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An Over View of Trademark Oppositions in the United States (I)

□ By Curtis Krechevsky, Michael A. Cantor

Introduction

This two-part article is intended to provide a brief overview of the trademark opposition procedure in the United States. Part I covers considerations for preparing and filing an opposition, and the available remedies. Part II covers considerations for responding to an opposition and also reviews the opposition procedure through a trial and possible appeal. We also discuss some practical considerations for deciding whether to file and how to litigate an opposition.

A trademark opposition is defined as an objection by a third party to a pending federal application after publication, and before a registration has been granted. Oppositions in the United States are therefore categorized as pre-grant, rather than post-grant, proceedings. The parties to an opposition are known as the “Opposer” or “Opponent” (the objecting party) and the “Applicant” (owner of the opposed application).

Who Decides Trademark Oppositions?

Oppositions are filed with the

Trademark Trial and Appeal Board (“TTAB”) of the United States Patent and Trademark Office (“USPTO”). The USPTO, an agency of the United States Department of Commerce, administers the national trademark registry of the United States, also known as the “federal” trademark registry.

Each of the 50 individual states in the U.S., plus the U.S. territory of the Commonwealth of Puerto Rico, maintain their own “state” trademark registries. Except for Puerto Rico, however, none of the states currently offers the ability to oppose a state trademark application.

The TTAB is an administrative adjudicatory body residing within the USPTO, authorized by the U.S. Trademark Law (the “Lanham Act”) to hear and decide trademark oppositions. The TTAB has exclusive jurisdiction over trademark oppositions. (The TTAB also hears and decides petitions to cancel federal registrations (trademark cancellation proceedings), appeals from final USPTO decisions on applications (typically where the application has

received a final refusal), and certain other proceedings under the Lanham Act.) An opposition cannot be filed in the federal or state trial courts, even as a companion claim to a larger related dispute, such as a trademark infringement complaint. (By contrast, a cancellation proceeding can be brought in a federal trial court under certain circumstances.)

Oppositions are decided by the TTAB’s administrative trademark judges. A panel of three judges hears each opposition and issues a written decision (also known as an “opinion”). TTAB decisions are either unanimous or by a majority (2-1) vote. Dissenting judges can and occasionally do file their own opinions. The administrative judges are very knowledgeable in trademark law, and are appointed by the U.S. Secretary of Commerce, in consultation with the Director of the USPTO. Once appointed the judges serve full-time for the TTAB. Prior to their appointment, judges often have acquired substantial trademark experience in private practice, at the USPTO, or in academia. As

of March 2015, the TTAB has 23 judges. A list of the TTAB judges and their backgrounds can be accessed at http://en.wikipedia.org/wiki/Trademark_Trial_and_Appeal_Board.

When To Oppose

Federal trademark applications are published for opposition in the weekly USPTO Trademark Gazette, available electronically or for download via the USPTO website. Once the USPTO publishes an application for opposition, a potential Opposer initially has thirty (30) calendar days within which to file a Notice of Opposition, or a request to extend the time to file a Notice of Opposition.

Unlike China, the United States permits extensions of time to oppose published applications. The initial thirty (30) day opposition period may be extended if the potential Opposer files a written extension request with the TTAB. Note, however, that any request for extension of time is communicated by the TTAB to the Applicant or Applicant's designated representative (such as outside counsel). Thus even requesting an extension of time puts the Applicant on notice that the potential Opposer has some concerns about the application.

The potential Opposer may file a request for a thirty (30) day extension as a matter of right (without showing cause and without Applicant's consent). If necessary or desired, the potential Opposer may then file a second request for an additional sixty (60) day extension, again without Applicant's consent, but this time showing some basis for "cause" for the additional extension request (for example, the potential Opposer's need to further investigate the matter, to confer with counsel, or

to engage or continue in settlement discussions). Alternatively, Opposer may file a single extension request, within the initial thirty (30) day period, without Applicant's consent, but showing a basis for cause, for a ninety (90) day extension.

