

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
ALEXANDRIA DIVISION**

**PRO-FOOTBALL, INC.,**

**Plaintiff,**

**v.**

**AMANDA BLACKHORSE, MARCUS  
BRIGGS-CLOUD, PHILLIP GOVER,  
JILLIAN PAPPAN and COURTNEY  
TSOTIGH,**

**Defendants.**

**Civil Action No.: 1:14-cv-1043-GBL-IDD**

**DEFENDANTS' REBUTTAL BRIEF  
IN SUPPORT OF THEIR MOTION TO DISMISS**

Phrased several different ways, Pro-Football, Inc. ("PFI") repeatedly argues that after a petition for cancellation before the TTAB has been decided, there is an absolute right by the trademark owner to file a civil action against the petitioners. This blunt argument fails because (1) it does not follow precedent interpreting the term "parties in interest" to require an ownership interest in the trademark or patent at issue or a potentially infringing one; and (2) it does not recognize that federal court jurisdiction under Article III requires a legal Case or Controversy that does not exist between PFI and the Blackhorse Defendants.

PFI does not dispute that the relief it seeks would not affect any legal rights or obligations of the Blackhorse Defendants. Likewise, PFI does not dispute that the Blackhorse Defendants have no claims in PFI's trademarks or in any similar trademark. The only allegation about the Blackhorse Defendants is that they successfully petitioned the TTAB. Accordingly, PFI's action should be dismissed for either of two reasons: (1) the Blackhorse Defendants are not "parties in

interest” under 15 U.S.C. § 1071(b)(4); and (2) there is no Case or Controversy under Article III between PFI and the Blackhorse Defendants.

PFI cites no legal authority to support its assertion that anyone who is eligible to petition the TTAB also qualifies as a “party in interest” under 15 U.S.C. § 1071(b)(4). To the contrary, both the case law and the text of § 1071(b)(4) contradict PFI’s position. One can petition the TTAB without thereby becoming a “party in interest” under § 1071(b)(4), and one can be a “party in interest” without having petitioned or appeared before the TTAB.

In a similar vein, PFI argues that the Court has Article III jurisdiction because the TTAB found that the Blackhorse Defendants had a right to petition it. PFI cites ambiguous dictum in *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 492 (Fed. Cir. 1987), to argue that the TTAB’s jurisdiction to hear a petition is coextensive with Article III Case or Controversy jurisdiction. The Federal Circuit rejected that notion in *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999), and the TTAB has also explained that its jurisdiction as an Executive Branch agency is broader than Article III Case or Controversy jurisdiction.

PFI’s other arguments are equally without merit, such as arguing for judicial estoppel without applying that doctrine’s three-part test (Opp. at 19); contending that the Blackhorse Defendants are “parties in interest” because the TTAB allegedly erred in rejecting PFI’s laches argument (Opp. at 19-20); denying that this is a declaratory judgment action even though that is the relief sought (Opp. at 21-23); and trying to distinguish *Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258 (Fed. Cir. 2014), based on irrelevant differences in Patent Trial and Appeal Board and TTAB procedure (Opp. at 23-24).

Finally, PFI’s request that it be permitted to serve the Director with the Complaint has no basis and should be denied.

## ARGUMENT

### **I. The Blackhorse Defendants Are Not “Parties In Interest” Under 15 U.S.C. § 1071(b)(4).**

PFI offers five different arguments that the Blackhorse Defendants are “parties in interest” who may be defendants under 15 U.S.C. § 1071(b)(4). None of these arguments has merit. Each is addressed in turn below.

#### **A. The Text And Structure of 15 U.S.C. § 1071(b)(4) Demonstrate That Defendants Are Not “Parties In Interest.”**

PFI first argues that because the Blackhorse Defendants met the minimal standards under 15 U.S.C. § 1064 to bring a cancellation petition, they are also “parties in interest” under 15 U.S.C. § 1071(b)(4). Opp. at 12-14. PFI’s claim that § 1064 and § 1071(b)(4) are coextensive is unsupported and incorrect.

