On June 16, 2020, the U.S. Patent and Trademark Office (USPTO) released final rules (the “Rules”) implementing changes to how Patent Term Adjustment (PTA) is calculated in certain circumstances in view of *Supernus Pharms., Inc. v. Iancu, 913 F.3d 1351 (Fed. Cir. 2019)*. In *Supernus*, a PTA deduction was considered for the filing of an Information Disclosure Statement (IDS) disclosing a European opposition 646 days after the filing of a Request for Continued Examination. The IDS was filed 100 days after receiving notification from the European Patent Office (EPO). The Federal Court held that the USPTO cannot charge a PTA deduction for the 546 days during which time the applicant was unaware of the European opposition. A review of the case can be found [here](#).

The Rules embody this holding in *Supernus* that the USPTO cannot charge a PTA deduction for applicant delay during a time period when applicant could have done nothing to advance prosecution and include five sections related to PTA calculations.
that apply to cases filed on or after May 29, 2020 in which a Notice of Allowance is mailed on or after July 16, 2020:

(1) **Deferral of issuance under 37 CFR § 1.704(c)(2)**. In this rule change, the time period between a deferral of issuance request and a termination of such a request by the applicant is removed from PTA deductions.

From:

“the period of adjustment ... 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**”

To:

“...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 earlier of the date a request to terminate the deferral was filed or the date the patent was issued.**”

(2) **Abandonment of an application under 37 CFR § 1.704(c)(3)**. This rule change takes into consideration that after the petition to revive the application is filed, no further action can be taken by the applicant.

From:

“the period of adjustment...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.**”

To:

“...ending on the date the grantable petition to revive the application or accept late payment of the issue fee was filed.

(3) **Filing of a preliminary amendment under 37 CFR § 1.704(c)(6)**. This change corresponds to the 37 CFR § 1.704(c)(13) eight-month time period for an application to be placed in condition for examination. Notably, PTA deductions are still only applicable if the preliminary amendment is filed less than 1 month before an Office Action and requires a supplemental Office Action.

From:

“the period of adjustment...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.”
To:

“...the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the preliminary amendment or other preliminary paper was filed.”

(4) Submission after a Patent Trial and Appeal Board (PTAB) or Federal court decision under 37 CFR § 1.704(c)(9). This rule change takes into consideration that no action can be taken by the applicant during the time period when which a decision by the Patent Trial and Appeal Board or a Federal court remains pending.

From:

“the period of adjustment...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.”

To:

“...the number of days, if any, beginning on the day after the date of the decision by the Patent Trial and Appeal Board or by a Federal court and ending on the date the amendment or other paper was filed.”

(5) Submission after a Notice of Allowance under 37 CFR § 1.704(c)(10). This rule change removes PTA deductions from the time period during which an applicant is waiting for a response and is unable to take an action to end prosecution. The rule is also further amended to clarify that PTA deductions are not applicable if the amendment under § 1.312 is expressed requested by the USPTO and such amendment is filed within three months from the notice requesting such filing. Notably, an IDS with a Request for Continued Examination will not affect PTA when filed with a statement in compliance with 37 CFR § 1.704(d).

From:

“the period of adjustment...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.”

To:

“the number of days, if any, beginning on the day after the date of mailing of the Notice of Allowance under 35 U.S.C. 151 and ending on the date the amendment under §1.312 or other paper was filed.”

Each of these rule changes is consistent with the notion that PTA deductions should not be inclusive of the time period during which no action could be taken by the applicant. That is, any filing that could not have been filed earlier should no longer be considered a failure to engage in reasonable efforts to conclude prosecution. It
seems the burden will now be on the USPTO to show that an applicant could have avoided a delay with reasonable efforts. Although the final rules may not change prosecution practice since there is always a duty to be vigilant in regards to timing of filings, the changes do provide an acknowledgement of the prosecution process and makes PTA calculations more reasonable by considering that some aspects of prosecution are truly out of an applicant’s control.

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