Once the potential Opposer has obtained extensions of time totaling ninety (90) days, Opposer can only extend the opposition deadline with Applicant's consent absent extraordinary circumstances. The TTAB normally permits only one final consented-to extension, for a period of sixty (60) additional days.

An opposition deadline (or any other deadline in an opposition proceeding) that does not fall on a normal business day (Monday through Friday), or that falls on a national public holiday, a local public holiday in Virginia if the USPTO is closed for that holiday, or on any other officially excluded days (for example when the USPTO is closed due to inclement weather), may be met by taking the appropriate action on the next business day.

Issues and Strategies Between Publication and the Opposition Deadline

Unlike China, the United States is a "first-to-use" trademark jurisdiction. Use-based trademark rights (also known as "common law" rights) are valid and enforceable if the use occurs within the United States. Thus oppositions can be based purely on owning senior common rights, *i.e.* an earlier use date prevails over a later filing date. Owning a prior federal application or trademark registration is not required. While common law rights are limited territorially to where the trademark owner can demonstrate substantial and continuous commercial use,

plus a reasonable zone of territorial expansion, the geographic scope of common law rights tends not to matter much for oppositions.

Where an application has been filed on the basis of Lanham Act Section 1(b) (Intent-To-Use), Section 44(e) (non-U.S. Applicant's home country national registration), or Section 66(a) (Madrid Protocol), and applicant's use has not yet commenced in the United States, Applicant's earlier filing date (also known as Applicant's "constructive use date") will prevail against an Opposer who begins use after the filing date, even though the Opposer's use may occur before Applicant's actual date of first use of the mark in the United States. This also means that a potential Opposer needs to be very careful to assure itself that it has senior rights before filing an opposition or even extending the time to oppose.

During the thirty (30) days between publication and the filing of even one extension of time to oppose, the potential Opposer is often well-advised to investigate the Applicant, the possible use of the mark in the application, any seniority of rights issues, and the history of the prosecution of the application, including whether any of the potential Opposer's marks were cited by the USPTO against the application, and if so, what arguments Applicant made to overcome the citations and achieve publication.

Applicant's history in other applications, and opposition and cancellation proceedings, is also readily available from the USPTO and TTAB websites, including (typically) all of the pleadings and documents. If Applicant is represented by counsel, then in addition to any website that counsel's firm maintains, the USPTO and TTAB records can be searched

to see what other applications or TTAB proceedings counsel has been involved with, what arguments were made, and what outcomes obtained.

In addition, it is often worthwhile to investigate Applicant's overall business and its apparent legal and financial resources, to determine how important the mark in the application appears to be to Applicant, and to gauge Applicant's willingness and ability to defend against an opposition.

Beyond any investigation that the potential Opposer or its counsel may conduct, consideration should be given to utilizing an outside investigator, particularly if evidence of Applicant's use or non-use of the mark, or information on Applicant's financial condition, are difficult to obtain through self-action.

During the time between publication and either the expiration of the opposition deadline or the filing of a Notice of Opposition, the potential Opposer should consider whether to send a demand letter to Applicant stating Opposer's concerns about the application and what steps would resolve those concerns (for example, withdrawal/abandonment of the application, undertaking not to use the mark, or more limited changes to the application). The opposition deadlines can be used to pressure Applicant for a response to the demand letter or, if a settlement has been reached, then to move forward quickly with the preparation and execution of an agreement.

Preparing and sending a demand letter is usually less costly than preparing and filing a Notice of Opposition. Therefore, if Opposer is able to accomplish its goals (for example, abandonment or amendment of the application) with a letter, then sending a letter at this

time is a cost-effective approach.

