

No. _____

**In The
Supreme Court of the United States**

————— ◆ —————

BRANDED LLC,
Petitioner,

v.

**ANDREI IANCU, DIRECTOR,
UNITED STATES PATENT AND
TRADEMARK OFFICE,**
Respondent.

————— ◆ —————

**ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

————— ◆ —————

PETITION FOR WRIT OF CERTIORARI

————— ◆ —————

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Dated: July 8, 2019

QUESTIONS PRESENTED

- I. Whether the Federal Circuit test impermissibly categorizes “descriptive” marks as unprotectable “generic” marks, on the basis of the mark describing the article of trade, its qualities, ingredients, or characteristics.

- II. Whether the Trademark Trial and Appeal Board impermissibly ignored their holdings in prior registration, which had been litigated ex parte before registering to the principal register, when there is no evidence of changes in circumstances surrounding the mark, the market, or the relevant public.

**LIST OF PARTIES
TO THE PROCEEDING**

All parties appear in the caption of the case on the cover page.

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, petitioner states that it has no parent corporation and no publicly held company owns 10% or more of petitioner's stock.

Branded, LLC is wholly owned by Keith Johnston. It has no parent corporation, and no publicly held company owns 10 percent or more of its stock.

STATEMENT OF RELATED CASES

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PETITION FOR A WRIT OF CERTIORARI

Branded LLC respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals is unreported and is reproduced at 1a. The opinion of the United States Trial and Appeal Board is unreported and is reproduced at 3a.

JURISDICTION

The Court of Appeals entered final judgment on April 8, 2019. No petition for rehearing was filed. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1). The Trademark Trial and Appeal Board had subject matter jurisdiction to hear this action under at least 15 U.S.C. § 1070. The Federal Circuit had appellate jurisdiction under 15 U.S.C. §§ 1071 and 1119 and 28 U.S.C. § 1295(a)(4)(B).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8 of the Constitution of the United States provides in relevant part:

The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

15 U.S.C. § 1052 provides:

No trademark by which the goods of the applicant may be distinguished from the goods

of others shall be refused registration on the principal register on account of its nature unless it— . . . (e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them

15 U.S.C. § 1052(f) provides:

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. . . .

STATEMENT OF THE CASE

This case presents two specific questions. First, this case presents a question of trademark law regarding the boundary of the distinctiveness categories “generic” and “descriptive”. The case specifically presents a question of whether a term describing an ingredient or a characteristic of a good is merely descriptive or generic. Second, this case presents a question of whether an agency may ignore their prior adjudicative final decisions that were properly litigated, when there is no evidence of a material change in circumstances.

I. The Lanham Act Requires a Mark be Distinctive to be Registered

A mark must be distinguishable from all other marks to be published on the federal register. 15 U.S.C. § 1052. A mark must be capable of being distinguishable from all other marks to be published on the supplemental register. 15 U.S.C. § 1091.

Whether a mark is distinguishable is determined by the distinctiveness of the mark, with five groups: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary; or (5) fanciful. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 2757 (1992). A mark is inherently eligible for federal trademark protection if it is suggestive, arbitrary, or fanciful. *Id.* A mark that is descriptive becomes eligible for federal trademark protection only when it has acquired distinctiveness through secondary meaning. *Id.* at 769. A generic mark is never eligible for trademark protection. *Id.* at 768. The Supreme Court has long distinguished between “generic” and “descriptive”. If the mark describes the “article of trade, of its qualities, ingredients, or characteristics”, then it is “descriptive”. *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871); see *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, 454, 31 S. Ct. 456, 457 (1911); *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543-44, 40 S. Ct. 414, 416 (1920). For a mark to be “generic”, it must be the term that “refers to the genus of which the particular product is a species.” *Park ‘n Fly v. Dollar Park & Fly*, 469 U.S. 189, 194, 105 S. Ct. 658, 661 (1985) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (CA2 1976)).

