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IP Issues Prompted by the COVID-19 Pandemic

The spreading novel coronavirus COVID-19 pandemic has left intellectual property (IP) attorneys and their clients in uncharted legal territory as quarantines are imposed and offices close. Most filing and prosecution of patent, trademark, and copyright applications should keep running smoothly for now, however, because almost all of that work is done online and most IP attorneys (like [Stradley Ronon's IP Practice Group](#)) are fully operational remotely. Nevertheless, the various IP offices around the world have announced measures to grant leeway in these exigent circumstances from certain requirements. These measures are summarized below and should give all peace of mind knowing that options are available should the need arise. Moreover, although the use of the measures may be unnecessary yet, that could change if attorneys, corporate clients, or inventors were to become seriously ill with the virus or the internet and computer systems become disrupted as the crisis progresses.

A. The U.S. Patent and Trademark Office (USPTO)

The USPTO announced that it lacks authority to extend many filing deadlines, despite the pandemic, because they are set by statute. Such deadlines include the deadline for non-provisional patent applications that claim priority to a foreign priority application, a provisional patent application, or a previously filed parent patent application, or the three-month deadline to pay an issue fee, among others. The USPTO does consider the pandemic to be an "extraordinary situation" within the meaning of 37 C.F.R. § 1.183, however, for affected patent and trademark applicants, patent and trademark owners, and reexamination parties. Therefore, the USPTO eased the burden on those who miss certain deadlines by waiving revival petition fees.

Specifically, with respect to patents, the USPTO gave notice that it will waive the petition fee normally required with any petition to revive an abandoned application or the termination or limitation of a reexamination proceeding when the pandemic caused a missed deadline. A copy of the USPTO notice that accompanies a petition (e.g., to revive) will be treated as a representation that the relevant delay in filing "was because the practitioner, applicant or at least one inventor was personally affected by the Coronavirus outbreak such that they were unable to timely reply." The waiver likewise applies to those whose trademark applications were abandoned or whose registrations were canceled or expired based on missed deadlines. Petitions to revive an abandoned application or reinstate a canceled or expired registration "must include a statement explaining how the failure to respond to the Office communication was due to the effects of the Coronavirus outbreak." As with any representation made to the USPTO, we recommend that the applicant, practitioner, or inventor maintain evidence supporting the representation.

The USPTO has also waived the requirements for an original handwritten signature for certain correspondence and for certain payments by credit card. And, not surprisingly, the USPTO has announced that it will no longer hold face-to-face meetings until further

notice, including Patent Trial and Appeal Board hearings, but will continue with phone and videoconferences. For additional guidance and updates, see the USPTO website at www.uspto.gov.

B. The U.S. Copyright Office

Citing the pandemic, the U.S. Copyright Office has implemented temporary rules addressing electronic applications for copyright registration that need to be processed quickly. The temporary rules for “special handling” of applications were prompted by the Copyright Office’s recent decision to close the Library of Congress buildings to the public and switch to a telework arrangement. The Office hopes that the buildings can reopen on April 1, 2020. Under the temporary rules, applicants who file their applications online can submit an electronic deposit of their work if a physical version is required with the applications. Examiners working remotely will then review the applications within five business days. The electronic deposit, which does not replace the physical requirement, must include a declaration or statement certifying that it has the same content as the physical one. As for electronic applications that do not require physical deposits of the work, the U.S. Copyright Office announced that those applications will continue to be examined within five business days by the teleworking examiners. The U.S. Copyright Office cautioned, “These measures are exceptional in nature and temporary in duration, and are projected to terminate when the library reopens its buildings to the public.” The U.S. Copyright Office provides helpful guidance about all things copyright on its website, www.copyright.gov.

C. The Madrid System of International Trademarks

Access to mail, delivery services, and even electronic communication might be or become impracticable due to measures taken in connection with the pandemic. In such a situation, under Rule 5(1), (2), and (3) of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Regulations), users of the Madrid System who have failed to meet a time limit for a communication addressed to the World Intellectual Property Organization (WIPO) may be excused if they send that communication within five days after regaining access to mail, delivery services, or electronic communication. In any event, WIPO must receive the communication no later than six months from the date on which the relevant time limit expired. Users must provide sufficient evidence of the reason why WIPO should excuse the delay. Evidence could be, for example, an official announcement or an attestation by a certified physician.



For more information, contact Kevin R. Casey at 610.640.5813 or kcasey@stradley.com.

D. The European Patent Office (EPO) & European Union IP Office (EUIPO)

Unlike the USPTO, the EPO has extended all deadlines falling between March 15, 2020, and April 17, 2020, including deadlines for international applications under the Patent Cooperation Treaty. The currently extended deadline of April 17 may be further extended by a future notice. To take advantage of the EPO deadline extensions, however, applicants or their representatives must offer “evidence that on any of the ten days preceding the day of expiry of a period, it was not possible to observe the time limit due to” a pandemic-related disruption. The EPO has announced that oral proceedings will continue but may be held by videoconference. For those with European Union Trademarks, the EUIPO in Alicante, Spain, remains open although all staff are now working from home. The EUIPO has extended all deadlines falling between March 9, 2020, and April 30, 2020 to May 1, 2020.

E. Canada

The Canadian Intellectual Property Office (CIPO) has extended all deadlines on IP matters under the Patent Act, Trademarks Act, and Industrial Design Act falling between March 16, 2020, and ending on March 31, 2020, to the next day. CIPO has confirmed that further extensions may be possible as the pandemic situation evolves.

F. Australia

IP Australia has published a notice indicating that the usual extension of time provisions (which are triggered when a deadline is missed due to “circumstances beyond control” or “error or omission”) will be available if the missed deadline is due to the pandemic.

If you have any questions regarding the response of other countries to the IP issues prompted by the COVID-19 pandemic, or more generally, any IP questions, we encourage you to contact one of Stradley Ronon’s [IP attorneys](#).