

Relief Available to Patent and Trademark Applicants, Patentees, Reexamination Parties, and Registered Trademark Owners Affected by the Severe Earthquake Impacting Japan

“On behalf of the United States Patent and Trademark Office (USPTO), I want to express our deepest condolences for the damage, injury, and loss of life that impacted the people of Japan as a result of the recent earthquake,” remarked USPTO Director Kathi Vidal.

The United States Patent and Trademark Office (USPTO or Office) considers the effects of the severe earthquake that struck the Noto Peninsula in Japan on January 1, 2024, to be an “extraordinary situation” within the meaning of 37 CFR 1.183, 2.146(a)(5), and 2.148 for affected patent and trademark applicants, patentees, reexamination parties, and registered trademark owners.

Patent-Related Correspondence—Time Periods for Reply

Patent applicants and reexamination parties affected by the severe earthquake in Japan may request that the USPTO restart the time period for reply set in an Office communication. For patent applications and reexamination proceedings pending in the USPTO as of January 1, 2024, having one or more inventors, an applicant, an assignee, a patent owner, or a correspondence address in the areas of Japan affected by the severe earthquake, in which a reply to an Office communication is outstanding, and for which the statutory or non-statutory time period set for reply has not yet expired, the USPTO will, on an applicant’s or a reexamination party’s request, restart the time period for reply set in the Office communication. The USPTO may restart the time period for reply by either withdrawing and reissuing the Office communication or sending a notice stating that the time period for reply to the Office communication is being restarted. The Office communication must have been outstanding on January 1, 2024. The request must be made prior to the expiration of the statutory or non-statutory time period set for reply and within sufficient time so that the USPTO can restart the time period for reply to the Office communication prior to the expiration of the statutory or non-statutory time period (as permitted to be extended under 37 CFR 1.136(a), or as extended under 37 CFR 1.550(c) or 37 CFR 1.956). The request must be accompanied by a copy of this notice in order to permit the USPTO to quickly identify it as a request for relief and facilitate timely processing. The inclusion of a copy of this notice will be treated as a representation that the need to restart the time period for reply set in the Office communication was due to the effects of the severe earthquake in Japan. The request should be sent via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If necessary, updates to the correspondence address of record should be provided to ensure receipt of subsequent Office communications.

Patent-Related Correspondence—Petitions to Revive

For patent applicants or patent owners who, beginning on January 1, 2024, were unable to timely reply to an Office communication due to the effects of the severe earthquake in Japan, which resulted in the application being held abandoned or the reexamination prosecution being terminated or limited, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant or patent owner files the reply with a petition under 37 CFR 1.137(a). See 35 U.S.C. 41(a)(7). The inclusion of a copy of this notice with the required reply to the outstanding Office

communication will be treated as a representation that the delay in filing the reply was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the petition fee under 37 CFR 1.17(m). The USPTO advises any patent applicant or patent owner who seeks to file a petition to revive under 37 CFR 1.137(a) with a request to waive the petition fee under 37 CFR 1.17(m) due to the effects of the severe earthquake in Japan, to promptly file the petition under 37 CFR 1.137(a) accompanied by the required reply (but not the petition fee under 37 CFR 1.17(m)) and a copy of this notice. The petition under 37 CFR 1.137(a) must be filed by July 1, 2024, in order to be entitled to a waiver of the petition fee under 37 CFR 1.17(m). A petition to revive under 37 CFR 1.137(a) due to the effects of the severe earthquake in Japan may be submitted via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent-Related Correspondence—Payment of Maintenance Fees

For patentees who, beginning on January 1, 2024, were unable to timely pay a patent maintenance fee due to the effects of the severe earthquake in Japan, the USPTO will waive: (1) the surcharge in 37 CFR 1.20(h) for paying a maintenance fee during the six-month grace period following the window to pay the maintenance fee, and (2) the petition fee in 37 CFR 1.17(m) for accepting a delayed maintenance fee payment when the patentee files the maintenance fee payment with a petition to accept a delayed maintenance fee under 37 CFR 1.378(b). See 37 CFR 1.183.