The Federal Circuit abandoned both the Supreme Court’s species-genus distinction and the definition of “descriptive” in the 2016. The Federal Circuit expanded the scope of “generic” to include the genus or to any category that may exist within the genus, without explaining how sub-groups fit in with the species-genus hierarchy or how to differentiate between these sub-categories and the species of the goods or services. *In re Cordua Rests., Inc.*, 823 F.3d

594, 605 (Fed. Cir. 2016) (“a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole”). The Federal Circuit has replaced the longstanding Supreme Court definition of “merely descriptive” with a “key aspect” test. Where the Supreme Court defined “merely descriptive” to encompass marks that describe the “article of trade, of its qualities, ingredients, or characteristics”, *Canal Co.*, 80 U.S. at 323, the Federal Circuit uses a “key aspect” test. *In re Cordua Rests.*, 823 F.3d at 603. The test is used to assess not whether a mark would be generic of the good or of the genus, but of any “key aspect”. *Id.* (a term can be generic for a genus of goods or services if the relevant public . . . understands the term to refer to a key aspect of that genus). When creating the rules, the Federal Circuit held that a Spanish word for “steak” was generic for the genus “restaurants”, because one of the characteristics of the Applicant’s restaurant was that it served steak dishes. *Id.* Later, the Federal Circuit used the rules to remand a case to determine if “Zero” was generic for the genus “soft drinks, energy drinks, and sports drinks” if, when “Zero” was placed beside the name of the drink, it would be understood as describing the amount of calories in the type of drink. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1368 (Fed. Cir. 2018).

II. TTAB Rules “TWEEDS”, US Registration Number 1697698, Eligible for Publication on the Federal Register and “TWEEDS” was Published on the Principal Register

The USPTO made a final order regarding the trademark “TWEEDS”, US Registration Number 1697698, which was previously published on the Principal Register. (30a). The mark was first in use on June 25, 1987. (32a). The application was filed on September 22, 1987. (30a). The mark was subjected to nearly two years of adjudication and review. (33a-34a). On April 22, 1991, the mark was approved for registration on the supplemental register, requiring a determination that the mark was not generic. (33a); 15 U.S.C. § 1091. The mark was published on the principal register on June 30, 1992, requiring determination that the mark had acquired distinctiveness. (33a).

III. TTAB Rules the Previous USPTO Holdings and the Registration of the Mark After Approval For The Supplemental Register and Acquiring Distinctiveness are “Meritless”

TTAB failed to address that the USPTO had already made a decision on the issue, and that USPTO registration decisions are subject to issue preclusion. *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1309 (2015). TTAB does so without any evidence of any material legal or factual change in circumstances since the prior decision. *See generally In re Branded LLC*, 2018 BL 69265, 1 (T.T.A.B. 2018).

TTAB held that previous registration of the mark, requiring litigation and finding of being not generic to be determined eligible for the supplemental register, to be “meritless”. *Id.* TTAB gave no weight to the previous USPTO decisions on the same issue, on the same mark for the same goods, between the same parties in the same positions, with the same laws, before the same agency. *Id.* at 1-2. To justify the position, TTAB relied on justification that different marks would be assessed independently assessed independently of one another for each required element, regardless of how similar the different marks may be. *Id.* TTAB fails to recognize that Application Serial No. 86/529,647 is legally the same mark, and thus issue preclusion would apply. *B&B Hardware*, 135 S. Ct. at 1308.

Instead of acknowledging the validity of the prior registration of the mark, The Trademark Trial and Appeals Board (“TTAB”) erroneously dismissed and characterized the argument as being focused on previous ownership of a mark. *In re Branded LLC*, 2018 BL 69265, 1-2. In doing so, TTAB failed to recognize that prior agency actions under the Lanham Act have preclusive effect on later adjudication, if the issue was actually litigated and necessary for the decision. *B&B Hardware*, 135 S. Ct. at 1306. TTAB argues that the prior decision was “meritless” and a new decision is warranted if the previous decision was mistaken. *In re Branded LLC*, 2018 BL 69265, 1-2. The TTAB argument fails to acknowledge that issue preclusion applies without regard to whether the current trier agrees with the earlier decision. *B&B Hardware*, 135 S. Ct. at 1308 (“The fact that the TTAB may have erred, however, does not prevent preclusion.”).

IV. TTAB Rules The Mark “Generic” Because the Mark Would Be Recognized For Indicating Ingredients, Qualities, And/Or Characteristics of The Goods

TTAB held that “TWEEDS” is generic, because “tweed”, when paired with “shirt” or “sweater” would be recognized by the relevant purchasing public to describe shirts or sweaters that were “made of tweed fabric, or that have the appearance, look, or style of tweed fabric”. *In re Branded LLC*, 2018 BL 69265, 3.

TTAB determines that the genera of goods are “Shirts” and “Sweaters”. *Id.* at 2. TTAB holds that the evidence does not support that “TWEEDS” or “tweed” would be understood to refer to the genera of “shirts” or “sweaters”. *Id.* at 3.

