

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Insights into Trademark Modernization Act nonuse cancellation petitions

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United States Patent and Trademark Office

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PATENT AND TRADEMARK OFFICE





TMA proceedings before the Director

Petition-initiated **expungement** before the Director

- Prima facie case that the mark has never been used on some or all of the goods or services
- Available between years three and ten against Sections 1, 44, 66 registrations
 - *Exception: available for any registration over three years old until December, 2023*

Petition-initiated **reexamination** before the Director

- Prima facie case that the mark was not in use on some or all of the goods or services as of the "relevant date."
- Available until year five against Section 1 registrations





TMA petition elements

Petitioner's name, domicile address, email

Filing fee: \$400 per class

U.S. registration number

Challenged goods and services

Expungement or reexamination

Verified statement of reasonable investigation

Must be comprehensive and targeted to finding nonuse for the challenged goods or services

Documentary evidence of nonuse

Index of evidence

Examiner will issue a 30 day letter if:

an element is missing AND

the examiner is planning to institute proceedings

the exception is documentary evidence of nonuse

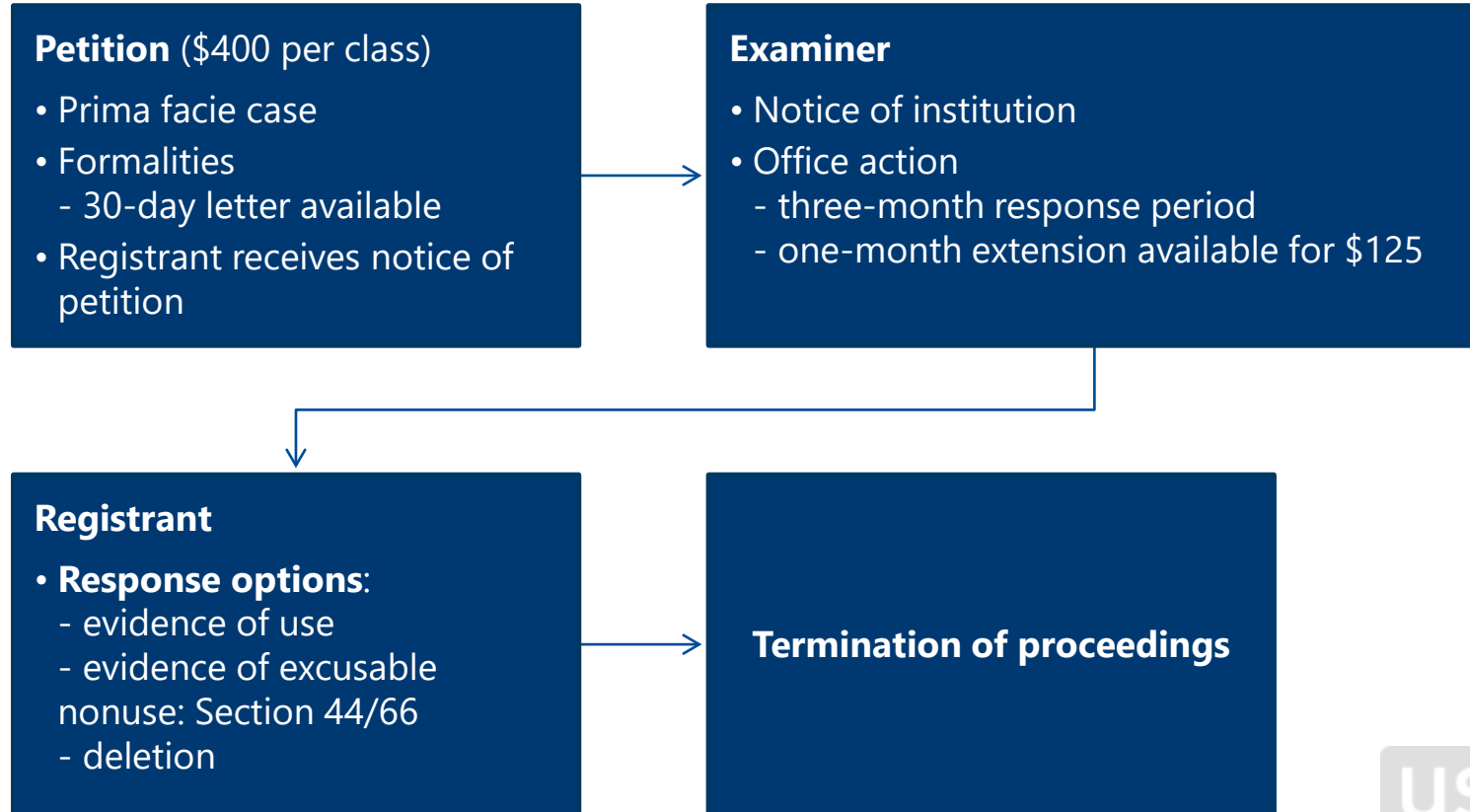
you may not supplement the evidence once the petition is filed

