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1201 Propriety of Appeal

1201.01 Readiness of Case for Appeal

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 §2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Commissioner 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 Commissioner (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 Commissioner. 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 Commissioner 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 Commissioner if permitted by §2.63(b).*

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

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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. *See* Section 12(b) of the Act; 37 CFR §2.64(a); and TMEP §1105.03. 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 a compliance with any requirement, or to a petition to the Commissioner if a petition is permitted by 37 CFR §2.63(b). *See* 37 CFR §2.64(a), and TMEP §1105.04(g). *See also* Section 20 of the Act, 15 U.S.C. §1070, and TMEP §1501. An applicant may consider a second refusal on the same ground(s), or a repeated requirement, as final for purposes of appeal. *See* 37 CFR §2.141; TMEP §1502; *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053 (TTAB 1991); and *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985).

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. *See* Section 20 of the Act; 37 CFR §§2.64(a) and 2.141; TMEP §1501; *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053 (TTAB 1991); and *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985). *But see* TBMP §§1201.02 and 1201.03.

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 Commissioner that the delay in responding was unavoidable, 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

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not be made final in a first action. *See* Section 12(b) of the Act, 15 U.S.C. §1062(b); 37 CFR §2.64(a); and TMEP §1105.04(a).

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. *See* TMEP §1105.04(a). *See also In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152 (TTAB 1992), and *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). Moreover, a final action should not be issued until all matters but for those which 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. *See In re Variable Speech Control Co.*, 209 USPQ 431 (TTAB 1980), and TMEP §1105.04(c). *See also In re Moore Business Forms Inc.*, 24 USPQ2d 1638 (TTAB 1992) (ground for refusal first raised in Examining Attorney's appeal brief given no consideration). As stated in TMEP §1105.04(c),

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 subsequent action, a repeated refusal or requirement may not be made final.

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 and by petition to the Commissioner. *See* TMEP §1105.04(e).

The prematureness of a final action is not a ground for appeal to the Board. *See* TMEP §1105.04(e). 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 suspend action with respect to the appeal and remand the case to the Examining Attorney with appropriate instructions. The instructions in the remand letter generally are to the effect that the finality of the Examining Attorney's action should be withdrawn; that a new nonfinal action should be issued; 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 appeal will be moot; and that if the Examining Attorney ultimately issues a new final action, no six-month response clause should be included therein, and the case should be returned to the

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Board for resumption of action with respect to the appeal. *See In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986), and *In re Variable Speech Control Co.*, 209 USPQ 431 (TTAB 1980) (NOTE: a possible alternative approach, suggested in the latter case for use in situations where informalities which are not the subject of the appeal have not been resolved, 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 because (1) present 37 CFR §2.142(c), adopted thereafter, provides that all requirements made by the examiner 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 Hamilton Bank*, 222 USPQ 174 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982); and TBMP §1217).

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. *See* TBMP §1201.01, and authorities cited therein.

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 remand the application to the Trademark Examining Attorney for further appropriate action. In the event that a final action, or a second refusal on the same ground(s) or a repeated requirement, is ultimately issued by the Examining Attorney, 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

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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 which have been made by the Trademark Examining Attorney, but which are not the subject of appeal. If an applicant which 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 which are the subject of appeal. See 37 CFR §2.142(c); *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990); *In re Cord Crafts Inc.*, 11 USPQ2d 1157 (TTAB 1989); *In re Riddle*, 225 USPQ 630 (TTAB 1985); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371 (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 (TTAB 1985), and *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985).

1201.05 Appeal Versus Petition

37 CFR §2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Commissioner 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 Commissioner (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 Commissioner. 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 Commissioner 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 Commissioner if permitted by §2.63(b).*

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37 CFR §2.146(a) *Petition may be taken to the Commissioner: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Commissioner; (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

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

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 Commissioner, or by either appeal or petition. The following discussion contains general guidelines for determining whether a matter is appealable or petitionable.

An appeal to the Board may be taken from any final action, second refusal to register on the same ground(s), or repeated requirement issued by the 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 Commissioner may not thereafter be the subject of an appeal to the Board. *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 (Comm'r 1986); and TBMP §1201.01.

