

## Joseph Matal in National Law Journal: 'Trademark Modernization Act a Game Changer, Ex-PTO Leader Says'

---

December 28, 2020

---

**PRACTICES** Intellectual Property, Trademark Prosecution, Trademark and Advertising

---

Haynes Boone Partner Joe Matal was featured prominently in an article in *The National Law Journal* about how trademark legislation contained in Congress' coronavirus relief package offers some powerful tools for policing infringement and clearing fraudulent registrations from the U.S. Patent and Trademark Office's (USPTO's) books.

Below is an excerpt:

Haynes Boone Partner Joseph Matal, who was acting director of the agency in 2017, said the Trademark Modernization Act "is a big deal."

"There's a lot of deadwood on the register"—registered trademarks that aren't being used or never have been used, Matal said. They're the result of false or fraudulent statements or photographs, often originating in China, that block new market entrants from claiming the mark, according to the legislative sponsors.

The new law, assuming it's signed by the president, will create two mechanisms for clearing them cheaply and efficiently, Matal said.

The first is reexamination. The PTO can determine that a trademark never should have been issued if there is no proof the mark was in use at the time of registration. Challengers will have only five years from the time of registration to request reexamination.

The second mechanism is expungement. A challenger will have to show that the registrant never used the mark. The registrant will have an opportunity to rebut that showing.

"The advantage of these proceedings is they're ex parte. There's no discovery," Matal said. Formal cancellation proceedings "are a lot more expensive."

Separately, the TMA clarifies that, notwithstanding the *U.S. Supreme Court's eBay v. MercExchange* decision limiting injunctions in patent cases, a trademark violation creates a rebuttable presumption of irreparable harm. This will make it much easier for mark owners to enjoin infringing conduct when they've proved violations.

That's important because damages are hard to measure and prove in trademark cases. Many times, "what you really want is the injunction to stop that person from infringing," Matal said.

The TMA's sponsors include Rep. Hank Johnson, chairman of the House Judiciary's Subcommittee on the Courts, Intellectual Property and the Internet, and Sen. Thom Tillis, chairman of the Senate's IP subcommittee.

Matal said it was notable that the reexamination and expungement provisions benefit as-yet-unknown market entrants who by definition don't possess political clout. "Chairman Johnson deserves to be commended for seeing this through," Matal said.

Two copyright provisions also added to the coronavirus relief bill are proving more controversial. One is a measure put together just in the last several weeks that will make it a felony to stream unauthorized copyrighted works for profit. The second measure will establish a voluntary small claims process to help individual creators and small businesses resolve copyright disputes quickly and at reasonable cost, according to Tillis, who sponsored the measure with Sens. John Kennedy, Dick Durbin and Mazie Hirono.

Matal said he did not expect the streaming bill to have broad impact, in part because it can only be enforced by the Department of Justice. "They have other things to do," Matal quipped. "It would have to be a pretty big criminal enterprise" for the DOJ to intervene.

To read the full article, click [here](#).