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116TH CONGRESS
2D SESSION

H. R. 6196

[Report No. 116-645]

To amend the Trademark Act of 1946 to provide for third-party submission of evidence relating to a trademark application, to establish expungement and ex parte proceedings relating to the validity of marks, to provide for a rebuttal presumption of irreparable harm in certain proceedings, and for other purposes.

IN THE HOUSE OF REPRESENTATIVES

MARCH 11, 2020

Mr. JOHNSON of Georgia (for himself, Mr. COLLINS of Georgia, Mr. NADLER, and Mrs. ROBY) introduced the following bill; which was referred to the Committee on the Judiciary

DECEMBER 14, 2020

Additional sponsors: Mr. CICILLINE, Mr. RESCENTIALER, Mr. CLINE, Mr. DEUTCH, Mr. STANTON, and Mr. JACOBS

DECEMBER 14, 2020

Reported with amendments, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on March 11, 2020]

A BILL

To amend the Trademark Act of 1946 to provide for third-party submission of evidence relating to a trademark application, to establish expungement and ex parte proceedings relating to the validity of marks, to provide for a rebuttal presumption of irreparable harm in certain proceedings, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
 2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE; TABLE OF CONTENTS.**

4 (a) *SHORT TITLE.*—*This Act may be cited as the*
 5 *“Trademark Modernization Act of 2020” or the “TM Act*
 6 *of 2020”.*

7 (b) *TABLE OF CONTENTS.*—*The table of contents for*
 8 *this Act is as follows:*

Sec. 1. Short title; table of contents.

Sec. 2. Definitions.

Sec. 3. Providing for third-party submission of evidence during examination.

Sec. 4. Providing for flexible response periods.

Sec. 5. Ex parte expungement; Ex parte reexamination; new grounds for cancella-
tion.

Sec. 6. Rebuttable presumption of irreparable harm.

Sec. 7. Report on decluttering initiatives.

Sec. 8. Amendments to confirm authority of the Director.

9 **SEC. 2. DEFINITIONS.**

10 *In this Act:*

11 (1) *DIRECTOR.*—*The term “Director” means the*
 12 *Under Secretary of Commerce for Intellectual Prop-*
 13 *erty and Director of the United States Patent and*
 14 *Trademark Office.*

15 (2) *TRADEMARK ACT OF 1946.*—*The term “Trade-*
 16 *mark Act of 1946” means the Act entitled “An Act to*
 17 *provide for the registration and protection of trade-*
 18 *marks used in commerce, to carry out the provisions*
 19 *of certain international conventions, and for other*
 20 *purposes”, approved July 5, 1946, as amended (15*

1 U.S.C. 1051, *et. seq*) (commonly referred to as the
2 “Trademark Act of 1946” or the “Lanham Act”).

3 **SEC. 3. PROVIDING FOR THIRD-PARTY SUBMISSION OF EVI-**
4 **DENCE DURING EXAMINATION.**

5 (a) *AMENDMENT.*—Section 1 of the Trademark Act of
6 1946 (15 U.S.C. 1051) is amended by inserting at the end
7 the following new subsection:

8 “(f) A third party may submit for consideration for
9 inclusion in the record of an application evidence relevant
10 to a ground for refusal of registration. The third-party sub-
11 mission shall identify the ground for refusal and include
12 a concise description of each piece of evidence submitted in
13 support of each identified ground for refusal. Within two
14 months after the date on which the submission is filed, the
15 Director shall determine whether the evidence should be in-
16 cluded in the record of the application. The Director shall
17 establish by regulation appropriate procedures for the con-
18 sideration of evidence submitted by a third party under this
19 subsection and may prescribe a fee to accompany the sub-
20 mission. If the Director determines that the third-party evi-
21 dence should be included in the record of the application,
22 only the evidence and the ground for refusal to which the
23 evidence relates may be so included. Any determination by
24 the Director whether or not to include evidence in the record
25 of an application shall be final and non-reviewable, and

1 *a determination to include or to not include evidence in*
 2 *the record shall not prejudice any party’s right to raise any*
 3 *issue and rely on any evidence in any other proceeding.”.*

4 *(b) DEADLINE FOR PROCEDURES.—Not later than one*
 5 *year after the date of the enactment of this Act, the Director*
 6 *shall establish the appropriate procedures described in sec-*
 7 *tion 1(f) of the Trademark Act of 1946, as added by sub-*
 8 *section (a).*

