

Patent Term and Patent Term Adjustment

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Over the past three decades, patent term has become increasingly important—and increasingly complicated—to the point where an accurate determination of when a patent expires now often requires specialized legal knowledge. This paper and the accompanying presentation provide patent practitioners with a working knowledge of how to calculate patent term, with a particular emphasis on patent term adjustment. However, this paper does not cover patent term extension because others will cover that topic.

I. Introduction and Historical Background

A. Why it Matters: The Three “L”s

Practitioners will need to calculate patent term in any number of situations, but the principal ones can be described as the three “L”s: Licensing, Litigation, and Life sciences. In licensing, not only the need for a license, but also the value of a license each depend upon the duration of the right to exclude. In litigation, patent expiration not only factors into the availability of an injunction, ongoing royalties, and back damages, but also affects decisions such as whether to seek reexamination or review in the Patent Office. The Patent Office will even construe claim terms differently depending upon whether a patent has expired or not. Finally in the life sciences and pharmaceutical contexts, where the maxim that “the last day of a patent’s term is its most valuable” often is true, knowledge of the term of a patent is particularly important. Not only does the Orange Book require specification of a patent’s expiration, but patent expiration may dictate prosecution strategy. Moreover, patent expiration figures heavily in many “non-legal” contexts such as valuation, revenue forecasting, and decisions on whether to enter particular markets. In short, an accurate determination of a patent’s term is often essential both for legal and business reasons.

B. A Short History of the Length of Patent Term in the United States

The United States Constitution permits Congress to give inventors the exclusive right to their discoveries “for limited Times.” U.S. Const. Art. I, § 8, clause 8; *see also Eldred v. Ashcroft*, 537 U.S. 186 (2003). In 1790, Congress enacted and President Washington signed “An and to promote the Progress of Useful Arts” which fixed the term of a patent at 14 years from issue, the same term as for copyrights. The patent act of 1836 permitted an term extension of 7 addition years, for a total of 21 years. In 1861, Congress gave all patents a term of 17 years from issue, and the 17 year term remained the law for more than a century. Although straightforward and generally calculable from merely looking at the face of the patent itself, the 17 year term for a utility patent is quickly becoming a thing of the past.

In the last 30 years, Congress has made the term of a utility patent increasingly complicated in a series of three major changes to the Patent Act. First, in 1984, the Hatch-Waxman Act first permitted patent term extension to modify the term of a utility patent.

Second, in 1995, Congress implemented the Uruguay Round of the General Agreement on Tariffs and Trade (GATT), harmonizing U.S. patent terms with many foreign jurisdictions. GATT included the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) treaty, which mandated a minimum patent term of 20 years from the application date. Thus, GATT changed the baseline term of a U.S. utility patent from 17 years after issue to 20 years after the application. In theory, the change was small for most original applications, since utility patents average roughly three years in prosecution before issuing. In practice however, prosecution time varies widely by art group and individual application.

Third, in 1999, the American Inventors Protection Act (AIPA) set forth most of the current rules for patent term adjustment. Since then, there have been other changes to patent term adjustment, both from Congress and the Courts.

Moreover, this legislation has necessitated intricate regulations governing the way that a term of a utility patent is calculated. Periodic changes in the regulations and their effective dates have made it necessary to be a scholar of patent term, in order to be assured that the term is calculated correctly.

Design patent term has also undergone significant changes. The patent act of 1842 established design patents with a term of 7 years, half the term of a utility patent (and half the cost—only \$15). In the 1861 act, an applicant was given the choice between a term of 3-1/2 years, 7 years, or 14 years, depending upon the fee paid. That scheme also lasted more than a century, until 1982 when a uniform 14 year term was implemented. Most recently, on December 18, 2013, the term of a design patent changed from 14 years to 15 years as part of the implementation of the Hague Agreement Concerning the International Registration of Industrial Designs.

Plant patents are subject to the same patent term as utility patents. *See generally* 35 U.S.C. § 161.

II. Calculating Patent Term: Principles, Methods, and Examples

This paper refers to a “baseline” term of a utility or plant patent as the 20 year GATT term set by 35 U.S.C. § 154(a), or as the 17 year pre-GATT term set by 35 U.S.C. § 154(c)(1), and refers to the baseline term of a design patent as the 15 year design patent term set by 35 U.S.C. § 173. *See In re Yamazaki*, 702 F.3d 1327, 1332 (Fed. Cir. 2012) (defining the “baseline term” for a post-GATT utility patent). The baseline term may then be modified by patent term adjustment, terminal disclaimers, and patent term extension. In addition, the modified term of a patent may be prematurely terminated by a number of events.

A. The First Day of a Patent’s Term and Provisional Rights

A patent grants rights to exclude “for a term beginning on the date on which the patent issues.” 35 USC 154(a)(2). Patents issue on Tuesday mornings, “just after 12:00 a.m.,” eastern

time, on the date of issue. *Encore Wire Corp. v. Southwire Corp.* No. 3:10-cv-86, 2011 U.S. Dist. LEXIS 22073, 2011 WL 833220 (N.D. Ga. Mar. 4, 2011); *but see Helene Curtis Indus., Inc. v. Sales Affiliates, Inc.*, 105 F. Supp. 886, 891 (S.D.N.Y. 1952) (noting that a patent issued at noon); Fed. R. Civ. P. 6(a)(1)(A) (stating the default rule when a statute does not specify a method of computing time, to “exclude the day of the event that triggers the period”). Under the theory in *Encore Wire*, an infringement suit could theoretically be filed in Palo Alto at 9:01 p.m. pacific time on the Monday evening before the day the patent issues.

Normally, there can be no act of infringement before the patent issues. *See, e.g., Nat’l Presto Indus. v. West Bend Co.*, 76 F.3d 1185, 1196 (Fed. Cir. 1996); *Reiffin v. Microsoft Corp.*, 270 F. Supp. 2d 1132, 1154 (N.D. Cal. 2003). However, there are provisional rights in a published patent application which could be infringed. *See* 35 USC § 154(d). Enforcing provisional rights requires a number of hurdles, beyond mere infringement: a patent must eventually issue with “substantially identical” claims to the published application; the accused infringer must have actual notice of the published application, and damages are limited to a reasonable royalty. *See Stephens v. Tech Int’l, Inc.*, 393 F. 3d 1269, 1275-76.

