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THE PRIVATE BRIEF · AI & IP

Responding to a USPTO Office Action: The Types, the Deadlines, and What a Response Costs

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IN BRIEF

- ◆ An office action is a letter from the USPTO's examining attorney identifying problems with a trademark application. A first office action is never final, and receiving one is a routine part of examination.
 - ◆ Most applications must be answered within three months of the letter's issue date, with one three-month extension available if requested before the deadline, for a fee on the USPTO's schedule. Applications that came in through the Madrid Protocol get six months and no extension. Miss the deadline and the application is abandoned.
 - ◆ The USPTO charges nothing for the response itself, so the cost is legal work, and it depends on the refusal: a procedural correction is a different job from an argument against a likelihood-of-confusion or descriptiveness refusal.
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The email from the U.S. Patent and Trademark Office (the USPTO) arrives on an ordinary Tuesday. An office action has issued on your trademark application. You open the letter, find the word “refused” in the second paragraph, and your stomach drops.

Read it twice before you decide how worried to be. An office action is the official letter an examining attorney (the USPTO lawyer reviewing your application) sends when the application is incomplete, needs amending, or the mark may not qualify for registration. They are a routine, common part of examination. What matters is which kind of letter you have, what it actually objects to, and when the answer is due.

The clock, which is the first thing to find

For most applications, the USPTO must receive your response within three months of the issue date shown on the office action. The letter states its own deadline, and in limited cases it sets a different one, so read the date off the letter rather than counting from memory.

You can buy one extension of three more months, up to six months from the issue date in total. The request has to reach the USPTO on or before the original deadline, and the USPTO’s fee schedule currently charges \$125 for it. The examining attorney has no discretion to give you more time than that.

Applications that reached the USPTO through the Madrid Protocol (the treaty system for extending a trademark filed in another country to the United States) run on a different clock: six months from the issue date, with no extension.

There is no USPTO fee for the response itself. The money that moves is your lawyer’s time, and the extension fee if you need it.

If no response arrives in time, the USPTO declares the application abandoned. A petition to revive it exists where the delay was unintentional, but it has its own short deadline (generally two months from the notice of abandonment) and a \$250 USPTO fee. It is a rescue, not a plan.

The kinds of letter

- ◆ **Nonfinal office action.** The ordinary first letter. It sets out the refusals and requirements the examining attorney sees, and you answer them. A first office action is never a final one.
- ◆ **Final office action.** Issued only after you have had a chance to respond to every issue. From here you can try to resolve what remains, appeal to the Trademark Trial and Appeal Board (the USPTO's own appeals tribunal), or both. Under the USPTO's rules, an appeal has to be filed within the final action's response period, so a final action is not the moment to wait and see.
- ◆ **Priority action.** A letter the examining attorney sends after discussing the problems with you or your lawyer, listing exactly what you need to do. It is still an office action, with a deadline.
- ◆ **Examiner's amendment.** A change the examining attorney makes to your application with your advance permission, usually given by email or phone. This is the good mail: it exists to clear small problems quickly.
- ◆ **Suspension notice.** Not a refusal. Examination is paused while an issue is resolved: for example, while an earlier-filed application for a similar mark either registers or is abandoned.

Procedural issues and substantive refusals

The letter looks the same either way. The work does not.

Procedural issues are corrections. A required disclaimer, which is a statement that you claim no exclusive right to a descriptive word on its own, apart from the mark as a whole. An amendment to the description of your goods or services. A substitute specimen (the real-world example of the mark in use), because the one filed was an advertisement rather than the mark on the product, its label or its packaging. An ownership or entity correction. A translation of non-English wording. The written consent of a person whose name or likeness appears in the mark. These take care and judgment, but not argument.

