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801 Briefs on the Case

801.01 In General

After the close of all testimony periods in an inter partes proceeding before the Board, the parties are allowed time in which to file briefs on the case. The brief is a party's "opportunity to present, in a systematic and coherent manner, and in a form which is permanent and can be referred to, a discussion of the facts in light of the law," its strongest affirmative arguments, and a rebuttal of its adversary's arguments. See David J. Kera, *TIPS FROM THE TTAB: Preparing and Filing Briefs With the Trademark Trial and Appeal Board*, 66 Trademark Rep. 141, 141 (1976).

Subject to FRCP 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. However, the facts and arguments presented in the brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence. See TBMP §§705.02 and 706.02, and authorities cited therein.

801.02 Time for Filing

37 CFR §2.128(a)(1) The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.

(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to

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show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

801.02(a) Plaintiff's Main Brief

The main brief of the party in the position of plaintiff is due not later than 60 days after the date set for the close of the rebuttal testimony period. *See* 37 CFR §2.128(a)(1).

If a party in the position of plaintiff fails to file a main brief, the Board may issue an order allowing plaintiff until a set time, not less than 15 days, in which to show cause why its failure to file a main brief should not be treated as a concession of the case. If the plaintiff fails to file a response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff. *See* 37 CFR §2.128(a)(3). The purpose of this order to show cause procedure is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is the policy of the Board not to enter judgment against a plaintiff, for failure to file a main brief on the case, where the plaintiff, in its response to the show cause order, indicates that it has not lost interest in the case. *See* TBMP §537, and authorities cited therein.

For further information concerning the 37 CFR §2.128(a)(3) order to show cause procedure, *see* TBMP §537.

801.02(b) Defendant's Main Brief

The filing of a brief on the case is not mandatory for a party in the position of defendant. *See* 37 CFR §2.128(a)(1); Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23132, and in the *Official Gazette* of June 21, 1983 at 1031 TMOG 13, 22; and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

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However, if a party in the position of defendant wishes to file a brief on the case, the brief is due not later than 30 days after the due date of the plaintiff's main brief. *See* 37 CFR §2.128(a)(1). *See also Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 25 (TTAB 1972).

801.02(c) Plaintiff's Reply Brief

The filing of a reply brief is not mandatory for a party in the position of plaintiff. *See* 37 CFR §2.128(a)(1), and T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984).

However, if a party in the position of plaintiff wishes to file a reply brief, the brief is due not later than 15 days after the due date of the defendant's main brief. *See* 37 CFR §2.128(a)(1).

801.02(d) Reply Brief for Defendant Not Permitted

There is no provision for the filing of a reply brief, rebuttal brief, rejoinder brief, etc. by a party in the position of defendant. If a party in the position of defendant files such a brief, it may be stricken, or given no consideration, by the Board. *See* TBMP §540, and cases cited therein.

However, if a defendant has counterclaimed to cancel a registration owned by the plaintiff, the defendant, as plaintiff in the counterclaim, may file a reply brief directed to the counterclaim.

801.02(e) Special Situations

In certain special situations, the Board will set, by written action, the due dates for the filing of briefs on the case. This occurs when (1) there is a counterclaim, or (2) proceedings have been consolidated, and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of them, or (3) there is an interference or a concurrent use registration proceeding involving more than two parties. *See* 37 CFR §2.128(a)(2).

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For example, if there is a counterclaim, the Board will issue a written action setting the due dates for plaintiff's main brief in the original proceeding (due the 60th day after the date set for the close of rebuttal testimony); defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim (due the 30th day after the due date of the plaintiff's main brief); plaintiff's combined reply brief in the original proceeding and its brief as defendant in the counterclaim (due the 30th day after the due date of defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim); and defendant's reply brief as plaintiff in the counterclaim (due the 15th day after the due date of plaintiff's combined reply brief in the original proceeding and brief as defendant in the counterclaim). *See Jan Bell Marketing Inc. v. Centennial Jewelers Inc.*, 19 USPQ2d 1636 (TTAB 1990) (example of a briefing schedule in an opposition with a counterclaim).

In an interference or concurrent use registration proceeding, the Board will schedule briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief in which it may meet the brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief. *See* TBMP §1007 (example of a briefing schedule in an interference proceeding), and TBMP §1108 (example of a briefing schedule in a concurrent use proceeding). *Cf.* 37 CFR §2.121(b)(2).