B. The Term of a Design Patent

Design patents present a relatively simple case for patent term: the term of the design patent can generally be determined by looking at the issue date on the face of the patent and simply adding 14 or 15 years. *See* 35 U.S.C. § 173 (effective Dec. 18, 2013) (“Patents for designs shall be granted for the term of 15 years from the date of grant.”). The change from 14 to 15 years was made by the Patent Law Treaties Implementation Act of 2012, P.L. 112-211, 126 Stat. 1532 (Dec. 18, 2012). Under the Act is, design patents resulting from applications filed before December 18, 2013, will have 14 year terms, and those resulting from applications filed on or after December 18, 2013, will have 15 year terms.

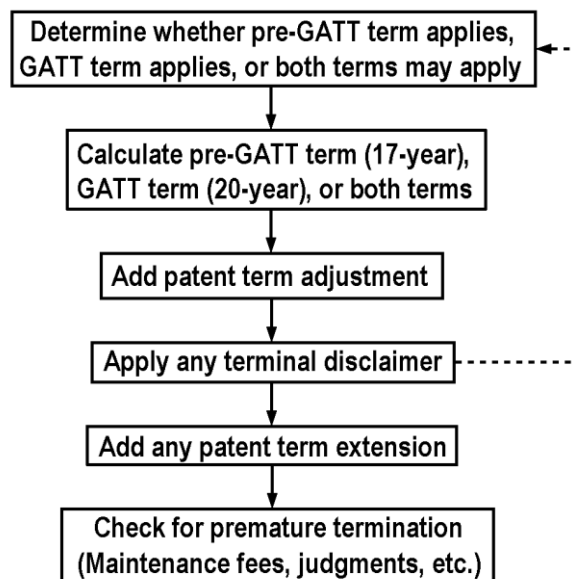
Design patents are also subject to the terminal disclaimers and to the same uncertainty as to the last day of their term, as described below for utility patents.

C. The Term of a Utility Patent: An Overview

The general method for determining the term of a utility patent involves these steps:

1. Determine which term applies: per-GATT (17 year), GATT (20 year) or both;
2. Calculate the proper term;
3. Add any patent term adjustment;
4. Apply any terminal disclaimer;
5. Add any patent term extension;
6. Check for premature termination.

The general method is illustrated in flow-chart form below.



D. Determining the Baseline Term of a Utility Patent

The baseline term of a utility patent (or plant patent) is either the pre-GATT 17 year term, or the GATT 20 year term. The determination of which baseline term applies is governed by 35 U.S.C. § 154(c)(1):

The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act [*i.e.*, June 8, 1995] shall be the greater of the 20 year term as provided in subsection (a) [*i.e.*, the GATT term], or 17 years from grant, subject to any terminal disclaimers.

Under the statute, patents fall into one of three categories based upon their status when the GATT treaty was implemented. Patents that had expired before the GATT treaty was implemented (*i.e.*, on or before June 7, 1995) received the baseline pre-GATT term of 17 years from grant. Those patents were completely unaffected by the GATT treaty. Conversely, any patent that issues from an applications filed once the GATT treaty was implemented (*i.e.*, on or after June 8, 1995, regardless of priority date) receives the baseline GATT term of 20 years from the application date. All others—patents in force on June 8, 1995 or whose applications were pending on June 7—get a baseline patent term of the longer of the pre-GATT 17 year term, or the GATT 20 year term. While the longer of the two is often easy to determine by simple inspection, to determine the baseline term of any patent whose application was pending on June 7, 1995, or any patent that was in force on June 8, 1995, strictly speaking one must calculate both the pre-GATT 17 year term and the GATT 20 year term, and select the longer of the two. To take advantage of the potential for longer patent term, there were enormous numbers of applications filed just before June 8, 1995, when the GATT treaty was implemented.

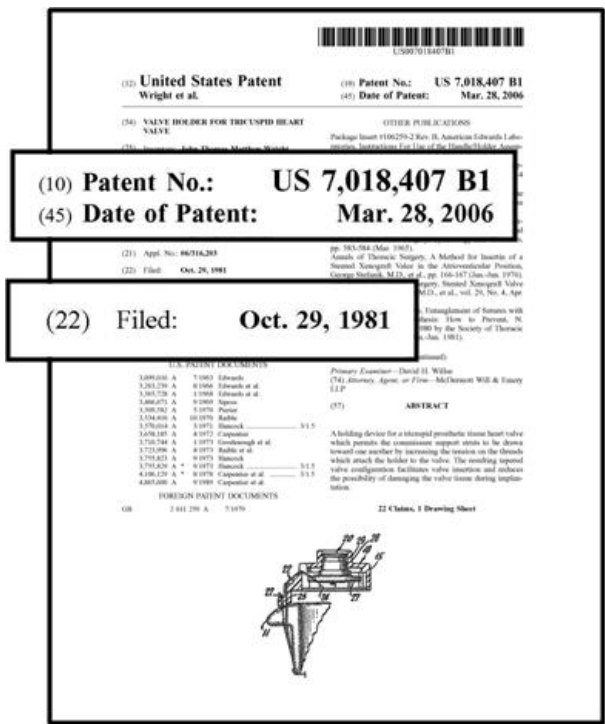
In addition to determining the correct baseline term, subsequent changes to the statute and regulations need to be taken into account when determining patent term. Some of these changes depend upon the filing date of the application, some on the date of allowance of the application, and still others depend upon the issue date. But none of the changes to patent term depend upon priority date. For example, a patent is only eligible for patent term adjustment if the application from which it issued was filed on or after May 29, 2000. If that application was an international application, then the law concerning certain A delay may depend upon whether the patent issued before or after the AIA Technical Corrections Act became applicable on or after January 14, 2013. The same act changed the process for challenging PTA decisions depending upon whether a notice of allowance was mailed after March 31, 2013, or not. Changes regarding the interaction between B and C delays, and certain applicant delays, were effective for applications allowed on or after September 17, 2012.

1. The Pre-GATT 17 Year Baseline Term

Like the baseline term of a design patent, the pre-GATT baseline term of a utility patent (or a plant patent) is straightforward. That term is “17 years from grant,” 35 U.S.C. § 154(c), and can generally be determined by adding 17 years to the issue date shown on the face of the patent. *See* 35 U.S.C. § 154(c).

However, there is some confusion about the last day of a pre-GATT patent term. For a hypothetical patent issued on Tuesday, February 1, 2000, a term lasting exactly 17 years would presumably end on the day before the 17th anniversary of the grant, that is, on January 31, 2017. However, in a tax case where the issue was litigated, the term was held to be enforceable on the anniversary date, yielding at term of 17 years and one day. *See Standard Oil v. Comm’r.*, 43 B.T.A. 973, 995 (1941), *aff’d*, 129 F.2d 363 (7th Cir. 1942). The same issue would presumably apply to design patents.

