

How Times Have Changed at the U.S. Patent and Trademark Office

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The U.S. Patent and Trademark Office saw record numbers of new trademark applications filed in 2021. During 2021, the USPTO reported over a 25% increase in applications. See USPTO Performance and Accountability Report 2021, available at <https://www.uspto.gov/sites/default/files/documents/USPTOFY21PAR.pdf>. Such a steep increase is thought to come from both foreign and domestic filings, with those from China outpacing growth from both U.S. applicants and applicants from other countries.

As a result of the surge in new filings, there is now a backlog of trademark applications causing significant delays at the USPTO. Applicants filing in the United States should expect longer wait times for the initial processing and examination of their application, subsequent processing of responses to Office Actions, and the review of post-registration filings.

According to the USPTO's Trademark Dashboard (<https://www.uspto.gov/dashboard/trademarks/>), an applicant's average wait period for a first response as of September 2022 is 8.3 months, up by two months from the average wait period in September 2021. Applicants may currently experience even longer initial response periods than those reported as of September 2022, reaching up to 11 months from the filing date.

The Trademark Modernization Act ("TMA") went into effect in December 2021, in part, as a response to the rise in new filings and the surge of new applications from foreign trademark owners. One change to existing procedures is a shortened response period for pre-registration and post-registration Office Actions.

As of December 3, 2022, applicants must respond within three months to Office Actions issued during examination of an application. Applicants can request a single 3-month extension of time to respond, with the submission of a \$125 fee. If the request for an extension of time is not received and a response is not filed within the new 3-month window, the application will be abandoned. This change does not apply to Madrid Section 66(a) applications, which continue to have a 6-month response deadline.

The shortened 3-month, post-registration response period will be implemented on October 7, 2023. Once the change is in effect, the same parameters will apply with respect to the single extension request. And if no extension or post-registration response is filed, the registration will be cancelled.

Among these changes and other important implementations, the TMA provides codified tools for trademark owners to attack applications and registrations that may have been procured without the requisite degree of use. These tools, including new ex parte expungement and reexamination proceedings, are intended to help the Trademark Office clear the register of dead wood. Any party has access to these tools, which can be used to assist the Trademark Office in preserving the register during a time when they need all the help they can muster.