

## **Relief Available to Patentees in View of the COVID-19 Outbreak for Submission of Initial Patent Term Extension Applications Filed Pursuant to 35 U.S.C. 156**

The United States Patent and Trademark Office (USPTO) considers the effects of the COVID-19 outbreak to be an “extraordinary situation” within the meaning of 37 CFR 1.183. In accordance with this notice, the USPTO will permit the filing of initial patent term extension applications pursuant to 35 U.S.C. 156 via the USPTO patent electronic filing systems (EFS-Web or Patent Center).

According to the “Legal Framework for Patent Electronic System” (<https://www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web>), certain documents are prohibited from being filed via the USPTO patent electronic filing systems. See section B2 of the “Legal Framework for Patent Electronic System” for the full list of documents. Item number 4 on the list is “Initial submissions for patent term extension under 35 U.S.C. 156.” Additionally, MPEP 502.05 indicates that “[i]f any of the documents listed [in section B2] is submitted via EFS-Web, the document will not be accorded a date of receipt and it will not be considered officially filed in the USPTO. Furthermore, no benefit will be given to a certificate of transmission under 37 CFR 1.8 on the document.”

Due to the COVID-19 outbreak, the prohibition against filing initial patent term extension applications in accordance with 37 CFR 1.740 or 37 CFR 1.790 via the USPTO patent electronic filing systems is hereby waived until further notice. In addition, for USPTO patent electronic filing system filings only, the requirements in 37 CFR 1.740(b) and 37 CFR 1.790(b) for two additional copies of the initial extension application are waived until further notice.

The following must be provided in order to be entitled to a filing date for an initial patent term extension application filed via the USPTO patent electronic filing systems:

1. An appropriate document description:
  - a. “Patent Term Extension Application Under 35 USC 156” (Doc Code TERM.REQ) must be selected for an initial submission under 35 U.S.C. 156(d)(1) (governed by 37 CFR 1.740), or
  - b. “PTE Interim Patent Extension filed” (Doc Code TERM.REQ.ITM) must be selected for an initial submission under 35 U.S.C. 156(d)(5) (governed by 37 CFR 1.790);
2. An email address in the contact information to facilitate contact with the applicant’s representative; and
3. The applicable fee:
  - a. the fee set forth in 37 CFR 1.20(j) for submission of an initial application for patent term extension under 37 CFR 1.740, or

- b. the fee set forth in 37 CFR 1.20(j) for submission of an initial application for interim patent term extension under 37 CFR 1.790.


Should any of the attachments exceed the system filing limits of the USPTO patent electronic filing systems, such document can be split into smaller files to permit uploading. Any document that is an attachment to the initial application for patent term extension must use the document description "Appendix to the Specification" (Doc Code APPENDIX).

This waiver is effective only until the USPTO provides further notice. Such notice may occur by publication in the Official Gazette or Federal Register or on the USPTO's website. However, the USPTO is continuing its efforts to modify the Patent Center, the new electronic filing and retrieval system, so that patent term extension applications can be filed electronically on a permanent basis.

Thus, in accordance with this notice, applicants may now submit initial patent term extension applications in accordance with 37 CFR 1.740 or 37 CFR 1.790 to the USPTO three ways, via: (1) the USPTO patent electronic filing systems (EFS-Web or Patent Center); (2) the United States Postal Service by Priority Mail Express® under 37 CFR 1.10 (MPEP 513) or with a certificate of mailing under 37 CFR 1.8 (MPEP 512); or (3) by hand-delivery to the Customer Service Window (MPEP 501).

Technical questions about filing patent term extension applications via EFS-Web or Patent Center may be directed to the Patent Electronic Business Center by telephone: 866-217-9197 (toll-free) or 571-272-4100 or by e-mail: [ebc@uspto.gov](mailto:ebc@uspto.gov). Other inquiries regarding patent term extension applications may be directed to Ali Salimi, Senior Legal Advisor, by telephone at 571-272-0909, or Raul Tamayo, Senior Legal Advisor, by telephone at 571-272-7728.

Date:           MAY 29 2020          



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