

Trademark Opposition & Cancellation Proceedings

Trademark rights can be contested in the U.S. Patent and Trademark Office (USPTO) both before and after a trademark proceeds to registration.

These proceedings to challenge the validity of a trademark application or registration are filed with and heard by the USPTO's Trademark Trial and Appeal Board (TTAB). A TTAB proceeding to attempt to prevent the issuance of a registration for a trademark is commenced by timely filing a Notice of Opposition to the application. After a trademark registration has issued, a TTAB proceeding can be commenced to challenge the validity of a trademark registration by filing a Petition to Cancel the registration.

Oppositions

Opposition proceedings are available for challenging a trademark application after it has been approved by an Examiner at the USPTO, but before it issues as a federal trademark registration. After an application has been allowed, the trademark is published for a 30-day opposition period. Any party that believes it would be harmed by the registration of the trademark can initiate an opposition proceeding in an attempt to prevent the trademark from registering. The party must file a Notice of Opposition within the 30-day window, or within an approved extension of time for filing the opposition.

There are multiple grounds on which an opposition can be based and various defenses that can be raised to fight off an opposition. We have represented both Opposers and Applicants in Opposition proceedings and have achieved successful resolutions of the contested matters depending on the needs of our clients, with strategies as diverse as contesting the full proceeding through a decision by the TTAB, or by negotiating an early settlement with a co-existence agreement that meets the business goals of both parties.

Cancellation Proceedings

Cancellation proceedings are available for challenging a trademark registration after it has issued. A party that is damaged by the continued existence of the registration can seek cancellation. Frequently, the proceedings are commenced by a party that asserts priority rights in the trademark. Sometimes a petition is filed to remove registrations that should no longer be in force because the registrant has abandoned the trademark, or the term has become generic. A Petition for Cancellation can be filed at any time after the registration issues; however, certain grounds for cancellation, such as likelihood of confusion, may no longer be available after the mark has been registered for five years. Once a cancellation proceeding has been instituted by the TTAB, it proceeds before the Board much like an opposition proceeding.

Our firm's attorneys are adept at guiding clients through these proceedings to appropriate resolutions and, if necessary, can handle the full proceeding to a final decision by the TTAB, as well as any appeal.