

Examination Guide 1-21

Expungement and Reexamination Proceedings Under the Trademark Modernization Act of 2020

December 2021

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On November 17, 2021, the United States Patent and Trademark Office (USPTO) published a final rule, [Changes to Implement Provisions of the Trademark Modernization Act of 2020](#),¹ which, in accordance with the Trademark Modernization Act of 2020 (TMA),² establishes ex parte expungement and reexamination proceedings for cancellation of a registration, in whole

¹ 86 Fed. Reg. 64,300 (Nov. 17, 2021) (to be codified at 37 C.F.R. pts. 2, 7).

² Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, §§221-228 (Dec. 27, 2020) (to be codified in scattered sections of 15 U.S.C.).

or in part, when the required use in commerce of the registered mark has not been made.³ This examination guide explains the procedures for these new proceedings.

The rule changes relevant to these proceedings are effective December 18, 2021,⁴ and on that date, this examination guide will supersede the current edition of the [Trademark Manual of Examining Procedure](#) (TMEP) and any other official USPTO guidance to the extent any inconsistency exists.

I. OVERVIEW

The ex parte expungement and reexamination proceedings created by the TMA allow the USPTO to cancel a registration, in whole or in part, for nonuse of the registered mark.⁵ Specifically, in an expungement proceeding, the USPTO may cancel a registration if the evidence of record shows that the registered mark has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration. In a reexamination proceeding, the USPTO may cancel a registration if the evidence of record shows that the registered mark was not in use in commerce on or in connection with some or all of the goods and/or services as of the filing date of the application or amendment to allege use, or before the deadline for filing a statement of use, as applicable.

As explained below, these proceedings may be requested and instituted, within specific time periods, based on a third-party petition, or on the USPTO Director's own initiative, if a prima facie case of nonuse of a registered mark is established. A petition requesting institution of an expungement proceeding may be filed in connection with a mark registered under Trademark Act Section 1, 44, or 66, 15 U.S.C. §§1051, 1126, 1141(f). However, a petition requesting institution of a reexamination proceeding may be filed only in connection with a mark registered under Section 1.

If the USPTO institutes an expungement or reexamination proceeding, whether based on a petition or on the Director's own initiative, the registrant will have the opportunity to present evidence of use rebutting the prima facie case or voluntarily delete the relevant goods and/or services from the registration. If the registrant does not delete the relevant goods and/or services and cannot rebut the prima facie case of nonuse, or otherwise fails to respond to an Office action issued as part of the proceeding, the proceeding will ultimately terminate with a determination of nonuse. After termination, the registration will be cancelled in whole or in part, as appropriate, when (1) the deadline for filing an appeal lapses without an appeal being filed, or (2) a determination subject to an appeal is not overturned on review and the appeal process has ended.

³ The final rule also provides for a new nonuse ground for cancellation before the Trademark Trial and Appeal Board; establishes flexible Office action response periods and sets fees for requests to extend Office action response deadlines; amends the existing letter-of-protest rule to indicate that letter-of-protest determinations are final and non-reviewable; amends the rules on attorney recognition in trademark matters; and establishes procedures regarding court orders cancelling or affecting registrations. To the extent these provisions are not related to the new ex parte expungement and reexamination procedures, they are beyond the scope of this examination guide and are not discussed herein.

⁴ Other parts of the final rule that do not relate to the new expungement and reexamination proceedings are scheduled to go into effect on December 1, 2022.

⁵ Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, §225 (Dec. 27, 2020) (to be codified at 15 U.S.C. §§1066A, 1066B).

II. TIMING FOR REQUESTING AND INSTITUTING EXPUNGEMENT OR REEXAMINATION PROCEEDINGS

The TMA specifies the time periods during which an expungement or reexamination proceeding may be requested and instituted.

Accordingly, under 37 C.F.R. §2.91(b)(1), a petitioner may request an ex parte expungement proceeding in connection with a registration at any time between 3 and 10 years after the date of registration. In addition, until December 27, 2023, a petitioner may request an expungement proceeding for a registration that is at least 3 years old, regardless of the 10-year limit.

