
New Legislation: Trademark Expungement and Reexamination Proceedings

By Roxana Monemdjou

On December 27, 2020, the United States enacted the Trademark Modernization Act (TMA) of 2020. The TMA, which will be implemented by December 27, 2021, aims to remove unused marks from the U.S. federal trademark register. In turn, the improved accuracy of the register will enable businesses to make more informed decisions regarding the adoption and enforcement of their marks. [More](#)

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In the current landscape, foreign applicants are able to register marks on the basis of a home-country registration or an extension of protection under the Madrid Protocol without having to first demonstrate use of the subject marks in U.S. commerce. There has also been a flood of use-based applications, mainly by foreign individuals and entities, accompanied by digitally-altered specimens where the “mark” has been applied to images of third-party products found on the Internet, or the specimens consist of homemade labels affixed to household products. With thousands of marks being registered through these avenues every year, the federal register has become crowded with marks that are not actually used in U.S. commerce. Removing these marks from the register is currently a time- and money-consuming endeavor.

In order to provide plaintiffs with a simpler method to remove marks from the register that are not in use in U.S. commerce, the TMA introduces two *ex parte* post-registration proceedings: expungement and

reexamination. Any person may file a petition requesting that the USPTO institute a proceeding to expunge a registration for a mark that has never been used in commerce, or reexamine a registration for a mark that was not used in commerce as of a particular relevant date.

Expungement Proceedings

This type of proceeding appears to be directed at marks registered based on home-country registrations or extensions of protection under the Madrid Protocol that have never in fact been used in U.S. commerce. These proceedings may also provide a means to expunge registrations that issued based on claims of use in commerce supported by fake specimens.

Any person can bring an expungement proceeding by filing a petition with the USPTO, which alleges that a registered mark has never been used for all or some of the registered goods and/or services. The petition must include a statement that the petitioner has conducted reasonable investigation into whether the subject mark has ever been used. But what will constitute “reasonable investigation” has not yet been defined. An expungement proceeding may be brought three years after a registration date, but no later than 10 years after that date.

Reexamination Proceedings

Reexamination proceedings will be available in cases where a mark was not in use in U.S. commerce on the date on which the applicant claimed the mark was in use, even if it was used thereafter. These proceedings might also be an appropriate means to address cases in which a fake specimen was submitted during examination.

Any person can file a petition to institute a reexamination proceeding, which alleges that a registered mark was not in use in commerce for all or some of the registered goods and/or services on or before a particular relevant date. Relevant dates include, for example, application filing dates and stated dates of first use. A reexamination proceeding must be brought within the first five years after a registration date. Similar to expungement proceedings, a party who brings a reexamination proceeding must file a petition with the USPTO and state that they have conducted reasonable investigation into whether the subject mark has been used.

Conduct of Both Proceedings

For both proceedings, if the USPTO determines that the petitioner has established a prima facie case that the registered mark was never used in commerce, or was not in use in commerce as of the relevant date, it will (1) grant the petition; (2) institute the proceeding; and (3) notify the registrant, who will then have an opportunity to respond with evidence of use in commerce or excusable nonuse.

Based on the evidence produced by the petitioner and, if applicable, the registrant, the USPTO has the discretion to cancel a registration for some or all of the goods and/or services. The registrant may appeal this decision to the Trademark Trial and Appeal Board and, if necessary, to the U.S. Court of Appeals for the Federal Circuit. If the USPTO determines that the subject mark has in fact been used for some or all of the goods and/or services, a petitioner cannot further challenge those same goods and/or services or bring a new proceeding against those same goods and/or services.

The USPTO can also initiate either of these proceedings upon information that establishes a prima facie case that a registered mark has never been used in commerce or has not been used in commerce as of a particular relevant date for some or all of the registered goods and/or services.

Although enacted, the TMA has not yet been finalized. The USPTO will draft and finalize detailed regulations implementing these new proceedings, with implementation to take effect by December 27, 2021. Trademark owners who do not engage in deceitful practices are hopeful that the new regulations will provide efficient means for clearing deadwood from the register without imposing burdensome evidentiary requirements for defending a registration.

Further information about the TMA and these proceedings can be found on the USPTO's [website](#).