



DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 90

[Docket No. PTO-C-2024-0011]

RIN 0651-AD78

Electronic Submission of Notices of Appeal to the United States Court of Appeals for the Federal Circuit, Notices of Election, and Requests for Extension of Time for Seeking Judicial Review

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (USPTO) issues this final rule to incorporate changes to the patent and trademark rules regarding judicial review of agency decisions, in particular how a notice of appeal to the United States Court of Appeals for the Federal Circuit, a notice of election to proceed by civil action in district court, and a request for extension of time for filing a notice of appeal or commencing a civil action must be filed. This final rule states that a notice of appeal, notice of election, and a request for extension of time for filing a notice of appeal or commencing a civil action must be filed with the Director of the USPTO by email, and in the event a request cannot be filed by email, it may be filed by Priority Mail Express®.

DATES: This rule is effective on [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].

FOR FURTHER INFORMATION CONTACT: Mai-Trang Dang or Monica Lateef, Office of the Solicitor, at 571-272-9035, or at mai-trang.dang@uspto.gov or monica.lateef@uspto.gov.

SUPPLEMENTARY INFORMATION:

The USPTO is revising 37 CFR 90.2, 90.3 and 2.145 to incorporate changes as to how a notice of appeal, a notice of election to proceed by civil action in district court, and a request for extension of time to file a notice of appeal or commence a civil action are to be filed with the Director of the USPTO. Prior to this final rule, appellants were required to file by mail or by delivery by hand to the address provided at 37 CFR 104.2. Under this final rule, the USPTO revises the regulations to allow for filings by email and by priority mail delivery to a new address. Specifically, this rule states that notices of appeal, notices of election, and requests for extension of time to file a notice of appeal or commence a civil action must be filed by email at the email address indicated on the USPTO's webpage for the Office of the General Counsel for filing such notices and requests. If there is some circumstance in which email cannot be used, the rule provides that said notices and requests may be sent by Priority Mail Express®. This change will ensure that the USPTO receives said notices and requests reliably and promptly. The USPTO is also making a technical amendment to § 90.3(c)(1) to remove the pronoun "his" in reference to the Director and replace it with "the Director."

Discussion of Regulatory Changes

The USPTO is revising §§ 2.145(a)(2)(i), (b)(2)(i) and (e)(2), 90.2(a)(1) and (b)(1), and 90.3(c)(2) to require notices of appeal, notices of election, and requests for extension of time to file a notice of appeal or commence a civil action, under those provisions, to be filed by email, or by Priority Mail Express®. The USPTO is revising § 90.3(c)(1) to incorporate a technical amendment.

Rulemaking Requirements

A. Administrative Procedure Act: The changes proposed by this rulemaking involve rules of agency practice and procedure, and/or interpretive rules, and do not require notice-and-comment rulemaking. *See Perez v. Mortg. Bankers Ass'n*, 575 U.S. 92, 97, 101 (2015) (explaining that interpretive rules "advise the public of the agency's construction of the

statutes and rules which it administers” and do not require notice and comment when issued or amended); *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice-and-comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”); and *JEM Broadcasting Co. v. F.C.C.*, 22 F.3d 320, 328 (D.C. Cir. 1994) (explaining that rules are not legislative because they do not “foreclose effective opportunity to make one’s case on the merits”).

In addition, the Office finds good cause pursuant to the authority at 5 U.S.C. 553(b)(B) and (d)(3) to dispense with prior notice and opportunity for public comment and a 30-day delay in effectiveness because such procedures are unnecessary in this instance. The changes in this rulemaking merely revise the regulations to provide expanded methods for submitting a notice of appeal, a notice of election, and a request for extension of time to file a notice of appeal to the Director of the USPTO. These changes ensure that the USPTO receives said notices and requests reliably and promptly. These revisions are largely procedural in nature and do not impose any additional requirements or fees on applicants. Thus, the USPTO implements this final rule without prior notice and opportunity for comment, or a 30-day delay in effectiveness.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility Act analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (September 30, 1993), as amended by Executive Order 14094 (April 6, 2023).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (January 18, 2011). Specifically, and

as discussed above, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking pertains strictly to federal agency procedures and does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes, (2) impose substantial direct compliance costs on Indian tribal governments, or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (November 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (February 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (April 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (March 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rulemaking are not expected to result in an annual effect on the economy of \$100 million or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rulemaking is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of \$100 million (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of \$100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are

necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

O. Paperwork Reduction Act of 1995: This final rule does not involve information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.).

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information has a currently valid OMB control number.

P. E-Government Act Compliance: The USPTO is committed to compliance with the E-Government Act to promote the use of the internet and other information technologies, to provide increased opportunities for citizen access to Government information and services, and for other purposes.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

37 CFR Part 90

Administrative practice and procedure, Inventions and patents, Lawyers.

For the reasons stated in the preamble, the USPTO amends 37 CFR parts 2 and 90 as follows:

PART 2 – RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for part 2 continues to read as follows:

Authority: 15 U.S.C. 1113, 1123; 35 U.S.C. 2; sec. 10, Pub. L. 112–29, 125 Stat. 284; Pub. L. 116–260, 134 Stat. 1182, unless otherwise noted. Sec. 2.99 also issued under secs. 16, 17, 60 Stat. 434; 15 U.S.C. 1066, 1067.

2. Section 2.145 is amended by revising paragraphs (a)(2)(i), (b)(2)(i) and (e)(2) to read as follows:

§ 2.145 Appeal to court and civil action.

(a) * * *

(2) * * *

(i) File the notice of appeal with the Director by electronic mail sent to the email address indicated on the United States Patent and Trademark Office’s webpage for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450;

* * * * *

(b) * * *

(2) * * *

(i) File a notice of election with the Director by electronic mail sent to the email address indicated on the United States Patent and Trademark Office's webpage for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450;

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(e) * * *

(2)(i) The request must be filed with the Director by electronic mail sent to the email address indicated on the United States Patent and Trademark Office's webpage for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® or by means at least as fast and reliable as Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(ii) A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.

PART 90—JUDICIAL REVIEW OF PATENT TRIAL AND APPEAL BOARD DECISIONS

3. The authority citation for part 90 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

4. Section 90.2 is amended by revising paragraphs (a)(1) and (b)(1) to read as follows:

§ 90.2 Notice; service.

(a) * * *

(1)(i) In all appeals, the notice of appeal required by 35 U.S.C. 142 must be filed with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's webpage for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(ii) A copy of the notice of appeal must also be filed with the Patent Trial and Appeal Board in the appropriate manner provided in §§ 41.10(a), 41.10(b), or 42.6(b) of this chapter.

* * * * *

(b) * * *

(1) Pursuant to 35 U.S.C. 141(d), if an adverse party elects to have all further review proceedings conducted under 35 U.S.C. 146 instead of under 35 U.S.C. 141, that party must file a notice of election with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's webpage for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® to the Office of the Solicitor, United

States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia
22313-1450.

* * * * *

5. Section 90.3 is amended by revising the paragraphs (c)(1) introductory text and (c)(2) to read as follows:

§ 90.3 Time for appeal or civil action.

* * * * *

(c) * * *

(1) The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

* * * * *

(2) The request must be filed with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's webpage for the Office of the General Counsel. This electronically submitted request will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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