To be eligible to petition the TTAB to cancel a registration, one must merely be a “person who believes that he is or will be damaged . . . by the registration of a mark . . . .” 15 U.S.C. § 1064. As a matter of logic and syntax, one can be a person who “believes that he or she will be damaged” (§ 1064) without necessarily being a “party in interest” (§ 1071(b)(4)). In the ordinary case, where a cancellation petition is filed by a business with a competing claim to the trademark or a similar mark, the petitioner will be both an acceptable petitioner under § 1064 and a “party in interest” under § 1071(b)(4). But this case is not the ordinary case; the Blackhorse Defendants – who have no interests in any relevant trademarks – may petition under § 1064 but are not “parties in interest” under § 1071(b)(4).

Indeed, the TTAB has interpreted § 1064 very broadly in the context of cancellation petitions based on disparagement. According to the TTAB, § 1064 is satisfied so long as the cancellation petitioner is a person who takes offense to a mark and is a member of the group

referenced by the mark. *See Boswell v. Mavety Media Grp. Ltd.*, 52 U.S.P.Q.2d 1600, 1604, 1999 WL 1040108, at \*3 (T.T.A.B. 1999) (“The evidence shows that opposer Boswell is an African American woman. As a member of the group which is asserted to be disparaged or brought into contempt or disrepute by the mark BLACK TAIL, she has clearly demonstrated her standing in this proceeding.”). The TTAB opens its doors widely to those opposing or seeking to cancel registrations so that the USPTO receives all relevant information from the public as it carries out the Executive Branch’s duty to faithfully execute the laws. *See Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999) (“This court has made it clear that the officials of the PTO may not readily assume, without more, that they know the views of a substantial composite of the public . . . . Thus, the policy behind the procedure for determining whether a mark is scandalous encourages, if not requires, participation by members of the general public who seek to participate through opposition proceedings.”).

In *Blackhorse*, the TTAB found that the Blackhorse Defendants could petition under 15 U.S.C. § 1064 merely because they are Native Americans who are offended by the term “redskin”:

A plaintiff must show that it has a ‘real interest’ in the outcome of a proceeding in order to have standing. *Ritchie v. Simpson*, 50 USPQ2d at 1025. A ‘real interest’ in the proceeding is a legitimate personal interest in the opposition or cancellation. *Id.*, citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Amanda Blackhorse is a member of the Navajo Nation. She testified that she considers the term REDSKINS in respondent’s marks to be derogatory and is offended by it.

Phillip Martin Gover is a member of the Paiute Indian Tribe of Utah. He testified that he perceives the terms REDSKIN and REDSKINS to be disparaging, even in connection with respondent’s services.

Courtney Tsotigh is a member of the Kiowa Tribe of Oklahoma. She testified that she finds the term REDSKIN to be disparaging in any context including for an “NFL team.”

Marcus Briggs-Cloud is a member of the Muscogee Nation of Florida. He testified that he finds the term REDSKINS in the registrations to be disparaging and offensive.

Jillian Pappan testified that she is a Native American. She testified, *inter alia*, that the use of the term REDSKIN is analogous to the term ‘[n\*gg\*r]’ and that people should not profit by dehumanizing Native Americans.

In view of the foregoing, we find that each of the petitioners has established a real interest, a personal stake, in the outcome of this proceeding and, therefore, has standing. Respondent [PFI] does not dispute the petitioners’ standing.

*Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1087, 2014 WL 2757516, at \*7 (T.T.A.B. June 18, 2014).

Thus, each of the Blackhorse Defendants qualifies as a “person who believes that he is or will be damaged . . . by the registration of a mark . . .” (and therefore eligible to petition for cancellation under 15 U.S.C. § 1064) merely because he or she is a Native American who finds the term “redskin” offensive. By contrast, to be a “party in interest,” one must have an ownership interest in the trademark or patent at issue or a potentially infringing one. *See Hans C. Bick, Inc. v. Watson*, 253 F.2d 344, 345-46 (D.C. Cir. 1958); *3V, Inc. v. CIBA Specialty Chems. Corp.*, 587 F. Supp. 2d 641, 647 (D. Del. 2008); *Nachtman v. Toulmin*, 196 F. Supp. 367, 369 (S.D. Ohio 1961). PFI cites no contrary authority to support its position that a party that meets the liberal standards for filing a cancellation petition under 15 U.S.C. § 1064 is automatically a “party in interest” under 15 U.S.C. § 1071(b)(4).

