Preface

In the first and second editions, this space was devoted to how A Legal Strategist’s Guide to Trademark Trial and Appeal Board Practice was conceived and updated. I, the chapter authors, and ABA Publishing very much appreciate the many compliments this treatment of Trademark Trial and Appeal Board (the TTAB or Board) practice has received. Collectively, we are gratified that the prior editions have become a staple on the bookshelves of TTAB litigators. We hope that you find this third edition to be an equally thorough yet concise up-to-date treatment of the procedural and substantive aspects of Board practice.

While the chapter manuscripts for this third edition were being written, the United States Supreme Court delivered Trademark Board practitioners a gift whose significance and ramifications may not be fully known for many years to come. The Supreme Court’s present came in the form of its decision in B&B Hardware, Inc. v. Hargis Industries, Inc., 575 U.S. ___, 135 S. Ct. 1293, 113 U.S.P.Q.2d 2045 (2015). In B&B Hardware, the Supreme Court held that “[s]o long as the other ordinary elements of issue preclusion are met, when the [parties’ trademark] usages adjudicated by the TTAB are materially the same as those before a district court, issue preclusion should apply.” 135 S. Ct. at 1310.

Equally beneficial as the Supreme Court’s holding in B&B Hardware was the Court’s explanations of the benefits of federal trademark registration, the trademark application process, the nature of opposition proceedings before the TTAB, and the comparison of Board proceedings to trademark infringement litigation. 135 S. Ct. at 1300–01. The Court’s opinion is worth reading for these passages alone.

The Court’s recitation of the issue preclusion factors was rather rudimentary. Citing the Restatement (Second) of Judgments § 27, at 250 (1980), the Court stated that “the general rule is that ‘[w]hen an issue of fact or
law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.” 135 S. Ct. at 1303. Where the Court broke new ground, at least in the trademark litigation arena, is its follow-on statement that “issue preclusion is not limited to those situations in which the same issue is before two courts. Rather, where a single issue is before a court and an administrative agency, preclusion also often applies.” Id.

The Supreme Court’s treatment of issue preclusion in this respect “reflects the Court’s longstanding view that ‘[w]hen an administrative agency is acting in a judicial capacity and resolves disputed issues of fact properly before it which the parties have had an adequate opportunity to litigate, the courts have not hesitated to apply res judicata to enforce repose.’” 135 S. Ct. at 1303.

The Court cautioned, however, that many registration decisions issued by the TTAB will not meet the ordinary elements of issue preclusion. 135 S. Ct. at 1306. For example, “if the TTAB does not consider the marketplace usage of the parties’ marks, the TTAB’s decision should have no later preclusive effect in a suit where actual usage in the marketplace is the paramount issue.” 135 S. Ct. at 1308. “[M]oreover, if the TTAB has not decided the same issue as that before the district court, there is no reason why any deference [to the Board’s decision] would be warranted.” Id. However, “this only suggests that sometimes issue preclusion might be inappropriate, not that it always is.” 135 S. Ct. at 1309.

So when would a TTAB decision be given preclusive effect in a later trademark infringement action? The easiest case for issue preclusion would be, for example, a use-based application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), opposed—on priority and likelihood of confusion grounds—by the owner of a use-based trademark registration issued under the same statutory provisions. See Trademark Act §§ 2(d) and 13(a), 15 U.S.C. §§ 1052(d) and 1063(a). Another case for issue preclusion might be a use-based registration sought for cancellation by the owner of common-law prior rights to a confusingly similar mark, and the targeted registration has not yet been registered for five years. See Trademark Act §§ 2(d) and 14(1), 15 U.S.C. §§ 1052(d) and 1064(1).

More difficult scenarios for issue preclusion to apply include (1) an opposition against an intent-to-use-based application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), or (2) an opposition brought by the owner of, or a cancellation proceeding brought against, a U.S. registration issued pursuant to foreign rights under Trademark Act § 44, 15 U.S.C. § 1126, which has not reached the time by which the owner must submit proof of use pursuant to Trademark Act § 8, 15 U.S.C. § 1058 (that is, between
the fifth and sixth year from registration). The combination of scenarios in which issues decided by the TTAB would (or would not) qualify for issue preclusion in subsequent trademark infringement litigation are too numerous to mention here.

The types of trademark disputes over which the TTAB has jurisdiction are finite. For example, the Board does not have the authority to decide claims for trademark or copyright infringement or unfair competition, nor does it have the authority to award damages or injunctive relief. Trademark Board Manual of Procedure (TBMP) § 102.01 (citing numerous cases). Given its limited jurisdiction, the Board in past decisions has lamented the size of the evidentiary records parties have submitted in trademark registrability proceedings. See TBMP § 702.05; UMG Recordings Inc. v. Mattel Inc., 100 U.S.P.Q.2d 1868, 1873 (T.T.A.B. 2011) (overly large records tax the resources of the Board and are entirely unnecessary); General Mills Inc. v. Fage Dairy Processing Industry SA, 100 U.S.P.Q.2d 1584, 1591–92 (T.T.A.B. 2011) (in which the Board expressed frustration with the sizeable record and overzealous litigation).

Issuance of the Supreme Court’s B&B Hardware decision thus raises the question: Will the Board be forced to reckon with larger evidentiary records, given the possible collateral estoppel effect of its decisions in subsequent infringement litigation? Only time will tell.

As a reminder to the reader, this third edition is an updated treatment of Board proceedings. It is a multiauthor analysis of practice before the TTAB, including inter partes proceedings, ex parte proceedings, appeals from final decisions of the Board, and the ethics of practicing before that administrative body. At the end of every chapter is a checklist of items that the practitioner should bear in mind during each stage of a Board proceeding.

Once more, I would like to thank each of the chapter authors, two of whom are former TTAB judges, whose continuing dedication and hard work brought this third edition to fruition. I also wish to thank the 2014–2015 Chair of the ABA-IPL Section, Lisa Dunner, and the Chair and Vice-Chair of the ABA-IPL Section Books Editorial Board, Mark Dickson and Stephen Gillen, as well as the publishing staff of the ABA-IPL Section, for their continuing support, which enabled this third edition to be published.

Finally, and as always, I wish to thank my family, my wife Betsey and my sons Aron and Justin, who have supported me throughout my career and in particular while the third edition of this book was being updated and edited.

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Editor