

No. 13-352

IN THE
Supreme Court of the United States

B&B HARDWARE, INC.,

Petitioner,

—v.—

HARGIS INDUSTRIES, INC.,
D/B/A SEALTITE BUILDING FASTENERS,
D/B/A EAST TEXAS FASTENERS, ET AL.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE EIGHTH CIRCUIT

**BRIEF OF *AMICUS CURIAE*
AMERICAN INTELLECTUAL
PROPERTY LAW ASSOCIATION
IN SUPPORT OF NEITHER PARTY**

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STATEMENT OF INTEREST¹

The American Intellectual Property Law Association (“AIPLA”) is a national bar association of approximately 15,000 members engaged in private and 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, and unfair competition law, as well as other fields of law affecting intellectual property. AIPLA members represent both owners and users of intellectual property.

AIPLA has no interest in any party to this litigation nor does AIPLA have a stake in the outcome of this case, other than its interest in seeking a correct application of issue preclusion in intellectual property cases.²

¹ In accordance with Supreme Court Rule 37.6, amicus curiae states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the amicus curiae and its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (ii) no representative of any party to this litigation participated in the authorship of this brief, and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

² In accordance with Supreme Court Rule 37.3(a), the parties have consented to the filing of this amicus brief in support of

SUMMARY OF ARGUMENT

AIPLA urges the Court to recognize that, in limited and perhaps rare circumstances, decisions of the Trademark Trial and Appeal Board (“TTAB” or “Board”) concerning likelihood of confusion may operate to preclude subsequent trademark infringement litigation.

AIPLA takes no position as to the correctness of the Eighth Circuit’s conclusion below that the district court in an infringement action was not collaterally estopped by a prior TTAB decision concerning a registration. AIPLA submits this brief, however, to emphasize that the determination of issue preclusion should not be based on functional differences between the TTAB and district courts, on high-level descriptions of the issues, or on differences in a list of analytical factors used by the various tribunals to decide likelihood of confusion. Rather, determination of issue preclusion requires a fact-intensive inquiry into the record presented and considered by a previous tribunal and the issues to be decided in the subsequent proceeding.

AIPLA further urges the Court to rule narrowly. Issue preclusion should not apply where, for instance, the Board simply compared the marks as they appeared in the trademark applications and registrations at issue, rather than comparing the

neither party. Counsel for Petitioner and Respondent have communicated this consent by emails which have been filed with this brief. In addition, Counsel for Respondent has filed a blanket consent to the filing of amicus briefs.

manner in which they appeared as used in the marketplace, which is the analysis typically conducted in trademark infringement lawsuits. Nor should issue preclusion apply if the goods and services at issue in the lawsuit are materially different from the goods and services considered by the Board. As is always the case, issue preclusion should not apply where there have been changes in the underlying facts, such as changes to how the marks are used, changes to the goods and services, changes to the strength of the marks, etc.

BACKGROUND

Petitioner B&B Hardware, Inc. (“B&B”) filed an opposition at the TTAB to prevent respondent Hargis Industries, Inc. (“Hargis”) from obtaining a trademark registration for SEALTITE for metal screws used in building manufacture. The TTAB sustained the opposition, finding that the Hargis mark was likely to be confused with B&B’s SEALTIGHT registration for metal fasteners, including screws, used in the aerospace industry.

In this infringement case between the parties, the district court refused to give preclusive effect to the TTAB decision finding of a likelihood of confusion. The Eighth Circuit, in a 2-1 decision, agreed that there was no preclusion, reasoning that “the same likelihood-of-confusion issues were not decided by the TTAB as those brought in the action

before the district court.”³ The Eighth Circuit also declined to give deference to the TTAB’s decision on the grounds that deference is only due when a party brings a civil action under 15 U.S.C. § 1071(b) to challenge a decision regarding registration of a trademark.⁴ This appeal ensued.

