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TOP IP LAWYERS

USPTO offers pendency exception for COVID-19-related trademark applications

By Sui Q. Duong

The United States began grappling with the start of what would become the COVID-19 pandemic over a year ago. State and local governments all over the United States established limits on public gatherings, many workplaces adopted working from home, and students from elementary school to college adjusted to online learning.

The medical industry mobilized to address long and short-term challenges like the development of an effective vaccine and the manufacture of adequate personal protective equipment supplies. The medical community worked with urgency to develop the science and logistical infrastructure necessary to bring their products and services to market. Along the way, attorneys worked in tandem to file patent and trademark applications to protect the innovation and economic value being created in that space. While many in the medical community undoubtedly worked with a sense of urgency, anyone who has experience with filing patent or trademark applications will know the U.S. Patent and Trademark Office does not always work at an urgent pace.

On the "T" side of the USPTO, a federal agency whose stated mission is precisely to foster innovation, competitiveness and economic growth domestically and abroad, just 622 trademark examining attorneys were employed in 2020 to review 738,112 trademark filings, according to the United States Patent and Trademark Office Performance and Accountability Report for FY 2020. With expected wait times between 75 days and 105 days for even initial review of a filed trademark application, those in the medical community looking for a speedy decision on whether a new product name for a new COVID-19 treatment would register were not likely to find one.

At least this was the case before the USPTO created a process to prioritize examination of trademark applications covering certain COVID-19-related products and services. In an unprecedented move, the USPTO Office of Trademarks announced it would deviate from its typical First Filed, First Examined modus operandi. Rather than examining qualifying applications in the order they were filed, applicants seeking registration of certain COVID-19-related medical products and services could jump to the front of the line under this new policy. Authority for the USPTO to prioritize certain applications during extraordinary situations is exercised under 37 C.F.R. Section 2.148.

In a June 12, 2020 public notice announcing the policy, the USPTO presented the requirements necessary for obtaining priority examination of a trademark application. Simply specifying your products or services are aimed at relieving the COVID-19 pandemic is not enough to immediately get an application in front of a USPTO trademark examining attorney however. Instead, the notice first makes clear only certain products and services qualify. The June 12 notice tells that suitable products and services that qualify for priority examination include, but are not limited to, pharmaceutical and medical products like diagnostic tests, ventilators, and personal protective equipment as well as direct medical services or medical research aimed at preventing, diagnosing, treating, or curing COVID-19. If applicants seek priority examination for a product, the product must be an item that is subject to approval by established FDA protocols. These existing FDA protocols include:

- Biologics License Applications ("BLA")
- Emergency Use Authorizations ("EUA")
- Investigational Device Exemptions ("IDE")
- Investigational New Drug Applications ("IND")
- New Drug Applications ("NDA")
- Premarket Approvals ("PMA")

This FDA requirement is notably unnecessary for services seeking priority examination, only products.

Second, the June 12 notice requires applicants of qualifying products or services to separately petition the USPTO for priority examination outside of its main trademark application filing. Applicants do not simply opt for priority examination in the application filing itself. The USPTO instead requires applicants to file a trademark application through the normal application processes and, only after filing, separately file a petition to the director requesting priority under this COVID-

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19 policy. The petition must specify the reasons why the applied-for products or services qualify. This article's author would have preferred a special designation within the application itself but this two-step process likely ensures a decision on priority examination qualification is reviewed by a small trained team of policymakers rather than the sprawling trademark examining attorney corps. In an applicant-friendly move, the USPTO decided to waive the typical $250 to $350 fee for petition filings.

As the pandemic begins to wind down, an interesting question exists about how long this process will, and should, continue. While the United States is nowhere near moving past the current pandemic, three vaccines are currently available to combat COVID-19 and more institutions return to their pre-pandemic states daily. The USPTO has not announced a termination date for the priority examination policy and the June 12 notice announcing its creation tells that any termination of it will be preceded by appropriate public notice. Figures for how many trademark applications have obtained priority examination through this new policy are currently unavailable. Despite the current lack of information, this article's author is interested in learning about the policy's popularity and even the precise number of applications which benefited from priority examination under it.

If the policy is popularly utilized, the trademark bar may express interest in maintaining at least some form of it. The existence of the policy also prompts the question of not just whether it should be maintained but also expanded. With still only 622 examining attorneys tasked with reviewing an ever-increasing number of trademark filings, should the USPTO use what it learned from this episode to perpetually prioritize certain applications? Such a change could not occur without a protracted rulemaking process, and perhaps even legislative action, but if this practice does come to pass, it would have roots in the current pandemic.

The USPTO's June 12, 2020 public notice Relief Available to Trademark and Service Mark Applicants in View of the COVID-19 Outbreak is available online at https://www.uspto.gov/sites/default/files/documents/TM-COVID-19-Prioritized-Examination.pdf. ■