
US Patent Formalities and their effect on Patent Term

- Patent term adjustment (PTA)
- Information Disclosure Statements (IDS)
- Terminal Disclaimers (TD)

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How to determine the term of a U.S. patent

Why is this date important?

- Length of patent protection
- Maintenance fees for U.S. patents
 - 4y, 8y, 12y after patent is issued
 - Patent can expire before 12y fee is due
- USPTO does not calculate patent expiration date



Patent Term Adjustment (PTA)

- Applications filed before June 8, 1995: 17y from grant
- Switch to 20y from filing date
- Loose total amount of patent term?
- Congress introduced law to grant PTA
 - 20y patent term plus USPTO delays
 - But, minus Applicant delays
 - USPTO has to make rules for how to implement PTA determination



Can you challenge PTA calculation?

- USPTO indicates calculation in PAIR
- Possible to request a correction of PTA
 - Request reconsideration 2 months from issue date (5m of extensions available- 7m from issue date)
- When is USPTO calculation incorrect?
 - Implementation of law: Developments in courts
 - Changes in law (e.g., AIA Technical Corrections Act 2013)
- How often incorrect when PAIR is up-to-date?

Three types of USPTO delays

A delays:

- 14-4-4-4 rule
- Must issue OA/RR/NOA 14 m from filing date or date national stage entry
- Must respond within 4m from applicant's reply to OA
- Must respond within 4m from decision of appeal board
- Must issue patent within 4m from when issue fee was paid
- Patentee is awarded 1 extra day of patent term

B delays:

- 3y rule
- Patent term is extended if it issues more than 3 y from filing date or national stage entry
- Not including time during continued examination (RCE)
- Patentee is awarded 1 extra day of patent term for each day of delay

C delays:

- Delays from interferences, successful appeals, secrecy orders

Days PTA =

A delay + B delay + C delay - overlapping delay – Applicant delay

* Applicant delay will not reduce “20 year term”

Applicant delay

- PTA reduced by the number of days the applicant failed to engage in reasonable efforts to conclude prosecution
 - Filing response later than 3m
 - Filing a supplemental reply
 - Information disclosure statement (IDS)

Duty of disclosure

- Applicant (and associated individuals) has obligation to disclose material references to the USPTO
- Issue that arises during litigation
- Inequitable conduct (“not playing fair”)
- Patent is unenforceable

What needs to be filed?

- Created by the courts: Information material to patentability
- USPTO rules and guidelines
- Information material to patentability
 - Art cited in search reports/OA from corresponding foreign application
 - Art cited in in related application US OAs (CON, DIV)
 - Art mentioned in application?
 - Art from non-related applications (similar subject-matter, same inventor)?

