

Examination Guide 2-22
Change in Office Action Response Periods for Section 1 and/or
Section 44 Applications
December 2022

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I. Introduction

On November 17, 2021, the United States Patent and Trademark Office (USPTO) published a final rule ([Changes to Implement Provisions of the Trademark Modernization Act of 2020](#), 86 FR 64300) establishing a three-month response period for office actions issued for applications filed under Trademark Act (Act) sections 1 and/or 44.¹ 37 C.F.R. §2.62(a)(1)(i). The rule also included an option for applicants to extend the deadline by filing a single three-month extension request. 37 C.F.R. §2.62(a)(2).

These rule changes are effective December 3, 2022,² and on that date, this examination guide supersedes the current edition of the Trademark Manual of Examining Procedure (TMEP) and any other official USPTO guidance to the extent any inconsistency exists.

Unless stated otherwise, the guidance set forth below applies only to pre-registration office actions,³ including suspension inquiries and Office actions issued after the filing

¹ The rule changes for post-registration office action response periods will be effective on October 7, 2023, and guidance relating to such rule changes will be issued on a later date. See [Changes to Implement Provisions of the Trademark Modernization Act of 2020; Delay of Effective Date and Correction](#), 87 FR 62032 (Oct. 13, 2022).

² Changes to Implement Provisions of the Trademark Modernization Act of 2020, [Final Rule](#) and [Correction](#), 86 FR 64300; 87 FR 62032 (effective Dec. 3, 2022, for examination of applications) (to be codified at 37 C.F.R. pts. 2 and 7).

³ Pre-registration office actions are office actions issued by examining attorneys prior to registration and do not include office actions issued by other business units. The rule changes do not affect current

of a statement of use (SOU), for applications filed under sections 1 and/or 44. The response period of six months remains unchanged for office actions issued in connection with applications filed under section 66(a). 37 C.F.R. §2.62(a)(1)(ii). Further, the time for filing a request for an extension of time to file an SOU after issuance of a notice of allowance remains unchanged. 37 C.F.R. §2.89(a)-(c); TMEP §1108.01.

II. Three-month Response Period

For applications filed under sections 1 and/or 44, the response period for an office action issued on or after December 3, 2022 is three months from the issue date.⁴ See 15 U.S.C. §1062(b)(2); 37 C.F.R. §2.62(a)(1)(i). The deadline for filing a notice of appeal is also three months from the issue date of a final office action issued on or after December 3, 2022. See 37 C.F.R. §2.142(a)(1).

The examining attorney has no discretion to extend the response deadline. However, an applicant may, before filing any response, make one request for a three-month extension of the deadline. See 15 U.S.C. §1062(b)(3); 37 C.F.R. §2.62(a)(2).

Response periods for office actions issued *before* December 3, 2022, are unchanged. See [Part V](#).

III. Request for Extension of Time to Respond

Under 37 C.F.R. §2.62(a)(2), an applicant may request one three-month extension of the time to respond, for a maximum response period of six months from the office action issue date, subject to payment of the applicable fee.

Only one extension request may be filed for each office action with a three-month response period. The total time period for response may not be extended beyond six months from the office action issue date. See 15 U.S.C. §1062(b)(3); 37 C.F.R. §2.62(a)(2). For example, a timely extension request filed after issuance of a final office action, but before submission of a response, extends the time for filing a response and/or notice of appeal to a maximum of six months from the final office action issue date.

No extensions of time are available for office actions with a six-month response period, such as an office action for a section 66(a) application or an office action issued prior to December 3, 2022. See [Part V](#).

USPTO practice regarding office actions that (1) do not require a response, such as examiner's amendments and suspension notices; or (2) do not restart the beginning of a statutory response period (e.g., denials of a request for reconsideration).

⁴ The time for taking any action when the response period ends on a Saturday, Sunday, or federal holiday remains unchanged. See 35 U.S.C. §21(b); 37 C.F.R. §2.196; TMEP §308.

A. Requirements for Extension Request

A complete request for an extension of time to respond must include: (1) a written extension request from the applicant, filed before the expiration of the three-month response period; and (2) payment of the fee required by 37 C.F.R. §2.6(a)(28), currently \$125 if filed via the Trademark Electronic Application System (TEAS) and \$225 if accompanying a permitted paper filing.

Applicants must file the extension request through TEAS, unless an exception to the requirement to file electronically applies. See 37 C.F.R. §§2.23(a), 2.62(c). The "Request for Extension of Time to File a Response" form must be used for this purpose. The submission must be properly signed by someone with firsthand knowledge of the facts pertaining to the extension request.⁵

Any extension request that is not accompanied by the applicable fee, or any request filed using a form other than the "Request for Extension of Time to File a Response" form,⁶ will be treated as a non-responsive communication under TMEP §719 and given no effect.

