

Highlights Part III of the Trademark Modernization Act of 2020: Letters of Protest and Shortened Office Action Response Times

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by Cathy Dahl



As we wrote in Parts I and II in this series, the Trademark Modernization Act of 2020 (“TMA”) was signed into law on December 27, 2020, containing several significant amendments to the Lanham Act. This post will cover two of the legislative changes: (1) the formalization of procedures for Letters of Protest; and (2) the discretionary shortened timeframe to file a response to Office Actions.

The formalization of procedures for Letters of Protest is not anticipated to require new regulations for implementation, and the

newly-formalized procedures and fee for submissions went into effect on January 2, 2021.

The new changes for shortened response times to Office Actions will take effect on December 27, 2021, though the implementing regulations and procedures, as well as the fees for these procedures, have not yet been set.

Procedures for Letters of Protest

Letters of Protest can be a useful tool for interested third parties to bring to the attention of an examining attorney the existence of prior pending applications or registrations alleged to be confusing similar, or other issues, such as the descriptive significance of the applied-for mark, that a third party believes create a bar to registration. A third party must follow the procedures set forth below. (For additional details, we suggest reviewing the procedures on the [USPTO’s website](#).) These newly-formalized procedures may not be very different from what has been informal practice up until now, but it is helpful to

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have confirmation of what the USPTO requires:

1. Letters of Protest must include a valid legal ground for a USPTO examining attorney to refuse registration. Evidence must be submitted by the party filing the Letter of Protest.
2. Timing for filing a Letter of Protest and Evidentiary Requirements:
 - a. If filed before the trademark application is published, the evidence must be relevant to the stated reason(s) for why registration should be refused.
 - b. If filed after the trademark application has published, the evidence must establish a *prima facie* case for refusing registration.
3. Letters of Protest must be filed electronically at the USPTO and a fee of \$50 is required.

The TMA adds the following changes to the procedures:

- A third party may submit for consideration for inclusion in the record of an application evidence relevant to a ground for refusal of registration. The submission shall identify the ground for refusal and include a concise description of each piece of evidence submitted in support of each identified ground for refusal. *Not later than 2 months after the date on which the submission is filed, the Director shall determine whether the evidence shall be included in the record of the application.*
- If the Director determines that the third party evidence should be included in the record of the application, only the evidence and the ground for refusal to which the evidence relates may be included.
- Any determination by the Director whether or not to include evidence in the record of an application shall be final and non-reviewable, and a determination to include or to not include evidence in the record shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding.

The key takeaway here is that the USPTO now will have a set deadline to review evidence submitted in Letters of Protest and make a determination about whether the evidence will be included in the record of the application.

Provision for Discretionary Shortened Response Deadline to Respond to Office Actions

Under current USPTO procedures, an application will be reviewed by an examining attorney, who will either approve an application for publication for opposition, or issue an Office Action raising particular issues that must be addressed before the application can move forward. If an Office Action issues, an applicant has 6 months to respond.

The TMA changes the current process by authorizing the issuance of Office Actions that require a response as early as 60 days after issuance, or within 6 months from issuance. The discretionary shortened response deadline is intended to be a tool for eliminating applications that will ultimately be abandoned and thus unclutter the register.

If an applicant fails to reply, amend, or appeal within the relevant time period, including any extension available, the application shall be deemed abandoned, unless it can be shown to the satisfaction of the Director that the delay was unintentional, in which case

the application may be revived and time may be extended. The Director may prescribe a fee to accompany any request to revive.

The Director shall provide by regulation for extensions of time to respond to the examiner for any time period that is less than 6 months. The Director shall allow the applicant to obtain extensions of time to reply or amend for a period of time not exceeding 6 months from the date of notification of the issuance of the Office Action. However, the Director may set by regulation the time for individual periods of extension, and prescribe a fee, by regulation, for any extension request. Any request for extension shall be filed on or before the date on which a reply or amendment is due.

It remains to be seen how it will be determined which issues might fall into the shortened “60-day deadline” or less than 6 months categories.

While the USPTO suggests that the goal behind the implementation of the shortened deadline to respond to an Office Action is to cut dead wood from the register, it could have the effect of making the application process more expensive for applicants who may need additional time beyond a 60-day Response deadline to address what may seem to an examining attorney to be relatively minor issues.

We will, of course, provide updates on the implementation of the TMA as updates become available over the course of 2021.