

this title, but shall not be limited in form to that of specimens as provided in section 1051(a) of this title.

(g) Examiner's decision; order to cancel

For each good or service for which it is determined that the registration should not have issued because the mark was not in use in commerce on or before the relevant date, the examiner shall find that the registration should be cancelled for each such good or service. Unless overturned on review of the examiner's decision, the Director shall issue an order cancelling the registration, in whole or in part, after the time for appeal has expired or any appeal proceeding has terminated.

(h) Reexamination by Director

(1) In general

The Director may, on the Director's own initiative, institute an ex parte reexamination proceeding if the Director discovers information that supports a prima facie case of the mark having not been used in commerce on or in connection with some or all of the goods or services covered by the registration on or before the relevant date. The Director shall promptly notify the registrant of such determination, at which time reexamination shall proceed according to the same procedures established pursuant to subsection (e). If the Director determines, based on the Director's own initiative, to institute an ex parte reexamination proceeding, the Director shall transmit or make available the information that formed the basis for that determination as part of the institution notice.

(2) Rule of construction

Nothing in this subsection shall be construed to limit any other authority of the Director.

(i) Time for institution

A petition for ex parte reexamination may be filed, or the Director may institute on the Director's own initiative an ex parte reexamination proceeding, at any time not later than 5 years after the date of registration of a mark registered based on use in commerce.

(j) Limitation on later ex parte reexamination proceedings

(1) No co-pending proceedings

With respect to a particular registration, while an ex parte reexamination proceeding is pending, no later ex parte reexamination proceeding may be instituted with respect to the same goods or services that are the subject of a pending ex parte reexamination proceeding.

(2) Estoppel

With respect to a particular registration, for any goods or services previously subject to an instituted ex parte reexamination proceeding for which, in that proceeding, it was determined that the registrant had used the mark for particular goods or services before the relevant date, and the registration was not cancelled as to those goods or services, no further ex parte reexamination proceedings may be initiated as to those goods or services, regardless of the identity of the petitioner.

(k) Supplemental register

The provisions of subsection (b) apply, as appropriate, to registrations under section 1091 of this title. Nothing in this section shall be construed to limit the timing of a cancellation action under section 1092 of this title.

(July 5, 1946, ch. 540, title I, § 16B, as added Pub. L. 116-260, div. Q, title II, § 225(c), Dec. 27, 2020, 134 Stat. 2205.)

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, see section 225(g) of div Q of Pub. L. 116-260, set out as an Effective Date of 2020 Amendment note under section 1064 of this title.

REGULATIONS

Director required to issue regulations to carry out this section no later than 1 year after Dec. 27, 2020, see section 225(f) of Pub. L. 116-260, set out as a note under section 1066a of this title.

§ 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

(b) The Trademark Trial and Appeal Board shall include the Director, Deputy¹ Director of the United States Patent and Trademark Office² the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Secretary of Commerce, in consultation with the Director.

(c) **AUTHORITY OF THE SECRETARY.**—The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative trademark judge who, before August 12, 2008, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative trademark judge.

(d) **DEFENSE TO CHALLENGE OF APPOINTMENT.**—It shall be a defense to a challenge to the appointment of an administrative trademark judge on the basis of the judge's having been originally appointed by the Director that the administrative trademark judge so appointed was acting as a de facto officer.

(July 5, 1946, ch. 540, title I, § 17, 60 Stat. 434; Pub. L. 85-609, § 1(a), Aug. 8, 1958, 72 Stat. 540; Pub. L. 93-596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 96-455, § 1, Oct. 15, 1980, 94 Stat. 2024; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4716], Nov. 29, 1999, 113 Stat. 1536, 1501A-580; Pub. L. 107-273, div. C, title III, § 13203(a)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 110-313, § 1(b), Aug. 12, 2008, 122 Stat. 3014.)

¹ So in original. Probably should be preceded by "the".

² So in original. Probably should be followed by a comma.

Editorial Notes**PRIOR PROVISIONS**

Act Feb. 20, 1905, ch. 592, § 7, 33 Stat. 726.

