

USPTO Issues Notice Waiving Certain Patent and Trademark Deadlines Due to COVID-19

By: Frank Bruno, Randy Friedberg, Ilaria Maggioni and Katherine Todd

Intellectual Property Alert

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On March 31, 2020, the United States Patent and Trademark Office (USPTO) issued Official Notices in the wake of the COVID-19 crisis, granting 30-day extensions for certain specifically enumerated trademark and patent deadlines falling between **March 27, 2020 and April 30, 2020**, the period of "national emergency" as defined by the Coronavirus Aid, Relief, and Economic Security Act (CARES Act). The categories of actions entitled to the extension are summarized below. Full lists of the specific actions are available in the full texts of the Trademark Notice, Patent Notice and original USPTO Coronavirus Relief Notice.

Summary of Relief Conditions

For both patents and trademarks, the respective notices offer relief to those impacted by the COVID-19 crisis due to office closures, cash flow interruptions, lack of accessibility to files or related materials, travel delays, personal or family illness, or other similar circumstances. However, it is not a blanket extension. The extension is automatic and it is not necessary to file an extension request if these conditions are met:

1. the person seeking relief must be personally affected by the above events and the outbreak must have materially interfered with the timely filing or payment; and
2. must certify that the person met both conditions in a statement that will be submitted at the time of filing the extended submission or fee payment within the 30-day extension period.

There are different provisions for certain actions pending before the Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB), for which it is necessary to file a written extension request or motion to obtain the relief.

All other actions not specifically mentioned may obtain relief by filing a Petition under the terms of the previous USPTO Notice of March 16, 2020 for deadlines that had already expired due to COVID-19 hardship. USPTO filing fees are waived.

Trademark Notice

Written request is not required to take advantage of the extension. Based on our discussions with the USPTO, affected applicants and owners are automatically permitted to file the following submissions and fees up to 30 days from the original deadline, **provided** they are accompanied by a mandatory statement that the delay was a direct result of being personally affected by COVID-19 (as set forth in the above summary):

- Office Action responses, including notices of appeal from a final refusal;
- Statements of use or requests for extension of time to file a statement of use;
- Affidavits of use or excusable nonuse; and
- Priority filings basis under 15 U.S.C. §§ 1126(d)(l) and 1141g, and 37 C.F.R. §§ 2.34(a)(4)(i) and 7.27(c).

TTAB Deadlines

Extensions of 30 days are also available for those affected by the COVID-19 outbreak with respect to certain other deadlines pending before the TTAB, but they are not automatic. The following deadlines may be extended only upon written request or motion:

- Notices of opposition, or requests for extension of time to file a notice of opposition.
- A TTAB party may file a request or a motion seeking an extension for any situation not addressed by the Notice.

Patent Notice

Written request is not required to take advantage of the extension. The deadlines for the following submissions in application and reexamination proceedings are extended by 30 days from their original deadline, **provided** that at time of filing they are accompanied by a mandatory statement that the delay was a direct result of being personally affected by COVID-19 (as set forth in the above summary):

- Office notices or actions issued during pre-examination processing;
- Office notices or actions issued during examination or patent publication processing;
- Notices of appeal;
- Appeal and reply briefs;
- Requests for a rehearing of a PTAB decision; and
- Payment of issues fees, maintenance fees, appeal forward fees.

PTAB Deadlines

Extensions of 30 days are available for the following deadlines pending before the PTAB, but they are not automatic. The following deadlines may be extended only upon written request or motion:

- Petitions to the Chief Judge;
- Responsive filings in trial proceedings; and
- A PTAB party may file a request or a motion seeking an extension for any situation not addressed by the Notice.

Other Deadlines

For other trademark and patent deadlines that had already expired before March 27, 2020, applicants and owners can still benefit from the relief procedures provided by the USPTO Notice issued March 16, 2020, which remains in force and effect. It requires filing of a Petition, but the fee is waived.

We expect additional updates from the USPTO later this month as the COVID-19 crisis evolves and will continue monitoring further developments.

If you have any questions or would like additional information, please contact: for trademark inquiries, Ilaria Maggioni (maggionii@whiteandwilliams.com; 212.868.4838) and Randy Friedberg (friedbergr@whiteandwilliams.com; 212.714.3079); or for patent inquiries, Frank Bruno (brunof@whiteandwilliams.com; 215.864.6225).

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White and
Williams LLP

As we continue to monitor the novel coronavirus (COVID-19), White and Williams lawyers are working collaboratively to stay current on developments and counsel clients through the various legal and business issues that may arise across a variety of sectors. Read all of the updates here.

This correspondence should not be construed as legal advice or legal opinion on any specific facts or circumstances. The contents are intended for general informational purposes only and you are urged to consult a lawyer concerning your own situation and legal questions.

