

UNITED STATES
PATENT AND TRADEMARK OFFICE



Experienced practitioners: Trademark ex parte expungement and reexamination proceedings

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Overview

- **Goals**

- Share insights on the history and purpose of proceedings
- Define use in commerce
- Discuss ways to establish a prima facie case of nonuse
- Discuss three-year anniversary highlights
- Discuss best practices for petitioners



Trademark Modernization Act of 2020 (TMA)

- Effective December 18, 2021
- Established two new ex parte proceedings to cancel unused registered trademarks
 - Expungement
 - Reexamination
- Faster, more efficient, and less expensive alternative to a contested inter partes cancellation proceeding
- Supplemental tool for clearing deadwood in addition to existing maintenance requirements for registrations

Nonuse cancellation: ex parte expungement and reexamination

Third-party petitions – proceedings before the Director

Third-party petition requesting either expungement (never been used) or reexamination (no use by relevant date)

- Must include nonuse evidence establishing a prima facie case
- \$400 per class
- Can be filed anonymously
- Cannot be withdrawn once filed
- Once instituted, petitioner not part of process

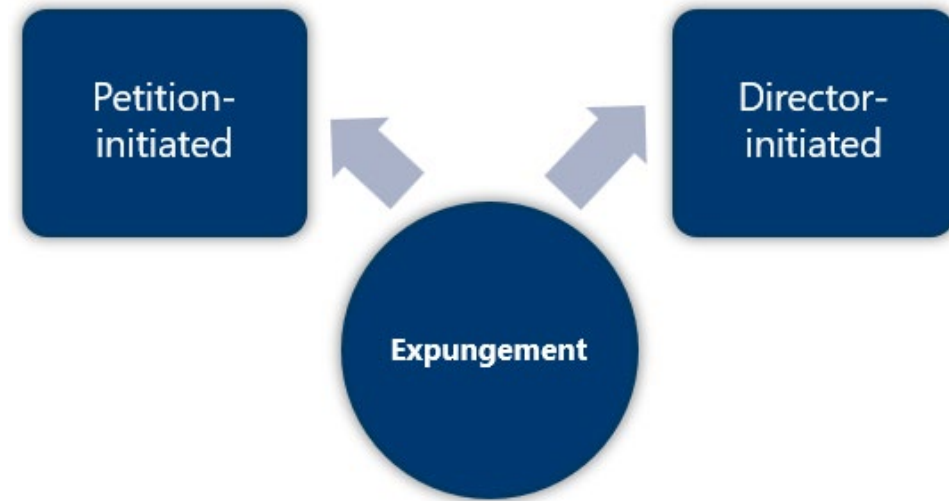
Director-initiated proceedings

Director can institute proceedings for expungement or reexamination based on the Director's own initiative without a petition

- Must present nonuse evidence establishing a prima facie case

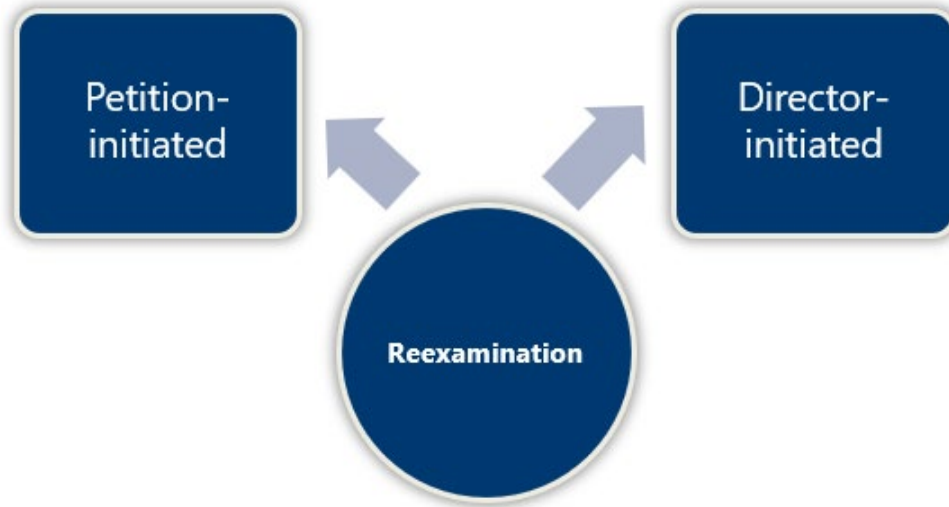
Challenged goods or services **canceled** if registrant does not establish use or, for Sections 44 and 66 only, excusable nonuse

Nonuse cancellation - expungement



- **New claim/ground**
 - Mark has **never** been used on some or all the goods or services
 - Not abandonment
 - Does not evaluate intent to commence use
- **Targeting**
 - Section 1, 44, 66 registrations
- **Can be filed**
 - Between 3-10 years post-registration

Nonuse cancellation - reexamination



- **New claim**
 - Mark is not in use as of the relevant date
 - 1(a) filing date
 - 1(b) the later of the date of the Amendment to Allege Use or the expiration of time to file the Statement of Use
- **Targeting**
 - Section 1 registrations
- **Can be filed**
 - Within first 5 years post-registration

TMA petition numbers

December 2021-May 2025

Type of proceeding	Petitions filed	Instituted proceedings	Non-institutions	Terminated proceedings	No cancellation	Cancellation	Number of goods or services canceled
Expungement	296 total 40 YTD	186	103	158	41	117	2,439 out of 2,489
Reexamination	312 total 32 YTD	181	122	165	39	126	3,469 out of 3,543
Total	608 total 72 YTD	367	225	323	80	243	5,908 out of 6,032

Are petitions meeting the evidentiary burden?

- Institution rate is 60%

Are the proceedings worth it for petitioners?

- Cancellation rate for instituted proceedings is 75% (of disposed of proceedings)
- Goods/services cancellation rate for instituted proceedings is 98% (of disposed of proceedings)



TMA Director-initiated numbers

December 2021-May 2025

Type of proceeding	Institutions	No cancellation	Full or partial cancellation	Number of goods or services canceled
Director-initiated expungement	24 total 3 YTD	0	21	2,278 out of 2,338
Director-initiated reexamination	2,574 total 1,558	0	2,001	45,280 out of 45,287
Total	2,598 1,561 YTD	0	2,022	47,558 out of 47,625

Are these proceedings effective at eliminating deadwood?

