

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-

merce on or before the relevant date, the examiner shall find that the registration should be cancelled for each such good or service. 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) Reexamination by Director

(1) In general

The Director may, on the Director's own initiative, institute an ex parte reexamination proceeding if the Director discovers information that supports a prima facie case of the mark having not been used in commerce on or in connection with some or all of the goods or services covered by the registration on or before the relevant date. The Director shall promptly notify the registrant of such determination, at which time reexamination shall proceed according to the same procedures established pursuant to subsection (e). If the Director determines, based on the Director's own initiative, to institute an ex parte reexamination proceeding, the Director shall transmit or make available the information that formed the basis for that determination as part of the institution notice.

(2) Rule of construction

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

(i) Time for institution

A petition for ex parte reexamination may be filed, or the Director may institute on the Director's own initiative an ex parte reexamination proceeding, at any time not later than 5 years after the date of registration of a mark registered based on use in commerce.

(j) Limitation on later ex parte reexamination proceedings

(1) No co-pending proceedings

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

(2) Estoppel

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

(k) Supplemental register

The provisions of subsection (b) apply, as appropriate, to registrations under section 1091 of this title. Nothing in this section shall be construed to limit the timing of a cancellation action under section 1092 of this title.

(July 5, 1946, ch. 540, title I, §16B, as added Pub. L. 116-260, div. Q, title II, §225(c), Dec. 27, 2020, 134 Stat. 2205.)

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

Director required to issue regulations to carry out this section no later than 1 year after Dec. 27, 2020, see section 225(f) of Pub. L. 116-260, set out as a note under section 1066a of this title.

§ 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

(b) The Trademark Trial and Appeal Board shall include the Director, Deputy¹ Director of the United States Patent and Trademark Office² the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Secretary of Commerce, in consultation with the Director.

(c) AUTHORITY OF THE SECRETARY.—The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative trademark judge who, before August 12, 2008, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative trademark judge.

(d) DEFENSE TO CHALLENGE OF APPOINTMENT.—It shall be a defense to a challenge to the appointment of an administrative trademark judge on the basis of the judge's having been originally appointed by the Director that the administrative trademark judge so appointed was acting as a de facto officer.

(July 5, 1946, ch. 540, title I, §17, 60 Stat. 434; Pub. L. 85-609, §1(a), Aug. 8, 1958, 72 Stat. 540; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 96-455, §1, Oct. 15, 1980, 94 Stat. 2024; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4716], Nov. 29, 1999, 113 Stat. 1536, 1501A-580; Pub. L. 107-273, div. C, title III, §13203(a)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 110-313, §1(b), Aug. 12, 2008, 122 Stat. 3014.)

PRIOR PROVISIONS

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

AMENDMENTS

2008—Subsec. (b). Pub. L. 110-313, §1(b)(1), inserted "Deputy Director of the United States Patent and Trademark Office" after "Director," and substituted

¹ So in original. Probably should be preceded by "the".

² So in original. Probably should be followed by a comma.