.²⁰¹ If the examining attorney's brief is late filed, the Board may exclude it in the absence of an adequate

¹⁹⁵ See 37 CFR § 2.142(f)(2). See also *In re Diet Tabs, Inc.*, *supra*.

¹⁹⁶ See *In re Diet Tabs, Inc.*, *supra*.

¹⁹⁷ See 37 CFR § 2.142(f)(3).

¹⁹⁸ See 37 CFR § 2.142(f)(3).

¹⁹⁹ See 37 CFR § 2.142(f)(3).

²⁰⁰ See *In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

²⁰¹ See 37 CFR § 2.142(f)(4).

Chapter 1200 EX PARTE APPEALS

explanation for the late filing.²⁰² 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.²⁰³ However, 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 applicant prior to the remand of the application, but had not yet been held, the oral hearing will be set after the expiration of applicant's time for filing a reply brief directed to the additional ground for refusal of registration.²⁰⁴ If an oral hearing had been held prior to the remand, or had not previously been requested by applicant, an oral hearing may be requested by applicant by separate paper 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.²⁰⁵

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

The examining attorney may not, upon remand under 37 CFR § 2.142(f)(1), refuse registration on a new ground not specified in the Board's remand letter. If the examining attorney, upon remand, wishes to 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 CFR § 2.142(f)(6), for jurisdiction to refuse registration on the new ground. Nor may the examining attorney, upon remand under 37 CFR § 2.142(f)(1), submit evidence relating to a ground not specified in the Board's remand letter.²⁰⁶

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

²⁰² Cf. *In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984), and TBMP § 1203.02(b) (Trademark Examining Attorney's Brief).

²⁰³ See 37 CFR § 2.142(f)(4).

²⁰⁴ See 37 CFR § 2.142(f)(5).

²⁰⁵ See 37 CFR § 2.142(f)(5).

²⁰⁶ 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. See also *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); and *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing).

Chapter 1200 EX PARTE APPEALS

1209.02 Upon Request by Trademark Examining Attorney

37 CFR § 2.142(f)(6) *If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand 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.*

If, during an ex parte appeal to the Board, it appears to the trademark 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.²⁰⁷ 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 appeal brief or supplemental appeal brief.²⁰⁸

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 CFR §§ 2.61 through 2.64.²⁰⁹

When, upon remand, the examining attorney determines that registration should not be finally refused on the additional ground for refusal of registration 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 file of the case to the Board; proceedings with respect to the

²⁰⁷ See 37 CFR § 2.142(f)(6).

²⁰⁸ 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). See also *In re Wells Fargo & Co.*, 231 USPQ 116, 119 (TTAB 1986); *In re Wells Fargo & Co.*, 231 USPQ 95, 101 (TTAB 1986); and *In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227, 228 (TTAB 1986). [NOTE: The latter three cases were decided prior to the adoption of 37 CFR § 2.142(f)(6)].

²⁰⁹ See 37 CFR § 2.142(f)(6). Cf. 37 CFR § 2.142(f)(3).

Chapter 1200 EX PARTE APPEALS

appeal will be resumed and further appropriate action will be taken therein.²¹⁰ If the examining attorney determines, after considering applicant's response to the nonfinal Office action, that a final refusal on that ground should issue, 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 the ground(s) asserted in the previous final action. The file should then be returned to the Board, and proceedings in the appeal will be resumed.²¹¹

The examining attorney may not, upon remand under 37 CFR § 2.142(f)(6), refuse registration on a new ground not mentioned in the examining attorney's request for remand. If the examining attorney, upon remand, wishes to 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 refuse registration on the new ground. Nor may the examining attorney submit evidence that does not relate to the 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.

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 Commissioner for Trademarks, a "letter of protest," that is, a letter that recites the facts and which is accompanied by supporting evidence.²¹² The Administrator for Trademark Identification, Classifications, and Practice ("Administrator") will determine whether the information should be given to the trademark examining attorney for consideration.²¹³

Proceedings in an ex parte appeal will not be suspended pending determination by the Office of the Commissioner for Trademarks 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

²¹⁰ See 37 CFR § 2.142(f)(6).