In an attempt to argue that the Blackhorse Defendants have suffered legal injury, PFI cites the Petition filed with the TTAB and quotes Amanda Blackhorse’s answer to an interrogatory. Opp. at 8. But the legitimate feelings of personal offense set forth in the Petition

and Ms. Blackhorse's answer do not evidence a cognizable interest in PFI's trademark that is required of a "party in interest." Neither the Petition nor Ms. Blackhorse's interrogatory answer, nor anything else, describes an economic or legal interest on the part of the Blackhorse Defendants in PFI's trademarks.<sup>1</sup>

Finally, PFI emphasizes that 15 U.S.C. § 1071(b)(4) contains a clause that "any party in interest may become a party to the action." Opp. at 14. PFI does not, however, explain how this clause supports its position. To the contrary, this clause reinforces that a "party in interest" is one with an economic interest in a trademark by allowing assignees of ownership rights to a trademark to join, or be added to, an action filed under 15 U.S.C. § 1071(b)(4) even if they did not appear before the TTAB. *See, e.g., Vosk Int'l Co. v. Zao Gruppya Predpriyatij Ost*, No. C11-1488RSL, 2012 WL 2976966, at \*3 n.3 (W.D. Wa. Mar. 27, 2012) (stating that assignee of defendant's trademark rights, who did not participate in the TTAB proceeding, could intervene as defendant if it wished). Indeed, the right of a party in interest to join a § 1071 proceeding after not participating before the TTAB establishes that, just as not all TTAB petitioners are "parties in interest," not all "parties in interest" need to have appeared before the TTAB.

**B. The Blackhorse Defendants Have No Trademark Interests To Disavow Or Disclaim.**

PFI next argues that the Blackhorse Defendants are "parties in interest" because they have not "disclaimed their interest by claiming that they are no longer harmed by the registrations' validity" and "the registrations have not yet been cancelled." Opp. at 14.

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<sup>1</sup> PFI also accuses the Blackhorse Defendants of "flatly contradict[ing]" "earlier representations" by stating that they lack an economic or legal interest in this action, but PFI does not cite their supposedly earlier contrary representations. Opp. at 13.

PFI is apparently trying to distinguish *3V, Inc. v. CIBA Specialty Chems. Corp.*, 587 F. Supp. 2d 641, 647 (D. Del. 2008) and *Nachtman v. Toulmin*, 196 F. Supp. 367, 369 (S.D. Ohio 1961). Opp. at 14-15, 16 n.16. In *3V v. CIBA*, 3V initially asserted ownership interests in a patent but then disclaimed those interests. In *Nachtman*, the owner of a patent conveyed its interests to an assignee. In both cases, the court held the defendant was not a “party in interest” because it lack the requisite ownership interest in a patent. In *3V* and *Nachtman*, the disclaimer and assignment were not significant in and of themselves but only as evidence that those parties lack any economic interest in the patents and therefore were not “parties in interest.” Because the Blackhorse Defendants never had an economic interest in PFI’s trademarks, any question of disclaimer or disavowal is irrelevant.

**C. The Adversarial Nature Of A TTAB Proceeding Does Not Mean That The Blackhorse Defendants Are “Parties In Interest” Under 15 U.S.C. § 1071(b)(4).**

PFI next contends that the Blackhorse Defendants are “parties in interest” because the TTAB decides cancellation petitions after an adversarial, quasi-judicial process. See 37 C.F.R. §§ 2.111-2.136. This argument is a non-sequitur. By following the TTAB’s procedures for public participation in the trademark registration review process, the Blackhorse Defendants did not become “parties in interest” under 15 U.S.C. § 1071(b)(4). Although they persuaded the TTAB that the USPTO erred in granting the trademark registrations between 1967 and 1990, they did not obtain any interest in PFI’s trademarks or any other trademarks.

Moreover, as discussed above, the TTAB found that the Blackhorse Defendants were eligible to initiate a cancellation proceeding under 15 U.S.C. § 1064 simply because they were Native Americans offended by the term “redskins.” See *supra* at 3-5. As explained, the

standard that the Blackhorse Defendants must meet to file a petition under 15 U.S.C. § 1064 is different from what is required to be a “party in interest” under 15 U.S.C. § 1071(b)(4). *See id.*

PFI also tries to undermine the authority of *Hans C. Bick, Inc. v. Watson*, 253 F.2d 344 (D.C. Cir. 1958). First, PFI asserts that the D.C. Circuit determined that the “party who filed a petition for cancellation was not a ‘party in interest’ because the plaintiff’s dispute was really with the Commissioner of Patents.” *Opp.* at 17. PFI’s characterization of the D.C. Circuit’s reasoning omits the key point. The D.C. Circuit determined that the cancellation petitioners were not “part[ies] in interest” because “[t]he petitioners for cancellation have never used or registered [Bick’s] mark or a mark claimed to be similar.” 253 F.2d at 346. It is *because* the cancellation petitioners never used the mark at issue or a similar mark that the D.C. Circuit observed that the trademark owner’s legal dispute was really with the USPTO.

