No. 18-1309

IN THE

Supreme Court of the United States

BOOKING.COM B.V.,

Petitioner,

v.

UNITED STATES PATENT AND TRADEMARK OFFICE, *et al.*,

Respondents.

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

MOTION FOR LEAVE TO FILE *AMICUS CURIAE* BRIEF AND BRIEF OF NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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May 16, 2019

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MOTION FOR LEAVE TO FILE BRIEF OF *AMICUS CURIAE*

Pursuant to Supreme Court Rule 37.2, the New York Intellectual Property Law Association ("NYIPLA" or "Association") respectfully moves for leave to file the accompanying *amicus* curiae brief in support of the Petition of Booking.Com B.V. ("Petitioner"). Petitioner has consented to the filing of this *amicus* curiae brief. Respondent has not yet provided consent for the NYIPLA to file this brief. Accordingly, this motion for leave to file is necessary.

The NYIPLA is a bar association of more than 1,000 attorneys who practice in the area of patent, copyright, trademark, and other intellectual property ("IP") law. It is one of the largest regional IP bar associations in the United States. The Association's members include a diverse array of attorneys specializing in patent law, from in-house counsel for businesses that own, enforce and challenge patents, to attorneys in private practice who represent inventors and petitioners in various proceedings before the United States Patent and Trademark Office ("PTO").

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 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 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.

Movant respectfully seeks leave to file the accompanying *amici curiae* brief in support of the of the Petition of Petitioner. Movant NYIPLA respectfully submits that the proffered *amicus* brief will contribute to a fuller understanding of why this Court should grant certiorari in this case and consolidate it with *Peter v. NantKwest*, No. 18-801 under Rules of the Supreme Court 27, as follows:

This case raises the same issue as *NantKwest*, but for the Trademark Act (15 U.S.C.) instead of the Patent Act (35 U.S.C.).

This case offers a complementary fact pattern, where the United States Government is seeking fees as the unsuccessful party.

This case will bring in additional experienced counsel to offer additional viewpoints to assist the Court.

For the foregoing reasons, the NYIPLA respectfully requests that this Court grant leave to participate as *amicus* curiae and to file the accompanying *amicus* curiae brief in support of Petitioner.

Respectfully submitted,

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QUESTION PRESENTED

Whether a trademark applicant must pay the PTO's attorneys' fees as "expenses" in United States district court appeals pursuant to 15 U.S.C. § 1071 (b)(3).

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INTEREST OF *AMICUS CURIAE*[1]

The New York Intellectual Property Law Association ("NYIPLA" or "Association") respectfully submits this *amicus curiae* brief in support of the Petition of Booking.Com B.V. ("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 *Booking.Com B.V. v. United States Patent and Trademark Office*, 915 F.3d 171 (4th Cir. 2019), *reh'g denied*, No. 17-2458, (4th Cir. Apr. 5, 2019).

The arguments set forth herein were approved on May 15, 2019 by an absolute majority of the officers and members of the Board of Directors of the NYIPLA, including any 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 or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Committee on Amicus Briefs who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party in this litigation.

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1. Consent of Petitioner has been provided for the NYIPLA to file this brief. Respondent has not yet provided consent for the NYIPLA to file this brief. Pursuant to Sup. Ct. R. 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the NYIPLA, its members, or its counsel made a monetary contribution to its preparation or submission.

The NYIPLA is a bar association of more than 1,000 attorneys who practice in the area of patent, copyright, trademark, and other intellectual property ("IP") law. It is one of the largest regional IP bar associations in the United States. The Association's members include a diverse array of attorneys specializing in patent law, from in-house counsel for businesses that own, enforce and challenge patents, to attorneys in private practice who represent inventors and petitioners in various proceedings before the United States Patent and Trademark Office ("PTO").

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 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 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.

SUMMARY OF ARGUMENTS

This Court should grant certiorari in this case and consolidate it with *Peter v. NantKwest*, No. 18-801 under Rules of the Supreme Court 27.

This case raises the same issue as *NantKwest*, but for the Trademark Act (15 U.S.C.) instead of the Patent Act (35 U.S.C.).

This case offers a complementary fact pattern, where the United States Government is seeking fees as the unsuccessful party.

This case will bring in additional experienced counsel to offer additional viewpoints to assist the Court.

ARGUMENT

THIS CASE SHOULD BE DECIDED SIMULTANEOUSLY AS A COMPANION TO NANTKWEST, INC. V. PETER

An applicant for a trademark registration dissatisfied with a decision of the Trademark Trial and Appeal Board ("TTAB") can commence a civil action seeking *de novo* review in a United States District Court. 15 U.S.C. § 1071 (b)(3). Specifically, the Lanham Act provides that an applicant availing itself of this type of appeal is responsible for paying "all the expenses of the proceeding." *Id.* However, the Lanham Act fails to define

the term "expenses." As such, the federal courts of appeals are split as to the meaning of the word "expenses" under federal law.

This Court recently accepted this question to review the nearly identical language of the Patent Statute, 35 U.S.C. § 145, in *NantKwest, Inc. v. Iancu*, 898 F.3d 1177 (Fed. Cir. 2018) (en banc). Section 145 of the Patent Act, provides that, in district court appeals by initially unsuccessful patent applicants, "[a]ll the expenses of the proceedings shall be paid by the applicant." 35 U.S.C. § 145. The definition of the term "expenses" under the statute is similarly at issue in *NantKwest.*

Here, where both this case and *NantKwest* challenge the statutory definition of "expenses" under the Lanham Act and Patent Act and are premised on the same or closely related legal theories, consolidation is not only appropriate, but desirable.

While this case examines the same legal issues as *NantKwest*, it presents additional compelling factual background and additional arguments to this controversy that are not raised in *NantKwest.* For example, Booking.com presented arguments that interpreting 15 U.S.C. § 1071 (b)(3) to award attorneys' fees in all cases would violate the First Amendment right to petition for redress of grievances, which was not presented in *NantKwest*. Given the additional facts and arguments presented in this case, the Court should grant petition for certiorari, and consolidate it for purposes of both briefing and oral argument with *NantKwest* as a matter of justice and judicial economy. Consolidation is in the best interest of the parties and the Court and will save both time and expenses.

Finally, *Booking.com* offers additional experienced counsel to assist the Court with the issues being presented in both *Nantkwest* and *Booking.com*.

CONCLUSION

For the reasons set forth above, the NYIPLA respectfully requests this Court to grant the petition for certiorari and consolidate it with *NantKwest* under Rules of the Supreme Court 27. This will ensure that the issues are resolved consistently, with the best set of fact patterns to frame the issues and that justice and judicial economy are maintained in the proceedings.

Respectfully submitted,

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