Surprising results can occur when an application filed before June 8, 1995, spends long periods in prosecution before issuance. Applications filed before that date do indeed continue to be issued, albeit less frequently, due to secrecy orders, appeals before the Patent Trial and Appeal Board (“PTAB”), § 145 actions, interferences and § 146 actions, etc. For example, U.S. Patent Application 06/316,203 was filed on October 29, 1981, and following a 19 year interference, it issued on March 28, 2006, as U.S. Patent 7,018,407. Because the application was filed before June 8, 1995, the ‘407 patent receives a baseline patent term of either the pre-GATT 17 year term, or the GATT 20 year term, whichever is longer. The GATT 20 year term would have expired in 2001, five years before the patent issued. Instead, this patent receives a term of 17 years from grant, expiring on March 28 (or perhaps March 27), 2023—more than 41 years after the patent was applied for.



2. The GATT 20 Year Baseline Term

The baseline GATT 20 year term of a utility patent (or plant patent) is governed by 35 U.S.C. § 154(a)(2) and (3) (as modified by P.L. 112-211 (Dec. 18, 2012), 126 Stat. 1531):

(2) **TERM.**—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c) or 386(c) of this title, from the date on which the earliest such application was filed.

(3) **PRIORITY.**—Priority under section 119, 365(a), 365(b), 386(a), or 386(b) of this title shall not be taken into account in determining the term of a patent.

The 20 year term after the application date is complicated both by the specific exclusions in § 145(a)(3), which extend patent term, and by the “specific reference” referred to in the statute, which reduces patent term.

Congress excluded certain priority claims from patent term calculations in § 154(a)(3) at least in part to give U.S. patentees the same term advantage that they often enjoy overseas. The exclusions permit an applicant to shift her prospective patent term later in time by a year, if the applicant chooses. Without losing priority, an applicant can effectively delay issuance by about a year, and can delay expiration by a year, by filing a provisional application and claiming priority under § 119(e), or by filing a foreign national application and claiming priority under §§ 119(a), 365(b), or 386(a), or by filing an international application designating a country other

than the United States and claiming priority under §§ 365(a) or 386(b). Similar options to shift patent term will present itself again during prosecution, if the applicant prosecutes with an eye toward patent term adjustment.

The “specific reference” requirement in § 154(b)(2) is also a requirement in 35 U.S.C. § 120 to make a priority claim to a prior pending application. However, because a specific reference is only one of several such requirements for a priority claim, certain imperfect priority claims can affect patent term, yet at the same time they may be insufficient to afford priority. A relatively common example of this is a continuation in part application (CIP) in which claims are not based upon the original disclosure; in such a case, the baseline GATT term will be based upon the original application date, even though priority will be based upon the later CIP filing date. And although the author has never seen a case litigated, other more esoteric examples are theoretically possible. For example, a chain of priority may be claimed with a specific reference to each, yet the chain might be broken due to some other imperfection in the chain (such as non-overlapping applications or an imperfect priority claim in an intermediate application). In such a case, because the specific reference requirement is met, § 154(b)(2) would seem to base patent term on an application date for which there can be no priority.

Just as the pre-GATT 17 year term can yield surprising results for patents issuing from applications filed before June 8, 1995, so too can the GATT 20 year term yield surprising results for patents issuing from applications filed on or after that date. For example, U.S. Patent 7,604,811¹ issued on October, 20, 2009, from an application filed on December 10, 1996. Because the application was filed on or after June 8, 1995, the ’811 patent receives the GATT 20 year term. However, the ’811 patent claims priority, through a series of abandoned applications, to an application filed on March 16, 1984. Hence, the ’811 patent expired on March 16, 2004—more than five years before it issued!

¹ The author thanks the blog, 1201Tuesday.com, for spotting some of these examples.

A “specific reference” is normally printed on the face of the patent as part of a priority claim. However, to be complete, one should make sure that such a reference does not appear elsewhere in the prosecution history, particularly if it might not be part of a priority claim. Common places to look include an application data sheet, the oath or declaration, and the first paragraph of the specification.

Like the ambiguity that exists for the last day of a baseline pre-GATT patent term, the last day of a baseline GATT term is no more straightforward. That term ends “20 years from the date on which the application for the patent was filed.” 35 U.S.C. § 154(a)(2). Thus, if an application were filed on February 1, 2000, then its baseline GATT term would end 20 years from that date—either January 31 or February 1, 2020.

E. Patent Term Adjustment

Patent Term Adjustment (PTA) was enacted by Congress as part of the AIPA in order to compensate patentees for delays in the prosecution of patents. While GATT harmonized patent term and ameliorated problems with “submarine” patents, compared to the pre-GATT 17 year term, it penalized patentees whose patents spent long times in prosecution. Because the baseline GATT term of a patent is set at the time the application is filed, every day spent in prosecution means one day less duration of enforceable patent term. PTA compensates for delays in the prosecution of utility patents (and plant patents) filed on or after May 29, 2000, but not design patents.

Subtitle D of the AIPA, titled the “Patent Term Guarantee Act of 1999,” addressed this concern by creating 35 U.S.C. § 154(b), titled “Adjustment of patent term.” Congress gave applicants three guarantees against extended prosecution times: a guarantee of prompt Patent Office response in § 154(b)(1)(A), a guarantee of an application’s pendency for no more than 3 years in § 154(b)(1)(B), and a guarantee concerning delays due to secrecy orders, appeals and interferences (and later derivation proceedings) in § 154(b)(1)(C). The three types of prosecution delay guaranteed against are called A delay, B delay, and C delay, respectively, after the different subsections where they are codified. If there is delay beyond any of these the guarantees, the statute compensates the patentee by adjusting the end of the patent term on a day-for-day basis, subject to several limitations. *See* 35 U.S.C. § 154(b)(2).

The corresponding regulations, 37 C.F.R. §§ 1.702-05, concern the grounds for determining if a guarantee has been met or not (§ 1.702), the amount of any adjustment due to the guarantee not being met (§ 1.703), reductions to the amount of PTA (§ 1.704), and the process for awarding PTA (§ 1.705). That process is inherently complicated and detail-oriented. Moreover, changes to both the statute and the regulations, which variously take effect based upon the date of filing, the date of allowance, or the date of issue, can make calculation of PTA quite complicated indeed.

The Patent Office has often seemed very stingy in granting PTA. This is evident not only from the Patent Office’s positions in the two major appellate cases concerning PTA (the *Wyeth* and *Novartis* cases described below), but also from the wide variety of applicant delays that the Office has defined, in that narrow area where the Patent Office has substantive rulemaking

authority. However, in at least one case the Patent Office has actually changed its rules to be more PTA friendly, as discussed below in the interaction between B and C delay for appeals.