However, sending a demand letter can escalate the seriousness of the dispute, even to the point of Applicant filing court litigation to "pre-empt" a possible trademark infringement claim. Moreover, sending a demand letter threatening an opposition is not generally advisable if the potential Opponent is not willing to follow through and make good on the threat. Consider also whether there is any history of past collaboration or conflict between Applicant and the potential Opposer, and whether a "business-to-business" communication channel exists or could be established to reach a settlement even if Applicant's counsel proves to be difficult.

1. This is also the best time to carefully assess the validity and strength of the rights on which the potential Opposer would rely if an opposition must be filed. For example, issues to be considered could include:

2. Possible vulnerability of Opposer's rights to partial or complete cancellation for non-use (abandonment).

3. Possible vulnerability of Opposer's rights to cancellation due to improper licensing ("naked license") or improper assignments or other chain of title defects.

4. Possible infirmities in Opposer's marks, such as descriptiveness / genericness issues, deceptiveness, geographic descriptiveness or deceptiveness, etc.

5. Other irregularities in the filing and prosecution of Opposer's federal applications and/or filings to maintain/renew federal registrations.

6. Opposer's prior knowledge of or acquiescence to Applicant's use and/or applications for the same or similar marks.

Commencing the Opposition

An opposition is commenced by filing a written "Notice of Opposition" with the TTAB. The Notice of Opposition uses similar format, structure, and language to a trademark infringement complaint filed in a federal trial court. Indeed, many of the TTAB rules that govern opposition proceedings are lifted directly from the comparable procedural rules governing federal court litigation. Although a Notice of Opposition can be as lengthy as the Opponent wishes, all that is necessary is a short and plain statement identifying the parties, the opposed application, the marks or other reasons on which the opposition is based, and a request that the TTAB sustain the opposition and refuse registration to the application.

The TTAB now permits (and indeed encourages) oppositions to be filed electronically via the TTAB's portion of the USPTO website. The TTAB's electronic filing system is known as the Electronic System for Trademark Trials and Appeals ("ESTTA"). See <http://estta.uspto.gov/>. Note that oppositions against applications based on extensions of protection under the Madrid Protocol (or requests for extensions of time to oppose such applications) must be filed electronically.

An opposition can be filed against all or some of the goods and services covered by the application. In addition, the Opponent can file a single Notice of Opposition against multiple published applications by the same Applicant if the same mark is involved and if the issues as to each application are identical to or substantially overlap with the issues for the other applications. Opponent can also base its opposition

on multiple federal trademark registrations and applications, as well as on any common law rights or other grounds Opponent may have. Although unusual, a joint opposition (a single opposition with two or more Opposers) can also be filed in appropriate circumstances.

An opposition is available against applications published by the USPTO for registration on the Lanham Act's Principal Register (the main register where most federal trademark applications and registrations reside).

Other Issues for the Notice of Opposition

Standing

Opposer must have legal "standing" to oppose. Standing extends to any "person" (which includes corporations, other business entities, and associations) who believes that he, she, or it will be damaged by the registration of the application. The TTAB is generally liberal in finding standing to oppose.

Grounds

Below is a list of the most typical grounds asserted in U.S. oppositions. Note that USPTO examiners can also raise most of these grounds as objections to the application during substantive examination. For example, the USPTO examines applications for conflicts with prior federal applications or registrations.

1. Immoral or scandalous matter - Lanham Act Section 2(a)
2. Deceptiveness - Lanham Act Section 2(a)
3. False suggestion of a connection - Lanham Act Section 2(a)
4. Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods - Uruguay Round Agreements Act ("UGAA") Section 2(9)

5. The mark consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof - Lanham Act Section 2(b)

6. The mark consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased U.S. President without the written consent of the surviving spouse - Lanham Act section 2(c)