9 *(c) EFFECTIVE DATE.—The amendment made by sub-*
 10 *section (a) shall take effect one year after the date of the*
 11 *enactment of this Act.*

12 **SEC. 4. PROVIDING FOR FLEXIBLE RESPONSE PERIODS.**

13 *Section 12(b) of the Trademark Act of 1946 (15 U.S.C.*
 14 *1062(b)) is amended to read as follows:*

15 *“(b)(1) If the applicant is found not entitled to reg-*
 16 *istration, the examiner shall notify the applicant thereof*
 17 *and of the reasons therefor. The applicant may reply or*
 18 *amend the application, which shall then be reexamined.*
 19 *This procedure may be repeated until the examiner finally*
 20 *refuses registration of the mark or the application is aban-*
 21 *doned as described in paragraph (2).*

22 *“(2) After notification under paragraph (1), the appli-*
 23 *cant shall have a period of six months in which to reply*
 24 *or amend the application, or such shorter time that is not*
 25 *less than sixty days, as prescribed by the Director by regu-*

1 *lation. If the applicant fails to reply or amend or appeal*
 2 *within the relevant time period, including any extension*
 3 *under paragraph (3), the application shall be deemed to*
 4 *have been abandoned, unless it can be shown to the satisfac-*
 5 *tion of the Director that the delay in responding was unin-*
 6 *tentional, in which case the application may be revived and*
 7 *such time may be extended. The Director may prescribe a*
 8 *fee to accompany any request to revive.*

9 “(3) *The Director shall provide, by regulation, for ex-*
 10 *tensions of time to respond to the examiner for any time*
 11 *period under paragraph (2) that is less than six months.*
 12 *The Director must allow the applicant to obtain extensions*
 13 *of time to reply or amend aggregating six months from the*
 14 *date of notification under paragraph (1) when the appli-*
 15 *cant so requests. However, the Director may set by regula-*
 16 *tion the time for individual periods of extension, and pre-*
 17 *scribe a fee, by regulation, for any extension request. Any*
 18 *request for extension must be filed on or before the date on*
 19 *which a reply or amendment is due under paragraph (1).”.*

20 **SEC. 5. EX PARTE EXPUNGEMENT; EX PARTE REEXAMINA-**
 21 **TION; NEW GROUNDS FOR CANCELLATION.**

22 (a) *EX PARTE EXPUNGEMENT.*—*The Trademark Act*
 23 *of 1946 (15 U.S.C. 1066) is amended by inserting after sec-*
 24 *tion 16, the following new section:*

1 **“SEC. 16A. EX PARTE EXPUNGEMENT.**

2 “(a) *PETITION.*—Notwithstanding sections 7(b) and
3 22, and subsections (a) and (b) of section 33, any person
4 may file a petition to expunge a registration of a mark
5 on the basis that the mark has never been used in commerce
6 on or in connection with some or all of the goods or services
7 recited in the registration.

8 “(b) *CONTENTS OF PETITION.*—The petition, together
9 with any supporting documents, shall—

10 “(1) identify the registration that is the subject
11 of the petition;

12 “(2) identify each good or service recited in the
13 registration for which it is alleged that the mark has
14 never been used in commerce;

15 “(3) include a verified statement that sets forth
16 the elements of the reasonable investigation the peti-
17 tioner conducted to determine that the mark has never
18 been used in commerce on or in connection with the
19 goods and services identified in the petition, and any
20 additional facts that support the allegation that the
21 mark has never been used in commerce on or in con-
22 nection with the identified goods and services;

23 “(4) include any supporting evidence on which
24 the petitioner relies; and

25 “(5) be accompanied by the fee prescribed by the
26 Director.

1 “(c) *INITIAL DETERMINATION; INSTITUTION.*—

2 “(1) *PRIMA FACIE CASE DETERMINATION, INSTI-*
3 *TUTION, AND NOTIFICATION.*—*The Director shall, for*
4 *each good or service identified under subsection (b)(2),*
5 *determine whether the petition sets forth a prima*
6 *facie case of the mark having never been used in com-*
7 *merce on or in connection with each such good or*
8 *service, institute an ex parte expungement proceeding*
9 *for each good or service for which the Director deter-*
10 *mines that a prima facie case has been set forth, and*
11 *provide a notice to the registrant and petitioner of the*
12 *determination of whether or not the proceeding was*
13 *instituted. Such notice should include a copy of the*
14 *petition and any supporting documents and evidence*
15 *that were included with the petition.*

