

How to Respond to a Trademark Opposition

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You have received a service copy of a notice of opposition. Your trademark application was recently allowed by a USPTO examiner and instead, you had been expecting to receive confirmation that your mark has registered. Upon reviewing the notice of opposition, the opposer's claims/assertions do not seem valid and you cannot see how someone could confuse your mark with the opposer's mark. You are now a defendant in litigation. What do you do?

Of primary concern: you have 40 days from the date of the filing of the notice of opposition to file a formal answer, which is filed with the Trademark Trial and Appeal Board (TTAB), generally using an online form. If you determine that you need more time to respond, you may file a request for an extension of time to answer for good cause (for example, if you need additional time to investigate and collect information needed to prepare your answer). Keep in mind that all filings with the TTAB must be served on your opposing party. Such service comprises a certificate of service, a copy of the filing, and the contents; which are sent by first class mail (the parties may stipulate to service by email) to the opposing counsel.

An answer should be captioned to include the names of the parties and the opposition number. Substantively, your answer must contain admissions and/or denials of the allegations in the complaint and may include any defenses to those allegations. Any significant defects in the notice of opposition should be raised in the answer; for example: a failure to state a claim upon which relief can be granted, an improper entity being named as a party, or improper service of process.

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.