

No. 15-563

IN THE
Supreme Court of the United States

MILO SHAMMAS,

Petitioner,

v.

DREW HIRSHFELD, COMMISSIONER FOR PATENTS,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

BRIEF OF NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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INTEREST OF *AMICUS CURIAE*

The New York Intellectual Property Law Association (“NYIPLA” or “Association”) respectfully submits this brief as *amicus curiae* in support of the Petition of Milo Shammas (“Petitioner”) and respectfully urges this Court to review the merits of the panel decision and judgment of the United States Court of Appeals for the Fourth Circuit in *Shammas v. Focarino*, 784 F.3d 219 (2015), *reh’g denied*, No. 14-1191, (4th Cir. July 1, 2015).¹

The arguments set forth herein were approved on November 24, 2015 by an absolute majority of the officers and members of the Board of Directors of the NYIPLA, including officers or directors who did not vote for any reason, including recusal, but do not necessarily reflect the views of a majority of the members of the Association, or of the law firms or corporate organizations with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director of the Association, or member of the Association’s Committee on Amicus Briefs who voted in favor of filing this brief, or any attorney associated with any such officer, director, or committee member, whether alone or in any law firm or corporate organization,

¹ Pursuant to Sup. Ct. R. 37.6, the NYIPLA and its counsel represent that they have authored the entirety of this brief, and that no person or entity other than the *amicus curiae* or its counsel has made a monetary contribution to the preparation or submission of this brief. Pursuant to Sup. Ct. R. 37.2(a), Respondent’s written consent to the filing of this brief is submitted herewith. Petitioner has consented to the filing of *amici curiae* briefs in support of either party or neither party in a docket entry dated November 18, 2015.

represents a party in this litigation. Some officers, directors, committee members, or attorneys associated with them may represent entities, including other *amici curiae*, which have an interest in other matters that might be affected by the outcome of this litigation.

The NYIPLA is a professional association of more than 1,300 attorneys whose interests and practices lie in the areas of trademarks, patents, copyrights, trade secrets, and other forms of intellectual property (“IP”) law. The NYIPLA is one of the largest regional IP bar associations in the United States. The Association’s members include in-house counsel serving businesses and other organizations that deal with IP rights in all products, technologies, and disciplines, as well as attorneys in private practice who represent both IP owners and their adversaries (many of whom are also IP owners). The entities served by the NYIPLA’s members include businesses, entrepreneurs, venture capitalists, inventors, universities, and industry and other associations.

Directly relevant to the issue here, many of the Association’s members regularly represent and counsel clients in the federal registration of their trademarks by the U.S. Patent and Trademark Office (“PTO”) pursuant to the Trademark Act of 1946 (the “Lanham Act”), 15 U.S.C. §§ 1051 *et seq.*, and in the judicial review of adverse decisions of the PTO. The NYIPLA’s members and their clients therefore have a keen desire and interest in maintaining clear, consistent, and equitable principles of trademark law and bring an informed perspective to the issue

presented.

In particular, the NYIPLA has an interest in the correct judicial interpretation of the expense-shifting language in Section 21(b)(3) of the Lanham Act, 15 U.S.C. § 1071(b)(3), relating to civil actions against the PTO in district court instituted by aggrieved trademark applicants who seek *de novo* review of the PTO's denial of registration. The NYIPLA, based on its own perspective and expertise, believes that the granting of *certiorari* is necessary in this case in order that the Court may provide uniform guidance to the lower federal courts as to the correct interpretation of the statute and enable NYIPLA members to advise their clients reliably regarding the consequences of filing an appeal to the district court of PTO denials of registration.

INTRODUCTION

Section 21 of the Lanham Act (15 U.S.C. § 1071) provides trademark applicants who are dissatisfied with certain decisions made by the PTO's Trademark Trial and Appeal Board ("TTAB") regarding their U.S. Trademark Applications with two options:

1. Under Section 21(a), they may appeal the unfavorable decision to the U.S. Court of Appeals for the Federal Circuit. 15 U.S.C. § 1071(a); or
2. Under Section 21(b), they may appeal the decision *de novo* to a U.S. district court. 15 U.S.C. § 1071(b).

Congress provided applicants with the ability to appeal to the district courts primarily to afford them the option of providing new evidence in a trial court. *See CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 673 (7th Cir. 2001).

