IP Alert | USPTO and Copyright Office Respond to COVID-19

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UPDATE: Since this article's publication, the USPTO has further extended deadlines pursuant to its authority under the CARES Act. The extensions discussed below have been adjusted so that deadlines falling between March 27 and May 31, 2020 have been extended to June 1, 2020. Please see the links below for the USPTO's press release regarding the updated extension, as well as the updated Trademark and Patent notices:

USPTO extends certain patent and trademark deadlines to June 1
Updated Trademark Notice
Updated Patent Notice

ORIGINAL POST:

The Coronavirus Aid, Relief, and Economic Security (CARES) Act was signed into law on March 27, 2020. The Act provides relief measures to individuals and businesses impacted by the COVID-19 pandemic, including through a series of loans and debt relief programs, among numerous other provisions. One such provision, in Section 12004 of the Act, provides temporary authority to the Director of the USPTO during the COVID-19 crisis to extend deadlines and take other actions to assist applicants and registrants. Section 19011 of the Act provides a similar temporary authority to the Register of Copyrights.

Below, we highlight the recent changes made by the USPTO and the Copyright Office using the temporary powers granted by the CARES Act.

U.S. Patent and Trademark Office

On March 31, the USPTO used its temporary authority under the CARES Act to announce extensions of time for certain patent and trademark fees and filings.

Patents

The USPTO has extended due dates for the below patent-related items, such that any deadlines between (and inclusive of) March 27, 2020 and April 30, 2020 are extended 30 days from the initial due date, provided the filing or payment is accompanied by a statement that the delay in filing or payment was due to the COVID-19 pandemic.

For the delay to be "due to the COVID-19 pandemic," the delay must be because the practitioner, applicant, patent owner, petitioner, third-party requester, inventor, or other party associated with the filing was personally affected by the outbreak. Parties may be personally affected by the outbreak due to office closures, cash flow interruptions, inability to access files or other necessary materials, travel delays, personal or family illness, or similar circumstances.

The affected filings and fees are:

1. Reply to an Office notice issued during pre-examination processing by a small or micro entity;
2. Reply to an Office notice or action issued during examination or patent publication processing;
3. Issue fee;
4. Notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 41.31;
5. Appeal brief under 37 C.F.R. § 41.37;
6. Reply brief under 37 C.F.R. § 41.41;
7. Appeal forwarding fee under 37 C.F.R. § 41.45;
8. Request for an oral hearing before the Patent Trial and Appeal Board (PTAB) under 37 C.F.R. § 41.47;
9. Response to a substitute examiner's answer under 37 C.F.R. § 41.50(a)(2);
10. 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);
11. Maintenance fee, filed by a small or micro entity;
12. Request for rehearing of a PTAB decision under 37 C.F.R. § 41.52
13. A request for rehearing of a PTAB decision under 37 C.F.R. §§ 41.125(c), 41.127(d), or 42.71(d);
14. A petition to the Chief Judge under 37 C.F.R. § 41.3; or
15. A patent owner preliminary response in a trial proceeding under 37 C.F.R. §§ 42.107 or 42.207, or any related responsive filings.

Trademarks

The USPTO has similarly extended due dates for the trademark-related filings outlined below. As with patents, any deadlines between (and inclusive of) March 27, 2020 and April 30, 2020 are extended 30 days from the initial due date, provided the filing or payment is accompanied by a statement that the delay in filing or payment was due to the COVID-19 pandemic.

For the delay to be "due to the COVID-19 pandemic," the delay must be because the practitioner, applicant, registrant, or other party associated with the filing was personally affected by the outbreak. Parties may be personally affected by the outbreak due to office closures, cash flow interruptions, inability to access files or other necessary materials, travel delays, personal or family illness, or similar circumstances.

The affected filings and fees are:

1. 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);
2. 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);
3. Notice of opposition or request for extension of time to file a notice of opposition under 15 U.S.C. § 1063(a) and C.F.R. §§ 2.101(c) and 2.102(a);
4. Priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. § 2.34(a)(4)(i);
5. Priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. § 7.27(c);
6. Transformation of an extension of protection to the United States into a U.S. application under the 15 U.S.C. § 1141j(c) and C.F.R. § 7.31(a);
7. Affidavit of use or excusable nonuse under 15 U.S.C. § 1058(a) and 37 C.F.R. § 2.160(a);
8. Renewal application under 15 U.S.C. § 1059(a) and 37 C.F.R. § 2.182; or
9. Affidavit of use or excusable nonuse under 15 U.S.C. § 1141k(a) and 37 C.F.R. § 7.36(b)

Filings with the Trademark Trial and Appeal Board (TTAB) are not covered by the deadline waiver, but parties can request extensions of time as needed.

The existing procedures for reviving an abandoned patent or trademark applications or reinstating a canceled or expired registration remain in place. Per the USPTO's March 16 "Relief Available to Patent and Trademark Applicants, Patentees and Trademark Owners" notice, fees for petitions to revive or to reinstate are waived if the cancelation or abandonment was related to COVID-19 (but note that trademark petitions to revive must be filed within two months of the issue date of the notice of abandonment or cancelation, and patent petitions must be filed within six months of the abandonment date to be entitled to the fee waiver).