- Director-initiated cancellation rate: 99.86%
- Director-initiated proceeding cancellations: 47,558 out of 47,625 goods/service canceled

TMA registrant domicile country

December 2021-May 2025

Type of proceeding	Registrant domicile country	Count / percentage of institutions
Director-initiated	China United States Other	2,355 (91%) 207 (8%) 36 (1%) 2,598 total
Petitions	United States China United Kingdom Germany Other	156 (43%) 108 (29%) 12 (3%) 9 (2%) 82 (23%) 367 total

Expungement and reexamination

Establishing nonuse

“Use in commerce”

- 15 U.S.C. §1127
- Bona fide use of the mark in the ordinary course of trade
- Not made merely to reserve a right in the mark

Goods	Services
Mark is placed on the goods, their containers, or affixed tags or labels or associated displays.	Mark is displayed in the sale or advertising of the services.
Goods are sold or transported in commerce.	Services are rendered in commerce.

"Use in commerce" issues

- No use of mark with goods or services subject to proceeding
 - Specimen shows use with other goods or services in the registration
 - Specimen is a mockup
- No use of mark with goods or services *as identified* in registration

No use with identified goods

- *In re Locus Link USA*, 2024 TTAB LEXIS 225 (2024)
- Ex parte appeal of petition-based expungement proceedings
- ID: "Components for air conditioning and cooling systems, namely, evaporative air coolers"
- **Held:** Decision to cancel registrations affirmed
"[T]he identification of goods, as set forth in the ... Registrations, covers evaporative air coolers that are components of air cooling systems. It does not identify or encompass component parts for evaporative air coolers, such as Registrant's connectors."

SMARTLOCK



ELBOW UNION (ELUN)

Connects same-sized copper/aluminum tube to copper/aluminum tube at a 90-degree angle.
There is no reduction in flow.

uspto®

Other “use in commerce” issues

- Intrastate only
- Foreign commerce only
- Unlawful use
- Current nonuse only
- Token use

Use in the ordinary course of trade

- *Adamson Sys. Eng'g, Inc. v. Peavey Elecs. Corp.*, 2023 TTAB LEXIS 454 (2023)
- Inter partes cancellation proceeding
- Board found the respondent's use was "sporadic, casual, and nominal"
 - "What constitutes 'bona fide use of the mark in the ordinary course of trade' may vary over time as markets and businesses change ... But Respondent's de minimis domestic use of the CS mark on amplifiers clearly fell below that standard."



Expungement and reexamination

Gathering evidence

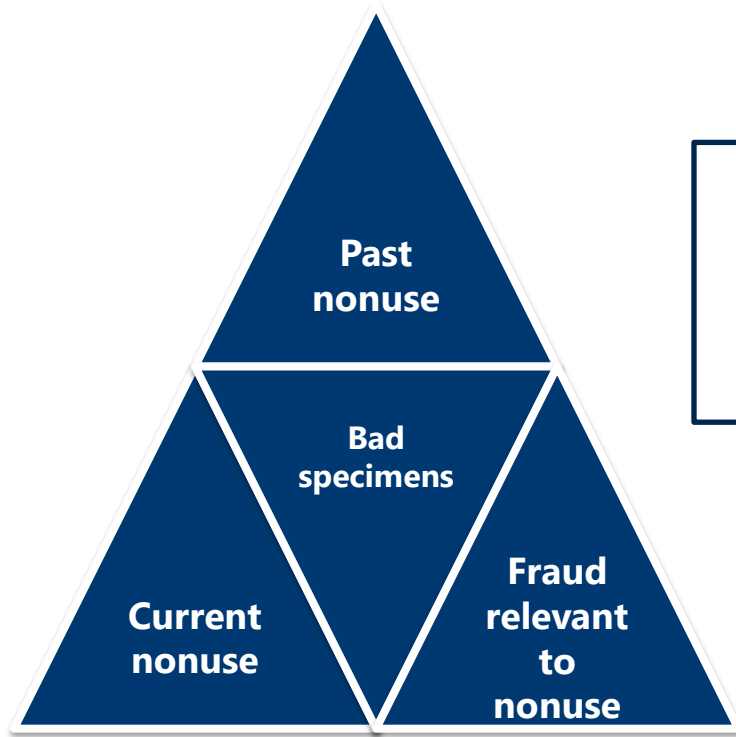
Reasonable investigation required

To show a reasonable investigation of nonuse, the petition should contain:

1. A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse, and an itemized index of the documentary evidence that helps connect the dots for the USPTO
2. Sources of evidence such as: screenshots of webpages showing URL and access date; state and federal trademark records; websites believed to be controlled or owned by registrant; filings made in state or federal regulatory agencies; private investigations; and litigation records. A single internet search is not sufficient.
3. Specific descriptions, for each source of information relied upon, of how information was obtained, how searches were conducted, and what information and evidence (if any) the searches revealed



Expungement/reexamination



Building the prima facie case

- Submit **multiple** types and sources of evidence that create inferences of nonuse

Expungement/reexamination (cont'd)

Bad specimen

- Fake/doctored image
- Original specimen doesn't show proper use in commerce (e.g., intrastate use only)

Fraud

- Lacks characteristics normally seen in e-commerce website
- Uses identical language as that on multiple third-party websites
- Features recognizable third-party goods with a superimposed trademark
- Features widely disparate goods
- Mark is for sale on auction websites

