

Two Bites at the Same Apple: Trademark Letters of Protest and
Opposition Proceedings
by James McConkie

In the world of trademark registration, an opposition proceeding is triggered when a party seeking to prevent the registration of another party's trademark files an opposition document with the Trademark Trial and Appeal Board (TTAB).[1] The opposition must be filed during a thirty-day period of time during which the mark seeking registration is "published" for opposition. Any party believing that it would be damaged by the registration of a proposed mark can file an opposition and try to stop the mark from being registered.

The opposition proceeding is an administrative process that plays out much like litigation in the courts. The parties to an opposition proceeding make disclosures, conduct discovery, designate experts, take testimony, make motions, prepare argument, and appeal results. When the party opposing the registration of a mark prevails, the applicant's trademark is refused and federal registration is denied. Opposition proceedings take time and the associated costs can be substantial.[2]

Parties concerned about the process and cost of an opposition proceeding might consider trying a letter of protest first. A letter of protest does not preclude the subsequent filing of an opposition but instead provides a party with a second bite at the proverbial registration apple.

The Trademark Manual of Examining Procedure (TMEP) defines a letter of protest at Section 1715 as follows:

A letter of protest is an informal procedure created by and existing at the discretion of the USPTO, whereby third parties may bring to the attention of the USPTO evidence bearing on the registrability of a mark.

The letter is reviewed by the Office of the Deputy Commission for Trademark Examination Policy to determine whether the evidence submitted should be given to the examining attorney for consideration. The letter does not, however, become a part of the application file. The Deputy Commission will accept a letter of protest when it is determined to contain relevant evidence which supports any reasonable basis on which to refuse registration of the

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mark at issue.^[3] According to section 1715.01(a) of the TMEP, issues appropriate for a letter of protest include descriptiveness, genericness, likelihood of confusion with a prior trademark registration, or notice of pending infringement litigation.

While there are other issues to be considered before filing a letter of protest, parties possessing quality evidence tending to support one of these grounds should consider a letter of protest as an important and cost-effective part of their trademark enforcement strategy.

[1]

<https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/trademark-trial-and-appeal-board-ttab#160488>

[2] Kilmer, Paul F., *The Value Equation of Trademark Oppositions: A Multinational Comparison of Costs and Perceived Benefits*, INTABulletin Vol. 68, No. 5 (March 1, 2013).

[3] Trademark Manual of Examining Procedure § 1715 (October 2017).