Under 37 C.F.R. §2.91(b)(2), a petitioner may request a reexamination proceeding in connection with a mark registered under section 1 of the Trademark Act during the first five years following the date of registration.

Finally, the Director may institute an ex parte expungement or reexamination proceeding on the Director's own initiative within these same time periods, if otherwise appropriate. See 37 C.F.R. §2.92(b).

III. PETITIONS TO REQUEST EXPUNGEMENT OR REEXAMINATION

Any person may file a petition requesting institution of an expungement or reexamination proceeding. 37 C.F.R. §2.91(a). Only one registration may be specified per petition, and a petitioner who wishes to request both expungement and reexamination proceedings for the same registration must file separate petitions for each type of proceeding. See 37 C.F.R. §§2.91(a), (c)(2).

Reexamination and expungement petitions are intended to allow *third parties* to bring nonuse of registered marks to the attention of the USPTO. Therefore, a registrant whose mark was not used in commerce, or is no longer used in commerce, should not file a petition against its own registration, but instead should voluntarily surrender the registration for cancellation in its entirety or amend the registration to delete the relevant goods and/or services, as appropriate, pursuant to section 7 of the Act, 15 U.S.C. §1057. To incentivize registrants to keep their registrations accurate and current, the USPTO previously established a \$0 fee for voluntary deletions of goods and/or services from a registration prior to submission of a post-registration maintenance document. See 37 C.F.R. §2.6(a)(11)(iii). There is no fee for voluntarily surrendering a registration for cancellation. [TMEP §1608](#).

A. Basis for the Petition

A petition for expungement must allege that the mark "has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration." 37 C.F.R. §2.91(a)(1).

A petition for reexamination must allege that the trademark "was not in use in commerce on or in connection with some or all of the goods and/or services recited in the registration on or before the relevant date," which, for any particular goods and/or services, is determined as follows:

- In a use-based application for registration of a mark with an initial filing basis under Section 1(a) for the goods and/or services listed in the petition, and not amended at

any point to be filed pursuant to Section 1(b), the relevant date is the filing date of the application; or

- In an intent-to-use application for registration of a mark with an initial filing basis or amended basis of Section 1(b) for the goods and/or services listed in the petition, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to Section 1(c), or the expiration of the deadline for filing a statement of use for the goods and/or services listed in the petition, pursuant to Section 1(d), including all approved extensions thereof.

37 C.F.R. §2.91(a)(2).

B. Requirements for a Complete Petition

Under 37 C.F.R. §2.91(c), only a complete petition for expungement or reexamination will be considered. A complete petition must be made in writing, filed through the USPTO's Trademark Electronic Application System (TEAS), and include:

- (1) The fee required by 37 C.F.R. §2.6(a)(26), currently \$400 per class;
- (2) The U.S. trademark registration number of the registration subject to the petition;
- (3) The basis for the petition under 37 C.F.R. §2.91(a) (see [part III.A](#));
- (4) The name, domicile address, and email address of the petitioner;
- (5) If the domicile of the petitioner is not located within the United States or its territories, a designation of an attorney, as defined in 37 C.F.R. §11.1, who is qualified to practice under 37 C.F.R. §11.14;
- (6) If the petitioner is, or must be, represented by an attorney, the attorney's name, postal address, email address, and bar information under 37 C.F.R. §2.17(b)(3);
- (7) Identification of each good and/or service recited in the registration for which the petitioner requests that the proceeding be instituted on the basis identified in the petition;
- (8) A verified statement signed by someone with firsthand knowledge of the facts to be proved that sets forth in numbered paragraphs:
 - (i) The elements of the reasonable investigation of nonuse conducted, as defined under 37 C.F.R. §2.91(d), where for each source of information relied upon, the statement includes a description of how and when the searches were conducted and what the searches disclosed (see [part III.C](#)); and
 - (ii) A concise factual statement of the relevant basis for the petition, including any additional facts that support the allegation of nonuse of the mark in commerce on or in connection with the goods and services as specified in paragraph 37 C.F.R. §2.91(a); and
- (9) A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence.

