

or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.

(July 5, 1946, ch. 540, title I, §16, 60 Stat. 434; Pub. L. 87-772, §11, Oct. 9, 1962, 76 Stat. 771; Pub. L. 97-247, §11, Aug. 27, 1982, 96 Stat. 321; Pub. L. 100-667, title I, §117, Nov. 16, 1988, 102 Stat. 3941; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583.)

#### PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §7, 33 Stat. 726.

#### AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner”.

1988—Pub. L. 100-667 substituted “used on or in connection with the goods or services” for “applied to the goods or when used in connection with the services”.

1982—Pub. L. 97-247 substituted “Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive” for “Whenever application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive, the Commissioner may declare that an interference exists”.

1962—Pub. L. 87-772 struck out “purchasers” after “or to deceive”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of Title 35, Patents.

#### EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

#### EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

#### REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

#### TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

### § 1066a. Ex parte expungement

#### (a) Petition

Notwithstanding sections 1057(b) and 1072 of this title, and subsections (a) and (b) of section

1115 of this title, any person may file a petition to expunge a registration of a mark on the basis that the mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.

#### (b) Contents of petition

A petition filed under subsection (a), together with any supporting documents, shall—

(1) identify the registration that is the subject of the petition;

(2) identify each good or service recited in the registration for which it is alleged that the mark has never been used in commerce;

(3) include a verified statement that sets forth—

(A) the elements of the reasonable investigation the petitioner conducted to determine that the mark has never been used in commerce on or in connection with the goods and services identified in the petition; and

(B) any additional facts that support the allegation that the mark has never been used in commerce on or in connection with the identified goods and services;

(4) include any supporting evidence on which the petitioner relies; and

(5) be accompanied by the fee prescribed by the Director.

#### (c) Initial determination; institution

##### (1) Prima facie case determination, institution, and notification

The Director shall, for each good or service identified under subsection (b)(2), determine whether the petition sets forth a prima facie case of the mark having never been used in commerce on or in connection with each such good or service, institute an ex parte expungement proceeding for each good or service for which the Director determines that a prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.

##### (2) Reasonable investigation guidance

The Director shall promulgate regulations regarding what constitutes a reasonable investigation under subsection (b)(3) and the general types of evidence that could support a prima facie case that a mark has never been used in commerce, but the Director shall retain the discretion to determine whether a prima facie case is set out in a particular proceeding.

##### (3) Determination by Director

Any determination by the Director whether or not to institute a proceeding under this section shall be final and non-reviewable, and shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding, except as provided in subsection (j).

#### (d) Ex parte expungement procedures

The procedures for ex parte expungement shall be the same as the procedures for examination

under section 1062(b) of this title, except that the Director shall promulgate regulations establishing and governing a proceeding under this section, which may include regulations that—

(1) set response and extension times particular to this type of proceeding, which, notwithstanding section 1062(b)(3) of this title, need not be extendable to 6 months;

(2) set limits governing the timing and number of petitions filed for a particular registration or by a particular petitioner or real parties in interest; and

(3) define the relation of a proceeding under this section to other proceedings concerning the mark.

**(e) Registrant's evidence of use**

A registrant's documentary evidence of use shall be consistent with when a mark shall be deemed to be in use in commerce under the definition of "use in commerce" in section 1127 of this title, but shall not be limited in form to that of specimens as provided in section 1051(a) of this title.

**(f) Excusable nonuse**

During an ex parte expungement proceeding, for a mark registered under section 1126(e) of this title or an extension of protection under section 1141f of this title, the registrant may offer evidence showing that any nonuse is due to special circumstances that excuse such nonuse. In such a case, the examiner shall determine whether the facts and evidence demonstrate excusable nonuse and shall not find that the registration should be cancelled under subsection (g) for any good or service for which excusable nonuse is demonstrated.

**(g) Examiner's decision; order to cancel**

For each good or service for which it is determined that a mark has never been used in commerce, and for which the provisions of subsection (f) do not apply, the examiner shall find that the registration should be cancelled for each such good or service. A mark shall not be found to have never been used in commerce if there is evidence of use in commerce by the registrant that temporally would have supported registration at the time the application was filed or the relevant allegation of use was made, or after registration, but before the petition to expunge was filed under subsection (a), or an ex parte expungement proceeding was instituted by the Director under subsection (h). Unless overturned on review of the examiner's decision, the Director shall issue an order cancelling the registration, in whole or in part, after the time for appeal has expired or any appeal proceeding has terminated.

**(h) Ex parte expungement by the Director**

**(1) In general**

The Director may, on the Director's own initiative, institute an ex parte expungement proceeding if the Director discovers information that supports a prima facie case of a mark having never been used in commerce on or in connection with any good or service covered by a registration. The Director shall promptly notify the registrant of such determination, at which time the ex parte

expungement proceeding shall proceed according to the same procedures for ex parte expungement established pursuant to subsection (d). If the Director determines, based on the Director's own initiative, to institute an expungement proceeding, the Director shall transmit or make available the information that formed the basis for that determination as part of the institution notice sent to the registrant.

**(2) Rule of construction**

Nothing in this subsection shall be construed to limit any other authority of the Director.

**(i) Time for institution**

**(1) When petition may be filed, ex parte expungement proceeding instituted**

A petition for ex parte expungement of a registration under subsection (a) may be filed, or the Director may institute on the Director's own initiative an ex parte expungement proceeding of a registration under subsection (h), at any time following the expiration of 3 years after the date of registration and before the expiration of 10 years following the date of registration.

