

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





INVENTION-CON 2017

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USPTO's Inventors Conference • August 11-12 • Alexandria, VA

UNITED STATES
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THE TRADEMARK EXAMINATION PROCESS

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WHAT IS AN “OFFICE ACTION”?

Official letter, *usually* requiring response within 6 months (statutory period).



5 TYPES

- **Formal Office Action**
- **Examiner's Amendment**
- **Priority Action**
- **Suspension Letter**
- **Suspension Inquiry Letter**

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- Formal Office Action

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- Examiner's Amendment

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- Priority Action

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- **Suspension Letter**

5 TYPES

- Suspension Inquiry Letter



RESPONSE DEADLINES

6 months from the mailing/issuing date stated in Office action, unless different period specifically stated. No extension possible because deadline is set by statute.



RESPONSE DEADLINES

Failure results in USPTO abandoning the application = no registration and no refund.
Only options: Filing either Petition or new application.



HOW TO FILE RESPONSE

Trademark Electronic Application System (TEAS)



TIPS FOR RESPONDING

Legal proceeding

Read through the entire Office action

Respond timely (and early)

Respond completely

Consider calling or e-mailing to respond, if appropriate



CONTENT OF RESPONSES

- Argue your interpretation of the evidence
- Educate the examining attorney about your field/industry
- Avoid conclusory or broad arguments without evidence to support them

SPECIFIC LEGAL ISSUES

- Requirements for “definite” identification of goods/services
- Requirement to “disclaim” a portion of the mark
- Section 2(d) “likelihood of confusion” refusal
- Section 2(e) “descriptiveness” refusal
- Specimen refusal



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- **Section 2(d) “likelihood of confusion” refusal**



SPECIFIC LEGAL ISSUES

- Section 2(e) “descriptiveness refusal

SPECIFIC LEGAL ISSUES

- Specimen refusal

COST

No fee unless amendment to the goods/services requires the addition of an actual new class of goods/services.



OPTIONS IF RESPONSE NOT SUCCESSFUL

- “Request for Reconsideration” after examining attorney issues a “final” refusal
- Appeal to the Trademark Trial and Appeal Board (the “Board” or “TTAB”)

