Trademark Office Actions: Responding to an Office Action

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A Practice Note discussing US Patent and Trademark Office (USPTO) trademark refusals to register and post-registration office actions. Topics discussed include the ex parte trademark examination process, bases for refusal, key considerations for responding to office actions, how to deal with final refusals, and ways to avoid office actions.

Contents

It is common during the ex parte examination of federal **trademark** applications for the **US Patent and Trademark Office** (USPTO) initially to refuse to register a mark by issuing an office action. However, an office action is not a final decision on the registrability of the applied-for mark. An applicant faced with an office action may submit arguments and evidence to the USPTO to attempt to overcome the refusal.

This Note discusses the key issues counsel should consider when reviewing and preparing a response to a trademark office action.

For more information on acquiring trademark rights and federal registrations, including the trademark application examination process, see Practice Notes, Acquiring Trademark Rights and Registrations and Filing a Federal Trademark Application.

For more information on trademarks generally, see Practice Note, Trademark: Overview.

Trademark Office Actions

After a trademark application is filed with the USPTO, it is assigned to an examining attorney (or trademark examiner or examiner) for review. While some applications may be approved on initial review, more often the examiner issues an office action: a letter refusing registration of the applied-for mark and setting out the bases for the refusal.

The first office action is a non-final office action. The applicant must file a response within six months after the date of the office action, addressing each issue raised in the office action by, as applicable:

- Correcting any technical defects.
- Providing arguments to refute any substantive refusals.
- Modifying the application to address substantive refusals.

After the applicant files a timely response to a non-final office action, the trademark examiner then issues either:

- A notice of publication or notice of allowance.
- Another (typically final) office action, if the examining attorney does not believe the refusals have been overcome and there are no new issues.

For an outline of the general process for registering a trademark in the USPTO, see Standard Documents, US Trademark Application Flowchart: Use-Based Application and US Trademark Application Flowchart: Intent-to-Use Application.

A trademark examiner may also issue an office action in response to a statement of use or a post-registration filing.

Legal Bases for Refusals to Register

Office actions can include one or more objections based on:

- Defects in the formal application requirements. For example, the examining attorney may object that:
- the application's goods or services identification is indefinite, too broad, or otherwise unacceptable;
- the specimen does not match the drawing of the mark; or
- there is no description of a design mark or the description is inaccurate or incomplete.
- Ineligibility for registration. For example:
- the mark consists of the name of a living person;
- product or package design elements are functional and not purely decorative; or
- the mark includes a representation of a flag, coats of arms, or other government insignia.
- Descriptiveness or one of the other grounds for refusal under 15 U.S.C. § 1052(e), such as:
- geographic descriptiveness; or
- that the applied-for mark is primarily merely a surname.

- A likelihood of confusion with a previously registered or applied-for mark.

The examiner cites to **Trademark Trial and Appeal Board** (TTAB) decisions and the Trademark Manual of Examining Procedure (TMEP) to support its refusal position.

Timing Considerations

The applicant must file a response within six months after the date of the office action. If the applicant does not submit a complete response to the office action by the due date, the USPTO deems the application abandoned. Therefore, on receiving an office action, the applicant and counsel should immediately:

- Docket the deadline and multiple interim reminders.
- Discuss an office action response strategy, as it may sometimes take several months to obtain affidavits, consents, and other necessary evidence.

An applicant can seek revival of an abandoned application by, within two months of the notice of abandonment, filing a petition to revive, which must include:

- A filing fee.
- A statement from someone with firsthand knowledge of the facts that the delay in responding to the office action was unintentional.
- The proposed response or a statement that the applicant did not receive the office action.

(37 C.F.R. § 2.66; TMEP § 1714.)

Suspension of Application

If the application is otherwise in condition for approval but circumstances prevent the examining attorney from finalizing its review, the examining attorney may issue a suspension notice suspending action on the application until the outstanding issue is resolved.

