

UNITED STATES
PATENT AND TRADEMARK OFFICE



Trademark basics boot camp: Responding to an office action

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Images used in this presentation are for educational purposes only.

Trademark basics boot camp

- Reminders:
 - This session is being recorded.
 - The slides will be emailed after the presentation.
 - Captioning is available.
 - Post your questions to the Q&A box.

Discussion topics

- Trademark basics
- Office action basics
- How to file a response
- Tips for successful response
- How to find help

Discussion topic

Trademark basics



Trademark basics

- Trademark
 - Identifies the source of goods and services.
 - Distinguishes them from the goods and services of another party.
 - Provides legal protection for a brand.



Trademark basics (cont'd)

- Remember:
 - You are not “buying” a trademark.
 - Not every trademark is registrable.
 - Filing fees are not refundable.

Discussion topic

Office action basics



Office action basics

- Office action
 - Official letter that USPTO examining attorney issues after reviewing trademark application
 - Notification of letter provided by email
 - Available to read and download via Trademark Status and Document Retrieval system (TSDR)
 - <https://tsdr.uspto.gov/>



Office action basics (cont'd)

- Common types of office actions
 - Nonfinal office action
 - Final office action
 - Denial of request for reconsideration
 - Examiner's amendment
 - Priority action
 - Suspension letter



Office action basics (cont'd 2)

- Nonfinal office action
 - Raises any refusal(s) or requirement(s) for first time.
 - Requires response for application to move forward.



Office action basics (cont'd 3)

- Final office action
 - Maintains and continues any remaining refusal(s) or requirement(s) for final time.
 - Requires response, unless applicant decides not to continue with application.



Knowledge check #1

If the USPTO refuses to register your trademark, does that mean your trademark can never be registered?

Yes

No





Knowledge check #2

If the USPTO refuses to register your trademark, does that mean you must stop using your trademark?

Yes

No



Discussion topic

How to file a response

How to file a response

- File using the Trademark Electronic Application System (TEAS) response forms.
 - Response link available through:
 - Office action
 - USPTO website
 - www.uspto.gov/trademarks/apply/response-forms



How to file a response (cont'd)

The screenshot displays the USPTO TSDR Case Viewer interface. At the top, the title "USPTO TSDR Case Viewer" is visible. Below it, a header bar contains "Case Id", "Document Description" (with a dropdown menu showing "3. Non-Final Action"), and "Mail/Create Date" (Jun. 04, 2022). On the right side of the header, there are buttons for "Download PDF", "Prev Doc", and "Next Doc". The main content area shows a document page with the following text:

To amend the basis from Section 1(a) to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §2.35(b)(1).

To withdraw an amendment to allege use, applicant must make a statement in the record requesting that the amendment to allege use be withdrawn.

For more information about the response options above and instructions on how to submit a different specimen using the online Trademark Electronic Application System (TEAS) form, see the [Specimen webpage](#).

RESPONSE GUIDELINES

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.


The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. [Click to file a response to this nonfinal Office action.](#)

Discussion topic

TEAS demonstration

TEAS demonstration

About Us Jobs Contact Us

Trademark Electronic Application System

PTO-1957
Approved for use through 11/30/2023. OMB 0651-0050
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

Response To Office Action

TEAS - Version 8.1

CONTACT:

For **general trademark information or help navigating the forms**, email TrademarkAssistanceCenter@uspto.gov, or telephone 1-800-786-9199 (press 1).

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If you need help resolving **technical glitches**, email TEAS@uspto.gov. Please include in your email your phone number, serial or registration number, and a screenshot of any error message you may have received.

Tips:

Use the **Continue** button at the bottom of each page to move through the form. Fill out all fields for which information is known. Fields with a * symbol are mandatory and must be completed.

Choose a signature method for signing the form on the Signature Page.

Review the data you entered by accessing the Input Table on the Validation Page. Confirm that all information is displayed properly. Return to the appropriate section of the form and make any needed corrections before submission of the response.

Click on the **Pay/Submit button** at the bottom of the Validation Page and provide the payment required (if any) to submit the form. When successful you will be navigated to a confirmation screen.

An email acknowledging receipt of the submission (a filing receipt) will be sent to the Primary Email Address for Correspondence.

Status Check:

The status of the filing is available in the [Trademark Status & Document Retrieval System \(TSDR\)](#) 72 hours after filing.

