

CORONAVIRUS

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USPTO Offers New Relief for Coronavirus-Caused Delays in Responding to Certain USPTO Communications

On Monday, March 16, 2020, the United States Patent and Trademark Office (“USPTO”) [announced](#) that it will consider the coronavirus pandemic to constitute an “extraordinary situation” within the meaning of the relevant patent and trademark regulations governing relief from certain delayed responses. Accordingly, patent and trademark applicants and registrants who were unable to reply in a timely manner to an Office Action or similar USPTO communication due to the rapidly evolving coronavirus pandemic may, if the delay resulted in abandonment or similar limitation on their intellectual property, obtain relief from the limitations and even request a fee waiver.

PATENTS

In the event of a patent application held abandoned, or a re-examination limited or terminated, due to the failure to reply to a USPTO communication, the USPTO will waive the petition fee when the patent applicant or patent owner files the reply with a petition under 37 CFR 1.137(a) along with a copy of the USPTO notice. The petition must be filed no later than two months of the issue date of the notice of abandonment or re-examination termination. If no notice was received, the petition must be filed not later than six months after the date the application became abandoned or

re-examination prosecution was terminated. Petitions may be submitted via EFS-Web using document code PET.RELIEF or by mail: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

TRADEMARKS

The USPTO will also waive the petition fee for trademark applications and registrations that were abandoned or deemed canceled/expired due to a coronavirus-related failure/delay in responding to an Office Action. To revive an abandoned application, the Trademark Electronic Application System (“TEAS”) “Petition to Revive Abandoned Application” form should be used. For canceled/expired registrations, the TEAS “Petition to the Director” form should be used. Petitions must include a statement explaining how the failure to respond was a result of the coronavirus outbreak. If a notice was received, the petition must be filed no later than two months of the issue date of the notice of abandonment or cancellation. If no notice was received, the petition must be filed within six months of the date upon which the application is shown to be abandoned or the registration deemed canceled/expired.

STATUTORY PERIODS NOT CHANGED BY ANNOUNCEMENT

It is important to note that the relief provided by the March 16 announcement does not extend statutory filing periods, but instead applies only to qualifying delays or failures in responding to USPTO Office Actions or like communications. Thus, by way of example, if the coronavirus outbreak prevented a trademark registrant from responding to an Office Action rejecting a timely filed trademark renewal filing, the new relief could apply. By contrast, the statutory period within which to file a non-provisional patent following a provisional patent application, or the statutory periods set forth for timely filing a renewal for a trademark registration or for timely filing a Statement of Use in a pending trademark application (*e.g.*, within 36 months after a trademark Notice of Allowance), remain unchanged.

Blank Rome's [Coronavirus \("COVID-19"\) Task Force](#) is continuing to monitor the COVID-19 crisis and will provide further updates for patent and trademark applicants and registrants as they become available.

For more information, please contact:

David M. Perry
215.569.5767 | perry@blankrome.com

Dipu A. Doshi
202.420.2604 | ddoshi@blankrome.com

Lisa Casey Spaniel
215.569.5337 | casey@blankrome.com

Russell T. Wong
713.632.8634 | rwong@blankrome.com