



WRIGHT LINDSEY JENNINGS

COVID-19 CLIENT ALERT: U.S. PATENT AND TRADEMARK OFFICE EXTENDS CERTAIN FILING DEADLINES UNDER CARES ACT FOR THOSE AFFECTED BY COVID-19

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The Coronavirus Aid, Relief, and Economic Security (CARES) Act was signed into law on March 27, 2020. The CARES Act provides widespread relief to businesses and individuals as the Coronavirus crisis continues to see travel restrictions, shelter-in-place orders, and business closures across the United States and world. In addition to providing [\\$100 billion in emergency funds](#) to eligible healthcare providers, [expanding unemployment benefits](#) for displaced workers, and allocating \$349 billion for loans to eligible businesses under the [Paycheck Protection Program](#), the CARES Act also provides temporary relief to businesses and entrepreneurs currently working to protect their intellectual property.

Section 12004 of the CARES Act, entitled Temporary Authority of Director of the USPTO During the COVID-19 Emergency, provides that the Director may toll, waive, adjust, or modify any applicable trademark or patent timing deadline in light of the Coronavirus crisis's prejudice to applicants, registrations, patent owners, or others appearing before the USPTO. Pursuant to this authority, and in light of the President's declaration of a national emergency, on March 31, 2020, the USPTO announced an extension of certain patent and trademark-related timing deadlines.

Delay Must be Due to COVID-19 Outbreak

Despite the COVID-19 outbreak, the USPTO is still open for filing of trademark and patent documents and fees. In this regard, the USPTO is clear that in order to receive the extensions outlined below, the delayed-filing must be accompanied by a statement that the delay in filing was due to the COVID-19 outbreak. The USPTO provides that a delay in filing is due to the outbreak if the applicant, registrant, or their attorney "was 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."

Relief for Meeting Certain Trademark Deadlines

The USPTO announcement provides that the due date for any of the following that was due between, and inclusive of, March 27, 2020 and April 30, 2020, will be extended 30 days from the initial date it was due:

- a response to an Office action (including a notice of appeal from a final refusal);
- a statement of use or request for extension of time to file a statement of use;
- a notice of opposition or request for extension of time to file a notice of opposition;
- a priority filing basis under 15 U.S.C. § 1126(d);

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- a priority filing basis under 15 U.S.C. § 1141g;
- a transformation of an extension of protection to the United States into a U.S. application under 15 U.S.C. § 1141j(c);
- an affidavit for use or excusable nonuse under 15 U.S.C. § 1058(a);
- a renewal application; or
- an affidavit of use or excusable nonuse under 15 U.S.C. § 1141k(a)

The USPTO announcement also provides that for those filings before the Trademark Trial and Appeal Board that would have been due on or after March 27, 2020, a request or motion for an extension or reopening of time, as appropriate, can be made.

Relief for Meeting Certain Patent Deadlines

The USPTO announcement provides that the due date for any of the following that was due between, and inclusive of, March 27, 2020 and April 30, 2020, will be extended 30 days from the initial date it was due:

- a reply to an Office notice issued during pre-examination processing by a small or micro entity;
- a reply to an Office notice or action issued during examination or patent publication processing;
- an issue fee;
- a notice of appeal, appeal brief, reply brief, or appeal forwarding fee;
- a request for oral hearing before the Patent Trial and Appeal Board (PTAB)
- a response to a substitute examiner's answer;
- an amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection;
- a maintenance fee, filed by a small or micro entity; or
- request for rehearing of a PTAB decision

Additional relief for the following PTAB related filings is also provided:

- a request for rehearing of a PTAB decision;
- a petition to the Chief Judge; or
- a patent owner preliminary response in a trial proceeding or any related responsive filings

For all other PTAB situations not covered above, a request for extension can be made by contacting the PTAB.

Practical Note: As indicated by the USPTO, in the case of a reply to an Office notice issued during pre-examination processing (such as a Notice of Omitted Items, a Notice to File Corrected Application Papers, etc.) and the case of maintenance fees, the extension will only be provided to those who qualify as small or micro entity.

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As COVID-19 continues to spread, affecting the health of our citizens and businesses, our intellectual property attorneys continue to work diligently to protect the rights of businesses and entrepreneurs. If you've been affected by the COVID-19 outbreak and want to know if you're eligible for an extension at the USPTO, contact K. Brandon Middleton, J. Charles Dougherty, Blake Glasgow, or Meredith Lowry. We hope for your safety and health in this uncertain time.



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