Trademark Modernization Act (TMA)

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Register protection

• Why does accuracy matter?
  – Trademark register is meant to be a reliable reflection of marks in use in commerce
  – Inaccurate or improper use claims:
    • Could result in loss of registration
    • Contribute to a cluttered trademark register
    • Diminish the register’s utility to business and public
Register protection

• Why does register integrity matter?
  – Obtaining registration by improper means gives bad actors an unfair advantage over competitors.
  – Challenging improperly granted registrations is costly for businesses.
Register protection

• Deter bad behavior
  – Special task force
  – Database login
  – Publicizing scams

• Improve accuracy
  – Post-registration audit
  – U.S. counsel rule
  – Specimen refusals
  – TMA
Register protection

• TMA provides us with updated tools.
  – Letters of protest
  – Flexible response period
  – New nonuse cancellation mechanisms
Letters of protest

• Third parties may submit for consideration for inclusion in the record evidence relevant to a ground for refusal of registration.
  – Two-month deadline
  – $50 per submission
Flexible response period

- Increase examination efficiency.
  - Authority to shorten six-month response period, but not less than 60 days
  - Extensions available up to full six months
  - Fee for extensions
Nonuse cancellation mechanisms

• New proceedings available
  – Expungement
    • Targets trademarks that have never been used in commerce.
      – Also available as a new claim at the Trademark Trial and Appeal Board (TTAB)
  – Reexamination
    • Targets trademarks that were not in use on or before the “relevant date.”
Nonuse cancellation mechanisms

• Petition/request requirements:
  – Identify registration.
  – Identify each good or service challenged.
  – Include verified statement regarding reasonable search conducted.
  – Include supporting evidence.
  – Pay fee.
Nonuse cancellation mechanisms

• Who may initiate?
  – Any person
  – The Director

• What may be challenged?
  – Expungement: Sections 1, 23, 44, or 66
  – Reexamination: Sections 1 or 23
Nonuse cancellation mechanisms

• When may they be filed?
  – Expungement: between 3-10 years after registration
  – Reexamination: between 0-5 years after registration

• What are the available remedies?
  – Cancellation in whole or in part
Nonuse cancellation mechanisms

• What is the appeal process?
  – From the Director to the TTAB and then the Court of Appeals for the Federal Circuit

• What prevents abuse of the process?
  – Estoppel as to the same goods or services
Nonuse cancellation mechanisms

• Rules
  – Must include:
    • What constitutes reasonable investigation
    • What constitutes acceptable types of evidence
  – May include:
    • Response and extension times
    • Limits on timing and number of petitions
    • Relationship to other proceedings
TMA implementation

• Notice of Proposed Rulemaking
  – Spring, 2021

• Deadline for implementation
  – December 27, 2021
USPTO resources and feedback

• USPTO external site

• USPTO feedback
  – Send input to TMFeedback@uspto.gov.