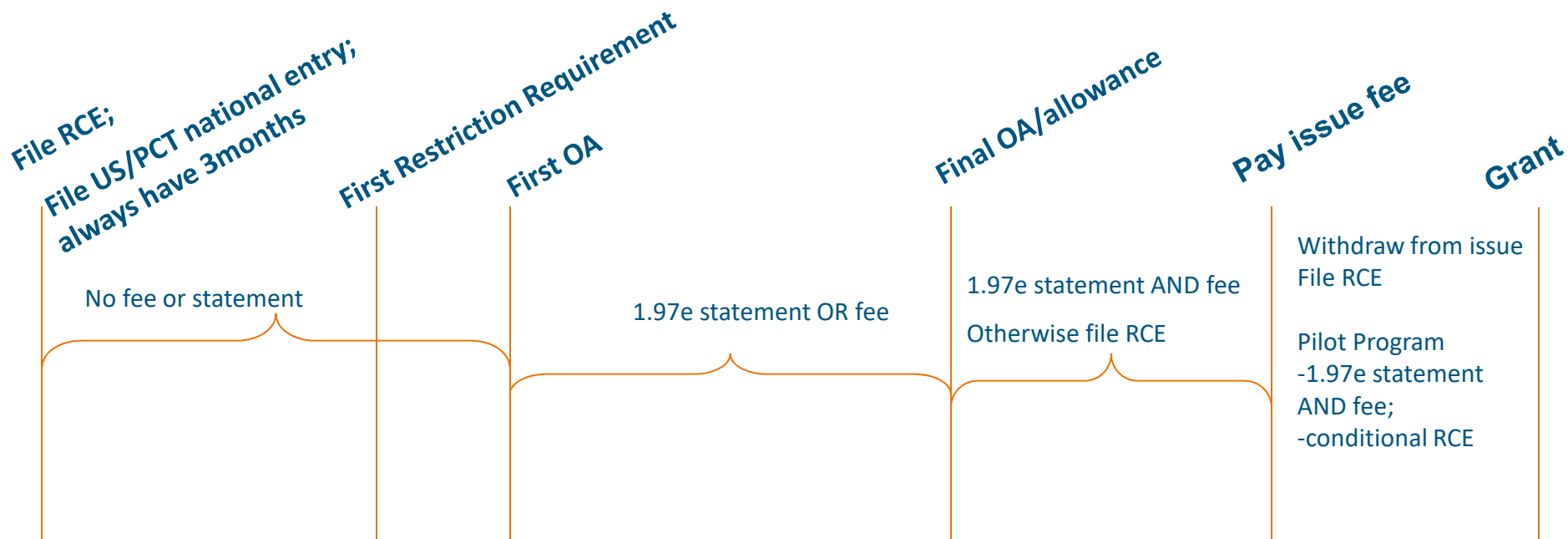
How does art need to be filed?

- Information Disclosure Statement
- Examiner initials and art is “considered”

- Art described in application: not sufficient
- Art cited in related US application (same examiner): not sufficient



When does art need to be filed? - 4 “windows”