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)--*see* TBMP §1201.01), but not for petition to the Commissioner. *See* 37 CFR §2.146(b); *In re Mission*

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Pharmacal Co., Inc., 33 USPQ2d 1060 (Comm'r 1993); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r 1993); *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r 1990); *In re Hart*, 199 USPQ 585 (Comm'r 1978); and *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r 1978).

Nevertheless, a wide variety of matters are petitionable. Petition may be taken to the Commissioner 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 Commissioner (*see, in this regard*, 37 CFR §2.146(b), and the preceding paragraph), or (ii) the Examining Attorney's action is made final and is limited to subject matter appropriate for petition to the Commissioner. *See* 37 CFR §§2.63(b) and 2.146(a)(1). If the petition is denied, the applicant will have six months from the date of the Office action which repeated the requirement or made it final, or 30 days from the date of the Commissioner's decision on the petition, whichever is later, to comply with the requirement. A formal requirement which was the subject of a petition to the Commissioner may not thereafter be the subject of an appeal to the Board. *See* 37 CFR §2.63(b). *See also In re Pony International Inc.*, 1 USPQ2d 1076 (Comm'r 1986).

(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 Commissioner. *See* 37 CFR §2.146(a)(2). Insofar as applications for registration are concerned, this includes petitions to make special (i.e., to advance an application out of its normal order of examination), petitions to revive an abandoned application, petitions to record a document in the Assignment Branch of the PTO, and petitions requesting that an interference be declared. *See* TMEP §§1702 and 1703.

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. *See* 37 CFR §2.146(a)(3). Under this provision, an applicant generally may petition to the Commissioner 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. *See, for example, In re Mission Pharmacal Co., Inc.*, 33 USPQ2d 1060 (Comm'r 1993); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r 1993); *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r 1990); *In re Hart*, 199 USPQ 585 (Comm'r 1978); and *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r

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1978); and TMEP §§1702 and 1703. For further information concerning the matters which are petitionable under this provision, *see* TMEP §§1702 and 1703.

(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). *See* 37 CFR §2.146(a)(4). Under this provision, an applicant may petition the Commissioner with respect to any situation, not covered by the rules, from which applicant seeks relief. *See* TMEP §1702.

(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. *See* 37 CFR §2.146(a)(5). For information concerning the meaning of the words "extraordinary situation," *see* TMEP §1702.

However, petition may not be taken to the Commissioner 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 Commissioner (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). *See* 37 CFR §§2.63(b), 2.64(a), 2.146(a), and 2.146(b); *In re Tetrafluor Inc.*, 17 USPQ2d 1160 (Comm'r 1990); *In re Hart*, 199 USPQ 585 (Comm'r 1978); *In re Stenographic Machines, Inc.*, 199 USPQ 313 (Comm'r 1978); and TMEP §1702.

For examples of matters which are appealable and those which are petitionable, *see* TMEP §1501.01.

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.*

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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 and paying the appeal fee.*

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 timely (*see* TBMP §1202.02) filing in the PTO both a notice of appeal *and* the prescribed appeal fee (*see* 37 CFR §2.6(a)(18) and TBMP §1202.04). *See* Section 20 of the Act, 15 U.S.C. §1070; 37 CFR §§2.141 and 2.142(a); and TMEP §1501. If the notice of appeal *and* fee are not timely filed, the application will be deemed to have been abandoned, and the appeal cannot be entertained by the Board unless applicant successfully petitions the Commissioner to revive the application. *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 §§1112.02, 1112.05(a), and 1112.05(b) *et seq.*

All requirements which 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. *See* 37 CFR §2.142(c). If an applicant which 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 which are the subject of appeal. *See* TBMP §1201.04, and authorities cited therein.

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 the subject of a petition decided by the

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Commissioner may not thereafter be the subject of an appeal to the Board. *See* TBMP §§1201.01 and 1201.05, and authorities cited therein.

An appeal to the Board must be filed within six months from the date of the action from which the appeal is taken. *See* Section 12(b) of the Act, 15 U.S.C. §1062, and 37 CFR §2.142(a). If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. *See* TBMP §1202.01, and authorities cited therein.

