

Why You Need an Attorney to Defend a Trademark Opposition

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In my opinion, if your trademark is worth fighting for, it is a good idea to hire an attorney to represent you. In most cases, an attorney, generally one that has experience in opposition practice, represents the opposer and there are subtleties in opposition litigation that provide an advantage to an experienced practitioner. See Trademark Trial and Appeal Board Manual of Procedure 114.01: “However, because the governing practices and proceedings before the Board are quite technical and highly specialized, it is strongly recommended that an attorney familiar with trademark law represent a party.”

Hiring an attorney shows your level of commitment to the opposing side, whereas not hiring an attorney can be perceived by your opponent as a sign of financial weakness or that you are not taking the litigation seriously. Since most oppositions are settled before going to trial, if you show weakness, your settlement position will be weakened as well.

An attorney experienced in opposition litigation will: (1) advise regarding the strengths and weaknesses of your case and your opponent’s case; (2) identify your strategic opportunities and pitfalls; (3) manage your expectations for resolution; (4) negotiate a settlement, if feasible; and (5) guide you through the opposition process.

For example, an attorney familiar with trademark law may identify affirmative defenses to raise in your answer, which you may have missed. During discovery, an experienced attorney will be able to identify your opponent’s requests that you have the right to object to instead of answering directly. Your attorney may be able to point out that your case is not as strong as you think it is, or alternatively that you are in a much better position than you think. Regarding settlement, an attorney may be able to think of and implement compromises between the parties that you might not have considered. As a business person, you likely want to have knowledge of all aspects of your business, but do you want to commit your time into researching and learning the intricacies of trademark opposition practice, when you can hire someone who already has that

knowledge – someone who can provide guidance that will help you defend, settle, and/or prevail in your opposition?

I am a patent attorney with Neifeld IP Law, PC and I manage my firm's trademark docket. I can be reached via email at bmargulies@neifeld.com and via telephone at 1.703.415.0012 ext 102. I welcome you to contact me to discuss your trademark issues.