

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Trademark Modernization Act of December 2020 - Summary

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# Trademark Modernization Act (TMA)

- Letters of protest
- Flexible response period
- Nonuse cancellation mechanisms
  - Expungement
  - Reexamination
- Presumption of irreparable harm
- USPTO Director's authority



**Letters of protest**

# Letters of protest - 15 U.S.C. §1051(f)

- Codifies an existing USPTO procedure.
  - TMEP Sections 1715 et seq.
- Third parties may submit to the USPTO **evidence relevant to a ground for refusal** of registration for any application.
- Determinations by the Director as to whether to include evidence in the record are **final and non-reviewable**.

# Letters of protest - 15 U.S.C. §1051(f)

- The Director must make a **decision** on a Letter of Protest **within two months** after the date of submission.
- TMA provides USPTO authority to prescribe a fee.
  - \$50 per submission as of the January 2, 2021 fee update; 37 C.F.R. §2.6(a)(25)

**Flexible response period**

# Flexible response period - 15 U.S.C. §1062(b)

- Allows USPTO to establish response periods for trademark matters that are shorter than six months, but no shorter than 60 days.
- Applicant may request extensions of time to respond – up to six months – with payment of a fee.
  - Director must allow extension upon compliance with timeliness and fee requirements. §1062(b)(3)



# Flexible response period - 15 U.S.C. §1062(b)

- Rulemaking conducted in 2021.
- All Office actions will have a three-month deadline; one extension of three months may be requested for a fee of \$125.
  - Excludes Madrid Protocol extensions of protection
- Effective date: December 1, 2022.

# **Nonuse cancellation mechanisms**

# New nonuse cancellation mechanisms

TMA creates two new mechanisms to challenge registrations for **nonuse**:

- **Section 16A – Expungement**, to allege a mark has **never been used** in commerce
- **Section 16B – Reexamination**, to allege a mark was **not in use on or before the “relevant date”**
  - Filing date for Section 1(a)-based registrations.
  - Deadline for filing SOU or the filing of an AAU for Section 1(b)-based registrations.

# New nonuse cancellation mechanisms

Petition to institute **must:**

- Identify registration
- Identify each good/service challenged
- Include verified statement regarding reasonable search conducted
- Include supporting evidence
- Include fee

# New nonuse cancellation mechanisms

- Overview of ex parte proceedings
- Who may initiate?
  - Any person
  - The Director
- What registrations may be challenged?
  - Expungement: Sections 1, 23, 44 or 66 registrations
  - Reexamination: Sections 1 or 23 registrations
- When?
  - Expungement: year three to year 10
  - Reexamination: until year five

# New nonuse cancellation mechanisms

## Overview of ex parte proceedings

- **Result?**
  - Cancellation in whole or in part.
- **Appeal?**
  - From the examiner to the Trademark Trial and Appeal Board and, if dissatisfied, to U.S. Court of Appeals for the Federal Circuit.
- **Abuse?**
  - Estoppel as to the same goods/services.
  - Limits on petitions may be set by regulation.



# Cancellation action at TTAB

- Expungement ground for challenge: “never been used in commerce” 15 U.S.C. §1064(6).
- Excusable nonuse due to special circumstances will be a defense with respect to challenged registrations issued on the basis of a foreign or international registration (Sections 44/66 of the Act).

**Presumption of irreparable harm,  
Director's authority**



# Rebuttable presumption

Section 34(a), 15 U.S.C. §1116(a), is amended to add:

“A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation identified in this subsection[.]”

# Rebuttable presumption

- Although *eBay v. MercExchange, L.L.C.* 547 U.S. 388 (2006) involved *patent* infringement, some courts stopped applying the previously recognized presumption in trademark cases.
- The TMA codified this presumption for trademark cases.

# Confirmation of Director's authority regarding TTAB decisions

- *"The authority of the Director under this section includes the authority to reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board"*
- *"The Director may reconsider, and modify or set aside, a decision of the Trademark Trial and Appeal Board under this section."*

# TMA Resources

# USPTO's TMA information page

The screenshot shows the top portion of the USPTO website. On the left is the USPTO logo with the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. To the right are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. Below these is a search bar with the text 'Search uspto.gov' and a magnifying glass icon. A navigation bar contains links for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. Below the navigation bar is a blue breadcrumb trail: 'Home > Trademarks > Laws > USPTO implements the Trademark Modernization Act'. To the right of the breadcrumb are 'Share' and 'Print' icons.

## Main menu

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[IP Policy](#)

[Learning and Resources](#)

[About Us](#)

[Jobs](#)

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[Expungement and reexamination petitions received](#)

## USPTO implements the Trademark Modernization Act

Regulations implementing the [Trademark Modernization Act of 2020](#) (TMA) went into effect on December 18, 2021. Individuals, businesses, and the United States Patent and Trademark Office (USPTO) now have new tools to clear away unused registered trademarks from the federal trademark register and the USPTO has the ability to move applications through the registration process more efficiently.

Read the [final rule](#) to learn more about these changes. A summary of the new features is provided below.

### New procedures

#### Two ex parte proceedings to cancel unused registered trademarks

The new ex parte expungement and reexamination proceedings provide a faster, more efficient, and less expensive alternative to a contested inter partes cancellation proceeding at the Trademark Trial and Appeal Board (TTAB).

#### Expungement proceeding