ARGUMENT

I. TTAB DECISIONS MAY HAVE PRECLUSIVE EFFECT, BUT ONLY IN APPROPRIATE AND NARROW CIRCUMSTANCES

For issue preclusion to apply, the following four factors must be met: (1) the issues in both proceedings must be identical, (2) the issue in the prior proceeding must have been actually litigated and actually decided, (3) there must have been a full and fair opportunity for litigation in the prior proceeding, and (4) the issue previously litigated must have been necessary to support a valid and final judgment on the merits.

The issue of likelihood of confusion arises frequently in both district court and TTAB proceedings. The commercial impression on consumers of the mark as used in the marketplace is a critical consideration for district courts determining likelihood of confusion. In contrast, actual marketplace usage is only sometimes considered by the TTAB.

³ *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 716 F.3d 1020, 1024 (8th Cir. 2013).

⁴ *Id.* at 1026.

**A. For Its Decision To Be Preclusive, The Board
Must Have Considered Evidence Of
Marketplace Usage Of Both Marks**

A decision by the TTAB on likelihood of confusion cannot be preclusive of a district court's determination in an infringement action unless the TTAB considered evidence of marketplace usage of both marks. This proposition reflects the first of the four factors to be considered in deciding whether issue preclusion applies.⁵

While seemingly simple, determining whether two issues are the same can be a complex question. As noted in a leading treatise, "the Restatement Second of Judgments has suggested that one of the most difficult problems of issue preclusion 'is to delineate the issue on which litigation is, or is not, foreclosed by the prior judgment.'"⁶ Of course issues may not be the same, even where they are called the same name.⁷ In other words, likelihood of confusion before the TTAB may or may not be the same as likelihood of confusion before a court, and the analysis of this question requires a close examination

⁵ *Parklane-Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979); *Levy v. Kosher Overseers Ass'n of America, Inc.*, 104 F.3d 38, 41 (2d Cir. 1997). See also *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1366 (Fed. Cir. 2000).

⁶ 18 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 4417 (2d ed. 1981-Present)

⁷ *B&B Hardware*, 716 F.3d at 1024 (citing *Jim Beam Brands Co. v. Beamish & Crawford Ltd.*, 937 F.2d 729, 734 (2d Cir. 1991)).

of the evidence submitted and the issues decided by the first tribunal.

In many cases, the Board will have no need to consider marketplace usage and will confine itself to comparing the similarity or dissimilarity of the marks as presented in competing registrations or applications. The limited scope of the TTAB comparison in such cases makes sense because (i) an application before the Board may be for a word mark alone,⁸ and (ii) an opposer may rely solely on its registration(s) and not on any common law rights arising from its actual use.⁹ If the TTAB considers marketplace usage of both marks, the issue it decided might be the same as that before a court, and preclusion might apply.

Both the Second Circuit and the Federal Circuit have clearly endorsed the notion that a TTAB decision could be preclusive.¹⁰ In describing the

⁸ In this case, Hargis argues that it “virtually always uses ‘Sealtite’ in the context of ‘Sealtite Building Fasteners,’ not in isolation.” Hargis never made that argument to the Board, however, because its application was for SEALTITE, not “Sealtite Building Fasteners.” Brief in Opposition on Petition for a Writ of Certiorari at 14.

⁹ In this case, B&B was unable to rely on common law rights due to a jury verdict in a prior litigation between the parties that found B&B’s mark was merely descriptive. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 252 F.3d 1010, 1012 (8th Cir. 2001).

¹⁰ *Levy*, 104 F.3d at 42 (“where the Trademark Board has indeed compared conflicting marks in their entire marketplace context, the factual basis for the likelihood of confusion issue is the same, the issues are the same, and collateral estoppel is appropriate.”). *See also Levi Strauss & Co. v. Abercrombie &*

standard for preclusion in a likelihood of confusion case, the Second Circuit stated that the Board must have “compared conflicting marks in their entire marketplace context” in order for the issue to be the same.¹¹ However, the Second Circuit also stated that, in order for issue preclusion to apply, the first tribunal considering likelihood of confusion “must have taken into account, in a meaningful way, the *context* of the marketplace.”¹²

