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Tuesday, April 21, 2020

Regarding: Resources for IP Lawyers During Covid-19

Introduction

This notice seeks to provide practitioners with an overview of notices and guidance issued by the US Patent and Trademark Office (USPTO) and the US Copyright Office along with links to issued guidance and communications.

We encourage practitioners to review the issued communications in detail and to be aware that this is a fluid situation and guidance can change quickly.

The USPTO: Trademarks and Patents

Trademarks

With the onset of the COVID-19 pandemic, Congress passed the Coronavirus Aid, Relief, and Economic Security (CARES) Act, in which Section 12004 gives the USPTO power to take steps where the pandemic materially affects the functioning of the USPTO; prejudices the rights of applicants, registrants, patent owners, and others appearing before the USPTO; and prevents applicants, registrants, patent owners, and others appearing before the USPTO from filing a document or fee. The USPTO has issued some guidance here.

The guidance primarily addresses payment and filing deadlines between the dates of March 27 and April 30. FAQs are available for trademark-related questions here.

The notice provides guidance for individuals who may be eligible for relief from certain filing deadlines. While the USPTO remains fully functional and open for business, the notice states that filing deadlines occurring between and inclusive of March 27 and April 30 for items listed below are extended 30 days from the original due date if the filings are “accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak” as further defined in the notice.

For trademark matters, the extension applies to due dates for any:

1. Response to trademark office actions, including a notice of appeal from a final refusal
2. Declarations of use and requests for extension of time to file declarations of use
3. Notice of opposition or request for extension of time to file notices of opposition
4. Priority filings made based on an earlier filed foreign application under Section 44(d)
5. Priority filing basis for a filing under the Madrid Protocol
6. Transformation of an extension of protection to the United States into a US application
7. Affidavits of use or excusable nonuse
8. Renewal applications

For all other situations where COVID-19 interfered or prevented a filing, such as certain filings before the Trademark Trial and Appeal Board, a request (ex parte) or motion (trial cases) for extension or reopening can be made.

COVID-19 material interference includes office closures, cash flow interruptions, inaccessibility to files or other materials, travel delays, personal or family illness, and similar circumstances.

Further, with respect to the publication period for applications, the notice has the consequence of potentially extending the time for opposition, which, in turn, will result in a delay in issuing registration rights for affected filings.

Perhaps the most perilous component of the notice is the requirement that individuals electing to utilize the deadline extension for one of the aforementioned filings must provide a written statement stating that the delay in filing or payment was “due to the COVID-19 outbreak”—a qualification which is, at best, vague.

You will need to provide the written statement explaining how and why you were affected by the COVID-19 outbreak when you make the filing. This means individuals acting under the notice will provide their explanation for relief after the deadline expires. It remains unknown how critical the USPTO will be in reviewing these statements. Likewise, it is undetermined if the USPTO will reject some or any statements filed based in reliance on the notice, which could jeopardize rights of individuals acting in reliance on the notice.

Parties that are affected by COVID-19 should be careful in choosing to exercise extension rights granted via the notice. Not until long after the COVID-19 pandemic passes will we start to see how the USPTO interprets the notice in the first place.

Patents

Most of the USPTO announcements and information set forth above for temporary extensions and waivers for trademarks apply with equal force to patents. However, the USPTO has a dedicated set of FAQs and other information specific to patents. Most of the extensions (typically 30 days) or waivers apply if an eligible document or fee was or is due between March 27 and April 30, but a review of the USPTO website is important to verify that the waivers and extensions apply to your situation.

As of March 16, the USPTO remains closed to the public. It considers the effects of COVID-19 as constituting an “extraordinary situation” within the meaning of 37 C.F.R. Part 1.183 and is waiving the handwritten signature requirement for certain correspondence, petitions, and payments. In addition, examiner interviews, oral hearings, and other in-person meetings scheduled after March 13 will be conducted remotely, but video or telephone (e.g., mail to: ExaminerInterviewPractice@uspto.gov).

The FAQs section of the USPTO website is a must read for patent practitioners. Topics include:

- How to avail yourself of the 30-day extension
- Must the extension request have resulted from the COVID-19?
- Does the extension apply to appeals?
- Do the extensions apply only to small or micro entities?
- What filings are not eligible for extensions?
- Which USPTO offices are still open for filing?
- Will these waivers and extensions be extended beyond April 30?

Copyrights and the Copyright Office

The CARES Act has added Section 710 to the Copyright Act, which permits the register to temporarily “toll, waive, adjust, or modify any timing provision ... or procedural provision” if the national emergency “disrupts or suspends the ordinary functioning of the copyright system ... or any component thereof.” The Copyright Office has amended certain timing provisions, application filing requirements, and physical services that have been impacted by COVID-19. These changes are intended to enable copyright applicants and owners to adequately exercise their rights under the Copyright Act while allowing Copyright Office staff to perform tasks remotely. The new measures are summarized below, with more details available on the Copyright Office website.

