

a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive, the Commissioner may declare that an interference exists”.

1962—Pub. L. 87-772 struck out “purchasers” after “or to deceive”.

#### 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 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

#### 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.

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

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

(b) The Trademark Trial and Appeal Board shall include the Director, Deputy<sup>1</sup> Director of the United States Patent and Trademark Office<sup>2</sup> the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Secretary of Commerce, in consultation with the Director.

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

(d) **DEFENSE TO CHALLENGE OF APPOINTMENT.**—It shall be a defense to a challenge to the appointment of an administrative trademark judge

on the basis of the judge's having been originally appointed by the Director that the administrative trademark judge so appointed was acting as a de facto officer.

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

#### PRIOR PROVISIONS

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

#### AMENDMENTS

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

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

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

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

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

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

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

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

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

#### EFFECTIVE DATE OF 1999 AMENDMENT

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

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

Pub. L. 96-455, §2, Oct. 15, 1980, 94 Stat. 2024, provided that: “This amendment [amending this section] shall

<sup>1</sup> So in original. Probably should be preceded by “the”.

<sup>2</sup> So in original. Probably should be followed by a comma.

become effective on the date of its enactment [Oct. 15, 1980]. Members of the Trademark Trial and Appeal Board on the date of enactment shall continue to be members under and in accordance with the provisions of section 17 of the Act of July 5, 1946, as amended [this section], in effect immediately preceding the date of enactment."

#### EFFECTIVE DATE OF 1975 AMENDMENT

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

#### EFFECTIVE DATE OF 1958 AMENDMENT

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

#### REPEAL AND EFFECT ON EXISTING RIGHTS

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

#### TRANSFER OF FUNCTIONS

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#### REORGANIZATION PLAN NO. 5 OF 1950

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

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

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

constructive use pursuant to section 1057(c) of this title.

(July 5, 1946, ch. 540, title I, §18, 60 Stat. 434; Pub. L. 100-667, title I, §118, Nov. 16, 1988, 102 Stat. 3941; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583.)

#### PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §§7, 13, 33 Stat. 726, 728.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted "Director" for "Commissioner" in two places.

1988—Pub. L. 100-667 substituted "the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register" for "or restrict", and "may refuse" for "or may refuse", and inserted provisions that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

#### 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

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### § 1069. Application of equitable principles in inter partes proceedings

In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.

(July 5, 1946, ch. 540, title I, §19, 60 Stat. 434; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 100-667, title I, §119, Nov. 16, 1988, 102 Stat. 3941.)

#### AMENDMENTS

1988—Pub. L. 100-667 struck out at end "The provisions of this section shall also govern proceedings heretofore begun in the Patent and Trademark Office and not finally determined."

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

#### 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 1975 AMENDMENT

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