

Patent Term Extensions

Update

The Patent Office has now posted the “Interim Procedure” for patentees to request recalculations of patent term extensions in light of the recent Wyeth decision.

In order to take advantage of the procedure, patent owners must request recalculations of patent term extensions no later than 180 days after the patent has issued. This procedure is only available for patents issued prior to March 2, 2010.

Please contact us if you would like further information.

Summary

Owners of recently issued patents that were delayed by the Patent Office may have the opportunity to gain extensions of patent term. The Federal Circuit recently issued its decision in Wyeth, finding that the Patent Office had been incorrectly calculating patent term extensions and that Wyeth’s patent was entitled to additional patent term.

Both the USPTO and the Department of Justice have decided not to seek further review of the Federal Circuit’s decision. Accordingly, the Patent Office will change its patent term extension calculations to conform to the Wyeth decision.

Background

In 1995, the effective term of a patent was changed from seventeen years from issuance to twenty years from filing. In 1999, the American Inventors Protection Act amended a statute to ensure patent applicants patent term extensions (i.e., “patent term adjustment”) for any delay during the prosecution of an application caused by the Patent Office. Specifically, the statute

guaranteed a patent applicant (subject to limitations): (A) prompt Patent Office responses; (B) no more than a 3-year application pendency; and, (C) adjustments for delays due to interferences, secrecy orders and appeals.

Any delay by the Patent Office under the (A) clause extends the term of the patent one day for each day the Patent Office does not meet certain examination deadlines. Likewise, any delay by the Patent Office under the (B) clause extends the term of the patent one day for each day the Patent Office fails to issue a patent within three years after the actual filing date of the application. The (A) and (B) clauses, however, are subject to limitations, which state that if any periods of delay under the (A) and (B) clauses overlap, an applicant will not be credited with delays under both clauses.

Wyeth v. Kappos

At issue in the Wyeth case was the determination of the meaning of the term “overlap” with regard to the periods of delay under the (A) and (B) clauses. The patent in question was Wyeth’s U.S. Patent No. 7,179,892, which had 610 days of delay under the (A) clause, 345 days of delay under the (B) clause, and 51 days of delay under the (A) clause that occurred after three years from the date the application was filed. The Patent Office’s view was that delay under the (B) clause began with the filing of the application, such that the entire period of delay under the (A) clause “overlaps” with the entire period of delay under the (B) clause. As such, Wyeth should receive the greater of either delays caused under the (A) clause (610 days) or delays caused under the (B) clause (345 days), but not both. Conversely, Wyeth argued that delay under the (B) clause does not begin until three years after

filing of the application and that the only way delays under the (A) clause and the (B) clause can “overlap” is if the periods of delay occur on the same calendar day. Accordingly, Wyeth argued that only 51 days of delay “overlapped” under the statute.

The Federal Circuit panel decision agreed with Wyeth’s reading of the statute, holding that before the three-year mark, no “overlap” can occur between (A) clause delays and (B) clause delays because the (B) clause delays have yet to take effect. Thus, if an (A) clause delay occurs on one day, and a (B) clause delay occurs on a different day, those two days do not “overlap” under the statute. Accordingly, Wyeth was awarded an additional 294 days of patent term extension (i.e., 345 days of (B) delay minus 51 days of overlap).

Implications

If you have a recently issued patent that was delayed by the Patent Office for failure to meet certain examination deadlines and/or that did not issue within three years of the filing date of the application, you may benefit from a review by patent counsel. The Intellectual Property practice group at Armstrong Teasdale invites you to contact us with any questions or concerns that your company may have about patent term extensions in light of the Wyeth decision.

For more information about the content of this article, please contact any of the attorneys listed below.

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