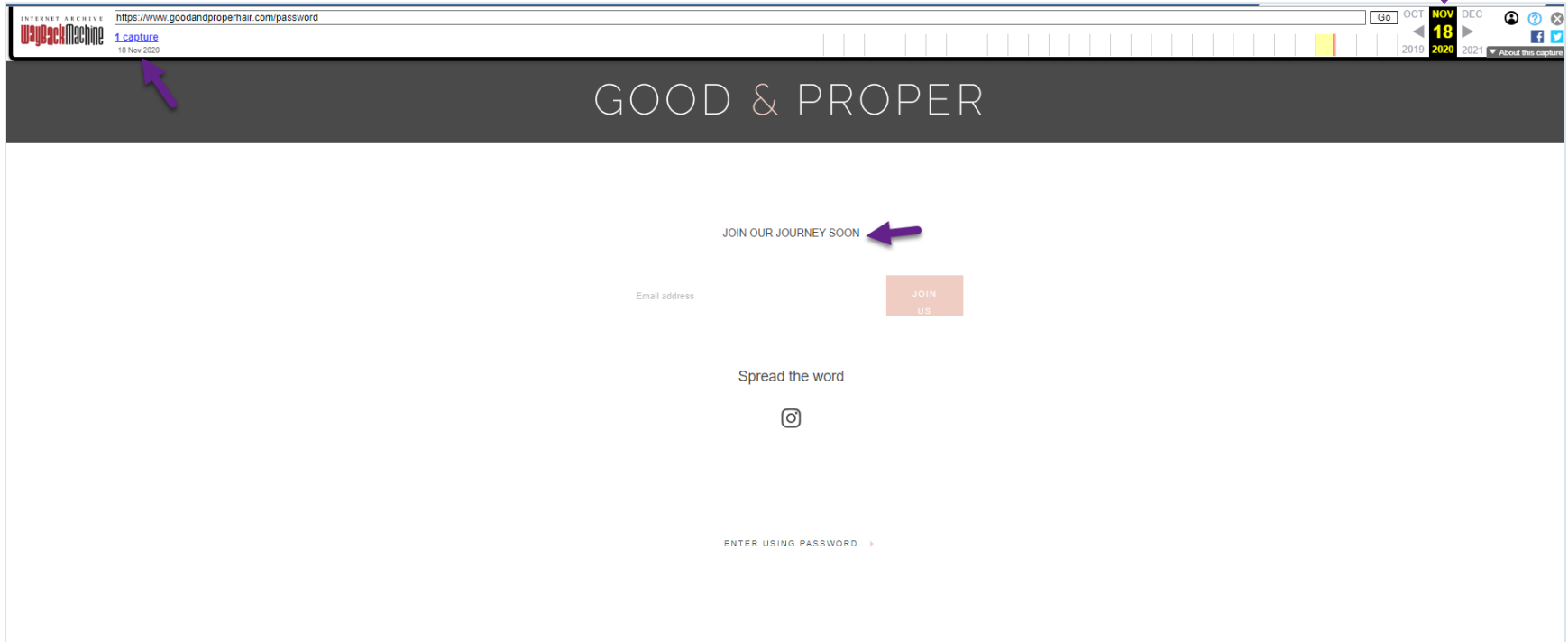
Past nonuse

- Wayback Machine®
- Lack of U.S. presence
- Lack of importation information
- Invalidity of country-of-origin registration for nonuse
- Statements that indicate sales are limited to outside of U.S.

Current nonuse

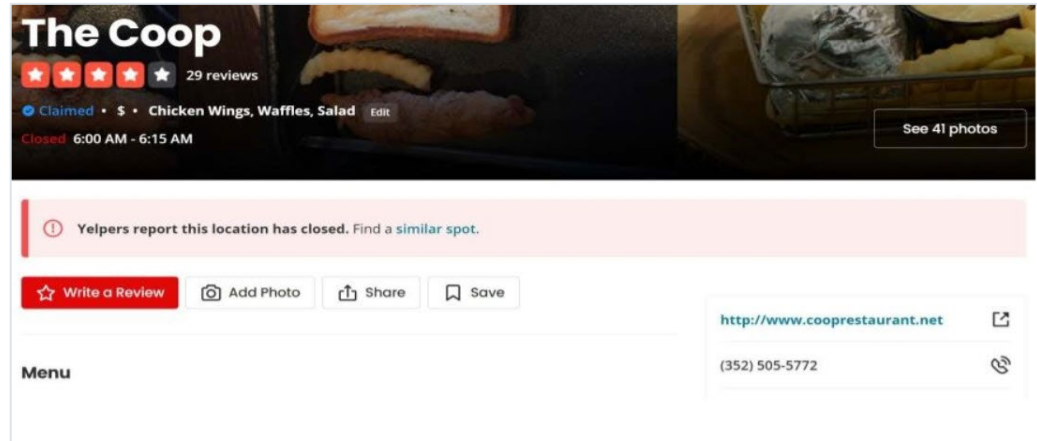
- On multiple big retail/wholesale platforms
- In more specialized stores
- Regulatory agency evidence
- Public filings with adverse registrant statements
- Reverse image results for design marks

Past nonuse evidence



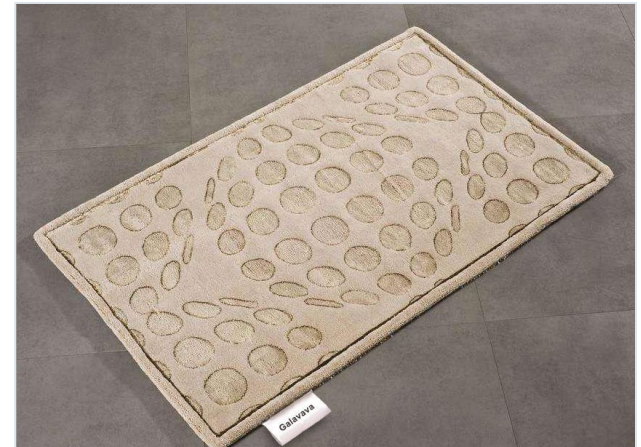
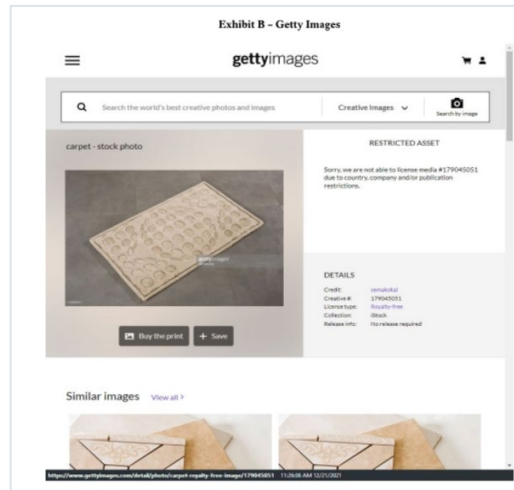
Past nonuse evidence (cont'd)

- Evidence that the services could not be provided
 - Restaurant closed before the relevant date



