

Should You Initiate a Trademark Opposition or Trademark Cancellation?

by Bruce Margulies

A trademark opposition is litigation comprising a third-party challenge to a trademark application, while a petition to cancel a trademark is a third-party challenge to a registered trademark. The standard for filing a notice of opposition or a petition to cancel – both of which would be decided by the Trademark Trial and Appeal Board (TTAB) – is whether you believe that you would be damaged by the registration of a mark upon the principal register. Your trademark “damage” could be, for example, a competitor’s similar mark causing you to lose business or causing consumer confusion regarding the source of the respective parties’ goods or services. You do not need to have a U.S. registered trademark to file an opposition – your common law trademark or federal trademark application will suffice.

In order to oppose a competitor’s trademark application, you have to take action within one month of the publication of that trademark application. If you miss that window, you are permitted to file a petition to cancel your competitor’s mark af-

ter it registers. If your competitor’s trademark is based on common law or state trademark rights, then you do not have jurisdiction before the TTAB.

Once an opposition or cancellation has been initiated, a TTAB interlocutory attorney will manage the trial proceedings, wherein filings are generally submitted online to the TTAB. Following periods to address: (1) potential settlement; (2) discovery of evidence and clarification of issues; and (3) submission of evidence, trial briefs are submitted to a three-judge panel of the TTAB, which will decide the merits of the opposition. If the party filing the opposition or cancellation proceeding prevails, then the defending trademark application/registration is abandoned/cancelled.

Often, the plaintiff in an opposition or cancellation does not intend to pursue the matter all the way through trial - a process that could potentially take several years and cost tens of thousands of dollars. The goal may be to forge a co-existence agreement to limit the scope

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of the use of the defendant's trademark. In many cases, a defendant trademark owner is unaware that its mark is actionably similar to the plaintiff's trademark. In such an instance, it can be relatively easy to reach a coexistence settlement, once the defending party is aware of the relevant trademark law. Such a resolution, particularly if reached early in the opposition or cancellation process, is generally a cost-effective solution for the parties and is often sufficient justification for a party filing the suit.

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