

Attorneys Optimistic Pandemic Won't Disrupt USPTO Filings

By Ryan Davis

Law360 (March 17, 2020, 9:02 PM EDT) -- The U.S. Patent and Trademark Office can't extend filing deadlines during the COVID-19 pandemic, but attorneys said patent and trademark prosecution should stay on track, with minimal use made of the office's offer to waive fees related to applications abandoned during the crisis.

The USPTO announced Monday that because many filing deadlines are set by statute, it has no authority to extend them due to the outbreak, as the European Patent Office has done. Instead, the office said it would waive the fee to file petitions seeking to revive patent and trademark applications abandoned because deadlines were missed due to the virus.

While everyone in the world is coming to terms with the ramifications of widespread remote work and lockdowns spurred by COVID-19, attorneys said so much of patent and trademark prosecution takes place online that it should keep running smoothly for now, though that could change.

"So far, we haven't encountered problems with clients not being able to meet deadlines, but we are at the very early stages of more clients, both domestically and around the world, dealing with quarantines and working from home," said Allison Strickland Ricketts, a trademark attorney at Fross Zelnick Lehrman & Zissu PC. "So I think it remains to be seen what kind of effect it will have."

Most attorneys can still work remotely, communicate with clients, and access firm computer systems necessary for patent and trademark filings, so "as far as I'm concerned, we can continue with business as usual," Daniel Jones of Michael Best & Friedrich LLP said.

Maintaining the normal routine of patent and trademark prosecution will be a welcome respite from all the uncertainty the world is facing, according to Bryan Wheelock of Harness Dickey & Pierce PLC.

"It's kind of nice to come in and have some normalcy: Look at the docket and make some filings," he said. "Our attorneys and staff appreciate that there's something still normal in your life. Clients like it, too: They're all hunkered down and looking for something to do."

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McKool Smith

However, if attorneys, corporate clients or inventors fell seriously ill with the virus, or internet or computer systems are disrupted during the crisis, that would cause problems, attorneys said.

"I think everything is going to keep running smoothly, but I'm sure there will be some subset of people that are indeed personally affected," Scott Hejny of McKool Smith PC said. "Very likely there's going to be inventors or attorneys who get infected with coronavirus, maybe to the point where they can't effectively participate in prosecution or represent their clients."

Even in those situations, attorneys would continue to do their best to keep meeting deadlines, both because it's their job and because the potential relief offered by the patent office is limited. It applies only when a failure to meet deadlines to respond to USPTO communications results in an application being abandoned.

"Abandonment is the third rail of patent law. We don't want to go there," Wheelock said. "I can't imagine anyone thinking, 'We'll let that deadline go because the office made it easier to revive.' They did what they could. It signals reasonableness on the part of the office, but we've got to make our deadlines: We want to and our clients want us to."

The office specifically waived the fee to file a petition seeking to revive an application abandoned because an applicant couldn't file a timely response to the office due to the crisis. It requires petitioners to include a statement explaining how an attorney, applicant or inventor "was personally affected by the coronavirus outbreak" such that they couldn't respond.

The office's announcement included numerous important limitations, Hejny said. It only applies to failures to timely respond to office actions, not missed statutory deadlines that can't be excused, like those related to when a patent application or Patent Trial and Appeal Board petition must be filed. And there's no guarantee the petitions that can now be filed for free will be granted.

"It doesn't imply that the PTO is going to be more lenient in reviving applications," Hejny said. "That's something that's going to have to be seen going forward."

The office's statement also "calls into question what it means to be 'personally affected' by the coronavirus outbreak," he said. Whether the office interprets that to mean situations where someone is unable to leave home during a quarantine, or only those where a person was actually infected with the virus, "that's going to have to be determined on a case-by-case basis."

As a result, it's not clear how often those requests to revive applications will be granted, or what criteria the office will use to evaluate them, Ricketts said.

"People miss deadlines and file petitions to revive all the time, and I'm sure that will continue to happen," she said. "Whether or not they'll be able to convince the office that it was due to the effects of the coronavirus outbreak, as opposed to plain old unintentionally missing the deadline, remains to be seen."

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GERALD MURPHY
Birch Stewart

In addition to problems caused by illness or quarantine, the possibility of disruptions caused by technical problems might be cause for concern going forward, Gerald Murphy of Birch Stewart Kolasch & Birch LLP said.

"I'm really more worried about the patent office's computer system going down or the attorney's computer system going down," he said. "Then you can't effectively do e-filing if you're up against a statutory deadline."

Having millions of people working from home all at once also puts a spotlight on some of the USPTO's other procedures, including its decision not to adopt commercial e-signing technology like DocuSign that is widely used in the business world, Ricketts said.

As a result, many clients print out documents, sign them in ink and scan them back in. The number of people now working from home who may not have a printer or a scanner has shown the limits of that system, and how helpful it would be if the office accepted standard e-signing technology, she said.

"This current crisis illustrates the need for the office to get a little bit more modern in terms of the signature methods that they accept," Ricketts said.

Beyond missed deadlines and potential technical issues, the drastic economic toll the pandemic has already taken could cause some companies to rethink their intellectual property strategies in light of budgetary constraints, Hejny said.

While companies involved in ongoing matters will likely see them through, "the impact on the economy could absolutely have impacts on clients that will leak over to what is or isn't done at the Patent and Trademark Office," he said.

During a major global crisis, the USPTO's decision to waive the fee for abandonment petitions is only a small step, but "it was kind of nice for the patent office to do something in advance, as opposed for waiting for things to fall off the edge," Wheelock said.

--Editing by Breda Lund and Emily Kokoll.

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