

# NEW COVID-19 PILOT PROGRAM AND EXTENSIONS FOR PATENTS AND TRADEMARKS

*Hodgson Russ Intellectual Property Alert*  
May 8, 2020

Many government agencies are implementing policies to reduce the need for in-person interaction and accommodate those affected by the COVID-19 outbreak. The United States Patent and Trademark Office is no exception.

## **Prioritized Examination Pilot Program**

On May 8, 2020, the USPTO announced a new prioritized examination pilot program. Normally, patent applications can be advanced for examination on an expedited basis if the applicant files a request for prioritized examination and pays a related fee. The new pilot program allows for prioritized examination without payment of the related fee if (1) the applicant is a small or micro entity and (2) the application claims products or processes that are subject to an applicable FDA approval for COVID-19 use, including an Investigational New Drug (IND) application, an Investigational Device Exemption (IDE), a New Drug Application (NDA), a Biologics License Application (BLA), a Premarket Approval (PMA), or an Emergency Use Authorization (EUA).

For prioritized examination, the USPTO has a goal of examination of applications within twelve months of special status being granted. Under the new pilot program, the USPTO will endeavor to reach final disposition of applications *within six months* if applicants provide all responses within 30 days of each notice by the USPTO.

A request for prioritized examination under the pilot program must be made with a new filing of utility or plant nonprovisional applications or with (or after) the filing of a request for continued examination (RCE) of an existing utility or plant application. However, applications that claim priority to two or more filed nonprovisional or international applications are not eligible for the pilot.

At this time, the USPTO has limited the pilot program to a total of no more than 500 requests.

## **CARES Act Adjustments**

The COVID-19 Aid, Relief, and Economic Security (CARES) Act became law on March 27, 2020. This sweeping relief package provides, among many other things, temporary authority to the Director of the USPTO to change statutory or regulatory timing deadlines relating to patent and trademark matters during the current

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national emergency.

### *Patents*

Using the emergency authority from the CARES Act, the Director extended various patent prosecution deadlines if the delay in filing a response or payment was due to the COVID-19 outbreak. Certain filings and fees having deadlines falling from March 27, 2020 to May 31, 2020 will be considered timely if filed on or before June 1, 2020 with a statement that the delay was due to the COVID-19 outbreak. The deadlines that are extended include certain:

- Replies to pre-examination notices by small or micro entities;
- Replies to office actions or notices to file corrected application papers;
- Issue fees;
- Notices of appeal;
- Appeal and reply briefs;
- Appeal forwarding fees;
- Requests for oral hearings before the Patent Trial and Appeal Board;
- Responses to substitute examiner's answers;
- Amendments when reopening prosecution in response to a Patent Trial and Appeal Board decision including a new ground of rejection;
- Maintenance fees filed by small or micro entities;
- Requests for rehearing of certain Patent Trial and Appeal Board decisions; and
- Petitions to the Chief Administrative Patent Judge.

Further, a 30-day extension may be requested for certain preliminary responses or related responsive filings by patent owners in trial proceedings before the Patent Trial and Appeal Board having deadlines falling between March 27, 2020 and April 30, 2020.

*Important Note:* The following statutory time periods are *not* extended by the Director's emergency action:

- The period to file a non-provisional application claiming priority to a foreign application or benefit of a provisional application; or
- The codependency requirement to file a continuation, continuation-in-part, or divisional application.

### *Trademarks*

Similarly, using emergency authority from the CARES Act, the Director extended various trademark prosecution deadlines. The below filings and fees having deadlines falling from March 27, 2020 to May 31, 2020 will be considered timely if filed on or before June 1, 2020 with a statement that the delay was due to the COVID-19 outbreak. The deadlines that are extended include certain:

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- Replies to office actions, including notices of appeal from final refusals;
- Statements of use or request for extension of time requests for filing the same;
- Notices of opposition or requests for extension of time for filing the same;
- Filings claiming priority to foreign applications or under the Madrid Protocol;
- Transformations of extension of protection to the United States into a U.S. application;
- Affidavits of use or excusable nonuse; and
- Renewal applications.

### Other Adjustments

Outside of the CARES Act, the Director deems the COVID-19 outbreak an “extraordinary situation” and has made certain adjustments to its normal procedures for patent and trademark matters.

#### *Interviews and Hearings*

The USPTO has closed its physical offices to the public for an indefinite time. During this closure, interviews and hearings will be conducted via video conference or teleconference. This includes examiner interviews, hearings before the Patent Trial and Appeal Board and Trademark Trial and Appeal Board, and other in-person meetings. If an in-person meeting was scheduled, it will now be conducted using these methods.

#### *Signatures*

Under normal circumstances, the USPTO requires handwritten signatures exclusively in correspondence with the Office of Enrollment and Discipline (OED) and credit card payments not using the USPTO’s electronic filing system (EFS-Web). The Director waived this requirement. A handwritten signature, a graphic representation of the same, or an electronic “s-signature” are temporarily acceptable for such correspondence and credit card transactions.

#### *Petitions to Revive*

With respect to both patent and trademark matters, the Director will waive the fee for a petition to revive an application, issued patent, or registered trademark that became abandoned on or before May 31, 2020, where the abandonment was a result of the COVID-19 outbreak.

### Conclusion

The USPTO continues to adjust its procedures to accommodate the impact of the COVID-19 situation. While the accommodations are not indefinite, they provide relief for certain emergency situations that would otherwise forfeit the application. We are glad to assist you in determining whether relief is available to you due to impacts of the COVID-19 outbreak.

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If you have questions about your intellectual property matters, please contact Alfonzo Cutaia (716.848.1580) for patents, Neil Friedman (646.218.7605) for trademarks, or any of the attorneys in our Intellectual Property Practice.

Please check our Coronavirus Resource Center and our CARES Act page to access information related this rapidly evolving topic.

If you received this alert from a third party or from visiting our website, and would like to be added to our Intellectual Property mailing list or any other of our mailing lists, please visit us at: <https://forms.hodgsonruss.net/sign-up-for-email-and-othercommunications.html>.