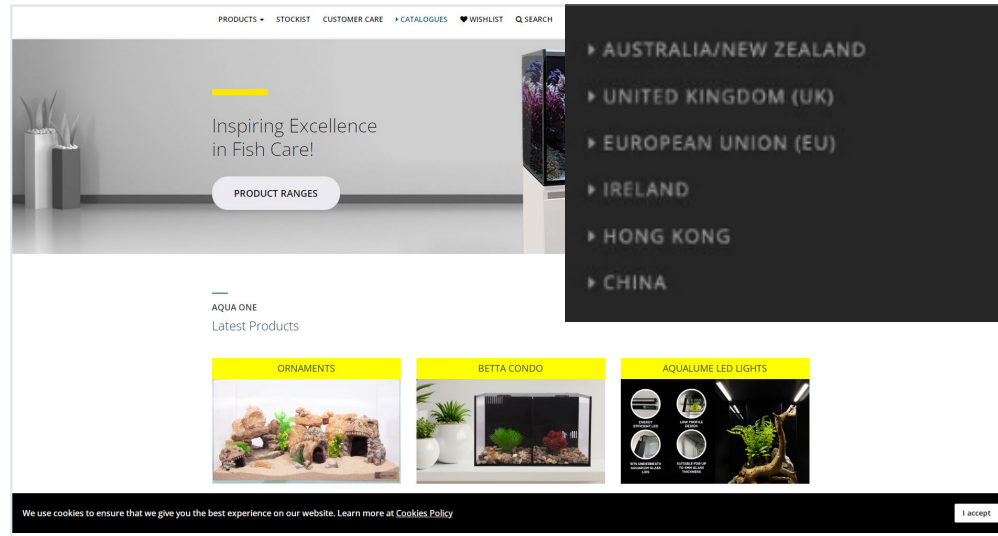
Past nonuse evidence (cont'd 2)

- Digitally altered specimen
 - Could include reverse image search of specimen showing it with other marks or specimen as a stock image



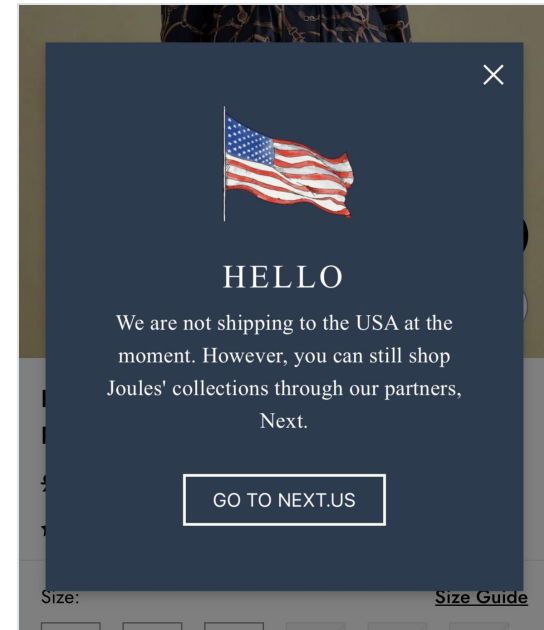
Current nonuse evidence

- Evidence that sales are limited to places outside the United States



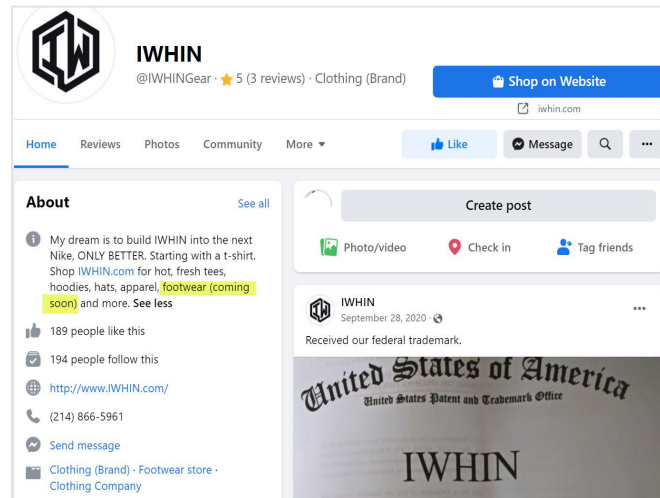
Current nonuse evidence (cont'd)

- Evidence that sales are limited to places outside the United States



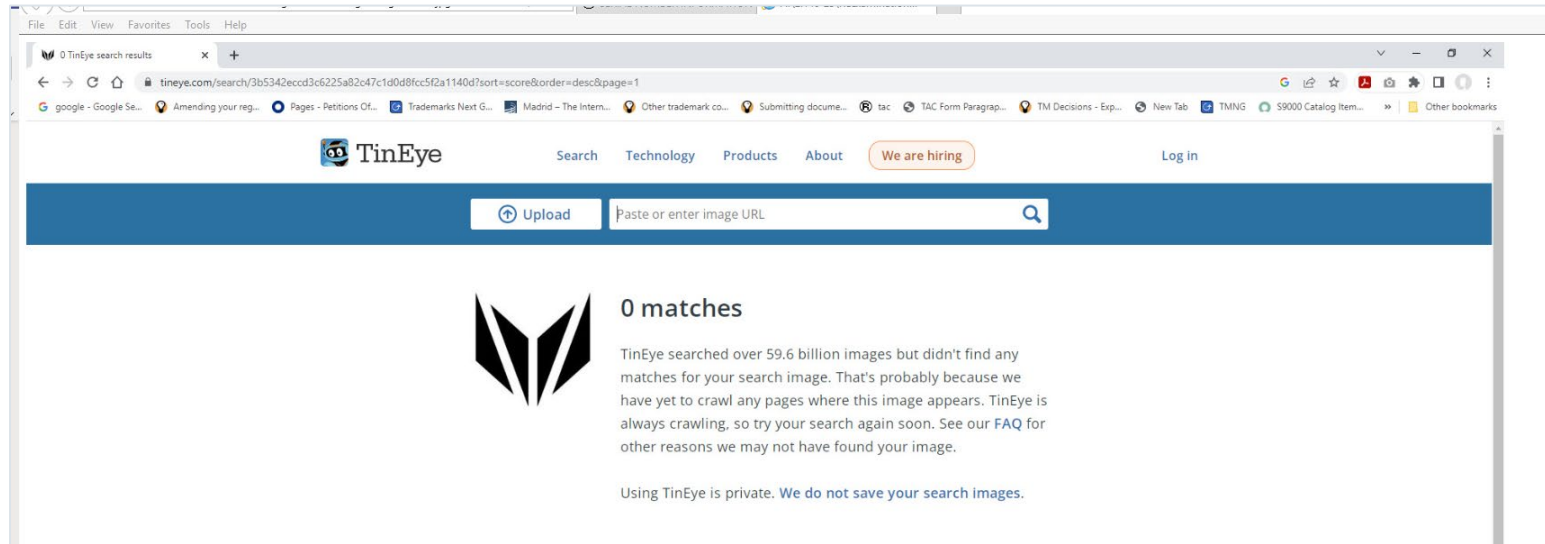
Current nonuse evidence (cont'd 2)

- Evidence consisting of statements from registrant that support inference of nonuse



Current nonuse evidence (cont'd 3)

