

# Chapter 1300 EX PARTE APPEALS FROM EXPUNGEMENT AND REEXAMINATION OF REGISTRATION PROCEEDINGS

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## 1301 Propriety of Ex Parte Appeal in Expungement or Reexamination Proceeding

*Trademark Act § 16A(c)(3), 15 U.S.C. § 1066A(c)(3) Ex Parte Expungement; Initial Determination; Institution. Determination by Director. Any determination by the Director whether or not to institute a proceeding under this section shall be final and non-reviewable....*

**Trademark Act § 16B(c)(3), 15 U.S.C. § 1066B(c)(3) Ex Parte Reexamination; Initial determination; institution. Determination by Director.** Any determination by the Director whether or not to institute a proceeding under this section shall be final and non-reviewable....

**Trademark Act § 20, 15 U.S.C. § 1070 Appeal from examiner to Trademark Trial and Appeal Board.** An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks or a final decision by an examiner in an ex parte expungement proceeding or ex parte reexamination proceeding upon the payment of the prescribed fee. The Director may reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board under this section.

### 1301.01 Readiness of Case for Appeal

**37 C.F.R. § 2.93(c) Action after response.** After response by the registrant, the Office will review the registrant's evidence of use or showing of applicable excusable nonuse, and/or arguments, and determine compliance with any requirement.

(1) **Final Office action.** If the registrant's timely response fails to rebut the prima facie case of nonuse or fully comply with all outstanding requirements, a final Office action will issue that addresses the evidence, includes the examiner's decision, and maintains any outstanding requirement. After issuance of a final Office action, the registrant may respond by filing within three months from the issue date of the final Office action:

(i) A request for reconsideration of the final Office action that seeks to further address the issue of use of the mark in commerce and/or comply with any outstanding requirement maintained in the final action; or

(ii) An appeal to the Trademark Trial and Appeal Board under § 2.141.

(2) **Time for filing a request for reconsideration or petition to the Director.**

(i) A request for reconsideration must be filed prior to the expiration of time provided for an appeal in § 2.142(a)(2). Filing a request for reconsideration does not stay or extend the time for filing an appeal or a petition under paragraph (c)(2)(ii) of this section.

(ii) Prior to the expiration of time for filing an appeal to the Trademark Trial and Appeal Board under § 2.142(a)(2), a registrant may file a petition to the Director under § 2.146 for relief from any outstanding requirement under §§ 2.11, 2.23, and 2.189 made final. If the petition is denied, the registrant will have 3 months from the date of issuance of the final action that contained the final requirement, or 30 days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A requirement that is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.\*\*\*

#### **37 C.F.R. § 2.141 Ex parte appeals**

(b) **Appeal from expungement or reexamination proceeding.** After issuance of a final Office action in an expungement or reexamination proceeding under § 2.93, a registrant may appeal to the Trademark Trial and Appeal Board, upon payment of the prescribed fee for each class in the registration for which the appeal is taken, within the time provided in § 2.142(a)(2).

#### **37 C.F.R. § 2.146 Petitions to the Director.**

(b) *Questions of substance arising during ... expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.*

(c)(1) *Questions of substance arising during ... expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.*

(2) *A petition requesting reinstatement of a registration cancelled in whole or in part for failure to timely respond to an Office action issued in an expungement and/or reexamination proceeding must include a response to the Office action, signed in accordance with § 2.193, or an appeal.*

If a registrant in an expungement or reexamination proceeding timely responds to the Office action but fails to rebut the prima facie case of nonuse or fully comply with all outstanding requirements, a final Office action will issue that addresses the evidence, includes the examiner's decision, and maintains any outstanding requirement. [Note 1.] After the final Office action issues, the registrant's response options are limited to an appeal to the Board, compliance with any requirement, or a petition to the Director if a petition is permitted by [37 C.F.R. § 2.93\(c\)\(2\)\(ii\)](#). [Note 2.] A registrant may file a request for reconsideration, but the submission of such a request does not stay or extend the time for filing a notice of appeal or petition. [Note 3.]

Any determination by the Director whether or not to institute an expungement or reexamination proceeding is final and non-reviewable, and therefore cannot be the subject of an appeal. [Note 4.]

#### NOTES:

1. See [37 C.F.R. § 2.93\(c\)\(1\)](#).
2. See [37 C.F.R. § 2.93\(c\)](#).
3. [37 C.F.R. § 2.93\(c\)](#).
4. [15 U.S.C. § 1066A\(c\)\(3\)](#).

### **1301.02 Premature Appeal from Expungement or Reexamination Proceeding**

Any determination by the Director whether or not to institute an expungement or reexamination proceeding is final and non-reviewable, and therefore cannot be the subject of an appeal. [Note 1.]

Guidance in [TBMP § 1201.03](#) regarding premature appeals may be applied to appeals in expungement and reexamination proceedings.

#### NOTES:

1. [15 U.S.C. § 1066A\(c\)\(3\)](#).

### **1301.03 Compliance With Requirements Not Subject of Appeal**

[37 C.F.R. § 2.142\(c\)](#) *All requirements made by the examining attorney and not the subject of appeal shall be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance.*

Guidance in [TBMP § 1201.04](#) regarding compliance with requirements that are not the subject of appeal may be applied to appeals in expungement and reexamination proceedings.

## 1301.04 Appeal from Expungement or Reexamination Proceeding versus Petition

### 37 C.F.R. § 2.93(c)(2) *Time for filing a request for reconsideration or petition to the Director.*

(ii) *Prior to the expiration of time for filing an appeal to the Trademark Trial and Appeal Board under § 2.142(a)(2), a registrant may file a petition to the Director under § 2.146 for relief from any outstanding requirement under §§ 2.11, 2.23, and 2.189 made final. If the petition is denied, the registrant will have 3 months from the date of issuance of the final action that contained the final requirement, or 30 days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A requirement that is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

### 37 C.F.R. § 2.146 *Petition 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, or expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.*

(c)(1) *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 qualified 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.*

(2) *A petition requesting reinstatement of a registration cancelled in whole or in part for failure to timely respond to an Office action issued in an expungement and/or reexamination proceeding must include a response to the Office action, signed in accordance with § 2.193, or an appeal.*

An appeal to the Board may be taken by the registrant in an expungement or reexamination proceeding from any final Office action deciding that the prima facie case of nonuse has not been rebutted as to the challenged goods and/or services. If the final Office action includes any outstanding requirement under §§ 2.11, 2.23, or 2.189, prior to the expiration of time for filing an appeal, the registrant may file a petition to the Director under § 2.146 for relief from such requirement. If the petition is denied, the registrant will have three months from the date of issuance of the final action that contained the final requirement, or 30 days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A requirement that

is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board. [Note 1.]

Substantive questions arising during the expungement or reexamination proceeding are considered to be appropriate subject matter for appeal to the Board (after issuance of a final action), but not for petition to the Director. [Note 2.]

