

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR

In re Snap Inc.,

Applicant.

Decision on Request for Extension of
Time under 37 C.F.R. § 2.145(e)

Appls. Ser. Nos. 87177292, 87211997

MEMORANDUM AND ORDER

On December 8, 2021, Applicant, Snap Inc., filed a request for an extension of time of sixty-one (61) days beyond the January 5, 2022 deadline (i.e., through and including March 7, 2022) within which to seek judicial review of the Trademark Trial and Appeal Board’s November 3, 2021, final decision in this case. The Director denied the request without prejudice because the December 8 request failed to set forth a reason why the 63-day period provided in 37 C.F.R. § 2.145(d) for determining whether and where to seek judicial review was inadequate.

On December 16, 2021, Applicant renewed its request, seeking a more modest extension of twenty-one days, through and including January 26, 2021. As explained below, the request is GRANTED.

Background

37 C.F.R. § 2.145(d) provides a disappointed applicant “sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board” within which to seek judicial review under either 15 U.S.C. § 1071(a) (appeal) or § 1071(b) (civil action). If a written request for an extension is filed before the period in section

2.145(d) expires, the Director assesses the request under the good cause standard. 37 C.F.R. § 2.145(e)(i). If the request is filed after the expiration of the time for seeking judicial review, the Director assesses it under the more stringent excusable neglect standard. 37 C.F.R. § 2.145(e)(ii). The Board's final decision was mailed on November 3, 2021, making the filing of any appeal or of any civil action challenging such decision due no later than January 5, 2022. Accordingly, this request for an extension of time is timely and the Director will assess whether Applicant has met the good cause standard.

In its December 8 request, Applicant stated that the reason for the requested extension is that it needs “additional time to obtain and evaluate new evidence to potentially introduce in a civil action, and to evaluate whether an appeal should be taken and, if so, whether it should be by way of a civil action or the Federal Circuit.” After the Director denied that request without prejudice, Applicant filed a renewed request, stating that the Board's November 3, 2021, decision “invited” Applicant to conduct and submit a consumer survey and that Applicant thereafter sought to identify a “suitable survey expert” to design, conduct, and review a survey for potential submission in a district court action under 15 U.S.C. § 101(b). Applicant's renewed motion further stated that, due to the fact that the 63-day period to seek judicial review encompassed the Thanksgiving, Christmas, and New Year's holidays, Applicant's “potential expert witnesses do not think they will be able to deliver their final results by January 5, 2022,” which is the final day for seeking judicial review.

Discussion

Because the December 8, 2021, order explained the “good cause” standard, this order will not repeat it, except to note that Rule 2.145(d) reflects the USPTO’s judgment that, ordinarily, 63 days is sufficient time to complete the tasks necessary to determine whether to seek judicial review and, if so, whether to do so in the Court of Appeals for the Federal Circuit under 15 U.S.C. § 1071(a) or in district court under 15 U.S.C. § 1071(b). Whether to augment the record by, for example, conducting a consumer survey for submission to a district court falls squarely within the tasks normally contemplated by dissatisfied applicants faced with section 1071’s choice of routes for seeking judicial review. In this case, the bases for refusal of Applicant’s applications were that the marks are “generic for the identified goods, and, alternatively, that [they are] highly descriptive and ha[ve] not acquired distinctiveness.”

13 TTABVue 32. Surveys have, for many decades, been specifically identified as potentially persuasive evidence in determining whether proposed marks are generic or have acquired distinctiveness. *See U.S. Patent and Trademark Office v. Booking.com BV*, 140 S. Ct. 2298, 2307 n.6 (2020) (noting that “[s]urveys can be helpful evidence of consumer perception”); *see also Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979) (identifying “consumer surveys” as “useful evidence” for determining genericness); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1345 (CCPA 1977) (noting the absence of “persuasive evidence” of a proposed mark’s secondary meaning “such as might be shown by a consumer

survey”). Thus, the potential usefulness of consumer surveys cannot be said to be a surprise to Applicant as a result of the TTAB’s decision, but rather was apparent during prosecution, when the genericness and/or lack of acquired distinctiveness refusals were made.

Applicant states that the TTAB “invited” Applicant to conduct and submit surveys, but no such “invitation” appears in the record. The TTAB’s decision in the case noted the longstanding legal proposition that surveys can be useful evidence in cases raising issues of acquired distinctiveness and/or genericness, and further observed that Applicant had not submitted one during prosecution.

Applicant also represents that “Applicant’s potential expert witnesses do not think they will be able to deliver their final [survey] results by January 5, 2022.” But there is no requirement or necessity that the “final results” of a survey to be submitted to a district court be completed at the time the disappointed applicant files its complaint contesting the Board’s decision. Any such evidence would need to be submitted only at such time as the district court’s scheduling/discovery order(s) specify, or when the Federal Rules of Civil Procedure require, such as on a summary judgment motion under Rule 56(c) or at trial.

However, because the period for seeking judicial review in this particular case encompasses three major legal holidays, a circumstance that complicates the logistics of conducting a survey, and because Applicant’s renewed request seeks a more

modest extension of twenty-one days, the request is granted. The time within which to seek judicial review is extended through and including January 26, 2022.

ANDREW HIRSHFELD,

*Performing the functions and duties of the Under
Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark
Office*

Date: January 5, 2022

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