7. Priority of rights and likelihood of confusion - Lanham Act Section 2(d)

8. The mark is merely descriptive - Lanham Act Section 2(e)(1)

9. The mark is deceptively misdescriptive - Lanham Act Section 2(e)(1)

10. The mark is primarily geographically descriptive - Lanham Act Section 2(e)(2)

11. The mark is primarily geographically deceptively misdescriptive - Lanham Act Section 2(e)(3)

12. The mark is primarily merely a surname - Lanham Act Section 2(e)(4)

13. The mark comprises matter that, as a whole, is functional - Lanham Act Section 2(e)(5)

14. The mark is likely to cause trademark dilution - Lanham Act Section 43(c)

15. The Applicant has committed fraud on the USPTO - *In re Bose Corporation*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

16. Genericness - Lanham Act Section 23

Amending the Notice of Opposition

With the exception of oppositions against Madrid Protocol applications, Opposer can amend the Notice of Opposition after filing to include

additional grounds on which the opposition may be granted. Opposer may amend the Notice of Opposition once as of right after filing and before Applicant answers or otherwise responds to the opposition. Opposer can amend the Notice of Opposition thereafter by consent/stipulation of the parties or upon a Motion to Amend filed with and granted by the TTAB. Note, however, that oppositions against Madrid Protocol Extensions of Protection (Section 66(a) applications) cannot be amended after filing.

Costs to File an Opposition

The USPTO/TTAB fee for filing an opposition is US\$300.00 per class of the application opposed. Attorney's fees are in addition to this cost.

Burden of Proof

Opposer has the burden of proof (on a more-likely-than-not, "preponderance of the evidence" standard) to support the allegations in the Notice of Opposition and demonstrate that the TTAB should sustain the opposition.

Effect of the Opposition on the Application

Even if the opposition is unsuccessful or is later withdrawn, the filing of a Notice of Opposition will delay the grant of a registration to Applicant.

A fully-litigated opposition proceeding to a decision on the merits (from the date a Notice of Opposition is filed to a decision by the TTAB) may take eighteen months to two years to complete. This is a significant delay to registration of the application.

The TTAB's procedural rules were modified in 2007 to more closely parallel the procedures applicable

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to federal district court litigation. Therefore, fully-litigating an opposition proceeding to a decision on the merits before the TTAB is an expensive and time-consuming undertaking for both Opposer and Applicant, with costs and attorneys' fees also similar to court litigation.

Remedies at the TTAB

Remedies at the TTAB are limited to whether the opposition will be sustained (granted) or denied (rejected). If the opposition is

sustained, then the application is refused, and the application becomes abandoned (assuming no appeal is taken). If the opposition is denied, then the application will be allowed to register (again assuming no appeal is taken). Occasionally oppositions are sustained in part or denied in part. No injunctive relief can be granted by the TTAB. Money damages, other monetary compensation, and injunctions are not available at the TTAB. The TTAB cannot award costs or attorneys'

fees to either Opposer or Applicant. Each party must bear its own costs and fees. If the Opposer has a claim for trademark infringement based on use of the mark, then a lawsuit for trademark infringement must be filed in federal or state court seeking money damages and, if desired, injunctive relief.¹⁷

End of Part I, Part II of the article will be published on the next issue, Issue 67.

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Introduction

This two-part article is intended to provide a brief overview of the trademark opposition procedure in the United States. Part I covered considerations for preparing and filing an opposition, and the available remedies. Part II covers considerations for responding to an opposition and also reviews the opposition procedure through a trial and possible appeal. We also discuss some practical considerations for deciding whether to file and how to litigate an opposition.

