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United States Patent and Trademark Office (USPTO) Grants Further Extension of Relief and Opportunities for Certain Patent-Related Matters

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Note: This client alert is in furtherance of a [client alert issued on April 3, 2020](#), authored by Shumaker lawyer Patrick B. Horne entitled, "*U.S. Patent and Trademark Office (USPTO) Provides Applicants Affected by COVID-19 Relief from Patent and Trademark Deadlines*," reflecting more recent notices issued by the USPTO.

Extensions of Patent Deadlines

The USPTO has been granted temporary authority under section 12004 of the Coronavirus Aid, Relief, and Economic Security Act (CARES Act) to toll, waive, adjust, or modify certain timing deadlines for patent-related matters. On April 28, 2020, under their authority, the USPTO granted relief for certain patent-related filings and fees due between, and including, March 27, 2020 and May 31, 2020. Those filings and fees due between the designated dates will be considered timely if filed on or before June 1, 2020.

Then on May 27, 2020, under their authority, the USPTO granted further relief for small and micro entities only. For small entities and micro entities, those filings and fees due between the designated dates will be considered timely if filed on or before July 1, 2020. Large entities can still seek relief after May 31, 2020 on a case-by-case basis by filing a petition for extensions of time or petitions to revive (with required fee). For definitions of entity status see 37 C.F.R. §§ 1.27 and 1.29.

Relief will be granted to those where a delay in filing or payment is due to the COVID-19 outbreak "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.” In order to obtain the relief, a statement must be submitted affirming that any delay was due to the COVID-19 outbreak.

For example, extensions of time may be granted for certain pre-examination responses, responses to non-final Office Actions and final Office Actions, appeal brief filing deadlines, payments of issue fees, payments of maintenance fees filed by small or micro entities, and requests for oral hearings before the Patent and Trademark Appeal Board (PTAB). The USPTO is also waiving the petition fee for filing a petition for the revival of applications that became abandoned on or before June 30, 2020.

It should be noted, extension of time fees required to place the filing, such as responses to Office Actions, filed within the designated dates will still need to be submitted. In a specific example, if a response to a non-final Office Action with a two-month extension of time is due on March 25 (before the designated window), then the two-month extension of time fee must still be paid, and a response to a non-final Office Action with a three-month extension of time (which ordinarily would be due April 15 and is within the designated dates) and three-month extension of time fee will be considered timely if filed on or before July 1. As a result, an analysis of time frames and fees due is required to maintain active applications.

Since many patent owners or potential patent owners likely suffered hardships, such as closures or decreases in business flow, it may be financially and strategically beneficial to take advantage of the relief granted. However, applicants for patent inventions should take caution and conduct a cost/burden/risk analysis to assure the basis for extensions will not be scrutinized or adjudicated in potential patent litigations or conflicts. Where inability to file and making payments is not an issue, foregoing the statement and adhering to the original (pre-COVID 19) dates may be the safer option.

The complete notices can be found on the USPTO website at <https://www.uspto.gov/about-us/news-updates/uspto-grants-further-relief-certain-patent-related-fees-and-deadlines>.

Opportunity for COVID-19 Related Inventions

Additionally, the USPTO is also offering a pilot program to fast track inventions related to COVID-19 without paying additional fees. The goal of the program is to advance prosecution of the COVID-19 related patent applications, wherein a final disposition of the patent application will attempt to be rendered within one year or less. This pilot program is available for small and micro entities.

Information regarding the COVID-19 Prioritized Examination Pilot Program can be found on the USPTO website at <https://www.uspto.gov/initiatives/covid-19-prioritized-examination-pilot>

Contact your Shumaker Patent lawyers to assist you with weighing your patent application options.