

JUNE 18, 2020 | PUBLICATION

Client Alert: USPTO Grants Relief to Restore Priority Rights for Patent Applicants

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According to U.S. patent law, the first inventor to file a patent application with the United States Patent and Trademark Office (USPTO) will receive the patent. Therefore, it is extremely important for applicants to receive an earlier filing date than another applicant filing a patent application for the same invention.

In certain circumstances, the USPTO allows an applicant filing a non-provisional patent application to claim priority (original filing date) of a foreign filed patent application or a provisional patent application. The non-provisional patent application seeking priority must be filed within 12 months of the prior foreign patent application or the provisional patent application (or six months for design patent applications claiming foreign priority). Typically, if the application is not filed within the time period, U.S. patent law permits an applicant two more months to file a non-provisional patent application seeking priority to or benefit of a prior-filed foreign or provisional patent application. See 37 CFR § 1.5(c) or 1.78(b). The two-month additional time is only if the delay in filing the application seeking priority was unintentional. A petition fee is also required.

However, due to the COVID-19 pandemic, the USPTO is granting further relief for those seeking priority. For any non-provisional patent application seeking priority of a prior-filed foreign application for which the 12-month time period (or six-month time period for design patent applications) or a provisional patent application for which the 12-month time period ended between, and inclusive of both, March 27, 2020 and July 30, 2020, the USPTO will:

- Permit the two-month time period to run until the later of:
 - July 31, 2020; or
 - The expiration of the two-month period
- Waive the petition fee as long as the petition states the failure to timely file was due to the COVID-19 outbreak

For many applicants, the COVID-19 pandemic may have halted certain testing, trials, development, investments, and other invention related activities that may have prolonged the decision to file a non-provisional patent application in the U.S. This prolongation may have resulted in a decision to not file a non-

provisional patent application or not claim the earlier filing dates in the U.S. due to the periods. Now an applicant is granted further time at no cost should the pandemic have affected their ability to file a non-provisional patent application.