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WELCOME TO THE LAND OF TRADEMARK CANCELLATION--WHERE NOT ALL FRAUD IS CREATED EQUAL

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**WELCOME TO THE LAND OF TRADEMARK
CANCELLATION—WHERE NOT ALL FRAUD
IS CREATED EQUAL**

Great Concepts, LLC v. Chutter, Inc.,
84 F.4th 1014 (Fed. Cir. 2023)♦

The intellectual property community is buzzing about a recent decision by the U.S. Court of Appeals for the Federal Circuit¹ handing down a ruling on trademark cancellation under the Lanham Act.² A divided panel grappled with whether the Agency³ had authority to cancel a trademark registration as a punishment for filing a false declaration.⁴ The majority held that the Agency was precluded from canceling the registration as a remedy for fraud unrelated to the issuance or maintenance of that mark.⁵ However, the dissent took aim at the majority’s reasoning, making a compelling argument that green-lighting any type of fraud harms the general public.⁶ Ultimately, the decision upended Agency precedent—of nearly fifty years—presumably because *stare decisis* is no shield for *ultra vires* agency action.⁷ As such, this outcome is an important stepping stone in the ever-changing landscape of the reviewability of agency decisions.⁸

♦ By Janelle Barbier, J.D. Candidate, Santa Clara University School of Law, 2023. I am grateful to Erik I. Perez for his incredible mentorship and his helpful suggestions on this Comment. Finally—as always—I thank my daughters and family. As my last contribution to HTLJ as Editor-in-Chief, I dedicate this final piece to them. © 2023 Janelle Barbier.

¹ In this Comment, the Court of Appeals for the Federal Circuit is referred to as the “Federal Circuit.”

² *Great Concepts, LLC v. Chutter, Inc.*, 84 F.4th 1014, 1020 (Fed. Cir. 2023) [hereinafter “*Great Concepts*”]; see, e.g., Ken Wilton & Dogan Ervin, *Federal Circuit Overturns Fifty Years of TTAB Precedent*, SEYFARTH’S GADGETS, GIGABYTES & GOODWILL BLOG (Nov. 08, 2023) (calling decision “an eye-catching opinion”); Bryan L. Adkins et al., *Congressional Court Watcher: Recent Appellate Decisions of Interest to Lawmakers (October 16, 2023–October 22, 2023)*, EVERYCRSREPORT (Oct. 23, 2023) (listing decision as one of “particular interest to federal lawmakers”).

³ The term “Agency” is used to collectively refer to the United States Patent and Trademark Office and its subsidiaries, which is discussed in more detail *infra*, Part I.

⁴ The Honorable Judge Stark and Judge Dyk formed the majority while The Honorable Judge Reyna dissented. *Great Concepts*, 84 F.4th at 1015.

⁵ *Id.* at 1016, 1018, 1019–20.

⁶ *Id.* at 1025.

⁷ *Id.* at 1019 n.3, 1022–23.

⁸ An analysis of how the decision implicates agency power is discussed

I. FACTUAL AND PROCEDURAL BACKGROUND

Respondent-Appellant, Great Concepts, LLC (“Great Concepts”), is the owner of the federally registered trademark, “DANTANNA’S”; the trademark was registered in 2005 “as a mark for a ‘steak and seafood restaurant.’”⁹ Petitioner-Appellee, Chutter, Inc. (“Chutter”), possesses a common law¹⁰ “mark for restaurant services,” named “DAN TANA.”¹¹ Chutter alleged that the mark owned by Great Concepts created a likelihood of confusion with its mark for consumers of restaurant services.¹²

In 2015, Chutter petitioned the Trademark Trial and Appeal Board (“TTAB”), an entity housed within the United States Patent and Trademark Office (“USPTO”), for cancellation of Great Concepts’s mark.¹³ At the TTAB, Chutter argued that cancellation was the appropriate sanction for a false declaration filed by Great Concepts with the Trademark Office.¹⁴ Chutter leaned heavily on the fact that Great Concepts filed a “combined” declaration with the twin aims of achieving incontestability status for its mark and fulfilling mandates for continued registration.¹⁵ Notably, Great Concepts conceded that

infra, Part V.

⁹ *Great Concepts*, 84 F.4th at 1016.

¹⁰ See *Why register your trademark?*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> (last visited Nov. 12, 2023) (The USPTO states that common law rights “are based solely on use of the trademark in commerce within a particular geographic area. This limits your rights, as you can only enforce your trademark rights for the specific area where your trademark is used.”).

¹¹ *Great Concepts*, 84 F.4th at 1016. Chutter’s predecessor-in-interest, Dan Tana, was a former actor and professional athlete when he “opened his eponymous restaurant in West Hollywood, California under the mark DAN TANA’S.” Wilton & Ervin, *supra* note 2.

¹² *Great Concepts*, 84 F.4th at 1016.

¹³ *Chutter, Inc. v. Great Concepts, LLC*, Cancellation No. 92061951, 2021 WL 4494251 (T.T.A.B. Sept. 30, 2021) (precedential). Chutter also filed an opposition, alleging that Great Concepts’s mark was likely to cause confusion and falsely suggested a connection to Chutter. *Id.* at *1. Prior to these cases (in 2006), Chutter’s predecessor-in-interest petitioned the TTAB for cancellation of the same mark and brought a corresponding action in district court for trademark infringement. *Great Concepts*, 84 F.4th at 1016. However, these older cases are not relevant to the present action.

¹⁴ *Great Concepts*, 84 F.4th at 1016, 1022. The declaration in question declared that there were no pending matters involving Great Concept’s mark; however, at that time, both of Chutter’s older cases were pending final resolution. *Id.* at 1016.

