

Insights: Alerts

# CARES Act | U.S. Patent and Trademark Office Extends Certain Deadlines to June 1

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*Please note: The below information may require updating, including additional clarification, as the COVID-19 pandemic continues to develop. Please monitor our main [COVID-19 Task Force page](#) and/or your email for updates.*

Section 12004 of the CARES Act allows the director of the United States Patent & Trademark Office (USPTO) (under certain conditions) to provide temporary relief from certain USPTO filing deadlines and fees. See [CARES Act | U.S. Patent and Trademark Office - Additional Extensions Available](#)

The USPTO previously determined that the CARES Act conditions were met, and published new Notices<sup>1</sup> of eligibility for 30-day extensions yesterday, April 28, 2020, further extending the time to file certain patent and trademark-related documents and to pay certain required fees, which otherwise would have been due between (or on) March 27 and May 31, to **June 1, 2020**. These notices supersede the March 31, 2020 notices entitled “Notice of Waiver of Patent-Related Timing Deadlines under the Coronavirus Aid, Relief, and Economic Security Act” and “Notice of Waiver of Trademark-Related Timing Deadlines under the Coronavirus Aid, Relief, and Economic Security Act,” as well as the March 16, 2020 notice entitled “Relief Available to the Patent and Trademark Applicants, Patentees and Trademark Owners Affected by the Coronavirus Outbreak.” The USPTO [stated](#) they will continue evaluating the evolving situation around the COVID-19 pandemic as well as the impact on the USPTO’s operations and stakeholders.

As described [here](#), any delayed filing (whether patent or trademark) must be accompanied by a statement that the delay in filing or payment was due to the COVID-19 pandemic. The many deadlines that can be extended are listed in the Notices, but primarily relate to certain responses to USPTO requirements, responses, and payments. No extensions are available for any of the statutory deadlines (claiming priority, and the like) excluded from the USPTO’s waiver of fees for certain petitions for extensions of time.

The USPTO will consider filing or payment delays, for the purposes of the CARES Act, for any a practitioner, applicant patent owner, petitioner, third party requester, inventor or other person associated with the filing or fee who was *personally* affected by the COVID-19 pandemic, including, without limitation, through office closures, cash flow interruption, 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.

Under Section II in both Notices, the USPTO considers the effects of the COVID-19 outbreak to be an “extraordinary situation” within the meaning of 37 CFR 2.146 for affected patent and trademark applicants as well as patent owners and trademark registrants. The USPTO provides relief to patent applicants and owners by waiving the petition fee to revive abandoned applications and reexamination proceedings that were terminated or limited due to the effects of the COVID-19 outbreak. The USPTO also provides relief to trademark applicants and registrants to reinstate canceled/expired registrations due to the effects of the COVID-19 outbreak by waiving the petition fee. However, this relief is limited to eligible applications, registrations and proceedings effected by the COVID-19 outbreak **on or before May 31, 2020**. Additional details are provided in the April 28, 2020, patent and trademark Notices.

### **Patent-specific Provisions**

Patent-related deadlines that can be extended include Pre-exam Notice (*limited to small+micro entities*); response to *any* office action (including post-allowance Notices); Issue Fee payment; Notice of Appeal; Appeal Brief; Request for Oral Hearing in front of the Patent Trial and Appeal Board (PTAB); response to substitute examiner's answer; amendment when reopening prosecution in response to; or request for a rehearing of a PTAB decision (including new ground of rejection); maintenance fees (*limited to small+micro entities*); and Request for Rehearing of PTAB decision (under 37 CFR 41.52).

Additional PTAB situations that can be extended include: Request for Rehearing of PTAB decision (under 37 CFR 41.125(c), 41.127(c), or 42.71(d)); petition to the Chief Judge under 37 CFR 41.3; or patent owner preliminary response in a trial proceeding under 37 CFR 42.107 or 42.207 or any related responsive filings. Should USPTO extend a deadline for patent owner preliminary response/related responsive filings, PTAB may also extend the deadlines provided in 35 USC 314(b) and 324(c).

For PTAB situations not listed above, a request for an extension of time, where the COVID-19 pandemic has prevented or interfered with a filing before the PTAB, can be made by contacting the PTAB at 571-272-9797 or by email at [Trials@uspto.gov](mailto:Trials@uspto.gov) (for AIA trials), [PTAB\\_Appeals\\_Suggestions@uspto.gov](mailto:PTAB_Appeals_Suggestions@uspto.gov) (for PTAB appeals) or [InterferenceTrialSection@uspto.gov](mailto:InterferenceTrialSection@uspto.gov) (for interferences). For Trademark Trial and Appeal Board (TTAB) situations not listed above, a request (in *ex parte* appeals) or motion (for trial cases) for an extension or reopening of time, as appropriate, can be made.

For patent applicants and patent owners who were unable to timely submit a filing or payment in reply to an Office communication having a due date of May 31, 2020, or earlier, such that the application became abandoned or the reexamination prosecution became terminated or limited, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant or patent owner files the reply with a petition under 37 CFR 1.137(a) and a statement that the delay in filing or payment was due to the COVID-19 pandemic. The inclusion of the statement that the delay in filing or payment was due to the COVID-19 outbreak will be treated as a request for *sua sponte* waiver of the petition fee under 37 CFR 1.17(m).

In situations where any patent applicant/owner seeks to file a petition to revive under 37 CFR 1.137(a) with a request to waive the petition fee under 37 CFR 1.17(m) due to the effects of the COVID-19 outbreak, the patent applicant/owner must promptly file the petition under 37 CFR 1.137(a) (together with the required statement and required reply. The petition fee under 37 CFR 1.17(m) should not be included. A petition to revive under 37 CFR 1.137(a) due to the effects of the COVID-19 outbreak may be submitted via the USPTO patent electronic filing systems (EFS-Web or Patent Center) using the document code PET.RELIEF or by mail direction to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

### **Trademark-specific Provisions**

For trademark applicants and trademark owners who were unable to timely submit a filing or payment in reply to an Office communication having a due date of May 31, 2020, or earlier, such that the application became abandoned or the registration became abandoned or the registration was canceled/expired, the USPTO will waive the petition fee (set by regulation rather than statute) to revive the abandoned application or reinstated the canceled /expired registration.

For abandoned applications, the applicants should use the Trademark Electronic Application System (TEAS) “Petition to Revive Abandoned Application” form. For canceled/expired registrations, trademark owners should use the TEAS “Petition to the Director” form. In all situations, the petition must include a statement that the delay in filing or payment was due to the COVID-19 pandemic. The inclusion of the statement will be treated as a request for a waiver of the petition fee under 37 CFR 2.6(a)(15). The petition must be filed not later than two months after the issue date of the notice of abandonment or cancellation. If the application or registrant did not receive a notice of abandonment or cancellation, the petition must be filed not later than six months after the date the trademark electronic records system indicates that the application is abandoned or the registration is canceled/expired.

For either patent or trademark extensions and fee-waivers, given the lack of guidance as to what statements would be accepted, any determination that the statement is insufficient would necessarily mean that the particular deadline passed without any permitted extension. Further, even if accepted, any statement that was not based on preserved evidence could, at least in theory, be attacked at a later date.

### **Footnotes**

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<sup>1</sup>The patent-related Notice is available [here](#). The trademark Notice is available [here](#).

## Related People

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