



News & Types: Client Advisories

USPTO and Copyright Office Exercise Emergency Powers Granted by CARES Act to Provide Further Relief During COVID-19 Crisis

4/8/2020

By: Michael S. Golenson

Practices: Intellectual Property & Technology

The unprecedented \$2.2 trillion Coronavirus Aid, Relief, and Economic Security Act (“CARES Act”), which was enacted on March 27, 2020, includes Section provisions which grant the Director of the United States Patent and Trademark Office (“USPTO”) and the Register of Copyrights discretionary emergency authority to modify statutory deadlines during the coronavirus emergency.[1] Last week, both the Director of the USPTO and the Register of Copyrights announced that they were invoking their emergency authority provided by the CARES Act to extend certain deadlines and modify other requirements to provide additional relief for those affected by the ongoing coronavirus emergency.

PATENTS AND TRADEMARKS

In accordance with Section 12004 of the CARES Act, the Director of the USPTO has determined that the coronavirus emergency has prejudiced the rights of applicants, patent and trademark owners, or others appearing before the USPTO in patent and trademark related matters and has prevented those persons from filing a document or fee with the USPTO. The Director specifically noted that the spread of the virus has significantly disrupted operations of numerous businesses, law firms, and inventors, and that small businesses and independent inventors may face particular difficulties. Accordingly, the Director has invoked his emergency authority under the CARES Act to extend certain patent- and trademark-related deadlines for persons who are unable to meet the original deadline due to the COVID-19 outbreak.

Specifically, with regard to patents, the USPTO is granting an automatic 30-day extension for certain filings whose initial due dates are between March 27, 2020 and April 30, 2020, if the delay in filing is due to the COVID-19 outbreak. The filings which are extended by 30 days include:

- i. reply to an Office notice issued during pre-examination processing;
- ii. reply to an Office notice or action issued during examination or patent publication processing;
- iii. issue fee;

- iv. notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 41.31;
- v. appeal brief under 37 C.F.R. § 41.37;
- vi. reply brief under 37 C.F.R. § 41.41;
- vii. appeal forwarding fee under 37 C.F.R. § 41.45;
- viii. request for an oral hearing before the Patent Trial and Appeal Board (PTAB) under 37 C.F.R. § 41.47;
- ix. response to a substitute examiner's answer under 37 C.F.R. § 41.50(a)(2);
- x. amendment when reopening prosecution in response to, or request for rehearing of, a PTAB decision designated as including a new ground of rejection under 37 C.F.R. § 41.50(b);
- xi. maintenance fee;
- xii. request for rehearing of a PTAB decision under 37 C.F.R. § 41.52.

Notably, for items (i) and (xi) above, the extension only applies to small and micro entities. Persons who do not qualify for small or micro entity status must still comply within the initial deadline for these filings.

The USPTO is also providing a 30-day extension for the following patent-related filings at the PTAB which have initial due dates between March 27, 2020 and April 30, 2020, *upon request*, if the requestor affirms that filing within the original deadline was or may be delayed due to the COVID-19 outbreak:

- i. a request for rehearing of a PTAB decision under 37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d);
- ii. a petition to the Chief Judge under 37 C.F.R. § 41.3;
- iii. a patent owner preliminary response in a trial proceeding under 37 C.F.R. §§ 42.107 or 42.207, or any related responsive filing.

With regard to trademarks, the USPTO is granting an automatic 30-day extension for the following types of filings, if the initial due dates for the filings are between March 27, 2020 and April 30, 2020, and if the delay in filing is due to the COVID-19 outbreak:

- i. response to an Office action, including a notice of appeal from a final refusal, under 15 U.S.C. § 1062(b) and 37 C.F.R. §§ 2.62(a) and 2.141(a);
- ii. statement of use or request for extension of time to file a statement of use under 15 U.S.C. § 1051(d) and 37 C.F.R. §§ 2.88(a) and 2.89(a);
- iii. notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and 37 C.F.R. §§ 2.101(c) and 2.102(a);
- iv. priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. § 2.34(a)(4)(i);
- v. priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. § 7.27(c);
- vi. transformation of an extension of protection to the United States into a U.S. application under 15 U.S.C. § 1141j(c) and 37 C.F.R. § 7.31(a);

- vii. affidavit of use or excusable nonuse under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
- viii. renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or
- ix. affidavit of use or excusable nonuse under 15 U.S.C. § 1141k(a) and 37 C.F.R. § 7.36(b).

As a catch-all for all other filings before the PTAB and the Trademark Trial and Appeal Board (TTAB) not specifically covered by the USPTO notices, the USPTO will consider individual requests for extension or reopening of time in situations where the COVID-19 outbreak has prevented or interfered with the filing.

All filings identified by the USPTO which are subject to the 30-day extension must be accompanied by a statement that the delay in filing was due to the COVID-19 outbreak. A delay in filing will be considered by the USPTO to be due to the COVID-19 outbreak if a practitioner, applicant, patent owner, petitioner, third party requester, inventor, trademark registrant, or other person associated with the filing 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.

The official USPTO patent-related notice is available [here](#). The official USPTO trademark-related notice is available [here](#).

COPYRIGHTS

In accordance with 17 U.S.C. § 710 (which was added to the Copyright Act by Section 19011 of the CARES Act), the Register of Copyrights has determined that the coronavirus emergency has generally disrupted the ordinary functioning of the copyright system with respect to the ability of certain persons to comply with statutory deadlines pertaining to copyright registration and the service and recordation of notices of termination. Accordingly, the Register of Copyrights has invoked her authority under Section 710 to adjust certain timing provisions in specific cases where compliance is not possible due to the coronavirus emergency.

