International Trademark Association

675 Third Avenue, 3rd Floor
New York, NY 10017-5704, USA
t: +1-212-642-1700 | f: +1-212-768-7796
inta.org | info@inta.org

The Honorable Gerard F. Rogers
Chief Administrative Trademark Judge, USPTO
600 Dulany Street, Alexandria, VA

The Honorable Marc A. Thurmon
Deputy Chief Administrative Trademark Judge, USPTO
600 Dulany Street, Alexandria, VA

Date: November 6, 2019

Dear Chief Judge Rogers and Deputy Chief Judge Thurmon:

The International Trademark Association ("INTA") is very pleased to be welcoming Deputy Chief Judge Thurmon as the TTAB representative at our Leadership Meeting in Austin this November and especially happy that he will be joining us to discuss the topic of TTAB Precedential Decisions on Thursday, November 21st, from 11:00 a.m. to 1:00 p.m. We are working on arrangements to have Chief Judge Rogers attend the meeting via conference call, and we also invited the ABA to attend, as they are interested in this topic as well. A lunch will be served at noon.

In anticipation of our meeting, attached is a report prepared at INTA's direction by the INTA Task Force on TTAB Precedential Decisions. As set forth in the report, INTA urges the TTAB to make changes that would result in substantially more precedential decisions, including particularly precedential decisions that involve multi-issue and factually complex matters.

We very much look forward to discussing this subject with you on November 21st. Thank you for your willingness to consider this important topic.

Best regards,

Etienne Sanz de Acedo
CEO

International Trademark Association

675 Third Avenue, 3rd Floor
New York, NY 10017-5704, USA
t: +1-212-642-1700 | f: +1-212-768-7796
inta.org | info@inta.org

INTERNATIONAL TRADEMARK ASSOCIATION

Enforcement Committee
Opposition & Cancellation Standards & Procedures Subcommittee

Task Force on TTAB Precedential Decisions

October 2019

EXECUTIVE SUMMARY

The Supreme Court confirmed the virtues of *stare decisis*, finding that it "promotes the evenhanded, predictable, and consistent development of legal principles, fosters reliance on judicial decisions, and contributes to the actual and perceived integrity of the judicial process."[1] But the doctrine of *stare decisis* only properly functions with a robust body of precedent.

The Trademark Trial and Appeal Board ("TTAB") is the preeminent decision-making body with respect to trademark matters. The importance of the TTAB to general jurisprudence has only increased since the Supreme Court's decision in *B&B Hardware, Inc. v. Hargis Industries, Inc.*[2] Yet, the TTAB continues to lag behind the federal judiciary with respect to the quantity of precedential decisions.

Since 2012, only a total of 287 of 4,645 decisions, or 6.18%, were designated precedential. By contrast, in 2018, 40.6% of the written and signed opinions from the U.S. Courts of Appeals were published, and 11.8% of all U.S. Courts of Appeals opinions and orders were published.[3]

The International Trademark Association ("INTA") urges the TTAB to substantially increase the number of decisions it designates as precedential.[4] This will, in turn, improve the

---

[1] *Kimble v. Marvel Enterprises, LLC*, 135 S. Ct. 2401, 2409 (2015), quoting *Payne v. Tennessee*, 501 U.S. 808, 827-28 (1991).
[2] 135 S. *Ct.* 1293 (2015).
[3] U.S. Courts of Appeals Judicial Facts and Figures (September 30, 2018), Table 2.5 (https://www.uscourts.gov/sites/default/files/data_tables/jff_2.5_0930.2018.pdf). Published decisions are precedential in federal courts. *See, e.g.*, Federal Rules of Appellate Procedure Ninth Circuit Rules, Circuit Rule 36-3(a).
[4] This report was prepared by the INTA Task Force on TTAB Precedential Decisions ("Task Force") at INTA's direction. The Task Force includes: Jan Jensen, Esq., Task Force Chair (Jensen Law Firm), Mark A. Finkelstein, Esq. (Umberg Zipser), Jonathan Hyman, Esq. (Knobbe Martens), James R. Menker, Esq. (Holley & Menker), Joseph T. Nabor, Esq. (Fitch Even), UnJu

quality and efficiency of trademark examination operations, enhance the development of trademark law, and promote predictability and consistency within trademark law.

INTA recognizes that the TTAB has been studying this issue and that the process by which TTAB decisions are designated as precedential is complex and time-consuming. INTA is nevertheless hopeful and urges the TTAB to consider making policy or other changes that would allow for an increase in the number of precedential decisions.

I. INTRODUCTION

INTA understands that over the years a number of organizations and individuals have approached the TTAB and expressed concern regarding the number of decisions the TTAB designates as precedential. By way of example, in 2005, the American Intellectual Property Law Association ("AIPLA") Trademark Law Committee issued a report on the "Low Rate of TTAB Decisions Designated Citable as Precedent" ("AIPLA Report").[5] The AIPLA Report concluded that the trend of a diminishing number of citable TTAB decisions "has caused dismay among trademark practitioners and has been the subject of significant commentary."[6] Indeed, in 2004, the TTAB issued only 12 citable decisions.