16 “(2) *REASONABLE INVESTIGATION GUIDANCE.*—
17 *The Director shall promulgate regulations regarding*
18 *what constitutes a reasonable investigation under sub-*
19 *section (b)(3) and the general types of evidence that*
20 *could support a prima facie case that a mark has*
21 *never been used in commerce, but the Director shall*
22 *retain the discretion to determine whether a prima*
23 *facie case is set out in a particular proceeding.*

24 “(3) *DETERMINATION BY DIRECTOR.*—*Any deter-*
25 *mination by the Director whether or not to institute*

1 *a proceeding under this section shall be final and*
2 *non-reviewable, and shall not prejudice any party's*
3 *right to raise any issue and rely on any evidence in*
4 *any other proceeding, except as provided by sub-*
5 *section (j).*

6 *“(d) EX PARTE EXPUNGEMENT PROCEDURES.—The*
7 *procedures for ex parte expungement shall be the same as*
8 *those for examination under section 12(b), except that the*
9 *Director shall promulgate regulations establishing and gov-*
10 *erning a proceeding under this section, which may include*
11 *regulations that set response and extension times particular*
12 *to this type of proceeding, which, notwithstanding section*
13 *12(b)(3) need not be extendable to six months, set limits*
14 *governing the timing and number of petitions filed for a*
15 *particular registration or by a particular petitioner or real*
16 *parties in interest, and defining the relation of a proceeding*
17 *under this section to other proceedings concerning the mark.*

18 *“(e) REGISTRANT’S EVIDENCE OF USE.—A reg-*
19 *istrant’s documentary evidence of use must be consistent*
20 *with when ‘a mark shall be deemed to be in use in com-*
21 *merce’ as defined in section 45, but shall not be limited*
22 *in form to that of specimens as provided in section 1(a).*

23 *“(f) EXCUSABLE NONUSE.—During an ex parte*
24 *expungement proceeding, for a mark registered under sec-*
25 *tion 44(e) or an extension of protection under section 66,*

1 *the registrant may offer evidence showing that any nonuse*
2 *is due to special circumstances that excuse such nonuse. In*
3 *such a case, the examiner shall determine whether the facts*
4 *and evidence demonstrate excusable nonuse and shall not*
5 *find that the registration should be cancelled under sub-*
6 *section (g) for any good or service for which excusable non-*
7 *use is demonstrated.*

8 “(g) *EXAMINER’S DECISION; ORDER TO CANCEL.—For*
9 *each good or service for which it is determined that a mark*
10 *has never been used in commerce, and for which the provi-*
11 *sions of subsection (f) do not apply, the examiner shall find*
12 *that the registration should be cancelled for each such good*
13 *or service. A mark may not be found to have never been*
14 *used in commerce if there is evidence of use in commerce*
15 *by the registrant that temporally would have supported reg-*
16 *istration at the time the application was filed or the rel-*
17 *evant allegation of use was made, or after registration, but*
18 *before the petition to expunge was filed under subsection*
19 *(a), or an ex parte expungement proceeding was instituted*
20 *by the Director under subsection (h). Unless overturned on*
21 *review of the examiner’s decision, the Director shall issue*
22 *an order cancelling the registration, in whole or in part,*
23 *after the time for appeal has expired or any appeal pro-*
24 *ceeding has terminated.*

25 “(h) *EX PARTE EXPUNGEMENT BY THE DIRECTOR.—*

1 “(1) *IN GENERAL.*—*The Director may, on the*
2 *Director’s own initiative, institute an ex parte*
3 *expungement proceeding if the Director discovers in-*
4 *formation that supports a prima facie case of a mark*
5 *having never been used in commerce on or in connec-*
6 *tion with any good or service covered by a registra-*
7 *tion. The Director shall promptly notify the reg-*
8 *istrant of such determination, at which time the ex*
9 *parte expungement proceeding shall proceed according*
10 *to the same procedures for ex parte expungement es-*
11 *tablished pursuant to subsection (d). If the Director*
12 *determines, based on the Director’s own initiative, to*
13 *institute an expungement proceeding, the Director*
14 *shall transmit or make available the information that*
15 *formed the basis for that determination as part of the*
16 *institution notice sent to the registrant.*

17 “(2) *RULE OF CONSTRUCTION.*—*Nothing in this*
18 *subsection may be construed to limit any other au-*
19 *thority of the Director.*

