

# Patent Term Adjustment (PTA)

Calculating PTA after Wyeth

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# Patent Term Adjustment (PTA)

- The term of a patent is 20 years from the date on which the patent application was filed
- 37 CFR 1.701-1.705 set forth adjustments to the patent term due to PTO and Applicant delays
- Two PTO Delay timelines:
  - 1.702(a) delay
    - Specific delays by the PTO (14-4-4)
  - 1.702(b) delay
    - Longer than 3 years of prosecution
- If overlapping, the two timelines are not counted twice
- These extensions will be reduced by applicant delay (37 CFR 1.704)

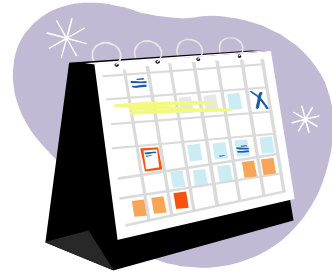


# PTA Goals

- The goal of PTA is to create incentives to guarantee prompt action from both sides in prosecuting patents
- Prompt action is defined by the PTO as:
  - Mail an official action or NOA within 14 months after the filing date of the patent application
  - Respond to a reply/appeal by the applicant within 4 months after the filing date of the reply/appeal
  - Act on an application within 4 months of a decision by the Board
  - Issue a patent within 4 months after the date on which the issue fee was paid
  - Less than 3 years of total prosecution time from filing

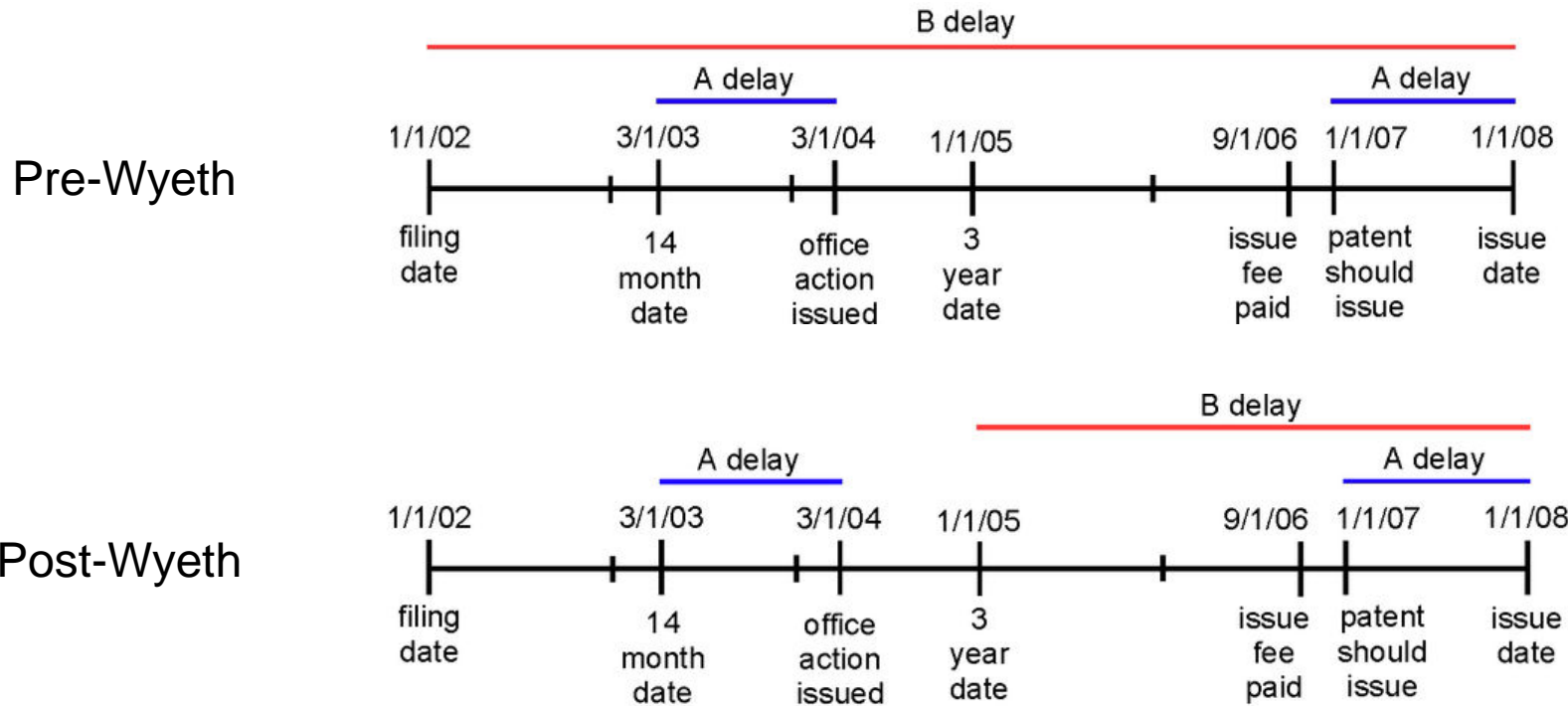
# PTA is Reduced By

- Requesting extensions for Replies
  - Anything over 3 months
- Filing anything just prior to Office Action
  - Within 30 days of Mailing Date
- Filing supplemental submissions
  - Supplemental Reply, IDS after Reply, Etc.
- Filing anything after allowance
  - Drawings, IDS, Comments on Examiner's Reasons for Allowance, 312 Amendment, Etc.



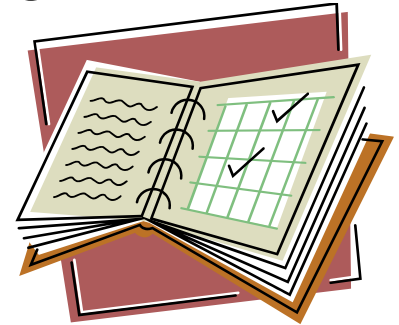
# Effect of Wyeth

- After Wyeth, the period of overlap of the two timelines is considered differently:



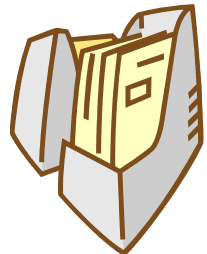
# PTA Calculation

- There are two times that Patent Term Adjustment (PTA) is calculated
  - At Allowance
  - and again at Issuance
    - Because PTA can change between Allowance and Issuance
- PTA is often miscalculated by the PTO
- We need to check it carefully after each PTO calculation



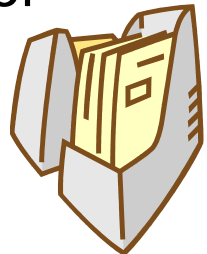
# PTA and IDS

- Patent Term Adjustment (PTA) can be negatively affected by IDS submissions.
- Generally, under 37 C.F.R. § 1.704, PTA is reduced by:
  - Preliminary submissions made less than one month prior to the mailing date of an office action;
  - Supplemental submissions made after the filing of a office action reply;
  - Submissions made after decision on appeal and less than one month prior to the mailing date of an office action; and
  - Submissions made after mailing of Notice of Allowance.



# PTA and IDS

- IDS submissions can avoid PTA consequences.
- 37 C.F.R. § 1.704 states that a paper containing only a compliant IDS will not reduce PTA if:
  - it is accompanied by a statement that each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart application, and
  - that this communication was not received by any individual designated with a duty to disclose under 37 C.F.R. §1.56 more than thirty days prior to the filing of the IDS.





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**THE END**