#### NOTES:

1. See [37 C.F.R. § 2.93\(c\)\(2\)\(ii\)](#). See also *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1770 (TTAB 2016) (Board will not revisit issue that was the subject of petition decided by the Director); *In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

2. See [37 C.F.R. § 2.146\(b\)](#).

## 1302 Filing an Appeal from Expungement or Reexamination Proceeding

### 1302.01 In General

**Trademark Act § 20, 15 U.S.C. § 1070 Appeal from examiner to Trademark Trial and Appeal Board.** An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks or a final decision by an examiner in an *ex parte* expungement proceeding or *ex parte* reexamination proceeding upon the payment of the prescribed fee

#### [37 C.F.R. § 2.141](#) *Ex parte* appeals

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(b) **Appeal from expungement or reexamination proceeding.** After issuance of a final Office action in an expungement or reexamination proceeding under § 2.93, a registrant may appeal to the Trademark Trial and Appeal Board, upon payment of the prescribed fee for each class in the registration for which the appeal is taken, within the time provided in § 2.142(a)(2).

(c) **Appeal fee required.** The applicant or registrant must pay an appeal fee for each class for which the appeal is taken. If an appeal fee is not paid for at least one class of goods or services before the expiration of the time for appeal, when the appeal is from a final refusal of an application, the application will be abandoned or, when the appeal is from an expungement or reexamination proceeding, the Office will terminate the proceeding. When a multiple-class application or registration is involved, if an appeal fee is submitted for fewer than all classes, the applicant or registrant must specify the class(es) for which the appeal is taken. If the applicant or registrant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant or registrant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant or registrant may either pay the additional fees or specify the class(es) being appealed. If the applicant or registrant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.

#### [37 C.F.R. § 2.142](#) *Time and manner of ex parte* appeals.

(a)(2) An appeal filed under the provisions of § 2.141(b) from an expungement or reexamination proceeding must be filed within three months from the issue date of the final Office action.

(a)(3) *An appeal is taken by filing a notice of appeal, as prescribed in § 2.126, and paying the appeal fee.*

An appeal to the Board from a final decision in an ex parte expungement proceeding or ex parte reexamination proceeding is taken by timely filing in the Office, *see* [TBMP § 1303.02](#), both a notice of appeal and the prescribed appeal fee. [Note 1.] *See* [TBMP § 1302.04](#). If the notice of appeal and fee are not timely filed, the Board cannot entertain the appeal, and will terminate the proceeding. [Note 2.]

All requirements made by the examining attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance. [Note 3.] If a registrant that files an appeal to the Board fails to comply with such a requirement, the decision from the expungement or reexamination proceeding may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal.

If a registration contains multiple classes that are the subject of an expungement or reexamination proceeding, and the registrant wishes to appeal a final decision as to some but not all of the classes, the registrant should indicate in the notice of appeal the classes in which the decision is being appealed. [Note 4.] Any remaining classes for which there is a final adverse decision that is not the subject of the appeal will be cancelled in due course as to goods/services for which there was a final adverse decision. [Note 5.]

#### NOTES:

1. *See* [37 C.F.R. § 2.142\(a\)\(3\)](#); [37 C.F.R. § 2.6\(a\)\(18\)](#). *See also* [15 U.S.C. § 1070](#); [37 C.F.R. § 2.141](#) and [37 C.F.R. § 2.142\(a\)](#).
2. [37 C.F.R. § 2.141\(c\)](#).
3. [37 C.F.R. § 2.142\(c\)](#).
4. *See* [37 C.F.R. § 2.141\(b\)](#).
5. *See* [37 C.F.R. § 2.94](#).

### **1302.02 Time for Appeal from Expungement or Reexamination Proceeding**

An appeal to the Board from a final decision in an ex parte expungement proceeding or ex parte reexamination proceeding must be filed within three months from the date of the final action from which the appeal is taken. [Note 1.] This deadline may not be extended. [Note 2.]

If a notice of appeal is timely filed, but the appeal fee is not timely paid, the appeal will be untimely, and the Board will terminate the proceeding. *See* [TBMP § 1302.01](#) and [TBMP § 1302.04](#).

A notice of appeal to the Board must be filed through ESTTA in the manner prescribed in [37 C.F.R. § 2.126\(a\)](#). For more information regarding filing via ESTTA, *see* [TBMP § 110](#). However, if ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 3.] In the rare circumstances paper filing is necessary, the certificate of mailing procedure described in [37 C.F.R. § 2.197](#), and the “Priority Mail Express®” procedure described in [37](#)



[C.F.R. § 2.198](#), are available for the filing of an appeal to the Board. [Note 4.] [TBMP § 111.01](#) and [TBMP § 111.02](#).

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, the registrant may file a request for reconsideration. [Note 5.] *See also* [TBMP § 1204](#). However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate). [Note 6.] For more information comparing an appeal to a petition to the Director, see [TBMP § 1201.05](#). If a registrant that 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 registrant must file a notice of appeal and pay the fee prior to the expiration of the three-month period following issuance of the final action.

Prior to the expiration of time for filing an appeal from an expungement or reexamination proceeding, a registrant may file a petition to the Director under § 2.146 for relief from any outstanding requirement under §§ 2.11, 2.23, and 2.189 made final. If the petition is denied, the registrant will have three months from the date of issuance of the final action that contained the final requirement, or 30 days from the date of the decision on the petition, whichever date is later, to comply with the requirement. Such requirements cannot then be the subject of an appeal. [Note 7.]

A registrant may petition the Director to reinstate a registration cancelled in whole or in part for failure to file a timely appeal from a final Office action issued in an expungement or reexamination proceeding. [Note 8.] Ordinarily, if a registrant files a petition for reinstatement for the purpose of filing an appeal, the notice of appeal must be filed through ESTTA, and the petition for reinstatement should be filed through TEAS with a statement that a notice of appeal is being filed with the Board.

#### NOTES:

1. [37 C.F.R. § 2.93\(c\)\(1\)](#).
2. *Contrast* [37 C.F.R. § 2.93\(b\)\(1\)](#) (providing for extension of time to respond to non-final Office actions).
3. *See* [37 C.F.R. § 2.126\(b\)](#). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) (“Such explanations must include the specific facts underlying the inability to file by ESTTA, rather than a mere conclusory statement that technical problems or extraordinary circumstances prevented the use of ESTTA.”).
4. *See* [37 C.F.R. § 2.197](#); [37 C.F.R. § 2.198](#).
5. [37 C.F.R. § 2.93\(c\)\(1\)\(i\)](#).
6. [37 C.F.R. § 2.93\(c\)\(2\)](#).
7. [37 C.F.R. § 2.93\(c\)\(2\)\(ii\)](#).
8. *See* [37 C.F.R. § 2.146\(c\)\(2\)](#); [37 C.F.R. § 2.146\(c\)\(2\)](#).