For example, the examiner typically suspends an otherwise publishable application if the examiner finds a likelihood of confusion between the applied-for mark and a mark in an earlier-filed third-party application that is still pending (see 37 C.F.R. § 2.67 and TMEP § 716.02(c)). If the third-party application matures into a registration, the examiner may then issue a likelihood of confusion refusal.

The examiner also may suspend an application when, for example:

- The applicant has filed a petition to cancel a registration cited against the application.
- A proceeding is pending before a court or the TTAB that is relevant to the registrability of the applied-for mark.
- Under the **Paris Convention** or other international agreement, the applicant has based its application on a foreign application that has not yet matured into registration.
- The TTAB's Assignment Recordation Branch has not yet recorded an assignment of the application that the applicant filed.

While an applicant is not required to respond to a suspension, it may do so. A response typically includes:

- Arguments and evidence addressing the substantive basis of the suspension.
- A request for the examining attorney to lift the suspension.

A response to a suspension may be submitted using the USPTO Response Form 3: Response to Suspension Inquiry or Letter of Suspension.

During longer suspensions, the examining attorney issues an office action every six months to get a status update from the applicant about the matter underlying the suspension, such as a pending litigation. If the applicant does not submit a timely response to the suspension inquiry, the application will be abandoned. (TMEP § 716.05.)

Responding to a Non-Final Office Action

Preparing the Response

Though some applicants still submit paper office action responses by mail, most responses are filed electronically. Applicants filing their trademark application using the USPTO's TEAS Plus or TEAS Reduced Fee options must respond to office actions electronically or else pay additional fees. The online process allows the applicant to present its arguments in response to the office action in narrative form, including case law citations if needed, just like a paper response.

When formulating a response, applicant and counsel should consider the following:

- Arguments in favor of registration (see Key Arguments in Favor of Registration).
- Supporting evidence (see Supporting Evidence).
- Possible amendments to the application (see Amending the Trademark Application in Response to a Refusal).
- Corrections to the application (see Corrections to the Application).
- Third-party consent (see Seeking a Consent Agreement).
- Collateral TTAB proceedings (see Petitioning to Cancel a Conflicting Registration).
- Discussing the refusal with the trademark examiner (see Discussing the Refusal with the Trademark Examiner).

Applicant and counsel should also review the relevant case law and TMEP provisions.

Key Arguments in Favor of Registration

The office action response should address all of the examining attorney's legal and factual arguments in the office action. Depending on the specific contentions and available evidence, the response is likely to include, for example:

- To counter a likelihood of confusion refusal, arguments to show that:
- the marks are dissimilar and distinguishable; and
- the goods or services and channels of trade are not related.
- For more, see Practice Note, Trademark Office Actions: Likelihood of Confusion Refusals.
- When facing a descriptiveness refusal, arguments that:
- a multistage reasoning process or degree of imagination, thought, or perception is required to determine what attributes of the goods or services the mark indicates;
- the mark is a double entendre or has some other meaning that keeps it from being **primarily** merely descriptive; or
- the mark has, through prolonged sales and advertising, acquired secondary meaning.
- (See TMEP § 1209.) For more, see Standard Clauses, Trademark Office Action Response: Mere Descriptiveness (2(e)(1)) Refusals.
- In response to a refusal based on geographic descriptiveness, arguments that:
- the primary meaning of the mark is not a known geographic location;
- the goods or services do not originate in the place allegedly identified by the mark; and
- the public is not likely to see the mark as the geographic source of the goods or services.

2• (See TMEP § 1210.)

In each case, the response should specifically address all of the examining attorney's arguments and evidence.

Post-Publication or Post-Registration Office Actions

In response to a post-publication or post-registration office action, the applicant or registrant should address any deficiencies in the statement of use or maintenance filing, which are typically ministerial and often involve specimens that do not match the mark in the application or registration.

As of March 2017, the USPTO may issue a post-registration office action that requests additional proof to support a use filing.

Supporting Evidence

Applicant and counsel should be prepared to include with the response evidence to support their arguments including, depending on the refusal basis:

1• Third-party trademark registrations, which can help show that any marks cited as likely to be confused with the applicant's are weak and entitled to only a narrow scope of protection.