¹⁵ *Id.* at 1019–20. The implications of the declaration’s “combined”

the declaration was “untrue” but “denie[d] it was filed with fraudulent intent.”¹⁶ However, Great Concepts contended that because its declaration only related to incontestability, and not trademark registration, it did not provide grounds for the registration’s cancellation.¹⁷ The TTAB agreed with Chutter and in 2021, it canceled Great Concepts’s mark.¹⁸

Great Concepts appealed to the Federal Circuit.¹⁹ And Katherine Vidal, Director of the USPTO, successfully intervened in this Federal Circuit action.²⁰ The Federal Circuit reversed the TTAB’s decision, holding that the Board exceeded its statutory authority under the Lanham Act.²¹ The court remanded the case back to the TTAB to allow the Agency to evaluate whether to impose sanctions other than cancellation, including the loss of incontestable status.²²

II. LEGAL BACKDROP

Before diving into *Great Concepts, LLC v. Chutter, Inc.*, there are two parts of the legal backdrop that are salient to appreciating the decision. First, the Lanham Act is a federal statute that protects trademarks through two mechanisms: granting trademark registration through the USPTO and authorizing action for trademark infringement in judicial courts.²³ Section 8 of the Act controls “Declarations of Continued Use” which are affidavits that are periodically required for continued trademark registration.²⁴ Section 14 of the Act governs the process for challenging a mark, including trademark cancellation petitions—such petitions require a showing that the filer “will be damaged” by the mark’s registration along with a justification for cancellation.²⁵ A trademark is susceptible to cancellation “[a]t any time if . . . its registration was obtained fraudulently.”²⁶

Finally, Section 15 of the Act sets out the requirements for

nature are discussed *infra*, Part V.

¹⁶ *Great Concepts*, 84 F.4th at 1016 n.1 (citing Appellant Br. at 33).

¹⁷ *Id.* at 1018–19.

¹⁸ *Id.* at 1016–17.

¹⁹ *Id.* at 1016.

²⁰ Brief for Intervenor, *Great Concepts*, No. 22-1212, 2022 WL 2828292 (July 14, 2022).

²¹ *Great Concepts*, 84 F.4th at 1016, 1018.

²² *Id.* at 1025.

²³ *Id.* at 1017 (citing *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142–43 (2015) (cleaned up)); see also 15 U.S.C. §§ 1051 et seq. (Lanham Act).

²⁴ *Great Concepts*, 84 F.4th at 1017 (citing 15 U.S.C. § 1058(b)(1)).

²⁵ 15 U.S.C. § 1064.

²⁶ *Id.* at § 1064(3).

obtaining “incontestable” status for a registered trademark that has been in continuous use for at least five years after its registration and is still in use in commerce.²⁷ Incontestability provides invaluable benefits to trademark owners—it provides “conclusive evidence” of a trademark’s validity and limits the grounds for a cognizable cancellation action.²⁸ In sum, “it is more burdensome and difficult to prove invalidity of a registered incontestable mark than a registered mark without incontestable status.”²⁹

Moreover, federal agencies play a prominent role in implementing the Lanham Act. The Trademark division of the USPTO reviews applications for federal trademarks and grants registration to successful applicants.³⁰ The TTAB, an agency subsidiary, is charged with adjudicating certain federal trademark claims.³¹ This entity hears the vast majority of trademark cancellation actions.³² However, the TTAB is not the only forum that entertains actions for federal trademark cancellation—federal and state lower courts are also empowered to hear these actions.³³

²⁷ *Id.* at § 1065.

²⁸ Deborah R. Gerhardt, *Beware the Trademark Echo Chamber: Why Federal Courts Should Not Defer to USPTO Decisions Not Defer to USPTO Decisions*, BERKELEY TECH. L.J., 643, 647 (2018) (citing 15 U.S.C. §§ 1115, 1064(3), 1065).

²⁹ Nikki Siesel, *CAFC Decision Refuses to Expand Statutory Grounds to Cancel Mark*, N.Y. TRADEMARK ATT’Y BLOG (Nov. 02, 2023).

³⁰ Gerhardt, *supra* note 28, at 646.

³¹ See *Trademark Trial and Appeal Board*, USPTO, <https://www.uspto.gov/trademarks/ttab> (last visited Nov. 12, 2023) (noting TTAB “handles appeals involving applications to register marks, appeals from expungement or reexamination proceedings involving registrations, and trial cases of various types involving applications or registrations”).

³² *E.g.*, *Trademark Cancellation: Everything You Need to Know*, UPCOUNSEL, <https://www.upcounsel.com/trademark-cancellation> (last updated July 07, 2020). The USPTO “is authorized to sanction the registrant by cancelling the mark.” *Great Concepts*, 84 F.4th at 1029 (citing 15 U.S.C. §§ 1064, 1068). For example, in 2019, over two thousand petitions for cancellation were filed in the TTAB. James Hastings, *TTAB Filing Statistics for 2019*, TRADEMARK OPPO. LAW. BLOG, <https://www.trademarklitigationguide.com/ttab-filing-statistics-for-2019/> (last visited Nov. 14, 2023). Courts likewise have authority to cancel marks. 15 U.S.C. § 1119.

³³ See Peter S. Menell et al., *Establishment Of Trademark Rights, in INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE: 2020*, at 1001 (2020) (“In civil suits where a federally registered mark is at issue, such as suits under Lanham Act § 2, the court may order cancellation of the registration.”); Olivia Maria Baratta & Theodore H. Davis, *Trademark*

Second, the TTAB's fraud jurisprudence has been evolving in favor of lower thresholds and harsher sanctions for wrongdoers. Even under the stringent clear and convincing evidentiary standard, the Agency has approved a vast array of fraud claims based on "indirect and circumstantial evidence."³⁴ Indeed, the TTAB's decision on appeal in this case was designated as one of the top ten most important trademark decisions in 2021.³⁵ Previously, the TTAB lowered the intent requirement for fraud, holding that "reckless disregard of the truth or falsity of a material statement in a trademark prosecution filing is sufficient to establish fraud in matters before the USPTO."³⁶ In the context of "procuring a trademark registration or renewal," the Federal Circuit has held that fraud "occurs when an applicant knowingly makes false, material representations of fact in connection with his application."³⁷ But the Federal Circuit has yet to weigh in on the TTAB's "reckless disregard" standard.

III. LEGAL ANALYSIS AND CONCLUSION

Great Concepts brought four issues on appeal,³⁸ of which I address two in this Comment. First, Great Concepts argued that the TTAB lacked the power to cancel its trademark based on a fraudulent declaration filed under Section 15.³⁹ Second, Great Concepts challenged the TTAB's finding that it committed fraud.⁴⁰

enforcement in the United States, LEXOLOGY (Nov. 12, 2018) ("state courts also have jurisdiction over federal trademark disputes").

