

# CORONAVIRUS OVERCOMING THE DIFFICULTIES

## IP OFFICES TAKE PRACTICAL MEASURES MADE NECESSARY BY THE CORONAVIRUS LOCKDOWN

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In response to the Covid-19 outbreak, all non-essential industries and activities have been locked down in Italy, and other European countries have taken steps that go in the same direction. Services pertaining to Intellectual Property make no exception.

As a consequence of the restrictive measures adopted by national Governments against the spread of the infection, IP Offices at national, European and International level issued **ad hoc provisions** aimed at averting adverse impacts on the proceedings falling within their competence and, ultimately, on the **protection of the IP rights** concerned.

In general, the **practical remedies** revolve around the suspension of procedural terms, as well as measures of internal reorganization of the Office through remote working, in order to ensure the continuity of the services provided and an efficient handling of transitional issues. Besides, there is an overarching commitment to keep users informed and updated, also through dedicated online sections in official websites.

### Italian Patent and Trademark Office (UIBM)<sup>1</sup>

First, by a Decree of the *General Directorate for the Protection of Industrial Property - Italian Patent and Trademark Office* dated 11 March 2020 (**Directorial Decree**), the UIBM **suspended the terms** expiring during the period from 9 March to 3 April 2020 for proceedings falling within its competence, without the need for the parties to submit any specific request. An exception was made for specific terms, namely the mandatory deadlines of opposition proceedings to trademark registration under Article 176 of the Italian Industrial Property Code (IPC) and the appeals notified under Article 147, para. 1, IPC.

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<sup>1</sup> See COVID-19: *Decreto direttoriale che sospende i termini in scadenza per i procedimenti di competenza dell'UIBM*, available in the UIBM website: [LINK](#).

In order to benefit from the suspension, users will only need to specify, when filling the paper or digital form prescribed for the accomplishment concerned once the suspension has expired, that the ordinary term was not met because of the Covid-19 sanitary emergency, pursuant to the abovementioned Directorial Decree.

In issuing the Directorial Decree, the UIBM took into consideration Article 3 of the Implementing Regulation to the Industrial Property Code<sup>2</sup>, which deals with the extension of terms expiring on a day when the receiving competent Offices are closed, including in case of events causing service disruptions.

Second, Decree Law no. 18 of 17 March 2020, the so-called *Cura Italia* Decree (**Care Italy Decree**), which is in force, also reflects on the measures taken by the UIBM and its activities. In particular, Article 103, para. 1, of the *Care Italy* Decree provides the suspension for the period from 23 February to 15 April 2020 of all terms, including mandatory ones, relating to administrative proceedings, upon request of a party or *ex officio*, which were pending on 23 February 2020 or initiated after that date. Moreover, paragraph 2 of said Article 103 states that any certificate, attestation, permit, concession, authorization or other enabling act howsoever named, expiring during the period from 31 January to 15 April 2020, retains its validity until 15 June 2020.

As a result, the preexisting provisions of the Directorial Decree were extended, from both a temporal and substantive point of view. More particularly, the **suspension of terms for proceedings before the UIBM** now covers the period from 23 February to **15 April 2020**; at the end of this period, the remainder of the suspended term will start to run again. Besides, such suspension now **also includes mandatory deadlines of opposition proceedings** to trademark registration under Article 176 IPC, because these deadlines can be suspended only by provisions of legislative rank, such as those contained in a Decree Law.

Conversely, as clarified in the UIBM website, terms of appeals before the *Commissione dei Ricorsi* (Board of Appeal) remain at this time outside the scope of the suspension introduced by the *Care Italy* Decree and the Directorial Decree, since they refer to proceedings of jurisdictional, rather than administrative, nature.

Besides, the life and renewal of Industrial Property rights filed with the UIBM, which already fell within the scope of the Directorial Decree, are now subject to the broader provision of Article 103, para. 2, of the *Care Italy* Decree. Hence, **IP rights expiring from 31 January to 15 April 2020 will remain valid until 15 June 2020**. After that date (always based on the existing legislation), it will be up to the interested person, who wishes to keep his IP right in effect or renew it, to take action for that purpose in the ordinary forms, with payment of fees etc being due by 30 June 2020.

