

Practice Update

# Patent and Trademark Office Provides Limited Extensions For Applicants Affected By COVID-19

April 1, 2020

Yesterday, March 31, 2020, the USPTO issued a Notice of Waiver of Patent-Related Timing Deadlines under the CARES Act ([found here](#)). The Waiver concerns a limited set of deadlines for patent-related documents or fees that are otherwise due on or after March 27, 2020. In general, the notice extends certain deadlines such as responding to USPTO office actions, pay various fees, and file or schedule various appellate matters. Although the CARES Act conferred near blanket authority to extend nearly all deadlines for the entire duration of the COVID-19 emergency, the current notice is more limited:

- First, it does not extend deadlines which could affect the viability of a patent such as claiming priority to a prior application.
- Second, it does not extend deadlines to file petitions for the USPTO to review granted patents (though it does indicate that such extensions may be requested on a case-by-case basis).
- Third, the notice does not provide any relief for deadlines before March 27 but after the COVID-19 emergency was declared on March 13. Finally, the extensions provided are not automatic: An applicant must include a statement as to how they have been affected by the COVID-19 emergency.

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The CARES Act conveyed to the Director of the U.S. Patent and Trademark Office the authority to toll, waive, adjust, or modify most deadlines during the duration of the COVID-19 emergency upon the Director's determination that the COVID-19 outbreak:

1. materially affects the USPTO's functioning;
2. prejudices the rights of applicants, registrants, patent owners, or others appearing before the USPTO; or
3. prevents applicants, registrants, patent owners, or others appearing before the USPTO from filing a document or fee with the USPTO.

Yesterday's notice acknowledged that the COVID-19 national emergency has prejudiced the rights of applicants, patent owners, or others appearing before the USPTO in patent matters, and has prevented applicants, patent owners, or others appearing before the USPTO in patent matters from filing a document or fee with the USPTO. Such prejudice has arisen, for example, from a disruption of the operations of numerous businesses, law firms, and inventors. The Director also recognized that small businesses and independent inventors, who typically have less access to capital, may face difficulties in meeting patent-related deadlines.

Accordingly, the notice identified twelve (12) different patent-related and reexamination proceedings for which an applicant, a patent owner, or another appearing before the USPTO may receive a 30-day filing extension. The 12 patent-related and reexamination proceedings include:

1. a Reply to Pre-Examination Processing Notice (available only to a small or micro entity);
2. a Reply to an Office Notice or Office Action issued during examination (e.g., a Notice of Omitted Items, Notice to File Corrected Applications Papers, Notice of Incomplete Application, Notice to Comply with Nucleotide Sequence Requirements, Notice to File

Missing Parts of Application, and Notification of Missing Requirements) or patent publication processing (e.g., a Notice to File Corrected Application Papers);

3. the Issue Fee;
4. a Notice of Appeal (35 U.S.C. § 134 and 37 C.F.R. § 41.31);
5. the Appeal Brief (37 C.F.R. § 41.37);
6. the Reply Brief (37 C.F.R. § 41.41);
7. the Appeal Forwarding Fee (37 C.F.R. § 41.45);
8. a Request for an Oral Hearing before the Patent Trial and Appeal Board (PTAB) (37 C.F.R. § 41.47);
9. a Response to a Substitute Examiner's Answer (37 C.F.R. § 41.50(a)(2));
10. an Amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection (37 C.F.R. § 41.50(b));
11. a Maintenance Fee (available only to a small or micro entity); and
12. a Request for Rehearing of a PTAB decision (37 C.F.R. § 41.52).

The extension only applies to those initial deadlines occurring on or between March 27, 2020 and April 30, 2020. The notice excluded initial deadlines occurring prior to March 27, 2020 (i.e., the day President Trump signed into law the CARES Act). To obtain the 30-day filing extension, the applicant, the patent owner, or the other appearing before the USPTO must provide a statement that the delay in filing the paper or paying the fee was due to the COVID-19 outbreak.

Specifically, the statement must confirm that the COVID-19 outbreak personally affected the practitioner, applicant, patent owner, petitioner, third party requester, inventor, or other person associated with the filing or fee. The notice explained

that office closures, cash flow interruptions, inaccessibility of files or other materials, travel delays, personal or family illness, or similar circumstances, can all personally affect one or more relevant parties. Applicants will be well-advised to provide documentation of such interruptions or inaccessibility at the time of requesting such a request to ensure the request is granted and avoid later claims that the request was made in bad faith.

The notice also addressed relief before the PTAB. The PTAB can provide a 30-day extension for (1) a Request for Rehearing of a PTAB decision (37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d)); (2) a Petition to the Chief Judge (37 C.F.R. § 41.3); or (3) a patent owner's Preliminary Response in a trial proceeding (37 C.F.R. §§ 42.107 or 42.207) or any related responsive filings. If the PTAB extends the deadline for a patent owner's Preliminary Response or any related responsive filings under subsection (2)(a)(iii), then the PTAB may also extend the deadlines provided in 35 U.S.C. §§ 314(b) and 324(c).

Again, the initial filing deadline for these PTAB proceedings must occur on or between March 27, 2020 and April 30, 2020. And, to obtain the 30-day filing extension, the Request must include a statement that the COVID-19 outbreak personally affected the practitioner, applicant, patent owner, or other appearing before the PTAB.

For all other non-enumerated filings (including interferences and AIA challenges), the notice advised that the practitioner, applicant, patent owner, or other appearing before the PTAB may request an extension of time due to the COVID-19 outbreak's prevention or interference with a filing. The notice provided a phone number for the PTAB and a distinct email address for AIA trials, PTAB appeals, and interferences.

The notice referred to the USPTO's previous waiver of the fee under 37 C.F.R. § 1.17(m) for a Petition to Revive an Application under 37 C.F.R. § 1.137, when

the applicant was unable to timely reply to an Office Communication due to the COVID-19 outbreak. For additional guidance regarding this fee waiver, please see the Office's Notice dated 16 March 2020 provided here.

Finally, the notice reinforced that because the USPTO is open for the filing of documents and fees, the deadline waiver is only available when the COVID-19 outbreak causes the delay. The USPTO will continue to evaluate the evolving situation around the COVID-19 outbreak and the impact on the USPTO's operations and stakeholders.

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This information is intended to inform firm clients and friends about legal developments, including recent decisions of various courts and administrative bodies. Nothing in this Practice Update should be construed as legal advice or a legal opinion, and readers should not act upon the information contained in this Practice Update without seeking the advice of legal counsel. Prior results do not guarantee a similar outcome.