³⁴ Britt Anderson, *Avoiding fraud attacks on US trademarks*, TRADEMARK LAW. 19, 20 (2023).

³⁵ John L. Welch, *The Top Ten TTAB Decisions of 2021 (Part 1)*, TTABLOG® (Jan. 04, 2022). In *Great Concepts*, the TTAB broadened the basis for fraud claims by holding that intent to deceive the USPTO could be shown through a lawyer signing an affidavit of use without reading it. Anderson, *supra* note 34, at 19, 21.

³⁶ Patrick Ngalamulume, *Sleeping Dogs May Lie but Trademark Applicants Cannot*, PARSONS BEHLE & LATIMER (Feb. 08, 2022); *see also TTAB: Reckless Disregard Satisfies the 'Willful Intent' Element of Fraud*, LOEB & LOEB LLP (Oct. 2021) ("'[r]eckless disregard' . . . is the legal equivalent of finding that a party had specific intent to deceive the USPTO").

³⁷ *Great Concepts*, 84 F.4th at 1018 (citing *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009)).

³⁸ Appellant's Opening Brief, *Great Concepts*, No. 22-1212, 2022 WL 897058, at *3-4 (Fed. Cir. Mar. 18, 2022), ECF No. 18; *see also* Appellee's Response Brief, *Great Concepts*, No. 22-1212, 2022 WL 2867748, at *7 (Fed. Cir. July 14, 2022), ECF No. 32 (responding to Appellant's issue statements).

³⁹ *Great Concepts*, 84 F.4th at 1018-19.

⁴⁰ *Id.* at 1016 n.1.

Writing for the majority, Judge Stark addressed the first issue as an issue of statutory interpretation.⁴¹ Reviewing the legal question *de novo*, the majority phrased the issue as:

whether Section 14 of the Lanham Act permits the Board to cancel a trademark's registration due to the owner's filing of a fraudulent Section 15 declaration for the purpose of acquiring incontestability status for its already-registered mark.⁴²

The majority started and ended the inquiry with the language in Section 14:

[a] petition to cancel a registration of a mark. . . . may . . . be filed . . .

(3) At any time if . . . its registration was *obtained fraudulently*⁴³

By zeroing in on the word “obtained,” the majority reasoned that “fraud committed in connection with obtaining incontestable status is distinctly *not* fraud committed in connection with obtaining the registration itself.”⁴⁴ Thus, “fraud in connection with acquiring incontestable status is not a basis for a Section 14 cancellation proceeding.”⁴⁵

The majority also dismissed Chutter's argument, which claimed that the Agency's actions were permissible under Federal Circuit precedent holding that “fraud in connection with *maintaining* a registration is actionable in a Section 14 cancellation proceeding.”⁴⁶ Not so, reasoned the majority, because a Section 15 declaration is not necessary to maintaining registration nor was there evidence that the Section 8 portion of Great Concepts's combined declaration was false.⁴⁷

TTAB precedent was pertinent to this inquiry—in 1975, the

⁴¹ *Id.* at 1017–18.

⁴² *Id.* at 1018.

⁴³ *Id.* at 1018, 1020 (citing 15 U.S.C. § 1064) (emphasis in original).

⁴⁴ *Id.* at 1021 (emphasis in original).

⁴⁵ *Great Concepts*, 84 F.4th at 1021. The Federal Circuit bolstered its conclusion with the interpretive canon of *expressio unius est exclusio alterius* and other provisions in the Lanham Act statutory scheme. *Id.* at 1021–22.

⁴⁶ *Id.* at 1019 (citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986)) (emphasis in original).

⁴⁷ *Id.* at 1019–20.

Board held that it had the power to cancel a mark under identical circumstances.⁴⁸ However, the majority criticized the TTAB's reading of Federal Circuit precedent. While the Board interpreted *Duffy-Mott Co. v. Cumberland Packing Co.* to stand for the proposition that falsity related to incontestability status can provide a basis for Board cancellation, the Federal Circuit clarified that the *Duffy-Mott* holding cabined the sanction to "precluding the mark owner's reliance on its registration in [a single] proceeding under review."⁴⁹ The sanction did not cancel the registration for *all* purposes.⁵⁰

In conclusion, the majority held that Section 14 "does not authorize cancellation of a registration when the incontestability status of that mark is obtained fraudulently."⁵¹ Overall, the Federal Circuit closed the door to cancelling a trademark's registration to remedy fraud unrelated to the issuance or maintenance of that mark.⁵² In other words, not all fraud is tantamount to fraud within Section 14.

Next, the majority declined to rule on the issue of whether the TTAB erred in finding that Great Concepts committed fraud.⁵³ The majority did not provide detailed reasoning on this issue, other than even assuming, *arguendo*, that fraud occurred, the Board was not authorized to cancel the registration based on the purported fraud committed by Great Concepts.⁵⁴ Notably, the decision leaves "in limbo whether the door has slammed shut once again on broader claims of fraud on the USPTO."⁵⁵

⁴⁸ *Id.* at 1022 (citing *Crown Wallcovering Corp. v. Wall Paper Mfrs. Ltd.*, 188 U.S.P.Q. 141, 1975 WL 20837, at *4 (T.T.A.B. 1975)).

⁴⁹ *Id.* at 1022–23, n.7 (citing *Duffy-Mott Co. v. Cumberland Packing Co.*, 424 F.2d 1095, 1099 (C.C.P.A. 1970)).

⁵⁰ *Id.*

⁵¹ *Great Concepts*, 84 F.4th at 1020.

⁵² Sam Eichner & Catherine Perez, *Federal Circuit Limits Fraud-on-the-PTO Claims, but Leaves Chutter Recklessness Standard Intact*, PILLSBURY INSIGHTS (Nov. 01, 2023).

⁵³ *Great Concepts*, 84 F.4th at 1025.