In addition, PFI points out that in 1962, Congress amended the Lanham Act in a way that abrogated a different aspect of *Bick*. *Opp.* at 17. In *Bick*, the D.C. Circuit permitted the trademark owner to litigate against the Commission of Patents in the district court. Congress amended the statute to eliminate that remedy if the TTAB proceedings featured adverse parties. *See Pub. Law 87-772 § 12*, 76 Stat. 769, 771-73 (Oct. 9, 1962); 15 U.S.C. § 1071(b)(3) (party dissatisfied with a TTAB decision may file civil action against the Director only if there was no adverse party before the TTAB). However, the 1962 legislation does *not* provide a statutory basis for PFI’s suit against the Blackhorse Defendants. To the contrary, after *Bick* Congress did not modify – and in fact reenacted – the “party in interest as shown by the records of the [USPTO]” language that *Bick* construed. *See Pub. Law 87-772 § 12*, 76 Stat. 769, 773 (Oct. 9, 1962). “Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change.” *Forest Grove*



*Sch. Dist. v. T.A.*, 557 U.S. 230, 239-40 (2009); *Florida Dep't of Revenue v. Piccadilly Cafeterias, Inc.*, 554 U.S. 33, 47 (2008). Thus, Congress is presumed to have adopted the D.C. Circuit interpretation that parties that “have never used or registered [a] mark or a mark claimed to be similar” are not “parties in interest” with respect to that mark. *Bick*, 253 F.2d at 346.

Finally, PFI notes that *Bick* has not been cited “for almost 50 years.” Opp. at 17 n.18. Of course, that is because ordinarily the parties in an action under 15 U.S.C. § 1071(b)(4) are two businesses arguing over trademark ownership and infringement issues, and there is rarely occasion to consider the meaning of “party in interest.” The Court in *3V* held that a party with no interest in a patent was not a “party in interest as shown by the records of the [USPTO]” without citing *Bick*, but it certainly could have done so. 587 F. Supp. 2d at 647.

Accordingly, PFI’s argument that the Blackhorse Defendants are “parties in interest” because they filed a cancellation petition, and then participated in the TTAB’s judicial-style decision-making process, lacks merit.

**D. The Blackhorse Defendants Are Not Judicially Estopped.**

PFI’s next argument – that the Blackhorse Defendants are judicially estopped from asserting that they are not “parties in interest” – is also without merit. Opp. at 18-19. PFI fails to explain the three-part test for judicial estoppel in this Circuit, let alone to meet its burden of demonstrating that the test was satisfied.

“Three elements must be satisfied before judicial estoppel will be applied.” *Zinkand v Brown*, 478 F.3d 634, 638 (4th Cir. 2007). As the Fourth Circuit explained:

First, the party sought to be estopped must be seeking to adopt a position that is inconsistent with a stance taken in prior litigation. The position at issue must be one of fact as opposed to one of law or legal theory. Second, the prior inconsistent position must have been accepted by the court. Lastly, the party against whom judicial estoppel is to be applied must have intentionally misled the

court to gain unfair advantage. This bad faith requirement is the determinative factor.

*Id.* at 638; *see also Whitten v. Fred's, Inc.*, 601 F.3d 231, 241 (4th Cir. 2010); *Touchcom, Inc. v. Bereskin & Parr*, 790 F. Supp. 2d 435, 441 (E.D. Va. 2011).

