March 10, 2020

Hon. Gerard F. Rogers
Chief Administrative Trademark Judge
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Issuance of Precedential Decisions by The Trademark Trial and Appeal Board

Dear Chief Judge Rogers:

The American Bar Association Section of Intellectual Property Law (“ABA-IPL”) thanks the United States Patent and Trademark Office for its continued attention to the issuance of precedential decisions by the Trademark Trial and Appeal Board, including Your Honor’s and Deputy Chief Judge Thurman’s participation in the productive November 22, 2019, meeting with representatives of the ABA-IPL, the International Trademark Association and the American Intellectual Property Law Association in Austin, Texas. The views expressed herein are presented on behalf of the Section and have not been approved by the House of Delegates or the Board of Governors of the American Bar Association. Accordingly, they should not be construed as representing the position of the ABA.

Since 1894, the ABA-IPL Section has advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for diverse perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves within the ABA as a highly respected voice within the intellectual property profession, before policy makers, and with the public.

For the reasons set forth in the ABA-IPL’s October 2019 letter addressing this issue and at the November 2019 meeting, the ABA-IPL continues to believe that the Board should increase its number of precedential
decisions issued, which would ensure consistency with Board procedures and promote more efficient and more effective practice that takes into account current market realities. An increase in precedential rulings would provide substantial guidance and lead to more integrity in legal practice and, ultimately, more integrity in the trademark Registers and Board case law. The additional guidance will also permit attorneys to provide better legal advice and reduce uncertainty for current and potential trademark owners.

The ABA-IPL supports the additional actions suggested by the Board that could potentially increase the number of precedential decisions and/or provide additional guidance to both practitioners and the Board, including (1) issuance of partially precedential decisions; (2) creation of a new “informative” designation for decisions; and (3) consideration of whether changes in the timing of the decisions would affect the amount and quality of precedential decisions. At the request of Your Honor and Deputy Chief Judge Thurman, the ABA-IPL’s view on each of these suggestions is addressed in more detail below.

1. The ABA-IPL Supports Partial Precedential Decisions.

The ABA-IPL supports the issuance of partially precedential decisions by the Board, i.e., decisions that are precedential on one or more issues and non-precedential with respect to others. The ABA-IPL understands from our November 2019 meeting that the Board believes that this action will increase the number of precedential decisions, especially in the case of complex, multi-issue matters; to the extent that the Board can designate some of those issues as precedential – but not others – the bar likely will see an uptick in issues deemed precedential.

As set out in our October 2019 letter, our research confirms that the Board has been less likely to treat a decision as precedential if it has multiple issues/claims or complex fact patterns. The ABA-IPL therefore supports partial designations, which seem likely to lead to additional precedential decisions touching upon complex fact patterns and/or overlapping issues and thereby increasing both the quantity and quality of guidance received from Board jurisprudence. The ABA-IPL does urge the Board to designate entire legal issues as precedential, e.g. likelihood of confusion, rather than parsing out sub-issues, e.g., designating only the channel of trade analysis in the likelihood-of-confusion section as precedential, and continue to consider designating entire decisions – even in complex, multi-issue matters – as precedential and ensure that the ability to partially designate does not thwart such a result when otherwise warranted. While partial designations will certainly be helpful, they, of course, will not be as useful as fully precedential decisions.

The ABA-IPL further recommends that, to the extent the Board adopts this approach, it consider organizing its webpage in a manner similar to that of the Patent Trial and Appeal Board (“PTAB”), which contains searchable categories allowing practitioners to readily gain a sense of which issues in each decision are precedential.
2. **The ABA-IPL Supports an “Informative” Category of Decisions.**

The ABA-IPL similarly supports the Board creating a new category of “informative” decisions to the extent such designations will lead to more guidance for both practitioners and the Board. We understand the Board would model this new “informative” designation off of the PTAB’s category of “informative” decisions, which, while not binding on the PTAB, sets forth “norms that should be followed [by the PTAB] *in most cases, absent justification.*” See PTAB Standard Operating Procedure 2 (Revision 10), available at https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf (emphasis added). To the extent this approach has successfully produced consistent opinions more readily followed by PTAB judges, the ABA-IPL would welcome the TTAB’s adoption of it.

While ABA-IPL strongly prefers decisions that are actually binding on the Board, it supports this new designation so long as the TTAB judges are committed to following such decisions “in most cases” to provide more guidance to the bar. If adopted, the ABA-IPL encourages the Board to work with stakeholders to develop criteria for its judges to better define the “justifications” for declining to follow an informative decision. We believe this would increase the effectiveness of such a designation.

3. **The Board Should Designate Decisions at the Time Most Likely to Lead to More Quality Precedent.**

In addition to addressing the above issues, the Board asked the ABA-IPL to weigh in on its preferred timing for the designation of precedential decisions. In particular, the Board asked whether the ABA-IPL supports the TTAB’s current process of reviewing decisions for potential precedential decisions before a decision is issued, which the Board believes leads to better quality decisions, or whether the ABA-IPL would prefer a post-mailing review process similar to that of the PTAB. The ABA-IPL does not have an opinion on which process should be used, but urges the Board to please select whichever process will lead to a higher number of quality precedential decisions.

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Thank you again for Your Honor’s and the USPTO’s attention to this matter. The ABA-IPL looks forward to continued conversation with the USPTO and Board on this important issue. If there are any further questions, or it would be helpful to hold additional meetings to address these issues, please feel free to contact me. Either I or another Section leader will gladly respond and participate.

Sincerely,

George W. Jordan III
Chair, ABA Section of Intellectual Property Law