⁵⁴ *Id.* at 1018 n.2. Perhaps the court wished to avoid opining on the standard of review for factual issues decided by the TTAB. A lively scholarly debate exists on this topic. Compare Gerhardt, *supra* note 28, at 649–50 (arguing "courts should not defer to USPTO trademark decisions"); with Melissa F. Wasserman, *What Administrative Law Can Teach the Trademark System*, 93 WASH. U. L. REV. 1511 (2016) (arguing courts should afford USPTO decisions great deference). The dissent took a clear position: defer to the Agency on its factual findings regarding fraud. See *Great Concepts*, 84 F.4th at 1029 ("substantial evidence supports the Board's finding of reckless disregard and inference of intent to deceive").

⁵⁵ Christina Moser, *Great Concepts LLC v. Chutter, Inc.: The Federal Circuit Weighs In on TTAB's Authority When a Registrant Commits Fraud on*

IV. THE DISSENT

The last word was uttered by Judge Reyna, who wrote a compelling dissent, and criticized the majority for instructing the Agency,

that there exists a milepost in the trademark administrative continuum, a green-light, beyond which inequitable conduct is encouraged by the promise of great gain with little to no meaningful risk to the registrant.⁵⁶

He gave four reasons to affirm the Board's action: "it accords with precedent, fits with statutory objectives, safeguards the integrity of the trademark system, and protects public interest."⁵⁷

The dissent first explained why the TTAB's finding of fraud should be affirmed, passing on an issue skipped over by the majority.⁵⁸ Then, similar to the majority, Judge Reyna began with the text of the statute when deciding whether to affirm the Board's cancellation.⁵⁹ He reasoned that settled precedent—by both the TTAB and the Federal Circuit—compelled the conclusion that the Board did not exceed its statutory authority.⁶⁰ He buttressed his conclusion with a panoply of justifications: (1) the statutory purpose of the Lanham Act; (2) the policy of the Agency, especially concerning public interest; and (3) reliance interests stemming from *stare decisis*.⁶¹ The dissent's approach seemingly aligned with TTAB policy that ensuring truthful submissions is integral to trademark administration.⁶² Further, as discussed below, the dissent also disagreed with the majority regarding deference to the Agency and the analogy between trademark fraud and

the Trademark Office, BAKERHOSTETLER (Oct. 19, 2023).

⁵⁶ *Great Concepts*, 84 F.4th at 1025–34.

⁵⁷ *Id.* at 1026.

⁵⁸ *Id.* at 1027–29.

⁵⁹ *Id.* at 1029.

⁶⁰ *Id.* at 1029–30. It is not unusual for Federal Circuit judges to come to polar opposite conclusions. Commentators have observed that there can be vastly different interpretations coming out of the Federal Circuit even when the judges have the same starting point like statutory interpretation. See generally Erik I. Perez, *A Proposed Analytical Framework for Resolving an Intra-Court Split on Claim Construction Ambiguity*, 39 SANTA CLARA HIGH TECH. L.J. 91 (2023) (discussing split in claim construction interpretation).

⁶¹ *Great Concepts*, 84 F.4th at 1026, 1029, 1033–34.

⁶² *Id.* at 1031, 1031 n.5, 1033–34.

patent fraud.⁶³

V. DISCUSSION

There are two important takeaways from this case. First, within the realm of trademark cancellation, not all fraud is created equal. This is not an easy pill to swallow. To be sure, the Federal Circuit’s obligation is “to say what the law is,” not what the law should be.⁶⁴ But as the dissent stressed, the Agency has long spoken on what the law is, in a way that conforms with the Lanham Act’s underlying purpose of ensuring the accuracy of the Registers of marks.⁶⁵ And Judge Reyna is not alone in his protest. Commentators note the “Stark” contrast between the majority’s strict adherence to statutory text and the dissent’s emphasis on how fraud threatens the integrity of the trademark system.⁶⁶ Yet others do not view the decision as a death knell to candor in trademark proceedings.⁶⁷ Further, trademark cancellation is not a linchpin for accused infringers; several federal appellate courts have held that cancellation by the TTAB does not preclude future infringement suits premised on the cancelled mark.⁶⁸ For this reason, the decision’s ripple effect will likely be minimal.

However, even if the decision does not have a far-reaching effect, the majority’s reading of *Duffy-Mott* seems incongruous with the purpose of a sanction.⁶⁹ I tend to agree with the dissent on this point. By limiting the *Duffy-Mott* holding to merely a bar on relying on the mark in an opposition proceeding against a new applicant, the

⁶³ *Id.* at 1033–34.

⁶⁴ *Marbury v. Madison*, 5 U.S. 137, 177 (1803); see *Great Concepts*, 84 F.4th at 1025 (“Whether we would prefer a different result be reflected in the statute is irrelevant to our responsibility to decide the case before us based on the law as it exists.”).

⁶⁵ *Great Concepts*, 84 F.4th at 1029–30, 1031 n.5.

⁶⁶ Dennis Crouch, *Fraudulent Incontestability Declarations: Textual Fidelity vs. Fraud Deterrence*, PATENTLY-O (Oct. 18, 2023); see *id.* (“The philosophical divide between textual fidelity and policy concerns is a recurring tension in administrative law.”).

⁶⁷ See Shana L. Olson, *A Limit to Cancel Culture? Federal Circuit Finds Fraud in Connection with Section 15 Declaration of Incontestability Not a Cancellable Offense*, STERNE, KESSLER, GOLDSTEIN & FOX (Oct. 2023) (noting the “encouraging statement” by the court urging the TTAB “to consider potential alternative consequences for the fraudulent conduct, suggesting that perhaps the incontestable status be revoked, or sanctions be imposed on *Great Concepts* and its counsel”).

⁶⁸ Blake Brittain, *TTAB proceedings don't preclude trademark infringement cases - 3rd Circuit*, REUTERS (Sept. 17, 2021).

⁶⁹ See *supra* Part III.

majority fails to punish the fraud in a meaningful way.⁷⁰ Under the majority's reading, a mark owner who commits Section 15 fraud cannot use that mark to block another applicant's new registration of a different mark. However, if that is the only prohibition on the wrongdoer, they are not precluded from asserting their mark against the new applicant in a future trademark infringement action. Because the buck stops with the Federal Circuit for trademark fraud, a strong argument exists for affirming harsher sanctions.

