

Final Rules for Trademark Modernization Act in Effect This Weekend – New Nonuse Procedures Available and Shortened Office Action Deadlines on the Horizon

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by Evan Everist



Attention trademark practitioners: the finalized rules implementing the 2020 Trademark Modernization Act (“TMA”) go into effect this weekend, on December 18, 2021. Significantly, this marks the availability of three new mechanisms for eliminating “deadwood” registrations: petitions for reexamination, petitions for expungement, and a new nonuse (expungement) cancellation ground. We previously wrote in detail about these three changes here. The PTO will begin accepting petitions for reexamination and expungement

starting December 27, 2021, but the new nonuse cancellation ground will presumably be available as of the 18th. The chart below compares these new procedures.

Starting in about a year (on December 1, 2022), the office action response period for most trademark applications will shrink to three months from the current six-month response period. But a three-month extension may be requested for a fee of \$125, and the response period for Madrid Protocol applications will remain six months.

The TMCA will continue to monitor and provide updates on the impacts of the TMA.

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	Expungement Petition	Reexamination Petition	New Nonuse (Expungement) Ground for Cancellation
For What?	Mark <u>never</u> used with some or all registered goods/services	Mark not used with some or all registered goods/services <u>on or before the "relevant date"</u> (i.e., on the filing date for use-based applications or AAU date for intent-to-use applications)	Mark <u>never</u> used with some or all registered goods/services
When?	Between 3-10 years after registration (or until 12/27/23 for <u>any</u> registration at least 3 years old)	Within 5 years of registration, unless on Supplemental Register (then available at any time)	Any time after 3 years of registration
Who?	Anyone, including the USPTO Director • no apparent standing requirement • no requirement to name real party in interest and may file in attorney's name; but Director may require information on real party in particular cases • Only one petition can be filed against a given good/service in a registration; multiple challenges not permitted even by different parties, but TTAB cancellation still available		Anyone with standing
How?	Submit a petition to the USPTO Director including: • A verified statement establishing a reasonable investigation and including a concise statement of facts • Evidence supporting a prima facie case of nonuse in commerce ("a reasonable predicate") • \$400 fee per class		File a petition to cancel with the TTAB
Foreign Registrations?	Yes, but for registrations based solely on foreign registrations or Madrid Protocol a registrant may offer evidence of special circumstances that provide a basis for excusable nonuse	No, not available for registrations based solely on foreign registrations or Madrid Protocol	Presumably yes
Basic Procedure?	• Petition filed with USPTO Director • Director reviews and, if prima facie case established, institutes proceeding • Examiner issues office action, to which registrant has 3 months to respond (can be extended 1 month with \$125 fee) • If registrant responds, examiner makes determination; if no response, cancellation order issued • If examiner issues cancellation order, request for reconsideration or appeal to TTAB available to registrant; no appeal available to petitioner		"Normal" cancellation procedure appears to apply