²¹¹ See *In re Boston Beer Co. L.P.*, *supra*. See also, 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, TBMP § 1209.01 (Remand Upon Board's Own Initiative).

²¹² See TMEP § 1715.

²¹³ See TBMP § 215 (Effect of letter of Protest) and authorities cited therein.

Chapter 1200 EX PARTE APPEALS

written request with the Board, pursuant to 37 CFR § 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 CFR § 2.142(f)(6), and TBMP § 1209.02.

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.²¹⁴ However, 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.

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.²¹⁵ No matter what the purpose, the request for remand must include a showing of good cause.²¹⁶ 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.

If 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 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.²¹⁷

²¹⁴ See TBMP § 1204 (Effect of Request for Reconsideration of Final Action).

²¹⁵ 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 Federal Circuit Court of Appeals).

²¹⁶ See TBMP § 1207.02 for examples of circumstances that have been found to constitute good cause for a remand for the purpose of submitting additional evidence. See TBMP § 1205 for examples of what constitutes good cause for the purpose of amending an application.

²¹⁷ If the request for remand is for the purpose of submitting additional evidence, *see generally*, TBMP § 1207.02. If the request for remand is for the purpose of submitting an amendment to the application, *see generally*, TBMP § 1205.

Chapter 1200 EX PARTE APPEALS

1210 Approval for Publication During Appeal

The trademark 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.²¹⁸ When the examining attorney does so, the appeal becomes moot.

However, the examining attorney should notify the applicant by telephone that the application is being approved for publication (or registration).²¹⁹

1211 Abandonment During Appeal

37 CFR § 2.68 Express abandonment (withdrawal) of application. *An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.*

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.²²⁰

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.²²¹

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

²¹⁸ See TMEP § 1501.03. See also, for example, TBMP §§ 1203.02(b), 1203.02(c), 1204, 1205, and 1207.02.

²¹⁹ See TMEP § 1501.03.

²²⁰ See 37 CFR § 2.68.

²²¹ See 37 CFR § 2.68. See also *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ2d 1264, 1267 (1st Cir. 1987). Cf. (re preclusive effect of prior final judgment arising out of an ex parte case) *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987); and *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987).

Chapter 1200 EX PARTE APPEALS

without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant.²²²

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 the Section 2(d), 15 U.S.C. § 1052(d), ground 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 Section 2(d) of the Act, 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 trademark 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 Section 2(d) of the Act, 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.²²³ If the applicant learns that the registration has expired or been cancelled, the applicant should immediately notify the Board thereof. Similarly, if the registration is assigned to applicant, the applicant should immediately notify the Board thereof.

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 applicant showing good cause for the requested suspension.²²⁴ Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, are listed below:

- (1) 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--Board may suspend pending final determination of the civil action or Board inter partes proceeding.

²²² See 37 CFR § 2.135, and TBMP §§ 602.01 (Withdrawal by Applicant) and 603 (Withdrawal by Interference or Concurrent Use Applicant).

²²³ See TBMP § 1203 (Appeal Briefs).

²²⁴ Cf. 37 CFR § 2.117, and TBMP § 510 (Motion to Suspend; Motion to Resume).

Chapter 1200 EX PARTE APPEALS

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

(3) A registration cited as a reference, under Section 2(d) of the Act, 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 Section 8 or 71 of the Act, 15 U.S.C. §§ 1058 or 1141k,²²⁵ or for an application for renewal under Section 9 or 70 of the Act, 15 U.S.C. §§ 1059 or 1141k.²²⁶ The Board may suspend 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 for ten-year term registrations (registrations that issued or were renewed on or after November 16, 1989), or after the 19th anniversary of the issue date for twenty-year registrations (registrations that issued prior to November 16, 1989 and which have not yet been renewed).