Lastly, for what it is worth, I think that the Federal Circuit should have affirmed the TTAB, albeit for a different reason that was alluded to by the dissent. The majority framed the issue as whether isolated Section 15 fraud can result in cancellation.⁷¹ A different question is whether fraud in a unified declaration used for the dual purposes of satisfying Section 8 and Section 15 renders the entire document invalid. Importantly, the Agency answers the question in the affirmative. A widely accepted tenet of administrative law is that agencies are authorized to craft rules of procedure.⁷² And as the dissent pointed out, the Agency promulgated regulations and developed official forms indicating that a combined Section 8 and 15 declaration functions as a single trademark filing.⁷³ The Agency warns that false

⁷⁰ *Great Concepts*, 84 F.4th at 1022 n.7, 1025.

⁷¹ I appreciate the majority's observation that "the Board did not base its cancellation decision on the fact that *Great Concepts*' Section 15 declaration happened to have been filed in connection with its Section 8 declaration of use." *Id.* at 1019. And I understand that the court is generally limited to reviewing the Agency's actual decisions. *Glaxo Grp. Ltd. v. TorPharm, Inc.*, 153 F.3d 1366, 1371 (Fed. Cir. 1998); *but see Great Concepts*, 84 F.4th at 1019 n.3 (citing *Glaxo*, 153 F.3d at 1371) ("we have discretion to resolve an issue not passed on in the tribunal we are reviewing '[i]f . . . the ground urged is one of law, and that issue has been fully vetted by the parties on appeal'"). I simply posit a different theory for this academic exercise.

⁷² See Janelle Barbier, Note, *The NHK-Fintiv Rule: Patent Law's Whack-A-Mole*, 39 SANTA CLARA HIGH TECH. L.J. 339, 363 (2023) (citing 5 U.S.C. § 553(b)(3)(A); *Am. Hosp. Ass'n v. Bowen*, 834 F.2d 1037, 1047 (D.C. Cir. 1987)) (noting agencies enjoy wide latitude in instituting "housekeeping rules that outline agency procedures and organization").

⁷³ Judge Reyna made two salient observations. First, the regulation at 37 C.F.R. § 2.168(a) states that a Section 15 declaration "*may also be used as the affidavit or declaration required by section 8.*" *Great Concepts*, 84 F.4th at 1032 (emphasis in original). Importantly, the words "the affidavit" signal that the combined declaration is inseparable—the two declarations merge into a single declaration. Second, the Combined Declaration Form warns that "willful false statements and the like may jeopardize the validity of this document." *Id.* at 1027; *see also, e.g., Combined Declaration of Use and Incontestability Under Section 8 and 15*, OFF. MGMT. & BUDGET (Ver. 3.8,

statements can invalidate a declaration, and that “failure to file the Section 8 Declaration will result in cancellation of the registration.”⁷⁴ Therefore, a combined declaration that is invalidated for fraud is no declaration at all—accordingly, the Agency could permissibly cancel the registration for failure to file a valid Section 8 declaration.⁷⁵

The decision’s second major theme highlights the gradual erosion of the power of the administrative state. In fact, this case illustrates an ongoing trend of USPTO challenges blessed by the Federal Circuit.⁷⁶ Notably, the *Great Concepts* decision shows that even a long-standing agency rule is not immune to judicial scrutiny on *ultra vires* grounds.⁷⁷ Interestingly, the majority did not appear to give deference to the Agency’s judgment that Section 15 declarations constitute trademark registration maintenance⁷⁸; however, the dissent thought that the Agency’s discretionary determinations “on how to

July 14, 2007), <https://omb.report/icr/201807-0651-003/doc/84478001.pdf>.

In this scenario, I presume that these agency actions constitute procedural rules that are owed considerable deference.

⁷⁴ Notably, the quoted provision is posted on the Agency’s website under “Combined Declaration of Use and Incontestability under Sections 8 & 15.” *Registration Maintenance/Renewal/Correction Forms*, USPTO, <https://www.uspto.gov/trademarks/maintain> (last visited Nov. 13, 2023); see *supra* note 73 (collecting sources and text on declaration forms).

⁷⁵ See 15 U.S.C. § 1058(a) (stating “the registration of any mark shall be canceled by the Director unless the owner of the registration files in the [USPTO] affidavits that meet the requirements of subsection (b)”). The use of the term “shall” suggests that the registration must be canceled for failure to file a valid Section 8 declaration. See, e.g., *Lexecon v. Milberg Weiss Bershad Hynes & Lerach*, 523 U.S. 26, 35 (1998) (explaining the word “shall” in a statute is “mandatory” and “normally creates an obligation impervious to judicial discretion”).

⁷⁶ *Federal Circuit Reins in TTAB’s Authority in Trademark Cancellation Proceedings*, VINSON & ELKINS (Oct. 20, 2023); see also Barbier, *supra* note 72, at 355 (describing Federal Circuit’s allowance of challenge to USPTO rule created without any formal procedure).

⁷⁷ Wilton & Ervin, *supra* note 2; see *Great Concepts*, 84 F.4th at 1019 n.3 (“[the issue] presents a question of exceeding importance: whether an agency, which is a creature of statute, has been acting *ultra vires* for years”).

⁷⁸ The majority acknowledged that the Agency provided information on Section 15 declarations on its webpage titled “Definitions for maintaining a trademark registration”; nevertheless, it concluded that the Agency’s actions did not “alter the legal relationship between two sections of the Lanham Act.” *Great Concepts*, 84 F.4th at 1019 n.4. Had the court sided with the Agency on this point, the Agency’s actions would have been permitted under Federal Circuit precedent. See *supra* Part III.

sanction fraudulent conduct” warranted at least *Skidmore* deference.⁷⁹ Of course, this tension between the majority and dissent is indicative of a much larger battle raging over whether to curb administrative power.⁸⁰

For the remainder of this Comment, I explore the relationship between *Great Concepts* and two areas near and dear to my heart: patent law and conflict of laws. As a disclaimer, I do not attempt to get into the weeds on these topics but hope to extend the discussion beyond the decision of the Federal Circuit. Enjoy!

