

IP Heads-Up™

On Current Changes Impacting Your Intellectual Property



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Trademarks

Big changes in US trademark law have been introduced by the Trademark Modernization Act ("TMA"), some key points of which are as follows:

- There are new tools for challenging a mark when it is not truly being used for some or all of the registered goods and services, through simple one-party petitions instead of competitive litigation. These Reexamination and Expungement proceedings can now be used instead of Oppositions and Cancellations at the USPTO or in court. The new law seeks to clear the Register of unused marks, and remove registered goods and services for which a mark is not being used.

Useful Tip: Now is the time to review your own portfolio to confirm your on-going record of trademark usage for all listed goods/services, and to make necessary corrections now, with no USPTO fee. This should insulate you from attacks by others.

- The TMA codifies Letters of Protest against trademark applications of concern, now *requiring* the USPTO to act on them. This makes such Letters a more useful tool.
- On December 1, 2022, trademark prosecution at the USPTO will be faster, so you can use the ® symbol sooner. This is a good time to file on your valuable trademarks.

Patents

A big change: The European Unitary Patent will finally come into existence in 2023; the intended date is April 1. A Unitary Patent will give coverage in all participating European Union countries. The Unified Patent Court ("UPC") will also come into existence. These changes impact US applicants and patent owners in many ways:

- Your pending and new patent applications at the European Patent Office ("EPO") will have more options for grant: (1) grant of a Unitary Patent; (2) the present "validation" system for EPO countries you select; or (3) a blend of both, to accommodate non-EU members of the EPO (e.g., the UK).
- As with Unitary Patents, your already-granted European patents can be enforced in the UPC; there are time-limited "opt-in" and "opt-out" provisions for such "classic" European patents.
- The EPO will still be the place to file and grant patent applications. So-called "national" patents (i.e., *not* filed in the EPO) cannot be enforced in the UPC.

Practical Note: We can handle all filing, grant, and enforcement matters for Europe.

Copyrights

In June, the US Copyright Office launched the Copyright Claims Board ("CCB"), a small claims tribunal as an alternative to federal courts. The CCB can enforce infringement claims and make declarations of noninfringement involving claims up to \$30,000.

Litigation

Another key provision of the TMA is that it *mandates* a presumption of irreparable harm to a trademark owner once trademark confusion is established, thereby strengthening a plaintiff's ability to get an injunction against an infringer. This issue arose and was a factor in connection with our firm just having secured a preliminary injunction against a trademark infringer in vigorously-contested litigation, leading to a final injunction.

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