### 1302.03 Notice of Appeal from Expungement or Reexamination Proceeding

A notice of appeal is the document by which a registrant appeals from the final Office action in an expungement or reexamination proceeding. A notice of appeal must be filed through ESTTA, found at

<https://estta.uspto.gov>. [Note 1.] See [TBMP § 106.03](#) and [TBMP § 110](#). Under “File a New Proceeding” choose “Notice of Appeal” from the drop-down menu, and enter the expungement or reexamination number; the relevant information will then automatically appear in the form.

Guidance in [TBMP § 1202.03](#) regarding the notice of appeal may be applied to appeals in expungement and reexamination proceedings.

#### NOTES:

1. See [37 C.F.R. § 2.126\(a\)](#). See also MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69966, 69970 (Oct. 7, 2016) (“The Office is amending § 2.195(d)(3) by deleting the option of filing notices of ex parte appeal by facsimile. This is a conforming amendment to align § 2.195(d)(3) with the final rules requiring that all filings with the Board be through ESTTA.”).

### 1302.04 Appeal Fee

#### [37 C.F.R. § 2.141](#) *Ex parte appeals.*

(b) **Appeal from expungement or reexamination proceeding.** After issuance of a final Office action in an expungement or reexamination proceeding under § 2.93, a registrant may appeal to the Trademark Trial and Appeal Board, upon payment of the prescribed fee for each class in the registration for which the appeal is taken, within the time provided in § 2.142(a)(2).

(c) **Appeal fee required.** The applicant or registrant must pay an appeal fee for each class for which the appeal is taken. If an appeal fee is not paid for at least one class of goods or services before the expiration of the time for appeal, when the appeal is from a final refusal of an application, the application will be abandoned or, when the appeal is from an expungement or reexamination proceeding, the Office will terminate the proceeding. When a multiple-class application or registration is involved, if an appeal fee is submitted for fewer than all classes, the applicant or registrant must specify the class(es) for which the appeal is taken. If the applicant or registrant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant or registrant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant or registrant may either pay the additional fees or specify the class(es) being appealed. If the applicant or registrant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.

Guidance in [TBMP § 1202.04](#) regarding the appeal fee may be applied to appeals in expungement and reexamination proceedings.

### 1303 Appeal Briefs in Expungement or Reexamination Proceeding

#### 1303.01 Form of Brief

#### [37 C.F.R. § 2.126](#) *Form of submissions to the Trademark Trial and Appeal Board.*

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*



(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:*

- (1) *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*
- (2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*
- (3) *If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*
- (4) *A paper submission must not be stapled or bound;*
- (5) *All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);*
- (6) *Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

(c) *To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(f) must be submitted using the “Confidential” selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.*

### **37 C.F.R. § 2.142 Time and manner of ex parte appeals.**

(b)(2) *Briefs must meet the requirements prescribed in § 2.126, except examining attorney submissions need not be filed through ESTTA. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety. Unless authorized by the Board, no further briefs are permitted.*

(b)(3) *Citation to evidence in briefs should be to the documents in the electronic record for the subject application or registration by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.*

Guidance regarding the form of appeal briefs in [TBMP § 1203.01](#) may be applied to appeals in expungement and reexamination proceedings.

In appeals in expungement and reexamination proceedings, the brief should indicate that it is an appeal brief, and include information identifying the expungement or reexamination proceeding number in which it is filed, the registrant’s name, the registration number, and the mark. When referring to the record, the registrant and examining attorney should cite to the proceeding record, currently the TSDR database. Citation format should be by date, name of the paper under which the evidence was submitted and the page number in the electronic record, for example: November 4, 2013 Office Action, TSDR p. 2. The Examining Attorney and

the registrant may cite to the TSDR record in .pdf format, but must indicate that they are doing so in their brief. [Note 1.] Where appropriate, reference to the TTABVUE entry and page number, e.g., 1 TTABVUE 2, should also be used. [Note 2.]

#### NOTES:

1. *Cf. In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1797 n.5 (TTAB 2017) (Board in its opinion cited to the TSDR record in .pdf format).

2. [37 C.F.R. § 2.142\(b\)\(3\)](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) (“The Office is adding new § 2.142(b)(3) to specify that citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record. The amendment is intended to facilitate review of record evidence by the applicant, the examining attorney, the Board, and the public.”).

### 1303.02 Time for Filing Brief

#### 1303.02(a) Registrant’s Main Brief

##### [37 C.F.R. § 2.142](#) *Time and manner of ex parte appeals.*

(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 examining attorney shall, within sixty days after the brief of appellant is sent to the examining attorney, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall email or 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 examining attorney.*

A registrant’s main brief in an ex parte appeal to the Board must be filed within sixty days from the date of appeal, or within an extension of time for that purpose, with the requisite fees, if applicable. [Note 1.] The time for filing the brief is set by rule; filing the notice of appeal through ESTTA automatically generates an acknowledgment. However, in the rare circumstances a notice of appeal is filed in paper with the required written explanation, although the Board attempts to send the registrant an acknowledgement of the receipt of the notice of appeal which indicates the date the brief is due, the failure to receive such acknowledgement does not affect the deadline for such filing. [Note 2.] If no brief is filed, the appeal will be dismissed. [Note 3.] If the brief is filed late, the registrant will be allowed an opportunity to submit an explanation for the late filing; in the absence of an adequate explanation, the appeal will be dismissed. The determination of whether to accept the brief will depend on the circumstances, including the length of time after the due date that the brief is filed, and the reason for the delay.

If the appeal is dismissed for failure to file a timely brief and no timely request to vacate the dismissal has been filed, the registrant’s recourse is to file a petition to the Director under the provisions of [37 C.F.R. § 2.146\(a\)\(3\)](#). Because such a petition invokes the supervisory authority of the Director, it is determined under the clear error/abuse of discretion standard, that is, whether the Board has committed clear error or abused its discretion in its determination not to accept the late-filed brief. [Note 4.] The registrant should not file a petition to the Director until it has first filed with the Board a request/motion to accept the late-filed brief, which must be filed within 30 days of dismissal, and that request/motion has been denied.

In the rare circumstances a notice of appeal (accompanied by the required fee) is filed in paper with the required written explanation and with a certificate of mailing by first-class mail pursuant to [37 C.F.R. § 2.197](#), or the Priority Mail Express® procedure described in [37 C.F.R. § 2.198](#), the date of mailing specified in the certificate will be used for determining the timeliness of the notice of appeal. However, the actual date of receipt of the notice of appeal in the Office will be used for all other purposes, including the running of the time for filing the registrant's main brief. [Note 5.] [TBMP § 1101.01](#) and [TBMP § 111.02](#).