TTAB explained that “tweed” can be used as an adjective that describes tweed fabric and the characteristics or qualities of tweed. *Id.* at 4. TTAB explains that the relevant public recognizes “tweed” to describe that tweed is an ingredient of the product or to describe the characteristics or qualities of the product. *Id.*

TTAB held when “tweed” is paired with “shirt” or “sweater”, the relevant purchasing public would understand it to refer to types of shirts or sweaters which in which tweed is an ingredient of the product or which have qualities or characteristics of tweed. *Id.* TTAB held, therefore, that “tweed shirts” and “tweed sweaters” would be distinct groups. *Id.* at 3. TTAB then, while “shirts” and “sweaters” are the genera. held that this makes “TWEEDS” generic for the species of shirts or sweaters that have tweed as an ingredient, quality, or characteristic. *Id.* at 4.

V. United States Court of Appeals for the Federal Circuit Affirms TTAB Ruling

The Federal Circuit affirmed the TTAB ruling without issuing an opinion. *In re Branded LLC*, 763 F. App'x 916, 916 (Fed. Cir. 2019) (per curiam).

VI. Based on prior US Supreme Court precedent Applicant disagrees with the ruling that the TWEEDS mark is generic

Based on prior US Supreme Court cases and precedent Applicant disagrees with the findings and rulings of the TTAB and the United States Court of Federal Appeals for the Federal Circuit that the TWEEDS mark is generic.

REASONS FOR GRANTING THE PETITION FOR THE FIRST QUESTION PRESENTED

I. THE DECISION BELOW CONFLICTS WITH MULTIPLE PRECEDENTS OF THIS COURT DEFINING AND APPLYING “GENERIC” AND “DESCRIPTIVE” FOR TRADEMARK DISTINCTIVENESS

The United States Supreme Court has ruled that “merely descriptive” has long been defined to include any mark that describes the “article of trade, of its qualities, ingredients, or characteristics”. *Canal Co.*, 80 U.S. at 323. A mark is generic if it “refers to the genus of which the particular product is a species.” *Park 'n Fly v. Dollar Park & Fly*, 469 U.S. 189, 194, 105 S. Ct. 658, 661 (1985) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (CA2 1976)).

Applicants for trademarks from the United States Trademark Office should be able to reply on the determinations made by the United States Supreme Court in determining if their mark is descriptive or generic.

The Federal Circuit previously has held that “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986) (the mark involved in the Ginn case was FIRE CHIEF used for a magazine directed to the field of firefighting, which the court found not to be generic). The court has laid out a “two-step inquiry” for making the genericness determination: “First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?” *Id.*

The Federal Circuit recently expanded the “*Ginn*” test, making it a broader test that is open to subjective findings that include terms which can be part of the claimed goods or services. *In re Cordua Rests.*, 823 F.3d at 605 (“a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole”). This test is overly broad and can have unforeseen and non-predictable outcomes for the applicant of a trademark application.

The Federal Circuit test creates results that are not consistent with prior Supreme Court rules. It is important that trademark applicants know if the previously decided US Supreme Court cases control whether or not a trademark is deemed to be descriptive or if the new test provided by the Federal Circuit Court in *In re Cordua Rests.*, controls. *See id.* Trademark owners need to know where the United States Supreme Court stands on this issue and test.

II. THE DECISION BELOW RENDERS 15 U.S.C. § 1052(f) SUPERFLUOUS

The Federal Circuit has rendered 15 U.S.C. § 1052(f) superfluous by creating legal tests that can be used to render any potentially descriptive term “generic”, even if it meets what has traditionally been understood to be “descriptive” in case law and previous statutes.

15 U.S.C. § 1052(f) is explicit that “merely descriptive” marks are capable of becoming distinctive. Congress, in text and by history, demonstrated an awareness of the case law that defined “descriptive” and created statutory law that holds that descriptive marks are separate and unique from generic marks. The Federal Circuit rules do an end-run around this rule by declaring descriptive terms to be “generic” because people can recognize that they refer to a quality or characteristic of a good.

Originally, common law trademarks did not protect generic or descriptive marks. *Canal Co.*, 80 U.S. at 323. “Descriptive” marks were long defined to include marks “consisting merely of words descriptive of the qualities, ingredients or characteristics of an article of trade”. *Estate of P.D.*

Beckwith, 252 U.S. at 543. The Registration Act of 1905 initially prohibited descriptive marks from federal protection. 58 P.L. 84, 33 Stat. 724, 58 Cong. Ch. 592, 58 P.L. 84, 33 Stat. 724, 58 Cong. Ch. 592. The Registration Act of 1905 deemed a mark descriptive if the mark “merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods.” *Id.*

Congress let its intent be known through the Lanham Act, which expanded protection to “descriptive” marks that acquired secondary meaning. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171, 115 S. Ct. 1300, 1307 (1995) (citing 15 U.S.C. § 1052(f)).

