

# Patent Office Excuses Certain Filing Deadlines and Fees in Response to COVID-19

Related People:  
Mark H. Anania

## COVID-19 Intellectual Property Alert

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The United States Patent and Trademark Office (USPTO) recently issued several notices excusing certain filing deadlines and fees to ease the burden on patent filers during the COVID-19 pandemic. But because these relief measures do not apply to **all** deadlines and fees, it is important to understand what is covered—and what is not—so that you can take the proper steps to protect your patents during this time. The key relief measures to date on patent filings are summarized below.

**COVID-19 Patent Relief**

**How to Get It**

Waiver of the petition fee to revive abandoned proceedings for applicants or patent owners unable to timely reply to a Patent Office communication resulting in the application being abandoned or the reexamination prosecution terminated or limited.

Timely file a copy of the USPTO's [March 16, 2020 Patent Notice](#) as well as a statement in the 37 C.F.R. § 1.137(a) petition "that the delay in filing the reply required to the outstanding Office communication was because the practitioner, applicant, or at least one inventor, was personally affected by the Coronavirus outbreak such that they were unable to file a timely reply."

Waiver of original handwritten signatures for:

- Correspondence relating to registration to practice, enrollment, and disciplinary investigations or proceedings
- Payments by credit card where payment is not by electronic filing systems

Automatic upon submission of an S-signature (such as "/First Last/") otherwise compliant with 37 CFR § 1.4(d).

A 30-day extension to any of the following deadlines falling between and including March 27, 2020, and April 30, 2020:

- Replies to Office Notices issued during pre-examination processing by a small or micro entity or Office Actions or Notices during examination or patent publication processing
- Issue fees and, *for small and micro entities only*, maintenance fees
- Appellate filings including notices of appeal, appeal briefs, reply briefs, and appeal forwarding fees
- Requests for oral hearings before the Patent Trial and Appeal Board (PTAB)
- Responses to substitute examiner's answer
- Amendments when reopening prosecution in response to, or request for rehearing of, a PTAB decision including a new ground of rejection
- Requests for rehearing of a PTAB decision under 37 C.F.R. § 41.52

File a statement accompanying the late filing that "the delay in filing or payment" was "**due to the COVID-19 outbreak**" as defined in the [March 31, 2020 Patent Notice](#).

A 30-day extension of the following types of PTAB deadlines falling between March 27, 2020, and April 30, 2020:

- Requests for rehearing of a PTAB decision under 35 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d)
- Petitions to the Chief Judge
- Patent owner preliminary responses or any related responsive filings (which if granted may also extend deadlines in 35 U.S.C. §§ 314(b) and 324(c))

Submit a request to the USPTO affirming that the "filing was or may be delayed **due to the COVID-19 outbreak**" as defined in the [March 31, 2020 Patent Notice](#).

Extensions of other PTAB deadlines not listed in the notices may be available upon request.

Request an extension from the PTAB by phone or email where "the COVID-19 outbreak has prevented or interfered with a filing before the PTAB."

To date, these relief measures **do not extend** to the following USPTO deadlines or payment of fees:

- The deadline to file a nonprovisional patent application claiming the benefit of a prior filed foreign application under 35 U.S.C. § 119(a)-(d);

- The deadline to file a nonprovisional application to obtain benefit of a provisional application's filing date under 35 U.S.C. § 119(e);
- The deadline to file a continuation application before issuance of the parent application under 35 U.S.C. § 120; and
- Any other dates or requirements set by statute not addressed by the notices.

Those who can should still attempt to meet their original deadlines so as to avoid any needless debate on whether relief was truly justified or authorized under these notices. But for those truly affected by the COVID-19 outbreak, these measures are a welcome relief. Before relying on any of these procedures, contact your patent counsel at McCarter & English to confirm that relief is available and has not further changed in this ever-dynamic environment.

The COVID-19 pandemic has forced changes to usual patent procedures. McCarter's patent attorneys are available to advise you on the best course of action for your patent portfolio.

For more information about the USPTO's separate relief measures on trademark filings and fees, click [here](#).