The following applies to situations in which a registrant files a notice of appeal when it has also filed a timely request for reconsideration. When the registrant files its notice of appeal through ESTTA, it should check the box that indicates that a request for reconsideration is also being filed. ESTTA will electronically generate the order acknowledging receipt of the appeal and request, suspend further proceedings (including the registrant's time for filing its appeal brief) with respect to the appeal, and remanding to the examining attorney for consideration of the request. The request for reconsideration should be filed through TEAS. In the rare circumstances the notice of appeal is a paper submission, the notice of appeal should indicate, in the body of the appeal, that there is a pending request for reconsideration; if a request for reconsideration is being filed contemporaneously with the paper submission of the notice of appeal, it should accompany the notice of appeal. When the written explanation for paper filing is acceptable, proceedings in the appeal will automatically be suspended when a request for reconsideration is pending; the registrant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by [37 C.F.R. § 2.142\(b\)\(1\)](#), even if the Board has not issued its order suspending proceedings prior to the date the appeal brief would otherwise be due. Nor does the registrant need to verify with the Board that the due date for its brief will be changed if necessary. [Note 6.]

If the examining attorney denies the request for reconsideration, proceedings with respect to the appeal if instituted will be resumed; and the registrant will be allowed time in which to file its appeal brief if one has not already been filed.

#### NOTES:

1. [37 C.F.R. § 2.6\(a\)\(18\)\(iii\)](#), [37 C.F.R. § 2.6\(a\)\(18\)\(iv\)](#), [37 C.F.R. § 2.6\(a\)\(18\)\(v\)](#), [37 C.F.R. § 2.6\(a\)\(18\)\(vi\)](#), and [37 C.F.R. § 2.6\(a\)\(18\)\(vii\)](#). **Please Note:** there is no fee for filing the first request to extend time to file an appeal brief. [37 C.F.R. § 2.6\(a\)\(18\)\(iii\)](#).
2. See *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998). See also [37 C.F.R. § 2.126\(b\)](#); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) (“In these situations, parties should consider any such paper filing accepted unless the Board indicates otherwise. ... The Board will review the explanation accompanying the paper filing in its consideration of the filing, and submissions that do not meet the technical problems or extraordinary circumstances showing will not be considered.”).
3. [37 C.F.R. § 2.142\(b\)\(1\)](#).
4. See [TMEP § 1706](#).
5. See [37 C.F.R. § 2.197](#); [37 C.F.R. § 2.198](#).
6. See *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

### 1303.02(b) Trademark Examining Attorney's Brief

When the registrant's main appeal brief has been received by the Board, the Board sends the case to the examining attorney for preparation of a brief. Within 60 days after the date of the Board's written order forwarding the case to the examining attorney, or within an extension of time for the purpose, the examining attorney must file an appeal brief answering the registrant's main brief. [Note 1.] The examining attorney must also send a copy of the brief to the registrant. [Note 2.] If the examining attorney's brief is late-filed, the Board may exclude it in the absence of an adequate explanation for the late filing. [Note 3.] An examining attorney's failure to file a brief will not result in the reversal of the decision in the expungement or reexamination proceeding; the Board will simply decide the appeal without the benefit of the brief.

#### NOTES:

1. [37 C.F.R. § 2.142\(b\)\(1\)](#). See *In re Wells Fargo & Co.*, 231 USPQ 106, 107 n.2 (TTAB 1986); *In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188 n.3 (TTAB 1984). See also *In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).
2. [37 C.F.R. § 2.142\(b\)\(1\)](#). See *In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475, 1476 n.3 (Fed. Cir. 1993).
3. See *In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188, 188 n.3 (TTAB 1984).

### 1303.02(c) Registrant's Reply Brief

Guidance in [TBMP § 1203.02\(c\)](#) regarding an applicant's reply brief generally may be applied to the registrant's reply brief in appeals in expungement and reexamination proceedings.

### 1303.02(d) Extension of Time for Filing Brief

Guidance in [TBMP § 1203.02\(d\)](#) regarding an extension of time for filing a brief generally may be applied in appeals in expungement and reexamination proceedings.

### 1303.02(e) Material May Not Be Submitted with Briefs

[37 C.F.R. § 2.142\(d\)](#) *The record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.*

\* \* \* \*

(2) *In an appeal from an expungement or reexamination proceeding, no additional evidence may be included once an appeal is filed, and the Board may not remand for further examination.*

It is not necessary to attach as exhibits to a brief evidence that is already in the record. Such evidence should not be resubmitted as exhibits to the brief. In ex parte appeals from expungement or reexamination proceedings, the record may not be supplemented, and the Board may not remand to allow for the introduction of additional evidence. [Note 1.]

**NOTES:**

1. [37 C.F.R. § 2.142\(d\)\(2\)](#).

**1303.02(f) Cases That May Be Cited**

Guidance in [TBMP § 1203.02\(f\)](#) may be applied to appeals in expungement and reexamination proceedings.

**1303.02(g) Waiver of Claim or Requirement in Brief**

Guidance in [TBMP § 1203.02\(g\)](#) may be applied to appeals in expungement and reexamination proceedings.

**1304 Effect of Request for Reconsideration of Final Action in Expungement or Reexamination Proceeding**

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, a registrant may file a request for reconsideration of the final Office action that seeks to further address the issue of use of the mark in commerce and/or comply with any outstanding requirement maintained in the final action. [Note 1.] However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate). [Note 2.] If the examining attorney does not reconsider, and no appeal or other proper response to the final refusal has been filed during the three months following issuance of the final action, the registration will be cancelled. [Note 3.] Thus, if a registrant that 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 registrant also must file an appeal prior to the expiration of the three-month period following issuance of the final action.

When a registrant files, in response to a final action, both a request for reconsideration and an appeal, the request for reconsideration should be made by separate submission through TEAS. The request for reconsideration should not be combined in the body of the notice of appeal. When the notice of appeal is filed through ESTTA, the registrant should check the box stating that a request for reconsideration has been filed.

In the rare circumstances when the registrant files its notice of appeal as a paper submission and also files a request for reconsideration, or has a request for reconsideration pending, the notice of appeal should indicate this. When the written explanation for paper filing is acceptable, a Board paralegal will then send the registrant an order, to the same effect as the order automatically generated when the notice of appeal is filed through ESTTA. However, because the order is not automatically generated, it will not issue immediately. Where a registrant has timely filed both a notice of appeal on paper and a request for reconsideration, but has not heard from the Board within sixty days with regard to the appeal and reconsideration request, the registrant should not file its appeal brief. [Note 4.] Rather, it may assume that the Board will institute the appeal, if the written explanation for the paper filing is acceptable, and then suspend proceedings, so that the due date for the appeal brief will be reset in the event that the examining attorney denies the request for reconsideration. The registrant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary. [Note 5.] [TBMP §1302.02](#). However, the registrant may wish to make a status inquiry with the Board if it has not received an institution and suspension order within sixty days of the filing of the notice of appeal.

If an appeal is late-filed, but the registrant timely filed a request for reconsideration, the Board will issue an order informing the registrant of the lateness of its appeal, stating that the late appeal cannot be entertained

by the Board, and the examining attorney will consider the request for reconsideration. See [TBMP § 1303.02\(a\)](#).

