

## IP Frontiers: Checking in on expungement and reexamination: Early common pitfalls

■ THOMAS SICA SPECIAL TO THE DAILY RECORD



Thomas Sica

Since Dec. 18, the United States Patent and Trademark Office has accepted two new types of ex parte proceedings to be filed for trademark purposes: expungement and reexamination.

When these new proceedings were first proposed and announced, many practitioners were curious about how effective these would be in practice. Now, a few months have passed since commencement of these proceedings; thus, we have an early look at how these are being handled by the USPTO.

To start: what is expungement and reexamination? The Trademark Office has long recognized that many registered trademarks are unfortunately not actually being used in commerce. Before the Trademark Office registers any mark, the trademark applicant must provide a specimen (i.e., an example) that the mark is being used in commerce on the goods and/or services that are listed in the application. While the specimen process is intended to weed out any marks that are not actually being used, several marks still slip

through the cracks through the use of fraudulent specimens.

The USPTO intended expungement and reexamination proceedings to act as a new way to remove fraudulently obtained trademark registrations from the rolls of the Trademark Office. Both proceedings commence with a petition to the Director of Trademarks claiming that an existing registration should be cancelled, in whole or in part. For an expungement proceeding, the basis for the petition is that the registered trademark was never used in commerce by the registrant for all or some of the identified goods and/or services listed in the registration. For reexamination proceedings, the basis for the petition is that the registered trademark was not in use in commerce in connection with some or all of the goods and/or services listed in the registration at the time use was alleged (i.e., at the time the application was filed in a use-based application, or at the time the statement of use was filed in an intent-to-use application).

Both petitions must contain certain items such as a required fee, the basis for the petition, the name and address of the petitioner, and the specific goods and/or services that the petitioner chal-

lenges. Additionally, the petition for expungement or reexamination must further include a verified statement from the petitioner outlining the investigation conducted along with the petitioner's basis for its belief that the trademark was not in use in commerce as of the relevant date and supporting documentary evidence.

However, the proceeding will not be instituted automatically. Once the petition is submitted, the Director of Trademarks must determine whether to institute the expungement or reexamination proceeding. If the director determines that the petitioner made a prima facie case that the mark was not used at the relevant time, then the director will institute the proceeding and issue an office action to the registrant. After which, the registrant will have an opportunity to respond, similar to how preregistration office actions are handled at the Trademark Office.

The USPTO, on their website at <https://www.uspto.gov/trademarks/apply/expungement-and-reexamination-petitions-received>, has been keeping a list of expungement and reexamination proceedings filed at the office. Between Dec. 21 and April 2, 64 petitions for expungement or reexamination have been filed.

As this process is still new, none of these actions have proceeded far enough yet to actually remove any trademark registrations from the rolls. But the director has made a decision on whether to institute 29 of these petitions thus far. To break it down, the director has issued institution orders for 10 expungement proceedings and six reexamination proceedings, but the director declined to institute seven expungement proceedings and six reexamination proceedings. That means that petitioners are thus far only 55% successful on getting the proceedings instituted. The director has not been rubber-stamping these petitions; the petitioner truly must make out a prima facie case that the trademark was not being used in order for the proceeding to even reach the registrant.

Among the failed petitions, there exists some commonality in the reasons that the director has declined to institute the expungement or reexamination proceeding. In other words, many petitioners are running into the same issues. Thus, here are three common pitfalls that petitioners are facing in attempting to institute these *ex parte* proceedings:

**No Index of Evidence.** One of the many requirements for a petition for expungement or reexamination is a “clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence.” 37 C.F.R. §2.91(c)(9). While most petitioners thus far have submitted documentary evidence, many have neglected to provide an itemized index of that evidence. The index of evidence acts similar to a table of

contents; it exists as a way for the director to easily navigate through the evidence provided. The itemized index is relatively simple but must not be forgotten when preparing these petitions.

**Insufficient Investigations.** “A petitioner must make a bona fide attempt to determine if the registered mark was not in use in commerce or never in use in commerce on or in connection with the goods and/or services ... by conducting a reasonable investigation.” 37 C.F.R. §2.91(d). Thus far, many petitions have been rejected based upon the director’s determination that the petitioner’s investigation was not reasonable or comprehensive enough. Some petitions have only submitted testimonial evidence rather than documentary evidence; other petitions have merely submitted screenshots of the registrant’s webpages in order to establish non-use. These types of evidence alone will not establish a prima facie case for non-use sufficient to institute an expungement or reexamination proceeding. More evidence is required such as State and Federal trademark records, website evidence outside of the registrant’s website, or attempts to contact the registrant or purchase the relevant goods and/or services, among other acceptable evidence. The evidence must be enough to establish a prima facie case that the mark was not used at the relevant time; a comprehensive investigation is necessary.

**Evidence not Tailored to the Relevant Date.** Neither expungement nor reexamination proceedings are concerned merely with the current use, or non-use, of the trademark at issue. A petition for expungement asserts that the trademark

has never been used in commerce; a petition for reexamination asserts that the trademark was not used as of the date that the registrant alleged use to the Trademark Office. Thus far, some petitioners have failed to submit evidence showing that the mark was not in use as of the relevant date. Petitioners must not only submit evidence about the current non-use of the trademark, but must submit evidence that the mark was not used at any time (in an expungement proceeding) or at the time that use was alleged (in a reexamination proceeding). The mere submission of recent evidence of non-use will not establish a prima facie case for expungement or reexamination, and the proceeding will not be instituted.

While expungement and reexamination proceedings may still be more convenient for petitioners than attempting to cancel a trademark at the Trademark Trial and Appeals Board, potential petitioners still must make a significant effort to follow the instructions provided by the USPTO, conduct a reasonable investigation and provide sufficient evidence in order for the director to institute the proceeding. We now know that merely instituting expungement or reexamination proceedings may be a significant hurdle to overcome; it still remains to be seen how successful these petitions will be once they are instituted.

*Thomas Sica is an associate with the law firm of Heslin Rothenberg Farley & Mesiti P.C. His experience includes litigation work, trademark prosecution, and general IP counseling. He can be reached at (518) 452-5600 or [thomas.sica@hrfm-law.com](mailto:thomas.sica@hrfm-law.com).*