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2701 Patent Term [R-11.2013]

35 U.S.C. 154 *Contents and term of patent; provisional rights.*

(a) IN GENERAL.—

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under [section 120](#), [121](#), or [365\(c\)](#) from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under [section 119](#), [365\(a\)](#), or [365\(b\)](#) shall not be taken into account in determining the term of a patent.

(c) CONTINUATION.—

(1) DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

(2) REMEDIES.—The remedies of [sections 283](#), [284](#), and [285](#) shall not apply to acts which —

(A) were commenced or for which substantial investment was made before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) became infringing by reason of paragraph (1).

(3) REMUNERATION.—The acts referred to in paragraph (2) may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under [chapter 28](#) and [chapter 29](#) (other than those provisions excluded by paragraph (2)).

For applications filed on or after June 8, 1995, Section 532(a)(1) of the Uruguay Round Agreements Act (Pub. L. No. 103-465, 108 Stat. 4809 (1994)) amended [35 U.S.C. 154](#) to provide that the term of a patent (other than a design patent) begins on the date the patent issues and ends on the date that is twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#), twenty years from the filing date

of the earliest of such application(s). This patent term provision is referred to as the “twenty-year term.” Design patents have a term of fourteen years from the date of patent grant, except for any design patent issued from applications filed on or after the date of entry into force of the Hague Treaty as to the United States, has a term of fifteen years from the date of patent grant (see Pub. L. No. 112-211). See [35 U.S.C. 173](#) and [MPEP § 1505](#).

All patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the “twenty-year term” or seventeen years from the patent grant. See [35 U.S.C. 154\(c\)](#). A patent granted on an international application filed before June 8, 1995, and which entered the national stage under [35 U.S.C. 371](#) before, on or after June 8, 1995, will have a term that is the greater of seventeen years from the date of grant or twenty years from the international filing date or any earlier filing date relied upon under [35 U.S.C. 120](#), [121](#) or [365\(c\)](#). The terms of these patents are subject to reduction by any applicable terminal disclaimers (discussed below).

I. CONTINUING APPLICATIONS

A patent granted on a continuation, divisional, or continuation-in-part application that was filed on or after June 8, 1995, will have a term which ends twenty years from the filing date of earliest application for which a benefit is claimed under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#), regardless of whether the application for which a benefit is claimed under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#) was filed prior to June 8, 1995.

II. INTERNATIONAL APPLICATIONS

A patent granted on an international application filed on or after June 8, 1995 and which enters the national stage under [35 U.S.C. 371](#) will have a term which ends twenty years from the filing date of the international application. A continuation or a continuation-in-part application claiming benefit under [35 U.S.C. 365\(c\)](#) of an international application filed under [35 U.S.C. 363](#) designating the United States will have a term which ends twenty

years from the filing date of the parent international application.

III. FOREIGN PRIORITY

Foreign priority under [35 U.S.C. 119\(a\)-\(d\)](#), [365\(a\)](#), or [365\(b\)](#) is not considered in determining the term of a patent. Accordingly, an application claiming priority under [35 U.S.C. 365\(a\)](#) or [365\(b\)](#) has a term which ends twenty years from the filing date of the application in the United States and not the prior international application.

IV. DOMESTIC BENEFIT UNDER [35 U.S.C. 119\(e\)](#)

Domestic priority under [35 U.S.C. 119\(e\)](#) to one or more U.S. provisional applications is not considered in the calculation of the twenty-year term. See [35 U.S.C. 154\(a\)\(3\)](#).

V. EXPIRATION DATE OF PATENTS WITH TERMINAL DISCLAIMERS

To determine the “original expiration date” of a patent subject to a terminal disclaimer, it is generally necessary to examine the language of the terminal disclaimer in the patent file history. If the disclaimer disclaims the terminal portion of the term of the patent which would extend beyond the expiration date of an earlier issued patent, then the expiration date of the earlier issued patent determines the expiration date of the patent subject to the terminal disclaimer. Before June 8, 1995, the terminal disclaimer date was printed on the face of the patent; the date was determined from the expected expiration date of the earlier issued patent based on a seventeen year term measured from grant. When [35 U.S.C. 154](#) was amended such that all patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the “twenty year term” or seventeen years from the patent grant, the terminal disclaimer date as printed on many patents became incorrect. If the terminal disclaimer of record in the patent file disclaims the terminal portion of the patent subsequent to the full statutory term of a referenced patent (without identifying a specific date), then the date printed on the face of the patent is incorrect when the full

statutory term of the referenced patent is changed as a result of [35 U.S.C. 154\(c\)](#). That is, the referenced patent's "twenty year term" is longer than the seventeen year term. In such a case, a patentee may request a Certificate of Correction under [37 CFR 1.323](#) to correct the information printed on the face of the patent. However, if the terminal disclaimer of record in the patent file disclaims the terminal portion of the patent subsequent to a specific date, without reference to the full statutory term of a referenced patent, then the expiration date is the date specified. Several decisions related to disclaimers are posted in the Freedom of Information Act (FOIA) section of the USPTO Web site (www.uspto.gov).

VI. PATENT TERM EXTENSIONS OR ADJUSTMENTS

See [MPEP § 2710](#) *et seq.* for patent term extensions or adjustments for delays within the USPTO under [35 U.S.C. 154](#) for utility and plant patents issuing on applications filed on or after June 8, 1995. Patents that issue from applications filed before June 8, 1995, are not eligible for patent term extension or patent term adjustment under [35 U.S.C. 154](#).

See [MPEP § 2750](#) *et seq.* for patent term extensions available under [35 U.S.C. 156](#) for premarket regulatory review. The patent term extension that may be available under [35 U.S.C. 156](#) for premarket regulatory review is separate from and will be added to any extension that may be available under former and current [35 U.S.C. 154](#). While patents that issue from applications filed before June 8, 1995, are not eligible for term adjustment under [35 U.S.C. 154](#), such patents may be extended under [35 U.S.C. 156](#).

2702-2709 [Reserved]

2710 Term Extensions or Adjustments for Delays Within the USPTO Under 35 U.S.C. 154 [R-11.2013]

Utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension provisions of former [35 U.S.C. 154\(b\)](#) and [37 CFR 1.701](#). See

[MPEP § 2720](#). Utility and plant patents issuing on applications filed on or after May 29, 2000 are eligible for the patent term adjustment provisions of [35 U.S.C. 154\(b\)](#) (effective May 29, 2000 and amended thereafter) and [37 CFR 1.702 -1.705](#). See [MPEP § 2730](#). See *Thomas D. Sykes v. Jon W. Dudas*, 573 F.Supp2d 191, 89 USPQ2d 1423 (D.D.C. 2008).

Plant and utility patents issuing on applications filed before June 8, 1995 which have a term that is the greater of the "twenty-year term" (see [MPEP § 2701](#)) or seventeen years from patent grant are not eligible for term extension or adjustment due to delays in processing the patent application by the United States Patent and Trademark Office.

Since the term of a design patent is not affected by the length of time prosecution takes place, there are no patent term adjustment provisions for design patents.

2711-2719 [Reserved]

2720 Applications Filed Between June 8, 1995, and May 28, 2000 [R-11.2013]

Former 35 U.S.C. 154 Contents and term of patent.

(b) TERM EXTENSION.—

(1) INTERFERENCE DELAY OR SECRECY ORDERS.—If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.—If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.—The period of extension referred to in paragraph (2)—

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.—The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference or derivation proceedings under [35 U.S.C. 135\(a\)](#); and/or

(2) The application being placed under a secrecy order under [35 U.S.C. 181](#); and/or

(3) Appellate review by the Patent Trial and Appeal Board or by a Federal court under [35 U.S.C. 141](#) or [145](#), if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under [35 U.S.C. 151](#) in the application, the remand shall be considered a decision in the review reversing an adverse determination of patentability as that phrase is used in [35 U.S.C. 154\(b\)\(2\)](#) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103-465, 108 Stat. 4809, 4983-85 (1994), and a final decision in favor of the applicant under paragraph (c)(3) of this section. A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under [35 U.S.C. 132\(b\)](#) that was not first preceded by the mailing, after such remand, of at least one of an action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#).

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c) (1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference or derivation proceeding in which the application was involved, the number of days, if any, in the period beginning on the date the interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under [35 U.S.C. 181](#);

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under [§ 41.39](#) of this

title in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding would be instituted but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under [37 CFR 5.3\(c\)](#) and ending on the date of mailing of the notice of allowance under [§ 1.311](#).

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Patent Trial and Appeal Board was filed under [35 U.S.C. 134](#) and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#).

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

The twenty-year term of a patent issuing from an application filed on or after June 8, 1995, and before May 29, 2000, may be extended for a maximum of five years for delays in the issuance of the patent due to interferences, secrecy orders and/or successful appeals to the Patent Trial and Appeal Board (Board) or the Federal courts in accordance with [37 CFR 1.701](#). See [former 35 U.S.C. 154\(b\)](#), as reproduced above. Extensions for successful appeals are limited in that the patent must not be subject to a terminal disclaimer. Further, the period of extension will be reduced by any time attributable to appellate review within three years of the filing date of the first national application for patent, and the period of extension for appellate review will be reduced by any time during which the applicant did not act with due diligence. The patent term extension that may be available under [35 U.S.C. 156](#) for premarket regulatory review is separate from and will be added to any extension that may be available under former and current [35 U.S.C. 154](#). See [MPEP § 2750 et seq. 35 U.S.C. 154\(b\)](#) was amended, effective May 29, 2000, to provide for patent term adjustment for applications filed on or after May 29, 2000, but the provisions of [former 35 U.S.C. 154\(b\)](#), as reproduced above, continue to apply to applications

filed between and including June 8, 1995 and May 28, 2000. [35 U.S.C. 154](#) also was amended effective Sept. 16, 2012 and Jan. 14, 2013.

Examiners make no decisions regarding patent term extensions. Any patent term extension granted as a result of administrative delay pursuant to [37 CFR 1.701](#) will be printed on the face of the patent in generally the same location as the terminal disclaimer information. The term of a patent will be readily discernible from the face of the patent (i.e., from the filing date, continuing data, issue date and any patent term extensions printed on the patent).

If applicant disagrees with the patent term extension information printed on the front page of the patent, applicant may request review by way of a petition under [37 CFR 1.181](#). If the petition is granted, a Certificate of Correction pursuant to [37 CFR 1.322](#) will be issued.

Effective May 24, 2004, [37 CFR 1.701\(a\)\(3\)](#) was amended to indicate that certain remands by the Board shall be considered “a decision in the review reversing an adverse determination of patentability” for patent term extension purposes.

Petitions and Certificates of Correction regarding patent term extension under [former 35 U.S.C. 154\(b\)](#) should be addressed to Mail Stop Patent Ext., Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

2721-2729 [Reserved]

2730 Applications Filed on or After May 29, 2000; Grounds for Adjustment [R-11.2013]

35 U.S.C. 154 Contents and term of patent; provisional rights.

(b) ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under [section 132](#) or a notice of allowance under [section 151](#) of this title not later than 14 months after—

(I) the date on which an application was filed under [section 111\(a\)](#); or

(II) the date of commencement of the national stage under [section 371](#) in an international application;

(ii) respond to a reply under [section 132](#), or to an appeal taken under [section 134](#), within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Patent Trial and Appeal Board under [section 134](#) or [135](#) or a decision by a Federal court under [section 141](#), [145](#), or [146](#) in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under [section 151](#) and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under [section 111\(a\)](#) in the United States, or, in the case of an international application, the date of commencement of the national stage under [section 371](#) in the international application, not including—

(i) any time consumed by continued examination of the application requested by the applicant under [section 132\(b\)](#);

(ii) any time consumed by a proceeding under [section 135\(a\)](#), any time consumed by the imposition of an order under [section 181](#), or any time consumed by appellate review by the Patent Trial and Appeal Board or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OF ADJUSTMENTS FOR DELAYS DUE TO DERIVATION PROCEEDINGS, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under [section 135\(a\)](#);

(ii) the imposition of an order under [section 181](#);

or

(iii) appellate review by the Patent Trial and Appeal Board or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(2) LIMITATIONS.—

(A) IN GENERAL.— To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

(B) DISCLAIMED TERM.— No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of

any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

(A) The Director shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

(B) Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination no later than the date of issuance of the patent; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

(C) The Director shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

(4) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.—

(A) An applicant dissatisfied with the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have the exclusive remedy by a civil action against the Director filed in the United States District Court for the Eastern District of Virginia within 180 days after the date of the Director's decision on the applicant's request for reconsideration. Chapter 7 of title 5, United States Code, shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

(B) The determination of a patent term adjustment under this subsection shall not be subject to appeal or challenge by a third party prior to the grant of the patent.

37 CFR 1.702 Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) *Failure to take certain actions within specified time frames.* Subject to the provisions of [35 U.S.C. 154\(b\)](#) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#) not later than fourteen months after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the date the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application;

(2) Respond to a reply under [35 U.S.C. 132](#) or to an appeal taken under [35 U.S.C. 134](#) not later than four months after the date on which the reply was filed or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Patent Trial And Appeal Board under [35](#)

[U.S.C. 134](#) or [135](#) or a decision by a Federal court under [35 U.S.C. 141](#), [145](#), or [146](#) where at least one allowable claim remains in the application; or

(4) Issue a patent not later than four months after the date on which the issue fee was paid under [35 U.S.C. 151](#) and all outstanding requirements were satisfied.

(b) *Three-year pendency.* Subject to the provisions of [35 U.S.C. 154\(b\)](#) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application, but not including:

(1) Any time consumed by continued examination of the application under [35 U.S.C. 132\(b\)](#);

(2) Any time consumed by an interference or derivation proceeding under [35 U.S.C. 135\(a\)](#);

(3) Any time consumed by the imposition of a secrecy order under [35 U.S.C. 181](#);

(4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) *Delays caused by interference and derivation proceedings.* Subject to the provisions of [35 U.S.C. 154\(b\)](#) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#).

(d) *Delays caused by secrecy order.* Subject to the provisions of [35 U.S.C. 154\(b\)](#) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the application being placed under a secrecy order under [35 U.S.C. 181](#).

(e) *Delays caused by successful appellate review.* Subject to the provisions of [35 U.S.C. 154\(b\)](#) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Patent Trial and Appeal Board under [35 U.S.C. 134](#) or by a Federal court under [35 U.S.C. 141](#) or [145](#), if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under [35 U.S.C. 151](#) in the application, the remand shall be considered a decision by the Patent Trial and Appeal Board as that phrase is used in [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#), a decision in the review reversing an adverse determination of patentability as that phrase is used in [35 U.S.C. 154\(b\)\(1\)\(C\)\(iii\)](#), and a final decision in favor of the applicant under [§ 1.703\(e\)](#). A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under [35 U.S.C. 132\(b\)](#) that was not first preceded by the mailing, after such remand, of at least one of an action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#).

(f) The provisions of this section and [§§ 1.703](#) through [1.705](#) apply only to original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

[35 U.S.C. 154\(b\)](#), was amended effective May 29, 2000, and further amended by Public Law 112-29, enacted on September 16, 2011, known as the Leahy-Smith America Invents Act (AIA) and by Public Law 112-274, enacted on January 14, 2013, known as the AIA Technical Corrections Act. All references to [35 U.S.C. 154\(b\)](#) hereinafter are to [35 U.S.C. 154\(b\)](#), as amended effective May 29, 2000

and as further amended by the Public Laws 112-29 and 112-274. [37 CFR 1.702-1.705](#) implement the provisions of [35 U.S.C. 154\(b\)](#) and apply to utility and plant patent applications filed on or after May 29, 2000.

Due to various effective dates of changes to the provisions of [37 CFR 1.702-1.705](#), there are several versions currently in place. For example, there is a version of [37 CFR 1.702](#) that applies only to patents granted on or after January 14, 2013 and another version that applies to patents granted prior to January 14, 2013. For another example, there is a version of the provisions of [37 CFR 1.703\(b\)\(4\)](#) and [\(e\)](#) that are only applicable to applications and patents in which a notice of allowance issued on or after September 17, 2012. Office personnel need to carefully consider the effective date provisions in the regulations in order to determine which version to apply to the particular application or patent under consideration.

[37 CFR 1.702](#) sets forth the bases for patent term adjustment under [35 U.S.C. 154\(b\)\(1\)](#).

[37 CFR 1.702\(a\)](#) indicates that a patent is entitled to patent term adjustment if the Office fails to perform certain acts of examination within specified time frames ([35 U.S.C. 154\(b\)\(1\)\(A\)](#)).

Effective September 16, 2012, the Board of Patent Appeals and Interferences has been re-designated the Patent Trial and Appeal Board. Accordingly, [37 CFR 1.702\(a\)\(3\)](#) has been amended to reflect the re-designation of the patent appeal board.

For applications in which a patent was granted on or after January 14, 2013, [37 CFR 1.702\(a\)\(1\)](#) provides patent term adjustment if the Office fails to mail either a notification under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C. 151](#) not later than 14 months after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the date the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application. For applications filed on or after May 29, 2000 in which the patent was granted prior to January 14 2013, the fourteen month measurement in international applications is based upon the date that the

application fulfilled the requirements of [35 U.S.C. 371](#) and not the date the national stage commenced.

[37 CFR 1.702\(b\)](#) indicates that a patent is entitled to patent term adjustment if, subject to a number of limitations, the Office fails to issue a patent within three years of the actual filing date of the application ([35 U.S.C. 154\(b\)\(1\)\(B\)](#)). In the case of an international application, the phrase “actual filing date of the application in the United States” means the date the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#). See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 Fed. Reg. 56366, 56382-84, (Sept. 18, 2000), 1239 Off. Gaz. Pat. Office 14, 28-30 (Oct. 3, 2000). On January 14, 2013 Section 1(h)(1)(B) of the AIA Technical Corrections Act amended [35 U.S.C. 154\(b\)\(1\)\(B\)](#) to change “the actual filing date of the application in the United States” to “the actual filing date of the application under [section 111\(a\)](#) in the United States, or, in the case of an international application, the date of commencement of the national stage under [section 371](#) in the international application.” The clarification of the meaning of the phrase “actual filing date of the application in the United States” did not require a change to the language of [37 CFR 1.702\(b\)](#) because the Office had interpreted, by regulation, the language of the former 35 U.S.C. 154(b)(1)(B) to have the same meaning as the current [35 U.S.C. 154\(b\)\(1\)\(B\)](#), as discussed above. See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 Fed. Reg. 56366, 56382-84, (Sept. 18, 2000), 1239 Off. Gaz. Pat. Office 14, 28-30 (Oct. 3, 2000). See also *Revisions to Patent Term Adjustment*, 78 Fed. Reg. 19416, 19417 (Apr. 1, 2013), 1389 Off. Gaz. Pat. Office 224 (Apr. 23, 2013).

Effective on September 16, 2012, [37 CFR 1.702\(b\)\(2\)](#) was amended to reflect the statutory change in section 3(i) of the AIA that replaced interference proceedings with derivation proceedings for some applications. In addition, section 3(j) of the AIA re-designated the title “Board of Patent Appeals and Interferences” as “Patent Trial and Appeal Board” in [35 U.S.C. 134](#), [145](#), [146](#), [154](#), and [305](#). Accordingly, [37 CFR 1.702\(b\)\(4\)](#) was amended to reflect the re-designation of the title of the Board. See *Changes to Implement Miscellaneous Post*

Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 46615 (August 6, 2012).

[37 CFR 1.702\(c\)](#) also indicates that a patent is entitled to patent term adjustment if the issuance of the patent was delayed by an interference proceeding ([35 U.S.C. 154\(b\)\(1\)\(C\)\(i\)](#)). Effective September 16, 2012, [37 CFR 1.702\(c\)](#) was amended to reflect the statutory change in section 3(i) of the AIA that replaced interference proceedings with derivation proceedings for certain applications. Specifically, [37 CFR 1.702\(c\)](#) added derivation proceedings to the guarantees of adjustment for Office delays. In addition, section 3(j) of the AIA redesignated the title “Board of Patent Appeals and Interferences” as “Patent Trial and Appeal Board” in [35 U.S.C. 134](#), [145](#), [146](#), [154](#), and [305](#). [37 CFR 1.702\(d\)](#) indicates that a patent is entitled to patent term adjustment if the issuance of the patent was delayed by the application being placed under a secrecy order under [35 U.S.C. 181](#) ([35 U.S.C. 154\(b\)\(1\)\(C\)\(ii\)](#)). [37 CFR 1.702\(e\)](#) indicates that a patent is entitled to patent term adjustment if the issuance of the patent was delayed by successful appellate review under [35 U.S.C. 134](#), [141](#), or [145](#) ([35 U.S.C. 154\(b\)\(1\)\(C\)\(iii\)](#)).

Effective May 24, 2004, [37 CFR 1.702\(e\)](#) was amended to indicate that certain remands by the Board of Patent Appeals and Interferences shall be considered “a decision in the review reversing an adverse determination of patentability” for patent term adjustment purposes. Effective September 16, 2012, [37 CFR 1.702\(e\)](#) was amended to implement section (3)(j) of the AIA by re-designating the title “Board of Patent Appeals and Interferences” as “Patent Trial and Appeal Board”.

[37 CFR 1.702\(f\)](#) provides that the provisions of [37 CFR 1.702](#) through [1.705](#) apply only to original (i.e., non-reissue) applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications. Since a continued prosecution application (CPA) filed under [37 CFR 1.53\(d\)](#) is a new (continuing) application, a CPA filed on or after May 29, 2000, and before July 14, 2003, is entitled to the benefits of the patent term adjustment provisions of [35 U.S.C. 154\(b\)](#) and [37 CFR 1.702](#) through [1.705](#). Since a request for

continued examination (RCE) filed under [35 U.S.C. 132\(b\)](#) and [37 CFR 1.114](#) is **not** a new application (it is a submission in a previously filed application), filing an RCE in an application filed before May 29, 2000, does **not** cause that application to be entitled to the benefits of the patent term adjustment provisions of [35 U.S.C. 154\(b\)](#) and [37 CFR 1.702](#) through [1.705](#).

37 CFR 1.703 Period of adjustment of patent term due to examination delay.

(a) The period of adjustment under [§ 1.702\(a\)](#) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) the date the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under [§ 1.111](#) was filed and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with [§ 1.113\(c\)](#) was filed and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with [§ 41.37](#) was filed and ending on the date of mailing of any of an examiner’s answer under [§ 41.39](#), an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Patent Trial and Appeal Board or by a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#) or [146](#) where at least one allowable claim remains in the application and ending on the date of mailing of either an action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first; and

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

(b) The period of adjustment under [§ 1.702\(b\)](#) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under [35 U.S.C. 132\(b\)](#) was filed and ending on the date the patent was issued;

(2) (i) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office

due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#) not involving the application and ending on the date of the termination of the suspension;

(3) (i) The number of days, if any, the application was maintained in a sealed condition under [35 U.S.C. 181](#);

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under [§ 41.39](#) in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under [§ 5.3\(c\)](#) of this chapter and ending on the date of mailing of the notice of allowance under [35 U.S.C. 151](#); and,

(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under [§ 41.35\(a\)](#) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under [§ 41.35\(b\)](#) of this chapter or the date of the last decision by a Federal court in an appeal under [35 U.S.C. 141](#) or civil action under [35 U.S.C. 145](#), whichever is later.

