98TH CONGRESS } HOUSE OF REPRESENTATIVES { REPORT
2d Session } { 98-619

TECHNICAL AMENDMENTS TO THE FEDERAL COURTS IMPROVEMENT ACT OF 1982

MARCH 14, 1984.—Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

Mr. KASTENMEIER, from the Committee on the Judiciary, submitted the following

REPORT

[To accompany H.R. ~~422~~ 4222]

[Including cost estimate of the Congressional Budget Office]

The Committee on the Judiciary, to whom was referred the bill (H.R. 4222) to make certain technical amendments with respect to the court of appeals for the Federal circuit, and for other purposes, having considered the same, reports favorably thereon with an amendment and recommend that the bill as amended do pass.

The amendment is as follows:

Strike out all after the enacting clause and insert in lieu thereof the following:

That this Act may be cited as the "Technical Amendments to the Federal Courts Improvement Act of 1982".

SEC. 2. (a) Section 1292(b) of title 28, United States Code, is amended by inserting "which would have jurisdiction of an appeal of such action" after "The Court of Appeals".

(b) Section 1292(c)(1) of title 28, United States Code, is amended by inserting "or (b)" after "(a)".

SEC. 3. Section 337(c) of the Tariff Act of 1930 (19 U.S.C. 1337(c)) is amended in the fourth sentence by inserting, "within 60 days after the determination becomes final," after "appeal such determination".

SEC. 4. (a) Sections 142, 143, and 144 of title 35, United States Code, are amended to read as follows:

"§ 142. Notice of appeal

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

"§ 143. Proceedings on appeal

"With respect to an appeal described in section 142 of this title, the Commissioner shall 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. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to the court in writing the grounds for the decision of the 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 Commissioner and the parties in the appeal.

"§ 144. Decision on appeal

"The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Commissioner its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.".

(b) Paragraphs (2), (3), and (4) of subsection (a) of section 21 of the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes", approved July 5, 1946 (15 U.S.C. 1071(a)(2), (3), and (4)), are amended to read as follows:

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

"(3) The Commissioner shall 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. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to the court a brief explaining the grounds for the decision of the 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 Commissioner 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 Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.".

(c) The amendments made by this section shall apply to proceedings pending in the Patent and Trademark Office on the date of the enactment of this Act and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date.

SEC. 5. Any individual who, on the date of the enactment of the Federal Courts Improvement Act of 1982, was serving as marshal for the Court of Appeals for the District of Columbia under section 713(c) of title 28, United States Code, may, after the date of the enactment of this Act, so serve under that section as in effect on the date of the enactment of the Federal Courts Improvement Act of 1982. While such individual so serves, the provisions of section 714(a) of title 28, United States Code, shall not apply to the Court of Appeals for the District Columbia.

PURPOSE OF THE LEGISLATION

The general purpose of the legislation is to correct several drafting flaws in the Federal Courts Improvement Act (Public Law 97–164), enacted on April 2, 1982, and effective October 1, 1982.

BACKGROUND

The Federal Courts Improvement Act (Public Law 97–164, 96 Stat. 25) created the United States Court of Appeals for the Federal Circuit (CAFC) by merging the preexisting United States Court of Claims with the former United States Court of Customs and Patent

Appeals. The Act further created the United States Claims Court, pursuant to Article I of the Constitution, from the former trial division of the Court of Claims. Finally, the Act contained several significant improvements to Federal judicial machinery.[1]

The new Court of Appeals for the Federal Circuit was given unique nationwide jurisdiction over certain types of cases. As a general proposition, other circuit courts only have regional jurisdiction. The CAFC has jurisdiction over such matters as appeals in patent cases arising in the district courts; appeals in patent and trademark matters arising in the Patent and Trademark Office; appeals and determinations of the International Trade Commission and the Court of International Trade; federal government contract disputes; and appeals from the new U.S. Claims Court.

The major goal of H.R. 4222 is to correct or improve certain areas relating to the jurisdiction of the CAFC that were overlooked during the consideration and passage of Public Law 97–164.

Before discussing subcommittee consideration of H.R. 4222 and the sectional analysis, it is appropriate to note that the Court of Appeals for the Federal Circuit has been considered by legal and judicial observers to be an initial success. The Chief Judge of the CAFC observed that ". . . operations of the Court . . . already have shown substantial promise." [2] A representative of the Administration seconded this thought by stating that ". . . by and large, the Federal Courts Improvement Act is working quite well. I think this is to the credit of the Congress, which spent so much time on the legislation, to the courts which were created, and to the bar of the courts." [3]

Through diligent oversight, the Committee—through the Subcommittee on Courts, Civil Liberties and the Administration of Justice—expects to monitor the development and maturation of both the CAFC and the Claims Court.