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. *See* 37 CFR §1.6(d)(8), and TBMP §107. The certificate of mailing and certificate of transmission procedures described in 37 CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for the filing of an appeal to the Board. *See* 37 CFR §§1.8(a) and 1.10(a), and TBMP §§110 and 111.

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. *See* 37 CFR §2.64(b). *See also* TMEP §§1105.04(f) and 1110, 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). However, the filing of a request for reconsideration will *not* serve to stay the time for filing an appeal (or for petitioning the Commissioner, if appropriate--*see* 37 CFR §§2.63(b) and 2.64(a), and TBMP §1201.05). *See* 37 CFR §2.64(b), and TMEP §1110. If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response (*see* 37 CFR §2.64(a), and TMEP §1105.04(g)) to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. *See* 37 CFR §§2.64 and 2.142(a), and TMEP §1105.04(f). Thus, if an applicant which has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant 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

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application to the Examining Attorney for appropriate action with respect to the paper that was timely filed.

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.

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. *Cf.* 37 CFR §2.119(e), and TBMP §106.02. The same is true of other unsigned papers filed in an application during an ex parte appeal to the Board.

For further information concerning signature of papers, *see* TBMP §106.02.

The Board prefers that a notice of appeal be submitted in typewritten or printed form, double spaced. A notice of appeal may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended. *See* TBMP §106.03. *Cf.* 37 CFR §2.31.

The PTO has no printed form for use in filing a notice of appeal. However, as an aid to applicants, the PTO 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 is shown below:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EX PARTE APPEALS

.....
(Name of applicant)

.....
(Serial Number of application)

.....
(Filing date of application)

.....
(Mark)

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.(1)

By.....
(Signature)(2)

.....
(Identification of person signing)(3)

FOOTNOTES

- (1) The required fee must be submitted for each class for which an appeal is taken. If an appeal is taken for fewer than the total number of classes in the application, the classes in which the appeal is taken should be specified.
- (2) The notice of appeal may be signed by the applicant or by the applicant's attorney or other authorized representative. If an applicant signing for itself is a partnership, the signature must be made by a partner; if an applicant signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.
- (3) State the capacity in which the signing individual signs, e.g., attorney for applicant, applicant (if applicant is an individual), partner of applicant (if applicant is a partnership), officer of applicant identified by title (if applicant is a corporation), etc.

1202.04 Appeal Fee

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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 or in connection with a petition for cancellation 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 PTO both a notice of appeal *and* the prescribed appeal fee. If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. See TBMP §1202.01, and authorities cited therein.

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 services (*see* 37 CFR §2.86(b)), the required fee must be paid for each class in which appeal is taken. *See* 37 CFR §2.6(a)(18). 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. *See* 37 CFR §2.141, and TMEP §1113.05(a).

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

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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. *See* 37 CFR §§2.85(e) and 2.141, and TMEP §§1113.05(a) and 1501.04.

1203 Appeal Briefs

1203.01 Form of Brief

37 CFR §2.142(b)(2) Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety.

A brief filed in an ex parte appeal to the Board should conform to the requirements of 37 CFR §2.142(b)(2). Only one copy of the brief need be submitted.

The brief should bear a title indicating that it is an appeal brief, as well as 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. *Cf.* TMEP §702.

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

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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. If no brief is filed, the appeal will be dismissed. *See* 37 CFR §2.142(b)(1). 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.

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 §1.8, 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 PTO will be used for all other purposes, including the running of the time for filing applicant's main brief. *See* 37 CFR §1.8(a).

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. If, upon the Examining Attorney's consideration of the request, 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), 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. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or for registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant.

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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. *See* 37 CFR §2.142(b)(1); *In re Wells Fargo & Co.*, 231 USPQ 106 (TTAB 1986); *In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188 (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 (TTAB 1985). The Examining Attorney must also mail a copy of his or her brief to the applicant. *See* 37 CFR §2.142(b)(1). *See also In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993). If the Examining Attorney's brief is late filed, it may be excluded by the Board in the absence of an adequate explanation for the late filing. *See In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, supra.*

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. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney must also notify the applicant, in writing. *See* TMEP §1501.03.

