

May 7, 2020

## **Cantor Colburn Client Alert: COVID-19: USPTO and Copyright Office Announce Further Deadline Extensions**

On Tuesday, April 28, the U.S. Patent and Trademark Office (USPTO) and the U.S. Copyright Office announced that under authority provided by the Coronavirus Aid, Relief, and Economic Security Act (CARES Act), extensions of time first announced on March 31 will be further extended for filing of certain documents and payment of certain fees. **The USPTO extensions are effective as to filings and payments due on or after March 27, 2020 through May 31, 2020. The Copyright Office extensions are now effective as against filings that would have been or are due for the period on or after March 13, 2020 through July 10, 2020.**<sup>1</sup>

The USPTO's Coronavirus Notices: <https://www.uspto.gov/coronavirus/>

The Copyright Office's Coronavirus Notices: <https://www.copyright.gov/coronavirus/>

### **Most Patent Filing and Payment Deadlines May Be Extended Through June 1, 2020**

Under the CARES Act, the USPTO has announced that some patent filings due between March 27, 2020 and May 31, 2020 will now be held due on June 1, 2020 provided that the delayed filing is accompanied with a statement that the delay in such filing or payment was caused by the COVID-19 outbreak; the USPTO has supplied a [form](#) for filing such a statement.<sup>2</sup> This guidance supersedes previous USPTO guidance that had been released on March 31, 2020.

Note that while the new extensions apply to most filings and payments, the further extensions do not apply to Patent Trial and Appeal Board (PTAB) filings. The PTAB is now instructed to offer a 30-day extension for deadlines falling between March 27, 2020 and April 30, 2020 but for situations falling outside those dates a party must move for an extension on a case-by-case basis. **The CARES Act extensions still do not apply to replies to pre-examination notices or to the payment of maintenance fees, except for micro-entity and small-entity filers.**

### **New USPTO CARES Act Patent Guidance:**

<https://www.uspto.gov/sites/default/files/documents/Patents-Notice-CARES-Act-2020-04.pdf>

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<sup>1</sup> The Copyright Office has made clear in its guidance that the July 10 end date is provisional and may be subject to change.

<sup>2</sup> The form SB/449 for Statement of Delay Due to COVID-19 Outbreak in patent cases is available online at <https://www.uspto.gov/sites/default/files/documents/sb0449.pdf>.

### **Trademark Registration Payment Deadlines May Be Extended Through June 1, 2020**

Also under the CARES Act, the USPTO has announced that certain trademark application and registration filings due between March 27, 2020 and May 31, 2020 will be extended held due on June 1, provided that the delayed filing be accompanied with a statement that the delay was caused by the COVID-19 outbreak, much as described above.<sup>3</sup> The trademark filing extension guidelines apply to a full range of filings and payments for all applicants in trademark prosecution.

### **TTAB Deadlines Are Not Specifically Extended by the CARES Act**

As with the previous guidance, the USPTO guidance does not list as specifically extended any filings before the Trademark Trial and Appeal Board (TTAB) but does provide that a motion for an extension of time can be made where appropriate.

### **New USPTO CARES Act Trademark Guidance:**

<https://www.uspto.gov/sites/default/files/documents/TM-Notice-CARES-Act-2020-04.pdf>

### **Copyright Office Timing Provisions Are Extended in Limited Circumstances, Now Effective Through July 10, 2020**

The CARES Act has amended the Copyright Act to allow the Register of Copyrights to toll, waive, adjust, or modify any timing provision in the Copyright Act in emergency situations.

The Acting Register has chosen to invoke certain emergency modifications for a period beginning March 13, now extended through July 10, 2020. However, **copyright registrants should be aware that the announced modifications are limited in scope**.

### **For Electronic Filers, Copyright Registration Timing Provisions Are Unchanged**

Under the Copyright Act, a copyright owner is eligible for statutory damages only if the work is registered prior to the alleged infringement or within three months of the work's first publication. The effective date of copyright registration is when the Copyright Office receives the application, deposit, and fee payment.

For registration applications that do not require submission of a physical deposit, which includes most written works, the timing provisions are unchanged.

### **Timing Provisions are Extended 30 Days for Electronic Filers Unable to Submit a Required Physical Deposit**

For applicants who are unable to timely file a physical deposit, the applicant should upload all possible electronic documents, and then submit the physical deposit along with a statement that the physical deposit would have been timely but-for the COVID-19 emergency. If the three-month window for registration after the date of first publication was open on or after March 13, 2020 through July 10, 2020, the statutory damages timing provision will be extended so long as the deposit is made within 30 days of the

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<sup>3</sup> The USPTO has not yet promulgated a form for filing such a COVID-19 delay statement in trademark cases.

end of the filer's disruption. The Copyright Office guidance explains that satisfactory for-cause explanations under this guidance will be interpreted generously.

### **Timing Provisions are Extended Two Months, For-Cause, for Applicants Unable to File Electronically or Physically**

For applicants unable to timely file electronically or physically, the applicant shall be granted an extension of two months from the end date of the disruption.

For purposes of this extension, the applicant must provide a statement of cause.

Satisfactory cause may be, for example, that the applicant could not access a computer and/or the internet; or that the applicant was unable to access or send required physical materials.

### **Timing Provisions for Notices of Termination**

The Copyright Act permits an author who granted her or his rights to another to terminate the grant under certain circumstances and revert the copyright to her or his self. For most cases, the law requires a waiting period of 35 years from the date of the grant of rights.<sup>4</sup> Generally, the grantor has a five-year window in which to terminate a grant of rights, provided that the grantor affords the grantee with two to ten years notice of intent to terminate. As of May 1, 2020, the Copyright Office has set forth guidance affecting these timing provisions.

### **Timing of the Notice**

Because the law requires at least two-years notice for termination, the Copyright Office is extending the five-year termination window for the full duration of a COVID-19-related disruption where the termination window would expire on or after March 14, 2022, through the two years from the date the emergency is declared ended, which under the current guidance would be July 10, 2022. A late termination notice must be accompanied by a statement setting forth the facts and circumstances of the declarant's disruption.

### **Timing of Recordal of Termination**

The law further requires that a termination is only effective if it is recorded with the Copyright Office within the five-year statutory window. Therefore, the Copyright Office has also extended the recordation deadline window for the full duration of a COVID-19-related disruption where the recordation deadline falls on or after March 14, 2022 through the date the emergency is declared ended, which under the current guidance would be July 10, 2020. A late recordation of termination must be accompanied by a statement setting forth the facts and circumstances of the declarant's disruption.

New Copyright Office CARES Act Guidance: <https://www.copyright.gov/coronavirus/>

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<sup>4</sup> For copyrighted works created before January 1, 1978, the waiting period for terminating a grant of rights is 56 years from the date the work was created.

**Further Information & Assistance**

Please do not hesitate to contact your Cantor Colburn attorney with any questions you may have regarding this alert and your IP. We understand that this is a challenging time and we will work with you to meet these challenges together.

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***Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.***