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<sup>2</sup> Decree of the Minister of Economic Development no. 33 of 13 January 2010 setting out the Implementing Regulation to the Industrial Property Code, Article 3: "... **Termini per il deposito** 1. **Se i termini prescritti per il deposito di domande, atti, documenti, ricorsi notificati di cui all'articolo 147, comma 1 del Codice e delle traduzioni in lingua italiana delle rivendicazioni delle domande di brevetto europeo e dei testi pubblicati dei brevetti europei concessi o mantenuti in forma modificata, di cui agli articoli 54 e 56 del Codice, e per il versamento di tasse scadono di sabato, di domenica o in un giorno festivo nazionale, ovvero in un giorno nel quale gli uffici competenti a ricevere il deposito sono, per qualsiasi causa, chiusi, la scadenza è prorogata al primo giorno successivo nel quale gli uffici stessi sono aperti.** Uguale proroga è concessa quando si tratti di chiusura determinata da festività locali o di **eventi interruttivi del servizio, incluso quello telematico, che riguardino singoli uffici**, a condizione che l'ufficio ricevente sia: a) per il deposito di domanda con rivendicazione di priorità, quello della residenza o della sede del richiedente o del suo mandatario; b) per gli adempimenti successivi al deposito di una domanda, per gli atti o per i ricorsi, quello in cui era stata depositata la domanda. Nel caso in cui, precedentemente all'adempimento successivo, la domanda sia stata trasferita ad altro richiedente o sia stato modificato il mandatario, si applica la disposizione di cui alla precedente lettera a). 2. I termini richiamati al comma 1 si considerano inoltre rispettati quando la loro mancata osservanza sia stata determinata da **interruzione, anche all'estero, del servizio postale utilizzato**, salvo che norme speciali contenute in convenzioni internazionali, cui la Repubblica Italiana abbia aderito, prevedano una disciplina diversa, a condizione che il plico sia stato spedito, con un servizio di posta che attesti la ricezione della documentazione, almeno cinque giorni prima della scadenza del termine, sempre che non fosse già in atto l'interruzione. 3. L'interessato deve **precisare e provare la causa che gli ha impedito di osservare i termini prescritti** ...".

Lastly, it is worth adding that, in view of the limitations imposed to working activities within the Office, the UIBM decided the deferral/extension of the terms relating to three financial aid schemes, namely **Disegni +4** (for the enhancement of industrial designs/models), **POC 2020** (for programs of patent enhancement) and **Marchi +3** (for EU and International trademark registrations)<sup>3</sup>.

## European Union Intellectual Property Office (EUIPO)<sup>4</sup>

After the Spanish Government activated a “state of alarm” due to the spread of COVID-19 across the country, the EUIPO closed its headquarters in Alicante and postponed all upcoming scheduled events. The EUIPO Executive Director authorized the activation of the Office’s **business continuity protocol**, with the effect that the EUIPO staff started working from remote.

However, the EUIPO committed itself to keep providing its services as usual, as far as possible under the circumstances: in particular, as users can read in the EUIPO website, “... *Trade mark and design applications will continue to be received, examined and published, and the Office will continue to send communications and set deadlines. Bulletins will continue to be published as usual. Our Information Centre and Second Line will continue to operate as normal to receive queries by phone or email ...*”; furthermore, “... *we will be publishing regular updates on our website and through our social media channels ...*”.

An important measure was taken by a **Decision of the EUIPO Executive Director** dated 16 March 2020<sup>5</sup> (**Decision**), whereby **all time limits** expiring between 9 March and 30 April 2020 inclusive that affect all **parties in proceedings before the Office** are **extended until 1 May 2020** (in practice May 4, because May 1 is a public holiday followed by a weekend). Such extension was decided in accordance with Article 101, para. 4, of the European Union Trademark Regulation (EUTMR)<sup>6</sup> and Article 58, para. 4, of the Community Design Implementing Regulation (CDIR)<sup>7</sup>.

In order to provide further guidance on the implementation of the Decision, the Office issued certain clarifications on the time limits affected by the extension, the nature of the extension and the measures to adapt communications sent to users.

As regards the time limits affected by the extension, the EUIPO website specifies that “... *The reference to ‘all time limits’ is to be read literally and encompasses all procedural deadlines, irrespective of whether they have been set by the Office or are statutory in nature (i.e. are stipulated directly in the Regulations) ...*”.

