

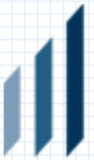
# COVID-19: IMPACT ON PATENT PROCEDURES

Amanda Varrichione | Wednesday,  
May 13, 2020



- Impact on United States Practice
  - Extendable/non-extendable deadlines
  - Petitions to revive
  - Prioritized Examination
  - Plant Patents
- Impact on European Practice
- Other Jurisdictions
  - WIPO policy tracker
- Takeaways





## Under the CARES Act

USPTO may toll, waive, adjust or modify any timing deadline under the 35 U.S.C. or regulations thereunder if the director of the USPTO determines that the emergency:

- (1) materially affects the functioning of the Patent and Trademark Office
- (2) prejudices the rights of applicants, registrants, patent and trademark owners, or others appearing before the Office; or
- (3) prevents applicants, registrants, patent and trademark owners, or others appearing before the Office from filing a document or fee with the Office

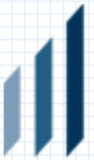
# United States – Extendable Deadlines



- USPTO has determined that a person unable to meeting deadlines due to COVID-19 may be eligible for a waiver of certain deadlines
- Extensions for certain deadlines to pay fees or file documents which fall on/between **March 27** and **May 31**
  - Deadlines extended to **June 1** – but:
    - Not automatic
    - Requires certification
    - Not for all deadlines
  - New order issued April 28 modifies previous order which allowed for extended deadlines to May 1, 2020



# United States – Applicable Deadlines



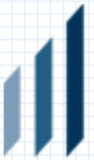
- Response to notice issued during pre-examination processing (**small or micro entities**)\*
- Response to Office Action or notice issued during examination\* or patent publication processing\*
- Issue fee
- Notice of appeal, Appeal brief, and Reply brief
- Appeal forwarding fee
- Maintenance fee (**small or micro entity**)
- Response to substitute examiner's answer, amendment when reopening prosecution in response to a PTAB decisions designated as including a new ground of rejection

# United States – Non-applicable Deadlines



- Certain filings for large entities
  - Response to notice issued during pre-examination processing
  - Maintenance fees
- Deadline for claiming priority to a provisional application
- Grace period after inventor's own disclosure
- 30-month deadline for entering the national stage of a PCT application
- Information disclosure statement submission timelines and associated fees





## Extensions are not automatic

- Only available where the delay in timely filing was due to COVID-19 outbreak
  - “where someone associated with the filing or payment was personally affected by the outbreak” through reasons such as:
    - Office closure
    - Cash flow interruption
    - Inaccessibility of files
    - Travel delay
    - Personal or family illness
    - Similar circumstances which “materially interfered with timely filing or payment”

# United States – Procedure



## Extensions are not automatic

- Must make statement that the delay in filing/payment was due to COVID-19 outbreak which is submitted with the filing/payment to qualify for extension
- USPTO has released a form for making the above statement – “**Statement of Delay Due to COVID-19 Outbreak (PTO SB-449)**”

Doc Code: COVID-19

Document Description: Request for extension under COVID-19

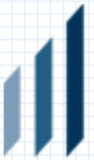
PTO/SB/449 (04-20)

STATEMENT OF DELAY DUE TO COVID-19 OUTBREAK (Page 1 of 1)			
Applicant or Patent Owner			
Application No. or Patent No.		Filing Date or Issue Date	
Title of Invention			
<p>This statement accompanies a filing or payment that was delayed due to the COVID-19 outbreak.</p> <p>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, including, without limitation, through 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 timely filing or payment.</p>			
Signature		Date	
Name (Print or Type)		Practitioner Registration Number	
<p><i>Note: This form must be signed in accordance with 37 CFR 1.33. Please see 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required and indicate below the total number of forms submitted.*</i></p>			
<input type="checkbox"/> *Total of <input type="text"/> forms are submitted.			

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



# United States – Other Relief



- Certain filing deadlines for PTAB proceedings are also applicable where COVID-19 outbreak has interfered with ability to timely file
  - Request for oral hearing before the PTAB
  - Request for rehearing of a PTAB decision
  - Petition to the Chief Judge
  - Patent owner preliminary response in a trial proceeding
- Applies to deadlines between **March 27 and April 30**
  - The PTAB shall provide a 30-day extension of time
  - Permits the PTAB to further extend deadlines for IPRs/PGRs in view of the above extensions
- For other situations the USPTO invites the representative to contact the PTAB by phone or email



- In addition to extensions, the USPTO has waived certain fees for revival or reinstatement due to abandonment because of the inability to timely reply due to COVID-19 outbreak
  - Limited to applications and reexamination proceedings which became abandoned on or before May 31, 2020 as a result of the COVID-19 outbreak
    - Applicable to petition fees under 37 C.F.R. § 1.17(m)
  - Must make statement regarding reason for delay submitted with the reply



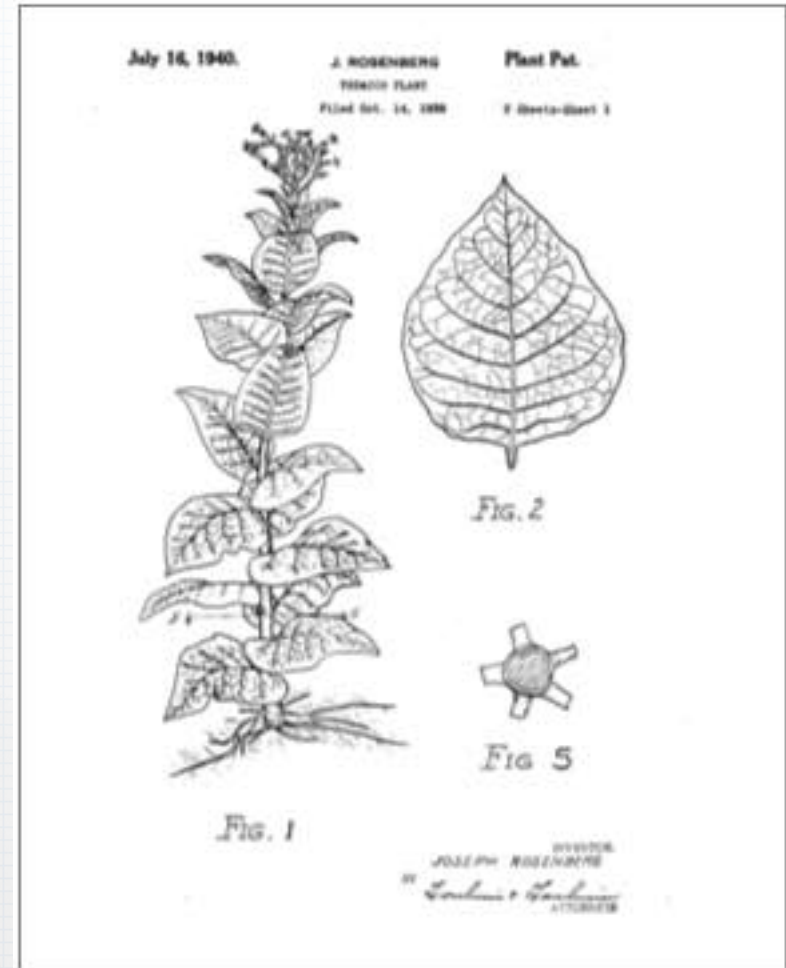
# United States – Prioritized Examination Pilot Program



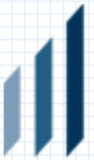
- Applicable to all patent applications of **small or micro entity** applicants with claims covering a product or process subject to U.S. FDA approval **for use in the prevention and/or treatment of COVID-19**
  - USPTO will grant prioritized examination without payment of typical fees associated with prioritized examination
    - Original utility or plant applications claiming the benefit of no more than one prior nonprovisional or international application
      - Made at the time of filing or with or after the filing of an RCE
  - Will endeavor to reach final disposition within twelve months, six months if applicant responds promptly to USPTO communications
  - Limited to first 500 applications filed under the pilot program
  - PTO/SB/450 form for submitting request



- Temporary waiver to file plant patent applications electronically through EFS-web/Patent Center until further notice
  - Certain required documents to be submitted detailed in Office Notice







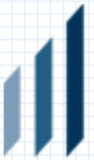
- The EPO has issued four notices regarding the extension of deadlines for patent applications
  - Most recent notice issued on May 1, 2020
    - Automatically extends deadlines expiring **on or after March 15 to June 2, 2020**
  - Applies also to international applications before the EPO
- Applies to “extensions of periods” but not all deadlines are “periods” – many deadlines are encompassed by the extension but best to check with European Associate

# Europe – Non-applicable Deadlines



- Filing a divisional application
  - May only be filed while the parent application is pending – no later than the day before the publication of the mention of grant of the patent
  - EPO appears to be still publishing the mention of grant on its usual timetable
- Filing an application on/before the date of a public disclosure
- Twelve-month priority period afforded by prior-filed applications in other jurisdictions
- “Double deadlines”
- Filing written submissions ahead of oral proceedings
- Renewal fees





- Additional safeguards applicable for delays caused to dislocation in delivery or transmission of mail or “natural calamity” in the locality where the applicant resides, has a place of business in, or is staying
  - Must offer evidence that delay was due to disruption and that filing was performed as soon as possible after the disruption ended (with certain time limits laid out in the Office Notice).

# Other Jurisdictions



Miller Canfield Chart Updated as of May 8th

Wolf Greenfield Update

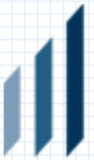
## Canada

- Automatic extension of deadlines between March 16<sup>th</sup> and May 15<sup>th</sup> to May 18<sup>th</sup>

## Australia

- Streamlined process for extensions of time
  - No explanation necessary – must check box that you are unable to meet deadline due to COVID-19
  - Extension of up to three months is free of charge
  - In place until at least May 31<sup>st</sup>





## India

- IPO closed until May 18<sup>th</sup> – automatic extensions for deadlines between March 23<sup>rd</sup> and May 18<sup>th</sup>

## China

- No special procedure for extensions
- May restore applications abandoned due to COVID-19 without cost



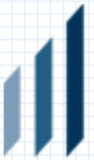
## South Korea

- Automatic extensions for deadlines between March 31<sup>st</sup> and May 31<sup>st</sup>
  - More stringent limitations on applicable deadlines

## Japan

- No automatic extensions but option to include explanation for late response to remedy delay





## Taiwan

- No special procedure for extensions but ability to request reinstatement for delay caused by COVID-19

## Brazil

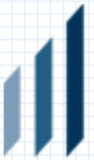
- Automatic extension of deadlines until May 15<sup>th</sup> 2020

# Policy Tracker



Country/Region	Office	Office Status	Operational hours	Teleworking	Working Remotely with Customers	Correspondence	Processing existing applications	Processing new applications	Time limits	Fee relief	Last updated	Details
International	WIPO	Open (virtually)	No change	Yes	Yes	Electronically only	Electronically only	Electronically only	May be extended	Deadlines may be extended	2020-05-06	<a href="#">view more</a>
European Union	EUIPO	Open (virtually)	No change	Yes	Yes		Yes	Yes	Extended	Deadlines extended	2020-04-30	<a href="#">view more</a>
Europe	EPO	Open (virtually)	No change	Yes	Yes		Yes	Yes	Extended	Deadlines extended	2020-05-04	<a href="#">view more</a>
Africa	OAPI	Open (virtually)	Reduced hours		Yes		Yes	Yes	Extended		2020-05-04	<a href="#">view more</a>
Africa	ARIPO	Open (virtually)		Yes	Yes		Yes	Yes	Case-by-case basis	Case-by-case basis	2020-05-04	<a href="#">view more</a>
Algeria	Algerian National Institute of Industrial Property	Open	Reduced hours	Yes	Yes		Yes	Yes	Extended	Deadlines extended	2020-04-10	<a href="#">view more</a>





- Extensions should be a last resort
- United States extensions:
  - Not automatic
  - Note which deadlines are non-applicable
- Foreign filings: consult with Foreign Associates for better understanding
- PCT applications relate to multiple jurisdictions and applicable relief may vary by jurisdiction
- Procedures are new and the limits of which have not been fully tested

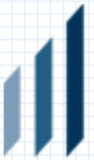
# Resources – United States



- [Wolf Greenfield Notice on USPTO Extensions](#)
- [USPTO Updated Notice on Patent Application Extensions](#)
- [USPTO Initial Notice on Patent Application Extensions](#)
- [Relief Available to Plant Patent Applications](#)
- [COVID-19 Prioritized Examination Pilot Program](#)



# Resources – Europe and Other Jurisdictions



- [Summary of COVID-19 Impact in Europe](#)
- [EPO Office Notice dated 1 May 2020](#)
- [EPO COVID-19 Updates](#)
- [Wolf Greenfield Update on COVID-19 IP Deadline Extensions Around the Globe](#)
- [WIPO IP Policy Tracker](#)

