

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

MANAGING INTERNATIONAL PATENT PORTFOLIOS IN WAKE OF THE CORONAVIRUS OUTBREAK

March 26, 2020

Speaker: Jonathan Berschadsky, Partner, Merchant & Gould PC

Important Information

- ▶ During the presentation, all attendees are muted.
- ▶ This presentation is being recorded and will be available on the NYIPLA's website.
- ▶ **All questions can be sent to admin@nyipla.org and will be addressed by the speaker via e-mail.**

Managing International Patent Portfolios in Wake of the Coronavirus Outbreak

MATERIALS ARE AVAILABLE ONLINE:

WWW.NYIPLA.ORG/ASSNFE/EV.ASP?ID=1326

Hosted by the Patent Law & Practice and Programs Committees

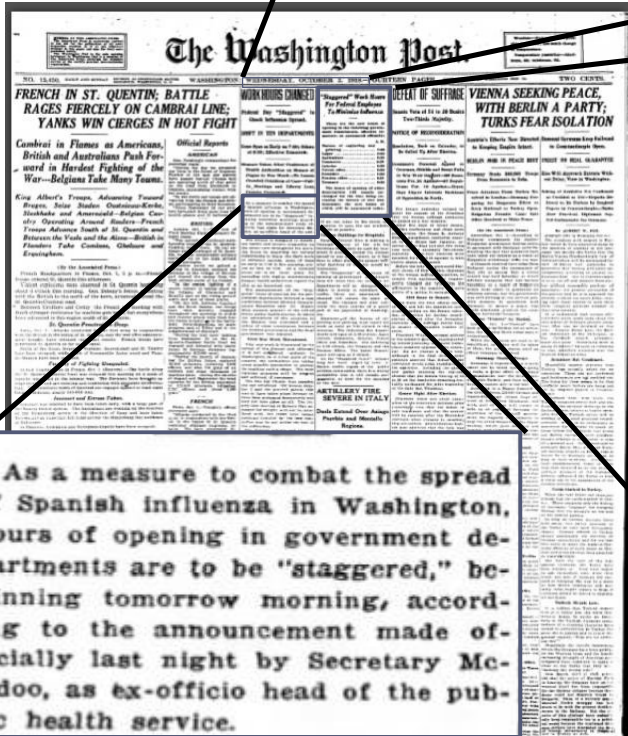
Coronavirus disease (COVID-19) Pandemic

- ▶ As of March 24: 375,498 cases in 195 Countries (*World Health Organization* | WHO)

This is not just a public health crisis, it is a crisis that will touch every sector, so every sector and every individual must be involved in the fight.

WHO Director General Tedros Adhanom Ghebreyesus

WEDNESDAY, OCTOBER 2, 1918.



As a measure to combat the spread of Spanish influenza in Washington, hours of opening in government departments are to be "staggered," beginning tomorrow morning, according to the announcement made officially last night by Secretary McAdoo, as ex-officio head of the public health service.

**"Staggered" Work Hours
For Federal Employees
To Minimize Influenza**

These are the new hours of opening in the following government departments, effective tomorrow, as announced officially:

A. M.

Bureau of engraving and printing	7:30
Labor	8:00
Agriculture	8:30
Commerce	8:30
Interior	8:30
Patent office	8:30
Postoffice	8:30
Pension office	9:30
Treasury	9:30

The hours of opening of other departments will remain unchanged for the time being excepting the bureau of war risk insurance, the new hours of which will be announced today.

More recently: Terrorist Attacks and Catastrophes

- ▶ September 11 Attacks
- ▶ Anthrax Attacks
- ▶ Northeast blackout of 2003

UNITED STATES POSTAL SERVICE INTERRUPTIONS

UNITED STATES POSTAL SERVICE INTERRUPTION AND EMERGENCY

The United States Postal Service (USPS) has informed the United States Patent and Trademark Office (USPTO) that as a result of the tragic event in New York City on September 11, 2001, all post offices in the borough of Manhattan are closed on September 12, 2001. These post offices will remain closed until further notice.

The USPTO is designating the interruption in the service of the USPS in the borough of Manhattan as a postal service interruption and an emergency within the meaning of 35 U.S.C. 21(a). Accordingly, the USPTO will consider the provisions of 37 C.F.R. 1.6(e) as now in effect. As soon as the USPTO receives further information from the USPS as to when postal services in the borough of Manhattan will be resumed, the USPTO will post the information on the USPTO website at www.uspto.gov and a final notice will be published in the Official Gazette regarding the postal interruption in New York City.

