



## Intellectual Property ADVISORY ■

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### USPTO Announces Additional Limited Extensions Due to the COVID-19 Pandemic

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On March 31, 2020, the director of the U.S. Patent and Trademark Office (USPTO) issued a [notice](#) of waiver of some [patent-related](#) and [trademark-related](#) deadlines in accordance with [Section 12004\(a\)](#) of the [Coronavirus Aid, Relief, and Economic Security \(CARES\) Act](#). This notice follows prior USPTO notices waiving certain revival petition fees resulting from the coronavirus (COVID-19) pandemic and ending face-to-face meetings between USPTO examiners and applicants. The director has now determined that the COVID-19 pandemic has prejudiced the rights of those appearing before the USPTO in patent and trademark matters. The director noted that the spread of the COVID-19 virus has disrupted the operations of businesses and law firms, particularly small businesses and independent inventors, and that a person that is unable to meet patent-related or trademark-related deadlines due to the COVID-19 pandemic may be eligible for a waiver of certain deadlines.

#### Extensions and Requirements

To receive relief for any eligible action, the delayed filing or payment must be accompanied by a statement that the delay was due to the COVID-19 pandemic. A delay may be due to the COVID-19 pandemic if a person associated with the filing or fee was personally affected by COVID-19 (due to office closures, cash-flow interruptions, inaccessibility of files or other materials, travel delays, personal or family illness, etc.) such that the pandemic *materially interfered with timely filing or payment*. Affected persons may be practitioners, patent applicants, trademark applicants, patent owners, trademark registrants and owners, or other person associated with the filing or payment.

Applicants are advised to rely on an extension due to the COVID-19 pandemic only if there is some unforeseen hardship or interference due to the pandemic, not merely to take advantage of an extension on the person's own initiative during the pandemic. COVID-19 extensions may be appropriate when there are unforeseen issues created due to working remotely, such as a critical IT failure or extended loss of network connectivity.

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Similarly, a COVID-19 extension may also be appropriate when necessary employees have taken leave or are on furlough. On the patent side, if inventors are not accessible due to the COVID-19 pandemic, an applicant could rely on an extension under this policy. On the trademark side, if the applicant is a retail establishment and its employees are unable to access product inventory due to a stay-at-home order, making them unable to obtain a specimen of use by the statement of use or maintenance deadline, the applicant could take advantage of this policy to obtain additional time beyond the deadline to prove use.

Financial or business factors could also form the basis for a COVID-19 statement, such as cash-flow interruptions, reduced revenue, emergency policy changes aimed at decreasing and delaying discretionary spending, and office or business closures. Notably, submitted statements will likely receive 37 C.F.R. § 1.56 scrutiny should any patent associated with a COVID-19 statement be litigated. It is also possible, if not likely, that discovery during patent litigation may be expanded into areas that were previously off-limits for patent disputes, such as financial records and other documents that might indicate an applicant's financial position and business practices at the time a COVID-19 statement was made.

Applicants should also note that the notice does not provide relief for a potential decrease of patent term adjustment (PTA). If an extension is taken due to the COVID-19 pandemic, an applicant should expect that any portion of the 30 days added to the due date may result in a corresponding decrease, or loss, of PTA. While this may not be a substantial consideration for some clients, other clients may prefer to avoid the potential decrease of PTA rather than take advantage of an extension due to the COVID-19 pandemic.

The USPTO has determined that *any action listed below that was due between March 27, 2020, and April 30, 2020, may be extended 30 days* from the action's initial due date. This waiver applies to the due date for any of the following patent-related and trademark-related actions and payments:

### ***Patents***

- Reply to an office notice or action during examination (e.g., non-final office action, final office action, or notice of noncompliance amendment) or patent publication processing (e.g., notice to file corrected application papers).
- Issue fee.
- Notice of appeal, appeal brief, reply brief, and appeal forwarding fee.
- Request for an oral hearing before the Patent Trial and Appeal Board (PTAB); response 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; and request for rehearing of a PTAB decision.

### ***In addition, for small and micro entity patent applicants only***

- Reply to an office notice during pre-examination processing (e.g., notice to file correct 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).

- Maintenance fee payment.

### **Trademarks**

- 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.
- Transformation of an extension of protection to the United States into a U.S. application.
- Renewal application.
- Affidavit of use or excusable nonuse.

The notice further defines additional relief for actions before the PTAB due between March 27, 2020 and April 30, 2020 that were delayed due to the COVID-19 pandemic. In particular, a request for rehearing of a PTAB decision, a petition to the chief judge, or a patent owner preliminary response in a trial proceeding, or any related responsive filings, may receive a 30-day extension of time from the PTAB when accompanied by a statement that the COVID-19 pandemic materially interfered with timely filing. And for all other situations where the COVID-19 pandemic has prevented or interfered with a filing before the Trademark Trial and Appeal Board (TTAB), a request (in ex parte appeals) or motion (for trial cases) for an extension or reopening of time, as appropriate, can be made.

*Applicants should note that the present USPTO notice only relates to deadlines associated with actions or fees explicitly referenced in the notice.* The timing and payment relief outlined in the notice does not extend to any other filings, including original patent or trademark application filing deadlines. Any deadline related to a nonprovisional application conversion filing deadline, Patent Cooperation Treaty (PCT) application filing, national stage application filing, Paris Convention application filing, Hague Treaty application filing, Madrid Protocol application filing, or other such filing deadline is not afforded a waiver by this notice. Similarly, any deadline related to an inter partes review (IRP) petition, post-grant review (PGR) petition, or other petition related to initiating post-grant review proceedings is not afforded a waiver by the notice.

The USPTO emphasized that it remains open for the filing of patent and trademark documents and fees and will continue to evaluate the impact of COVID-19 on the USPTO's operations. Alston & Bird will continue to monitor USPTO operations and communications to keep our clients and friends informed of any further developments.

Alston & Bird has formed a multidisciplinary [task force](#) to advise clients on the business and legal implications of the coronavirus (COVID-19). You can [view all our work](#) on the coronavirus across industries and [subscribe](#) to our future webinars and advisories.

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