

# Patent, Trademark and Copyright Filing Deadlines Extended Under CARES Act

by Andrew L. Goldstein

## A FREEBORN & PETERS LLP CLIENT ALERT

In addition to providing needed economic relief, the recently passed Coronavirus Aid, Relief, and Economic Security (CARES) Act gave authority to the United States Patent and Trademark Office (“USPTO”) and the United States Copyright Office (“USCO”) to temporarily “toll, waive, adjust, or modify, any timing deadline” established by statute or regulations. Accordingly, as discussed in detail below, both the USPTO and the USCO announced that each will grant extensions to file certain documents and to pay certain required fees. This client alert supplements the [previous Freeborn & Peters LLP Intellectual Property Client Alert](#) published on March 20, 2020.



### **UNITED STATES PATENT AND TRADEMARK OFFICE**

The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office stated that: “Inventors and entrepreneurs are the lifeblood of our economy, and we recognize that many of them are having difficulty as a result of COVID-19. ... We are especially mindful of the outsized impact on small businesses and independent inventors, and we have provided additional relief for these groups. Ultimately, our goal is to ensure not only that inventors and entrepreneurs can weather the storm, but that they can also hit the ground running once it passes.”

Therefore, USPTO deadlines falling **on or after March 27, 2020, through April 30, 2020** for filing certain documents and/or fees, may be extended by thirty days from the initial due date. In order to take advantage of these extensions, stakeholders must file, along with the required document or fee, a statement that the delay in filing or payment was due to the COVID-19 outbreak. The USPTO stated that a delay in filing or payment is due to the COVID-19 outbreak “if a practitioner, applicant, patent owner, petitioner, third party requester, inventor, or other person associated with the filing or fee 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 or payment.”

### **Extensions Related to Trademarks**

Extensions related to trademark filings in the USPTO are available for the following:

- Responses to an Office action, including a Notice of Appeal from a final refusal;
- Statements of use or requests for extensions of time to file a Statement of Use;
- Notices of Opposition in the Trademark Trial and Appeal Board (“TTAB”) or requests for extension of time to file a Notice of Opposition;
- Affidavits of use under Section 8;
- Renewal applications; and
- Priority filings for applications based on foreign applications.

For a complete list of trademark-related deadlines that may be extended, [see here](#).

For situations relating to deadlines in the TTAB that are not covered above, a request (in *ex parte* appeals) or motion (for trial cases) for an extension or reopening of time, as appropriate, can be made.

## Extensions Related to Patents

Extensions related to patent filings in the USPTO are available for the following:

- Reply to an Office notice issued during pre-examination processing by a small or micro entity;
- Reply to an Office notice or action issued during examination or patent publication processing;
- Issue fee;
- Notice of appeal;
- Appeal brief;
- Reply brief;
- Appeal forwarding fee;
- Request for an oral hearing before the Patent Trial and Appeal Board (“PTAB”);
- Maintenance fee, filed by a small or micro entity; and
- Request for rehearing of a PTAB decision.

For certain PTAB matters, additional relief may be provided. Upon request to the USPTO affirming that a filing due between, and inclusive of both, March 27, 2020 and April 30, 2020 was or may be delayed due to the COVID-19 outbreak, the PTAB will provide a 30-day extension of time for the following:

- A request for rehearing of a PTAB decision;
- A petition to the Chief Judge; and
- A patent owner preliminary response in a trial proceeding, or any related responsive filings.

For all other PTAB situations, a request for an extension of time where the COVID-19 outbreak has prevented or interfered with a filing can be made by contacting the PTAB.

For a complete list of patent-related deadlines that may be extended, [see here](#).

## **UNITED STATES COPYRIGHT OFFICE**

The Acting Register of the USCO adjusted certain deadlines relating to copyright registration affecting remedies available for infringement and notices of termination in specific cases for persons unable to comply due to the COVID-19 national emergency.

### **Registration Timing Requirements Affecting Remedies for Infringement**

A copyright owner generally may recover attorney’s fees and costs and statutory damages in an infringement action only if the work is registered prior to the infringement or within three months of the work’s first publication. The effective date of registration is the date when the USCO receives the application, a deposit copy of the work, and fee.

Due to the national emergency, the USCO acknowledged that some copyright owners may be prevented from completing and submitting copyright applications in a timely manner due to lack of access to physical documents, including deposit copies of copyrighted works, or the inability to deliver materials to a mail carrier.

Accordingly, the USCO made adjustments to the three-month deadline as follows:

- **For copyright applications that can be submitted entirely in electronic form** (i.e., those that do not require submission of a physical deposit), the timing provisions are unchanged.

- **If an applicant can submit an application electronically but is unable to submit a required physical deposit**, the applicant may upload, together with the application, 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 emergency, and setting forth satisfactory supporting evidence. Examples of such supporting evidence include, but are not limited to:
  - a statement that the applicant is subject to a stay-at-home order issued by a state or local government; or
  - a statement 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, the USCO will extend the three-month window, provided that the applicant submits the required deposit within thirty days after the date the disruption has ended.

- **If an applicant is unable to submit an application electronically or physically during the disruption**, the applicant may submit an application after the USCO has announced the end of the disruption, and 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 emergency, and providing satisfactory supporting evidence. Examples of such supporting evidence include, but are not limited to:
  - a statement that the applicant did not have access to a computer and/or the internet; or
  - a statement that the applicant was prevented from accessing or sending required physical materials for reasons such as those noted above.

If these requirements are met, the USCO will toll the three-month window between March 13, 2020, and the date that the disruption has ended. For example, if a work was first published on February 13, 2020, the applicant would have two months following the end of the disruption to register the work in order to be eligible for the applicable remedies.

### Timing Requirements for Serving and Recording Notices of Termination

Under the Copyright Act, individual authors may terminate assignments or transfers of copyrights in certain specified circumstances, including after the passage of thirty-five years from the date of transfer. An author must effect such a termination by serving notice on the transferee within a five-year window.

To ensure that these authors are not deprived of their ability to effect termination, the USCO temporarily adjusted the timing requirements to the extent they apply to persons affected by the national emergency as follows:

- **Where the termination window is expiring:** the five-year window for service of a notice of termination will be extended during the period of disruption if: (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 a notice of termination within thirty days after the date the USCO announces as the date the disruption has ended; and (3) the notice of termination is accompanied by a declaration or similar statement certifying, under penalty of perjury, that but for the national 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. When these requirements are met, the notice will be considered timely served.
- **Where the window to record is expiring:** the requirement that a notice be recorded before the date of termination will be waived if (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 date the USCO announces as the date the disruption has ended; (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 national emergency, and setting forth satisfactory evidence in support of that statement. Examples of such satisfactory evidence would include, but not be limited to, a statement that the author was prevented from accessing or mailing the required physical materials. When these requirements are met, the notice will be treated as timely recorded.

Please note that the policies of the USPTO and the USCO may evolve in the coming weeks, and Freeborn & Peters LLP is continuously monitoring the coronavirus implications regarding intellectual property rights and regulations. If you have any questions, please contact Andrew Goldstein or another member of Freeborn & Peters LLP's Intellectual Property Practice Group. Stay tuned for further developments on [Freeborn's COVID-19 webpage](#).

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