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 (Section 2(d) of the Trademark Act), 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 paper has been submitted, the examining attorney may request remand so the application can be suspended pending final disposition of the cited registration.²²⁷ 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 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 so notify the applicant. If the Section 2(d) refusal is only one of the issues of appeal, the examining attorney should

²²⁵ A 66(a) registration is subject to the Section 71 requirements for affidavits of continued use (or excusable nonuse). A Section 71 affidavit is filed with the Office.

²²⁶ A renewal under Section 70 of the Trademark Act refers to a renewal of the international registration underlying a 66(a) registration. A 66(a) registration will be cancelled under Section 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 U.S. will expire as of the expiration date of the international registration and the 66(a) registration will be cancelled by the Office. *See* Section 70 of the Trademark Act.

²²⁷ *See* TMEP § 716.02(e).

Chapter 1200 EX PARTE APPEALS

notify the Board of the status of the cited registration, and return the file to the Board, which will resume proceedings in the appeal. If an appropriate affidavit or renewal application is filed for the cited registration, the examining attorney should notify the Board, and return the file 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 action 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.

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.²²⁸

A request 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 Section 2(d) of the Act (*i.e.*, a refusal to register on the ground that 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.²²⁹

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 paper notifying the Board thereof as soon as that knowledge comes to applicant's attention. When an appeal has been suspended pending a determination of whether a cited registration will be cancelled or will expire, 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

²²⁸ See TBMP § 1214 (Consolidation).

²²⁹ See *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799, 1800 (Comm'r 1986).

Chapter 1200 EX PARTE APPEALS

appeal will be dismissed as moot. If the cited registration formed only one basis of the refusals on appeal, the Board will resume proceedings in the appeal with respect to the remaining issues.

In addition, when the refusal of registration, or one of the grounds of refusal, is based on Section 2(d) of the Act, 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 *sua sponte* suspend action in the following circumstance. When an ex parte appeal has been assigned to an Administrative Trademark Judge for final decision, the case will be suspended if the due date for filing a 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 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.

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.²³⁰

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 trademark examining attorney or upon its own initiative, may order the consolidation of the cases for purposes of briefing, oral hearing, and/or final decision.²³¹ The Board may also consider two or more cases in one opinion even if they have not been consolidated.²³² Even if the Board renders its decisions on two appeals in a single opinion, the appeals will not necessarily be consolidated.²³³

²³⁰ See TBMP §§ 1202.02; 1203.02(a); 1203.02(b); 1204; 1205; 1206.01; 1207.02; 1207.06; and 1209.

²³¹ See, for example, *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997). See also *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991); *In re Del E. Webb Corp.*, 16 USPQ2d 1232 (TTAB 1990); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987); and *In re Petersen Manufacturing Co.*, 2 USPQ2d 2032 (TTAB 1987). Cf. FRCP 42(a), and TBMP § 511 (Motion to Consolidate). See also *In re Le Sorbet, Inc.*, 228 USPQ 27 (TTAB 1985); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983); *In re 1776, Inc.*, 223 USPQ 186 (TTAB 1984); *In re Canadian Pacific Ltd.*, 222 USPQ 533 (TTAB 1984), *aff'd*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984); and *In re Armour & Co.*, 220 USPQ 76 (TTAB 1983).

²³² *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,

Chapter 1200 EX PARTE APPEALS

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.

1215 Alternative Positions

Just as the trademark 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 Section 2(e)(1) of the Act, 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 applicant's mark, as applied to its goods and/or services, is merely descriptive of them, applicant may take the position that its mark is not merely descriptive, and, alternatively, assert a claim, under the provisions of Section 2(f) of the Act, 15 U.S.C. § 1052(f), that its mark has become distinctive of its goods and/or services in commerce.²³⁴ However, it is applicant's responsibility to make clear that it is taking alternative positions.²³⁵

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).

²³³ *In re Hudson News Co.*, 39 USPQ2d 1914, 1915 n. 5 (TTAB 1996), *aff'd without published opinion* (Fed. Cir. 1997) (Board issued a single opinion in interest of judicial economy, but each appeal stands on its own merits).

