

August 2009

Contacts

Washington, DC
1900 K Street NW
Washington, DC 20006

[Thomas E. Anderson](#)
(202) 955-1808
andersont@hunton.com

[Brian M. Buroker](#)
(202) 955-1894
bburoker@hunton.com

[Robert M. Schulman](#)
(202) 955-1928
rschulman@hunton.com

[Laurence H. Posorske](#)
(202) 419-2080
lposorske@hunton.com

[Dwight M. Benner, II](#)
(202) 955-1993
dbenner@hunton.com

U.S. Patent Office Error in Patent Term Adjustment Calculations May Extend Patent Protections

The United States Patent and Trademark Office (“PTO”) recently acknowledged that it has been miscalculating the patent term adjustment for some PCT national phase applications by basing its calculations improperly upon the date when the applicant complies with the provisions of 35 U.S.C. § 371(c) (e.g., filing an executed inventor declaration) rather than properly upon the date when the national stage is commenced.¹

Therefore, some patents issued from U.S. national phase applications may be entitled to several months to a year or more of additional patent term.

35 U.S.C. § 154(b)(1)(B) requires that the PTO issue a patent within three years of the “actual filing date” of the application in the United States. 37 C.F.R § 1.702(b) explains that for a national phase application, the “actual filing date” is the date that “the national stage commenced under 35 U.S.C. 371(b) or (f).” Under 35 U.S.C. § 371(b), the U.S. national stage commences 30 months from the earliest priority date of a prior-filed international application, unless the applicant files a request under

35 U.S.C. § 371(f) for early processing and completes the requirements of section 371(c) prior to the 30-month date. Because the PTO has been miscalculating patent term adjustments based upon the date when the applicant complies with the provisions of 35 U.S.C. § 371(c) rather than upon the “actual filing date,” in many cases this error has resulted in an under-calculation of the patent term.

An Example Resulting in Too Little Patent Term Adjustment

The applicant for a PCT international application requests that the U.S. national stage commence on January 1, 2005, which is 30 months from the priority date of the PCT application. However, the national stage is commenced without one or more of the items required by § 371(c), such as an executed inventor declaration. After receiving a Notice to File Missing Requirements, the applicant submits all missing requirements on June 1, 2005, five months after the actual filing date. Under this scenario, instead of calculating the three-year term from January 1, 2005, the date the national stage commenced, the PTO has been calculating the three-year term from June 1, 2005, the missing requirements compliance date. In this example, the

¹ The error discussed here is different from the patent term adjustment calculation error challenged in *Wyeth v. Dudas*, 88 USPQ2d 1538 (D.D.C. 2008) relating to the potential overlap between “A Delays” and “B Delays.”



PTO's error results in a loss of five months of patent term adjustment.

While it appears the PTO will eventually correct the way it calculates patent term adjustments for national stage filings, it remains unclear when such a change will be instituted. Therefore, patentees should be aware of this potential error going forward as well as assessing the potential effect of this error on already issued patents.

We would be happy to assist in analyzing your patent portfolio and in obtaining increases in patent term adjustments where available. If we can be of assistance in this regard or on any other matter, please do not hesitate to contact us.

© 2009 Hunton & Williams LLP. Attorney advertising materials. These materials have been prepared for informational purposes only and are not legal advice. This information is not intended to create an attorney-client or similar relationship. Please do not send us confidential information. Past successes cannot be an assurance of future success. Whether you need legal services and which lawyer you select are important decisions that should not be based solely upon these materials.