**NOTES:**

1. See [37 C.F.R. § 2.93\(c\)\(1\)\(i\)](#).
2. See [37 C.F.R. § 2.93\(c\)\(2\)\(i\)](#).
3. See [37 C.F.R. § 2.93\(c\)\(3\)\(ii\)](#); [37 C.F.R. § 2.94](#).

4. Should the registrant file an appeal brief in this situation, the Board will normally remand the proceeding to the examining attorney to consider the request for reconsideration and, if reconsideration is denied, the Board may upon resumption of proceedings in the appeal give the registrant an opportunity to submit a supplemental appeal brief. Cf. *In re Husqvarna Aktiebolag*, 91 USPQ2d 1436, 1437 (TTAB 2009) (because Board was not aware of applicant's request for reconsideration which was filed two days before notice of appeal, the order instituting the appeal allowed applicant sixty days to file its appeal brief; examining attorney, unaware of either notice of appeal or appeal brief, issued nonfinal Office action, and subsequently another final refusal, and returned application to Board for resumption of appeal; applicant requested that it be permitted to file second brief, and Board accepted it as operative brief).

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

**1305 No Submission of Evidence During Appeal from Expungement or Reexamination Proceeding**

[37 C.F.R. § 2.142\(d\)](#) *The record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.*

\* \* \* \*

(2) *In an appeal from an expungement or reexamination proceeding, no additional evidence may be included once an appeal is filed, and the Board may not remand for further examination.*

The evidentiary record should be complete prior to the filing of an ex parte appeal to the Board. [Note 1.] See [TBMP § 1203.02\(e\)](#). In ex parte appeals from expungement or reexamination proceedings, the record may not be supplemented, and the Board may not remand to allow for the introduction of additional evidence. [Note 2.]

**NOTES:**

1. [37 C.F.R. § 2.142\(d\)](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) (“The Office is amending § 2.142(d) to clarify that evidence should not be filed with the Board after a notice of appeal is filed. The amendment more directly states the prohibition.”).

2. [37 C.F.R. § 2.142\(d\)\(2\)](#).



## 1306 Treatment of Evidence in Appeal from Expungement or Reexamination Proceeding

The Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an ex parte proceeding than it does in an inter partes proceeding. [Note 1.] That is, in an ex parte proceeding the Board tolerates some relaxation of the technical requirements for evidence and focuses instead on the spirit and essence of the rules of evidence. [Note 2.]

For example, the affidavit or [37 C.F.R. § 2.20](#) declaration is an established method for the introduction of evidence in an ex parte proceeding without the option of cross examination. [Note 3.]

Similar to inter partes proceedings, in an ex parte appeal, evidence properly made of record may be cited by either the examining attorney or by the registrant for any permissible purpose. [Note 4.]

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 from a refusal of registration, evaluates the sufficiency of the evidence offered by the examining attorney, see the cases cited in the note below. [Note 5.]

### NOTES:

1. See *In re Embiid*, 2021 USPQ2d 577, at \*5 n.19 (TTAB 2021) (Board is “more permissive regarding the use of hearsay in ex parte appeals” but “may still consider the hearsay nature of evidence in assessing its probative value in an ex parte proceeding”); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018); *In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) (“...the Board does not, in ex parte appeals, strictly apply the Federal Rules of Evidence, as it does in inter partes proceedings.”).

2. See *In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10, 1924 n.18 (TTAB 1996), *aff’d without opinion* (Fed. Cir. 1997) (Board allowed NEXIS evidence to show psychological effect of color blue, despite hearsay nature, recognizing the difficulty for examining attorney to establish such fact without relying on NEXIS evidence; Board also accepted sufficiency of evidence showing features of applicant’s trade dress were common, recognizing that USPTO’s limited resources constrain an examining attorney’s ability to acquire photographs of interiors of retail establishments); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996); *In re Murphy Door Bed Co.*, 223 USPQ 1030, 1032 n.9 (TTAB 1984). See also *In re Berman Brothers Harlem Furniture Inc.*, 26 USPQ2d 1514, 1515 (TTAB 1993).

3. See, e.g., [37 C.F.R. § 2.41\(a\)\(3\)](#); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018); *In re Manco Inc.*, 24 USPQ2d 1938, 1941 n.8 (TTAB 1992); *In re Bauhaus Designs Canada Ltd.*, 12 USPQ2d 2001, 2004 (TTAB 1989); *In re Motorola, Inc.*, 3 USPQ2d 1142, 1143 (TTAB 1986); *In re Peterson Manufacturing Co.*, 229 USPQ 466, 468 (TTAB 1986); *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986); *In re Gammon Reel, Inc.*, 227 USPQ 729, 731 (TTAB 1985); *In re Original Red Plate Co.*, 223 USPQ 836, 838 (TTAB 1984).

4. See *In re Guild Mortgage Co.*, 2020 USPQ2d 10279, at \*10 n.4 (TTAB 2020) (Board clarified that in ex parte proceedings, evidence properly made of record may be cited by either the examining attorney or by the applicant for any permissible purpose).

5. *In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988) (Court, being mindful that the USPTO has limited facilities for acquiring evidence--it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits--concludes evidence of record is sufficient to establish a prima facie case of deceptiveness); *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.”).

### **1306.01 Internet Material and Multimedia Materials**

Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings. [Note 1.] To make Internet material properly of record, the offering party must provide the full address (URL) for the web page, and the date it was accessed or printed, either by the information displayed on the web page itself, or by providing this information in an Office action or a registrant’s response. [Note 2.]

It is the obligation of the examining attorney and the registrant to ensure that Internet evidence made of record is complete. [Note 3.]

The Board will consider multimedia evidence [Note 4.], including video files submitted through TEAS during the proceeding. [Note 5.]

Additional guidance in [TBMP § 1208.03](#) regarding internet, social media, and multimedia materials may be applied to appeals in expungement and reexamination proceedings.

#### **NOTES:**

1. See, e.g., *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018).
2. See *Safer Inc. v. OMS investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (“Safer”); *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018) (applying *Safer* to evidence submitted by examining attorneys and applicants in ex parte cases).
3. See *In re Sausser Summers, PC*, 2021 USPQ2d 618, at \*24 n.59 (TTAB 2021) (portions of webpage evidence were “missing or cut off,” and it was applicant’s responsibility to ensure the legibility of its evidence); *In re tapio GmbH*, 2020 USPQ2d 11387, at \*3 (TTAB 2020) (exhibits purportedly uploaded with applicant’s request for reconsideration but not appearing in the TSDR record not considered by the Board).
4. See *In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1025 n.56 (TTAB 2017) (Board considered audio-visual materials containing television commercials in evaluating whether applicant’s proposed single-color mark had acquired distinctiveness).
5. See *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1143 n.13 (TTAB 2016) (TEAS accepts multimedia evidence, including video files under 30 MB).