With regard to copyright registrations, the Register has modified certain requirements to provide relief to copyright applicants in limited circumstances. Section 412 of the Copyright Act generally allows for a copyright owner to be eligible to be awarded statutory damages in an infringement action so long as the work is registered prior to the infringement or within three months of the work's first publication.

The Register has recognized that the COVID-19 emergency may prevent some copyright owners of published works from being able to complete and submit copyright applications in a timely manner due to a lack of access to physical documents or the inability to deliver materials to a mail carrier. Accordingly, for applicants who are seeking to register their works within three months of the work's first publication in accordance with Section 412, the Register has modified the timing provision for such applications as follows:

- i. **No extension for copyright applications that can be submitted entirely in electronic form:** The timing provisions of Section 412 remain unchanged for applicants that can be filed entirely in electronic form.

- ii. **Extension to submit required physical deposit for applicants who can submit a copyright application electronically, but are unable to submit a required physical deposit:** In these instances, applicants should still submit the application electronically within the original timing provision of Section 412. In the electronic application, the applicant must include a declaration or similar statement certifying, under penalty of perjury, that the applicant is unable to submit the physical deposit and would have done so but for the national COVID-19 emergency. The declaration must set forth satisfactory evidence, such as a statement that the applicant is subject to the stay-at-home order issued by a state/local government or that the applicant is unable to access required physical materials due to closure of the business where they are located. If these requirements are met, and the three-month window for registration of the work after its first publication was open as of March 13, 2020, then the window for eligibility of statutory remedies under Section 412 will be extended provided that the applicant submits the required deposit within thirty days after the Register issues a public announcement that the disruption to the copyright system has ended.

- iii. **Tolling of three-month window for applicants who are unable to submit an application electronically or physically during the disruption:** If an application cannot be submitted electronically or physically during the disruption, the three-month window to register a work from the date of its first publication under Section 412 will be tolled between March 13, 2020 and the date that the disruption ends. For example, if only one month of the three-month window for registration had passed as of the March 13, 2020 tolling start date, then the applicant would have two months remaining from the end of the disruption to submit an application in order to be eligible for the remedies provided under Section 412. In order to qualify for this extension, the application must include a declaration or similar statement certifying, under penalty of perjury, that the applicant was unable to submit an application electronically or physically and would have done so but for the national COVID-19 emergency. The declaration must set forth satisfactory evidence, such as a statement that the applicant did not have access to a computer and/or the internet, or that the applicant was prevented from accessing or sending required physical materials due to a stay-at-home order or was otherwise unable to access required physical materials due to closure of the business where they are located.

The Register has also modified certain timing requirements to provide relief for certain individual authors who seek to reclaim copyright interests previously transferred to another party under 17 U.S.C. §§ 203 and 304(c). In general, under Sections 203 and 304(c), in order to reclaim the interests, the individual author must terminate the prior transfer within a specified five-year window and the author must serve notice of the termination on the transferee within a period between two and ten years prior to the chosen date of termination. The termination notice must also be recorded with the Copyright Office before the date of termination.

The Register has recognized that the COVID-19 emergency may affect an author's ability to serve notices of termination within the statutorily required time period and to submit the notices to the Copyright Office for recordation within the time period set forth by the Copyright Office. Accordingly, for individual authors who seek

to reclaim copyright interests under Sections 203 and 304(c), the Register has modified the timing provisions for serving and recording notices of termination as follows:

- i. **Extension of five-year window for service of a notice of termination.** An individual author's five-year window to serve a notice of termination will be extended during the period of disruption if the following conditions are met:
 1. The author's five-year termination window expires on or after March 13, 2022, and less than two years after the date the disruption ends;
 2. The author serves the notice of termination within thirty days after the end of the disruption period; and
 3. The notice of termination is accompanied by a declaration or similar statement certifying, under penalty of perjury, that but for the COVID-19 emergency, the author would have been able to serve the notice within the five-year window and setting forth an explanatory statement in support of that certification. The statement must also be included with the materials sent to the Copyright Office for recordation.

- ii. **Extension of time period to record notice of termination at the Copyright Office.** An author's requirement to record a notice of termination before the date of termination will be waived if the following conditions are met:
 1. The author has already served the notice on the transferee;
 2. The termination date listed on the notice is on or after March 14, 2020, and on or before the end of the disruption period;
 3. The author records the notice within thirty days after the date the disruption has ended; and
 4. The recordation submission includes a declaration or similar statement certifying, under penalty of perjury, that the author would have submitted the notice in a timely manner but for the COVID-19 emergency, and setting forth satisfactory evidence in support of that statement. Satisfactory evidence could include a statement that the author was prevented from accessing or mailing the required physical materials or other statements similar to the statements mentioned above with regard to registration applications.

For copyright applications and transfer terminations that fall within the COVID-19 relief measures discussed above, the Copyright Office will annotate the registration and public records appropriately.

The COVID-19 relief measures will be in effect for a period of sixty days (i.e., through May 30, 2020), unless the Register issues an announcement shortening or extending the period.

The official notice from the Copyright Office is available [here](#).

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

[1] For additional information about the emergency authority granted to the Director of the USPTO and the Register of Copyrights under the CARES Act, please refer to Masuda Funai's article titled "COVID-19 Emergency Relief Measures Relating to Intellectual Property Rights", which was published on March 31, 2020, and can be accessed [here](#).