20 “(i) *TIME FOR INSTITUTION.*—

21 “(1) *WHEN PETITION MAY BE FILED, EX PARTE*
22 *EXPUNGEMENT PROCEEDING INSTITUTED.*—*A petition*
23 *for ex parte expungement of a registration under sub-*
24 *section (a) may be filed, or the Director may institute*
25 *on the Director’s own initiative an ex parte*

1 *expungement proceeding of a registration under sub-*
2 *section (h), at any time following the expiration of*
3 *three years after the date of registration and before*
4 *the expiration of ten years following the date of reg-*
5 *istration.*

6 “(2) *EXCEPTION.—Notwithstanding paragraph*
7 *(1), for a period of three years after the date of enact-*
8 *ment of this Act, a petition for expungement of a reg-*
9 *istration under subsection (a) may be filed, or the Di-*
10 *rector may institute on the Director’s own initiative*
11 *an ex parte expungement proceeding of a registration*
12 *under subsection (h), at any time following the expi-*
13 *ration of three years after the date of registration.*

14 “(j) *LIMITATION ON LATER EX PARTE EXPUNGEMENT*
15 *PROCEEDINGS.—*

16 “(1) *NO CO-PENDING PROCEEDINGS.—With re-*
17 *spect to a particular registration, while an ex parte*
18 *expungement proceeding is pending, no later ex parte*
19 *expungement proceeding can be instituted with re-*
20 *spect to the same goods or services that are the subject*
21 *of a pending ex parte expungement proceeding.*

22 “(2) *ESTOPPEL.—With respect to a particular*
23 *registration, for goods or services previously subject to*
24 *an instituted expungement proceeding for which, in*
25 *that proceeding, it was determined that the registrant*

1 *had used the mark for particular goods or services, as*
 2 *relevant, and the registration was not cancelled as to*
 3 *those goods or services, no further ex parte*
 4 *expungement proceedings may be initiated as to those*
 5 *goods or services, regardless of the identity of the peti-*
 6 *tioner.*

7 “(k) *USE IN COMMERCE REQUIREMENT NOT AL-*
 8 *TERED.*—*Nothing in this section shall affect the require-*
 9 *ment for use in commerce of a mark registered under section*
 10 *1(a) or section 23.”.*

11 (b) *NEW GROUNDS FOR CANCELLATION.*—*Section 14*
 12 *of the Trademark Act of 1946 (15 U.S.C. 1064) is amend-*
 13 *ed—*

14 (1) *by striking the colon at the end of paragraph*
 15 (5) *and inserting a period;*

16 (2) *by adding after paragraph (5) the following:*

17 “(6) *At any time after the three-year period fol-*
 18 *lowing the date of registration, if the registered mark*
 19 *has never been used in commerce on or in connection*
 20 *with some or all of the goods or services recited in the*
 21 *registration:”;* *and*

22 (3) *in the flush left text, by inserting “Nothing*
 23 *in paragraph (6) shall be construed to limit the tim-*
 24 *ing applicable to any other ground for cancellation.*

25 *A registration under sections 44(e) or 66 shall not be*

1 cancelled pursuant to paragraph (6) if the registrant
 2 demonstrates that any nonuse is due to special cir-
 3 cumstances that excuse such nonuse.” after “identical
 4 certification mark is applied.”.

5 (c) *EX PARTE REEXAMINATION.*—*The Trademark Act*
 6 *of 1946 (15 U.S.C. 1066), as amended by subsection (a),*
 7 *is further amended by inserting after section 16A, the fol-*
 8 *lowing new section:*

9 **“SEC. 16B. EX PARTE REEXAMINATION.**

10 “(a) *PETITION FOR REEXAMINATION.*—Any person
 11 may file a petition to reexamine a registration of a mark
 12 on the basis that the mark was not in use in commerce
 13 on or in connection with some or all of the goods or services
 14 recited in the registration on or before the relevant date.

15 “(b) *RELEVANT DATE.*—In this section, the term ‘rel-
 16 evant date’ means, with respect to an application for the
 17 registration of a mark with an initial filing basis of—

18 “(1) section 1(a) and not amended at any point
 19 to be filed pursuant to section 1(b), the date on which
 20 the application was initially filed; or

21 “(2) section 1(b) or amended at any point to be
 22 filed pursuant to section 1(b), the date on which—

23 “(A) an amendment to allege use under sec-
 24 tion 1(c) was filed; or

1 “(B) the period for filing a statement of use
2 under section 1(d) expired, including all ap-
3 proved extensions thereof.