It would be appreciated if members of the public would bring to the USPTO's attention any other post office closings related to current events. Such information can be brought to the USPTO's attention by contacting Eugenia Jones by e-mail at eugenia.jones@uspto.gov or telephone at 703-306-5586, or by contacting Carol Smith by e-mail at carol.smith@uspto.gov or by telephone at 703-308-8910 (ext 149).

Coronavirus disease (COVID-19) Pandemic

Governor Cuomo has put NY State on PAUSE: All non-essential workers are directed to work from home, and everyone is required to maintain a 6-foot distance from others in public.

COVID-19 Update

Governor Murphy Announces Statewide Stay at Home Order, Closure of All Non-Essential Retail Businesses. [Learn More](#)



NOTICE: Executive order from Governor Lamont: All non-essential functions in Connecticut should suspend in-person operations beginning Monday, March 23 at 8:00 p.m. This excludes any entity providing essential services or functions, such as healthcare, food service, law enforcement, and similar services. Businesses are strongly encouraged to employ work-from-home procedures. Additional guidance for businesses regarding this order will be released over the weekend. >> [Read the Governor's announcement](#)

Resources – Most important information!

- ▶ Centers for Disease Control and Prevention (CDC)
 - ▶ www.cdc.gov
- ▶ World Health Organization
 - ▶ www.who.int
- ▶ State and Local Government (www.XY.gov; XY=state initials or state/town name (E.g., AL vs. Alaska))
 - ▶ www.ny.gov
 - ▶ www.nj.gov
 - ▶ www.ct.gov



USPTO Notices Regarding COVID-19

► www.uspto.gov

<https://www.uspto.gov/coronavirus>

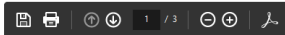
March 16, 2020

Relief Available to Patent and Trademark Applicants, Patentees and Trademark Owners Affected by the Coronavirus Outbreak

The United States Patent and Trademark Office (USPTO) considers the effects of the Coronavirus outbreak that began in approximately January 2020 to be an "extraordinary situation" within the meaning of 37 CFR 1.183 and 37 CFR 2.146 for affected patent and trademark applicants, patentees, reexamination parties, and trademark owners.

Patent-Related Correspondence – Petitions to Revive

For patent applicants or patent owners who were unable to timely reply to an Office communication due to the effects of the coronavirus outbreak, which resulted in the application being held abandoned or the reexamination prosecution terminated or limited, the USPTO will waive the petition fee in 37 CFR 1.137(m) when the patent applicant or patent owner files the reply with a petition under 37 CFR 1.137(a). See 35 U.S.C. § 410(b). The inclusion of a copy of this notice with the reply required to the outstanding Office communication will be treated as a representation that the delay in filing the reply was due to the effects of the Coronavirus outbreak, and as a request for *waiver* of the petition fee under 37 CFR 1.137(m). In addition, the petition under 37 CFR 1.137(a) must include a statement that the delay in filing the reply required to the outstanding Office communication was because the petitioner, applicant, or at least one inventor, was personally affected by the Coronavirus outbreak such that they were unable to file a timely reply. The USPTO advises any patent applicant or patent owner who seeks to file a petition to revive under 37 CFR 1.137(a) with a request to waive the petition fee under 37 CFR 1.137(m) due to the effects of the Coronavirus outbreak, to promptly file the petition under 37 CFR 1.137(a) (including the required statement) accompanied by the required reply (but not the petition fee under 37 CFR 1.137(m)) and a copy of this notice. The petition under 37 CFR 1.137(a) must be filed not later than two months of the issue date of the notice of abandonment or the notification that reexamination prosecution has been terminated under 37 CFR 1.550(d) or 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) in order to be entitled to a waiver of the petition fee under 37 CFR 1.137(m). If the patent applicant or patent owner did not receive a notice of abandonment or notification that reexamination prosecution has been terminated under 37 CFR 1.550(d) or 37 CFR 1.957(b) or limited under 37 CFR 1.957(c), the petition must be filed not later than six months after the date the application became abandoned or the reexamination prosecution was terminated or limited in order to be entitled to a waiver of the petition fee under 37 CFR 1.137(m). A petition to revive under 37 CFR 1.137(a) due to the effects of the Coronavirus outbreak may be submitted via EFS-Web using document code PET_RELIEF or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



March 19, 2020

3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2020-0018]

Waiver of Original Handwritten Signature Requirement Due to the COVID-19 Outbreak

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) considers the effects of the COVID-19 outbreak to be an extraordinary situation. Therefore, pursuant to the Office's authority, the USPTO is waiving its only regulatory requirements for an original handwritten signature personally signed in permanent dark ink or its equivalent for certain correspondence with the Office of Enrollment and Discipline and certain payments by credit card. In both instances, the Office will accept copies of handwritten signatures. The USPTO has no other requirements for original handwritten, ink signatures.

