

Assessing the USPTO System for Calculating AIPA Patent Term Adjustment

PatentTerm Online, LLC
Fairfax, Virginia

Opinions expressed are solely those of the author and are not legal advice.

©2004 James Longfellow

October 14, 2004

Session Outline



- Basics of AIPA Patent Term Adjustment (PTA)
 - Applicability and statistics
 - Overview of PTO system for calculating PTA
 - Audit, correction, and third-party challenge; other legal implications of improper PTA
- Introduction to Calculating AIPA Patent Term
 - Basic algorithm
 - Common PTA rules
 - Example calculation
- Assessment of USPTO System for Calculating PTA
 - Audit results
 - Common errors
- Getting more information on PTA calculation

©2004 James Longfellow

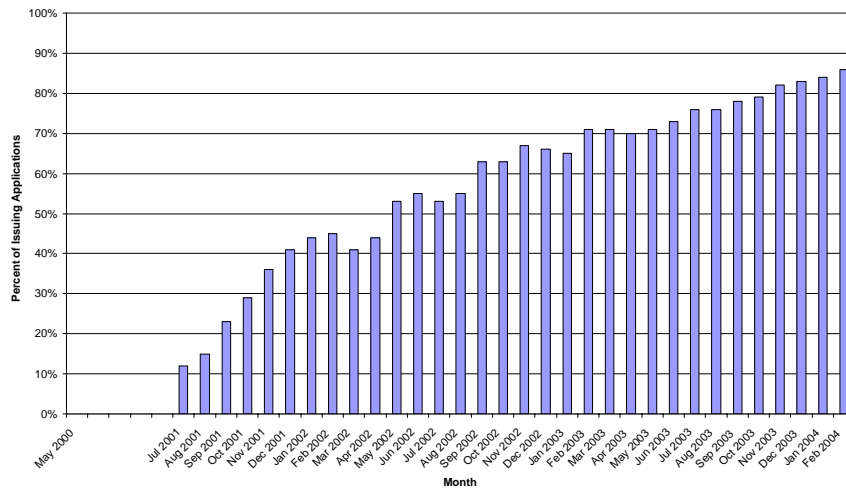
AIPA PTA Applicability

- Original applications filed on or after May 29, 2000
 - CPA is a new application (but no PTA for pendency of ancestral application)
 - RCE is not a new application
 - PCT is PTA-eligible starting at commencement of national stage, but only if international filing date is on or after May 29, 2000
- Applies to utility and plant applications; not design applications
- Does not apply to reissues or reexaminations

©2004 James Longfellow

For many practitioners, the first impression was the PTA rarely applied ...

Applications Subject to AIPA PTA by Issuing Month
(source: sample of applications from USPTO PAIR system)

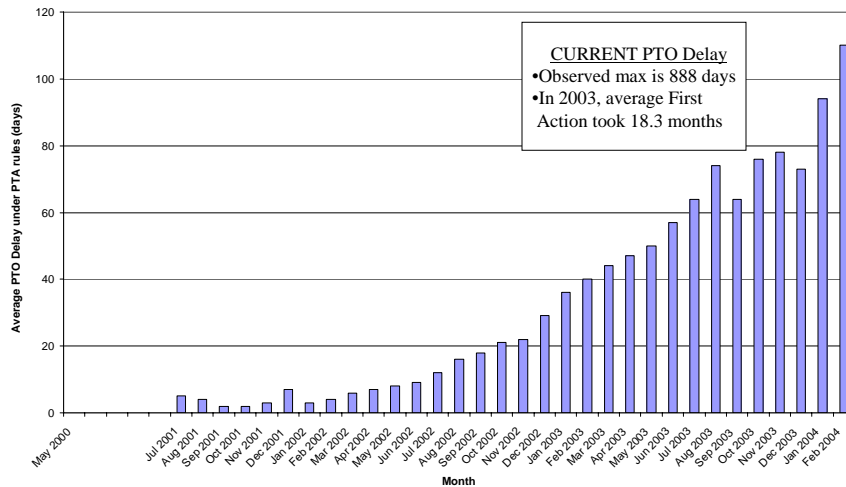


©2004 James Longfellow

And was generally inconsequential

Average PTO Delay under PTA rules by Issuing Month

(source: sample of applications subject to AIPA PTA from USPTO PAIR system)



©2004 James Longfellow

PTO PTA is calculated by PALM

- PTO relies on an automated computer program analyzing data stored in its Patent Application Location and Monitoring (PALM) system
- Initial determination is provided with Notice of Allowance
- Final determination is provided on printed patent (considers post-allowance activity)
- Some calculation details are available to applicant via the Patent Application Information Retrieval (PAIR) system

©2004 James Longfellow

Applicant has a limited opportunity to seek correction

- Correction of PTO's initial PTA determination:
 - Application for Patent Term Adjustment must be made after allowance but before payment of issue fee
- Correction of PTO's final PTA determination:
 - If issued patent indicates, or should have indicated, a revised PTA, an Application for Patent Term Adjustment must be filed within two months of the issue date
 - You cannot raise issues that were raised, or could have been raised, prior to issue fee payment
- Before allowance, applicant can seek correction of PALM / PAIR data*
- What if PTO-calculated PTA is too great?

