

**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.”.

