

Joseph Matal in WIPR: ‘Trademark Modernization Act: A Year of ‘Brand Housekeeping’ Ahead’

January 19, 2022

PRACTICES Intellectual Property, Trademark and Advertising

As the enforcement of the U.S. Trademark Modernization Act heralds changes for brand safeguarding, attorneys predict opportunities but also marked challenges.

The [USPTO’s Trademark Modernization](#) Act (TMA) will deliver some of the most sweeping changes to federal trademark law in decades.

As a result of the act, the [U.S. Patent and Trademark Office](#) (USPTO) will be able to use new methods to clear away unused registered trademarks from the federal trademark register and third parties will have new grounds to file trademark cancellation actions with the [Trademark Trial and Appeal Board](#).

Haynes Boone Partner and former USPTO Acting Director [Joseph Matal](#) explains: “For trademark attorneys and applicants, the most immediate effect of the new rules is that they must now respond to an office action within three months rather than six.

“They can get a three-month extension that will effectively entitle them to the prior law’s full six months, but they must file the request for the extension within the new three-month deadline, and they will have to pay a fee.”

The new *ex parte* expungement and reexamination proceedings, he predicts, should help clear the increasing amount of “deadwood” on the trademark register. “More and more prime trademark terms are being taken up by people who are not using the marks in commerce. These proceedings will provide a cheap and efficient way to challenge marks that have never been used in commerce or that were not used at the relevant time,” he explains.

According to Matal, the act will generate many benefits for brands.

“The USPTO has tailored the rules with an eye toward encouraging their robust use and turned down several appeals from sceptics who wanted to cabin the new proceedings,” he says.

“For example, it declined to impose a limit on the number of petitions that can be filed, instead waiting to see how the proceedings are actually used; and it cut the filing fee by one third to just \$400, recognising the public benefit of the use of these proceedings.”

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