Responding to An Opposition

Immediately upon the filing of an opposition, the TTAB issues a Scheduling Order that governs the entire schedule of the proceeding through trial to a decision on the merits. The Scheduling Order includes a deadline for Applicant to file its Answer to the opposition. Applicant has forty (40) days from the filing of the opposition in which to answer the Notice of Opposition. (While it is also possible to respond to the Notice of Opposition with certain types of motions rather than an Answer, the intricacies of when and how to file

such motions are beyond the scope of this article. For present purposes, we are assuming that the Notice of Opposition has been properly pled and an Answer is to be filed.) This deadline can be extended upon Applicant's motion with or without Opposer's consent, and subsequent TTAB order. If Applicant does not answer, then the TTAB will issue a Notice of Default allowing Applicant thirty (30) days to show cause as to why it did not answer. Such cause must be a legitimate reason for missing the deadline. If Applicant fails to respond to the Notice of Default, then the TTAB will issue a Default Judgment sustaining the opposition and refusing the registration of the opposed application(s).

Contents of Answer

In the Answer, Applicant must admit or deny each of the allegations in the Notice of Opposition, based on Applicant's own knowledge of the factual background to the opposition. If Applicant is without sufficient knowledge to be able to admit or deny the allegation, then Applicant must so state and deny the allegation. Applicant should raise any

available Affirmative Defenses in the Answer. Such defenses may include, for example, Opposer's failure to state a claim, acquiescence, or laches. Applicant bears the burden of proof on its Affirmative Defenses. If counterclaims are appropriate, then Applicant may raise counterclaims in the Answer. Where the opposition is based on one or more of Opposer's federal registrations, a typical counterclaim would seek cancellation of the registration(s) on any available grounds, such as abandonment for non-use, fraud, or priority and likelihood of confusion. Applicant bears the burden of proof on its counterclaims.

Discovery Conference

The TTAB Scheduling Order requires the parties to hold a Discovery Conference within thirty days after Applicant files its Answer. The Discovery Conference can be held in person, by telephone, or (by mutual consent) by email. At the Discovery Conference, the parties or their counsel are, at a minimum, required to discuss the following topics: (a) the merits of the claims and defenses in the Notice of Opposition

and the Answer; (b) the possibility of settling the opposition, or if settlement does not seem feasible at the time, the possibility of at least narrowing the scope of the claims or defenses; and (c) any arrangements to expedite or limit disclosures, pre-trial discovery, and the introduction of evidence at trial. Either party can request TTAB participation in the Discovery Conference to help facilitate the conference. The TTAB representative will facilitate the conference, address any fundamental misconceptions regarding trademark law, and help facilitate Accelerated Case Review (“ACR”, discussed below) should the parties agree to utilize that process. TTAB participation is particularly helpful when Applicant is pro se or Applicant’s counsel is not a knowledgeable or experienced trademark attorney.

Other Issues to Address Early

1. Protective Order for Sensitive Commercial Information and Trade Secrets

The TTAB automatically enters a standard Protective Order in the opposition whereby each party may designate confidential materials that may be withheld from the public view. The Protective Order allows parties to designate and produce confidential materials during discovery and to submit such confidential materials to the TTAB in pleadings, briefs, and as exhibits by submitting redacted documents for public viewing and unredacted documents under seal for review by the TTAB. This mechanism allows the parties to rely on relevant but confidential material during the opposition proceeding. The parties may agree to amend that Protective Order to tailor the Protective Order to the specific needs of the parties.

Each party may, however, challenge another party’s designation of documentation as confidential.

2. Service of Pleadings and Other Documents

If the parties agree, service of pleadings and other documents can be accomplished by electronic mail as opposed to regular mail, fax, or courier service. If service is made by U.S. First Class (regular) mail, then the receiving party has an additional five days to respond beyond whatever the normal response period would be as provided in the Scheduling Order or TTAB rules. If service is via email, there is no additional time outside the response period.

3. Production of Documents and Other Evidence

The parties or their counsel should discuss how documents and other evidence will be produced, including the location of the production and whether production will occur electronically, on paper, or otherwise.

4. Protection of Attorney-Client Privilege

Counsel should discuss the creation of Privilege Logs, and whether documents dated after the Notice of Opposition was filed should be logged because such documents are presumably privileged.

5. Witness Deposition Procedures

Counsel should discuss any special concerns or issues related to witness depositions.

