

INTELLECTUAL PROPERTY

ALERT

APRIL 2, 2020

Limited Extension of USPTO Trademark Deadlines under the CARES Act

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On March 31, 2020, the United States Patent and Trademark Office (USPTO) issued an advisory Notice (Notice) on the waiver of certain trademark-related deadlines for those who have been personally affected by the COVID-19 outbreak. Pursuant to the Coronavirus Aid, Relief, and Economic Security Act (CARES Act), the USPTO has extended the filing deadline for certain trademark-related documents or fees which otherwise would have been due on or after March 27, 2020.

MODIFICATION OF TIMING DEADLINES DURING COVID-19 OUTBREAK

The Director of the USPTO has determined that the COVID-19 emergency has prejudiced the rights of trademark applicants, registrants, owners, or others appearing before the office regarding trademark matters. Further, the emergency has prevented these interested individuals from appearing before the Office and from filing a document or fee with the Office. Under subsection 12004(a) of the CARES Act, the USPTO is modifying the deadlines established by the Trademark Act as set forth below.

EXTENSION OF TIME FOR DEADLINES DUE BETWEEN MARCH 27, 2020 AND APRIL 30, 2020

The deadline for any filings or payments which would have been due between March 27, 2020 and April 30, 2020, inclusive, will be extended by 30 days from the initial due date. The extension applies to:

- responses to Office Actions, including notices of appeal from final refusals;
• statements of use or requests for extensions of time to file a statement of use;

- notice of opposition or requests for extensions of time to file a notice of opposition;
• priority filing basis under 15 U.S.C. § 1126(d)(1) and 37 C.F.R. §2.34(A)(4)(I);
• priority filing basis under 15 U.S.C. § 1141g and 37 C.F.R. §7.27(c);
• transformations of an extension of protection to the United States into a U.S. application;
• affidavits of use or excusable nonuse under 15 U.S.C. §1058(a) and 37 C.F.R. §2.160(a);
• renewal applications; or
• affidavits of use or excusable nonuse under 15 U.S.C. §1141k(a) and 37 C.F.R. §7.36(b).

The filing must be accompanied by a statement that the delay in filing or payment was due to the COVID-19 outbreak. A "delay due to the COVID-19 outbreak" will be deemed to have occurred if a person associated with the filing or fee was personally affected by the outbreak of the virus, such that it materially interfered with the timely filing or payment. This includes, but is not limited to, office closures, travel delays, cash flow interruptions, inaccessibility of files, or personal or family illness.

For all other circumstances where the COVID-19 outbreak has interfered with a filing or payment, requests or motions for extensions or reopenings of time can be made.

USPTO REMAINS OPEN FOR FILINGS AND PAYMENTS DURING EMERGENCY

This limited extension of time under Section 12004 only applies if a delay was due to the outbreak of the virus. The USPTO is still operational during the COVID-19 outbreak for filing of trademark-related documents and fees. Existing procedures to revive abandoned applications or reinstate cancelled/expired registrations remain available to applicants who were unable to timely respond to the USPTO due to the outbreak. The fees for such petitions are waived. Any queries relating to the Notice issued by the USPTO may be addressed to TMPolicy@uspto.gov.

The full Notice is available at <https://www.uspto.gov/sites/default/files/documents/TM-Notice-CARES-Act.pdf>.

This Alert was based on information available at the time of publishing. It is subject to change. You should consult government websites and publications for the most up-to-date information. ◆

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