(c) The period of adjustment under [§ 1.702\(c\)](#) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#) not involving the application and ending on the date of the termination of the suspension.

(d) The period of adjustment under [§ 1.702\(d\)](#) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, the application was maintained in a sealed condition under [35 U.S.C. 181](#);

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under [§ 41.39](#) in the application under secrecy order and ending on the date the secrecy order was removed;

(3) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(4) The number of days, if any, in the period beginning on the date of notification under [§ 5.3\(c\)](#) of this chapter and ending on the date of mailing of the notice of allowance under [35 U.S.C. 151](#).

(e) The period of adjustment under [§ 1.702\(e\)](#) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under [§ 41.45\(a\)](#) of this chapter and ending on the date of a final decision in favor of applicant by the Patent Trial and Appeal Board or a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#).

(f) The adjustment will run from the expiration date of the patent as set forth in [35 U.S.C. 154\(a\)\(2\)](#). To the extent that periods of delay attributable to the grounds specified in [§ 1.702](#) overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under [§ 1.702](#) and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under [§ 1.704](#). The date indicated on

any certificate of mailing or transmission under [§ 1.8](#) shall not be taken into account in this calculation.

(g) No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under [§ 1.702](#) and this section beyond the expiration date specified in the disclaimer.

On September 16, 2012, [37 CFR 1.703](#) was amended to reflect the statutory change in section 3(i) of the AIA that replaced interference proceedings with derivation proceedings for certain applications. See AIA section 3(n). [37 CFR 1.702\(c\)](#) added derivation proceedings to the guarantees of adjustment for Office delays. In addition, section 3(j) of the AIA redesignated the “Board of Patent Appeals and Interferences” as “Patent Trial and Appeal Board” in [35 U.S.C. 134](#), [145](#), [146](#), [154](#), and [305](#). [37 CFR 1.703\(a\)\(5\)](#) was amended to reflect the change to the title of the Patent Board and [37 CFR 1.703\(b\)\(2\)](#), [\(b\)\(3\)](#), [\(c\)\(1\)](#), and [\(d\)\(3\)](#) were amended to reflect the addition of derivation proceedings to the rules providing parent term adjustment for Office delay.

Effective September 17, 2012, any application that receives a notice of allowance on or after such date and issues as a patent, is entitled to patent term adjustment under [37 CFR 1.702\(e\)](#) for the sum of the number of days, if any, in the period beginning on the date on which jurisdiction passes to the Patent Trial and Appeal Board and ends on the date of a final decision in favor of applicant by the Patent Trial and Appeal Board or a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#). See *Revisions of Patent Term Adjustment Provisions Relating to Appellate Review*, 77 Fed. Reg. 49354 (August 16, 2012).

Effective September 17, 2012, any application that receives a notice of allowance on or after such date and issues as a patent, the three year delay under [37 CFR 1.703\(b\)](#) does not include the number of days, if any, in the period beginning on the date which jurisdiction passes to the Patent Trial and Appeal Board under [37 CFR 41.35\(a\)](#) to the date that the jurisdiction by of the Patent Trial and Appeal Board ends under [37 CFR 41.35\(b\)](#) or the date of the last decision by the Federal court in an appeal under [35 U.S.C. 141](#) or civil action under [35 U.S.C. 145](#).

The Office will also apply the changes to [37 CFR 1.703](#) in any timely patent term adjustment reconsideration proceeding that is initiated on or after September 17, 2012. To allow patentees to take

advantage of changes to this provision relating to appellate review, the Office will consider the following timely-filed proceedings to be eligible "patent term adjustment reconsideration proceeding" if initiated on or after September 17, 2012:

(1) Reconsideration proceedings initiated pursuant to a remand from a timely filed civil action in Federal court;

(2) reconsideration proceedings initiated pursuant to a timely request for reconsideration of the patent term adjustment indicated in the patent under [37 CFR 1.705\(d\)](#) (2012) in which the patentee argues that the change to [37 CFR 1.703](#) in this final rule is applicable to his or her patent; and

(3) reconsideration proceedings initiated pursuant to a request for reconsideration that seeks reconsideration of the Office's decision under [37 CFR 1.705\(d\)](#) (2012) regarding patent term adjustment under the Office's former interpretation of the appellate review language of [35 U.S.C. 154\(b\)\(1\)\(B\)\(ii\)](#) and [\(C\)\(iii\)](#), if such request is filed within two months of the date of the decision for which reconsideration is requested. See [37 CFR 1.181\(f\)](#).

For applications in which the patent was granted on or after January 14, 2013, [37 CFR 1.703\(a\)\(1\)](#) provides patent term adjustment if the Office fails to mail at least one of a notification under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C. 151](#) not later than 14 months after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the date the national stage commence under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application. For applications filed on or after May 29, 2000 in which the patent was granted prior to January 14, 2013, the fourteen month measurement in international applications is based upon the date that application fulfilled the requirements of [35 U.S.C. 371](#) and not the date the national stage commenced.

37 CFR 1.704 Reduction of period of adjustment of patent term.

(a) The period of adjustment of the term of a patent under [§ 1.703\(a\) through \(e\)](#) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in [§§ 1.702\(a\) through \(e\)](#), and in particular the ground of adjustment set forth in [§ 1.702\(b\)](#), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed

or given to the applicant, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in [§ 1.703](#) to the extent that the periods are not overlapping:

(1) Suspension of action under [§ 1.103](#) at the applicant's request, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under [§ 1.103](#) was filed and ending on the date of the termination of the suspension;

(2) Deferral of issuance of a patent under [§ 1.314](#), in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under [§ 1.314](#) was filed and ending on the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

(5) Conversion of a provisional application under [35 U.S.C. 111\(b\)](#) to a nonprovisional application under [35 U.S.C. 111\(a\)](#) pursuant to [35 U.S.C. 111\(b\)\(5\)](#), in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date the application was filed under [35 U.S.C. 111\(b\)](#) and ending on the date a request in compliance with [§ 1.53\(c\)\(3\)](#) to convert the provisional application into a nonprovisional application was filed;

(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C. 151](#) that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice of allowance; or

(ii) Four months;

(7) Submission of a reply having an omission ([§ 1.135\(c\)](#)), in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days,

if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

(9) Submission of an amendment or other paper after a decision by the Patent Trial and Appeal Board, other than a decision designated as containing a new ground of rejection under [§ 41.50\(b\)](#) of this title or statement under [§ 41.50\(c\)](#) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C. 151](#) that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

(10) Submission of an amendment under [§ 1.312](#) or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under [§ 1.312](#) or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under [§ 1.312](#) or such other paper; or

(ii) Four months;

(11) Failure to file an appeal brief in compliance with [§ 41.37](#) of this chapter within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under [35 U.S.C. 134](#) and [§ 41.31](#) of this chapter, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under [35 U.S.C. 134](#) and [§ 41.31](#) of this chapter, and ending on the date an appeal brief in compliance with [§ 41.37](#) of this chapter or a request for continued examination in compliance with [§ 1.114](#) was filed; and

(12) Further prosecution via a continuing application, in which case the period of adjustment set forth in [§ 1.703](#) shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

(d) (1) A paper containing only an information disclosure statement in compliance with [§§ 1.97](#) and [1.98](#) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement.

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in [§ 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in [§ 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendible.

(e) The submission of a request under [§ 1.705\(c\)](#) for reinstatement of reduced patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

Section 3(j) of the AIA redesignated the title “Board of Patent Appeals and Interferences” as “Patent Trial and Appeal Board” in [35 U.S.C. 134, 145, 146, 154, and 305](#). Effective September 16, 2012, [37 CFR 1.704\(c\)\(9\)](#) was amended to reflect the change to the title of the Board.

Effective December 1, 2011, [37 CFR 1.704\(d\)](#) was amended to allow the diligent applicant to avoid patent term adjustment reduction for an IDS submission that results from a communication from the Office if submitted within 30 days of receipt of the action by any individual designated in [37 CFR 1.56\(c\)](#). See *Revision of Patent Term Adjustment Provisions Relating to Information Disclosure Statements*, 76 Fed. Reg. 74700 (Dec. 1, 2011). Previously, this section only allowed a diligent applicant to avoid patent term adjustment reduction if the IDS was cited as a result from a foreign patent Office.

Effective September 17, 2012, [37 CFR 1.704\(c\)\(11\)](#) was amended to provide that failure to file an appeal brief in compliance with [37 CFR 41.37](#) within three months from the date that the notice of appeal was filed would constitute a failure to engage in reasonable efforts to conclude processing or examination of the application. The amended rule is applicable with respect to the filing of an appeal brief in any application (other than design or reissue applications) in which the notice of appeal is filed on or after September 17, 2012.

Effective September 17, 2012, the provision previously labeled as 1.704(c)(11) is located in [37 CFR 1.704\(c\)\(12\)](#).

37 CFR 1.705 Patent term adjustment determination

(a) The patent will include notification of any patent term adjustment under [35 U.S.C. 154\(b\)](#).

(b) Any request for reconsideration of the patent term adjustment indicated on the patent must be by way of an application for patent term adjustment filed no later than two months from the date the patent was granted. This two-month period may be extended under the provisions of [§ 1.136\(a\)](#). An application for patent term adjustment under this section must be accompanied by:

- (1) The fee set forth in [§ 1.18\(e\)](#); and
- (2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under [§ 1.702](#) for the adjustment;

(ii) The relevant dates as specified in [§§ 1.703\(a\) through \(e\)](#) for which an adjustment is sought and the adjustment as specified in [§ 1.703\(f\)](#) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv) (A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in [§ 1.704](#); or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in [§ 1.704](#).

(c) Any requests for reinstatement of all or part of the period of adjustment reduced pursuant to [§ 1.704\(b\)](#) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request be filed prior to the issuance of the patent. This time period is not extendable. Any request for reinstatement of all or part of the period of adjustment reduced pursuant to [§ 1.704\(b\)](#) must also be accompanied by:

(1) The fee set forth in [§ 1.18\(f\)](#); and

(2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) No submission or petition on behalf of a third party concerning patent term adjustment under [35 U.S.C. 154\(b\)](#) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

Any patent granted on or after January 14, 2013, is subject to amended [37 CFR 1.705](#).

2731 Period of Adjustment [R-11.2013]

37 CFR 1.703 Period of adjustment of patent term due to examination delay.

(a) The period of adjustment under [§ 1.702\(a\)](#) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the date the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under [§ 1.111](#) was filed and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with [§ 1.113\(c\)](#) was filed and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with [§ 41.37](#) was filed and ending on the date of mailing of any of an examiner's answer under [§ 41.39](#), an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first;

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision

by the Patent Trial and Appeal Board or by a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#) or [146](#) where at least one allowable claim remains in the application and ending on the date of mailing of either an action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first; and

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

(b) The period of adjustment under [§ 1.702\(b\)](#) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or the national stage commenced under [35 U.S.C. 371\(b\)](#) or [\(f\)](#) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under [35 U.S.C. 132\(b\)](#) was filed and ending on the date the patent was issued;

(2) (i) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#) not involving the application and ending on the date of the termination of the suspension;

(3) (i) The number of days, if any, the application was maintained in a sealed condition under [35 U.S.C. 181](#);

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under [§ 41.39](#) in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under [§ 5.3\(c\)](#) of this chapter and ending on the date of mailing of the notice of allowance under [35 U.S.C. 151](#); and,

(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under [§ 41.35\(a\)](#) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under [§ 41.35\(b\)](#) of this chapter or the date of the last decision by a Federal court in an appeal under [35 U.S.C. 141](#) or civil action under [35 U.S.C. 145](#), whichever is later.

(c) The period of adjustment under [§ 1.702\(c\)](#) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference or proceeding was instituted to involve the application in the interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#) not involving the application and ending on the date of the termination of the suspension.

(d) The period of adjustment under [§ 1.702\(d\)](#) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, the application was maintained in a sealed condition under [35 U.S.C. 181](#);

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under [§ 41.39](#) of this title in the application under secrecy order and ending on the date the secrecy order was removed;

(3) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(4) The number of days, if any, in the period beginning on the date of notification under [§ 5.3\(c\)](#) of this chapter and ending on the date of mailing of the notice of allowance under [35 U.S.C. 151](#).

(e) The period of adjustment under [§ 1.702\(e\)](#) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under [§ 41.35\(a\)](#) of this chapter and ending on the date of a final decision in favor of applicant by the Patent Trial and Appeal Board or a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#).

(f) The adjustment will run from the expiration date of the patent as set forth in [35 U.S.C. 154\(a\)\(2\)](#). To the extent that periods of delay attributable to the grounds specified in [§ 1.702](#) overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under [§ 1.702](#) and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under [§ 1.704](#). The date indicated on any certificate of mailing or transmission under [§ 1.8](#) shall not be taken into account in this calculation.

(g) No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under [§ 1.702](#) and this section beyond the expiration date specified in the disclaimer.

[37 CFR 1.703](#) specifies the period of adjustment if a patent is entitled to patent term adjustment under [35 U.S.C. 154\(b\)\(1\)](#) and [37 CFR 1.702](#). When a period is indicated (in [37 CFR 1.703](#) or [1.704](#)) as “beginning” on a particular day, that day is included in the period, in that such day is “day one” of the period and not “day zero.” For example, a period beginning on April 1 and ending on April 10 is ten (and not nine) days in length.

[35 U.S.C. 154\(b\)\(1\)\(A\) and \(B\)](#) provide for an adjustment of one day for each day after the end of the period set forth in [35 U.S.C. 154\(b\)\(1\)\(A\)\(i\), \(ii\), \(iii\), \(iv\), and \(B\)](#) until the prescribed action is taken, whereas [35 U.S.C. 154\(b\)\(1\)\(C\)](#) provides for an adjustment of one day for each day of the pendency of the proceeding, order, or review prescribed in [35 U.S.C. 154\(b\)\(1\)\(C\)\(i\) through \(iii\)](#). Therefore, the end of the period set forth in [37 CFR 1.703\(a\)](#) and [1.703\(b\)](#) (which correspond to [35 U.S.C. 154\(b\)\(1\)\(A\) and \(B\)](#)) is “day zero” (not “day one”) as to the period of adjustment, whereas the first day of the proceeding, order, or review set forth in [37 CFR 1.703\(c\), 1.703\(d\), and 1.703\(e\)](#) (which correspond to [35 U.S.C. 154\(b\)\(1\)\(C\)\(i\) through \(iii\)](#)) is “day one” of the period of adjustment.

[37 CFR 1.703\(a\)](#) pertains to [35 U.S.C. 154\(b\)\(1\)\(A\)](#) and indicates that the period of adjustment under [37 CFR 1.702\(a\)](#) is the sum of the periods specified in [37 CFR 1.703\(a\)\(1\)](#) through [37 CFR 1.703\(a\)\(6\)](#).

[37 CFR 1.703\(a\)\(1\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(A\)\(i\)](#) and specifies that the period is the number of days, if any, beginning on the date after the day that is fourteen months after the date on which the application was filed under [35 U.S.C. 111\(a\)](#) or fulfilled the requirements of [35 U.S.C. 371](#) in an international application and ending on the mailing date of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first. For purposes of [35 U.S.C. 154\(b\)\(1\)\(A\)\(i\)\(II\)](#) in effect prior to enactment of the AIA Technical Corrections Act, an international application fulfills the requirements of [35 U.S.C. 371](#) on the date of commencement of the national stage under [35 U.S.C. 371\(b\) or \(f\)](#), or the date the application fulfills the requirements of [35 U.S.C. 371\(c\)](#) if that date is later than the date of commencement of the national stage under [35 U.S.C. 371\(b\) or \(f\)](#). In other words, the requirements of [35 U.S.C. 371](#) are met when applicant has met all of the requirements of [35 U.S.C. 371\(c\)](#) and, unless applicant requests early processing under [35 U.S.C. 371\(f\)](#), the time limit set forth in the applicable one of [PCT Articles 22](#) and [39](#) has expired. Accordingly, the requirements of [35 U.S.C. 371](#) are met when the Office can begin examination of the patent application. If, for example, an applicant files the required oath or declaration ([35 U.S.C. 115](#)) and any necessary English translation after the expiration of the time limit set forth in [Article 22](#) of the PCT or the time limit under [Article 39](#) of the PCT, the date the requirements of [35 U.S.C. 371](#) are met is the date the requirements of [35 U.S.C. 371\(c\)](#) are met. If, however, an applicant files the required declaration, filing fee, and any required English translation before the expiration of the relevant [PCT Article 22](#) or [Article 39](#) time period, but does not request early processing under [35 U.S.C. 371](#), the requirements of [35 U.S.C. 371](#) will be met once the applicable time period has expired.

For patents issuing from international application that are granted on or after January 14, 2013, [37 CFR 1.703\(a\)\(1\)](#) in effect on April 1, 2013 applies. The AIA Technical Corrections Act and the changes

to [37 CFR 1.703\(a\)\(1\)](#) revised the date that begins the fourteen-month measurement from the date on which the international application fulfilled the requirements of [35 U.S.C. 371](#) to the date of commencement of the national stage under [35 U.S.C. 371](#). The change to [35 U.S.C. 154\(b\)\(1\)\(A\)\(i\)\(II\)](#) means that the time period will begin sooner in international applications where the inventor does not file the inventor's oath or declaration ([35 U.S.C. 371\(c\)\(4\)](#)) or other requirements at the time of the commencement.

A written restriction requirement, a written election of species requirement, a requirement for information under [37 CFR 1.105](#), an action under *Ex parte Quayle*, 1935 Comm'r Dec. 11 (1935), and a notice of allowability (PTOL-37) are each an action issued as a result of the examination conducted pursuant to [35 U.S.C. 131](#). As such, each of these Office actions is a notification under [35 U.S.C. 132](#). Office notices and letters issued as part of the pre-examination processing of an application are not notices issued as a result of an examination conducted pursuant to [35 U.S.C. 131](#), and thus are not notifications under [35 U.S.C. 132](#). Examples of such pre-examination processing notices are: a Notice of Incomplete Nonprovisional Application, a Notice of Omitted Item(s) in a Nonprovisional Application, a Notice to File Missing Parts of Application, a Notice of Informal Application, a Notice to File Corrected Application Papers Filing Date Granted, or a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures.

Written restriction requirements are notifications under [35 U.S.C. 132](#). In considering whether a restriction requirement under [35 U.S.C. 121](#) was appealable under [35 U.S.C. 134](#), the Court of Customs and Patent Appeals (CCPA) noted that: (1) [35 U.S.C. 121](#) denoted its restriction procedure as a "requirement"; (2) [35 U.S.C. 132](#) stated that the Commissioner shall give notice to the applicant whenever "any claim for a patent is rejected, or any objection or requirement made"; and (3) [35 U.S.C. 134](#) provided for an appeal only by an applicant whose claims have been "twice rejected." See *In re Hengehold*, 440 F.2d 1395, 1402-03, 169 USPQ 473,479 (CCPA 1971). Thus, the CCPA concluded that Congress intended to differentiate between

objections and requirements ([35 U.S.C. 132](#)) and actual rejections of claims ([35 U.S.C. 132](#)) and made appeal applicable only to the latter. See *Hengehold*, 440 F.2d at 1403, 169 USPQ at 479. Since the CCPA cited with approval the "requirement" language of [35 U.S.C. 121](#) and evaluated rejections, objections, and requirements together under [35 U.S.C. 132](#) when discussing and differentiating among them to determine whether a restriction requirement was appealable under [35 U.S.C. 134](#), the CCPA must have considered a restriction requirement to be a requirement under [35 U.S.C. 132](#). In other words, the CCPA's analysis determined that the making of a written restriction (or election) requirement is a notification under [35 U.S.C. 132](#). See also *Digital Equipment Corp. v. Diamond*, 653 F.2d 701, 713 n.13, 210 USPQ 521, 535-36 n.13 (1st Cir. 1981) ([35 U.S.C. 132](#) when noting that the terms "requirement" and "objection" are distinct from "rejection" and as such, objections were not appealable under [35 U.S.C. 134](#)). In addition, the Office has long considered a written restriction requirement containing no action on the merits to be a notice under [35 U.S.C. 132](#). For example, [MPEP § 710.02\(b\)](#) instructs examiners to set a shortened statutory period for reply of one month for a written restriction requirement containing no action on the merits under the authority given by [35 U.S.C. 133](#). [35 U.S.C. 133](#) would not apply to the period for reply to a written restriction requirement, if a written restriction requirement containing no action on the merits is not a notice under [35 U.S.C. 132](#).

[37 CFR 1.703\(a\)\(2\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(A\)\(ii\)](#) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date a reply under [37 CFR 1.111](#) was filed and ending on the mailing date of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first.

[37 CFR 1.703\(a\)\(3\)](#) also pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(A\)\(ii\)](#) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date a reply in compliance with [37 CFR 1.113\(c\)](#) was filed and ending on the date of mailing of either an action under [35 U.S.C. 132](#), or a notice of

allowance under [35 U.S.C. 151](#), whichever occurs first. A reply under [37 CFR 1.113](#) is a reply to a final Office action, and a reply in compliance with [37 CFR 1.113](#) is a reply that cancels all of the rejected claims and removes all outstanding objections and requirements or otherwise places the application in condition for allowance. Any amendment after final that does not cancel all of the rejected claims and remove all outstanding objections and requirements or otherwise place the application in condition for allowance is not a reply in compliance with [37 CFR 1.113\(c\)](#) and will not trigger the four-month requirement under [37 CFR 1.703\(a\)\(3\)](#) for the Office to act on the after-final reply.

[37 CFR 1.703\(a\)\(4\)](#) also pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(A\)\(ii\)](#) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date an appeal brief in compliance with [37 CFR 41.37](#) was filed and ending on the mailing date of any of an examiner's answer under [37 CFR 41.39](#), an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first. As discussed below, the phrase "the date on which" an "appeal was taken" in [35 U.S.C. 154\(b\)\(1\)\(A\)\(ii\)](#) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with [37 CFR 41.37](#)" requires that: (1) the appeal brief fee ([37 CFR 1.17\(b\)](#)) be paid ([37 CFR 41.20](#)); and (2) the appeal brief complies with the requirements in [37 CFR 41.37\(c\)](#). However, for applications in which the appeal brief was filed on or after March 19, 2013, the fee required to accompany the appeal brief is set to zero dollars in amended [37 CFR 41.37\(a\)](#), and accordingly, the phrase "appeal brief in compliance with [37 CFR 41.37](#)" no longer requires the filing of the appeal brief fee. See *Setting and Adjusting Patent Fees*, 78 Fed. Reg. 4212, 4291 (January 18, 2013).