Statement

The Subcommittee on Courts, Civil Liberties and the Administration of Justice held one day of hearings on September 28, 1983, on H.R. 3824. Testimony was received from the Judicial Conference of the United States (Honorable Howard T. Markey, Chief Judge, U.S. Court of Appeals for the Federal Circuit), the United States Department of Justice (Honorable Stuart Schiffer, Deputy Assistant Attorney General, Civil Division), and the United States Department of Commerce (Honorable Rene D. Tegtmeyer, Assistant Commissioner of Patents). Written statements were received from a number of other sources.

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[1] For the pertinent legislative history of Public Law 97–164, *see* H. Rep. No. 97–312, 97th Cong., 1st Sess. (1981), and S. Rep. No. 97–275, 97th Cong., 1st Sess. (1981). Significant floor debate occurred in the Senate on Dec. 8, 1981 (127 Cong. Rec. S14683) and the House on Mar. 9, 1982 (128 Cong. Rec. H737). *See* Hearings on Industrial Innovation and Patent and Copyright Law Amendments Before the House Judiciary Subcommittee on Courts, Civil Liberties and the Administration of Justice, 96th Cong., 2d Sess. (1980); *see also* Hearings on Court of Appeals for the Federal Circuit (1981) Before the House Judiciary Subcommittee on Courts, Civil Liberties and the Administration of Justice, 97th Cong., 1st Sess. (1981).

[2] *See* Hearings on Technical Amendments to the Federal Courts Improvement Act of 1982 Before the House Judiciary Subcommittee on Courts, Civil Liberties and the Administration of Justice, 98th Cong., 1st Sess. 6 (1983) [hereinafter referred to as House Hearings] (statement of Howard T. Markey).

[3] *Id.* at 24 (statement of Stuart E. Schiffer).

On October 20, 1983, H.R. 3824 was marked-up, a quorum of Members being present. A technical amendment was offered by Chairman Kastenmeier, unanimously approved by the subcommittee; then H.R. 3824 was reported unanimously by voice vote to the full Committee in the form of a clean bill (H.R. 4222).

On February 28, 1984, the Committee, a quorum of Members again being present, by voice vote ordered the bill favorably reported.

Section-by-Section Analysis

Section 1 of the bill provides the title of the bill: the "Technical Amendments to the Federal Courts Improvement Act."

Section 2 of the bill amends 28 U.S.C. §§ 1292(b) and (c). Both of these sections deal with interlocutory appeals from district courts to the circuit courts of appeals. The Federal Courts Improvement Act of 1982 does not explicitly provide that interlocutory appeals on controlling questions of law certified from a district court could go to the CAFC. The CAFC, *en banc*, noted the gap in the law in its order entered in the case of *Harrington Manufacturing Co., Inc.* v. *Powell Manufacturing Co., Inc.* (June 22, 1983). This strict construction of the Court's jurisdiction—mandated in the Act's legislative history—created the unexpected situation of having interlocutory appeals in patent cases go to the geographic circuits and final appeals directed to the CAFC. Section 2 resolves this conflict by clarifying that the circuit court which has jurisdiction of an appeal has jurisdiction of the certification of a controlling question of law.

Section 3 [4] of the bill amends section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) to provide that an appeal from a final determination of the International Trade Commission must be taken within 60 days. In 1975 section 337 specified that appeals from determinations of the International Trade Commission were to be filed in the Court of Customs and Patent Appeals in accordance with the procedure for taking appeals from the Customs Court, that is, within 60 days.[5] In 1980, section 337 was amended to provide that appeals were to be taken in accordance with the Administrative Procedure Act; under the APA, however, the time for taking an appeal is set forth in the governing jurisdictional statute. The net effect of this change was to remove the 60 day time limit for appeal. *SSIH Equipment SA* v. *USITC*, 673 F.2d 1387 (CCPA 1982). By recodifying this drafting deficiency, the Federal Courts Improvements Act unwittingly continued the problem. The proposed amendment contained in section 3 reinserts the original 60 day time-period for taking an appeal from a determination of the International Trade Commission.