Sidebar: Analogy To Patent Law’s Equitable Doctrines

On the topic of fraud, the comparison to patent law is something that caught my eye. While reading the opinion, patent law’s inequitable conduct doctrine crept in my mind. The majority swiftly swatted the analogy away—raised by Chutter—as patent law “is governed by a different statute.”⁸¹ On the other hand, the dissent was moved by the similarities between trademark fraud and patent fraud, pointing out the “inequitable nature” of *Great Concepts*’s false declaration and positing that any type of fraud “falls within a range of misconduct that equitable doctrines have come to identify and

⁷⁹ *Great Concepts*, 84 F.4th at 1033–34. The dissent also noted that the Agency interpreted the words “obtained fraudulently” in Section 14 as including “not only the initial securance of a registration, but also the maintenance thereof, i.e., the securing of continuing rights of registration, by fraud.” *Id.* at 1029. This definition encompasses fraud in not only combined declarations, but also in independent Section 15 declarations.

⁸⁰ One issue concerns dismantling the *Chevron* doctrine. See, e.g., Pamela King, *Supreme Court may end Chevron doctrine. These states have already done it.*, GREENWIRE (Nov. 08, 2023) (detailing history of *Chevron* doctrine and observing that Supreme Court cases next year “have the potential to end the nearly 40-year-old *Chevron* doctrine”). For an excellent discussion of the Supreme Court’s “Major Questions Doctrine” that has neutered the *Chevron* doctrine, see generally Walter G. Johnson & Lucille M. Tournas, *The Major Questions Doctrine And The Threat To Regulating Emerging Technologies*, 39 SANTA CLARA HIGH TECH. L.J. 137 (2023).

As an aside, even though *Great Concepts* dealt with statutory interpretation, there are reasons to decline to afford the USPTO *Chevron* deference. For example, the Federal Circuit has held that the USPTO is not entitled to *Chevron* deference because it lacks “general substantive rulemaking power” under the statutes it is charged with administering. *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996). This likely explains why the dissent advocated for lower *Skidmore* deference.

⁸¹ *Great Concepts*, 84 F.4th at 1025 (citing Appellee Br. at 60).

embrace.”⁸²

Arguably, the relevance of the analogy turns on what rule authorizes the remedy. In patent land, two avenues exist for punishing fraud: fraud on the office and inequitable conduct.

First, the USPTO’s authority to regulate “Fraud on the PTO” stems from the Patent Act.⁸³ The USPTO promulgated regulations that trigger this offense, including rules imposing disclosure duties.⁸⁴ The Agency can invoke its regulations to order sanctions for Fraud on the PTO.⁸⁵ District courts can also grant relief for claims of Fraud on the PTO brought in the first instance to a trial court.⁸⁶ And appellate courts can review the appropriateness of sanctions from both entities on appeal.⁸⁷

Second, the inequitable conduct doctrine—birthed from the unclean hands doctrine—is an equitable remedy often deemed broader than the Agency’s regulatory sanctions.⁸⁸ Described as the “atomic bomb” of patent law, this remedy can render unenforceable an entire family of tainted patents.⁸⁹ In contrast to Fraud on the PTO, which arises from statutes, equitable remedies arise from equitable powers.⁹⁰ Federal courts derive their equitable powers from equitable principles “found largely in judicial practice.”⁹¹ On the other hand, federal

⁸² *Id.* at 1027 n.2, 1034.

⁸³ *See Norton v. Curtiss*, 433 F.2d 779, 791–92 (C.C.P.A. 1970) (holding Agency’s “power to deal specifically with fraudulent misconduct” arises from 35 U.S.C. § 6).

The term, “Fraud on the PTO,” collectively includes fraud related to patents and fraud related to trademarks.

⁸⁴ *E.g.*, Duty to disclose information material to patentability, 37 C.F.R. § 1.56 (2007).

⁸⁵ *E.g.*, *id.*

⁸⁶ *See, e.g., Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1441 (9th Cir. 1990) (reviewing trademark cancellation judgment issued by district court).

⁸⁷ *See, e.g., id.* (reviewing trademark fraud sanctions issued by the district court); *In re Bose*, 580 F.3d at 1242 (reviewing trademark fraud sanctions issued by the TTAB).

⁸⁸ The unclean hands doctrine started out as a “narrow rule.” ROBERT PATRICK MERGES & JOHN FITZGERALD DUFFY, *PATENT LAW AND POLICY* 979 (2017). That doctrine expanded and gave rise to the inequitable conduct doctrine which “now imposes disclosure obligations that are independent of, and not always identical to, the obligations imposed by the PTO.” *Id.*

⁸⁹ *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1288–89 (Fed. Cir. 2011) (en banc).

⁹⁰ *See MERGES & DUFFY, supra* note 88, at 979 (“the courts themselves have relied upon their inherent equitable powers to hold patents unenforceable”).

⁹¹ John Harrison, *Federal Judicial Power And Federal Equity Without*

executive agencies do not possess equitable powers on par with courts.⁹²

There are significant differences between the two remedies for patent fraud. Inequitable conduct is a defense that is available when a defendant faces a patent infringement suit.⁹³ Because the USPTO lacks jurisdiction over infringement actions, this defense cannot be raised in Agency proceedings.⁹⁴ In contrast, Fraud on the PTO may be raised affirmatively in a Supplemental Examination at the Agency or in a declaratory judgment action for patent invalidity in a district court.⁹⁵ Moreover, equitable remedies such as inequitable conduct can only be ordered by courts—an agency’s powers are confined to those conferred upon it by Congress.⁹⁶

Similarly, in trademark land, two avenues exist for punishing fraud: fraud on the office and unclean hands.

First, Fraud on the PTO in trademark law operates in a way that mirrors the fraud offense in patent law. As mentioned by the dissent, Agency regulations likewise prohibit fraud in trademark proceedings in front of the Agency.⁹⁷ And, as in patent law, Fraud on the PTO in the trademark context stems from duties implicit in the statutory requirements of the Lanham Act.⁹⁸ As in patent fraud, the USPTO can invoke its regulations to order sanctions for Fraud on the PTO in connection with trademark proceedings.⁹⁹ Finally, Fraud on the PTO may be raised at the Agency level or in a trial court for

Federal Equity Powers, 97 NOTRE DAME L. REV. 1911, 1911–12 (2022).

⁹² See *Plaskett v. Wormuth*, 18 F.4th 1072, 1087 (9th Cir. 2021) (stating that in regard to inherent equitable power, “an administrative agency simply does not stand on the same footing as an Article III court”).

