



## ARE Trademark Alert: The U.S. Supreme Court Grants, Vacates and Remands *Booking.com* in Light of *NantKwest*

Author(s): Charles R. Macedo, David P. Goldberg,

On Thursday, July 2, 2020, the Supreme Court granted the petition for writ of certiorari in *Booking.com B.V. v. United States Patent and Trademark Office*, No. 18-1309, then vacated the judgment and remanded the case to the United States Court of Appeals for the Federal Circuit for further consideration in light of *Peter v. NantKwest*, 589 U.S. \_\_\_, 140 S. Ct. 365 (2019).

When *Booking.com BV* filed the petition, there were two cases pending at the U.S. Supreme Court on the issue of whether the U.S. Patent and Trademark Office (USPTO) could recover the salaries of its attorneys and paralegals in appeals brought in district courts.

In *Peter v. NantKwest*, the Court was asked to address this question with respect to Section 145 of the Patent Act. In *Booking.com B.V.*, the Court was asked to address this question under 15 U.S.C. § 1071(b)(3) under the Lanham Act.

In an amicus brief dated May 2019 in *Booking.com*, the New York Intellectual Property Law Association (NYIPLA), represented by Amster, Rothstein & Ebenstein and others, requested the Court consolidate *Booking.com* with *NantKwest* so these related issues could be addressed simultaneously.

The NYIPLA argued that since both *Booking.com* and *NantKwest* regarded the statutory definition of “expenses” under the Lanham Act and Patent Act, and were premised on the same or closely related legal theories, they should have been consolidated to ensure consistent resolutions.

In December 2019, as previously reported, the Supreme Court held in *Peter v. NantKwest, Inc.* that the term “expenses” in Section 145 of the Patent Act does not include attorney’s fees, and that the USPTO cannot recover the salaries of its attorneys and paralegals in appeals brought under that section of the Patent Act. 589 U.S. \_\_\_, 140 S. Ct. 365 (2019); (see our December 11, 2019 alert “[The U.S. Supreme Court Holds That the USPTO Cannot Be Reimbursed for Salaries of its Legal Personnel in Appeals under § 145 of the Patent Act.](#)” The NYIPLA, represented by our firm and others, had also submitted an amicus brief in this case, advocating for the position eventually taken by the Supreme Court.

Absent surprising developments, the July 2, 2020 decision of the Supreme Court in this case will almost certainly lead to a decision below that the USPTO cannot recover the salaries of its attorneys and paralegals in appeals brought under 15 U.S.C. § 1071(b)(3) under the Lanham Act.



We will continue to monitor this issue and report on developments. For more information, please contact us.

\*[Charles R. Macedo](#) is a partner, and [David Goldberg](#) and [Chandler Sturm](#) are associates at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues, including litigating patent, trademark and other intellectual property disputes. Messrs. Macedo and Goldberg represented the NYIPLA as an amicus in this case. They may be reached at [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com), [dgoldberg@arelaw.com](mailto:dgoldberg@arelaw.com) and [csturm@arelaw.com](mailto:csturm@arelaw.com).