Pre-Trial Discovery

The term “discovery” refers to the U.S. litigation procedure whereby the parties disclose to each other the witnesses and evidence that the parties intend to rely on in the opposition proceeding. This disclosure is mandatory and a party who fails or refuses to comply with discovery can be severely sanctioned,

up to and including having judgment entered against that party. The typical TTAB Scheduling Order allows the parties six months to complete their discovery. Discovery techniques vary, and can be both formal and informal. The TTAB rules provide for the following formal types of discovery techniques:

1. **Initial Disclosures:** Early exchanges of information relevant to the opposition.

2. **Interrogatories:** Written questions concerning the issues and allegations in the opposition, given to the other party to be answered under oath.

3. **Requests for Production:** Written requests to the other party to produce documents and other evidence relevant to the issues and allegations in the opposition.

4. **Requests to Admit:** Written requests to the other party to admit or deny specific allegations relevant to the opposition.

5. **Witness Depositions:** Live examination of a party’s witnesses, by either that party’s counsel or opposing counsel, recorded by a stenographer, about that party’s knowledge of the facts and evidence relevant to the opposition.

A party’s written discovery requests cannot be served until that party’s Initial Disclosures are served. Service of Initial Disclosures and written discovery requests can be simultaneous. In the Initial Disclosures, the parties need to disclose their respective witnesses who likely have discoverable information to support the parties’ claims and defenses. Such information can include, for example, Opposer’s and Applicant’s use, advertising, marketing, promotion efforts, sales, fame, channels or trade and expansion into additional channels of trade, and targeted consumers

regarding the parties' respective marks, and the likelihood of confusion and/or dilution that Applicant's mark will cause. In the Initial Disclosures, the parties also need to list the categories of documents on which they intend to rely to support their claims and defenses.

If a party fails to respond to written discovery, fails to appear for a deposition, or fails to answer one or more questions at a deposition, the requesting party can file with the TTAB a "Motion to Compel" seeking an order that certain discovery be produced. If the ordered party continues to withhold discovery, then the TTAB can issue sanctions, up to and including default judgment against that party.

Sometimes parties will engage expert witnesses to support a particular claim or defense. For example, expert witnesses are often involved where a party wishes to conduct and enter into evidence a consumer survey either supporting or refuting a likelihood of confusion between the respective marks of Opposer and Applicant.

Summary Judgment

Summary judgment is a faster way for the parties to obtain an opposition decision. (The TTAB has also created a "fast-track" opposition procedure known as "Accelerated Case Review" ("ACR"). The ACR procedure is still fairly new and not yet widely used, but in essence the parties agree to arrangements and limitations regarding disclosures, discovery, and/or the introduction of evidence, thereby reducing or relaxing the discovery or evidentiary requirements under normal TTAB rules and procedures. In exchange, the TTAB promises to decide the

opposition within fifty days after the final trial brief is filed, significantly faster than TTAB decisions normally issue. The most appropriate cases appropriate cases for ACR are those in which one or more of the following circumstances apply: (a) little discovery is necessary; (b) parties are able to stipulate to many facts; (c) each party expects to rely on the testimony of one or two witnesses and the overall record will not be extensive; (d) parties are prepared to make summary judgment submissions with exhibits and are prepared to stipulate that the TTAB panel deciding the case can resolve any lingering genuine disputes as to material facts; or (e) parties are prepared to stipulate to the admissibility of most of the record, and will merely reserve the right to object in trial briefs on the grounds of relevancy or the appropriate weight to be given to particular items of evidence.)