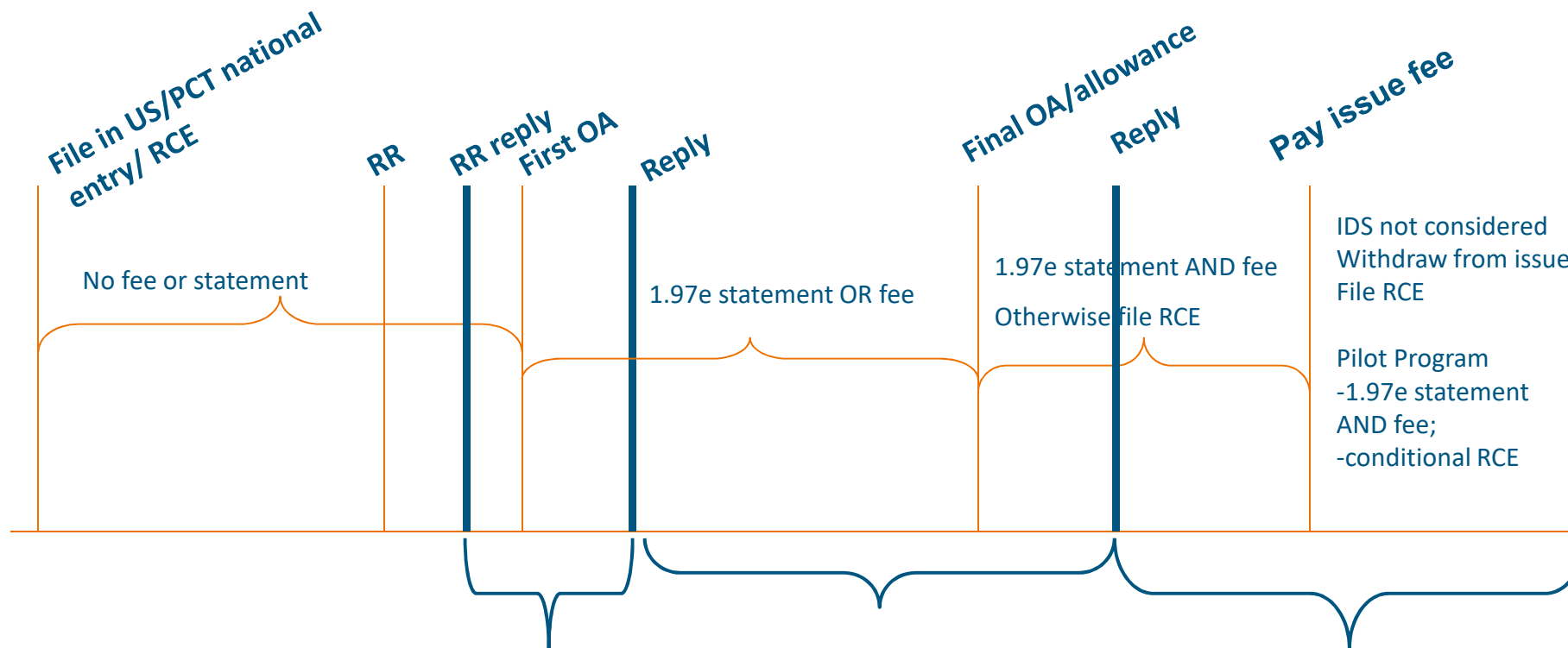


1.97e statement:

- art not known (prior to last 3 months)
- art cited in foreign OA in the last 3 months



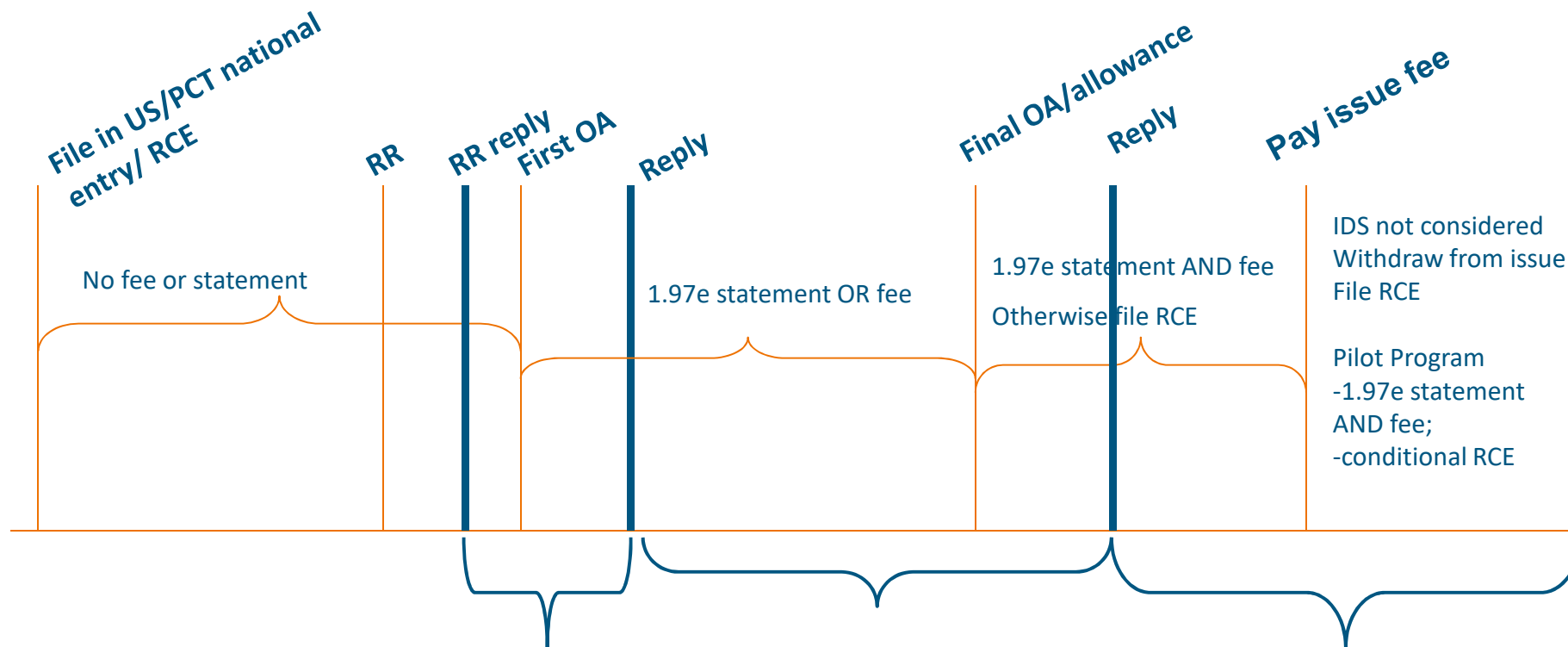
How does IDS submission affect PTA?