PFI bases its judicial estoppel argument on a request by the Blackhorse Defendants for reconsideration of a preliminary TTAB order that adopted the D.C. Circuit test for laches. The TTAB had adopted the D.C. Circuit standard because the post-TTAB federal court proceedings in *Harjo* occurred in the D.C. federal courts. *See Blackhorse v. Pro-Football, Inc.*, Cancellation No. 9204618, 2011 WL 1131509, at \*3 (T.T.A.B. Mar. 15, 2011). After the TTAB's preliminary order, Congress enacted the America Invents Act ("AIA") which changed the venue for multi-party cases under 15 U.S.C. § 1071(b)(4) from the District of Columbia to the Eastern District of Virginia. *See Pub. L. 112-29 § 9(a)*, 125 Stat. 284 (Sept. 16, 2011). In light of the AIA, the Blackhorse Defendants asked the TTAB to reconsider its decision to follow D.C. Circuit precedent for laches because there would be no possibility that the D.C. federal courts would serve as the venue for post-TTAB litigation.<sup>2</sup> The TTAB agreed that it no longer made sense to apply the D.C. Circuit standard for laches due to the AIA's new venue provision. *See Blackhorse*, 111 U.S.P.Q.2d at 1112, 2014 WL 2757516, at \*30.

None of the three required elements of judicial estoppel is met here. First, the Blackhorse Defendants did not adopt inconsistent positions on an issue of fact. And even more to the point, they made no representations that they would be "parties in interest" in any § 1071(b) action or that this Court would have jurisdiction over such an action. *See Ex. 1*. The AIA's revision to 15

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<sup>2</sup> *See* Petitioners' Motion to Reconsider Legal Standard For Laches In Light Of The America Invents Act, *Blackhorse v. Pro-Football, Inc.*, No. 92/046,185 (T.T.A.B.) (filed Sept. 6, 2012) (Exhibit 1).

U.S.C. § 1071(b)(4) did not deal with jurisdiction, only venue. *See, e.g., Kappos v. Hyatt*, 132 S. Ct. 1690, 1694 (2012) (the AIA “changed the venue for § 145 actions from the United States District Court for the District of Columbia to the United States District Court for the Eastern District of Virginia”); *Janssen Pharmaceutica, N.V. v. Kappos*, 844 F. Supp. 2d 707, 709 (E.D. Va. 2012) (the AIA “replaced the United States District Court for the Eastern District of Virginia as the exclusive venue for civil actions”); *Vosk Int’l Co. v. Zao Gruppya Predpriyatij Ost*, No. C11-1488RSL, 2012 WL 1033535, at \*3 (W.D. Wash. Mar. 27, 2012) (“[T]hough the statute speaks in terms of ‘jurisdiction,’ it really refers to ‘venue.’”). Second, the TTAB did not accept any factual positions in connection with its decision to reconsider the laches legal standard. And, third, there is no suggestion that the Blackhorse Defendants acted in bad faith when they correctly notified the TTAB that the AIA changed the venue for multi-party actions asserted under 15 U.S.C. § 1071(b)(4).

For these reasons, PFI’s judicial estoppel argument fails.

**E. The Blackhorse Defendants Are Not “Parties In Interest” Because Of PFI’s Laches Argument.**

PFI makes a final argument that the Blackhorse Defendants are “parties in interest” “because [PFI] has asserted a laches defense against them . . . .” Opp. at 19. PFI cites no authority for its position that the Blackhorse Defendant can be converted into “parties in interest” based on PFI’s assertion of an equitable defense to the cancellation proceeding below. Yet, PFI asserts that the Blackhorse Defendants may be made defendants because laches is supposedly a “necessarily individualized and personal inquiry that cannot be adequately defended by the Director of the USPTO or any other party.” *Id.* This claim is meritless.

PFI’s laches argument is that the Blackhorse Defendants’ allegedly waited too long after they turned age 18 to file their cancellation petition, and that PFI was unfairly prejudiced by the

delay. The TTAB rejected the laches argument both as a matter of law (holding that laches does not apply to petitions that raise issues of broad public concern) and as a matter of fact (that the factual record presented to it by PFI did not demonstrate undue delay or prejudice). *See Blackhorse*, 111 U.S.P.Q.2d at 1112-14, 2014 WL 2757516, at \*31-34. The factual record in *Blackhorse* included transcripts of PFI's depositions of each *Blackhorse* Defendant and their answers to interrogatories. The *Blackhorse* Defendants also responded to document requests. *See* Opp. at 16 (*Blackhorse* Defendants "produced discovery" and "sat for depositions").