²³⁴ *See, for example, In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Seaman & Associates Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Professional Learning Centers, Inc.*, 230 USPQ 70 (TTAB 1986); *In re American Home Products Corp.*, 226 USPQ 327 (TTAB 1985); and TMEP § 1212.02(c). *See also In re Lillian Vernon Corp.*, 225 USPQ 213 (TTAB 1985); *In re Narwood Productions, Inc.*, 223 USPQ 1034 (TTAB 1984); *In re Anania Associates, Inc.*, 223 USPQ 740 (TTAB 1984); *In re Perfect Fit Industries, Inc.*, 223 USPQ 92 (TTAB 1984); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983); and *In re Harrington*, 219 USPQ 854 (TTAB 1983).

Cf. Fed. R. Civ. P. 8(e)(2), and TBMP §§ 309.03 (Substance of Complaint) and 311.02(b) (Affirmative Defenses).

²³⁵ *See In re A La Vielle Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001) (applicant did not assert Section 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).

But see 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

Chapter 1200 EX PARTE APPEALS

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 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 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 in commerce, but applicant is not willing to accept a registration issued under Section 2(f) on the basis of the claim of distinctiveness unless the Board holds, on appeal from the refusal to register, that the mark is merely descriptive, applicant should clearly so state. Otherwise, if the examining attorney finds applicant's claim of 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 applicant will be issued under the provisions of Section 2(f) of the Act.

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 applicant's alternative claims.²³⁶

1216 Oral Hearing

37 CFR § 2.142(e)

(1) If the appellant desires an oral hearing, a request therefor 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 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 his attorney or other authorized representative.

(2) If the appellant requests an oral argument, the examiner who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examiner from the same examining division as designated by the supervisory attorney thereof, 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.

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).

²³⁶ See TMEP § 1212.02(c).

Chapter 1200 EX PARTE APPEALS

(3) Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examiner. 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.²³⁷ If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs.²³⁸ 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 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 trademark 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, by separate paper, not later than 10 days after the due date for applicant's reply brief. Only one copy of such request should be submitted. When the applicant has filed a timely request for an oral hearing, the Board sets the date and time for the hearing, and sends the applicant a notice of hearing specifying the date, time, and location of the hearing. Ordinarily, hearings are scheduled on Tuesdays, Wednesdays and Thursdays. In setting the oral hearing, it is the normal practice of the Board to set a time that is convenient for both the applicant and the examining attorney. Hearings are almost exclusively held at the offices of the Board.²³⁹

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). 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.²⁴⁰ Board practice in such a situation is to reschedule an oral hearing, either by postponing the date or by moving it forward, but, absent compelling circumstances, not to change a hearing date if the request for rescheduling is made within two

²³⁷ See 37 CFR § 2.142(e)(1).

²³⁸ See 37 CFR § 2.142(e)(2).

²³⁹ Videoconferences are available in California and Michigan. *For information on requesting a videoconference, see TBMP § 802.03.*

²⁴⁰ See 37 CFR § 2.142(e)(1).

Chapter 1200 EX PARTE APPEALS

weeks of the scheduled hearing date, unless both the applicant and the examining attorney agree to the change. Therefore, if applicant requires a rescheduling of the oral hearing, it should inform the Board by telephoning the secretary to the Chief Judge, and by a follow-up facsimile transmission, not later than two weeks prior to the scheduled hearing date. If circumstances arise that prevent applicant from providing such notice, applicant should inform the Board as soon as the circumstances become known. Although the Board will allow the cancellation of the oral hearing by the applicant at any point, the Board will consider the circumstances in determining whether it will grant a request by applicant to reschedule the oral hearing, or whether it will decide the case on briefs without oral hearing.²⁴¹

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 from the same USPTO law office who has been designated for the purpose by the managing attorney of that law office, must appear at the hearing and present an oral argument.²⁴² If the examining attorney requires a rescheduling of the oral hearing, he or she should advise the secretary to the Chief Judge of the Board, by telephone and e-mail, 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 the managing attorney of the law office 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.²⁴³ 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.²⁴⁴ If the request is granted, the examining attorney will also be allowed additional time.

