

New Year, New Trademark Law – Petitions for Expungement and Reexamination of Trademark Registrations

January 14, 2022
By Laura J. Winston

Petitions for Expungement and Reexamination of Trademark Registrations

The Trademark Modernization Act took effect on December 18, 2021, and now it is easier and less expensive to cancel unused registered trademarks. Any party can bring an *expungement* or *reexamination* proceeding to remove a trademark from the register. An **expungement proceeding** is when a party believes that a **trademark has never been used in commerce**. The proceeding must be brought when the registration is between 3 and 10 years old (although until December 27, 2023, the proceeding can be brought against any registration more than three years old). A **reexamination proceeding** is for when a party believes that a **trademark was not in use at the time an application based on use was filed or when use is claimed in an application originally based on intent to use**. The proceeding must be brought before the 5th anniversary of the registration. Below are answers to questions some may have about these new proceedings.

1. How do expungement and reexamination differ from a trademark cancellation action?

These new, simplified proceedings will be brought before Trademark Examining Attorneys instead of the judges of the Trademark Trial and Appeal Board. A cancellation action, which is similar to a lawsuit in federal court, has discovery, a trial, and the possibility of motions. Expungement and reexamination will be much more streamlined – the petitioner files a petition setting forth the information to demonstrate non-use. The registrant then has the opportunity to file a response including evidence of use or excusable non-use. The Examining Attorney then reaches a decision based on the petition and response. If the Examining Attorney orders that the registration be canceled, the registrant has the opportunity to file a request for reconsideration and appeal.

The costs for expungement and reexamination will be considerably lower than a start-to-finish cancellation proceeding. The filing fee for expungement or re-exam is \$400 per class of goods or services, which is less than the \$600/class fee for a cancellation action. More significantly, the legal costs for handling the proceeding will be significantly less than for a cancellation action.

2. If there's no discovery, how does the petitioner show that the mark was not used?

The petitioner is required to submit the results of a "reasonable investigation." This will vary based on the goods or services, relevant industry and customary channels of trade for the goods or services. Generally speaking, a thorough use investigation conducted by an experienced private investigator will likely be appropriate.

3. Why would I want to file a petition for expungement or reexamination of a third party's registration?

There are various reasons to file for expungement or reexamination, but the most common reason is likely to be that a party wants to adopt a new trademark that cannot be registered because of prior registration.

4. How can I avoid a petition for expungement or reexamination being filed against a trademark registration I own?

If you are selling the goods or rendering the services covered by your trademark, it is unlikely that someone will file a petition for expungement or reexamination against your registration. It will be helpful to make sure that you are actively demonstrating your use and showing your products and services on your website and on social media as may be appropriate for your business and industry. If you have any questions about the use of your trademarks, please feel free to contact me.

5. I was able to get my registration without using the trademark. Can someone petition for expungement or reexamination against my registration?

Trademark owners from most countries outside of the US can register trademarks in the US if they are registered in the owner's home country. If this is your situation, your registration will be vulnerable to an expungement proceeding after three years (and before ten years) if it has never been used. The best way to avoid expungement will be to sell your goods or render your services in the US.

Need assistance in navigating the new expungement and reexamination proceedings or guidance on protecting, enforcing or defending trademarks pursuant to these amendments? Please contact Laura Winston at lwinston@offitkurman.com or 347-589-8536.