4 “(c) *REQUIREMENTS FOR THE PETITION.*—The peti-
5 tion, together with any supporting documents, shall—

6 “(1) identify the registration that is the subject
7 of the petition;

8 “(2) identify each good and service recited in the
9 registration for which it is alleged that the mark was
10 not in use in commerce on or in connection with on
11 or before the relevant date;

12 “(3) include a verified statement that sets forth
13 the elements of the reasonable investigation the peti-
14 tioner conducted to determine that the mark was not
15 in use in commerce on or in connection with the
16 goods and services identified in the petition on or be-
17 fore the relevant date, and any additional facts that
18 support the allegation that the mark was not in use
19 in commerce on or before the relevant date on or in
20 connection with the identified goods and services;

21 “(4) include supporting evidence on which the
22 petitioner relies; and

23 “(5) be accompanied by the fee prescribed by the
24 Director.

25 “(d) *INITIAL DETERMINATION; INSTITUTION.*—

1 “(1) *PRIMA FACIE CASE DETERMINATION, INSTI-*
2 *TUTION, AND NOTIFICATION.*—*The Director shall, for*
3 *each good or service identified under subsection (c)(2),*
4 *determine whether the petition sets forth a prima*
5 *facie case of the mark having not been in use in com-*
6 *merce on or in connection with each such good or*
7 *service, institute an ex parte reexamination pro-*
8 *ceeding for each good or service for which the Director*
9 *determines that the prima facie case has been set*
10 *forth, and provide a notice to the registrant and peti-*
11 *tioner of the determination of whether or not the pro-*
12 *ceeding was instituted. Such notice should include a*
13 *copy of the petition and any supporting documents*
14 *and evidence that were included with the petition.*

15 “(2) *REASONABLE INVESTIGATION GUIDANCE.*—
16 *The Director shall promulgate regulations regarding*
17 *what constitutes a reasonable investigation under sub-*
18 *section (c)(3) and the general types of evidence that*
19 *could support a prima facie case that the mark was*
20 *not in use in commerce on or in connection with a*
21 *good or service on or before the relevant date, but the*
22 *Director shall retain discretion to determine whether*
23 *a prima facie case is set out in a particular pro-*
24 *ceeding.*

1 “(3) *DETERMINATION BY DIRECTOR.*—Any deter-
2 mination by the Director whether or not to institute
3 a reexamination proceeding under this section shall
4 be final and non-reviewable, and shall not prejudice
5 any party’s right to raise any issue and rely on any
6 evidence in any other proceeding, except as provided
7 by subsection (j).

8 “(e) *REEXAMINATION PROCEDURES.*—The procedures
9 for reexamination shall be the same as those established
10 under section 12(b) except that the Director shall promul-
11 gate regulations establishing and governing a proceeding
12 under this section, which may include regulations that set
13 response and extension times particular to this type of pro-
14 ceeding, which, notwithstanding section 12(b)(3) need not
15 be extendable to six months; set limits governing the timing
16 and number of petitions filed for a particular registration
17 or by a particular petitioner or real parties in interest; and
18 define the relation of a reexamination proceeding under this
19 section to other proceedings concerning the mark.

20 “(f) *REGISTRANT’S EVIDENCE OF USE.*—A registrant’s
21 documentary evidence of use must be consistent with when
22 ‘a mark shall be deemed to be in use in commerce’ as defined
23 in section 45, but shall not be limited in form to that of
24 specimens as provided in section 1(a).

1 “(g) *EXAMINER’S DECISION; ORDER TO CANCEL.*—For
2 *each good or service for which it is determined that the reg-*
3 *istration should not have issued because the mark was not*
4 *in use in commerce on or before the relevant date, the exam-*
5 *iner shall find that the registration should be cancelled for*
6 *each such good or service. Unless overturned on review of*
7 *the examiner’s decision, the Director shall issue an order*
8 *cancelling the registration, in whole or in part, after the*
9 *time for appeal has expired or any appeal proceeding has*
10 *terminated.*

