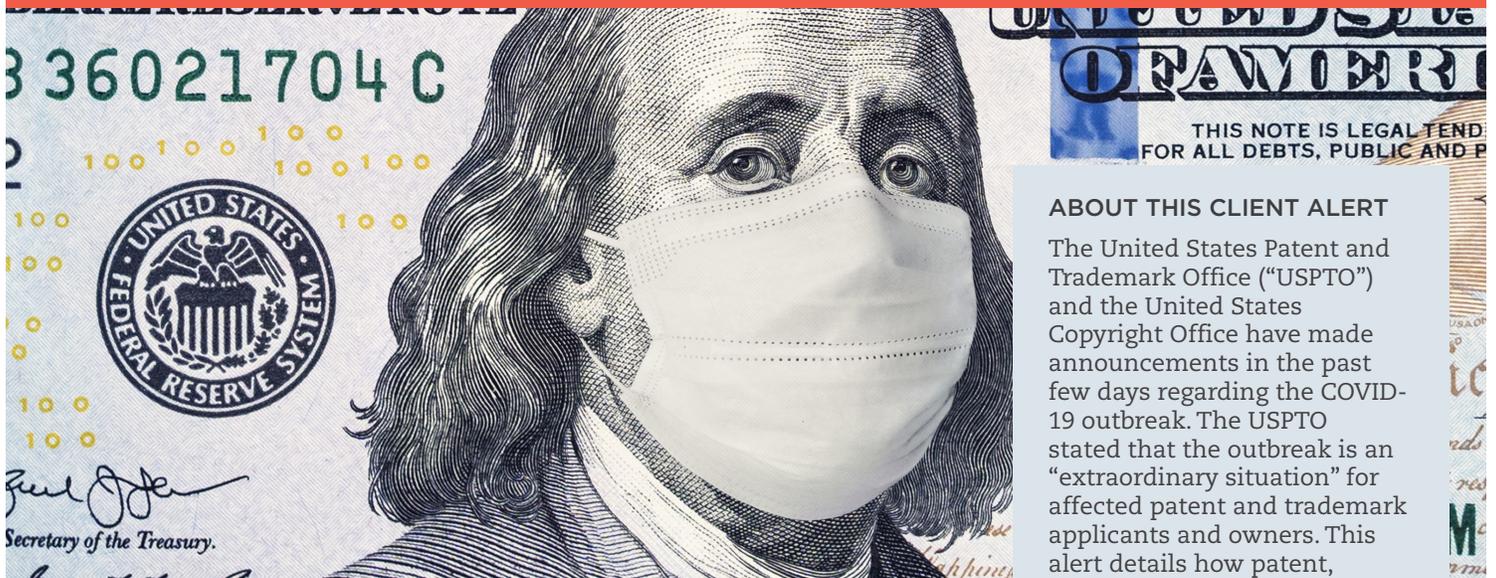


Protecting Intellectual Property During COVID-19

by Andrew L. Goldstein

A FREEBORN & PETERS LLP CLIENT ALERT



ABOUT THIS CLIENT ALERT

The United States Patent and Trademark Office (“USPTO”) and the United States Copyright Office have made announcements in the past few days regarding the COVID-19 outbreak. The USPTO stated that the outbreak is an “extraordinary situation” for affected patent and trademark applicants and owners. This alert details how patent, trademark and copyright applicants and owners may be affected during this time.

The United States Patent and Trademark Office (“USPTO”) and the United States Copyright Office (“USCO”) have made announcements in the past few days regarding the COVID-19 (“coronavirus”) outbreak. The USPTO stated that the coronavirus outbreak is an “extraordinary situation” for affected patent and trademark applicants and owners.

United States Patent and Trademark Office

At the time of this alert, the USPTO remains open for business; however, it is closed for public visits and in-person interviews. Any Examiner and Examining Attorney interviews, Patent Trial and Appeal Board (“PTAB”) and Trademark Trial and Appeal Board (“TTAB”) oral hearings, and other similar in-person meetings with parties and stakeholders scheduled to take place at USPTO

offices on or after March 13, 2020 are to be conducted remotely by video or telephone.

To address the difficulties brought on by the coronavirus outbreak, the USPTO is granting relief to patent and trademark applicants and owners who are affected by the outbreak. By statute the USPTO cannot grant waivers or extensions for filing deadlines. However, if you miss a filing deadline, you can petition the USPTO to revive an application or registration. The USPTO is waiving the fee for filing such a petition if the failure to meet the deadline is due to the coronavirus outbreak and, while not stating as much, the announcement implies that if the failure to meet the deadline was due to the coronavirus outbreak, the USPTO will grant the petition.

Petitions relating to patents and patent applications must be filed **no later than two months** from the issue date of the notice of abandonment and or the notification that reexamination prosecution must be terminated. Petitions relating to trademark applications and registrations must be filed **no later than two months** from the issue date of the notice of abandonment or cancellation, or, if the applicant or registrant did not receive a notice of abandonment or cancellation, then **no later than six months** after the date the USPTO electronic records indicate that the application is abandoned or the registration is cancelled or expired.

