



## **COVID-19 RELATED WAIVER OF TRADEMARK DEADLINES**

The United States Patent and Trademark Office (USPTO or "Office") has issued a Notice of temporary waiver of certain trademark-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.

### **Trademark Applicants, Registrants, and Parties to TTAB Proceedings**

For COVID-19 related delays,<sup>1</sup> relief in connection with the due date for trademark applicants, registrants and parties to TTAB proceedings are available for any of the following acts that were or are due during the Deadline Period starting March 27, 2020 and extending through April 30, 2020:

- 1) Responding to an Office Action, including a notice of appeal from a final refusal, under 15 U.S.C. § 1062(b) and 37 C.F.R. §§ 2.62(a) and 2.141(a);
- 2) Submitting a statement of use or request for extension of time to file a statement of use under 15 U.S.C. § 1051(d) and 37 C.F.R. §§ 2.88(a) and 289(a);
- 3) Submitting a notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and 2.102(a);
- 4) Submitting a priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. § 2.34(a)(4)(i);
- 5) Submitting a priority filing basis under 15 U.S.C. § 1141(g) and 37 C.F.R. § 7.27(c);
- 6) Transforming an extension of protection to the United States into a U.S. application under 15 U.S.C. § 1141J(c) and 37 C.F.R. § 7.31(a);
- 7) Submitting an affidavit of use or excusable nonuse under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
- 8) Submitting a renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or
- 9) Submitting an affidavit of use or excusable nonuse under 15 U.S.C. § 1141K(a) and 37 C.F.R. § 7.36(b).

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

### **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) trademark owner;
- 4) petitioner; or
- 5) third-party requester.

### **TEAS Filings**

The USPTO Trademark Electronic Application System (TEAS) will accept the filing. To file using TEAS you must:

- 1) Locate the TEAS form for the filing you need to make;
- 2) Enter the required information for the filing, and
- 3) Add a statement that the delay in filing or payment was due to the COVID-19 outbreak in the "Miscellaneous Statement" field on the form you are filing.

### **Issues Specific to Trademark TTAB Proceedings**

The Trademark Trial and Appeal Board (TTAB) deadlines that are eligible for the 30-day extension of time are:

- 1) Filing a notice of appeal from a final refusal under 15 U.S.C. § 1062(b) and 37 C.F.R. § 2.62(a); and
- 2) Filing of a notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and § 2.102(a).

For all other situations where the COVID-19 outbreak has prevented or interfered with a filing before the Board, you can make a request (in *ex parte* appeals) or file a motion (for trial cases) for an extension or reopening of time, as appropriate.

### **ESTTA Filings**

The USPTO Electronic System for Trademark Trials and Appeals (ESTTA) will accept the filing. To file using ESTTA you must:

- 1) Locate the ESTTA form for the filing you need to make;
- 2) Enter the required information for the filing; and
- 3) Add a statement that the delay in filing or payment was due to the COVID-19 outbreak in the attachment or appropriate field of the form you are filing.

### **Final 60-Day Extension of Time to Oppose**

The effects of the COVID-19 outbreak are considered good cause in support of a second extension of time to oppose, if the first extension was a 30-day extension of time to oppose, or in support of an initial extension of 90 days to oppose, when a longer initial extension is desired. The effects of the COVID-19 outbreak also are considered extraordinary circumstances in support of the final 60-day extension of time to oppose. Fees for an extension requiring a showing of good cause or extraordinary circumstances are still required, even though the filing may be made later than when it would otherwise be due, if the delay in filing is due to the COVID-19 outbreak. When

specifying the good cause or extraordinary circumstances, the statement that the delay was due to the COVID-19 outbreak can be included in the “other” basis for the extension.

### **USPTO Resources**

The following links provide additional USPTO information concerning the waiver of deadlines in trademark matters 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 Trademark-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 and registrations that were canceled/expired due to an inability to timely respond to a Trademark-related Office communication as a result of the effects of the COVID-19 outbreak.

