

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

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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

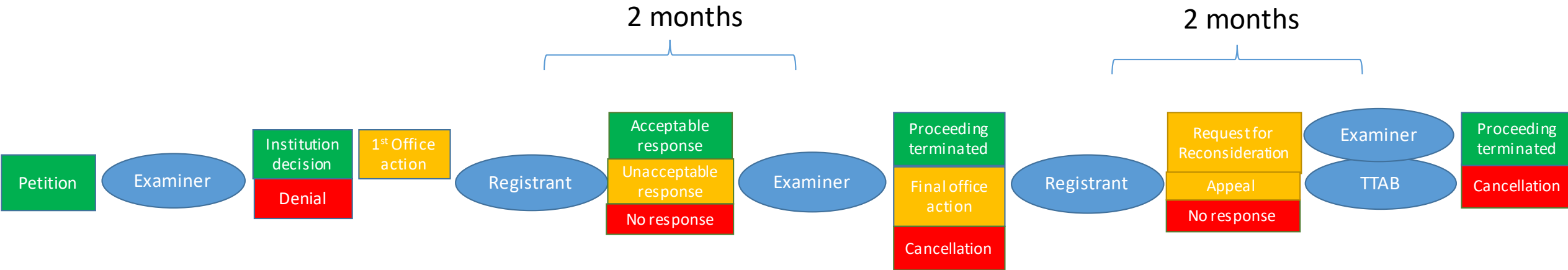
- Estoppel
 - Goods and services for which use in commerce has already been established cannot be subject to further proceedings

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
- 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
- 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

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

Nonuse cancellation rule sections

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

Recognition and court order rules

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

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

