

Term Extensions

It is possible for the lifetime ("term") of a US patent to be extended if the United States Patent and Trademark Office (USPTO) delays processing of the application. However, any extension can be reduced if delays are caused by actions of the applicant. This sheet summarises the law and suggests ways to maximise any possible term extension. As a general guide, you need to give us instructions in good time (i.e. at least a month) before any due date in order to make use of these provisions.

BACKGROUND

The provisions relating to term extensions apply to US patent applications filed on or after 29th May 2000.

The concept underlying these provisions is that a patent applicant should be compensated by means of extensions to the term of their patent if the USPTO delays the processing of their application.

However, any such term extensions can be reduced or wiped out if the applicant "fails to engage in reasonable efforts to conclude processing or examination".

The application of these provisions cannot result in a patent having a term less than 20 years from its filing date.

Delays by the USPTO

The patent term can be increased if the USPTO fails to:

- issue a first Official Action or notice of allowance within fourteen months of filing;
- issue an action within four months of an applicant's response to an Official Action;
- issue the patent within four months of payment of the issue fee.

The patent term will also be extended if the USPTO fails to issue a patent within three years of the actual filing date of the application, with certain provisos.

The patent term will also be increased for delays caused by interference proceedings, secrecy orders and successful appeals.

The overall extension is calculated by adding the various delays.

Reductions in term extensions

Any extension which results from Patent Office delays will be reduced if the applicant fails to engage in reasonable efforts to conclude processing or examination. This is currently defined as including:

- taking more than three months to reply to any notice or action by the USPTO making any rejection, objection, argument or other request; or
- any one of a number of other separately enumerated specific circumstances resulting in delay, such as filing incomplete responses.

As stated above, these latter reductions only serve to reduce any positive adjustments to patent term. They cannot reduce the patent term below the standard term of 20 years from the filing date.

Calculation of extension

The USPTO will calculate any term extension to which they believe the applicant is entitled (based on an expected issue date) and detail this on the notice of allowance.

It is possible to dispute this calculation by filing a protest.

If the patent issues on a date other than the expected issue date and this necessitates a revision of the previously advised term extension, the patent will indicate the revised patent term adjustment.

Why is this important?

It is not uncommon to use the three month automatic extension for replying to Official Actions issued by the Examiner to allow time for consideration of the Examiner's report.

Previously, such an approach may have added slightly to the cost of the application but had no further effect.

Such a strategy could now have the effect of reducing any possible patent terms extension caused by the delay of the USPTO.

The number of cases where this will matter is small; overall, almost two thirds of all US patents are not renewed for their whole term. Therefore trying to maximise any possible term extension may not be necessary in all situations. However, it may be important for some or all of your cases.

What do you need to do?

If you are interested in maximising any possible patent term extension on any case, we ask that you:

- inform us of your interest in maximising patent term extension; and
- give us instructions to reply to an Official Action from the USPTO at least one month in advance of the official reply deadline.

In these circumstances we will make every effort to ensure that prompt instructions are sent to the US attorneys handling the case, and that they are aware of your interest in maximising patent term extension.

This sheet reflects our current understanding of the law and applicable rules, which may be amended in the future.

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