If a petition fails to include all of the elements required by 37 C.F.R. §2.91(c), the USPTO will issue a letter giving the petitioner 30 days to perfect the petition by complying with the outstanding requirements, if otherwise appropriate. The 30-day letter will not include a determination regarding whether the petition establishes a prima facie case, and the petitioner may not include additional evidence in its response. If the petitioner includes additional evidence in its response, the evidence will not be considered.

C. Reasonable Investigation Requirement

Under 37 C.F.R. §2.91(d), a petitioner must demonstrate that a bona fide attempt has been made to determine if the relevant registered mark was never used in commerce (for expungement petitions) or was not in use in commerce as of the relevant date (for reexamination petitions) on or in connection with the goods and/or services identified in the petition by conducting a reasonable investigation. The petition must include a verified statement that specifies the elements of this reasonable investigation for each source of information relied upon. 37 C.F.R. §2.91(c)(8). In particular, the statement must describe the sources searched, how and when the searches were conducted, and what information and evidence, if any, the searches produced. *Id.*

1. Definition of Reasonable Investigation

“A reasonable investigation is an appropriately comprehensive search, which may vary depending on the circumstances but is calculated to return information about the underlying inquiry from reasonably accessible sources where evidence concerning use of the mark during the relevant time period on or in connection with the relevant goods and/or services would normally be found.” 37 C.F.R. §2.91(d)(1). Thus, what constitutes a reasonable investigation is a case-by-case determination. However, any investigation should focus on the mark disclosed in the registration and its use in the relevant marketplace on the identified goods and/or services, keeping in mind their scope and applicable trade channels.

The petition should establish that the petitioner’s investigation included a search covering the relevant channels of trade and advertising for the identified goods and/or services but did not reveal any relevant use of the mark consistent with the definition of “use in commerce” set forth in Section 45, and in relevant case law. See [TMEP §§901-901.03](#) regarding use in commerce.

2. Sources of Information and Evidence for a Reasonable Investigation

The sources of information and evidence provided in the petition should include reasonably accessible sources that can be publicly disclosed, because petitions requesting institution of expungement and reexamination proceedings will be entered in the registration record and be publicly viewable through the USPTO’s [Trademark Status & Document Retrieval](#) (TSDR) database. The number and nature of the sources a petitioner must check in order for its investigation to be considered reasonable, and the corresponding evidence that would support a prima facie case, will vary depending on the goods and/or services involved, their normal trade channels, and whether the petition is for expungement or reexamination.

For purposes of expungement and reexamination proceedings, nonuse is necessarily determined in reference to a time period that includes past activities, not just current activities. Accordingly, a petitioner’s investigation normally would include research into past usage of the mark for the goods and/or services at issue in the petition and thus may include a

search for archival evidence, including cached web pages from sources such as Wayback Machine®.

A single search using an internet search engine likely would not be considered a reasonable investigation. See [H.R. Rep. No. 116-645](#), at 15 (2020). However, a reasonable investigation does not require a showing that all of the potentially available sources of evidence were searched. Generally, an investigation that produces reliable and credible evidence of nonuse during the relevant time period may be considered sufficient.

Appropriate sources of evidence and information for a reasonable investigation may include, but are not limited to:

- State and Federal trademark records;
- Internet websites and other media likely to or believed to be owned or controlled by the registrant;
- Internet websites, other online media, and publications where the relevant goods and/or services likely would be advertised or offered for sale;
- Print sources and webpages likely to contain reviews or discussions of the relevant goods and/or services;
- Records of filings made with or of actions taken by any State or Federal business registration or regulatory agency;
- The registrant's marketplace activities, including, for example, any attempts to contact the registrant or purchase the relevant goods and/or services;
- Records of litigation or administrative proceedings reasonably likely to contain evidence bearing on the registrant's use or nonuse of the registered mark; and
- Any other reasonably accessible source with information establishing that the mark was never in use in commerce (expungement), or was not in use in commerce as of the relevant date (reexamination), on or in connection with the relevant goods and/or services.