*Contact the Customer Service Representative for the Technology Center (TC) where application is assigned

©2004 James Longfellow

Third-Party Challenges

- Third-parties cannot challenge PTA prior to issuance
- After issuance, PTA can be challenged in an infringement or DJ action:
 - Determination of correct patent expiration date
 - Allegation that patent is unenforceable because of inequitable conduct
- PTA can be raised in conjunction with an Abbreviated New Drug Application:
 - ANDA Applicant may dispute the patent expiration date listed in the Orange Book pursuant to 21 CFR 314.53(f)
 - If expiration date is not corrected, ANDA applicant may institute a DJ action with respect to the patent, or could file a paragraph IV certification arguing that because the PTA is incorrect, the patent is unenforceable
 - See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 FR 56366, 56390 (Sept. 18, 2000).
- Other legal implications—antitrust, corporate asset suits, and practitioner malpractice

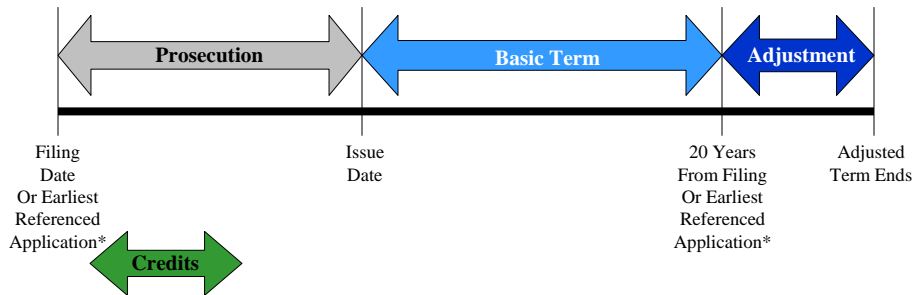
©2004 James Longfellow

Session Outline

- Basics of AIPA Patent Term Adjustment (PTA)
 - Applicability and statistics
 - Overview of PTO system for calculating PTA
 - Audit, correction, and third-party challenge; other legal implications of improper PTA
- ➔ • Introduction to Calculating AIPA Patent Term
 - Basic algorithm
 - Common PTA rules
 - Example calculation
- Assessment of USPTO System for Calculating PTA
 - Audit results
 - Common errors
- Getting more information on PTA calculation

©2004 James Longfellow

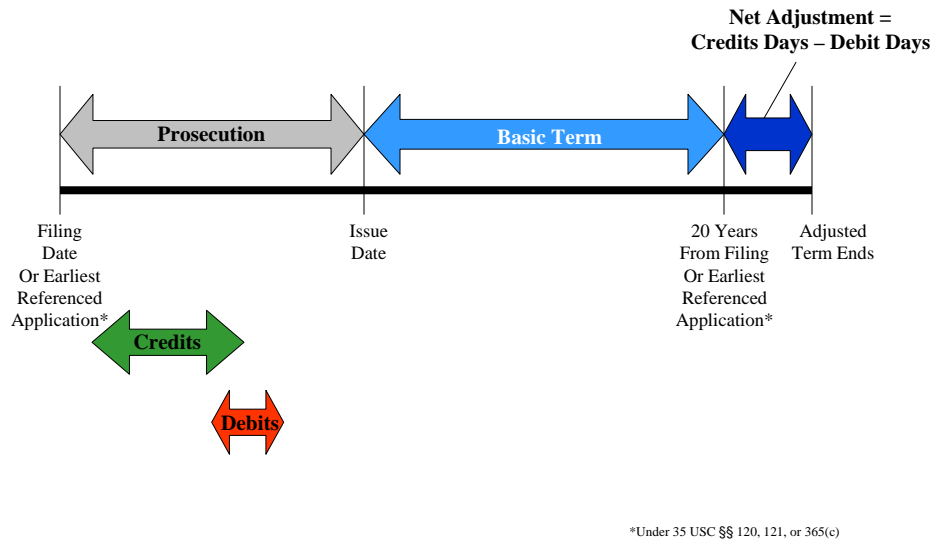
Basic AIPA Patent Term



*Under 35 USC §§ 120, 121, or 365(c)

