



Scott Greenberg
Culhane Meadows

Scott Greenberg, a partner at Culhane Meadows PLLC, has extensive experience counseling his clients on all aspects of trademark protection and transactions. From his time as a USPTO Trademark Examining Attorney, through his many years at an intellectual property boutique, an AMLAW 100 firm, up through the present, Scott has acquired the expertise to provide his clients with specific and cost-effective advice for any trademark or related issue that may arise. Scott has prosecuted, rendered opinions, managed portfolios, negotiated and drafted agreements including license and settlement agreements, and has experience in litigation before the courts and the U.S. Patent and Trademark Office, in the fields of trademark, unfair competition, copyright law and domain name disputes, on behalf of a wide variety of clients in numerous service and manufacturing fields.

ROBERT J. RANDO, PARTNER, TAYLOR ENGLISH DUMA LLP



Robert Rando is a partner with the firm's Intellectual Property Department. Mr. Rando focuses his practice on patent and other intellectual property infringement disputes. He is experienced in a wide range of technologies, including computer hardware and software, silicon chip manufacturing, biotechnology products, medical devices, pharmaceuticals, chemical compounds, food additives, alternative energy products, consumer electronics, communications, security, Internet, and e-commerce.

Mr. Rando has more than 30 years of federal civil litigation experience and has litigated disputes in the Southern District of New York ("SDNY"), the Eastern District of New York ("EDNY"), and several other United States District Courts across the country. In addition to intellectual property matters, Mr. Rando has also handled litigation matters involving antitrust, civil rights, complex commercial disputes, class action product liability, employment discrimination and other employment disputes, and ERISA cases.

Mr. Rando has extensive appellate court experience, including having served as counsel of record or co-counsel on numerous Amicus brief filings before the United States Supreme Court and Federal Circuit on various intellectual property, constitutional and administrative law issues from 2006 to the present.

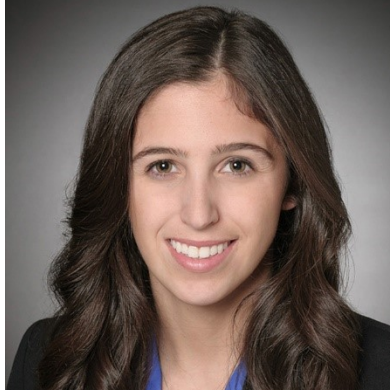
Mr. Rando is a Fellow of the Academy of Court-Appointed Masters and, since 2004, has served by judicial appointment as a Special Master in numerous cases involving complex patent law issues. He has also served as a Mediator in several private mediations all with successful outcomes and as a Neutral in patent and non-patent cases.

Mr. Rando has also worked closely with USPTO leaders and is actively engaged in federal judiciary matters. Along with other FBA patent practitioners he developed and conducted a series of lectures in 2012 on the AIA, and along with other NYIPLA patent practitioners he provided a lecture on Alice/Mayo/Section 101 patent eligibility issues in 2018, for the SDNY and EDNY Patent Pilot Program Judges, Magistrate Judges and Law Clerks. He represented the NYIPLA and FBA at the Tillis/Coons Section 101 Patent Law Reform Roundtable discussions and, on behalf of the FBA IPLS, submitted written testimony included in the record at the June 11, 2019 hearing.

As a member of the EDNY Litigation Advisory Committee since 2005, Mr. Rando has worked alongside other practitioners, members of the judiciary and academia reviewing and providing input and commentary on proposed rules changes to the Federal Rules and the EDNY local rules. Mr. Rando also served as a member of the joint EDNY/SDNY Committee on Local Patent Rules.

Mr. Rando began his legal career as an Associate with Skadden Arps, later moving to Kenyon & Kenyon. Prior to joining Taylor English, Mr. Rando founded and led his own firm for nearly 25 years. Before attending law school, he served as a Systems Analysis Engineer at Sperry Corporation, now a part of Lockheed Martin. In this role, Mr. Rando helped design, develop, implement, and analyze computer software that could use advanced mathematics as part of nuclear submarine navigation and weapons systems under a government required security clearance.

Mr. Rando is a published author and frequent lecturer at law schools, bar associations, CLE programs and trade groups on constitutional law, administrative law, patent law and other IP law issues.



Ashley Ross
Kirkland & Ellis

Ashley Ross is a partner in the New York office of Kirkland & Ellis LLP. Ashley focuses her practice on patent and trade secrets litigation. Ashley routinely works on high-tech patent cases involving small molecules, pharmaceutical compositions, biofuels, therapeutic antibodies, DNA amplification technology, mechanical and medical devices, and has extensive experience in Hatch-Waxman and other life sciences cases. Ashley received her Bachelor's degree in Molecular and Cellular Biology with a focus on Immunology from the University of California, Berkeley, and received her J.D. from Georgetown University.



Mitchell Stein
Sullivan & Worcester

Mitch Stein is an intellectual property partner at the New York offices of Sullivan & Worcester LLP. Mitch's practice focuses on copyright, trademark, and data privacy work in a wide range of industries, including bio-tech, medical devices, software, e-commerce, sports and entertainment, and luxury goods. He represents clients in litigation and dispute resolution matters, advises clients in connection with negotiation of complex commercial licenses, research collaborations, clinical study agreements, pilot program agreements, and consulting agreements, and also handles clients' U.S. and international trademark portfolios. Mitch has been practicing in the field of intellectual property since 1994, and is currently co-chair of the Copyright Committee of the NYIPLA.



Jeanna Wacker
Kirkland & Ellis

Jeanna M. Wacker is an experienced intellectual property litigation partner in the New York office of Kirkland & Ellis LLP. She concentrates her practice on patent litigation in the life sciences field and has extensive experience representing clients in the pharmaceutical, biotechnology, chemical and medical device industries. Jeanna has represented both plaintiffs and defendants at all stages of litigation, including trial and appeal. Her clients have included Bristol-Myers Squibb, Hoffmann La-Roche, E.I. du Pont de Nemours, Merus B.V., Novartis Pharmaceuticals, Genentech, Gilead Sciences, Ranbaxy, Boehringer Ingelheim, Sun Pharmaceuticals, Hospira, Pfizer, Impax, IBM and Advanced Technology Materials, Inc.