<sup>3</sup> See *Covid-19: differiti i termini di 3 bandi UIBM*, available in the UIBM website: [LINK](#).

<sup>4</sup> See *COVID 19 Update: measures in place after activation of ‘state of alarm’ in Spain*, available in the EUIPO website: [LINK](#).

<sup>5</sup> See *Decision No EX-20-3 of the Executive Director of the Office of 16 March 2020 concerning the extension of time limits*, available in the EUIPO website: [LINK](#).

<sup>6</sup> Article 101, para. 4, Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark: “... **If an exceptional occurrence, such as a natural disaster or strike, interrupts or interferes with proper communication from the parties to the proceedings to the Office or vice-versa, the Executive Director may determine that for parties to the proceedings having their residence or registered office in the Member State concerned or who have appointed a representative with a place of business in the Member State concerned all time limits that otherwise would expire on or after the date of commencement of such occurrence, as determined by him, shall extend until a date to be determined by him. When determining that date, he shall assess when the exceptional occurrence comes to an end. If the occurrence affects the seat of the Office, such determination of the Executive Director shall specify that it applies in respect of all parties to the proceedings ...**”

<sup>7</sup> Article 58, para. 4, Commission Regulation (EC) no. 2245/2002 of 21 October 2002 implementing Council Regulation (EC) no. 6/2002 on Community designs: “... *If an exceptional occurrence such as natural disaster or strike interrupts or dislocates the proper functioning of the Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month of the notification of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as determined by the President of the Office ...*”

Among others, the following statutory time limits **covered** by the extension are exemplified:

- Payment of the Application Fee (Article 32 EUTMR)
- Right of Priority (Article 34(1) EUTMR and Article 41 CDR, Community Design Regulation)
- Exhibition Priority (Article 38(1) EUTMR and Article 44 CDR)
- Opposition Period (Article 46(1) EUTMR)
- Payment of the Opposition Fee (Article 46(3) EUTMR)
- Request for Renewal (Article 53(3) EUTMR and Article 13 CDR)
- Filing of an Appeal and of the Statement of Grounds, payment of the Appeal Fee (Article 68 (1) EUTMR and Article 57 CDR),
- Conversion (Article 139 EUTMR)
- Deferment of publication of design (Article 50 CDR).

The reference in the Decision to “**proceedings before the Office**” means that time limits relating to proceedings **before other authorities** are **not covered** by the extension. In particular, this is the case of the time limit for bringing an appeal before the General Court against decisions of the EUIPO Boards of Appeal (Article 72(5) EUTMR and Article 61 CDR). Besides, the same expression **only relates to trademark and design matters**. Therefore, time limits relating to other subjects, such as employment, procurement or governance matters remain **uncovered** by the Decision.

As to the **nature of the extension**, it is pointed out that this has the immediate effect of preventing the deadlines concerned from lapsing when they were originally due, and of setting a new generally applicable expiry date (i.e. 1 May 2020, in practice 4 May). This effect is **automatic**. Hence, the affected parties are not required to file an application to the Office in order to positively obtain the extension. However, “... *in case the parties are in a position to meet either the original or the extended deadline, and choose to discharge their procedural obligations during that period, the procedure will take its usual course and any documents filed will be examined in the regular manner ...*”

Users whose time limits are affected **will not be informed individually** of extensions granted. However, “... *The Office has done its utmost to adapt its IT systems in such a way as to guarantee a seamless treatment of the time limits that were due to expire before the extension date. However, in the unlikely event that a communication from the Office does not adhere to the given extension, the Office will address the case immediately by issuing a rectification ...*”

## World Intellectual Property Organization (WIPO)<sup>8</sup>

The World Intellectual Property Organization published a number of important notices in its website concerning operations under WIPO-Administered Treaties and WIPO’s Arbitration and Mediation Center (AMC) for domain name disputes.

In general, the Organization activated its **business continuity protocol** and, in line with public health authorities’ guidance to curb the further spread of Covid-19, put in place remote working arrangements for most of its staff. Only a small pool of critical personnel retains access to the Geneva headquarters and all meetings are postponed or cancelled through the end of April.

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<sup>8</sup> See *Covid-19 Update: WIPO’s IP Services*, available in the WIPO website: [LINK](#).