Section 4 of the bill simplifies the procedures on appeals from the Patent and Trademark Office to the CAFC mainly by eliminating the outmoded requirements of Titles 15 and 35, United States Code, that the appellant set forth "reasons of appeal" when the appeal is filed. Section 4 thus attempts to modernize the procedure before the CAFC, thereby conforming it with that of the other circuit courts of appeals and with modern notions of effective judicial administration.[6]

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[4] The genesis of section 3 is H.R. 1291, 98th Cong., 1st Sess. (1983), introduced by Mr. Frank.

[5] *See* 28 U.S.C. 2601(a).

[6] For further information about section 4, *see* letter of Jan. 16, 1984, from the Honorable Giles S. Rich to the Honorable W. Kastenmeier, *reprinted in* Appendix to House Hearings.

Section 4(a) of the bill amends sections 142, 143 and 144, Title 35, United States Code, not only to eliminate "reasons of appeal, but also to remove the burdensome requirement that the Commissioner of Patents and Trademarks shall transmit certified copies to the CAFC of all necessary papers and evidence. Since certification requires substantial expenditure of litigant and taxpayer expense, section 4(a) is a cost-saving provision.

Section 4(b) similarly amends sections 21(a)(2), (3) and (4) of the Lanham Act (15 U.S.C. § 1071(a)(2), (3), and (4)), which deal with appeals from the Patent and Trademark Office to the CAFC in trademark cases. The proposed amendments are virtually identical to those set forth in section 4(a) for patent cases.

Section 4(c) of the bill makes this section applicable to proceedings pending in the Patent and Trademark Office and to appeals pending in the CAFC.

Nothing in section 4 changes the present litigating authority of the United States Department of Justice.

Section 5 of the bill is a remedial grandfather provision. Public Law 97–164 eliminated the position of marshal for the Court of Appeals for the District of Columbia; it thereby removed a qualified individual from an existing position.[7] Section 5 merely provides that the individual who was serving as the marshal of the D.C. Circuit under section 713(c) of Title 28, U.S.C., may, after October 1, 1982 (the date of enactment of the Federal Courts Improvement Act), continues to so serve.[8]

Oversight Findings

Oversight of the Federal judicial system, including its structure and organization, is the responsibility of the Committee on the Judiciary. During the 96th and 97th Congresses, the Committee—through the Subcommittee on Courts, Civil Liberties and the Administration of Justice—held extensive hearings on proposals to create a U.S. Court of Appeals for the Federal Circuit from the pre-existing U.S. Court of Claims and the pre-existing U.S. Court of Customs and Patent Appeals.

Pursuant to clause 2(l)(3)(A) of rule XI of the Rules of the House of Representatives, the Committee issues the following fiinding:

It is the view of the Committee that Public Law 97–164—which created the new Court and which also improved Federal judicial machinery in other respects—has been well implemented, is working quite well, and shows substantial promise in terms of future development.

In regard to clause 2(l)(3)(B) of the Rules of the House of Representatives, no oversight findings have been submitted to the Committee by the Committee on Government Operations.

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[7] The individual in question has, however, was not forced to seek employment elsewhere. A new position was created on an interim basis in order to allow Congress time to clarify the situation. Section 5 therefore will have no budgetary impact.

[8] Section 5 was originally introduced as separate legislation in the form of H.R. 2609 (Kastenmeier). For further information about the section, *see* letter from the Honorable J. Skelly Wright to Honorable Robert W. Kastenmeier, *reprinted in* House Hearings, at 21.

New Budget Authority

In regard to clause 2(l)(3)(B) of rule XI of the Rules of the House of Representatives, the bill creates no new budget authority on increased tax expenditures for the Federal judiciary.

Inflationary Impact Statement

Pursuant to clause 2(l)(4) of rule XI of the Rules of the House of Representatives, the committee feels that the bill will have no foreseeable inflationary impact on prices or costs in the operation of the national economy.

Cost Estimate

In regard to clause 7 of rule XIII of the Rules of the House of Representatives, the committee agrees with the cost estimate of the Congressional Budget Office.

Statement of the Congressional Budget Office

Pursuant to clause 2(l)(3)(C) of rule XI of the Rules of the House of Representatives, and section 403 of the Congressional Budget Act of 1974, the following is the cost estimate on H.R. 4222 prepared by the Congressional Budget Office.

U.S. Congress,
Congressional Budget Office,
Washington, D.C., March 12, 1984.

Hon. Peter W. Rodino, Jr.,
Chairman, Committee on the Judiciary, U.S. House of Representatives, Rayburn House Office Building, Washington, D.C.

