

USPTO Permitting Patent Applicants to Extend Certain Deadlines Due to COVID-19

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On March 31, 2020, the U.S. Patent and Trademark Office (USPTO) [announced](#) that it is permitting patent applicants to request extensions of the time allowed to file certain documents and to pay certain fees due to the ongoing COVID-19 emergency in the United States. In doing so, USPTO director Andrei Iancu is exercising temporary authority granted to him under the Coronavirus Aid, Relief, and Economic Security Act (CARES Act) signed into law on March 27.

The CARES Act provides that the USPTO may toll, waive, adjust, or modify any timing deadline established by Title 35 of the United States Code (commonly known as the Patent Act) and the regulations promulgated thereunder that are in effect during the emergency period. Director Iancu has now determined, among other things, that the COVID-19 emergency has sufficiently prejudiced the rights of patent applicants, patent owners, and others appearing before the USPTO in patent matters to justify invoking the emergency authority provided to him under the CARES Act.

Accordingly, a person who cannot meet certain patent-related timing deadlines due to the COVID-19 outbreak may be eligible to receive a limited waiver of those deadlines. These deadlines pertain to the due dates for filing the following documents and fees with the USPTO:

1. Reply to an Office notice issued during pre-examination processing by a small or micro entity (this includes a Notice of Omitted Items, Notice to File Corrected Application Papers, Notice of Incomplete Application, Notice to Comply with Nucleotide Sequence Requirements, Notice to File Missing Parts of Application, and Notification of Missing Requirements);
2. Reply to an Office notice or action issued during examination or patent publication processing (this includes a final or non-final Office action and Notice of Non-Compliant Amendment);
3. Issue fee;
4. Notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 41.31;
5. Appeal brief under 37 C.F.R. § 41.37;
6. Reply brief under 37 C.F.R. § 41.41;

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7. Appeal forwarding fee under 37 C.F.R. § 41.45;
 8. Request for an oral hearing before the Patent Trial and Appeal Board (PTAB) under 37 C.F.R. § 41.50(b);
 9. Response to a substitute examiner's answer under 37 C.F.R. § 41.50(a)(2);
 10. Amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection under 37 C.F.R. § 41.50(b);
 11. Maintenance fee, filed by a small or micro entity; or
 12. Request for rehearing of a PTAB decision under 37 C.F.R. § 41.52.

The due dates that are presently eligible for extension are only those due dates that are between, and inclusive of, March 27, 2020 and April 30, 2020. The [Notice](#) published by the USPTO states that a due date will be extended only by “30 days from the initial date it was due.” The safest reading of this language is that the extension applies only to the *initial, un-extended* date on which a document is due, not a date that is already in an extension period. For example, it appears that the extension for a response to an Office action would apply only to the initial three-month shortened statutory period for reply, *not* the final six-month deadline. Additional clarity will hopefully be forthcoming from the USPTO.

To obtain an extension, the patent filing must be accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak. This means 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, 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.”

The USPTO's Notice does not provide additional guidance on what it means for a person to be “personally affected by the COVID-19 outbreak” or that “the outbreak materially interfered with timely filing or payment.” Practitioners, therefore, should exercise some caution and might consider requesting an extension only when the COVID-19 outbreak has genuinely interfered with the timely filing of a document or payment of a fee with the USPTO.

The USPTO's Notice also leaves unclear whether and how patent term adjustment (which compensates patent applicants for delays that occur during patent prosecution) is affected by a requested extension due to the COVID-19 outbreak. Thus, requesting an extension to file after the initial due date might generate a delay that could reduce any patent term adjustment.

Note that the extensions apparently do *not* apply to the filing deadlines for new patent applications. It thus appears, for example, that a patent applicant cannot request an extension of the one-year statutory bar applicable to pre-filing disclosures made by an inventor or joint inventor. See 35 U.S.C. § 102(b)(1). It also appears that a patent applicant cannot request an extension of the one-year right of priority to a patent application filed in a foreign country, see 35 U.S.C. § 119(a), or an extension of the one-year right of priority to a provisional patent application filed in the United States, see 35 U.S.C. § 119(e). The USPTO's Notice leaves unclear how an extension might apply to a

continuation or divisional application filed in lieu of an office action response. In the absence of further guidance from the USPTO, the safest reading of the USPTO's Notice is that the extensions do *not* apply to such a continuation or divisional application.

See [this article](#) on the USPTO permitting trademark applicants to request extensions due to the ongoing COVID-19 emergency.

As you are aware, things are changing quickly and there is no clear-cut authority or bright line rules. This is not an unequivocal statement of the law, but instead represents our best interpretation of where things currently stand. This article does not address the potential impacts of the numerous other local, state and federal orders that have been issued in response to the COVID-19 pandemic, including, without limitation, potential liability should an employee become ill, requirements regarding family leave, sick pay and other issues.

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