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. *See* TMEP §1501.02. *See also In re Moore Business Forms Inc.*, 24 USPQ2d 1638 (TTAB 1992) (ground for refusal first raised in Examining Attorney's appeal brief given no consideration). For information concerning

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requests for remand, *see* TBMP §1209 and TMEP §1504.05(a). If the request is denied, the Board will reset the Examining Attorney's time in which to file an appeal brief. *See In re Miller Brewing Co.*, 226 USPQ 666 (TTAB 1985). If the request is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the Examining Attorney for further examination in accordance with the request for remand. If, during the course of the further examination, the application is ultimately approved for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. If the Examining Attorney refuses registration on a new ground, or makes a new requirement, and the new refusal or requirement is ultimately made final, the new final action should not include a six-month response clause; the application should be returned to the Board; and the Board will resume proceedings with respect to the appeal and allow 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. *See* 37 CFR §2.142(b)(1); *In re Gena Laboratories, Inc.*, 230 USPQ 382 (TTAB 1985); and *In re Randall & Hustedt*, 226 USPQ 1031 (TTAB 1985). *Cf. In re Gale Hayman Inc.*, 15 USPQ2d 1478 (TTAB 1990). However, the filing of a reply brief is not mandatory.

If the applicant files a reply brief, a copy thereof will be forwarded by the Board to 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. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney must also notify the applicant, in writing. *See* TMEP §1501.03.

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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. *See* TMEP §1501.02(a).

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

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. *See* 37 CFR §2.64(b). *See also* TMEP §§1105.04(f) and 1110, 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). However, the filing of a request for reconsideration will *not* serve to stay the time for filing an appeal (or for petitioning the Commissioner, if appropriate--*see* 37 CFR §§2.63(b) and 2.64(a), and TBMP §1201.05). *See* 37 CFR §2.64(b), and TMEP §1110. If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response (*see* 37 CFR §2.64(a), and TMEP §1105.04(g)) to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. *See* 37 CFR §§2.64 and 2.142(a), and TMEP §1105.04(f). Thus, if an applicant which has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant 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

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an appeal, the request for reconsideration should be made by separate paper and should specify the reasons why applicant believes reconsideration is warranted. The request for reconsideration should not be combined with the applicant's appeal brief. *See In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984).

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. For information concerning the actions which an Examining Attorney may take in response to a request for reconsideration of a final action, *see* TMEP §1110. *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992). 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.

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 Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant. If, upon the Examining Attorney's consideration of the request, 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), 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 an appeal is late filed, but applicant timely filed a 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

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forwarding the application to the Examining Attorney for consideration of the request for reconsideration.

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. *See* 37 CFR §2.142(d). *See also* TBMP §1207. However, evidence submitted with a timely request for reconsideration of an appealed action, that is, a request filed during the six-month response period following issuance of the appealed action, is considered by the Board to have been filed prior to appeal, even if the notice of appeal was, in fact, filed earlier in the six-month response period than the request for reconsideration. *See* 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 Corning Glass Works*, 229 USPQ 65 (TTAB 1985), and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984).

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.

1205 Amendment of Application During Appeal

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 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. The Board will acknowledge receipt of the amendment and appeal, suspend further proceedings (including applicant's time for filing its appeal brief) 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

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further actions which may and/or should be taken by the Examining Attorney in conjunction with the Examining Attorney's consideration of the amendment. For information concerning the actions which may be taken by the Examining Attorney upon consideration of the amendment, *see* TMEP §1110. *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992); *In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152 (TTAB 1992); and *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). 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 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, and the request is granted.

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. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant.

If the Examining Attorney, after consideration of the amendment filed after appeal, 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 applicant will be allowed time in which to file its appeal brief.

If an applicant which 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 normally 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 which may and/or should be taken by the Examining Attorney in conjunction with the Examining Attorney's consideration of the amendment. However, remand in an *ex parte* appeal is a matter of discretion with the Board, and the Board may refuse to remand for

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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 late appeal cannot be entertained by the Board; and forwarding the application to the Examining Attorney for appropriate action with respect to the amendment.

An application which has been considered and decided on appeal may be amended, if at all, only in accordance with 37 CFR §2.142(g). For further information concerning amendment after decision on appeal, *see* TBMP §1218, and TMEP §1501.05.