1. A Delay

A delay occurs when the Patent Office fails to meet the guarantee to make any of four specific responses to an applicant's filings during prosecutions. *See* 35 U.S.C. §§ 154(b)(1)(A)(i)-(iv).

For purposes of calculating A delay, an applicant does not get the benefit of a certificate of mailing, but must rely on a filing's actual receipt date. 37 C.F.R. § 1.703(f) (also applicable to B and C delays). However, the weekend and holiday rule in 35 U.S.C. § 21(b) does apply. *See ArQule, Inc. v. Kappos*, 793 F. Supp. 2d 214 (Fed. Cir. 2011).

a. 14 Month A Delay

The first A delay guarantee is to provide an initial office action within 14 months of the filing date of an application. For a regular utility application filed under 35 U.S.C. § 111(a), the filing date accorded an application is what counts here; missing parts do not prevent the 14 month deadline from being set. Similarly, priority does not matter for PTA purposes; the PTA for a continuation or divisional application depends only upon the filing date of the application under examination, not any parent application. *See Mohsenzadeh v. Lee*, No. 1:13-cv-824, 2014 U.S. Dist. LEXIS 38666 (E.D. Va. Mar. 19, 2014).

For international applications, however, the picture is a bit more complicated. Before the AIA Technical Corrections Act became applicable on January 14, 2013, the "filing date" for an international application (for purposes of 14 month A delay) was defined by the pre-AIA regulation as occurring when the requirements of §§ 371(b) or (f) were met. 37 C.F.R. § 1.703(b). Thus, by regulation the 14 month clock should have started to run either 30 months after the international filing date (§ 371(b)) or after an earlier request to start the national stage along with the declaration and oath and other parts of the application (§§ 371(f) and (c)). However, Patent Office's calculations frequently misconstrued the provision as only requiring fulfillment of § 371(c), regardless of whether the 30 month deadline had passed and regardless of whether a § 371(f) request had been made. So in many instances mis-calculated the start of the 14 month deadline beyond 30 months and improperly calculated B delay.

For patents issued on or after January 14, 2013, from international applications, the current version of 35 U.S.C. § 154(b)(1)(A)(i)(II) explicitly starts the 14 month clock when the application enters the U.S. national stage, in effect making the previous regulation part of the statute. As before, the national stage begins no later than 30 months after the international filing date, but can begin earlier at the applicant's request, provided that an oath or declaration is filed. *See* 35 U.S.C. §§ 371(b), (c), & (f). However, to further complicate this matter, since the AIA Technical Corrections Act it appears that the Patent Office has still not changed its calculations to reflect the Act, so there are still frequent errors for patent term adjustment for patents issuing from international applications.

Initial office actions include restriction requirements. However, they do not include notices to file missing parts.

b. 4 Month A Delays

The three other A delay guarantees are all straightforward 4 month guarantees, for response after the applicant’s reply to an office action or appeal, to act after a decision of the Patent Trial and Appeal Board (PTAB), and to issue a patent after payment of the issue fee. *See* 35 U.S.C. §§ 154(b)(1)(A)(ii)-(iv).

What constitutes a “response” by the Patent Office has generated litigation. In *Univ. of Mass. v. Kappos*, 903 F. Supp. 2d 77 (D.D.C. 2012), the court held that a reply by the Patent Office stopped A delay from accruing, even if the reply was later vacated and replaced with an amended reply. However, there remains a question whether a response that is later amended can qualify under 35 U.S.C. § 132(a), as required by the PTA statute, because it presumably does not give all the reasons for rejection nor the information “as may be useful in judging of the propriety of continuing the prosecution.”

c. An Example of A Delay

Consider the following scenario:

January 1, 2008:	Foreign national application filing date
January 1, 2009:	International filing date
August 1, 2011:	Declaration filed and 35 U.S.C. § 371(c) met
November 1, 2012:	Restriction
December 1, 2012:	Election
May 1, 2013:	Allowance
June 1, 2013:	Issue fee paid
November 5, 2013:	Issuance

Here, because the application was filed on or after June 8, 1995, the 20 year GATT term applies. Therefore the baseline term expires on January 1, 2029. This patent is also eligible for PTA because the application was filed after May 29, 2000. Moreover, the current A delay rules apply because the patent issued after the AIA Technical Corrections Act became effective on January 14, 2013. There is no B delay, C delay, overlap, or applicant delay in this scenario.

The application entered the U.S. national stage 30 months after its international filing date, on July 1, 2011, regardless of not having a declaration filed. *See* 35 U.S.C. § 371(b). That triggered a 14 month guarantee for the Patent Office to reply (*i.e.*, by September 1, 2012). *See* 35 U.S.C. § 154(b)(1)(A)(i)(II); 37 C.F.R. §§ 1.702(a)(1), 1.703(a)(1). Although a restriction qualifies as a response for purposes of 14 month A delay, the restriction on November 1, 2012, was delayed by 61 days beyond the 14 month guarantee. The applicant’s election on December 1, 2012 triggered a 4 month guarantee for a reply by the Patent Office (*i.e.*, by April 1, 2012). *See* 35 U.S.C. § 154(b)(1)(A)(ii); 37 C.F.R. §§ 1.702(a)(2), 1.703(a)(2). The allowance from the Patent Office on May 1 was delayed by 30 days beyond the guarantee. Payment of the issue fee on June 1, 2013, triggered a guarantee of issuance in 4 months (*i.e.*, by October 1, 2013), *See* 35 U.S.C. § 154(b)(1)(A)(iv); 37 C.F.R. §§ 1.702(a)(4), 1.703(a)(6). The actual issuance on Tuesday, November 5 was delayed by 35 days beyond the 4 month guarantee. Hence the total amount of A delay is 61 days, plus 30 days, plus 35 days, or 126 days. Assuming no other

effects, the expiration of this patent is 126 days after the baseline expiration date, or May 7, 2029.

2. B Delay

B delay is a backstop provision that guarantees a diligent applicant will have a GATT term that is at least as long as the pre-GATT 17 year term, for an original application (but not for continuations or divisionals). B delay occurs when the Patent Office fails to meet the guarantee of no more than a three year application pendency:

(B) Guarantee of no more than 3-year application pendency.—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under section 111 (a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application, not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132 (b);

(ii) any time consumed by a proceeding under section 135 (a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Patent Trial and Appeal Board or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

35 U.S.C. § 154(b)(1)(B).

a. Calculation of B Delay Without Any of the Exceptions

Pendency, for purposes of B delay, is the amount of time from “the actual filing date of the application in the United States” until the date of issue. For an international application, “the “actual filing date of the application in the United States” which triggers the 3 year guarantee is defined as the date the application enters the U.S. national stage, 37 C.F.R. § 1.703(b). This is same date defined in the AIA Technical Corrections Act to trigger the 14-month A delay guarantee.

