

The United States Patent and Trademark Office Extends the Filing Deadlines of Certain Non-Provisional Patent Applications Affected by COVID-19

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An ongoing challenge during the COVID-19 pandemic has been to meet the filing deadlines of non-provisional patent applications that claim priority to prior patent applications (e.g., prior provisional or foreign patent applications). In response to this challenge, the United States Patent and Trademark Office (USPTO) has exercised temporary authority provided by the Coronavirus Aid, Relief, and Economic Security Act (CARES Act) to extend the filing deadlines of certain non-provisional patent applications for at least two months if an applicant is unable to meet the filing deadline due to the COVID-19 pandemic (“Notice”)[1]. **Table 1** provides a summary of the requirements and deadlines for requesting such extensions of time in accordance with the Notice.

Scope of COVID-19-related delays	Inability to meet the patent application filing deadline due to the COVID-19 pandemic
Qualifying non-provisional patent applications	<ol style="list-style-type: none"> 1. Non-provisional patent applications that claim priority to a foreign utility or design patent application. 2. Non-provisional patent applications that claim priority to a provisional patent application. 3. International patent applications (e.g., PCT applications) that claim priority to a prior patent application.
Extendible deadline window	The patent application filing deadline must be on or after March 27, 2020, but on or before July 30, 2020
Amount of time that can be extended	Later of July 31, 2020 or two (2) months from the filing deadline
Procedural requirements for obtaining the extension	File the patent application by the extended deadline along with a petition and a statement that the failure to meet the original deadline was due to the COVID-19 outbreak
Fees for obtaining the extension	None (fees waived)

Table 1. Requirements and deadlines for requesting extensions of time for filing non-provisional patent applications affected by COVID-19.

I. Background: patent application filing deadlines are extendible due to unintentional delays

Under ordinary circumstances, a patent application claiming priority to or benefit of a prior-filed foreign or provisional application must be filed within 12 months (or 6 months in the case of a design application claiming foreign priority) of the prior-filed application[2]. Thereafter, an applicant has two more months to petition for restoration of the right to claim priority to or benefit of a prior-filed foreign or provisional application if the delay in filing the application seeking priority or benefit was unintentional[3]. Under such circumstances, the applicant must file the application within the two month period along with a petition fee and a statement that the delay was unintentional[4].

II. Certain patent application filing deadlines are now extendible due to COVID-19-related delays

Under the Notice, the USPTO has expanded the extensions of time to file non-provisional patent applications to instances where a party involved in the filing and preparation process was not able to meet the patent application filing deadline due

to the COVID-19 pandemic[5]. The USPTO has broadly identified such COVID-19-related delays to include instances where “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 outbreak” through various occurrences, such as “office closures, cash flow interruptions, inaccessibility of files or other materials, travel delays, personal or family illness, or similar circumstances.”[6]

According to the Notice, the following non-provisional patent applications qualify for extensions of time due to COVID-19-related Delays:

- Non-provisional patent applications that claim priority to a foreign patent application, thereby requiring the filing deadline to be within 12 months of the foreign patent application filing date;
- Non-provisional patent applications that claim priority to a foreign design patent application, thereby requiring the filing deadline to be within 6 months of the foreign patent application filing date;
- Non-provisional patent applications that claim priority to a provisional patent application, thereby requiring the filing deadline to be within 12 months of the provisional patent application filing date; and
- International patent applications (i.e., patent applications filed under the Patent Cooperation Treaty) that claim priority to a prior U.S. or foreign patent application, thereby requiring the filing deadline to be within 12 months of the earliest patent application[7].

III. Applicants affected by COVID-19 are entitled to at least a two month extension of time

To qualify for a COVID-19-related extension of time under the Notice, a patent application must have a filing deadline that falls on or after March 27, 2020, and on or before July 30, 2020[8]. Under the Notice, the USPTO will permit the filing deadline of the patent application to be extended to the later of July 31, 2020 or two-months after the deadline to file the patent application[9].

In order to request the extension of time under the Notice, applicants must file the following materials by the extended deadline:

- The non-provisional patent application (or international patent application);
- The appropriate petition for requesting the deadline to be extended[10]; and
- A statement that the failure to timely file the application was due to the COVID-19 outbreak. The USPTO has provided form PTO/SB/449 for this purpose[11].

No fees are required for requesting the extension of time[12].

IV. Conclusion

The CARES Act provides the Director of the USPTO with broad discretionary authority to modify, extend, or adjust numerous deadlines established by patent or trademark statute or regulation. The USPTO has already invoked the CARES Act to provide numerous accommodations to applicants that have been affected by the COVID-19 pandemic[13]. The USPTO Notice outlined in this article further expands such accommodations by providing affected applicants with the opportunity to extend the filing deadline of certain non-provisional patent applications.

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Contacts:

[Frank Amini, Ph.D.](#) | 713.650.2795 | famini@winstead.com

[Sam Udovich](#) | 214.745.5319 | sudovich@winstead.com

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[1] See the 6/11/2020 USPTO [Notice](#) entitled ““Notice of the United States Patent and Trademark Office's COVID-19 Outbreak Relief Relating to Restoring the Right of Priority or Benefit to Patent Applicants.”

[2] 35 U.S.C. § 119(a)

[3] 37 C.F.R. § 1.55(c)

[4] See the 6/11/2020 USPTO [Notice](#) entitled ““Notice of the United States Patent and Trademark Office's COVID-19 Outbreak Relief Relating to Restoring the Right of Priority or Benefit to Patent Applicants.”

[5] *Id.*

[6] See pages 2-3 of the 4/28/20 USPTO [Notice](#) entitled “Notice of Extended Waiver of Patent-Related Timing Deadlines under the Coronavirus Aid, Relief, and Economic Security Act and Other Relief Available to Patent Applicants and Patentees.”

[7] See the 6/11/2020 USPTO [Notice](#) entitled ““Notice of the United States Patent and Trademark Office's COVID-19 Outbreak Relief Relating to Restoring the Right of Priority or Benefit to Patent Applicants.”

[8] *Id.*

[9] *Id.*

[10] The appropriate petitions are as follows: (1) petition under 37 CFR §1.55(c) for patent applications that claim priority to foreign utility or design patent applications; (2) a petition under 37 CFR § 1.78(b) for patent applications that claim priority to a provisional patent application; and (3) a petition under 37 CFR § 1.452 for international patent applications that claim priority to a foreign or provisional patent application.

[11] See the 6/11/2020 USPTO [Notice](#) entitled ““Notice of the United States Patent and Trademark Office's COVID-19 Outbreak Relief Relating to Restoring the Right of Priority or Benefit to Patent Applicants.”

[12] *Id.*

[13] See [USPTO Notice Regarding COVID-19](#)