

CLIENT ALERT

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USPTO PANDEMIC RESPONSE

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Like many public and private enterprises, the USPTO has had to make changes in light of the COVID-19 pandemic. It is likely that, in future pandemics, the USPTO would take similar steps.

KEY TAKEAWAYS

- The CARES Act has granted the USPTO Director the ability to extend deadlines.
- Thirty-day extensions will be granted in certain proceedings where a due date was between, and inclusive of, March 27, 2020, through April 30, 2020, **and a statement is filed indicating that the delay in filing or payment was due to the COVID-19 outbreak.**
- The USPTO is waiving petition fees for the revival of abandoned applications, or terminated or limited reexamination prosecution on the basis of unintentional delay for where **a statement is filed indicating that the delay in filing the reply required to the outstanding Office communication was because the practitioner, applicant, or at least one inventor, was personally affected by the Coronavirus outbreak such that they were unable to file a timely reply.**
- USPTO offices are closed to the public, but the USPTO continues to operate.
- USPTO events are subject to cancellation, postponement, or changed to video or teleconference only.

CARES ACT GRANTS USPTO DIRECTOR ABILITY TO EXTEND DEADLINES

Congress has passed the Coronavirus Aid, Relief, and Economic Security ("CARES") Act, which grants the Director of the USPTO discretion to "toll, waive, adjust, or modify" any timing deadline established under 35 U.S.C. (patent law), the Trademark Act, and any timing regulations established based on those laws for the duration of the coronavirus pandemic.

Sec. 12004.

- a. In General—During the emergency period described in subsection (e), the Director may toll, waive, adjust, or modify, any timing deadline established by title 35, United States Code, the Trademark Act, section 18 of the Leahy-Smith America Invents Act (35 U.S.C. 321 note), or regulations promulgated thereunder, in effect during such period, if the Director determines that the emergency related to such period—
 1. materially affects the functioning of the Patent and Trademark Office;
 2. prejudices the rights of applicants, registrants, patent owners, or others appearing before the Office; or
 3. prevents applicants, registrants, patent owners, or others appearing before the Office from filing a document or fee with the Office.

As discussed below, the Director has acted to grant extensions under this authority.

30-DAY EXTENSIONS TO BE GRANTED FOR DELAY DUE TO COVID-19 IN CERTAIN PROCEEDINGS

The due date for any of the following patent proceedings **that was due between, and inclusive of, March 27, 2020, through April 30, 2020, will be extended 30 days from the initial date it was due, provided that the filing is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak.** The notice XXXXXX

- i. reply to an Office notice issued during pre-examination processing (for example, a Notice of Omitted Items, Notice to File Corrected Application Papers, Notice of Incomplete Application, Notice to Comply with Nucleotide Sequence Requirements, Notice to File Missing Parts of Application, and Notification of Missing Requirements) **by a small or micro entity;**
- ii. reply to an Office notice or action issued during examination (for example, **an Office Action** (Either Final or Non-Final) and Notice of Non-Compliant Amendment) or patent publication processing (for example, a Notice to File Corrected Application Papers issued by the Office of Data Management);
- iii. **issue fee;**
- iv. notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 41.31;
- v. appeal brief under 37 C.F.R. § 41.37;
- vi. reply brief under 37 C.F.R. § 41.41;
- vii. appeal forwarding fee under 37 C.F.R. § 41.45;
- viii. request for an oral hearing before the Patent Trial and Appeal Board (PTAB) under 37 C.F.R. § 41.47;
- ix. response to a substitute examiner's answer under 37 C.F.R. § 41.50(a)(2);
- x. amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection under 37 C.F.R. § 41.50(b);
- xi. **maintenance fee,** filed by **a small or micro entity;** or
- xii. request for rehearing of a PTAB decision under 37 C.F.R. § 41.52.

A delay is "due to the COVID-19 outbreak" if a practitioner, applicant, patent owner, petitioner, third party requester, inventor, or other person associated with the filing or fee was personally affected by the COVID-19 outbreak, including, without limitation, through **office closures, cash flow interruptions, inaccessibility of files or other materials, travel delays, personal or family illness,** or similar circumstances, such that the outbreak **materially interfered with timely filing or payment.**

Further, relief is offered before the PTAB. Upon **a request to the USPTO affirming that a filing due between, and inclusive of, March 27, 2020, through April 30, 2020, was or may be delayed due to the COVID-19 outbreak as defined above,** a 30-day extension of time will be provided for the following:

- i. a request for rehearing of a PTAB decision under 37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d);
- ii. a petition to the Chief Judge under 37 C.F.R. § 41.3; or
- iii. a patent owner preliminary response in a trial proceeding under 37 C.F.R. §§ 42.107 or 42.207, or any related responsive filings.
 - In the event that the USPTO extends a deadline for a patent owner's preliminary response, or any related responsive filings under subsection (2)(a)(iii), the PTAB may also extend the deadlines provided in 35 U.S.C. §§ ~14(b) and 324(c).

