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USPTO's Interim Procedures for Patent Term Adjustment under *Wyeth*

The U.S. Patent and Trademark Office (USPTO) is modifying the computer program it uses to calculate Patent Term Adjustment (PTA) in light of the recent decision in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). In *Wyeth*, the U.S. Court of Appeals for the Federal Circuit affirmed that the USPTO has been improperly calculating patent term adjustment under 35 U.S.C. § 154(b). The Federal Circuit's decision will result in additional patent term for many U.S. patents, however, there are strict deadlines and immediate review of recently granted patents may be important to pursue this opportunity.

The USPTO expects its software modification to be complete by March 2, 2010, at which point newly issuing patents should have the correct term adjustment calculation in the USPTO's electronic records. In the meantime, the USPTO has announced it is waiving one of the timing requirements to request a correction, and providing patentees with the option to request this PTA recalculation without a fee as an alternative to the petition and fee required by 37 C.F.R. § 1.705(d) within two months from grant of a patent. More importantly, the period from two months to six months after grant of a patent typically requires filing suit in district court against the USPTO, however, the USPTO has now taken the position that its proposed fee-free request will be sufficient to correct the PTA calculation.

In order to qualify for this PTA recalculation option, a form requesting a recalculation of the PTA must be submitted no later than 180 days after the patent has issued, and the patent must be issued prior to March 2, 2010. In addition, this procedure is only available for alleged errors in PTA calculations that are specifically identified in *Wyeth*. The USPTO form (PTO/513/131) for requesting a recalculation of PTA in view of *Wyeth* is now available on the [USPTO Web site](#).

Before simply filing this form for recently granted patents, however, there are some substantive issues that should be considered to protect your rights. First, the optional recalculation of PTA may preclude a patentee from seeking relief under 35 U.S.C. § 154(b)(4)(A), which would otherwise allow "[a]n applicant dissatisfied with a determination made by the Director... remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent." This is because 35 U.S.C. § 154(b)(3)(B)(ii) "provide[s] the applicant *one opportunity* to request reconsideration of any patent term adjustment determination made by the Director" (emphasis added). Thus, requesting reconsideration of the PTA through the PTO's interim procedures may preclude a patentee from using a second opportunity to request reconsideration of any other PTA decision or error made by the Director. For a patent that has a PTA error not related to *Wyeth* that is larger than the *Wyeth* error, for example, filing this USPTO form might cause irrevocable loss of the other option to obtain the correct PTA.

Another unaddressed issue is the status of patents having been issued for more than 180 days. The USPTO interim procedures require the request form to be submitted no later than 180 days after the patent has issued. Therefore, it appears the patentee is out of luck because neither the USPTO's notice nor the statute provide a remedy for improper PTA calculation after this time period has elapsed. The General Hospital Corporation, however, is already seeking review of the PTA on a patent that issued more than 180 days before suit was filed. *The General Hospital Corporation v. Dudas*, No. 1:09-cv-00109-RMU (D.D.C. filed Jan. 16, 2009). A determination in this case was stayed pending the results of *Wyeth*. Now that *Wyeth* has been decided, the outcome of this case may provide the answer to this important undecided issue of whether a patentee with a patent issued for more than 180 days will be able to seek PTA recalculation for error(s) related to *Wyeth*.

Bearing on this case is the USPTO assertion that the requirement of 35 U.S.C. § 154(b)(4) that any civil action be filed within 180 days is **not** waived. This agency decision will likely be given deference by the District of DC in deciding the General Hospital Corporation case. Moreover, patentees should be mindful of this 180-day window even if the USPTO's decision from their optional request has not yet arrived.

If you have any questions regarding your specific situation, feel free to contact any of the [patent lawyers](#) at Haynes and Boone, LLP.

[Wei Wei Jeang](#)
972.739.8631
weiwei.jeang@haynesboone.com

[Sanjay Pant](#)
972.739.6939
sanjay.pant@haynesboone.com