⁹³ MERGES & DUFFY, *supra* note 88, at 977.

⁹⁴ *Managing a Patent*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/patents/basics/manage> (last visited Nov. 15, 2023).

⁹⁵ See MERGES & DUFFY, *supra* note 88, at 990–92 (citing 35 U.S.C. § 257) (discussing fraud raised in Supplemental Examination); *Asghari-Kamrani v. United Servs. Auto. Ass’n*, 252 F. Supp. 3d 562, 567 (E.D. Va. 2017) (adjudicating declaratory judgment action for patent unenforceability premised on fraud under 37 C.F.R. § 1.56).

⁹⁶ See *Int’l Union of Elec., Radio & Mach. Workers v. NLRB*, 502 F.2d 349, 352 n.* (D.C. Cir. 1974) (opin. of MacKinnon, J.) (“An administrative agency possesses no such inherent equitable power, however, for it is a creature of the statute that brought it into existence; it has no powers except those specifically conferred upon it by statute.”).

⁹⁷ *Great Concepts*, 84 F.4th at 1031 (citing 37 C.F.R. § 11.18); see 37 C.F.R. § 11.18(b) (requiring that any signed representations to the USPTO are true).

⁹⁸ *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009).

⁹⁹ See, e.g., 37 C.F.R. § 11.18.

trademark fraud.¹⁰⁰

In the context of trademark law, the Federal Circuit has explained that the Agency's power to sanction Fraud on the PTO can arise from Section 14 of the Lanham Act.¹⁰¹ The dissent seized on this ruling for support that the TTAB is authorized to make "discretionary determinations" on "how to sanction fraudulent conduct" based on its "specialized experience."¹⁰² But as discussed below, the TTAB is limited to issuing sanctions authorized by the Lanham Act, whereas courts have equitable powers to issue sanctions beyond those enumerated in the statute.

Second, similar to inequitable conduct in patent actions, a defendant in a trademark action may rely on the unclean hands doctrine as a defense.¹⁰³ Courts can invoke their equitable powers to impose sanctions for wrongful conduct under the unclean hands doctrine.¹⁰⁴

As mentioned, in the *Great Concepts* case, the trademark fraud allegation was originally raised at the TTAB, and that Agency assessed sanctions for the wrongdoing. The dissent referred to equitable remedies, presumably as a way of justifying the TTAB's actions in *Great Concepts*. First, Judge Reyna pointed to *Duffy-Mott*, noting that the Federal Circuit relied on the doctrine of unclean hands to bar the registrant from relying on its registration for any purpose in the Agency or in the Federal Circuit.¹⁰⁵ Next, he cited *Duffy-Mott* for the proposition that trademark rights under the Lanham Act and conduct before the USPTO "are not 'divorced from equitable principles.'"¹⁰⁶ He concluded that the Agency had both authority and discretion to sanction inequitable conduct.¹⁰⁷

Notwithstanding that *Duffy-Mott*'s fraud sanction analysis was dicta,¹⁰⁸ in that case it was the Federal Circuit who applied the doctrine

¹⁰⁰ See *In re Bose*, 580 F.3d at 1243 (reviewing Agency decision on fraud); *Robi*, 918 F.2d at 1441 (reviewing district court order on fraud).

¹⁰¹ *In re Bose*, 580 F.3d at 1243.

¹⁰² *Great Concepts*, 84 F.4th at 1033–34.

¹⁰³ E.g., *Duffy-Mott*, 424 F.2d at 1049.

¹⁰⁴ *Id.*

¹⁰⁵ *Great Concepts*, 84 F.4th at 1029.

¹⁰⁶ *Id.* at 1034.

¹⁰⁷ *Id.*

¹⁰⁸ In *Duffy-Mott*, the applicant argued to the Agency that the opposer should be precluded from relying on the opposer's trademark due to prior fraud; however, the TTAB did not "predicate any holding" on these fraud allegations. *Duffy-Mott*, 424 F.2d at 1049. Nevertheless, the Board dismissed the opposition on other grounds. See *Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 154 U.S.P.Q. 498 (T.T.A.B. 1967). The Federal Circuit independently determined that "a further reason" for precluding the opposer's

of unclean hands to extend the sanction's reach, not the TTAB.¹⁰⁹ Indeed, this is similar to cases where courts have relied upon the inequitable conduct doctrine to kill an entire patent family. Notably, the panel in *Duffy-Mott* cited the Lanham Act for the proposition that trademark rights “are not ‘divorced from equitable principles.’”¹¹⁰ The statute cited to permits the TTAB to apply “equitable principles of laches, estoppel, and acquiescence.”¹¹¹ Conspicuously absent from the list is the doctrine of unclean hands. Therefore, the TTAB lacks congressional authority to sanction conduct under the unclean hands doctrine.

Accordingly, because Chutter was precluded from invoking the unclean hands doctrine at the TTAB, nor was it in a defensive posture at the Federal Circuit, Chutter was stuck with seeking refuge under the Fraud on the PTO avenue for relief. In sum, this is a long way of saying that while I agree with the dissent that any type of Fraud on the PTO harms the public, I think that the majority correctly prevented the TTAB from imposing sanctions beyond those authorized in the Lanham Act. However, all is not lost. Based on the holding in *Duffy-Mott* and the commentary in *Great Concepts*, it is quite possible that a court would assert the doctrine of unclean hands to prevent Great Concepts from relying on its registration should Great Concepts pursue a future trademark infringement action.

***Sidebar: Implications Of The Federal Circuit's Decision
Resulting From Choice Of Law Rules***

For those of us who relish civil procedure and conflict of laws discussions, I have added a section on the national implications of this case. The Federal Circuit has a unique jurisdictional grant in that it hears all cases—regardless of their geographic location—in circumscribed subject matter areas.¹¹² When a case includes at least one cause of action within the court's exclusive jurisdiction, all other actions in that case are dragged along for the ride to the Federal Circuit on appeal.¹¹³

reliance on its registration was that it filed a “patently false combined affidavit.” *Duffy-Mott*, 424 F.2d at 1051.

¹⁰⁹ *Duffy-Mott*, 424 F.2d at 1051.

¹¹⁰ *Id.* (citing 15 U.S.C. § 1069).