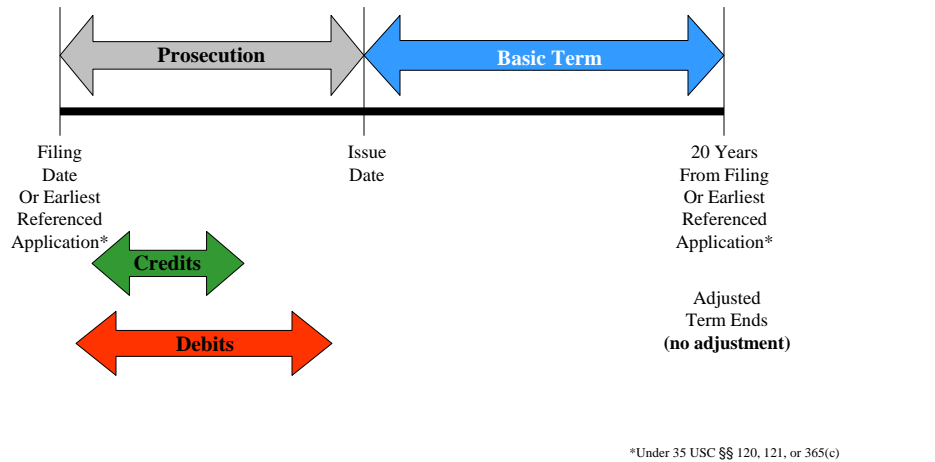
©2004 James Longfellow

Basic AIPA Patent Term



©2004 James Longfellow

Basic AIPA Patent Term



©2004 James Longfellow

Summary of Basic AIPA Patent Term

- Term is 20 years from:
 - Filing date; or
 - Earliest referenced application under 35 USC §§ 120, 121, or 365(c)
- Day-by-day adjustments:
 - PTO delays, “No-fault” delays → Adjustment **Credits**
 - Do not count credit overlap days
 - Special “actual delay” limitation now applies for the 3-Year Issue guarantee overlap
 - Applicant delays → Adjustment **Debits**
 - Do not count debit overlap days
 - Final PTA is **Credits** minus **Debits**
 - No negative adjustment
- **Credits** and **Debits** are determined by PTA rules

©2004 James Longfellow

PTA Rules Summary

| PTO Deadlines (37 CFR § 1.702) → Credits | |
|--|---|
| <ul style="list-style-type: none"> ▪ 3 Year Issue (not including “exclusions”) ▪ 14 Month First Action ▪ 4 Month Response to Reply | <ul style="list-style-type: none"> ▪ 4 Month Issue after Requirements Satisfied ▪ 4 Month Response to Appeal Brief ▪ 4 Month Response to Appellate Decision |
| Applicant Requirements/Deadlines (37 CFR § 1.704) → Debits | |
| <ul style="list-style-type: none"> ▪ 3 Month Response to Notice or Action ▪ (1) Suspension at Applicant’s Request ▪ (2) Deferral of Issuance ▪ (3) Abandonment ▪ (4) 2 Months to Petition—Abandonment ▪ (5) Conversion of Provisional ▪ (6) Preliminary Amendment or Other Paper | <ul style="list-style-type: none"> ▪ (7) Reply having omission ▪ (8) Supplemental Reply/Other Paper ▪ (9) Amendment/Other Paper after Appeal ▪ (10) Amendment/Other Paper after Allowance ▪ “Failure to Engage” Myriad |
| Exclusionary Rules (37 CFR § 1.702) → Exclusions and Credits | |
| Exclusions (from 3-Year Issue Requirement) | Corresponding Credits |
| <ul style="list-style-type: none"> ▪ Interference ▪ Secrecy Order ▪ Appeal ▪ RCE ▪ Delay Requested by Applicant | <ul style="list-style-type: none"> ▪ Interference ▪ Secrecy Order ▪ <u>Winning</u> Appeal |

©2004 James Longfellow

Most Fundamental PTA Rules

- PTO 14-4-4-4 deadlines generate **credits**:
 - PTO must mail a section 132 action within 14 months from filing
 - PTO must respond a reply to a section 132 action within 4 months
 - PTO must issue patent within 4 months after issue fee paid and all requirements satisfied
 - PTO must respond to appeal brief and appellate decision within 4 months

- Applicant 3-month deadline generates **debits**:
 - Applicant must respond to any PTO request within 3 months (where response is required)
 - 3-month deadline applies independent of reply period
 - No extensions for weekends or holidays
 - Effective response date is PTO date stamp or express mail date
 - Deadline is extendable for additional 3 months for good cause (e.g., natural disaster, illness or death of sole practitioner, test data required for response)