37 C.F.R. §2.91(d)(2).

D. Notice of Petition for Expungement or Reexamination

When a petition requesting institution of expungement or reexamination proceedings is filed, the petition will be uploaded into the registration record and be publicly viewable through TSDR. The USPTO will send a courtesy email notice of the petition to the registrant and/or the registrant's attorney, as appropriate, if an email address is of record. The registrant may not respond to this courtesy notice, and no response from the registrant will be accepted except in response to an Office action issued after institution of a proceeding under 37 C.F.R. §2.92.

For purposes of correspondence related to these proceedings, the "registrant" is the owner/holder currently listed in USPTO records. If there has been a change of ownership, it is the registrant's or the new owner's responsibility to provide such information to the USPTO. See [TMEP §502.01](#). Therefore, it is in the best interests of both the prior and new owners to

provide evidence of changes of title, either by recordation of an assignment or otherwise, in a timely manner.

IV. INSTITUTING EXPUNGEMENT AND REEXAMINATION PROCEEDINGS

A. Prima Facie Case of Nonuse

An expungement or reexamination proceeding will be instituted only in connection with the goods and/or services for which a prima facie case of nonuse for the relevant time frame has been established. See 37 C.F.R. §2.92. In this context, a prima facie case requires only that a reasonable predicate concerning such nonuse be established. See H.R. Rep. No. 116-645, at 8 (citing *In re Pacer Tech.*, 338 F.3d 1348, 1351 (Fed. Cir. 2003) and *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985)). Thus, with respect to these proceedings, a prima facie case includes sufficient notice of the claimed nonuse to allow the registrant to respond to and potentially rebut the claim with competent evidence, which the USPTO must then consider before making a determination as to whether the registration should be cancelled in whole or in part, as appropriate.

For expungement and reexamination proceedings based on a petition under 37 C.F.R. §2.91, the determination of whether a prima facie case has been made is based on the evidence and information that is collected as a result of the petitioner's reasonable investigation and set forth in the petition, along with the USPTO's electronic record of the involved registration. See [part III.C.2](#) regarding evidence of nonuse.

For Director-initiated expungement and reexamination proceedings, the information and evidence available to the USPTO must establish a prima facie case of nonuse. See 37 C.F.R. §2.92(b). For these Director-initiated proceedings, the evidence and information that may be relied upon to establish a prima facie case may be from essentially the same sources as those in a petition-initiated proceeding.

If a petition-based proceeding is instituted, the petitioner will not have any further involvement. In a Director-initiated proceeding, there is no petitioner, and thus all relevant notices will be provided only to the registrant and the registrant's attorney, if any. In both types of proceedings, documents associated with the proceeding will be uploaded into the registration record and will be publicly viewable through TSDR. This includes any prima facie evidence that the USPTO relied upon to institute a Director-initiated proceeding.

Under 37 C.F.R. §2.92(c)(1), any determination by the Director whether to institute an expungement or reexamination proceeding, based either on a petition or on the Director's own initiative, is final and non-reviewable. See Pub. L. 116-260, Div. Q, Tit. II, Subtit. B, §225(a), (c).

B. Consolidating Proceedings

To ensure consistency and promote efficiency, the Director may consolidate proceedings involving the same registration, including a Director-initiated proceeding with a petition-initiated proceeding. See 37 C.F.R. §2.92(e)(1). Consolidated proceedings are related parallel proceedings that may include both expungement and reexamination grounds. *Id.*

If two or more petitions under 37 C.F.R. §2.91 directed to the same registration have been submitted and no ex parte expungement or reexamination proceeding has been instituted as to either, or the Director wishes to institute an ex parte expungement or reexamination proceeding on the Director's own initiative under 37 C.F.R. §2.92(b) concerning a registration

for which one or more petitions under 37 C.F.R. §2.91 was submitted, the Director may elect to institute a single proceeding. 37 C.F.R. §2.92(e)(2). For example, if two or more petitions directed to the same registration identify goods and/or services in different classes, but each petitioner provides the required evidence and complies with the requirements of 37 C.F.R. §2.91, the Director may institute a single proceeding for the convenience of both the USPTO and the registrant. Similarly, if two or more petitions directed to the same registration identify various goods and/or services with some overlap, the Director may institute a single proceeding that covers all of the goods and/or services for which a prima facie case concerning nonuse is established.

