

It's Business As Usual *Mostly* at the U.S. Patent & Trademark Office

The disruption of the COVID-19 virus to everyday life and virtually every business and agency is impossible to miss. In an effort to stem the spread of the virus, many institutions have reduced hours of operation, limited access and reduced staffing to minimal levels. The federal government and many state and local governments have instituted extreme measures to provide short term relief to individuals and business; for example, the extension of the federal tax filing deadline.¹ Many federal courts have also issued broad extensions of time and suspended activities, such as a suspension of civil hearings and civil jury trials.

Despite the numerous extensions and suspensions, the U.S. Patent and Trademark Office has not materially altered its operations. Thus far, it has issued the following announcements:

- All interviews and oral arguments with examiners, the PTAB and TTAB will be done remotely by telephone or video conference;
- The physical USPTO offices are temporarily closed to the public;
- Electronic signatures are now acceptable in all circumstances (waiving the original handwritten, ink signature requirement of 37 C.F.R. 1.4(e)(1) and (2)); and

- Petition fees in some situations, such as petitions to revive, are waived.

Critically, Deadlines Are Not Extended

The fact that deadlines are not extended is an important factor for businesses to be cognizant of during the present market turmoil. Many businesses are struggling with skeletal staff, trying to coordinate with remote employees, and addressing cashflow problems due to lack of demand or inability to manufacture and supply product. However, it is important to remain focused on the critical deadlines that, if missed, could cost the business its ability to secure its valuable intellectual property assets.

Particularly, patent applicants must meet the following deadlines to ensure they maintain the ability to secure IP rights²:

Patents

- Inventors must file a patent application within one year of a public disclosure, sale, or offer to sell an invention. Failure to file will result in a bar to patentability under 35 USC 102.
- Applicants must file a utility application claiming priority to any provisional application within one year of the filing date of the provisional application under 35 USC 119(e). Failure to do so will bar the priority claim.

- Applicants must file a U.S. utility application claiming priority to any foreign patent application within one year of the priority date of the foreign application under 35 USC 119(a)-(d). Failure to do so will bar the priority claim and may result in the foreign application becoming prior art to any U.S. application.
- Continuation or divisional application must be filed while the parent application remains pending under 35 USC 102. Failure to file during the copendency period will bar the applicant from claiming priority to the parent application
- Issue fees must be paid within the three-month window provided by 35 USC 151. Failure to pay the issue fee will result in abandonment, but under the new USPTO guidelines, the fee for a petition to revive may be waived.
- The requestor in an ex parte reexamination proceeding must file any reply to a statement filed by the patentee within the two-month time period of 35 USC 304.

Trademarks

- An applicant's statement of use and associated fee must be filed within 36 months of the notice of allowance of an intent-to-use application under 15 USC 1051(d). Failure to file will result in abandonment of the application with no ability to revive it.
- Affidavits of continued use or excusable non-use of a mark and the associated fees under 15 USC 1058 and 1141(k), must be filed within between five and six years from the registration date and every 10 years thereafter. Failure to file will result in

cancellation of the mark with no ability to revive it.

- Renewals and associated fees under 15 USC 1059 must be filed every 10 years from the date of registration. Failure to file will result in cancellation of the mark with no ability to revive it.
- Oppositions and cancellation proceedings must be filed within the time periods set forth in 15 USC 1063 and 1064 respectively. Failure to file will preclude a party from instituting an opposition or cancellation proceeding.

While it may be difficult to focus on the business's intangible assets during a time when employees are struggling, business will return to normal in the near future. It is important that every business maintain its IP assets during this period so that each remains strong when we emerge from these tumultuous times.

If you have any questions about this Alert, please contact the author listed below or the Aronberg Goldgehn attorney with whom you normally consult.

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¹ <https://www.irs.gov/newsroom/tax-day-now-july-15-treasury-irs-extend-filing-deadline-and-federal-tax-payments-regardless-of-amount-owed>

² https://www.uspto.gov/sites/default/files/documents/coronavirus_relief_notice_03162020.pdf