

TRADEMARK OPPOSITIONS AND CANCELLATIONS

Of the various trademark enforcement mechanisms, two of the most widely used are cancellation and opposition proceedings administered by the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board. Whether opposing or seeking to cancel a trademark or defending against the same, Hodgson Russ attorneys have significant experience with such proceedings. For example, we assist clients with preparing and filing Notices of Opposition and Petitions for Cancellation; preparing and filing Answers to Notices of Opposition and Petitions for Cancellation; representing clients through each stage of opposition and cancellation proceedings, including any discovery, substantive motions, depositions, and oral arguments; and negotiating settlements, where appropriate, including by way of co-existence agreements and other settlement agreements. We work closely with agents in numerous countries to assist clients with these services in other jurisdictions.

Experience

Defended client in a cancellation action involving a registration dating back from 1921 and simultaneously commenced a parallel opposition proceeding against adverse party.

Defended sports & entertainment client against a cease and desist letter and threatened opposition from adverse party involving the client's signature trademark used in conjunction with the trademark portfolio. We were able to obtain a favorable settlement and coexistence.

Assisted client in responding to a cease and desist letter, threatened and commenced opposition proceedings in the US and EU involving the client's decision to change its name. The adverse party claimed that their company name and the proposed new client name were likely to be confused on similar goods. As a result of our intervention and response, the adverse party withdrew all claims and dismissed all actions against our client in the United States and the European Union. The client went forward with its name change.

Prosecuted opposition proceeding for client. Adverse party had filed trademark applications in the US and EU. We negotiated favorable settlement and coexistence agreement.

Hodgson Russ intellectual property attorneys handle U.S. patent and trademark filings for a well-known German manufacturer of microscopes and related systems. The relationship is now more than two decades old.

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Publications

Wine and Spirit Companies Trademark Alert: Check your Trademarks to Ensure they are not “Deceptive”
Hodgson Russ Food & Beverage Alert, March 9, 2021

Trademark Modernization Act of 2020 to Strengthen Trademark Owners' Rights
Hodgson Russ Trademark Oppositions & Cancellations Alert, January 25, 2021

Great Scott! The return of the DeLorean trademark dispute!
Intellectual Property & Technology Alert, October 17, 2018

Back to the Future – The DeLorean Trademark Saga Continues
Intellectual Property & Technology Alert, October 15, 2015

Presentations & Events

What Nordic Companies Need to Know to Protect Their Intellectual Property Interests in the U.S.
November 8, 2018