1• Witness affidavits. These can be useful, for example, to:

1• show amounts spent on advertising a mark to support claims about a mark's strength or to establish secondary meaning;

1• support marketplace coexistence or dissimilarities in trade channels or buying conditions, to counter a likelihood of confusion refusal; or

1• establish the meaning of a mark in the relevant industry.

1• Research results, such as:

1• dictionary definitions;

1• website print-outs; or

1• directory pages.

In response to a post-registration office action requesting additional proof to support a use filing, a registrant may need to submit any or all of the following:

1• Information.

1• Exhibits.

1• Affidavits or declarations.

1• Specimens of use for additional goods or services. For examples of appropriate specimens, see Trademark Acceptable Specimen Chart.

(See Legal Update, USPTO Publishes Final Rule Facilitating Verification of Certain Trademark Use Claims in Affidavits or Declarations.)

Before the filing deadline, counsel should ensure that the evidence conforms to the USPTO's acceptable file types and size limit for attachments. To aid the examiner's review and reduce the chances that documents get misplaced in the event of a transmission glitch, it is good practice to name each attachment with the application serial number and an exhibit number.

Amending the Trademark Application in Response to a Refusal

Sometimes amending the application can assist registration by eliminating a basis for refusal. An applicant may not amend the application to expand the coverage of the mark, but may suggest a limiting or clarifying amendment in response to refusals based on:

- Likelihood of confusion. An amendment may lower the potential for confusion with a cited mark by, for example:
- limiting the application's coverage with a carve-out of specific goods or services; or
- restricting the goods or services to specified trade channels.
- Descriptiveness. The applicant may be able to resolve a descriptiveness refusal by, for example:
- deleting those goods or services for which the applied-for mark is a descriptive term without secondary meaning; or
- adding a disclaimer.
- Technical problems with the application that may be corrected by, for example:
- changing or deleting an international class number in the application;
- adding a translation or transliteration; or
- revising the description of the mark.

In determining whether an amendment is appropriate, the applicant should consider:

- The likelihood that the proposed amendment addresses the examining attorney's concerns and resolves the refusal grounds.
- Whether the amendment is consistent with the applicant's plans for using the mark.

When entering an amendment as part of the office action response, the response should explain how the amendment serves to eliminate the basis for refusal, such as by limiting the trade channels for applicant's goods or services where likelihood of confusion is an issue or removing goods or services described by the applied-for mark where descriptiveness is an issue.

Corrections to the Application

The applicant may need to make corrections to an application that was filed with errors or omissions. Common errors include:

- Misstating the applicant's entity type.
- Neglecting to list prior registrations.
- Not providing names and other information for the general partners in a partnership applicant.

If this is the only basis for the office action, it is most efficient to respond electronically or to contact the examiner directly (see Discussing the Refusal with the Trademark Examiner).

Seeking a Consent Agreement

An applicant facing a likelihood of confusion refusal should consider whether to seek a consent agreement from the owner of any mark cited against the application. Many factors influence whether to pursue a consent, including whether the applicant is prepared to abandon the applied-for-mark altogether if the registration owner declines to grant consent. (By requesting a consent, the applicant may alert the registration owner of a trademark use it objects to, which may prompt an enforcement

action against the applicant.)

An applicant should work quickly to finalize any necessary consent agreement as typically the USPTO does not suspend an application to give the applicant time to secure the agreement.

For more on using a consent agreement to overcome a likelihood of confusion refusal, see Practice Note, Trademark Office Actions: Likelihood of Confusion Refusals: Consent Agreements and Legal Update, Consent or Coexistence? Deciding Which Trademark Agreement to Use.

For a sample trademark consent agreement, see Standard Document, Trademark Consent Agreement.

Petitioning to Cancel a Conflicting Registration

While an applicant may not mount a collateral attack on a conflicting registration in an office action response, depending on the facts, the applicant may consider filing a petition with the TTAB to cancel any conflicting registrations. Potential grounds for cancellation may include:

- Likelihood of confusion, if the applicant has prior rights to those of the registrant.
- Abandonment, if the registrant has ceased use of its mark without an intent to resume use.
- Fraud, if the registrant made material misrepresentations to the USPTO to obtain or maintain its registration.

