

CANTOR COLBURN CLIENT ALERT

USPTO Implements New Deadlines to Respond to Office Actions in Trademark Applications

Summary

Effective December 3, 2022, the USPTO will cut Trademark Office Action review time in half, from six to three months, with a single three-month extension available. The USPTO's intent is to decrease the time it takes to get and maintain a registration and to provide the flexibility to request additional time to respond to more complex office actions.

Overview

On Wednesday October 12, 2022, the U.S. Patent and Trademark Office (USPTO) confirmed that beginning December 03, 2022, new rules regarding response deadlines for office actions in trademark applications will be put into effect. These rules, implemented by the Trademark Modernization Act (TMA), will have significant impact to trademark stakeholders.

Effective December 03, 2022, the deadline to respond to an office action issued in trademark applications based on Sections 1 or 44 of the Trademark Act ("national applications") will be three months, with a single three-month extension available. This is a reduction from the current six-month response period.

Pending Extensions of Protection of International Registrations are not subject to the new three-month deadline; office action deadlines will remain at six months for such pending Extensions.

By shortening the response time, the USPTO's stated intent is to:

- Decrease the time it takes to get and maintain a registration
- Provide the flexibility to request additional time to respond to more complex office actions

This new response period does not currently apply to post-registration office actions. The USPTO plans to implement the new three-month response period (with extension) for post-registration office actions on October 07, 2023. The new post-registration office action deadlines will apply to registrations based on national applications, as well as Extensions of Protection.

More information can be found online at [New deadline to respond to office actions for applications | USPTO](#).

Further Information & Assistance

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