If none of the exceptions in 35 U.S.C. §§ 154(b)(1)(B)(i), (ii) and (iii) apply, then calculation of B delay is relatively easy. For example, an application filed on (or an international application entering the U.S. national stage on) January 1, 2010, would trigger a guarantee to be issued by the third anniversary of its filing (or national stage entry) (*i.e.*, by January 1, 2013. If issuance were delayed until January 8, 2013, amount of B delay would be 7 days.

b. The Exceptions to B Delay

The exceptions to B delay in 35 U.S.C. §§ 154(b)(1)(B)(i), (ii) and (iii) are respectively for the time consumed in any request for continued examination (RCE), for the time consumed by interferences, derivation proceedings, secrecy orders, and PTAB and court appeals of patentability, and for the time consumed by delays requested by the applicant. 37 C.F.R. §§ 1.702(b) and 1.703(b) describe how the exceptions have heretofore been applied by the Patent Office. These rules, which were at issue in the *Novartis v. Lee* case discussed below, generally took the B delay calculation above and subtracted from it the number of days in which an RCE, interference, derivation proceeding, secrecy order, appeal, or applicant delay lasted. Under the rules, B delay would only accrue if the application had been pending more than three years longer than those proceedings lasted.

The exception for appeals works in tandem with C delay. The statutory and regulatory scheme excludes the time spent during an appeal from B delay, but permits that time to be counted as C delay if the applicant's appeal is successful; that is, if final decision reverses an adverse determination of patentability. Until changes in the regulations effective for applications issued a notice of allowance on or after September 17, 2012, the period of time during which C delay was available instead of B delay began when a notice of appeal was filed. Starting on that date, B delay became available until jurisdiction passed to the Board.

c. RCEs and *Novartis v. Lee*

Recently, the Federal Circuit decided that the Patent Office had erred in deciding B delay for many cases involving an RCE. Going forward, those cases will receive B delay credit for the time from allowance to issue.

Until now, the Patent Office has interpreted the exception in 35 U.S.C. §§ 154(b)(1)(B)(i) for RCEs to consume the entire amount of time from the day of filing of the RCE until issue. See 37 C.F.R. § 1.703(b)(1). The Patent Office has only considered B delay to last from the day after the third anniversary of the actual filing date, until the day before the filing of an RCE. Put another way, if an RCE is filed before the third anniversary of the actual filing date, then until now no B delay would be awarded by the Patent Office. However, numerous patentees have read 35 U.S.C. § 154(b)(1)(B) differently, concluding that the literal language of the statute meant that the exceptions were only applied to the determination of whether the patent issued within 3 years, and that the exceptions were not applied to decrease the remedy. Recently, the Federal Circuit rejected both positions and reinterpreted how to calculate B delay with any of the exceptions. See *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). Although the deadline for seeking *certiorari* has not expired as of this writing, the Federal Circuit decided that where any of the exceptions apply, the proper calculation is

patent term adjustment time should be calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of [§ 154](b)(1)(B)) and determining the extent to which the result exceeds three years.

Novartis, 740 F.3d at 601. As for the time “continued examination time” to be subtracted due to an RCE, the Federal Circuit held that such time was the time before allowance, effectively adding the time from allowance to issue back into B delay. *Novartis*, 740 F.3d at 602. The court did not rule out the possibility that there might be exceptional cases when prosecution might resume after a notice of allowance, but it reserved judgment on such cases.

Thus, post *Novartis*, the proper measure of B delay, where there is an RCE is to determine the entire time from the actual filing date in the United States until the day of issue (inclusive), then subtract the time from the filing of the RCE until the day before the allowance (inclusive), and that the patent term adjustment is the extent to which that time exceeds three years. *Novartis* also indicates that the same kind of calculation should take place where there are exceptions for interferences, derivation proceeding, secrecy orders, or PTAB or court appeals of patentability that are not decided in favor of the applicant, presumably using the times in 37 C.F.R. §§ 1.703(b)(2)-(4).

In a similar situation in 2010 following an adverse decision in the *Wyeth* case described below, the Patent Office quickly implemented an interim procedure to alleviate the number of petitions and civil actions that were being filed. 75 Fed. Reg. 5043 (Feb. 1, 2010). The Patent Office has not done so following *Novartis*, so it appears that patentees affected by the change in *Novartis* will have to petition for redress under 37 C.F.R. § 1.705(b).

The Innovation Act, as recently passed by the House of Representatives and currently pending in the Senate, would restore the Patent Office’s original interpretation if enacted.

d. An Example of B Delay

Consider the following scenario:

January 1, 2010:	Filing date
March 1, 2011	Restriction
June 1, 2011:	Election
October 1, 2011:	Non-final office action
January 1, 2012:	Amendment
May 1, 2012:	Final office action
August 1, 2012:	RCE and amendment
December 1, 2012:	Non-final office action
March 1, 2013:	Amendment
July 1, 2013	Allowance
October 1, 2013	Issue Fee
January 31, 2014	Issuance

Here, because the application was filed on or after June 8, 1995, the 20 year GATT term applies. Therefore the baseline term expires on January 1, 2030. This patent is also eligible for PTA because the application was filed after May 29, 2000. There is no A delay, C delay, overlap, or applicant delay in this scenario.

Under *Novartis*, the pendency of the application was January 1, 2010, through January 31, 2014, inclusive, or 1492 days. The duration of the RCE was from August 1, 2012 through

June 30, 2013, inclusive, or 334 days. The difference is 1158 days. Three years is 1095 days (if there are no leap years; it remains to be seen whether leap years will lead to any further controversy). Hence, the difference is the B delay, or 63 days. Assuming no other effects, the expiration of this patent is 63 days after the baseline expiration date, or March 5, 2030.

3. C Delay

C delay is to compensate a patentee for delays in prosecution that occur due to interferences and derivation proceedings, secrecy orders, and appeals (if the applicant is successful). *See* 35 U.S.C. § 154(b)(1)(C).

For interferences and derivation proceedings, the amount of C delay is the number of days from institution to termination of the proceeding, plus any additional, non-overlapping days that prosecution is suspended as a result of the proceeding. *See* 37 C.F.R. §§ 1.702(c), 1.703(c).

