

USPTO Extends Deadlines for Certain Trademark and Patent Matters Under the CARES Act

April 6, 2020

The Coronavirus Aid, Relief, and Economic Security (“CARES”) Act was passed with the goal of providing relief to individuals and businesses impacted by the COVID-19 outbreak. In order to assist inventors, entrepreneurs, and business owners who may be struggling in the wake of illness or office shutdowns due to coronavirus, the CARES Act permits the United States Patent and Trademark Office (“USPTO”) to toll, waive, adjust, or otherwise modify any deadlines set forth by title 35 United States Code, the Trademark Act, section 18 of the Leahy-Smith America Invents Act, or any applicable regulations during the national emergency declared by the President on March 13, 2020.

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.”

Accordingly, the due date for certain trademark-related matters falling in between (or inclusive of) March 27, 2020 and April 30, 2020 will be extended 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 impacted matters are as follows:

- 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 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182.

For proceedings currently before the Trademark Trial and Appeal Board (“TTAB”), a request for an extension or reopening of time may be made if the parties have been impacted by the COVID-19 crisis. Such requests will be granted by the TTAB at its discretion.

With regard to patents, certain deadlines falling in between (or inclusive of) March 27, 2020 and April 30, 2020 will be extended for thirty (30) days provided that the filing is accompanied by a statement that the delay was caused by the effects of 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; or
- requests for rehearing of an original PTAB decision under 37 C.F.R. § 41.52.

Additionally, if a request is made to the USPTO that a filing due between (or inclusive of) March 27, 2020 and April 30, 2020 was or may be delayed due to the COVID-19 outbreak, the PTAB shall provide a thirty (30) day extension of time for: (i) a request for rehearing of a decision on a motion for judgment in a contested PTAB case, or request for rehearing of a decision on a petition or motion made in a trial before the PTAB (37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d)); (2) a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3; or (3) a patent owner preliminary response in a trial proceeding under 37 C.F.R. §§ 42.107 or 42.207, or any related responsive filing thereto.

For all other situations before the PTAB, requests may be made for extensions by contacting the PTAB with an explanation as to how the COVID-19 crisis has prevented or otherwise impacted a filing. Such requests may be granted at the PTAB’s discretion.

The USPTO has emphasized it remains open for the filing of documents and fees in trademark and patent matters and, according to a Press Release issued on March 31, 2020, all in-person meetings (i.e., hearings and examiner’s interviews) will be conducted either virtually or by phone going forward. Moreover, the extensions of time discussed above are not available to all applicants and registrants—rather, it must be demonstrated that

any delay in filing or payment was specifically related to the COVID-19 outbreak.

It is likely that, as the coronavirus crisis progresses, the USPTO will issue further guidelines under the authority vested by the CARES Act with regard to deadlines for filings and related matters.

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

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