As mentioned above, the USPTO is bound by statutory requirements and, therefore, the following are **not** extendable by petition:

Patents:

- the one-year deadline to file a utility patents based on provisional filing or a foreign application;
- the deadline requirements for filing continuation, continuation in part or divisional applications;
- the three-month deadline to pay an issue fee; and,
- the deadline for filing a reexamination proceeding.

Trademarks:

- all post registration deadlines, such as Section 8 & 15 Declarations of use and renewals;
- the deadline for pending intent-to-use applications to file a Statement of Use (“SOU”) or an extension request to file an SOU; and,
- the deadline to file opposition or cancellation proceedings.



United States Copyright Office

The USCO, as well as all Library of Congress buildings, are closed to the public until Wednesday, April 1, 2020, at 8:30 a.m.

The USCO is still accepting copyright applications online through its existing systems and it strongly encourages applicants to submit applications online as the most efficient and cost-effective method of registering claims in copyright. Because of extended telework requirements for the USCO, the processing of paper applications and the examination of physical deposits will be delayed.

To minimize the effects of these measures on copyright infringement actions, the USCO is adopting an interim policy for the “special handling” of applications on an expedited basis. For special handling claims that are submitted electronically and for which electronic deposits are permissible under the regulations, these claims will continue to be examined within five business days by examiners that are teleworking.

For electronic applications that require the submission of physical deposits of the best edition, applicants must still send the physical deposits, but the USCO will allow the applicant to additionally upload an electronic deposit of that same work. This will allow teleworking examiners to examine such claims within five business days.

Unrelated to the coronavirus, the USCO adopted a new fee schedule for services related to: registration, recordation, record retrieval, search and certification, the Licensing Division, and other services. The new fee schedule went into effect today, March 20, 2020, and can be found [here](#).

Please note that the USPTO’s policies 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 (agoldstein@freeborn.com; (312) 360-6438) or another member of Freeborn & Peters LLP’s Intellectual Property Practice Group, or visit [Freeborn’s COVID-19 webpage](#).

ABOUT THE AUTHOR



Andrew L. Goldstein

Senior Counsel

Chicago Office
(312) 360-6438

agoldstein@freeborn.com

Andrew Goldstein is a Senior Counsel in the Corporate Practice Group and a member of the Emerging Industries Team. Andrew focuses his practice in the area of Intellectual Property and Information Technology. He has extensive experience in the areas of intellectual property law.

140+ Attorneys. 5 Offices.

Freeborn & Peters LLP is a full-service law firm with international capabilities and offices in Chicago, Ill.; New York, Ny; Richmond, Va.; Springfield, Ill.; and Tampa, Fla. Freeborn is always looking ahead and seeking to find better ways to serve its clients. It takes a proactive approach to ensure its clients are more informed, prepared and able to achieve greater success – not just now, but also in the future. While the firm serves clients across a very broad range of sectors, it has also pioneered an interdisciplinary approach that serves the specific needs of targeted industries.

Freeborn's major achievements in litigation are reflective of the firm's significant growth over the last several years and its established reputation as a Litigation Powerhouse®. Freeborn has one of the largest litigation departments among full-service firms of its size – currently with more than 90 litigators, which represents about two-thirds of the firm's lawyers.

Freeborn is a firm that genuinely lives up to its core values of integrity, effectiveness, teamwork, caring and commitment, and embodies them through high standards of client service and responsive action. Its lawyers build close and lasting relationships with clients and are driven to help them achieve their legal and business objectives.

For more information visit: www.freeborn.com

CHICAGO

311 South Wacker Drive
Suite 3000
Chicago, IL 60606
(312) 360-6000
(312) 360-6520 fax

NEW YORK

230 Park Avenue
Suite 630
New York, NY 10169
(212) 218-8760
(212) 218-8761 fax

SPRINGFIELD

217 East Monroe Street
Suite 202
Springfield, IL 62701
(217) 535-1060
(217) 535-1069 fax

RICHMOND

901 East Byrd Street
Suite 950
Richmond, VA 23219
(804) 644-1300
(804) 644-1354 fax

TAMPA

1 Tampa City Center
201 North Franklin Street
Suite 3550
Tampa, FL 33602
(813) 488-2920

Disclaimer: This publication is made available for educational purposes only, as well as to provide general information about the law, not specific legal advice. It does not establish an attorney/client relationship between you and Freeborn & Peters LLP, and should not be used as a substitute for competent legal advice from a licensed professional in your state.

© 2020 Freeborn & Peters LLP. All rights reserved. Permission is granted to copy and forward all articles and text as long as proper attribution to Freeborn & Peters LLP is provided and this copyright statement is reproduced.