

November 1, 2022

What is taking so long for my trademark registration application?

New Deadlines to Respond to Trademark Registration Application Office Actions from USPTO

Starting during the pandemic, a surge in trademark registration applications filed with the United States Patent and Trademark Office (USPTO) doubled the number of applications waiting to be examined. The surge is believed to be the result of growth in e-commerce. Before the surge, the USPTO was typically examining applications 3-4 months after filing. Now we don't typically see the USPTO's examination until 7-10 months after filing, which has drastically affected many of our clients.

In an attempt to decrease the amount of time it takes to get to registration, the USPTO has now amended its rules to shorten the amount of time trademark registration applicants have to respond to USPTO office actions. Up until now, trademark registration applicants have had six months to respond to an office action during the examination of a trademark application at the USPTO. Beginning on December 3, 2022, trademark applicants will have three months to respond to the office action, with a possible three-month extension. If the extension is needed, a \$125 fee must be paid on or before the initial deadline in the office action. Failure to either respond to an Office Action or request an extension within the initial three-month response time will result in abandonment of the application.

Many of our clients, for various good reasons, wait until closer to 6 months following an office action to authorize our response. Those clients will now be incurring this additional expense for the extension in so doing. To avoid any issue in being granted an extension, we will be encouraging clients to authorize our response within three months of the date of the office action until more is known about the USPTO's standards in granting or denying such extension requests.

Again, this only applies to office action mailed on or after December 3, 2022. It does not apply to trademark registration applications based on international registrations (under Section 66(a) of the Trademark Act).

Peacock Law P.C.
Client Newsletter
November 1, 2022
Page 3

G:\ADMIN\ClientNews\2022\November - TM Deadlines\DRAFT Client newsletter November - Trademark Response Deadlines
11.07.22.docx