

United States Trademark Updates



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New USPTO Fee Proposal

On May 8, 2023, the USPTO Announced its intent to set or adjust trademark related fees, along with proposed fees, to the public. More information is available [here](#).

USPTO Objectives

- Promote efficient operations
- Better align fees with costs of services provided
- Reduce application pendency
- Finance ongoing and planned strategic initiatives to promote access to trademark system

Anticipated Timeline

- June 2023: TPAC hearing
- January–March 2024: Publish notice of proposed rulemaking
- March–June 2024: Public comment period
- October 2024: Publish final rule
- November 2024: Anticipated effective date of fee changes

New USPTO Fee Proposal

Application Filing Fees

Creation of a “basic application” fee for complete applications that use pre-approved ID, among other things; and

Creation of a “premium application” fee surcharge for applications that are or include:

- Incomplete applications
- Custom descriptions of goods / services
- Excessively long, free-form or custom identifications of goods/services (in excess of 1000 characters per class)

Intent-to-use Filings

Increases for:

- Amendments to allege use
- Statements of use
- Extensions for filing a statement of use

Letters of Protest

Increase for all letters of protest, changes the filing fee from \$50 to \$200.

New USPTO Fee Proposal

Maintenance Filings

Increases for:

- Renewals
- Declarations of Use
- Declarations of Incontestability

Petitions to the Director

Increase for all Petitions to the Director

Petitions to Revive an Application

Increase for all Petitions to revive an application

New USPTO Fee Proposal

Fee category	Description	Current fee	Proposed fee
Application filings	Basic application, per class	\$250	\$350
	Basic application (§66(a)), per class	n/a	\$350
	Basic application (filing a subsequent designation under §66(a)), per class	n/a	\$350
	Fee for insufficient information (§66(a)), per class	n/a	\$100
	Fee for goods and services identifications not contained in Trademark Next Generation ID Manual (using the free-form text box) (§66(a)), per class	n/a	\$200
	For each additional 1,000 characters in excess of 1,000 (§66(a)), per class	n/a	\$200
	Fee for insufficient information, per class	n/a	\$100
	Fee for using goods and services identifications not contained in Trademark Next Generation ID Manual (using the free-form text box), per class	n/a	\$200
Intent to use/use fees	For each additional 1,000 characters in excess of 1,000, per class	n/a	\$200
	Amendment to allege use (AAU), per class	\$100	\$200
	Fourth and subsequent request for six-month extension for filing an SOU, per class	n/a	\$250
Maintenance Fees	Statement of use (SOU), per class	\$100	\$150
	§71 declaration, per class	\$225	\$300
	§15 declaration, per class	\$200	\$250
	§8 declaration, per class	\$225	\$300
	§9 registration renewal application, per class	\$300	\$350
	Renewal fee filed at WIPO	\$300	\$350
Trademark processing fees	Letter of protest	\$50	\$250
	Petition to revive an application	\$150	\$250
	Petition to the Director	\$250	\$400

Office Action Response Times

In December 2022, the United States Patent and Trademark Office (USPTO) shortened the response deadline for some Office actions issued during trademark application examination. Applicants have only three months to respond to some Office actions issued on or after December 3, 2022. An optional, single three-month extension (for a total of six months from the Office action issue date) must be requested before the initial three-month period expires and before any response is filed^[1] and be submitted along with a fee (currently \$125).

[1] “Responses” are broader than just Office action responses and also include requests for reconsideration and notices of appeal. Therefore, any extension, if desired, would also be filed before filing a request for reconsideration or notice of appeal.

Office Action Response Times

Exceptions

- Shortened three-month period does not apply to Office actions issued on or before December 2, 2022. Those deadlines remain unchanged.
- Applications filed under section 66(a), *i.e.* those based on an international registration seeking an extension of protection into the United States, will continue to have a six month response period with no extension of time available.

By shortening the response time, the USPTO intends to decrease the time it takes to obtain a registration while providing additional time to respond when needed. Detailed information on the response process, the rationale behind the change, and links to the final rule can be found on the USPTO's [website](#).

A similar shortening of the response periods will go into effect for post-registration actions on October 7, 2023.

Ex Parte Proceedings

Ex parte proceedings to cancel unused, but registered trademarks

In December 2021, the USPTO implemented “Expungement” and “Reexamination” proceedings to provide an *ex parte* process for challenging any goods or services in a registration

Expungement may be used when the registrant never used the trademark in commerce with the goods or services, and can be used with registrations based on use in commerce, a foreign registration, or the Madrid Protocol. Expungement may be requested between three and ten years after the registration date. Except, however, until December 27, 2023, a expungement may be requested for any registration that has been registered more than three years.

Reexamination may be used when the registrant did not use the mark in commerce before the relevant date either (a) if a use-based application, then the filing date of the application; (b) if an intent-to-use application, then the date that an accepted amendment to allege use was filed or the end date of the statement-of-use period for an accepted statement of use. Reexamination must be requested within the first five years of registration.

Marshall Gerstein Team Attending 2023 INTA Conference



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Thank you

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