The WIPO has committed to ensure that any transitional issues experienced by users, IP Offices and any other stakeholders in proceedings and processes before the Organization are kept to a minimum, and specified that netting payments, as well as monthly and annual distribution payments, for IP Offices and Member States continue as scheduled.

Specific remedies are available within the **Madrid System for the International Registration of Marks (Madrid System)**<sup>9</sup>.

In a situation where means of communication may become impracticable because of lockdown, quarantine, self-isolation or other restrictive measures, certain Rules of the *Regulations under the Protocol Relating to the Madrid Agreement* (the Regulations) may apply. In particular, pursuant to Rule 5(1), (2) and (3) of the Regulations, **users of the Madrid System who have failed to meet a time limit for a communication addressed to the WIPO can be excused** if they send that communication within five days after regaining access to mail, delivery services or electronic communications. Users must provide adequate evidence of the reason why the WIPO should excuse the failure (such as an official announcement or an attestation by a certified physician). In any event, the WIPO must receive the communication concerned no later than six months from the date on which the original time limit expired.

As a general recommendation aimed to mitigate the negative effects of possible disruptions in postal or delivery services, the WIPO strongly encouraged applicants, holders, their representatives and IP Offices to use **electronic communications**. In particular, applicants, holders and representatives are urged to provide an e-mail account to receive electronic communications from the WIPO; they are also firmly advised to use the available **e-Services** (among others, e-Payment and e-Renewal).

Besides, without giving any reason or providing any evidence, holders or applicants who have failed to meet time limits indicated in specific Rules may request the **continued processing** of the International application, subsequent designation, payment or request concerned: see Rules 11(2) and (3), 20*bis*, 24(5)(b), 26(2), 34(3)(c)(iii) and 39(1) of the Regulations. In order to apply for continued processing, applicants or holders must present an official form to the WIPO within two months from the date on which the original time limit expired, and comply with all requirements prescribed.

Furthermore, an **automatic extension of time limits** applies under Rule 4(4) of the Regulations, whereby “... *If a period expires on a day on which the International Bureau or the Office concerned is not open to the public, the period shall ... expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public ...*”. Hence, all time limits under the Madrid System that concern the IP Office of any Contracting Party, such as the time limit for that Office to send a provisional refusal to the WIPO and the time limit for the holder to respond to a notification of provisional refusal, would be extended accordingly. IP Offices should inform the Organization of their closure, also specifying the dates on which they will not be open to the public and will reopen.

Similarly, under the **Hague System for the International Registration of Industrial Designs (Hague System)**<sup>10</sup> **specific remedies** are available in case of disruptions to communication

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<sup>9</sup> See *Covid-19: Remedies and Extension of Time Limits Available for Madrid System Users*, available in the WIPO website: [LINK](#).

services involving a failure to meet a prescribed time limit, and an extension of time limits is provided in case of closure of the Office of a Contracting Party.

As regards the **Patent Cooperation Treaty (PCT)**<sup>11</sup>, the International Bureau (IB) and the IB as Receiving Office remain open for purposes of **filing and processing PCT applications**. Reference is also made to upcoming practical advice on possible remedies in the case of missed time limits where the PCT Office with which an action needs to be taken is exceptionally closed, or if the applicant's or agent's company/firm is forced to close temporarily.

## European Patent Office (EPO)<sup>12</sup>

The European Patent Office has posted several updates concerning the actions taken during the past few days, in the aftermath of the epidemic outbreak.

One of the main measures adopted by EPO is the decision to **put off until further notice all oral proceedings before the Examination and Opposition Divisions scheduled until 17 April 2020**, unless they were previously confirmed to take place by means of videoconferencing. Meanwhile, the Office will explore options for further facilitating, where applicable, the use of videoconferencing in oral proceedings.

All parties involved will receive separate notifications about a postponement as soon as possible. In order to ensure that they are informed in due time, the Office may exceptionally resort to additional means of communication, like email messages. The notice of postponement will also be available via the European Patent Register shortly after its dispatch. The relevant announcement specifies that other activities performed by the Search, Examining and Opposition Divisions will continue.

Also judicial activities within the Boards of Appeal have been limited. **Oral proceedings will not be held at the premises of the Boards of Appeal until 17 April 2020**, and the parties will be informed accordingly. On the other hand, the Boards of Appeal will continue to issue written decisions, as well as communications and summonses to oral proceedings.