More information can be found on the USPTO website, which has a separate page containing all USPTO notices regarding COVID-19.

Copyright Office

On its COVID-19 Operations Updates page, the Copyright Office has announced several changes to its operations and procedures in light of the COVID-19 pandemic, including a number of timing and deadline changes related to the temporary authority granted under the CARES Act. These changes are shown below, and are generally in effect until May 12, 2020 (note this is slightly longer than the USPTO extensions, which are currently slated to end on April 30), unless the Acting Register issues a statement shortening or lengthening the time.

Timing Requirements for § 412 Statutory Remedies

Pursuant to the Copyright Act § 412, a copyright owner can generally only be awarded certain statutory damages in an infringement action if the work is registered before the infringement or within three months of first publication of the work. The effective date of registration for this purpose is the date the Copyright office receives the application, deposit, and filing fee.

Due to the national emergency, the timelines to obtain these statutory damages have been changed as follows:

- If the applicant can submit the application and deposits electronically – no changes.
- If the applicant can submit the application electronically but cannot submit the physical deposit – the applicant must include a declaration or similar statement with the application stating under penalty of perjury that the applicant is unable to submit the physical deposit due to the national emergency, including factual evidence such as a statement that the applicant is subject to a stay-at-home order in their state or was unable to access the required physical materials due to closure of the business where the materials are located.
- If the applicant cannot submit the application electronically or physically during the crisis – the applicant may submit an application "after the Acting Register has announced the end of the disruption," including a declaration certifying under penalty of perjury that the applicant was unable to submit an application electronically or physically due to the national emergency, along with factual evidence to support this statement. If the declaration is sufficient, the three-month filing window under Section 412 will be tolled between March 13, 2020, and the date of the "end of the disruption." The Copyright Office will then annotate the registration record to reflect that the applicant was affected by the national emergency.

Timing Requirements for Copyright Termination

Pursuant to the Copyright Act §§ 203 and 304(c), individual authors may reclaim previously transferred copyright interests, generally, within a statutory five-year window (determined by the specific circumstances of the transfer, but usually around 35 years from the date of the original transfer) provided the author gives notice to the transferee between two and 10 years before the author's chosen termination date. After service, this notice must be recorded with the Copyright Office before the date of termination.

Due to the national emergency, the timelines to provide and record the copyright termination notice have been changed as follows:

- If the five-year notice of termination window is expiring**:** the notice will still be considered timely if:
  - the statutory five-year window ends on or after March 13, 2022, and less than two years after the date the disruption ends;
  - the author serves notice on the transferee within 30 days after the Acting Register announces the end of the "disruption period"; and
  - the notice of termination is accompanied by a declaration certifying, under penalty of perjury, that the author was unable to serve the notice at least two years before the close of the five-year window.

Note, although the statutory notice would still be considered timely if the above provisions are met, the author would still have to choose a termination date at least two years after the date of notice.

- If the window to record is expiring**:** the requirement that a notice be recorded before the date of termination will be waived if
  - the author has already served the notice on the transferee;
  - the termination date listed on the notice is on or after March 14, 2020, and on or before the date the Acting Register announces as the date the disruption has ended;
  - the author records the notice within thirty days after the date the disruption has ended; and
  - the recordation submission includes a declaration or similar statement certifying, under penalty of perjury, that the author was unable to record the notice due to the COVID-19 crisis, and setting forth satisfactory evidence in support of that statement.

Timing Requirements for § 115 Compulsory Music Licenses

Under § 115 of the Copyright Act, a compulsory license to make and distribute recordings of a musical work is currently available under certain conditions, including service of a notice of intention (NOI) upon the copyright owner and delivering a monthly statement of account (SOA) and royalty payment to that owner.

Due to the national emergency, digital music providers and other entities engaged in the compulsory music license scheme may have difficulty submitting NOIs and SOAs within the required time. The copyright office has made a number of adjustments to the timing of various administrative requirements under § 115, which can be found in detail in the "Public Notice Regarding Timing Provisions for Persons Affected by COVID-19" section of the Copyright Office's COVID-19 Operations Updates page.

Note that, unrelated to the COVID-19 crisis, many Copyright Office fees increased on March 20, 2020. The current fee schedule can be found on the Copyright Office website.

What Actions Should Intellectual Property Owners Take?

If possible, the best practice is to strive to meet existing patent, trademark, and copyright deadlines. However, there are many situations where that may not be realistic or possible.

Because the COVID-19 crisis is ongoing and circumstances are continuously changing for intellectual property owners as well as the federal government – including the USPTO and the Copyright Office, it is a good idea to regard the foregoing information as advisory only, and to determine on a case-by-case basis whether the exact details of your particular situation and relevant deadlines are impacted by the latest updates to the procedures and regulations of each office.

We recommend checking the USPTO notices regarding COVID-19 and the Copyright Office's COVID-19 Operations Updates page to confirm whether there have been further developments before taking any actions. Note also that both the USPTO and the Copyright Office have provided a number of email contacts on their respective COVID-19 web pages that intellectual property owners can use to reach out with specific questions as needed.

Click here to view a PDF of the article.

For more information about the content in this alert or if you have questions about the business and legal implications of the COVID-19 situation, please contact a Banner Witcoff attorney.

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