AIPLA agrees with views of the United States in this case that it is not appropriate to scrutinize how “meaningful” the Board’s consideration of the marketplace context was.¹³ As pointed out in the government’s amicus brief recommending review, “the appropriate question is whether the infringement action encompasses usages that materially differ from the usages that the Board considered.”¹⁴

The United States explained that “issue preclusion depends on whether the scope of usage considered by the Board materially differed from the actual usage presented in the infringement action.”¹⁵ Later in its brief, the United States refers to the

Fitch Trading Co., 719 F.3d 1367, 1374-74 (Fed. Cir. 2013) (analyzing whether a court judgment was preclusive of TTAB proceedings).

¹¹ *Levy*, 104 F.3d at 42.

¹² *Id.* (emphasis in original).

¹³ CVSG Brief for the United States as Amicus Curiae on Petition for a Writ of Certiorari at 19.

¹⁴ *Id.*

¹⁵ *Id.* at 10.

difficulty this court might have in determining what the TTAB and the district court “adjudicated.”¹⁶ AIPLA generally agrees with the United States’ position, but notes that issue preclusion may be considered early in litigation before evidence of actual usage has been “presented” or “adjudicated.”¹⁷

B. The Fact That Two Tribunals Use Slightly Different Factors To Analyze Likelihood Of Confusion Does Not Mean They Are Not Analyzing The Same Issue

The Eighth Circuit decision incorrectly implies that the specific list of factors considered must be the same in order for issue preclusion to apply. In its discussion, the Eighth Circuit held:

Although some of the *E.I. DuPont* factors are the same or comparable to the *SquirtCo* factors, “for collateral estoppel to apply, the [TTAB] must have examined the ‘entire marketplace context’” as is done in trademark infringement actions.¹⁸

The implication that a court should undertake a comparison of the factors applied as part of its preclusion analysis is misplaced. The factors that

¹⁶ *Id.* at 23.

¹⁷ *See, e.g., Jean Alexander Cosmetics, Inc. v. L’Oreal USA, Inc.*, 458 F.3d 244, 246 (3d Cir. 2006) (affirming district court dismissal based on issue preclusion); *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 746 F.2d 375 (7th Cir. 1984) (affirming district court grant of summary judgment on basis of collateral estoppel).

¹⁸ *B&B Hardware*, 716 F.3d at 1025.

courts consider are merely “guideposts,”¹⁹ and differences between them do not alter the issue to be decided, namely whether there is a likelihood of confusion between marks as used in the marketplace. If differences between the factors were part of the preclusion analysis, decisions by courts in other circuits could never be issue preclusive.

C. Under Principles Of Administrative Law And This Court’s Precedent, TTAB Decisions May Have Preclusive Effect In Appropriate Circumstances

Although it was presented with the issue, the Eighth Circuit assumed without deciding that the TTAB, as an administrative agency rather than an Article III court, has the capacity to render decisions that may be afforded preclusive effect.

This Court should now take this opportunity to settle the question by expressly confirming that the TTAB has such a capacity. The majority opinion provides the authority for this conclusion in its citation to this Court’s precedent in *Univ. of Tenn. v. Elliott*, 478 U.S. 788 (1986) (citing *United States v. Utah Constr. & Mining Co.*, 384 U.S. 394, 422 (1966)) (“We have previously recognized that it is sound policy to apply principles of issue preclusion to the

¹⁹ See *La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, No. 12-15985 2014 U.S. App. LEXIS 15166 (9th Cir. Aug. 6, 2014).

factfinding of administrative bodies acting in a judicial capacity.”).²⁰

In addition, the dissenting Ninth Circuit judge in this case recognized the weight of authority supporting this conclusion.²¹ Circuit Judge Colloton pointed to this Court’s statement that “giving preclusive effect to administrative factfinding serves the value underlying general principles of collateral estoppel: enforcing repose.”²²

This conclusion is also supported by a renowned treatise author on trademark law, who has stated as follows:

The Trademark Board’s function “is to determine whether there is a right to secure or to maintain a registration.” If in the course of doing so factual issues are decided, there is no policy reason why those factual questions should not be foreclosed from further re-litigation in court as long as the issues in the two cases are indeed

²⁰ See also *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 107 (1991) (holding that issue preclusion is generally appropriate when “an administrative agency is acting in a judicial capacity and resolved disputed issues of fact properly before it which the parties have had an adequate opportunity to litigate.”).