801.03 Form and Contents of Brief

37 CFR §2.128(b) Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Each brief shall contain an alphabetical index of cases cited therein. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-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 facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Three legible copies, on good quality paper, of each brief shall be filed.

A brief on the case must comply with the requirements of 37 CFR §2.128(b). *See also*, with respect to briefs on the case, David J. Kera, *TIPS FROM THE TTAB*:

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Preparing and Filing Briefs With the Trademark Trial and Appeal Board, 66 Trademark Rep. 141 (1976).

The description of the record should comprise a list of the evidence properly introduced by the parties, such as, "The evidence of record consists of opposer's Registration No. 1,234,567; applicant's answers to opposer's interrogatories; the discovery deposition of Mr. X; and the testimony depositions of opposer's witnesses, Mr. Y and Ms. Z." The recitation of facts should include, for each significant fact recited, a citation to the portion of the evidentiary record where supporting evidence may be found.

Without prior leave of the Board, a main brief on the case may not exceed 55 pages in length in its entirety, and a reply brief may not exceed 25 pages in its entirety. See 37 CFR §2.128(b). See also *United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994), and *Conorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992). The parts of the brief which fall within the length limit include the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary. Extensive single-spaced footnotes may not be used as a subterfuge to avoid the page limit. See *Conorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, *supra*. Exhibits or appendices to a brief, not being part of the brief itself, are not included within the limit. See 37 CFR §2.128(b), and Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34895, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 33-34. Cf. *American Optical Corp. v. Atwood Oceanics, Inc.*, 177 USPQ 585 (Comm'r 1973) (case decided under earlier version of 37 CFR 2.128(b)). For information concerning motions for leave to file a brief exceeding the page limit, see TBMP §538.

When cases are cited in a brief, the case citation should include a citation to *The United States Patent Quarterly*, if the case has appeared in that publication. If the case has not been published in *The United States Patent Quarterly*, it is recommended that a copy of the case be submitted with the brief.

If a mark which is the subject of, or is pleaded in, a proceeding includes stylization or a design feature, a picture of the mark should be included in the brief on the case.

If a plaintiff files a reply brief, the brief must be confined to rebutting the defendant's main brief.

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801.04 Amicus Briefs

The Board may, in its discretion, entertain an amicus brief. *See* TBMP §539, and authorities cited therein. An entity which wishes to file an amicus brief should file a motion with the Board for leave to do so. For information concerning motions for leave to file an amicus brief, *see* TBMP §539.

801.05 Motion to Strike Brief on Case

A party may move to strike a brief on the case on a variety of grounds, including that the brief was untimely filed, exceeds the page limit for a brief on the case, violates the format requirements for such a brief, is a brief not provided for by the applicable rules (i.e., is a reply brief filed by the defendant, for example), etc. In addition, a party may move to strike evidentiary matter attached to a brief where the evidentiary matter was not properly made of record during the time for taking testimony. For information concerning motions to strike a brief on the case, or matter attached to such a brief, *see* TBMP §540, and cases cited therein.

802 Oral Hearing

37 CFR §2.129(a) If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.

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(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives.

802.01 In General

The oral hearing on the case in an inter partes proceeding before the Board corresponds to the oral summation in court proceedings after all the evidence is in. *See* 37 CFR §2.116(f).

An oral hearing is not mandatory, but rather is scheduled only if a timely request therefor is filed by a party to the proceeding. The oral hearing provides a party with one last opportunity to emphasize its strongest arguments, and to refute its adversary's arguments. It is particularly useful in cases with complex issues or a complex record, or where the defendant needs to respond to arguments in the plaintiff's reply brief. For information concerning situations in which it may be advisable to request an oral hearing on a case, *see* Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977).

Subject to FRCP 11, a party is entitled to offer at oral hearing any argument it feels will be to its advantage. However, the facts recited and arguments made at oral hearing must be based on the evidence offered at trial. An oral hearing may not be used as a vehicle for the introduction of evidence. *See* 37 CFR §2.123(l); TBMP §717; and Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977). *Cf.* TBMP §801.01.

802.02 Request for Oral Hearing

A party which wishes to have an oral hearing on the case must file a request therefor, by separate paper (not as part of its brief on the case), not later than 10 days after the due date for the filing of the last reply brief in the proceeding. *See* 37 CFR §2.129(a). A hearing may be requested by any party to the proceeding.

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If an oral hearing is not requested, the case will be decided in due course after the due date for the filing of the last reply brief on the case.

