

## U.S. Patent and Trademark Office Decides to Modify Process for Calculating Patent Term Adjustment

January 29, 2010

The United States Patent and Trademark Office (USPTO) recently agreed to modify how Patent Term Adjustment (PTA) is calculated in view of the recent Federal Circuit decision that overturned the way that the USPTO calculated PTA. The USPTO has stated that modifications to its software that calculates PTA are underway and are expected to be completed by March 2, 2010.

In the interim, the USPTO has further stated that it is implementing a means for recalculating PTA for recent patentees. In lieu of filing a petition with the required fee under 37 C.F.R. § 1.705(d), the USPTO will accept a Request for Recalculation without any further fee required. The Request for Recalculation is available only for patents issued before March 2, 2010 and must be filed no later than 180 days after the issue date. The USPTO will only accept the Request for Recalculation for alleged errors specific to the Federal Circuit's decision. For patents issued after March 2, 2010, a request for reconsideration under 37 C.F.R. § 1.705(d) and the accompanying fee will be required within two months of the date that the patent issues.

The USPTO has also advised that for patentees who previously filed a request for reconsideration and are awaiting a decision, those requests will now be considered, based on the Federal Circuit's decision. For patentees that previously filed a request for reconsideration of PTA under 37 C.F.R. § 1.705(d) and received a decision based on the prior methods for calculating PTA, a request for reconsideration of that decision may be filed within two months of the date of the decision. If the basis of requesting reconsideration is solely based on the newly implemented means for calculating PTA, the request need only state that reconsideration is requested in view of the Federal Circuit's decision.

The Request for Recalculation should be kept in mind for recent patentees. The Request is a single-page form that requires no fee by the USPTO and the difference in PTA may be significant.

If you have any questions or would like more information on any of issues discussed in this LawFlash, please contact any of the following Morgan Lewis attorneys:

### Washington, D.C.

Robert (Bob) Smyth

202.739.5139

[rsmyth@morganlewis.com](mailto:rsmyth@morganlewis.com)

### Philadelphia

Louis W. Beardell

215.963.5067

[lbeardell@morganlewis.com](mailto:lbeardell@morganlewis.com)

## San Francisco

Robin M. Silva

415.442.1379

[rsilva@morganlewis.com](mailto:rsilva@morganlewis.com)

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