

The U.S. Patent and Trademark Office Response to COVID-19

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On March 27, President Donald Trump signed into law the Coronavirus Aid, Relief, and Economic Security (CARES) Act. The CARES Act temporarily expands the authority of the Director of the United States Patent and Trademark Office (USPTO) to adjust statutory deadlines during the COVID-19 crisis. In particular, Section 12004 of the legislation provides “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 Invests Act (35 U.S.C. 321 note), or regulations promulgated thereunder.” In exercising that authority, the Director must determine that the COVID-19 crisis “materially affects the functioning of the Patent and Trademark Office,” “prejudices the rights of applicants, registrants, patent owners, or others appearing before the Office,” or “prevents applicants, registrants, patent owners, or others appearing before the Office from filing a document or fee with the Office.”

Prior to passage of the CARES Act, the USPTO was limited in its legal authority to extend deadlines set by statute. However, the USPTO had deemed the effects of COVID-19 an “extraordinary situation” under 37 C.F.R. § 1.183, which authorizes the Director to suspend or waive regulations that are not statutory requirements. In its limited authority, the USPTO implemented the following initial relief measures to assist applicants and owners who have been affected by COVID-19:

- For patent applications, the USPTO will waive petition fees associated with reviving patent applications that are abandoned or for which a reexamination was terminated or limited for failure to timely respond

to a USPTO communication due to the coronavirus, with a statement that the practitioner, applicant, or at least one inventor was personally affected by the COVID-19 outbreak.

- For trademark applications and registrations, the USPTO will waive petition fees associated with reviving applications abandoned and trademark registrations canceled/expired due to inability to timely respond to a USPTO communication due to the coronavirus, with a statement that the failure to respond was due to the effects of the COVID-19 outbreak.
- The USPTO is waiving the requirements of 37 C.F.R. § 1.4(e)(1) and (2) for an original handwritten signature for correspondence relating to registration to practice before the USPTO and for payments not being made via the USPTO’s electronic filing systems.
- All examiner and examining attorney interviews, Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB) oral hearings, and other in-person meetings scheduled to take place at USPTO offices are to be conducted remotely by video or telephone.

On March 31, exercising its temporary authority under the CARES Act, the USPTO announced an expansion of these initial relief measures. More specifically, the USPTO has provided notice of extensions to deadlines set by statute for filing certain patent/trademark-related documents and paying certain fees.

For patent application and reexamination proceedings, the expanded relief measures include extensions to deadlines set by statute for the following:

- Reply to a notice issued during pre-examination processing by a small or micro entity (e.g., 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, or Notification of Missing Requirements)
- Reply to a notice or action issued during examination or patent publication processing (e.g., a final or non-final Office Action, a Notice of Non-Compliant Amendment, or a Notice to File Corrected Application Papers)
- Payment of an issue fee
- Filing of a notice of appeal, appeal brief or reply brief
- Payment of an appeal forwarding fee
- Request for an oral hearing before the PTAB
- Reply to a substitute examiner's answer
- Amendment when reopening prosecution in response to or request for rehearing of a PTAB decision designated as including a new ground of rejection
- Payment of a maintenance fee, filed by a small or micro entity
- Request for a rehearing of a PTAB decision

Additional extensions to deadlines are also available to parties before the PTAB as it relates to a request for rehearing of a PTAB decision, a petition to the Chief Judge, and a patent owner's preliminary response in a trial proceeding or any related responsive filings.

For trademark filings and registrations, the expanded relief measures include extensions to deadlines set by statute for the following:

- Response to an Office Action, including a notice of appeal from a final refusal
- Statement of Use or request for extension of time to file a Statement of Use
- Notice of opposition or request for extension of time to file a notice of opposition
- Priority filing basis for a request for extension of protection to the United States or for an application in the United States filed within six months from the date on which the application was first filed in the foreign country
- Transformation of an extension of protection to the United States into a U.S. application
- Affidavit of use or excusable nonuse
- Renewal application

The due date for any of the foregoing enumerated actions that was due between

and inclusive of March 27 and April 30 has been extended 30 days from the initial date it was due. However, to qualify for the deadline extension, the filing must be accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak.

This statement must specify that 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.

For situations at the PTAB or TTAB not covered above, parties can still make a request or motion for an extension or reopening of time, as appropriate, under the usual procedures.

The USPTO offices remain open for employees, and operations continue without interruption.

In jurisdictions outside the U.S., many intellectual property offices have already enacted various measures for suspension and extension of deadlines for patent and trademark matters. New measures are announced daily, and we are closely monitoring these changes in order to guide organizations and individuals alike in preserving their intellectual property rights in the U.S. and abroad.

We are available to assist with any questions regarding the impact of COVID-19 on patent and trademark matters.

To see our prior alerts and other material related to the pandemic, please visit the Coronavirus/ COVID-19: Facts, Insights & Resources page of our website by clicking [here](#).

Contacts

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