

Publication

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Update: USPTO Patent Deadline Extensions Under the CARES Act

Throughout March and April 2020, the United States Patent and Trademark Office ("USPTO") responded to the COVID-19 outbreak by offering relief to stakeholders. The widest ranging of these relief efforts was issued under the CARES Act and relates to how certain patent and trademark deadlines would be handled by the USPTO.

Included in this CARES Act relief effort is the April 28, 2020 notice that certain patent, patent application, and Patent Trial and Appeal Board ("PTAB") related deadlines due from March 27, 2020 to May 31, 2020 will be considered timely if they are filed on or before June 1, 2020 with the filing of a qualifying COVID-19 statement. This relief supersedes the relief offered to stakeholders in previously issued notices, such as the 30-day extension of time for certain patent, patent application, and PTAB related deadlines due from March 27, 2020 through April 30, 2020.

A summary of the permitted patent-related deadline extensions provided by the USPTO is detailed below.

Which deadlines falling from March 27, 2020 to May 31, 2020 are considered timely filed on or before June 1, 2020 by filing a qualifying COVID-19 statement?

For all applicants, payment and filing of the following fees/replies to the following actions are considered

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timely filed on or before June 1, 2020 by filing a qualifying COVID-19 statement:

- Replies to office notices, non-final office actions, final office actions, and notices of non-compliant amendments during examination or patent publication processing;
- Issue fees;
- Appeal-related filings, including:
 - notices of appeal,
 - appeal briefs,
 - reply briefs,
 - appeal forwarding fees,
 - requests for an oral hearing before the PTAB,
 - responses to a substitute examiner's answer,
 - amendments in connection with a new ground of rejection by the PTAB, and
 - requests for rehearing of a PTAB appeal decision);
- Various PTAB filings (including requests for rehearing of a PTAB decision in an AIA trial or interference proceeding, and petitions to the Chief Judge)

For applicants qualifying as Micro or Small Entities, payment and filing of the following fees/replies to the following actions are considered timely filed on or before June 1, 2020 by filing a qualifying COVID-19 statement:

- Maintenance fees;
- Replies to office notices during pre-examination processing, including:
 - replies to notices of omitted items,

- replies to notices to file corrected application papers,
- replies to notices of incomplete application,
- replies to notices to comply with nucleotide sequences requirements,
- replies to notices to file missing parts of application (including, without limitation, the payment of the filing fees), and
- replies to notifications of missing requirements).

A qualifying COVID-19 statement pertains to the delay in filing or payment being due to the COVID-19 outbreak by 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. A USPTO form to be used to make such a statement can be found [here](#).

Which deadlines falling from March 27, 2020 to May 31, 2020 are not extendable?

- The deadline to file a non-provisional patent application claiming the benefit of a previously-filed foreign patent application;
- The deadline to file a non-provisional application that obtains the benefit of a provisional application's priority date;
- Any co-pendency requirements between the parent application and a later-filed child application;
- A patent owner's preliminary response in a PTAB trial proceeding, or any related responsive filings due after April 30, 2020 which did not otherwise qualify for the existing 30-day extension of time for filings due from March 27, 2020 through April 30, 2020.



The USPTO continues to evaluate the changing circumstances surrounding COVID-19.

If you have any questions regarding USPTO deadline extensions or other intellectual property issues, please contact Holby Abern, Adam Masia and Kenneth Matuszewski or your Neal Gerber Eisenberg attorney.

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