V. PROCEDURES FOR EXPUNGEMENT AND REEXAMINATION PROCEEDINGS

A. Notice of Institution

When an expungement or reexamination proceeding is instituted, the USPTO will issue an Office action to the registrant providing notice of the institution, in accordance with the correspondence rules in 37 C.F.R. §2.18. 37 C.F.R. §2.92(f)(2). The Office action will also require the registrant to provide such evidence of use, information, exhibits, affidavits, or declarations as may be reasonably necessary to rebut the prima facie case of nonuse by establishing that the required use in commerce has been made on or in connection with the goods and/or services at issue. See 37 C.F.R. §§2.92(f)(2), 2.93(a).

Office actions in these proceedings are substantively limited in scope to the question of use in commerce, but the registrant remains subject to the requirements of 37 C.F.R. §2.11 (requirement for representation), 37 C.F.R. §2.23 (requirement to correspond electronically), and 37 C.F.R. §2.189 (requirement to provide a domicile address). Thus, the registrant may be required to furnish domicile information as necessary to determine if the registrant must be represented by a U.S.-licensed attorney. In addition, registrants will be required to provide a valid email address for correspondence, if one is not already in the record, and to update the email address as necessary to facilitate communication with the USPTO.

B. Responding to the Initial Office Action

The registrant must respond to the initial Office action via TEAS within three months of the issue date, but, within that time period, may request a one-month extension of time to respond, which requires the payment of the \$125 fee set forth in 37 C.F.R. §2.6(a)(27). 37 C.F.R. §2.93(b)(1). The response must be properly signed. See 37 C.F.R. §2.93(b)(3).

When a timely response by the registrant is a bona fide attempt to advance the proceeding and is a substantially complete response to the Office action, but consideration of some matter or compliance with a requirement has been omitted, the registrant may be granted 30 days, or to the end of the time period for response set forth in the Office action to which the substantially complete response was submitted, whichever is longer, to resolve the issue. See 37 C.F.R. §2.93(b)(2). Granting the registrant additional time in such circumstances does not extend the time for filing an appeal to the Trademark Trial and Appeal Board (TTAB) or a petition to the Director.

If the registrant timely responds to the initial Office action in the expungement or reexamination proceeding, the USPTO will review the response to determine if use of the mark in commerce at the relevant time has been established for each of the goods and/or services at issue. If the USPTO finds, during the course of the proceeding, that the registrant has: (1) demonstrated relevant use of the mark in commerce sufficient to rebut the prima facie case, (2) demonstrated excusable nonuse in appropriate expungement cases, or (3) deleted goods

and/or services, such that no goods and/or services remain at issue, the proceeding will be terminated, and the USPTO will issue a notice of termination under 37 C.F.R. §2.94. See [part V.E](#) regarding notices of termination.

If the registrant fails to timely respond to the initial Office action or timely submit a request for extension, the proceeding will terminate and the registration will be cancelled, in whole or in part, as appropriate. See [part V.F](#) regarding requesting reinstatement after cancellation for failure to respond to an Office action.

To ensure that registrants are aware of any correspondence or activity associated with any ex parte cancellation proceedings concerning their registered marks, registrants must monitor the status of their registrations in the USPTO's electronic systems at least every three months after notice of the institution of an expungement or reexamination proceeding until the registrant receives a notice of termination under 37 C.F.R. §2.94. See 37 C.F.R. §2.23(d)(3).

C. Evidence of Use or Excusable Nonuse

Any documentary evidence of use provided by the registrant need not be the same as that required under the USPTO's rules of practice for specimens of use under Section 1(a), but must be consistent with the definition of "use in commerce" in Section 45, and in relevant case law. See [TMEP §§901-901.03](#) regarding use in commerce. Although testimonial evidence may be submitted, it should be supported by corroborating documentary evidence.

In most cases, the documentary evidence of use will include specimens of use, but there may be situations where, for example, specimens for particular goods and/or services are no longer available, even if they may have been available at the time the registrant filed an allegation of use. In these cases, the registrant may provide additional evidence and explanations, supported by declaration, to demonstrate how the mark was used in commerce at the relevant time. Generally, because the registration file has already been considered in instituting the proceeding based on a prima facie case of nonuse, merely resubmitting the same specimen of use previously submitted in support of registration or maintenance thereof, or a verified statement alone, without additional supporting evidence, will likely be insufficient to rebut a prima facie case of nonuse.