Discussion topic

Tips for successful response



Tips for successful response

- All situations
 - Read the office action carefully.
 - Don't procrastinate.



Tips for successful response (cont'd)

- Examining attorney suggests discussion
 - Call or email to discuss application issues.
 - Office action will specifically state that option.
- Discussion not suggested
 - Respond completely, addressing all issues.
 - Use TEAS response form.



Tips for successful response (cont'd 2)

- If you disagree with refusal or requirement
 - Educate the examining attorney.
 - Avoid conclusory arguments.
 - Argue the evidence.
 - Submit new evidence.



Tips for successful response (cont'd 3)

- Responding to Section 2(d) refusal
 - Check status of cited trademarks.
 - Argue no likelihood of confusion exists.



Tips for successful response (cont'd 4)

- Responding to Section 2(e)(1) refusal
 - Argue trademark does not describe the goods and services.
 - Amend goods and services.
 - Accept alternative, if suggested by examining attorney.



Tips for successful response (cont'd 5)

- Responding to “indefinite ID” requirement
 - Consider suggestions in office action.
 - Propose acceptable wording.
 - Remember:
 - Cannot broaden scope of identification.
 - Cannot “undo” amendments to your identification after you make them.





Tips for successful response (cont'd 6)

- Responding to disclaimer requirement
 - Consider suggestion in office action.



Knowledge check #3

Can you request an extension of time to file your response to an office action?

Yes

No

Discussion topic

How to find help

USPTO resources

The screenshot shows the USPTO website interface. At the top, there is a dark header with the USPTO logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. To the right of the logo are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. Below the header is a search bar with the text 'Search uspto.gov' and a magnifying glass icon. A navigation bar below the search bar contains links for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. Below the navigation bar is a blue breadcrumb trail: 'Home > Trademarks > Maintain > Responding to office actions'. To the right of the breadcrumb trail are 'Share' and 'Print' icons. The main content area has a left sidebar with a list of links: 'Application process', 'Searching trademarks', 'Apply online', 'Disclosure of public information', 'Checking application status & viewing documents', 'Responding to Office actions' (highlighted), 'Abandoned applications', 'Ordering certified documents', and 'Trademark Trial and Appeal Board'. The main content area features the title 'Responding to office actions' and a paragraph: 'The United States Patent and Trademark Office (USPTO) may issue several different types of office actions about your trademark application. This page focuses on office actions that trademark examining attorneys send during the application process.' Below the paragraph are links for 'Expand all' and 'Collapse all'. A list of six items is displayed in a table-like structure, each with a right-pointing chevron icon: 'What is an office action?', 'Deadline for filing a timely response', 'How to file a response', 'File a complete response', 'Who to contact with questions about your office action', and 'Responding to common refusals or requirements'.



How to find help

- For substantive questions
 - Assigned examining attorney
 - Supervisor of assigned examining attorney
- For technical questions
 - TEAS@uspto.gov

Caution: scam alert

- Beware of scams.
 - www.uspto.gov/TMFraud
- Beware of non-attorney filing firms.
 - www.uspto.gov/trademarks/protect/filing-firms
- Beware of misleading notices and offers.
 - www.uspto.gov/TrademarkSolicitations



USPTO resources

- Website
 - www.uspto.gov
- Trademark videos
 - www.uspto.gov/TMvideos
- Trademark basics registration toolkit
 - www.uspto.gov/TrademarkBasicsToolkit



USPTO resources (cont'd)

- IP Identifier
 - <https://ipidentifier.uspto.gov>
- Free services and resources
 - www.uspto.gov/FreeServices
- USPTO virtual assistant
 - www.uspto.gov/trademarks/basics





USPTO resources (cont'd 2)

- Trademark Assistance Center
 - Main support center for all trademark customers
 - Phone: 1-800-786-9199 (press 1)
 - Email: TrademarkAssistanceCenter@uspto.gov

USPTO resources (cont'd 3)

- The USPTO does not:
 - Provide legal advice.
 - Enforce legal rights.
 - Recommend specific private attorneys.



Legal resources

- Remember:
 - The best resource is an experienced trademark attorney.
 - Most trademark filing companies can only provide limited services.



Questions?



DISCLAIMER: References to particular trademarks, service marks, certification marks, products, services, companies, or organizations are for illustrative and educational purposes only and do not constitute or imply endorsement by the U.S. government, the U.S. Department of Commerce, the U.S. Patent and Trademark Office, or any other federal agency.