In the years immediately following the AIPLA Report, the TTAB should be applauded for initially increasing the number of precedential decisions. For example, by 2007 the TTAB raised the number of precedential decisions from 12 to 66. Nonetheless, despite some improvement since 2004, the number of TTAB precedential decisions continues to lag far behind both the number of historical precedential decisions, as well as the number of precedential decisions from the TTAB's federal judiciary counterpart. For instance, in 1974, 403 TTAB decisions were published. Ten years later, in 1984, the USPQ published 238 TTAB decisions. Yet, in the last five years *combined*, the TTAB only designated 201 decisions as precedential, an average of only 40 per year, or 6.17% of its decisions. By contrast, in 2018, 40.6% of the written and signed opinions from the U.S. Courts of Appeals were published, and 11.8% of all U.S. Courts of Appeals opinions and orders were published. [7]

Precedential TTAB decisions are critical to practitioners, trademark stakeholders, and the public at large. Indeed, such decisions improve the quality and efficiency of trademark proceedings, aid in the development of trademark law, provide critical guidance and clarity so that trademark owners can avoid disputes and issues, and raise the profile of the TTAB on the global trademark stage. Moreover, the TTAB's reluctance to designate decisions as precedential

---

Paik, formally Head of Intellectual Property Group for 21st Century Fox, Jennifer M. Reynolds, Esq. and Eric Westerberg, Esq.

[5] The AIPLA Report is attached hereto as Exhibit "A."

[6] AIPLA Report at p. 1.

[7] U.S. Courts of Appeals Judicial Facts and Figures (September 30, 2018), Table 2.5 (https://www.uscourts.gov/sites/default/files/data_tables/jff_2.5_0930.2018.pdf). Published decisions are precedential in federal courts. *See, e.g.*, Federal Rules of Appellate Procedure Ninth Circuit Rules, Circuit Rule 36-3(a).

in cases involving complex factual scenarios and/or multiple legal issues does a disservice to the trademark community because it fails to acknowledge the reality of our world's exceedingly complex business and legal environment.

While it is INTA's position that there is a general need for more precedential decisions, INTA can also demonstrate that there are specific areas of trademark law that lack or have minimal recent precedential decisions. Although some key issues of trademark law, such as likelihood of confusion, are the subject of multiple precedential decisions a year, there are other important issues that have not been addressed recently and would benefit greatly from current precedential decisions. In addition, even where certain issues are the subject of multiple precedential decisions in a given year, additional precedential decisions are still needed.

INTA understands that the process for designating decisions as precedential is challenging. Nonetheless, given the importance of having more precedential decisions, INTA strongly encourages a more streamlined process to allow for a substantial increase in the number of precedential decisions.

II. DISCUSSION

A. Increasing the Number of Precedential Decisions Will Result in a More Complete and Current Body of TTAB Case Law.

The low number of precedential decisions means that many legal issues have not been addressed, or have not been recently addressed, in a TTAB decision that can be relied upon as binding. As a result, trademark practitioners, trademark stakeholders, Trademark Examining Attorneys, and the TTAB are relying on older precedent that may not be as relevant in today's world and/or they are relying on case law that has no binding effect on the TTAB. INTA recognizes that the TTAB is not in control of which cases arise and, therefore, which issues reach final decision. Nevertheless, designating more decisions as precedential should help to close these gaps.

As set forth in Exhibit "B," INTA's analysis of the TTAB's precedential decisions during the five-year period from 2014 through 2018 reveals that there are many issues of trademark law that have either not been addressed at all, or have been addressed in only 1-3 precedential decisions, including important issues such as dilution and what constitutes bona fide use of a trademark. While there are some key areas of trademark law that were the subject of multiple precedential decisions during 2014-2018, such as likelihood of confusion, other areas would benefit greatly from more recent precedent. Moreover, even where certain issues are the subject of multiple precedential decisions in a given year, additional precedential decisions are still needed. This is particularly true in the context of new technology as the law tries to catch up with new issues presented by the technological advances created by the business community and brand owners.

Many of the TTAB's precedential decisions date back decades, since the TTAB used to designate as precedential many more decisions than are designated as such today. For instance, in 1974, the USPQ published 403 TTAB decisions, whereas, in 2014, only 46 decisions were

published. As set forth in Exhibit "C," an analysis of the Board's 39 precedential decisions from 2017 reveals that a total of 933 separate cases were cited in these 39 decisions. Of those 933 cited cases, only 182 were precedential TTAB decisions from the years 2010-2018, whereas 396 were precedential TTAB decisions from 2009 or before, and 266 were precedential TTAB decisions from 1999 and prior.

Accordingly, practitioners, trademark stakeholders, and Trademark Examining Attorneys are often forced to rely on very old precedent. In the abstract, there is nothing problematic about old precedent. In fact, old precedent that continues to be applicable may assist with the predictability of the law. The TTAB, however, often is confronted with ongoing revolutionary changes in technology and the ways in which goods and services are created, distributed, used, and consumed. In such circumstances, older precedent may not be directly applicable, leaving practitioners, trademark stakeholders, and Trademark Examining Attorneys with no relevant authority. Even where older precedent may appear relevant, questions of applicability may still exist due to the age of the precedent.

New precedential decisions also can help identify sections in the TMEP and TBMP that need revision. Additionally, such decisions can highlight federal regulations that have become outdated or need amendment or clarification through the legislative process. Moreover, precedential decisions will encourage the TTAB to continue to write thorough and well-reasoned decisions, knowing that the decisions will serve as a guidepost for the future.