©2004 James Longfellow


Simple PTA Calculation

| Line Item | Date | Event Description | Rule Invoked | Responsive Event | Debit Days | Credit Days |
|----------------------|------------|---------------------------|--|--------------------------------|------------|-------------|
| 1 | 06/29/2000 | Filing Date | 14-Month First PTO Action | 11/07/2001 Office Action | | 70 |
| | | | 3-Year PTO Issue Requirement | 08/13/2002 Issue Date | | |
| 2 | 11/07/2001 | Non-final Office Action | 3-Month Applicant Response to Notice or Action | 02/28/2002 Reply | 21 | |
| 3 | 02/28/2002 | Reply to Non-final Action | 4-Month PTO Response to Reply | 03/21/2002 Allowance | | |
| | | | Supplemental Reply (IDS) | 03/12/2002 IDS | 12 | |
| 4 | 03/12/2002 | IDS * | | | | |
| 5 | 03/21/2002 | Notice of Allowance | 3-Month Applicant Response to Notice or Action | 6/21/2002 Issue Fee Payment | | |
| 6 | 6/21/2002 | Issue Fee Payment | 4 Month PTO Issue of Patent | 08/13/2002 Issue Date | | |
| 7 | 08/13/2002 | Issue Date | | | | |
| Total ... | | | | | 33 | 70 |
| Final PTA ... | | | | | | 37 |

©2004 James Longfellow

*Without Statement under Rule 1.704(d)

Session Outline

- Basics of AIPA Patent Term Adjustment (PTA)
 - Applicability and statistics
 - Overview of PTO system for calculating PTA
 - Audit, correction, and third-party challenge; other legal implications of improper PTA
- Introduction to Calculating AIPA Patent Term
 - Basic algorithm
 - Common PTA rules
 - Example calculation
-  • Assessment of USPTO System for Calculating PTA
 - Audit results
 - Common errors
- Getting more information on PTA calculation

©2004 James Longfellow

Audit Methodology

- Randomly selected 50 U.S. national applications subject to AIPA PTA, issuing from August to early November 2003, subject to:
 - to increase the likelihood of prosecution activity affecting PTA, we selected applications having a longer than average pendency of 36 to 40 months; and
 - to ensure potentially significant commercial value, we selected only applications assigned to a top 50 pharmaceutical company
- Reviewed all publicly available data:
 - File Contents and Patent Term Adjustment screens from PAIR
 - actual paper file wrapper
- Performed a complete independent PTA calculation computing credits, debits, and the final PTA

©2004 James Longfellow

Audit Result Summary

- In 42% of the cases, the final PTA was wrong. Error range was:
 - 319 days (too little PTA)
 - +177 days (too much PTA)
- In another 46% of the cases, either the credits or debits were incorrectly calculated, but final PTA was zero despite the errors
- In 2 cases, applicant filed application for correction
- Remember, we audited applications having 36 – 40 month pendencies. Shorter pendencies will have fewer errors. Longer pendencies will have more errors of greater magnitude.
- See article handout for audit details

©2004 James Longfellow

What went wrong?

- Death by a thousand paper cuts:
 - In one case, drawings filed after allowance did not generate a required PTA reduction. But in another case, a phantom drawing (it wasn't actually filed) did generate a reduction.
 - In one case, the PTO required itself to respond within 4 months to a response to a notice to comply with sequence listings, generating an improperly large PTA. In other cases, however, the PTO did not require itself to respond within 4-months to an office action response, reducing the proper PTA.
 - IDS's filed after office action responses did not typically generate proper reductions, nor did various other papers (such as a request for refund) filed after allowance.
 - Rules requiring a 3-month applicant response to a final rejection, and a 4-month PTO response thereto, were misapplied or missing in many cases, as well as the rule for 3-year pendency guarantee.
- Generally, errors stemmed from the rules being misapplied, rules not being applied where required, or PALM data errors where papers had the incorrect dates, improper classifications, or were missing altogether.

©2004 James Longfellow

Effect of 1.703(f) Revision (“Actual Delay” Limitation) on Audit

| | Original Audit | Identical Prosecution Histories under Revised 37 CFR 1.703(f) |
|--|---------------------|---|
| Percent of cases where final USPTO-calculated PTA was incorrect | 42% | 26% |
| Percent of cases where USPTO calculation had errors, but those errors did not affect the final PTA | 46% | 44% |
| Total Errors | 107 | 88 |
| Largest PTA Deficit (i.e., too little PTA granted) | 319 days (1) | 317 days (1) |
| Largest PTA Overage (i.e., too much PTA granted) | 177 days | 193 days |
| Number of cases where USPTO-calculated PTA was too great | 6 cases | 8 cases |
| Number of cases where USPTO-calculated PTA was too small | 15 cases | 5 cases |
| Number of cases where applicant is entitled to PTA under the 3-Year Issue Guarantee | 29 cases | 10 cases |
| Number of cases where USPTO granted PTA under the 3-Year Issue Guarantee | None | None |

(1) Applications for PTA correction were filed and granted in US Patent Nos. 6,617,340 and 6,610,708.