802.03 Time and Place of Hearing

When a timely request for an oral hearing on the case has been filed by a party to an inter partes proceeding before the Board, the Board sets the date and time for the hearing, and sends each party a notice of hearing specifying the date, time, and location of the hearing. *See* 37 CFR §2.129(a). It is the normal practice of the Board, in setting an oral hearing, to telephone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing, following which the written notice formally scheduling the hearing is mailed. Oral hearings are held at the offices of the Board.

Attendance at a scheduled oral hearing is voluntary, not mandatory. If any party appears at the specified time, the party will be heard, whether or not the party which appears is the one which requested the hearing. *See* 37 CFR §2.129(a). If a party elects not to attend a scheduled hearing, the party should notify the Board, well in advance of the scheduled hearing date, that it will not attend the hearing.

If a party which requested an oral hearing fails to appear at the appointed time, without giving prior notice to the Board of nonappearance, the failure to appear will be construed by the Board as a withdrawal of the request for an oral hearing, and any new request for an oral hearing will be granted only upon a showing that the failure to appear was occasioned by extraordinary circumstances.

If the Board is prevented from hearing the case at the time specified in the notice of hearing, a new hearing date will be set. *See* 37 CFR §2.129(a). The date or time of a hearing may also be reset, so far as is convenient and proper, at the request of the parties and their attorneys or other authorized representatives. *See* 37 CFR §2.129(b). For information concerning requests to reset an oral hearing, *see* TBMP §542.01. However, parties should not file repeated requests to reset an oral hearing.

802.04 Before Whom Held

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An oral hearing is held before a panel of at least three members (i.e., administrative trademark judges) of the Board. *See* 37 CFR §2.129(a). *Cf.* Section 17 of the Act, 15 U.S.C. §1067; *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417 (CCPA 1972); and 37 CFR §2.142(e)(1). Normally, an oral hearing panel consists of only three Board members. If a member of a panel of three before which an oral hearing was held is, for some reason, unable to participate in the final decision, another Board member may be substituted at final decision for the missing member, even though the substituted member was not present at the oral hearing; no new oral hearing is necessary. *See In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985), and *Jockey International, Inc. v. Bette Appel Unltd.*, 216 USPQ 359 (TTAB 1982). *Cf. Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464 (TTAB 1983) (final decision rendered by only two Board members invalid); *Ronson Corp. v. Ronco Teleproducts, Inc.*, 197 USPQ 492 (Comm'r 1978) (final decision rendered by only two Board members invalid); and *Ethicon, Inc. v. American Cyanamid Co.*, 193 USPQ 374 (Comm'r 1977) (alleged invalid appointment to Board of one panel member).

The Board may, in its discretion, use an augmented panel to hear a case. *See* TBMP §541, and cases cited therein. A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding. For information concerning motions for an augmented panel hearing, *see* TBMP §541. For further information concerning the constitution of Board panels, *see In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

802.05 Length of Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal. *See* 37 CFR §2.129(a). If there is a counterclaim, the defendant, as the plaintiff in the counterclaim, may also reserve part of its 30 minutes for rebuttal on the counterclaim.

There is no requirement that a party use all of its allotted 30 minutes for oral argument. Often, a case is of such nature that a party's oral arguments thereon may be presented in considerably less than 30 minutes.

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On the other hand, if a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time. *See* 37 CFR §2.129(a), and TBMP §542.02. *Cf.* 37 CFR §2.128(b), and TBMP §538. For information concerning requests for additional time for oral argument, *see* TBMP §542.02. If the request is granted, each party will be allowed the same amount of time for oral argument.

802.06 Audiotaping

Upon motion showing good cause, the Board will usually permit a party to make an audiotape recording of an oral hearing. Such a recording, when permitted by the Board, is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding. For information concerning motions for leave to audiotape an oral hearing, *see* TBMP §543.

If permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audiotaping equipment in an unobtrusive manner. A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, an oral hearing before the Board may not be videotaped. *See* TBMP §543.

802.07 Visual Aids, etc.

The Board will generally allow certain types of materials, such as graphs, large depictions of marks, schedules, charts, etc., to be used at oral hearing, either for clarification or to eliminate the need for extended description, when such materials are based on evidence properly of record. *See Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990).

A party may also bring to the oral hearing any materials introduced as exhibits at trial, including audiotapes or videotapes of commercials or demonstrations. A party which introduced an audiotape or videotape as an exhibit at trial, and wishes to play it at the oral hearing, should notify the Board in advance. In addition, a party which wishes to play such a tape at oral hearing is responsible for furnishing, operating, and removing the necessary equipment in an unobtrusive manner.