Once filed, you cannot withdraw the petition



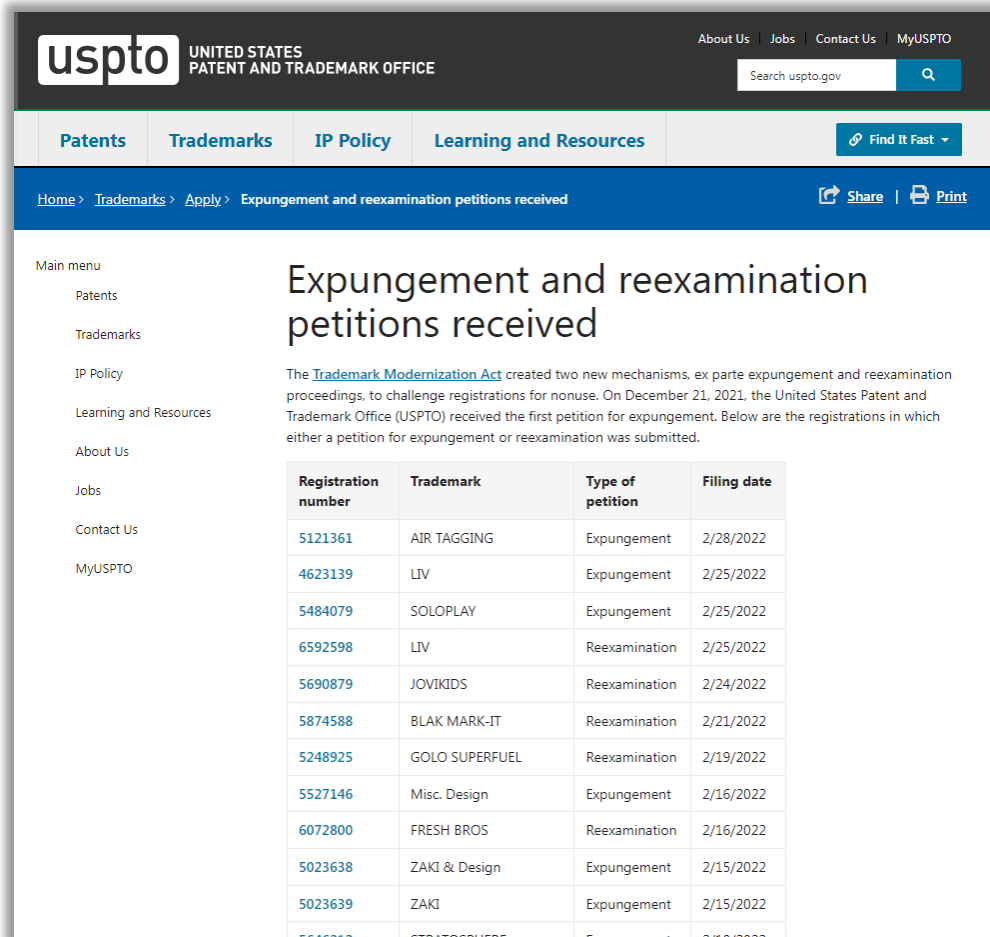


Petition-initiated proceedings



TMA petitions

- 58 petitions received
- 34 expungement
 - Section 44/66: 18
 - Section 1(a): 16
- 24 reexamination
- 13 notices of institution
- 10 notices of non-institution
- 1 Director-initiated proceeding



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Expungement and reexamination petitions received

The [Trademark Modernization Act](#) created two new mechanisms, ex parte expungement and reexamination proceedings, to challenge registrations for nonuse. On December 21, 2021, the United States Patent and Trademark Office (USPTO) received the first petition for expungement. Below are the registrations in which either a petition for expungement or reexamination was submitted.