Increasing Availability of Electronic Services

The Copyright Office issued a final rule to broaden its acceptance of electronic submissions during the COVID-19 pandemic for certain materials previously requiring physical deliveries. A partial list of materials that, as of April 8, may be submitted electronically is set forth below:

- Notices of termination for recordation
- Requests for removal of personally identifiable information from the online public catalog or other public records
- Cancellation of completed registrations
- Filing a notice of intent to enforce a restored copyright
- Filing a notice to libraries and archives of normal commercial exploitation or availability at reasonable price
- Group registration of automated databases
- Requests for reconsideration for refusals to register
- Supplementary registrations for restored works, non-photographic databases, and renewal registrations
- Registration of restored copyrights
- Requests for full-term retention of copyright deposits.

A list of the current physical and electronic submission options for these services, and others, are available on the Copyright Office website along with a full list of affected submissions.

Changes to Physical Deposit Requirements

Because the Copyright Office has permitted telework for its staff and closed the Library of Congress to the public, the office has temporarily modified the deposit copy requirements for certain registration applications submitted electronically. For applications submitted electronically with a mailed physical deposit copy of the work before April 2, the Copyright Office may contact applicants and give them the option to provide an electronic copy of the deposit copy along with a declaration stating that the electronic copy of the deposit material is identical to the one submitted to the Copyright Office by mail.

For those applications submitted electronically on or after April 2 that require a “best edition” physical copy of deposit, “the applicant will have the option of uploading an electronic copy of the work in addition to mailing the required physical copies” along with a declaration stating that the mailed copy is identical to the electronic copy. Further requirements on utilizing these changes are described in more detail on the Copyright Office website in the “Temporary Relief For Claims with Physical Deposits” section.

Changes to Special Handling Procedures for Expedited Applications

To aid those who would like to register their works on an expedited basis, the Copyright Office has also modified its special handling procedures. These changes are detailed in the “Registration Special Handling” section on the Copyright Office website. Most notably, for electronic applications that require physical deposits, an applicant will be permitted to submit a digital copy of the same work through the eCO system in addition to a physical deposit copy. The electronic upload must be accompanied by a declaration or similar statement certifying, under penalty of perjury, that the content of the digital deposit is identical to the physical deposit that has been sent to the Copyright Office.

Amendments to Timing Requirements

Section 412 Statutory Remedies

Under Section 412 of the Copyright Act, a copyright owner is only generally eligible for statutory damages in an infringement action if the owner’s work is registered before the infringement commences or within three months of the work’s first publication. The effective date of registration is the date when the Copyright Office receives the owner’s application, deposit, and fee. During the COVID-19 crisis, applicants who are unable to submit required physical deposit copies with their electronic applications and applicants that are unable to submit an application electronically or physically are given extensions if they meet certain requirements and provide accompanying declarations after the disruption has ended. These requirements and examples of satisfactory evidence for purposes of these declarations are provided on the Copyright Office’s website in the “Public Notice Regarding Timing Provisions for Persons Affected by COVID-19” section.

Serving and Recording Notices of Termination

Under sections 203 and 304(c) of the Copyright Act, individual authors may recover copyright interests they previously transferred to another party if the author satisfies certain criteria. An author has the option to terminate a transfer within a five-year window as long as the author serves notice on the transferee between two and 10 years before the chosen termination date. Notice of the transfer must be recorded with the Copyright Office prior to the date of termination.

The Copyright Office has amended requirements under these provisions to allow for an extension of the termination window during the period of disruption and a waiver of the requirement that the notice be recorded before the date of termination if the author meets certain requirements. These requirements are outlined on the Copyright Office’s website in the “Public Notice Regarding Timing Provisions for Persons Affected by COVID-19” section.

Requirements for Stakeholders of a Section 115 License

Licensees, music publishers, and songwriters that may be subject to a Section 115 compulsory license for making and distributing phonorecords are provided with certain timing adjustments to their notices of intention and their statements of account and royalty payments in certain limited circumstances. The conditions to utilize these modifications are detailed on the website in the “Public Notice Regarding Timing Provisions for Persons Affected by COVID-19” section.

Additional Changes

The Library of Congress, which includes the Copyright Office, will remain closed to the public until further notice.

Because most of the staff is working remotely during this time, mailed copies of refusal letters and responses to requests for consideration will not be sent to applicants. Instead, these communications will be sent to the email address provided in the registration application. The Copyright Office will also not be accepting deliveries through personal couriers, but will accept deliveries through US postal mail and commercial delivery services.

Lastly, while not a response to COVID-19, the Copyright Office has also modified its filing fee requirements and fees for certain services as of March 20. The new fee schedule is available on its website here.

Conclusion

Hopefully, this summary and overview provides helpful information for members of the IP Section and other sections alike. You can stay current with any USPTO notices by subscribing to receive email updates here, and, for updates related to the Copyright Office, you can sign up for its NewsNet service. For general information on COVID-19 visit coronavirus.gov and usa.gov/coronavirus.

Thank You

The Intellectual Property Law Section thanks the following individuals for their contribution to this legal alert:

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Marc Lieberstein, Esq. *Kilpatrick Townsend & Stockton LLP*
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