For reexamination proceedings, the registrant's evidence of use must demonstrate use of the registered mark in commerce on or in connection with the goods and/or services at issue on or before the relevant date established under 37 C.F.R. §2.91(a)(2).⁶ See 37 C.F.R. §2.93(b)(6)(i). Specifically, if registration of the mark was based on an application with an initial filing basis under Section 1(a) for the goods and/or services listed in the petition or subject to a Director-initiated proceeding, and not amended at any point to be filed pursuant to Section 1(b), the relevant date is the filing date of the application. 37 C.F.R. §2.91(a)(2)(i). Or, if registration of the mark was based on an application with an initial filing basis or amended basis of Section 1(b) for the goods and/or services listed in the petition or subject to a Director-initiated proceeding, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to Section 1(c), or the expiration of the deadline for filing a statement of use for the goods and/or services listed in the petition, pursuant to Section 1(d), including all approved extensions thereof. 37 C.F.R. §2.91(a)(2)(ii).

⁶ The relevant dates set forth in 37 C.F.R. §2.91(a)(2)(i)-(ii) are considered for each good and/or service identified in a petition for reexamination. Under 37 C.F.R. §2.92(b), a Director-initiated proceeding may be instituted for the same reasons as those appropriate for a petition, and the relevant dates are therefore the same for a Director-initiated proceeding, even though there was no petition.

For expungement proceedings, the registrant's evidence of use must show that the use occurred before the filing date of the petition to expunge under 37 C.F.R. §2.91(a), or before the date the proceeding was instituted by the Director under 37 C.F.R. §2.92(b), as appropriate. 37 C.F.R. §2.93(b)(5)(i).

In addition, a registrant in an expungement proceeding may provide verified statements and evidence to establish that any nonuse as to particular goods and/or services with a sole registration basis under Section 44(e) or Section 66(a) is due to special circumstances that excuse such nonuse, as set forth in 37 C.F.R. §2.161(a)(6)(ii). 37 C.F.R. §2.93(b)(5)(ii). However, excusable nonuse may not be considered for any goods and/or services registered under Section 1. *See id.*

D. Deleting Goods and/or Services or Surrendering the Registration

A registrant may respond to an Office action in an expungement or reexamination proceeding by submitting a response that deletes some or all of the goods and/or services at issue in the proceeding or surrenders the entire registration for cancellation. *See* 37 C.F.R. §2.93(d). An acceptable deletion will be immediately effective, and the deleted goods and/or services may not be reinserted into the registration. 37 C.F.R. §2.93(d)(1). No other amendment to the identification of goods and/or services in a registration will be permitted as part of the proceeding. 37 C.F.R. §2.93(d). If goods and/or services that are subject to an expungement or reexamination proceeding are deleted after the filing, and before the acceptance, of an affidavit or declaration under Section 8 or 71, the deletion will be subject to the fee under 37 C.F.R. §2.161(c) or 37 C.F.R. §7.37(c). 37 C.F.R. §2.93(d)(1).

In addition, a registrant may submit a separate request to surrender the subject registration for cancellation under 37 C.F.R. §2.172 or a request to amend the registration under §2.173. However, the mere filing of these requests will not constitute a sufficient response to an Office action requiring the registrant to provide evidence of use of the mark in the expungement or reexamination proceeding. The registrant must affirmatively notify the USPTO of the separate request in a timely response to the Office action. *See* 37 C.F.R. §2.93(d)(2).

Any deletion of goods and/or services at issue in a pending proceeding requested in a response, a surrender for cancellation under 37 C.F.R. §2.172, or an amendment of the registration under 37 C.F.R. §2.173, shall render the proceeding moot as to those goods and/or services, and the USPTO will not make any further determination regarding the registrant's use of the mark in commerce as to those goods and/or services.

