

REPORT

**U.S. PATENT OFFICE PROVIDES REDUCED-COST INTERIM
PATENT TERM ADJUSTMENT PROCESS**

February 1, 2010

As discussed in our January 22 Special Report, the U.S. Court of Appeals for the Federal Circuit recently issued its *Wyeth* decision that requires the U.S. Patent and Trademark Office (USPTO) to change the way it calculates patent term extensions under certain circumstances.¹ In that decision, the Federal Circuit effectively held that the USPTO's pre-*Wyeth* patent term adjustment (PTA) calculation methodology resulted in many patents receiving less patent term extension than they were entitled to receive when applications for those patents had remained pending for more than three years.

As reported in our January 22 Special Report, the USPTO announced on January 21 that it would not contest the *Wyeth* decision, and that it would issue guidance for expediting requests for recalculation of PTA by the USPTO. The USPTO has now issued that guidance and established new procedures, effective February 1, 2010, for expeditiously correcting PTA calculations in recently issued patents.

On an interim basis, the USPTO is waiving various procedural requirements for requesting reconsideration of erroneous PTA calculations to minimize its burden in dealing with requests for reconsideration and civil actions based on that decision. In addition, over the next month, the USPTO will revise its PTA calculation software to comply with the *Wyeth* decision. However, the erroneous determinations will likely continue to appear on patents issuing while the software is being revised.

In summary, for patents issued before March 2, 2010, the USPTO has:

- (1) waived the two-month time limit for requesting recalculation by the USPTO of its PTA determinations based on the error exposed in the *Wyeth* decision, in favor of a 180-day time limit that matches the time limit for filing a civil action,
- (2) waived the \$200 government fee for requesting such reconsideration, and
- (3) provided a simplified request form that reduces the requirements, and thus cost (e.g., attorney fees) of requesting recalculation.

The waivers and simplified request form are only available to address recalculation based on the USPTO's erroneous pre-*Wyeth* interpretation of the statute. Furthermore, the 180-day time limit for filing a civil action has not been waived; thus, regardless of whether or not a petition or request has been filed in or acted upon by the USPTO, any civil action to correct the PTA determination must still be filed within 180 days of issuance of the involved patent. In addition, no remedy is available for patents that issued more than 180 days prior to the filing of a request, petition or civil action. The normal petition and fee procedure will again be applicable, and the waivers and simplified form will not be applicable, for patents issuing on or after March 2, 2010, when the USPTO predicts that its corrected PTA calculation software will result in more reliable PTA adjustments being printed on newly issued patents.

¹ *Wyeth v. Kappos*, Appeal No. 2009-1120 (Fed. Cir. January 7, 2010), discussed in our January 22, 2010 Special Report entitled "Federal Circuit Modifies PTO's Formula For Determining Patent Term Adjustment."

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The recommendations set forth in our January 22 Special Report therefore are still fully applicable. However, in making the cost-benefit analysis of our recommendation (b), please keep in mind that the cost of requesting a recalculation has been significantly decreased for patents issuing before March 2, 2010. In addition, please keep in mind that the 180-day deadline for filing a civil action to request a new PTA determination remains applicable whether or not a corrected PTA determination has been received from the USPTO before that deadline.

Please let us know if you have any questions regarding these matters.

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