

CORONAVIRUS

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U.S. Patent and Trademark Office Extends or Waives Certain Requirements in Response to COVID-19

On March 31, 2020, the United States Patent and Trademark Office (“USPTO”) announced that it was using the authority provided to it under the Coronavirus Aid, Relief, and Economic Security Act (the “CARES Act”) to extend certain statutory deadlines that would otherwise have been due from March 27, 2020 to April 30, 2020 (inclusive). The USPTO issued separate notices for [patents](#) and [trademarks](#). These notices are in addition to the USPTO’s previous guidance that it considers the effects of the coronavirus (“COVID-19”) to be an “extraordinary situation.” That notice is discussed in our earlier [alert](#), and summarized below.

To date, the following is a summary of the deadline or requirements that are extended, waived or adapted:

EXTENSION OF PATENT AND TRADEMARK DUE DATES:

The due date for any of the below listed actions that was due from March 27, 2020 to April 30, 2020 (inclusive), 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.”

Each of the patent and trademark notices define “due to the COVID-19 outbreak” when a practitioner, applicant, registrant, 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.”

PATENT DUE DATES:

- reply to an Office notice issued during pre-examination processing by a small or micro entity;
- reply to an Office notice or action issued during examination or patent publication processing;
- issue fee;
- notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. §41.31;
- appeal brief under 37 C.F.R. § 41.37;
- reply brief under 37 C.F.R. § 41.41;
- appeal forwarding fee under 37 C.F.R. § 41.45;
- request for an oral hearing before the Patent Trial and Appeal Board (“PTAB”) under 37 C.F.R. § 41.47;

- response to a substitute examiner’s answer under 37 C.F.R. § 41.50(a)(2);
- 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);
- maintenance fee, filed by a small or micro entity;
- request for rehearing of a PTAB decision under 37 C.F.R. § 41.52;
- a request for rehearing of a PTAB decision under 37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d);
- a petition to the Chief Judge under 37 C.F.R. § 41.3;
- a patent owner preliminary response in a trial proceeding under 37 C.F.R. §§ 42.107 or 42.207, or any related responsive filings; or
- other situations not covered above that are before the PTAB, which may be requested.

TRADEMARK DUE DATES:

- 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);
- 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);
- 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);
- priority filing basis under 15 U.S.C. § 1126(d)(I) and 37 C.F.R. § 2.34(a)(4)(i);
- priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. § 7.27(c);
- 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);
- affidavit of use or excusable nonuse under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
- renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or 1x. affidavit of use or excusable nonuse under 15 U.S.C. § 1141k(a) and 37 C.F.R. § 7.36(b); or
- other situations not covered above that are before the Trademark Trial and Appeal Board (“TTAB”), which may be requested.

FEES RELATED TO PETITIONS TO REVIVE:

In addition, as discussed in our prior [alert](#), if a patent/trademark applicant or owner was unable to timely reply to a USPTO communication due to the effects of coronavirus and the failure to reply resulted in the application/registration being held abandoned/canceled/expired, or the re-examination prosecution terminated or limited, the USPTO is waiving the petition fee¹ provided that the applicant/owner: (1) files the outstanding reply with the petition; (2) includes 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, or in the case of trademark applications/registrations, how “the failure to respond to the Office communication was due to the effects of the coronavirus outbreak;” and (3) the petition is filed not later than two months, and in some cases six months, of the issues date of the respective notice of abandonment, termination, or limitation. In addition, for patent-related correspondence, the inclusion of the March 16, 2020 notice with the reply will be treated as a representation that the delay in filing the reply was due to the effects of the coronavirus outbreak and as a request for waiver of the petition fee.

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.

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1. 37 C.F.R. §1.17(m).