For all other situations before the PTAB, a request for an extension of time where the COVID-19 outbreak has prevented or interfered with a filing before the PTAB can be made by contacting the PTAB.

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For further details relating to patent proceedings, click [here](#).

Similarly, the due date for any of the following trademark proceedings **that was due between, and inclusive of**, March 27, 2020, through April 30, 2020, will be extended 30 days from the initial date it was due, **provided that the filing is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak**.

- iv. **response to an Office action**, including a notice of appeal from a final refusal, under 15 U.S.C. § 1062(b) and 37 C.F.R. §§ 2.62(a) and 2.141(a);
- v. statement of use or request for extension of time to file a statement of use under 15 U.S.C. § 1051(d) and 37 C.F.R. §§ 2.88(a) and 2.89(a);
- vi. notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and § 2.102(a);
- vii. priority filing basis under 15 U.S.C. § 1126(d)(l) and 37 C.F.R. § 2.34(a)(4)(i);
- viii. priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. § 7.27(c);
- ix. transformation of an extension of protection to the United States into a U.S. application under 15 U.S.C. § 1141j(c) and 37 C.F.R. § 7.31(a);
- x. affidavit of use or excusable nonuse under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
- xi. renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or
- xii. affidavit of use or excusable nonuse under 15 U.S.C. § 1141k(a) and 37 C.F.R. § 7.36(b).

For Trademark Trials and Appeals Board (TTAB) proceedings not covered by the above and where the COVID-19 outbreak has prevented or interfered with a filing before the TTAB, a request (in ex parte appeals) or motion (for trial cases) for an extension or reopening of time, as appropriate, can be made.

For further details relating to trademark proceedings, click [here](#).

Again, as a reminder, in all cases **a statement must be filed stating that the delay in filing or payment was due to the COVID-19 outbreak and the due date must be between, and inclusive of, March 27, 2020, through April 30, 2020** in order to receive the extension.

USPTO WAIVING PETITION FEES FOR REVIVAL OF ABANDONED APPLICATION, OR TERMINATED OR LIMITED REEXAMINATION PROSECUTION

Included are fees for petitions to revive patent applications with a petition under 37 CFR 1.137(a) (revival of abandoned application, or terminated or limited reexamination prosecution on the basis of unintentional delay). In order to qualify for the fee waiver, the petition under 37 CFR 1.137(a) must include a statement "that the delay in filing the reply required to the outstanding Office communication was because the practitioner, applicant, or at least one inventor, was personally affected by the Coronavirus outbreak such that they were unable to file a timely reply." The USPTO recommends including a copy of [this notice](#) with the petition.

Further included are fees for petitions to revive the abandoned trademark applications or reinstate the canceled/expired registration due to an inability to timely respond to a trademark-related Office communication as a result of the effects of the Coronavirus outbreak.

Waivers and extensions of dates or requirements set by statute are not being granted, and the dates and requirements set by statute remain unchanged.

For further details, follow [this link](#).

ORIGINAL HANDWRITTEN SIGNATURE REQUIREMENT WAIVED

The following correspondence must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent:

1. Correspondence requiring a person's signature and relating to registration to practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings; and
2. Payments by credit cards where the payment is not being made via the Office's electronic filing systems.

37 CFR 1.4(e)(1) and (2) are the only places where original handwritten, ink signatures are required, and will likely impact a limited number of practitioners.

Interviews, oral hearings, and in-person meetings are now to be conducted remotely by video or telephone.

USPTO OFFICES ARE CLOSED TO THE PUBLIC AS OF MARCH 16, 2020.

USPTO offices remain open to "employees, contractors, and those with access badges." USPTO operations are expected to continue without interruption until further notice.

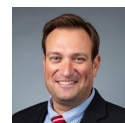
USPTO EVENTS

A number of USPTO events have been cancelled, postponed, or changed to video or teleconference only. For further information see: <https://www.uspto.gov/about-us/events>.

Sources and further information:

- <https://www.congress.gov/bill/116th-congress/house-bill/748/text>
- <https://www.uspto.gov/sites/default/files/documents/Patents%20CARES%20Act.pdf>
- <https://www.uspto.gov/sites/default/files/documents/TM-Notice-CARES-Act.pdf>
- <https://www.uspto.gov/coronavirus>
- https://www.uspto.gov/sites/default/files/documents/coronavirus_relief_ognotice_03162020.pdf
- <https://www.uspto.gov/about-us/events>

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