[37 CFR 1.703\(a\)\(5\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date of a final decision by the Patent Trial and Appeal Board (Board) or by a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#) or

[146](#), where at least one allowable claim remains in the application and ending on the mailing date of either an action under [35 U.S.C. 132](#), or a notice of allowance under [35 U.S.C. 151](#), whichever occurs first.

The phrase "allowable claims remain in the application" for purposes of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#) means that after the decision there is at least one pending claim (for purposes of statutory construction, "words importing the plural include the singular" ([1 U.S.C. 1](#))) that is not withdrawn from consideration and is not subject to a rejection, objection, or other requirement. This applies in the following situations: (1) at least one claim is allowable (not merely objected to) at the time the examiner's answer is mailed and is not canceled before, or made subject to a rejection as a result of, the appellate review; or (2) when all of the rejections applied to at least one claim are reversed, and such claim is not made subject to a rejection, as a result of the appellate review. For example:

(A) If claims 1 and 2 (both independent) are pending, the decision affirms the rejection of claim 1, and claim 2 was indicated as allowable prior to the appeal, then "allowable claims remain in the application" for purposes of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#).

(B) If claims 1 and 2 are pending, the decision affirms the rejection of claim 1, and claim 2 was objected to by the examiner prior to the appeal as being allowable except for its dependency from claim 1, "allowable claims" do not "remain in the application" for purposes of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#) (claim 2 is not allowable because there is an outstanding objection to it).

(C) If claims 1 and 2 are pending (claim 2 either depending from claim 1 or is an independent claim), and the decision affirms the rejection of claim 1 and reverses the rejection of claim 2, then "allowable claims remain in the application" for purposes of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#) (claim 2 is "allowable" within the meaning of [37 CFR 1.703\(a\)\(5\)](#)) because there is no outstanding objection or requirement as to it (see [MPEP § 1214.06](#), paragraph (II)).

For a Board decision to be a "decision by the Patent Trial and Appeal Board under [\[35 U.S.C.\] 134](#)" within the meaning of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#) (and [§ 1.703\(a\)\(5\)](#)), the decision must sustain or

reverse the rejection(s) of the claim(s) on appeal, or in limited circumstances as further described below, a remand may be deemed a decision for purposes of [37 CFR 1.703\(a\)\(5\)](#). For a Board decision to be a “decision by the Patent Trial and Appeal Board under [\[35 U.S.C.\] 135](#)” within the meaning of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#) (and [§ 1.703\(a\)\(5\)](#)), the decision must include a decision on the patentability of the claims, derivation or priority of invention.

If an application is remanded by a panel and the remand is the last action by a panel of the Board prior to the mailing of a notice of allowance under [35 U.S.C. 151](#), the remand generally shall be considered a decision by the Patent Trial and Appeal Board as that phrase is used in [35 U.S.C. 154\(b\)\(1\)\(A\)\(iii\)](#), a decision in the review reversing an adverse determination of patentability as that phrase is used in [35 U.S.C. 154\(b\)\(1\)\(C\)\(iii\)](#), and a final decision in favor of the applicant as that phrase is used in [37 CFR 1.703\(e\)](#). However, a remand by a panel of the Board shall not be considered a decision in the review reversing an adverse determination of patentability, as provided in this paragraph, if there is filed a request for continued examination under [35 U.S.C. 132\(b\)](#) that was not first preceded by the mailing, after the remand, of at least one of an action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#).

The phrase “final decision” in [37 CFR 1.703\(a\)\(5\)](#) means that: (1) the decision is the last decision in the review by the Board (or by a Federal court); and (2) the decision does not require further action by the applicant to avoid termination of proceedings as to the rejected claims. Thus, a Board decision containing a new ground of rejection under [37 CFR 41.50\(b\)](#) requires action by the applicant to avoid termination of proceedings as to the rejected claims and is, thus, is not considered a “final decision” for purposes of [37 CFR 1.703\(a\)\(5\)](#). The phrase “final decision,” however, does not require that the decision be final for purposes of judicial review (e.g., a Board decision reversing the rejection of all of the claims on appeal is not “final” for purposes of judicial review, but (absent a subsequent decision by the Board) is a “final decision” for purposes of [37 CFR 1.703\(a\)\(5\)](#)).

[37 CFR 1.703\(a\)\(6\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(A\)\(iv\)](#) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued. The date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. Note that the filing of a priority document (and processing fee) is not considered an outstanding requirement under [35 U.S.C. 154\(b\)\(1\)\(A\)\(iv\)](#) and [37 CFR 1.703\(a\)\(6\)](#) because if the priority document is not filed the patent simply issues without the priority claim (the application is not abandoned). If prosecution in an application is reopened after allowance (see [MPEP § 1308](#)), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under [35 U.S.C. 151](#) (see [MPEP § 1308](#)) and the form PTOL-85(b) from the latest notice of allowance is returned to the Office along with any outstanding requirements, such as payment of any additional fees owed and/or additional required drawings to be submitted by the applicant.

[37 CFR 1.703\(b\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(B\)](#) and indicates that the period of adjustment under [37 CFR 1.702\(b\)](#) is the number of days, if any, in the period beginning on the day after the date that is three years after the actual filing date of the application and ending on the date a patent was issued. [37 CFR 1.703\(b\)](#) also sets forth the limitations on patent term adjustment specified in [35 U.S.C. 154\(b\)\(1\)\(B\)\(i\) and \(ii\)](#). Specifically, [37 CFR 1.703\(b\)](#) provides that the period of adjustment of the term of a patent shall not include the period equal to the sum of the following periods: (1) The period of pendency consumed by continued examination of the application under [35 U.S.C. 132\(b\)](#) ([35 U.S.C. 154\(b\)\(1\)\(B\)\(i\)](#)); (2) the period of pendency consumed by interference proceedings ([35 U.S.C. 154\(b\)\(1\)\(B\)\(ii\)](#)); (3) the period of pendency consumed by imposition of a secrecy order ([35 U.S.C. 154\(b\)\(1\)\(B\)\(ii\)](#)); and (4) the period of pendency consumed by appellate review under [35 U.S.C. 134](#), [141](#), [145](#), whether successful or unsuccessful ([35 U.S.C. 154\(b\)\(1\)\(B\)\(ii\)](#)). The provisions of [35 U.S.C. 154\(b\)\(1\)\(B\)\(iii\)](#) concerning

the period of pendency consumed by delays in the processing of the application requested by the applicant are treated in [37 CFR 1.704](#) as such applicant delays are also circumstances constituting a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

[37 CFR 1.703\(c\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(C\)\(i\)](#) and indicates that the period of adjustment under [37 CFR 1.702\(c\)](#) is the sum of the following periods (to the extent that such periods are not overlapping): (1) the number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and (2) the number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under [35 U.S.C. 135\(a\)](#) not involving the application and ending on the date of the termination of the suspension.

[37 CFR 1.703\(d\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(C\)\(ii\)](#) and indicates that the period of adjustment under [37 CFR 1.702\(d\)](#) is the sum of the following periods (to the extent that such periods are not overlapping): (1) the number of days, if any, the application was maintained in a sealed condition under [35 U.S.C. 181](#); (2) the number of days, if any, in the period beginning on the date of mailing of an examiner's answer under [37 CFR 41.39](#) in the application under secrecy order and ending on the date the secrecy order was removed; (3) the number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under [35 U.S.C. 135\(a\)](#) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and (4) the number of days, if any, in the period beginning on the date of notification under [37 CFR 5.3\(c\)](#) and ending on the date of mailing of the notice of allowance under [35 U.S.C. 151](#) and [37 CFR 1.311](#).

[37 CFR 1.703\(e\)](#) pertains to the provisions of [35 U.S.C. 154\(b\)\(1\)\(C\)\(iii\)](#) and indicates that the period of adjustment under [37 CFR 1.702\(e\)](#) is the sum of

the number of days, if any, in the period beginning on the date on which a jurisdiction over the application passes to the Patent Trial and Appeal Board under [37 CFR 41.35\(a\)](#) and ending on the date of a final decision in favor of the applicant by the Board or by a Federal court in an appeal under [35 U.S.C. 141](#) or a civil action under [35 U.S.C. 145](#).

[37 CFR 1.703\(f\)](#) indicates that the adjustment will run from the expiration date of the patent as set forth in [35 U.S.C. 154\(a\)\(2\)](#) and also indicates that to the extent that periods of delay attributable to the grounds specified in [37 CFR 1.702](#) overlap, the period of adjustment will not exceed the actual number of days the issuance of the patent was delayed ([35 U.S.C. 154\(b\)\(2\)\(A\)](#)). [35 U.S.C. 154\(b\)\(2\)\(A\)](#) provides that "[t]o the extent that periods of delay attributable to grounds specified in [[35 U.S.C. 154\(b\)\(1\)](#)] overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." The USPTO previously had interpreted this provision as covering situations in which a delay by the USPTO contributes to multiple bases for adjustment (the "pre-Wyeth" interpretation of [35 U.S.C. 154\(b\)\(2\)\(A\)](#)). See *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), 1284 Off. Gaz. Pat. Office 56 (July 13, 2004). The United States Court of Appeals for the Federal Circuit, however, held that the USPTO's earlier interpretation of [35 U.S.C. 154\(b\)\(2\)\(A\)](#) was erroneous, and that periods of delay overlap under [35 U.S.C. 154\(b\)\(2\)\(A\)](#) only if the periods which measure the amount of adjustment under [35 U.S.C. 154\(b\)\(1\)](#) occur on the same calendar day. See *Wyeth v. Kappos*, 591 F.3d 1364, 93 USPQ2d 1257 (Fed. Cir. 2010).

[37 CFR 1.703\(f\)](#) also specifically indicates that the term of a patent entitled to adjustment under [37 CFR 1.702](#) and [1.703](#) shall be adjusted for the sum of the periods calculated under [37 CFR 1.703\(a\) through \(e\)](#), to the extent that such periods are not overlapping, less the sum of the periods calculated under [37 CFR 1.704](#).

Moreover, [37 CFR 1.703\(f\)](#) provides that the date indicated on any certificate of mailing or

transmission under [37 CFR 1.8](#) shall not be taken into account in this calculation. The date indicated on a certificate of mailing is used only to determine whether the correspondence is timely (including whether any extension of the time and fee are required) so as to avoid abandonment of the application or termination or dismissal of proceedings. The actual date of receipt of the correspondence in the Office is used for all other purposes. See [37 CFR 1.8\(a\)](#). Thus, while the date indicated on any certificate of mailing or transmission under [37 CFR 1.8](#) will continue to be taken into account in determining timeliness, the date of filing ([37 CFR 1.6](#)) will be the date used in a patent term adjustment calculation. Applicant may wish to consider the use of the electronic filing system (EFS), the “Express Mail Post Office to Addressee” service of the United States Postal Service ([37 CFR 1.10](#)) or facsimile transmission ([37 CFR 1.6\(d\)](#)), when permitted, for replies to be accorded the earliest possible filing date for patent term adjustment calculations. Alternatively, applicant may choose to mail correspondence with sufficient time to ensure that the correspondence is received in the Office (and stamped with a date of receipt) before the expiration of the three-month period. Applicants are encouraged to check PAIR to verify the date of deposit entered in PALM for the correspondence. Applicants should contact the Office for correction of any such entries prior to the grant of the patent. At the time of the grant of the patent, the patent term adjustment calculation will be made with the dates in PALM. Thereafter, a patent term adjustment accompanied by the requisite fee and statement or showing, will be necessary to have any reduction of patent term under [37 CFR 1.704](#) reinstated.

Finally, [37 CFR 1.703\(g\)](#) indicates that no patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under [37 CFR 1.702](#) and [1.703](#) beyond the expiration date specified in the disclaimer ([35 U.S.C. 154\(b\)\(2\)\(B\)](#)).

2732 Reduction of Period of Adjustment of Patent Term [R-11.2013]

37 CFR 1.704 Reduction of period of adjustment of patent term.

(a) The period of adjustment of the term of a patent under [§ 1.703\(a\) through \(e\)](#) shall be reduced by a period equal to the period

of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in [§§ 1.702\(a\) through \(e\)](#), and in particular the ground of adjustment set forth in [§ 1.702\(b\)](#), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in [§ 1.703](#) to the extent that the periods are not overlapping:

(1) Suspension of action under [§ 1.103](#) at the applicant’s request, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under [§ 1.103](#) was filed and ending on the date of the termination of the suspension;

(2) Deferral of issuance of a patent under [§ 1.314](#), in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under [§ 1.314](#) was filed and ending on the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

(5) Conversion of a provisional application under [35 U.S.C. 111\(b\)](#) to a nonprovisional application under [35 U.S.C. 111\(a\)](#) pursuant to [35 U.S.C. 111\(b\)\(5\)](#), in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the date the application was filed under [35 U.S.C. 111\(b\)](#) and ending on the date a request in compliance with [§ 1.53\(c\)\(3\)](#) to convert the provisional application into a nonprovisional application was filed;

(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C. 151](#) that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice of allowance; or

(ii) Four months;

(7) Submission of a reply having an omission ([§ 1.135\(c\)](#)), in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

(9) Submission of an amendment or other paper after a decision by the Patent Trial and Appeal Board, other than a decision designated as containing a new ground of rejection under [§ 41.50\(b\)](#) of this title statement under [§ 41.50\(c\)](#) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C. 151](#) that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

(10) Submission of an amendment under [§ 1.312](#) or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under [§ 1.312](#) or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under [§ 1.312](#) or such other paper; or

(ii) Four months;

(11) Failure to file an appeal brief in compliance with [§ 41.37](#) of this chapter within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under [35 U.S.C. 134](#) and [§ 41.31](#) of this chapter, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under [35 U.S.C. 134](#) and [§ 41.31](#) of this chapter, and ending on the date an appeal brief in compliance with [§ 41.37](#) of this chapter or a request for continued examination in compliance with [§ 1.114](#) was filed, and

(12) Further prosecution via a continuing application, in which case the period of adjustment set forth in [§ 1.703](#) shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

(d) (1) A paper containing only an information disclosure statement in compliance with [§§ 1.97](#) and [1.98](#) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by an individual designated in [§ 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in [§ 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendable.

(e) The submission of a request under [§ 1.705\(c\)](#) for reinstatement of reduced patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

[37 CFR 1.704](#) implements the provisions of [35 U.S.C. 154\(b\)\(2\)\(C\)](#) which provides that the period of patent term adjustment under [35 U.S.C. 154\(b\)\(1\)](#) “shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application,” and specifies certain circumstances as constituting a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Further, [35 U.S.C. 154\(b\)\(2\)\(C\)\(iii\)](#) gives the Office the authority to prescribe regulations establishing circumstances that constitute “a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.” [35 U.S.C. 154\(b\)\(2\)\(C\)](#) does not require the applicant’s action or inaction (that amounts to a failure to engage in reasonable efforts to conclude prosecution of the application) to have caused or contributed to patent term adjustment for the period of adjustment to be reduced due to such action or inaction. The patent term adjustment provisions of [35 U.S.C. 154\(b\)](#) create a balanced system allowing for patent term adjustment due to Office delays for a reasonably diligent applicant. Since the public has an interest in the technology disclosed and covered by a patent being available to the public at the earliest possible date, [35 U.S.C. 154\(b\)\(2\)\(C\)\(i\)](#) provides that patent term adjustment is reduced by any period of time during which applicant failed to engage in reasonable efforts to conclude prosecution of the application, regardless of whether the applicant’s actions or inactions caused or contributed to patent term adjustment.

[37 CFR 1.704\(a\)](#) implements the provisions of [35 U.S.C. 154\(b\)\(2\)\(C\)\(i\)](#) and sets forth that the period of adjustment shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (i.e., processing or examination) of an application.

[37 CFR 1.704\(b\)](#) provides that with respect to the ground for adjustments set forth in [37 CFR 1.702\(a\) through \(e\)](#), and in particular [37 CFR 1.702\(b\)](#), an

applicant shall be deemed to have failed to engage in reasonable efforts to conclude prosecution for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant. A Notice of Omitted Items in a Nonprovisional Application, however, is not a notice or action by the Office making a rejection, objection, argument, or other request within the meaning of [35 U.S.C. 154\(b\)\(2\)\(C\)\(ii\)](#) or [37 CFR 1.704\(b\)](#), since the Office does not require a reply to that notice to continue the processing and examination of an application. [37 CFR 1.704\(b\)](#) indicates that the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. As discussed above, a reply is considered filed on the date of its actual receipt in the Office as defined by [37 CFR 1.6](#), and the date indicated on any certificate of mailing or transmission under [37 CFR 1.8](#) will not be taken into account for patent term adjustment purposes.

The three-month period in [37 CFR 1.704\(b\)](#) applies to the Office notices and letters issued as part of the pre-examination processing of an application (except a Notice of Omitted Items in a Nonprovisional Application as discussed above). These notices include: (1) a Notice of Incomplete Nonprovisional Application (except as to any period prior to the filing date ultimately accorded to the application); (2) a Notice to File Missing Parts of Non-Provisional Application; (3) a Notice of Informal Application; (4) a Notice to File Corrected Application Papers Filing Date Granted; or (5) a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures.

In addition, the three-month period in [35 U.S.C. 154\(b\)\(2\)\(C\)\(ii\)](#) and [37 CFR 1.704\(b\)](#) applies regardless of the period for reply set in the Office action or notice. For example, if an Office action

sets a one-month period for reply (restriction requirement), the applicant may obtain a two-month extension of time under [37 CFR 1.136\(a\)](#) before being subject to a reduction of patent term adjustment under [35 U.S.C. 154\(b\)\(2\)\(C\)\(ii\)](#) and [37 CFR 1.704\(b\)](#). If, however, an Office action sets a six-month period for reply, as is commonly set in applications subject to secrecy orders (see [MPEP § 130](#)), the applicant is subject to a reduction of patent term adjustment under [35 U.S.C. 154\(b\)\(2\)\(C\)\(ii\)](#) and [37 CFR 1.704\(b\)](#) if the applicant does not reply to the Office action within three months, notwithstanding that a reply may be timely filed six months after the mailing date of the Office action. If the last day of the three-month time period from the Office communication notifying the applicant of the rejection, objection, argument, or other request falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, then action, may be taken, or fee paid, on the next succeeding secular or business day without loss of any patent term adjustment under [37 CFR 1.704\(b\)](#). See *ArQule v. Kappos*, 793 F.Supp2d 214 (D.D.C. 2011). For example, no reduction in patent term adjustment would occur if an applicant's three-month reply time period expires on a Saturday and the applicant files a reply that is received by the Office on the following Monday, which is not a Federal holiday within the District of Columbia. In this case, any patent term adjustment would not be reduced under [37 CFR 1.704\(b\)](#) because the reply was received on Monday, the next succeeding secular or business day after the expiration of the three-month reply time. If applicant files his reply on Tuesday, then any patent term adjustment for the patent issuing from the application would be reduced under [37 CFR 1.704\(b\)](#) by one day.

[37 CFR 1.704\(c\)](#) establishes further circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. [37 CFR 1.704\(c\)\(1\) through \(c\)\(11\)](#) set forth actions or inactions by an applicant that interfere with the Office's ability to process or examine an application (and, thus, are circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application), as well as the period by which a period of adjustment set forth in [37 CFR 1.703](#) shall be reduced if an

applicant engages in any of the enumerated actions or inactions. [37 CFR 1.704\(c\)](#) requires that an applicant refrain from engaging in actions or inactions that prevent or interfere with the Office's ability to process or examine an application. An applicant who is engaging in actions or inactions that prevent or interfere with the Office's ability to process or examine an application cannot reasonably be characterized as "engag[ing] in reasonable efforts to conclude processing or examination of an application" ([35 U.S.C. 154\(b\)\(2\)\(C\)\(i\)](#)).

[37 CFR 1.704\(c\)\(1\)](#) through [1.704\(c\)\(12\)](#) address situations that occur with sufficient frequency to warrant being specifically provided for in the rules of practice. These situations do not represent an exhaustive list of actions or inactions that interfere with the Office's ability to process or examine an application, since there are a myriad of actions or inactions that occur infrequently but will interfere with the Office's ability to process or examine an application (e.g., applicant files and persists in requesting reconsideration of a meritless petition under [37 CFR 1.10](#); parties to an interference obtain an extension for purposes of settlement negotiations which do not result in settlement of the interference; and when the scope of the broadest claim in the application at the time an application is placed in condition for allowance is substantially the same as suggested or allowed by the examiner more than six months earlier than the date the application was placed in condition for allowance). Thus, the actions or inactions set forth in [37 CFR 1.704\(c\)](#) are exemplary circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The Office may also reduce a period of adjustment provided in [37 CFR 1.703](#) on the basis of conduct that interferes with the Office's ability to process or examine an application under the authority provided in [35 U.S.C. 154\(b\)\(2\)\(C\)\(iii\)](#), even if such conduct is not specifically addressed in [37 CFR 1.704\(c\)](#).

[37 CFR 1.704\(c\)\(1\)](#) establishes suspension of action under [37 CFR 1.103](#) at the applicant's request as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Obviously, if action is suspended at the applicant's

request, the Office is precluded from processing or examining the application as a result of an action by the applicant. [37 CFR 1.704\(c\)\(1\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under [37 CFR 1.103](#) was filed and ending on the date of the termination of the suspension.

[37 CFR 1.704\(c\)\(2\)](#) establishes deferral of issuance of a patent under [37 CFR 1.314](#) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Obviously, if issuance of the patent is deferred under [37 CFR 1.314](#), the Office is precluded from issuing the application as a result of an action by the applicant. When a petition under [37 CFR 1.314](#) is granted, the petition decision generally states that the application will be held for a period of a month to await the filing of a paper. At the end of the period, the application is returned to the issue process without a further communication from the Office to the applicant. [37 CFR 1.704\(c\)\(2\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under [37 CFR 1.314](#) was filed and ending on the issue date of the patent.

[37 CFR 1.704\(c\)\(3\)](#) establishes abandonment of the application or late payment of the issue fee as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Obviously, if the application is abandoned (either by failure to prosecute or late payment of the issue fee), the Office is precluded from processing or examining the application as a result of an action or inaction by the applicant. [37 CFR 1.704\(c\)\(3\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the day the issue fee was due, and ending on the earlier of: (1) the date of mailing of the decision reviving the application or accepting late payment of the issue fee; or (2) the date that is four months after the date the grantable petition to revive the application or accept late

payment of the issue fee was filed. The phrase “earlier of...[t]he date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed” is to place a cap (measured from the filing date of the grantable petition) on the reduction if the Office does not act on (grant) the grantable petition to revive within four months of the date it was filed.

[37 CFR 1.704\(c\)\(4\)](#) establishes failure to file a petition to withdraw a holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Any applicant who considers an application to have been improperly held abandoned (the reduction in [37 CFR 1.704\(c\)\(3\)](#) is applicable to the revival of an application properly held abandoned) is expected to file a petition to withdraw the holding of abandonment (or to revive the application) within two months from the mailing date of a notice of abandonment. See [MPEP § 711.03\(c\)](#), paragraph (I). [37 CFR 1.704\(c\)\(4\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed.

