
Cantor Colburn Client Alert: Top 5 Changes in the Trademark Modernization Act that Trademark Owners Need to Know

Summary

On November 17, 2021, the United States Patent and Trademark Office (USPTO) finalized a series of new rules implementing the provisions of the Trademark Modernization Act (TMA). Many of these new rules have significant impact to trademark stakeholders. Five of the most important changes are discussed below.

1. Flexible Office Action Response Periods - Effective Date: December 1, 2022

The TMA changes the response period for office actions issued in national applications (those based on use in commerce, intent to use, or based on foreign registration) to three months, with an available three-month extension (for an additional fee).

This reduces the current six-month response period by half. Applicants may request a single three-month extension of the three-month deadline, subject to a fee. To be considered timely, the request for an extension must be received by the USPTO on or before the deadline for response. As with current law, if the applicant fails to respond or request an extension, the application will be abandoned.

The same three-month response period and single three-month extension apply to post-registration review and maintenance filings.

Pending and registered Extensions of Protection of and International Registrations are not subject to the new three-month deadline; deadlines will remain at six months for such Extensions.

2. New Ex Parte Proceedings - Effective Date: December 18, 2021

The TMA creates two new Ex Parte proceedings: 1) Petition for Expungement and 2) Petition for Reexamination. These proceedings allow a third party to challenge a registration for nonuse, subjecting the registration to re-examination by the USPTO, and cancellation in its entirety or with respect to certain goods or services.

A Petition for Expungement must allege that the registered trademark has never been used in commerce on or in connection with some or all of the goods and/or services listed in the registration.

A Petition for Reexamination must allege that the trademark was not in use in commerce with some or all of the goods and/or services listed, on or before the “relevant date,” which is determined as follows:

- For use-based application/registrations (Section 1(a)), the “relevant date” is the filing date of the application.
- For intent to use based applications/registrations (Section 1(b)), the “relevant date” is the later of the filing date, or the expiration of the deadline for filing a statement of use, including all approved extensions.

In addition to formalities, these Petitions must include a verified statement that sets forth in numbered paragraphs:

- i. The elements of the reasonable investigation of nonuse the petitioner conducted, and, for each source of information relied upon, a description of how and when the searches were conducted and what the searches disclosed;

- ii. A concise factual statement of the relevant basis for the petition, including any additional facts that support the allegation of nonuse of the mark in commerce on or in connection with the relevant goods and services; and
- iii. A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence

Successful assertion of a bona fide claim as noted above will institute the Ex Parte proceeding, which is then handled exclusively between the USPTO and the Registrant; there is no further participation by the Petitioner. Failure by a Registrant to comport with the additional requirements by the USPTO to establish use of the mark in commerce at the relevant time (or to sufficiently establish excusable nonuse, if applicable) will result in cancellation of the relevant registration, in whole or in part.

3. New nonuse Ground for Cancellation - Effective Date: December 18, 2021

The TMA creates a new nonuse ground for cancellation, allowing a petitioner to allege that a mark has never been used in commerce as a basis for cancellation before the Trademark Trial and Appeal Board (TTAB), available any time after the first three years from the registration date.

4. Codifying Existing Practice Regarding Letters of Protest - Effective Date: December 18, 2021

The TMA codifies existing procedure which allows third parties to submit to the USPTO to protest a pending trademark application on “any reasonable ground” for refusal appropriate in ex parte examination. The TMA also authorizes the USPTO to charge a fee for letters of protest.

5. Presumption of Irreparable Harm - Effective Date: Immediately (December 27, 2020)

The TMA codifies existing procedure which grants plaintiffs a presumption of irreparable harm upon any violation of the Lanham Act in Trademark Infringement Actions. A plaintiff seeking injunctive relief is entitled to a rebuttable presumption of irreparable harm upon finding of a violation, which lowers the burden of proof necessary for plaintiffs seeking injunctive relief. This effectively should make injunctions easier to procure in trademark infringement cases.

What This Means to You

Overall, brand owners can expect the TMA to aid in protecting their trademarks and consumers. Cantor Colburn has reviewed the provisions closely and is prepared to incorporate the new procedures into our practice.

For Further Information and Assistance

Cantor Colburn’s [Trademark & Copyright Practice](#) has substantial experience representing clients in trademarks matters of all kinds; in fact, the firm is the #8 trademark law firm in the U.S. Please do not hesitate to contact [Michelle Ciotola](#), at mciotola@cantorcolburn.com and +1 (860) 286-2929, ext. 1229 or your Cantor Colburn attorney with any questions you may have regarding this matter and your IP in general.

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.