



## Business as usual? Patent prosecution in the wake of the coronavirus

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In response to the COVID-19 pandemic, the United States Patent and Trademark Office (USPTO) announced that all of its offices are closed to the public and non-essential employees, but that it is otherwise continuing operations as normal. Starting on March 13, all examiner interviews, Patent Trial and Appeal Board ([PTAB](#)) and Trademark Trial and Appeal Board ([TTAB](#)) oral hearings, and other similar in-person meetings with parties and stakeholders scheduled to take place at USPTO offices are being conducted remotely through video or teleconference (see “[USPTO notices regarding COVID-19](#)”). The USPTO has also issued a number of notices—discussed in more detail below—outlining the few requirements and deadlines that have changed, and those that have not.

It’s important to understand what changes the USPTO is imposing, but perhaps even more important to understand the deadlines and requirements that remain in place in order to avoid abandonment of a patent application or forfeiture of patent rights.

### Waivers of certain fees and requirements:

The USPTO will waive petition fees (37 C.F.R. 1.17(m)) for petitions filed pursuant to 37 C.F.R. 1.137(a) for revival of patent applications that have been found abandoned or reexamination prosecutions that have been terminated or limited as a result of the patent owner or applicant being “unable” to timely reply to an office communication due to the coronavirus outbreak.

### *Certain requirements apply*

- The reply to the office communication must be filed along with the petition.
- A copy of the USPTO’s [March 16 Relief Notice](#) must be included with the reply.
- The petition must include a statement attesting to the fact that the delay in filing the reply was because the counsel, applicant, or at least one inventor was personally affected by the coronavirus outbreak such that they were unable to file a timely reply.
- The petition must be filed as soon as possible and *not later* than two months following the issue date of the notice of abandonment or the notification that reexamination prosecution has been terminated or limited in order. If no notice or notification was received, the petition must be filed *not later* than six months after the date on which the application

became abandoned, or the reexamination prosecution was terminated or limited.

In the [March 19 Handwritten Signature Notice](#), the USPTO indicated that the requirement for original handwritten signatures is being waived for certain correspondence with the Office of Enrollment and Discipline and certain payments by credit card, per 37 CFR 1.4(e)(1) and (2).

### **Statutory deadlines:**

The USPTO made clear that all statutory deadlines remain in place and are not affected by the coronavirus outbreak. The [March 16 Relief Notice](#) does *not* grant a waiver or extension of dates and requirements set forth by the statutes. These include, among others:

- The time period for filing a non-provisional patent application claiming the benefit of a prior-filed foreign application, per 35 U.S.C. §119(a)–(d)
- The time period during which a non-provisional application claiming the benefit of a prior-filed provisional application must be filed in order to obtain the benefit of the provisional application’s filing date, per 35 U.S.C. §119(e)
- The co-pendency requirement that exists between a parent application, which issues as a patent, and a child application, which requires that the child application be filed prior to issuance of the parent application, per 35 U.S.C. §120
- The three-month issue fee deadline, per 35 U.S.C. §151
- In *ex parte* reexamination proceedings, the two-month deadline given to the requester of the reexamination to reply to any statement filed by the patent owner, per 35 U.S.C. §304

All deadlines and requirements not specifically waived by the USPTO should be treated as unaltered and standing. Additional updates will be provided as the USPTO issues additional guidelines relating to the coronavirus.

Many foreign patent offices have implemented their own special procedures and adjustments to respond to the coronavirus pandemic, and continue to do so as the situation evolves. If you have questions about USPTO practice or any foreign countries’ latest approaches to these issues, please contact our [Coronavirus Response Team](#), your Nixon Peabody patent counsel, or:

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