If a petition to withdraw the holding of abandonment is granted, the Office’s PALM system records should be checked to ensure that the correct term adjustment determination is made. Applicants are encouraged to check the Office’s PALM system records for their applications through PAIR (see [MPEP § 2733](#)). For example, if applicant shows in the petition that a reply was filed in the Office on March 2, but the March 2 reply was never matched with the file, when the petition to withdraw the holding of abandonment is granted, the receipt of a paper on March 2 should be recorded on the Office’s PALM system records. If the papers or dates are recorded incorrectly, applicant should contact the examiner, the examiner’s supervisor or the Technology Center customer service representative to have the entry corrected. If an applicant receives a Notice of

Abandonment and does not request that the holding of abandonment be withdrawn within two months of the mailing date of the notice, the applicant has failed to engage in reasonable efforts to conclude prosecution and any patent term adjustment will be reduced pursuant to [37 CFR 1.704\(c\)\(4\)](#).

[37 CFR 1.704\(c\)\(5\)](#) establishes conversion of a provisional application under [35 U.S.C. 111\(b\)](#) to a nonprovisional application under [35 U.S.C. 111\(a\)](#) (pursuant to [35 U.S.C. 111\(b\)\(5\)](#); (see [MPEP § 201.04](#))) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Conversion of a provisional application to a nonprovisional application will require the Office to reprocess the application (as a nonprovisional application) up to one year after the filing date that will be accorded to such nonprovisional application as a result of an action by the applicant. [37 CFR 1.704\(c\)\(5\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the date the application was filed under [35 U.S.C. 111\(b\)](#) and ending on the date a request in compliance with [37 CFR 1.53\(c\)\(3\)](#) to convert the provisional application into a nonprovisional application was filed.

[37 CFR 1.704\(c\)\(6\)](#) establishes submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#) that requires the mailing of a supplemental Office action or notice of allowance as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. If the submission of a preliminary amendment or other paper requires the Office to issue a supplemental Office action or notice of allowance, the submission of that preliminary amendment or other paper has interfered with the processing and examination of an application. [37 CFR 1.704\(c\)\(6\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the lesser of the number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice

of allowance or four months. The phrase “lesser of . . . or [f]our months” is to provide a four-month cap for a reduction under [37 CFR 1.704\(c\)\(6\)](#) if the Office takes longer than four months to issue a supplemental Office action or notice of allowance.

[37 CFR 1.704\(c\)\(7\)](#) establishes submission of a reply having an omission (e.g., [37 CFR 1.135\(c\)](#)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Submitting a reply having an omission requires the Office to issue an action under [37 CFR 1.135\(c\)](#) and await and process the applicant’s reply to the action under [37 CFR 1.135\(c\)](#) before the initial reply (as corrected) can be treated on its merits. In addition, [37 CFR 1.704\(c\)\(7\)](#) provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The reference to [37 CFR 1.135\(c\)](#) is parenthetical because [37 CFR 1.704\(c\)\(7\)](#) is not limited to Office actions under [37 CFR 1.135\(c\)](#) but applies also when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under [37 CFR 1.47](#) dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with [37 CFR 1.821](#) *et seq.* The filing of a non-compliant appeal brief, however, will not be deemed an omission under [37 CFR 1.704\(c\)\(7\)](#) if the notice of appeal was filed on or after September 17, 2012. This situation is covered under [37 CFR 1.704\(c\)\(11\)](#).

[37 CFR 1.704\(c\)\(8\)](#) establishes submission of a supplemental reply or other paper after a reply has been filed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of a supplemental reply or other paper (e.g., an information disclosure statement (IDS) or petition) after an initial reply was filed requires the Office to restart consideration of

the initial reply in view of the supplemental reply or other paper, which will result in a delay in the Office’s response to the initial reply. [37 CFR 1.704\(c\)\(8\)](#) does not apply to a supplemental reply or other paper that was expressly requested by the examiner. If an amendment is requested by an examiner, the examiner will have the paper processed so that it is included as part of an interview summary or examiner’s amendment and not a separate paper for PALM to flag in the patent term adjustment calculation. [37 CFR 1.704\(c\)\(8\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or such other paper was filed.

Applicant’s submission of an information disclosure statement pursuant to [37 CFR 1.97\(c\)](#) or an amendment under [37 CFR 41.33](#) after a notice of appeal has been filed but prior to jurisdiction passing to the Patent Trial and Appeal Board is deemed an applicant delay under [37 CFR 1.704\(c\)\(8\)](#). Under [37 CFR 1.97\(c\)](#), an applicant who submits an information disclosure statement meeting the requirements of [37 CFR 1.97](#) and [1.98](#) will have such submission considered by the examiner if it is accompanied by a statement under [37 CFR 1.97\(e\)](#) and the fee under [37 CFR 1.17\(p\)](#). Moreover, the Office may admit an amendment after notice of appeal if it meets the applicable requirements in [37 CFR 41.33\(a\)](#) and [\(b\)](#) for consideration. Because the treatment of these papers may delay the Board taking jurisdiction of the application, the Office will treat such papers similarly to how the Office treats a supplemental reply under this provision, in that the papers will be considered as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

[37 CFR 1.704\(c\)\(9\)](#) establishes submission of an amendment or other paper (other than a statement under [37 CFR 41.50\(c\)](#)) in an application after a decision by the Patent Trial and Appeal Board (other than a decision containing a rejection under [37 CFR 41.50\(b\)](#)) or a Federal court less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or notice of allowance under [35 U.S.C.](#)

[151](#), that requires the mailing of a supplemental Office action or supplemental notice of allowance as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of an amendment or other paper (e.g., IDS or petition) in an application after a Board decision or court decision requires the Office to restart consideration of the application in view of the amendment or other paper, which will result in a delay in the Office's taking action on the application. [37 CFR 1.704\(c\)\(9\)](#) also provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the lesser of the number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance or four months. The phrase "lesser of...or [f]our months" is to provide a four-month cap for a reduction under [37 CFR 1.704\(c\)\(9\)](#) if the Office takes longer than four months to issue a supplemental Office action or notice of allowance. If the amendment is requested by an examiner, the examiner will have the paper processed so that it is included as part of an interview summary or examiner's amendment and not a separate paper for PALM to flag in the patent term adjustment calculation.

[37 CFR 1.704\(c\)\(10\)](#) establishes submission of an amendment under [37 CFR 1.312](#) or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is **not** considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1)

Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (micro/small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office). Papers that **will be** considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under [37 CFR 1.312](#); (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations. [37 CFR 1.704\(c\)\(10\)](#) provides that in such a case the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the lesser of: (1) the number of days, if any, beginning on the date the amendment under [37 CFR 1.312](#) or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under [37 CFR 1.312](#) or such other paper; or (2) four months. The phrase "lesser of...or [f]our months" is to provide a four-month cap for a reduction under [37 CFR 1.704\(c\)\(10\)](#) if the Office takes longer than four months to issue an Office action or notice in response to the amendment under [37 CFR 1.312](#) or other paper.

Effective for applications in which a notice of appeal was filed on or after September 17, 2012, [37 CFR 1.704\(c\)\(11\)](#) establishes that failure to file an appeal brief in compliance with [37 CFR 41.37](#) within three months from the date on which a notice of appeal to the Patent Trial and Appeal Board was filed under [35 U.S.C. 134](#) and [37 CFR 41.31](#) is a circumstance that constitutes a failure to engage in reasonable efforts to conclude processing or examination of the application. It is noted that although the appeal brief is due within two months of the filing of the notice of appeal under [37 CFR 41.37](#), [37 CFR 1.704\(c\)\(11\)](#) provides three months before any patent term adjustment under [37 CFR 1.703](#) will be reduced for the late submission of an appeal brief. If applicant files a non-compliant appeal brief and thereafter files a compliant appeal brief, the period of time from the filing of a non-compliant appeal brief to the filing of the compliant appeal brief will not be considered a failure to engage in reasonable efforts to conclude

processing or examination of the application under [37 CFR 1.704\(c\)\(8\)](#). However, if the compliant appeal brief is filed more than three months from the date on which the notice of appeal was filed, the provisions of [37 CFR 1.704\(c\)\(11\)](#) may result in reduction of any patent term adjustment under [37 CFR 1.703](#). [37 CFR 1.704\(c\)\(11\)](#) provides that the period of adjustment set forth in [37 CFR 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date three months from the date on which the notice of appeal to the Patent Trial and Appeal Board was filed and ending on the date an appeal brief in compliance with [37 CFR 41.37](#) or a request for continued examination in compliance with [37 CFR 1.114](#) was filed.

If the Office reopens prosecution of the application more than three months after the filing of the notice of appeal but prior to the submission of a compliant appeal brief, the Office will not deem the period of time from the day after three months from the filing of the notice of appeal to the date the Office reopens prosecution to be an applicant delay under [37 CFR 1.704\(c\)\(11\)](#). In addition, the Office's reopening of prosecution after appeal will not be considered as vacating any previous response that potentially increases patent term adjustment under [35 U.S.C. 154\(b\)\(1\)\(A\)\(i\)](#) through [\(iv\)](#). As discussed above, the change to [37 CFR 1.704\(c\)\(11\)](#) is applicable to any applications that includes an appeal brief in which the notice of appeal was filed on or after September 17, 2012.

[37 CFR 1.704\(c\)\(12\)](#) (which was formerly 37 CFR 1.704(c)(11)) establishes further prosecution via a continuing application as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Currently, a continuing application may be used to: (1) obtain further examination of an invention disclosed and claimed in the prior application (continuation application); (2) obtain examination (for the first time) of an invention disclosed but not claimed or not elected for examination in the prior application (divisional application); or (3) obtain examination of an invention neither disclosed nor claimed in the prior application (continuation-in-part application). The provisions of [35 U.S.C. 132\(b\)](#) and [37 CFR 1.114](#) permit an applicant to obtain further or

continued examination of an invention disclosed and claimed in an application, which renders it unnecessary for an applicant whose application is eligible for patent term adjustment under [35 U.S.C. 154\(b\)](#) to file a continuing application to obtain further examination of an invention disclosed and claimed in an application. If an applicant is filing a continuing application to obtain examination (for the first time) of an invention disclosed but not claimed or not elected for examination in the prior application or an invention neither disclosed nor claimed in the prior application, it is not appropriate for that applicant to obtain any benefit in the continuing application for examination delays that might have occurred in the prior application. Thus, the Office has established further prosecution via a continuing application as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application, in that the period of adjustment set forth in [37 CFR 1.703](#) shall not include any period that is prior to the actual filing date of the application that resulted in the patent. Thus, if the application that resulted in the patent is a continuing application (including a CPA), the period of adjustment set forth in [37 CFR 1.703](#) (if any) will not include any period that is prior to the actual filing date of the application (in the case of a CPA, the filing date of the request for a CPA) that resulted in the patent.

A CPA under [37 CFR 1.53\(d\)](#) filed on or after May 29, 2000 and before July 14, 2003 is entitled to the patent term adjustment provisions of [35 U.S.C. 154\(b\)](#) as amended by § 4402 of the American Inventors Protection Act of 1999 (CPAs can only be filed in design patent applications on or after July 14, 2003, and design applications are not entitled to PTA). The period of patent term adjustment set forth in [37 CFR 1.703](#) (if any), however, will not include any period that is prior to the filing date of the request for that CPA.

Delays before the filing date of an application are not relevant to whether an application is entitled to patent term adjustment. Patent term adjustment will not be reduced by applicant actions or inactions (that amount to a failure to engage in reasonable efforts to conclude processing or examination of the

application) occurring in a prior (or other) application.

[37 CFR 1.704\(d\)](#) provides that a paper containing only an information disclosure statement in compliance with [37 CFR 1.97](#) and [1.98](#) will not be considered (result in a reduction) under [37 CFR 1.704\(c\)\(6\)](#), [1.704\(c\)\(8\)](#), [1.704\(c\)\(9\)](#), or [1.704\(c\)\(10\)](#) if it is accompanied by a statement that each item of information:

(i) was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by an individual designated in [37 CFR 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement; or

(ii) is a communication that was issued by a patent office in a counterpart foreign international application or by the Office, and this communication was not received by any individual designated in [37 CFR 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement.

The above-mentioned statement(s) should accompany the submission of the information disclosure statement.

This provision will permit applicants to submit information first cited in a communication from a patent office in a counterpart foreign or international application or from the Office in another application without a reduction in patent term adjustment if an information disclosure statement is promptly (within thirty days of receipt of the first communication) submitted to the Office. This provision also permits an application to submit communications that were issued by a patent office in a counterpart foreign or international application or by the Office that were not received by any individual designated in [37 CFR 1.56\(c\)](#) more than thirty days prior to the filing of the information disclosure statement to avoid a reduction in any patent term adjustment.

Compliance with the statement requirement of [37 CFR 1.704\(d\)](#) does not substitute for compliance with any relevant requirement of [37 CFR 1.97](#) or [1.98](#). [37 CFR 1.704\(d\)](#) also provides that this thirty-day period is not extendable.

The determination of when the thirty day period in [37 CFR 1.704\(d\)\(1\)\(i\)](#) or [\(ii\)](#) begins to run is dependent on the role of each entity involved in the prosecution of the U.S. and foreign applications, and the role that each plays (if any) vis-à-vis the application being examined by the USPTO. The inventors, the assignee and the U.S. patent counsel are all individuals designated in [37 CFR 1.56\(c\)](#). The issue is whether the foreign patent counsel is also an individual designated in [37 CFR 1.56\(c\)](#).

[37 CFR 1.56\(c\)](#) provides that individuals associated with the filing or prosecution of a patent application within the meaning of [37 CFR 1.56](#) are:

1. Each inventor named in the application;
2. Each attorney or agent who prepares or prosecutes the application; and
3. Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

Based on these elements of [37 CFR 1.56\(c\)](#), the following three examples provide guidance in regard to the discussed situations.

Example A:

An applicant based in Chicago, Illinois, directs U.S. counsel to prepare, file and prosecute an application in the United States Patent and Trademark Office (USPTO). The U.S. counsel subsequently sends the application to foreign counsel for filing and prosecution in foreign jurisdictions. The U.S. counsel directs foreign counsel to provide copies of all communications from the foreign office (by fax or overnight mail) within seven days of receipt thereof, and expressly reserves all decision-making authority as to prosecution of the U.S. and foreign applications.

On January 5, 2002, a foreign counsel in Germany receives a communication from the European Patent Office (EPO) that includes a list of citations of patents. On January 8, the foreign counsel, pursuant to the standing instructions of U.S. counsel, sends by overnight mail, a copy of the communication from the EPO. The document is received by U.S. counsel on January 12, 2002. On January 30, the U.S. counsel reviews the document and discovers a previously uncited patent. A copy of the patent and an IDS is then prepared and filed by the U.S. counsel, which was received at the USPTO on February 11, 2002.

Answer to Example A:

The thirty-day period would be calculated from January 12, 2002. As such, the IDS received on February 11, 2002 would be filed within the thirty-day period in [37 CFR 1.704\(d\)](#), and thus would not result in a reduction of any patent term adjustment pursuant to [37 CFR 1.704\(c\)\(6\)](#), [\(c\)\(8\)](#), [\(c\)\(9\)](#), or [\(c\)\(10\)](#).

In this example, the foreign counsel has no substantive role in the prosecution of the U.S. application. The explicitly defined role of the foreign counsel relative to the U.S. counsel in combination with the practice in the described fact pattern removes any potential doubt as to the role of the foreign counsel. For these reasons, the foreign counsel is not deemed a person who is substantially involved in the U.S. application under [37 CFR 1.56\(c\)](#).

Example B:

An applicant based in Paris, France, directs French counsel to prepare, file and prosecute an application in the European Patent Office (EPO). The EPO application is then sent to U.S. counsel by French counsel to be reviewed, edited, and prepared for filing in the United States Patent and Trademark Office (USPTO). The counsel works with the French counsel to review the edited application, and then files the application at the USPTO. The review and editing of the U.S. application filed at the USPTO also leads the French counsel to amend its EPO application.

On January 5, 2002, the French counsel receives a search report from the European Patent Office that includes a list of six patents. On January 20, 2002, the U.S. counsel receives from French counsel (by overnight mail) a copy of the communication from the EPO and suggests that the U.S. counsel review the search report and “take appropriate action.” On January 25, 2002, the French counsel provides a copy of the search report to the applicant. On January 30, 2002, the U.S. counsel reviews the document and discovers a previously uncited patent. A copy of the patent and an IDS is then prepared and filed by the U.S. counsel, which is received at the USPTO on February 14, 2002

Answer to Example B:

The thirty-day period would be calculated from **January 5, 2002**. As such, the submission of the IDS would not be received within the thirty-day window in [37 CFR 1.704\(d\)](#), and thus could result in a reduction of any patent term pursuant to [37 CFR 1.704\(c\)\(6\)](#), [\(c\)\(8\)](#), [\(c\)\(9\)](#), or [\(c\)\(10\)](#).

In this example, the USPTO would consider the French counsel to have been a party within the meaning of [37 CFR 1.56\(c\)](#). The French counsel, based on the above facts, played a substantive role in the preparation and prosecution of the U.S. application (e.g., the French counsel drafted the original application, worked with U.S. counsel to amend the application and subsequently amended the EPO application based on the work product produced with U.S. counsel).

Example C:

An applicant based in Chicago, Illinois, hires U.S. counsel to prepare an application suitable for filing in the United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO). The U.S. counsel engages a German attorney to assist in the review and editing of the application to take account of issues relevant to EPO practice. The U.S. counsel then reviews the edited application, approves the changes, and files it at the USPTO. The U.S. counsel then directs the German attorney to file the application in the EPO. During prosecution of the U.S. case, the U.S. counsel receives an Office action citing three patents.

On December 1, 2001, the U.S. counsel sends the three patents to the German attorney for review and appropriate action. On January 5, 2002, the German attorney receives a search report from the EPO that cites the three previously cited patents, plus a fourth patent, which are all designating all as “X” references. On January 15, 2002, the German

attorney reviews the fourth patent and compares it to the three patents cited in the U.S. prosecution. The German attorney concludes that the fourth patent is duplicative of one of the three patents, and takes no further action.

On March 1, 2002, during a routine status inquiry, the U.S. counsel is informed of the citation of the fourth patent by the EPO and the decision of the German attorney that the information in the newly cited patent was duplicative of the three patents previously cited by the USPTO. The U.S. counsel also obtains copies of the newly cited patent on this date. On March 5, 2002, the U.S. counsel files an IDS containing the newly cited patent, which is received at the USPTO on the same date.

Answer to Example C:

The thirty-day period would be calculated from January 5, 2002. As such, the submission of the IDS would be determined to have not been received, received within the thirty-day period in [37 CFR 1.704\(d\)](#), and thus could result in a reduction of any patent term pursuant to [37 CFR 1.704\(c\)\(6\)](#), [\(c\)\(8\)](#), [\(c\)\(9\)](#), or [\(c\)\(10\)](#).

In this example, the USPTO would consider the participation of the German attorney in the prosecution and decision-making as to the relevance of the newly cited art vis-à-vis the previously cited three patents to be a substantive participation in the U.S. prosecution. As such, the German attorney would be considered by the USPTO to be a party covered by [37 CFR 1.56\(c\)](#). Accordingly, evaluation of compliance with [37 CFR 1.704\(d\)](#) would consider the date that the foreign counsel first learned of the fourth patent (i.e., the newly cited reference).

[37 CFR 1.704\(e\)](#) provides that a submission of a request under [37 CFR 1.705\(c\)](#) for reinstatement of reduced patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under [37 CFR 1.704\(c\)\(10\)](#). The Office will not deem such a failure to engage in reasonable efforts to conclude processing or examination of the application under [37 CFR 1.704\(c\)\(10\)](#) because the statute expressly requires that all such requests be filed prior to the issuance of the patent. See [35 U.S.C. 154\(b\)\(3\)\(C\)](#). Other papers concerning patent term adjustment (e.g., status letters, untimely applications for patent term adjustment, requests for reconsideration of the Office’s decisions on applications for patent term adjustment, petitions under [37 CFR 1.181](#), [1.182](#), or [1.183](#) concerning patent term adjustment, or miscellaneous letters concerning patent term adjustment), however, will be considered a failure to engage in reasonable efforts to conclude

prosecution (processing or examination) of the application under [37 CFR 1.704\(c\)\(10\)](#).

2733 Patent Term Adjustment Determination [R-11.2013]

37 CFR 1.705 Patent term adjustment determination.

(a) The patent will include notification of any patent term adjustment under [35 U.S.C. 154\(b\)](#).

The AIA Technical Corrections Act was enacted on January 14, 2013. See Pub. L. No. 112-274, 126 Stat. 2456 (2013). Section 1(h) of the AIA Technical Corrections Act revises the patent term adjustment provisions of [35 U.S.C. 154\(b\)](#) and is effective for any patent granted on or after January 14, 2013. Section 1(h)(2) of the AIA Technical Corrections Act amended [35 U.S.C. 154\(b\)\(3\)\(B\)\(i\)](#) to change “shall transmit a notice of that [patent term adjustment] determination with the written notice of allowance of the application under [section 151](#)” to “shall transmit a notice of that [patent term adjustment] determination no later than the date of issuance of the patent.” See 126 Stat. at 2457. This change eliminates the need for the Office to provide an initial patent term adjustment determination with the notice of allowance and before the patent term adjustment under [35 U.S.C. 154\(b\)\(1\)\(A\)\(iv\)](#) and [154\(b\)\(1\)\(B\)](#) is known. See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 Fed. Reg. 56365, 56374 (September 18, 2000) (explaining that a two-part process is required because the Office is obliged under [35 U.S.C. 154\(b\)\(3\)](#) to provide a patent term adjustment determination before the issue date, and thus the patent term adjustment, is known). [37 CFR 1.705\(a\)](#) has been amended to reflect that the Office will provide notification of the patent term adjustment on the patent. The Office will no longer provide a notification of the patent term adjustment with the mailing of the notice of allowance for any patent granted on or after January 14, 2013.

The Office has revised [37 CFR 1.705](#) to implement the statutory changes to [35 U.S.C. 154\(b\)\(3\)\(B\)\(i\)](#). The amendment to the statute provides that the Office shall transmit a determination of the patent term adjustment no later than the date of issuance of the patent. Accordingly, the Office is no longer required to transmit a determination at the time of

the mailing of the notice of allowance which occurs before all of the guarantees of the statute could be calculated. The Office, however, will continue to provide a preliminary patent term adjustment calculation with the issue notification that is mailed to applicant prior to issuance of the patent, but the patent term adjustment indicated on the patent is the “official” notification of the Office’s patent term adjustment determination under [35 U.S.C. 154\(b\)](#). Accordingly, patentee should wait until the grant of the patent to determine whether or not a request for reconsideration of the patent term adjustment indicated on the patent is warranted. See [MPEP § 2734](#) for a discussion of the requirements of any such request.