**Other measures** taken by EPO include: the postponement of all events organized in March, April and May 2020 (with organizers being committed to contact participants on an individual basis and, where possible, inform them of any new dates); the request to external partners to abstain from visiting the Office if they have recently visited a high risk area; remote working arrangements for staff, while ensuring the full functioning of technical infrastructures.

Further, remedies are offered in case of **non-observance of time limits caused by the disruptions** connected with the sanitary emergency, applying to parties and representatives in proceedings under the European Patent Convention (EPC) and the Patent Cooperation Treaty (PCT). Such remedies were taken within the framework of specific provisions of the *Implementing*

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<sup>10</sup> See *Remedies Available in Case of Failure to Meet a Time Limit and Extension of Time Limits in Case of Closure*, available in the WIPO website: [LINK](#).

<sup>11</sup> See *Covid 19 Pandemic: International Bureau and International Bureau as Receiving Office Remain Open for the Purposes of Filing and Processing of PCT Applications*, available in the WIPO website: [LINK](#).

<sup>12</sup> See *Coronavirus (COVID-19) - continually updated information*, available in the EPO website: [LINK](#).

*Regulations to the European Patent Convention (EPC Implementing Regulations) and the Regulations under the Patent Cooperation Treaty (PCT Regulation).*

Rule 134(2) of the EPC Implementing Regulations provides that “... *If a period expires on a day on which there is a general dislocation in the delivery or transmission of mail in a Contracting State, the period shall extend to the first day following the end of the interval of dislocation for parties which are resident in the State concerned or have appointed representatives with a place of business in that State. Where the State concerned is the State in which the European Patent Office is located, this provision shall apply to all parties and their representatives ...*”.

According to an EPO Notice dated 15 March 2020<sup>13</sup> (**Notice**), the restrictions on movement and circulation of persons, as well as on certain services, exchanges and public life in general, that Germany (the State in which the main EPO Office is located), like many other Contracting States, is experiencing can be qualified as a “**general dislocation**” within the meaning of Rule 134(2). Thus, **periods expiring on or after the date of that Notice are extended for all parties and their representatives until 17 April 2020**. If the dislocation continues beyond this date, the aforesaid period may be further extended.

The Notice also refers to Rule 134(5) of the EPC Implementing Regulations, whereby : “... *a party concerned may produce evidence that on any of the ten days preceding the day of expiry of a period the delivery or transmission of mail was dislocated due to an exceptional occurrence such as a natural disaster, war, civil disorder, a general breakdown in any of the means of electronic communication permitted by the President of the European Patent Office ..., or other like reasons affecting the locality where the party or his representative resides or has his place of business. If the evidence produced satisfies the European Patent Office, a document received late shall be deemed to have been received in due time, provided that the mailing or the transmission was effected at the latest on the fifth day after the end of the dislocation ...*”.

This provision, as highlighted in the Notice, offers a **safeguard** in case non-observance of a time limit is a result of **exceptional circumstances beyond one’s control affecting the locality where an applicant, party or representative resides or has his place of business**. Hence, it may be invoked by any applicant, party to proceedings or their representatives affected by a disruption in the areas affected by the outbreak.

Lastly, the Notice mentions Article 150(2) EPC, whereby “... *International applications filed under the PCT may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of the PCT and its Regulations shall be applied, supplemented by the provisions of this Convention. In case of conflict, the provisions of the PCT or its Regulations shall prevail ...*”.

As regards **time limits and conditions applicable under the PCT**, reference is made to Rule 82*quater*.1 of the PCT Regulation. In particular, according to the Notice “... *where the interested party offers satisfactory evidence that a time limit under the PCT was not met due to natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible (and no later than six months after expiry of the time limit in question), the delay in meeting the time limit*

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<sup>13</sup> See Notice from the European Patent Office dated 15 March 2020 concerning the disruptions due to the COVID-19 outbreak, available in the EPO website: [LINK](#). It will be published in the EPO’s March Official Journal.

*is excused. This provision applies to international applications pending in the international phase, but not to the priority period ...” (Para. 5 of the Notice).*

With the epidemiological situation evolving day by day, it cannot be ruled out that the IP Offices of high-risk regions will introduce additional measures, such as renewals of the suspension of procedural terms.

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