Jeanna is also regularly called upon to advise pharmaceutical and biotech companies on intellectual property aspects of corporate merger agreements and product acquisitions.

NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

NYIPLA 2020 FALL PATENT CLE: IP Policy Issues for the New Congress November 17, 2020

Moderator

Jeanna Wacker, Kirkland & Ellis LLP

Panelists

Robert Rando, Taylor English Duma LLP

Ashley Ross, Kirkland & Ellis LLP

Scott Greenberg, Culhane Meadows PLLC

Mitchell C. Stein, Sullivan & Worcester LLP

NYIPLA LAC Patent Law Update

NYIPLA 2020 ANNUAL PATENT LAW CLE

Rob Rando, Taylor English Duma LLP

November 17, 2020

taylor | english



Rob Rando is a partner with the firm’s Intellectual Property Department. He focuses his practice on patent and other intellectual property infringement disputes. He is experienced in a wide range of technologies, including computer hardware and software, silicon chip manufacturing, biotechnology products, medical devices, pharmaceuticals, chemical compounds, food additives, alternative energy products, consumer electronics, communications, security, Internet, and e-commerce.

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Overview

- Section 101 Patent Eligibility
- USPTO Request For Comments: AIA Proceedings
- STRONGER Patents Act
- ITC Reform
- A New Administration?

Section 101 Patent Eligibility

Congressional Activity

- Senators Tillis and Coons Senate IP Subcommittee
 - Prior Efforts
 - NYIPLA Engagement
 - Active participation in Roundtable meetings
 - Hearing testimony
 - Current/Future Efforts
 - Ongoing discussions between stakeholders
 - Kappos and Judge Michel (ret.)
 - » “Practical Utility” v. Abstract Idea
 - Expectations for progress

SCOTUS

- **FUGGEDABOUTIT!**

- Supremes have passed on every opportunity to grant cert. to take up the issue.

USPTO Request For Comments: AIA Proceedings

USPTO

- October 20, 2020 USPTO published Request for Comments on Discretion to Institute Trials Before the Patent Trial and Appeal Board
- Seeks public comments on considerations for instituting trials before the Office under the AIA
- Considering codification of its current policies and practices, or modification thereof, through rulemaking

USPTO

- Seeks public comments on the Office's current approach and various other approaches suggested to the Office by stakeholders
- Seven specific questions for public comments on appropriate considerations for instituting AIA trials

USPTO

- Current PTAB Practice Rules
 - Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (Consolidated Trial Practice Guide or CTPG), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>
 - More than 40 decisions designated as precedential or informative available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>

USPTO

- Discretion in Deciding Whether To Institute
- Director's Discretionary Institution Authority in General
- Discretion Under 35 U.S.C. 314(a) and 324(a)
- Serial Petitions
- Timely Completion Of Proceedings & Efficient Administration Of The Office
- Parallel Petitions
- Proceedings In Other Tribunals

Seven Specific Questions

USPTO

- **Serial Petitions**

1. Should the Office promulgate a rule with a case-specific analysis, such as generally outlined in *General Plastic, Valve I, Valve II* and their progeny, for deciding whether to institute a petition on claims that have previously been challenged in another petition?
2. Alternatively, in deciding whether to institute a petition, should the Office (a) altogether disregard whether the claims have previously been challenged in another petition, or (b) altogether decline to institute if the claims have previously been challenged in another petition?

USPTO

- **Parallel Petitions**

3. Should the Office promulgate a rule with a case-specific analysis, such as generally outlined in the Consolidated Trial Practice Guide, for deciding whether to institute more than one petition filed at or about the same time on the same patent?
4. Alternatively, in deciding whether to institute more than one petition filed at or about the same time on the same patent, should the Office (a) altogether disregard the number of petitions filed, or (b) altogether decline to institute on more than one petition?

USPTO

- **Proceedings in Other Tribunals**

5. Should the Office promulgate a rule with a case-specific analysis, such as generally outlined in *Fintiv* and its progeny, for deciding whether to institute a petition on a patent that is or has been subject to other proceedings in a U.S. district court or the ITC?
6. Alternatively, in deciding whether to institute a petition on a patent that is or has been subject to other proceedings in district court or the ITC, should the Office (a) altogether disregard such other proceedings, or (b) altogether decline to institute if the patent that is or has been subject to such other proceedings, unless the district court or the ITC has indicated that it will stay the action?

USPTO

- **Other Considerations**

7. Whether or not the Office promulgates rules on these issues, are there any other modifications the Office should make in its approach to serial and parallel AIA petitions, proceedings in other tribunals, or other use of discretion in deciding whether to institute an AIA trial?

STRONGER PATENTS ACT

Congressional Activity

- Senators Coons Introduced The Bill in 2019
- Contains many provisions aimed at pro-patentee reforms
- Key aspects include changes to PTAB practice and effectively overturn the Supreme Court's 2006 *eBay* decision re: injunctions
- May pick up steam in some incarnation in the new congress
 - Depends on Senator Coons remaining in the Senate

ITC Reform

Congressional Activity

- House Representatives DelBene and Schweikert Introduced H.R. 8037, the “Advancing America’s Interests Act” (AAIA)
- Making Domestic Industry About The Industry
- Eliminating Domestic Industry By Subpoena
- Putting Public Interest Back Into The ITC

A New Administration?

Potential Changes

- USPTO Director
- Patent Reforms
- International Trade Agreements Impact on Patents
- Senator Coons Potential Cabinet Position

Questions?

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THANK YOU!

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NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

NEW AND PENDING LEGISLATION IN THE PHARMACEUTICAL SPACE

Ashley Ross – November 17, 2020

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Ashley Ross is a partner in the New York office of Kirkland & Ellis LLP. Ashley focuses her practice on patent and trade secrets litigation. Ashley routinely works on high-tech patent cases involving small molecules, pharmaceutical compositions, biofuels, therapeutic antibodies, DNA amplification technology, mechanical and medical devices, and has extensive experience in Hatch-Waxman and other life sciences cases. Ashley received her Bachelor's degree in Molecular and Cellular Biology with a focus on Immunology from the University of California, Berkeley, and received her J.D. from Georgetown University.

