

The USPTO Further Extends Certain Deadlines Pursuant to the CARES Act

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The Coronavirus Aid, Relief, and Economic Security (“CARES”) Act provides that the Director of the United States Patent and Trademark Office (“USPTO”) may extend certain filing deadlines in the wake of the COVID-19 pandemic. The outbreak has closed countless law firms and offices, and left owners of intellectual property and their attorneys without access to files and information vital to completing required filings. In consideration of these hardships, the USPTO has established a number of extended deadlines.

As we previously reported last month, the CARES Act provides the Director of the USPTO with the power to extend such deadlines if the Director determines that the COVID-19 emergency: (1) materially affects the functioning of the USPTO; (2) prejudices the rights of applicants, registrants, patent and trademark owners, or others appearing before the USPTO; or (3) prevents applicants, registrants, patent and trademark owners, or others appearing before the USPTO from filing documents or fees. On March 31, 2020, the USPTO issued notices setting forth that its Director had determined that the COVID-19 emergency did indeed prejudice the rights of applicants, registrants, trademark and patent owners, and others, as “the spread of the virus has significantly disrupted the operations of numerous businesses and law firms.”

The USPTO had originally extended the due date for certain trademark-related matters falling in between (or inclusive of) March 27, 2020 and April 30, 2020 thirty (30) days from the initial deadline if the filer includes a statement that the delay in filing or payment was caused by the applicant, registrant, or practitioner being personally affected by the COVID-19 outbreak, for example, by way of office closures, interruptions of cash flow, inaccessibility of files, travel delays, or personal or family illness, which materially interfered with timely filing or payment. The USPTO has now offered further relief, and certain filings due between and inclusive of March 27, 2020 and May 31, 2020 will be considered timely if filed on or before June 1, 2020 provided that the filing is accompanied by a statement that the delay was caused by the COVID-19 outbreak as previously described.

The impacted filings are:

- responses to office actions (including notices of appeal from a final refusal of registration of a trademark) under 15 U.S.C. § 1062(b) and 37 C.F.R. §§ 2.62(a) and 2.141(a);
- statements of use or requests for an extension of time to file a statement of use for pending intent-to-use applications under 15 U.S.C. § 1051(d) and 37 C.F.R. §§ 2.88(a) and 2.89(a);
- notices of opposition to the registration of a mark or requests for an extension of time to file a notice of opposition to the registration of a mark under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and 2.102(a);

- applications for priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. § 2.34(a)(4)(i) or 15 U.S.C. § 1141g and 37 C.F.R. 7.27(c);
- requests for transformation of extensions of protection to the United States for foreign marks under 15 U.S.C. § 1141j(c) and 37 C.F.R. § 7.31(a);
- affidavits of use or excusable nonuse of a mark under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a) or 15 U.S.C. § 1141k(a) and 37 C.F.R. § 7.36(b); and
- renewal applications for marks under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182.

Additionally, if a trademark owner or applicant is unable to submit a filing or payment in response to a communication from the USPTO which has a due date on or before May 31, 2020, and an application becomes abandoned or a mark is canceled or expires, the USPTO will waive the fee typically required to petition to revive the application or reinstate the mark. Such petition must be filed within two months after the issue date of the notice of abandonment or cancellation and must be accompanied by a statement explaining that the delay was due to the COVID-19 outbreak. If the applicant or owner did not receive a notice of abandonment or cancellation, then the petition must be filed within six months from the date the USPTO records indicate that the application was abandoned or the mark was cancelled.

The USPTO has also extended certain deadlines for patent filings due between and inclusive of March 27, 2020 and May 31, 2020. Such filings will also be considered timely if filed on or before June 1, 2020 and accompanied by a statement that the delay was caused by the COVID-19 outbreak as set forth above. The covered deadlines are as follows:

- replies to office notices issued during pre-examination processing by a small or micro entity;
- replies to office notices or actions issued during the examination of a patent application or patent publication processing;
- issue fees;
- notices of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 41.31, appeal briefs under 37 C.F.R. § 41.37, and reply briefs under 37 C.F.R. § 41.41 for ex parte appeals made by a patent applicant;
- appeal forwarding fees owed by appellants in an application or ex parte reexamination proceeding under 37 C.F.R. § 41.45;
- requests for oral hearings before the Patent Trial and Appeal Board (“PTAB”) under 37 C.F.R. § 41.47;
- responses to substantive examiner’s answers under 37 C.F.R. § 41.50(a)(2);
- amendments when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as a new ground of rejection under 37 C.F.R. § 41.50(b);
- maintenance fees filed by small or micro entities;
- requests for rehearing of an original PTAB decision under 37 C.F.R. § 41.52;
- requests for rehearing of a PTAB decision under 37 C.F.R. §§ 41.125(c) or 41.127(d); or
- a petition to the Chief Judge under 37 C.F.R. § 41.3.

Additionally, for applications or reexamination proceedings that become abandoned on or before May 31, 2020 due to the failure to timely submit a filing or payment as a result of the COVID-19 outbreak, the USPTO will waive the fee when the applicant or owner files a petition to revive an abandoned application or terminated or limited examination proceeding along with a statement explaining how the delay was caused by the coronavirus crisis.

The USPTO website remains functional and capable of accepting filings. It is important to note that the above extensions are available only to those who can demonstrate that delays were directly related to the COVID-19 outbreak.

If you have questions feel free to contact Karen I. Levin at (516) 296-9110 or via email at klevin@cullenllp.com or Ariel E. Ronneburger at (516) 296-9182 or via email at aronneburger@cullenllp.com.

Practices

- Intellectual Property

Attorneys

- Karen I. Levin
- Ariel E. Ronneburger