The Petition presents a question of exceptional importance to brand owners seeking to avail themselves of the advantages of federal trademark registration:

Whether the requirement in Section 21(b)(3) of the Lanham Act, that “unless the court finds [them] to be unreasonable, all the *expenses* of the proceeding shall be paid by the party bringing the action,” 15 U.S.C. § 1071(b)(3) (emphasis added), was misconstrued by the Court of Appeals to include the salaries of the PTO’s in-house legal and paralegal employees as “attorney fees?”²

The NYIPLA respectfully submits that the Fourth Circuit’s decision to include these salaries contravenes the meaning of the Lanham Act, violates the American Rule and, if allowed to stand, will discourage trademark applicants from seeking warranted *de novo* reviews of flawed PTO decisions.

² All emphasis supplied unless otherwise indicated.

THE PROCEEDINGS BELOW

I. IN THE PATENT AND TRADEMARK OFFICE

In 2009, Milo Shammas, who owns a company that sells gardening products, sought to register PROBIOTIC as a trademark for use on fertilizers. Shammas based his U.S. trademark application serial no. 77/758,863, on Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).³ In October 2012, the Trademark Trial and Appeal Board (“TTAB”) affirmed the examining attorney’s final rejection of the application on the grounds that the mark was generic and incapable of functioning as a source identifier for applicant’s goods. For the sake of completeness, the TTAB further found that even if the PROBIOTIC mark were considered merely descriptive, the evidence presented was insufficient to support a finding that the mark had acquired secondary meaning. *In re Shammas*, No. 77/758,863, 2012 TTAB LEXIS 429 (T.T.A.B. Oct. 25, 2012).

II. IN THE U.S. DISTRICT COURT

Shammas appealed the TTAB’s decision to the U.S. District Court for the Eastern District of Virginia rather than to the U.S. Court of Appeals for the Federal Circuit. *Shammas v. Rea*, No. 1:13-cv-1462 (E.D. Va. filed Dec. 19, 2012). By filing in the

³ Subject to certain exceptions, 15 U.S.C. § 1052(f) allows the PTO to register a trademark that is merely descriptive if the applicant can show that the mark has become sufficiently distinctive as to acquire “secondary meaning” among the public and functions as a trademark despite its descriptiveness.

district court, each side was afforded the opportunity to introduce additional evidence, not previously made of record before the TTAB, and have the district court decide the question of registration in light of the TTAB record and such new evidence *de novo*. *Shammas v. Rea*, 978 F. Supp. 2d 599, 608 (E.D. Va. 2013). This manner of appeal is specifically provided for by statute. 15 U.S.C. § 1071(b).

In 2013, the Parties filed cross-motions for summary judgment. Shammas argued that the PROBIOTIC mark had acquired secondary meaning and was therefore entitled to registration. The PTO, represented by Department of Justice (“DOJ”) lawyers,⁴ contended that the agency was entitled to judgment as a matter of law because the mark was generic and/or merely descriptive. After reviewing the evidence, the district court held that it was insufficient to support a finding of acquired distinctiveness and found that the PROBIOTIC mark was generic for the applied-for goods. The district court therefore granted summary judgment to the PTO. *Shammas v. Rea*, 978 F. Supp. 2d 599, 609 (E.D. Va. 2013).

Shortly thereafter, Shammas was served with a motion by the U.S. Attorney’s Office seeking expenses under 15 U.S.C. § 1071(b)(3). For the first time in the history of the Act (to the Association’s knowledge), such a motion sought payment not just of the PTO’s “expenses” in the action, but also “the

⁴ In district court, the PTO is usually represented by lawyers from the U.S. Attorney’s Office of the Department of Justice. 28 U.S.C. § 516.

outlay of . . . salaries . . . for the USPTO in-house attorneys and paralegal.” Memorandum In Support of Defendant’s Motion for Fees and Expenses, ECF 45 at 15-16, *Shammas v. Rea*, 978 F. Supp. 2d 599 (E.D. Va. 2013). Shammas opposed the awarding of such expenses to the PTO, noting that “nowhere in the hundreds of [civil actions against the PTO] in district courts spanning 170 years . . . had the PTO asked to recover [nor was it ever awarded] the money paid to its attorneys for hours worked” as an “expense” under § 1071(b)(3). Memorandum In Opposition to Defendant’s Motion for Fees and Expenses, ECF 48 at 2, *Shammas v. Rea*, 978 F. Supp. 2d 599 (E.D. Va. 2013).

Shammas further noted that, under the common law in this country, the presumption known as the American Rule is that each party to a litigation generally must bear its own attorney fees.⁵ *Id.*, at 3. Under the American Rule, attorney fees for services rendered in federal statute-enabled civil actions are neither taxable as costs nor recoverable as expenses against the losing party unless Congress expressly exercises its power to legislate otherwise. *See Marx v. General Revenue Corp.*, 133 S. Ct. 1166, 1175 (2013). The fact that Congress did not do so in § 1071(b)(3) should have precluded the award of such fees to the PTO in this case.