If a registered practitioner receives a patent term adjustment indicated on the front of the patent that is longer than expected, the practitioner may disclose the error to the Office in a letter in compliance with the practitioner’s duty of candor and good faith in practice before the Office. The Office will treat letters submitted by patentees stating that Office’s determination of patent term adjustment indicated on the patent is greater than what the applicant or patentee believes is appropriate by placing these letters in the file of the patent without comment. The Office will not review these letters or issue certificates of correction under either [35 U.S.C. 254](#) or [255](#) on the of these letters. In addition, the Office will not grant a request for a certificate of correction under either [35 U.S.C. 254](#) or [255](#) to revise the patent term adjustment indicated in a patent, unless the certificate of correction is issued to revised the patent for consistency with (1) the patent term adjustment determined via a decision on the request for reconsideration under [37 CFR 1.705](#); or (2) the total patent term adjustment indicated on the Patent Application Information Retrieval (PAIR) screen that displays the patent term adjustment calculation for the patent. If patentee submits a request for a certificate of correction under either [35 U.S.C. 254](#) or [255](#) to revise the patent term adjustment indicated in a patent that also includes changes in the patent for which a certificate of correction would be appropriate, the request for a certificate of correction will not be granted unless the patentee submits a new request for a certificate of correction that does not also attempt to revise the patent term adjustment indicated in the patent.

If patentee wants the Office to reconsider its patent term adjustment determination, the patentee must use the procedures set forth in [37 CFR 1.705](#) for requesting reconsideration of a patent term adjustment determination. Specifically, the procedures set forth in [37 CFR 1.705](#) must be used whether the USPTO's patent term adjustment determination is greater than or less than the adjustment that the applicant or patentee believes to be appropriate.

A patentee may also file a terminal disclaimer at any time disclaiming any period considered in excess of the appropriate patent term adjustment. See [35 U.S.C. 253](#) and [37 CFR 1.321](#).

Note that the Office does not require patentee to file either a request for reconsideration under [37 CFR 1.705](#) or a terminal disclaimer when the patent term adjustment indicated on the patent is greater than what the patentee believes is appropriate. As discussed above, the patentee or the appointed registered practitioner may disclose the alleged error to the Office in a letter in compliance with the practitioner's duty of candor and good faith.

Information as to how the patent term adjustment calculation has been made will be available through Patent Application Information Retrieval (PAIR) at <http://pair.uspto.gov>. Applicants may routinely use PAIR to check the accuracy of the data entered in the PALM system for their applications (i.e., the type of the paper and date of receipt in the Office) throughout prosecution. If any errors are detected, they should be brought to the Office's attention (e.g., by contacting the examiner or the Technology Center's customer service representative) as soon as possible to ensure that they are corrected before allowance of the application and the determination of the patent term adjustment. In checking Office records, applicants should keep in mind that the date that should be recorded in the Office computer records is the date of receipt of the paper, not the date that it was mailed under [37 CFR 1.8](#). In addition, if an original paper is misplaced by the Office and a duplicate is filed with a post card receipt showing the date of receipt of the original paper, the date shown on the post-card receipt for the original paper is the date that should be shown in the Office computer records. If Express Mail service was used,

then the date shown as the "date in" on the Express Mail label will be entered into the Office computer records. Otherwise, the date reflected in the Office computer records for a duplicate copy of correspondence will normally be the date that the duplicate was received in the Office.

2734 Application for Patent Term Adjustment; Due Care Showing [R-11.2013]

37 CFR 1.705 Patent term adjustment determination.

(b) Any request for reconsideration of the patent term adjustment indicated on the patent must be by way of an application for patent term adjustment filed no later than two months from the date the patent was granted. This two-month period may be extended under the provisions of [§ 1.136\(a\)](#). An application for patent term adjustment under this section must be accompanied by:

- (1) The fee set forth in [§ 1.18\(e\)](#); and
- (2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under [§ 1.702](#) for the adjustment;

(ii) The relevant dates as specified in [§§ 1.703\(a\) through \(e\)](#) for which an adjustment is sought and the adjustment as specified in [§ 1.703\(f\)](#) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv) (A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in [§ 1.704](#); or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in [§ 1.704](#).

(c) Any request for reinstatement of all or part of the period of adjustment reduced pursuant to [§ 1.704\(b\)](#) for failing to reply to a rejection, objection, argument, or other request within three months of the date of the mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must be filed prior to the issuance of the patent. This time period is not extendable. Any request for reinstatement of all or part of the period of adjustment pursuant to [§ 1.704\(b\)](#) must be accompanied by:

- (1) The fee set forth in [§ 1.18\(f\)](#); and
- (2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

[37 CFR 1.705\(b\)](#) provides that any request for reconsideration of the patent term adjustment indicated on the patent must be by way of an application for patent term adjustment which must be filed within two months of the date the patent was

granted and accompanied by the fee set forth in [37 CFR 1.18\(e\)](#) and a statement of the facts involved. [37 CFR 1.705\(b\)\(2\)](#) provides that such statement of facts involved must specify: (1) the correct patent term adjustment and the basis or bases under [37 CFR 1.702](#) for the adjustment; (2) the relevant dates as specified in [37 CFR 1.703\(a\) through \(e\)](#) for which an adjustment is sought and the adjustment as specified in [37 CFR 1.703\(f\)](#) to which the patent is entitled; (3) whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and (4) any circumstances, if any, during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in [37 CFR 1.704](#) (or a statement that there were no such circumstances). The two month period set in [37 CFR 1.705\(b\)](#) is extendable under [37 CFR 1.136](#) for up to five additional months (permitting patentee to request reconsideration of the patent term adjustment indicated on the patent as late as within seven months after the date the patent was granted).

If the Office agrees with applicant's request for reconsideration of the patent term adjustment determination, the Office will *sua sponte* issue a certificate of correction to revise the patent term adjustment determination on the patent in accordance with the determination by the Office.

If the Office issues a decision denying patentee's request for reconsideration, then patentee may appeal such decision to the District Court for the Eastern District of Virginia by filing a civil complaint within 180 days of the date of the decision on the request for reconsideration of patent term adjustment.

Section 1(h)(3) of the AIA Technical Corrections Act amended [35 U.S.C. 154\(b\)\(4\)](#) to provide that "[a]n applicant dissatisfied with the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have exclusive remedy by a civil action against the Director filed in the United States District Court for the Eastern District of Virginia within 180 days after the date the Director's decision on the applicant's request for reconsideration." The change to [35 U.S.C. 154\(b\)\(4\)](#) clarifies that (1) a civil action under [35 U.S.C. 154\(b\)\(4\)](#) is not an alternative to

requesting reconsideration of the patent term adjustment under [35 U.S.C. 154\(b\)\(3\)](#) but is the remedy for an applicant who is dissatisfied with the Director's decision on the applicant's request for reconsideration under [35 U.S.C. 154\(b\)\(3\)](#); and (2) a civil action provided in [35 U.S.C. 154\(b\)\(4\)](#) is the **exclusive** remedy for an applicant who is dissatisfied with the Director's decision on the applicant's request for reconsideration. In other words, an applicant that is dissatisfied with the patent term adjustment determination on the patent must first request reconsideration under [35 U.S.C. 154\(b\)\(3\)](#) and [37 CFR 1.705\(b\)](#). Only after receiving a decision denying the request for reconsideration, may the applicant file a civil action, proscribed in [35 U.S.C. 154\(b\)\(4\)](#), if the applicant is dissatisfied with the decision on the request for reconsideration.

Section 1(n) of the AIA Technical Corrections Act provides that amendments made in section 1(h) shall take effect on January 14, 2013 (the date of enactment) and shall apply to the proceedings commenced on or after January 14, 2013. Section 1(n) of the Technical Corrections Act does not limit the applicability of the changes in section 1(h) to applications filed on or after January 14, 2013. Cf. Section 4405(a) of the American Inventors Protection Act of 1999 (AIPA), Pub. L. No. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (limiting the applicability of the patent term adjustment provisions of the AIPA to applications filed on or after May 29, 2000 (the date that is six months after the enactment of AIPA)). Patent term adjustment proceedings are not "commenced" until the Office notifies the applicant of the Office's patent term adjustment determination under [35 U.S.C. 154\(b\)\(3\)](#), which now occurs when the patent is granted. Accordingly, the changes to [35 U.S.C. 154](#) in section 1(h) of the AIA Technical Corrections Act apply to any patent granted on or after January 14, 2013.

I. DUE CARE SHOWING

[37 CFR 1.705\(c\)](#) implements the provisions of [35 U.S.C. 154\(b\)\(3\)\(C\)](#) and specifically provides that a request for reinstatement of all or part of the period of adjustment reduced pursuant to [37 CFR 1.704\(b\)](#) for failing to reply to a rejection, objection, argument, or other request within three months of

the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must include: (1) the fee set forth in [37 CFR 1.18\(f\)](#); and (2) a showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. [37 CFR 1.705\(c\)](#) also provides that the Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request ([35 U.S.C. 154\(b\)\(3\)\(C\)](#)). [35 U.S.C. 154\(b\)\(3\)\(C\)](#) and [37 CFR 1.705\(c\)](#) also requires that the request for reinstatement be filed prior to the issuance of the patent. Because [35 U.S.C. 154\(b\)\(3\)\(C\)](#) requires that the request be filed prior to the issuance of the patent, the Office will not consider or act on a request for reinstatement in a paper filed after the patent is issued. For example, a request for reinstatement cannot be made as part of a request for reconsideration under [37 CFR 1.705\(b\)](#). Applicants are aware during the pendency of the application of situations where the reply was filed more than three months after the Office communication notifying the applicant of the rejection, objection, argument, or other request. If applicants believe that they can make the required showing that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument or other Office request within three months, then applicants should file the request promptly and no later than at least one day prior to the issuance of the patent. Applicants need not review of the patent term adjustment calculation to establish a request for reinstatement under [37 CFR 1.705\(c\)](#). The Office will not delay issuance of the patent but will make a decision on the request for reinstatement after the grant of the patent and if appropriate, issue a certificate of correction to revise the patent term adjustment determination on the patent.

Filing a reply outside of three months after an Office action is *per se* a failure to engage in reasonable efforts to conclude prosecution under [35 U.S.C.](#)

[154\(b\)\(2\)\(C\)\(ii\)](#) unless applicant can establish that the delay was “in spite of all due care.” The provisions of [35 U.S.C. 21\(b\)](#) are applicable to the determination of three-month period for reply. If the last day of the three-month period from the Office communication notifying the applicant the applicant of the rejection, objection, argument, or other request falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, then action, may be taken, or the fee paid, on the next succeeding secular or business day without loss of any patent term adjustment under [§ 1.704\(b\)](#). See *ArQule v. Kappos*, 793 F.Supp2d 214 (D.D.C. 2011). For example, an applicant’s three-month reply time period expires on a Saturday and the applicant files a reply that is received by the Office on Monday, which is not a Federal holiday within the District of Columbia. In this case, any patent term would not be reduced under [37 CFR 1.704\(b\)](#) because the reply was received on Monday, the next succeeding secular or business day after the expiration of the three-month reply time. Accordingly, a request for reinstatement of all or part of the period of adjustment under [37 CFR 1.705\(c\)](#) would not be applicable since applicant would not have been deemed to reply more than three months from the date of the Office action.

The Office “shall reinstate all or part of the cumulative period of time of an adjustment reduced under [[35 U.S.C. 154\(b\)\(2\)\(C\)](#)] if the applicant... makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period....” See [35 U.S.C. 154\(b\)\(3\)\(C\)](#). The “due care” of a reasonably prudent person standard has been applied in deciding petitions under the “unavoidable delay” standard of [35 U.S.C. 133](#). See *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912) (“the word ‘unavoidable’ ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business”) (quoting and adopting *Ex parte Pratt*, 1887 Dec. Comm’r Pat. 31, 32-33); see also *Ray v. Lehman*, 55 F.3d 606, 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (“in determining whether a delay...was unavoidable, one looks to whether the party...exercised the due care of a reasonably prudent person”). While the legislative history of the American Inventors Protection Act of 1999 is silent as to the meaning of the phrase “in spite of all

due care,” the phrases “all due care” and “unable to respond” invoke a higher degree of care than the ordinary due care standard of [35 U.S.C. 133](#), as well as the “reasonable efforts to conclude processing or examination [or prosecution] of an application” standard of [35 U.S.C. 154\(b\)\(2\)\(C\)\(i\) and \(iii\)](#). Therefore, applicants should not rely upon decisions relating to the “unavoidable delay” standard of [35 U.S.C. 133](#) as controlling in a request to reinstate reduced patent term adjustment on the basis of a showing that the applicant was unable to respond within the three-month period in spite of all due care.

Examples

The following are examples of showings that may establish that the applicant was unable to respond within the three-month period in spite of all due care:

(A) a showing that the original three-month period was insufficient to obtain the test data necessary for an affidavit or declaration under [37 CFR 1.132](#) that was submitted with a reply filed outside the original three-month period;

(B) a showing that the applicant was unable to reply within the original three-month period due to a natural disaster;

(C) a showing that applicant was unable to reply within the original three-month period because testing was required to reply to an Office action, and the testing necessarily took longer than three months; or

(D) a showing that the applicant was unable to reply within the original three-month period due to illness or death of a sole practitioner of record who was responsible for prosecuting the application.

The patent term adjustment reinstated would be limited to the period in which the showing establishes that applicant was acting with all due care to reply to the Office notice or action, but circumstances (outside applicant’s control) made applicant unable to reply in spite of such due care. An applicant will not be able to show that he or she was unable to reply within the three-month period “in spite of all due care” if the reply was not filed within the three-month period due to reasons within the control of applicant or agencies within the applicant’s control.

Examples of circumstances that would **NOT** establish that the applicant was unable to respond within the three-month period in spite of all due care are:

(A) an applicant’s or representative’s preoccupation with other matters (e.g., an *inter partes* lawsuit or interference) that is given priority over prosecution of the application;

(B) illness or death of the practitioner in charge of the application if the practitioner is associated (in a law firm) with other practitioners (since the other practitioners could have taken action to reply within the three-month period);

(C) time consumed with communications between the applicant and his or her representative, regardless of whether the applicant resides in the United States or chooses to communicate with the United States representative via a foreign representative;

(D) vacation or other non-attention to an application that results in a failure to reply within the three-month period;

(E) applicant filing a reply on or near the last day of the three-month period using first class mail with a certificate of mailing under [37 CFR 1.8](#), rather than by electronic filing, Express Mail under [37 CFR 1.10](#) or facsimile (if permitted), and the reply is not received (filed) in the Office until after the three-month period; or

(F) failure of clerical employees of applicant or applicant’s representative to properly docket the Office action or notice for reply or perform other tasks necessary for reply within the three-month period.

Rarely is the power of attorney given to a single attorney and often many attorneys are given power of attorney in an application. An attorney in litigation, working on an interference or taking a vacation is generally aware of that fact before the event and should make plans for another to take over his or her work so that it is completed and filed in the Office within the three-month period. Thus, failure to reply within the three-month period in [35 U.S.C. 154\(b\)\(2\)\(C\)\(ii\)](#) due to preoccupation with other matters (e.g., an *inter partes* lawsuit or interference) given priority over the application, or vacation or other non-attention to an application, cannot be relied upon to show that applicant was

unable to reply “in spite of all due care” under [35 U.S.C. 154\(b\)\(3\)\(C\)](#).

2735 [Reserved]

2736 Third Party Papers [R-11.2013]

37 CFR 1.705 Patent term adjustment determination.

(d) No submission or petition on behalf of a third party concerning patent term adjustment under [35 U.S.C. 154\(b\)](#) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

[37 CFR 1.705\(d\)](#) implements the provisions of [35 U.S.C. 154\(b\)\(4\)\(B\)](#) and provides that no submission or petition on behalf of a third party concerning patent term adjustment under [35 U.S.C. 154\(b\)](#) will be considered by the Office, and that any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

2737-2749 [Reserved]

2750 Patent Term Extension for Delays at other Agencies under 35 U.S.C. 156 [R-11.2013]

The right to a patent term extension based upon regulatory review is the result of the Drug Price Competition and Patent Term Restoration Act of 1984, Pub. L. No. 98-417, 98 Stat. 1585 (codified at 21 U.S.C. 355(b), (j), (l); [35 U.S.C. 156](#), [271](#), [282](#))(Hatch-Waxman Act). The act sought to eliminate two distortions to the normal “patent term produced by the requirement that certain products must receive premarket regulatory approval.” *Eli Lilly & Co. v. Medtronic Inc.*, 496 U.S. 661, 669, 15 USPQ2d 1121, 1126 (1990). The first distortion was that the patent owner loses patent term during the early years of the patent because the product cannot be commercially marketed without approval from a regulatory agency. The second distortion occurred after the end of the patent term because competitors could not immediately enter the market upon expiration of the patent because they were not allowed to begin testing and other activities

necessary to receive FDA approval before patent expiration.

The part of the act codified as [35 U.S.C. 156](#) was designed to create new incentives for research and development of certain products subject to premarket government approval by a regulatory agency. The statute enables the owners of patents on certain human drugs, food or color additives, medical devices, animal drugs, and veterinary biological products to restore to the terms of those patents some of the time lost while awaiting premarket government approval from a regulatory agency. The rights derived from extension of the patent term under [35 U.S.C. 156\(a\)](#) are defined in [35 U.S.C. 156\(b\)](#), but are not limited to a claim-by-claim basis. Rather, [subsection\(a\) of 156](#) indicates that “[t]he term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended.” See *Genetics Institute LLC v. Novartis Vaccines and Diagnostics Inc.*, 655 F.3d 1291, 99 USPQ2d 1713 (Fed. Cir. 2011). However, pursuant to [35 U.S.C. 156\(b\)](#), if the patent claims other products in addition to the approved product, the exclusive patent rights to the additional products expire with the original expiration date of the patent.

In exchange for extension of the term of the patent, Congress legislatively overruled *Roche Products v. Bolar Pharmaceuticals*, 733 F.2d 858, 221 USPQ 937 (Fed. Cir. 1984) as to products covered by [35 U.S.C. 271\(e\)](#) and provided that it shall not be an act of infringement, for example, to make and test a patented drug solely for the purpose of developing and submitting information for an Abbreviated New Drug Application (ANDA). [35 U.S.C. 271\(e\)\(1\)](#). See Donald O. Beers *et al.*, *Generic and Innovator Drugs: A Guide to FDA Approval Requirements*, Eighth Edition, Wolters Kluwer Law & Business, 2013, 4.05 for a discussion of the Hatch-Waxman Act and infringement litigation. Furthermore, Congress provided that an ANDA that the FDA will grant to the marketing applicant a period of 5 years of data exclusivity for any active ingredient or salt or ester of the active ingredient which had not been previously approved under section 505(b) of the Federal Food, Drug and Cosmetic Act. 21 U.S.C. 355(j)(4)(D)(ii). See also Lourie, *Patent Term Restoration: History, Summary, and Appraisal*, 40

Food, Drug and Cosmetic L. J. 351, 353-60 (1985). See also Lourie, *Patent Term Restoration*, 66 J. Pat. Off. Soc’y 526 (1984).

On November 16, 1988, [35 U.S.C. 156](#) was amended by Public Law 100-670, essentially to add animal drugs and veterinary biologics to the list of products that can form the basis of patent term extension. Animal drug products which are primarily manufactured through biotechnology are excluded from the provisions of patent term extension.

On December 3, 1993, [35 U.S.C. 156](#) was further amended to provide for interim extension of a patent where a product claimed by the patent was expected to be approved, but not until after the original expiration date of the patent. Public Law 103-179, Section 5.

An application for the extension of the term of a patent under [35 U.S.C. 156](#) must be submitted by the owner of record of the patent or its agent within the sixty-day period beginning on the date the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. See [35 U.S.C. 156\(d\)\(1\)](#). This language regarding the sixty-day period has been clarified by the America Invents Act where the Act provides that, “[f]or purposes of determining the date on which a product receives permission under the second sentence of this paragraph, if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is not a business day, the product shall be deemed to receive such permission on the next business day. For purposes of the preceding sentence, the term 'business day' means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under section 6103 of title 5.” See Section 37 of the AIA and [35 U.S.C. 156](#). The USPTO initially determines whether the application is formally complete and whether the patent is eligible for extension. The statute requires the Director of the United States Patent and Trademark Office to notify the Secretary of Agriculture or the Secretary of Health and Human Services of the submission of an application for extension of patent term which complies with [35 U.S.C. 156](#) within sixty days and to submit to the

Secretary a copy of the application. Not later than thirty days after receipt of the application from the Director, the Secretary will determine the length of the applicable regulatory review period and notify the Director of the determination. If the Director determines that the patent is eligible for extension, the Director calculates the length of extension for which the patent is eligible under the appropriate statutory provision and issues an appropriate Certificate of Extension.

Patent term extensions provided by private relief legislation, public laws other than as enacted by [35 U.S.C. 156](#), such as [35 U.S.C. 155](#) and [155A](#), are not addressed herein.

2751 Eligibility Requirements [R-11.2013]

35 U.S.C. 156 Extension of patent term

(a) The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended in accordance with this section from the original expiration date of the patent, which shall include any patent term adjustment granted under [section 154\(b\)](#), if —

(1) the term of the patent has not expired before an application is submitted under subsection (d)(1) for its extension;

(2) the term of the patent has never been extended under subsection (e)(1) of this section;

(3) an application for extension is submitted by the owner of record of the patent or its agent and in accordance with the requirements of paragraphs (1) through (4) of subsection (d);

(4) the product has been subject to a regulatory review period before its commercial marketing or use;

(5) (A) except as provided in subparagraph (B) or (C), the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of the product under the provision of law under which such regulatory review period occurred;

(B) in the case of a patent which claims a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use of the product after such regulatory period is the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or

(C) for purposes of subparagraph (A), in the case of a patent which —

(i) claims a new animal drug or a veterinary biological product which (I) is not covered by the claims in any other patent which has been extended, and (II) has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and

(ii) was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal. The product referred to in paragraphs (4) and (5) is hereinafter in this section referred to as the “approved product.”

(f) For purposes of this section:

(1) The term “product” means:

(A) A drug product.

(B) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

(2) The term “drug product” means the active ingredient of—

(A) a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) or

(B) a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient.

(3) The term “major health or environmental effects test” means a test which is reasonably related to the evaluation of the health or environmental effects of a product, which requires at least six months to conduct, and the data from which is submitted to receive permission for commercial marketing or use. Periods of analysis or evaluation of test results are not to be included in determining if the conduct of a test required at least six months.

(4) (A) Any reference to section 351 is a reference to section 351 of the Public Health Service Act.

(B) Any reference to section 503, 505, 512, or 515 is a reference to section 503, 505, 512, or 515 of the Federal Food, Drug and Cosmetic Act.

(C) Any reference to the Virus-Serum-Toxin Act is a reference to the Act of March 4, 1913 (21 U.S.C. 151 - 158).

(5) The term “informal hearing” has the meaning prescribed for such term by section 201(y) of the Federal Food, Drug and Cosmetic Act.

(6) The term “patent” means a patent issued by the United States Patent and Trademark Office.

