

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

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.

#### 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.

#### CONSTRUCTION OF 2020 AMENDMENT

Pub. L. 116-260, div. Q, title II, §228(b), Dec. 27, 2020, 134 Stat. 2210, provided that:

“(1) AUTHORITY BEFORE DATE OF ENACTMENT.—The amendments made by subsection (a) [amending this section and sections 1070 and 1092 of this title] shall not be construed to mean that the Director lacked the authority to reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board before the date of enactment of this Act [Dec. 27, 2020].

“(2) AUTHORITY WITH RESPECT TO PARTICULAR DECISIONS.—The amendments made by subsection (a) shall not be construed to require the Director to reconsider, modify, or set aside any particular decision of the Trademark Trial and Appeal Board.”

[“Director” as used in section 228(b) of Pub. L. 116-260, set out above, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, see section 222 of Pub. L. 116-260, set out as a note 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.

### § 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.

#### 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.

### § 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners

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 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.

(July 5, 1946, ch. 540, title I, §20, 60 Stat. 435; Pub. L. 85-609, §1(b), Aug. 8, 1958, 72 Stat. 540; Pub. L. 116-260, div. Q, title II, §§225(d)(1), 228(a)(2), Dec. 27, 2020, 134 Stat. 2207, 2210.)

#### AMENDMENT OF SECTION

*Pub. L. 116-260, div. Q, title II, §225(d)(1), (g), Dec. 27, 2020, 134 Stat. 2207, 2208, provided that, effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, this section is amended by inserting “or a final decision by an examiner in an ex parte expungement proceeding or ex parte reexamination proceeding” after “registration of marks”. See 2020 Amendment note below.*

#### PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §§8, 13, 33 Stat. 726, 728.

#### AMENDMENTS

2020—Pub. L. 116-260, §228(a)(2), inserted “The Director may reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board under this section.” at end.

Pub. L. 116-260, §225(d)(1), inserted “or a final decision by an examiner in an ex parte expungement proceeding or ex parte reexamination proceeding” after “registration of marks”.

1958—Pub. L. 85-609 substituted “Trademark Trial and Appeal Board” for “Commissioner in person” and “fee” for “fees”, and struck out “of interferences or” after “examiner in charge”.

#### EFFECTIVE DATE OF 2020 AMENDMENT

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

## 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.

## CONSTRUCTION OF 2020 AMENDMENT

For construction of amendment made by section 228(a)(2) of div. Q of Pub. L. 116-260 regarding Director's authority before Dec. 27, 2020, and authority with respect to particular decisions, see section 228(b) of div. Q of Pub. L. 116-260, set out as a note under section 1068 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 condi-