
Hughes Hubbard & Reed

COVID-19 Impact on Intellectual Property Filings and Proceedings

Client Advisories

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The COVID-19 pandemic has resulted in unprecedented closures and quarantines that have raised many questions regarding the effect of statutory and court-imposed deadlines relating to intellectual property rights.

Current U.S. Filings and Proceedings

In the U.S., patent, trademark, and copyright filings appear to be running smoothly, as much of that work has been conducted through on-line filing portals. Most firms, including HHR, are continuing to file remotely without incident.

On March 31, the USPTO announced that it will allow an extension of time for some patent and trademark filing deadlines, for IP owners and applicants who are experiencing difficulty meeting such deadlines as the result of the COVID-19 epidemic. The announcement can be found at <https://www.uspto.gov/about-us/news-updates/uspto-announces-extension-certain-patent-and-trademark-related-timing>.

In addition, the following relief has been instituted by notice:

- The U.S. Patent and Trademark Office (U.S.P.T.O.) will waive the petition fee normally required with any petition to revive an abandoned patent or patent application, or trademark application or registration where the pandemic caused a missed deadline. A petition to revive, with a copy of the Notice, is sufficient to establish that “the practitioner, applicant or at least one inventor was personally affected by the Coronavirus outbreak such that they were unable to timely reply,” but “must include a statement explaining how the failure to respond to the Office communication was due to the effects of the Coronavirus outbreak.”
- The U.S.P.T.O. has waived the requirements for an original handwritten signature for certain correspondence and for certain payments by credit card.
- The U.S.P.T.O.’s offices are closed to the public, and all interviews with patent examiners and trademark examining attorneys, as well as Trademark Trial and Appeal Board (T.T.A.B.) and Patent Trial and Appeal Board (P.T.A.B.) hearings will continue by phone or videoconferences.

- The Copyright Office is also closed to the public, and will be permitting electronic deposits of works with applications, although physical copies must be submitted later.
- The Federal Circuit, which hears all appeals in patent cases, has announced all oral arguments will be conducted by teleconference.

The U.S.P.T.O. maintains its current COVID-19 notices at <https://www.uspto.gov/coronavirus>, and the U.S. Copyright Office maintains its information at <https://www.copyright.gov/coronavirus>. The Federal Circuit's announcements are at <http://www.ca9.uscourts.gov/announcements/updated-public-advisory-concerning-federal-circuits-april-2020-sitting-march-18-2020>.

The CARES Act

The CARES Act (Coronavirus Aid, Relief, and Economic Security Act) authorizes the Director of the U.S.P.T.O. to “toll, waive, adjust, or modify” patent and trademark statutory filing deadlines. The Director is only authorized to make changes to such deadlines if the Director determines that the COVID-19 emergency:

- Materially affects the functioning of the U.S.P.T.O.;
- Prejudices the rights of applicants, registrants, or others appearing before the Office; or
- Prevents applicants, registrants, patent owners, or others appearing before the Office from filing a document or fee with the Office.

There are no provisions in the CARES Act directed to activities in the Copyright Office.

Prior to enactment of the CARES Act, the U.S.P.T.O. did not have authority to make changes to statutory deadlines, such as reply dates for Office Actions, deadlines for fee payments, deadlines for submission of declarations and/or specimens in trademark filings, deadlines for filing divisional, continuation, or non-provisional patent applications to preserve claims to priority of an earlier-filed application, or statutory limitations for filing opposition proceedings or requests for review or re-examination before the T.T.A.B. or P.T.A.B.

International Resources

Worldwide, the response to the pandemic varies widely among the international and national intellectual property offices. The list below includes links to most countries of common interest:

- European Patent Office
<https://www.epo.org/news-issues/covid-19.html>
- Canada (Canadian Intellectual Property Office)
<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00050.html>(See also FAQ at:
<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04762.html>)
- Argentina (National Institute of Industrial Property)
<https://www.boletinoficial.gob.ar/detalleAviso/primera/226931/20200318>
- Brazil (National Institute of Industrial Property)
<http://www.inpi.gov.br/noticias/esclarecimentos-sobre-a-portaria-no-120-que-trata-da-suspensao-dos-prazos/view>
- Chile (National Institute of Industrial Property)
<https://www.inapi.cl/sala-de-prensa/detalle-noticia/inapi-informa-medidas-adoptadas-frente-al-coronavirus>
- Germany (German Patent and Trademark Office)
https://www.dpma.de/english/our_office/publications/news/corona/index.html
- UK (Intellectual Property Office)
<https://www.gov.uk/government/news/update-on-ipo-services>

- France (National Institute of Industrial Property)
<https://www.inpi.fr/fr/report-de-dela-is-lie-la-crise-sanitaire>
- Italy (National Institute of Industrial Property)
<https://uibm.mise.gov.it/index.php/it/sospensione-di-tutti-i-termini-dei-procedimenti-amministrativi-ed-estensio-ne-della-validita-degli-atti-in-scadenza>
- Spain (Spanish Patent and Trademark Office)
http://www.oepm.es/export/sites/oepm/comun/documentos_relacionados/Noticias/2020/2020_03_16_Resolucio
- Israel (Israel Patent Office)
https://www.justice.gov.il/Units/RashamHaptentim/news/Pages/operations_changes_ILPO.aspx
- China (China National Intellectual Property Administration)
<http://english.sipo.gov.cn/news/officialinformation/1145981.htm> (See also,
<http://english.sipo.gov.cn/news/officialinformation/1145980.htm>)
- Hong Kong (Intellectual Property Department)
https://www.ipd.gov.hk/eng/whats_new/news.htm
- Korea (Korean Intellectual Property Office)
https://www.kipo.go.kr/en/BoardApp/UEngBodApp?a=&c=1003&seq=1693&supp_cd=001&board_id=kiponews&cp=1&pg=1&npp=10&catmenu=ek06_01_01&sdate:
- Taiwan (Intellectual Property Office)
<https://www.tipo.gov.tw/en/cp-282-863966-09602-2.html>
- Australia (IP Australia)
<https://www.ipaustralia.gov.au/about-us/news-and-community/news/business-continuity-and-coronavirus-disease-covid-19-outbreak>
- Singapore (Intellectual Property Office of Singapore)
<https://www.ipos.gov.sg/media-events/updates/ViewDetails/relief-measures-for-covid-19>
- WIPO
<https://www.wipo.int/portal/en/news/2020/>

We note that Japan and Mexico have not yet released intellectual property notices relating to the pandemic.

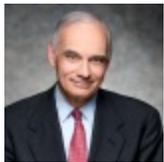
Important Considerations

It is critical to keep in mind that any modification to patent and trademark U.S. deadlines, even in times of emergency, does not relieve the burden of response in other jurisdictions, including deadlines for international applications, foreign fee payments, and the like. There are similar concerns about maintaining intellectual property rights across all jurisdictions, as each jurisdiction may or may not recognize altered deadlines in other jurisdictions. Accordingly, to the extent possible and so long as electronic filing systems remain functional, intellectual property filings, both in the U.S. and abroad, should be accomplished as of the standard statutory or procedural deadline, notwithstanding any modifications which the U.S.P.T.O. or other jurisdictions may make to deadlines under these emergency circumstances.

For further guidance and assistance relating to particular issues, please contact counsel.

[Click here to go to our COVID-19 Resource Center for more advisories, articles and other content related to the coronavirus pandemic.](#)

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