The requisite forms for abandoned and canceled/expired trademark matters are available [here](#). For abandoned applications, the TEAS Petition to Revive Abandoned Application - Failure to Respond Timely to Office Action form or Petition to Revive Abandoned Application - Failure to File Timely Statement of Use or Extension Request form should be used. The first of these two forms should be used to indicate that a notice of appeal to the TTAB from a final Office Action is also being filed. For canceled/expired registrations, the TEAS Petition to Director form should be used.

In all cases, the petition must include the Statement explaining how the failure to respond to the Office communication was due to the COVID-19 outbreak. The petition must be filed not later than two months after the issue date of the notice of abandonment or cancellation. 37 CFR §§ 2.66(a)(1), 2.146(d)(1). If the applicant or registrant did not receive a notice of abandonment or cancellation, the petition must be filed not later than six months after the date the trademark electronic records system indicates that the application is abandoned or the registration is canceled/expired. 37 CFR §§ 2.66(a)(2), 2.146(d)(2).

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 UPSTO'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 Trademark Deadlines, *cont.***

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

### **Notice of Waiver of Trademark-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 trademark-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 the Trademark Act, 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: 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, registrants, trademark owners, or others appearing before the Office in trademark matters, and has prevented applicants, registrants, trademark owners, or others appearing before the Office in trademark 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 and law firms. Accordingly, a person who is unable to meet trademark-related timing deadlines due to the COVID-19 outbreak may be eligible for a waiver of certain deadlines, as further described below.

#### **Relief for Trademark Applicants, Registrants, and Parties to TTAB Proceedings**

(a) The due date for any:

- i. response to an Office action, including a notice of appeal from a final refusal, under 15 U.S.C. §1062(b) and 37 C.F.R. §§ 2.62(a) and 2.141(a);
- ii. statement of use or request for extension of time to file a statement of use under

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

- 15 U.S.C. § 1051(d) and 37 C.F.R. §§ 2.88(a) and 2.89(a);
- iii. notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and § 2.102(a);
- iv. priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. § 2.34(a)(4)(i);
- v. priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. § 7.27(c);
- vi. transformation of an extension of protection to the United States into a U.S. application under 15 U.S.C. § 1141j(c) and 37 C.F.R. § 7.31(a);
- vii. affidavit of use or excusable nonuse under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
- viii. renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or
- xi. affidavit of use or excusable nonuse under 15 U.S.C. § 1141(a) and 37 C.F.R. § 7.36(b)

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.

A delay in filing or payment is due to the COVID-19 outbreak for the purposes of this notice if a practitioner, applicant, registrant, 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.

### **TTAB Situations Not Covered Above**

For all other situations where the COVID-19 outbreak has prevented or interfered with a filing before the Board, a request (in ex parte appeals) or motion (for trial cases) for an extension or reopening of time, as appropriate, can be made.

### **The USPTO Remains Open for Filing Documents and Fees**

The USPTO is open for the filing of trademark and TTAB documents and fees. As the USPTO remains open for the filing of trademark 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.

The existing procedures to revive an abandoned application or reinstate a canceled/expired

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

registration pursuant to 37 CFR §§ 2.66 and 2.146 remain available to applicants and registrants whose applications and registrations were abandoned or canceled/expired due to inability to timely respond to a trademark-related Office communication as a result of the COVID-19 outbreak. As described in the Office's March 16, 2020 "Relief Available to Patent and Trademark Applicants, Patentees and Trademark Owners" notice, fees for such petitions are waived.

### **Comments and Contact Information**

Comments and trademark-related inquiries concerning this notice may be addressed to [TMPolicy@uspto.gov](mailto:TMPolicy@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 Trademark Office of Petitions at (571) 272-8950 for special instructions. For TTAB-related inquiries contact Cheryl Butler at [Cheryl.Butler@uspto.gov](mailto:Cheryl.Butler@uspto.gov) or (571) 272-4259 or Denise DelGizzi at [Denise.DelGizzi@uspto.gov](mailto:Denise.DelGizzi@uspto.gov) or (571) 272-4265.

Date: 3/31/2020

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