AMENDMENTS

2008—Subsec. (b). Pub. L. 110-313, §1(b)(1), inserted “Deputy Director of the United States Patent and Trademark Office” after “Director,” and substituted “appointed by the Secretary of Commerce, in consultation with the Director” for “appointed by the Director”.

Subsecs. (c), (d). Pub. L. 110-313, §1(b)(2), added subsecs. (c) and (d).

2002—Subsec. (b). Pub. L. 107-273, which directed amendment of subsec. (b) by inserting “the Deputy Commissioner,” after “Commissioner,” could not be executed because “Commissioner,” does not appear in text.

1999—Pub. L. 106-113 amended section generally. Prior to amendment, section read as follows:

“In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Commissioner shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

“The Trademark Trial and Appeal Board shall include the Commissioner, the Deputy Commissioner, the Assistant Commissioners, and members appointed by the Commissioner. Employees of the Patent and Trademark Office and other persons, all of whom shall be competent in trademark law, shall be eligible for appointment as members. Each case shall be heard by at least three members of the Board, the members hearing such case to be designated by the Commissioner.”

1980—Pub. L. 96-455 inserted provisions requiring that the Trademark Trial and Appeal Board include the Deputy Commissioner and members appointed by the Commissioner and provisions that employees of the Patent and Trademark Office and other persons, all of whom shall be competent in trademark law, shall be eligible for appointment as members; and struck out provision that the Board include Patent and Trademark Office employees, designated by the Commissioner and whose qualifications have been approved by the Civil Service Commission as being adequate for appointment to the position of examiner in charge of interferences.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1958—Pub. L. 85-609 substituted “a Trademark Trial and Appeal Board” for “the examiner in charge of interferences” in first paragraph, and inserted second paragraph relating to the composition of the Board.

Statutory Notes and Related Subsidiaries**EFFECTIVE DATE OF 1999 AMENDMENT**

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of Title 35, Patents.

EFFECTIVE DATE OF 1980 AMENDMENT; BOARD MEMBERSHIP AS OF OCTOBER 15, 1980, UNAFFECTED

Pub. L. 96-455, §2, Oct. 15, 1980, 94 Stat. 2024, provided that: “This amendment [amending this section] shall become effective on the date of its enactment [Oct. 15, 1980]. Members of the Trademark Trial and Appeal Board on the date of enactment shall continue to be members under and in accordance with the provisions of section 17 of the Act of July 5, 1946, as amended [this section], in effect immediately preceding the date of enactment.”

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

EFFECTIVE DATE OF 1958 AMENDMENT

Pub. L. 85-609, §3, Aug. 8, 1958, 72 Stat. 541, provided that: “This Act [amending this section and sections 1070, 1071, 1092, and 1113 of this title] shall take effect on approval [Aug. 8, 1958]; it shall apply to ex parte appeals taken to the Commissioner prior to the date of approval which have not been heard but shall not apply to any such appeal which has been heard or decided in which event further proceedings may be had as though this Act had not been passed; it shall apply to inter partes cases instituted prior to the date of approval which have not been heard by an examiner of interferences, but shall not apply to any such case which has been heard or decided by an examiner of interferences in which event further proceedings may be had as though this Act had not passed.”

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

REORGANIZATION PLAN NO. 5 OF 1950

Pub. L. 85-609, §2, Aug. 8, 1958, 72 Stat. 540, provided that: “The provisions of this Act [amending this section and sections 1070, 1071, 1092, and 1113 of this title] shall be subject to Reorganization Plan No. 5 of 1950 (64 Stat. 1263).”

Executive Documents**TRANSFER OF FUNCTIONS**

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1068. Action of Director in interference, opposition, and proceedings for concurrent use registration or for cancellation

In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings. The authority of the Director under this section includes the authority to reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board: *Provided*, That in the case of the registration of any mark based on concurrent use, the Director shall determine and fix the conditions and limitations provided for in subsection (d) of section 1052 of this title. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(July 5, 1946, ch. 540, title I, §18, 60 Stat. 434; Pub. L. 100-667, title I, §118, Nov. 16, 1988, 102 Stat. 3941; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat.