

---

# The Trademark Modernization Act



Jason Blair – Smith, Gambrell & Russell, LLP  
(Austin, TX)



[jbblair@sgrlaw.com](mailto:jbblair@sgrlaw.com)

<https://www.sgrlaw.com/attorneys/jason-p-blair/>

<https://www.linkedin.com/in/jasonpaulblair/>

*Calendaring Our Future Together.™*





# The Trademark Modernization Act (TMA)



## Who is this guy?

- Native Hoosier
- UCLA Class of 2000
- University of Miami (FL) Law 2003
- USPTO Trademark Examining Attorney, 2005-2018
- Chief Sound and Motion Mark Examining Attorney, 2007-2018
- Joined Fleckman & McGlynn in 2018
- Joined Smith, Gambrell & Russell in March of 2022





# The Trademark Modernization Act (TMA)





# The Trademark Modernization Act (TMA)



## An overview of the TMA

- A history of use requirements in the United States, and an overview of the issues the TMA and other recent USPTO requirements are intended to address
- Attorney licensing and identification requirement for foreign applicants
- Shorter Response Periods for Office Actions (effective December 1, 2022)
- Letters of Protest
- The USPTO's Post Registration Audit Program
- Ex Parte Reexamination Proceedings
- Ex Parte Expungement Proceedings
- Non-Use Cancellations at the Trademark Trial and Appeal Board (TTAB)
- Practical tips for filing applications and maintaining registrations





# The Trademark Modernization Act (TMA)



## Use Requirements in the US – History



### Article I, Section 8 of the United States Constitution:

The Congress shall have the power... to regulate commerce with foreign nations, and among the several states.... and to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

U.S. jurisprudence considered the “authors and inventors” language to give the federal government the ability to issue patents and copyrights, but the power of the federal government to grant trademark rights was not as clear.





# The Trademark Modernization Act (TMA)



## Use Requirements in the US (continued)

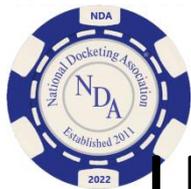
The Congress shall have the power... to regulate commerce with foreign nations, and among the several states....

After the U.S. Civil War, the understanding of the “interstate commerce clause” was expanded, and the federal government began issuing trademarks, but only to brands that could demonstrate they were in use in interstate or international commerce.

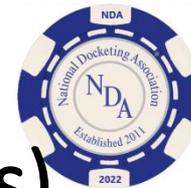
The federal government lacked authority to issue trademark rights to a party who was not operating (or was imminently operating) in commerce between states.

Accordingly, use of the mark in interstate commerce has always been a prerequisite to obtaining trademark rights in the United States. “Defensive” or preemptory trademarks cannot be granted under the U.S. Constitution.





# The Trademark Modernization Act (TMA)



## Use Requirements in the US (differences)



### Advantages of a US-style “First to Use” system:

- Trademark rights come from use, not from registration
- A party cannot obtain trademark rights for goods and services they have no intention of providing
- The trademark register more accurately reflects the real-world marketplace
- Marks that are no longer in use are periodically removed from the register, clearing the way for new companies to put those marks to their own use

### Disadvantages of a US-style “First to Use” system:

- Registrants cannot “overclaim” goods and services that they do not provide, but may be related.
- Trademark rights can be lost for non-use, even if a registration is not due for renewal.
- Proving that the mark is in use in commerce takes extra time and effort
- Prior-existing unregistered users can claim senior rights over a registration holder



# The Trademark Modernization Act (TMA)



## What Problems Led to the TMA?

### Kent Anderson laid the blueprint

- A high school security guard named Kent Anderson filed many trademark applications for FUTURE in every International Class
- Kent's fundraising website claims that he is applying for FUTURE because he wants all people to have a right to have a future
- Claims that big corporations and the US government want to "steal" people's future by giving exclusive rights to the future to big corporations
- Because his applications cover almost every good and service, good faith applicants with FUTURE in their mark get blocked due to Anderson's prior-filed applications



Futurevisionaries.com<sup>SM</sup>

My name is Kent G Anderson I'm the founder /President of FutureVisionaries.com and Global FUTURE Brands ; I want you to know what I've been through and so it may help you . I cant tell you in words how I feel every day I live with this knowing that your ideas your rights to the Brand FUTURE are being taken every day since sept 2004 The Day I was set up In September I Feel like the world Trade Center. Find out how I got destroyed and also how the world I had created got destroyed

Also how an agreement was Hidden for more than 2 Years and the attorney who I trusted Set Me Up ; I would like you to know their names You The people should contact them write to The USPTO.Gov tell them how you feel. I fought for your Global rights and ideas To the Brand FUTURE all I've got is stabbed in the Back and your ideas and mine taken from me . I'm not rich I work a Security job at High school for years ; Nor do I Own a New Car or A Home I live at home. I Cant tell you How much is spend In Time allowances For FUTURE ; So many wanting me to Fail So they will get your ideas and Global rights along with Mine ; I Don't Like monopolies ; No press will even do a story on me ;ABC;NBC;CBS;and talk Shows ;Tabloids; None Does any attorney want to represent me in Federal Court Because I don't have the money . I have tried I called nonprofit ; Pro bono; VC ; Angel investors ; Its like you have to live in there city to even get funded ; And they only fund you if your making money How can I ; Your and my world is being attacked and our own ideas are being used against us ; Like you to See PEP BOYS Only has a Tire wheel cover and Hub Caps for FUTURA ; pep boys sued Ford Motor Over the Name FUTURA for a modal of a Car ; I Question Why Ford Didn't even fight the Judges Judgment ? I question Why That the USPTO Allowed pep boys to file against our ideas I say its our ideas Because i was going to let all people and all countries benefit by the Brand For there own ideas ; By the way PEP BOYS 17 Objections vs me For 4 Years are in the discovery Stage need people who cares as I Do ; I need help now funding ; I'm not going to give up on the people and there ideas I Hope daily that I will find a philanthropy ; All I'm finding out that Regardless of your prior pend ideas and Rights ; in countries people lawyers companies will file after you wait . Attack you ; File objections Vs You ; I have been Fighting a war For 7 Years ; even with the trademark office I Challenged them and the way companies have and get monopolies ;



# The Trademark Modernization Act (TMA)



## What Problems Led to the TMA? (cont.)

### Others began to follow

- Over the past several years, the number of strange trademark applications at the USPTO has skyrocketed
- While not exclusively, most of these strange applications have originated from overseas applicants
- Traditionally, the USPTO did not heavily scrutinize specimens of use
- In the event a good-faith filer was blocked from registration due to a mark with a questionable specimen, the only course of action was to file a full-fledged cancellation proceeding with the Trademark Trial and Appeal Board (TTAB)
- A full cancellation proceeding is very time consuming and expensive

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	JPJLCN
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	JPJLCN
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Feng Jian
INTERNAL ADDRESS	740 Daba Road, Gaoshan Town,
*MAILING ADDRESS	Xianfeng County,
*CITY	Hubei Province
*COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	China
*ZIP/POSTAL CODE (Required for U.S. and certain international addresses)	445600





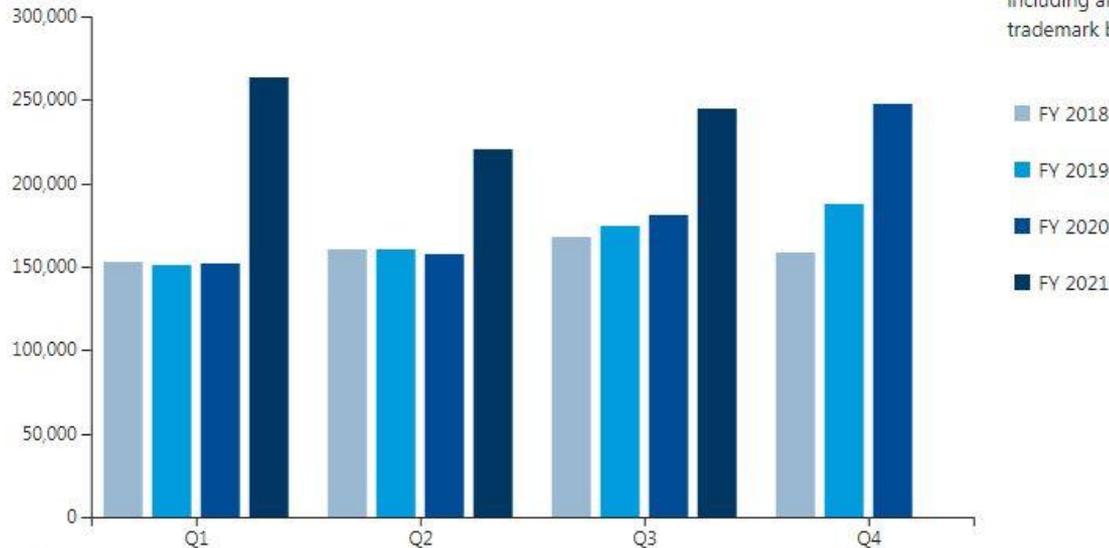
# The Trademark Modernization Act (TMA)



## What Problems Led to the TMA? (cont.)

FILINGS ARE THROUGH THE ROOF!

Application Filings (classes)





# The Trademark Modernization Act (TMA)

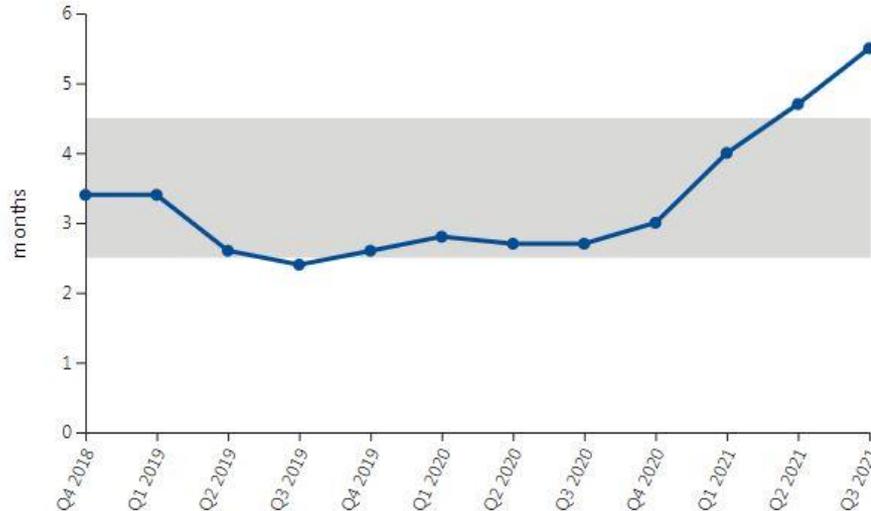


## How is this affecting TM registration?

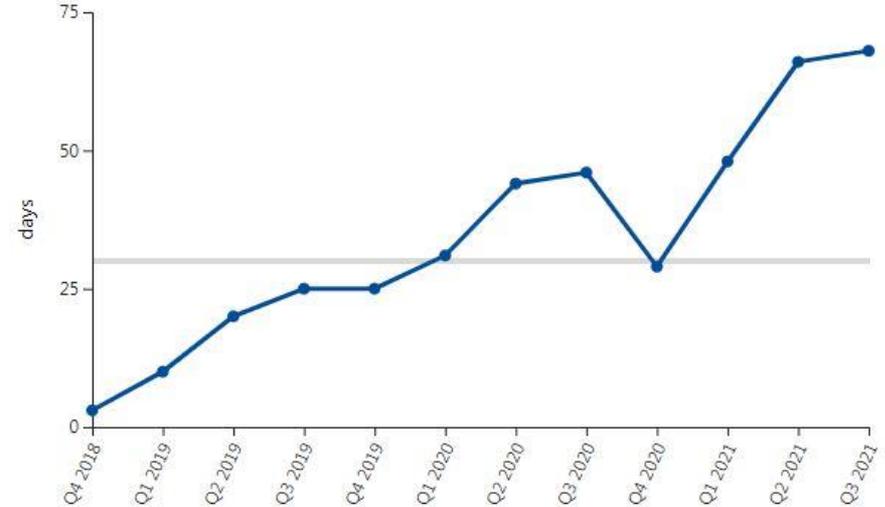
Instead of 3 months, it is now taking **10+ months** to have a new application examined.

This means U.S. applicants may not know if their mark is approved before having to decide on filing foreign applications under the Paris Convention

First Action Pendency, Last Three Years



Post Registration Renewal Pendency (days), Last Three Years





# The Trademark Modernization Act (TMA)

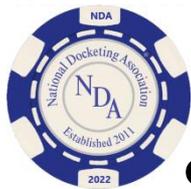


## Some examples of problematic registrations



Actual specimen on record (left) vs. image found on Google Image Search (right)





# The Trademark Modernization Act (TMA)



## Some examples of problematic registrations



Input Field	Entered
<b>TEAS Plus</b>	<b>YES</b>
<b>MARK INFORMATION</b>	
*MARK	<a href="#">TTOOHHHJDD</a>
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	TTOOHHHJDD
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	Shenzhen Keterui Business Technology Co., Ltd.
INTERNAL ADDRESS	Rm.1105,Jiye Bldg.,No.21,Zhongxin Rd.
*MAILING ADDRESS	Nansan Community,Buji St.,Longgang Dist.
*CITY	Shenzhen City
*COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	China
*ZIP/POSTAL CODE (Required for U.S. and certain international addresses)	518000



# The Trademark Modernization Act (TMA)



## Some examples of problematic registrations

Amazon Fashion

Women Men Kids Luggage Sales & Deals New Arrivals Our Brands prime try before you buy

Portable Laptop Monitor Touchscreen 15.6" INNOCN 1080P... ★★★★☆ 92 \$212.49 prime

Clothing, Shoes & Jewelry · Novelty & More · Clothing · Novelty · Men · Shirts · Button-Down Shirts

Brand: ZXCVB  
ZXCVB Baseball Button Down Jersey Hipster Hip Hop Short Sleeves

Price: \$55.99  
& Free Returns on some sizes and colors

Size: Select

Color: Black

- 100% Polyester
- Button closure
- 100% Polyester, Baseball Jerseys Are Crafted From Lightweight Material
- Baseball Button Down Jersey Shirts Are Perfect For School Uniforms, Party, Hip Hop Performance

To buy, select Add to Cart

Add to List

Share ✉ f t p

5% off coupon

Custom Baseball Jersey Stitched Personalized Baseball Shirts...  
\$19.99

EMIRISTIC "Good Luck" Elephant Necklace for Women with Birthstone Zirconia, Birthday...  
prime

Smith Gambrell Russell

Mark: ZXCVB

Clicking on "Add to Cart" reveals item out of stock/not available for shipping





# The Trademark Modernization Act (TMA)



## Steps the USPTO has taken prior to the TMA

- Foreign domiciled applicants must be represented by a US attorney
- Applicant must provide URL and date of capture of website specimens, so that the USPTO examiner can visit the site to confirm the website is active, and goods or services can actually be purchased/ordered
- Examiners given authority to scrutinize specimens that appear questionable, and can request additional documentation to prove a mark is actually in use for the goods/services claimed
- Implementation of the Post Registration Audit Program (more on that later)





# The Trademark Modernization Act (TMA)



## Why haven't those steps worked?

### Foreign domiciled applicants must be represented by a US attorney

- Some US licensed attorneys have filed and electronically signed an inordinate number of trademark applications for foreign applicants
- One attorney electronically signed the declaration statement on over 22,000 trademark applications for applicants domiciled in China in a single year! (That's over 60 applications every single day.)
- A person signing the declaration on an application attests to having first-hand knowledge of the facts, and swears to the truthfulness that the mark is in commerce for the goods and services claimed in the application
- The USPTO is investigating these attorneys to determine if they are willing participants, or if their credentials were compromised

United States Patent and Trademark Office  
 Home | Site Index | Search | FAQ | Glossary | Contacts | eBusiness | eBiz alerts | News  
 Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Sat Jan 15 03:32:22 EST 2022

TESS HOME | NEW USER | STRUCTURED | FREE FORM | BROWSE DICT | SEARCH OQ | PREVIOUS LIST | NEXT LIST | IMAGE LIST | BOTTOM

Logout Please logout when you are done to release system resources allocated for you.

Start List At:  OR Jump to record:  22109 Records(s) found

Refine Search  [jonathan g morton[at] and 2020\$[fd]]

Current Search: S10:  [jonathan g morton[at] and 2020\$[fd]] docs: 22109 occ: 44218

Export displayed results (1 ~ 100)

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead	Class(es)
1	90439307		SANHO	TSDR	LIVE	
2	90437770		FARANY	TSDR	LIVE	
3	90436695		QUESAM	TSDR	LIVE	
4	90434574		MESCHETT	TSDR	LIVE	
5	90429597		AZOFAMILY	TSDR	LIVE	
6	90421563		YOYA VALLEY	TSDR	DEAD	
7	90417850		AIEOE	TSDR	DEAD	
8	90417835		AEDGY	TSDR	DEAD	
9	90415043		DOBAOJIA	TSDR	LIVE	
10	90414757		KADIYAGE	TSDR	LIVE	
11	90414380		VIMIV	TSDR	LIVE	
12	90414376		RESOVO	TSDR	LIVE	
13	90414367		DOTDAY	TSDR	LIVE	
14	90413152		DIVAVA	TSDR	LIVE	
15	90413140		CELECONA	TSDR	LIVE	
16	90412801		MANGO	TSDR	DEAD	
17	90412795		SITAMU	TSDR	LIVE	
18	90412524		STARRYLAB	TSDR	DEAD	
19	90411170		COOKYCOO	TSDR	LIVE	
20	90410036		MANGO	TSDR	DEA	
21	90410032		MANGO	TSDR	DEA	
22	90410026		MANGO	TSDR	DEA	





# The Trademark Modernization Act (TMA)



## Why haven't those steps worked?



**Examiners given authority to scrutinize specimens that appear questionable, and can request additional documentation to prove a mark is actually in use for the goods/services claimed**

- It can be difficult for USPTO examiners to determine whether a specimen is legitimate
- Good faith applicants are often getting their specimens rejected for small things like poor lighting in photographs, and even wrinkles in clothing that don't look right to an examiner
- The time and expense locating substitute specimens, and responding to Office Actions can be considerable



# The Trademark Modernization Act (TMA)



## TMI about the TMA!

### MAIN FEATURES OF THE TRADEMARK MODERNIZATION ACT (TMA):

- Attorney/applicant identification verification
- Shorter Response Periods for Office Actions (effective December 1, 2022)
- Letters of Protest
- *Ex Parte* Reexamination Proceedings
- *Ex Parte* Expungement Proceedings
- Streamlined Non-Use Cancellations at the Trademark Trial and Appeal Board (TTAB)



# The Trademark Modernization Act (TMA)



## Attorney/applicant ID verification

- Access to the USPTO's TEAS filing system now requires identity verification.
- U.S. Attorneys, Canadian Trademark Agents, and U.S. Applicants not represented by an attorney must enroll through ID.me.
- Paralegals and legal support staff can be sponsored by a verified attorney.
- Other than Canadian Trademark Agents, foreign individuals, companies, and attorneys will not be allowed to access the USPTO's TEAS filing system
- To be verified, ID.me requires (1) a government-issued photo ID, driver's license or passport, (2) your Social Security number, (3) a biometric face scan (a selfie), and (4) a credit check.
- ID.me stores your personally-identifiable data according to federal privacy standards. The USPTO does not store any data other than the user's name.



Sign in to ID.me

New to ID.me?  
[Create an ID.me account](#)

Email

Password

[Sign in to ID.me](#)



# The Trademark Modernization Act (TMA)



## Practical effects of ID verification



Sign in to ID.me

New to ID.me?  
[Create an ID.me account](#)

Email

Password

[Sign in to ID.me](#)

- Attorneys will be less able to claim that filings done under their name at the USPTO were done by an imposter, or someone who has stolen their credentials.
- Hopefully will cut down on bad faith filings signed by U.S. attorneys.
- Parties (both in the U.S. and internationally) can still access the USPTO's TESS database to search the trademark register without verification.
- Makes it more difficult for unrepresented applicants based on the U.S. to file their own applications. – Possible privacy concerns?
- Increases the time it takes to file applications and documents with the USPTO (likely increasing legal costs).
- Burden of sponsoring paralegals and legal support staff may be disproportionate for large law firms, where attorneys may use multiple paralegals and staff.
- Attorneys will be responsible for any bad acts committed by a sponsored user.



# The Trademark Modernization Act (TMA)



## Shorter Response Deadlines



- EFFECTIVE DECEMBER 1, 2022
- Response deadlines for filing responses to Office Actions shortened from 6 months to 3 months.
- Applicants may obtain a 3-month extension for a \$125 fee. (Only one extension will be granted.)
- Applications filed through the Madrid Protocol are exempt from the shortened timeframe. (Response deadlines remain at 6 months.)

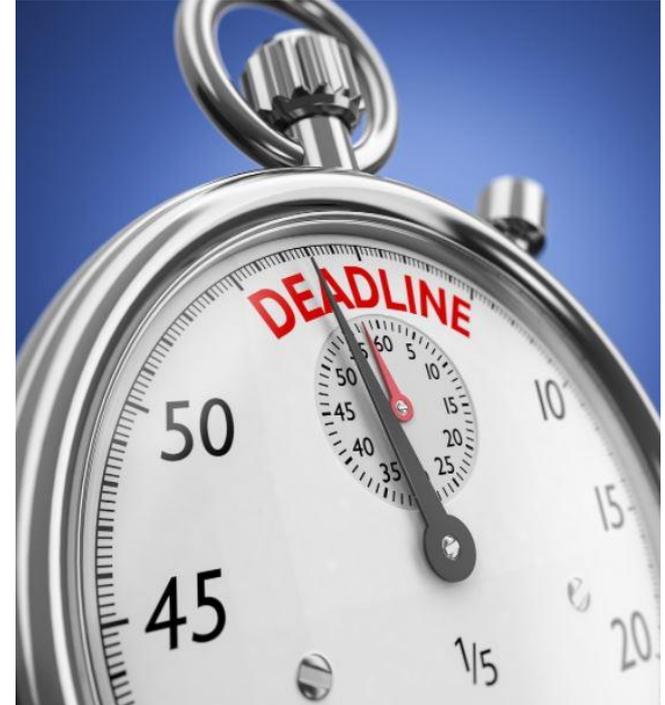


# The Trademark Modernization Act (TMA)



## Practical Effects of Shorter Deadlines

- **EMBRACE THE SHORTER DEADLINE!** – Historically, clients tend to put responses on the “back burner” when an Office Action issues. As practitioners, use the shorter deadline to keep the response strategy a priority.
- **CAREFULLY TIME INTENT-TO-USE APPLICATIONS** – The new deadlines should shorten the length of time between filing an application and receiving a Notice of Allowance. For clients who may need a long lead time to get a product to market (for example, pharmaceuticals that require FDA approval), don’t always count on Office Actions to intentionally lengthen your deadline to market.
- **CLOSELY MONITOR BLOCKING APPLICATIONS** - Although response deadlines have shortened, the USPTO still suspends applications for 6 months when there is a potentially blocking application. If your application is suspended, check on the blocking application after 3 months to see if they filed a response, rather than wait on the USPTO to automatically check in 6 months.





# The Trademark Modernization Act (TMA)



## Letters of Protest – Formalized Process

**uspto** About Us Jobs Contact Us Logout

Trademark Electronic Application System

PTO-2303  
Approved for use through 11/20/2024. OMB 0651-0041  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**Letter of Protest**  
TEAS - Version 8.0

**GENERAL FORM INFORMATION:**

- TIMEOUT WARNING:** You're required to log back in after 30 minutes of [inactivity](#). This ensures the USPTO complies with [mandatory federal information security standards](#) and protects user information. After 25 minutes of inactivity, you will be prompted to continue your session. If you do not continue within 5 minutes, the session will end, you will be logged out of your USPTO gov account, and you will lose any unsaved data in the form. Please have all of your information ready before you start.
- DO NOT USE YOUR BROWSER BACK FORWARD BUTTONS:** Use only the navigation buttons at the bottom of each page.
- TIPS ON USING THIS FORM MOST EFFECTIVELY:** [Click here](#) or on any underlined word for additional information.
- REQUIRED FIELDS:** All have an **ASTERISK (\*)**, and the form will not validate if these fields are not filled-out.

**IMPORTANT:** After this letter of protest is submitted, the USPTO will send a filing receipt to the email address for correspondence provided in the form.

**CONTACT:**  
For general trademark information or help navigating the forms, email [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov), or telephone 1-800-786-9199 (press 1).  
If you need help resolving **technical glitches**, email [TEAS@uspto.gov](mailto:TEAS@uspto.gov). Please include in your email your phone number, serial or registration number, and a screenshot of any error message you may have received.

**FOLLOW THE STEPS BELOW TO ACCESS THE LETTER OF PROTEST FORM:**

**STEP 1: CHECK STATUS.**  
A letter of protest will be considered before publication if the submitted evidence is relevant to the identified ground(s) for refusal, such that it is appropriate for the examining attorney to consider whether to issue a refusal or make a requirement. When a letter of protest is filed on the date of publication or within 30 days after the date of publication, the letter of protest will only be considered if the submitted evidence establishes a prima facie case for refusal on the identified ground(s), such that failure to issue a refusal or make a requirement would likely result in issuance of a registration in violation of the Trademark Act or Rules of Practice. Letters of protest filed more than 30 days after publication are untimely. **Confirm the status of the application** before proceeding. If the application is not in the correct status, you will receive an error message when you click the "Continue" button.

**STEP 2: ENTER THE U.S. APPLICATION SERIAL NUMBER BEING PROTESTED BELOW OR ACCESS PREVIOUSLY FILLED-OUT/SAVED FORM.**

\* Serial Number:  (Do not enter serial number if you are accessing your saved form.)

OR

To upload a previously saved form file, first review the [TEAS Help instructions for accessing previously saved data](#) and then use the "Browse..." button below to access the form file saved on your computer. **WARNING:** Failure to follow the TEAS Help instructions will result in the inability to edit your data.

- Letters of Protest (LOPs) are not new. The TMA merely formalizes aspects that were previously informal.
- Formatted LOP form is now available to use in TEAS.
- LOPs can only be filed against pending applications, and must be accompanied by a \$50 fee.
- Under the TMA, the USPTO has two months to review an LOP in order to determine if it is sufficiently relevant to forward to the examiner for consideration.
- If the Deputy Commissioner determines an LOP should not be considered, the determination is not reviewable.
- LOPs filed after the close of the 30-day opposition period are untimely, and will be rejected.
- Any evidence submitted with an LOP must include an index itemizing the evidence.
- Maximum of 10 items of evidence, totaling no more than 75 pages.



# The Trademark Modernization Act (TMA)



## Practical Tips for Letters of Protest

- **FILE LOPs AS EARLY AS POSSIBLE** - Examiners are reluctant to pull back applications which they have already approved and closed out of their docket.
- **KEEP LOPs AS SHORT AS POSSIBLE** – LOPs are not intended to replace an Opposition or Cancellation proceeding. They are merely intended to highlight possible evidence that an examiner might have missed. If an examiner feels you are trying to overwhelm his/her own judgement, the examiner may not be as sympathetic to your plea.
- **DO NOT CONTACT AN EXAMINER DIRECTLY** – Examination is still an *ex parte* proceeding. Your contact is limited to filing the LOP. Any other contact with an examiner by a non-applicant is not proper under the ethics rules, and could create issues for your client in a subsequent opposition, cancellation, or litigation.

**uspto** About Us Jobs Contact Us Logout

Trademark Electronic Application System

PTO-2303  
Approved for use through 11/30/2024, OMB 0651-0061  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**Letter of Protest**  
TEAS - Version 8.0

**GENERAL FORM INFORMATION:**

- **TIMEOUT WARNING:** You're required to log back in after 30 minutes of inactivity. This ensures the USPTO complies with mandatory federal information security standards and protects user information. After 25 minutes of inactivity, you will be prompted to continue your session. If you do not continue within 5 minutes, the session will end, you will be logged out of your USPTO gov account, and you will lose any unsaved data in the form. Please have all of your information ready before you start.
- **DO NOT USE YOUR BROWSER BACK/FORWARD BUTTONS:** Use only the navigation buttons at the bottom of each page.
- **TIPS ON USING THIS FORM MOST EFFECTIVELY:** Click here or on any underlined word for additional information.
- **REQUIRED FIELDS:** All have an ASTERISK (\*), and the form will not validate if these fields are not filled-out.

**IMPORTANT:** After this letter of protest is submitted, the USPTO will send a filing receipt to the email address for correspondence provided in the form.

**CONTACT:**  
For general trademark information or help navigating the forms, email [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov), or telephone 1-800-786-9199 (press 1).

If you need help resolving technical glitches, email [TEAS@uspto.gov](mailto:TEAS@uspto.gov). Please include in your email your phone number, serial or registration number, and a screenshot of any error message you may have received.

**FOLLOW THE STEPS BELOW TO ACCESS THE LETTER OF PROTEST FORM:**

**STEP 1: CHECK STATUS.**

A letter of protest will be considered before publication if the submitted evidence is relevant to the identified ground(s) for refusal, such that it is appropriate for the examining attorney to consider whether to issue a refusal or make a requirement. When a letter of protest is filed on the date of publication or within 30 days after the date of publication, the letter of protest will only be considered if the submitted evidence establishes a prima facie case for refusal on the identified ground(s), such that failure to issue a refusal or make a requirement would likely result in issuance of a registration in violation of the Trademark Act or Rules of Practice. Letters of protest filed more than 30 days after publication are untimely. Confirm the status of the application before proceeding. If the application is not in the correct status, you will receive an error message when you click the "Continue" button.

**STEP 2: ENTER THE U.S. APPLICATION SERIAL NUMBER BEING PROTESTED BELOW OR ACCESS PREVIOUSLY FILLED-OUT/SAVED FORM.**

\* Serial Number:  (Do not enter serial number if you are accessing your saved form.)

OR

To upload a previously saved form file, first review the [TEAS Help instructions for accessing previously saved data](#) and then use the "Browse..." button below to access the form file saved on your computer. **WARNING:** Failure to follow the TEAS Help instructions will result in the inability to edit your data.

Choose File No file chosen

Continue



# The Trademark Modernization Act (TMA)



## Expungement and Reexamination

This is the biggest change with the TMA. Expungement and Reexamination are completely new procedures, which allow third parties and the Director to challenge a registered mark **WITHOUT** initiating a formal Cancellation proceeding with the TTAB.

### The differences:

**EXPUNGEMENT** – An allegation that the mark has **NEVER BEEN IN USE AT ANY TIME** for some or all of the goods/services claimed. Expungements can be initiated after a mark has been registered for 3 years.

**REEXAMINATION** - An allegation that the mark was not in use **WHEN THE APPLICATION or ALLEGATION OF USE** was filed. Reexaminations can be initiated within the first 5 years of registration.





# The Trademark Modernization Act (TMA)



## Filing Expungement or Reexamination

### REQUIREMENTS -

- (1) \$400 filing fee
  - (2) A concise statement for the basis of the petition.
  - (3) A verified statement by a U.S. domiciled party, U.S. attorney, or recognized Canadian agent that a reasonable investigation was conducted to establish a *prima facie* case of non-use.
  - (4) A copy of the evidence supporting the *prima facie* case of non-use, and an itemized index of that evidence.
- The USPTO will upload the petition evidence into the public record and will notify the registration owner that a petition has been filed, but the registration owner will not be able to respond to the notice at this time.
  - The Director will then review the petition to determine if a *prima facie* case has been established. If so, the Director will initiate the relevant proceeding. If not, the Director's decision is final and non-reviewable.
  - Note that the Director may initiate an expungement or reexamination proceeding directly, even when no third-party petition has been filed.





# The Trademark Modernization Act (TMA)



## Expungement/Reexamination Process

- Once initiated, the party who petitioned for expungement or reexamination is no longer involved in the process. The USPTO “drives the bus” going forward.
- The USPTO will issue an Office Action to the registration owner, requiring evidence of use necessary to rebut the prima facie case of non-use.
- The registration owner will have 3 months to respond, but can request a 1-month extension for \$125.
- If the registration owner does not respond, the mark is cancelled, either fully or partially, as appropriate.
- If the registration owner does respond, but the examiner does is not convinced that the prima facie case has been rebutted, the USPTO will issue a FINAL Office Action, which also has a 3-month deadline to either file a Request for Reconsideration, or appeal to the TTAB.





# The Trademark Modernization Act (TMA)



## Tips for Expungement/Reexamination



- While the USPTO deals with an enormous number of applicants and registrants each year, you'd be surprised to know how much they pay attention to repeat bad actors.
- If you have been unfortunate enough to be a party (or represent a party) with repeated losses in expungement or reexamination proceedings, keep in mind that the Director can initiate proceedings directly, so don't become a "usual suspect!"
- When filing a petition for expungement or reexamination, remember that it's hard to "prove a negative." Since we don't have a track record of how readily these petitions are likely to be approved, and the Director's decision to reject a petition is non-reviewable, make sure to include as much evidence as possible.
- The USPTO has the authority to bar parties who file a large number of these petitions, if such petitions appear vindictive.