©2004 James Longfellow

Session Outline

- Basics of AIPA Patent Term Adjustment (PTA)
 - Applicability and statistics
 - Overview of PTO system for calculating PTA
 - Audit, correction, and third-party challenge; other legal implications of improper PTA
- Introduction to Calculating AIPA Patent Term
 - Basic algorithm
 - Common PTA rules
 - Example calculation
- Assessment of USPTO System for Calculating PTA
 - Audit results
 - Common errors
- ➔ • Getting more information on PTA calculation

©2004 James Longfellow

Getting More Information and Assistance on Calculating PTA

- www.PatentTerm.com — online service to assist in calculating AIPA patent term adjustment
- Free one-day training workshop in San Diego on Friday, October 15th
 - detailed training on performing computerized PTA audit calculations
 - for further details, or to register, visit www.PatentTerm.com/training
 - Patent Resources Group, Inc. offers various courses relating to AIPA patent term adjustment
- Contact the presenter at jlongfellow@patentterm.com

©2004 James Longfellow

Questions

©2004 James Longfellow

Assessing the PTO System for Calculating AIPA Patent Term Adjustment

BY JAMES P. LONGFELLOW AND IRVING KAYTON¹

The authors are Directors of PatentTerm Online, LLC, an online service to assist practitioners in independently calculating AIPA patent terms. The service is accessible at www.PatentTerm.com. Opinions expressed are solely those of the authors and are not legal advice.

SUMMARY

To assess the effectiveness of the PTO system for calculating AIPA patent term adjustment (PTA), the authors carefully audited 50 recent patents, randomly selected subject to the criteria that each is assigned to a top 50 pharmaceutical firm and has a pendency of at least 36 months.

Our results indicate that practitioners should be extremely wary of relying exclusively on the PTO-calculated PTA. In 42% of the audited cases, the PTA was incorrectly calculated, with an error range of -319 days (too little PTA) to +177 days (too much PTA). In addition, another 46% of the cases had calculation errors, but those errors did not affect the final PTA (since the final PTA was zero). In only two cases did the applicant seek correction of an erroneous PTA.

OVERVIEW OF AIPA PTA CALCULATIONS

On May 29, 2000, the Patent Term Guarantee provisions of the American Inventor's Protection Act of 1999 (AIPA) became effective², correcting several perceived inequities in the twenty-year-from-filing patent term provided under the Uruguay Round Agreements Act (URAA)³.

Specifically, AIPA provides patent term adjustment to compensate for certain term losses that are not the fault of the applicant such as various PTO prosecution delays, interference proceedings, and successful appeals⁴. Additionally, AIPA guarantees that diligent applicants will always receive at least the same 17-year term as provided under the pre-GATT patent law⁵. For non-

diligent applicants, PTA is reduced in accordance with an intricate set of PTO regulations⁶.

Of course, all term guarantees provided by AIPA depend entirely on an accurate PTA determination. Since the laws and regulations implementing PTA are complex, both in substance and especially in application, this determination is not a straightforward proposition.

Primary responsibility for calculating PTA falls to the PTO, with oversight responsibility to the applicant. To fulfill its responsibility, the PTO relies on an automated computer program analyzing the prosecution history data stored in its Patent Application Location and Monitoring (PALM) system. Via this system, an initial PTA calculation is provided to the applicant with the notice of allowance. Thereafter, a final determination, including consideration of post-allowance activity, is provided with the issue notification⁷.

Upon receiving the initial PTA determination, the applicant typically has just one opportunity⁸ to challenge the PTO-calculated PTA during the window from issuance of the notice of allowance to payment of the issue fee. Third parties cannot challenge PTA prior to issuance, but can raise the issue in an infringement or declaratory judgment action, or in conjunction with an Abbreviated New Drug Application (ANDA)⁹.

METHODOLOGY

To assess the accuracy of the PTO system for calculating PTA, we randomly selected 50 U.S. national applications¹⁰ subject to AIPA patent term adjustment, issuing from August to early November 2003, subject to the following criteria¹¹:

- (1) to increase the likelihood of prosecution activity affecting PTA, we selected applications having a longer than average pendency¹² of 36 to 40 months; and
- (2) to ensure potentially significant commercial value, we selected only applications assigned to a top 50 pharmaceutical company¹³.

