

What is a Trademark Petition to Cancel (Trademark Cancellation)?

by Bruce Margulies

A petition to cancel a trademark registration may be filed by any person who believes that he or she is or will be damaged, for example, by dilution by blurring or dilution by tarnishment. A trademark cancellation, which is a process similar to a trademark opposition, is litigation comprising a third-party challenge to a trademark registered by the United States Patent and Trademark Office (USPTO).

Prior to registration of the defendant trademark, the examiner will have searched for marks that may be likely to be confused with that mark. However, the examiner is limited in time and resources, and the determination of likelihood of confusion has a subjective component. Therefore, the USPTO allows third parties to police registered marks with respect to their own marks, particularly regarding issues such as alleged infringement, likelihood of confusion, and trademark dilution.

A key distinction between a trademark cancellation and a trade-

mark opposition is that a trademark cancellation is initiated after the defendant trademark has registered, while a trademark opposition is initiated within 30 days of the publication of the defendant trademark application.

Once a trademark cancellation has been initiated, the USPTO Trademark Trial and Appeal Board (TTAB) maintains jurisdiction over the opposition. A TTAB interlocutory attorney manages the pretrial proceedings, wherein filings to the TTAB are generally submitted online. Following periods to address potential settlement, discovery of evidence and clarification of issues, and submission of evidence, trial briefs are filed with a three-judge panel of the TTAB, which will decide the merits of the opposition. If the petitioner prevails, then the trademark registration is cancelled.

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