PFI is wrong to state that the *Blackhorse* Defendants must be parties in order to decide whether the TTAB erred in rejecting PFI's laches argument. Had PFI appealed to the Federal Circuit, the USPTO could have defended the TTAB's legal interpretation and the TTAB's decision that the factual record developed did not establish the facts necessary for laches. Under 15 U.S.C. § 1071(a), there are no limits to the issues that can be raised on appeal. PFI could have argued in an appeal that the TTAB erred in rejecting laches, just as it could have argued that the TTAB erred in any other way.

## **II. This Action Does Not Present A "Case Or Controversy."**

PFI attempts to make four points in response the *Blackhorse* Defendants' showing that no Article III Case or Controversy exists between the team and the *Blackhorse* Defendants. Opp. at 20-24. None of these has merit.

*First*, PFI argues that the "TTAB's finding that Defendants had sufficient standing to bring their petition for cancellation necessarily establishes" that there is a Case or Controversy in this Court. Opp. at 20. In support, PFI cites ambiguous dictum in *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 492 (Fed. Cir. 1987), where the Court stated that the

standing needed to file an opposition with the TTAB “is in harmony with the standing requirements for maintaining a law suit in an Article III court.” Opp. at 20.

To the extent PFI argues that “in harmony with” means “coextensive,” PFI’s position is incorrect as a matter of law, and its interpretation of the *Jeweler’s Vigilance* dictum is contradicted by a later Federal Circuit ruling, the TTAB’s own statements, and common sense. A finding by the TTAB that a party is eligible to petition for cancellation or file an opposition does not “necessarily establish” Article III jurisdiction, contrary to PFI’s assertion. Opp. at 20.

In *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999), the Federal Circuit explained that standing to petition the TTAB is broader than the test for Article III standing or jurisdiction:

[T]he policy behind the procedure for determining whether a mark is scandalous encourages, if not requires, participation by members of the general public who seek to participate through opposition proceedings.

In courts created pursuant to Article III of the United States Constitution, a plaintiff must make out a ‘case or controversy’ between himself and a defendant to have standing.... However, ‘case’ and ‘controversy’ restrictions for standing do not apply to matters before administrative agencies and boards, such as the PTO. *See, e.g., California Ass’n of Physically Handicapped v. FCC*, 778 F.2d 823, 826 n.8 (D.C. Cir. 1985) (“The Article III restrictions under which this court operates do not, of course, apply to the FCC. The Commission may choose to allow persons without Article III ‘standing’ to participate in FCC proceedings.”)

....

*Id.* at 1094. In *Ritchie*, the Federal Circuit cited *Jewelers Vigilance*, apparently finding nothing in that case inconsistent with its clear explanation that standing to petition the TTAB is broader than the test for an Article III Case or Controversy. *See Ritchie*, 170 F.3d at 1095; *see also Coach Servs., Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1376 (Fed. Cir. 2012) (distinguishing statutory standing to petition the TTAB from Article III jurisdiction); *Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258, 1261 (Fed. Cir. 2014) (“WARF”) (“To be clear, although Article III standing is not necessarily a requirement to appear

before an administrative agency, once a party seeks review in federal court, ‘the constitutional requirement that it have standing kicks in.’”) (internal citation omitted); *Sierra Club v. EPA*, 292 F.3d 895, 899 (D.C. Cir. 2002) (same).

Indeed, the TTAB itself has made clear that it does not apply the Article III Case or Controversy standard when it decides questions of statutory standing. The TTAB’s standard for statutory standing is broader than the standard for Article III jurisdiction. *See Corporacion Habanos, S.A. v. Rodriguez*, 13 U.S.P.Q.2d 1873, 1875 n.4, 2011 WL 3871952, at \*2 n.4 (T.T.A.B. 2011) (“Clearly the Board is not an Article III court and does not need to find Article III standing.”); *Corporacion Habanos, S.A. v. Anncas, Inc.*, 88 U.S.P.Q.2d 1785, 1790, 2008 WL 4409768, at \*4 (T.T.A.B. 2008) (“[A]pplicant’s reliance on *Lujan* is misplaced inasmuch as the standing test set forth therein is for federal Article III standing, not standing for an opposition proceeding.”).