B. Increasing the Number of Precedential Decisions Will Improve the Predictability, Quality and Efficiency of Trademark Examination Operations for the USPTO and Practitioners.

Unlike federal district courts, the TTAB is often not designated as a fact-finding body. Rather, in the instance of *ex parte* appeals, the TTAB is reviewing the decisions of the Trademark Examining Attorney and facts established during trademark prosecution, much like federal courts of appeals. Because existing precedents are scarce, especially with respect to certain issues, Trademark Examining Attorneys have limited tools in issuing refusals and evaluating responses. More decisions, including those with more detailed fact patterns, will enable Trademark Examining Attorneys to allow or refuse applications with finer precision and sharper distinctions, making prosecution more consistent and efficient for both the USPTO and applicants.

This will have the added benefit of providing more certainty to attorneys and the public at large. Indeed, with clear precedent, brand owners can govern their behavior accordingly, which should lead to fewer disputes. Further, more TTAB precedent on a broader range of issues will likely reduce the number of appeals because attorneys will be better able to gauge the likelihood of success for any given appeal.

C. Development of Trademark Law Aids the TTAB and Practitioners.

Precedential decisions are indexed and abstracted, which makes development of new lines of cases easier to trace and new doctrines more easily identified. Precedential decisions also can be the source of new legal scholarly works and education for the trademark community

and brand owners. Because precedential decisions are integrated into the TMEP, they aid trademark examination and USPTO practice by providing invaluable guidance to Trademark Examining Attorneys and brand owners alike.

Precedential decisions also encourage *stare decisis* and the further evolution of trademark law and development of new lines of cases. While cases that are not precedential can be cited in TTAB proceedings,[8] the value of such citation is limited and the weight somewhat uncertain.

Further, precedential decisions provide a valuable interpretation of the law. TTAB decisions often reflect extensive legal advocacy, as well as thoughtful judicial analysis, and a great deal is lost when such decisions are not designated as precedential. As there is no more prolific source of jurisprudence, legal reasoning or expertise in the area of trademark law than the TTAB and its decisions, it is important that more of them be designated as precedential.

B&B Hardware, Inc. v. Hargis Indus., Inc. arguably served to increase the importance of TTAB precedential decisions. In any event and even if that were not the case, additional guidance from the TTAB will allow parties to better gauge whether to pursue or defend an *inter partes* proceeding to a decision. Precedential decisions enhance education and awareness of developing principles in trademark law and practice. Finally, additional precedential decisions will help deter litigants from advancing failing arguments, ultimately saving precious TTAB resources.

D. Precedential Decisions Raise the Profile of the TTAB and Increase the Potential Reach and Impact of its Decisions.

With a global economy and global brands, the legal clarity provided by more precedential decisions would enhance the influence of USPTO decisions on global trademark practice. The failure to designate TTAB decisions as precedential deprives the TTAB of the wider forum for its decisions that it deserves.

Precedential decisions help the TTAB keep pace with similarly situated courts. Indeed, the Board recognizes the high value placed on precedential decisions. Section 101.03 of the TBMP recognizes that Board proceedings are governed, for the most part, by precedential decisions in prior cases. The high value the trademark bar places on the decisions of the TTAB allows the entire trademark community to have the same body of law for use in Article III courts. Since the TTAB recognizes that non-precedential decisions are not binding on the Board, similar treatment by courts is expected.

E. Complex Factual Scenarios and Multiple Issues Add Value to Precedential Decisions.

Historically, TTAB decisions that have been designated precedential tend to involve a single issue, such as likelihood of confusion, with a relatively simple fact pattern. However, the

[8] United States Patent and Trademark Office OG Notices: 23 January 2007, Citation of Opinions to the Trademark Trial and Appeal Board.

TTAB should not shy away from designating as precedential those decisions that have more complex fact scenarios or more than one issue. By addressing more complex issues and facts, the TTAB will give Examining Attorneys and practitioners more insight into its legal analysis. Additionally, having a greater body of opinions with different fact scenarios allows brand owners to better analogize to and/or distinguish their cases from existing precedent. It seems counterintuitive to prevent a thoughtful and sophisticated opinion from being available as precedent to guide the trademark community simply because it is complex.

F. INTA Recognizes the Challenges Associated With Designating Decisions as Precedential.

INTA is cognizant of the challenges that are concomitant with additional precedential decisions. We recognize that TTAB decisions are binding on the USPTO, and thus procedures must be implemented to identify and designate decisions as precedential. We understand those procedures are purposeful and time-consuming.[9] Nevertheless, given the importance of having more precedential decisions, INTA respectfully urges that the TTAB consider streamlining the process, encourage that Trademark Examining Attorneys identify more decisions as candidates for designation as precedential or develop another alternative to increase the number of precedential decisions.

