

Intellectual Property Offices Worldwide Take Action to Accommodate COVID-19 Impacts

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Client Advisory

April 3, 2020 by John M. Griem, Jr., Danielle C. Sullivan, Rose Auslander and Theodore Y. McDonough

As in other areas, the COVID-19 pandemic has affected the ability of individual inventors, companies and others to meet deadlines to protect and register their intellectual property. Intellectual property offices in the United States and Europe have taken action, and in the United States have received authority to waive statutory deadlines where necessary to account for the effect of the pandemic. Similar steps are being taken by Intellectual Property Offices worldwide, although the specifics vary by country. Below we present the steps already taken in the United States Patent and Trademark Office and the United States Copyright Office, in the World Intellectual Property Organization, and in the European Patent Office.

United States

On March 27, 2020, the President signed the COVID-19 stimulus package, also known as the Coronavirus Aid, Relief and Economic Security ("CARES") Act. The CARES Act granted emergency powers to the Patent and Trademark Office Director and the Register of Copyrights, providing them with "emergency relief authority" for a limited period of time. (Sections 12004 and 19011). During this emergency period, the Director of the USPTO may "toll, waive, adjust or modify, any timing deadline" relating to patents, trademark or copyrights if the Director determines that the COVID-19 emergency has affected the functioning of their Offices or prejudiced the rights of applicants and registrants.

Patent and Trademark Deadlines

On March 31, exercising this newly granted authority, the United States Patent and Trademark Office announced that the deadlines for the most common filings for prosecution and maintenance of patents and trademarks due between (and inclusive of) March 27 to April 30, 2020 will be extended 30 days from the initial date it was due, provided that any filing made during the period of extension is accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak. The USPTO has explained that a delay in filing or payment is "due to the COVID-19 outbreak" if a 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."

Similarly, the Patent Trial and Appeal Board will provide a 30-day extension of time for a request for rehearing of a PTAB motion or judgment, a petition to the chief judge, or a patent owner preliminary response. Additionally, while the 30-day extension does not apply to *ex parte* appeals or trials pending before the Trademark Trial and Appeal Board, a party may file a motion for an extension of time from the TTAB.

Notably, a 30-day extension is not available for original patent filing deadlines, PCT or national stage filing deadlines, deadlines for filing a non-provisional application following a provisional, or the deadline for filing an *inter partes review* (IPR) petition. Nor is an extension available for

most trademark-related deadlines that are set by international treaty such as the Madrid Protocol, although filing priority deadlines can be extended as discussed above.

Note that these new opportunities for extensions of time do not replace or obviate existing provisions for extensions of time, or provisions providing for the revival of unintentionally abandoned applications, patents or registrations within certain periods.

Copyright-Related Deadlines

The Acting Register has determined to exercise her authority under the CARES Act to adjust timing provisions with respect to statutory deadlines pertaining to copyright registration and the service and recordation of notices of termination.

Under section 412 of the Copyright Act, a copyright owner generally may be awarded statutory damages in an infringement action only if the work is registered prior to the infringement or within three months of the work's first publication. In response to the COVID-19 pandemic, the Acting Register is temporarily adjusting the application of the timing provisions of section 412 to persons who are unable to submit a required physical deposit, and to persons who are unable to submit an application electronically or physically. An applicant whose application requires a physical deposit will have 30 days to submit the required physical deposit after the Acting Register declares that the disruption has ended, provided it also submits evidence that the failure to do so was caused by the COVID-19 emergency. Similarly, an applicant who is unable to submit an application electronically or physically during the disruption may submit an application within two months after the Acting Register has announced the end of the disruption.

Notably, for copyright application that can be submitted entirely in electronic form (i.e., those that do not require submission of a physical deposit), the timing provisions are unchanged. And there has been no change in the deadlines, and no new opportunities for extension of time, for provisions requiring the commencement of an action or proceeding in Federal court within a specified period of time, or the provisions relating to the term of a copyright.

World Intellectual Property Organization

WIPO has announced that where communications are disrupted as a result of COVID-19 effects, under Rule 5(1), (2) and (3), users of the Madrid System who have failed to meet a time limit for a communication addressed to WIPO may be excused if they send that communication within five days after regaining access to mail or delivery services or to electronic communication. WIPO must receive the communication no later than six months from the date on which the time limit concerned expired. To take advantage of this new rule, users must provide sufficient evidence of the reason why WIPO should excuse the failure, such as an official announcement or an attestation by a certified physician.

In addition, even without evidence of a COVID 19 related problem, holders or applicants who have failed to meet certain internal time limits may request that WIPO continue processing the international application, subsequent designation, payment or request, if they request continued processing within two months of the missed deadline.

European Patent Office

Rather than providing a process for reviving applications or filing late responses, the European Patent Office has announced overall deadline extensions. Time limits expiring between March 9, 2020 and April 30, 2020 will be extended to May 1, 2020 (in practice, May 4, 2020, since Friday, May 1, 2020, is an official holiday).

The European Patent Office has provided deadline extensions for EPC and PCT proceedings. All time limits (procedural deadlines) expiring on or after March 15, 2020 are extended until April 17, 2020. If the disruption should continue after April 17, 2020, the EPO is expected to publish another notice informing users about further extensions and remedies in respect of time limits. This deadline extension is only for routine official

actions and paying fees, such as renewal fees. The deadline extension does not apply to some circumstances such as the filing of a divisional application.

For those with European Union Trademarks, EUIPO has extended all deadlines falling between March 9, 2020, and April 30, 2020 to May 1, 2020 (in practice, May 4, 2020, since Friday, May 1, 2020, is an official holiday).

Conclusion

As the legal landscape continues to rapidly evolve in the wake of the COVID-19 pandemic, intellectual property owners are encouraged to consult legal counsel to assist in assessing the applicability of the various statutes and regulations if they are unable to meet deadlines because of COVID-19 or government actions to slow its spread. The Carter Ledyard team is monitoring developments in this area and will continue to issue updates as the situation evolves.

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*Carter Ledyard has created a COVID-19 Response Group to monitor the evolving legal landscape, address client questions and ensure client compliance with the laws and regulations issued in response to the COVID-19 pandemic. The Carter Ledyard COVID-19 Response Group consists of **Jeffery S. Boxer** (212-238-8626, boxer@clm.com), **Judith A. Lockhart** (212-238-8603, lockhart@clm.com), **Bryan J. Hall** (212-238-8894, hall@clm.com), **Alexander G. Malyshev** (212-238-8618, malyshev@clm.com), **Melissa J. Erwin** (212-238-8622, erwin@clm.com), and **Leonardo Trivigno** (212-238-8724, trivigno@clm.com). Clients should contact the attorneys listed above or their regular CLM attorney for any questions concerning legal obligations arising from the COVID-19 pandemic.*

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