11 “(h) *REEXAMINATION BY DIRECTOR.*—

12 “(1) *IN GENERAL.*—The Director may, on the
13 *Director’s own initiative, institute an ex parte reex-*
14 *amination proceeding if the Director discovers infor-*
15 *mation that supports a prima facie case of the mark*
16 *having not been used in commerce on or in connec-*
17 *tion with some or all of the goods or services covered*
18 *by the registration on or before the relevant date. The*
19 *Director shall promptly notify the registrant of such*
20 *determination, at which time reexamination shall*
21 *proceed according to the same procedures established*
22 *pursuant to subsection (e). If the Director determines,*
23 *based on the Director’s own initiative, to institute an*
24 *ex parte reexamination proceeding, the Director shall*
25 *transmit or make available the information that*

1 *formed the basis for that determination as part of the*
2 *institution notice.*

3 “(2) *RULE OF CONSTRUCTION.*—*Nothing in this*
4 *subsection may be construed to limit any other au-*
5 *thority of the Director.*

6 “(i) *TIME FOR INSTITUTION.*—*A petition for ex parte*
7 *reexamination may be filed, or the Director may institute*
8 *on the Director’s own initiative an ex parte reexamination*
9 *proceeding, at any time not later than five years after the*
10 *date of registration of a mark registered based on use in*
11 *commerce.*

12 “(j) *LIMITATION ON LATER EX PARTE REEXAMINA-*
13 *TION PROCEEDINGS.*—

14 “(1) *NO CO-PENDING PROCEEDINGS.*—*With re-*
15 *spect to a particular registration, while an ex parte*
16 *reexamination proceeding is pending, no later ex*
17 *parte reexamination proceeding can be instituted*
18 *with respect to the same goods or services that are the*
19 *subject of a pending ex parte reexamination pro-*
20 *ceeding.*

21 “(2) *ESTOPPEL.*—*With respect to a particular*
22 *registration, for any goods or services previously sub-*
23 *ject to an instituted ex parte reexamination pro-*
24 *ceeding for which, in that proceeding, it was deter-*
25 *mined that the registrant had used the mark for par-*

1 *ticular goods or services before the relevant date, and*
 2 *the registration was not cancelled as to those goods or*
 3 *services, no further ex parte reexamination pro-*
 4 *ceedings may be initiated as to those goods or serv-*
 5 *ices, regardless of the identity of the petitioner.*

6 “(k) *SUPPLEMENTAL REGISTER.*—*The provisions of*
 7 *subsection (b) apply, as appropriate, to registrations under*
 8 *section 23. Nothing in this section shall be construed to*
 9 *limit the timing of a cancellation action under section 24*
 10 *of the Act.”.*

11 (d) *APPEAL.*—

12 (1) *APPEAL TO TRADEMARK TRIAL AND APPEAL*
 13 *BOARD.*—*Section 20 of the Trademark Act of 1946*
 14 *(15 U.S.C. 1070) is amended by inserting “or a final*
 15 *decision by an examiner in an ex parte expungement*
 16 *proceeding or ex parte reexamination proceeding”*
 17 *after “registration of marks”.*

18 (2) *APPEAL TO COURTS.*—

19 (A) *EXPUNGEMENT OR EX PARTE REEXAM-*
 20 *INATION.*—*Section 21(a)(1) of the Trademark*
 21 *Act of 1946 (15 U.S.C. 1071(a)(1)) is amended*
 22 *by striking “or an applicant for renewal” and*
 23 *inserting the following: “an applicant for re-*
 24 *newal, or a registrant subject to an ex parte*

1 *expungement proceeding or an ex parte reexam-*
2 *ination proceeding”.*

3 (B) *EXCEPTION.*—Section 21(b)(1) of the
4 *Trademark Act of 1946 (15 U.S.C. 1071(b)(1)) is*
5 *amended by inserting “except for a registrant*
6 *subject to an ex parte expungement proceeding or*
7 *an ex parte reexamination proceeding” before “is*
8 *dissatisfied”.*

9 (e) *TECHNICAL AND CONFORMING AMENDMENTS.*—The
10 *Trademark Act of 1946 (15 U.S.C. 1051 et seq.) is amend-*
11 *ed—*

12 (1) *in section 15, by striking “paragraphs (3)*
13 *and (5)” and inserting “paragraphs (3), (5) and*
14 *(6)”;* and

15 (2) *in section 26, by adding at the end the fol-*
16 *lowing: “Registrations on the supplemental register*
17 *are subject to ex parte expungement and ex parte re-*
18 *examination under sections 16A and 16B, respec-*
19 *tively.”.*

