

TTAB Relents: Board Agrees to Vacate Likelihood of Confusion Finding at District Court's Direction

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Last week, the TTAB agreed to vacate a precedential decision at the direction of a district court judge putting an end (for now) to a stand-off between the administrative body and the federal judiciary. As we have previously reported, the Supreme Court's landmark decision in *B&B Hardware* not only raised the stakes in opposition proceedings — by holding that TTAB rulings can have a preclusive effect on infringement suits — it is also likely to impact the broader TTAB/federal court dynamic. This rare showdown between the district court and TTAB represents the first clash between the two tribunals as they navigate the changed post-*B&B Hardware* landscape.

Back in 2008, the University of Alabama opposed an application to register the mark HOUNDSTOOTH MAFIA, asserting common law rights in the houndstooth pattern worn by its legendary football coach Paul Bryant and a crimson and white color scheme. In 2013, the TTAB issued a precedential ruling finding no likelihood of confusion between the University's asserted marks and the HOUNDSTOOTH MAFIA mark.

Following the decision, the University filed a *de novo* action in federal court in the Northern District of Alabama under 15 U.S.C. § 1071(b). While the civil action was pending, the parties settled the dispute and submitted a motion for entry of a final consent judgment. On May 7, 2014, District Court Judge R. David Proctor signed the consent judgment, which included as one of its terms an order that the TTAB vacate its decision.

The TTAB, however, refused to comply with the court's directive. According to the TTAB, "the parties did not have the right to agree among themselves that the Board's precedential decision should be vacated. . . ." and because the court was not presented with the full administrative record, it had no basis upon which to make a decision.

In an opinion authored late last month, Judge Proctor vehemently disagreed. Judge Proctor explained that the district court acts as an appellate court when reviewing TTAB decisions and the TTAB therefore did not have the authority to ignore the court's final judgment. The district court's Final Consent Judgment "is not merely a 'piece of paper,' Judge Proctor noted with evident agitation, but "an order of a court sitting in appellate review (pursuant to 15 U.S.C. § 1071(b)) over a decision of the TTAB."

Although yesterday's order from the TTAB vacates its previous decision as directed by the federal court, the agency did "specifically reserve[] the right to seek further review of the orders and opinions of the district court in this matter." The fight, it seems, may not be over yet.

In the wake of the Supreme Court's decision in *B&B Hardware*, the dynamic between the federal courts and the TTAB is in flux. Judge Proctor's recognition that the TTAB had "simply misapprehend[ed] its position in relation to a district court's appellate review pursuant to Section 1071(b)" in this case represents an important step toward preservation of the *pre-B&B Hardware* relationship between these two bodies.

The federal court case is *Board of Trustees of the University of Alabama v. Houndstooth Mafia Enterprises LLC*, No. 7:13-cv-01736 (N.D. Ala. filed Sept. 19, 2013). The opposition proceeding is *Board of Trustees of the University of Alabama et al. v. Pitts*, No. 91187103, at the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board.

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