Loose PTA if filed as “supplemental reply”



How does IDS submission affect PTA?



Loose PTA if filed after a reply, unless 37 C.F.R. § 1.704(d) statement

- Art was cited in OA/search report from foreign or US counterpart application and
- Must file submit art in IDS not later than 30d from when an individual associated with the filing or prosecution of the U.S. patent application received the communication



(12) **United States Patent**
Donaldson et al.

(10) **Patent No.:** **US 7,993,889 B1**
(45) **Date of Patent:** ***Aug. 9, 2011**

(54) **FERMENTIVE PRODUCTION OF FOUR
CARBON ALCOHOLS**

(75) Inventors: **Gail K. Donaldson**, Newark, DE (US);
Andrew C. Eliot, Wilmington, DE (US);
Dennis Flint, Newark, DE (US); **Lori**
Ann Maggio-Hall, Wilmington, DE
(US); **Vasantha Nagarajan**,
Wilmington, DE (US)

(73) Assignee: **Butamax(TM) Advanced Biofuels**
LLC, Wilmington, DE (US)

(*) Notice: Subject to any disclaimer, the term of this
patent is extended or adjusted under 35
U.S.C. 154(b) by 852 days.

This patent is subject to a terminal dis-
claimer.

(21) Appl. No.: **12/018,216**

(22) Filed: **Jan. 23, 2008**

Related U.S. Application Data

(62) Division of application No. 11/586,315, filed on Oct.
25, 2006, now Pat. No. 7,851,188.

(60) Provisional application No. 60/730,290, filed on Oct.
26, 2005.

What is the patent expiration date?

A. Oct. 26, 2025

B. Oct. 26, 2025 plus 852 days

C. Oct. 25, 2026

D. Oct. 25, 2026 plus 852 days

E. Jan. 23, 2028

F. Jan. 23, 2028 plus 852 days

G. No idea....

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Terminal Disclaimer

- “Fix” for a “obviousness-type” double patenting rejection
- Old system of patent term: 17y from grant
 - Filed application on A and AB in 1990
 - Invention A: grants in 1993; 17y term is 2010
 - Invention AB (CON): grants in 1997; 17y term is 2014
- Courts: Not fair!
- Allowed patents on both, but...
 - Later application can't have longer patent term
 - Both patents commonly enforced (same owner)
- Terminal Disclaimer: form that “disclaims” longer patent term and agrees to common ownership



Terminal Disclaimer

- Office Action in “AB” application
 - Obviousness-type double patent rejection over patent “A”
- Terminal Disclaimer: USPTO form that “disclaims” patent term over patent “A” and agrees to common ownership

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- Which patent?
- What is the patent term of patent?

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Assume: TD over divisional; no PTA

Oct. 25, 2026

Patent term

- Is it a 17y or 20y term? (filed after 8 June 1995)
- What is the 20y term? (first non-provisional U.S. application)
- Is there PTA?
- Is there a terminal disclaimer?
 - Over which patent?
 - What is the patent term for the other patent?
- New law in China
- USMCA (new NAFTA): CA and MX

Thank you!