For more information on grounds for cancellation, see Practice Note, TTAB Oppositions and Cancellations: Grounds and Defenses.

When an applicant files a petition to cancel a registration cited against its application, the applicant should inform the examining attorney of its filing within the time period for responding to the office action and request that the application be suspended until the cancellation action is resolved. If the application is otherwise in condition for approval or final refusal, the applicant may advise the examining attorney of the filing by phone. This constitutes a proper response to the refusal provided there are no outstanding issues requiring a written response (see TMEP § 716.02(a)).

Discussing the Refusal with the Trademark Examiner

An office action includes the examining attorney's telephone number. Though an examining attorney typically does not withdraw substantive refusals in a telephone call, an applicant may call the examiner to try to resolve informalities, for example, to:

- Modify the wording of the identification of goods or services.
- Request entry of a disclaimer.
- Claim ownership of prior registrations for the applied-for mark.

A telephone call may also be helpful for obtaining the examining attorney's informal feedback on whether a particular amendment to the application (for example, the deletion of certain goods or services) may be sufficient to overcome a refusal.

It is also possible that during a call or a subsequent email exchange the examining attorney and the applicant may agree on an amendment to the application that effectively removes the basis for the refusal (for example, if the identification of goods is indefinite and needs clarification). The examining attorney then issues an examiner's amendment memorializing the amendment. No response to the examiner's amendment is required, however, the applicant should review it carefully to ensure it accurately reflects the agreed changes. (See TMEP § 707.)

If the examiner still requires action from the applicant after a phone or email discussion, the examiner may issue a priority action. Unlike an examiner's amendment, a priority action has a six-month deadline like a regular office action, but typically the response requires only confirmation or a submission from the applicant.

Considering Future Conflicts

Before submitting any arguments or evidence in response to the office action, applicant's counsel should consider that the office action response is a public record. Therefore, any arguments the applicant makes potentially may be used against it by a party in a future conflict or proceeding. For example, if the applicant secures a registration and later opposes a third-party

application, the third party may argue that:

- By amending its application to add a disclaimer, the applicant conceded descriptiveness of the disclaimed element.
- Applicant's evidence of third-party registrations for similar marks shows that the applicant's own mark is weak or diluted.
- Applicant's argument that its mark is not confusingly similar to a particular mark supports the third party's position that confusion between the applicant's mark and the third party's mark is unlikely.

Submitting the Response

The USPTO encourages applicants to submit office action responses using the USPTO's Response Form 1: Response to Examining Attorney Office Action Form. This form guides the user through the required steps and provides prompts for submitting the necessary information and relevant evidence. The USPTO also provides a PDF preview of the form that the user can review before completing the actual form. An applicant that filed its application by mail or through TEAS (though **not** through TEAS Plus or TEAS Reduced Fee) also has the option of filing an office action response by mail.

An applicant or registrant can submit a response to a post-publication or post-registration office action using the Response Form 8: Response to Intent-to-Use (ITU)/Divisional Unit Office Action Form or Response Form 9: Response to Post-Registration Office Action Form, as applicable, from the USPTO's Response Forms page.

For more information, including form office action responses for specific refusals, see Trademark Office Action Response Toolkit.

Options When Facing a Final Refusal

If the applicant is unsuccessful in overcoming the initial refusal and receives a final refusal, the application is deemed abandoned unless the applicant files an appropriate response with the USPTO within six months from the issuance of the final refusal. The two principal responses are:

- A request for reconsideration of the final refusal by the examining attorney (see Requesting Reconsideration of a Final Refusal).
- A notice of appeal of the examining attorney's final refusal to the TTAB, along with the requisite fee (see Appealing a Final Refusal to the TTAB).

If the refusal was based on a likelihood of confusion, the applicant also may consider whether it has a basis to file a petition with the TTAB to cancel any conflicting registration.