(7) The term “date of enactment” as used in this section means September 24, 1984, for human drug product, a medical device, food additive, or color additive.

(8) The term “date of enactment” as used in this section means the date of enactment of the Generic Animal Drug and Patent Term Restoration Act for an animal drug or a veterinary biological product.

37 CFR 1.710 Patents subject to extension of the patent term

(a) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, either alone or in combination with other ingredients that read on a composition that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and meets all other conditions and requirements of this subpart.

(b) The term *product* referred to in paragraph (a) of this section means —

(1) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(3) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

37 CFR 1.720 Conditions for extension of patent term

The term of a patent may be extended if:

(a) The patent claims a product or a method of using or manufacturing a product as defined in [§ 1.710](#);

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to [§§ 1.701, 1.760, or 1.790](#);

(c) An application for extension is submitted in compliance with [§ 1.740](#);

(d) The product has been subject to a regulatory review period as defined in [35 U.S.C. 156\(g\)](#) before its commercial marketing or use;

(e) The product has received permission for commercial marketing or use and —

(1) The permission for the commercial marketing or use of the product is the first received permission for commercial marketing or use under the provision of law under which the applicable regulatory review occurred, or

(2) In the case of a patent other than one directed to subject matter within [§ 1.710\(b\)\(2\)](#) claiming a method of manufacturing the product that primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use is the first received permission for the commercial marketing or use of a product manufactured under the process claimed in the patent, or

(3) In the case of a patent claiming a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

(f) The application is submitted within the sixty-day period beginning on the date the product first received permission for commercial marketing or use under the provisions of law under which the applicable regulatory review period occurred; or in the case of a patent claiming a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or in the case of a patent that claims a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and said drug or product has received permission for the commercial marketing or use in non-food-producing animals, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal;

(g) The term of the patent, including any interim extension issued pursuant to [§ 1.790](#), has not expired before the submission of an application in compliance with [§ 1.741](#); and

(h) No other patent term has been extended for the same regulatory review period for the product.

[35 U.S.C. 156\(a\)](#) sets forth what patents can be extended and the conditions under which they may be extended. [37 CFR 1.710](#) also addresses the patents that may be extended, and [37 CFR 1.720](#) describes the conditions under which a patent may be extended. As set forth in [35 U.S.C. 156](#) and [37 CFR 1.710](#), a patent which claims a human drug

product, medical device, food or color additive first approved for marketing or use after September 24, 1984, or an animal drug or veterinary biological product (which was not primarily manufactured through biotechnology) first approved for marketing or use after November 16, 1988, may qualify for patent term extension. Furthermore, [35 U.S.C. 156\(a\)\(1\)-\(5\)](#) require that the applicant establish that:

(1) the patent has not expired before an application under [35 U.S.C. 156\(d\)](#) was filed (this may be an application for patent term extension under subsection (d)(1) or an application for interim extension under subsection (d)(5));

(2) the patent has never been extended under [35 U.S.C. 156\(e\)\(1\)](#);

(3) the application for extension is submitted by the owner of record of the patent or its agent to the Office within 60 days of regulatory agency approval of the commercial marketing application and the application includes details relating to the patent, the approved product, and the regulatory review time spent in securing regulatory agency approval;

(4) the product has been subject to a regulatory review period within the meaning of [35 U.S.C. 156\(g\)](#) before its commercial marketing or use;

(5) the approval is the first permitted commercial marketing or use of the product ([35 U.S.C. 156\(a\)\(5\)\(A\)](#)), except in the case of human drug products manufactured using recombinant DNA technology where the provisions of [35 U.S.C. 156\(a\)\(5\)\(B\)](#) apply, or in the case of a new animal drug or a veterinary biological product where the provisions of [35 U.S.C. 156\(a\)\(5\)\(C\)](#) apply.

[35 U.S.C. 156\(c\)\(4\)](#) also requires that no other patent term has been extended for the same regulatory review period for the product. See [MPEP § 2761](#).

I. TERMINALLY DISCLAIMED PATENTS ARE ELIGIBLE

A patent may be extended under [35 U.S.C. 156](#), even though it has been terminally disclaimed. A patent term extension under [35 U.S.C. 156](#) is a limited extension of the patent rights associated with the approved product that is attached onto the original term of the patent. See [35 U.S.C. 156\(b\)](#). Only one patent may be extended for a regulatory review period for any product, and [35 U.S.C. 156](#) sets the

expiration date of a patent term extension. Although [35 U.S.C. 154\(b\)\(2\)](#) (June 8, 1995) precludes a patent from being extended under [35 U.S.C. 154\(b\)](#) if the patent has been terminally disclaimed due to an obviousness-type double patenting rejection (see [MPEP § 2720](#)), there is no such exclusion in [35 U.S.C. 156](#). Additionally, [35 U.S.C. 154\(b\)\(2\)\(B\)](#) (May 29, 2000) provides that a patent cannot be adjusted beyond the date set by the disclaimer (see [MPEP § 2730](#)), but there is no similar provision in [35 U.S.C. 156](#). Thus patents may receive a patent term extension under [35 U.S.C. 156](#) beyond an expiration date set by a terminal disclaimer. See *Merck & Co., Inc. v. Hi-Tech Pharmacal, Co., Inc.*, 482 F.3d 1317, 82 USPQ2d 1203 (Fed. Cir. 2007).

II. MEANING OF “PRODUCT” AS DEFINED IN 35 U.S.C. 156(f)

As required by [35 U.S.C. 156\(a\)](#), patents eligible for extension of patent term are those which:

(A) claim a “product” as defined in [35 U.S.C. 156\(f\)\(1\)](#), either alone or in combination with other ingredients, wherein the product reads on a composition (product) that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and

(B) meet all other conditions and requirements of the statute.

The term “claims a product” is not synonymous with “infringed by a product.” A patent which claims a metabolite of an approved drug does not claim the approved drug. *Hoechst-Roussel Pharmaceuticals Inc. v. Lehman*, 109 F.3d 756, 759, 42 USPQ2d 1220, 1223 (Fed. Cir. 1997).

The term “product” means:

(A) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(B) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily

manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(C) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

See 21 CFR 60.3(b) for definitions of terms such as active ingredient, color additive, food additive, human drug product, and medical device.

Essentially, a “product” is a “drug product,” medical device, food additive, or color additive requiring Food and Drug Administration or Department of Agriculture (Plant and Animal Inspection Service) approval of an order or regulation prior to commercial marketing or use. “Drug product” is the active ingredient of a human drug, animal drug (excluding those primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques), or biological product (as defined by the Federal Food, Drug and Cosmetics Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient. Animal biological products are approved by the Plant and Animal Inspection Service of the Department of Agriculture.

A “drug product” means the active ingredient found in the final dosage form prior to administration of the product to the patient, not the resultant form the drug may take after administration. See *Hoechst-Roussel*, 109 F.3d at 759 n.3 (“For purposes of patent term extension, this active ingredient must be present in the drug product when administered.”). In addition, a patent to a drug product having one form of an active ingredient may qualify for an extension even though another form of the underlying chemical moiety was previously approved and commercially marketed or used. For example, a drug product having the ester form of a particular chemical moiety is a different drug product from the same chemical moiety in a salt form, even though both the salt and the ester are used to treat the same disease condition. See *PhotoCure v. Kappos*, 603 F.3d 1372, 95 USPQ2d 1250 (Fed. Cir. 2010); see

also *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 13 USPQ2d 1628 (Fed. Cir. 1990) (holding that a patent which claimed an ester of the acid cefuroxime was eligible for extension regardless of previous approvals of two salts of cefuroxime). Thus, eligibility for patent term extension for a patent which claims a product subject to regulatory review as set forth in [35 U.S.C. 156\(b\)](#) turns on the question of whether the product, i.e., the active ingredient of the drug product, present in the final dosage form was previously approved by FDA. If neither it, nor any salt or ester of that active ingredient has been previously approved by FDA, then the patent should be eligible for patent term extension.

Furthermore, a “drug product” is the active ingredient of a particular new drug, rather than the entire composition of the drug product approved by the Food and Drug Administration. See *Fisons plc v. Quigg*, 1988 U.S. Dist. LEXIS 10935; 8 USPQ2d 1491, 1495 (D.D.C. 1988); *aff’d.*, 876 F.2d 99, 110; 10 USPQ2d 1869, 1870 (Fed. Cir. 1989).

A patent is considered to claim the product at least in those situations where the patent claims the active ingredient *per se*, or claims a composition or formulation which contains the active ingredient(s) and reads on the composition or formulation approved for commercial marketing or use.

III. NO PREVIOUS EXTENSIONS (WITH LIMITED EXCEPTIONS)

[37 CFR 1.720\(b\)](#) explains that patent term extension pursuant to [35 U.S.C. 156](#) is available only if the term of the patent has never been previously extended, except for extensions issued pursuant to [37 CFR 1.701](#), [1.760](#), or [1.790](#). An extension issued pursuant to [37 CFR 1.701](#) is an extension of the patent due to administrative delay within the Office. Note that the term of a patent is “adjusted,” not extended, pursuant to [37 CFR 1.702-1.705](#). An extension issued pursuant to [37 CFR 1.760](#) is an interim extension under [35 U.S.C. 156\(e\)\(2\)](#). An extension issued pursuant to [37 CFR 1.790](#) is an interim extension under [35 U.S.C. 156\(d\)\(5\)](#).

IV. REGULATORY REVIEW PERIOD

[37 CFR 1.720\(d\)](#) restates the statutory requirement set forth in [35 U.S.C. 156\(a\)\(4\)](#). The regulatory review period must have been a regulatory review period defined by the statute. A regulatory review period under section 510(k) of the Federal Food, Drug and Cosmetic Act is not a regulatory review period which gives rise to eligibility for patent term extension under [35 U.S.C. 156](#). *In re Nitinol Medical Technologies Inc.*, 17 USPQ2d 1492, 1492-1493 (Comm'r Pat. & Tm. 1990). See also *Baxter Diagnostics v. AVL Scientific Corp.*, 798 F. Supp. 612, 619-620; 25 USPQ2d 1428, 1434 (CD Cal. 1992) (Congress intended only Class III medical devices to be eligible for patent term extension).

If the product is alleged to be a medical device, then regulatory review must have occurred under section 515, and not section 505, of the Federal Food, Drug and Cosmetic Act. Drug products are not reviewed under section 515.

If more than one application for patent term extension is filed based upon a single regulatory review period, election will be required of a single patent. See [MPEP § 2761](#).

V. FIRST PERMITTED MARKETING OR USE

[37 CFR 1.720\(e\)](#) follows [35 U.S.C. 156\(a\)\(5\)](#), and sets forth that the approval under the relevant provision of law must have been the first permitted marketing or use of the product under the provision of law, unless the product is for use in food producing animals as explained below. See *In re Patent Term Extension Application, U.S. Patent No. 3,849,549*, 226 USPQ 283, 284 (Pat. & Tm. Office 1985). If the product is a human drug product, then the approval of the active ingredient must be the first permitted commercial marketing or use of the active ingredient as a single entity or in combination with another active ingredient under the provision of law under which regulatory review occurred.

Where a product contains multiple active ingredients, if any one active ingredient has not been previously approved, it can form the basis of an extension of patent term provided the patent claims that ingredient. See *In re Alcon Laboratories Inc.*, 13

USPQ2d 1115, 1121 (Comm'r Pat. & Tm. 1989) for examples of products having different combinations of active ingredients. A different ratio of hormones is not a different active ingredient for purposes of [35 U.S.C. 156](#). Furthermore, an approved product having two active ingredients will not be considered to have a single active ingredient made of the two active ingredients. See *Arnold Partnership v. Dudas*, 362 F.3d 1338, 70 USPQ2d 1311 (Fed. Cir. 2004). In considering whether a patent claiming an enantiomer, where the enantiomer was subject to pre-market regulatory review, is barred from receiving patent term extension in light of the previous approval of the racemate of the drug product, the court indicated that an enantiomer was a separate drug product from the racemate and each could support a patent term extension. See *Ortho-McNeil Pharmaceutical Inc. v. Lupin Pharmaceuticals Inc.*, 603 F.3d 1377, 95 USPQ2d 1246 (Fed. Cir. 2010).

As to [35 U.S.C. 156\(a\)\(5\)\(C\)](#), which is addressed in [37 CFR 1.720\(e\)\(3\)](#), the term of a patent directed to a new animal drug or veterinary biological product may be extended based on a second or subsequent approval of the active ingredient provided all the following conditions exist:

- (A) the patent claims the drug or product;
- (B) the drug or product is not covered by the claims in any other patent that has been extended;
- (C) the patent term was not extended on the basis of the regulatory review period for use in non-food producing animals; and
- (D) the second or subsequent approval was the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal. In this case, the application must be filed within sixty days of the first approval for administration to a food-producing animal.

For animal drugs or products, prior approval for use in a non-food producing animal will not make a patent ineligible for patent term extension based upon a later approval of the drug or product for use in food producing animals, if the later approval is

the first approval of the drug or product for use in food producing animals.

2752 Patent Term Extension Applicant [R-11.2013]

35 U.S.C. 156 Extension of patent term

(d) (1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the Director. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The application shall contain—

(A) the identity of the approved product and the Federal statute under which regulatory review occurred;

(B) the identity of the patent for which an extension is being sought and the identity of each claim of such patent;

(C) information to enable the Director to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);

(D) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities; and

(E) such patent or other information as the Director may require.

For purposes of determining the date on which a product receives permission under the second sentence of [35 U.S.C. 156\(d\)\(1\)](#), if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is not a business day, the product shall be deemed to receive such permission on the next business day. For purposes of the preceding sentence, the term “business day” means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under 5 U.S.C. 6103.

37 CFR 1.730 Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of [§ 1.740](#).

(b) If the application is submitted by the patent owner, the application must be signed either by:

(1) The patent owner in compliance with [§ 3.73\(b\)](#) of this chapter; or

(2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (e.g., a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of

the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

[35 U.S.C. 156\(d\)\(1\)](#) requires that the application for extension of the patent term must be submitted by the owner of record of the patent or its agent. If the application is filed by an assignee, the application papers should refer to the reel and frame number of the recorded assignment. A power of attorney from the patent owner to any patent attorney or agent submitting the patent term extension application papers should be filed, if the attorney or agent is not already of record in the patent (see [37 CFR 1.34\(b\)](#)).

If the applicant for patent term extension was not the marketing applicant before the regulatory agency, then there must be an agency relationship between the patent owner and the marketing applicant during the regulatory review period. To show that such an applicant is authorized to rely upon the activities of the marketing applicant before the Food and Drug Administration or the Department of Agriculture, it is advisable for the applicant for patent term extension to obtain a letter from the marketing applicant specifically authorizing such reliance.

2753 Application Contents [R-11.2013]

37 CFR 1.740 Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Director. A formal application for the extension of patent term must include:

(1) A complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics;

(2) A complete identification of the Federal statute including the applicable provision of law under which the regulatory review occurred;

(3) An identification of the date on which the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred;

(4) In the case of a drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Virus-Serum-Toxin Act, or a statement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients), the use for which it was approved, and the provision of law under which it was approved.

(5) A statement that the application is being submitted within the sixty day period permitted for submission pursuant to [§ 1.720\(f\)](#) and an identification of the date of the last day on which the application could be submitted;

(6) A complete identification of the patent for which an extension is being sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(7) A copy of the patent for which an extension is being sought, including the entire specification (including claims) and drawings;

(8) A copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(9) A statement that the patent claims the approved product, or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page of the relevant dates and information pursuant to [35 U.S.C. 156\(g\)](#) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued;

(ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of Section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a *Federal Register* notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device, if no IDE was submitted, and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

(11) A brief description beginning on a new page of the significant activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities;

(12) A statement beginning on a new page that in the opinion of the applicant the patent is eligible for the extension and a statement as to the length of extension claimed, including how the length of extension was determined;

(13) A statement that applicant acknowledges a duty to disclose to the Director of the United States Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture any information which is material to the determination of entitlement to the extension sought (see [§ 1.765](#));

(14) The prescribed fee for receiving and acting upon the application for extension (see [§ 1.20\(j\)](#)); and

(15) The name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed.

(b) The application under this section must be accompanied by two additional copies of such application (for a total of three copies).

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of [§ 1.136](#).

[37 CFR 1.740](#) sets forth the requirements for a formal application for extension of patent term. See [MPEP § 2752](#) for a discussion of who may apply for a patent term extension. See [37 CFR 1.741](#) and [MPEP § 2754](#) for a description of the information that must be submitted in the patent term extension application in order to be accorded a filing date.

[37 CFR 1.740\(a\)\(1\)](#) requires a complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics so as to enable the Director to make a determination of whether the patent claims the approved product, or a method of using or manufacturing the approved product.

[37 CFR 1.740\(a\)\(2\)](#) requires a complete identification of the federal statute including the applicable provision of law under which the regulatory review occurred. When the regulatory review of the product took place under more than one Federal statute, each appropriate statute should be listed. This could apply to a situation where a

human biological product is tested under an investigational new drug (IND) application pursuant to the Federal Food, Drug, and Cosmetic Act, but is approved under the Public Health Service Act; or to a situation where approval is sought for use of a particular medical device with a specific drug product which may require approval under more than a single provision of law. The product that forms the basis of an application for patent term extension must be either a medical device or a drug product; any extension will be granted based upon the review of the product as either a medical device or a drug product; it cannot be a combination of those separate products. See the file history of U.S. Patent No. 4,428,744 for an example of the application of this principle.

The date that a product receives permission for commercial marketing or use (which must be identified pursuant to [37 CFR 1.740\(a\)\(3\)](#)) is generally the mailing date of the letter from the regulatory agency indicating regulatory approval. For a food additive, the approval date is generally the effective date stated in the regulation and the date the regulation is published.

[37 CFR 1.740\(a\)\(4\)](#) provides that for drug products, each active ingredient must be identified and there must be an indication of the use for which the product was approved. For each active ingredient, a statement must be made that either the active ingredient was not previously approved for commercial marketing or use under the Federal Food, Drug and Cosmetic Act, or that the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients) and the provision of law under which it was approved. The information is especially necessary for a determination of eligibility where, for example, the application is based on a second or subsequent approval of an active ingredient, but the first approval for administration to a food-producing animal.

In accordance with [37 CFR 1.740\(a\)\(5\)](#), the application must be submitted within the sixty day period permitted for submission pursuant to [37 CFR 1.720\(f\)](#). If the sixty day period ends on a Saturday, Sunday or Federal holiday, then the last day on which the application could be submitted will be

considered to be the next business day following the Saturday, Sunday or Federal holiday. See [37 CFR 1.7](#). The starting date of the sixty-day period as recited in [35 U.S.C. 156\(d\)\(1\)](#) has been clarified by the America Invents Act where the Act provides that, “[f]or purposes of determining the date on which a product receives permission under the second sentence of this paragraph, if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is not a business day, the product shall be deemed to receive such permission on the next business day. For purposes of the preceding sentence, the term 'business day' means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under section 6103 of title 5.” See Section 37 of the American Invents Act and [35 U.S.C. 156](#). However, applicants are cautioned to avoid filing an application for patent term extension on the last day for filing to avoid the application being denied because the filing deadline was inadvertently missed.

The expiration date of the patent for which an extension is sought as identified pursuant to [37 CFR 1.740\(a\)\(6\)](#) should be the expiration date according to the law ([35 U.S.C. 154](#)) at the time of filing of the application for patent term extension, and should include any patent term adjustment under [35 U.S.C. 154\(b\)](#).

Pursuant to [37 CFR 1.740\(a\)\(9\)](#), the application for patent term extension need only explain how one product claim of the patent claims the approved product, if there is a claim to the product. In addition, the application need only explain how one method of use claim of the patent claims the method of use of the approved product, if there is a claim to the method of use of the product. Lastly, the application need only explain how one claim of the patent claims the method of manufacturing the approved product, if there is a claim to the method of manufacturing the approved product. At most, a showing explaining three claims is required. However, each claim that claims the approved product, the method of use of the approved product, or the method of manufacturing the approved product must be listed. See [35 U.S.C. 156\(d\)\(1\)\(B\)](#).

The showing should clearly explain how each listed claim reads on the approved product. For example, where a generic chemical structure is used in the claim to define the claimed invention, a listing of variables and substituents which correspond to the approved product is appropriate. Where a claim uses the “means for” language permitted by [35 U.S.C. 112, paragraph 6](#), or [35 U.S.C. 112\(f\)](#) for patents granted on AIA applications, reference to the column and line number of the patent text and any drawing reference numbers, as well as a description of any relevant equivalents, is also appropriate.

Pursuant to [37 CFR 1.740\(a\)\(10\)](#), the patent term extension applicant must provide a statement to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory period. In cases where there is no regulatory event to reflect the commencement of the testing or approval phase of the regulatory review period, applicants should include in the application the dates that they claim initiate either the approval or the testing phases and an explanation of their reasonable bases for why they conclude that these dates are the relevant dates. For instance, when the clinical trials are conducted outside of the United States, the testing phase for a medical device begins on the date the clinical investigation involving the device began. An applicant should include an explanation as to why the date claimed is the date on which such clinical investigations had commenced. If the applicant has any means of substantiating that date, that information should be included in the application.

[37 CFR 1.740\(a\)\(11\)](#) requires a brief description of the activities of the marketing applicant before the regulatory agency. This description should include an identification of significant communications of substance with the regulatory agency and the dates related to such communications. For example, these activities would include the dates of the submissions of new data to the FDA, communications between FDA and the applicant with respect to the appropriate protocols for testing the product, and communications between FDA and the applicant that are attempts to define the particular requirements for premarketing approval for this particular product. The applicant is not required to establish the existence of due diligence during the regulatory

review period in order to have a complete application.

As stated above, the marketing applicant must have been an agent of the patent owner, if not the same entity as the patent owner. Accordingly, the Office will not assist the patent owner in obtaining information required in an application for patent term extension from the marketing applicant. It is sufficient that the description of the activities briefly identify those significant activities undertaken by the marketing applicant directed toward regulatory approval, and a submission of insignificant details or identification of non-substantive communications is not required.

[37 CFR 1.740\(a\)\(12\)](#) requires that the extension applicant state the length of extension claimed and show how the length of extension was calculated, including whether the 14-year limit of [35 U.S.C. 156\(c\)\(3\)](#) or the five-year limit of [35 U.S.C. 156\(g\)\(6\)\(A\)](#) applies.

[37 CFR 1.740\(a\)\(15\)](#) requires the patent term extension applicant to provide a correspondence address. A fax number should also be provided. Normally only communications regarding the application for patent term extension will be sent to the address specified in the patent term extension application. If the address is changed after filing the application for patent term extension, the change of address should be sent to Mail Stop Hatch-Waxman PTE, since changing the address for the patent file will not cause the address for the patent term extension application to also be changed.

