



Important Notice Regarding Patent Term Adjustment

A U.S. District Court for the Eastern District of Virginia decision held that the United States Patent and Trademark Office (USPTO) has been incorrectly determining patent term adjustment (PTA) for some patents in which a Request for Continued Examination (RCE) was filed during prosecution of the application. Any pending application that has been allowed or any patent issued within the last 180 days can be reviewed to determine if the USPTO improperly calculated the PTA.

PTA is added to the 20-year base term for a patent to compensate for delays in prosecuting the application prior to issuance of the patent.

In *Exelixis, Inc. v. Kappos (E.D. Va.)*, the Court held that RCEs filed more than three years after the filing date of the application "have no impact on PTA." Contrary to this ruling, prior to this case, the USPTO had been subtracting the period of application pendency, if any, that occurred more than three years after the filing date of the application due to the filing of an RCE. However, this case determined that such calculation of PTA was contrary to the statutory guarantee of no more than a three-year application pendency of 35 U.S.C. 154(b)(1)(B).

Timely action needs to be taken to contest the USPTO's calculation of PTA. For granted patents, a patentee must contest the USPTO's determination of PTA within 180 days after issuance of the patent. To contest pre-issuance PTA of pending applications, the applicant must contest the USPTO's pre-issuance determination of PTA prior to paying the issue fee.

Reinhart's Patent Attorneys can help you analyze whether or not any PTA calculations for your applications or patents should be contested. Please contact Jeremy Bridge, your Reinhart attorney or any of our Patent Attorneys for further information on this time-sensitive issue.

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POSTED:

Dec 12, 2012

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