

## Ex Parte Trademark Expungement and Reexamination

Management of a trademark portfolio is an ongoing process, in which hands-on knowledge of the relevant procedure is essential. The attorneys of Rothwell Figg's *Ex Parte* Trademark Expungement and Reexamination practice focus their work on the implementation of trademark strategies enabled by the most recent changes in trademark law. In doing this, they enable clients, when appropriate, to take quick, aggressive action in defense of their marks, or against fraudulent or unauthorized competitive marks.

Passed in 2020 and effective in 2021, the U.S. Trademark Modernization Act (TMA) ushers in new and bold changes in the federal trademark application and registration process. It will have a major impact on certain trademark-related activities, but like all game-changing updates in the law, it also has complexities and nuances that require informed, experienced guidance. At Rothwell Figg, that's what we provide.

These changes provide new methods to challenge a trademark application even before it is allowed and published, and to eliminate marks which no longer are in use by utilizing a simplified procedure.

Because our trademark team is among the nation's most experienced in challenging pending trademark applications and issued registrations at the U.S. Patent and Trademark Office (USPTO), we hit the ground running in navigating these procedures.

The Act adds new techniques to the process designated by the USPTO, such as Letters of Protest. We have long experience dealing with these Letters, and have seen and experienced the process gradually becoming broader and more useful. The changes to the law significantly expand the Letter of Protest process, giving us the tools to further help clients monitor, and as needed, act against infringing trademark applications by finding ways to bring information to the attention of the USPTO before they grant a competitor's application. Appropriately utilized, this can present clients with significant tactical opportunities and cost savings.

For marks already registered but which seem no longer to be in use, the law provides for a streamlined process for cancellation or "expungement." While this is new in the U.S., it echoes processes already in place in other countries, with which we are familiar and experienced. As practitioners, we are comfortable with the type of information which will justify the process, and have also had the chance to participate in expungement proceedings which have already existed in other countries. On the other hand, this process also makes registration from other countries more exposed to attack. We advise our clients on how to plan their applications and use of their marks in a way which will minimize the exposure to expungement whenever possible.

For example, we counsel brand owners that they must be extremely precise about claims that their marks are being used in commerce in the United States. Claims of use must be accurate for all the goods and services specified in their application. If some will not be offered in U.S. commerce, brand owners should remove them from filings.



In addition to the scope of our knowledge of the subject, our legal counsel concerning the potential utilization of the TMA is guided by a deep understanding of each client's business priorities and needs. As is true across our entire firm, we take care to bring a pragmatic, business-focused perspective to every engagement, and to ensure that trademarks, and the enterprises they represent, receive guidance that, above all, helps further their business goals.