



ALERTS

USPTO Revises Deadlines For Some Patent And Trademark Matters Delayed By COVID-19 Challenges

May 11, 2020

Highlights

The deadline for timely filing a response in some matters has been extended to June 1, 2020, if the delay in filing is due to COVID-19 outbreak

The revised extension of time could provide significant additional time to respond in some matters

Original deadlines between March 27, 2020, and May 31, 2020, may be eligible to be extended

The CARES Act authorized the U.S. Patent and Trademark Office (USPTO) to [temporarily modify statutory deadlines](#) and it has done so. The USPTO has revised the deadline for responding to some Patent and Trademark matters to June 1, 2020, if the filing delay was due to COVID-19 related circumstances. The party requesting the extension must include a statement that:

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

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materials, travel delays, personal or family illness, or similar circumstances, such that the outbreak materially interfered with timely filing or payment.

The USPTO now provides a form for submitting this statement.

This [revised COVID-19 extension](#) is similar to the prior extension, but imposes a new fixed deadline of June 1, 2020, to complete filings instead of a prior sliding 30-day extension window. In some cases, this revised fixed deadline could add significantly more time to the earliest original filing deadlines.

For example, an original filing deadline of March 31, 2020, was previously extended 30 days to April 30, 2020. This same deadline has now been extended to June 1, 2020 – providing an additional 32 days to timely complete the filing. In another case, an original deadline of April 29, 2020, was extended to May 29, and now is extended to June 1, 2020 – in this case providing only three additional days to timely complete the filing.

The USPTO will also continue to waive certain fees if there is a need to petition to reinstate or revive a registration or application for which a deadline passed during this time period. The Trademark Trial and Appeal Board (TTAB) also has authority, upon request, to extend deadlines if COVID-19 prevented or interfered with a filing.

The USPTO continues to remain open for all activities except for live in-person meetings such as examiner interviews and TTAB proceedings. Anecdotal observations suggest that the USPTO examiners are using the current period of remote work to help promote some applications to allowance.

Patent Matters Extended to June 1, 2020

The following patent events that had deadlines between March 27, 2020, and May 31, 2020, will be timely filed if filed on or before June 1, 2020, along with the necessary COVID-19 statement:

- Reply to an Office notice issued during pre-examination processing by a small or micro entity
- Reply to Office notice or action issued during examination or patent publication processing
- Issue fee
- Notice of appeal
- Appeal brief, reply brief, or appeal forwarding fee
- Request for oral hearing before the Patent Trial and Appeal Board
- Response to 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
- Maintenance fee, filed by a small or micro entity

- Request for rehearing of a PTAB decision under 37 CFR §41.52, 37 CFR §41.125(c), or 37 CFR §41.127(d)
- Petition to the Chief Judge

Upon submitting a statement that a filing that was or is due between March 27, 2020, and April 30, 2020, was delayed due to the COVID-19 outbreak, the PTAB will also provide a 30-day extension of time for:

- Preliminary response in a trial proceeding by patent owner under 37 CFR §§ 42.107 or 42.207 or any related responsive filings.

For other PTAB matters where COVID-19 has delayed a filing, a request for an extension of time can be made.

Trademark Matters Extended to June 1, 2020

The following trademark events that had deadlines between March 27, 2020, and May 31, 2020, will be considered timely filed if filed on or before June 1, 2020, along with the necessary COVID-19 statement:

- to an Office action, including notice of appeal
- Statement of use or extension of time to file statements of use
- Notice of opposition or request for extension of time to file a notice of opposition
- Priority filing basis for applications under Section 44(d) or Section 67
- Transformation of an extension of protection to the U.S. into a U.S. application under Section 70(c)
- Section 8 declarations
- Section 9 renewals
- Affidavit of use or excusable nonuse under Section 71(a)

Where COVID-19 has interfered with other TTAB filings, a party can make a request or motion for an extension or reopening, as appropriate. The existing procedures to revive an abandoned application or reinstate a canceled or expired registration remain in place, with the fees previously waived by the USPTO.

For more information, contact the Barnes & Thornburg attorney with whom you work or Grant Peters at 312-214-8332 or grant.peters@btlaw.com.

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