

Changes to Trademark Procedures at the USPTO

11.29.2021

In the waning days of 2020 and in the heights of the COVID-19 pandemic, Congress passed the Trademark Modernization Act. It directed the United States Patent and Trademark Office (USPTO) to change certain procedures in important ways, with aims of speeding up the initial application process as well as the clearing out of unused or overly broad (i.e. often foreign-based) registrations. The USPTO has now issued its final rule on those changes. Most of the changes will kick in during December 2021, while one important change will become effective in over a year – on Dec. 1, 2022.

December 2021 Changes

Individuals and businesses will have new methods to try to clear unused trademarks from the federal trademark register and to shorten up the list of unused goods and services for marks – and especially registrations based upon foreign registrations where long laundry lists of goods/services are common.

First, a party may request “expungement” of some or all of the goods or services in a trademark registration if the registrant never used the trademark in commerce in the U.S. with those goods or services. Expungement applies only to registrations at least three years old, and after late 2023 it is scheduled to no longer be available to registrations over 10 years old. So, consult with counsel about acting now.

Second, a party may request “reexamination” by the USPTO as to some or all of the goods or services in a use-based registration if there is evidence that the trademark was not used in commerce with those goods or services on or before a particular relevant date. Reexamination must be requested before a registration reaches its fifth anniversary.

Some think that these proceedings will be cheaper, less involved, and have a lower hurdle to surmount than the traditional routes of suing in court for cancellation or petitioning for cancellation, and having to prove intentional abandonment or another traditional ground for cancellation.

Other procedural changes were also adopted.

December 2022 Change

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An important time period is being sliced in half, unless one buys an extension of time. Starting Dec. 1, 2022, applicants and registrants (excluding Madrid section 66(a) applications) will have only three months – rather than six months – to respond to office actions issued during examination of an application or post-registration office actions. A single three-month extension may be requested for a fee – scheduled to be \$125.

If you have questions about these changes, please contact David Sar or Micole Little.

PEOPLE

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