Registration number	Trademark	Type of petition	Filing date
5121361	AIR TAGGING	Expungement	2/28/2022
4623139	LIV	Expungement	2/25/2022
5484079	SOLOPLAY	Expungement	2/25/2022
6592598	LIV	Reexamination	2/25/2022
5690879	JOVIKIDS	Reexamination	2/24/2022
5874588	BLAK MARK-IT	Reexamination	2/21/2022
5248925	GOLO SUPERFUEL	Reexamination	2/19/2022
5527146	Misc. Design	Expungement	2/16/2022
6072800	FRESH BROS	Reexamination	2/16/2022
5023638	ZAKI & Design	Expungement	2/15/2022
5023639	ZAKI	Expungement	2/15/2022
5016222	STRAIGHTSHEEP	Expungement	2/14/2022

Demo of new database

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Expungement/Reexamination Proceedings

10 Results found Page updated: Feb 25, 2022 01:32 AM E

	Trademark	Registration Number	Registrant Name	Date	Proceeding Type	Document Type	
+		5939922	Toucan Toco - Guided Analytics	9/3/2020	Expungement	Notice of Institution-Notice 	
+		5939933	DreamWorks Animation	10/6/2020	Reexamination	Notice of Institution/Non-Final Action	
+		5939987	AXSMARINE	9/3/2020	Expungement	Notice of Submission of E/R Petition Registrant's Email-Notice	
+	OPEN LIBERTY	5939345	International Business Machines Corporat...	10/6/2020	Reexamination	Petition for Expungement/ReExam form	
+		5939777	HARIBO Holding GmbH & Co. KG	9/3/2020	Expungement	Notice of Submission of E/R Petition Registrant's Email-Notice 	
+		5939652	HERUTU ELECTRONICS CORPORATION	10/6/2020	Reexamination	Petition for Expungement/ReExam form	

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Trademark Modernization Act (TMA)

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USPTO implements the Trademark Modernization Act

Regulations implementing the [Trademark Modernization Act of 2020](#) (TMA) went into effect on December 18, 2021. Individuals, businesses, and the United States Patent and Trademark Office (USPTO) now have new tools to clear away unused registered trademarks from the federal trademark register and the USPTO has the ability to move applications through the registration process more efficiently.

Read the [final rule](#) to learn more about these changes. A summary of the new features is provided below.

New procedures

Two ex parte proceedings to cancel unused registered trademarks

The new ex parte expungement and reexamination proceedings provide a faster, more efficient, and less expensive alternative to a contested inter partes cancellation proceeding at the Trademark Trial and Appeal Board (TTAB).

Expungement proceeding

Any party may request cancellation of some or all of the goods or services in a registration because the registrant never [used the trademark in commerce](#) with those goods or services.

Time limit. This proceeding must be requested between three and ten years after the registration date. Until December 27, 2023, however, a proceeding may be requested for any registration at least three years old, regardless of the ten-year limit.

Reexamination proceeding

Any party may request cancellation of some or all of the goods or services in a use-based registration on the basis that the trademark was not in [use in commerce](#) with those goods or services on or before a particular relevant date.

- When the underlying application was initially filed based on use of the trademark in commerce, the relevant

Expand all | Collapse all

- > Who can request expungement or reexamination
- > How to request institution of proceedings
- > How a decision to institute is reached
- > What happens during a proceeding
- > Actions the USPTO Director may take
- > Preventing abuse
- > Limitations of proceedings
- > Best practices
- > Tip for trademark registrants

New!