### **1306.02 Judicial Notice**

Guidance in [TBMP § 1208.04](#) regarding judicial notice may be applied to appeals in expungement and reexamination proceedings.

### **1306.03 Registrant’s Own Materials**

A registrant’s materials, such as its website or advertisements describing its goods or services, or specimens of use of its mark, may be considered. [Note 1.]

**NOTES:**

1. See *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at \*2-3 (Fed. Cir. 2022) (considering applicant's specimens in assessing whether proposed mark functions as a source identifier); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (as a matter of law, the Board "did not err by considering the explanatory text of the specimens in the descriptiveness inquiry"); *In re James S. Fallon*, 2020 USPQ2d 11249, at \*9-10 (TTAB 2020) (Board considered applicant's own website advertisement touting product features in affirming mere descriptiveness refusal); *In re Emergency Alert Sols. Group, LLC*, 122 USPQ2d 1088, 1091 n.16, 1092 (TTAB 2017) (Board considered applicant's own webpage and specimen describing its services in affirming genericness refusal); *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1202 (TTAB 2017) (Board, in affirming surname refusal, considered applicant's website stating that WEISS is the surname of Applicant's founder and head watchmaker).

**1306.04 Confidential Material**

Submissions filed in ex parte appeal proceedings cannot be filed under seal pursuant to a protective order unless so issued or ordered by any court or by the Board. See [37 C.F.R. § 2.27\(d\)](#), [37 C.F.R. § 2.27\(c\)](#). [Note 1.]

In responding to an Office action in an expungement or reexamination proceeding, a registrant who wishes to submit confidential information in order to show use in commerce of the mark should redact such information and/or petition the Director under § 2.146 for permission to submit the information outside of TEAS to keep the information from becoming part of the public record. [Note 2.]

**NOTES:**

1. See *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1962 n.6 (TTAB 2016) (consent agreement, in addition to supporting registration, provides the public with notice of the basis on which the USPTO allowed registration). Compare *Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 n.4 (TTAB 2011) (parties' confidential consent agreement referred to in general terms). See also [37 C.F.R. § 2.126\(c\)](#) regarding the filing of confidential submissions.

2. Changes to Implement Provisions of the Trademark Modernization Act of 2020, 86 FR 64300, 64313 (Nov. 17, 2021) (USPTO response to Comment 12).

**1307 Deletion of Goods and/or Services at Issue During Appeal from Expungement or Reexamination Proceeding**

[37 C.F.R. § 2.93\(d\)\(3\)](#) *Deletion of goods and/or services at issue in a pending proceeding in a response, a surrender for cancellation under § 2.172, an amendment of the registration under § 2.173, or any other accepted submission, shall render the proceeding moot as to those goods and/or services, and no further determination will be made regarding the registrant's use of the mark in commerce as to those goods and/or services.*

**[37 C.F.R. § 2.172](#) *Surrender for cancellation.***

*Upon application by the owner, the Director may permit any registration to be surrendered for cancellation. The application for surrender must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified*

to practice under § 11.14 of this chapter. When a registration has more than one class, one or more entire class(es) but fewer than the total number of classes may be surrendered. Deletion of fewer than all the goods or services in a single class constitutes amendment of the registration as to that class (see § 2.173), rather than surrender. A surrender for cancellation may not subsequently be withdrawn.

**37 C.F.R. § 2.173 Amendment of registration.**

(a) **Form of amendment.** *The owner of a registration may apply to amend a registration or to disclaim part of the mark in the registration. The owner must submit a written request specifying the amendment or disclaimer. ...*

(b) **Requirements for request.** *A request for amendment or disclaimer must:*

(1) *Include the fee required by § 2.6;*

(2) *Be verified and signed in accordance with § 2.193(e)(6); and*

(3) *If the amendment involves a change in the mark: one new specimen per class showing the mark as used on or in connection with the goods, services, or collective membership organization; a verified statement that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark. When requested by the Office, additional specimens must be provided.*

(4) *The Office may require the owner to furnish such specimens, information, exhibits, and affidavits or declarations as may be reasonably necessary to the proper examination of the amendment.*

\*\*\*

(e) *Amendment of identification of goods, services, or collective membership organization. No amendment in the identification of goods or services, or description of the nature of the collective membership organization, in a registration will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark.*

\*\*\*

During an ex parte appeal to the Board from an expungement or reexamination proceeding, i.e., before the Board issues a final decision [Note 1], the registrant may surrender for cancellation under § 2.172 the registration at issue, or amend the registration under § 2.173 to delete the goods and/or services at issue in the proceeding. [Note 2.] The surrender or amendment must be signed by the registrant or its attorney or other authorized representative. [Note 3.] A deletion of goods and/or services or a surrender for cancellation may not be subsequently withdrawn. [Note 4.]

Such a deletion of the goods and/or services at issue renders the proceeding moot as to those goods and/or services, and no further determination will be made regarding the registrant's use of the mark in commerce as to those goods and/or services. [Note 5.]

**NOTES:**

1. *See In re Information Builders Inc.*, 2021 USPQ2d 228, at \*1 n.1 (TTAB 2021) (defining “final decision” as final dispositive ruling that ends litigation on the merits before the Board).

2. [37 C.F.R. § 2.93\(d\)\(3\)](#).

3. [37 C.F.R. § 2.172](#), [37 C.F.R. § 2.173\(b\)\(2\)](#).

4. [37 C.F.R. § 2.172](#); *see* [37 C.F.R. § 2.173\(c\)](#).

5. [37 C.F.R. § 2.93\(d\)\(3\)](#).

### **1308 Suspension of Appeal from Expungement or Reexamination Proceeding**

Prior to the issuance of the Board's decision in an ex parte appeal from an expungement or reexamination proceeding, proceedings with respect to the appeal may be suspended by the Board sua sponte or upon written request by the registrant or the examining attorney showing good cause for the requested suspension. [Note 1.] Such a request must be filed prior to the issuance of the Board's final decision in the case.

When proceedings have been suspended upon the registrant's request, and the event for which proceedings have been suspended occurs, such as when a civil action for which proceedings have been suspended has been finally determined, the registrant should file a submission notifying the Board thereof as soon as that knowledge comes to the registrant's attention. The Board will then resume proceedings and take further appropriate action in the appeal.

#### **NOTES:**

1. [37 C.F.R. § 2.67](#); [37 C.F.R. § 2.117](#). *See also In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518 n.24 (TTAB 2016).

### **1309 Consolidation of Appeals from Expungement or Reexamination Proceedings**

Upon request by the registrant or the examining attorney, or upon its own initiative, the Board may order the consolidation of appeals for purposes of briefing, oral hearing, and/or final decision. [Note 1.] *Cf.* [TBMP § 511](#). The Board may also consider two or more cases in one opinion even if they have not been consolidated. [Note 2.] Even if the Board renders its decisions on two appeals in a single opinion, the appeals will not necessarily be consolidated. [Note 3.]

