



Memorandum

March 23, 2021

U.S. Trademark Modernization Act of 2020 The Importance of Accurate Identifications

Overview

The Trademark Modernization Act of 2020 (TMA), which will go into effect December 27, 2021, is aimed at improving and strengthening the accuracy and integrity of the U.S. federal trademark register. The TMA establishes two new procedures that can be used by anyone to challenge a trademark registration on the basis of nonuse of the mark:

1. *Expungement* on the ground that the mark was never used in commerce with the goods and services identified in the registration.
2. *Reexamination* on the basis that the mark was not used in commerce with the goods and services on or before a relevant date, such as the claimed date of first use in commerce.

What This Means

When the TMA takes effect, trademark applicants in the U.S. will have two new options for challenging an existing registration on the ground of nonuse of the mark in commerce. At the same time, it is vital for trademark owners to understand that a U.S. registration can be challenged if the mark is not used with all of the goods and services covered by the registration.

Considerations for Owners of U.S. Trademarks

In order to withstand an expungement or reexamination proceeding, owners of U.S. trademarks will want to ensure that their trademark applications and registrations accurately identify the goods and services with which the mark is used.

This can be accomplished in two ways:

1. Confirming that new applications identify the actual goods and services with which the mark is used, or will be used, when filing the application and the statement of use.
2. Confirming that existing registrations accurately reflect the goods and services with which the mark is used when filing a declaration of use.

Conclusion

With the enactment of the TMA later this year, owners of U.S. trademarks or those planning to file for U.S. trademark protection will want to carefully consider whether their marks are used in commerce or will be used in commerce with the identified goods and services and take corrective action if necessary. For more information about the TMA, please contact a COJK attorney.

This memorandum is not intended to provide legal advice, and no legal or business decision should be based on its content. Questions concerning issues addressed in this memorandum should be directed to:

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