TERM Act: Disclaimer of Patent Term

“(1) IN GENERAL.—Except as provided in paragraph (2), in a proceeding challenging the validity of patents under section 505(c) of the Federal Food, Drug, and Cosmetic Act (**21 U.S.C. 355(c)**) with respect to a drug, under section 351(l) of the Public Health Service Act (**42 U.S.C. 262(l)**) with respect to a **biological product**, or a Federal district court proceeding involving patents that are the subject of an action under **section 271(e)(2)**, the patentee shall be **presumed to have disclaimed the patent term for each of the listed patents after the date on which the term of the first patent expires**, subject to the exceptions provided for in subsection (2).”

TERM Act: Exceptions to Disclaimer

“(2) DEMONSTRATION OF DISTINCT INVENTIONS.—If a patentee demonstrates by a **preponderance of the evidence** that certain patents described in paragraph (1) cover **patentably distinct inventions** from the invention claimed in the first such patent to expire, no part of the term of any such patent shall be presumed to have been disclaimed, and **all patent term extensions granted** by the United States Patent and Trademark Office **shall be respected**, unless and to the extent the patentee expressly disclaims, in writing, the patent term for each such patent.”

California's Health & Safety Code § 134002(a)(1)

Effective
January 1, 2020

- ▶ A settlement “in connection with the sale of a pharmaceutical product, shall be **presumed** to have anticompetitive effects and shall be a violation of this section if **both** of the following apply
- ▶ (A) A nonreference drug filer receives **anything of value** from another company asserting patent infringement, including, but not limited to, an **exclusive license** or a **promise that the brand company will not launch an authorized generic version of its brand drug**.
- ▶ (B) The nonreference drug filer agrees to **limit or forego** research, development, manufacturing, marketing, or sales of the nonreference drug filer’s product for any period of time.

§ 134002(a)(1): What does not constitute “anything of value”

- ▶ Right to market competing product before expiration of patent / statutory exclusivity
- ▶ Covenant not to sue on allegation of patent infringement
- ▶ Compensation for “**saved reasonable future litigation expenses**” only if
 - Total expenses are reflected in budgets of RLD, **documented / adopted ≥ 6 months prior**
 - Total does not exceed *lower* of \$7.5M **or** 5% revenue that nonreference drug holder projected in first 3 years of sales as **documented ≥ 12 months prior** (or \$250k if projections not recorded)

§ 134002(a)(1): What does not constitute “anything of value”

- ▶ Right to launch if RLD seeks approval to launch/launches a different dose, strength, or form of RLD with same active ingredient
- ▶ Agreement by RLD not to interfere with / facilitate nonreference drug filer’s ability to obtain regulatory approval
- ▶ Agreement forgiving potential damages accrued by nonreference drug for at-risk launch

§ 134002(a)(1): What is Not a Violation

- ▶ Demonstrate by **preponderance of the evidence** that **either**:
 - Value received by nonreference drug filer is **fair and reasonable** compensation **solely** for other goods or services they are providing
 - Agreement has directly generated **procompetitive** benefits, which outweigh the anticompetitive effects of the agreement.

§ 134002(a)(1): Personal Consequences of Anticompetitive Agreements

- ▶ **Each person** who violates **or assists in the violation** of the law owes:
 - If the person received **any value** due to violation, then greater of up to 3x value received or \$20,000,000
 - If no value received, then greater of up to 3x value given to other parties to the agreement or \$20,000,000

Other States Following in California's Footsteps

- ▶ **2020 Connecticut Senate Bill No. 251** – An Act Concerning the Availability of Generic Pharmaceuticals
- ▶ **2019 Illinois No. 4822** – Preserving Access to Affordable Drugs Act
- ▶ **2019 Minnesota Senate File 3097** – Preserving Access to Affordable Drugs Act
- ▶ **2019 New York S5169A** – Manufacturer Disclosure and Transparency Act

International Reach



■ **THANK YOU!**

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IP Issues for the New Congress

Trademark Modernization Act of 2020

November 17, 2020
Scott D. Greenberg

New York Intellectual Property Law Association



Introduction



Scott D. Greenberg | New York Trademark Partner

Scott Greenberg has extensive experience counseling his clients on all aspects of trademark protection and transactions. From his time as a USPTO Trademark Examining Attorney, through his many years at an intellectual property boutique, an AMLAW 100 firm, up through the present, Scott has acquired the expertise to provide his clients with specific and cost-effective advice for any trademark or related issue that may arise.

Trademark Modernization Act of 2020 – H.R. 6196/S. 3449.

Introduced on a bipartisan/bicameral basis.

Main Purposes:

- Provide tools to address trademark registrations obtained based on false claims of use in US commerce, mainly by China-based filers, without the need for costly, time-consuming cancellation actions before the Trademark Trial and Appeal Board.
- Generally provide timely, less costly procedures to challenge lack of use for registered trademarks, to ease the burden on new market entrants.
- Also:
 - Clarifies that, in civil actions, when a trademark violation is established, a rebuttable presumption of irreparable harm exists.
 - Clarifies the authority of the PTO Director to re-consider decisions of the TTAB, including those that result from new ex parte proceedings created by the bill.

New Ex Parte Proceeding To Expunge Registrations of Marks That Were Never Used in Commerce – Part A

Any party may petition the Director of the USPTO to institute an ex parte proceeding to expunge any registration of mark, or any particular goods/services within registration, where mark was never used in commerce (essentially, interstate commerce, US-foreign commerce, or intrastate commerce having a significant and direct effect on interstate commerce).

- Petition must include results of investigation and/or other evidence supporting claim that registered mark was never used in commerce, supported by verified statement.
- If Director deems that a prima facie case of “never used” has been established, then Director will institute the ex parte proceeding (to be conducted between the examiner and registrant).
- Examiner will give registrant a set period of time to come forward with evidence of use of the mark in commerce; following which examiner will find that petition should either be granted or denied.
- Foreign treaty-based registrants can overcome expungement by establishing excusable nonuse in commerce.
- If examiner finds that petition to expunge should be granted as to pertinent goods/services, then Director, unless reversing on review, shall grant cancellation after exhaustion of potential appeal.