In order to change the address of all correspondence, including maintenance fee reminders, a change of address should also be filed. A change of address must be signed by the patent applicant, the assignee of the entire interest, or an attorney or agent of record. [37 CFR 1.33\(a\)](#). Accordingly, if the patent term extension application is signed by the marketing applicant, as an agent of the patent owner, a power of attorney from the patent owner to any attorney for the marketing applicant would be necessary for the attorney for the marketing applicant to be able to sign a change of address for the patent file.

Pursuant to [37 CFR 1.740\(b\)](#), two additional copies of the application for patent term extension must be filed with the application. The original copy, along with the patent file (if not already scanned into the Image File Wrapper system), is scanned into the Image File Wrapper system so that all patent prosecution and patent term extension documents are available in PUBLIC PAIR. One copy of the application is forwarded to the regulatory agency and the second copy is used by the Legal Advisor in the Office of Patent Legal Administration.

2754 Filing Date [R-11.2013]

37 CFR 1.741 Complete application given a filing date; petition procedure.

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office or filed pursuant to the procedures set forth in [§ 1.8](#) or [§ 1.10](#). A complete application must include:

- (1) An identification of the approved product;
 - (2) An identification of each Federal statute under which regulatory review occurred;
 - (3) An identification of the patent for which an extension is being sought;
 - (4) An identification of each claim of the patent which claims the approved product or a method of using or manufacturing the approved product;
 - (5) Sufficient information to enable the Director to determine under subsections (a) and (b) of [35 U.S.C. 156](#) the eligibility of a patent for extension, and the rights that will be derived from the extension, and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and
 - (6) A brief description of the activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities.
- (b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in [§ 1.17\(h\)](#) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time period may be extended under the provisions of [§ 1.136](#).

I. FILING DATE ACCORDED

An application for patent term extension under [35 U.S.C. 156](#) may be filed by mail addressed to Mail Stop Hatch-Waxman PTE., Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 or may be hand carried to the Office of Patent Legal Administration. Applicants are encouraged to use the post card receipt practice described in [MPEP § 502](#).

As set forth in [37 CFR 1.741\(a\)](#), the filing date of an application for patent term extension is the date on which a complete application is received in the USPTO or filed pursuant to the certificate of mailing provisions of [37 CFR 1.8](#) (see [MPEP § 512](#) for suggested formats for a certificate of mailing) or the Express Mail provisions of [37 CFR 1.10](#). Patent term extension applications must not be filed by facsimile or the Office's electronic filing system (EFS-Web). However correspondence setting forth a change of address and other papers relating to a patent term extension may be sent by facsimile to the Office of Patent Legal Administration or via EFS-Web.

II. COMPLETE APPLICATION

The term "complete application" is defined in [37 CFR 1.741\(a\)](#) and is an application meeting the requirements set forth in [35 U.S.C. 156\(d\)\(1\)](#). For the establishment of a filing date, the distinction between the requirements of [37 CFR 1.740](#) and the requirements of [37 CFR 1.741](#) are important. While the requirements of [37 CFR 1.740](#) may be satisfied outside the 60-day filing period, the requirements of [37 CFR 1.741](#) are mandated by [35 U.S.C. 156](#) and must be satisfied within the 60-day filing period for the establishment of the filing date. The Office will consider each of these statutory requirements to be satisfied in an application which provides sufficient information, directed to each requirement, to act on the application, even though further information may be desired by the USPTO or the regulatory agency before a final determination of eligibility and length of patent term extension is made.

III. INFORMAL APPLICATION

37 CFR 1.740 Formal requirements for application for extension of patent term; correction of informalities.

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of [§ 1.136](#).

If the application does not meet all the formal requirements of [37 CFR 1.740\(a\)](#) (see [MPEP § 2753](#)), the applicant will be notified of the

informalities and may seek to have that holding reviewed under [37 CFR 1.740\(c\)](#) or to correct the informality. The time periods set forth therein are subject to the provisions of [37 CFR 1.136](#), unless otherwise stated in the notice.

Note that if the application satisfies the requirements of [37 CFR 1.741](#), the application filing date will have been established even if the application is held to be informal under [37 CFR 1.740](#).

2754.01 Deadline for Filing an Application Under 35 U.S.C. 156(d)(1) [R-11.2013]

An application for patent term extension under [35 U.S.C. 156\(d\)\(1\)](#) may only be filed within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The statutory time period is not extendable and cannot be waived or excused. See U.S. Patent No. 4,486,425 (application for patent term extension filed after the end of the 60-day period and was therefore denied). For purposes of determining the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use, if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is not a business day, the product shall be deemed to have received such permission on the next business day. The term “business day” in this context means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under 5 U.S.C. 6103.

The statute takes into account only the regulatory review carried out by the Food and Drug Administration or the Department of Agriculture and no other government obstacles to marketing or use. See *Unimed, Inc. v. Quigg*, 888 F2d 826, 828; 12 USPQ2d 1644, 1646 (Fed. Cir. 1989). For drug products the approval date is the date of a letter by the Food and Drug Administration indicating that the application has been approved, even if the letter requires further action before the drug can be marketed. *Mead Johnson Pharmaceutical Group v. Bowen*, 838 F2d 1332, 1336; 6 USPQ2d 1565, 1568

(D.C. Cir. 1988). For food or color additives, the relevant date is the effective date of the regulation or order, which is set forth in the regulation or order, and generally is the date that the regulation or order is published, e.g., in the Federal Register. See 21 U.S.C. 348(e). This date will generally be later than the date the approval is communicated to the marketing applicant.

2754.02 Filing Window for an Application Under 35 U.S.C. 156(d)(5) [R-8.2012]

A first application for interim extension under [35 U.S.C. 156\(d\)\(5\)](#) (to extend the patent term before product approval) must be filed within the period beginning six months and ending fifteen days before the patent is due to expire. Each subsequent application for interim extension must be filed during the period beginning sixty days before and ending thirty days before the expiration of the preceding interim extension. [35 U.S.C. 156\(d\)\(5\)\(C\)](#). An interim extension granted under [35 U.S.C. 156\(d\)\(5\)](#) terminates sixty days after permission for commercial marketing or use of the product is granted, except, if within the sixty-day period any additional information needed for an application for patent term extension under [35 U.S.C. 156\(d\)\(1\)](#) is submitted, the patent may be further extended. [35 U.S.C. 156\(d\)\(5\)\(E\)](#). The additional information required to be submitted includes the fee for an application for patent term extension under [35 U.S.C. 156\(d\)\(1\)](#), identification of the date the product received permission for commercial marketing or use, a statement that the application is being submitted within sixty days of such date, and identification of the last date that the application could be submitted. See [37 CFR 1.740\(a\)\(3\) and \(5\)](#). However, if the product is not approved within the period of interim extension, a new request for interim extension must be filed and another interim extension granted to keep the patent in force. An applicant is generally limited to four one-year interim extensions.

See [MPEP § 2755.02](#) for additional information pertaining to the interim extension of patent term under [35 U.S.C. 156\(d\)\(5\)](#).

2754.03 Filing of a Request for an Extension Under 35 U.S.C. 156(e)(2) [R-8.2012]

A request for an interim extension under [35 U.S.C. 156\(e\)\(2\)](#) (to extend the patent term during the processing of the patent term extension application) should be made at least three months before the patent is due to expire. See [MPEP § 2755.01](#) for information pertaining to the interim extension of patent term under [35 U.S.C. 156\(e\)\(2\)](#).

2755 Eligibility Determination [R-8.2012]

37 CFR 1.750 Determination of eligibility for extension of patent term

A determination as to whether a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for extension filed in compliance with [§ 1.740](#) or [§ 1.790](#). This determination may be delegated to appropriate Patent and Trademark Office officials and may be made at any time before the certificate of extension is issued. The Director or other appropriate officials may require from applicant further information or make such independent inquiries as desired before a final determination is made on whether a patent is eligible for extension. In an application for extension filed in compliance with [§ 1.740](#), a notice will be mailed to applicant containing the determination as to the eligibility of the patent for extension and the period of time of the extension, if any. This notice shall constitute the final determination as to the eligibility and any period of extension of the patent. A single request for reconsideration of a final determination may be made if filed by the applicant within such time as may be set in the notice of final determination or, if no time is set, within one month from the date of the final determination. The time periods set forth herein are subject to the provisions of [§ 1.136](#).

The determination as to whether a patent is eligible for an extension will normally be made solely from the representations contained in the application for patent term extension. However, further information may be required or inquiry made of applicant before a final determination is made on whether a patent is eligible for extension. In circumstances where further information is required by the Office, the applicant will be given a time period within which to respond. The failure to provide a response within the time period provided may result in a final determination adverse to the granting of an extension of patent term unless the response period is extended. An extension of time to respond may be requested under the provisions of [37 CFR 1.136](#). Under appropriate circumstances, e.g., if time is of the essence for a particular reason, a request for information may

contain a statement that the provisions of [37 CFR 1.136\(a\)](#) are not available. The intentional failure to provide the information requested may result in an adverse final determination.

A final determination may be made at any time after an application is filed. A single request for reconsideration of a final determination may be filed within one month or within such other time period set in the final determination. A notice will be mailed to applicant containing the determination as to eligibility of the patent for extension and the period of time of the extension of the term, if any. This notice shall constitute the final determination as to eligibility and any period of extension of the patent term. If no request for reconsideration is filed within the time period set in the notice of final determination, the certificate of patent term extension will be issued in due course. See [MPEP § 2758](#).

2755.01 Interim Extension of Patent Term During the Processing of the Application [R-11.2013]

35 U.S.C. 156 Extension of patent term.

(e) (2) If the term of a patent for which an application has been submitted under subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the Director shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

37 CFR 1.760 Interim extension of patent term under 35 U.S.C. 156(e)(2).

An applicant who has filed a formal application for extension in compliance with [§ 1.740](#) may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to [§ 1.750](#). Any such request should be filed at least three months prior to the expiration date of the patent. The Director may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

If the original term of the patent for which extension is sought will expire before a final decision to issue a certificate of extension can be made, and a determination is made that the patent is eligible for extension, [35 U.S.C. 156](#) provides that the Director

may issue an interim extension of the patent term for up to one year pending a final decision on the application for extension. Should additional time be necessary, additional interim extensions of up to one year may be granted by the Director. The length of any interim extension is discretionary with the Director so long as it is for one year or less. Its length should be set to provide time for completion of any outstanding requirements. See *In re Reckitt & Colman Products Ltd.*, 230 USPQ 369, 372 (Comm'r Pat. & Tm. 1986). The Director may issue an interim extension under [35 U.S.C. 156\(e\)\(2\)](#) with or without a request from the applicant.

Where a determination is made that the patent is not eligible for patent term extension, an interim extension of the patent term is not warranted under [35 U.S.C. 156\(e\)\(2\)](#). See *In re Alcon Laboratories Inc.*, 13 USPQ2d 1115, 1123 (Comm'r. Pat. & Tm. 1989).

Where an interim extension has been granted and it is subsequently determined that the patent is not eligible for patent term extension, the interim extension may be vacated *ab initio* as ineligible under [35 U.S.C. 156\(e\)\(2\)](#). See *In re Reckitt*, 230 USPQ at 370.

While [37 CFR 1.760](#) provides that a request for an interim extension by the applicant “should” be filed three months prior to the expiration of the patent, this time frame is not mandatory. Any request filed within a shorter period of time will be considered, upon a proper showing, where it is not possible to make an earlier request. However, for an interim extension to be granted, the application for extension, in compliance with [37 CFR 1.741](#), must have been filed prior to the expiration date of the patent. In no event will an interim extension be granted for a period of patent term extension longer than the period of extension to which the patent would be eligible.

A notice of each interim extension granted will be issued to the applicant for patent term extension. The notice will be recorded in the official file of the

patent and will be considered as part of the original patent.

2755.02 Interim Extension of Patent Term Before Product Approval [R-11.2013]

35 U.S.C. 156 Extension of patent term.

(d) (5) (A) If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraphs (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect, the owner or its agent may submit an application to the Director for an interim extension during the period beginning 6 months, and ending 15 days before such term is due to expire. The application shall contain—

(i) the identity of the product subject to regulating review and the Federal statute under which such review is occurring;

(ii) the identity of the patent for which interim extension is being sought and the identity of each claim of such patent which claims the product under regulatory review or a method of using or manufacturing the product;

(iii) information to enable the Director to determine under subsection (a)(1), (2), and (3) the eligibility of a patent for extension;

(iv) a brief description of the activities undertaken by the applicant during the applicable regulatory review period to date with respect to the product under review and the significant dates applicable to such activities; and

(v) such patent or other information as the Director may require.

(5) (B) If the Director determines that, except for permission to market or use the product commercially, the patent would be eligible for an extension of the patent term under this section, the Director shall publish in the Federal Register a notice of such determination, including the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year.

(C) The owner of record of a patent, or its agent, for which an interim extension has been granted under subparagraph (B), may apply for not more than 4 subsequent interim extensions under this paragraph, except that, in the case of a patent subject to subsection (g)(6)(C), the owner of record of the patent, or its agent, may apply for only 1 subsequent interim extension under this paragraph. Each such subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

(D) Each certificate of interim extension under this paragraph shall be recorded in the official file of the patent and shall be considered part of the original patent.

(E) Any interim extension granted under this paragraph shall terminate at the end of the 60-day period beginning on the day on which the product involved receives permission for commercial marketing or use, except that, if within that 60-day period, the applicant notifies the Director of such permission and submits any additional information under paragraph (1) of this subsection not previously contained in the application for interim extension, the patent shall be further extended, in accordance with the provisions of this section—

(i) for not to exceed 5 years from the date of expiration of the original patent term; or

(ii) if the patent is subject to subsection (g)(6)(C), from the date on which the product involved receives approval for commercial marketing or use.

(F) The rights derived from any patent the term of which is extended under this paragraph shall, during the period of interim extension—

(i) in the case of a patent which claims a product, be limited to any use then under regulatory review;

(ii) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent then under regulatory review; and

(iii) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make the product then under regulatory review.

37 CFR 1.790 Interim extension of patent term under 35 U.S.C. 156(d)(5).

(a) An owner of record of a patent or its agent who reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect may submit one or more applications for interim extensions for periods of up to one year each. The initial application for interim extension must be filed during the period beginning 6 months and ending 15 days before the patent term is due to expire. Each subsequent application for interim extension must be filed during the period beginning 60 days before and ending 30 days before the expiration of the preceding interim extension. In no event will the interim extensions granted under this section be longer than the maximum period of extension to which the applicant would be entitled under [35 U.S.C. 156\(c\)](#).

(b) A complete application for interim extension under this section shall include all of the information required for a formal application under [§ 1.740](#) and a complete application under [§ 1.741](#). Sections (a)(1), (a)(2), (a)(4), and (a)(6) - (a)(17) of [§ 1.740](#) and [§ 1.741](#) shall be read in the context of a product currently undergoing regulatory review. Sections (a)(3) and (a)(5) of [§ 1.740](#) are not applicable to an application for interim extension under this section.

(c) The content of each subsequent interim extension application may be limited to a request for a subsequent interim extension along with a statement that the regulatory review period has not been completed along with any materials or information required under [§§ 1.740](#) and [1.741](#) that are not present in the preceding interim extension application.

37 CFR 1.791 Termination of interim extension granted prior to regulatory approval of a product for commercial marketing or use.

Any interim extension granted under [35 U.S.C. 156\(d\)\(5\)](#) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. If within that 60-day period the patent owner or its agent files an application for extension under [§§ 1.740](#) and [1.741](#) including any additional information required under [35 U.S.C. 156\(d\)\(1\)](#) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of [35 U.S.C. 156](#).

If a patent that claims a product which is undergoing the approval phase of regulatory review as defined by [35 U.S.C. 156\(g\)\(1\)\(B\)\(ii\)](#), [\(2\)\(B\)\(ii\)](#), [\(3\)\(B\)\(ii\)](#), [\(4\)\(B\)\(ii\)](#), and [\(5\)\(B\)\(ii\)](#) is expected to expire before approval is granted, interim patent term extension is available under [35 U.S.C. 156\(d\)\(5\)](#). The application for patent term extension that must be submitted is generally the same as would be filed had the product been approved, except that the

approval date is not required to be set forth. Once the product is approved, the application must be converted to an application for patent term extension under [35 U.S.C. 156\(d\)\(1\)](#) to obtain patent term extension under that subsection.

Processing of an application for interim patent term extension under [35 U.S.C. 156\(d\)\(5\)](#) is performed in the Office of Patent Legal Administration and is similar to other applications for patent term extension, except that the Office is not required to seek the advice of the relevant regulatory agency. The relevant agency, however, is normally consulted before an interim extension is granted or before the application is denied. The fee for an application for patent term extension under [35 U.S.C. 156\(d\)\(5\)](#) is set forth in [37 CFR 1.20\(j\)\(2\)](#), and the fee for a subsequent application is set forth in [37 CFR 1.20\(j\)\(3\)](#). Copies of an application for interim extension are maintained in the same manner as applications for patent term extension. As required by [35 U.S.C. 156\(d\)\(5\)\(B\)](#), a determination that a patent is eligible for extension under [35 U.S.C. 156](#), but for regulatory approval, is published in the Federal Register. A sample order granting a second interim extension follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

In re ____

Request for Patent Term Extension ORDER GRANTING U.S. Patent No. ____ INTERIM EXTENSION

On __, patent owner __, filed an application under [35 U.S.C. 156\(d\)\(5\)](#) for interim extension of the term of U.S. Patent No. __. The patent claims the active ingredient __ in the human drug product “__.” The application indicates that the product is currently undergoing a regulatory review before the Food and Drug Administration for permission to market or use the product commercially. The original term of the patent expired on __. On __, the patent was granted a first interim extension under [35 U.S.C. 156\(d\)\(5\)](#) for a period of one year.

Review of the application indicates that except for receipt of permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under [35 U.S.C. 156](#). Since it is apparent that the regulatory review period may extend beyond the date of expiration of the patent, as extended by the first interim extension, a second interim extension of the patent term under [35 U.S.C. 156\(d\)\(5\)](#) is appropriate.

An interim extension under [35 U.S.C. 156\(d\)\(5\)](#) of the term of U.S. Patent No. __ is granted for a period of one year from the extended expiration date of the patent.

As seen from the example given, a series of one-year interim extensions may be granted if requested in a timely manner (in the window of time between thirty and sixty days before the extended expiration date).

An interim extension granted under [35 U.S.C. 156\(d\)\(5\)](#) terminates sixty days after permission for commercial marketing or use of the product is granted, except, if within the sixty day period any additional information needed for an application for patent term extension under [35 U.S.C. 156\(d\)\(1\)](#) is submitted, the patent may be further extended. [35 U.S.C. 156\(d\)\(5\)\(E\)](#).

2756 Correspondence Between the USPTO and the Regulatory Agency [R-11.2013]

It is the Director's responsibility to decide whether an applicant has satisfied the requirements of the statute and whether the patent qualifies for patent term extension. The regulatory agency possesses expertise and records regarding some of the statutory requirements and has certain direct responsibilities under [35 U.S.C. 156](#) for determining the length of the regulatory review period. Consequently, to facilitate eligibility decisions and permit the regulatory agency and the Office to carry out their responsibilities under [35 U.S.C. 156](#), both the Food and Drug Administration and the Department of Agriculture have entered into an "agreement" of cooperation with the Office. *Memorandum of Understanding Between the Patent and Trademark Office and the Food and Drug Administration*, 52 Fed. Reg. 17830 (May 12, 1987); *Memorandum of Understanding Between the Patent and Trademark Office and the Animal and Plant Health Inspection Service*, 54 Fed. Reg. 26399 (June 23, 1989); 1104 Off. Gaz. Pat. Office 18 (July 11, 1989). The agreements establish the procedures whereby the regulatory agency assists the Office in determining a patent's eligibility for patent term extension under [35 U.S.C. 156](#). It also establishes procedures for exchanging information between the regulatory agency and the Office regarding regulatory review period determinations, due diligence petitions and informal regulatory agency hearings under the law. The patent term extension applicant receives a copy of all correspondence between the Office and the regulatory agency.

The Animal and Health Inspection Service of the Department of Agriculture is responsible for assisting the Office in determining the eligibility of patent claiming a veterinary biological product that has been subject to the Virus-Serum-Toxin Act (21 U.S.C. 151-59) and for determining the regulatory review period of the veterinary biological product. The Secretary of Health and Human Services of the Food and Drug Administration is responsible for assisting the Office in determining the eligibility of patents claiming any other product for which regulatory review gives rise to eligibility for patent term extension. 21 CFR 60.10.

I. INFORMATION REGARDING ELIGIBILITY FOR EXTENSION

If the Office has no clear reason to deny eligibility for patent term extension (even if there are questions concerning eligibility), or if the applicant has been notified of any informalities and it is anticipated that the informalities will be corrected or explained, a first letter is sent to the regulatory agency to request information regarding eligibility. The letter is accompanied by a copy of the patent term extension application. This letter does **not** request the determination of the applicable regulatory review period.

The regulatory agency reply is usually in the form of a written response:

(A) verifying whether the product has undergone a regulatory review period within the meaning of [35 U.S.C. 156\(g\)](#) prior to commercial marketing or use;

(B) stating whether the marketing permission was for the first permitted commercial marketing or use of that product, or, in the case of recombinant DNA technology, whether such commercial marketing or use was the first permitted under the process claimed in the patent;

(C) informing the Office whether the patent term extension application was submitted within sixty days after the product was approved for marketing or use; and

(D) providing the Office with any other information relevant to the Office determination of whether a patent related to a product is eligible for patent term extension.

While the Office has primary responsibility for the eligibility determination, the regulatory agency often possesses information which is not readily available to the Office. The assistance on the part of the regulatory agency enables both the Office and the agency to process applications efficiently and to conserve resources.

II. PRELIMINARY ELIGIBILITY DECISION

Upon receipt of a reply from the regulatory agency to the first letter from the Office requesting assistance on determining eligibility, a preliminary eligibility decision (not the final decision) is made as to whether the patent is eligible for an extension of its term. As noted above, the reply from the regulatory agency will usually inform the Office as to whether the permission for commercial marketing and use of the product on which the application for patent term extension is based is the first such approval for that product. Furthermore, the regulatory agency usually provides information regarding the date of product approval to permit a determination as to whether the application was filed within the sixty-day statutory period. The information provided by the regulatory agency is then compared with the related information from the application. If no major discrepancies are found and the patent is determined to be eligible for patent term extension, a second letter requesting a determination of the length of the regulatory review period of the product is mailed to the regulatory agency not later than sixty (60) days after the Office receipt date of the reply from the regulatory agency. In the interest of efficiency, if the patent is determined to be ineligible for patent term extension, the Office will dismiss the application rather than request a determination of the regulatory review period. *In re Allen & Hansbury, Ltd.*, 227 USPQ 955, 960 n. 9 (Comm'r Pat. & Tm. 1985). The second letter states that, subject to final review, the patent is considered eligible for patent term extension and

requests a determination of the applicable regulatory review period.