Common mistakes

Common petition mistakes

- Provides no index of evidence that explains for which good or service each piece of evidence is relevant
- Screen capture is too small
- Provides no URLs or they are too small to read
- Explains scope of investigation but provides no documentary evidence
- Provides testimonial evidence of investigation but no documentary evidence to corroborate

Common evidentiary mistakes

- Provides evidence of one fake specimen to challenge entire class
- Provides only current evidence of nonuse to challenge past nonuse
- References other registration records but does not include relevant portions
- Provides entire records of other filings/proceedings and not simply the relevant portions





Reasonable investigation

Element of a complete petition

- Considered as part of the analysis in whether a prima facie case is made

Must be comprehensive

- Is it likely to find nonuse of the type of goods or services challenged?
- Consider using Archive.org (WayBack machine) for evidence of past nonuse
- For design only marks, do a reverse image search
- Examiners will consider the nature of the investigation when weighing evidence



Documentary evidence of nonuse

Current nonuse is not enough

- Prima facie case requires evidence of nonuse “as of the relevant date”
- But examiners will consider it as a factor

Original specimens

- Evidence the original specimen is fake or digitally altered may establish prima facie case of nonuse for the goods or services for which the specimen was offered

Additional evidence needed to challenge entire class

- E.g., current nonuse
- No internet presence for owner, distributor, or goods/services
- No U.S. presence for owner or distributor



Documentary evidence of nonuse

Avoid extraneous evidence

- No data dumps
- Provide the portion of the document/evidence that is relevant
- You can rely on the record of another registration of the registrant, but simply providing the registration number or the TSDR entry does not tell examiner what is relevant to nonuse challenge
- Examiner has discretion whether to review that non-specific evidence and how to weigh that evidence



Institution determination

Notice of institution

- Identifies the goods/services for which the prima facie case was established
- Includes office action

Office action

- Directs registrant to provide proof of use as of the relevant date for the identified goods/services within 3 months from the office action
- For Section 44 or 66 registrants, advises that excusable nonuse may be claimed if the registrant meets the statutory requirements



Institution determination

Notice of non-institution

- Indicates that a prima facie case was not established for any of the challenged goods/services

Non-reviewable

- Do not expect a lot of detail about why your evidence failed to establish a prima facie case
- Examiner will not issue a 30 day letter to perfect a deficient petition if the examiner is not instituting



Director-initiated proceedings

Notice of institution

- Indicates if proceeding is director-initiated
- Includes evidence of prima facie case
- If instituted on same registration as ongoing petition-initiated proceeding
 - examiner will consolidate examination and
 - align response due dates where possible

Do not rely on the Director to institute proceedings

- Resources may be unavailable as number of proceedings increase

No consolidation of Petition and Director proceedings yet...

- Nonetheless, same examiner handles both
- We need an IT fix to reset and consolidate response period dates





Suspensions

Civil litigation

- Examiner may suspend TMA proceedings, upon request and if otherwise appropriate if litigation relevant to the registration is ongoing

Trademark Trial and Appeal Board (TTAB)

- TTAB and TMA examiners consult to determine suspensions

Examination

- Examining attorneys and post-registration staff may suspend, on their own initiative or upon request, examination while relevant TMA proceedings are ongoing, if otherwise appropriate



Section 7 Request for amendment

Narrow identification (ID) of goods or services

- Registrant may file a Section 7 request to narrow ID in response to office action
- Registrant must inform examiner so that examiner can request Post-Registration to expedite review



Deleting goods or services

Section 7 Request

- Registrant can delete unused goods and services at any time by filing a Section 7 Request to delete

Office action response

- Registrant can delete the challenged goods and services once the proceeding has been instituted by submitting a response to the office action and requesting deletion of the challenged goods/services

Non-response

- If the registrant fails to respond to the office action, the challenged goods and services will be cancelled

Maintenance examination

- If the registrant deletes goods or services in any of the above ways while the registration is subject to maintenance examination in post-registration, the registrant must pay the \$250 deletion fee
- Failure to pay the deletion fee will result in cancellation of the entire registration





Unexpected uses of proceedings

Interstate Commerce

- Petition alleges that the mark was not in use in interstate commerce

Original specimens don't establish use of the mark on the goods/services in the registration

- If the specimens are not fake/digitally altered but don't establish use in commerce of the identified goods/services, that may establish a prima facie case of nonuse
- E.g., specimens don't support the ID or evidence submitted shows original specimen contains website that did not and does not exist

