

IP Frontiers: US Patent and Trademark Office aims to provide relief, spur innovation amid COVID-19



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The United States Patent and Trademark Office (USPTO) has made provisions and extended deadlines for responding to certain matters in light of the hardships created by the COVID-19 outbreak and has also created programs intended to spur innovation in the

fight against COVID-19.

Under section 12004 of the Coronavirus Aid, Relief, and Economic Security Act (CARES Act), the USPTO has the authority to extend timing deadlines during the emergency period defined in subsection 12004(e) of the CARES Act. Accordingly, the USPTO decided that the national emergency of COVID-19 has prejudiced the rights of patent applicants, owners, and others appearing before the USPTO in patent matters, and has prevented patent applicants, owners, and others appearing before the USPTO in patent matters from filing a document or fee with the USPTO. The USPTO has further acknowledged that the COVID-19 outbreak has particularly impacted independent inventors and small businesses, who may not have access to capital and who may be significantly impacted by patent-related fees.

The USPTO initially set forth the details of the fee deferral in a first notice issued March 31, 2020, then later published a second notice on April 28, 2020, superseding the first notice, and extending the period for deferral until June 1, 2020. In a third notice of May 27, 2020, the USPTO further extended its fee deferral provisions through July 1, 2020, for small and micro entities. Pursuant to this most recent notice of May 27, 2020, large entities need to request relief on a case-by-case basis by filing a petition for extension of time

or petition to revive. Small or micro entities are entitled to an extension of time until July 1, 2020, for any:

- reply to a USPTO notice issued during pre-examination processing;
- reply to a USPTO notice or action issued during examination or patent publication processing;
- issue fee;
- 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;
- maintenance fee; or
- request for rehearing of a PTAB decision.

To make use of these provisions, a statement must be filed certifying that the 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, for example, by 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.

The USPTO has also waived the fee for filing a petition to revive an application (or reexamination proceeding) that became abandoned on or before June 30, 2020, provided there is a statement that the delay was due to the practitioner, applicant, or at least one inventor being personally affected by COVID-19 and that they were unable to file a timely reply. This waiver is available to patent applicants of all entity sizes.

There is additional relief available for submitting initial applications for Patent Term Extension (PTE) to the USPTO. For example, initial PTE applications may now be submitted (1) electronically (by EFS-Web or Patent Center), (2) by U.S. Postal Service Priority Mail Express® or with a certificate of mailing, or (3) by hand delivery to the USPTO customer service window.

Moreover, the USPTO has begun temporarily permitting the filing of plant patent applications and follow-on documents via the USPTO patent electronic filing systems. According to the USPTO, these provisions were created to simplify action required by those filing plant patent applications and also to allow for the identification and processing of plant patent applications and follow-on documents by the USPTO during the COVID-19 outbreak.

Prior to the COVID-19 outbreak, there were two situations at the USPTO that required original handwritten signatures personally signed in permanent ink and for which the USPTO has implemented a waiver until further notice — those include certain correspondence with the Office of Enrollment and Discipline and certain payments by credit card where the payment is not being made via the USPTO's electronic filing systems.

In an effort to generate innovation, the USPTO is implementing, beginning on July 13, 2020, a COVID-19 Prioritized Examination Pilot Program, which will grant qualified requests for prioritized examination without payment of certain fees for applicants that qualify as small or micro entity status. This Pilot Program is available for applications that cover a product or process related to COVID-19, and those applications must be subject to an applicable U.S. Food and Drug Administration (FDA) approval for prevention and/or treatment of COVID-19. The

goal of this pilot program, according to the USPTO, is to reach a final disposition within 12 months from the grant date of prioritized status, and, ideally to reach a final disposition in six months provided applicants file timely responses. This pilot program is one of the efforts made by the USPTO to encourage innovation by small and micro entities in the fight against COVID-19.

Moreover, there is a new “Patents 4 Partnerships” pilot program that will provide a centralized, searchable, and accessible database of U.S. patents and published patent applications that are available for licensing if they relate to applications for the prevention, diagnosis, and/or treatment of or protection from COVID-19, including, for example, disinfectants, test kits, ventilators, and components thereof.

On June 11, 2020, the USPTO issued a further notice that extends the two-month peri-

od of time for restoring the right of priority to or benefit of a provisional or foreign application for any nonprovisional application due to be filed between March 27, 2020, and July 30, 2020 (inclusive of both dates), and waives the associated petition fee.

Although more limited than the relief available in patent matters, there is also relief available to trademark applicants and registrants, which may be particularly useful for individuals and small businesses. More information on these can be found at the [uspto.gov/coronavirus](https://www.uspto.gov/coronavirus).

Relief under the USPTO provisions and notices is limited to specific circumstances, entity size, and, in some instances, subject matter. Accordingly, any entity considering making use of these provisions should discuss such a strategy with their patent and trademark professionals, who can assist in evaluating whether the required conditions

are met. Other factors should also be considered, as proceeding under these provisions has the potential to expose a patent applicant to risks such as possible post-issuance challenges, exposure of financial records, and even loss of Patent Term Adjustment. Your patent and trademark professional can assist in evaluating the advantages and risks of utilizing the above USPTO provisions during the COVID-19 outbreak.

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