

Publications

TMA: A Year in Review

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CLIENT ALERT | 1.9.2023

It has been one year since the remaining provisions of the Trademark Modernization Act (TMA) went into effect at the end of 2021. When crafting the TMA, lawmakers sought to speed up the trademark examination process and give the Director of Trademarks and other third parties more tools to challenge unused marks on the register. Despite these efforts, trademark applicants are seeing longer delays than ever in getting their applications across the registration finish line—sometimes waiting up to a year for their applications to be assigned to an examining attorney.

The TMA made the following changes:

New Shortened Office Action Response Period

As of December 1, 2022, Applicants have three months instead of six to respond to office actions. If the applicant is unable to respond in three months, they can pay a fee for a three-month extension (meaning, effectively, they can obtain the original six months to reply). The additional fee is intended to discourage applicants from waiting to respond. This shorter deadline will speed up the examination of pending applications, as applicants are likely to respond to outstanding issues much sooner.

Letters of Protest Codified

Third parties may submit evidence to the Director via a mechanism called a "Letter of Protest" detailing why a pending application is ineligible for registration. Letters of Protest preexisted the TMA, but the TMA codified the procedure and instituted a new deadline. Now, the Director of Trademarks must issue a decision within two months of receipt of a Letter of Protest. If the Director agrees with the evidence therein, the Director can then forward some or all of the evidence to the examining attorney to consider during examination. This procedure can speed up the issuance of a refusal against a pending application as it places evidence of grounds for refusal in the examiner's lap. This is of great utility to owners of trademark registrations, as it is less expensive to ask the Trademark Office to issue refusals based on earlier marks

than file oppositions as a first step. It also highlights the importance of having watch services in place in order to act early on concerning new applications.

Ex Parte Proceedings a Cheaper Alternative to Cancellations

When a mark appears to no longer be in use, third parties may now seek expungement or reexamination proceedings. This abridged proceeding is a much cheaper alternative to filing a cancellation action. The petitioner must present a prima facie case of nonuse to be successful. A reexamination proceeding must be filed within the first five years of registration, and an expungement proceeding can only be filed between three and 10 years after the date of registration.

Uptick in Registration Audits

Although not a part of the TMA, registration holders may have noticed an uptick in registration audits, particularly in the last two years. Since launching the Post-Registration Audit Program in 2017, the U.S. Patent and Trademark Office (USPTO) has audited 23,825 trademark registrations. The USPTO audits trademark registrations at random at the point of renewal. Owners will receive a post-registration office action requiring evidence of use in commerce of the selected goods or services. Owners may delete the audited goods and services if they do not have evidence of use, but they will have to pay a fee. On average, 47% of responses to random audits in 2022 resulted in deletion of all or part of the audited goods or services. Trademark owners should anticipate audits and may consider voluntarily delete goods or services no longer in use upon renewal to avoid paying additional fees as the result of an audit.

Vorys attorneys are available to advise on the new proceedings and deadlines available under the TMA.

Our prior *Client Alerts* on the TMA are included below:

11.23.2021: New Year, New USPTO: Petitions for Challenging Unused Marks Under TMA Accepted Starting December 27, 2021

5.27.2021: Prove It or Lose It: TMA Provides New Tools to Sweep Away Deadwood Marks, Settles Circuit Split over Injunctive Relief Burden of Proof