

Available Relief for Delays in Timely Filing Certified Copies of Foreign Priority Applications Due to the COVID-19 Outbreak

The USPTO recognizes that some foreign intellectual property offices are not currently issuing paper certified copies of foreign applications due to the COVID-19 outbreak. Thus, under the conditions set forth in this notice, the USPTO will suspend the requirement in 37 CFR 1.55(f) and 1.55(g) for filing the certified copy of the foreign application when the foreign application was filed in a foreign intellectual property office that does not participate in a bilateral or multilateral priority document exchange program with the USPTO that would cover the application and thus permit retrieval through the program.

Conditions for Suspension of the Certified Copy Requirement

For applicants who meet the following criteria, the USPTO will suspend the requirement in 37 CFR 1.55(f) and 1.55(g) for filing the certified copy of the foreign application when the foreign application was filed in a foreign intellectual property office that does not participate in a bilateral or multilateral priority document exchange program with the USPTO that would cover the application:

1. Prior to payment of the issue fee, the applicant must have requested a certified copy of the foreign priority application from the foreign intellectual property office, but was unable to file it on or before the date of payment of the issue fee because the foreign intellectual property office was unable to process the request as a result of the COVID-19 outbreak;
2.
 - a. For a utility or plant application under 35 U.S.C. 111(a) filed on or after March 16, 2013, the applicant must have met the timeliness requirement in 37 CFR 1.55(f)(1) by filing an interim copy as provided in 37 CFR 1.55(j);
 - b. For an application under 35 U.S.C. 371 in which the national stage commenced on or after December 18, 2013, the applicant must have met the timeliness requirement in 37 CFR 1.55(f)(2) by filing an interim copy as provided in 37 CFR 1.55(j); or
 - c. For a utility or plant application under 35 U.S.C. 111(a) filed before March 16, 2013, an application under 35 U.S.C. 371 in which the national stage commenced before December 18, 2013, or a design application, the applicant must have filed an interim copy as defined in 37 CFR 1.55(j) no later than payment of the issue fee (i.e., filed a copy of the original foreign application clearly labeled as “Interim Copy” including the specification, and any drawings or claims upon which it is based, in the

Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority)); and

3. The applicant must file a request for suspension of the requirement for submission of the certified copy no later than the date of payment of the issue fee and include the required statement as defined below. The USPTO encourages the use of Form PTO/SB/453 titled “Certification and Request to Suspend the Requirement in 37 CFR 1.55(f) and (g) for Submission of the Certified Copy Due to the COVID-19 Outbreak” to make the request for suspension of the requirement for submission of the certified copy. Form PTO/SB/453 is available at <https://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012>. Form PTO/SB/453 contains the required statement. Use of Form PTO/SB/453 will also enable the USPTO to quickly identify and timely process the request.
4. Relief is not available under this notice if the foreign application was filed in a foreign intellectual property office that participates in a bilateral or multilateral priority document exchange program with the USPTO that covers the application, as in that instance retrieval of the priority document is possible. Information about participating foreign intellectual property offices is provided on the USPTO’s website at <https://www.uspto.gov/patents-getting-started/international-protection/electronic-priority-document-exchange-pdx>.

Request and Required Statement

The request may be submitted via the USPTO patent electronic filing systems (EFS-Web or Patent Center) using the document description “Relief in Emergency Situations Determined by Dir” (Doc Code PET.RELIEF) or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

The request for suspension of the certified copy submission requirement must be accompanied by one of the following statements (“the required statement”):

1. For applicants of utility or plant applications filed on or after March 16, 2013, or for applicants of applications under 35 U.S.C. 371 in which the national stage commenced on or after December 18, 2013, the applicant must state that the applicant submitted an

interim copy as provided in 37 CFR 1.55(j) within the time period set forth in 37 CFR 1.55(f)(1) or (f)(2), and that the applicant requested a certified copy of the foreign priority application from the foreign intellectual property office before payment of the issue fee, but was unable to file it on or before the date of payment of the issue fee because the foreign intellectual property office was unable to process the request as a result of the COVID-19 outbreak; or

2. For applicants of design applications, or for applicants of applications under 35 U.S.C. 371 in which the national stage commenced before December 18, 2013, or for applicants of utility or plant applications filed before March 16, 2013, the applicant must state that the applicant submitted an interim copy as defined in 37 CFR 1.55(j) and that the applicant requested a certified copy of the foreign priority application from the foreign intellectual property office before payment of the issue fee, but was unable to file it on or before the issue fee date of payment because the foreign intellectual property office was unable to process the request as a result of the COVID-19 outbreak.

Certified Copy Must Still Be Submitted

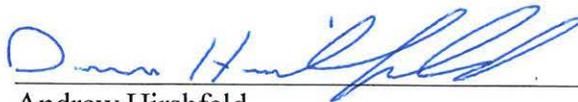
If the USPTO grants a request for suspension of the certified copy submission requirement, then the USPTO will proceed to issue the patent with the foreign priority claim on the front page of the patent. Once the foreign intellectual property office resumes processing requests for paper certified copies, the patentee must: (1) comply with the requirements of the foreign intellectual property office for obtaining a paper certified copy (which may include submitting a new request for a paper certified copy) within two months after the date the foreign intellectual property office resumes processing requests for paper certified copies; and (2) submit the paper certified copy to the USPTO within one month after the date the paper certified copy is issued from the foreign intellectual property office. The burden is on the patentee to ensure that the certified copy is filed within this time period. The submission of the paper certified copy to the USPTO does not need to be accompanied by a petition for delayed submission of a certified copy under 37 CFR 1.55(f) or (g), if the patentee submits the certified copy within the time period identified herein. If the certified copy is submitted after the time period identified herein, then a petition for delayed submission of a certified copy under 37 CFR 1.55(f) or (g) must be filed and must include a showing of good and sufficient cause for the delay.

Contact Information

Inquiries concerning this notice may be directed to the Office of Patent Legal Administration at 571-272-7704 (571-272-7703 for reexamination), or by email to

COVID19PatentsRelief@uspto.gov. Inquiries about priority document exchange programs may be directed to the EBC Customer Support Center at 866-217-9197 or 571-272-4100, or by email to PDX@uspto.gov.

Dated: JAN 29 2021



Andrew Hirshfeld
Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office