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USPTO Notices Regarding COVID-19

- ▶ USPTO waives original handwritten signature requirement
- ▶ Relief for USPTO customers affected by COVID-19
 - ▶ E.g., fees for revival of abandoned applications
- ▶ USPTO offices closed to the public
- ▶ USPTO events
- ▶ Interviews, oral hearings and in-person meetings
 - ▶ USPTO Automated Interview Request (AIR) Form

Patent-Related Time Periods that are not Extendable by Petition

- ▶ (1) period set forth in 35 U.S.C. § 119(a)-(d) to file a nonprovisional patent application claiming the benefit of a prior-filed foreign application
- ▶ (2) period set forth in 35 U.S.C. § 119(e) during which a nonprovisional application claiming the benefit of a prior filed provisional application must be filed in order to obtain benefit of the provisional application's filing date
- ▶ (3) copendency requirement of 35 U.S.C. § 120 between a parent application which issues as a patent and a later filed child application, which requires that the child application be filed prior to issuance of the parent application
- ▶ (4) three-month time period to pay the issue fee set forth in 35 U.S.C. §151
- ▶ (5) 35 U.S.C. § 304 two-month time period from the date of patentee service, for a requester to file, in an ex parte reexamination, a reply to a statement filed by the patentee

- ▶ www.wipo.int
- ▶ WIPO has moved to an almost entirely virtual work presence
- ▶ Last Updated: March 20, 2020
 - ▶ Operations Continuing for
 - ▶ Patent Cooperation Treaty (PCT)
 - ▶ the Madrid System for the International Registration of Marks
 - ▶ the Hague System for the International Registration of Industrial Designs
 - ▶ the Lisbon System for the International Registration of Geographical Indications
- ▶ WIPO's Arbitration and Mediation Center (AMC) is also continuing its important work in processing domain name disputes under the Uniform Domain Name Dispute Resolution Policy (UDRP) and other alternative dispute resolution cases
- ▶ Go to WIPO's Global IP Systems and the AMC for more information
- ▶ For IP offices and member states, netting payments as well as monthly and annual distribution payments are proceeding as scheduled

- ▶ www.epo.org
- ▶ EPO has moved to an almost entirely virtual work presence
- ▶ Last Updated: March 20, 2020
 - ▶ Oral Proceedings before Examining and Opposition Divisions
 - ▶ Postponed until further notice: all oral proceedings in examination and opposition proceedings scheduled until 17 April 2020 unless they have already been confirmed to take place by means of videoconferencing
 - ▶ Oral Proceedings before the Boards of Appeal
 - ▶ Will not be held in the premises of the Boards of Appeal until 17 April 2020
 - ▶ Remedies in case of non-observance of time limits
 - ▶ For Certain Situations!! Pending due dates will be extended to April 17, 2020

Other Patent Offices

- ▶ Discourage walk-in enquiries (ARIPO 3/19)
 - ▶ Most PTOs: online services will be maintained operational
- ▶ Business as usual (Sweden as of 3/24) → Suspended/modified operations
 - ▶ March 31st, April, 3rd, May 15th, “for an indefinite period”
- ▶ No deadline extensions → Various degrees of deadline extensions
 - ▶ Those with no deadline extensions note that applicants may still make request

Practice Recommendations

- ▶ Review your dockets each day for the next two weeks for any non-extendible dates that are outside of USPTO's authority to extend
 - ▶ Bar dates
 - ▶ Conversion and/or foreign priority one year dates
- ▶ Prepare summary e-mails – both internally and for clients
 - ▶ What you are working on?
 - ▶ Issues?
 - ▶ E.g., Does action (in any country) depend on the action of a foreign client in a country where the government has restricted travel or postal/delivery services?
- ▶ Daily billing

Practice Recommendations, con't.

- ▶ Consider filing “contingency” applications in their current form
 - ▶ File with deferred fees
 - ▶ Can be later abandoned if and when a final/complete utility application is filed before the actual bar date
- ▶ Know how to electronically file yourself
- ▶ Know how to access the USPTO payment system
 - ▶ Credit card or deposit account
 - ▶ Payment may be required to meet a due date
 - ▶ **OR** consider an explicit pre-authorization for fees to be drawn from deposit account
- ▶ Prepare for network bandwidth limitations
 - ▶ Download docs during off hours
 - ▶ Work locally, then upload

Stay well, be safe.

“

The time is now to show some kindness, to show some compassion to people, show some gentility - even as a New Yorker.

”

Governor Andrew M. Cuomo, March 21, 2020