- Reverse image search results for design marks showing no hits

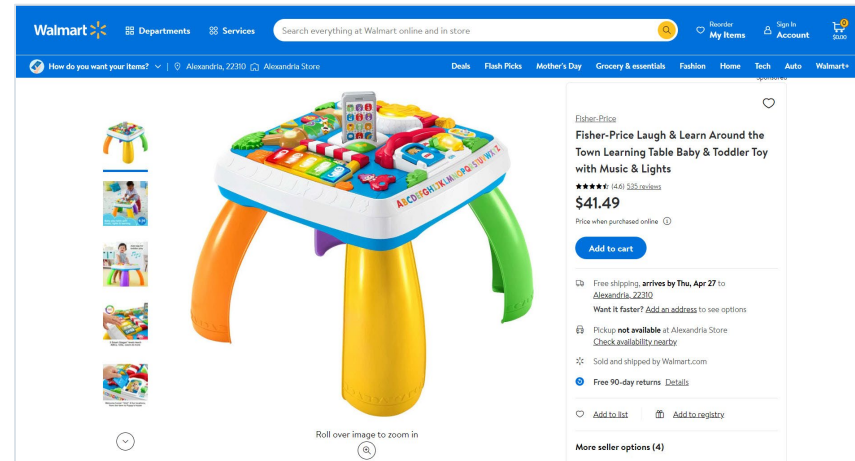


Other nonuse evidence

- Website features recognizable third-party goods with a superimposed trademark that seems mocked up.



Image on website



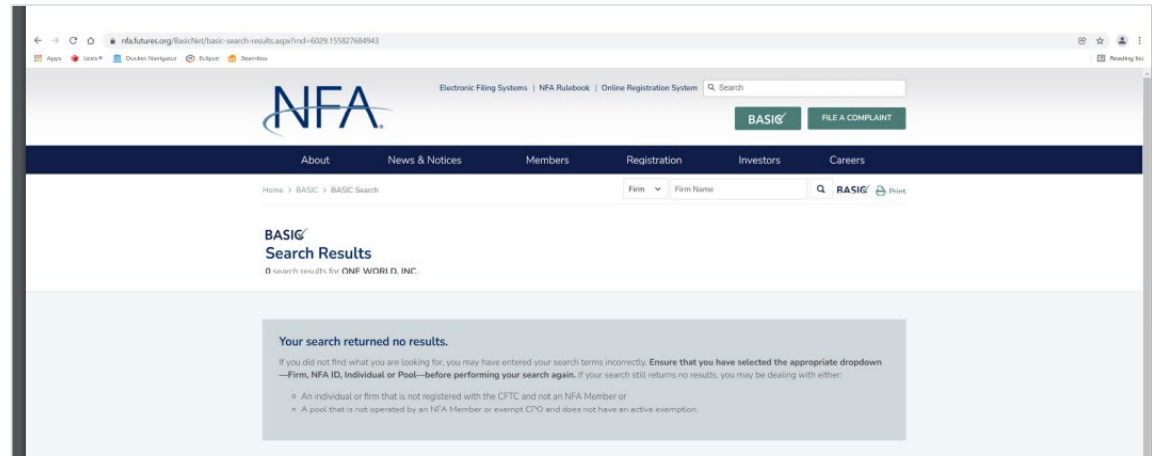
Third party good

Gathering industry-specific evidence

- Research whether registrant's industry requires licensing, certificates, etc.
 - Pharmaceuticals (FDA)
 - Finance (SEC and FDIC)
- Research whether registrant is certified by third parties
 - Dietary supplements (NSF and USP)

Current nonuse evidence (cont'd 4)

- Industry-specific evidence from regulatory agencies where relevant to show nonuse



- Registration required with National Futures Association for commodity trading

Current nonuse evidence (cont'd 5)

- Drugs@FDA: FDA-approved drugs database

Search Results for "meclofenamate sodium"

Products listed on this page may not be equivalent to one another.

MECLODIUM
<ul style="list-style-type: none">• MECLODIUM (MECLOFENAMATE SODIUM) ANDA #071380 CAPSULE, ORAL Discontinued QUANTUM PHARMICS• MECLODIUM (MECLOFENAMATE SODIUM) ANDA #071381 CAPSULE, ORAL Discontinued QUANTUM PHARMICS
MECLOFENAMATE SODIUM
<ul style="list-style-type: none">• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #070400 CAPSULE, ORAL Discontinued WATSON LABS• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #070401 CAPSULE, ORAL Discontinued WATSON LABS• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071007 CAPSULE, ORAL Discontinued USL PHARMA• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071008 CAPSULE, ORAL Discontinued USL PHARMA• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071081 CAPSULE, ORAL Prescription MYLAN• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071382 CAPSULE, ORAL Discontinued AM THERAP• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071383 CAPSULE, ORAL Discontinued AM THERAP• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071489 CAPSULE, ORAL Discontinued ANI PHARMS• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071640 CAPSULE, ORAL Discontinued WATSON LABS• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071641 CAPSULE, ORAL Discontinued WATSON LABS• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071684 CAPSULE, ORAL Discontinued VITARINE• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #071710 CAPSULE, ORAL Discontinued VITARINE• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #072077 CAPSULE, ORAL Discontinued PAR PHARM• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #072078 CAPSULE, ORAL Discontinued PAR PHARM• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #072282 CAPSULE, ORAL Discontinued FOSUN PHARMA• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #072283 CAPSULE, ORAL Discontinued FOSUN PHARMA• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #072809 CAPSULE, ORAL Discontinued BARR• MECLOFENAMATE SODIUM (MECLOFENAMATE SODIUM) ANDA #072848 CAPSULE, ORAL Discontinued BARR

Expungement and reexamination

Avoiding pitfalls

Petitioners

Do this!

- Provide index of evidence
- Provide name/domicile/email of petitioner
- Provide more than one bad specimen as evidence
- Check our sanctions webpage
- Provide relevant industry-specific search evidence
- Provide relevant website screenshots
- Label all exhibits; provide URL/date accessed

Not that!

- Don't try to narrow the registrant's ID
- Don't provide testimony in petition without documentary evidence to substantiate it
 - Don't give us an investigator's report without documentation of the findings
- Don't provide **only** hitlists of online sources
- Don't challenge "hooded sweatshirts for babies, children" but then not challenge "hooded sweatshirts"

Petitioners (cont'd)

Do this!

- Focus on the correct relevant date
- Provide relevant evidence pertaining to the relevant date
- Establish a case of nonuse for all goods and services subject to the petition
- Provide the "negative evidence"

Not that!

