

## REPEAL AND EFFECT ON EXISTING RIGHTS

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

## TRANSFER OF FUNCTIONS

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

## REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

**§ 1071. Appeal to courts****(a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure**

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 of this title or section 1141k of this title, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

**(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure**

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in inter-

est may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

(July 5, 1946, ch. 540, title I, §21, 60 Stat. 435; July 19, 1952, ch. 950, §2, 66 Stat. 814; Pub. L. 85-609, §1(c), Aug. 8, 1958, 72 Stat. 540; Pub. L. 87-772, §12, Oct. 9, 1962, 76 Stat. 771; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 93-600, §2, Jan. 2, 1975, 88 Stat. 1955; Pub. L. 97-164, title I, §162(1), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98-620, title IV, §414(b), Nov. 8, 1984, 98 Stat. 3363; Pub. L. 100-667, title I, §120, Nov. 16, 1988, 102 Stat. 3942; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583; Pub. L. 111-146, §3(c), Mar. 17, 2010, 124 Stat. 67; Pub. L. 112-29, §9(a), Sept. 16, 2011, 125 Stat. 316.)

#### CODIFICATION

Pub. L. 93-596, which provided for the substitution of “Patent and Trademark Office” for “Patent Office” each time appearing in this chapter, became effective Jan. 2, 1975, as did Pub. L. 93-600, which in the course of amending subsec. (a)(3) and (4) of this section, referred merely to “Patent Office”. “Patent and Trademark Office” has been substituted for “Patent Office” in subsec. (a)(3) and (4) on authority of Pub. L. 93-596.

#### PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§9, 22, 33 Stat. 727, 729; Mar. 2, 1929, ch. 488, §2(b), 45 Stat. 1478.

#### AMENDMENTS

2011—Subsec. (b)(4). Pub. L. 112-29 substituted “United States District Court for the Eastern District of Virginia” for “United States District Court for the District of Columbia”.

2010—Subsec. (a)(1). Pub. L. 111-146, §3(c)(2), inserted “or section 1141k of this title” after “section 1058 of this title”.

Subsec. (a)(2) to (4). Pub. L. 111-146, §3(c)(1), inserted “United States” before “Patent and Trademark Office” wherever appearing.

Subsec. (b)(3). Pub. L. 111-146, §3(c)(1), inserted “United States” before “Patent and Trademark Office” in two places.

Subsec. (b)(4). Pub. L. 111-146, §3(c)(1), (3), inserted “United States” before “Patent and Trademark Office” and substituted “If there are” for “If there be”.

1999—Pub. L. 106-113 substituted “Director” for “Commissioner” wherever appearing.

1988—Subsec. (a)(1). Pub. L. 100-667, §120(1), made technical amendments to references in the original act to subsection (b) of this section resulting in no change in text, and substituted “paragraph (2) of this subsection” for “subsection (a)(2) of this section” and “action under subsection” for “action under said subsection”.

Subsec. (a)(4). Pub. L. 100-667, §120(2), inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

Subsec. (b)(1). Pub. L. 100-667, §120(3), made technical amendments to references in the original act to subsection (a) of this section resulting in no change in text and inserted provision that no final judgment be en-

tered before mark is registered if applicant cannot prevail without establishing constructive use.

Subsec. (b)(3). Pub. L. 100-667, §120(4), amended first sentence generally. Prior to amendment, first sentence read as follows: “In all cases where there is no adverse party, a copy of the complaint shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the party bringing them, whether the final decision is in his favor or not.”

1984—Subsec. (a)(2). Pub. L. 98-620 substituted provisions requiring the appellant to file a written notice of appeal in the Patent and Trademark Office directed to the Commissioner for provisions requiring the appellant to file the notice of appeal with the Commissioner, and struck out provision which required the notice of appeal to specify the party or parties taking the appeal, to designate the decision or part thereof appealed from, and to state that the appeal was being taken to the United States Court of Appeals for the Federal Circuit.

Subsec. (a)(3). Pub. L. 98-620 substituted provisions requiring the Commissioner to transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office for provisions which required the Commissioner to transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant, and any additional papers and evidence specified by the appellee, and inserted provision that the court may request that the Commissioner forward the original or certified copies of such documents during the pendency of the appeal.

Subsec. (a)(4). Pub. L. 98-620 substituted provisions requiring the court to review the decision from which the appeal is taken on the record before the Patent and Trademark Office, and, upon its determination, to issue its mandate and opinion to the Commissioner for provisions which required the court to decide such appeal on the evidence produced before the Patent and Trademark Office and to return to the Commissioner a certificate of its proceedings and decision.

1982—Subsecs. (a)(1), (2), (b)(1). Pub. L. 97-164 substituted “United States Court of Appeals for the Federal Circuit” for “United States Court of Customs and Patent Appeals” and “Court of Customs and Patent Appeals” wherever appearing.

1975—Subsec. (a)(2). Pub. L. 93-600 substituted provisions relating to filing of notice of appeal with the Commissioner and the contents of such notice of appeal, for provisions relating to giving notice of appeal to the Commissioner and requiring filing in the Patent Office reasons for appeal.

Subsec. (a)(3). Pub. L. 93-600 inserted provision requiring the Commissioner to furnish the court with a brief explaining the grounds of the decision of the Office.

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

Subsec. (a)(4). Pub. L. 93-600 substituted “decide” for “hear and determine” and struck out “Upon its determination,” before “the court shall return” and provision requiring the decision to be confined to the points set forth in the reasons of appeal.

Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office” in two places.

Subsec. (b)(3), (4). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 amended section generally, and among other changes, incorporated with necessary changes in language, the various provisions of Title 35, Patents, relating to the procedure of appeals to the Court of Customs and Patent Appeals and review by civil action in patent cases, which had previously been incorporated by reference only.

1958—Pub. L. 85-609 authorized appeals by persons dissatisfied with the decision of the Trademark Trial and Appeal Board, and substituted “Trademark Trial and Appeal Board” for “Commissioner” in proviso.

1952—Act July 19, 1952, substituted references to new title 35 for repealed section of title 35.

## EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §9(b), Sept. 16, 2011, 125 Stat. 316, provided that: “The amendments made by this section [amending this section and sections 32, 145, 146, 154, and 293 of Title 35, Patents] shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any civil action commenced on or after that date.”

## EFFECTIVE DATE OF 1999 AMENDMENT

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

## EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

## EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-620 applicable to proceedings pending in the Patent and Trademark Office on Nov. 8, 1984, and to appeals pending in the United States Court of Appeals for the Federal Circuit on that date, see section 414(c) of Pub. L. 98-620, set out as a note under section 142 of Title 35, Patents.

## EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

## EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 93-600 effective Jan. 2, 1975, but not to affect any suit, proceeding, or appeal then pending, see section 4 of Pub. L. 93-600, set out as a note under section 1063 of this title.

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

## EFFECTIVE DATE OF 1958 AMENDMENT

For effective date and applicability of amendment by Pub. L. 85-609, see section 3 of Pub. L. 85-609, set out as a note under section 1067 of this title.

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Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

### § 1072. Registration as constructive notice of claim of ownership

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.

(July 5, 1946, ch. 540, title I, §22, 60 Stat. 435.)

## REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in text, are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

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## SUBCHAPTER II—THE SUPPLEMENTAL REGISTER

### § 1091. Supplemental register

#### (a) Marks registerable

In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled “An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes”, to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant's goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

#### (b) Application and proceedings for registration

Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

#### (c) Nature of mark

For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such