New Ex Parte Proceeding To Expunge Registrations of Marks That Were Never Used in Commerce – Part B

- Director shall promulgate implementing regulations.
- Director can also institute the proceeding on Director's own initiative.
- Order of cancellation appealable to TTAB; TTAB decision appealable to Federal Circuit, but not via district court de novo review.
- There will also be a corresponding ground of cancellation in a TTAB proceeding.
- Time for bringing challenge (as modified in House bill by Judiciary Committee):
 - During first three years following enactment of legislation: Any time after the third anniversary of registration.
 - Thereafter: Between third and tenth anniversaries of registration.

New Ex Parte Reexamination Proceeding To Challenge Claims of Use In Commerce That Resulted In Registration (Part A)

Any party may petition the Director to reexamine a registration of a mark that was registered based on a claim of use in commerce, on the ground that the mark was not in use in commerce on or in connection with some or all of the recited goods/services on or before the date when the claim of use in commerce was made.

- Petition must include results of investigation and/or other evidence supporting claim that registered mark not used in commerce when claim of use-in-commerce was made by registrant, supported by verified statement.
- If Director deems that a prima facie case of nonuse in commerce at relevant time has been established, then Director will institute the ex parte reexamination proceeding (to be conducted between the examiner and registrant).
- Examiner will give registrant a set period of time to come forward with evidence of use of the mark in commerce at the relevant time; following which examiner will find that petition should either be granted or denied.
- Proceeding only applies to registrations that issued based on use in commerce (not to foreign treaty-based registrations).
- If examiner finds that petition should be granted, then Director, unless reversing on review, shall grant cancellation as to pertinent goods/services after exhaustion of potential appeal.

New Ex Parte Reexamination Proceeding To Challenge Claims of Use In Commerce That Resulted In Registration (Part B)

- Director shall promulgate implementing regulations.
- Director can also institute the proceeding on Director's own initiative.
- Order of cancellation appealable to TTAB; TTAB decision appealable to Federal Circuit, but not via district court de novo review.
- There will also be a corresponding ground of cancellation in a TTAB proceeding.
- Time for bringing challenge: Within first five years of registration.

Codification of Letter of Protest Procedure

Provides that a third party may submit, for consideration to be included in the record of an application, evidence relevant to a ground for refusal of registration. Director will then determine whether the evidence shall be included in the record for the examiner's consideration.

- Essentially a codification of the USPTO's Letter of Protest procedure, which is not presently provided for in the statute or regulations.
- Director shall establish the appropriate procedures via regulation.

Flexible Response Periods

- Presently, Office Actions issued in connection with trademark applications have a six-month response period.
- This provision authorizes the Director to set, via regulation, a shorter initial response period, not less than 60 days.
- Applicants may apply for extensions up to a total of six months. The Director may set fees for such extensions.

Codification of Rebuttable Presumption Of Irreparable Harm for Injunctive Relief Where Trademark Infringement or Dilution Has Been Established

- Provides that where a claimant in a federal civil action has established trademark infringement or dilution and seeks a permanent injunction, or a likelihood of success in establishing such a trademark violation when seeking a preliminary injunction, that claimant is entitled to a rebuttable presumption of irreparable harm.
- Resolves conflict that has arisen among federal courts, some of which have applied the holding of the Supreme Court in a patent case, *eBay, Inc. v. MercExchange LLC*, to trademark cases, requiring additional evidence of irreparable harm beyond the violation itself for injunctive relief.

Codification of Director's Authority Over TTAB Decisions (added to H.R. 6196)

- Confirms authority of Director to reconsider, modify, or set aside decisions of the Trademark Trial and Appeal Board.
- Intended to avoid issues regarding authority of Board judges to render decisions in registration cases similar to issues raised in *Arthrex* case with regard to PTAB judges under the Appointments Clause of the Constitution.
- The USPTO Director is appointed by the President with advice and consent of Senate. TTAB judges are appointed by the Secretary of Commerce in consultation with the Director.

Status of Bill and Prospects

- H.R. 6196 approved and reported by House Judiciary Committee with above-mentioned changes. Awaiting consideration by full House.
- S. 3449 awaiting all further action after introduction.
- Further action in either chamber will likely have to wait until next session of Congress.
- Factors favoring bill:
 - Bi-partisan interest in “getting tough” with China on IP issues.
 - USPTO favors bill as an aid in de-cluttering the Register from unused marks.

IP Issues for the New Congress

Trademark Modernization Act of 2020

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New York Intellectual Property Law Association



2020 NYIPLA Fall Patent CLE Series:
IP Issues for the New Congress

The Digital Millennium Copyright Act

By Mitchell C. Stein
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November 17, 2020



DMCA: Background

- Enacted in 1998, no major amendments since enactment.
- Purpose was to find a balance protecting interests of content owners online while providing OSPs with protections for complying with law.
- DMCA creates 4 “Safe Harbors” for OSPs:
 - › Conduits
 - › Caching Services
 - › Hosting Services
 - › Web Location Tools
- DMCA provides for “Notice and Take-Down” Process.

DMCA: The Copyright Office 2020 Report

- May 21, 2020, Copyright Office issues an over 200-page report on whether DMCA is functioning properly and in accord with Congressional intent.
- Conclusion: the DMCA is “tilted askew” and is not in accord with Congressional intent
- The issues raised in the report raise deep conflicts:
 - › “Big Content” vs. “Big Tech”
 - › Big business vs. small time content owners

DMCA Reform: Current Status

- Both Senate Judiciary and House Judiciary Committees involved, with Senate taking a leading role. No proposed legislation drafted yet.
- Top 10 Issues Currently Being Considered:
 - › Should DMCA be “One Size Fits All?”
 - › Should the safe harbor categories be adjusted?
 - › Is the burden on content owners too onerous? In particular, should “notice and take-down” be replaced with “notice-and-stay-down”?
 - › What knowledge does an OSP need to have before being required to take action? Should OSPs have a duty to monitor as well as investigate? Actual knowledge v. “red-flag” knowledge?
 - › Should injunctive remedies under 512(j) be expanded?