Summary judgment requires a motion to the TTAB requesting a decision on the merits in the Movant's favor without the necessity of a full trial. The Movant must demonstrate the absence of any genuine dispute of material facts, and that Movant is entitled to judgment as a matter of law. Because trademark oppositions are so fact-intensive and the facts are often in dispute, summary judgment is difficult to obtain at the TTAB. According to TTAB statistics, in Fiscal Year 2013, only 21 summary judgment motions were granted out of 153 summary judgment motion decided. Summary judgment motions are expensive to prepare, file, and argue. Because of this expense and because it is so difficult to prevail on a summary judgment motion, the Movant should be as certain as possible that Movant

has clear and undisputed facts and an uncomplicated legal argument as to why judgment should enter in Movant's favor.

The Opposition "Trial" at the TTAB

The "trial" of an opposition is not like a trial in court. Instead, most evidence, including witness testimony, is submitted electronically or on paper. The TTAB reviews the evidentiary record and makes a ruling. The process by which evidence is formally introduced is beyond the scope of this article, but readers should be aware that there are specific and numerous TTAB rules governing this process and it is essential to pay close attention to them to avoid the risk of important evidence not being considered by the TTAB.

Following submission of the evidence, each party files a "trial brief" summarizing the evidence and presenting legal argument why the TTAB should rule in that party's favor.

Either or both of the parties can request a hearing with the TTAB at which oral arguments can be made and any questions from the TTAB panel can be answered. If neither party requests a hearing, then the TTAB decides the opposition only on the evidentiary record. While hearings often occur with representatives of both parties physically present in the same room as the TTAB panel, the hearings can take place via videoconference with one or both parties. The TTAB is occasionally willing to hold hearings outside of the TTAB's offices at the USPTO in Alexandria, Virginia, but most hearings take place at the TTAB's offices.

TTAB decisions on the merits of an opposition can take anywhere

from a few months to more than one year to issue.

TTAB decisions can be appealed to either a federal appellate court (the U.S. Court of Appeals for the Federal Circuit) or by instituting a new opposition proceeding in a U.S. federal trial court. Having two different appellate procedures available is unusual for U.S. legal proceedings, and is a unique feature of U.S. opposition practice.

Opposition Costs

Because oppositions share many features with standard U.S. court litigation, the attorney's fees and costs of a fully-litigated opposition can reach into the hundreds of thousands of U.S. Dollars. Thus one important strategic consideration before making any form of objection to a federal trademark application is whether the potential Opponent is prepared to make such a substantial investment of financial resources. However, from a statistical standpoint, the fact is that approximately two-thirds of all oppositions are settled before even before Applicant's answer has been filed.


Settlement / Withdrawal of An Opposition

An opposition may be settled at any time prior to the TTAB's decision on the merits. Depending on the terms of the parties' settlement agreement, termination of the opposition may be on a "with prejudice" or "without prejudice" basis. Opposer's withdrawal of an opposition with or without Applicant's consent automatically terminates the proceedings. Withdrawal of an opposition with Applicant's consent is on a "without prejudice" basis, allowing Opposer to bring the same claim against the same Applicant in the future, typically in the form of a cancellation action at the TTAB. Withdrawal of an opposition without Applicant's consent but before Applicant has filed its Answer to the opposition is also on a "without prejudice" basis. Withdrawal of an opposition without Applicant's consent but after Applicant has already filed its Answer to the opposition results in a "with prejudice" dismissal of the opposition. A "with prejudice" withdrawal will prevent Opposer

from later bringing the same claim against the same Applicant at the TTAB.

If Applicant withdraws an opposed application with or without Opposer's consent, this automatically terminates the proceeding. Withdrawal of the application without Opposer's consent will result in an adverse judgment against Applicant. The entry of an adverse judgment should prevent Applicant from re-filing an application for the same mark covering the same goods/services, and prevents Applicant from later defending against the same claim brought by the same party in the TTAB.

Conclusion

We hope that our two-part article has been helpful to familiarize readers with the trademark opposition procedure in the United States. Of course any overview like this one must of necessity leave out many specifics and complexities. Thus it is imperative to work with an experienced U.S. attorney if you or your client is faced with filing or defending against a trademark opposition. 



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