For secrecy orders, the amount of C delay is the number of non-overlapping days that the application is sealed, that any appeal is under a secrecy order, that any derivation or interference is under a secrecy order, and that the application is suspended due to a secrecy order while in a condition for allowance. *See* 37 C.F.R. §§ 1.702(d), 1.703(d).

For Patent Office appeals, the amount of C delay is the number of days from when jurisdiction passes to the PTAB until there is a final decision, if the final decision reverses an adverse determination of patentability. *See* 37 C.F.R. §§ 1.702(e), 1.703(e). Such a decision generally requires that, upon remand, the Patent Office issues a notice of allowance without any intervening action. *See* 37 C.F.R. §§ 1.702(e). If an applicant's appeal is not successful in this way, then no C delay will accrue. For applications receiving a notice of allowance prior to September 17, 2012, the potential for C delay (and the corresponding exception for no B delay) began when a notice of appeal was filed.

Congress had addressed these same three issues in former section 155 of the Patent Act, which was implemented with GATT in 1995. Section 155 was titled "Patent Term Extension" but should not be confused with patent term extension from the Hatch-Waxman Act. It was effective for patents issuing from applications filed on or after GATT became effective on June 8, 1995, but before patent term adjustment became effective on May 29, 2000. GATT patent term extension was nearly identical to C delay, but had an overall limit of 5 years of extension and had certain other limits on delay for appeals. Although it is theoretically possible that there are pending applications that could still benefit from 35 U.S.C. § 155, Congress repealed the section as part of the AIA (although the enabling regulation, 37 C.F.R. § 1.701, remains).

4. Overlapping Delays

Where A, B, and/or C delays overlap, the overlap is excluded from PTA so that a patentee does not receive any double (or triple) benefit. 35 U.S.C. § 154(b)(2)(A); 37 C.F.R. § 1.703(f).

a. Wyeth v. Kappos

Although the overlap provision seems straightforward enough, it was litigated in *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010). There, Wyeth claimed that it was due patent term adjustment for each individual date on which there was either A delay or B delay (or C delay), and that overlap meant particular dates on which more than one type of delay accrued. In contrast, the Patent Office contended that once a patent had been pending for 3 years, every day of A delay (or C delay) had necessarily caused a day of B delay, regardless whether the two delays occurred on the same date or not. Thus, the Patent Office argued that a patentee was due the larger of the amount of A delay or B delay (or C delay), but that they should never be added together. The Federal Circuit rejected the Patent Office’s interpretation and held that the overlap in 35 U.S.C. § 154(b)(2)(A) meant that two different kinds of delay had to occur on the same date.

The overlap between A delay and B delay is most common. A delay occurring early in prosecution (*e.g.*, 14 month A delay) generally does not overlap with B delay, unless substantive examination is long delayed. However, A delay occurring more than 3 years into prosecution, where no RCE has been filed, generally does not extend a patent’s term because it overlaps with B delay.

b. An Example of Overlapping Delays

Consider the following scenario:

January 1, 2010:	Filing date
October 1, 2013	Issue Fee
April 1, 2014	Issuance

Here, because the application was filed on or after June 8, 1995, the 20 year GATT term applies. Therefore the baseline term expires on January 1, 2030. This patent is also eligible for PTA because the application was filed after May 29, 2000. There is no RCE, C delay or applicant delay in this scenario.

Because the patent application was still pending on the third anniversary of its filing date (*i.e.*, by January 1, 2013), B delay begins to accrue on January 2, 2013, and continues to accrue until issuance on April 1, 2014, for a total of 455 days of B delay. Also, because the patent did not issue by the 4 month anniversary of the payment of the issue fee (*i.e.*, by February 1, 2014), A delay begins to accrue on the next day and continues to accrue until issuance on April 1, 2014, for a total of 59 days. However, from February 1, 2014 through April 1, 2014, both A delay and B delay were accruing. Therefore, those 59 days are not double counted, and the total amount of patent term adjustment is 455 days. Assuming no other effects, the expiration of this patent is 455 days after the baseline expiration date, or April 1, 2031.

5. Applicant Delay

When enacting the AIPA and creating PTA, Congress recognized the potential for an applicant to purposefully delay prosecution to shift his patent’s term forward in time. To limit such attempts, Congress provided for a reduction in PTA “equal to the period of time during

which the applicant failed to engage in reasonable efforts to conclude prosecution of the application” (applicant delay). 35 U.S.C. § 154(b)(2)(C). Congress defined one particular example of applicant delay and gave the Patent Office substantive rulemaking authority to define other instances. Those delays are detailed in 37 U.S.C. § 1.704(b) and (c), respectively. However, where one flavor of applicant delay overlaps with another, the applicant is not penalized twice. 37 C.F.R. § 1.704(c).

Applicant delay is pernicious. Not only does it cut off the expiration date of any patent that would otherwise receive PTA, but also it presumably delays the issuance of the patent. Hence, each day of applicant delay may actually shorten the enforceable term of a patent by two days.

a. Statutory (3 Month) Applicant Delay

The PTA statute defines one instance of applicant delay:

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

35 U.S.C. § 154(b)(2)(C)(ii). Although the statute appears to apply this statutory applicant delay “with respect to [B delay],” the regulations apply it regardless of whether or how much B delay there may be. *See* 37 C.F.R. § 1.704(b). Note that the 3 month period for PTA purposes is completely unrelated to any shortened statutory period for reply. *Id.* Note also that this 3 month period is asymmetrical with the Patent Office’s 4 month period for many replies. *See* 35 U.S.C. § 154(b)(1)(A). A notice of missing parts does not trigger statutory applicant delay. However, statutory applicant delay is triggered by restrictions, non-final and final office actions, objections to drawings, notices of allowance, requirements for information under 37 C.F.R. § 1.105, etc.

In calculating statutory applicant delay, the amount of delay is the number of days beginning on the day after the 3 month anniversary of the office action, etc., and ending on the day of the response, inclusive. Thus, an office action issued on February 1, 2012, must be responded to by May 1, 2012, to avoid applicant delay. A response on August 1, 2012, will accrue 92 days of statutory applicant delay.

If an applicant petitions before the patent issues and makes “a showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply within three months,” then the Patent Office may reinstate up to 3 months of statutory applicant delay. 35 U.S.C. § 154(b)(3)(C); 37 C.F.R. § 1.705(c).

b. Regulatory Applicant Delays Applicant Requests for Delay

Congress gave the Patent Office substantive rulemaking authority to define additional applicant delays. 35 U.S.C. § 154(b)(2)(C)(iii). Those regulatory applicant delays are set out at 37 C.F.R. §§ 1.704(c)(1)-(12).