Dear Mr. Chairman: The Congressional Budget Office has reviewed H.R. 4222, the Technical Amendments to the Federal Court Improvements Act, as ordered reported by the House Committee on the Judiciary, February 28, 1984. We estimate that this bill would have no significant budget impact.

H.R. 4222 amends the Federal Court Improvement Act (Public Law 97-164), enacted April 2, 1982, and effective October 1, 1982. It states that the Court of Appeals which has jurisdiction of an appeal has jurisdiction of the certification of a controlling question of law. The bill provides that appeals following a final determination of the International Trade Commission must be taken within 60 days after the final determination. H.R. 4222 eliminates the appeal case requirement that appellants file "reasons of appeal" with the Patent and Trademark Office (PTO). In appeal cases, the bill no longer requires the PTO Commissioner to transmit certified copies of the documents comprising the case record to the Court of Appeals for the Federal Circuit (CAFC). Unless the CAFC requests the actual certified documents, a certified list of these documents is all that will be required. H.R. 4222 also restores to the position of Marshal for the Court of Appeals for the District of Columbia the individual who held that post on October 1, 1982.

If enacted, H.R. 4222 will not require any federal government expenditures. Based on information provided by the CAFC and the PTO, CBO estimates that some savings will be realized from reductions in processing costs incurred by the PTO and the CAFC. These savings are not expected to be significant.

Enactment of this bill would not affect the budgets of state and local governments.

If you wish further details on this estimate, we will be pleased to provide them.

Sincerely,

RUDOLPH G. PENNER, *Director.*

COMMITTEE VOTE

H.R. 4222 was reported by voice vote, a quorum of Members being present.

CHANGES IN EXISTING LAW MADE BY THE BILL, AS REPORTED

In compliance with clause 3 of Rule XIII of the Rules of the House of Representatives, changes in existing law made by the bill, as reported, are shown as follows (existing law proposed to be omitted is enclosed in black brackets, new matter is printed in italics, existing law in which no change is proposed is shown in roman):

SECTION 1292 OF TITLE 28, UNITED STATES CODE

§ 1292. Interlocutory decisions

(a) Except as provided in subsections (c) and (d) of this section, the courts of appeals shall have jurisdiction of appeals from:

(1) Interlocutory orders of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court;

(2) Interlocutory orders appointing receivers, or refusing orders to wind up receiverships or to take steps to accomplish the purposes thereof, such as directing sales or other disposals of property;

(3) Interlocutory decrees of such district courts or the judges thereof determining the rights and liabilities of the parties to admiralty cases in which appeals from final decrees are allowed.

(b) When a district judge, in making in a civil action an order not otherwise appealable under this section, shall be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation, he shall so state in writing in such order. The Court of Appeals *which would have jurisdiction of an appeal of such*

action may thereupon, in its discretion, permit an appeal to be taken from such order, if application is made to it within ten days after the entry of the order: *Provided, however*, That application for an appeal hereunder shall not stay proceedings in the district court unless the district judge or the Court of Appeals or a judge thereof shall so order.

(c) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

(1) of an appeal from an interlocutory order or decree described in subsection (a) *or* (*b*) of this section in any case over which the court would have jurisdiction of an appeal under section 1295 of this title; and

(2) of an appeal from a judgment in a civil action for patent infringement which would otherwise be appealable to the United States Court of Appeals for the Federal Circuit and is final except for an accounting.

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SECTION 337 OF THE TARIFF ACT OF 1930

SEC. 337. UNFAIR PRACTICES IN IMPORT TRADE.

(a) UNFAIR METHODS OF COMPETITION DECLARED UNLAWFUL.—

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(c) DETERMINATIONS; REVIEW.—The Commission shall determine, with respect to each investigation conducted by it under this section, whether or not there is a violation of this section. Each determination under subsection (d) or (e) shall be made on the record after notice and opportunity for a hearing in conformity with the provisions of subchapter II of chapter 5 of title 5, United States Code. All legal and equitable defenses may be presented in all cases. Any person adversely affected by a final determination of the Commission under subsection (d), (e) or (f) may appeal such determination, *within 60 days after the determination becomes final*, to the United States Court of Appeals for the Federal Circuit for review in accordance with chapter 7 of title 5, United States Code. Notwithstanding the foregoing provisions of this subsection, Commission determinations under subsections (d), (e), and (f) with respect to its findings on the public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers, the amount and nature of bond, or the appropriate remedy shall be reviewable in accordance with section 706 of title 5, United States Code.