---

[9] It is our understanding that the TTAB uses the following process for determining whether to designate decisions as precedential:

- A three-judge panel reviews and decides a specific dispositive issue or case and one of the judges is assigned to draft the opinion.
- The opinion author, members of the tribunal, interlocutory attorney, or others at the TTAB associated with the case can suggest it as a candidate for designation as precedential.
- If the decision involves motion practice, all interlocutory attorneys are asked to weigh in on the determination.
- If the decision is flagged as a potential candidate for precedential evaluation, it is referred to the Chief Judge and Deputy Chief Judge of the TTAB.
- Thereafter, all 23 TTAB Judges and the interlocutory attorneys review the decision, and a super majority of the judges (roughly 2/3) is needed to approve the decision for publication as precedential.
- The Chief Judge and Deputy Chief Judge review all comments and questions. At this point, they can decide whether to go back to the original deciding panel to raise questions or to encourage revisions. Alternatively, the Judges may decide to revise the opinion themselves to incorporate the comments and questions.
- From there, any decision still under consideration for designation as precedential is passed to the Commissioner's Office on Policy and to the Office of the Solicitor.
- The Solicitor's Office reviews the decision both for legal sufficiency and to evaluate whether any aspects of the decision could conflict with prior Agency policy and weighs in on whether it believes the decision would be defensible before the Federal Circuit. If the Solicitor's Office does not agree with the decision or is not prepared to defend it on appeal, it is labelled non-precedential.

III. CONCLUSION

The number of precedential TTAB decisions is low, both compared to the federal judiciary as well as the TTAB's historical practice. As discussed above, increasing the number of precedential TTAB decisions would have many positive benefits for trademark practitioners, trademark owners, and the USPTO. Thus, INTA urges the TTAB to make changes that would result in substantially more precedential decisions including more multi-issue and factually complex precedential decisions.

INTA appreciates the opportunity to address this important matter. The INTA Task Force will make itself available for any questions and discussion.

EXHIBIT A

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
TRADEMARK LAW COMMITTEE

WORKING GROUP ON TTAB DECISIONS

EXECUTIVE SUMMARY

SUBJECT: Low Rate of TTAB Decisions Designated as Citable Precedent

The percentage of cases designated "Citable as Precedent of the TTAB" has declined dramatically over the years.

Year	Citable Cases
1974	403
1984	238
1994	36
2004	12

*Based on date of publication in the USPQ

Only 2% of the 600^{+} TTAB decisions issued in 2004 were designated as citable precedent.

Comparison with Federal Judiciary: In 2004 in all U.S. Courts of Appeals except the Court of Appeals for the Federal Circuit, the average number of citable opinions in each court was over 400, with the lowest percentage being 12.2% in the Eleventh Circuit, which published a total of 365 decisions (out of nearly 3,000 cases decided).

Detrimental Effect on TTAB: More cases decided prior to 1969 were cited in the TTAB's 2004 decisions than were cases decided since 2000.

Detrimental Effect on Trademark Examination Operation: TTAB instruction on examination practice and standards is instrumental feedback that helps assure quality in the Trademark Examination Operation and therefore in resulting registrations. Only cases citable as precedent can be relied upon in developing examination practice.

Detrimental Effect on Trademark Owners: The Trademark Examination Operation and the TTAB do not permit the citation of cases that have not been designated citable precedent in responses to Office actions and TTAB proceedings.

The TTAB is the most prolific source of jurisprudence and legal reasoning in the trademark area. TTAB decisions, whether designated citable or not, involve extensive efforts and reasoning and provide invaluable interpretation of trademark law. Its decisions, if available as citable precedent, would provide welcome guidance on many issues.

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
TRADEMARK LAW COMMITTEE

WORKING GROUP ON TTAB DECISIONS

SUBJECT: Low Rate of TTAB Decisions Designated Citable as Precedent

REPORT

Issue. The TTAB decides ex parte appeals from refusals of registration of trademarks by the Patent and Trademark Office's Examination Division, and inter-partes opposition and cancellation proceedings. The past few years have seen a vastly diminishing number of decisions by the TTAB that are designated "Citable as Precedent of the TTAB" ("Citable Cases" or "Citable Decisions").[1] In 2003, despite rendering more than 600 decisions, the TTAB designated only 21 Citable Decisions.[2] In 2004 the total number of Citable Decisions issued by the TTAB declined even further: out of more than 600 cases decided, the TTAB designated only 13 Citable Decisions.[3] This was the lowest in decades, if not in the entire TTAB history. This trend has caused dismay among trademark practitioners and has been the subject of significant commentary.[4]

Methodology. In an effort to quantify the deleterious effects on the trademark community of the low number of Citable Cases, the AIPLA Trademark Law Committee established a working group to analyze all of the TTAB's decisions in 2004. Specifically, the working group catalogued every decision and created an Excel database containing the following information:

- the name and year of every decision that was cited in every 2004 decision
- the length (in number of pages) of every TTAB decision issued in 2004

This information was sorted in various ways to produce the underlying source material for this report. Such source materials is cited herein as "AIPLA Trademark Law Committee Working Group Research." In particular, the working group was able to prepare a list of all cases that were cited in 2004 TTAB decisions, the number of times they were cited, and the year of cited case. Printed reports can be generated but are quite voluminous. Summary charts are provided as exhibits to this report.

---

[1] Citable Cases are reported in the United States Patent Quarterly reporter (USPQ) and thus are also known as "published cases." On occasion, the USPQ will publish decisions that have not been designated Citable Cases by the USPTO. Therefore, while the number of decisions published in the USPQ roughly approximates the number of decisions that are designated Citable Cases by the Board, there is not an exact correlation between publication and citable status.

