



## COVID-19 RELATED WAIVER OF PATENT DEADLINES

The United States Patent and Trademark Office (USPTO or "Office") has issued a Notice of temporary waiver of certain patent-related deadlines pursuant to the CARES Act which was recently passed into law. The text of this Deadline Waiver Notice is appended to this Guide.

### Patent Application and Reexamination Proceedings

For COVID-19 related delays,<sup>1</sup> the Deadline Waiver Notice extends by 30 days the time to file certain patent-related documents or pay certain fees. The 30-day extension is available *only* for the following actions that were or are due during the Deadline Period starting March 27, 2020 and extending through April 30, 2020:

- 1) Responding to a Restriction Requirement, Office Action, or other notice/Action issued during examination or patent publication processing – this includes responding to an Office Action that was originally due prior to March 27, but for which any monthly extension is due during the Deadline Period – even if it is the last extension that falls within this period;
- 2) Paying an issue fee;
- 3) Filing a notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. §41.31;
- 4) Filing an appeal brief under 37 C.F.R. §41.37;
- 5) Filing a reply brief under 37 C.F.R. §41.41;
- 6) Paying the appeal forwarding fee under 37 C.F.R. §41.45;
- 7) Requesting an oral hearing before the Patent Trial and Appeal Board (PTAB) under 37 C.F.R. §41.37;
- 8) Responding to a substitute examiner's answer under 37 C.F.R. §41.50(a)(2);
- 9) Amending when reopening prosecution in response to, or a request for rehearing of, a PTAB decision designating as including a new ground of rejection under 37 C.F.R. §41.50(b); and
- 10) Requesting a rehearing of a PTAB decision under 37 C.F.R. §41.52

**Small and Micro Entities** *only* may extend deadlines for Maintenance Fees and replies to an Office notice issued during pre-examination processing.<sup>2</sup>

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<sup>1</sup> The USPTO will continue to evaluate the situation and the impact on its operations and stakeholders.

<sup>2</sup> This includes pre-exam Notices of Omitted Items, of Missing Requirements, of Incomplete Applications, to File Corrected Application Papers, to File Missing Parts, and to Comply with Nucleotide Sequence Requirements.

### **Computing New Deadlines**

The Deadline Waiver Notice effectively tolls the designated due dates that occur during the Deadline Period. This means that an initial deadline occurring within the Deadline Period will be tolled for 30 days, as will any and all allowable extensions of that initial deadline. When calculating the 30-day extension, day 1 is the first day *after* the original due date that would have been in effect without the 30-day extension. Please note that the 30 day period is a departure from ordinary deadlines which are expressed in months. Be very careful when counting your 30 days because March had 31 days so for any extension of due dates occurring from March 27-31, the deadlines will fall in April but one day sooner. By way of example, if you had a March 30<sup>th</sup> due date, the new due date is April 29<sup>th</sup>. If the 30-day extension ends on a Saturday, Sunday or Federal holiday, the period for taking the action is *further extended* until the next business day.

### **COVID-19 Waiver Statement is Required**

To invoke the 30-day extension you *must* include with the response or fee payment a Statement that the delay in filing or payment was due to the COVID-19 outbreak. The Statement does not need to be verified or provided in an affidavit or a declaration. This is because the submission of such a statement to the USPTO constitutes a certification under 37 C.F.R. §11.18(b) and violations of that section may result in sanctions. The Statement can be included in the paper that is being filed if done in a “conspicuous manner,” preferably in a separate paper.

The 30-day extension may only be obtained if a person associated with the filing of a paper or fee was personally affected by the COVID-19 outbreak such that it materially interfered with the timely filing of the paper or fee. Material interference can include (but is not necessarily limited to):

- 1) office closures;
- 2) cash flow interruptions;
- 3) lack of access to files or other material;
- 4) travel delays;
- 5) personal or family illness; or
- 6) other similar circumstances.

A person associated with filing the paper or fee includes (but is not necessarily limited to):

- 1) practitioner;
- 2) applicant;
- 3) patent owner;
- 4) petitioner;
- 5) third-party requester; or
- 6) inventor.

