

USPTO Extending Time to File Trademark Related Documents

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PRACTICE AREAS

- Intellectual Property

An McV Intellectual Property Alert

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In accordance to section 12004 of the Coronavirus Aid, Relief, and Economic Security Act (**CARES Act**), the United States Patent and Trademark Office (USPTO) is extending the time to file trademark related documents under certain circumstances.

Filings covered by the extension are:

- Response to an Office action, including a notice of appeal from a final refusal, under 15 U.S.C. §1062(b) and 37 C.F.R. §§ 2.62(a) and 2.141(a);
- Statement of use or request for extension of time to file a statement of use under 15 U.S.C. § 1051(d) and 37 C.F.R. §§ 2.88(a) and 2.89(a);
- Notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and § 2.102(a);
- Priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. § 2.34(a)(4)(i);
- Priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. § 7.27(c);
- Transformation of an extension of protection to the United States into a U.S. application under 15 U.S.C. § 1141j(c) and 37 C.F.R. § 7.31(a);
- Affidavit of use or excusable non-use under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
- Renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or
- Affidavit of use or excusable non-use under 15 U.S.C. § 1141k(a) and 37 C.F.R. § 7.36(b)

For all other situations where the COVID-19 outbreak has prevented or interfered with a filing before the Trademark Trial and Appeal Board, a request (in ex parte appeals) or motion (for trial cases) for an extension or reopening of time can be made.

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If an eligible document or fee was or is due between March 27, 2020, and April 30, 2020, the filing will be considered timely if:

- made within 30 days of the original due date
- the filing is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak

A delay is considered due to the COVID-19 outbreak “if a practitioner, applicant, registrant, 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.”

The USPTO continues to waive the petition fee to revive abandoned applications or reinstate canceled/expired registrations that were canceled/expired due to an inability to timely respond to a Trademark-related Office communication as a result of the effects of the COVID-19 outbreak.

The USPTO continues evaluating the situation around COVID-19 and its impact on the USPTO’s operations and stakeholders. If the USPTO extends the CARES Act relief, it will provide timely notice. We will alert you as soon as any announcements are made.

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