For each application, we reviewed the publicly available File Contents and Patent Term Adjustment screens from the Patent Application Information Retrieval (PAIR) system, as well as the actual paper file wrapper for verification. Based on this information, we performed a complete independent PTA calculation, computing both the positive adjustment (for PTO delays and other no-fault delays) and reductions (for dilatory applicant behavior), as well as the final PTA.

RESULTS

Of the 50 patents, we found that 88% had at least one PTA calculation error¹⁴, with one case having as many as 6 mistakes¹⁵. Somewhat analogous to death by a thousand paper cuts, numerous diverse and fact specific issues contributed, so a succinct and complete explanation of exactly what went wrong is difficult to present, but was precisely determined. To illustrate:

- In one case¹⁶, drawings filed after allowance did not generate a required PTA reduction. But in another case¹⁷, a phantom drawing (it wasn't actually filed) did generate a reduction.
- In one case¹⁸, the PTO required itself to respond within 4 months to a response to a notice to comply with sequence listing requirements, generating an improperly large PTA. In other cases¹⁹, however, the PTO did not require itself to respond within 4-months to an office action response, reducing the proper PTA.
- Information Disclosure Statements filed after office action responses did not typically generate proper reductions²⁰, nor did various other papers (such as a request for refund) filed after allowance²¹.
- Rules requiring a 3-month applicant response to a final rejection, and a 4-month PTO response thereto, were misapplied or missing in many cases²², as well as the rule for 3-year pendency guarantee²³.
- And so on and so forth.

Generally, all PTA calculation errors stemmed from the rules being misapplied, rules not being applied where required, or PALM data errors where papers had the incorrect dates, improper classifications, or were missing altogether.

| Error Category | No. Errors ¹⁴ | Typical PTA Effect | Exemplary US Patent Nos. |
|--|--------------------------|--------------------|---|
| PTO used incorrect applicant response event (or incorrect event date) in determining whether applicant took in excess of 3 months to reply to a PTO notice or action, or did not generate a PTA reduction where applicant took longer than 3 months to reply. See 37 CFR § 1.704(b). | 30 | Either | 6,603,031; 6,605,666; 6,608,033; 6,610,204 (2 errors); 6,610,382; 6,610,708 ²⁵ ; 6,613,761; 6,613,791 (2 errors); 6,627,196; 6,629,643; 6,630,175 (2 errors); 6,630,503 (2 errors); 6,630,572; 6,632,673; 6,632,675; 6,632,814; 6,632,838; 6,633,530; 6,634,747; 6,635,596 (2 errors); 6,635,655 (2 errors); 6,642,024; 6,642,038; 6,645,359 |
| PTO incorrectly calculated PTA credit where patent issued more than 3 years (not including exclusionary periods) after its filing date. See 37 CFR §§ 1.702(b), 1.703(b). | 29 | Too Little PTA | 6,605,623; 6,610,382; 6,610,708 ²⁵ ; 6,610,905; 6,612,447; 6,613,761; 6,617,340 ²⁵ ; 6,617,456; 6,620,866; 6,623,677; 6,627,106; 6,627,196; 6,627,199; 6,629,884; 6,630,283; 6,630,503; 6,630,572; 6,632,673; 6,632,675; 6,632,814; 6,632,872; 6,632,895; 6,633,530; 6,638,507; 6,641,820; 6,641,880; 6,641,942; 6,642,024; 6,642,038 |
| PTO failed to generate PTA reduction where applicant submitted a supplemental reply or other paper, not expressly requested by the examiner, after a reply had been filed. 37 CFR § 1.704(c)(8). | 14 | Too Much PTA | 6,605,623 (2 errors); 6,607,570 (2 errors); 6,612,447; 6,630,175 (2 errors); 6,630,503; 6,632,673; 6,632,838; 6,635,655; 6,641,820; 6,642,038; 6,645,359 |
| PTO improperly applied, or failed to apply, rule requiring PTO to respond to a reply under 35 USC § 132 within 4 months. See 35 USC § 154(b)(1)(A)(ii); 37 CFR §§ 1.702(a)(2), 1.703(a)(2),(3). | 10 | Either | 6,605,666 (2 errors); 6,608,033; 6,610,905; 6,617,340 ²⁵ ; 6,630,503; 6,630,572; 6,632,838; 6,634,747; 6,638,507 |
| PTO improperly applied, or failed to apply, rule requiring PTA reduction where applicant submitted a 37 CFR § 1.312 amendment or other paper after a notice of allowance. See 37 CFR § 1.704(c)(10). | 9 | Either | 6,605,623; 6,609,888; 6,612,447; 6,632,673; 6,632,807; 6,633,530; 6,635,655; 6,642,024; 6,642,038 |
| PTO failed to generate a PTA reduction where applicant submitted a reply having an omission. 37 CFR § 1.704(c)(7). | 7 | Too Much PTA | 6,605,666; 6,609,888; 6,617,456; 6,627,199; 6,630,572; 6,638,507; 6,641,820 |
| PTO failed to generate a PTA reduction where application was inadvertently abandoned for failure to respond or late payment of issue fee. See 37 CFR § 1.704(c)(3). | 3 | Too Much PTA | 6,612,447; 6,632,673; 6,634,747 |
| PTO failed to consider restart of response period in determining whether applicant took in excess of 3 months to reply to a PTO notice or action. See 37 CFR § 1.704(b). | 3 | Too Little PTA | 6,617,340 ²⁵ ; 6,632,675; 6,641,820 |
| PTO improperly applied rule requiring PTO to issue the patent within 4 months after issue fee payment and all outstanding requirements are satisfied. See 35 USC § 154(b)(1)(A)(iv); 37 CFR §§ 1.702(a)(4), 1.703(a)(6). | 2 | Either | 6,632,673; 6,632,807 |
| Total Errors in 50 Audited Cases | 107 | | |