DMCA Reform: Current Status (cont.)

- Top 10 (Continued)
 - › What should the process be for challenging take-down notices?
 - › Should take-down notices and counter-notices be standardized forms from the Copyright Office?
 - › How to prevent or reduce the instance of false or abusive take-down notices?
 - › Should the Copyright Office set “Standard Technical Measures” for OSPs to use to identify and protect copyrighted works?
 - › Should the anti-circumvention provisions in sec. 1202 be amended to replace the “double intent” with a “single intent” standard: i.e., the defendant removed or altered rights management information (knowingly or not) with knowledge it would encourage infringement.

QUESTIONS?

Mitchell C. Stein



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Your
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**AMENDMENT IN THE NATURE OF A SUBSTITUTE
TO H.R. 6196
OFFERED BY MR. NADLER**

Strike all after the enacting clause and insert the following:

1 SECTION 1. SHORT TITLE; TABLE OF CONTENTS.

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

5 (b) TABLE OF CONTENTS.—The table of contents for
6 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 cancellation.
- Sec. 6. Rebuttable presumption of irreparable harm.
- Sec. 7. Report on decluttering initiatives.
- Sec. 8. Amendments to confirm authority of the Director.

7 SEC. 2. DEFINITIONS.

8 In this Act:

9 (1) DIRECTOR.—The term “Director” means
10 the Under Secretary of Commerce for Intellectual
11 Property and Director of the United States Patent
12 and Trademark Office.

1 (2) TRADEMARK ACT OF 1946.—The term
2 “Trademark Act of 1946” means the Act entitled
3 “An Act to provide for the registration and protec-
4 tion of trademarks used in commerce, to carry out
5 the provisions of certain international conventions,
6 and for other purposes”, approved July 5, 1946, as
7 amended (15 U.S.C. 1051, et. seq) (commonly re-
8 ferred to as the “Trademark Act of 1946” or the
9 “Lanham Act”).

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

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

15 “(f) A third party may submit for consideration for
16 inclusion in the record of an application evidence relevant
17 to a ground for refusal of registration. The third-party
18 submission shall identify the ground for refusal and in-
19 clude a concise description of each piece of evidence sub-
20 mitted in support of each identified ground for refusal.
21 Within two months after the date on which the submission
22 is filed, the Director shall determine whether the evidence
23 should be included in the record of the application. The
24 Director shall establish by regulation appropriate proce-
25 dures for the consideration of evidence submitted by a

1 third party under this subsection and may prescribe a fee
2 to accompany the submission. If the Director determines
3 that the third-party evidence should be included in the
4 record of the application, only the evidence and the ground
5 for refusal to which the evidence relates may be so in-
6 cluded. Any determination by the Director whether or not
7 to include evidence in the record of an application shall
8 be final and non-reviewable, and a determination to in-
9 clude or to not include evidence in the record shall not
10 prejudice any party's right to raise any issue and rely on
11 any evidence in any other proceeding.”.

12 (b) DEADLINE FOR PROCEDURES.—Not later than
13 one year after the date of the enactment of this Act, the
14 Director shall establish the appropriate procedures de-
15 scribed in section 1(f) of the Trademark Act of 1946, as
16 added by subsection (a).

17 (c) EFFECTIVE DATE.—The amendment made by
18 subsection (a) shall take effect one year after the date of
19 the enactment of this Act.

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

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

23 “(b)(1) If the applicant is found not entitled to reg-
24 istration, the examiner shall notify the applicant thereof
25 and of the reasons therefor. The applicant may reply or

1 amend the application, which shall then be reexamined.
2 This procedure may be repeated until the examiner finally
3 refuses registration of the mark or the application is aban-
4 doned as described in paragraph (2).

5 “(2) After notification under paragraph (1), the ap-
6 plicant shall have a period of six months in which to reply
7 or amend the application, or such shorter time that is not
8 less than sixty days, as prescribed by the Director by regu-
9 lation. If the applicant fails to reply or amend or appeal
10 within the relevant time period, including any extension
11 under paragraph (3), the application shall be deemed to
12 have been abandoned, unless it can be shown to the satis-
13 faction of the Director that the delay in responding was
14 unintentional, in which case the application may be revived
15 and such time may be extended. The Director may pre-
16 scribe a fee to accompany any request to revive.

17 “(3) The Director shall provide, by regulation, for ex-
18 tensions of time to respond to the examiner for any time
19 period under paragraph (2) that is less than six months.
20 The Director must allow the applicant to obtain extensions
21 of time to reply or amend aggregating six months from
22 the date of notification under paragraph (1) when the ap-
23 plicant so requests. However, the Director may set by reg-
24 ulation the time for individual periods of extension, and
25 prescribe a fee, by regulation, for any extension request.

1 Any request for extension must be filed on or before the
2 date on which a reply or amendment is due under para-
3 graph (1).”.

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

6 (a) EX PARTE EXPUNGEMENT.—The Trademark Act
7 of 1946 (15 U.S.C. 1066) is amended by inserting after
8 section 16, the following new section:

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

10 “(a) PETITION.—Notwithstanding sections 7(b) and
11 22, and subsections (a) and (b) of section 33, any person
12 may file a petition to expunge a registration of a mark
13 on the basis that the mark has never been used in com-
14 merce on or in connection with some or all of the goods
15 or services recited in the registration.

16 “(b) CONTENTS OF PETITION.—The petition, to-
17 gether with any supporting documents, shall—

18 “(1) identify the registration that is the subject
19 of the petition;

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

23 “(3) include a verified statement that sets forth
24 the elements of the reasonable investigation the peti-
25 tioner conducted to determine that the mark has

1 never been used in commerce on or in connection
2 with the goods and services identified in the petition,
3 and any additional facts that support the allegation
4 that the mark has never been used in commerce on
5 or in connection with the identified goods and serv-
6 ices;

7 “(4) include any supporting evidence on which
8 the petitioner relies; and

9 “(5) be accompanied by the fee prescribed by
10 the Director.

