

Federal Circuit Holds USPTO Miscalculating Patent Term Adjustments

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In early 2010, the Court of Appeals for the Federal Circuit issued a ruling that the United States Patent and Trademark Office (USPTO) was miscalculating patent term adjustments on issued patents. The Court stated that the USPTO's method of calculating a patent term adjustment was contrary to the plain language of the statute providing for patent term adjustments.

A patentee can obtain an adjustment of a patent term, i.e., an extension of the patent term past twenty (20) years from the effective filing date of the patent, due to USPTO delays occurring during the prosecution of the application. A patentee can obtain an adjustment in the patent term for A) delays in the occurrence of specific prosecution matters, e.g., the USPTO taking more than fourteen (14) months after the filing of an application to issue a first response, or where B) the patent application being pending more than three (3) years. The USPTO had been treating these two delays as exclusive of each other, i.e., a patentee could only get the longer of the term provided for under the calculation of (A) or the calculation of (B). The Court stated that this method of calculating a patent term adjustment was not proper and that the correct method included accounting for delays calculated under both (A) and (B). Specifically, a patentee is entitled to a patent term adjustment for delays occurring under both (A) and (B), except that calculated delays occurring under (A) more than three years from the filing date would not be counted because they would overlap with calculated delays occurring under (B).

In view of the Court's ruling, the USPTO has established a relatively simple procedure for patentees to request a recalculation of a patent term adjustment based on the court's ruling without having to pay a fee. However, any request for recalculation of a patent term adjustment under this procedure must occur within one hundred eighty (180) days of the grant of the patent. Finally, the USPTO has stated that patents issued on and after March 2, 2010 will have patent term adjustments calculated in accordance with the Court's ruling and will not be eligible for the simplified procedure.

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