

U.S. Patent and Trademark Office Extensions Under the CARES Act

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On Tuesday, March 31, 2020, the U.S. Patent and Trademark Office ('USPTO') notified the public that it may extend certain deadlines and delay payment of fees.

On March 16, 2020, the USPTO notified the public that it would waive revival petition fees for missed deadlines due to COVID-19-related issues, but only where those deadlines

were for responding to USPTO communications (*i.e.*, deadlines set by regulations not statute). More specifically, these petitions are to revive abandoned applications or canceled registrations. The USPTO's authority to do so came from interpreting the effects of the COVID-19 outbreak as an "extraordinary situation" within the meaning of 37 CFR 1.183 and 37 CFR 2.126.

The Coronavirus Aid, Relief, and Economic Security Act ("CARES Act"), signed by the president on March 27, 2020, granted extra authority to the USPTO director to extend *statutory* deadlines and payment of fees, or provide additional other relief to patent and/or trademark owners, as may be necessary in the USPTO's discretion. In response, the USPTO released notices for patents and trademarks.

All prosecution deadlines for filing certain trademark-related and patent-related documents that fall on, or between, March 27, 2020, and April 30, 2020, are eligible for a thirty-day extension.

The extension of deadlines and/or payment of fees, however, is only applicable for delays "*due to the COVID-19 outbreak.*" Therefore, any requisite filing would need an accompanying statement that the COVID-19 outbreak caused the delay - *e.g.*, payment interruptions, inability to access documents, or illness of key employees or officers.

Upon request, such extensions may also apply to certain filings due before the Patent Trial and Appeal Board ("PTAB") that were or may be delayed due to the COVID-19 outbreak. For other PTAB situations not specifically listed in the notice, a request for an extension due to the COVID-19 outbreak can be made by contacting the PTAB. Aside from deadlines to file a notice of opposition, an extension to file a notice of opposition, or a notice of appeal from a final refusal, such extensions are not applicable to the Trademark Trial and Appeal Board ("TTAB"). Extensions to most TTAB deadlines due to COVID-19-related issues may or may not be granted, following separate motion or request to the TTAB.

It is unknown whether the USPTO will adopt similar measures *after* April 30, 2020, if COVID-19-related effects continue to burden patent and trademark owners.

Some companies and individuals may find relief from the thirty-day extensions, but others may wish to avoid delay in prosecution. An earlier trademark registration or patent grant, for example, could be used for enforcement in the marketplace. For this reason, the USPTO's decision to make extensions optional provides more flexibility than foreign intellectual property offices like the European Patent ("EPO") and European Intellectual Property Offices ("EUIPO"). Prosecution deadlines are automatically extended, to April 17, 2020, for the EPO and May 1, 2020, for the EUIPO. Other foreign intellectual property offices are completely closed in response to the disruption caused by the COVID-19 outbreak, with attorneys, companies, and individuals, waiting for clear direction on how to proceed and/or how intellectual property rights will be affected during the blackout.

While the USPTO has been closed to the public for a few weeks, the Office remains fully operational for submitting documents and paying fees. More details from the USPTO are available via its website.

Anyone who has questions about whether the USPTO extensions under the CARES Act apply to their patent or trademark deadlines should seek legal counsel before relying on them. Our IP team can help.

Ed. note: We made revisions to this article on April 7, 2020, following further clarification from the USPTO.

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