⁵ The American Rule has long been recognized and followed by courts in all U.S. jurisdictions except Alaska. *See Warren Drilling Co. v. Equitable Prod. Co.*, No. 14-3872, 2015 U.S. App. LEXIS 11530 at *14 (6th Cir. 2015).

On January 3, 2014, the U.S. district court held that:

The question whether ‘all the expenses of the proceeding’ includes attorney fees . . . is a straightforward case of statutory interpretation with the analysis beginning and ending with the plain language of the statute. In this regard, the ordinary definition of the term ‘expenses’ answers the question presented.

Shammas, 990 F. Supp. 2d at 590. The dictionary meaning of the term “expenses,” by itself, was deemed by the district court to include attorney fees. The court continued:

“But if any doubt remains about that inclusion, it is removed by Congress’s addition of the word ‘all’ to clarify the breadth of the term ‘expenses.’ When the word ‘expenses’ is prefaced with the word ‘all,’ it is pellucidly clear that Congress intended that the plaintiff in such an action pay for all the resources expended by the PTO during the litigation, including attorney fees.”

Id. The court cited a number of other statutes that explicitly include “attorney fees” as a “subset” of “expenses,” and relied upon *Fox v. Vice*, 131 S. Ct. 2205, 2213 (2011), and *United States ex. rel. Smith v. Gilbert Realty Co.*, 34 F. Supp. 2d 527 (E.D. Mich.), as further support. The court concluded that because the term “all the expenses of the proceeding’

clearly includes attorney fees, it follows that the PTO's claim for . . . [its allocated pro rata in-house attorney and paralegal] salaries . . . must be granted." *Shammas*, 990 F. Supp. 2d at 591-592.

III. IN THE U.S. COURT OF APPEALS

The U.S. Court of Appeals for the Fourth Circuit, in a divided three-judge panel decision affirmed the district court's order granting the PTO's request for attorney fees. *Shammas v. Focarino*, 784 F.3d 219 (2015), *reh'g denied*, No. 14-1191(4th Cir. July 1, 2015).

Shammas had based his appeal on two principles:

1. The bedrock principle of the American Rule whereby "each litigant pays his own attorney fees, win or lose, unless a statute or contract provides otherwise." Brief for Plaintiff-Appellant, ECF No. 20, at 11, *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015), (citing *Marx v. General Revenue Corp.*, 133 S. Ct. 1166, 1175 (2013)).
2. The holding in *Alyeska Pipeline Service Co. v. Wilderness Society*, 421 U.S. 240 (1975), that a district court cannot award attorney fees under an expense-shifting statute unless the statute specifically and explicitly includes such fees as part of the "expenses." *See also Baker Botts L.L.P. v. ASARCO LLC*, 135 S. Ct. 2158, 2164 (2015) (The Equal

Access to Justice Act “offers a good example of the clarity we have required to deviate from the American Rule” because it explicitly mentions fees.).

Building upon those principles, Shammas argued that there is “no other provision in the United States Code where Congress requires a litigant to pay the government’s attorney fees, irrespective of whether the litigant prevails. Although Congress presumably has the power to create such a formidable barrier to access to the district court, the district court [in this case] pointed to nothing to support its conclusion that Congress intended to take such an unparalleled step in [1071(b)(3)].” Brief for Plaintiff-Appellant, ECF No. 20, at 10, *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015).

The panel majority held that the American Rule is irrelevant because the expense-shifting provision in § 1071(b)(3) applies irrespective of who wins. The provision simply operates as a funding provision for the benefit of the PTO that “imposes a unilateral, compensatory fee on including attorneys fees, on every *ex parte* applicant who elects to engage the resources of the PTO when pursuing a *de novo* action in the district court.” 784 F.3d at 225.

The dissenting member of the panel (King, J.) gave three “compelling reasons” why the American Rule applies to § 1071(b)(3) and therefore precludes the district court from awarding attorney fees. 784 F.3d at 228.

