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COVID-19 Emergency Relief Measures Relating to Intellectual Property Rights

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As individuals and businesses grapple with the wide-spread impact of the coronavirus pandemic, the U.S. Patent and Trademark Office and the U.S. Congress have taken certain emergency relief measures to address the effect of the coronavirus outbreak on intellectual property rights.

USPTO WAIVES FEES FOR CERTAIN PETITIONS TO REVIVE

On March 16, 2020, the United States Patent and Trademark Office (“USPTO”) announced that it considers the coronavirus outbreak to be an “extraordinary situation” and, accordingly, that it will waive certain fees for patent and trademark applicants and owners and reexamination parties who have been impacted by the coronavirus.

With regard to patents, the USPTO announced that it will waive the petition fee for revival of abandoned applications or terminated/limited reexamination prosecution. The fee waiver applies to applications which were held abandoned or to reexamination prosecutions which were terminated/limited as a result of the patent applicant’s or patent owner’s inability to timely reply to a USPTO communication due to the effects of the Coronavirus outbreak.

Similarly, with regard to trademarks, the USPTO will waive the petition fee to revive abandoned trademark applications or reinstate canceled/expired trademark registrations that were abandoned or canceled/expired due to inability to timely respond to a trademark-related USPTO communication as a result of the effects of the Coronavirus outbreak.

In order to qualify for the fee waiver, the USPTO requires the petition for revival to include a statement explaining how the failure to respond to the USPTO communication was due to the effects of the Coronavirus outbreak. The petition to revive must also be filed within two months of the issue date of the notice of abandonment or the notification that reexamination prosecution has been terminated for patents and patent applications or within two months of the issue date of the notice of abandonment or cancellation for trademark applications and registrations. If no notice is issued by the USPTO, then the petition for revival must be filed within six months after the date that the patent/trademark application becomes abandoned, trademark registration is canceled, or patent reexamination prosecution is terminated or limited.

Because the USPTO did not have authority to waive or modify certain statutory requirements at the time the March 16th notice was issued, the notice made clear that the USPTO was not granting waivers or extensions of dates or requirements set by statute and that statutory time periods for patent- and trademark-related events could not be extended by petition.

CARES ACT GRANTS EMERGENCY POWERS TO THE USPTO DIRECTOR AND THE REGISTER OF COPYRIGHTS

On March 27, 2020, the unprecedented \$2.2 trillion Coronavirus Aid, Relief, and Economic Security Act (“CARES Act”) was signed into law. Among various other provisions intended to provide relief and stimulus to the United States amidst the coronavirus crisis, the CARES Act grants the Director of the USPTO and the Register of Copyrights discretionary emergency authority to modify statutory deadlines during the coronavirus emergency.

In particular, the CARES Act authorizes Director of the USPTO to toll, waive, adjust, or modify any timing deadline established by the patent and trademark acts and the regulations promulgated thereunder. The Director’s emergency powers are effective throughout the duration of the emergency declared by President Trump pursuant to the National Emergencies Act and for an additional 60-day period following the termination of the emergency declaration. The Director may exercise these emergency powers if the Director determines that the coronavirus emergency (1) materially affects the functioning of the USPTO, (2) prejudices the rights of applicants, registrants, patent owners, or others appearing before the USPTO, or (3) prevents applicants, registrants, patent owners, or others appearing before the USPTO from filing a document or fee with the USPTO. The Director must provide public notice if the Director determines that tolling, waiving, adjusting, or modifying a timing deadline is appropriate.

As of the date of publication of this article, the Director of the USPTO has not given any indication the USPTO will exercise its emergency powers under the CARES Act. However, given that the USPTO has already declared the coronavirus outbreak an “extraordinary situation” in order to provide some relief to parties interacting with the USPTO, it is plausible that the USPTO will exercise its emergency powers under the CARES Act to extend some statutory deadlines to provide further relief to applicants, patentees, trademark owners, and others practicing before the USPTO.

The CARES Act also grants the Register of Copyrights the discretion to toll, waive, adjust, or modify any timing provision or procedural provision contained in the copyright law and the accompanying regulations if the Register of Copyrights determines that a national emergency declared by the President under the National Emergencies Act generally disrupts or suspends the ordinary functioning of the copyright system. The Register of Copyrights may make such determination anytime on or before December 31, 2021. The tolling, waiver, adjustment or modification of any deadline or requirement may only extend for a period of time reasonably determined by the Register to be appropriate to mitigate the impact of the disruption caused by the national emergency. The Register’s emergency powers generally do not extend to provisions requiring the commencement of an action or proceeding in Federal court within a specified time period. The emergency powers also generally do not allow the Register to extend the duration of a copyright. As of the date of

publication of this article, the Register of Copyrights has not given any indication whether the Copyright Office will exercise its emergency powers under the CARES Act.

For additional information about the relief measures outlined in this article and further coronavirus developments relating to intellectual property rights, please contact Michael Golenson.