

NOTICE OF PATENT TERM ADJUSTMENT

A “patent term adjustment” (PTA) may be available for certain delays during prosecution of a U.S. patent application. PTA applies to U.S. patents issued from applications filed on or after May 29, 2000. PTA compensates for delays, as discussed below. The U.S. Patent and Trademark Office (USPTO) makes a determination of the amount of PTA. The applicant or patentee may challenge this determination.

PATENT TERM ADJUSTMENT (PTA)

Under the current version of 35 U.S.C. § 154(b), PTA may be granted when prosecution was delayed due to:

(A) USPTO failure to act timely (a “14-4-4-4” rule requires: (i) a first official action on the merits within 14 months from the application filing date or national stage entry date of an international PCT application; (ii) a next action within 4 months from a response or an appeal; (iii) a next action within 4 months from a decision on appeal; and (iv) issuance within 4 months from payment of the issue fee);

(B) USPTO failure to issue the patent within three years from the application filing date (discounting any continued prosecution, appeal, or delay requested by applicant); or

(C) interference, secrecy order, or appellate review reversing an adverse determination of patentability.

The PTA may be reduced by any terminal disclaimer and by any delays caused by the applicant’s failure to engage in reasonable efforts to conclude prosecution.

Challenging a Determination of PTA

The USPTO sends a determination of PTA with the notice of allowance. This determination may be challenged by filing an “application for PTA” under 37 C.F.R. § 1.705(b) on or before payment of the issue fee.

If a patent issues on a date different from the date specified on the Issue Notification, and the PTA is changed, the modified determination of PTA may be challenged on any grounds by filing a “request for reconsideration of the PTA” within two months from issuance of the patent.

Under 35 U.S.C. § 154, applicants also have a remedy against the USPTO’s determination of PTA by a civil action in the District Court of the District of Columbia within 180 days of issuance of the patent.