Moreover, as noted above at Section I.A, the TTAB found that the Blackhorse Defendants had statutory standing to petition under 15 U.S.C. § 1064 solely because they are Native Americans offended by the term “redskins.” *See Blackhorse*, 111 U.S.P.Q.2d at 1087, 2014 WL 2757516, at \*7. The TTAB did not, and did not purport to, apply an Article III jurisdictional test. And even more fundamentally, the TTAB does not decide for this Court whether it has jurisdiction. *See, e.g., Shweika v. Dep’t of Homeland Sec.*, 723 F.3d 710, 718 (6th Cir. 2013) (“*Chevron* deference does not apply to an agency’s interpretation of a federal court’s jurisdiction.”); *Lindstrom v. United States*, 510 F.3d 1191, 1195 n. 3 (10th Cir. 2007) (“Determining federal court jurisdiction is exclusively the province of the courts regardless of what an agency may say.”) (internal quotations omitted); *Lopez–Elias v. Reno*, 209 F.3d 788,

791 (5th Cir. 2000) (“[T]he determination of our jurisdiction is exclusively for the court to decide.”).

**Second**, PFI contends that the Supreme Court’s test for finding a Case or Controversy in declaratory judgment cases does not apply here. Opp. at 21-22. The jurisdictional test for declaratory judgment cases requires that a court must determine “whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007); *see also S. Walk at Broadlands Homeowner’s Ass’n, Inc. v. OpenBand at Broadlands, LLC*, 1:13-CV-1353-GBL/JFA, 2014 WL 1911884, at \*6-7 (E.D. Va. May 13, 2014) (dismissing complaint seeking declaratory judgment due to lack of a case or controversy, where defendant was not alleged to have acted unlawfully and where the true case or controversy was between plaintiff and a non-party). Although PFI has the burden of establishing jurisdiction, it did not try to demonstrate “adverse legal interests” between itself and the Blackhorse Defendants. In fact, there are no “adverse legal interests” between the parties; they have no legal relations. No relief is sought against the Blackhorse Defendants, and the Blackhorse Defendants’ legal rights and obligations will not be affected regardless of the outcome of this case.

Instead of addressing the jurisdictional test, PFI asserts that this case is not a declaratory judgment case because it follows a TTAB decision. *See* Opp. at 21-22. That argument is another non sequitur. This case is a declaratory judgment case – a declaratory judgment case is one in which the plaintiff seeks a declaratory judgment. PFI does not dispute that the relief it seeks is a declaratory judgment. *See* Compl. at 34-35 (Prayer For Relief). The Complaint even

alleges that the Declaratory Judgment Act, 28 U.S.C. § 2201, gives this Court “declaratory judgment jurisdiction.” *See id.* ¶ 15.

To portray this case as other than one seeking declaratory judgment, PFI calls it an “appeal” of the TTAB decision. The Fourth Circuit has recently rejected that notion, explaining that an action under 15 U.S.C. § 1071(b) is a new civil action where the TTAB’s factual and legal conclusions are reviewed *de novo*, and where the parties may introduce new evidence. *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 156 (4th Cir. 2014). The Lanham Act itself distinguishes between appeals under § 1071(a) and civil actions in lieu of appeals under § 1071(b). *Compare* 15 U.S.C. § 1071(a)(1) (party dissatisfied with a TTAB decision “may appeal”) *with* 15 U.S.C. § 1071(b)(1) (a party dissatisfied with a TTAB decision “authorized by [15 U.S.C. § 1071(a)] to appeal . . . may, unless appeal has been taken . . . , have remedy by a civil action . . .”).

However this action is dubbed – an “appeal,” a “quasi-appeal,” a “new civil action,” or something else entirely – it is an action for declaratory judgment and the Supreme Court’s jurisdictional test for declaratory judgment actions is relevant.

**Third**, PFI tries unsuccessfully to distinguish *Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258, 1261 (Fed. Cir. 2014) (“WARF”). *Opp.* at 23-24. PFI contends that WARF is distinguishable because the standard to file a patent reexamination request with the PTAB is even broader than the standard to petition the TTAB to cancel a trademark registration. *Opp.* at 23-24. Even if that observation is accurate, it is irrelevant. The TTAB’s decision that the Blackhorse Defendants could petition for cancellation does not require this Court to find that a Case or Controversy exists. As explained above, the TTAB does not purport to apply Article III standards when it decides whether a person satisfies the requirements



of 15 U.S.C. § 1064 to enable it to petition for cancellation. *See supra* at 12-14. And, of course, this Court is not bound by TTAB decisions concerning its jurisdiction.

