

# Changes to implement provisions of 2020 Trademark Modernization Act (TMA)

Amy P. Cotton

Deputy Commissioner for Trademark Examination Policy

June 2021

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Notice of proposed rulemaking (NPRM)

- Contains draft rules on:
  - Letters of protest
  - Response times for office actions
  - New ex parte nonuse proceedings
  - Attorney recognition for representation
  - Court orders concerning registrations



# NPRM

- All proposed rules in the NPRM are subject to change.
- Rules will not take effect until date indicated in the final rule.
- Roundtable comments are considered informal and will not form part of the formal rulemaking record unless submitted in writing to [regulations.gov](https://www.regulations.gov).

**Letters of protest**



# Letters of protest rule

- Third-party protest
  - Third parties may submit for consideration for inclusion in the record evidence relevant to a ground for refusal of registration.
    - NPRM amends existing rule to indicate that letter-of-protest determinations are final and non-reviewable.

**Flexible response period**

# Flexible response period rule

- NPRM describes three options.
- All options apply to both applications and post-registration office actions.
- Shortened response periods would not apply to Section 66a applications.



# Flexible response period rule

- Options:
  1. Three-month response period, with one extension
  2. Two-phase examination
  3. Patent model



**Nonuse cancellation mechanisms**



# Nonuse cancellation mechanisms

- New proceedings available
  - Expungement
    - Also a new claim at the Trademark Trial and Appeal Board (TTAB)
  - Reexamination



# Nonuse cancellation mechanisms

- Filing a petition
  - \$600 per class
  - USPTO.gov account
  - Petitioner's name, domicile address, and email address
  - Verified statement
  - Documentary evidence of nonuse



# Nonuse cancellation mechanisms

- Reasonable investigation sources
  - State and federal trademark records
    - Other regulatory filings
  - Websites or print sources
    - Controlled by registrant
    - Where relevant goods/services likely offered for sale
    - Where reviews or discussion of relevant goods/services are likely



# Nonuse cancellation mechanisms

- Reasonable investigation sources
  - Registrant's marketplace activities
    - Including attempts to purchase
  - Litigation or administrative proceeding records



# Nonuse cancellation mechanisms

- **Prima facie case**
  - USPTO Director decides whether prima facie case is made
  - If prima face case is made, Director must institute proceedings
  - Director's decision to institute is final and non-reviewable
- **Institution**
  - Office action issues with two-month response period



# Nonuse cancellation mechanisms

- Registrant's response
  - Acceptable response options:
    - Documentary evidence of use
    - Verified statement and evidence of excusable nonuse
      - Applies only to Section 44 or 66 registrants in an expungement proceeding
    - Deletion of goods or services
  - If acceptable, proceedings terminate

# Nonuse cancellation mechanisms

- Registrant's response
  - Non-response
    - Failure to respond results in **immediate** cancellation in whole or in part
  - Unacceptable response
    - Final action issues, continuing requirements, with two-month response period



# Nonuse cancellation mechanisms

- Response to final action
  - Request reconsideration
  - Appeal to TTAB



# Nonuse cancellation mechanisms

- Estoppel
  - Goods and services for which use in commerce has already been established cannot be subject to further proceedings

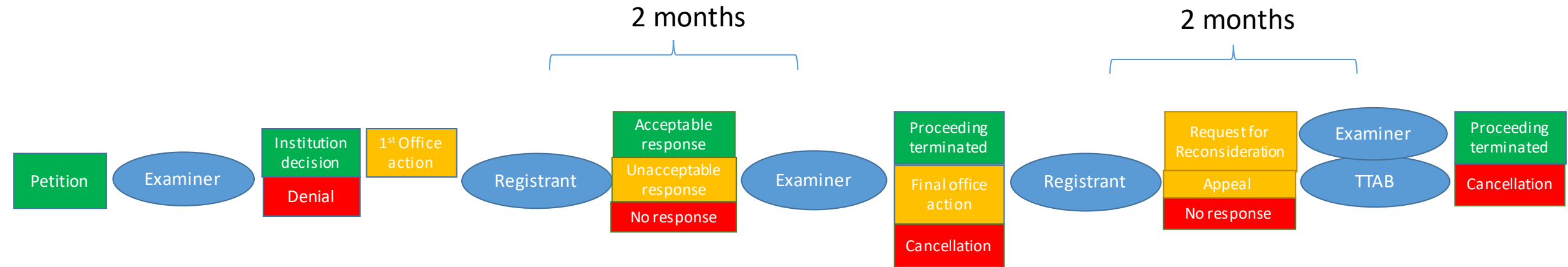
# Nonuse cancellation mechanisms

- Relationship to other proceedings
  - Expungement and reexamination proceedings are included among the types of proceedings for which suspension of action by the Trademarks organization or the TTAB is authorized.
  - TTAB will suspend proceedings when another proceeding that is relevant to registrability (not limited to same party/parties) is ongoing.





