

Torys on Intellectual Property

IP 2010-3

February 3, 2010

Patentees May Request Recalculation of U.S. Patent Terms

By [Edward Fan](#)

The United States Patent and Trademark Office (PTO) has released guidelines explaining how patentees of recently issued patents may request the recalculation of the terms of their patents.¹ This guidance arose from the Court of Appeals decision in *Wyeth v. Kappos* in January 2010, which held that the PTO had previously misapplied the statutory provisions relating to patent term adjustments.²

At issue in *Wyeth* were two periods of patent term adjustments provided by the U.S. patent statute: (i) an adjustment period for delays caused by the PTO's failure to adhere to prescribed deadlines for certain actions during the examination process; and (ii) an adjustment period for a patent that issues more than three years after its application date as a result of delays caused by the PTO.

In the past, the PTO had calculated the patent term adjustment as the longer of the adjustment periods of (i) and (ii). However, in *Wyeth*, the Court found that a patent term adjustment should be cumulative of the adjustments periods in (i) and (ii), except when the two periods overlap; in that case any period of overlap should then be subtracted from the cumulative total of the adjustment periods of (i) and (ii) to avoid double counting any period of overlap.

As a result, when a patent issued with patent term adjustments based on both (i) PTO delays during examination and (ii) PTO delays resulting in issuance more than three years after filing, the *Wyeth* decision would generally lead to additional patent term being available to the patentee. In addition to announcing that it would not further appeal the *Wyeth* decision,³ the PTO has also provided guidance to patentees of recently issued patents so that they may request recalculation of their patent term adjustment. According to the new guidance, an applicant merely has to submit a request within 180 days of the issue date of the patent to request the PTO to reconsider the available patent term adjustment. The guidance includes a simple form that the patentee can complete to request recalculation.

Patentees considering seeking recalculation of their patent terms should also assess whether to concurrently pursue a civil action, especially if they are submitting their recalculation requests to the PTO close to the end of the 180-day period and if it is unclear whether the PTO will confirm a correction by the expiry of the period for requesting reconsideration. **1**

To discuss these issues, please contact the author.

For media calls, please contact [Stuart Wood](#), Chief Marketing Officer, 416.865.8205.

To contact us, please email info@torys.com.

Torys' bulletins are available on our website at www.torys.com, under Publications.

This bulletin is a general discussion of certain legal and related developments and should not be relied upon as legal advice. If you require legal advice, we would be pleased to discuss the issues in this bulletin with you, in the context of your particular circumstances.

© 2010 by Torys LLP. All rights reserved.

¹ www.uspto.gov/patents/announce/pta_wyeth.pdf.

² C.A.F.C. No. 2009-1120 (Jan. 7, 2010).

³ www.uspto.gov/patents/announce/wyeth_v_kappos.jsp.