**(2) Exception**

Notwithstanding paragraph (1), for a period of 3 years after December 27, 2020, a petition for expungement of a registration under subsection (a) may be filed, or the Director may institute on the Director's own initiative an ex parte expungement proceeding of a registration under subsection (h), at any time following the expiration of 3 years after the date of registration.

**(j) Limitation on later ex parte expungement proceedings**

**(1) No co-pending proceedings**

With respect to a particular registration, while an ex parte expungement proceeding is pending, no later ex parte expungement proceeding may be instituted with respect to the same goods or services that are the subject of a pending ex parte expungement proceeding.

**(2) Estoppel**

With respect to a particular registration, for goods or services previously subject to an instituted expungement proceeding for which, in that proceeding, it was determined that the registrant had used the mark for particular goods or services, as relevant, and the registration was not cancelled as to those goods or services, no further ex parte expungement proceedings may be initiated as to those goods or services, regardless of the identity of the petitioner.

**(k) Use in commerce requirement not altered**

Nothing in this section shall affect the requirement for use in commerce of a mark registered under section 1051(a) or 1091 of this title.

(July 5, 1946, ch. 540, title I, §16A, as added Pub. L. 116-260, div. Q, title II, §225(a), Dec. 27, 2020, 134 Stat. 2202.)

**EFFECTIVE DATE**

Section effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any

mark registered before, on, or after that effective date, see section 225(g) of div. Q of Pub. L. 116-260, set out as an Effective Date of 2020 Amendment note under section 1064 of this title.

#### REGULATIONS

Pub. L. 116-260, div. Q, title II, § 225(f), Dec. 27, 2020, 134 Stat. 2207, provided that: “Not later than 1 year after the date of enactment of this Act [Dec. 27, 2020], the Director shall issue regulations to carry out sections 16A and 16B of the Trademark Act of 1946 [15 U.S.C. 1066a, 1066b], as added by subsections (a) and (c).”

[For definitions of terms used in section 225(f) of Pub. L. 116-260, set out above, see section 222 of Pub. L. 116-260, set out as a note under section 1051 of this title.]

### § 1066b. Ex parte reexamination

#### (a) Petition for reexamination

Any person may file a petition to reexamine a registration of a mark on the basis that the mark was not in use in commerce on or in connection with some or all of the goods or services recited in the registration on or before the relevant date.

#### (b) Relevant date

In this section, the term “relevant date” means, with respect to an application for the registration of a mark with an initial filing basis of—

(1) section 1051(a) of this title and not amended at any point to be filed pursuant to section 1051(b) of this title, the date on which the application was initially filed; or

(2) section 1051(b) of this title or amended at any point to be filed pursuant to section 1051(b) of this title, the date on which—

(A) an amendment to allege use under section 1051(c) of this title was filed; or

(B) the period for filing a statement of use under section 1051(d) of this title expired, including all approved extensions thereof.

#### (c) Requirements for the petition

A petition filed under subsection (a), together with any supporting documents, shall—

(1) identify the registration that is the subject of the petition;

(2) identify each good and service recited in the registration for which it is alleged that the mark was not in use in commerce on or in connection with on or before the relevant date;

(3) include a verified statement that sets forth—

(A) the elements of the reasonable investigation the petitioner conducted to determine that the mark was not in use in commerce on or in connection with the goods and services identified in the petition on or before the relevant date; and

(B) any additional facts that support the allegation that the mark was not in use in commerce on or before the relevant date on or in connection with the identified goods and services;

(4) include supporting evidence on which the petitioner relies; and

(5) be accompanied by the fee prescribed by the Director.

#### (d) Initial determination; institution

##### (1) Prima facie case determination, institution, and notification

The Director shall, for each good or service identified under subsection (c)(2), determine whether the petition sets forth a prima facie case of the mark having not been in use in commerce on or in connection with each such good or service, institute an ex parte reexamination proceeding for each good or service for which the Director determines that the prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.

##### (2) Reasonable investigation guidance

The Director shall promulgate regulations regarding what constitutes a reasonable investigation under subsection (c)(3) and the general types of evidence that could support a prima facie case that the mark was not in use in commerce on or in connection with a good or service on or before the relevant date, but the Director shall retain discretion to determine whether a prima facie case is set out in a particular proceeding.

##### (3) Determination by Director

Any determination by the Director whether or not to institute a reexamination proceeding under this section shall be final and non-reviewable, and shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding, except as provided in subsection (j).

#### (e) Reexamination procedures

The procedures for reexamination shall be the same as the procedures established under section 1062(b) of this title except that the Director shall promulgate regulations establishing and governing a proceeding under this section, which may include regulations that—

(1) set response and extension times particular to this type of proceeding, which, notwithstanding section 1062(b)(3) of this title, need not be extendable to 6 months;

(2) set limits governing the timing and number of petitions filed for a particular registration or by a particular petitioner or real parties in interest; and

(3) define the relation of a reexamination proceeding under this section to other proceedings concerning the mark.

#### (f) Registrant's evidence of use

A registrant's documentary evidence of use shall be consistent with when a mark shall be deemed to be in use in commerce under the definition of “use in commerce” in section 1127 of this title, but shall not be limited in form to that of specimens as provided in section 1051(a) of this title.

#### (g) Examiner's decision; order to cancel

For each good or service for which it is determined that the registration should not have issued because the mark was not in use in com-