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# Implementation of the Trademark Modernization Act of 2020 by the USPTO Ushers in New Procedures that Aim to Remove Unused Trademarks from the Register

By [Allison Strickland Ricketts](#)

The Trademark Modernization Act (“TMA” or “Act”) enacted new expungement, reexamination and cancellation proceedings that can be deployed for the purpose of cancelling, in whole or in part, registrations for trademarks that are not in use for some or all of the goods and services in a registration: [More](#)

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- A new ground for cancellation under 15 USC § 14(6) provides for cancellation in whole or in part based on a finding that the mark has never been used in commerce with some or all of the products and services covered by the registration. This differs from the existing “abandonment” claim under 14(3) since intention to resume or commence use is not relevant. As with all cancellation proceedings, the petitioner must show that it is entitled to a statutory cause of action for cancellation

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due to a reasonable belief in damage proximately caused by the continued registration of the mark (a concept formerly known as “standing”).

- A petition seeking “expungement” of a registration can be filed by anyone on the basis that the mark has never been used in commerce with any product or service covered by the registration.
- A petition seeking “reexamination” of a registration can be filed by anyone on the basis that the mark was not in use in commerce on a date when the applicant claimed that it was.

Due to treaty obligations, the Act allows owners of trademarks registered on the basis of the applicant’s ownership of a home country registration (*Section 44(e)*) or ownership of an International Registration extended to the U.S. (*Section 66(a)*) to maintain their registrations regardless of nonuse, if they can show special circumstances that excuse such nonuse. This may undercut the effectiveness of the new expungement procedure and new non-use ground for cancellation.

The petitions for expungement and reexamination can be filed by anyone, and the identity of the real party in interest need not be disclosed. These petitions must be supported by a verified statement that sets forth the elements of the reasonable investigation that the petitioner conducted to determine that the mark was never used in commerce (for expungement) or was not in use in commerce as of the relevant date (for reexamination petitions). The verified statement must specifically describe the sources searched, how and when the searches were conducted, and what information and evidence, if any, the searches produced. What constitutes a reasonable investigation is a case-by-case determination. Documentary evidence of non-use must be presented in an itemized index. If the Director determines that the petition establishes a prima facie case of non-use for the relevant goods and/or services, the Trademark Office will institute the proceeding and issue an Office action requiring the registrant to provide evidence of use. Once instituted, the petitioner no longer has a role in the proceeding, so its financial investment is limited to conducting the reasonable investigation and preparing/filing the petition.

The chart below compares a number of features of the various proceedings now available for the purpose of reducing the number of unused trademarks on the register.

[Download chart](#)

## **Primary Contacts**

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