# The Trademark Modernization Act (TMA)



## Expungement Cancellation at the TTAB

- Traditionally, a non-use cancellation at the TTAB required a showing that a registration owner has ABANDONED their mark.
- ABANDONMENT requires proof that in addition to not using the mark, the registration owner has no intention to resume use of the mark.
- Proving a party's state of mind in an ABANDONMENT cancellation is often difficult, and evidence-intensive.
- Under the TMA, parties can now file for cancellation under the theory of EXPUNGEMENT.
- Unlike abandonment, EXPUNGEMENT does not require proof that a registration owner has no intention to resume use of the mark. The plaintiff need only prove that the mark has NEVER been used.
- A cancellation claiming EXPUNGEMENT can be filed at any time after a mark has been registered for 3 years.





# The Trademark Modernization Act (TMA)



## Practical Tips for TTAB Expungements



- If a registrant has EVER used the mark in commerce in the United States for the goods and services at issue, even if that use was more than 3 years ago, EXPUNGEMENT is not an appropriate cause of action for a TTAB cancellation.
- For instances when a registrant has used the mark for the goods and services at issue, even if it was a long time ago, the proper cause of action is ABANDONMENT, which still requires proof that the registrant has no intention to resume use.
- While the rule for EXPUNGEMENT requires waiting 3 years after registration, ABANDONMENT does not. While ABANDONMENT shifts the presumption after 3 years of non-use, a party can claim ABANDONMENT in less than 3 years if there is evidence that a registrant has no intention to resume use.



# The Trademark Modernization Act (TMA)



## Post Registration Audit Program

- While implemented separately from the TMA, the USPTO's Post Registration Audit Program is also a key component in the USPTO's overall strategy of removing fraudulent and overbroad registrations from the Register.
- Every renewal or maintenance filing is run through an algorithm, and only registrations meeting the algorithm's requirements are flagged.
- The algorithm mainly scans for semicolons and commas in a class. Each semicolon is given a certain number of "points," and each comma is given some lesser number of "points."
- Although not exact, the algorithm is trying to bring up descriptions that contain **10 or more entries** in a single class.
- Examiners are instructed to be on the lookout for goods/services that seem obscure, or do not fit within the overall theme of the other goods and services, and flag those for proof-of-use.
- If selected for audit, an examiner will ask a registrant to provide proof of use for two goods/services in a description.
- If the registrant cannot prove use for those two entries, they will be deleted, and the registrant will then have to prove use for **ALL** goods/services in that class.





# The Trademark Modernization Act (TMA)



## Tips for Avoiding a USPTO Audit



- Keep the descriptions of goods and services as short and concise as possible. Avoid “European-style” laundry-list IDs at all costs. Including “computer software; computer programs; computer applications” when just one of those will cover you will increase your chances for an audit.
- Keep commas and semicolons to a minimum. If you can get “audio processing hardware,” keep that. Avoid “audio processing hardware, namely, amplifiers, noise reducers, equalizers, filters, etc.” because you’re racking up the comma count for the algorithm to flag you.
- Consider keeping IDs to under 10 entries per class, if possible. File applications where goods/services groupings make sense, regardless of the classification. For example, consider filing a class 41 application for entertainment services, and a separate class 41 application for educational services. That way the examiner is not as likely to think “integrated circuit boards” is out of place in a list of software.
- For existing registrations, consider deleting or restricting the description of goods and services to eliminate goods that are no longer in use prior to filing a renewal or declaration of use.





# The Trademark Modernization Act (TMA)



## Overall Takeaways

- Keep in mind that many of the TMA's provisions are targeted at foreign applicants and registration owners who may not be used to the strict use requirements in the United States.
- **Consult with U.S. counsel prior to filing an application with the USPTO.** Broadly worded and overly-long descriptions of goods and services are much more likely to run into trouble. While simply copying your description of goods and services from your foreign registration saves money up front, it will likely cost the client lots more money later on in the form of responding to audits and expungements.
- **Don't view registration as the end goal!** Since rights in the US come from use, and not purely from registration, it's not a "win" to simply obtain a registration certificate that doesn't accurately reflect the goods and services provided. Registration owners must be prepared to prove use for many years after obtaining a registration.
- **Periodically review your registrations to ensure you are still using the mark on all of the goods and services claimed.** Don't put your entire registration in jeopardy because of goods and services you don't actually use anymore. You can voluntarily delete unused goods and services without a USPTO fee.



---

# Thank you!



Jason Blair – Smith, Gambrell & Russell, LLP  
(Austin, TX)



[jblair@sgrlaw.com](mailto:jblair@sgrlaw.com)

<https://www.sgrlaw.com/attorneys/jason-p-blair/>

<https://www.linkedin.com/in/jasonpaulblair/>

*Calendaring Our Future Together.™*

