

Publications

New Year, New USPTO: Petitions for Challenging Unused Marks Under TMA Accepted Starting December 27, 2021

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On Wednesday, November 17, 2021, the U.S. Patent and Trademark Office published its final rule for new procedures allowing third parties to challenge unused trademark registrations. The rule enacts changes in trademark law embodied in the Trademark Modernization Act (TMA) that went into force in December, 2020.

Most notable are two new ex parte procedures that parties may use to challenge unused, abandoned, or over-broad registered marks: expungement and reexamination. Any third party may file a petition for either type of challenge, and the identity of the real party in interest is not required, although the Director retains discretion to require identification to prevent abusive filings. There is also no limit to the number of petitions that may be filed against a registration, at least for the time being. The USPTO announced that it would begin accepting petitions for expungement and reexamination on December 27, 2021.

Expungement

An “Expungement” proceeding may be used to challenge a registered mark that has never been used in commerce or never used in connection with at least some of the goods and/or services cited in the registration. This procedure is best for clearing out over-broad marks that claim a wide range of goods and services that are not actually being offered under the mark.

Timing

An expungement proceeding may be instituted between 3 and 10 years following the date of registration. However, the TMA provides that a petitioner may request an expungement proceeding for a registration that is at least 3 years old, regardless of the 10 year limit, until December 27, 2023 (3 years from the TMA's enactment date)

Petition Requirements

The petition must allege that the relevant registered trademark has never been used in commerce or in connection with some or all of the goods and/or services listed in the registration.

Petition Fee

\$400 per class

Other requirements

Petitions must be made in writing, filed through the USPTO's Trademark Electronic Application System, and must include a verified statement that sets forth the elements of the reasonable investigation the petitioner conducts to determine that the mark was never used in commerce.

Reexamination

A party may use a "Reexamination" proceeding to assert that a targeted mark was not actually in use in commerce on or in connection with the goods or services recited in the application at the time of filing (for a use-based application), or at the time of filing for an amendment to allege use or by the end of the statutory period of time set for filing a statement of use (for an intent-to-use-based application). Reexamination proceedings are best for attacking registrations obtained using a questionable specimen of use or for marks registered for too broad a set of goods or services.

Timing

A reexamination proceeding may be instituted during the first 5 years following the date of registration.

Petition Requirements

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 services listed in the registration on or before any of the following dates:

- 1) the filing date of a use-based application;
- 2) the filing date for an amendment to allege use; or
- 3) the end of the period of time set for filing a statement for use.

Petition Fee

\$400 per class

Other requirements

Petitions must be made in writing, filed through the USPTO's Trademark Electronic Application System, and must include a verified statement that sets forth the elements of the reasonable investigation the petitioner conducts to determine that the mark was not in use in commerce as of the relevant date on or

in connection with the goods and services identified in the petition.

TAKEAWAY

Because these proceedings may be instituted through the Trademark Office at a fee of only \$400 per class, they will be much cheaper than traditional cancellation proceedings, formerly the only way to challenge an unused, registered mark. This, along with the fact that interested parties do not have to identify themselves, will incentivize third parties to challenge overbroad and unused deadwood marks currently cluttering the register. Trademark applicants and registrants must be aware that any overbroad or unused mark will now be much more vulnerable. Further, trademark registrants should retain all information and evidence of proper use of their trademarks to rely on in the event of a use-based challenge.

Our attorneys are available to review US trademark portfolios and strategize ways to prepare for and/or mitigate risk presented by these new proceedings.