20 (f) *DEADLINE FOR PROCEDURES.*—Not later than one
21 *year after the date of the enactment of this Act, the Director*
22 *shall issue regulations to carry out sections 16A and 16B*
23 *of the Trademark Act of 1946, as added by subsections (a)*
24 *and (c).*

1 (g) *EFFECTIVE DATE.*—*The amendments made by this*
 2 *section shall take effect upon the expiration of the one year*
 3 *period beginning on the date of enactment of this Act, and*
 4 *shall apply to any mark registered before, on, or after that*
 5 *effective date.*

6 **SEC. 6. REBUTTABLE PRESUMPTION OF IRREPARABLE**
 7 **HARM.**

8 (a) *AMENDMENT.*—*Section 34 of the Trademark Act*
 9 *of 1946 (15 U.S.C. 1116) is amended in subsection (a) by*
 10 *inserting after the first sentence the following new sentence:*
 11 *“A plaintiff seeking any such injunction shall be entitled*
 12 *to a rebuttable presumption of irreparable harm upon a*
 13 *finding of a violation identified in this subsection in the*
 14 *case of a motion for a permanent injunction or upon a find-*
 15 *ing of likelihood of success on the merits for a violation*
 16 *identified in this subsection in the case of a motion for a*
 17 *preliminary injunction or temporary restraining order.”.*

18 (b) *RULE OF CONSTRUCTION.*—*The amendment made*
 19 *by subsection (a) shall not be construed to mean that a*
 20 *plaintiff seeking an injunction was not entitled to a pre-*
 21 *sumption of irreparable harm before the date of the enact-*
 22 *ment of this Act.*

23 **SEC. 7. REPORT ON DECLUTTERING INITIATIVES.**

24 (a) *STUDY.*—*The Comptroller General of the United*
 25 *States shall consult with the Director to conduct a study*

1 *on the efforts of the Director during the period beginning*
 2 *12 months after the date of the enactment of this Act and*
 3 *ending 30 months after the date of the enactment of this*
 4 *Act to address inaccurate and false claims of use in trade-*
 5 *mark applications and registrations. Inaccurate and false*
 6 *claims of use include any declaration of use by a trademark*
 7 *applicant or registrant that cannot be supported by use in*
 8 *commerce as defined in section 45 of the Trademark Act*
 9 *of 1946 (15 U.S.C. 1127) or the regulations relevant to the*
 10 *definition of specimens under section 1 of the Trademark*
 11 *Act of 1946 (15 U.S.C. 1051), as applicable.*

12 *(b) CONTENTS OF STUDY.—In conducting the study*
 13 *under subsection (a), the Comptroller General shall assess*
 14 *the following:*

15 *(1) With respect to sections 16A and 16B of the*
 16 *Trademark Act of 1946, as added by section 5—*

17 *(A) the number of petitions filed under each*
 18 *such section for which a decision not to institute*
 19 *was issued;*

20 *(B) the number of petitions filed under each*
 21 *such section for which a decision to institute was*
 22 *issued;*

23 *(C) the number of in-process and completed*
 24 *proceedings instituted under each such section,*

1 including any proceedings instituted by the Di-
2 rector's own initiative;

3 (D) the average time taken to resolve pro-
4 ceedings instituted under each such section, in-
5 cluding the average time between—

6 (i) the filing of a petition under each
7 such section and an examiner's final deci-
8 sion under section 16A(g) and 16B(g), or
9 the last decision issued by the examiner if
10 the registrant failed to respond to the latest-
11 in-time decision by the examiner; and

12 (ii) the institution of a proceeding
13 under each such section, including any pro-
14 ceedings instituted by the Director's own
15 initiative, and an examiner's final decision
16 under section 16A(g) and 16B(g), or the
17 last decision issued by the examiner if the
18 registrant fails to respond to the latest-in-
19 time decision by the examiner;

20 (E) the number of appeals of decisions of
21 examiners to the Trademark Trial and Appeal
22 Board and to the courts for each such pro-
23 ceeding; and

24 (F) an accounting of the final outcome of
25 each such proceeding instituted by identifying

1 *the number of goods or services for which such*
2 *proceedings were instituted, and the number of*
3 *goods or services for each involved registration*
4 *that were cancelled pursuant to such proceedings.*

5 *(2) With respect to section 1(f) of the Trademark*
6 *Act of 1946, as added by section 3—*

