

>> COVID-19 ALERT

The Impact of COVID-19 on U.S. Trademark Applications and Registrations

THE BOTTOM LINE

- >> Although the USPTO may extend certain filing deadlines and payments by 30 days where the trademark owner can show that the COVID-19 outbreak interfered with timely filing or payment, trademark owners should continue to exercise best efforts to comply with all deadlines.
- >> Davis & Gilbert will periodically provide updates on trademark-related changes that result from the Coronavirus pandemic in the US and internationally.

On March 31, 2020, the U.S. Patent and Trademark Office (USPTO) issued a notice concerning the waiver of certain trademark-related timing deadlines pursuant to Section 12004 of the Coronavirus Aid, Relief, and Economic Security Act (the CARES Act).

The CARES Act (which was signed into law by President Trump on March 27, 2020) provides the USPTO with the temporary authority during the “emergency period” to extend deadlines established by the Trademark Act.

Specifically, the USPTO may extend these statutory filing deadlines if it determines that the Coronavirus emergency:

- 1) Materially affects the USPTO’s functioning;
- 2) Prejudices the rights of applicants, registrants, or others appearing before the USPTO; or
- 3) Prevents applicants, registrants, or others appearing before the USPTO from filing a document or fee.

The emergency period referenced by the CARES ACT began on March 27, 2020 and is set to end 60 days after the duration of the Coronavirus emergency.

Certain trademark filing deadlines that fall between March 27, 2020 and April 30, 2020 may be extended 30 days from their initial due date, if the delay was due to the COVID-19 outbreak. The USPTO defines a delay as being due to the COVID-19 outbreak to mean that a person associated with the filing or paying the fee must have been personally affected by the COVID-19 outbreak (including through office closures, cash flow interruptions, inaccessibility of files or other materials, trial delays, personal or family illness, or similar circumstances), such that the outbreak materially interfered with their timely filing or payment.

At this time, the extended deadlines only apply to the following:

- >> Response to an office action, including a notice of appeal;
- >> Statement of use or request for extension of time to file a statement of use;
- >> Notice of opposition or request for extension of time to file a notice of opposition;
- >> Priority filing basis, based on a foreign application or international registration;

- >> Transformation of an extension of protection to the U.S. into a U.S. application;
- >> Affidavit of use or excusable nonuse for U.S. registrations or international registrations extending to the U.S.; and
- >> Renewal application.

For all other situations where the COVID-19 outbreak prevents or interferes with a filing before the

Trademark Trial and Appeal Board, a motion or request for an extension or reopening of time can be made.

Finally, the USPTO stated that it remains open for the filing of trademark-related documents and fees and will continue to review the effect of the COVID-19 outbreak on trademark owners.

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