

How to protect your IP rights during the Covid-19 pandemic

By [Kay Rickelman](#)

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As Daniel Kahneman observed in his book *Thinking, Fast and Slow*, there are two principal modes of human thinking. In a crisis, like our current one, our instinct is to think fast, simplify and leap to conclusions. But when we do this, we tend to rush, and by rushing we risk neglecting the all-important slow thinking, reflecting and anticipating.



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Let us examine how to think slower, to safeguard our intellectual property (IP) rights. After all, Covid-19 means that an especially well thought-out plan is required, to ensure that critical IP matters do not fall by the wayside against the backdrop of a global health crisis.

Individual vigilance

When people are working from home, they tend to work in a manner similar to that of when they were 'at work', not recognising the risks inherent in the different setting.

It is important that your people remain vigilant in their standard IP practices, even while away from corporate headquarters. After all, once your employees return to the office, they don't want to be surprised by lapsed protections on some of your organisation's IP.

To avoid unintentional IP loss, remind employees and contractors to be aware of protections to be observed when using and disposing of confidential information. In addition, ask that they save information only on company storage systems; use only company computers, if available, to perform work; avoid unsecured sites while sharing documents; and refrain from using personal e-mail to transmit work-related data.

Review of agreements

Ensure that any royalty/minimum payments are continuing to be made, or consider alternate payment arrangements to

avoid termination of agreement and loss of licensed-in IP rights.

There is a likelihood that companies may enter bankruptcy during the Covid-19 pandemic or thereafter. If your business is struggling financially and does not have the financial resources to maintain your rights when fees are due to be paid, talk to your lawyer.

This is especially true if you have rights to many marks in many countries and can't afford to maintain all rights in all countries. You don't want your registered rights to lapse, and third parties to try to take advantage of the situation by infringing on them or trying to register the mark themselves.

I have been approached by several corporate clients requesting a 'reprieve' from invoices for a certain period of time and also that we place all but the critical work on hold. Others have requested special discounts during this time noting that the businesses are struggling. Many lawyers are willing to assist clients with such requests, although a well-established relation with the client certainly assists in a law firm deciding to honour requests like these.

Review all IP agreements (including licenses, joint ownership, joint development and research agreements) to maintain your obligations to keep agreements in force. During the review, determine which obligations can be delayed due to force majeure and what the requirements are – both during and after the force majeure period.

Deadlines and extensions

With remote working and perhaps a reduced staff for in-house lawyers or the IP team, leaders are advised to commit personnel and financial resources to meeting deadlines.

Many businesses and trade mark registries are not working at optimal capacity, and in some cases, are closed for long periods of time. As such, deadlines may be missed, including:

- filing renewals of patents or trade marks,
- filing statements of use of a trade mark,
- filing an application to claim convention priority based on a file of the same mark in another country,
- responding to office actions rendered by the patent or trade mark office, and
- filing documents at courts where litigation is involved.

In many cases, registries will grant automatic extensions without request, but each will have its own rules – depending on the situation in the specific country at the time. The World Intellectual Property Office (WIPO) has a website that provides information on what measures and extensions of deadlines have been adopted by various IP offices in the world to [deal with Covid-19 related issues](#).

It's important to be aware that different countries offer different special deadlines. What's more, these will expire at different times. Don't count on every IP office being willing to grant one, and don't assume an automatic extension, just because one

country granted them.

“First to file”

Most intellectual property offices operate on a “first to file” basis and as such, hesitating now could lead to someone else filing before you. The first to file usually has the senior rights, unless the rights are in a country that recognises common law rights through use.

If you intend to file for IP protection, but are unsure of when you will actually do so, consider the impact of a deferral. By hesitating, you may lose not only priority over a competing party, but also any costs, effort, and time already invested in developing the IP.

It is a good idea to file at least the first application now, or as soon as possible. If you do, you can delay filing for the same mark in other countries for up to six months and still preserve the filing date of the first application – provided that you claim convention priority through the Paris Convention when filing in other countries.

With regard to hearings before the registrar or enforcement matters before a court, it is important to be aware that, in light of the pandemic, some matters will likely not be heard for some time. Alternatively, if your matter is urgent, it may be heard on a virtual basis and not in person, as you might have expected.

In conclusion, whenever IP rights are on the table, there must be a plan in place. But now, more than ever, what’s needed is slow thinking, reflection and anticipation – not haste – if we are to yield a well thought-out IP protection plan that contains clear priorities.

ABOUT THE AUTHOR

Kay Rickelman, Foreign Counsel, Spoor & Fisher Kay Rickelman's fields of practice are domestic and international trade mark registration, searches and clearance, international trade mark litigation. She specialises in portfolio management and oversees the needs of many large international companies with regard to their trademark matters in Africa and abroad. As the firm's foreign trade marks counsel, Kay also specialises in obtaining and enforcing trade mark protection in foreign countries.

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