

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.
 - Scams of United States Patent and Trademark Office (USPTO) customers erode trust.



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
 - <https://www.uspto.gov/trademarks/laws/2020-modernization-act>
- USPTO feedback
 - Send input to TMFeedback@uspto.gov.