E. Final Action and Notice of Termination

If the registrant's timely response to a nonfinal Office action in an expungement or reexamination proceeding fails to establish use of the mark in commerce at the relevant time (or to sufficiently establish excusable nonuse, if applicable) for all of the goods and/or services at issue, or otherwise fails to comply with all outstanding requirements, the USPTO will issue a final action. 37 C.F.R. §2.93(c)(1).

In an expungement proceeding, the final action will include the examiner's decision that the registration should be cancelled for each good or service challenged in the petition and/or Director-initiated proceeding for which the mark was determined to have never been used in commerce or for which no excusable nonuse was established.

In a reexamination proceeding, the final action will include the examiner's decision that the registration should be cancelled for each good and/or service challenged in the petition and/or Director-initiated proceeding for which it was determined the mark was not in use in commerce on or before the relevant date.

As appropriate, in either an expungement or reexamination proceeding, the final action will include the examiner's decision that the registration should be cancelled in whole for noncompliance with any requirement set forth in a previous Office action under 37 C.F.R. §§2.11, 2.23, or 2.189.

If a final action is issued, the registrant will have three months to file a request for reconsideration or an appeal to the TTAB, if appropriate. 37 C.F.R. §2.93(c)(1). This deadline may not be extended.

If the registrant fails to timely appeal or file a request for reconsideration that establishes use of the mark in commerce at the relevant time for all goods and/or services that remain at issue in a final action (or that deletes the remaining goods and/or services at issue), the USPTO will issue a notice of termination of the proceeding. 37 C.F.R. §2.94. The notice will clearly set forth the goods and/or services for which relevant use was, or was not, established, as well as any other outstanding requirements. See 37 C.F.R. §2.93(c)(3)(ii). The notice of termination is a statement intended to provide notice to the registrant and the public of the ultimate outcome of the proceedings and is not itself reviewable on petition or appeal.

If the required use in commerce (or excusable nonuse, in appropriate cases) is not established, the notice of termination will indicate whether some of the goods and/or services, or the entire registration, will be cancelled. See 37 C.F.R. §2.94. If the goods and/or services for which use (or excusable nonuse) was not demonstrated are the only goods and/or services in the registration, or there remain any additional outstanding requirements, the entire registration will be cancelled. However, if the notice of termination relates only to a portion of the goods and/or services in the registration, and there are no other outstanding requirements, the registration will be cancelled in part, as appropriate. A notice of termination will not issue until all outstanding issues are satisfactorily resolved (and thus no cancellation is necessary) or the time for appeal has expired or any appeal proceeding has terminated. Petitioners and other interested parties may monitor the progress of a proceeding by reviewing the status and associated documents through TSDR.

If a notice of termination issues and indicates that some or all of the goods and/or services will be cancelled, the USPTO will then cancel the registration, in whole or in part, accordingly.

Registrations cancelled in whole or in part will be published in the electronic *Trademark Official Gazette*. In addition, the USPTO will issue an updated registration certificate for any registration cancelled in part.

F. Requesting Reinstatement After Cancellation for Failure to Respond

If a registration is cancelled, in whole or in part, because of a failure to respond to a nonfinal or final Office action in an expungement or reexamination proceeding, and that failure to respond is due to an extraordinary situation, the registrant may file a petition requesting reinstatement of the registration, in whole or in part, and resumption of the proceeding. See 37 C.F.R. §2.146(a)(5). The petition must be filed no later than two months after the date of actual knowledge of the cancellation of the registration, in whole or in part, and may not be filed later than six months after the date of cancellation in TSDR. 37 C.F.R. §2.146(d)(2)(iv).

In addition, the petition must include a response to the Office action or an appeal to the TTAB (if the applicant failed to respond to a final action). 37 C.F.R. §2.146(c)(2).

G. Estoppel

Upon termination of an expungement proceeding in which it was established that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue in the proceeding prior to the date a petition to expunge was filed under 37 C.F.R. §2.91 or the Director-initiated proceedings were instituted under 37 C.F.R. §2.92, no further ex parte expungement proceedings may be instituted as to those particular goods and/or services. 37 C.F.R. §2.92(d)(1). However, subsequent reexamination proceedings for marks registered under Section 1 are not barred under these circumstances because reexamination proceedings involve a question of whether the mark was in use in commerce as of a particular relevant date, whereas earlier expungement proceedings would only have involved a determination of whether the mark was never used. Proof of use sufficient to rebut a prima facie case of nonuse in an expungement proceeding might not establish use in commerce as of a particular relevant date, as required in a reexamination proceeding.