7 *(A) the number of third-party submissions*
8 *filed under such section for which the third-party*
9 *asserts in the submission that the mark has not*
10 *been used in commerce; and*

11 *(B) of those applications identified in para-*
12 *graph (A) above, the number of applications in*
13 *which the third-party submission evidence is in-*
14 *cluded in the application; and*

15 *(C) of those applications identified in para-*
16 *graph (B) above, the number of applications—*

17 *(i) refused registration based on an as-*
18 *sertion by the examiner that the mark has*
19 *not been used in commerce; and*

20 *(ii) for which the examiner requested*
21 *additional information from the applicant*
22 *related to claims of use.*

23 *(3) The effectiveness of—*

24 *(A) the proceedings under sections 16A and*
25 *16B of the Trademark Act of 1946, as added by*

1 *section 5, in addressing inaccurate and false*
 2 *claims of use in trademark registrations; and*

3 *(B) any additional programs conducted by*
 4 *the Director designed to address inaccurate and*
 5 *false claims of use in trademark applications*
 6 *and registrations, including the post-registration*
 7 *use audit, as implemented at the date of enact-*
 8 *ment of this Act under sections 2.161(h) and*
 9 *7.37(h) of title 37, Code of Federal Regulations.*

10 *(c) REPORT TO CONGRESS.—Not later than three years*
 11 *after the date of enactment of this Act, the Comptroller Gen-*
 12 *eral of the United States shall submit to the Committee on*
 13 *the Judiciary of the House of Representatives and the Com-*
 14 *mittee on the Judiciary of the Senate a report—*

15 *(1) on the results of the study conducted under*
 16 *this section; and*

17 *(2) that includes any recommendations, based on*
 18 *the results of the study, for any changes to laws or*
 19 *regulations that will improve the integrity of the*
 20 *trademark register or reduce inaccurate or false*
 21 *claims of use.*

22 **SEC. 8. AMENDMENTS TO CONFIRM AUTHORITY OF THE DI-**
 23 **RECTOR.**

24 *(a) AMENDMENTS.—*

1 (1) *Section 18 of the Trademark Act of 1946 (15*
 2 *U.S.C. 1068) is amended by inserting after “estab-*
 3 *lished in the proceedings” the following: “. The au-*
 4 *thority of the Director under this section includes the*
 5 *authority to reconsider, and modify or set aside, a de-*
 6 *cision of the Trademark Trial and Appeal Board”.*

7 (2) *Section 20 of the Trademark Act of 1946 (15*
 8 *U.S.C. 1070) is amended by inserting at the end the*
 9 *following: “The Director may reconsider, and modify*
 10 *or set aside, a decision of the Trademark Trial and*
 11 *Appeal Board under this section.”.*

12 (3) *Section 24 of the Trademark Act of 1946 (15*
 13 *U.S.C. 1092) is amended by inserting after “shall be*
 14 *canceled by the Director” the following: “, unless the*
 15 *Director reconsiders the decision of the Board, and*
 16 *modifies or sets aside, such decision”.*

17 (b) *RULES OF CONSTRUCTION.—*

18 (1) *AUTHORITY BEFORE DATE OF ENACTMENT.—*
 19 *The amendments made by subsection (a) may not be*
 20 *construed to mean that the Director lacked the au-*
 21 *thority to reconsider, and modify or set aside, a deci-*
 22 *sion of the Trademark Trial and Appeal Board before*
 23 *the date of the enactment of this Act.*

24 (2) *AUTHORITY WITH RESPECT TO PARTICULAR*
 25 *DECISIONS.—The amendments made by subsection (a)*

1 *may not be construed to require the Director to recon-*
2 *sider, modify, or set aside any particular decision of*
3 *the Trademark Trial and Appeal Board.*

Amend the title so as to read: “A bill to amend the Trademark Act of 1946 to provide for third-party submission of evidence relating to a trademark application, to establish expungement and ex parte proceedings relating to the validity of marks, to provide for a rebuttable presumption of irreparable harm in certain proceedings, and for other purposes.”.

Union Calendar No. 530

116TH CONGRESS
2D Session

H. R. 6196

[Report No. 116-645]

A BILL

To amend the Trademark Act of 1946 to provide for third-party submission of evidence relating to a trademark application, to establish expungement and ex parte proceedings relating to the validity of marks, to provide for a rebuttal presumption of irreparable harm in certain proceedings, and for other purposes.

DECEMBER 14, 2020

Reported with amendments, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed