

Coding Error Impacting USPTO Patent Term Adjustment Software

Summary

The United States Patent and Trademark Office (USPTO) has discovered that a recent update to USPTO software introduced a coding error into the patent term adjustment software that the USPTO uses to perform patent term adjustment (PTA) determinations. This error impacted certain patents that issued from March 19, 2024, through July 30, 2024, and may have caused an incorrect calculation of the delay under 35 U.S.C. 154(b)(1)(A) (“A” delay) and the amount of overlap under 35 U.S.C. 154(b)(2)(A) (“Overlap”). The other PTA calculations under 35 U.S.C. 154(b) were not impacted by this error. The USPTO has identified the source of this error and corrected the computer program. Patentees seeking a revised PTA determination based on this error must submit a timely request for reconsideration of the PTA indicated in the patent under 37 CFR 1.705(b).

Background

The American Inventors Protection Act of 1999 or AIPA (Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999)) amended 35 U.S.C. 154(b) to provide for patent term adjustment in the event that the issuance of the patent is delayed due to one or more of the enumerated administrative delays listed in 35 U.S.C. 154(b)(1). Under the patent term adjustment provisions of the AIPA, a patentee generally is entitled to patent term adjustment for the following reasons: (1) if the USPTO fails to take certain actions during the examination and issue process within specified time frames (35 U.S.C. 154(b)(1)(A)) (“A” delay); (2) if the USPTO fails to issue a patent within three years of the actual filing date of the application (35 U.S.C. 154(b)(1)(B)) (“B” delay); and (3) for delays due to interference or derivation proceedings, secrecy orders, or successful appellate review (35 U.S.C. 154(b)(1)(C)) (“C” delay). See 35 U.S.C. 154(b)(1). The AIPA, however, sets forth a number of conditions and limitations on any patent term adjustment accrued under 35 U.S.C. 154(b)(1). Specifically, 35 U.S.C. 154(b)(2)(A) provides, “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.” The USPTO implemented the patent term adjustment provisions of the AIPA in a final rule published in September of 2000. See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 Fed. Reg. 56365 (Sept. 18, 2000) (final rule).

The USPTO performs an automated calculation of how much patent term adjustment, if any, is due to a patentee using the information recorded in the USPTO's One Patent Service Gateway (OPSG) system. See 65 Fed. Reg. at 56380-81. The AIA Technical Corrections Act was enacted on January 14, 2013. See Pub. L. 112-274, 126 Stat. 2456 (2013). Section 1(h) of the AIA Technical Corrections Act revised the patent term adjustment provisions of 35 U.S.C. 154(b). 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.”

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The USPTO has estimated that approximately 1% of patents issued from March 19, 2024, through July 30, 2024, may have been impacted by the coding error. Impacted patentees may file a request for reconsideration of the PTA determination as set forth in 37 CFR 1.705(b). The request for reconsideration must be filed no later than two months from the date the patent was granted. The two-month period may be extended under the provisions of 37 CFR 1.136(a). Where the sole reason for contesting the PTA determination in this patent is a calculation error in the amount of “A” delay and “Overlap”, the USPTO will waive the fee to file the request for reconsideration under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) as well as any extension of time fees under 37 CFR 1.136(a). See 37 CFR 1.183. **Accordingly, any request for reconsideration where the sole reason for contesting the PTA determination in this patent is a calculation error in the amount of “A” delay and “Overlap” can be filed without a fee within seven months of the date the patent was granted.** The USPTO will not consider any untimely filed request for reconsideration of the patent term adjustment nor will the USPTO grant any petition under 37 CFR 1.182 or 1.183 to extend such deadline. Patentee should mention this notice when seeking waiver of the fees and may consider authorizing fees to be charged to a deposit account if the waiver is not applicable.

If the request for reconsideration is not based solely on the USPTO's computer error related to the calculation of “A” delay and “Overlap,” the patentee must file a request for reconsideration of the patent term adjustment indicated on the patent under 37 CFR 1.705(b) with the fee set forth in 37 CFR 1.18(e) and any extension of time fees necessary.

In addition, it is noted that the fee specified in 37 CFR 1.18(e) is required for a request for reconsideration under 37 CFR 1.705(b), and the USPTO may only refund fees paid by mistake or in excess of that required (35 U.S.C. 42(d)). Thus, the waiver set forth in this document is not a basis for requesting a refund of the fee paid in accordance with 37 CFR 1.18(e) for any request for reconsideration under 37 CFR 1.705 or the extension fees under 37 CFR 1.136, including any previously filed request that was solely based on the USPTO's error in not properly calculating the “A” delay and “Overlap.”

The Office of Petitions will manually review the request for reconsideration of the patent term adjustment filed under 37 CFR 1.705(b). Specifically, the Office of Petitions will review the accuracy of the patent term adjustment calculation in view of regulations 37 CFR 1.702 through

1.704 as part of the recalculation. The results of the review will proceed as outlined in MPEP § 2734.

This notice is intended to provide notification of the recent coding error that impacted patent term adjustment software and the relief available, and is NOT a notice of the Director's determination of the period of patent term adjustment under 35 U.S.C. 154(b)(3)(B) for any patent, including any patents impacted by the coding error.

Contact information

Any inquiries concerning this notice may be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patents, by telephone at (571) 272-7757, or Fenn Mathew, Acting Director, Office of Petitions, by telephone at (571) 272-4978, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Director of the United States Patent and Trademark Office