

## **Changes to The Lanham Act? - What you Need to Know**

**Erica L. Loeffler, Esq.**

The Lanham Act (“Trademark Act”) was modified when the Trademark Modernization Act of 2020 (TMA) became law on December 27, 2020. The TMA clarifies and restores the rebuttable presumption of irreparable harm to obtain injunctive relief for a trademark violation, revises certain prosecution procedures before the USPTO, and establishes new procedures for third parties to challenge fraudulent applications and registrations.

First, The TMA clarifies that irreparable harm can be presumed in requests for injunctive relief upon a finding of trademark infringement. Following the U.S. Supreme Court’s decision *in Ebay Inc. v. MercExchange*, 547 U.S. 388 (2006), the courts have been split on whether harm could be presumed. When a trademark is infringed it is almost impossible to quantify the monetary loss suffered by the owner of the mark, therefore, injunctive relief is often the only meaningful remedy. The TMA has restored the presumption of irreparable harm for trademark owners making injunctive relief more easily attainable for trademark owners.

In addition, the TMA changes response times to Office Actions issued by the USPTO. Currently, Applicants have six months to respond to an Office Action. Under the TMA these response times can be anywhere between 60 days and six months. Extensions of time will be available for a fee. Also, the TMA provides official guidance for submitting letters of protest to challenge third party applications. The TMA sets forth what must be included in such letters as well as setting forth procedures for the USPTO to follow upon receiving such a letter. The rule further permits the USPTO to charge a fee for submitting such a letter.

Finally, The TMA provides two new procedures that permit anyone to challenge a trademark registration based on non-use. These new procedures, expungement and reexamination, are similar and are intended to be faster and less expensive than a standard cancellation proceeding. The basis for bringing an expungement proceeding is that the registration was never used in connection with one or more of the goods or services identified in the registration. An expungement proceeding may only be brought between the registrations third and tenth-year anniversaries. The basis of bringing a challenge under the reexamination proceeding is that the mark was not used in connection with one or more of the goods or services at the time the trademark owner declared to the USPTO that it was. A reexamination proceeding may be brought any time up to the fifth-year anniversary of the registration.

The Trademark Modernization Act provides additional methods of challenging applications and registrations and resolves a split in the circuit courts for providing injunctive relief. The USPTO now has one year to enact the rules to execute the policies set forth under the TMA.