[2] John L. Welch, *The TTAB in 2003: Fraud, Fame and a Landmark Dilution Claim, Part I*," Intellectual Property Today, May 2004, p. 36.

[3] AIPLA Trademark Law Committee Working Group Research. See Exhibit B.

[4] *See, e.g.*, John L. Welch, *2004 at the TTAB: 12 Citables and 3 Precedential CAFC decisions*, 18 Allen's Trademark Digest 9, at 9 (March 2005). (John Welch later acknowledged in his TTAB Blog that there was one additional Citable Case in 2004, for a total of 13.)

DISCUSSION

The decline in the TTAB's issuance of Citable Decisions, though sharper in 2004, reflects a significant and now longstanding trend against publication. In 1974, the USPQ published 403 TTAB decisions, but by 1984 that number had dwindled to 238. In recent years, the drop has been even more prodigious. In 1994 the TTAB issued 36 Citable Decisions.[5] In 2004, it issued 12 Citable Decisions, and, as of October, 2005, the TTAB had designated only ten decisions for publication.[6]

The detrimental consequences of such a perennially low rate of published cases to the trademark legal community, including the Trademark Examining Operation ("TMEO"), trademark owners, trademark practitioners, educators and students, and the TTAB itself, are far-reaching and significant.

Invaluable Interpretation of Trademark Law. There is no more prolific source of jurisprudence and legal reasoning in the trademark area than the TTAB and its decisions. The failure to designate TTAB decisions as Citable Cases deprives the TTAB of the wider forum for its decisions that it deserves. TTAB decisions, whether designated Citable Cases or not, involve extensive efforts and reasoning; nearly a quarter of unpublished TTAB decisions exceed fifteen pages in length.[7] Specifically, of 134 decisions that exceeded 15 pages in length in 2004, only eight of these were designated Citable as Precedent of the TTAB. Thus, there were 128 decisions of significant length that were not widely reported, disseminated, indexed or abstracted.

Prohibition on Citation of Cases Not Designated Citable. The citation of cases that have not been designated Citable Cases in responses to Office actions and proceedings before the Board is not permitted.[8] Thus, the vast amount of jurisprudence and interpretation of the Lanham Act contained in TTAB decisions analyzing current fact scenarios is not available to practitioners, trademark owners and the Trademark Examination Operation.

Benefits of Citable Cases - Trademark Community. Publication of TTAB decisions enhances education and awareness of developing principles in trademark law and procedure. Published decisions are indexed and abstracted. This makes development of new lines of cases easier to trace and new doctrine more easily identified. This also makes more cases available for commentary and discussion, and for reference by law school faculties, in CLE lectures and other educational forums as demonstrating developing trends in trademark law. In sum, publishing,

---

[5] AIPLA Trademark Law Committee Working Group Research. Figures for 1974, 1984 and 1994 obtained from USPQ Digests for each year. See Exhibit A. See also footnote 1 for comments on the inexact correlation between Citable Case status and publication in the USPQ.

[6] John L. Welch, The TTAB Blog, October 7, 2005.

[7] AIPLA Trademark Law Committee Working Group Research.

[8] *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n. 9 (TTAB 1992) ("[T]he Board has decided that citation of "unpublished" or "digest" Board decisions as precedent will no longer be allowed. In the future, the Board will disregard citation as precedent of any unpublished or digest decision."); *see also* Trademark Manual of Examining Procedure § 705.05; Trademark Board Manual of Procedure § 101.3.

reporting and digesting TTAB decisions makes them and the guidance they provide more readily available to the trademark community.

Benefits of Citable Cases - TTAB. Sheer numbers readily illustrate one consequence of the declining number of cases that are designated Citable Decisions, that being a loss of precedential development in TTAB decisions themselves. In all decisions issued in 2004 by the TTAB, citations to cases decided prior to 1989 accounted for more than 40% of the total citations.[9] In fact, more cases decided prior to 1969 were cited in the TTAB's 2004 decisions than were cases decided since 2000.[10] For an administrative body that has issued more than 2000 decisions in the last four years alone, this is an unsettling statistic.

Reliance on older precedent may affect current TTAB decisions. For example, in the recent U.S. Federal Circuit Court of Appeals case of In re Steelbuilding, a published opinion that reversed a non-citable TTAB decision, eleven of seventeen total cases cited by the majority opinion were decided after 1989 (nine cases, all but one decided after 1989, were cited in a separate opinion concurring in part and dissenting in part). In contrast, the original TTAB decision cited twenty-nine cases, of which only fifteen were cases decided after 1989.

Given the few citable decisions issued, TTAB decisions currently must draw upon increasingly older and older precedent. Even if this precedent remains sound through the years, the lack of newer published cases that reaffirm the rulings and holdings in these older cases leave in doubt their continued viability or their suitability to apply them to new and different fact situations.

Increasing the number of Citable Decisions would give the TTAB recent cases it could cite in support of its decisions in subsequent cases.

Benefits of Citable Cases - Trademark Examination Operation. Trademark Examining Attorneys read published decisions in the USPQ, and improvements in examining practices are implemented by the Trademark Office according to the rulings presented. TTAB instruction as to current examination practice and standards is instrumental feedback that helps assure quality in examination and therefore in resulting registrations.