The only changes since common law are that the Registration Act of 1905 did not define “descriptive” to include “ingredients”, and that the Lanham Act later removed the ban on descriptive marks. Trademark laws did not redefine the terms “descriptive” or “generic” in any way that would change characteristics or qualities of the goods from being descriptive. *See generally* 15 U.S.C. §§ 1051-1141n.

III. THIS CASE IS AN IDEAL VEHICLE TO RESTORE CLARITY OF THE DIFFERENCES BETWEEN THE “GENERIC” AND “DESCRIPTIVE” CATEGORIES

This case is a clean example of a descriptive term that serves either as an indication of an “ingredient”, “quality”, or “characteristic” of the good. The case provides a simple legal example of what is descriptive compared to what is generic. It is a clean

example of deviation from the genus-species framework provided by the United States Supreme Court, as TTAB clearly distinguished “Shirts” and “Sweaters” as the genera but then ignored the genus and instead applied the “generic” test on a term describing the “tweed” species of “Shirts” and “Sweaters.”

**REASONS FOR GRANTING THE PETITION
FOR SECOND QUESTION PRESENTED**

I. THE DECISION BELOW CONFLICTS WITH RECENT PRECEDENT OF THIS COURT BY STATING THAT IT WAS NOT BOUND BY PREVIOUS ADJUDICATIVE HOLDINGS ON THE EXACT ISSUE

“This Court has long recognized that ‘the determination of a question directly involved in one action is conclusive as to that question in a second suit.’” *B&B Hardware*, 135 S. Ct. at 1302 (citing *Cromwell v. County of Sac*, 94 U.S. 351, 354, 24 L. Ed. 195 (1877)). “Once a court has decided an issue, it is ‘forever settled as between the parties.’” *B&B Hardware*, 135 S. Ct. at 1302 (citing *Baldwin v. Iowa State Traveling Men’s Assn.*, 283 U.S. 522, 525, 51 S. Ct. 517, 75 L. Ed. 1244 (1931)).

The Court’s longstanding view is that “[w]hen an administrative agency is acting in a judicial capacity and resolves disputed issues of fact properly before it which the parties have had an adequate opportunity to litigate, the courts have not hesitated to apply res judicata to enforce repose”, a view that was not followed in this case. *University of Tenn. v. Elliott*, 478 U.S. 788, 797-798, 106 S. Ct. 3220, 92 L. Ed. 2d 635 (1986) (quoting

United States v. Utah Constr. & Mining Co., 384 U.S. 394, 422, 86 S. Ct. 1545, 16 L. Ed. 2d 642, 176 Ct. Cl. 1391 (1966).

The *B&B Hardware* case states that TTAB decisions can create issue preclusion. 135 S. Ct. at 1305. But counter to the ruling, the TTAB explicitly stated that a prior TTAB decision on the same issues and same trademark have “no merits”, without ever exploring if the prior holding would preclude re-litigating the trademark based on the same issue, on the same mark for the same goods, between the same parties in the same positions, with the same laws, before the same agency. The prior trademark resulted in registration on the primary registry and was not determined to be generic.

II. THIS CASE IS AN IDEAL VEHICLE TO APPLY ISSUE PRECLUSION TO ADJUDICATION BETWEEN THE PATENT AND TRADEMARK BOARD AND APPLICANTS

Regarding issue preclusion, this case is ideal as the only issue is whether an ex parte TTAB holding can be a final ruling for issue preclusion purposes. The mark at hand is the same trademark registration that was previously litigated and registered, not a similar or even identical mark, but the actual and legally same trademark. The United States Patent and Trademark Office (“USPTO”) never alleges that there has been any material changes of any aspect of the mark, the market, or the relevant public. There is no factual issue in dispute, as it is just that TTAB outright refuses to consider the previous holdings.

There are no legal issues regarding whether issue preclusion could apply, as it was previously litigated; distinctiveness is mandatory for registration, it was found to be eligible for the supplemental register and then acquired it as a descriptive mark in use for 5 years; the USPTO is in the exact same position and litigation is with the applicant who is the successor to the original trademark.

CONCLUSION

For the reasons set forth above, this Petition for a Writ of Certiorari should be granted.

Dated: July 8, 2019

Respectfully submitted,

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