### **PTAB Proceedings<sup>3</sup>**

Relief in connection with the due date for patent application and reexamination proceedings are available *only* for the following actions that were or are due during the Deadline Period starting March 27, 2020 and extending through April 30, 2020:

- 1) Requesting a rehearing of a PTAB decision in an AIA trial or interference proceeding
- 2) Petitioning to the Chief Judge;
- 3) Filing and serving of a patent owner preliminary response in a trial proceeding, or any related responsive filings. In the event that the USPTO extends a deadline for a patent owner preliminary response or any related filings, the PTAB may also extend the deadlines provided in 35 U.S.C. §§ 314(b) and 324(c); and
- 4) For all other situations where the COVID-19 outbreak has prevented or interfered with a filing before the PTAB, a request for an extension can be made by contacting the PTAB.

Please note the PTAB is *not* extending any statutory deadlines for filing an AIA petition under either 35 U.S.C. §§ 315(b) (“An inter partes review may not be instituted if the petition requesting the proceeding is filed more than one-year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent”); or 321(c) (“A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be)” ).

The PTAB will provide the extension of time, *provided that* the filing is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak.

For all other situations, a request for an extension of time should be made before the expiration of the deadline sought to be extended. The request 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)

InterferenceTrialSection@uspto.gov (for interferences)

The PTAB is following the one-year deadline for issuing final decision which may be extended for good cause shown for not more than six months. The COVID-19 outbreak could trigger the extension.

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<sup>3</sup> The standard and people affected for making the statement are the same as set forth above in connection with Patent Application and Reexamination Proceedings.

## Reising's Guide to COVID-19 Related Waiver of Patent Deadlines, *cont.*

### USPTO Resources

The following links provide additional USPTO information concerning the waiver of deadlines in patent cases due to the COVID-19 outbreak:

[USPTO COVID-19 Main Notices Page](#)

[Press release concerning the extension of certain patent and trademark-related timing deadlines under the CARES Act](#)

[Notice of Waiver of Patent-Related Timing Deadlines under the CARES Act](#)

[FAQ for the USPTO Deadline Waiver Notice](#)

### Miscellaneous Other Relief

The Patent and Trademark Office has also:

- 1) waived the requirements for an original handwritten signature for certain correspondence with the Office of Enrollment and Discipline and certain payments by credit card; and
- 2) waived the fee for petitions to revive applications that became abandoned because applicants could not meet the deadline for responding to an Office communication due to the COVID-19 outbreak.

Further information concerning these Miscellaneous Other Relief provisions can be found at the [USPTO COVID-19 Main Notices Page](#) or by contacting the attorney handling your matters.

### Disclaimer

Please note that nothing contained herein constitutes legal advice or is meant to establish an attorney-client relationship. The computations of revised deadlines described herein are based on the USPTO's Deadline Waiver Notice as well as additional information provided by the USPTO in response to specific inquiries. Reising Ethington P.C. makes no guarantee or warranty, express or implied, that the information or deadline computations described herein are correct or that the USPTO will grant waivers of deadlines based on the information provided herein. You should consult with the attorney handling your matter as to the specific circumstances for which you wish to request a waiver of deadlines.

## **Reising's Guide to COVID-19 Related Waiver of Patent Deadlines, *cont.***

The following is the text of the USPTO Notice of Waiver of Patent-Related Timing Deadlines under the CARES Act. The executed original is available [here](#).

### **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<sup>1</sup> by a small or micro entity;
  - ii. reply to an Office notice or action issued during examination<sup>2</sup> or patent publication processing;<sup>3</sup>
  - 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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<sup>1</sup> 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.

<sup>2</sup> This includes, for example, an Office action (either final or Non-final) and Notice of Non-Compliant Amendment.

<sup>3</sup> This includes, for example, a Notice to File Corrected Application Papers issued by the Office of Data Management.

## **Reising's Guide to COVID-19 Related Waiver of Patent Deadlines, *cont.***

### **(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](mailto:Trials@uspto.gov) (for AIA trials), [PTAB\\_Appeals\\_Suggestions@uspto.gov](mailto:PTAB_Appeals_Suggestions@uspto.gov) (for PTAB appeals) or [InterferenceTrialSection@uspto.gov](mailto: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<sup>®</sup> 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

## **Reising's Guide to COVID-19 Related Waiver of Patent Deadlines, *cont.***

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

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