

USPTO To Issue Electronic Registration Certificates and Shorten Office Action Response Timelines

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In its ongoing efforts to modernize its practices and increase the efficiency of examination, the United States Patent and Trademark Office (USPTO) is implementing two changes to issuance of trademark registration certificates and the available period in which to respond to office actions provisionally refusing pending applications.

The USPTO's first change is, as of May 24, 2022, to issue only electronic trademark registration certificates. After that date, electronically issued registration certificates authenticated with the electronic signature of the USPTO Director and agency digital seal will serve as official registration certificates.

The USPTO will offer printed presentation copies of the registration certificates. These presentation copies will consist of a single-page paper version of the registration certificate featuring a gold foil seal. For registrations issued from applications filed before May 24, 2022, the presentation copies can be ordered with no fee charged. For registrations issued from applications filed on or after May 24, 2022, the presentation copies can be purchased for a \$25 USPTO fee.

According to the USPTO, the electronic trademark registration certificates will be issued 1-2 weeks more quickly than the current paper printed registration certificates and reduce paper processing for the 6,000-9,000 printed registration certificates issued each week.

The USPTO's second change is, as of Dec. 1, 2022, to reduce the response period for office actions from 6 months to 3 months. According to USPTO data, most responses to office actions are already filed within 3 months. This formal change is intended to promote efficiency in examination by shortening the prosecution timeline.

If additional time is needed, applicants may request a single extension of 3 months (for a total of 6 months) for a \$125 USPTO fee. The extension must be requested in the initial response period of 3 months.

The change does not alter the response period for applications filed under the Madrid system. The timing for those will remain at 6 months to accommodate additional processing at the USPTO and the World Intellectual Property Organization's International Bureau.

Lowenstein Sandler is ready to work with clients as the USPTO's changes are implemented. Please contact one of the listed authors if you have questions with respect to the USPTO changes or would like assistance with your trademark or other intellectual property matters either in the U.S. or globally. Lowenstein's trademark team registers and protects brands for its clients in nearly 200 countries worldwide.

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Please contact the listed attorneys for further information on the matters discussed herein.

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