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). *See* 37 CFR §2.76(a), and "*Wavier [sic] of Trademark Rule 2.76(a)*," 1156 TMOG 12 (November 2, 1993). *See also In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm'r 1991).

Thus, an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely, even if the amendment to allege use was filed after the expiration of the six-month response period following issuance of the appealed

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final action. *See "Wavier [sic] of Trademark Rule 2.76(a)," 1156 TMOG 12 (November 2, 1993).*

If an applicant which 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, 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. *See, in this regard, TBMP §1205.* For information concerning examination by the Examining Attorney of an amendment to allege use filed in conjunction with a notice of appeal, *see TMEP §1105.05(a)(i).* 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. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), or has become abandoned, so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant, by telephone. 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. *See TMEP §1105.05(a)(i).*

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. *See "Wavier [sic] of Trademark Rule 2.76(a)," 1156*

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TMOG 12 (November 2, 1993). If the final determination of the appeal is adverse to applicant, the amendment to allege use will be moot.

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). *See* 37 CFR §2.88(a).

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. *See* Section 13(b)(2) of the Act, and 37 CFR §2.81(b). *See also* TMEP §1105.05(e)(i) and TBMP §219.

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. *See* 37 CFR §2.88(a). *See also* TMEP §1105.05(e)(i). Instead, the premature statement of use will be returned to applicant after action has been taken to refund the fee submitted with the paper.

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.*

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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. *See* 37 CFR §2.142(d). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987); *In re Gold's Gym Enterprises Inc.*, 3 USPQ2d 1716 (TTAB 1987); *In re International Environmental Corp.*, 230 USPQ 688 (TTAB 1986); *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); *In re Pierre Fabre S.A.*, 221 USPQ 1210 (TTAB 1984); *In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983); *In re Gagliardi Bros., Inc.*, 218 USPQ 181 (TTAB 1983); and *In re Royal Viking Line A/S*, 216 USPQ 795 (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).

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. *See* 37 CFR §2.142(d). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); *In re Consolidated Foods Corp.*, 218 USPQ 184 (TTAB 1983); and *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982).

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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. *See In re Johanna Farms, Inc.*, 223 USPQ 459 (TTAB 1984), and *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984). 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. *See In re Big Wrangler Steak House, Inc.*, 230 USPQ 634 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); and *In re Historic Wharf's Associates, Inc.*, 222 USPQ 92 (TTAB 1984). Examples of circumstances which have been found to constitute good cause for a remand for additional evidence include the following:

- (1) The evidence was not previously available.
- (2) A new attorney for the applicant, or a new Examining Attorney, has taken over the case and wishes to supplement the evidence of record. (The transfer of a case from one firm member to another is not considered by the Board to constitute good cause for a remand under the "new attorney" rationale.)
- (3) The applicant and Examining Attorney have agreed to the remand. *See In re Pennzoil Products Co.*, 20 USPQ2d 1753 (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).

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) (*see, for example, In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985), and *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *cf. In re Mastic Inc.*, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987)), 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. *See In re Northland Aluminum Products, Inc.*, 221 USPQ 1110 (TTAB

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1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). *Cf. In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983).

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 notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant. 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 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.

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 until a specified 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.

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1207.03 Evidence Considered Due to Actions of Nonoffering Party

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence (*see* TBMP §1207.02), may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, *and* (2) discusses the new evidence or otherwise affirmatively treats it as being of record. *See, for example, In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); *In re Nuclear Research Corp.*, 16 USPQ2d 1316 (TTAB 1990); *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989); *In re Pencils Inc.*, 9 USPQ2d 1410 (TTAB 1988); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986); *In re Weather Channel, Inc.*, 229 USPQ 854 (TTAB 1985); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938 (TTAB 1985); *In re Bee Pollen From England Ltd.*, 219 USPQ 163 (TTAB 1983); *In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983); 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). In such a situation, evidence submitted by the nonoffering party to rebut the untimely evidence may be considered by the Board. *See In re Development Dimensions International, Inc., supra.* *Cf. In re Northland Aluminum Products, Inc.*, 221 USPQ 1110 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

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. *See* TBMP §1204, and authorities cited therein.

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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.

