

COVID-19 Crisis Leads to Temporary Changes to Trademark Registration Practice, Possibly with More to Come

March 31, 2020

As with other areas, the government has taken several steps to address trademark practice issues related to the COVID-19 crisis.

First, on March 16, 2020, the United States Patent and Trademark Office (“PTO”) announced a relaxation of certain regulations. Acknowledging that it did not have the power to extend or otherwise amend statutory deadlines, the Trademark Office indicated that it would waive the petition fee (set by regulation rather than by statute) to revive abandoned applications or reinstate cancelled or expired registrations for any trademark applications and registrations that were abandoned, cancelled or expired due to the inability to timely respond to a trademark-related Office communication as a result of the emergency. To receive a waiver, the applicant or registrant must file a petition including a statement explaining how the failure to respond to the Office communication was due to the effects of the Coronavirus outbreak. The petition must be filed within two months of the issue date of the notice of abandonment or cancellation or, if not received, within six months after abandonment, cancellation or expiration is officially entered.

These waivers do not extend (1) the 36-month period set forth in 15 U.S.C. § 1051(d) within which a statement of use must be filed; (2) the periods set forth in 15 U.S.C. §§ 1058, 1141(k) for filing affidavits of continued use or excusable nonuse; (3) the period set forth in 15 U.S.C. § 1059 for filing a renewal; and (4) the periods set forth in 15 U.S.C. §§ 1063 and 1064 for filing an opposition or cancellation proceeding at the Trademark Trial and Appeal Board. Statutory fee requirements have also not been waived.

On the same day, the PTO announced that all in-person meetings, conferences and hearings before the PTO and Trademark Trial and Appeal board would be conducted remotely, and that the physical PTO building would be closed to any visitors.

Second, on March 27, 2020, the Coronavirus Aid Relief, and Economic Security Act (CARES Act) was signed into law. Among many other items, the CARES Act gives the USPTO Director the authority to “toll, waive, adjust, or modify” any statutory deadlines during the COVID-19 crisis. To do so, the Director must determine that the COVID-19 emergency “materially affects the functioning” of the USPTO, “prejudices the rights of applicants, registrants, patent owners, or others appearing before” the USPTO, or “prevents” such people “from filing a document or fee” with the USPTO. So far, the Director has not invoked this authority, nor has the USPTO issued any statement about the circumstances or timing in which he may do so, if at all.

Notwithstanding these actual and potential changes, trademark registrants and applicants should only utilize any extended deadlines, the ability to revive abandoned applications without fees, and the ability to reinstate cancelled or expired registrations without fees if they are forced to do

so. Regardless of any extensions, rights in connection with trademark registrations – from seniority to incontestability – are determined in connection with the filing date. Therefore, any filings should be made promptly when they are permitted and the filer is ready to move forward.

If you have any questions concerning the protection of your valuable marks and brands, please contact *Jakob Halpern* or any member of our trademark practice group.