(1) Applicant Requests for Delay

Applicant delays under 37 C.F.R. § 1.704(c)(1) and (2) concern the applicant's request to suspend prosecution or defer issuance. *See* 37 C.F.R. §§ 1.103, 1.314. These delays may be doubly harmful to patent term adjustment, because they trigger an exception to B delay under 35 U.S.C. § 154(b)(1)(B)(iii).

(2) Abandonment

Applicant delays under 37 C.F.R. § 1.704(c)(3) and (4) concern abandonment of an application. If the application is abandoned (or the issue fee paid late), then there is applicant delay from the date of abandonment until a petition to revive is granted (or accepting the late issue fee), up to a maximum of 4 months. 37 C.F.R. § 1.704(c)(3). Moreover, if a petition to revive is not filed within 2 months after a notice of abandonment, applicant delay accrues until such a petition is filed, with no limit. 37 C.F.R. § 1.704(c)(4).

(3) Conversion of a Provisional Application

Converting a provisional application to a non-provisional application incurs applicant delay for the period of time until the conversion is requested. 37 C.F.R. § 1.704(c)(5). There seems to be no good reason to ever incur this applicant delay.

(4) Amendments Requiring a Supplemental Office Action

If a preliminary amendment (or other "preliminary paper" such as an IDS) is filed, and if an office action or notice of allowance is mailed less than one month later, and if a supplemental office action or notice is mailed as a result of the preliminary amendment or paper, then the time between the original and supplemental office actions or notices of allowance is applicant delay, up to a maximum of 4 months. 37 C.F.R. § 1.704(c)(6).

Similarly, if an amendment (or other paper such as an IDS) is filed after a PTAB decision with a new ground of rejection or after a court decision, and if an office action or notice of allowance is mailed less than one month later, and if a supplemental office action or notice is mailed as a result of the amendment or paper, then the time between the original and supplemental office actions or notices of allowance is applicant delay, up to a maximum of 4 months. 37 C.F.R. § 1.704(c)(9).

(5) Supplemental Replies

A reply with an omission creates applicant delay from the time of the first reply and the corrected reply. 37 C.F.R. § 1.704(c)(7). Similarly, a supplemental reply (unless expressly requested by the examiner) will also trigger applicant delay from the time of the original reply

and the supplemental reply. 37 C.F.R. § 1.704(c)(8). Corrections and supplements can be viewed broadly to include many papers filed by an applicant after his reply, but before the Patent Office's next action, including not just a supplemental amendments or replies, but also information disclosure statements (IDSs) and terminal disclaimers. However, preliminary amendments and interview summaries are not considered corrected replies and do not trigger applicant delay. Wherever possible, all "supplements" should be filed at the same time as a substantive response.

In the author's experience, applicants filing an IDS after an amendment, instead of simultaneously with it, the second most common source of applicant delay, behind statutory 3 month applicant delay. However, if the references in an IDS were first cited in a counterpart application, and if the applicant received that communication no more than 30 days before filing the IDS (akin to *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 487 F.3d 897 (Fed. Cir. 2007)), then the applicant can avoid applicant delay under 37 C.F.R. § 1.704(c) (6), (7), (8), or (9) by filing a statement to that effect with the IDS. See 37 C.F.R. § 1.704(d),

(6) Papers after a Notice of Allowance

A Rule 312 amendment or other paper filed after a notice of allowance (other than papers filed along with the issue fee), will incur applicant delay from the date of the amendment or other paper, until the date of the Patent Office's response. 37 C.F.R. § 1.704(c)(10). Even a status request, if transmitted and entered into the file wrapper instead of telephoned to the examiner, will incur this applicant delay. However, a Rule 705(d) petition to restore statutory applicant delay will not trigger applicant delay under this section.

(7) Late Appeal Brief

After filing a notice of appeal, failure to file an appeal brief within 3 months will incur applicant delay for any additional time required. 37 C.F.R. § 1.704(c)(11). This ground for applicant delay was added for applications allowed on or after September 17, 2012, when the period from the filing of a notice of appeal until jurisdiction passes to the Board was made eligible for B delay. Before that change, it was possible to file a notice of appeal and then take up to 7 months (with extension) to file an appeal brief or RCE, without incurring applicant delay.

(8) Continuation Application

37 C.F.R. § 1.704(c)(12) makes clear that in a continuation application, no patent term adjustment can accrue from or carry over from before the filing date. Each application stands on its own without regard to priority. See *Mohsenzadeh v. Lee*, No. 1:13-cv-824, 2014 U.S. Dist. LEXIS 38666 (E.D. Va. Mar. 19, 2014).

6. Process for Determining and Appealing Patent Term Adjustment

The total amount of patent term adjustment is the sum of A, B, and C delays, minus any overlap, and minus any applicant delay. If the amount of applicant delay exceeds the amount of non-overlapping A, B, and C delays, the patent term adjustment is zero; it cannot be negative and cannot result in any net loss of term.

The Patent Office notifies the applicant of the anticipated PTA (without B delay) with a notice of allowance and prints the result of its calculation on the face of the patent. *See* 35 U.S.C. § 154(b)(3)(B)(i); 37 C.F.R. § 1.705(a). A patentee may petition for correction of this calculation within 2 months of issue, extendable by five additional months. 37 C.F.R. § 1.705(b). A decision on that petition triggers a 180 day statute of limitations for filing a civil action to correct PTA, with exclusive jurisdiction in the Eastern District of Virginia. 35 U.S.C. § 154(b)(4)(A). Third parties may not challenge PTA administratively. 37 C.F.R. § 1.705(d). Corrections to PTA will appear in a certificate of correction.

For patents issued before April 1, 2013, when this portion of the AIA Technical Corrections Act became effective, if the applicant thought the calculation was in error, she had to file a pre-issuance petition to seek reconsideration, and a post-issuance petition was due within 2 months of issue. The statute of limitations for a civil action was 180 days after issue, although some courts would toll that statute if a petition was still pending.

In *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014), Novartis argued that the 180 day limitation period should be tolled based on changes in the law concerning RCEs and B delay. The Federal Circuit soundly rejected that theory, giving finality to the Patent Office's determination if not appealed promptly.

Finally, although prosecution is closed, the Patent Office considers there to be a duty of disclosure akin to Rule 56 during the PTA petition process. 65 Fed. Reg. 56387 (comments on the AIPA). Because a petition under Rule 705 must include the correct PTA, that duty presumably includes the duty to disclose any errors that the Patent Office may have made in the patentee's favor. Presumably, they would be outweighed by errors in favor of the patentee, otherwise the patentee would not be filing a petition.

