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 (“USPTO”) for the opportunity to present its position on the issuance of precedential decisions by the Trademark Trial and Appeal Board (“TTAB” or the “Board”). The views expressed herein are presented on behalf of the Section of Intellectual Property Law. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the position of the Association.

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 rich 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. The ABA-IPL Section membership includes attorneys who represent trademark owners, trademark users, accused infringers, small corporations, universities, and research institutions across a wide range of industries.

The Section believes that the Board should increase its number of precedential decisions issued, and it appreciates this opportunity to present some empirical data on recent trends regarding the issuance of precedential TTAB decisions. The data underscore just how important-precedential decisions are to virtually every aspect of trademark practice, both in TTAB proceedings and in counselling clients. The data also highlight a few of the more salient policy reasons supporting the Board’s efforts to continue to issue meaningful precedential decisions and, to the extent possible, to increase the number of those decisions issued annually.
By brief way of statistical background, the Section conducted a review of all Board decisions issued from 2013 through 2018 that were designated “Citable as Precedent.” According to that research, in fiscal year 2018, the Board issued 585 *ex parte* and *inter partes* decisions on the merits, of which 39 (approximately 6.6%) were designated “Citable as Precedent.” Consistent with this finding, in fiscal years 2013-2018, the Board issued a total of 234 precedential *ex parte* and *inter partes* decisions, which was an average of 4-6% per year. Generally, the Board has been issuing precedential decisions at a rate of approximately 35-45 decisions annually.

Our research also revealed that precedential decisions have been less common in cases involving certain areas of trademark law—including geographical descriptiveness and misdescriptiveness under Sections 2(e)(2) & 2(e)(3), compulsory and voluntary disclaimers under Section 6, and the loss of rights in a certification mark under Section 14(5)—and of those that have been issued on these points, decisions are often years or sometimes decades old. In certain cases, the utility of these older decisions has diminished over time due to changes in technology, use, market realities and other factors. While the Section agrees that older decisions are not necessarily infirm, the market conditions described in these older opinions may no longer reflect how business is currently conducted in the relevant industries. Therefore, the Section believes that the increased issuance of current decisions on these points of law would be very useful to ensure consistency with Board procedures, provide relevant fact patterns for current litigants and provide current guidance on relevant laws.

There are a number of sound policy reasons for issuing precedential *ex parte* and *inter partes*, including multi-issue decisions. One such reason is that additional precedential decisions promote better, more efficient and more effective practice. Increasing the number of precedential Board decisions would have a positive effect on trademark practice as a whole by providing meaningful and relevant interpretation of existing legal principles and procedures. According to our research, the current availability of citable decisions reveals some areas of law where meaningful precedent is lacking and indicates the need for additional cases to aid practitioners with interpreting current Board rules and legal principles.

Precedential decisions create the potential for the development of *stare decisis* and traceable lines of developing law. This is especially important when considering Board jurisprudence as it intersects with federal court litigation. For example, the Supreme Court’s holding in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 134 S. Ct. 2899 (2014), highlights the increased significance of Board decisions, as they may serve as a potential barrier to bringing claims in separate court proceedings or may otherwise substantively impact the issues to be decided in those proceedings. Increased numbers of precedential Board decisions will enable parties to better determine whether to pursue trademark claims in federal court or at the Board, and also improve education and awareness of developing principles in trademark law and practice.

A second sound policy reason weighing in favor of increasing the number of precedential Board decisions is that aging decisions do not necessarily reflect market realities. Additional decisions also provide practitioners and Trademark Office examining attorneys with more developed case law that can evolve as changes in marketplace forces and
technology occur. In particular, the age of many of the decisions being cited indicates the need for more relevant guidance. In certain areas of law – such as the interpretation of “use in commerce” under the Lanham Act – modern decisions that reflect the realities of 21st century global commerce would allow for better and more reliable interpretation of the law as it applies to use, appropriate specimens and the promotion and distribution of goods and services in today’s market. Considering the small number of precedential opinions issued, examining attorneys and practitioners often need to rely on older cases that do not necessarily match existing commercial realities or market trends. Issuing more precedential opinions would give examining attorneys and practitioners more relevant guidance based on fact patterns that more closely resemble the commercial framework in which trademark law operates today.

Lastly, precedential decisions need not be limited to just one issue, and thus the utility of such decisions could be spread across a number of different issues that often present themselves to practitioners and examiners simultaneously. In connection with its research, we noted the simplicity of past precedential decisions and the need for decisions in cases involving complex facts and/or overlapping issues. Our research of the Board's body of precedential decisions suggests that the Board is less likely to treat a decision as precedential if it has multiple issues/claims or complex fact patterns. Instead of limiting Board precedents to single-issue decisions, examining attorneys and practitioners would benefit from precedential decisions that consider multiple – and especially overlapping – issues. The reality is that most cases will not be limited to one specific issue. Excluding complex decisions from the stable of precedential case law risks limiting both the quantity and quality of guidance received from Board jurisprudence.

The Section is proud to join with other professional organizations and stakeholders in supporting the Board’s efforts to increase the annual number of meaningful precedential decisions. An increase in precedential rulings would provide substantial guidance leading to more integrity in legal practice and, ultimately, more integrity in the Trademark Register and Board case law.

If you have any questions or would like to discuss any of these comments, please feel free to contact me. Either I or another Section leader will gladly respond.

Sincerely,

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

cc: Andrei Iancu