Comparison With Federal Judiciary. The federal courts present a marked contrast to the TTAB's low publication rate. In 2004, in all U.S. Courts of Appeals except the Court of Appeals for the Federal Circuit, the average number of published opinions in each court was over 400, with the lowest percentage being 12.2% in the Eleventh Circuit, which published a total of 365 decisions (out of nearly 3,000 cases decided). Even the relatively low percentage of published cases in the 11th Circuit is far above that of the TTAB, which had a publication rate lower than 2% in 2004.[11]

---

[9] AIPLA Trademark Law Committee Working Group Research. See Exhibit C.

[10] Id. However, the number of citations to the post-2000 cases exceeds the number of citations to the pre-1969 cases.

[11] Only the Second, Seventh and Ninth Circuits ban outright citation of unpublished decisions. *See*, Tony Mauro, "Judicial Conference Supports Citing Unpublished Opinions", *Legal Times*, September 20, 2005.

At its September 2005 conference, the federal judiciary endorsed rule changes that would, if ratified, allow lawyers to cite unpublished opinions in federal appeals courts.[12] The potential effect of these rule changes on TTAB practice is uncertain as it is likely the TTAB will have latitude in setting its own rules concerning the precedential value of its unpublished decisions. While permitting unpublished decisions to be cited in proceedings before the TMEO and the TTAB would be a welcome improvement, it will not produce the benefits of the greater issuance of Citable Cases discussed above.

Illustrative cases.

The Fraud Cases. In the last few years the TTAB has issued a number of decisions addressing the issue of fraud in obtaining and maintaining a trademark registration. These decisions represent a line of cases in which the TTAB has taken a position that arguably marks a significant departure from prior rulings, yet only one of these decisions has been designated a Citable Case. Since the decisions have in most cases resulted in cancellation of trademark registrations on the ground of fraud, these cases have caused significant concern among trademark owners and practitioners. Rather than rely on the sole Citable Case to govern application of the new rule to a multiplicity of similar, though potentially distinguishable, fact patterns, all cases should have been published, discussed and debated. Publication would serve an invaluable educational tool and would reinforce vital practice points.

The Concurrent Use Case. In a discussion of the effect of the Internet on the feasibility of granting concurrent geographically restricted registrations, the TTAB wrote:

> The Board declines to establish or assert an absolute prohibition on the issuance of geographically restricted registrations when the evidence shows that one or more of the parties to a concurrent use proceeding does business on the Internet.

Hubcap Heaven, LLC v. Hubcap Heaven, Inc., Concurrent Use No. 94.001,147 (Slip Op., at page 15, January 25, 2005).

This is a statement of significant import that could influence a trademark owner's decision about whether to file a concurrent use application as well as negotiations between parties about a geographical separation of uses to resolve a trademark disagreement. Clearly a published and citable decision would have been of much greater utility and persuasiveness.

Other Issues. The TTAB addresses many topical, timely issues and its decisions would provide welcome guidance on a number of issues. These include:

- trade dress/product configurations;
- dilution;
- refusals on the ground that a mark "falsely suggests a connection" under Section 2(a) of the Lanham Act;
- discovery objections and motions to compel discovery responses;

[12] Tony Mauro, "Judicial Conference Supports Citing Unpublished Opinions", *Legal Times*, September 20, 2005

- electronic evidence;
- sanctions, including requiring electronic filing of correspondence;
- doctrine of foreign equivalents in descriptiveness and likelihood of confusion contexts; and
- application of Section 2(d) DuPont factors to exceptional fact sets.

EXHIBIT A

CITABLE TTAB DECISIONS 2004

	Case Name	Date	# of Pages
1	In re Los Angeles Police Revolver and Athletic Club, Inc.	January 15, 2004	2
2	In re Planalytics, Inc	March 30, 2004	17
3	Jacob Zimmerman v. National Association of Realtors	March 31, 2004	39
4	In re Gregory	May 12, 2004	14
5	Yahoo! Inc. v. Franklin Loufrani	May 13, 2004	5
6	Alfacell Corporation v. Anticancer, Inc.	June 22, 2004	22
7	Finger Furniture Company, Inc. v. Finger Interests Number One, Ltd.	June 29, 2004	25
8	Baseball America, Inc. v. Powerplay Sports, Inc.	August 11, 2004	15
9	In re Dell Inc.	August 12, 2004	13
10	In re Consolidated Specialty Restaurants, Inc.	August 25, 2004	23
11	In re Julie White	September 8, 2004	27
12	In re Candy Bouquet International, Inc.	September 8, 2004	25
13	Cognis Corp. v. DBC, LLC	November 2, 2004	5

EXHIBIT B

TTAB Citable Cases Comparison Chart*

Quarter	1974	1984	1994	2004
January - March	116	43	9	3
April - June	121	59	8	3
July - August	38	73	8	5
September - December	128	63	11	1
Total	403	238	36	12

*Based on date of publication in the USPQ

EXHIBIT C

2004 TTAB Decisions

Year	Total Number of Cases Cited from Each Time Period	Frequency of Their Citation (*i.e.*, number of uses of these cases)
1888-1948	17	20
1950-1959	40	89
1960-1969	79	131
1970-1979	198	930
1980-1989	402	1298
1990-1999	290	1155
2000-2004	111	472
Totals	1137	4095

AIPLA TRADEMARK LAW COMMITTEE
WORKING GROUP ON TTAB CITABLE CASES

Index of Research Data Compiled

The following data was compiled in order to prepare this report.

