

USPTO Meetings Ban Due To Virus Unlikely To Disrupt Cases

By Ryan Davis

Law360 (March 13, 2020, 8:02 PM EDT) -- The U.S. Patent and Trademark Office on Friday called off all in-person meetings, including Patent Trial and Appeal Board hearings, in favor of phone or video conferences due to the COVID-19 pandemic, a move attorneys say should cause only minimal disruptions.

The USPTO office said that face-to-face meetings between applicants and patent and trademark examiners, along with hearings before the PTAB and Trademark Trial and Appeal Board, will not take place until further notice. Parties will instead receive instructions about how to proceed with teleconferences or phone calls, it said.

The decision came one day after the Federal Circuit began canceling some oral arguments or holding them over the phone due to the viral outbreak. While that is uncharted territory for an appeals court, USPTO practitioners frequently communicate with the office electronically, so the new restrictions should be an easy adjustment, attorneys say.

“If any agency is ready for this, it’s the patent office,” said Kevin Noonan of McDonnell Boehnen Hulbert & Berghoff LLP.

Many patent examiners work from home and don’t often meet with applicants to begin with, and PTAB judges are located around the country and frequently teleconference into oral hearings under normal circumstance, he noted.

“Unlike the Federal Circuit, where people really do want to be in front of the judges and have that back-and-forth with them, the patent office is perfectly ready for this structurally,” Noonan said.

Other intellectual property agencies announced pandemic-related closures and restrictions Friday. The U.S. International Trade Commission said it was postponing all in-person hearings in Section 337 intellectual property cases scheduled to take place in the next 60 days, but that cases will proceed otherwise. The U.S. Copyright Office said it will be closed to the public until at least April 1.

For PTAB practitioners, in-person interaction with the board is the exception rather than the rule, so “I believe the disruptions from the PTAB going remote will be minimal,” said Alex Yap of Morrison & Foerster LLP, who was a PTAB judge for four years before joining the firm in January.

He noted that all the board's judges have laptops capable of videoconferencing and often handle disputes over the phone, and some attend hearings remotely.

"From the beginning of the proceeding, most of the contact with the judges at the PTAB is by teleconference, except for the final hearing. So everyone is used to that," said Jon Wright of Sterne Kessler Goldstein & Fox PLLC.

He noted that even the oral hearing often has one judge who is teleconferencing from elsewhere, so most attorneys have experience with that arrangement.

"The best oral advocacy at hearing is a conversation, and a conversation is best done in person," Wright said. "Doing it telephonically or by videoconference is less than ideal, but I think this is completely preferable to having the system grind to a halt."

One challenge that may arise is that deadlines have recently become tighter in some cases with the introduction of new PTAB procedures for amending patents, in which the board provides feedback on proposed amendments. In those cases, "less wiggle room for modifications" and any pandemic-related delays could cause more issues, Wright said.

With so many people around the world working remotely due to the pandemic, conducting discovery or performing depositions might be more difficult, but attorneys said they expect the parties and the board to work together to manage those situations.

"I can definitely see issues with depositions of foreign witnesses until this is all cleared up," said Joseph Palys of Paul Hastings LLP.

Some people may not want to travel for depositions, or may be unable to enter the U.S. due to travel restrictions or unwilling to be deposed in public places. However, when that happens, "I expect the board will make allowances when virus situations require delay," Wright said.

He added that he hopes all parties recognize the public health danger facing the country and will work together to keep the system moving smoothly because "if everyone is on the same page, that's how we'll get through the pandemic."

"It would be terrible if anyone tried to have a strategy to leverage the situation to try to gain some advantage or perceived advantage for their clients," he said. "We should deal with things in an equitable way that's fair to both sides, and I think that will happen. It's a collegial bar."

The USPTO has an example to look to with its counterpart in China, where the outbreak began. The China National Intellectual Property Administration "has been flexible with regard to deadlines that have been impacted by coronavirus," said Charles Gray of Kilpatrick Townsend & Stockton LLP's Shanghai office.

The time limits for responding to office actions or paying fees have been extended when the parties can show that they need more time because they were infected or quarantined or offices were closed due to a government order, with no fees imposed for making the request, he said.

"The idea is for people not to be fearful of missing a deadline due to coronavirus," Gray said.

He pointed out that his firm's office was closed and he returned to the U.S., while most clients worked remotely because of government orders, and the patent office has taken that into account.

China is beginning to get back to normal, he said, and he hopes to return to Shanghai in a few weeks. The situation is still evolving in the U.S., but attorneys said the steps taken by the IP agencies to close or restrict access have been prudent.

"When you weigh the risk that the world is dealing with now with the virus, the PTO made the right decision," Palys said.

--Editing by Philip Shea and Kelly Duncan.