B. Time for Filing

To be considered timely, a complete request for an extension of time to respond must be received by the USPTO on or before the end of the three-month response period set forth in the office action. 37 C.F.R. §2.62(a)(2).

In addition, the extension request must be filed *before* filing any response.⁷ In the context of extension requests, a "response" includes a notice of appeal to the Trademark Trial and Appeal Board (Board). Therefore, no extension of time will be granted following the filing of a notice of appeal as to the preceding final office action.

Furthermore, an extension request only extends the response deadline for the particular office action to which it applies. Each office action that issues with a new three-month response period sets a new time for filing an extension request as to that office action. For example, a supplemental office action⁸ or a subsequent final action in which an appeal has not previously been filed⁹ are office actions that begin

⁵ Although any individual with firsthand knowledge of the facts pertaining to the extension request may sign the extension request, unrepresented foreign-domiciled applicants are required to appoint a qualified U.S.-licensed attorney to represent them before the USPTO in any application-related filing.

⁶ See TMEP §301.01(b) regarding TEAS availability.

⁷ The filing of an amendment to allege use, a request to divide, or a Change Address or Representation (CAR) form does not generally constitute a "response." See TMEP §§1104, 1110.08. See also TMEP §719 regarding communications that are treated as "non-responsive communications."

⁸ See TMEP §711.02.

⁹ A subsequent final office action issued after remand of an application by the Board does not set a new three-month response period because no response is required from the applicant. The application is immediately returned to the Board for resumption of the appeal after the action issues. See TMEP §715.04(b). The response clause must be omitted from the action. *Id.*

a new three-month response period and therefore set a new time for filing an extension request.

Extensions do not affect current USPTO practice regarding notices of incomplete response or actions continuing a final refusal (i.e., 30-day letters)¹⁰ or any denial of a request for reconsideration. A 30-day letter or a denial of a request for reconsideration does not reset the original three-month response period and is only issued after a response has been filed. Therefore, an applicant may not file an extension request in response to a 30-day letter or a denial of a request for reconsideration.

Consider the following examples:

Example: If an office action was issued on December 6, 2022, and the applicant timely files a complete extension request on or before March 6, 2023, prior to filing a response, the applicant has until June 6, 2023, to file a response.

If the applicant later files a response within the extended response period and a notice of incomplete response must issue, the relevant deadline is 30 days from the issuance of the notice of incomplete response or June 6, 2023, whichever is longer.

Example: An office action was issued on December 6, 2022, and the applicant filed a response on December 13, 2022. No timely extension request was filed prior to the response. If the examining attorney issues a 30-day letter following review of the response, the relevant deadline is 30 days from the issuance of the 30-day letter or the remainder of the original three-month response period (March 6, 2023), whichever is longer. No extension request may be filed because the applicant has already submitted a response.

Example: If a final office action was issued on December 6, 2022, and the applicant files a request for reconsideration on March 6, 2023, but did not file an extension request prior to filing the request for reconsideration, the end of the response period and time for filing an appeal is March 6, 2023. No extension request may be filed because the applicant has already filed a response.

Similarly, if the applicant filed a notice of appeal on or before March 6, 2023, the notice of appeal constitutes a response, and no extension request may be filed.

If the examining attorney later issues a nonfinal office action, the nonfinal office action begins a new three-month response period. The applicant may file an extension request as to that office action provided it is filed before the applicant submits a response.

¹⁰ See TMEP §§718.03, 718.03(b).

C. Failure to Timely File a Response or Extension Request

Under 37 C.F.R. §2.65, an application becomes abandoned if, before the end of the three-month response period, the applicant (1) fails to respond to an office action, or fails to respond completely;¹¹ or (2) fails to timely file a complete request for an extension of time to respond. In addition, if a timely extension request is granted, but the applicant fails to respond within the extended period for response, the application will be abandoned for failure to respond. The examining attorney has no authority to accept a late response.

IV. Petitions to Revive

Applicants may seek to revive an abandoned application in full or in part by filing a petition to revive under 37 C.F.R. §2.66.

A. Office Actions with a Three-month Response Period

Nonfinal office actions

If an application is abandoned because the applicant did not file a response or a timely extension request to a *nonfinal* office action within the three-month response period set forth in the office action, the petition to revive must include all of the following:

- (1) The petition fee required by 37 C.F.R. §2.6(a)(15)(iii)-(iv);
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional;
- (3) A response to the office action, signed pursuant to 37 C.F.R. §2.193(e)(2), or a statement that the applicant did not receive the office action or the notification that an office action issued; and
- (4) If the applicant does not assert non-receipt of the office action or notification, the extension request fee under 37 C.F.R. §2.6(a)(28).

