



5 KEY TAKEAWAYS

Combating Misrepresentations in Trademark Prosecution and Maintenance: The Trademark Modernization Act and Beyond

[Kilpatrick Townsend's Ted Davis](#) and [Rita Weeks](#) recently presented on the topic of “Combating Misrepresentations in Trademark Prosecution and Maintenance: The Trademark Modernization Act and Beyond.” [The Trademark Modernization Act \(TMA\)](#), many aspects of which went into effect December 27, 2021, implemented numerous changes to U.S. trademark practice, including codification of letters of protest, changes to the response deadlines for office actions, clarification of the presumption of irreparable harm, and, perhaps, most significantly, the introduction of new ex parte expungement and reexamination proceedings. Roughly contemporaneously with the enactment and implementation of the TMA, the United States Patent and Trademark Office (USPTO) implemented a sanctions program targeting “improper filing schemes.” And, in a related development, the Trademark Trial and Appeal Board (TTAB) has held that a reckless disregard of the truth can constitute an intent to deceive the USPTO for purposes of fraud-based attacks on applications and registrations.

Mr. Davis and Ms. Weeks gave an overview of these developments and discussed strategies and best practices in light of these changes. Key takeaways from the discussion, include:

1

Dramatic increases in the numbers of applications to register trademark and service marks in the USPTO are straining that agency's resources and delaying its processing of filings.

In responding with the TMA of 2020, Congress enacted the most substantive reforms to U.S. trademark law since the Trademark Law Revision Act in 1988.

2**3**

The USPTO has now implemented many aspects of the TMA through administrative rulemaking, including the new ex parte expungement and reexamination proceedings, several of which have been successfully initiated.

The implementation of the TMA is not the only step the USPTO has taken recently to battle misrepresentations in trademark prosecution practice, for it also has greatly expanded its administrative sanctions process.

4**5**

The TTAB has stepped in as well by liberalizing the test for fraudulent procurement and maintenance of registrations.



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