



ARE USPTO Alert: USPTO Adopts Shorter Deadline to Respond to Office Actions for Trademark Applications

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On November 17, 2021, the United States Patent and Trademark Office (USPTO) published a final rule implementing provisions of the Trademark Modernization Act of 2020 (TMA).

One important new aspect of the rule, which applies to most trademark Office Actions issued on or after December 3, 2022, cuts the deadline to respond to Office Actions in half, from six months to only three months. However, the rule allows for a three-month extension (of course with an extra government fee). This is similar to the way the USPTO deals with Office Actions for patent applications.

The new response time applies to most application filing bases, including use in commerce section 1(a), intent to use section 1(b), foreign application section 44(e), and foreign application section 44(d). In these situations, trademark applicants can request a single three-month extension to respond for a \$125 fee. This would bring the total available response time back to six months.

There are two notable exceptions to this new policy. An applicant cannot request an extension of time if the application was filed as a Madrid Protocol section 66(a) application. For those foreign-based applications, the response period will remain at six months. Similarly, extensions are not available if the Office Action was issued before December 3, 2022, which also will automatically enjoy the full six months.

The USPTO intends to accomplish two things by shortening the response time. Specifically, the USPTO hopes to: (i) decrease the time it takes to get a registration; and (ii) provide the flexibility to request additional time to respond to more complex Office Actions.

The shortened response time (without paying the extra fee) will have significant real-world effects for trademark practitioners and their clients. For example, Applicants will have less time to report and decide how to respond to an Office Action, including whether to submit written arguments based on a cited mark or marks, whether to oppose or cancel the cited mark(s), and/or whether to seek a co-existence agreement with the owner(s) of the cited mark(s).

It is important to note that this new response period applies to pending trademark applications only. It will not apply to post-registration office actions for things like renewals. Changes to the post-registration response period will be implemented on October 7, 2023, and we will



report again once we learn what is in store there.

More information is available at the [USPTO website](#).

We will continue to monitor and report on USPTO developments and developments in this area of trademark law. In the meantime, please feel free to contact us to learn more.

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