

One year on: TMA proceedings serve purpose but aren't shoo-ins

Rani Mehta January 20, 2023



New expungement proceedings for trademarks have been good tools in litigation, but lawyers must put in the work, say counsel at six US firms

More than one year ago, the USPTO received the first petition for expungement under the Trademark Modernization Act.

The act's expungement and re-examination proceedings are intended to make it easier for parties to cancel marks that are no longer in use.

Parties can file expungement petitions when marks have never been used in commerce, and re-examination petitions when marks haven't been used on or before the filing date of the application or the deadline to file the statement of use.

Now, more than 200 petitions have been filed by third parties at the office.

These proceedings have been incredibly welcome in the fight against false trademarks and have been fairly manageable, but also have a couple of key challenges, according to lawyers at six firms who have filed at least one petition.

For one thing, counsel must include sufficient detail to ensure their petitions are instituted, which can be difficult in some cases, say sources.

They also have to advise their clients on when it makes sense to take advantage of these new proceedings and when it doesn't.

Pretty pleased

A lot of lawyers were pleased with these proceedings because they got the results they wanted.

Ian McFarland, partner at Merchant & Gould in Tennessee, submitted an expungement petition against 'Wow no cow!' which resulted in goods getting cancelled and was a useful part of his client's litigation against the registrant.

He notes that the process was straightforward – the firm prepared a petition and submitted it to the USPTO, which then ruled on the petition and sent an office action to the registrant requesting evidence of use.

“At that point, everything was out of our hands,” he says. ,

Petitioners also found the process fairly straightforward because a lot of registrants didn't fight back.

According to [data compiled by law firm Thompson Coburn](#), 29 registrations out of 118 instituted third-party proceedings were partially or entirely cancelled because the registrant hadn't filed a timely response to an office action, while three were voluntarily surrendered. Most of these petitions are still pending.

Trevor Caudle, founder of Trevor Caudle Law Practice in San Francisco who successfully filed a re-examination proceeding against 'OYU', says he wasn't surprised that the registrant didn't fight back in his case given that the specimens of use appeared to be photoshopped.

He adds that the process is designed for clearcut matters, which means a lot of registrants won't bother to argue that they're using the marks.

Proving a negative

But it doesn't matter whether registrants will fight back if attorneys can't get the USPTO to institute these proceedings – which a fair number have struggled to do.

According to [the data compiled by Thompson Coburn](#), 34% of proceedings weren't instituted because the petitioner hadn't established a prima facie case of non-use.

Sarah Robertson, partner at Dorsey & Whitney in New York who filed a petition against 'Fitcoin' that wasn't instituted, says these proceedings can be challenging because it can be difficult to prove a negative.

Not everyone has struggled to do this, however.

Rémi Jaffré, partner at Jenner & Block in New York, says his case involved a mark for an app, something which is typically only sold on a couple platforms such as Apple's App Store and Google Play.

He produced evidence that the app wasn't available in these stores and conducted Google searches to show that he couldn't find press releases announcing the app's release in the US, which allowed his client to prevail.

Petitioners may be able to convince the trademark office to institute proceedings if they can also demonstrate that specimens of use are suspicious.

Britt Anderson, partner at Perkins Coie in California, says it's not always possible to prove that specimens are fake. But an argument that a specimen is likely false is pretty compelling in showing that that the mark is not in use.

Preparing a good case may be just as much about how the information is organised as it is about what's in the petition, however.

Anderson says a lot of parties that didn't get their petitions instituted hadn't created organised indexes, which is important to do.

Growing pains

Compiling this information may be easier than it was a year ago.

Sources who filed in the early days of these proceedings point out that there were very few decisions that they could use to gauge what the office wanted, which made the process rather challenging. Now they can look at published rulings.

Jaffré at Jenner & Block points out that petitions are available on the [USPTO's website](#) and notes that lawyers should sort through them to see what arguments worked.

But some lawyers would like to see these proceedings become even easier in certain cases.

Frederic Rocafort, partner at Harris Bricken in Seattle who successfully filed an expungement petition against 'World Famous Salmon Tackle Salmon Snatcher Get Hooked Up', says the amount of work involved was a little too much.

That's because the case was clearcut, he says, though he notes that he is limited in what he can disclose about it.

"These proceedings are a very welcome development. But if I could add something to my wish list, I'd like there to be more streamlined proceedings when there's absolutely nothing out there that demonstrates use," he says.

When to file?

Until Rocafort and other petitioners get their wish lists, they'll have to make do with the proceedings as they are and figure out when to advise their clients to take advantage of them.

One factor that could come into play when making this decision is timing, as these processes aren't always the fastest option.

Anderson at Perkins Coie says that cancellation proceedings at the Trademark Trial and Appeal Board can actually be resolved faster than the TMA's in cases when registrants don't respond.

But he notes that if the trademark owner does respond, the TMA's expungement or re-examination procedures will be more efficient.

Others were pleased with the time that the USPTO took, however.

Heather Kliebenstein, partner at Merchant & Gould in Minneapolis who also worked on the petition against 'Wow no cow!', says the timelines were extremely reasonable, noting that litigation matters in district courts can take several years.

What do you want?

Lawyers also have to consider the goals of their clients when deciding whether to advise them to use these proceedings.

McFarland says such goals can include clearing a path for the client's own registration or taking out a threat in litigation.

There can be drawbacks to relying on these processes in disputes. Petitioners have no control over them once they're filed, which limits their ability to use these proceedings as leverage. They couldn't, for example, file a petition and offer to withdraw it if an adversary agreed to a settlement.

But McFarland says the expungement tool can be used to put additional pressure on an adversary. He notes that in broader disputes there can be numerous levers that may or may not bring parties closer to resolution.

"The expungement proceeding offers one more available and inexpensive lever to pull. If there are other things for your adversary to lose or gain, it can be an effective measure to coax a settlement agreement," he says.

Parties should also consider whether getting rid of marks is worth the work that counsel will put in and the subsequent cost to clients.

Robertson at Dorsey & Whitney says parties can't file something as a matter of form and put the burden on the trademark office to produce evidence.

"These are extensive endeavours," she says.

Those who are able to step up to the plate and put in the work have a decent chance of getting the results they want, however. With more than 200 petitioners to compare against, counsel can further hone their

strategies in the coming year.

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