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cancelled under §8 of the Act of 1946 or has failed to renew his involved registration under §9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989]

37 CFR 2.135 Abandonment of application or mark.

After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989]

37 CFR 2.136 Status of application on termination of proceeding.

On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.

APPEALS**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.

[41 FR 760, Jan. 5, 1976]

37 CFR 2.142 Time and manner of ex parte appeals.

(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.

(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

(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.

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

(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

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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.

(e)(1) If the appellant desires an oral hearing, a request therefor should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or his attorney or other authorized representative.

- (2) If the appellant requests an oral argument, the examiner who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examiner from the same examining division as designated by the supervisory attorney thereof, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.
- (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.

(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 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.
- (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.

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(g) An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under §6 of the Act of 1946 or upon order of the 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.

[48 FR 23141, May 23, 1983, as amended at 54 FR 34901, Aug. 22, 1989]

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.

[41 FR 760, Jan. 5, 1976, as amended at 54 FR 29554, July 13, 1989]

37 CFR 2.145 Appeal to court and civil action.

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

- (1) In the Patent and Trademark Office give written notice of appeal to the Commissioner (see paragraphs (b) and (d) of this section);
 - (2) In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.
- (b) Notice of appeal.
- (1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Commissioner, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.
 - (2) In inter partes proceedings, the notice must be served as provided in §2.119.
 - (3) The notice, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.
- (c) Civil action.
- (1) Any person who may appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under §21(b) of the Act. Such civil action must be commenced within the time specified in paragraph (d) of this section.
 - (2) Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under §21(b) of the Act.
 - (3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in §21(b) of the Act. The notice of election must be served as provided in §2.119.
 - (4) A party to a proceeding before the Trademark Trial and Appeal Board which commences a civil action, pursuant to §21(b) of the Act, seeking review of a decision of the Board should file written notice thereof in the Patent and Trademark Office, addressed to the Board, within one month after the expiration of the time for

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appeal or civil action, in order to avoid premature termination of the Board proceeding.

(d) Time for appeal or civil action.

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

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

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

The certificate of mailing practice of §1.8 is not available for filing a notice of appeal or cross-appeal. See §1.8(a)(2)(ix).

- (2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.
- (3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under §21(a)(1) of the Act electing to have all further proceedings conducted under §21(b) of the Act, the time for filing a civil action thereafter is specified in §21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

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

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

[47 FR 47382, Oct. 26, 1982, as amended at 51 FR 28710, Aug. 11, 1986; 53 FR 16414, May 9, 1988; 54 FR 29554, July 13, 1989; 54 FR 34901, Aug. 22, 1989; 58 FR 54503, Oct. 22, 1993]

PETITIONS AND ACTION BY THE COMMISSIONER

37 CFR 2.146 Petitions to the Commissioner.

(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

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circumstances;

- (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations;
- (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

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

(c) Every petition to the Commissioner shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the requisite fee (see §2.6). Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits or declarations in accordance with §2.20, and any exhibits, shall accompany the petition.

(d) A petition on any matter not otherwise specifically provided for shall be filed within sixty days from the date of mailing of the action from which relief is requested.

(e)(1) A petition from the denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the denial of the request and shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by §2.119(a). The applicant may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by §2.119(a). No further paper relating to the petition shall be filed.

- (2) A petition from an interlocutory order of the Trademark Trial and Appeal Board shall be filed within thirty days after the date of mailing of the order from which relief is requested. Any brief in response to the petition shall be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection shall be served on every adverse party pursuant to §2.119(a).

(f) An oral hearing will not be held on a petition except when considered necessary by the Commissioner.

(g) The mere filing of a petition to the Commissioner will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.

(h) Authority to act on petitions, or on any petition, may be delegated by the Commissioner.

[48 FR 23142, May 23, 1983; 48 FR 27226, June 14, 1983]

37 CFR 2.147 [Reserved]

37 CFR 2.148 Commissioner may suspend certain rules.

In an extraordinary situation, when justice requires and no other party is injured thereby, any requirement of the rules in this part not being a requirement of the statute may be suspended or waived by the Commissioner.

CERTIFICATE

37 CFR 2.151 Certificate.

When the requirements of the law and of the rules have been complied with, and the Patent and Trademark Office has adjudged a mark registrable, a certificate will be issued to the effect that the