# Nonuse cancellation mechanisms



# **Attorney recognition for representation**

# Recognition for representation

- Recognition for representation continues until revocation or withdrawal
  - Owners and attorneys must proactively file revocation or withdrawal documents.



# Withdrawal from representation

- Clarifying attorney obligations for withdrawal
  - Rule differentiates the grounds under which the attorney may request to withdraw versus those situations where an attorney must request withdrawal.

# Court orders





# Court orders

- Codifying USPTO's longstanding procedures concerning action on court orders cancelling or affecting a registration
  - The USPTO requires submission of a certified copy of the court order and normally does not act on such orders until the case is finally determined.



# NPRM comments

- Send formal comments to [www.regulations.gov](http://www.regulations.gov)
- Docket number PTO-T-2021-0008
- <https://www.federalregister.gov/public-inspection/2021-10116/changes-to-implement-provisions-of-the-trademark-modernization-act>
- Deadline for formal comments: July 19, 2021

# TMA resources

- USPTO website
  - <https://www.uspto.gov/trademarks/laws/2020-modernization-act>
  - Public roundtables on June 1 and June 14, 2021
  - Send questions to [TMFeedback@uspto.gov](mailto:TMFeedback@uspto.gov)
- TMA legislation
  - <https://www.congress.gov/116/cprt/HPRT42770/CPRT-116HPRT42770.pdf#page=2606>
- TMA Committee Report
  - <https://www.congress.gov/116/crpt/hrpt645/CRPT-116hrpt645.pdf>



# Letter of protest and response period rules

	<b>Conforming amendment to rule for letters of protest</b>
<b>37 C.F.R. § 2.149</b>	Protest determination is final and non-reviewable
	<b>Conforming amendments for shortened response periods</b>
<b>37 C.F.R. § 2.62</b>	Three-month response period for responses to Office actions in applications under sections 1 and/or 44 of the Act; three month extension available
<b>§ 2.63</b>	Fee for requesting extension to file response
<b>§ 2.65</b>	Application abandons for failure to respond to office action within relevant time period of response, including extensions of time to respond
<b>§ 2.66</b>	Petition to revive must include the extension fee if request for extension filed after the three-month response period
<b>§ 2.141; 2.142</b>	Appeal to TTAB from ex parte refusal made within time period for response including any granted extension of time to respond or appeal
<b>§ 2.163; 2.165; 2.184; 2.186; 7.39; 7.40</b>	Three-month response period for responses to post-registration office actions; three month extension available
<b>§ 2.6; 7.6</b>	Fee for extensions

# Nonuse cancellation rule sections

	<b>New rules for nonuse cancellation</b>
<b>37 C.F.R. § 2.91</b>	Requirements for a petition requesting the institution of expungement or reexamination
<b>§ 2.92</b>	Institution of expungement and reexamination proceedings
<b>§§ 2.93 - 2.94</b>	Procedures for expungement and reexamination proceedings
<b>§ 2.143</b>	Appeals to the TTAB in connection with these new proceedings
	<b>Conforming amendments</b>
<b>§ 2.11</b>	U.S. counsel for foreign-domiciled petitioners and registrants
<b>§ 2.23</b>	Duty to monitor the status of a registration
<b>§ 2.67; 2.117</b>	Suspension of proceedings
<b>§ 2.111</b>	Timing of petition to cancel at the TTAB for expungement
<b>§ 2.141 – 2.142</b>	Time and manner of ex parte appeals
<b>§ 2.145</b>	Appeals to the U.S. Court of Appeals for the Federal Circuit
<b>§ 2.146</b>	Petitions to the Director
<b>§ 2.193</b>	Signature requirements

# Recognition and court order rules

	Recognition of representation and withdrawal
<b>37 C.F.R. § 2.17</b>	Fraudulent designation of representative is ineffective; recognition continues until representative withdraws from representation
<b>§ 2.18</b>	Correspondence only with representative; exception for service of notice of cancellation and notices of institution of expungement/reexamination proceedings
<b>§ 2.19</b>	Withdrawal; no withdrawal needed if recognition is ineffective

	Court orders rule change
<b>37 C.F.R. § 2.177</b>	Court orders concerning registrations must be certified and sent to Director after the proceeding is finally determined