²⁴¹ 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).

²⁴² See 37 CFR § 2.142(e)(2).

²⁴³ See 37 CFR § 2.142(e)(3).

²⁴⁴ Cf. 37 CFR § 2.129(a), and TBMP § 802.05 (Length of Oral Argument).

Chapter 1200 EX PARTE APPEALS

For information concerning audiotaping, visual aids, videoconferencing and the nature of an oral hearing before the Board, see TBMP §§ 802.06, 802.07, 802.03 and 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.²⁴⁵

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 trademark 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.²⁴⁶ Thus, 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,²⁴⁷ 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.²⁴⁸

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.²⁴⁹ 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 CFR § 2.142(g), as discussed below.²⁵⁰ That is, while

²⁴⁵ *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).

²⁴⁶ *See In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); and *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); and *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426, 428 (CCPA 1975).

²⁴⁷ *See* TBMP § 1209 (Remand).

²⁴⁸ *See In re D.B. Kaplan Delicatessen, supra.*

²⁴⁹ *See, for example, In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 397 n.2 (TTAB 1982); and TMEP § 1501.06.

²⁵⁰ *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) and *In re Mercedes Slacks, Ltd., supra.*

Chapter 1200 EX PARTE APPEALS

the Board, in its final decision in an opposition, concurrent use, or interference proceeding, may include a remand of the application (except a 66(a) application)²⁵¹ 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 case²⁵² 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.²⁵³ 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).²⁵⁴

1218 Reopening (Amendment, etc., After Final Decision)

37 CFR § 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 § 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.²⁵⁵ 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.²⁵⁶ They are as follows:

²⁵¹ A 66(a) application may not be remanded under 37 CFR § 2.131.

²⁵² See 37 CFR § 2.131 and TBMP § 515 (Motion to Remand).

²⁵³ See 37 CFR § 2.142(f)(1) and TBMP § 1209.01 (Remand Upon Board's Own Initiative).

²⁵⁴ See *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, 1037 n.1 (TTAB 1984); and *In re Wallyball, Inc.*, 222 USPQ 87, 88 n.2 (TTAB 1984).

²⁵⁵ See TBMP § 1219 (Review of Final Decision).

²⁵⁶ See 37 CFR § 2.142(g); *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

Chapter 1200 EX PARTE APPEALS

(1) The application may be reopened by the Board for entry of a disclaimer under Section 6 of the Act, 15 U.S.C. § 1056,²⁵⁷ 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.²⁵⁸

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.²⁵⁹

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

²⁵⁷ See 37 CFR § 2.142(g); *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); and *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).

²⁵⁸ See 37 CFR § 2.142(g); *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 denies request to reopen application, after final decision, for amendment to Supplemental Register, quoting 37 CFR § 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); and *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); and TMEP § 1501.06.

²⁵⁹ See *In re Lowrance Electronics Inc.*, 14 USPQ2d 1251, 1251 (TTAB 1989).

Chapter 1200
EX PARTE APPEALS

1219 Review of Final Decision

1219.01 By Request for Reconsideration

37 CFR § 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 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.²⁶⁰

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the trademark examining attorney.²⁶¹ 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.²⁶²

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 two months after action on the request.²⁶³

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

²⁶⁰ See 37 CFR § 2.144.

²⁶¹ See *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); and TMEP § 1501.07

²⁶² See *In re Ferrero S.p.A.*, *supra* at 24 USPQ2d 1062 n.1.

²⁶³ See 37 CFR § 2.145(d)(1).

Chapter 1200
EX PARTE APPEALS

United States Court of Appeals for the Federal Circuit, or by way of a civil action for review of the decision of the Board.²⁶⁴

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

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.²⁶⁵

²⁶⁴ Section 21 of the Act, 15 U.S.C. § 1071, and 37 CFR § 2.145.

²⁶⁵ See TBMP § 1218 (Reopening).