1. List of the 13 citable TTAB decisions issued in 2004 by the TTAB.
2. Cases cited in 2004 TTAB decisions (by quarter).
3. TTAB 2004 decision exceeding 15 pages (134 decisions).
4. Cases Published in USPQ in 1974, 1984, 1994 and 2004
5. Cases cited in 2004 TTAB decisions, and number of times cited, by year of cited case.
6. Cases cited in 2004 TTAB decisions, and number of times cited, by year of case (alphabetical order).

EXHIBIT B

EXHIBIT "B"[1]

I. **Likelihood of Confusion Issues**
   1. Analysis of claims of actual confusion
   2. Unity of control in likelihood of confusion determinations
   3. Section 18 claims or defenses

II. **Dilution Issues**
   1. Types of evidence required for proof of fame for purposes of dilution

III. **Registration/Prosecution Issues**
   1. Failure to function
   2. Use of domain names as trademarks
   3. Bona fide intent-to-use (or lack thereof) per Section 1(b)
   4. Specimen issues including:
      a. Acceptability of specimens to support Internet sales
      b. Acceptability of specimens of use that do not explicitly mention the services with which the mark is being used.
      c. Acceptability of online displays as specimens of use for goods
   5. Trademark use issues, including:
      a. Acceptability of nontraditional uses sufficient to constitute use in commerce
      b. Excusable non-use
      c. Meaning of "current" use
      d. Minimum use necessary to support a claim of actual use
      e. Use in commerce where the services are promoted/sold to U.S. residents, but the services are primarily performed outside the United States.
      f. Use not intended or directed by mark owner (e.g. diverted/gray-market goods)
   6. Materiality in the context of proving deceptiveness
   7. Evidentiary requirements for acquired distinctiveness

IV. **Ownership Issues**
   1. Assignments in accordance with or contrary to Section 10
   2. Meaning of "bona fide and effective commercial establishment" per Section 44
   3. Meaning of "a real and effective industrial or commercial establishment" per Section 66

V. **Evidence/Discovery/Rules of Practice Issues**
   1. Electronic evidence
   2. Hearsay
   3. Rulings interpreting the application of rules of practice

VI. **Other Registration Issues**
   1. Section 2(a) – Deceptiveness
   2. Section 2(b) – Flag, Coat of Arms, or Other Insignia
   3. Section 2(c) – Consent of Living Individual
   4. Section 2(a) -- False Connection
   5. Section 2(a) --False Association
   6. Section 2(c) – Consent to Register
   7. Family of Marks
   8. Laches
   9. Nonuse/Abandonment/Specimen of Use/Failure to Function
   10. Goods in Trade
   11. Identification of Goods
   12. Nonuse
   13. Nonuse/Specimen of Use
   14. Cancellation Under Section 14(3)
   15. Rule 2.61(b) Compliance
   16. Section 10 Assignability
   17. Concurrent Use
   18. Section 44(e) Basis
   19. Use in Commerce/Specimen of Use/Mutilation
   20. Certification Mark Control
   21. Failure to Function/Phantom Mark

---

[1] This Exhibit lists important issues of trademark law that during the five-year period from 2014 through 2018 have either not been addressed at all or have been addressed in only 1-3 precedential decisions.

EXHIBIT C

EXHIBIT "C"

