

REPORT

USPTO PROVIDES INTERIM REDUCED-COST PROCEDURE FOR REQUESTING RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF THE AIA TECHNICAL CORRECTIONS ACT**May 23, 2014**

The USPTO has established an interim optional procedure, effective May 15, 2014, for expeditiously requesting recalculation of patent term adjustment (PTA) for patents that recently issued directly from international applications (i.e., national stage applications under 35 U.S.C. §371). The USPTO is providing this optional procedure because the USPTO has experienced a significant delay in modifying the computer program it uses to calculate PTA with respect to the changes resulting from the AIA Technical Corrections Act.

As discussed in our January 2, 2013 Special Report, the AIA Technical Corrections Act revised the fourteen-month PTA period for the USPTO to issue a first substantive Office Action to begin on the date of commencement of the national stage. The date of commencement for national stage applications under 35 U.S.C. §371 is the earlier of (a) the date that is 30 months after the earliest claimed priority date or (b) the date of satisfaction of all the §371(c) requirements coupled with an express request for examination. Hence, the fourteen-month period and the three-year period for PTA A-delay and B-delay calculations now begin on the same date. This change applies to patents granted on or after January 14, 2013.

The USPTO calculates the PTA determination indicated on a patent with a computer program that uses the information recorded in the USPTO's PALM system. However, there were significant delays in modifying the computer

program with respect to measuring the fourteen-month PTA period from the date of commencement of the national stage in international applications. The programming modifications were eventually completed in April of 2014, and thus PTA determinations for patents issued on or after May 20, 2014, will be consistent with the changes to the PTA provisions in the AIA Technical Corrections Act.

In view of this significant delay, the USPTO is providing an optional procedure to request a recalculation of the PTA only for patents issued between January 14, 2013 and May 20, 2014, that resulted directly from international applications. Hence, this optional procedure is not applicable to patents that resulted from applications under 35 U.S.C. §111(a), including bypass continuations of international applications, and continuations of international applications that entered the national stage under 35 U.S.C. §371. To take advantage of this optional procedure, the USPTO has provided a simplified request form (Form PTO/SB/132 entitled "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF AIA TECHNICAL CORRECTIONS ACT") that requires only minimal identification information be provided for the patent for which the request is being filed. The simplified request form must be filed with the USPTO no later than July 31, 2014. The USPTO has waived the \$200 government fee and the two-month time limit after the issue date of

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the patent for requests for recalculation filed under this optional procedure. Because the two-month time limit has been waived, this optional procedure can also be used for qualifying patents that are unable to file a request for reconsideration of PTA under normal procedures because they issued more than seven months ago.

This optional procedure is not applicable to requests that the USPTO recalculate the PTA for alleged errors other than those pertaining to the fourteen-month PTA period. Furthermore, the USPTO has indicated that this interim procedure will not be considered as a basis for requesting a refund of the \$200 government fee, or any extensions of time fees paid for any previously filed request for reconsideration under §1.705, including any previously filed request that was solely based on the USPTO's alleged error pertaining to the fourteen-month PTA period.

In response to a request under this optional procedure, the USPTO will recalculate PTA and issue a new PTA determination. However, this new PTA determination is not the USPTO's "final decision" on PTA determination. Thus, before a civil action can be filed in the district court, the new PTA determination must first be challenged by timely filing a request for reconsideration of PTA under §1.705 with the \$200 government fee and the statement of facts that are normally required. This request must be filed no later than two months after the date of the new PTA determination. This two-month time period may be extended for up to five additional months upon payment of the appropriate government fees.

Because the USPTO has waived the \$200 government fee and has provided a very simple form for requesting recalculation that greatly reduces the cost for preparing the request, the overall cost of requesting a recalculation under this optional procedure will be significantly less than a typical request for reconsideration of PTA determination under §1.705.

Thus, we recommend that clients review their patent portfolios to take advantage of this interim procedure as warranted for important, qualifying patents. In this regard, the search for possible candidates can be quickly narrowed by eliminating from consideration qualifying patents in which all the filing requirements were met on the initial filing date of the national stage application. Among the remaining candidates, only those in which the national fee was paid, or the Declaration or translation of the international application was filed, after the date that is 30 months after the earliest claimed priority date would be patents for which the USPTO computed an incorrect starting date for the fourteen-month A-delay PTA period.

Please contact us if you have any questions regarding this interim procedure, or if you have any questions regarding PTA determinations for a specific matter.

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Oloff PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

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