

NIESAR & VESTAL LLP

Law Alert

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The Trademark Modernization Act of 2020 amends existing trademark law

The Trademark Modernization Act of 2020 (the “**Act**”) is now the law of the land. The Act provides a number of significant amendments to the Lanham Act that can impact the viability of trademark owner’s registration.

Cancellation Based on Non-Use

Registrations can now be cancelled on the basis of three years of non-use. Heretofore, a cancellation proceeding relating to non-use could only be brought if the petitioner established such non-use coupled with proof that the registrant had no intention to resume use.

The Act provides an exception for foreign or Madrid Protocol registrations (Sections 44(e) or 6). These registrations cannot be cancelled if the registrant can demonstrate that non-use is due to special circumstances that excuse such non-use.

Expungement of Goods or Services

Under a new procedure, a party can seek to expunge some goods or services listed in a registration, if they have never been used in interstate commerce. Thus, if an applicant states in its application that the mark has been used on multiple goods or services, and the mark in question was never actually used in connection with some of these goods or services in interstate commerce, these goods or services can be removed from the registration via this procedure.

Reexamination Procedure

Any party can request a Reexamination of a registration on the ground that the mark in question was never used prior to registration, though this proceeding must be brought prior to the fifth-year anniversary of the registration.

In view of this new law, we suggest the following:

1. As to marks which allege use in commerce, only list marks that have been in actual use in interstate commerce.
2. As to marks filed on the basis of a foreign registration or Madrid Protocol registration, periodically monitor the use of the marks in question. And, if no use has been made of a particular mark for three years, consider re-filing a trademark application.

If you have any questions regarding the above-mentioned Act or its application, please feel free to contact Jay Begler (jbegler@nvlawllp.com) or Oscar Escobar (oesobar@nvlawllp.com).

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