Upon termination of a reexamination proceeding in which it was established that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue, on or before the relevant date at issue in the proceedings, no further ex parte expungement or reexamination proceedings may be instituted as to those particular goods and/or services. 37 C.F.R. §2.92(d)(2).

H. Co-pending Proceedings

Once an expungement proceeding has been instituted for a particular registration and is pending, no later expungement proceeding may be instituted for that registration with respect to the same goods and/or services at issue in the pending proceeding. 37 C.F.R. §2.92(d)(3). In addition, while a reexamination proceeding is pending against a particular registration, no later expungement or reexamination proceeding may be instituted for that registration with respect to the same goods and/or services at issue in the pending proceeding. 37 C.F.R. §2.92(d)(4).

For the purposes of these rules, the wording "same goods and/or services" refers to identical goods and/or services that are the subject of the pending proceeding or the prior determination. Thus, for example, if a subsequent petition for reexamination identifies goods that are already the subject of a pending reexamination proceeding and goods that are not, only the latter goods could potentially be the subject of a new proceeding. The fact that there is some overlap between the goods and/or services in the pending proceeding and those identified in a petition would not preclude the goods and/or services that are not the same from being the subject of a new proceeding, if otherwise appropriate. This situation is addressed in 37 C.F.R. §2.92(c)(2), which permits the Director to institute a proceeding on petition for fewer than all of the goods and/or services identified in the petition.

I. Suspension Pending Disposition of Expungement or Reexamination Proceedings

Action by the USPTO in a matter, including examination of a pending trademark application or a TTAB proceeding, may be suspended pending the disposition of an expungement or reexamination proceeding. See 37 C.F.R. §§2.67, 2.117(a). The fact that an expungement or reexamination proceeding is pending before the USPTO that is relevant to the issue of initial or

continued registrability of a mark, and that proceeding has not been finally determined, will be considered prima facie good and sufficient cause for suspension. 37 C.F.R. §2.67.

The following suspension guidelines apply when an examining attorney has cited, or will cite, a registration under §2(d) that is the subject of an expungement or reexamination proceeding:

- If the examining attorney is **ready to issue a *nonfinal* refusal** of registration under Section 2(d), and the Trademark database shows that a petition for expungement or reexamination was filed, or that an expungement or reexamination proceeding was instituted, the examining attorney must issue an Office action that addresses all other refusals and/or requirements. The Office action must also indicate that, upon receipt of a timely response, the application will be suspended pending a determination regarding whether an expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding.
- If the examining attorney is **ready to issue a *final* refusal** of registration under Section 2(d), or **a denial of a request for reconsideration** of a final refusal of registration under Section 2(d), the examining attorney must suspend action pending a determination of whether the expungement or reexamination proceeding will be instituted and/or upon a final determination regarding such a proceeding. If the petition to institute a proceeding is not granted, or the proceeding was instituted but has been terminated, the examining attorney will remove the application from suspension and issue a final refusal, as appropriate.

An applicant's request for a suspension of action in the applicant's pending application, filed within the response period set forth in 37 C.F.R. §2.62(a), may be considered responsive to the previous Office action issued in connection with the pending application. 37 C.F.R. §2.67.

A USPTO or court proceeding is not considered finally determined until an order or ruling that ends the proceeding or litigation has been rendered and noticed, and the time for any appeal or other further review has expired with no further review sought. *Id.* Accordingly, an expungement or reexamination proceeding is considered to end when a notice of termination under 37 C.F.R. §2.94 has been issued. If a registration subject to an expungement or reexamination proceeding is cited in a refusal under Section 2(d) against a pending application, and is not withdrawn for other reasons, the refusal cannot be withdrawn until the Trademark database shows that the proceeding is terminated and the registration is cancelled. *Cf.* [TMEP §716.02\(e\)](#).