

## How to Win a Trademark Opposition

by Bruce Margulies

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You win a trademark opposition by promptly reaching a reasonable settlement, which may feature a co-existence agreement between the parties. Accomplishing this before you spend time, effort, and attorney fees pursuing litigation that you may not be able to afford, given the cost through completion, is indeed a victory.

I recommend, well in advance of your 40-day deadline to file an answer to the notice of opposition, hiring an attorney familiar with trademark law, particularly one experienced in trademark opposition practice. Such an attorney will review the prosecution history of your trademark, review the notice of opposition, and discuss with you your use of your mark as well as your knowledge of the opposer's mark, in order to identify the strengths and weaknesses of your case. Your attorney will then provide you with your practical legal and business considerations: your estimated chance of winning, your estimated costs, and some potential areas for compromise, which may allow the parties to

reach a settlement.

Early in the process, you should determine the sunk costs, the intangible costs (such as sweat equity), and the acquired goodwill associated with the use of your trademark. Consider the consequences if your business had to proceed without that mark. Are there conditions under which you feel that your mark could coexist with the mark(s) held by your opponent? Prioritize your options to determine circumstances that the opposer may accept in which the respective marks can coexist in the marketplace.

Once you have considered options for coexistence or settlement, you should decide whether to propose the options to opposing counsel prior to filing an answer to the notice of opposition or after filing your answer. Another strategic consideration is whether to propose a settlement or wait until opposing counsel proposes one.

If your attorney speaks with opposing counsel and a coexistence

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settlement appears to be feasible, both sides can consent to suspend the litigation process of the opposition in order to allow the parties to reach a settlement. If a settlement is not achieved, the opposition will resume with the Trademark Trial and Appeal Board taking the position that the parties are encouraged to reconsider and pursue settlement options on a continual basis as the opposition proceeds.

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