



Insights: Perspectives

4 Key Takeaways | Trademark Modernization Act of 2020

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Written by **Christopher P. Bussert** and **Theodore H. Davis Jr.**

4 KEY TAKEAWAYS

Trademark Modernization Act of 2020

Kilpatrick Townsend partner [Ted Davis](#) and senior counsel [Chris Bussert](#) recently presented an audio seminar for West/Thomson Reuters. The title of the seminar was *The Trademark Modernization Act of 2020: What Practitioners Need to Know* and the speakers provided guidance on the key aspects of the new legislation including clarification of the status of the presumption of irreparable harm in litigation as well as its new prosecution and ex parte invalidation procedures.

Mr. Davis and Mr. Bussert offer four key takeaways regarding this subject:

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TMA 2020 has either restored or confirmed (depending on the jurisdiction) the presumption of irreparable harm where a violation of the Lanham Act has been shown. However, trademark owners are well advised not to ignore the importance of submitting any available evidence of irreparable harm in trademark infringement matters, rather than relying solely on the presumption. Doing so is particularly important in matters where the opposing party seeks to rebut the presumption in responsive pleadings. It also may be advantageous in jurisdictions like the Ninth Circuit that had previously abandoned the presumption and may, at least initially, respond in a tepid manner to its reapplication.

TMA 2020 provides two new mechanisms for challenging registrations where substantial questions exist whether the subject mark was used in commerce:

- The first is a procedure for ex parte reexamination that permits challenges to use-based registrations issued under Section 1(a) of the Lanham Act on the ground that the subject mark was not used in commerce at the time the application was filed (if use was averred there), or alternatively, as part of the amendment to allege use or statement of use submitted during prosecution of an application originally filed under Section 1(b).
- The second is a procedure for ex parte expungement, which permits challenges to registrations covering marks that have never been used in commerce. The primary purpose of the expungement option is to target registrations obtained by foreign-based businesses under either Section 44(e) or Section 66(a) of the Lanham Act.

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TMA 2020 codifies existing letter of protest procedures, which allow third parties to raise certain challenges to pending applications during examination. Under TMA 2020, third parties may submit for consideration evidence relevant to a ground for refusal. Within two months after the date on which that submission is filed, the Director will determine whether to include that evidence in the record of the subject application.

Under TMA 2020, the Director has been provided flexibility to establish shorter deadlines in responding to office actions of not less than sixty days, which may be extended at the request of the applicant for an aggregate of up to six months from the issuance of the original office action, upon payment of a fee prescribed by the Director.

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For more information, please contact:

Chris Bussert, cbussert@kilpatricktownsend.com

Ted Davis, tdavis@kilpatricktownsend.com

www.kilpatricktownsend.com

Related People



Christopher P. Bussert

t 404.815.6545

cbussert@ktslaw.com



Theodore H. Davis Jr.

t 404.815.6534

tdavis@ktslaw.com