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A party may not, however, use an oral hearing for the purpose of offering new evidence, whether in the form of charts, graphs, exhibits, or other such materials. *See* TBMP §802.01, and authorities cited therein. Nor may a party submit in writing the text of its oral argument; to allow such a practice would be to permit a party, in effect, to file an additional brief on the case. *See Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990).

802.08 Nature of Hearing

Prior to an oral hearing, the Board panel members read the briefs on the case and, if necessary, examine the case files. Thus, persons presenting oral arguments should not read from the briefs on the case, except to emphasize an admission contained in an adversary's brief.

Normally, an oral hearing case is not assigned to a particular Board member for the drafting of a final decision until some time after the oral hearing. Thus, the Board member who sits in the middle of the panel of three is not necessarily the person to whom the case will be assigned for decision; rather, the middle panel member is usually (but not always) the senior panel member.

A person presenting oral arguments should be prepared to answer questions from Board panel members at any point in the arguments. If exhibits or visual aids have been brought to the oral hearing, they should be shown to the adversary before they are shown to the Board panel. Further, a person presenting oral arguments should never interrupt the oral arguments of the adversary.

For further information on how to argue a case before the Board, *see* Saul Lefkowitz, *TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977).

803 Final Decision

After an oral hearing has been held in a Board inter partes proceeding, the case is set down for final decision. If no oral hearing is requested, the case is set down for final decision after the due date for the filing of the last reply brief on the case.

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The final decision is rendered by a panel of at least three Board members. *See* Section 17 of the Act, 15. U.S.C. §1067; *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417 (CCPA 1972); *Plus Products v. Medical Modalities Associates, Inc.*, 217 USPQ 464 (TTAB 1983); and *Ronson Corp. v. Ronco Teleproducts, Inc.*, 197 USPQ 492 (Comm'r 1978). *Cf.* 37 CFR §§2.129(a) and 2.142(e)(1); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); *Jockey International, Inc. v. Bette Appel Unltd.*, 216 USPQ 359 (TTAB 1982); and *Ethicon, Inc. v. American Cyanamid Co.*, 193 USPQ 374 (Comm'r 1977). When there has been an oral hearing in a case, the final decision normally is rendered by the panel before which the oral hearing was held. If a member of a panel of three before which an oral hearing was held is unable to participate in the final decision, another Board member may be substituted at final decision for the missing member. *See* TBMP §802.04, and cases cited therein.

The Board may use an augmented panel at final decision. For information concerning the use of an augmented panel, *see* TBMP §541. For further information concerning the constitution of Board panels, *see In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

The evidentiary record in a case is not read by every member of the panel assigned to decide the case. Rather, one panel member is assigned to read the testimony and examine the other evidence of record, discuss the case with the other panel members, and then draft a decision and supporting opinion. The draft is circulated to the other panel members for their approval and signature. A panel member who does not agree with the decision may write a dissent. A panel member who agrees with the decision, but disagrees with the reasoning expressed in the opinion supporting the decision, or wishes to express additional reasons, may write a concurring opinion.

When a final decision has been signed by the members of the panel rendering the decision, a copy thereof is mailed to every party to the proceeding.

804 Request for Reconsideration of Final Decision

A party may file a request for rehearing, reconsideration, or modification of a decision issued after final hearing. *See* 37 CFR §2.129(c). For information concerning requests for rehearing, reconsideration, or modification of a decision issued after final hearing, *see* TBMP §544.

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805 Final Decision Remand to Examining Attorney

37 CFR §2.131 Remand after decision in inter partes proceeding.

If, during an inter partes proceeding, facts are disclosed which appear to render the mark of an applicant unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may refer the application to the examiner for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon receiving the application, the examiner shall withhold registration pending reexamination of the application in the light of the reference by the Board. If, upon reexamination, the examiner finally refuses registration to the applicant, an appeal may be taken as provided by §§2.141 and 2.142.

If, during the course of an opposition, concurrent use, or interference proceeding, facts are disclosed which appear to render the subject mark of an involved applicant unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to FRCP 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, remand the application to the Trademark Examining Attorney for further examination in light of the disclosed facts. That is, the Board may include in its decision a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the Examining Attorney reexamine the application in light of the disclosed facts. *See* 37 CFR §2.131, and TBMP §515 and cases cited therein. *Cf.* TBMP §1217.