1. First, the operative and necessary words “attorney fees” do not appear in the statute as they expressly do in at least five other sections of the Lanham Act. *Id.* This shows that Congress purposefully intended to omit such fees from § 1071(b)(3). *Id.* at 228-229.
2. Second, the statute does not otherwise provide clear support for the award of such fees. *Id.* at 229. In the absence of such clear support, courts should not override the presumption that the American Rule applies and engage in bootstrapping judicial speculation on the meaning of the term “all the expenses.” *Id.* at 228.
3. Third, “the background and subsequent long legislative history of § 1071(b)(3) fail to show that Congress ever intended to authorize” the awarding of attorney fees in these cases as it did in other litigation settings. *Id.* at 229-230. Furthermore, the PTO’s failure over the years to seek attorney fees in other § 1071(b)(3) cases seems to be “more than passing strange.” *Id.* at 230 n.4.

The dissent thus concluded that the panel majority’s acceptance of the PTO’s novel theory of how the statute should be interpreted, and the district court’s award of attorney fees under § 1071(b)(3) cannot be squared with the background legal principles or the history of the statute.

SUMMARY OF THE ARGUMENT

This case is one of first impression on the meaning of the term “all the expenses” in 15 U.S.C. § 1071(b)(3). The Petition seeks to clarify whether the term mandates that an aggrieved party seeking *de novo* review of an adverse PTO decision in an *ex parte* trademark case in federal district court must pay, as part of “all the expenses of the proceeding,” the PTO’s attorney fees, win or lose.

For the first time in its history as far as this Association is aware, the PTO has in this case made the unprecedented and unjustifiable argument that “all the expenses” includes its attorney fees. The PTO’s argument contravenes the American Rule. In fact, Section 1071(b)(3) does not expressly and unequivocally mandate attorney fee-shifting.

A writ for Petition for Certiorari should be granted to reject this argument, and preserve the feasibility of this statutory framework for aggrieved trademark owners.

I. The decisions below to award the PTO its “attorneys fees” as “expenses” under § 1071(b)(3) was clear error and must be corrected. This error is compounded by the award of non-out-of-pocket attorney fees (e.g., employees salaries).

Section 1071(b)(3) merely includes the award of “expenses” and not “attorney fees”. This Court has long recognized that unless Congress expressly authorizes the grant of “attorney fees”, the American

Rule prohibits such an award. The statutory language falls far short of such statutory authority.

II. The decisions below will have an unduly chilling effect on brand owners' ability to challenge improper governmental actions at the TTAB with new evidence. Without express statutory authority, this Court should not allow this denial of justice.

III. This case is the correct vehicle to address this issue. If this issue is not addressed in the present case, there is a risk that the decision below will discourage future litigants from having the opportunity to raise this issue. This Court should act now and fix this error while it has this vehicle to do so.

ARGUMENT

I. THE DECISION TO AWARD THE PTO ITS ATTORNEY FEES AS A PART OF "ALL THE EXPENSES OF THE PROCEEDING" UNDER SECTION 1071(b)(3) REPRESENTS CLEAR ERROR WHICH SHOULD BE CORRECTED BY THIS COURT

The Association respectfully submits that the decisions below to award the PTO its attorney fees under the guise of part of "all the expenses of the proceeding" is error which must be corrected by this Court. This error is further compounded by the award of non-out-of-pocket fees (e.g., employee salaries) in this case.

Section 1071(b)(3) does not expressly or implicitly permit the award of “attorney fees” to the PTO. Specifically, Section 1071(b)(3) states simply that

all the *expenses* of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not.

By its express terms, the statute merely allows for the award of “expenses,” and not “attorney fees.”

As this Court explained in *Alyeska Pipeline Service Co. v. Wilderness Society*, “[I]n 1796, this Court appears to have ruled that the Judiciary itself would not create a general rule, independent of any statute, allowing awards of attorney fees in federal courts.” 421 U.S. 240, 249 (1975). After discussing the progression of this nation’s rules regarding the award of “attorney fees” and “costs” in litigation, *Alyeska* explained “[u]nder this scheme of things, it is apparent that the circumstances under which attorney fees are to be awarded and the range of discretion of the courts in making those awards are matters for Congress to determine.” *Id.* at 262. Thus, *Alyeska* concluded that it was not for the Courts (even this Court) to allow for the award of attorney fees without express Congressional authority.

There are many examples of statutory schemes where Congress has, contrary to the American Rule authorized the award of attorney fees, as *Alyeska* explains. But in each case, Congress

used the words “attorney fees” and not merely “expenses.”

Here, there is no express statutory authority to award “attorney fees.” The statute does not expressly state that “attorney fees” are also to be shifted, and the word “expenses,” in itself, does not clearly include attorney fees (let alone the non-out-of-pocket fees--e.g., employee salaries sought by the government as a party here).