11 “(c) INITIAL DETERMINATION; INSTITUTION.—

12 “(1) PRIMA FACIE CASE DETERMINATION, IN-
13 STITUTION, AND NOTIFICATION.—The Director
14 shall, for each good or service identified under sub-
15 section (b)(2), determine whether the petition sets
16 forth a prima facie case of the mark having never
17 been used in commerce on or in connection with
18 each such good or service, institute an ex parte
19 expungement proceeding for each good or service for
20 which the Director determines that a prima facie
21 case has been set forth, and provide a notice to the
22 registrant and petitioner of the determination of
23 whether or not the proceeding was instituted. Such
24 notice should include a copy of the petition and any

1 supporting documents and evidence that were in-
2 cluded with the petition.

3 “(2) REASONABLE INVESTIGATION GUID-
4 ANCE.—The Director shall promulgate regulations
5 regarding what constitutes a reasonable investigation
6 under subsection (b)(3) and the general types of evi-
7 dence that could support a prima facie case that a
8 mark has never been used in commerce, but the Di-
9 rector shall retain the discretion to determine wheth-
10 er a prima facie case is set out in a particular pro-
11 ceeding.

12 “(3) DETERMINATION BY DIRECTOR.—Any de-
13 termination by the Director whether or not to insti-
14 tute a proceeding under this section shall be final
15 and non-reviewable, and shall not prejudice any par-
16 ty’s right to raise any issue and rely on any evidence
17 in any other proceeding, except as provided by sub-
18 section (j).

19 “(d) EX PARTE EXPUNGEMENT PROCEDURES.—The
20 procedures for ex parte expungement shall be the same
21 as those for examination under section 12(b), except that
22 the Director shall promulgate regulations establishing and
23 governing a proceeding under this section, which may in-
24 clude regulations that set response and extension times
25 particular to this type of proceeding, which, notwith-

1 standing section 12(b)(3) need not be extendable to six
2 months, set limits governing the timing and number of
3 petitions filed for a particular registration or by a par-
4 ticular petitioner or real parties in interest, and defining
5 the relation of a proceeding under this section to other
6 proceedings concerning the mark.

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

12 “(f) EXCUSABLE NONUSE.—During an ex parte
13 expungement proceeding, for a mark registered under sec-
14 tion 44(e) or an extension of protection under section 66,
15 the registrant may offer evidence showing that any nonuse
16 is due to special circumstances that excuse such nonuse.
17 In such a case, the examiner shall determine whether the
18 facts and evidence demonstrate excusable nonuse and shall
19 not find that the registration should be cancelled under
20 subsection (g) for any good or service for which excusable
21 nonuse is demonstrated.

22 “(g) EXAMINER’S DECISION; ORDER TO CANCEL.—
23 For each good or service for which it is determined that
24 a mark has never been used in commerce, and for which
25 the provisions of subsection (f) do not apply, the examiner

1 shall find that the registration should be cancelled for each
2 such good or service. A mark may not be found to have
3 never been used in commerce if there is evidence of use
4 in commerce by the registrant that temporally would have
5 supported registration at the time the application was filed
6 or the relevant allegation of use was made, or after reg-
7 istration, but before the petition to expunge was filed
8 under subsection (a), or an ex parte expungement pro-
9 ceeding was instituted by the Director under subsection
10 (h). Unless overturned on review of the examiner's deci-
11 sion, the Director shall issue an order cancelling the reg-
12 istration, in whole or in part, after the time for appeal
13 has expired or any appeal proceeding has terminated.

14 “(h) EX PARTE EXPUNGEMENT BY THE DIREC-
15 TOR.—

16 “(1) IN GENERAL.—The Director may, on the
17 Director's own initiative, institute an ex parte
18 expungement proceeding if the Director discovers in-
19 formation that supports a prima facie case of a
20 mark having never been used in commerce on or in
21 connection with any good or service covered by a
22 registration. The Director shall promptly notify the
23 registrant of such determination, at which time the
24 ex parte expungement proceeding shall proceed ac-
25 cording to the same procedures for ex parte

1 expungement established pursuant to subsection (d).
2 If the Director determines, based on the Director's
3 own initiative, to institute an expungement pro-
4 ceeding, the Director shall transmit or make avail-
5 able the information that formed the basis for that
6 determination as part of the institution notice sent
7 to the registrant.

8 “(2) RULE OF CONSTRUCTION.—Nothing in
9 this subsection may be construed to limit any other
10 authority of the Director.

11 “(i) TIME FOR INSTITUTION.—

12 “(1) WHEN PETITION MAY BE FILED, EX
13 PARTE EXPUNGEMENT PROCEEDING INSTITUTED.—
14 A petition for ex parte expungement of a registra-
15 tion under subsection (a) may be filed, or the Direc-
16 tor may institute on the Director's own initiative an
17 ex parte expungement proceeding of a registration
18 under subsection (h), at any time following the expi-
19 ration of three years after the date of registration
20 and before the expiration of ten years following the
21 date of registration.

22 “(2) EXCEPTION.—Notwithstanding paragraph
23 (1), for a period of three years after the date of en-
24 actment of this Act, a petition for expungement of
25 a registration under subsection (a) may be filed, or

1 the Director may institute on the Director's own ini-
2 tiative an ex parte expungement proceeding of a reg-
3 istration under subsection (h), at any time following
4 the expiration of three years after the date of reg-
5 istration.

6 “(j) LIMITATION ON LATER EX PARTE
7 EXPUNGEMENT PROCEEDINGS.—

8 “(1) NO CO-PENDING PROCEEDINGS.—With re-
9 spect to a particular registration, while an ex parte
10 expungement proceeding is pending, no later ex
11 parte expungement proceeding can be instituted with
12 respect to the same goods or services that are the
13 subject of a pending ex parte expungement pro-
14 ceeding.