Requesting Reconsideration of a Final Refusal

If the applicant wishes to present new arguments or evidence not presented in response to the initial refusal, the applicant may file a request for reconsideration after issuance of a final office action and before the deadline for filing an appeal to the TTAB (37 C.F.R. § 2.63(b)). The request for reconsideration may be filed using the USPTO's Response Form 2: Request for Reconsideration after Final Office Action Form. Filing a request for reconsideration does not extend the time for filing an appeal or other proper response to the final action (37 C.F.R. § 2.63(b)).

When submitting a request for reconsideration, the applicant should include all evidence it expects to rely on in a possible appeal to the TTAB to ensure that the evidentiary record for the application is complete before the appeal is filed (see Appealing a Final Refusal to the TTAB). The TTAB does not normally consider new evidence (see Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1207.01; Practice Note, Appealing Trademark Refusals to the TTAB: Evidence on Appeal).

Appealing a Final Refusal to the TTAB

The Lanham Act authorizes applicants to appeal to the TTAB following a final action by an examining attorney (15 U.S.C. § 1070). The applicant may appeal within six months of the date of the final action by:

1. Filing a notice of appeal.

1. Paying the required appeal fee for each class in the application for which the appeal is taken.
(15 U.S.C. § 1070; 37 C.F.R. § 2.142(a).)

If the applicant does not timely submit a notice of appeal and the appeal fee, the application is abandoned. However, under certain circumstances, the applicant may file a petition to revive its application under 37 C.F.R. § 2.66.

The USPTO recommends that applicants file notices of appeal using the USPTO's Electronic System for Trademark Trials and Appeals.

The applicant's appeal brief is due within 60 days of the date of the appeal (TMEP § 1501.02(a)).

Requesting Reconsideration and Filing a Notice of Appeal Concurrently

The applicant may file a notice of appeal concurrently with a separate request for reconsideration (see Requesting Reconsideration of a Final Refusal). In that case, the application is then referred to the TTAB for processing of the appeal. The TTAB then:

1. Acknowledges the appeal.

1. Suspends further proceedings on the appeal, including the applicant's time to file an appeal brief.

1. Remands the application to the examining attorney to review the request for reconsideration.
(TMEP § 715.04; TBMP § 1204.)

If, after reviewing the request for reconsideration, the examining attorney maintains the refusal, the applicant may go ahead with the appeal if it timely filed a notice of appeal.

For more on appeals, see Practice Note, Appealing Trademark Refusals to the TTAB.

Avoiding Refusals

While it may be possible to overcome a refusal by using persuasive arguments and evidence, it is best to avoid receiving an office action in the first place. Strategies for avoiding refusals include:

1. Proper trademark searching and clearance. An applicant may modify its mark or choose a different mark where a search identifies potential conflicts or reveals that others in the same industry use the mark descriptively. For more information on trademark searching and clearance, see Practice Note, Trademark Searching and Clearance.

1. Tailoring trademark applications to avoid refusals. In some cases, an applicant may be able to:

1. help distinguish its mark from a potentially conflicting registered mark, by "drafting around" the registered mark with limitations in the goods and services identification or by filing its mark in a stylized form or with a design element;

1. limit refusals based on descriptiveness, by modifying its mark or narrowing the goods and services identification; or
1. avoid a refusal because the examiner deems the identification vague or too general, by drafting the goods and services identification based on wording in the USPTO's online Acceptable Identification of Goods and Services Manual.

1. Delaying filing of the application. A prospective applicant that uses its mark for a sufficient time period without consumer confusion or objection from the owner of a potentially conflicting mark may be in a better position to overcome a likelihood of confusion refusal by arguing that the long-term marketplace coexistence without actual consumer confusion shows that confusion is unlikely. Likewise, prolonged use may strengthen an applicant's position that its descriptive mark has acquired distinctiveness.
1. Filing a petition to cancel any conflicting registrations and requesting that the USPTO suspend action on the applicant's application pending the cancellation's outcome (see TMEP § 716.02(d)).