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) 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 of the applicant unregistrable), *and* (2) the Examining Attorney, upon remand, does, in fact, issue a new refusal to register or requirement. *See In re Bank America Corp.*, 229 USPQ 852 (TTAB 1986). If no new refusal or requirement is made, and the file is instead returned by the Examining Attorney to the Board, no additional evidence may be submitted. *See In re Diet Tabs, Inc.*, 231 USPQ 587 (TTAB 1986).

1207.06 Letter of Protest Evidence

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the PTO by filing, with the Director of the Trademark Examining Groups, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. The Director will determine whether the information should be given to the Trademark Examining Attorney for consideration. *See TBMP* §215, and authorities cited therein.

Proceedings in an ex parte appeal will not be suspended pending determination by the Director 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

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

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

1208 Treatment of Evidence

The Board generally takes a somewhat more permissive stance with respect to the introduction and evaluation 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 technical requirements for the introduction of 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. *See In re Murphy Door Bed Co.*, 223 USPQ 1030 (TTAB 1984); *In re Pillsbury Co.*, 174 USPQ 318 (TTAB 1972); 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).

For example, the affidavit or 37 CFR §2.20 declaration is an established method for the introduction of evidence in an *ex parte* proceeding. *See, for example*, 37 CFR §2.41(b); *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992); *In re Bauhaus Designs Canada Ltd.*, 12 USPQ2d 2001 (TTAB 1989); *In re Motorola, Inc.*, 3 USPQ2d 1142 (TTAB 1986); *In re Peterson Manufacturing Co.*, 229 USPQ 466 (TTAB 1986); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985); and *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984). 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. *See* 37 CFR §2.123(b), and TBMP §713.02 and cases cited therein.

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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 In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988) (Court, being mindful that the PTO 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 (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.").

1209 Remand for New Refusal or New Requirement

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 supplemental

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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. *See* 37 CFR §2.142(f)(1). *See also In re United States Tobacco Co.*, 1 USPQ2d 1502, 1505 (TTAB 1986) (rule comes into play only where a possible ground of refusal not previously raised is discovered by the Board); *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 also In re Wella A.G.*, 230 USPQ 77 (TTAB 1986) (*but see In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988)). The further examination must be completed within 30 days from the date of remand, or within an extension of time for that purpose. *See* 37 CFR §2.142(f)(1).

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. *See* 37 CFR §2.142(f)(2). *See also In re Diet Tabs, Inc.*, 231 USPQ 587 (TTAB 1986).

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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 which were the subject of the appeal; no consideration will be given to the issue which was the subject of the remand. *See In re Diet Tabs, Inc.*, 231 USPQ 587 (TTAB 1986).

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. *See* 37 CFR §2.142(f)(3). 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. *See* 37 CFR §2.142(f)(3).

If applicant fails to file a supplemental brief within the specified 60-day period, or during an extension of time for the purpose, the appeal may be dismissed. *See* 37 CFR §2.142(f)(3). 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 the purpose, the Examining Attorney must file a written brief answering the supplemental brief of the applicant. The Examining Attorney must also mail a copy of his or her brief to the applicant. *See* 37 CFR §2.142(f)(4). If the Examining Attorney's brief is late filed, it may be excluded by the Board in the absence of an adequate explanation for the late filing. *Cf. In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188 (TTAB 1984), and TBMP §1203.02(b). Within 20 days from the mailing 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. *See* 37 CFR §2.142(f)(4). However, the filing of a reply brief is not mandatory. If the applicant files a reply brief, a copy thereof will be forwarded by the Board to the Examining Attorney.

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

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after the expiration of applicant's time for filing a reply brief directed to the additional ground for refusal of registration. *See* 37 CFR §2.142(f)(5). 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. *See* 37 CFR §2.142(f)(5).

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.

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

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

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applicant unregistrable, the Examining Attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. *See* 37 CFR §2.142(f)(6). *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 cited cases were decided prior to the adoption of 37 CFR §2.142(f)(6)).

If the Examining Attorney's request for remand is granted, the application will be forwarded by the Board 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. *See* 37 CFR §2.142(f)(6). *Cf.* 37 CFR §2.142(f)(3).

When, upon remand, the Examining Attorney either determines that registration should not be finally refused on the additional ground for refusal of registration mentioned in the request for remand, or issues a final refusal to register on that ground, 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. *See* 37 CFR §2.142(f)(6). *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.

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.

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

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A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the PTO by filing, with the Director of the Trademark Examining Groups, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. The Director will determine whether the information should be given to the Trademark Examining Attorney for consideration. *See* TBMP §215, and authorities cited therein.

Proceedings in an ex parte appeal will not be suspended pending determination by the Director of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the Examining Attorney, having considered the supporting evidence submitted with the letter of protest, believes that an issue not involved in the appeal may render the mark of the applicant unregistrable, the Examining Attorney may file a written request with the Board, pursuant to 37 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.

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. *See* TMEP §1501.03. *See also, for example,* TBMP §§1203.02(b), 1203.02(c), 1204, 1205, and 1207.02. When the Examining Attorney does so, the appeal becomes moot.

However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant. *See* TMEP §1501.03.

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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 PTO 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. *See* 37 CFR §2.68.

The express abandonment, during an ex parte appeal to the Board, of the applicant's involved application will not, in any proceeding in the PTO, affect any rights that the applicant may have in the mark which is the subject of the abandoned application. *See* 37 CFR §2.68. *See also Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ2d 1264 (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*, *Vesper Corp. v. Lukens Inc.*, 831 F.2d 306 (Fed. Cir. 1987).

In contrast, after the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of its involved application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. *See* 37 CFR §2.135, and TBMP §§602.01 and 603.

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 PTO

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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. 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. *Cf.* 37 CFR §2.117, and TBMP §510. Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, are listed below:

(1) Applicant is involved in a civil action, or a Board inter partes proceeding, which 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.

(2) Another application which 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 of the Act, 15 U.S.C. §1058, or for an application for renewal under Section 9 of the Act, 15

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U.S.C. §1059--Board may suspend pending determination of whether registration will continue in existence or will, instead, be cancelled under Section 8 or expire under Section 9.

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

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 and requesting that further appropriate action be taken in the appeal.

Proceedings in an ex parte appeal may also be suspended by the Board during remand to the Examining Attorney, as, for example, during remand 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. *See* TBMP §§1202.02; 1203.02(a); 1203.02(b); 1204; 1205; 1206.01; 1207.02; 1207.06; and 1209.

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. *See, for example, 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); *In re Petersen*

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Manufacturing Co., 2 USPQ2d 2032 (TTAB 1987); *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). Cf. FRCP 42(a), and TBMP §511.

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. *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); *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); *In re*

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Harrington, 219 USPQ 854 (TTAB 1983), and TMEP §1212.02(c). Cf. FRCP 8(e)(2), and TBMP §§312.03 and 318.02(b).

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 which 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. See TMEP §1212.02(c).

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.*

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(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.

(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. See 37 CFR §2.142(e)(1). If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs. See 37 CFR §2.142(e)(2). An oral hearing is particularly useful in ex parte cases involving complex issues, 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 therefor, by separate paper, not later than 10 days after the due date for the applicant's reply brief. When a proper request for an oral hearing has been filed by the applicant, 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. The hearing will be set for a time which is convenient for both the applicant and the Examining Attorney, and will be held at the offices of the Board, before at least three Board members (i.e., 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. See 37 CFR §2.142(e)(1).

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

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from the same PTO 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. *See* 37 CFR §2.142(e)(2).

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. *See* 37 CFR §2.142(e)(3). 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. *Cf.* 37 CFR §2.129(a), and TBMP §802.05. If the request is granted, the Examining Attorney will also be allowed additional time.

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

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. *See In re AFG Industries Inc.*, 17 USPQ2d 1162 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566 (TTAB 1985); and *In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985). *Cf. Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976); and *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426 (CCPA 1975). 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 (*see* TBMP §1209), the Examining Attorney is not precluded from raising, during appeal, new arguments and/or additional case

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citations in support of a ground for refusal which was timely raised and is a subject of the appeal. *See In re D.B. Kaplan Delicatessen, supra.*

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. *See, for example, In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982); and TMEP §1501.05. 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 which has been considered and decided on appeal to the Board may be reopened only as provided in 37 CFR §2.142(g). *See In re Johanna Farms, Inc.*, 223 USPQ 459 (TTAB 1984), and *In re Mercedes Slacks, Ltd., supra.* That is, while the Board, in its final decision in an opposition, concurrent use, or interference proceeding, may include a remand to the Examining Attorney for further examination with respect to a matter which appears to render the mark of an applicant unregistrable but which was not tried under the pleadings in the case (*see* 37 CFR §2.131, and TBMP §515), 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. *See* 37 CFR §2.142(f)(1), and TBMP §1209.01. Alternatively, if the issue not previously raised is an application defect which 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). *See In re Lativ Systems, Inc.*, 223 USPQ 1037 (TTAB 1984), and *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984).

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 section 6 of the Act of 1946 or upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.*

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Once an application has been considered and decided by the Board on appeal, applicant's course of action normally is limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom (either by way of an appeal to the Court of Appeals for the Federal Circuit, or by way of a civil action seeking review of the Board's decision). *See* TBMP §1219. An application may not be "reopened," that is, an applicant may not amend its application, or submit additional evidence, at this stage, except in two very limited situations. *See* 37 CFR §2.142(g); *In re Hines*, 32 USPQ2d 1376 (TTAB 1994); and *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986). They are as follows:

(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. *See* 37 CFR §2.142(g); *In re Petite Suites Inc.*, 21 USPQ2d 1708 (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 (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); and

(2) The application may be reopened upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated. *See* 37 CFR §2.142(g); *In re Vycom Electronics Ltd.*, 21 USPQ2d 1799 (Comm'r 1986) (petition to reopen to allow applicant to file and litigate petition to cancel cited registration denied); *In re Vesper Corp.*, 8 USPQ2d 1788 (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 Trademark Examining Attorney would be required); *In re Taverniti, SARL*, 228 USPQ 975 (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 to reopen); *In re Taverniti, SARL*, 225 USPQ 1263 (TTAB 1985) (it has been practice of the Commissioner to refuse to reopen, after final decision, for amendment to the Supplemental Register); *In re Johanna Farms, Inc.*, 223 USPQ 459 (TTAB 1984) (Board has no jurisdiction to remand an application, after final decision, for submission of new evidence; only Commissioner has authority, after final decision, to remand for the purpose of reopening the application); *In re S. D. Fabrics, Inc.*, 223 USPQ 56 (TTAB 1984) (Board cannot accept an amendment to the Supplemental Register after a case has been decided on appeal; such an amendment may be accepted only by the Commissioner 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 (TTAB 1983) (Board denies request to reopen application, after final decision, for amendment to

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Supplemental Register, quoting 37 CFR §2.142(g)); *In re Mack Trucks, Inc.*, 189 USPQ 642 (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); *In re Hickory Manufacturing Co.*, 183 USPQ 789 (Comm'r 1974) (petition to reopen for disclaimer granted because subject only to updating search, mark would be ready for publication upon entry of disclaimer; no other examination by the Examining Attorney would be required--NOTE: this petition was filed under an earlier version of what is now 37 CFR §2.142(g); the earlier version did not provide for reopening by the Board for a disclaimer); and *Ex parte Simoniz Co.*, 161 USPQ 365 (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 §1501.05.

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence. *See In re Lowrance Electronics Inc.*, 14 USPQ2d 1251 (TTAB 1989).

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 §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.

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An applicant which 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 request must be filed by the applicant 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. *See* 37 CFR §2.144.

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the Trademark Examining Attorney. *See In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992). The request must be filed by the Examining Attorney within one month of the date of the final decision, unless the time is extended by the Board upon a showing of sufficient cause. *See In re Ferrero S.p.A.*, 24 USPQ2d 1061 (TTAB 1992).

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. *See* 37 CFR §2.145(d)(1).

1219.02 By Appeal

An applicant which has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may have remedy by way of an appeal to the United States Court of Appeals for the Federal Circuit, or by way of a civil action for review of the decision of the Board. Section 21 of the Act, 15 U.S.C. §1071, and 37 CFR §2.145. For information concerning the taking of an appeal from a final decision of the Board, *see* TBMP §§901-904.

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