Notice of Waiver of Patent-Related Timing Deadlines under the Coronavirus Aid, Relief, and Economic Security Act

In accordance with section 12004 of the Coronavirus Aid, Relief, and Economic Security Act (CARES Act), the United States Patent and Trademark Office (USPTO or Office) is extending the time to file certain patent-related documents or fees which otherwise would have been due on or after March 27, 2020.

CARES Act

Subsection 12004(a) of the CARES Act provides that the USPTO may toll, waive, adjust, or modify, any timing deadline established by title 35, United States Code, the Trademark Act, section 18 of the Leahy-Smith America Invents Act (35 U.S.C. 321 note), or regulations promulgated thereunder, in effect during the emergency period described in subsection 12004(e) of the CARES Act, if the Director of the USPTO determines that the emergency related to such period: (1) materially affects the functioning of the Patent and Trademark Office; (2) prejudices the rights of applicants, registrants, patent and trademark owners, or others appearing before the Office; or (3) prevents applicants, registrants, patent and trademark owners, or others appearing before the Office from filing a document or fee with the Office.

On March 13, 2020, the President declared a national emergency under the National Emergencies Act as a result of the COVID-19 outbreak. The Director of the USPTO has determined that the emergency has prejudiced the rights of applicants, patent owners, or others appearing before the USPTO in patent matters, and has prevented applicants, patent owners, or others appearing before the USPTO in patent matters from filing a document or fee with the Office. Among other things, the spread of the virus has significantly disrupted the operations of numerous businesses, law firms, and inventors. Small businesses and independent inventors, who frequently have less access to capital and for whom patent-related fees may constitute a more significant expense, may face particular difficulties. Accordingly, a person who is unable to meet patent-related timing deadlines due to the COVID-19 outbreak may be eligible for a waiver of certain deadlines, as further described below.

(1) Relief in patent application and reexamination proceedings

(a) The due date for any:

i. reply to an Office notice issued during pre-examination processing[1] by a small or micro entity;

ii. reply to an Office notice or action issued during examination[2] or patent publication processing;[3]

iii. issue fee;

iv. notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 41.31;

v. appeal brief under 37 C.F.R. § 41.37;

vi. reply brief under 37 C.F.R. § 41.41;

vii. appeal forwarding fee under 37 C.F.R. § 41.45;

viii. request for an oral hearing before the Patent Trial and Appeal Board (PTAB) under 37 C.F.R. § 41.47;

ix. response to a substitute examiner's answer under 37 C.F.R. § 41.50(a)(2);

x. amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection under 37 C.F.R. § 41.50(b);

xi. maintenance fee, filed by a small or micro entity; or

xii. request for rehearing of a PTAB decision under 37 C.F.R. § 41.52

that was due between, and inclusive of, both March 27, 2020 and April 30, 2020, will be extended 30 days from the initial date it was due, provided that the filing is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak as defined in subsection (b), below.

(b) A delay in filing or payment is due to the COVID-19 outbreak for the purposes of this notice if a practitioner, applicant, patent owner, petitioner, third party requester, inventor, or other person associated with the filing or fee 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.

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[1] This includes, for example, a Notice of Omitted Items, Notice to File Corrected Application Papers, Notice of Incomplete Application, Notice to Comply with Nucleotide Sequence Requirements, Notice to File Missing Parts of Application, and Notification of Missing Requirements.

[2] This includes, for example, an Office action (either final or Non-final) and Notice of Non-Compliant Amendment.

[3] This includes, for example, a Notice to File Corrected Application Papers issued by the Office of Data Management.

(2) Additional Relief before the Patent Trial and Appeal Board

(a) Upon a request to the USPTO affirming that a filing due between, and inclusive of both, March 27, 2020 and April 30, 2020 was or may be delayed due to the COVID-19 outbreak as defined above in subsection (1)(b), the PTAB shall provide a 30-day extension of time for:

i. a request for rehearing of a PTAB decision under 37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d);
ii. a petition to the Chief Judge under 37 C.F.R. § 41.3; or
iii. a patent owner preliminary response in a trial proceeding under 37 C.F.R. §§ 42.107 or 42.207, or any related responsive filings.

(b) In the event that the USPTO extends a deadline for a patent owner preliminary response or any related responsive filings under subsection (2)(a)(iii), the PTAB may also extend the deadlines provided in 35 U.S.C. §§ 314(b) and 324(c).

PTAB Situations Not Covered Above

For all other situations, a request for an extension of time where the COVID-19 outbreak has prevented or interfered with a filing before the Board can be made by contacting the PTAB at 571-272-9797 or by email at Trials@uspto.gov (for AIA trials), PTAB_Appeals_Suggestions@uspto.gov (for PTAB appeals) or InterferenceTrialSection@uspto.gov (for interferences).

The USPTO remains open for the filing of documents and fees

The USPTO is open for the filing of patent documents and fees. Specifically, patent documents and fees may be submitted to the USPTO via: (1) the USPTO's electronic filing system (EFS-Web) (MPEP § 502.05); (2) the United States Postal Service (USPS) by Priority Mail Express® under 37 C.F.R. § 1.10 (MPEP § 513) or with a certificate of mailing under 37 C.F.R. § 1.8 (MPEP § 512); (3) by hand-delivery to the Customer Service Window (MPEP § 501); and (4) facsimile transmission (MPEP § 502.01). AIA trial documents may be submitted to the USPTO via the PTAB E2E electronic filing system under 37 C.F.R. § 42.6, and interference documents may be submitted to the USPTO Interference Web Portal under 37 C.F.R. § 41.106(d)(2). As the USPTO remains open for the filing of documents and fees, the waiver set forth in this notice is available only if the delay was due to the COVID-19 outbreak as defined above. The USPTO will continue to evaluate the evolving situation around COVID-19 and the impact on the USPTO's operations and stakeholders.

In addition to the relief provided herein, the USPTO has previously waived the fee under 37 C.F.R. § 1.17(m) for petitions to revive applications under 37 C.F.R. § 1.137, when applicants

were unable to timely reply to an office communication due to the COVID-19 outbreak, as described in the Office's March 16, 2020 notice.

Comments and Contact Information

Comments and Patent-related inquiries concerning this notice may be sent by email addressed to: Covid19PatentsRelief@uspto.gov. If email submission of comments is not feasible due to lack of access to a computer and/or the internet, please call the Office of Patent Legal Administration at (571) 272-7704 ((571) 272-7703 for reexamination) for special instructions.

Date: 3/31/2020 Andrei Iancu

Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office