F. Terminal Disclaimers

Terminal disclaimers are permitted by 35 U.S.C. § 253 and 37 C.F.R. § 1.321, and they apply equally to design, utility, and plant patents. They cut off the term of a patent *after* any patent term adjustment has been applied to the baseline term, but before any patent term extension has been applied. *See* 35 U.S.C. § 154(b)(2)(B); 37 C.F.R. § 1.703(g); *Merck & Co. v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317 (Fed Cir. 2007).

Terminal disclaimers may be used by an applicant to overcome non-statutory, obviousness type double patenting rejections, where an claimed invention in one application is merely an obvious variation of another patent claim of the same inventor. A terminal disclaimer prevents a later-issued patent from effectively getting a timewise extension of the right to exclude granted by the same inventor's earlier patent, due to a later expiration date. *Boehringer Ingelheim Int'l GmbH v. Barr Labs., Inc.*, 592 F.3d 1340, 1347 (Fed. Cir. 2010). Moreover, terminal disclaimers require that common ownership of the disclaimed and the disclaimed-over patents be maintained, so that an accused infringer cannot be sued by different patentees. *In re Hubbell*, 709 F.3d 1140, 1148-49 (Fed. Cir. 2013). GATT did not mean the end of obvious type double patenting rejections, nor of the use of terminal disclaimers to overcome them. Although GATT eliminated many differences in patent term between related applications, differences do

remain (due to, for example, different specific references or different awards of patent term adjustment or extension).

The effect of a terminal disclaimer may or may not depend upon the exact wording used. Older disclaimers in particular tend to disclaim the term beyond a date certain, while the modern trend is to disclaim beyond the expiration of the prior patent which caused a double patenting rejection, using a form provided by the Patent Office. Where the date certain is not the expiration date of the prior patent (such as when an expiration date changed due to GATT), the issue becomes which date applies: the date in the terminal disclaimer, or the date on which the prior patent's term expired. In the leading case on the issue, the Federal Circuit interpreted a pre-GATT terminal disclaimer that disclaimed the term beyond "October 01, 2002, the earlier of the expiration dates of U.S. Patent Nos. 4,544,658 (issued October 01, 1985) and 4,556,658 (issued December 03, 1985)." The Court held that the disclaimer date was not October 1, 2002, but instead was modified by GATT. *See Bayer AG v. Carlsbad Tech., Inc.*, 298 F.3d 1377 (Fed. Cir. 2002). It remains unclear whether the case would have come out the same way had the terminal disclaimer only stated a date certain. Nevertheless, to receive the longest term possible, and to avoid ambiguity, Patent Office form PTS/SB/25 is the safest bet; it does not disclaim any term lost due to premature termination (discussed below) or to a terminal disclaimer filed before the patent issues.

Terminal disclaimers create a recursive calculation; that is, to calculate the term of a patent with a terminal disclaimer, it is necessary to calculate the term of the preceding patent. If the preceding patent also has a terminal disclaimer, then it is necessary to calculate the term of the second preceding patent, and so forth.

G. Patent Term Extension

Patent term extension, first made available as part of the Hatch-Waxman Act in 1984, permits extension of the term of certain patents concerning products that cannot be marketed before regulatory review (*e.g.*, pharmaceuticals, medical devices, and food additives) to be extended upon application to the Patent Office. *See generally* 35 U.S.C. § 156. Patent term extension is applied after any patent term adjustment and after any terminal disclaimer. *See Merck & Co. v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317 (Fed Cir. 2007). However, patent term extension is an extensive topic that is not covered by this paper.

Patent term extension should not be confused with former section 155 of the Patent Act, titled "Patent term extension," which was originally put in place in 1995 as part of GATT but which has since been repealed.

A related section of the Patent Act, 35 U.S.C. § 155A (titled, "Patent term restoration") affected certain drug patents affected by FDA approval process in the 1970s and 1980s, all of which have long since expired. Patent term restoration is moot and was repealed as part of the AIA.

H. Premature Termination

Even once a patent's expiration date is calculated, including any patent term adjustment, terminal disclaimer, and patent term extension, it is still possible that the right to exclude will not

last for the entire term of the patent. Determining whether a patent has expired requires checking these premature terminations.

1. Maintenance Fees

Maintenance fees apply to utility patents only and are due 3-1/2, 7/1/2, and 11-1/2 years after issue of the patent. 35 U.S.C. §§ 41(b)(1) & (3). With the GATT baseline term, it is possible for some patents to expire before maintenance fees are due, particularly the 11-1/2 year fee. A payment window opens 6 months before the due date, and a grace period allows payment (with a surcharge) up to 6 months after a due date. 35 U.S.C. § 41(b)(2). A patent expires at the end of the grace period. 35 U.S.C. § 41(c)(2). The status of maintenance fees is publicly available on the Patent Office website.

However, patents that have expired due to the non-payment of a maintenance fee are not necessarily “dead.” Upon petition, the Patent Office can excuse unintentional delay in payment for another 2 years, and unavoidable delay indefinitely, although intervening rights apply. 35 U.S.C. § 41(c)(1). Such petitions are visible on PAIR.

2. The “Re-s”: Reissue, Reexamination, and Review

Any of the post-issue administrative procedures to evaluate patentability has the potential to cut off a patent’s (or particular claims’) term, or to eliminate it *ab initio*. These include reissue, 35 USC § 251, *ex parte* reexamination and supplemental examination, 35 USC §§ 257, 302, *inter partes* reexamination, 35 USC § 311 (pre-AIA), *inter partes* review, 35 USC § 311 (post-AIA), post-grant review, 35 USC § 321 (post-AIA), transitional covered business method patent review, AIA § 18. Reexaminations themselves, and the existence of reviews, are normally visible in PAIR.

3. Disclaimer

A patentee may not only make a terminal disclaimer, but may also disclaim the entire term of a patent. 35 U.S.C. § 253. Disclaimers appear in PAIR.

4. Judgments

Judgments may alter a patent’s term, may render a patent invalid (on a claim by claim basis) or unenforceable. Judgments should appear in PAIR. 35 U.S.C. § 290.

III. Conclusion

The calculation of a patent’s term is no longer a simple exercise that can be conducted quickly and simply. Particularly with patent term adjustment, the calculation is not only confusing and technical, but may also change depending upon the various dates for application, allowance, and issue. Practitioners should pay particular attention to the calculation of patent term because of the many implications it can have in licensing, in litigation, and in the life sciences.