Although cases consolidated prior to briefing may be presented on the same brief, they do not have to be. The registrant (and/or the examining attorney) may file a different brief in each case if the registrant (and/or the examining attorney) so desires. When consolidated cases are to be presented on the same brief, the brief should bear the proceeding number of each consolidated expungement or reexamination proceeding, and a copy of the brief should be submitted for each.

The registrant must notify the Board at the time of filing its notice of appeal and throughout the appeal whether any other expungement or reexamination proceedings, Board proceedings or applications, are pending that involve the same or similar marks for the same or similar goods and/or services, regardless of whether or not those are on appeal.

#### **NOTES:**

1. *See, e.g., In re S. Malhotra & Co.*, 128 USPQ2d 1100, 1102 (TTAB 2018) (Board sua sponte consolidated two appeals); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1085 (TTAB 2016) (Board consolidated appeals in two applications upon examining attorney's motion); *In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board sua sponte consolidated two appeals); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011) (same); *In re America Online Inc.*, 77 USPQ2d 1618, 1618 (TTAB 2006) (Board consolidated appeals in four applications upon applicant's motion); *In re Bacardi & Co. Ltd.*, 48 USPQ2d

1031, 1033 (TTAB 1997); (Board sua sponte considered appeals in five applications together and rendered single opinion); *In re Pebble Beach Co.*, 19 USPQ2d 1687, 1687 (TTAB 1991); *In re Del E. Webb Corp.*, 16 USPQ2d 1232, 1233 (TTAB 1990) (proceedings consolidated because issue in two appeals the same); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (applicant requested after hearing on one appeal that appeals be consolidated; Board granted and decided appeals in single decision); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659, 1662 n.7 (TTAB 1987); *In re Petersen Manufacturing Co.*, 2 USPQ2d 2032, 2033 (TTAB 1987) (four appeals consolidated for oral hearing and decision); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067, 1608 (TTAB 1983) (appeals consolidated for oral hearing and decision).

2. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion); *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009) (because appeals involved common questions of law and fact and records were practically identical, Board decided both in a single opinion); *In re Vertex Group LLC*, 89 USPQ2d 1694, 1695 (TTAB 2009) (because of virtually identical issues presented in appeals for two applications, Board issued single opinion); *In re Supply Guys Inc.*, 86 USPQ2d 1488, 1490 (TTAB 2008) (because issues and record similar, Board issued one opinion that addressed applicant's three applications); *In re Orange Communications Inc.*, 41 USPQ2d 1036, 1037-39 (TTAB 1996); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 (TTAB 1996) (because issues and record in each case essentially identical, Board rendered decision as to two applications in a single opinion, noting that applicant and examining attorney treated the cases as consolidated for purposes of briefs and oral hearing).

3. *In re Hudson News Co.*, 39 USPQ2d 1915, 1916 n.5 (TTAB 1996) (Board issued a single opinion in interest of judicial economy, but each appeal stands on its own merits), *aff'd without opinion* (Fed. Cir. 1997).

## **1310 Oral Hearing in Appeal from Expungement or Reexamination Proceeding**

### **[37 C.F.R. § 2.142\(c\)](#)**

(1) *If the appellant desires an oral hearing, a request 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 Administrative Trademark Judges or other statutory 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 the appellant's attorney or other authorized representative. Appellants, examining attorneys, and members of the Board may attend in person or, at the discretion of the Board, remotely.*

(2) *If the appellant requests an oral argument, the examining attorney who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examining attorney as designated by a supervisory or managing attorney, 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 examining attorney. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.*

Guidance in [TBMP § 1216](#) regarding oral hearings may be applied to appeals in expungement and reexamination proceedings.



## 1311 Final Decision in Appeals from Expungement and Reexamination Proceedings

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 from expungement or reexamination proceedings. [Note 1.]

In determining an ex parte appeal, the Board reviews the appealed decision of the examining attorney to determine if it was correctly made. The Board's review will address the goods or services challenged in the petition and subject to appeal, as well as noncompliance with any requirement properly subject to appeal. The Board need not find that the examining attorney's rationale was correct in order to affirm the decision, but rather may rely on a different rationale. [Note 2.] Further, the examining attorney is not precluded from raising, during appeal, new arguments and/or additional case citations in support of the decision. [Note 3.]

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. [Note 4.] Similarly, the Board has no authority, either in its final decision on appeal or thereafter, to remand the case to the examining attorney. [Note 5.]

### NOTES:

1. See *In re Information Builders Inc.*, 2021 USPQ2d 228, at \*1 n.1 (TTAB 2021) (defining “final decision” as final dispositive ruling that ends litigation on the merits before the Board).
2. See *In re Berkeley Lights, Inc.*, 2022 USPQ2d 1000, at \*20 (TTAB 2022) (clarifying that reliance on a different rationale “does not mean that the Board may rely on a new ground for refusal;” in that circumstance, remand of the application would be appropriate); *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1401-02 (TTAB 2018) (Board declined to consider second rationale raised only in an advisory manner during prosecution but raised again by the examining attorney's brief because it was unclear that applicant had “a full opportunity to address the alternative rationale ... prior to appeal.”); *In re Harley*, 119 USPQ2d 1755, 1758 (TTAB 2016) (applicants' failure to address refusals is a basis for affirming the examining attorney's refusal on all grounds); *In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 343 n.2 (TTAB 1985). Cf. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1009 (Fed. Cir. 1988); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485, 488 (CCPA 1976); *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426, 428 (CCPA 1975).
3. See *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 342 n.2 (TTAB 1985).
4. See [37 C.F.R. § 2.142\(d\)\(2\)](#); Cf., e.g., *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 n.2 (TTAB 1982). See also [37 C.F.R. § 2.145\(a\)\(1\)](#).
5. [37 C.F.R. § 2.142\(d\)\(2\)](#). Cf. *In re Berkeley Lights, Inc.*, 2022 USPQ2d 1000, at \*3 n.1 (TTAB 2022) (Board has no authority to remand an application after a final decision in an appeal except in the limited circumstances provided in Trademark Rule 2.142(g)).

## 1312 Review of Final Decision in Appeals from Expungement and Reexamination Proceedings

### 1312.01 By Request for Reconsideration

[37 C.F.R. § 2.144](#) *Reconsideration of decision on ex parte appeal.* Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.

For general information concerning requests for rehearing, reconsideration, or modification of a final decision of the Board, see [TBMP § 543](#) and [TBMP § 544](#). What follows is information pertaining specifically to requests for rehearing, reconsideration, or modification of a final decision of the Board in an ex parte appeal.

A registrant that has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may file a request for rehearing, reconsideration, or modification of the decision. The registrant must file the request within one month from the date of the decision. The time for filing the request may be extended by the Board upon a showing of sufficient cause. [Note 1.]

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the examining attorney. [Note 2.] The examining attorney must file the request within one month of the date of the final decision, unless the time is extended by the Board upon a showing of sufficient cause. [Note 3.]

