Reinhart

Effects of CARES Act on Patent and Trademark Practice Before the USPTO

UPDATE, April 1, 2020:

The director of the U.S. Patent and Trademark Office (USPTO) has now invoked his authority to waive certain deadlines in patent and trademark matters. In particular, the deadlines for certain filings due during the period of March 27, 2020, and April 30, 2020, will be extended 30 days from the initial due date. Filings made during the extension period must be accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak. The situations he determination of whether the COVID-19 outbreak delayed a filing varies slightly between patent and trademark matters.

In extending the deadlines for certain patent and trademark actions, the examiner has determined that the COVID-19 emergency prejudices the rights of certain entities appearing before the USPTO and has prevented certain entities from filing documents or fees with the Office. Specifically, with respect to patents, the director determined that small businesses and independent inventors are particularly vulnerable to the disruptions cause by the COVID-19 outbreak because such entities typically have less access to capital and because patent-related fees may be a more significant expense for such entities. With respect to trademarks, the director determined that the outbreak has significantly disrupted the operations of businesses and law firms.

As mentioned above, a filing made during the extension period for one of the patent or trademark actions enumerated below requires a statement that the delay was due to the COVID-19 outbreak. As explained by the USPTO, such delay is attributable to the COVID-19 outbreak if a person associated with such 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.

Patents

The extension of deadlines applies to patent application and reexamination proceedings for the following actions:

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- reply to a USPTO notice issued during pre-examination processing by a small or micro entity;
- reply to a USPTO notice or action issued during examination or patent publication processing;
- issue fee;
- maintenance fee, filed by a small or micro entity; or
- filings made in connection with *ex parte* appeals, including a notice of appeal, appeal brief, reply brief, appeal forwarding fee, request for an oral hearing before the Patent Trial and Appeal Board (PTAB), response to a substitute examiner's answer, amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection, or request for rehearing of a PTAB decision.

Additionally, when a request is made that affirms delay of a filing due to the COVID-19 outbreak, the PTAB shall provide a 30-day extension of time for:

- a request for rehearing of a PTAB motion or judgment in a contested case or trial;
- a petition to the chief judge; or
- a patent owner preliminary response in an *inter partes* review or post-grant review proceeding and any related responsive filings (such extension allows the PTAB to also extend the deadline to institute such proceedings).

Trademarks

The extension of deadlines applies to trademark applications, registrations and proceedings for the following actions:

- response to an Office action, including a notice of appeal from a final refusal;
- statement of use or request for extension of time to file a statement of use;
- notice of opposition or request for extension of time to file a notice of opposition;
- priority filing basis based on foreign registration;
- priority filing basis, transformation of an extension of protection to the United States into a U.S. application, and affidavit of use or excusable nonuse under the Madrid Protocol; and
- affidavit of use or excusable nonuse and renewal application for trademark registrations.

In *ex parte* appeals or trials pending before the Trademark Trial and Appeal Board (TTAB), a request or motion for an extension or reopening of time must be made

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to the TTAB.

Notably, for both patents and trademarks, the director emphasized that the USPTO remains open and available to receive filings and accept fee payment electronically or through the mail. Additionally, the director made clear that patent or trademark applications abandoned due to the inability to timely respond as a result of the COVID-19 outbreak can be revived without the fees typically associated with a petition to revive.

Also of note, both the patent and trademark notices issued by the director refer to "the initial date [the filing] was due," which seems to refer to any shortened period for reply as opposed to statutory deadlines. If so, then any filings already in their extension period prior to March 27, 2020, including those having a statutory deadline within the emergency period, would not be subject to the extended deadline. As such, best practice remains to submit any filings by the scheduled deadlines and only attempt to rely on the deadline extension where doing so is absolutely unavoidable.

Original article:

As individuals and businesses struggle to cope with restrictions to their activities related to the COVID-19 pandemic, the CARES Act recently passed into law provides some relief to, among others, patent and trademark applicants, registrants and other related parties.

By way of background, prosecution of patent and trademark applications involves adhering to strict statutory deadlines (typically three- or six-month deadlines) for responding to actions issued by the U.S. Patent and Trademark Office (USPTO). Additionally, litigation-related proceedings, such as trademark oppositions and cancellations, inter partes review, post grant review, etc., have strict deadlines for filing documents and paying fees. Failure to take prescribed action within the statutory deadline typically results in abandonment of the patent or trademark application or adverse judgments in litigation-related proceedings.

Under the CARES Act, authority has been given to the director of the USPTO to "toll, waive, adjust, or modify, any timing deadline" set by the Patent and Trademark acts or any regulation promulgated thereunder.

Such action must be taken by the director during the emergency period as declared by the President, resulting from the COVID-19 outbreak, or the 60-day period following the duration of the emergency period. Additionally, the director

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must determine that the COVID-19 emergency:

1. materially affects the functioning of the USPTO;
2. prejudices the rights of applicants, registrants, patent owners or others appearing before the Office; or
3. prevents applicants, registrants, patent owners or others appearing before the USPTO from filing a document or fee with the USPTO.

As of this writing, the director has not tolled, waived, adjusted, or modified any deadline for responding to USPTO actions. Further, with respect to the three alternatives listed above, it is not clear yet which alternative(s) the director would invoke.

In particular, under the first alternative, the USPTO has functioned and appears capable of continuing to function during the outbreak. Indeed, Reinhart attorneys have been able to conduct business with the USPTO using electronic filing and fee payment, including while working from home.

However, electronic filing and fee payment, though prevalent, have not been universally adopted by all practitioners (especially *pro se* applicants and registrants), who may not have been set up for conducting electronic business with the USPTO at the time of the COVID-19 outbreak. Thus, the third alternative may be grounds for the director to toll, waive, adjust, or modify deadlines. The second alternative seems promising because individuals and businesses may certainly feel prejudiced by restrictions related to the COVID-19 outbreak, but what exactly is meant by the phrase "prejudices the rights" is not clear, e.g., whether such prejudice must be to the right itself (i.e., patent or trademark right) or economic rights related to the difficulty of responding while restricted by the COVID-19 outbreak.

Though no declaration regarding deadlines has been made, the USPTO does consider the effects of the COVID-19 outbreak to be an "extraordinary situation" within the meaning of 37 CFR 1.183 and 37 CFR 2.146. As such, the USPTO has decided to waive the fees associated with petitions to revive patent or trademark applications abandoned or canceled as a result of the inability to timely file a response due to the effects of the COVID-19 outbreak. In order to qualify, the petition to revive must comply with certain filing and timing requirements.

While the CARES Act provides a glimmer of relief for those appearing before the USPTO, the director will still need to invoke the authority granted before deadlines can be tolled, waived, adjusted, or modified. Additionally, the authority

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regarding deadlines appears to relate to statutorily set deadlines, such as the six-month statutory deadline to respond to a patent Office Action. However, the USPTO often sets shortened deadlines that are not set by statute or regulation and that require payment of extension fees to take advantage of the full statutory deadline. The effect on shortened deadlines and payment of extension fees is an outstanding question. Additionally, the effect on certain other deadlines such as deadlines related to filing dates are unclear, especially as they relate to treatment in foreign patent offices. That is, while the USPTO may extend the filing deadline for converting provisional or foreign applications, the late filing may not be waived reciprocally in foreign jurisdictions. Thus, attorneys at Reinhart will endeavor to meet original response and filing deadlines even should the director invoke the authority granted under the CARES Act.

If you need assistance reviving an application abandoned or canceled as a result of the COVID-19 outbreak, or have questions in general, please contact a member of Reinhart's Intellectual Property Practice or your Reinhart attorney.

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