If a party to an opposition, concurrent use, or interference proceeding believes that the facts disclosed therein appear to render the subject mark of an involved application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to FRCP 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR §2.131 remand to the Examining Attorney. The request may be made in the party's brief on the case, or by separate motion.

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806 Termination of Proceeding

When an inter partes proceeding before the Board has been finally determined (that is, when the time for filing an appeal from a decision of the Board determining the case has expired, and no appeal has been filed, or when any appeals filed have been determined), the Board takes certain further steps, based on the judgment entered therein, to close out the proceeding file and give effect to the judgment. *See* Notice of Final Rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34896, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 34. The same is true when a proceeding ends by stipulation of the parties, or by a voluntary withdrawal or consent to judgment by one party.

For example, when a decision of the Board dismissing an opposition becomes final (that is, the time for filing an appeal has expired, and no appeal has been filed), or the opposition is dismissed pursuant to a stipulation of the parties or as the result of a withdrawal by opposer, the Board normally takes the following steps, inter alia:

(1) The testimony depositions, any discovery depositions made of record in the case, and one copy of each brief on the case (that is, materials which, because of their bulkiness, would not have been kept by the Board in the proceeding file--*see* TBMP §120.01), are all placed on the prongs in the proceeding file. The two extra copies of each brief are discarded.

(2) The word "TERMINATED" is stamped on the proceeding file.

(3) The proceeding file is sent to the PTO warehouse where terminated proceeding files are stored.

(4) Exhibits which, because of their size, were too bulky to put in the proceeding file, and therefore were stored separately by the Board (*see* TBMP §120.02), are returned to the party which filed them.

(5) Confidential materials filed under protective order are returned to the party which filed them.

(6) The applicant's subject application is sent to the appropriate section of the PTO for further appropriate action, such as, issuance of a notice of allowance under 37 CFR §2.81(b), in an intent-to-use application for which no amendment to allege use under 37 CFR §2.76 has been submitted and accepted; issuance of a registration pursuant to 37 CFR §2.81(a); republication, if necessary for some reason; or reexamination by the Trademark Examining Attorney pursuant to a 37 CFR §2.131 remand (*see* TBMP §805). Alternatively, if the applicant's subject application has been abandoned by the applicant, the abandoned application is sent

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to the PTO warehouse where newly abandoned applications are stored (pending their destruction approximately two years after abandonment).

When a decision of the Board granting a petition for cancellation becomes final, the first five steps listed above are taken, and the subject registration is cancelled by separate order of the Commissioner. When a decision of the Board dismissing a petition for cancellation becomes final, the first five steps are taken, and the file of the registration is returned to the PTO warehouse where "live" (subsisting) registrations are stored.

Because the Board will take the termination steps described above when a decision of the Board determining a case appears, from the records of the PTO, to have become final, a party which commences a civil action, pursuant to Section 21(b) of the Act, 15. U.S.C. §1071(b), seeking review of the Board's decision should file written notice thereof in the PTO, addressed to the Board, within one month after the expiration of the time for appeal or civil action. *See* 37 CFR §2.145(c)(4). If a party files a civil action seeking review of a Board's decision determining a proceeding, but fails to notify the Board thereof, the Board, believing that its decision has become final, will terminate the proceeding. As a result, a registration may be issued or cancelled prematurely, while the civil action seeking review of the Board's decision is still pending.

807 Status of Application After Proceeding

37 CFR §2.136 Status of application on termination of proceeding.

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

When an opposition, concurrent use or interference proceeding ends with a judgment which is not adverse to an involved applicant, the application returns to the status it had before commencement of the proceeding, unless the Board indicates in its decision that the application must be republished for some reason, or includes in its decision a 37 CFR §2.131 remand to the Trademark Examining Attorney (*see* TBMP §805). *See* 37 CFR §2.136.

BRIEFS ON CASE, ORAL HEARING, FINAL DECISION

If the proceeding ends with a judgment which is adverse to the applicant, the application stands refused, the file thereof is stamped "ABANDONED," and all proceedings thereon are considered terminated. *See* 37 CFR §2.136; *In re Vesper Corp.*, 8 USPQ2d 1788 (Comm'r 1988) (Commissioner refuses to reopen application after adverse final judgment in opposition); and *National Patent Development Corp. v. Hercules Inc.*, 192 USPQ 491 (Comm'r 1976) (Commissioner refuses to reopen application after adverse final judgment in opposition).