

ALERT

December 2022

Update: The United States Patent and Trademark Office Shortens the Time to Respond to Office Actions

By: MH&H Intellectual Property Practice Group

As we previously reported in our [October IP Alert](#), starting on December 3, 2022 the period for responding to office actions issued against most trademark applications was reduced from 6 to 3 months with the option of requesting a single 3-month extension of the deadline for a fee of \$125. The term for filing a request for reconsideration and/or an appeal against a final office has also been reduced to 3 months.

These changes apply to most applications including those filed based on claims of use, intent to use and ownership of foreign applications and registrations. The changes, however, do not apply to applications filed pursuant to the Madrid Protocol, for which the response time will remain 6 months.

The United States Patent and Trademark Office (“USPTO”) hopes the reduced response time will decrease the time from the filing of an application to registration. However, the USPTO also recognizes that some office actions may require additional time to prepare a response. Therefore, an applicant may obtain a single 3-month extension of the deadline for a fee of \$125.00.

There will also be a shortened 3-month term to respond to post-registration office actions, but this change does not go into effect until October 7, 2023.

While the reduced response time should speed up the process for obtaining a registration, it will also alter the trademark prosecution strategy in certain circumstances. Trademark attorneys often utilize timelines to formulate trademark filing strategies such as, for example, when the date a mark is anticipated to be put into use or third-party rights are factors in the decision to file a trademark application.

The attorneys in Moritt Hock & Hamroff LLP’s intellectual property department welcome the opportunity to discuss the impact this change may have on a trademark registration strategy. Please feel free to contact us with any questions pertaining to this Alert or any other trademark or IP related matters. Our contact information is set forth below.

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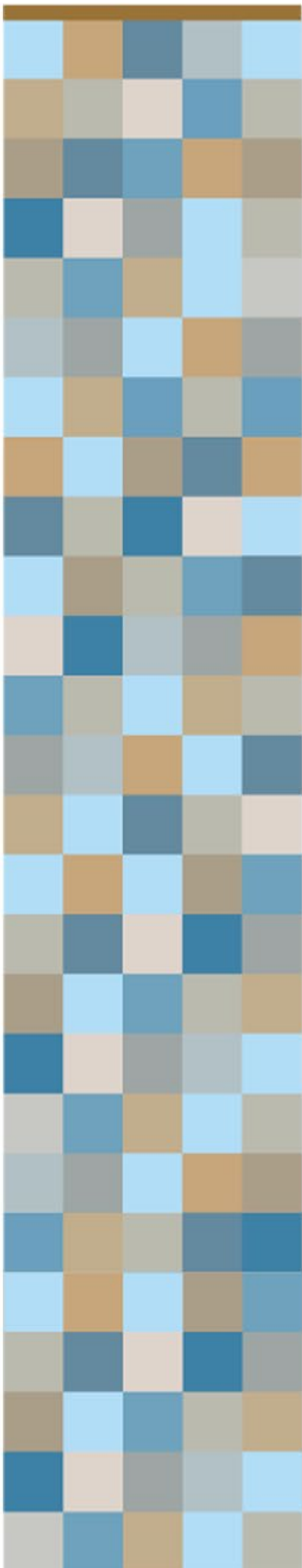
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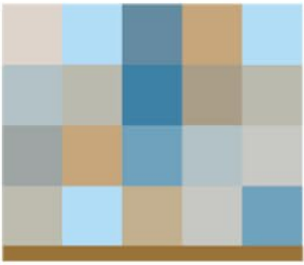
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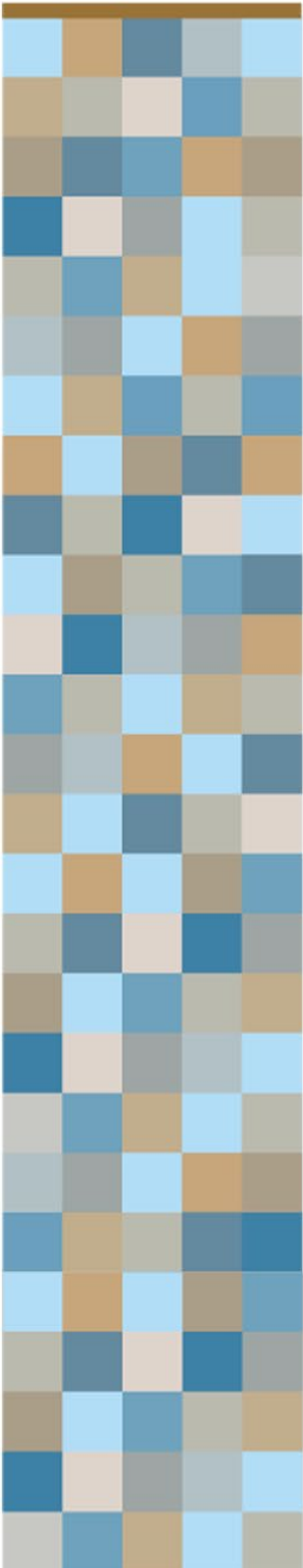
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