No.	PRECEDENTIAL DECISION	LENGTH OF OPINION	NO. OF CASES CITED	DATE RANGE OF CITED CASES																							
				1888-1948			1950-1959			1960-1969			1970-1979			1980-1989			1990-1999			2000-2009			2010-2018		
				TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.	TTAB/ CCPA	Fed. Cir.	Other Ct.
1	In re Tapco International Corporation, 122 USPQ2d 1369 (TTAB 2017)	19	14		1		1			2			1			1	2		1	1			1		3		
2	In re Shabby Chic Brands LLC, 122 USPQ2d 1139 (TTAB 2017)	15	9							1			2										4		1	1	
3	In re Family Emergency Room LLC, 121 USPQ2d 1886 (TTAB 2017)	9	8										2			1						1			2	2	
4	Bell's Brewery, Inc. v. Innovation Brewing, 125 USPQ2d 1340 (TTAB 2017)	27	46							3			4		1	3	2		1	3		3	4		13	9	
5	Tao Licensing, LLC v. Bender Consulting Ltd. d/b/a Asian Pacific Beverages, 125 USPQ2d 1043 (TTAB 2017)	49	55									2	4			3	4		4	5	1	7	5		10	10	
6	Julie A. Moreno v. Pro Boxing Supplies, Inc., 124 USPQ2d 1028 (TTAB 2017)	19	18							1						4	2		2	1		3			4	1	
7	In re USA Warriors Ice Hockey Program, Inc., 122 USPQ2d 1790 (TTAB 2017)	16	22			1	1						2			1	3		1	2		2	3	1	3	2	
8	Apollo Medical Extrusion Technologies, Inc. v. Medical Extrusion Technologies, Inc., 123 USPQ2d 1844 (TTAB 2017)	30	60							5			3			12	2	1	3	4		5	3		15	7	
9	In re United Trademark Holdings, Inc., 122 USPQ2d 1796 (TTAB 2017)	11	30							1			4			8	1	1	2			4	4		2	3	
10	In re Well Living Lab Inc., 122 USPQ2d 1777 (TTAB 2017)	9	13										2			2	1					2	2		2	2	
11	In re Calphalon Corp., 122 USPQ2d 1153 (TTAB 2017)	29	17							2			3			2						3	1	1	2	3	
12	Kohler Co. v. Honda Giken Kogyo K.K., 125 USPQ2d 1468 (TTAB 2017)	130	85			1	1			6			5			2	10	1	3	2	4	8	5	11	18	5	3
13	In re Olin Corporation, 124 USPQ2d 1327 (TTAB 2017)	31	33										1			2	3		3			5	3		14	2	
14	In re Weiss Watch Company, Inc., 123 USPQ2d 1200 (TTAB 2017)	16	26				1						3			3	2		2			7	2		6		
15	Azeka Building Corp. v. Bryan Kenji Azeka, 212 USPQ2d 1477 (TTAB 2017)	29	33										2			3	4	2	3	3		6	1	1	6	2	
16	In re Beds & Bars Limited, 122 USPQ2d 1546 (TTAB 2017)	13	11										2			1	1		1			3			3		
17	Poly-America, L.P. v. Illinois Tool Works Inc., 124 USPQ2d 1508 (TTAB 2017)	29	29							1			1			3	2		1	1		4	4	1	8	3	
18	In re Change Wind Corp., 123 USPQ2d 1453 (TTAB 2017)	33	25										2			2	4		3	2		5	2	1	2	1	1
19	Executive Coach Builders, Inc. v. SPV Coach Company, Inc., 123 USPQ2d 1175 (TTAB 2017)	61	46	1		1	1			2						4	2		5	4		11		2	9	3	1

20	Luxco, Inc. v. Consejo Regulador del Tequila, A.C., 121 USPQ2d 1477 (TTAB 2017)	77	45							1		1	3			6	4		2	5		5	3		12	3	
21	Frito-Lay North America, Inc. v. Princeton Vanguard, LLC, 124 USPQ2d 1184 (TTAB 2017)	53	52			3				2			1		3	5	5	1		3	1	3	9	5	8	2	1
22	In re Empire Tech. Dev. LLC, 123 USPQ2 1453 (TTAB 2017)	51	25							2						2	3		1	1		3	2	1	8	2	
23	Azalea Health Innovations, Inc. v. Rural Health Care, Inc.., 125 USPQ2d 1236 (TTAB 2017)	13	12										5			1			1			2			3		
24	Jive Software, Inc. v. Jive Communications, Inc., 125 USPQ2d 1175 (TTAB 2017)	19	16									1	1			4			1	1		3	1		2		2
25	Shared, LLC v. SharedSpaceofAtlanta, LLC, 125 USPQ2d 1143 (TTAB 2017)	4	4										1			1			1			1					
26	Barclays Capital Inc. v. Tiger Lily Ventures Ltd., 124 USPQ2d 1160 (TTAB 2017)	18	23										1			5	1		5			5	1		5		
27	Sun Hee Jung v. Magic Snow, LLC, 124 USPQ2d 1041 (TTAB 2017)	9	15													2			2	1		2	1	2	4	1	
28	United States Postal Service v. RPost Communication Limited, 124 USPQ2d 1045 (TTAB 2017)	6	3																1			2					
29	Prospector Capital Partners, Inc. v. DTTM Operations LLC, 123 USPQ2d 1832 (TTAB 2017)	13	20			1							2			1	1	3	2		1	2		4	1		2
30	Yufan Hu v. TJ Food Service, LLC, 123 USPQ2d 1777 (TTAB 2017)	10	17			1							1		1		1	3			1	2	1	3	2		1
31	Estudi Moline Dissey, S.L. v. BioUrn Incorporated, 123 USPQ2d 1268 (TTAB 2017)	8	3																			2			1		
32	DFC Expo LLC v. Coyle, 121 USPQ2d 1903 (TTAB 2017)	9	1																			1					
33	In re General Mills IP Holdings II, LLC, 124 USPQ2d 1016 (TTAB 2017)	28	22							3			3				5			2	1			2	1	3	2
34	In re PharmaCann LLC, 123 USPQ2d 1122 (TTAB 2017)	16	12				1			1						3						1		1	2		3
35	In re University of Miami, 123 USPQ2d 1075 (TTAB 2017)	12	13							1			1			1	1			2		5	1		1		
36	In re Emergency Alert Solutions Group, LLC, 122 USPQ2d 1088 (TTAB 2017)	16	14														1			2		4	3		2	2	
37	In re Kohr Brothers, Inc., 121 USPQ2d 1793 (TTAB 2017)	8	12										1			1			3		1	3	1		2		
38	In re Keep A Breast Foundation, 123 USPQ2d 1869 (TTAB 2017)	30	39							5			8			4	4		1	2	1	4	1	2	4	3	
39	In re Construction Research & Technology GmbH, 122 USPQ2d 1583 (TTAB 2017)	8	5										1							1		1	1		1		
Total				1	1	8	6	0	0	39	0	4	72	0	5	93	71	12	55	48	11	130	69	38	182	72	16