37 C.F.R. §2.66(b)(1)-(4).

Final office actions

If an application was abandoned after a *final* office action and the applicant does not assert non-receipt of the office action, then, in addition to the above requirements, the applicant must also file: (1) a notice of appeal to the Board under 37 C.F.R. §2.141 or a petition to the Director under 37 C.F.R. §2.146, if permitted by 37 C.F.R. §2.63(b)(2)(iii); or (2) a statement that no appeal or petition is being filed from any final refusal or requirement. 37 C.F.R. §2.66(b)(5). The response submitted with the petition to revive is treated as a request for reconsideration. *Id.*

¹¹ See TMEP §§718.03-718.03(b) regarding incomplete responses.

Extension Fee Does Not Extend Time Period for Response Beyond the Submission of the Petition to Revive

Payment of the extension request fee with the petition to revive does not provide additional time to file a further response, including a further request for reconsideration or notice of appeal to the Board, as applicable. A response, including the filing of a notice of appeal to the Board, if applicable, is due at the time of filing the petition to revive.

Assertion of non-receipt of the office action

If the applicant asserts non-receipt of the office action, no extension request fee is required with the petition. An applicant may not assert again in a subsequent petition that it did not receive the same office action or notification. 37 C.F.R. §2.66(b)(3).

B. Office Actions with an Extended Response Period

Nonfinal office actions

If an application is abandoned because the applicant did not file a response to a *nonfinal* office action with an extended response period, the petition to revive must include all of the following:

- (1) The petition fee required by 37 C.F.R. §2.6(a)(15)(iii)-(iv);
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and
- (3) A response to the office action, signed pursuant to 37 C.F.R. §2.193(e)(2).

37 C.F.R. §2.66(b)(1)-(3).

Final office actions

If an application was abandoned after a *final* office action, in addition to the above requirements the applicant must also file: (1) a notice of appeal to the Board under 37 C.F.R. §2.141 or a petition to the Director under 37 C.F.R. §2.146, if permitted by 37 C.F.R. §2.63(b)(2)(iii); or (2) a statement that no appeal or petition is being filed from any final refusal or requirement. 37 C.F.R. §2.66(b)(5). The response submitted with the petition to revive is treated as a request for reconsideration. *Id.*

Assertion of non-receipt of the office action

The filing of the extension request presumes knowledge of the issuance of the office action. Accordingly, in the limited circumstance in which an applicant has been

granted an extension of the response period to six months and does not file a response within the extended time period, the applicant may not claim non-receipt of the office action in any petition to revive under 37 C.F.R. §2.66. In such case, the applicant must provide a response to the outstanding office action with the petition to revive. In the rare circumstance in which the applicant alleges that an extraordinary situation resulted in non-receipt of the office action, even though an extension request was filed, the applicant may provide proof of such alleged extraordinary situation in a petition to the Director under 37 C.F.R. §2.146(a)(5).

V. Procedures for Office Actions Issued Prior to December 3, 2022

The six-month response deadline for an office action issued *before* December 3, 2022 is unchanged. See 37 C.F.R. §2.62(a)-(a)(1). For example, an office action issued on December 2, 2022 with a six-month response period will continue to have a six-month response period on or after December 3, 2022. However, if a subsequent office action¹² is issued for the same section 1 and/or section 44 application on or after December 3, 2022, the subsequent office action will have a three-month response period, with an option to file one three-month extension request.

Each office action must set forth the appropriate deadline for response. See 37 C.F.R. §2.62(a).

The following table sets forth the relevant deadlines for office actions issued before and after December 3, 2022, whether it is a first office action or a subsequent office action.

Filing basis	Issue date of office action/notification to the International Bureau (for §66(a) first actions)	Response deadline
§1 and/or §44 filing basis	Before December 3, 2022	Six months
§1 and/or §44 filing basis	On or after December 3, 2022 (even if a previous office action had a six-month response period)	Three months, with an option to extend the deadline to six months by filing a timely three-month extension request
§66(a)	Anytime	Six months

¹² Subsequent office actions do not include 30-day letters or other letters that do not start a new statutory period for response. In these instances, the relevant response period will be based on when the previous office action setting forth a statutory period for response was issued. See also [footnote 9](#) regarding certain subsequent final actions in which the response clause must be omitted.