

USPTO Deadline Extensions Give Flexibility During Crisis

By Ryan Davis

Law360 (April 1, 2020, 7:40 PM EDT) -- The U.S. Patent and Trademark Office's decision to extend some deadlines during the COVID-19 pandemic is welcome news for applicants and attorneys facing disruptions due to the crisis, though it's unclear how often they will be put to use.

Tuesday's announcement that many deadlines related to patents and trademarks will be extended came soon after the \$2 trillion coronavirus relief law enacted Friday gave the office the authority to change deadlines that are otherwise set by statute.

The announcement is relatively narrow in scope, extending various deadlines that fall between March 27 and April 30 by 30 days. But for patent applicants whose business has been upended by the pandemic, the flexibility in the office's announcement will "provide some much-needed relief," said Tracy-Gene Durkin of Sterne Kessler Goldstein & Fox PLLC.

"This is a pretty dire circumstance, and the office did this quite quickly and with all the good intentions," she said. "So I think applicants should feel comfortable that this really is what it appears to be."

While those seeking extensions must provide a statement that the missed deadline was caused by the pandemic, the office outlined some broad parameters for what that means. It covers situations where the filer or attorney or their family is "personally affected" by the outbreak, such that it "materially interfered" with their ability to meet the deadline. This includes illnesses, delays in the ability to meet deadlines caused by office closures, cash-flow interruptions, inaccessibility of files and other circumstances.

The office appears to be willing to take the filer's word that the crisis impeded their ability to meet a deadline, Durkin said: "This isn't a gotcha game. They're planning on relying on whatever statement is provided."

For attorneys, the announcement provides reassurance that firms will not be at risk if a client is unavailable to answer a question or pay a fee associated with a patent or trademark filing, said Monica Riva Talley of Sterne Kessler.

"Hopefully, that does give a little bit of cushion and comfort when we can't find our clients to get instructions because they're out of the office or their business has been shut down for a while," she said.

The extensions cover most deadlines that come up in prosecution, as well as some situations during Patent Trial and Appeal Board proceedings, including requests for rehearing and a patent owner's preliminary response to a petition challenging a patent. The office said that extensions may be available for other types of PTAB filings, but litigants must contact the board to ask.

"There's a whole raft of other filing deadlines and I expect that for those, you will have to email the PTAB," said Kory Christensen of Polsinelli PC. That will include whether it's possible to get an extension on the one-year deadline that targets of complaints have to challenge a patent at the board after being served, he noted.

Whether a party takes advantage of the extensions will depend on their business objectives, said Stuart Meyer of Fenwick & West LLP. For some companies, a delay in obtaining a patent or trademark could disrupt their plans, while for others, relief from a deadline may be a godsend, and "I'm pretty confident there are going to be lots of people in both camps," he said.

Some companies may feel that even during a crisis, they need to get a patent as soon as they can to use against competitors, and "they're going to want to stick to some accelerated schedule if they possibly can. That makes tremendous sense," Meyer said.

Other businesses may be facing a cash crunch due to the shutdown of their business, and being able to delay paying USPTO fees for a month may be a big help.

"I think you'll find lots of people who say 'thanks but no thanks' to the extensions, but there will also be lots of people who say 'thank goodness' and take advantage of them," Meyer said.

As the office gained the authority to extend deadlines when the relief bill was enacted on Friday, missed deadlines before that date are not covered by the new extensions. In those cases, applicants may need to take advantage of the USPTO's announcement last month that it will waive the fee to revive applications abandoned due to the crisis.

Many large law firms that represent companies have technology in place to be able to meet the original statutory deadlines without many issues, but situations may arise where it's necessary to take advantage of the extensions, Christensen said.

"I could imagine a situation where we need the client to give us instructions in a particular way or we need an inventor to sign something, which could potentially be a problem given the circumstances," he said. "So I can see potentially using that relief."

One question left unanswered by the USPTO's deadline extension announcement is whether there will be further deadline extensions beyond April 30. Attorneys said they could see the office going either way.

"My guess is that the PTO is probably going to extend this, because I think most of us recognize now that it's going to take a lot longer than 30 days" for things to get back to normal, Christensen said.

However, Meyer said he could see the office taking the position that the deadline extension will provide help while everyone is adjusting to working remotely, and that further extensions will no longer be necessary once everyone is used to it by the end of April.

"Is the idea that this may well be followed up by more comprehensive extensions, or is the office going to say we had a chance to think about this already and this is how far we're going to go?" he said.

The USPTO did not immediately respond to a request for comment Wednesday about whether further deadline extensions may be forthcoming.

--Editing by Brian Baresch and Philip Shea.