

# Intellectual Property Alert

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## The USPTO Provides Deadline Extensions Through the CARES Act, Including for Inter Partes Reviews at the Patent Trial and Appeal Board

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### Key Points:

- The CARES Act grants the Director of the USPTO temporary authority to “toll, waive, adjust, or modify” statutory deadlines under the Title 35 of the United States Code governing patent law.
- In a Notice published on March 31, 2020, the USPTO issued guidelines to allow 30-day extensions of certain filings and pleadings for those affected by the COVID-19 national emergency.
- In addition, the USPTO provides for the extension of certain deadlines in *inter partes* reviews and other proceedings at the PTAB.

In response to this grant of authority under the CARES ACT, the USPTO published a notice on March 31, 2020, entitled “Notice of Waiver of Patent-Related Timing Deadlines under the [CARES] Act” (link [here](#)) (“Notice”). In that Notice, the Director of the USPTO determined that the national emergency relating to the COVID-19 outbreak “has prejudiced the rights of applicants, patent owners, or others appearing before the USPTO in patent matters, and has prevented applicants patent owners, or others appearing before the USPTO in patent matters from filing a document or fee with the [USPTO].” Accordingly, the USPTO will grant extensions of time for certain patent-related filings if a 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 pandemic.

The Notice identified certain patent-related filings or fees that are due between March 27, 2020, and April 30, 2020, inclusive of both dates, for which the deadline will be extended 30 days from the date the filing or fee was originally due:

1. Reply to an Office notice issued during pre-examination processing by a small or micro entity, with certain notices identified by example.
2. Reply to an Office notice or action issued during examination or patent publication processing, with certain notices and actions identified by example.

### Contact Information

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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.
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. § 41.47.
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.
12. Request for rehearing of a PTAB decision under 37 C.F.R. § 41.52.

This 30-day extension will be granted if filing is accompanied by a statement that the "delay in filing or payment was due to the COVID-19 outbreak." Acceptable explanations for the delay may include "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 the timely filing or payment." Importantly, these deadline extensions under the CARES Act apply only to granted patents and applications that have already been filed; patent application filing deadlines, for example, are not affected by these 30-day extensions.

The USPTO also established deadline extensions for certain events specific to proceedings before the PTAB, including exceedingly significant and popular *inter partes* reviews. Specifically, the USPTO will grant 30-day extensions for the following deadlines:

1. Requests for rehearing regarding a PTAB decision.
2. Petitions to the Chief Judge under 37 C.F.R. § 41.3.
3. Patent owner preliminary responses in trial proceedings under 37 C.F.R. § 42.107 or 42.207, or any related responsive pleadings.

Extensions must be requested by a party and accompanied by a statement explaining that the delay was due to the COVID-19 outbreak. If a patent owner preliminary response or related responsive filing is granted a 30-day extension, the deadline for institution of an *inter partes* review or post-grant review may also be extended by the USPTO. For all other situations not covered by the Notice, practitioners may contact the PTAB to request a time extension where the COVID-19 outbreak has interfered with a filing.

Under the CARES Act and its Notice of March 31, 2020, the USPTO provides generous relief, and clients with pending proceedings at the USPTO, including *inter partes* reviews at the PTAB, may be in a position to qualify for a 30-day deadline extension. Practitioners should carefully consider whether a time extension may be warranted, or even beneficial, in fully asserting their rights before the USPTO and meeting their business needs during this global pandemic.

