



American Intellectual Property Law Association

November 20, 2019

The Honorable 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 Intellectual Property Law Association (AIPLA) greatly appreciates your attendance at our recent annual meeting, and the Trademark Trial and Appeal Board (TTAB) holding two live hearings at our meeting. Our members especially enjoyed the opportunity to discuss current issues with you and the other TTAB judges.

The International Trademark Association (INTA) has shared with AIPLA its Task Force Report on TTAB Precedential Decisions, and we understand that the topic will be discussed at the INTA Leadership Meeting on November 21. AIPLA is pleased to have this opportunity to provide comments on the issue of TTAB precedential decisions.

AIPLA is a national bar association of approximately 12,000 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA believes that an increased number of precedential TTAB decisions would be helpful to trademark owners, trademark practitioners, educators, and students. TTAB decisions, if available as citable precedent, would provide more predictability and guidance on many issues. The recent INTA Task Force Report identifies a number of important issues of trademark law that have not recently been addressed in precedential TTAB decisions. The findings are consistent with a 2005 AIPLA working group study and report on the "Low Rate of TTAB Decisions Designated Citable as Precedent."

Precedential TTAB decisions in the areas of trademark law identified in the INTA report would provide invaluable analysis and guidance on the interpretation of trademark law. An increased number of precedential decisions on these issues would

provide greater certainty to trademark practitioners and owners, which would promote better, more efficient practice. It would also provide guidance to Trademark Examining Attorneys.

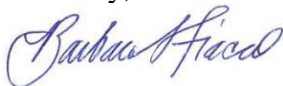
Precedential TTAB decisions are even more important since the Supreme Court's holding in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 134 S. Ct. 2899 (2014). Since *B&B Hardware*, key issues in litigation of trademark infringement claims may be determined by the TTAB in *inter partes* proceedings, rather than in a district court. Courts may preclude parties from re-litigating key issues, such as likelihood of confusion, acquired distinctiveness, and uses sufficient to constitute use in commerce, and the TTAB decision may determine the outcome of infringement litigation. Thus, there is now an even greater need for the development of *stare decisis* and guidance through precedential TTAB decisions.

Although older precedential decisions exist to provide guidance on some issues of trademark law, the older decisions may not reflect the realities of the marketplace and commerce today. Thus, there is a need for more recent precedential decisions addressing today's market realities and technology. New precedential decisions would allow for better and more predictable interpretation of trademark law on issues such as use in commerce, appropriate specimens, geographical reach of trademark rights, and promotion and distribution of goods and services in today's frequently internet-based market.

AIPLA recognizes the challenges the TTAB faces in designating additional decisions as precedential and in continuing to maintain procedures to ensure that any decision identified as precedential is subjected to sufficient review. In view of the importance of having more precedential decisions, however, AIPLA joins INTA and the American Bar Association's Intellectual Property Law Section in encouraging the TTAB's efforts to increase the annual number of meaningful precedential decisions.

Thank you for considering the AIPLA's suggestions.

Sincerely,



Barbara A. Fiocco

President

American Intellectual Property Law Association