

JANUARY 29, 2010
USPTO ISSUES INTERIM PROCEDURES TO REQUEST RECALCULATION OF PATENT TERM ADJUSTMENT

On January 7, 2010, the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) issued a decision in *Wyeth v. Kappos*, regarding the calculation of patent term adjustments (“PTA”) under U.S. patent statute 35 U.S.C. §154(b). The Federal Circuit’s decision rejects the United States Patent and Trademark Office’s (USPTO) interpretation of the “overlapping delay” limitation in Section 154(b)(2)(A).

35 U.S.C. §154(b) promised patent applicants a full patent term adjustment for any delay during prosecution caused by the USPTO. This promise took the form of three distinct “guarantees” in 35 U.S.C. § 154(b)(1):

(A) Guarantee of prompt Patent and Trademark Office responses.—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to [meet deadlines specified in clauses (i)-(iv)] ...

the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) Guarantee of no more than 3-year application pendency.—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States ...

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) Guarantee or adjustments for delays due to interferences, secrecy orders, and appeals.—Subject to the limitations under paragraph (2) ... the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

The Federal Circuit affirmed a ruling that the “B” Patent Term Adjustment (PTA) period commences at the end of three years from the filing date, so that the PTA is the sum total of any “A” period delays within the first three years by the USPTO plus the period of pendency for “B” measured from the three years after filing. The USPTO is prohibited from reducing delays that occurred within three years of the filing date of an application by delays that occur during the “B” Patent Term Adjustment (PTA) period, which starts three years after the filing date of the application.

On January 28, 2010, the USPTO announced that the USPTO is providing patentees with the ability to request a recalculation of their patent term adjustment without a fee or petition as is normally required pending completion of necessary modifications to the USPTO’s computer program for calculating patent term adjustments. The USPTO expects to complete the software modification necessary to comply with the Federal Circuit’s recent *Wyeth* decision regarding the overlapping delay provision by March 2, 2010. In the meantime, the USPTO will be processing recalculation requests under an interim procedure that is available to a patentee whose patent issues prior to March 2, 2010, and who requests recalculation no later than 180 days after the patent issue date. A copy of the notice submitted to the *Federal Register* for publication and the form for patentees to use in requesting a recalculation of patent term is on the USPTO Web site at http://www.uspto.gov/patents/announce/pta_wyeth.pdf.