²¹ *B&B Hardware*, 716 F.3d at 1028.

²² See *Univ. of Tenn.*, 478 U.S. at 798, 106 S.Ct. 3220, 92 L.Ed.2d 635 (1986).

identical and the other rules of collateral estoppel are carefully observed.²³

This Court should clarify that, as an administrative agency acting in a judicial capacity, TTAB decisions may be entitled to the application of collateral estoppel in appropriate circumstances, albeit those circumstances may be rare.²⁴

II. BROAD APPLICATION OF ISSUE PRECLUSION COULD NEGATIVELY TRANSFORM *INTER PARTES* PRACTICE BEFORE THE TTAB

A. TTAB Preclusion Should Be The Exception, Not The Rule

This Court should recognize the possibility that a TTAB ruling may have a preclusive effect, but it also should recognize that a broad application of issue preclusion could negatively affect inter partes practice before the TTAB.

²³ 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:99 (4th ed. 2013) (footnote omitted).

²⁴ See *United States v. Utah Constr. & Mining Co.*, 384 U.S. 394, 422 (1966) (“We have previously recognized that it is sound policy to apply principles of issue preclusion to the factfinding of administrative bodies acting in a judicial capacity.”); *Astoria Fed. Sav.*, 501 U.S. at 107 (holding that issue preclusion is generally appropriate when “an administrative agency is acting in a judicial capacity and resolved disputed issues of fact properly before it which the parties have had an adequate opportunity to litigate.”).

For example, if a TTAB ruling on likelihood of confusion routinely became the last word on likelihood of confusion, parties may feel compelled to introduce significantly more evidence, object more to the other side's evidence, and generally handle the proceeding more aggressively.

These concerns should be balanced against the policy benefits on which issue preclusion is grounded. While issue preclusion could increase the costs and burdens of TTAB litigation, avoidance of subsequent litigation conserves the overall resources of both litigants and courts.²⁵

B. TTAB Disputes Are Not Litigated In The Same Way As Lawsuits

Narrow application of issue preclusion to TTAB proceedings is important because of the significant differences between TTAB and court proceedings.

Parties engaged in a TTAB dispute typically do not invest the same resources or effort as they would invest in a lawsuit. Survey evidence indicates that the median total cost of a trademark opposition or cancellation proceeding is \$80,000, while the median total cost of a trademark infringement action

²⁵ *Parklane-Hosiery Co. v. Shore*, 439 U.S. 322, 326 (1979) (“Collateral estoppel, like the related doctrine of res judicata, has the dual purpose of protecting litigants from the burden of relitigating an identical issue with the same party or his privy and of promoting judicial economy by preventing needless litigation.”) (citations omitted).

is \$300,000 where less than \$1 million is at stake, and rises to \$800,000 where \$1-25 million is at stake.²⁶

This is undoubtedly because the TTAB can only rule on trademark applications and registrations, and cannot issue injunctive or monetary relief. As such, parties often consider less to be at stake at the TTAB, and view the “psychological impact” of commencing a TTAB proceeding to be less than that of filing a federal court litigation.²⁷

Further, there are many situations where TTAB decisions will not be based upon a consideration of the entire marketplace context, and a preclusion consequently should not apply. For example where:

- the application was based on intent-to-use, and the Board did not consider evidence of the applicant’s use;
- the application was for a word mark (standard characters) rather than a stylized mark or logo, and the applicant’s manner of using the mark in the marketplace differs from that depicted in the application;

²⁶ See AIPLA, REPORT OF THE ECONOMIC SURVEY 35-36, I-161-62, I-169 (2013).

