

Trademark Opposition and Cancellation Proceedings in the United States

Lee J. Eulgen | leulgen@nge.com

Ian J. Block | iblock@nge.com

Jessica Rissman Cohen | jcohen@nge.com

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Today's Presenters



Lee J. Eulgen



Jessica R. Cohen



Ian J. Block

Basic U.S. Opposition and Cancellation Features

- U.S. Opposition and Cancellation Proceedings are the most burdensome in the world.
- U.S. Opposition and Cancellation Proceedings are the most expensive in the world.
- U.S. Opposition and Cancellation Proceedings are subject to the Federal Rules of Civil Procedure and, thus, they operate like a miniature U.S. lawsuit with discovery mechanisms such as the formal exchange of documents, answers to written questions (“interrogatories”), and answering verbal questions for up to 7 hours per witness (“depositions”).
- As a result, foreign applicants often dislike the U.S. system.
- Over 95% of U.S. U.S. Opposition and Cancellation Proceedings settle before a decision on the merits.



An aerial photograph of a city skyline at dusk or dawn. The sky is filled with dark, heavy clouds, and the buildings are illuminated from below, creating a warm, golden glow. A prominent vertical yellow line runs through the center of the image, separating the two text elements. The buildings vary in height and architectural style, with some featuring intricate details and others being more modern and glass-fronted.

U.S. Opposition Proceedings

Trademark Applications

Availability and Timing of Oppositions

- A Notice of Opposition must be prepared and filed to commence the proceeding and set for the grounds for opposition.
- The U.S. is a member of the Madrid Protocol, and applications filed on the basis of international registrations may be opposed just as national applications.
- The 30-day opposition window opens when the trademark application is “published for opposition.” Interested parties may file Extensions of Time to extend the opposition window by a total of 90 days without the applicant’s consent, and a further 60 days with consent.
- The Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office (USPTO) hears and decides both Oppositions and Cancellations.
- As in the EU and France, an opposition will delay the grant of full registration rights to the applicant.

Grounds for Opposition

A Notice of Opposition may be based on grounds including the following:

- Likelihood of confusion with a previously used or registered mark
- Dilution
- Genericness, descriptiveness, deceptive misdescriptiveness, geographic misdescriptiveness (for wine or spirits)
- Non-distinctiveness or failure to function as a trademark
- Abandonment
- No *bona fide* intent to use the mark in connection with the identified goods or services as of the filing date of an intent-to-use application.
- Fraud on the U.S. Trademark Office
- The opposed mark is not used in connection with lawful goods and/or services (*i.e.*, cannabis products)



Burden of Proof, Standing, and Jurisdiction

- The burden of proof is on the opposer to prove the grounds
- Any person who believes they would be damaged by registration of the subject mark may oppose the mark
- Filings must be made by a U.S.-licensed attorney
- The U.S. Trademark Trial and Appeal Board decides the proceeding and, notably, does not have the power to issue monetary awards or sanctions, nor injunctions regarding a party's use of a mark.

Proceeding | Notice of Opposition and Institution Order

- The Notice of Opposition sets out (usually in numbered paragraphs) identifying information about the opposer and its allegations of standing and grounds for opposition.
- Once the Notice of Opposition is filed, the Board issues an Institution Order, which sets out the initial schedule for the proceeding:
 - Applicant's time to file its answer (40 days);
 - Discovery period (6 months);
 - Testimony periods (30 days for opposer; 30 days for applicant; and 15 days for opposer's rebuttal);
 - Trial briefing schedule; and
 - Oral hearing (optional).
- Deadlines may be extended on consent of the parties or by order of the Board. These extensions are usually granted, unless a party has been thwarting progress in the case.

Proceeding | Answer

- In its answer, the Applicant is required to admit or deny the allegations in the Notice of Opposition.
- The Applicant may also assert affirmative defenses, including but not limited to acquired distinctiveness, unclean hands, or fraud. Laches, acquiescence and related defenses are generally not available in trademark opposition proceedings.
- The Applicant may also file a counterclaim to cancel a registration upon which the Opposition is based. This will, in effect, create an additional cancellation proceeding, requiring a new round of pleadings and a new scheduling order.

Proceeding | Discovery and Motion Practice

- Means by which the parties obtain discoverable information are:
 - Written Interrogatories (limit of 75)
 - Requests for the Production of Documents
 - Requests for Admission
 - Deposition Testimony
 - In TTAB proceedings, depositions take the place of trial testimony and occur during the “testimony period.” They occur out of the presence of the Board, with the parties submitting written transcripts and exhibits to the Board.
 - Unlike in federal lawsuits in court, the default in Board proceedings is that foreign witnesses are deposed on written questions.
- The Board decides discovery disputes through motion practice, similar to federal court, *except* there are no fee awards/sanctions or any fee shifting.
- Parties may also file dispositive motions, such as Motions to Dismiss, Motions for Summary Judgment, or Motions to Suspend the proceeding because a related proceeding has been filed in court.
- TTAB Proceedings also allow for the use of expert testimony, such as consumer survey experts.