2757 Regulatory Agency Determination of the Length of the Regulatory Review Period [R-11.2013]

Under [35 U.S.C. 156](#), the regulatory agency is responsible for the determination of the length of the regulatory review period for the approved product on which the application for patent term extension is based. The determination by the regulatory agency is made based on the application as well as the official regulatory agency records for the approved product. See, e.g., 21 CFR Ch. 1, Subpart C. The determination of the length of the regulatory review period is solely the responsibility of the regulatory agency. *Aktiebolaget Astra v. Lehman*, 71 F.3d 1578, 1580-81, 37 USPQ2d 1212, 1214-15 (Fed. Cir. 1995) (regarding U.S. Patent No. 4,215,113). To determine the regulatory review period for an animal drug where the New Animal Drug Application (NADA) components were submitted to FDA in a phased review, the approval phase, as defined by [35 U.S.C. 156\(g\)\(4\)\(B\)\(ii\)](#), begins on the date of the submission of the administrative NADA. See *Wyeth Holdings Corp. v. Sebelius*, 603 F.3d 1291, 1299-1300, 95 USPQ2d 1233,1240 (Fed. Cir. 2010).

Once the determination has been made, the regulatory agency publishes the information in the Federal Register and forwards a letter to the Office with the same information. Included in both the Federal Register Notice and the letter to the Office are the total length of the regulatory review period and the relevant dates on which the determination is based. Both the letter to the Office and the Federal Register Notice separate the total regulatory period into the initial or testing phase and the final approval phase. This provides the Office with the information necessary to determine the actual length of extension for which the patent may be eligible. The Federal Register Notice also sets a date, 180 days after publication of the notice, as a deadline for filing written comments concerning any of the information set forth in the notice or a petition for a determination regarding whether the marketing applicant has acted with due diligence during the regulatory review period. The letter to the Office

makes clear that the determination does not take into account the issue date of the patent nor does it exclude one-half of the testing phase.

The regulatory review period determination is not final until due diligence petitions and informal hearings, if any, have been resolved. A certificate for extension of the term of a patent may not issue from the Office until the regulatory review period determination is final unless an interim extension appears warranted under [35 U.S.C. 156\(d\)\(5\)](#) and [\(e\)\(2\)](#).

2757.01 Due Diligence Determination [R-11.2013]

If a due diligence petition is filed during the 180-day period following publication of the regulatory agency determination of the regulatory review period, the regulatory agency (e.g., FDA) makes the determination under [35 U.S.C. 156\(d\)\(2\)\(B\)](#) whether the applicant for patent term extension acted with due diligence during the regulatory review proceedings. The term “due diligence” is defined in [35 U.S.C. 156\(d\)\(3\)](#) as “that degree of attention, continuous directed effort, and timeliness as may reasonably be expected from, and are ordinarily exercised by, a person during a regulatory review period.” After affirming or revising the determination of the regulatory review period, the regulatory agency notifies the Office and publishes the results in the Federal Register. If no comment or petition is filed in the time period provided, the regulatory agency notifies the Office that the period for filing a due diligence petition pursuant to the notice has expired and that the regulatory agency therefore considers its determination of the regulatory review period for the product to be final. Following notification from the regulatory agency, the Office will proceed with the final eligibility determination. See 21 CFR Ch. 1, Subparts D and E.

2758 Notice of Final Determination - Calculation of Patent Term Extension [R-11.2013]

35 U.S.C. 156 Extension of patent term.

(c) The term of a patent eligible for extension under subsection (a) shall be extended by the time equal to the regulatory review period

for the approved product which period occurs after the date the patent is issued, except that—

(1) each period of the regulatory review period shall be reduced by any period determined under subsection (d)(2)(B) during which the applicant for the patent extension did not act with due diligence during such period of the regulatory review period;

(2) after any reduction required by paragraph (1), the period of extension shall include only one-half of the time remaining in the periods described in paragraphs (1)(B)(i), (2)(B)(i), (3)(B)(i), (4)(B)(i), and (5)(B)(i) of subsection (g);

(3) if the period remaining in the term of a patent after the date of the approval of the approved product under the provision of law under which such regulatory review occurred when added to the regulatory review period as revised under paragraphs (1) and (2) exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years, and

(4) in no event shall more than one patent be extended under subsection (e)(i) for the same regulatory review period for any product.

(6) A period determined under any of the preceding paragraphs is subject to the following limitations:

(A) If the patent involved was issued after the date of the enactment of this section, the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(B) If the patent involved was issued before the date of the enactment of this section and —

(i) no request for an exemption described in paragraph (1)(B) or (4)(B) was submitted and no request for the authority described in paragraph (5)(B) was submitted,

(ii) no major health or environment effects test described in paragraph (2)(B) or (4)(B) was initiated and no petition for a regulation or application for registration described in such paragraph was submitted, or

(iii) no clinical investigation described in paragraph (3) was begun or product development protocol described in such paragraph was submitted, before such date for the approved product the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(C) If the patent involved was issued before the date of the enactment of this section and if an action described in subparagraph (B) was taken before the date of enactment of this section with respect to the approved product and the commercial marketing or use of the product has not been approved before such date, the period of extension determined on the basis of the regulatory review period determined under such paragraph may not exceed two years or in the case of an approved product which is a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act or the Virus-Serum-Toxin Act), three years.

After reviewing the information provided by the regulatory agency, if the Office determines the patent to be eligible for extension, the Office then calculates the length of extension for which the patent is eligible under the appropriate statutory provisions ([35 U.S.C. 156\(c\)](#); [37 CFR 1.750](#)). The length of extension is subject to the limitations of [35 U.S.C. 156\(c\)\(3\)](#) and [35 U.S.C. 156\(g\)\(6\)](#). A Notice of Final Determination is mailed to applicant which states the length of extension for which the application has been determined to be eligible and the calculations

used to determine the length of extension. Recently mailed Notices of Final Determination are posted in the Freedom of Information (FOIA) section of the USPTO Web site (www.uspto.gov) with other Decisions of the Director. The notice provides a period, usually one month, in which the applicant can request reconsideration of any aspect of the Office determination as to eligibility or the length of extension for which the application has been found eligible.

If the application has been determined to be ineligible for patent term extension, an appropriate Notice of Final Determination is mailed to applicant which dismisses the application and sets forth the basis for the dismissal. The applicant is given a period, usually one month, in which to seek reconsideration of the determination.

If the patent is found to be eligible for extension, the Notice of Final Determination may include text similar to the following:

A determination has been made that U.S. Patent No. ____, which claims the human drug ____, is eligible for patent term extension under [35 U.S.C. 156](#). The period of extension has been determined to be ____.

A single request for reconsideration of this final determination as to the length of extension of the term of the patent may be made if filed within one month of the date of this notice. Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to this time period. In the absence of such request for reconsideration, the Director will issue a certificate of extension, under seal, for a period of ____ days.

The period of extension has been calculated using the FDA determination of the length of the regulatory review period published in the Federal Register of ____. Under [35 U.S.C. 156\(c\)](#)

Period of Extension = RRP - PGRRP - DD - ½ (TP - PGTP)¹

¹Consistent with [35 U.S.C. 156\(c\)](#), “RRP” is the total number of days in the regulatory review period, “PGRRP” is the number of days of the RRP which were on and before the date on which the patent issued, “DD” is the number of days of the RRP that the applicant did not act with due diligence, “TP” is the testing phase period described in paragraphs (1)(B)(i), (2)(B)(i), (3)(B)(i), (4)(B)(i), and (5)(B)(i) of subsection (g) of [35 U.S.C. 156](#), and “PGTP” is the number of days of the TP which were on and before the date on which the patent issued, wherein half days are ignored for purposes of the subtraction of ½ (TP - PGTP).

Since the regulatory review period began ____, before the patent issued ____, only that portion of the regulatory review period occurring after the date the patent issued has been considered in the above determination of the length of the extension period [35 U.S.C. 156\(c\)](#). (From __ to __ is ____ days; this period is subtracted for the number of days occurring in the testing phase according to the FDA determination of the length

of the regulatory review period.) No determination of a lack of due diligence under [35 U.S.C. 156\(c\)\(1\)](#) was made.

The 14 year exception of [35 U.S.C. 156\(c\)\(3\)](#) operates to limit the term of the extension in the present situation because it provides that the period remaining in the term of the patent measured from the date of approval of the approved product (____) when added to the period of extension calculated above (____ days) cannot exceed fourteen years. The period of extension is thus limited to ____, by operation of [35 U.S.C. 156\(c\)\(3\)](#). Since the patent term ([35 U.S.C. 154](#)) would expire on ____, the period of extension is the number of days to extend the term of the patent from its expiration date to and including ____, or ____ days.

The limitations of [35 U.S.C. 156\(g\)\(6\)](#) do not operate to further reduce the period of extension determined above.

See [MPEP § 2759](#) for further information pertaining to the issuance of a certificate of extension.

A patent term extension generally extends the patent from its “original expiration date,” as defined by [35 U.S.C. 154](#) to include extension under former 35 U.S.C. 154(b) (for applications filed between June 8, 1995 and May 28, 2000) and patent term adjustment under [35 U.S.C. 154\(b\)](#) (for applications filed on or after May 29, 2000).

No certificate or extension will be issued if the term of a patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations the final determination would issue indicating that no certificate will issue.

I. CALCULATION OF PATENT TERM EXTENSION

The procedure for calculating the length of the patent term extension is set forth for human drugs, antibiotic drugs, and human biological products in [37 CFR 1.775](#); for food or color additives in [37 CFR 1.776](#); for medical devices in [37 CFR 1.777](#); for animal drug products in [37 CFR 1.778](#); and for veterinary biological products in [37 CFR 1.779](#). The length of patent term extension is the length of the regulatory review period as determined by the Secretary of Health and Human Services or the Secretary of Agriculture, but reduced, where appropriate, by the time periods provided in [37 CFR 1.775 - 1.779](#). The Office will rely on the Secretary’s determination of the length of the regulatory review period when calculating the length of the extension period under [37 CFR 1.775 - 1.779](#).

Any part of the regulatory review period which occurs before the patent was granted will not be counted toward patent term extension. Any period in which the marketing applicant failed to exercise due diligence, thereby unnecessarily adding to the length of the regulatory review period after the patent issued, will not be considered in determining the length of the extension period. In making the calculation of the extension period, half days will be ignored and thus will not be subtracted from the regulatory review period.

For products other than animal drug or veterinary biological products, the calculated extension period cannot exceed any of the following statutory maximum periods of extension:

(A) If the period remaining in the term of the patent after the date of approval of the approved product when added to the calculated regulatory review period exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years;

(B) If the patent involved was issued after September 24, 1984, (the date of enactment of the statute), the calculated period of extension may not exceed five years;

(C) If the patent involved was issued before September 24, 1984, (the date of enactment of the statute), and the regulatory review period proceeding started after this date, the calculated period of extension may not exceed five years; and

(D) If the patent involved was issued before September 24, 1984, (the date of enactment of the statute), and the regulatory review period proceeding started before this date, and the commercial marketing or use of the product has been approved after such date, the calculated period of extension may not exceed two years.

For animal drug or veterinary biological products, the calculated extension period cannot exceed any of the following statutory maximum periods of extension:

(A) If the period remaining in the term of the patent after the date of approval of the approved product when added to the calculated regulatory review period exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years;

(B) If the patent involved was issued after November 16, 1988, the calculated period of extension may not exceed five years;

(C) If the patent involved was issued before November 16, 1988, and the regulatory review period proceeding started after this date, the calculated period of extension may not exceed five years; and

(D) If the patent involved was issued before November 16, 1988, and the regulatory review period proceeding started before this date, and the commercial marketing or use of the product has been approved after such date, the calculated period of extension may not exceed three years.

The patent term extension of a patent that issued before September 24, 1984, where the regulatory review period began and ended before September 24, 1984, would only be a function of the regulatory review period and the fourteen-year limit, and may be extended for more than five years. *Hoechst Aktiengesellschaft v. Quigg*, 917 F2d 522, 525, 16 USPQ2d 1549, 1551 (Fed. Cir. 1990).

2759 Certificate of Extension of Patent Term [R-11.2013]

35 U.S.C. 156 Extension of patent term.

(e) (1) A determination that a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for the extension. If the Director determines that a patent is eligible for extension under subsection (a) and that the requirements of paragraphs (1) through (4) of subsection (d) have been complied with, the Director shall issue to the applicant for the extension of the term of the patent a certificate of extension, under seal, for the period prescribed by subsection (c). Such certificate shall be recorded in the official file of the patent and shall be considered as part of the original patent.

37 CFR 1.780 Certificate or order of extension of patent term.

If a determination is made pursuant to [§ 1.750](#) that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under [35 U.S.C. 156\(d\)\(5\)](#), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. Notification of the issuance of the order granting an interim extension under [35 U.S.C. 156\(d\)\(5\)](#), including the identity of the product currently under regulatory review, will be published in the *Official Gazette of the United States Patent and Trademark Office* and in the *Federal Register*. No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations, the final determination

made pursuant to [§ 1.750](#) will indicate that no certificate or order will issue.

Once a determination is made pursuant to [37 CFR 1.750](#) that a patent is eligible for extension of its term, a certificate of extension, under seal, will be issued to the patent owner at the correspondence address specified in the application for patent term extension. Following the one-month period provided in the Notice of Final Determination, and where an extension is appropriate, the Certificate of Extension is signed by the Director. The original certificate is mailed or delivered to the applicant and a copy is sent to the regulatory agency. A copy of the certificate is placed in the two files (official file/patent file and public file) maintained for the patent term extension application.

Upon issuance of the certificate of extension, a notice is published in the *Official Gazette*. A sample *Official Gazette* Notice Follows:

PATENT TERM EXTENDED UNDER [35 U.S.C. 156](#)

A Certificate extending the term of the following patent was issued on ___.

U.S. Patent No.: ___ Granted: ___; Applicant: ___; Owner of Record: ___; Title: ___; Classification: ___ Product Trade Name: ___; Original Expiration Date: ___; Term Extended: ___; Extended Expiration Date: ___.

All original papers from the application for patent term extension in the official file are transferred to the official patent file of the subject patent and become a part of the permanent record. A copy of the certificate of extension of patent term is added to the patent electronic database as part of the patent record in the same manner as is a certificate of correction or a terminal disclaimer. The patent is also added to the list of patents extended under [35 U.S.C. 156](#), a copy of which is posted on the USPTO Web site (www.uspto.gov) and which is also available in the “Patent Term Extension (Restoration)” section of the electronic FOIA

Reading Room of USPTO’s Web site at http://www.uspto.gov/ip/boards/foia_m/resources/patents/pte.jsp.

2760 Trade Secret, Confidential, and Protective Order Material [R-8.2012]

There is no provision in the statute or the rules for withholding from the public any information that is submitted to the Office or the regulatory agency relating to an application for patent term extension. While one submitting such materials to the Office in relation to a pending application for patent term extension must generally assume that such materials will be made of record in the file and be made public, the Office is not unmindful of the difficulties this sometimes imposes. Proprietary or trade secret information should be submitted generally in accordance with the procedures set forth in [MPEP § 724.02](#). Identification of the propriety or trade secret material should be made by page, line, and word, as necessary. The Office will not in the first instance undertake the task of determining the precise material in the application which is proprietary or trade secret information. Only the applicant is in a position to make this determination. See *In re Schering-Plough Corp.*, 1 USPQ2d 1926, 1926 (Comm’r Pat. & Tm. 1986).

The information will not be made public as part of the patent file before a certificate of patent extension is issued. Should the Office receive a Freedom of Information Act (FOIA) request for the material, the applicant will be provided notice and an opportunity to substantiate its claim that the material is proprietary before the Office determines whether disclosure of the material is required under the FOIA. If such information was material to a determination of eligibility or any other Office responsibility under [35 U.S.C. 156](#), it will be made public at the time the certificate of extension is issued. Otherwise, if a suitable petition to expunge is filed before the issuance of the certificate, the trade secret or confidential information will be expunged from the file and returned to the patent term extension applicant. If a petition to expunge is not filed prior to the issuance of the certificate, all of the information will be open to public inspection.

2761 Multiple Applications for Extension of Term of the Same Patent or of Different

Patents for the Same Regulatory Review Period for a Product [R-08.2012]

35 U.S.C. 156 Extension of patent term.

(c)(4) in no event shall more than one patent be extended under subsection (e)(i) for the same regulatory review period for any product.

37 CFR 1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.

(a) Only one patent may be extended for a regulatory review period for any product [§ 1.720\(h\)](#). If more than one application for extension of the same patent is filed, the certificate of extension of patent term, if appropriate, will be issued based upon the first filed application for extension.

(b) If more than one application for extension is filed by a single applicant which seeks the extension of the term of two or more patents based upon the same regulatory review period, and the patents are otherwise eligible for extension pursuant to the requirements of this subpart, in the absence of an election by the applicant, the certificate of extension of patent term, if appropriate, will be issued upon the application for extension of the patent term having the earliest date of issuance of those patents for which extension is sought.

(c) If an application for extension is filed which seeks the extension of the term of a patent based upon the same regulatory review period as that relied upon in one or more applications for extension pursuant to the requirements of this subpart, the certificate of extension of patent term will be issued on the application only if the patent owner or its agent is the holder of the regulatory approval granted with respect to the regulatory review period.

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such information within the period for reply set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval.

(e) Determinations made under this section shall be included in the notice of final determination of eligibility for extension of the patent term pursuant to [§ 1.750](#) and shall be regarded as part of that determination.

Only one patent may be extended for a regulatory review period for any product. If more than one application for extension is filed for a single patent by different applicants, the certificate of extension of the term of the patent, if appropriate, would be issued based upon the first filed application for extension of patent term. If a single applicant files more than one application for patent term extension for a single patent based upon the regulatory review period of different products, then the final determination under [37 CFR 1.750](#) will provide a period of time (usually one month) for the patent

owner to elect the product for which extension is desired. An express withdrawal of the applications for extension of the nonelected products should accompany the election. The final determination will indicate that if the patent owner fails to elect a single product within the set time period, the Office will issue a certificate of extension for the patent for a specified one of the products.

If more than one application for extension is filed by a single applicant for the extension of the terms of different patents based upon the same regulatory review period for a product, the certificate of extension will be issued on the application for extension of the patent having the earliest date of issuance of those for which extension is sought unless all but one application for extension is voluntarily withdrawn by the applicant. When plural patents are found to be eligible for patent term extension based on the same regulatory review of a product, the final determination under [37 CFR 1.750](#) will provide a period of time (usually one month) for the patent owner to elect the patent for which extension is desired. An express withdrawal of the application(s) for extension of the nonelected patent(s) should accompany the election. A failure to elect within the set time period will result in issuance of a certificate of extension for the patent having the earliest date of issue.

If applications for extension are filed by different applicants for the extension of the terms of different patents based upon the same regulatory review period of a product, the certificate of extension will be issued on the application of the holder of the regulatory approval (marketing applicant). If the marketing applicant is not an applicant for extension, the certificate of extension will issue to the applicant for extension which holds an express authorization from the marketing applicant to rely upon the regulatory review period as the basis for the application for extension. See also [37 CFR 1.785\(d\)](#).

2762 Duty of Disclosure in Patent Term Extension Proceedings [R-08.2012]

37 CFR 1.765 Duty of disclosure in patent term extension proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every

other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding must bring such information to the attention of the Office or the Secretary, as appropriate, in accordance with paragraph (b) of this section, as soon as it is practical to do so after the individual becomes aware of the information. Information is material where there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding.

(b) Disclosures pursuant to this section must be accompanied by a copy of each written document which is being disclosed. The disclosure must be made to the Office or the Secretary, as appropriate, unless the disclosure is material to determinations to be made by both the Office and the Secretary, in which case duplicate copies, certified as such, must be filed in the Office and with the Secretary. Disclosures pursuant to this section may be made to the Office or the Secretary, as appropriate, through an attorney or agent having responsibility on behalf of the patent owner or its agent for the patent term extension proceeding or through a patent owner acting on his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the determination of entitlement to the extension sought.

(c) No patent will be determined eligible for extension and no extension will be issued if it is determined that fraud on the Office or the Secretary was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence in connection with the patent term extension proceeding. If it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office or the Secretary in connection with the patent term extension proceeding or that there was any violation of the duty of disclosure through bad faith or gross negligence in connection with the patent term extension proceeding, a final determination will be made pursuant to [§ 1.750](#) that the patent is not eligible for extension.

A duty of candor and good faith toward the USPTO, the Secretary of Health and Human Services, and the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner, and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding, must bring such information to the attention of the Office or the Secretary, as appropriate, as soon as it is practicable to do so after the individual becomes aware of the information. Information is “material” when there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding. Any such material information should be submitted to the Director of the United States Patent and Trademark Office, the Secretary

of Health and Human Services, or the Secretary of Agriculture, as appropriate, accompanied by a copy of each written document being disclosed. The information may be submitted through a patent attorney or agent.

A determination of eligibility for an extension or the issuance of a certificate will not be made if clear and convincing evidence of fraud or attempted fraud on the Office or a Secretary is determined to be present, or the duty of disclosure is determined to have been violated through bad faith or gross negligence in connection with the patent term extension proceeding. Since the determination as to whether a patent is eligible for extension may be made solely on the basis of the representations made in the application for extension, a final determination to refuse a patent term extension because of fraud or a violation of the duty of disclosure is expected to be rare. See [MPEP § 2010](#).

2763 Limitation of Third Party Participation [R-08.2012]

37 CFR 1.765 Duty of disclosure in patent term extension proceedings.

(d) The duty of disclosure pursuant to this section rests on the individuals identified in paragraph (a) of this section and no submission on behalf of third parties, in the form of protests or otherwise, will be considered by the Office. Any such submissions by third parties to the Office will be returned to the party making the submission, or otherwise disposed of, without consideration by the Office.

Although the statute specifically provides for public input into the determination of the regulatory review period, i.e., the filing of a due diligence petition before the regulatory agency, no such provision was made for proceedings before the Office. Since applicant already has a duty of disclosure to both the Office and the regulatory agency, and Congress expected that it would be an administratively simple proceeding, no input from third parties is permitted. Absent an invitation from the Director, any such submission would be inappropriate. Accordingly, [37 CFR 1.765\(d\)](#) precludes submissions to the Office by or on behalf of third parties, thereby making patent term extension proceedings in the Office an *ex parte* matter between the patent owner or its agent and the Office. Submissions by third parties not requested by the Office will be returned,

or otherwise disposed of, without consideration. See *In re Dubno*, 12 USPQ2d 1153, 1154 (Comm'r Pat. & Tm. 1989).

2764 Express Withdrawal of Application for Extension of Patent Term [R-08.2012]

37 CFR 1.770 Express withdrawal of application for extension of patent term.

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to [§ 1.750](#) by filing in the Office, in duplicate, a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for reply to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the Office does not entitle applicant to a refund of the filing fee ([§ 1.20\(j\)](#)) or any portion thereof.

Any request for withdrawal of an application for extension of patent term after a determination has been made pursuant to [37 CFR 1.750](#) must be submitted on or before the date permitted for reply to the final determination, and be accompanied by a petition under [37 CFR 1.182](#) with the appropriate petition filing fee.