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Client Alert

USPTO Due Date Extension Available Amid COVID-19 Outbreak

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As the COVID-19 outbreak affects the daily lives and businesses of patent and brand owners in the United States, the United States Patent and Trademark Office (USPTO) issued a notice of waiver of certain deadlines.

Patent Extensions

According to the Notice, the patent deadlines for which relief may be obtained are:

- i. Reply to an Office notice issued during pre-examination processing by a small or micro entity;
- ii. Reply to an Office notice or action issued during examination or patent publication processing;
- 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

The due date for taking action or paying the required fee (for example, the issue fee) must be between, and inclusive of, March 27 and April 30, 2020.

To request this waiver, the filing must be accompanied by a statement that: "The delay in filing or payment was due to the COVID-19 outbreak as defined in subsection (1)(b) of the USPTO Notice of Waiver of Patent-Related Timing Deadlines under the Coronavirus Aid, Relief, and Economic Security Act." A delay can be due to the COVID-19 outbreak for the purposes of the Notice "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." Subsection (1)(b) of the USPTO Notice.

In addition, the USPTO has previously waived the fee for petitions to revive applications under 37 C.F.R. §1.137 when applicants were not able to timely reply to an office communication due to the COVID-19 outbreak.

If you as a patent owner are having difficulties in meeting any deadlines listed above, you should carefully consider whether to request a waiver of the deadlines and whether the situation would qualify the conditions listed in subsection (1)(b) of the USPTO Notice. If you or those involved in patent prosecution do not meet any of the conditions and/or 30 days are not sufficient, you can consider other available options. For example, if a patent application is at the statutory deadline and 30 days are not sufficient to remove the deadline, the applicant can abandon the application and file a continuation application without paying any fees. This option can provide about four to six months or longer before responding to the next deadline.

Trademark Extensions

Similarly, trademark due dates falling between March 27, 2020 and April 30, 2020, will be extended 30 days from the “initial date it was due” for the following types of filings, provided they are accompanied by a statement that “The delay in filing or payment was due to the COVID-19 outbreak as defined in subsection (1)(b) of the USPTO Notice of Waiver of Patent-Related Timing Deadlines under the Coronavirus Aid, Relief, and Economic Security Act”:

- i. Response to an Office Action, including a notice of appeal from a final refusal, under 15 U.S.C. §1602(b) and 37 C.F.R. §§2.62(a) and 2.141(a);
- ii. Statement of Use or Request for an 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);
- iii. Notice of Opposition or Request for Extension of Time to File a Notice of Opposition under 15 U.S.C. §1603(a) and 37 C.F.R. §§2.101(c) and 2.102(a);
- iv. Priority filing basis under 15 U.S.C. §1126(d)(1) and 37 C.F.R. §2.34(a)(4)(i);
- v. Priority filing basis under 15 U.S.C. §1141g and 37 C.F.R. §7.27(c);
- vi. Transformation of an extension of protection to the United States into U.S. application under 15 U.S.C. §1141j(c) and 37 C.F.R. §7.31 (a);
- vii. Affidavit of use or excusable nonuse under 15 U.S.C. §1058(a) and 37 C.F.R. §2.160(a);
- viii. Renewal application under 15 U.S.C. §1059 (a) and 37 C.F.R. §2.182; or
- ix. Affidavit of use or excusable nonuse under 15 U.S.C. §1141k(a) and 37 C.F.R. §7.36(b).

In addition, for any deadlines that may have been missed resulting in an abandonment notice, applicants can petition to revive the application on the grounds that the deadline was missed pursuant to impact from the COVID-19 outbreak. TTAB filings that were prevented or delayed by the COVID-19 outbreak can similarly be extended or reopened.

The electronic trademark forms have been updated to allow for these extensions.

If you are having difficulties in meeting any deadlines listed above due to the COVID-19 outbreak, this additional flexibility may help you maintain valuable patent and trademark rights during this period of interruption and uncertainty.

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