- Don't get the relevant date incorrect
- Don't provide only **current** evidence of nonuse

Expungement and reexamination

Director-initiated proceedings


Director-initiated proceedings

- Same standard as petition-based proceeding
 - Prima facie case of nonuse
- Effective tool for removing unused registered marks
 - Supplement to petition-based proceeding
 - Specimen farms

Cancellation success

Trademark Alert

50,000 goods and services canceled from trademark registrations using TMA proceedings



We've hit a new milestone in our efforts to declutter the trademark register—over 50,000 goods and services canceled using ex parte expungement and reexamination proceedings. The majority of cancellations came from proceedings instituted on the USPTO Director's own initiative against registrations linked to [specimen farms](#). Some [filing firms](#) built these e-commerce websites solely to create fake specimens of use, but the marks were never actually used in commerce.

Learn how to [request an expungement or reexamination proceeding](#) to cancel unused goods and services from registrations blocking your client's or your company's path to new business opportunities.

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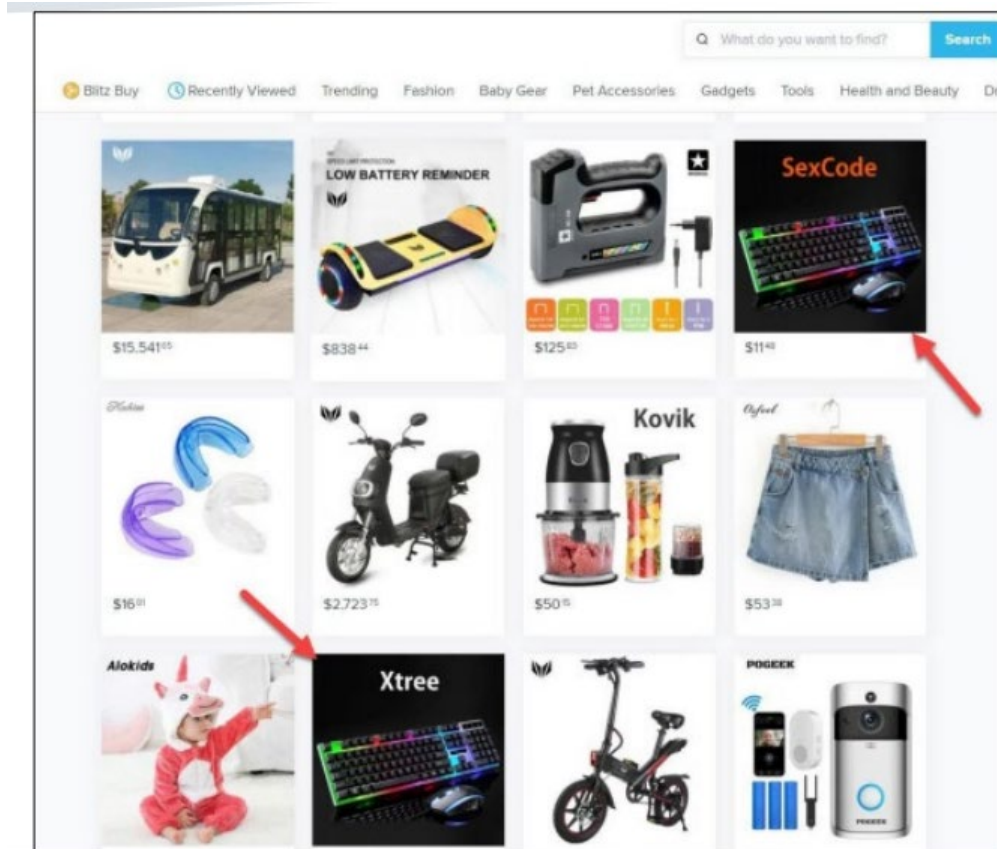
uspto®

uspto®

What is a specimen farm?

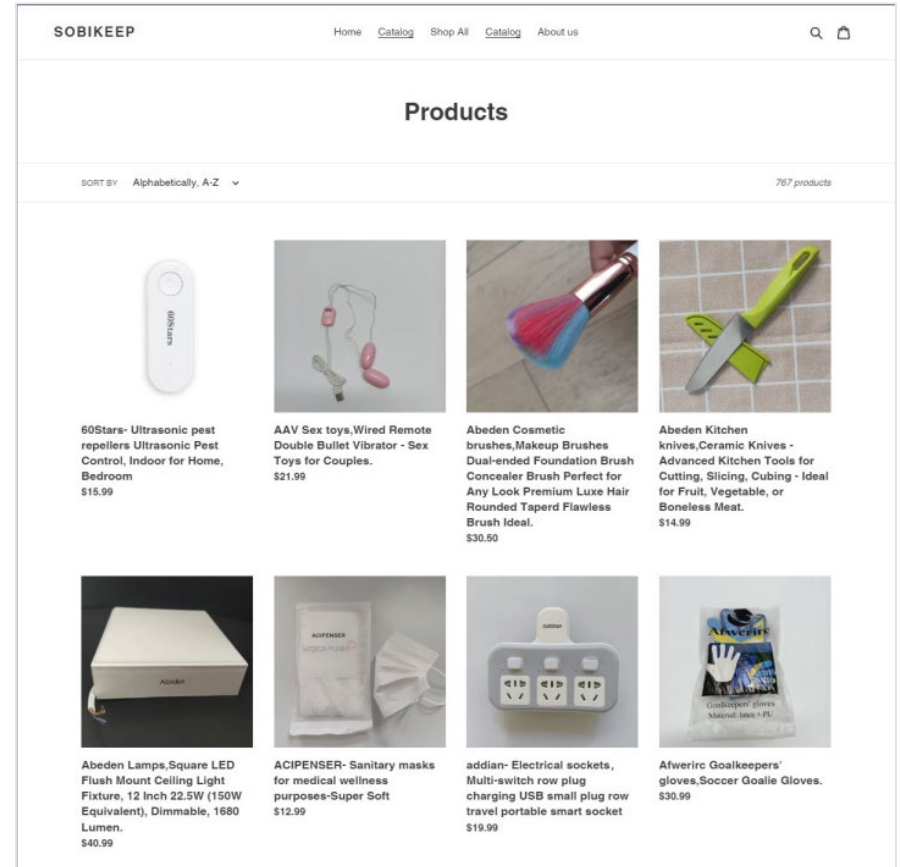
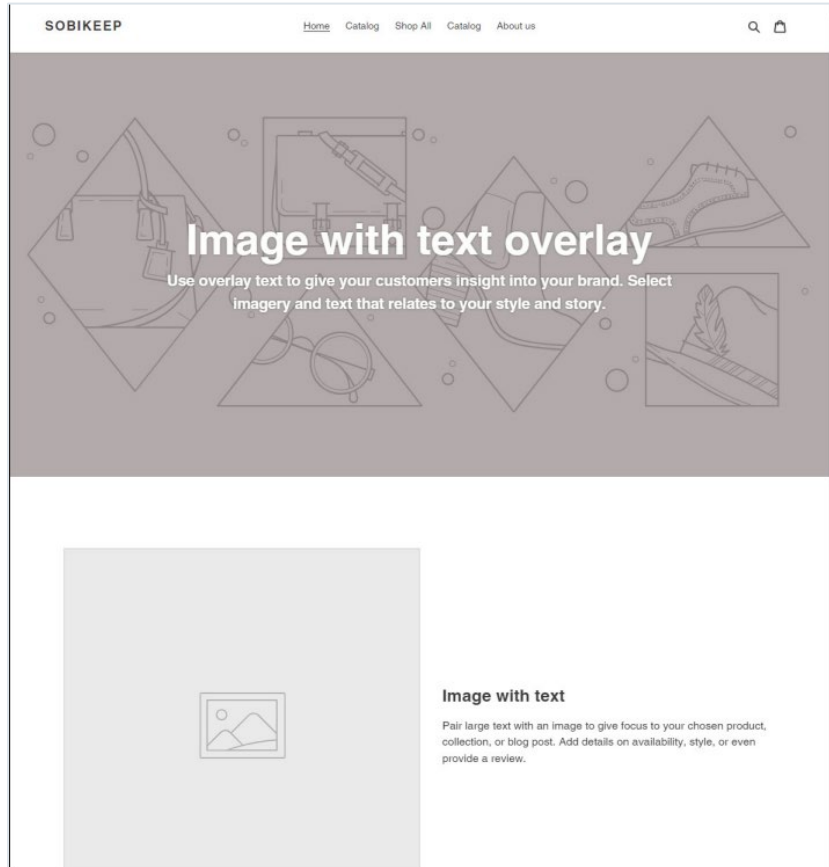
- E-commerce website created solely for the purpose of creating specimens
- Displays hundreds of products with various trademarks
- No actual use in commerce