If a request for rehearing, reconsideration, or modification of the Board's final decision in an ex parte appeal is timely filed, the registrant's time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire no later than sixty-three (63) days after action on the request. [Note 4.] A registrant need not request reconsideration before it files an appeal of the Board's final decision, but if a registrant requests reconsideration, it must do so before it files a notice of appeal. [Note 5.] For more information concerning the time for filing a notice of appeal of the Board's final decision in an ex parte appeal, see [TBMP § 1312.02](#).

#### NOTES:

1. [37 C.F.R. § 2.144](#).
2. See *In re Squaw Valley Development Co.*, 80 USPQ2d 1264, 1266 (TTAB 2006); *In re Ferrero S.p.A.*, 22 USPQ2d 1800, 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992) (in the absence of statutory or regulatory prohibition, Board has inherent authority to entertain examining attorney's request for reconsideration).
3. See *In re Ferrero S.p.A.*, 24 USPQ2d 1061, 1062 n.1 (TTAB 1992).
4. See [37 C.F.R. § 2.145\(d\)\(4\)](#).
5. [37 C.F.R. § 2.145\(a\)\(1\)](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69969 (Oct. 7, 2016) ("The Office is further amending § 2.145(a)(1) to add that it is unnecessary to request reconsideration before filing an appeal of a Board decision, but a party requesting reconsideration must do so before filing a notice of appeal.").

## 1312.02 By Appeal to the United States Court of Appeals for the Federal Circuit

A registrant that has filed an ex parte appeal to the Board from an expungement or reexamination proceeding, 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. [Note 1.] The determination by the Director to institute the proceeding is final and nonreviewable, and so cannot be the subject of judicial review. [Note 2.] No remedy by civil action is available from ex parte appeals to the Board from expungement and reexamination proceedings. [Note 3.]

A copy of the notice of appeal to the Federal Circuit must be filed with the Board via ESTTA, [Note 4.], and by email with the Director to the email address indicated on the USPTO's webpage for the Office of the General Counsel for filing such notices, [Note 5.] It is unnecessary to request reconsideration of a final decision before filing any such appeal. However, a party requesting reconsideration must do so before filing a notice of appeal. [Note 6.]

For information concerning the taking of an appeal to the Federal Circuit from a final decision of the Board, see [TBMP § 902](#). For general information on the taking of an appeal from a final decision of the Board, see [TBMP § 901](#).

### NOTES:

1. Trademark Act § 21, [15 U.S.C. § 1071](#); [37 C.F.R. § 2.145\(a\)](#).
2. [15 U.S.C. § 1066A\(c\)\(3\)](#); [15 U.S.C. § 1066B\(c\)\(3\)](#).
3. *See* [15 U.S.C. § 1071\(b\)\(1\)](#); [37 C.F.R. § 2.145\(c\)](#).
4. [37 C.F.R. § 2.145\(a\)\(2\)\(ii\)](#); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69969 (Oct. 7, 2016) (“The Office also is amending the provisions in § 2.145 that require copies of notices of appeal, notices of election, and notices of civil action to be file with the Trademark Trial and Appeal Board to specify that such notices must be filed with the Board via ESTTA.”).
5. [37 C.F.R. § 2.145\(a\)\(2\)\(i\)](#); Electronic Submission of Notices of Appeal to the United States Court of Appeals for the Federal Circuit, Notices of Election, and Requests for Extension of Time for Seeking Judicial Review, 89 Fed. Reg. 22084, 22085 (Mar. 29, 2024).
6. [37 C.F.R. § 2.145\(a\)](#).

## 1313 Termination of Appeals from Expungement and Reexamination Proceedings

When the Board issues a final decision in an ex parte appeal from an expungement or reexamination proceeding, the Board does not terminate the appeal until after the period to seek judicial review has expired and no review has been sought. If the registrant files an appeal to the Federal Circuit, the Board does not act to terminate the ex parte appeal proceeding until after the court review action has been finally determined.

For an appeal to the Federal Circuit, the Board normally will not act until after the mandate issues and the time for petitioning for review to the U.S. Supreme Court has expired with no review being sought, and if

U.S. Supreme Court review is sought, until after the Supreme Court denies a petition for certiorari or if it grants certiorari, until after the Supreme Court issues its decision.

### 1314 Estoppel

Upon termination of an expungement proceeding in which it was established that the registered mark was used in commerce on or in connection with particular goods and/or services at issue in the proceeding prior to the date a petition to expunge was filed under [37 C.F.R § 2.91](#) or the date the Director-initiated proceedings were instituted under [37 C.F.R § 2.92](#), no further ex parte expungement proceedings may be instituted as to those particular goods and/or services. [15 U.S.C § 1066a\(j\)\(2\)](#); [37 C.F.R § 2.92\(d\)\(1\)](#). *See also* [TMEP §1716.04\(g\)](#). However, subsequent reexamination proceedings for marks registered under Section 1 are not barred under these circumstances because reexamination proceedings involve a question of whether the mark was in use in commerce as of a particular relevant date, whereas earlier expungement proceedings would only have involved a determination of whether the mark was never used. Proof of use sufficient to rebut a prima facie case of nonuse in an expungement proceeding might not establish use in commerce as of a particular relevant date, as required in a reexamination proceeding. *See also* [TMEP § 1716.04\(g\)](#).

Upon termination of a reexamination proceeding in which it was established that the registered mark was used in commerce on or in connection with particular goods and/or services at issue, on or before the relevant date at issue in the proceedings, no further ex parte expungement or reexamination proceedings may be instituted as to those particular goods and/or services. *See* [15 U.S.C § 1066\(j\)\(2\)](#); [37 C.F.R § 2.92\(d\)\(2\)](#).

As ex parte proceedings, reexamination and expungement proceedings have no preclusive effect against a petitioner who seeks to cancel that same registration through a TTAB cancellation proceeding, even if that petitioner also submitted the petition requesting institution of a reexamination or expungement proceeding. [Note1]. Because persons who file a petition requesting institution of a reexamination or expungement proceeding are not a party to that ex parte proceeding, they have no right to appeal the Director's decision in that proceeding. [Note 2].

The termination of a reexamination or expungement proceeding in favor of a registrant cannot be the basis for the registrant's assertion of claim or issue preclusion in a proceeding before the Board to cancel that registration. [Note 3].

For more information regarding expungement and reexamination proceedings *see* [TMEP § 1716](#) -- [TMEP § 1716\(h\)](#).

#### NOTES:

1. *Common Sense Press Inc. dba Pocket Jacks Commics v. Sciver and Maplica*, 2023 USPQ2d 601, at \*2-3 (TTAB 2023).
2. *Common Sense Press Inc. dba Pocket Jacks Commics v. Sciver and Maplica*, 2023 USPQ2d 601, at \*3 (TTAB 2023).
3. *Common Sense Press Inc. dba Pocket Jacks Commics v. Sciver and Maplica*, 2023 USPQ2d 601, at \*3 (TTAB 2023).