15 “(2) ESTOPPEL.—With respect to a particular
16 registration, for goods or services previously subject
17 to an instituted expungement proceeding for which,
18 in that proceeding, it was determined that the reg-
19 istrant had used the mark for particular goods or
20 services, as relevant, and the registration was not
21 cancelled as to those goods or services, no further ex
22 parte expungement proceedings may be initiated as
23 to those goods or services, regardless of the identity
24 of the petitioner.

1 “(k) USE IN COMMERCE REQUIREMENT NOT AL-
2 TERED.—Nothing in this section shall affect the require-
3 ment for use in commerce of a mark registered under sec-
4 tion 1(a) or section 23.”.

5 (b) NEW GROUNDS FOR CANCELLATION.—Section 14
6 of the Trademark Act of 1946 (15 U.S.C. 1064) is amend-
7 ed—

8 (1) by striking the colon at the end of para-
9 graph (5) and inserting a period;

10 (2) by adding after paragraph (5) the following:

11 “(6) At any time after the three-year period fol-
12 lowing the date of registration, if the registered
13 mark has never been used in commerce on or in con-
14 nection with some or all of the goods or services re-
15 cited in the registration:”; and

16 (3) in the flush left text, by inserting “Nothing
17 in paragraph (6) shall be construed to limit the tim-
18 ing applicable to any other ground for cancellation.
19 A registration under sections 44(e) or 66 shall not
20 be cancelled pursuant to paragraph (6) if the reg-
21 istrant demonstrates that any nonuse is due to spe-
22 cial circumstances that excuse such nonuse.” after
23 “identical certification mark is applied.”.

24 (c) EX PARTE REEXAMINATION.—The Trademark
25 Act of 1946 (15 U.S.C. 1066), as amended by subsection

1 (a), is further amended by inserting after section 16A, the
2 following new section:

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

4 “(a) PETITION FOR REEXAMINATION.—Any person
5 may file a petition to reexamine a registration of a mark
6 on the basis that the mark was not in use in commerce
7 on or in connection with some or all of the goods or serv-
8 ices recited in the registration on or before the relevant
9 date.

10 “(b) RELEVANT DATE.—In this section, the term
11 ‘relevant date’ means, with respect to an application for
12 the registration of a mark with an initial filing basis of—

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

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

18 “(A) an amendment to allege use under
19 section 1(c) was filed; or

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

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

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

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

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

16 “(4) include supporting evidence on which the
17 petitioner relies; and

18 “(5) be accompanied by the fee prescribed by
19 the Director.

20 “(d) INITIAL DETERMINATION; INSTITUTION.—

21 “(1) PRIMA FACIE CASE DETERMINATION, IN-
22 STITUTION, AND NOTIFICATION.—The Director
23 shall, for each good or service identified under sub-
24 section (c)(2), determine whether the petition sets
25 forth a prima facie case of the mark having not been

1 in use in commerce on or in connection with each
2 such good or service, institute an ex parte reexam-
3 ination proceeding for each good or service for which
4 the Director determines that the prima facie case
5 has been set forth, and provide a notice to the reg-
6 istrant and petitioner of the determination of wheth-
7 er or not the proceeding was instituted. Such notice
8 should include a copy of the petition and any sup-
9 porting documents and evidence that were included
10 with the petition.

11 “(2) REASONABLE INVESTIGATION GUID-
12 ANCE.—The Director shall promulgate regulations
13 regarding what constitutes a reasonable investigation
14 under subsection (c)(3) and the general types of evi-
15 dence that could support a prima facie case that the
16 mark was not in use in commerce on or in connec-
17 tion with a good or service on or before the relevant
18 date, but the Director shall retain discretion to de-
19 termine whether a prima facie case is set out in a
20 particular proceeding.

21 “(3) DETERMINATION BY DIRECTOR.—Any de-
22 termination by the Director whether or not to insti-
23 tute a reexamination proceeding under this section
24 shall be final and non-reviewable, and shall not prej-
25 udice any party’s right to raise any issue and rely

1 on any evidence in any other proceeding, except as
2 provided by subsection (j).

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

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

21 “(g) EXAMINER’S DECISION; ORDER TO CANCEL.—
22 For each good or service for which it is determined that
23 the registration should not have issued because the mark
24 was not in use in commerce on or before the relevant date,
25 the examiner shall find that the registration should be

1 cancelled for each such good or service. Unless overturned
2 on review of the examiner's decision, the Director shall
3 issue an order cancelling the registration, in whole or in
4 part, after the time for appeal has expired or any appeal
5 proceeding has terminated.

6 “(h) REEXAMINATION BY DIRECTOR.—

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

23 “(2) RULE OF CONSTRUCTION.—Nothing in
24 this subsection may be construed to limit any other
25 authority of the Director.

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

7 “(j) LIMITATION ON LATER EX PARTE REEXAMINA-
8 TION PROCEEDINGS.—

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

16 “(2) ESTOPPEL.—With respect to a particular
17 registration, for any goods or services previously
18 subject to an instituted ex parte reexamination pro-
19 ceeding for which, in that proceeding, it was deter-
20 mined that the registrant had used the mark for
21 particular goods or services before the relevant date,
22 and the registration was not cancelled as to those
23 goods or services, no further ex parte reexamination
24 proceedings may be initiated as to those goods or
25 services, regardless of the identity of the petitioner.

1 “(k) SUPPLEMENTAL REGISTER.—The provisions of
2 subsection (b) apply, as appropriate, to registrations
3 under section 23. Nothing in this section shall be con-
4 strued to limit the timing of a cancellation action under
5 section 24 of the Act.”.

6 (d) APPEAL.—

7 (1) APPEAL TO TRADEMARK TRIAL AND APPEAL
8 BOARD.—Section 20 of the Trademark Act of 1946
9 (15 U.S.C. 1070) is amended by inserting “or a
10 final decision by an examiner in an ex parte
11 expungement proceeding or ex parte reexamination
12 proceeding” after “registration of marks”.

13 (2) APPEAL TO COURTS.—

14 (A) EXPUNGEMENT OR EX PARTE REEX-
15 AMINATION.—Section 21(a)(1) of the Trade-
16 mark Act of 1946 (15 U.S.C. 1071(a)(1)) is
17 amended by striking “or an applicant for re-
18 newal” and inserting the following: “an appli-
19 cant for renewal, or a registrant subject to an
20 ex parte expungement proceeding or an ex parte
21 reexamination proceeding”.