Specimen farms



- QSeel's Red1985 storefront has a large variety of unrelated products.
- The listings may include the identical product image, but a different mark.

Specimen farms (cont'd)



Specimen farm evidence

Atypical features for an e-commerce website

Product listings are identical to descriptions of products offered under other **third-party** marks.

Many of the goods listed on website feature marks that were the subject of trademark application filings made by registrant around the same time period.

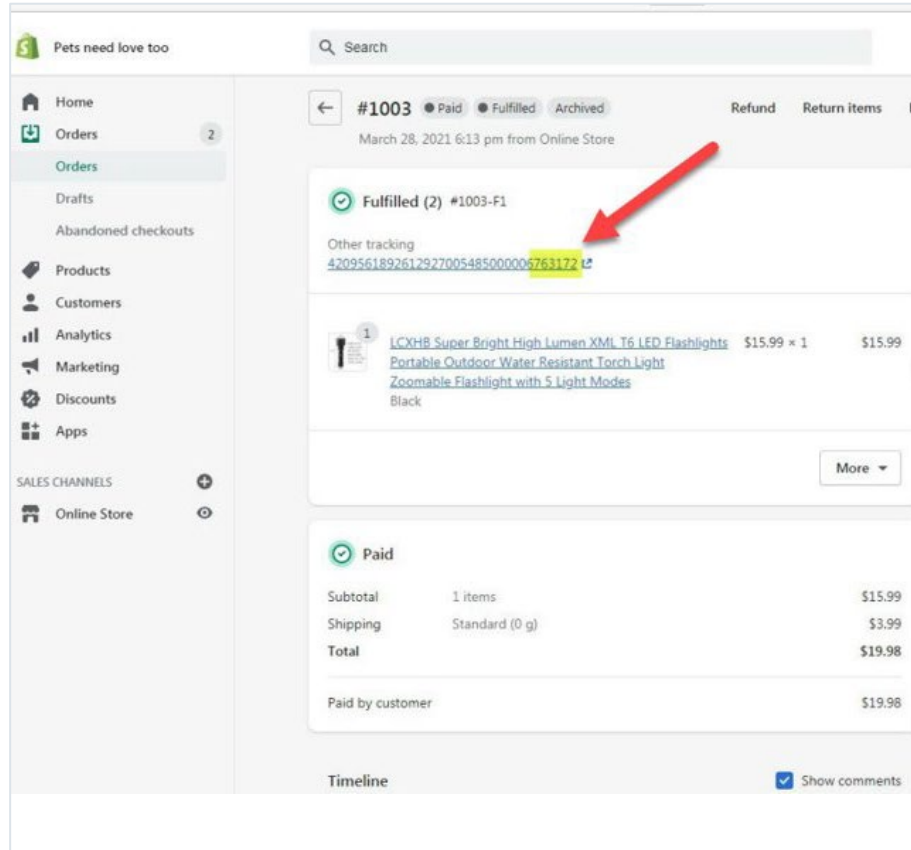
Specimen farms (+ auction sites)

6523829	WOLFOX	Reexamination	12/14/2022
6542930	PHYSI	Reexamination	12/14/2022
6550836	BALLEY	Reexamination	12/14/2022
6550837	HUSHLY	Reexamination	12/14/2022
6550838	TOYAGO	Reexamination	12/14/2022
6542989	HOTOX	Reexamination	12/14/2022
6579411	FURNIT	Reexamination	12/14/2022
6550875	VACES	Reexamination	12/14/2022
6543031	ANTENS	Reexamination	12/14/2022
6432103	GEOPLE	Reexamination	12/14/2022
6534414	HONES	Reexamination	12/14/2022
6432133	BABAG	Reexamination	12/14/2022
6558798	BAGFUN	Reexamination	12/14/2022
6534522	INLANT	Reexamination	12/14/2022
6534523	ACAFE	Reexamination	12/14/2022
6534524	AQUID	Reexamination	12/14/2022
6534525	MAROO	Reexamination	12/14/2022
6506315	ME SO FUNNY	Reexamination	12/14/2022

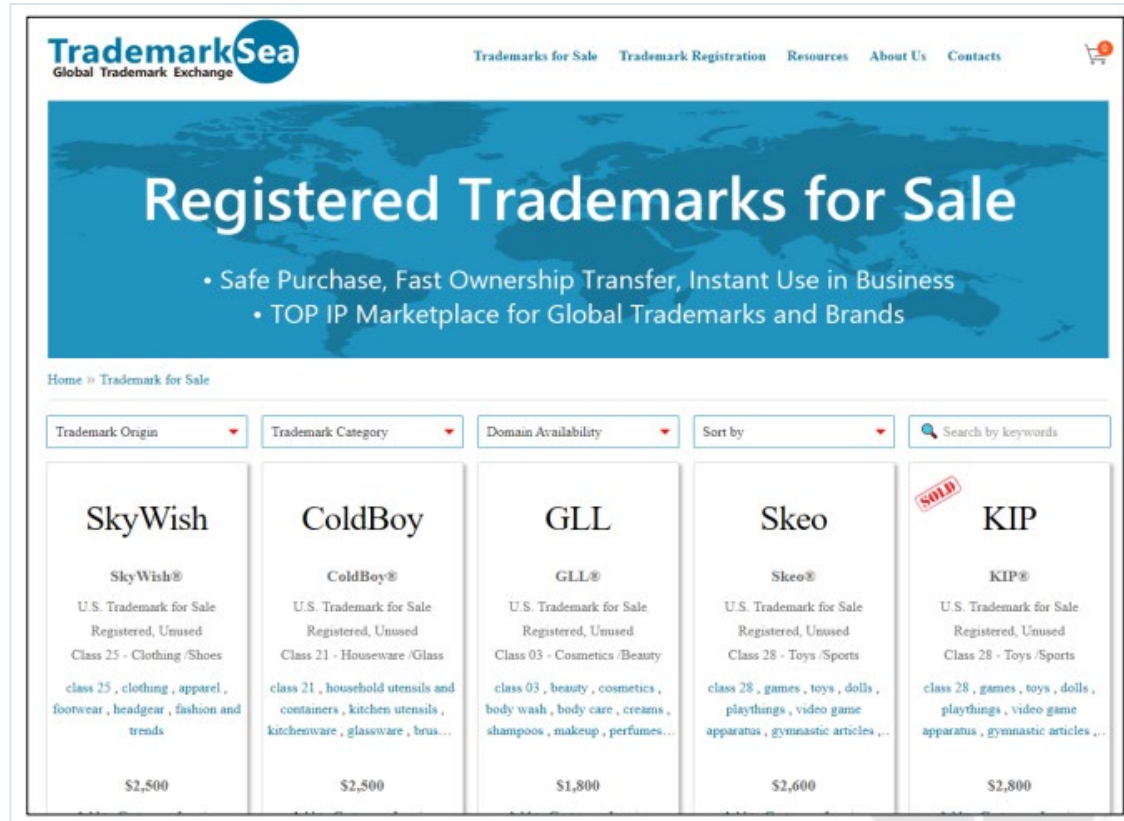
Index of Evidence	
Exhibit A	Wayback Machine screenshots of www.bomixusa.com from September 27, 2020, October 27, 2020, and December 3, 2020
Exhibit B	Wayback Machine screenshots of www.bomixusa.com showing the product listings for the marks BALLEY, PHYSI, and HUSHLY from October 27, 2020 and October 28, 2020
Exhibit C	Screenshots from www.linkedin.com/company/wix-com and www.twitter.com/wix showing the social media links on www.bomixusa.com reverted to the web platform publishing the website and not to registrant's social media sites
Exhibit D	Screenshots from Amazon.com showing the product listings for the CSBD water bottle, which is copied in the specimen and product listing for the BALLEY mark, the Achedaway Pro massage gun, which is copied in the specimen and product listing for the PHYSI mark, and the H.Versailtex curtain panels, which is copied in the specimen and product listing for the HUSHLY mark
Exhibit E	Copy of the current status of U.S. Registration Nos. 6542930 (PHYSI), 6550836 (BALLEY) and 6523829 (HUSHLY) and the specimens submitted in each record
Exhibit F	Copy of www.bomixusa.com showing the website is no longer available
Exhibit G	Google search results for "Wolfox" and "Best Tomorrow"

False invoices

- Identical tracking number across multiple invoices
- Nonexistent addresses



Auction sites



The screenshot shows the TrademarkSea website, a Global Trademark Exchange. The main heading is "Registered Trademarks for Sale". Below this, there are two bullet points: "Safe Purchase, Fast Ownership Transfer, Instant Use in Business" and "TOP IP Marketplace for Global Trademarks and Brands". The page features a navigation bar with links: "Trademarks for Sale", "Trademark Registration", "Resources", "About Us", and "Contacts". A shopping cart icon is also present. Below the navigation bar, there is a search bar and filters for "Trademark Origin", "Trademark Category", "Domain Availability", and "Sort by". The main content area displays five trademark listings, each with a name, status, class, description, and price.

Trademark	Status	Class	Description	Price
SkyWish®	U.S. Trademark for Sale Registered, Unused	Class 25 - Clothing /Shoes	class 25, clothing, apparel, footwear, headgear, fashion and trends	\$2,500
ColdBoy®	U.S. Trademark for Sale Registered, Unused	Class 21 - Houseware /Glass	class 21, household utensils and containers, kitchen utensils, kitchenware, glassware, brus...	\$2,500
GLL®	U.S. Trademark for Sale Registered, Unused	Class 03 - Cosmetics /Beauty	class 03, beauty, cosmetics, body wash, body care, creams, shampoos, makeup, perfumes...	\$1,800
Skeo®	U.S. Trademark for Sale Registered, Unused	Class 28 - Toys /Sports	class 28, games, toys, dolls, playthings, video game apparatus, gymnastic articles, ...	\$2,600
KIP®	U.S. Trademark for Sale Registered, Unused	Class 28 - Toys /Sports	class 28, games, toys, dolls, playthings, video game apparatus, gymnastic articles, ...	\$2,800

Resources

- General background:
 - <https://www.uspto.gov/trademarks/laws/2020-modernization-act>
- Final rule:
 - <https://www.federalregister.gov/documents/2021/11/17/2021-24926/changes-to-implement-provisions-of-the-trademark-modernization-act-of-2020>
- E&R decisions and proceedings:
 - <https://developer.uspto.gov/tm-decisions/search/expungement>
- TMEP Section 1716:
 - https://tmepp.uspto.gov/RDMS/TMEP/current#/current/ch1700_d35c41_29d53_196.html
- Specimen farms:
 - <https://www.uspto.gov/trademarks/protect/challenge-invalid-specimens>





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