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DIY TRADEMARKS DIRECT

TRADEMARK WARS

OFFICE ACTION Guide

USPTO Office Actions and Response Strategies Explained



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TRADEMARK WARS MASTER CLASS

OFFICE ACTION EDITION

Program Materials

TIMELINES AND STATUS CHECK:

- Must act within six (6) months of Office Action Date
- To Check Status of Application Enter Serial Number: <http://tsdr.uspto.gov/>

THE FOLLOWING ARE GROUNDS FOR OFFICE ACTION OR REFUSAL OF REGISTRATION:

(1) The applicant is not the owner of the mark; [TMEP §1201](#));

(“TMEP” is Trademark Manual of Examining Procedure)

(2) The subject matter for which registration is sought does not function as a mark because, for example, the proposed mark:

(a) is used solely as a trade name ([TMPEP §1202.01](#));

(b) is functional, i.e., consists of a utilitarian design feature of the goods or their packaging; [TMPEP §§1202.02\(a\)–1202.02\(a\)\(viii\)](#));

(c) is a nondistinctive configuration of the goods or their packaging ([TMPEP](#) ;

(d) is mere ornamentation ([TMPEP §§1202.03–1202.03\(g\)](#));

(e) is the generic name for the goods or services ([TMPEP §§1209.01\(c\)–1209.01\(c\)\(iii\)](#)); or

(f) is the title of a single creative work or the name of an author or performing artist ([TMPEP §§1202.08–1202.08\(f\)](#), [1202.09–1202.09\(b\)](#));

(3) The proposed mark comprises immoral or scandalous matter ([TMPEP §1203.01](#));

(4) The proposed mark is deceptive ([TMPEP §§1203.02–1203.02\(g\)](#));

(5) The proposed mark comprises matter that may disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute ([TMPEP §§1203.03–1203.03\(c\)\(iii\)](#));

(6) The proposed mark comprises the flag, coat of arms, or other insignia of the United States or any State, municipality, or foreign nation ([TMPEP §§1204–1204.05](#));

(7) The applicant's use of the mark is or would be unlawful because it is prohibited by statute ([TMPEP §§1205–1205.02](#));

(8) The proposed mark comprises a name, portrait, or signature identifying a particular living individual without the individual's written consent, or the name,

portrait, or signature of a deceased president of the United States during his widow's life, without written consent of the widow ([TMEP §§1206–1206.05](#));

(9) Likelihood of Confusion: The proposed mark so resembles a previously registered mark as to be likely, when used with the applicant's goods and/or services, to cause confusion or mistake, or to deceive [TMEP §§1207–1207.04\(g\)\(i\)](#);

Response Options Include

- File Arguments Against Likelihood of Confusion, or
- Get written consent to registration from owner of cited mark(s), or
- Challenge cited mark

(10) The proposed mark is merely descriptive or deceptively misdescriptive of the applicant's goods and/or services ([TMEP §§1209–1209.04](#));

(11) The proposed mark is primarily geographically descriptive of the applicant's goods and/or services ([TMEP §1210.01\(a\)](#));

(12) The proposed mark is primarily geographically deceptively misdescriptive of the applicant's goods and/or services ([TMEP §1210.01\(b\)](#));

(13) The proposed mark is primarily merely a surname ([TMEP §§1211–1211.02\(b\)\(vii\)](#)); or

(14) The proposed mark merely identifies a character in a creative work ([TMEP §1202.10](#)).

RESPONSE FORMS

Online form to file response to Office Action: <https://teas.uspto.gov/office/roa/>

Trademark Electronic Application System

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1957 (Rev. 10/2011)
OMB No. 6551-0050 (Exp. 09/20/2020)

Response To Office Action

TEAS - Version 7.1

GENERAL FORM INFORMATION:

- **TIMEOUT WARNING:** After 25 minutes of inactivity, you will be prompted to continue your session. If you do not continue within 5 minutes, the session will end, you will be logged out of your USPTO.gov account, and you will lose any unsaved data in the form. Please have all of your information ready before you start.
- **DO NOT USE YOUR BROWSER BACK/FORWARD BUTTONS.** Use only the navigation buttons at the bottom of each page.
- **TIPS ON USING THIS FORM MOST EFFECTIVELY:** Click on any underlined (hyperlinked) terms for additional information.
- **REQUIRED FIELDS:** All have an **ASTERISK (*)**, and the form will not validate if these fields are not filled-out.

TO ACCESS THE RESPONSE FORM:

STEP 1: CHECK STATUS.

To use this form, the "Current Status" of your application must be "A Non-final Action has been mailed." Use the [Trademark Status & Document Retrieval \(TSDBR\)](#) to confirm the status before proceeding. If the application is not in the correct status, you must wait until the status is updated (usually 48-72 hours after receiving an email notice that an Office action has issued). Otherwise, you will receive an error message when you click the "Continue" button at the bottom of the page.

STEP 2: ENTER APPLICATION SERIAL NUMBER BELOW OR ACCESS PREVIOUSLY FILLED-OUT/SAVED FORM.

* Serial Number: *(Do not enter serial number if you are accessing your saved form.)*

OR

To upload a previously saved form file, first review the [TEAS Help instructions for accessing previously saved data](#) and then use the "Browse..." button below to access the form file saved on your computer. **WARNING:** Failure to follow the TEAS Help instructions will result in the inability to edit your data.

Do **NOT** upload or attach any other file(s) (for example, a specimen or foreign registration certificate) using the button below. You must upload other attachments within the proper section of the actual form, after answering "Yes" to the appropriate wizard question(s) on the next page.

Choose File | No file chosen