Proceeding | Briefs and Hearing

- The Opposer must file a trial brief at the conclusion of the discovery period. The Applicant may file a brief, after which the Opposer may file a rebuttal brief.
- An oral hearing is held only if requested by a party to the proceeding. The non-requesting party need not attend.
- No new evidence may be introduced in either the trial brief(s) or oral hearing.

Proceeding | Decision and Termination

- The Board will typically issue a decision in 3-6 months.
- In addition to adjudicating the merits of the Opposition, the Board may remand the application to the Examining Attorney for a determination on registrability issues.
- The losing party may request a reconsideration from the Board, appeal to the United States Court of Appeals for the Federal Circuit, or file a new civil action in a U.S. District Court. Only the third option allows the parties to submit additional evidence.
- Each party to a TTAB proceeding pays its own costs. There are no damage awards, fee shifting, or fee awards.
- Withdrawal of either the opposition or the opposed application—including on the basis of settlement, which the Board need not approve—automatically terminates the proceeding.

An aerial view of a city skyline at dusk, featuring numerous skyscrapers and buildings. A vertical yellow bar is positioned in the center of the image, extending from the top to the bottom. The sky is dark with some clouds, and the city lights are visible at the bottom.

Cancellations

Trademark Registrations

Availability and Effect of Cancellations

- A Petition to Cancel a mark may be brought against all or part of the goods or services in an issued trademark registration.
- The U.S. is a member of the Madrid Protocol, and registrations issued on the basis of international registrations may be the subject of Petitions to Cancel just as national registrations.
- A Petition to Cancel may be brought at any time, but the availability of certain grounds are sharply reduced once the mark becomes “incontestable” (5 years after registration).
- For WIPO registrations based on a U.S. registration, cancellation of the U.S. mark within 5 years of registration will result in cancellation of the WIPO mark. After 5 years, the WIPO registration becomes independent of the U.S. registration.

Grounds for Cancellation

- The grounds for cancellation of a trademark registration within five years of registration are largely the same as the grounds for opposition of a trademark application (previously discussed).
- After 5 years, a registration may still be subject to cancellation, but the grounds for cancellation are more limited and include the following:
 - Genericness, descriptiveness, deceptive misdescriptiveness, false association, geographic misdescriptiveness (for wine or spirits).
 - In particular, genericness or descriptiveness may occur where particularly popular or successful trademarks become commonly-used generic terms for the goods or services they are used in connection with (*i.e.*, Aspirin, Cellophane, etc.)
 - Abandonment or non-use with no intent to resume use.
 - Non-use for three or more years gives rise to a presumption of abandonment. The presumption can be overcome by the registrant showing that it intends to resume use.
 - Fraud on the USPTO.
 - Claim or issue preclusion.

New *Ex-Parte* Post-Registration Proceedings

- The USPTO recently introduced two new *ex parte* proceedings to challenge trademark registrations, as follows:
 - **Expungement.** A party may bring a claim to expunge a registration on the basis either that it has never been used in commerce. This type of *ex parte* proceeding must be brought between three to ten years of the mark's registration date.
 - **Reexamination.** A party may request that the USPTO reexamine the registration of a mark on the basis that it was not used in commerce before the relevant date. This type of proceeding must be brought within five years of registration.
- Both types of proceedings may be brought against all or part of the goods or services identified in the application, and generally require a verified statement that a reasonable investigation was conducted regarding whether the trademark was in use.

Burden of Proof, Standing, and Jurisdiction

- These issues are the same as with Oppositions:
 - The burden of proof is on the Petitioner.
 - Any person who believes they are damaged by the registration may petition to cancel it.
 - The filing must be made by a U.S.-licensed attorney or by a U.S.-domiciled *pro se* Petitioner.
 - The Board has limited jurisdiction to determine the registrability of trademarks and does not have the power to issue monetary awards nor injunctions regarding a party's use of a mark.
- In addition, U.S. District Courts have the power to order cancellation of trademark registrations.

Proceeding

- A Cancellation proceeding progresses much like an Opposition proceeding, with the following stages:
 - Petition to Cancel
 - Answer
 - Discovery and Motion Practice
 - Testimony Period (depositions)
 - Submission of Evidence
 - Trial Briefs
 - Optional Oral Hearings
 - Decision and Termination
- A final Cancellation decision may be appealed to the Federal Circuit or within a new civil action in a U.S. District Court (again, the latter allows for the introduction of new evidence).





Questions?

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If you have any questions,
please do not hesitate to contact:

Lee J. Eulgen

Ian J. Block

Jessica Rissman Cohen

or your Neal Gerber Eisenberg attorney.