¹¹¹ 15 U.S.C. § 1069.

¹¹² Janelle Barbier, *Reconceptualizing The Federal Circuit's Choice Of Law Doctrine: A Blend Of Reverse Erie, Interest Analysis, And Federal Common Law* (forthcoming 2024) (manuscript at 1) (on file with Author).

¹¹³ *E.g.*, *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808–09 (1988).

Enter now trademark appeals. TTAB appeals can land either at the Federal Circuit or at any federal district court with jurisdiction over the dispute.¹¹⁴ As discussed, the Federal Circuit does not have exclusive jurisdiction over all trademark appeals.¹¹⁵ In addition, trademark infringement actions cannot be brought in the TTAB¹¹⁶; in these actions, defendants often raise issues of trademark validity that the court must rule on.¹¹⁷ Moreover, judicial courts have statutory power to cancel trademark registrations.¹¹⁸ Appeals from federal district courts go to the respective regional circuit court, absent an action within the Federal Circuit's jurisdictional mandate.¹¹⁹ Overall, this means that multiple federal Courts of Appeals, as well as state appellate courts, have the power to shape federal trademark law.

Because the Federal Circuit receives appeals from all over the

¹¹⁴ Gerhardt, *supra* note 28, at 649 (citing 15 U.S.C. § 1071). The appellant is entitled to choose where to file the appeal. If filed in a court, the parties have the right to submit further evidence. *Id.* at 651 n.45. Thus, conventional wisdom might suggest that filing in district court is preferable when the appellant seeks to proffer new evidence not presented to the Board.

¹¹⁵ See 28 U.S.C. § 1295(a)(4)(B) (granting exclusive Federal Circuit jurisdiction over TTAB appeals “with respect to applications for registration of marks and other proceedings as provided in . . . 15 U.S.C. § 1071”); 15 U.S.C. § 1071 (delineating options for contesting TTAB decisions by appealing to the Federal Circuit or commencing a civil action in a court).

¹¹⁶ See, e.g., *About TTAB*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/about-ttab> (last visited Nov. 14, 2023) (“the Board is not authorized to determine questions of trademark infringement”).

¹¹⁷ See, e.g., *Dymo Indus., Inc. v. Tapeprinter, Inc.*, 326 F.2d 141, 143 (9th Cir. 1964) (holding trademark registration may be collaterally attacked by an accused infringer's challenge to the validity of the mark); Anderson, *supra* note 34, at 19 (“allegations of fraud are frequently used by defendants to attack brand owners' registered trademark rights in the United States”).

¹¹⁸ See Power of court over registration, 15 U.S.C. § 1119 (“In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action.”); see also *Ditri v. Coldwell Banker Residential Affiliates, Inc.*, 954 F.2d 869, 873 (3d Cir. 1992) (“Although a petition to the Patent and Trademarks Office is the primary means of securing a cancellation, the district court has concurrent power to order cancellation as well for the obvious reason that an entire controversy may thus be expediently resolved in one forum.”). However, some federal circuits do not allow plaintiffs to file independent trademark cancellation claims, holding that cancellation is only a remedy for preexisting actions. E.g., *Airs Aromatics, LLC v. Victoria's Secret Stores Brand Mgmt., Inc.*, 744 F.3d 595 (9th Cir. 2014).

¹¹⁹ 28 U.S.C. §§ 1294(1), 1295.

country, it employs a custom-made choice of law doctrine: the court draws on its own jurisprudence for substantive law within its exclusive jurisdiction and applies procedural law from the regional circuit—when necessary, the court places itself in the shoes of that second appellate court and predicts how that court would rule.¹²⁰ Therefore, even if regional circuit law differs in a case on appeal from a district court, the Federal Circuit can sometimes disregard that circuit’s law in favor of applying its own law.¹²¹ Indeed, the *Great Concepts* case touched on this choice of law dynamic. The majority acknowledged that the Court of Appeals for the Ninth Circuit previously reached the opposite conclusion.¹²² Instead, the majority sided with a district court in Missouri that held Section 14 “does not state that a registration can be canceled because of a fraudulent Section 15 filing.”¹²³ In other words, different jurisdictions have conflicting rules regarding the impact of a false Section 15 declaration on a cancellation under Section 14.

What does this mean for nation-wide trademark law uniformity? District courts faced with the same question of the effect of Section 15 fraud on trademark cancellation may be forced to follow different rules for cases heading to regional circuits than for those off to the Federal Circuit. True, the issue is not likely to arise often. And it remains to be seen whether the Federal Circuit would apply its same holding to a case originating in the district court instead of the TTAB.¹²⁴ Moreover, a lower court could conceivably invoke its equitable powers to “override” a statutory interpretation that it disagreed with. In sum, while these outcomes remain speculative, it is important to highlight the *Great Concepts* decision’s potential connection to forum shopping, which should be discouraged.¹²⁵

¹²⁰ Janelle Barbier, Case Comment, *Federal Circuit Declines To Find Patent Claims Indefinite For Broad Descriptive Words (And An Ode To 11 Civil Procedure)*, 39 SANTA CLARA HIGH TECH. L.J. 113, 122 (2022).

¹²¹ See, e.g., *Manildra Milling Corp. v. Ogilvie Mills, Inc.*, 76 F.3d 1178, 1181–82 (Fed. Cir. 1996) (displacing regional circuit law in favor of Federal Circuit law for the term “prevailing party” in patent actions).

¹²² *Great Concepts*, 84 F.4th at 1023 (citing *Robi*, 918 F.2d at 1444).

¹²³ *Id.* at 1023 n.9 (citing *O’Reilly Auto. Stores, Inc. v. Bearing Techs., Ltd.*, No. 16-3102-CV-S-BP, 2018 WL 4323943, at *5 (W.D. Mo. Sept. 10, 2018)).

¹²⁴ The Federal Circuit almost certainly would reach the same decision in a cancellation action originating in a district court. It cited with approval a cancellation action in a district court that reached the same decision as in *Great Concepts*. *Id.*; see *O’Reilly*, 2018 WL 4323943, at *1 (recounting case’s procedural posture).

¹²⁵ E.g., *Hanna v. Plumer*, 380 U.S. 460, 467–68, 472–73 (1965).