



# THINK FORWARD

## Developments at the USPTO – COVID-19

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The worldwide spread of COVID-19 has brought about challenges for different government agencies operating around the globe, and the United States Patent and Trademark Office (“USPTO”) is no exception.

On March 31, the USPTO, pursuant to its authority under the Coronavirus Aid, Relief, and Economic Security Act (“CARES Act”), announced that extensions would be available for certain deadlines that are typically non-extendable. The extensions are not automatic. When requesting an extension, the filing or payment must be accompanied by a statement that the delay is “due to the COVID-19 outbreak” and that a person associated with the filing or payment was “personally affected by the COVID-19 outbreak.” The USPTO defines “due to the COVID-19 outbreak” as the practitioner, applicant, patent owner, petitioner, third party requester, inventor, registrant, or other person associated with the filing or fee being “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.” Whether an extension request was proper will be measured against this standard, and it remains possible that a request could be denied or challenged later in litigation for failure to meet this standard.

Extensions are available for 30 days from the initial filing due date, and apply to deadlines on or after March 27, 2020 through and including April 30, 2020.

The extensions apply only to certain due dates, as detailed below:

### Patent Application and Reexamination

- Reply to an Office notice issued during pre-examination of an application by a small or micro-entity;
- Reply to an Office notice or action issued during examination or patent publication processing;
- Issue Fee;
- Notice of Appeal;
- Appeal Brief;
- Reply Brief;
- Appeal Forwarding Fee;
- Request for an Oral Hearing Before the 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;
- Maintenance Fee, filed by a small or micro entity; or
- Request for Rehearing of a PTAB decision.

### **Patent Trial and Appeal Board (“PTAB”) Proceedings**

- Request for Rehearing of a PTAB decision;
- Petition to the Chief Judge; or
- Patent Owner Preliminary Response in a Trial Proceeding.

In addition, the USPTO recommends contacting the PTAB for other situations, not covered above, where COVID-19 has prevented or interfered with a filing before the Board.

### **Trademark Prosecution**

- 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;
- Priority filing date based on a foreign application (Section 44(d) application);
- Priority filing date based on an international registration (Section 66(a) application);
- Transformation of an extension of protection to the United States into a U.S. application;
- Section 8 affidavit of use or excusable nonuse;
- Renewal application; and
- Section 71 affidavit of use or excusable nonuse.

### **Trademark Trial and Appeal Board (“TTAB”) Proceedings**

- Notice of Opposition or Request for Extension of Time to file a Notice of Opposition.

In addition, the USPTO recommends that a request or motion for an extension be made for other situations where COVID-19 has prevented or interfered with a filing before the TTAB.

### **Implications and Guidance**

A CARES Act extension should be available if your business qualifies under the USPTO’s definition of a delay “due to the COVID-19 outbreak.” The following are important points to keep in mind when considering whether to request an extension under the CARES Act:

- Extensions under these rules are not automatic. The USPTO may deny a CARES Act extension request, which could result in an abandonment of rights if the filing period expires during the USPTO’s consideration of the request.
- An adverse party may challenge the validity of the CARES Act extension in litigation on the ground that the extension was wrongfully requested.

### **Contact Us**

If you have questions or concerns about your upcoming deadlines, please do not hesitate to [contact us](#) to discuss whether your business may qualify for an extension.