

April 5, 2013



USPTO Announces Revisions to Patent Term Adjustment Rules

On April 1, 2013, the U.S. Patent and Trademark Office (USPTO) published an interim final rule revising several patent term adjustment (PTA) provisions in view of the AIA Technical Corrections Act. 78 Fed. Reg. 19416. In general, the revised rules apply to any patent granted on or after January 14, 2013. Public comments on the revised rules are due by May 31, 2013. A summary of the major changes follows.

Deadline for Requesting Reconsideration at USPTO

Under the revised rules, applicants will receive notice of the USPTO's PTA determination with the issue notification rather than upon receipt of a notice of allowance. Further, the revised rules create a single deadline of two months from issuance to seek reconsideration of PTA, which can be extended for an additional five months.

Deadline for Civil Action

The PTA statute, 35 U.S.C. § 154, provides a civil action remedy for applicants dissatisfied with the USPTO's PTA determination. The revised rules clarify that such an action must be filed within 180 days after the date of a "decision on the applicant's request for reconsideration" and emphasize that a civil action is "not an alternative" to requesting reconsideration at the USPTO. The prior rules specified a civil action must be filed "within 180 days after the grant of the patent," which caused many applicants to file civil actions by this deadline although they had not yet received a decision on a request for reconsideration by the USPTO.

National Phase Applications

35 U.S.C. § 154 also provides PTA for certain delays caused by the USPTO, including when a first action on the merits is issued more than 14 months after the application filing date. The revised rules specify the date used for calculating this adjustment for U.S. national phase applications begins on the date of commencement of national phase, instead of the date national phase requirements under 35 U.S.C. § 371 are met. The revised rules also confirm the USPTO's practice of using the national phase commencement date as the beginning date for calculating other PTA based on pendency of the application for more than three years. As such, U.S. national phase applications may be entitled to a longer PTA under the revised rules where national phase is commenced without meeting all requirements under 35 U.S.C. § 371.

Reinstatement of PTA Subtracted for Failure to Reply in Three Months

PTA is reduced for periods of time an applicant "failed to engage in reasonable efforts to conclude prosecution," which includes taking more than three months to reply to a notice or action by the USPTO. However, an applicant can request reinstatement of PTA if the applicant shows that in spite of all due care, the applicant was unable to respond within three months. The revised rules clarify that such a request must still be filed prior to issuance with no extensions of time available. This requirement applies to all applications in which a notice of allowance was mailed on or after April 1, 2013.

In view of the significant changes to PTA practice made by the revised rules, it is therefore advisable to consider their effect on patents and applications and to adjust PTA filing strategies at the USPTO and district court accordingly.

For more information, please contact:

Lori M. Brandes, Ph.D.
lbrandes@skgf.com

Eric K. Steffe
esteffe@skgf.com

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Sterne, Kessler, Goldstein & Fox P.L.L.C.

1100 New York Avenue, NW Washington, DC 20005

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