

ACTELION PHARMS., LTD. v. MATAL, Appeal No. 2017-1238 (Fed. Cir. February 6, 2018). Before Lourie, O'Malley, and Wallach. Appealed from E.D. Va. (Judge O'Grady). (PTA Calculation)

Background:

Actelion filed a national stage application on January 12, 2012, meeting all 35 U.S.C. §371(c) requirements. The application was filed four days before the 30-month deadline for commencing the national stage: January 16, 2012, a federal holiday. When filing the application paperwork on January 12, Actelion included a statement in a preliminary amendment that "Applicant earnestly solicits early examination and allowance of these claims." However, Actelion did not check the box on the accompanying PTO form reading "This is an express request to begin national examination procedures."

The PTO awarded a grant of 40 PTA days, running from March 17, 2013 (14 months from January 17, 2012), until April 26, 2013, when a Restriction Requirement was mailed. Actelion challenged the calculation, arguing that the 14-month "clock" should run from when all §371(c) requirements were met. Alternatively, Actelion argued that its statement "earnestly solicit[ing] early examination" qualified as an express request to begin national examination procedures, starting the clock. Actelion also argued that at the latest, commencement of the national stage began on January 16 regardless of whether January 16 was a federal holiday.

The district court held that the PTO correctly calculated the PTA, and Actelion appealed.

Issue/Holding:

Did the district court err in concluding that the PTO correctly calculated the PTA? No, affirmed.

Discussion:

The Federal Circuit first determined that the PTA 14-month clock begins, in a national stage application, when all requirements of §371 are met, including requirements under Article 22 of the Patent Cooperation Treaty to commence the national stage within 30 months from the priority date or by an express request to commence the national stage at an earlier date. In reaching this conclusion, the court noted that the PTA statute references "section 371" in general without reference to any particular subsection (such as §371(c)). Accordingly, to begin the clock before the 30-month date, Actelion needed to make an "express request" for examination under §371(f).

Actelion failed to make this request. Actelion's statement "earnestly solicit[ing] early examination" was boilerplate language that it also included in non-PCT applications. The statement made no reference to §371(f) and did not reflect any intent to commence the national stage early. These facts, together with the unchecked box on the PTO form, led the court to conclude that Actelion did not make an express election to begin the national stage.

Thus, the 14-month clock began with commencement of the national stage at the expiration of the 30-month period. The court held that the national stage commenced on January 17, 2012, the next workday after the 30-month date that fell on a federal holiday. Although the PTA statute is designed to restore patent term lost due to delay, it restores only "undue delays in patent examination caused by the PTO," which does not include holidays.