Consistent with this Court’s longstanding practice as discussed in *Alyeska*, attorney fees should be shifted only if the underlying fee-shifting statute expressly indicates and unequivocally states that expenses or costs include such fees. *Marek v. Chesny*, 473 U.S. 1, 8-9 (1985); *Utility Automation 2000, Inc. v. Choctawhatchee Elec. Co-op, Inc.*, 298 F.3d 1238, 1246 (11th Cir. 2002). That is simply not the case here. 15 U.S.C. § 1071(b)(3).

If the Section were construed to include attorney fees as advocated by the PTO, then because the expense shifting provision is agnostic as to the prevailing party, it could lead to the fundamental absurdity of requiring the winner in a civil action to pay for the losing side’s lawyers. In contrast, there is no absurdity in construing the Section to exclude attorney fees, because it is logically consistent that Congress would condition a trademark applicant’s right to an appeal under § 1071(b)(1) that allows additional discovery on paying the PTO’s expenses associated with that incremental discovery, which incremental expenses would not be incurred in a Federal Circuit appeal under § 1071(a)(1), yet in

either case the PTO would be responsible for its attorney fees.

Furthermore, unless the term “expenses of the proceeding” can be read to include “attorney fees”, the panel majority’s reliance upon “all” must be deemed misplaced. Since attorney fees cannot in fact be contemplated by terms like “expenses of the proceeding” or “cost of suit,” the focus upon “all” adds nothing. Indeed, where Congress wishes to include attorney’s fees within such a term, it has known since 1914 exactly how this can be accomplished and expressed.

Thus, Section 4 of the Clayton Act, 15 U.S.C. § 15, explicitly provides that any person injured “by reason of anything forbidden in the antitrust laws” may sue for recovery of “threefold the damages by him sustained, and the cost of suit, including a reasonable attorney’s fee.”

A Writ of Certiorari should issue to correct the injustice arising from the erroneous construction of “all the expenses” below.

II. THE DECISION BELOW WILL HAVE A CHILLING EFFECT ON THE BRINGING OF MERITORIOUS *DE NOVO* REVIEWS OF TTAB DECISIONS IN U.S. DISTRICT COURTS

If the Fourth Circuit’s decision in this case is allowed to stand unaltered, the ruling will have a chilling effect on *de novo* trademark appeals from the

TTAB to the U.S. district courts. As Judge Hill explained in his dissent to the Court of Appeals decision, “a primary justification for the [American] Rule is that a party should not be *penalized* for merely . . . prosecuting a lawsuit.” *Shammas*, 784 F.3d at 230. However, by ignoring the American Rule and substituting their own judgment for that of Congress, the PTO and lower courts do just that. If the Fourth Circuit’s decision is not corrected, very few aggrieved trademark applicants will elect to incur the extraordinary—and unpredictable—financial burden of paying the PTO’s lawyers by exercising their hitherto unfettered statutory right to challenge in district court the PTO’s denial of a federal trademark registration and the rights attendant thereto. Unless this Court takes action, the PTO’s argument and the Fourth Circuit’s decision affirming it would effectively eliminate, especially for plaintiffs of limited means, the practical relevance of § 1071(b) as recourse from adverse TTAB decisions by Congressionally mandated *de novo* judicial review. This would particularly penalize emerging entrepreneurs seeking to establish new products, create jobs, and protect their most important commercial asset – their brand.

III. THIS CASE IS THE CORRECT VEHICLE TO ADDRESS THIS ISSUE

This is the correct case for this Court to decide this very important issue. Prior to this decision, no court had ever adopted this overly expansive definition of “expenses” under the statute. If this

issue is not addressed in this case, and now, there is a risk that its impact will be to preclude other challenges to improper decisions of the TTAB under 15 U.S.C. § 1071(b). Thus, if not corrected here and now, there is a risk that this Court will not be provided with an additional opportunity to fix this egregious and harmful error.

This Court's long history of construing fee shifting statutes, the existence of a dissenting opinion at the Court of Appeals level, as well as the participation by *Amicus Curiae* both below and here, means that the record in this case already presents diverse perspectives and raises the relevant issues for consideration.

Accordingly, this case is well suitable to inform this Court's judgment on this important trademark issue in a timely manner.

CONCLUSION

For the foregoing reasons, the NYIPLA supports the Petition and believes that the present case is an appropriate vehicle for the Court to decide the merits of the issues as to whether "all the expenses of the proceeding" in an action against the PTO under Section 21(b) of the Lanham Act includes the salaries of attorneys and paralegals pro-rata employed by the PTO. Accordingly, the NYIPLA respectfully urges the Court to grant the Petition in its entirety.

Respectfully submitted,

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