²⁷ JONATHAN HUDIS, A LEGAL STRATEGIST’S GUIDE TO TRADEMARK TRIAL AND APPEAL BOARD PRACTICE 2 (ABA, 2d ed. 2012).

- the opposer relied solely on its rights under one or more registrations, and the Board did not consider the opposer's manner of use of its marks in the marketplace;
- either party's manner of using its mark in the marketplace differs from usages considered by the Board, e.g., the defendant uses different colors or fonts, or uses a disclaimer;
- either party's goods and services differs from those considered by the Board;
- the facts have changed, e.g., one party's mark has become stronger or weaker, the goods and services are different, etc.

These distinctive features of TTAB proceedings are recognized by courts and commentators. For example, in determining that issue preclusion did not apply between a lawsuit and a subsequent TTAB proceeding, the Federal Circuit emphasized that the goods and services set forth in the subject application were broader than the items the applicant had already marketed.²⁸

²⁸ *Levi Strauss*, 719 F.3d at 1373 (holding that issue preclusion is not warranted “where infringement litigation was followed by PTO proceedings involving a challenge to a registration of broader scope than the subject of the infringement case.”). *See also* 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:88 (4th ed. 2013) (discussing changes in facts).

C. Issue Preclusion Is Fact Specific, Requiring Consideration Of All The Traditional Elements

Of course under this Court's long-standing authority, identity of issues is not the sole factor in a determination of issue preclusion. Courts must also evaluate whether the issues were actually litigated, whether the determination of the issues was necessary to the resulting judgment, and whether the parties had a full and fair opportunity to litigate the issues. These are necessarily fact-specific determinations to be decided on a case-by-case basis.

Further, as noted above, a TTAB decision also may not be preclusive if there have been changes to marketplace usages, the strength of the parties' marks, consumer perceptions, etc.

III. NO DEFERENCE SHOULD BE AFFORDED IF ISSUE PRECLUSION DOES NOT APPLY BECAUSE THE TTAB DECIDED A DIFFERENT ISSUE

B&B argues in its petition for review that the Fifth and Eleventh Circuits would apply a form of deference, and that if the Eighth Circuit were to follow them, it would have been enough to reverse. However, B&B concludes that such an approach "ultimately is inadequate," since a TTAB decision becomes final absent an appeal, and should not be "second-guessed" by a subsequent court, "even if that

court has a ‘thorough conviction’ that the TTAB has erred.”²⁹

In its brief in opposition to review, Hargis addresses the issue in a single footnote,³⁰ where it states that the PTO is looking at a different issue (the goods described in the registration regardless of actual usage of the mark), and then asserts that this analysis requires “no specialized knowledge” or “expertise” since juries can decide likelihood of confusion.

The United States argues that if the TTAB decision is not given preclusive effect, “there is no sound reason to give the Board decision any measure of deference. The deference question might be answered differently when issue preclusion is inappropriate for another reason – for example, when the issue actually resolved by the Board was not necessary to its ultimate decision – but that situation is not presented here.”³¹

AIPLA agrees with the United States’ position. If a TTAB decision is not afforded preclusive effect because the issue is not the same, then no deference is due. However, deference may be appropriate where a TTAB decision is denied preclusive effect for other reasons.

²⁹ Petition for a Writ of Certiorari to the United States Court of Appeals for the 8th Circuit at 25.

³⁰ Brief in Opposition on Petition for a Writ of Certiorari at n.10.

³¹ CVSG Brief for the United States as Amicus Curiae on Petition for a Writ of Certiorari at 17-18.

CONCLUSION

For the foregoing reasons, AIPLA respectfully requests that the Court clarify that a TTAB decision on likelihood of confusion can, in appropriate and narrow circumstances, have a preclusive effect, and that if a TTAB decision is denied preclusive effect because the issue is not the same, then no deference is due. However, deference may be appropriate where a TTAB decision is denied preclusive effect for other reasons.

Respectfully submitted,

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