Patentees who seek to pay a maintenance fee during the six-month grace period following the window to pay the maintenance fee with a request to waive the surcharge in 37 CFR 1.20(h) must mail the payment and request to Mail Stop Maintenance Fee, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; or submit them via facsimile to 571-273-6500.

The request must be accompanied by a copy of this notice in order to permit the USPTO to quickly identify it as a request for relief and facilitate timely processing. The inclusion of a copy of this notice with the payment of the maintenance fee during the grace period will be treated as a representation that the late payment of the fee was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the surcharge under 37 CFR 1.20(h). This waiver may only be appropriately requested where the original window of time to pay the maintenance fee without the surcharge required by 37 CFR 1.20(h) expired on or after January 1, 2024, and the delay in paying the fee was due to the effects of the severe earthquake in Japan.

The USPTO advises patentees who need to file a petition to accept a delayed maintenance fee payment due to the effects of the severe earthquake in Japan, where the maintenance fee payment was required to have been paid on or after January 1, 2024, to promptly file a petition under 37 CFR 1.378(b), (using USPTO form PTO/SB/66, “Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b))”), accompanied by the applicable maintenance fee payment (but not the petition fee under 37 CFR 1.17(m)) and a copy of this notice. The inclusion of a copy of this notice will be treated as a representation that the delay in payment of the maintenance fee was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the petition fee under 37 CFR

1.17(m). The petition must be filed by January 1, 2025, in order to be entitled to a waiver of the petition fee under 37 CFR 1.17(m). A petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) due to the effects of the severe earthquake in Japan may be submitted via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent-Related Correspondence—Late Submission of Inventor’s Oath or Declaration or Filing Fees

For patent applicants who filed a nonprovisional application on or after January 1, 2024, and prior to February 2, 2024, without an executed inventor’s oath or declaration or payment of the basic filing fee, search fee, and/or examination fee due to the effects of the severe earthquake in Japan, the USPTO will waive the surcharge set forth in 37 CFR 1.16(f) for the late filing of the inventor’s oath or declaration or basic filing fee, search fee, and/or examination fee. Patent applicants seeking a waiver of the surcharge must include a copy of this notice, along with the executed inventor’s oath or declaration or the basic filing fee, search fee, or examination fee, in order to permit the USPTO to quickly identify it as a request for relief and facilitate timely processing. The inclusion of a copy of this notice will be treated as a representation that the late filing of the inventor’s oath or declaration or the basic filing fee, search fee, or examination fee was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the surcharge under 37 CFR 1.16(f). A reply to a Notice to File Missing Parts requiring the inventor’s oath or declaration or the filing fees (or other notice stating that the executed inventor’s oath or declaration has not been received) may be submitted via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent-Related Correspondence—Petitions for Unintentionally Delayed Domestic Benefit and Foreign Priority Claims

For patent applicants who, beginning on January 1, 2024, were unable to timely file a benefit claim under 37 CFR 1.78(a) or (d) due to the effects of the severe earthquake in Japan, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant submits the benefit claim with the appropriate petition under 37 CFR 1.78(c) or (e). See 35 U.S.C. 41(a)(7). Similarly, for patent applicants who, beginning on January 1, 2024, were unable to timely file a priority claim under 37 CFR 1.55 due to the effects of the severe earthquake in Japan, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant submits the priority claim with the appropriate petition under 37 CFR 1.55(e). The inclusion of a copy of this notice with a petition under 37 CFR 1.78(c), 1.78(e), or 1.55(e) will be treated as a representation that the delay in filing the benefit or priority claim and the need to file the petition was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the petition fee under 37 CFR 1.17(m). The USPTO advises any patent applicant who seeks to file a petition under 37 CFR 1.78(c), 1.78(e), or 1.55(e) with a request to waive the petition fee under 37 CFR 1.17(m) due to the effects of the severe earthquake in Japan, to promptly file the petition under 37 CFR 1.78(c), 1.78(e), or 1.55(e) (but not the petition fee under 37 CFR 1.17(m)) and a copy of this notice. The petition under 37 CFR 1.78(c), 1.78(e), or 1.55(e) must be filed by July 1, 2024, in order to be entitled to a waiver of the petition fee under

37 CFR 1.17(m). A petition under 37 CFR 1.78(c), 1.78(e), or 1.55(e) due to the effects of the severe earthquake in Japan may be submitted via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent-Related Correspondence—Petitions for Restoration of Domestic Benefit and Foreign Priority Claims

For patent applicants who are filing or have filed a nonprovisional application on or after January 1, 2024, who meet the requirements for restoration of the right to claim the benefit of a provisional application, and who missed the 12-month time period under 35 U.S.C. 119(e) due to the effects of the severe earthquake in Japan, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant files a petition under 37 CFR 1.78(b) to restore the benefit of a provisional application. See 35 U.S.C. 41(a)(7). The nonprovisional application must have been filed within two months from the expiration of the 12-month time period. For patent applicants who are filing or have filed a nonprovisional application on or after January 1, 2024, who meet the requirements for restoration of the right of priority, and who missed the 12-month time period under 35 U.S.C. 119(a) (or the six-month time period under 35 U.S.C. 172 in a design application) due to the effects of the severe earthquake in Japan, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant files a petition under 37 CFR 1.55(c) to restore the right of priority. Note that the nonprovisional application must have been filed within two months from the expiration of the 12-month time period (or six-month time period in a design application). The inclusion of a copy of this notice with a petition under 37 CFR 1.78(b) or 1.55(c) will be treated as a representation that the delay in filing the nonprovisional application and the need to file the petition was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the petition fee under 37 CFR 1.17(m). The USPTO advises any patent applicant who seeks to file a petition under 37 CFR 1.78(b) or 1.55(c) with a request to waive the petition fee under 37 CFR 1.17(m) due to the effects of the severe earthquake in Japan, to promptly file the petition under 37 CFR 1.78(b) or 1.55(c) (but not the petition fee under 37 CFR 1.17(m)) and a copy of this notice. The petition under 37 CFR 1.78(b) or 1.55(c) must be filed by July 1, 2024, in order to be entitled to a waiver of the petition fee under 37 CFR 1.17(m). A petition under 37 CFR 1.78(b) or 1.55(c) due to the effects of the severe earthquake in Japan may be submitted via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent-Related Correspondence—Petitions for Restoration in International Applications

For patent applicants who are filing or have filed an international application on or after January 1, 2024, who meet the requirements for restoration of the right of priority under Patent Cooperation Treaty Rule 26 *bis*.3 to an earlier application, and who missed the 12-month priority period due to the effects of the severe earthquake in Japan, the USPTO will waive the petition fee in 37 CFR 1.17(m) when the patent applicant files a petition under 37 CFR 1.452 to restore the right of priority. Note that the international application must have been filed within two months from the expiration of the 12-month priority period. The inclusion of a copy of this notice with a petition under 37 CFR 1.452 will be treated as a representation that the delay in filing the international application and the need to file the petition was due to the effects of the severe earthquake in Japan and as a request that the Office waive, at its own initiative, the

petition fee under 37 CFR 1.17(m). The USPTO advises any patent applicant who seeks to file a petition under 37 CFR 1.452 with a request to waive the petition fee under 37 CFR 1.17(m) due to the effects of the severe earthquake in Japan, to promptly file the petition under 37 CFR 1.452 (but not the petition fee under 37 CFR 1.17(m)) and a copy of this notice. The petition under 37 CFR 1.452 must be filed by July 1, 2024, in order to be entitled to a waiver of the petition fee under 37 CFR 1.17(m). A petition under 37 CFR 1.452 due to the effects of the severe earthquake in Japan may be submitted via the USPTO patent electronic filing system (Patent Center) using document code PET.RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent-Related Correspondence—Contact Information

Patent-related inquiries concerning this notice may be directed to the Office of Patent Legal Administration at 571-272-7704 (571-272-7703 for reexamination) or PatentPractice@uspto.gov.

Patent Trial and Appeal Board-Related Correspondence

For proceedings before the Patent Trial and Appeal Board (PTAB), a request for an extension of time where the effects of the severe earthquake in Japan have prevented or interfered with a filing before the Board can be made by contacting the PTAB at 571-272-9797 or by email at Trials@uspto.gov (for AIA trials), PTAB_Appeals_Suggestions@uspto.gov (for PTAB appeals), or InterferenceTrialSection@uspto.gov (for interferences).

Trademark-Related Correspondence

For trademark applications and registrations with a correspondence or owner address in the areas of Japan affected by the severe earthquake as of January 1, 2024, in which an Office action (final, non-final, post-registration, or other), a notice of allowance, or other Office notice requiring a response (collectively referred to as “Office communication” in this notice) is outstanding, the USPTO will, upon written request, withdraw the Office communication and reissue it with a new response period. The request must be made prior to the deadline for responding to the Office communication and must indicate that the need for the reissuance of the Office communication is due to the effects of the severe earthquake in Japan. The request should be sent via e-mail to TMPolicy@uspto.gov with “Earthquake Relief” in the subject line and should include the serial number or registration number. Updates to the correspondence information of record must be provided using the Trademark electronic filing system “Change Address or Representation (CAR)” form to ensure receipt of subsequent Office communications.

For trademark applications and registrations with a correspondence or owner address in the areas of Japan affected by the severe earthquake as of January 1, 2024, that were abandoned or canceled due to the inability to timely respond to a trademark-related Office communication due to the effects of the severe earthquake in Japan, the USPTO will refund the petition fee to revive the abandoned application or reinstate the canceled registration. The “Petition to Revive Abandoned Application” form should be used to request the revival of an abandoned application, and the “Petition to Director” form should be used to request the reinstatement of a canceled registration. The petition must include a statement that the failure to respond to the Office communication was due to the effects of the severe earthquake in Japan. The petition fee is

required in order to submit the form, but it will be refunded if a request is sent to TMPolicy@uspto.gov.

Trademark-Related Correspondence—Contact Information

Trademark-related inquiries concerning this notice may be directed to TMPolicy@uspto.gov.

Trademark Trial and Appeal Board- Related Correspondence

For applications or registrations involved in a proceeding before the Trademark Trial and Appeal Board (TTAB), a request (in ex parte appeals) or a motion (for trial cases) may be filed for an extension or reopening of time, or a suspension of proceedings, as appropriate. The request or motion must be filed using the TTAB’s electronic filing system, must indicate that it is being made due to the effects of the severe earthquake in Japan, and must provide any other information available in support of the request or motion.

General Information Regarding Patent-Related and Trademark-Related Statutory Time Periods and Requirements

This notice does not grant waivers or extensions of dates or requirements set by statute. For example, the following patent-related time periods or requirements are not extended or waived: (1) the period set forth in 35 U.S.C. 119(a)-(d) to file a nonprovisional patent application claiming the benefit of a prior-filed foreign application; (2) the period set forth in 35 U.S.C. 119(e) during which a nonprovisional 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; (3) the copendency requirement of 35 U.S.C. 120 between a parent application that issues as a patent and a later filed child application, which requires that the child application be filed prior to the issuance of the parent application; (4) the three-month time period to pay the issue fee set forth in 35 U.S.C. 151; and (5) the 35 U.S.C. 304 two-month time period from the date of patentee service, for a requester to file, in an ex parte reexamination, a reply to a statement filed by the patentee.

The following statutory trademark-related time periods are not extended, and statutory fees are not waived: (1) the 36-month period set forth in 15 U.S.C. 1051(d) within which a statement of use must be filed, and the associated fee(s); (2) the periods set forth in 15 U.S.C 1058 and 1141(k) for filing affidavits of continued use or excusable nonuse, and the associated fee(s); (3) the period set forth in 15 U.S.C. 1059 for filing a renewal, and the associated fee(s); (4) the period set forth in 15 U.S.C. 1063 for filing an extension of time to oppose, which must be filed prior to the expiration of the 30-day period after publication; and (5) the periods set forth in 15 U.S.C 1063 and 1064 for filing an opposition or cancellation proceeding at the TTAB.

Users, Vidal,
Katherine (Kathi)

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Vidal, Katherine (Kathi)
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Katherine K. Vidal

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office