(d) EXCLUSION OF ARTICLES FROM ENTRY.—If the Commission determines, as a result of an investigation under this section, that there is violation of this section, it shall direct that the articles concerned, imported by any person violating the provision of this section, be excluded from entry into the United States, unless after considering the effect of such exclusion upon the public health and welfare, competitive conditions in the United States economy, the production

of like or directly competitive articles in the United States, and United States consumers, it finds that such articles should not be excluded from entry. The Commission shall notify the Secretary of the Treasury of its action under this subsection directing such exclusion from entry, and upon receipt of such notice, the Secretary shall, through the proper officers, refuse such entry.

(e) EXCLUSION OF ARTICLES FROM ENTRY DURING INVESTIGATION EXCEPT UNDER BOND.—If, during the course of an investigation under this section, the Commission determines that there is reason to believe that there is a violation of this section, it may direct that the articles concerned, imported by any person with respect to whom there is reason to believe that such person is violating this section, be excluded from entry into the United States, unless, after considering the effect of such exclusion upon the public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers, it finds that such articles should not be excluded from entry. The Commission shall notify the Secretary of the Treasury of its action under this subsection directing such exclusion from entry, and upon receipt of such notice, the Secretary shall, through the proper officers, refuse such entry, except that such articles shall be entitled to entry under bond determined by the Commission and prescribed by the Secretary.

(f) CEASE AND DESIST ORDERS.—(1) In lieu of taking action under subsection (d) or (e), the Commission may issue and cause to be served on any person violating this section, or believed to be violating this section, as the case may be, an order directing such person to cease and desist from engaging in the unfair methods or acts involved, unless after considering the effect of such order upon the public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers, it finds that such order should not be issued. The Commission may at any time, upon such notice and in such manner as it deems proper, modify or revoke any such order, and, in the case of a revocation, may take action under subsection (d) or (e), as the case may be.

(2) Any person who violates an order issued by the Commission under paragraph (1) after it has become final shall forfeit and pay to the United States a civil penalty for each day on which an importation of articles, or their sale, occurs in violation of the order of not more than the greater of $10,000 or the domestic value of the articles entered or sold on such day in violation of the order. Such penalty shall accrue to the United States and may be recovered for the United States in a civil action brought by the Commission in the Federal District Court for the District of Columbia or for the district in which the violation occurs. In such actions, the United States district courts may issue mandatory injunctions incorporating the relief sought by the Commission as they deem appropriate in the enforcement of such final orders of the Commission.

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TITLE 35, UNITED STATES CODE

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PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

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CHAPTER 13—REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS

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[§ 142. Notice of appeal

[When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner and shall file in the Patent and Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.]

§ 142. Notice of appeal

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

[§ 143. Proceedings on appeal

[The United States Court of Appeals for the Federal Circuit shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall 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 in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent and Trademark Office, in writing, touching all the points involved by the reasons of appeal.]

§ 143. Proceedings on appeal

With respect to an appeal described in section 142 of this title, the Commissioner shall 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. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to the court in writing the grounds for the decision of the 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 Commissioner and the parties in the appeal.

[§ 144. Decision on appeal

[The United States Court of Appeals for the Federal Circuit, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern the further proceedings in the case.]

§ 144. Decision on appeal

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Commissioner its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

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SECTION 21 OF THE ACT OF JULY 5, 1946

AN ACT To provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes

SEC. 21. (a) (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 8, or an applicant for renewal, who is dissatisfied with the decision of the Commissioner 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 section 21(b) hereof: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Commissioner, shall, within twenty days after the appellant has filed notice of appeal according to section 21(a) (2) hereof, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 21(b) hereof. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under said section 21(b), in default of which the decision appealed from shall govern the further proceedings in the case.

[(2) Such an appeal to the United States Court of Appeals for the Federal Circuit shall be taken by filing a notice of appeal with the Commissioner, within sixty days after the date of the decision appealed from or such longer time after said date as the Commissioner appoints. The notice of such appeal shall specify the party or parties taking the appeal, shall designate the decision or part thereof appealed from, and shall state that the appeal is taken to said court.

[(3) The court shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall 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 in an ex parte case the Commissioner shall furnish the court with a brief explaining the grounds of the decision of the Patent and Trademark Office, touching all the points involved in the appeal.

[(4) The court shall decide such appeal on the evidence produced before the Patent and Trademark Office. The court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern 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 Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

(3) The Commissioner shall 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. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to the court a brief explaining the grounds for the decision of the 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 Commissioner 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 Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

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