22 (B) EXCEPTION.—Section 21(b)(1) of the
23 Trademark Act of 1946 (15 U.S.C. 1071(b)(1))
24 is amended by inserting “except for a registrant
25 subject to an ex parte expungement proceeding

1 or an ex parte reexamination proceeding” be-
2 fore “is dissatisfied”.

3 (e) TECHNICAL AND CONFORMING AMENDMENTS.—

4 The Trademark Act of 1946 (15 U.S.C. 1051 et seq.) is
5 amended—

6 (1) in section 15, by striking “paragraphs (3)
7 and (5)” and inserting “paragraphs (3), (5) and
8 (6)”; and

9 (2) in section 26, by adding at the end the fol-
10 lowing: “Registrations on the supplemental register
11 are subject to ex parte expungement and ex parte
12 reexamination under sections 16A and 16B, respec-
13 tively.”.

14 (f) DEADLINE FOR PROCEDURES.—Not later than
15 one year after the date of the enactment of this Act, the
16 Director shall issue regulations to carry out sections 16A
17 and 16B of the Trademark Act of 1946, as added by sub-
18 sections (a) and (c).

19 (g) EFFECTIVE DATE.—The amendments made by
20 this section shall take effect upon the expiration of the
21 one year period beginning on the date of enactment of this
22 Act, and shall apply to any mark registered before, on,
23 or after that effective date.

1 **SEC. 6. REBUTTABLE PRESUMPTION OF IRREPARABLE**
2 **HARM.**

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

14 (b) RULE OF CONSTRUCTION.—The amendment
15 made by subsection (a) shall not be construed to mean
16 that a plaintiff seeking an injunction was not entitled to
17 a presumption of irreparable harm before the date of the
18 enactment of this Act.

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

20 (a) STUDY.—The Comptroller General of the United
21 States shall consult with the Director to conduct a study
22 on the efforts of the Director during the period beginning
23 12 months after the date of the enactment of this Act and
24 ending 30 months after the date of the enactment of this
25 Act to address inaccurate and false claims of use in trade-
26 mark applications and registrations. Inaccurate and false

1 claims of use include any declaration of use by a trade-
2 mark applicant or registrant that cannot be supported by
3 use in commerce as defined in section 45 of the Trade-
4 mark Act of 1946 (15 U.S.C. 1127) or the regulations
5 relevant to the definition of specimens under section 1 of
6 the Trademark Act of 1946 (15 U.S.C. 1051), as applica-
7 ble.

8 (b) CONTENTS OF STUDY.—In conducting the study
9 under subsection (a), the Comptroller General shall assess
10 the following:

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

13 (A) the number of petitions filed under
14 each such section for which a decision not to in-
15 stitute was issued;

16 (B) the number of petitions filed under
17 each such section for which a decision to insti-
18 tute was issued;

19 (C) the number of in-process and com-
20 pleted proceedings instituted under each such
21 section, including any proceedings instituted by
22 the Director's own initiative;

23 (D) the average time taken to resolve pro-
24 ceedings instituted under each such section, in-
25 cluding the average time between—

1 (i) the filing of a petition under each
2 such section and an examiner's final deci-
3 sion under section 16A(g) and 16B(g), or
4 the last decision issued by the examiner if
5 the registrant failed to respond to the lat-
6 est-in-time decision by the examiner; and

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

15 (E) the number of appeals of decisions of
16 examiners to the Trademark Trial and Appeal
17 Board and to the courts for each such pro-
18 ceeding; and

19 (F) an accounting of the final outcome of
20 each such proceeding instituted by identifying
21 the number of goods or services for which such
22 proceedings were instituted, and the number of
23 goods or services for each involved registration
24 that were cancelled pursuant to such pro-
25 ceedings.

1 (2) With respect to section 1(f) of the Trade-
2 mark Act of 1946, as added by section 3—

3 (A) the number of third-party submissions
4 filed under such section for which the third-
5 party asserts in the submission that the mark
6 has not been used in commerce; and

7 (B) of those applications identified in para-
8 graph (A) above, the number of applications in
9 which the third-party submission evidence is in-
10 cluded in the application; and

11 (C) of those applications identified in para-
12 graph (B) above, the number of applications—

13 (i) refused registration based on an
14 assertion by the examiner that the mark
15 has not been used in commerce; and

16 (ii) for which the examiner requested
17 additional information from the applicant
18 related to claims of use.

19 (3) The effectiveness of—

20 (A) the proceedings under sections 16A
21 and 16B of the Trademark Act of 1946, as
22 added by section 5, in addressing inaccurate
23 and false claims of use in trademark registra-
24 tions; and

1 (B) any additional programs conducted by
2 the Director designed to address inaccurate and
3 false claims of use in trademark applications
4 and registrations, including the post-registra-
5 tion use audit, as implemented at the date of
6 enactment of this Act under sections 2.161(h)
7 and 7.37(h) of title 37, Code of Federal Regu-
8 lations.

9 (c) REPORT TO CONGRESS.—Not later than three
10 years after the date of enactment of this Act, the Comp-
11 troller General of the United States shall submit to the
12 Committee on the Judiciary of the House of Representa-
13 tives and the Committee on the Judiciary of the Senate
14 a report—

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

17 (2) that includes any recommendations, based
18 on the results of the study, for any changes to laws
19 or 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
2 (15 U.S.C. 1068) is amended by inserting after “es-
3 tablished in the proceedings” the following: “. The
4 authority of the Director under this section includes
5 the authority to reconsider, and modify or set aside,
6 a decision of the Trademark Trial and Appeal
7 Board”.

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

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

18 (b) RULES OF CONSTRUCTION.—

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

1 (2) AUTHORITY WITH RESPECT TO PARTICULAR
2 DECISIONS.—The amendments made by subsection
3 (a) may not be construed to require the Director to
4 reconsider, modify, or set aside any particular deci-
5 sion of 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.”.

