

## § 2.143

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hearing, one will be set and heard as provided in paragraph (e) of this section.

(6) If, during an appeal from a refusal of registration, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examining attorney may, by written request, ask the Board to suspend the appeal and to remand the application to the examining attorney for further examination. If the request is granted, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. After the additional ground for refusal of registration has been withdrawn or made final, the examining attorney shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

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

[48 FR 23141, May 23, 1983, as amended at 54 FR 34901, Aug. 22, 1989; 68 FR 55768, Sept. 26, 2003; 72 FR 42263, Aug. 1, 2007; 80 FR 2312, Jan. 16, 2015; 81 FR 69985, Oct. 7, 2016]

## § 2.143 [Reserved]

### § 2.144 Reconsideration of decision on *ex parte* appeal.

Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.

[54 FR 29554, July 13, 1989]

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

(a) *For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.* (1) An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an

application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board, and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration by the Board before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal.

(2) In all appeals under section 21(a), the appellant must take the following steps:

(i) File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;

(ii) File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA; and

(iii) Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.

(3) *Additional requirements.* (i) The notice of appeal shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(ii) In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.

(b) *For a notice of election under section 21(a)(1) to proceed under section 21(b) of the Act.* (1) Any applicant or registrant in an ex parte case who takes an appeal to the United States Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(2) If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:

(i) File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in §104.2 of this chapter;

(ii) File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA; and

(iii) Serve the notice of election as provided in §2.119.

(c) *For a civil action under section 21(b) of the Act.* (1) Any person who may appeal to the United States Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. It is unnecessary to request reconsideration by the Board before filing any such civil action; however, a party requesting reconsideration must do so before filing a civil action.

(2) Any applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act must serve the summons and complaint pursuant to Rule 4(i) of the Federal Rules of Civil Procedure with the copy to the Director addressed to the Office of the General Counsel as provided in §104.2 of this chapter. A copy of the complaint must also be filed with the Trademark Trial and Appeal Board via ESTTA.

(3) The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.

(d) *Time for appeal or civil action—(1) For an appeal under section 21(a).* The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter

partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(2) *For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.* The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.

(3) *For a civil action under section 21(b).* A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(4) *Time computation.* (i) If a request for rehearing or reconsideration or modification of the Board decision is filed within the time specified in §2.127(b), §2.129(c), or §2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire no later than sixty-three (63) days after action on the request.

(ii) *Holidays.* The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to §2.196.

(e) *Extension of time.* (1) The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

(i) Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or

(ii) Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a

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showing that the failure to act was the result of excusable neglect.

(2) The request must be filed as provided in §104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.

[81 FR 69986, Oct. 7, 2016, as amended at 81 FR 89383, Dec. 12, 2016]

### PETITIONS AND ACTION BY THE DIRECTOR

#### §2.146 Petitions to the Director.

(a) Petition may be taken to the Director in a trademark case:

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

(2) In any case for which the Act of 1946, Title 35 of the United States Code, or parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director;

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

(4) In any case not specifically defined and provided for by parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations; or

(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 appropriate subject matter for petitions to the Director.

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by §2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner quali-

fied to practice under §11.14 of this chapter, in accordance with the requirements of §2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) Unless a different deadline is specified elsewhere in this chapter, a petition under this section must be filed by not later than:

(1) Two months after the issue date of the action, or date of receipt of the filing, from which relief is requested; or

(2) Where the applicant or registrant declares under §2.20 or 28 U.S.C. 1746 that it did not receive the action, or where no action was issued, the petition must be filed by not later than:

(i) Two months of actual knowledge of the abandonment of an application and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part;

(ii) Where the registrant has timely filed an affidavit of use or excusable non-use under Section 8 or 71 of the Act, or a renewal application under Section 9 of the Act, two months after the date of actual knowledge of the cancellation/expiration of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired; or

(iii) Two months after the date of actual knowledge of the denial of certification of an international application under §7.13(b) and not later than six months after the trademark electronic records system indicates that certification is denied.

(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed by not later than fifteen days after the issue date of the grant or denial of the request. A petition from the grant of a request must be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant.