

COVID-19 and Intellectual Property Law - UPDATED

On Friday, March 27, 2020, the [CARES ACT](#) was signed into law. The Cares Act includes provisions for changing deadlines for patents, trademarks, and copyrights. For patents and trademarks, the Act permits the Under Secretary of Commerce for Intellectual Property and the Director of the United States Patent and Trademark Office to change the deadlines imposed by Title 35 of the United States Code, the Trademark Act, Section 18 of the Leahy-Smith America Invents Act. The Directors can change deadlines in an emergency, if the emergency materially affects the functioning of the Patent and Trademark Office, prejudices the rights of applicants, registrants, patent owners, or others appearing before the Office, or prevents applicants, registrants, patent owners, or others appearing before the Patent and Trademark Office from filing a document or fee. For copyrights, the Act permits the Register of Copyrights to make a change if a national emergency declared by the President generally disrupts or suspends the ordinary functioning of the copyright system. The Director or Register must, within 20 days of the change, submit a statement to Congress describing the action taken, the relevant background, and the rationale for the period of change if the change is in effect for a consecutive or cumulative period exceeding 120 days.

The Director of the United States Patent and Trademark Office has now invoked his authority to delay due dates for [patents](#) and [trademarks](#) within the United States for the present disruption caused by COVID-19.

For patents and trademarks, a due date that falls between and includes March 27th and April 30th will be extended by 30 days from the initial date it was due. To obtain the extension, the filing must be accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak. Although these extensions apply to most USPTO due dates, the extensions *do not* apply to all due dates. For example, replies to an Office notice issued during pre-examination processing is only extended for small or micro entities, but not large entities, while responses to substantive Office Actions are extended for all applicants regardless of size. Of particular importance for patent holders, the deadline for filing a priority application (or any new application claiming a priority benefit to another application) is *not* extended. Conversely, new application filings for trademarks do obtain the benefit of an extension. As a backstop for any due date not extended under the Director's new notice, the previous relief provided by the Office in waiving the petition fee to revive an application when applicants were unable to timely reply to an office communication due to the COVID-19 outbreak is still available.

A delay is due to COVID-19 if the attorney, applicant, patent owner, petitioner, inventor, or other person associated with the filing or fee payment 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 list specifically calls out the interruption of cash flow as a legitimate cause for requesting a delay. This is in stark contrast to the conventional rules in which monetary limitations will not be an excuse for a late filing.

The Register of Copyrights implemented similar provisions to delay due dates for [copyrights](#) within the United States. For new copyright filings, the office has provided a tiered application of modifications depending on how the application can be submitted to the Copyright Office. For applications that can be submitted in electronic form, such as software code, the timing provisions remain unchanged. For applications that require a physical deposit or a physical filing, but an electronic application can be submitted, the applicant must still submit the electronic application and declare that the applicant is unable to submit the physical deposit, setting forth evidence in support of the delay. If the three-month window for registration after the date of first publication was open on March 13, 2020, the window will be extended if the applicant submits the required physical deposit within thirty (30) days after the disruption has ended. For applications in physical form, the filing period is tolled from March 13, 2020 until the date the disruption providing the Register with the authority to modify dates has ended. For example, a work that was first published on February 13, 2020 would have the remainder of the two months from March 13, 2020 to still file a physical copyright application after the disruption has ended.

The Register of Copyrights has also extended the timing requirements for serving and recording notices of termination. If the termination window for serving a termination notice expires on or after March 13, 2022, and within two years after the date the disruption ends, the author has thirty days after the termination of the disruption if the notice is accompanied by a declaration that the delay in service is from the national emergency and provides sufficient evidence. If the author has already served a notice, the requirement that the notice be recorded before the date of termination will be extended if the termination date listed on the notice is on or after March 14, 2020, and on or before the date the disruption terminates to thirty days after the date the disruption has ended and the recordation includes a declaration the author's delay in recording was caused by the national emergency and includes sufficient evidence.

Satisfactory evidence supporting a declaration of an applicant that a deposit was not able to be made may include a statement that the applicant is subject to a stay-at-home order, or a failure to access required physical materials because of a business closure. Satisfactory evidence that an applicant was unable to submit an application electronically or physically may include a statement that the applicant did not have access to a computer or the internet.

Other Patent and Trademark Offices around the world are similarly evaluating how best to address these issues. Below is a summary of what some foreign patent office are currently doing:

- Japan – The [Japanese Patent Office](#) (JPO) has not implemented any extension provisions.
- Korea – The [Korean Intellectual Property Office](#) (KIPO) has extended due dates between March 31st and April 29th to April 30th. However, statutory periods in the Patent Act, Trademark Act, Design Act, are not within the automatic extension provided by KIPO.
- China – The Chinese National Intellectual Property Administration (CNIPA) has waived late fees for missed patent annuity payments if the delay was related to COVID-19.

- Europe – The [European Patent Office](#) (EPO) has extended all deadlines fall on or after March 15th to be due on April 17th. The EPO has excluded the deadline for filing a divisional and other procedural acts from this exemption however.
- Europe – The [European Union Intellectual Property Office](#) (EUIPO) has extended its deadlines between March 9th and April 30th until May 1st.
- Canada – The [Canadian Intellectual Property Office](#) (CIPO) has extended all deadlines falling between March 16th and April 30th to May 1st. CIPO is also not processing any requests to fill document orders until service resumes.
- India – The [Office of Controller General of Patents, Designs and Trademarks](#) (CGPDTM) has extended all due dates from March 25th to April 15th.
- Australia – The [Australian Patent Office](#) (APO) is allowing requests for extensions of time and waiver of extension fees on a case by case basis.
- Africa – The [African Regional Intellectual Property Organization](#) (ARIPO) will consider extensions of time and other relief on a case by case basis.
- The [World Intellectual Property Organization](#) (WIPO) is continuing operations without implementing any extension provisions.

Buchalter has a full team of attorneys working remotely that can handle any patent, trademark, and copyright action during this time of crisis and cover any actions that need immediate attention.

If we can be of assistance and to discuss various options and specific situations, please feel free to contact any of the Buchalter Intellectual Property Attorneys below.

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