Figure 1. List of Error Categories.

A list of error categories as well as exemplary patent numbers is shown in Figure 1.

Not all errors caused the final PTA to be incorrect. In about half of the flawed calculations, the reductions were greater than the positive PTA, so the final PTA was zero despite the errors. In 42% of the 50 cases, however, the final PTO-calculated PTA was erroneous. A list of these cases along with the magnitude²⁴ of the errors is shown in Figure 2.

In only two of the audited cases²⁵ did the applicant seek correction of an erroneous PTO-calculated PTA. In the first case, the applicant disclosed to the PTO that too much PTA was granted at the time of allowance. The disclosure, however, delayed issuance which generated genuine PTA not recognized by the PTO, forcing the applicant to petition for correction. In the second case, the applicant petitioned for correction after allowance, but, again, the

petition delayed issuance which generated a few additional days of unrecognized PTA.

CONCLUSION

Given the empirical data presented herein, practitioners should be extremely wary of relying exclusively on the PTO-calculated PTA, especially for cases having above average pendency, non-standard prosecution history, some probability of third party challenge, or significant commercial value.

A complete list of patents analyzed for this article, as well as an extensive article discussing PTA calculation, is available at www.PatentTerm.com. Practitioners interested in reviewing (or challenging) any of our calculations are invited to request our detailed analyses. E-mail your request to jlongfellow@patentterm.com. Please limit your request to two patents and provide specific patent numbers. Any corrections will be posted.

ENDNOTES

1. Professor of Law Emeritus, The George Mason University School of Law.
2. Pub. L. 106-113, 113 Stat. 1501 (1999). AIPA PTA applies to applications filed on or after May 29, 2000. *Id.*
3. Pub. L. 103-465, 108 Stat. 4809 (1994).
4. 35 USC § 154(b)(1)(A), (C). Under URAA, extensions for interferences and successful appeals were available, but limited to 5 years.
5. 35 USC § 154(b)(1)(B); *see also* 145 Cong. Rec. S14708, S14718 (daily ed. Nov. 17, 1999).
6. *See* 37 CFR §§ 1.703-1.705.
7. Some details of the initial and final PTO calculations are shown on the Patent Term Adjustment screen available via the PAIR system.
8. *See* 37 CFR § 1.705. If a patent issues on other than its projected issue date and this change necessitates a PTA revision, the applicant may have a second opportunity to request reconsideration of some PTA issues within thirty days of issue. 37 CFR § 1.705(d).
9. 35 USC § 154(b)(4)(B); *see also* *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 FR 56366, 56390 (Sept. 18, 2000).