Substantive refusals are arguments. Two are worth understanding:

1. **Likelihood of confusion, under Section 2(d) of the trademark statute.** The examining attorney has found a registered mark too close to yours for related goods or services. The USPTO's examination manual treats two questions as key in every such case: how similar the marks are, and how related the goods are. A response has to engage both, with evidence.
2. **Merely descriptive, under Section 2(e)(1).** The mark simply describes what you sell. The USPTO's own example is SPEEDY & CHEAP for a photocopying service: the words tell you what the service is, so they are not yet a mark. Sometimes the refusal can be argued head-on. Sometimes the honest answer is a showing of acquired distinctiveness under Section 2(f), which means proving that customers have come to see the words as pointing to one business. The evidence is the work: how long you have used the mark, what you have sold under it, what you have spent advertising it, and statements from the trade or the public. The statute lets the USPTO accept five years of substantially exclusive and continuous use as a starting showing, though it does not have to.

A descriptive term can also sometimes be moved to the Supplemental Register, a secondary register for terms that are not yet marks but may become one. It still lets you use the ® symbol and bring an infringement suit in federal court.

The firm prices responses by the kind of refusal: procedural corrections, a likelihood-of-confusion refusal, and a descriptiveness refusal that needs an acquired-distinctiveness showing each carry their own fee, published on the firm's trademark page. A refusal outside those is reviewed and quoted before work begins, and every response fee is confirmed in writing before any work starts. Responding is always a separate engagement from the application.

Narrowing is not losing.

An illustration

This is a composite, not a client. A candle maker's application is refused under Section 2(d) over a registration for a similar mark on home fragrance products, and the same letter requires a disclaimer of a descriptive word in the mark.

- ◆ USPTO fee to respond: none.
- ◆ The owner needs sales records that sit with an outside bookkeeper and cannot gather them inside three months. An extension request, filed before the original deadline, buys three more months for \$125.
- ◆ Total government cost across the whole episode: \$125.

Had the letter raised only the disclaimer, the work would have been a correction rather than an argument. The letter would have looked identical. The ground would not.

What a good response actually contains

A response is not a letter saying you disagree. On a substantive refusal it is a record, and it has three parts.

The legal frame. What the examining attorney has to find, and which considerations the refusal actually rests on. A response that argues only the easier half (the goods are different) while ignoring the harder one (the marks sound identical) is unlikely to persuade.

The evidence. Registrations and uses by third parties showing that the shared word is common in the field and so carries little weight. Dictionary and trade evidence on how buyers understand the words. Where the goods really are distinct, evidence of different channels and different buyers. On a descriptiveness refusal, the use, sales and advertising history, assembled from your own records, which is why a good lawyer starts asking for them early.

The amendments. Often the practical move is narrowing the description of goods so the conflict falls away, or disclaiming a word you were never going to own anyway. Narrowing is not losing. Registering a smaller thing you can defend usually beats arguing for a larger one you cannot.

Why the first response is the one that counts

Under the USPTO's rules, the record should be complete before an appeal is filed, and evidence should not be filed with the appeals board after the notice of appeal. In practice, that makes the first response the place where the record gets made. Treating it as a formality and the appeal as the real fight has the sequence backwards.

*The letter looks the same
either way. The work does not.*

None of this is a promise about the result. Registration is never guaranteed: the USPTO decides.

Where to start

Today, find the issue date and the response deadline printed on the letter. Put the deadline in your calendar, and a second reminder two weeks before it. Then make a short list of what the letter asks for, sorted into corrections and arguments, and gather anything you already know you will need: specimens, dates of first use, sales and advertising records. That list is the first half hour of any response, whoever writes it.

This is general information about how trademark office actions work, not legal advice about the one on your desk. USPTO fees and rules change, so check the current fee schedule before relying on any figure here.

WRITTEN BY

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Anthony is the Managing Partner of Clemenza Law Group and serves as general counsel to a wide range of companies and philanthropic organizations. Nearly every essay here began as a real question from a real client: the contract that landed at 4 p.m., the board that meets on Thursday. He writes them the way he would answer you across the table, plainly and with care.

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