Significantly, PFI does not argue that *WARF* was wrongly decided. And PFI does not respond to the commonsensical point that if there is no Article III Case or Controversy when Party “A” sues Party “B” over a given matter, then there can be no Case or Controversy when Party “B” sues Party “A” over the same matter. *See* Mem. of Law in Supp. of Defs.’ Mot. to Dismiss [Dkt. 19] at 16. Consumer Watchdog in *WARF* cannot be distinguished from the Blackhorse Defendants in this case. Consumer Watchdog had no claims to the stem cell patent or a similar patent, and no plans to conduct scientific research with stem cells. Likewise, the Blackhorse Defendants have no claims to any trademark registrations.

The United States agrees with the Federal Circuit’s decision in *WARF*. At the invitation of the Court, the United States filed an *amicus curiae* brief arguing that there was no Case or Controversy due to Consumer Watchdog’s lack of an interest in the stem cell patents. *See* Brief for the United States as Amicus Curiae Supporting Respondent, *Consumer Watchdog v. Wisconsin Alumni Research Found.*, No. 13-1377 (Fed. Cir. Jan. 17, 2014) (Exhibit 2). The United States pointed out that Consumer Watchdog “claims no commercial interest in the subject matter of the ‘913 patent; it faces no plausible risk of an infringement claim; it is neither a prospective competitor nor a prospective licensee of *WARF*.” *Id.* at 7. All this can likewise be said of the Blackhorse Defendants in relation to PFI’s trademarks.

*WARF* is dispositive.<sup>3</sup>

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<sup>3</sup> PFI asks whether there would be a Case or Controversy if it had prevailed before the TTAB and the Blackhorse Defendants sought to overturn the decision by bringing an appeal or civil action. *Opp.* at 22-23. The answer is straightforward. Under *WARF*, there would be no Case or Controversy.

*Fourth*, PFI apparently argues once again that the Blackhorse Defendants have a sufficient interest to create a Case or Controversy because they had a sufficient interest to file a cancellation petition. Opp. at 24 (citing *Jewelers Vigilance*). This final point is redundant and has already been addressed. While PFI again relies on dictum in *Jewelers Vigilance* to assert that the standard for standing to petition is coextensive with the standard for Article III jurisdiction, the Federal Circuit's decision in *Ritchie*, 170 F.3d at 1094, and the TTAB's own prior cases, make clear that statutory standing to petition the TTAB is broader than Article III jurisdiction. *See supra* at 12-14.

### **III. PFI Should Not Be Granted Leave To Litigate Against The Director.**

If the Court grants the Motion to Dismiss, PFI requests permission to serve the Complaint on the Director of the USPTO and litigate against the Director. Opp. at 24-25. This effort to salvage the litigation has no legal basis.

Following contested TTAB proceedings, the dissatisfied party does not have the right to bring a civil action against the Director. PFI acknowledges this. *See* Opp. at 6 (“§ 1071(b) prohibits involvement by the Director of the USPTO as a party when a review of inter partes TTAB proceedings are sought by civil action.”). A civil action can be brought against the Director only where there was no “adverse party” before the TTAB. 15 U.S.C. § 1071(b)(3).

PFI cites two cases in which courts transferred venue to another district rather than dismiss the action, which would have resulted in the litigation becoming time barred. *See* Opp. at 25. Those two courts relied on 28 U.S.C. § 1406(a), which gives courts the option of transferring cases to another district in lieu of dismissal for improper venue, “if it be in the interest of justice.” Here, there is no “interest of justice” provision that overrides 15 U.S.C. § 1071(b).

For these reasons, PFI's request for leave to serve the Complaint on the Director should be denied.<sup>4</sup>

**CONCLUSION**

For the foregoing reasons, the Motion To Dismiss should be granted, and the Complaint should be dismissed. In addition, the Court should not permit PFI to pursue this case against the Director.

Dated: October 9, 2014.

Respectfully submitted,

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<sup>4</sup> PFI had two months from the time of the TTAB decision to file a notice of appeal to the Federal Circuit. *See* 15 U.S.C. § 1071(a)(2); 37 C.F.R. § 2.145(d)(1). The Director may extend the time if PFI can prove to the Director that its failure to appeal timely was the result of "excusable neglect." 37 C.F.R. § 2.145(e)(2).

**CERTIFICATE OF SERVICE**

I hereby certify that on this 9th day of October, 2014, the foregoing pleading or paper was filed and served electronically by the Court's CM/ECF system upon all registered users in this action:

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