| Patent Number and Title | USPTO PTA (days) | Audited PTA (days) | PTA Delta ²⁴ (days) | |
|---|------------------|--------------------|--------------------------------|--------------------|
| | | | Too Much Granted | Too Little Granted |
| 6,610,708, Cyclic amino compounds | 0 | 319 | | 319 ²⁵ |
| 6,610,905, Transgenic mouse model for Kaposi's sarcoma | 218 | 41 | 177 | |
| 6,641,880, Signage having films to reduce power consumption and improve luminance uniformity and method for using same | 327 | 454 | | 127 |
| 6,638,507, Mammalian proteases; related reagents | 0 | 108 | | 108 |
| 6,632,675, Multi-analyte reference solutions with stable pO ₂ in zero headspace containers | 0 | 81 | | 81 |
| 6,634,747, Sample indicator lens | 72 | 0 | 72 | |
| 6,641,942, Solid-state energy storage module employing integrated interconnect board | 217 | 262 | | 45 |
| 6,617,340, N-(substituted glycol)-pyrrolidines, pharmaceutical compositions containing them and their use in inhibiting dipeptidyl peptidase-IV | 8 | 52 | | 44 ²⁵ |
| 6,632,895, Functionalized alkoxyamine initiators | 453 | 497 | | 44 |
| 6,610,382, Friction control article for wet and dry applications | 0 | 36 | | 36 |
| 6,620,866, Rubber mixtures and vulcanizates containing agglomerated rubber gels | 179 | 210 | | 31 |
| 6,630,283, Photothermographic and photographic elements having a transparent support having antihalation properties and properties for reducing woodgrain | 178 | 208 | | 30 |
| 6,632,673, Directing the ratio of B2:B1 avermectins in Streptomyces avermitilis host cells | 26 | 0 | 26 | |
| 6,632,872, Adhesive compositions including self-assembling molecules, adhesives, articles, and methods | 319 | 344 | | 25 |
| 6,633,530, Optical pickup apparatus with light source unit including first light source and common light receiving section | 120 | 97 | 23 | |
| 6,627,199, Isolation, identification and characterization of trmst2, a novel member of the TNF-receptor supergene family | 19 | 0 | 19 | |
| 6,623,677, Decorated article made by film insert molding | 213 | 225 | | 12 |
| 6,642,024, Guanylate-binding protein | 54 | 66 | | 12 |
| 6,627,106, Salt mixtures for storing thermal energy in the form of heat of phase transformation | 268 | 279 | | 11 |
| 6,632,807, (2R,4S)-(-)-[N-(4-diethoxyphosphorylmethyl)phenyl]-1,2,4,5-tetrahydro-4-methyl-7,8-methylenedioxy-5-oxo-3-benzothiepin-2-carboxamide | 360 | 355 | 5 | |
| 6,642,038, GlcNAc phosphotransferase of the lysosomal targeting pathway | 329 | 330 | | 1 |

Figure 2. List of Patents where PTO-Calculated final PTA was Incorrect.

10. 35 USC § 111(a).

11. We omitted several applications where the prosecution history file was not readily available for public inspection from the PTO.

12. Since AIPA-based PTA generally deals with matters delaying prosecution in various forms, applications having shorter pendencies typically have less potential for PTA error. In fiscal 2003, the average application pendency was 26.7 months. See *US Patent and Trademark Office Performance and Accountability Report: Fiscal Year 2003* <<http://www.uspto.gov/web/offices/com/annual/2003/index.html>>.

13. *Fourth Annual Pharm Exec 50, Pharmaceutical Executive* (May 2003). Applications were located using a keyword search of company names in the PTO assignment data. Therefore, not all applications are pharmacological in nature.

14. The authors consider a calculation error to be the misapplication, or failure to apply, a PTA rule that demonstrably changes PTO-calculated positive adjustment (for PTO delays and other no-fault delays) or reductions (for dilatory applicant behavior) as shown on the Patent Term Adjustment

screen in the PAIR system. The authors believe the vast majority of errors are clear under the AIPA PTA statute, rules, and commentary. For the small percentage of errors where current authority is ambiguous, however, the authors used their judgment to predict the proper outcome.

15. US Patent No. 6,632,673. See Figure 1 for the error categories.

16. US Patent No. 6,642,024. See 37 CFR § 1.704(c)(10).

17. US Patent No. 6,609,888.

18. US Patent No. 6,610,905.

19. *E.g.*, US Patent No. 6,638,507. See 35 USC § 154(b)(1)(A)(ii); 37 CFR §§ 1.702(a)(2), 1.703(a)(2),(3).

20. *E.g.*, US Patent No. 6,612,447. See 37 CFR § 1.704(c)(8). An IDS after a reply which includes a statement under 37 CFR § 1.704(d), however, is not a reduction.

21. *E.g.*, US Patent No. 6,633,530. See 37 CFR § 1.704(c)(10); see also *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).

22. *E.g.*, US Patent No. 6,632,838. See 37 CFR 1.704(b); 35 USC § 154(b)(1)(A)(ii); 37 CFR §§ 1.702(a)(2), 1.703(a)(3).

23. *E.g.*, US Patent No. 6,617,340. See 35 USC § 154(b)(1)(B); 37 CFR §§ 1.702(b), 1.703(b). In applying the 3-year pendency guarantee, the authors did not count applicant-requested extensions as exclusionary periods, as is our understanding of the PTO interpretation. See 35 USC § 154(b)(1)(B)(iii); 37 CFR §§ 1.702(b)(5), 1.703(b).

24. In many cases, the error magnitude would have been greater but for offsetting errors.

25. Applications for PTA correction were filed and granted in US Patent Nos. 6,617,340 and 6,610,708. See 37 CFR § 1.705.