




UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE CHIEF INFORMATION OFFICER

January 22, 2010

Memorandum

To: Alexander Hunt
Chief, Information Policy Branch
Office of Information and Regulatory Affairs
Office of Management and Budget

From: Susan K. Fawcett 
Records Officer
U.S. Patent and Trademark Office

Subject: Request for Emergency Clearance

The United States Patent and Trademark Office (USPTO) requests emergency review of an information collection request associated with 0651-0020, Patent Term Adjustment. A recent Federal Circuit Court decision has impacted the information collection activities. The USPTO is implementing a new procedure for patentees to seek a revised patent term adjustment in a patent if the patentee's sole basis for requesting recalculation of the patent term adjustment in the patent is the USPTO's pre-Wyeth interpretation of 35 U.S.C. § 154(b)(2)(A).

Under 35 U.S.C. § 154(b)(1), an applicant is entitled (subject to certain conditions and limitations) to patent term adjustment for the following reason: (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)), which are known as the "A" delays; (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)), which are known as the "B" delays; and (3) for delays due to interference, secrecy order, or successful appellate review (35 U.S.C. § 154(b)(1)(C)), which are known as the "C" delays. 35 U.S.C. § 154(b)(2)(A) provides that "[t]o the extent that periods of delay attributable to grounds specified in [35 U.S.C. § 154(b)(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 interpreted this provision as covering situations in which a delay by the USPTO contributes to multiple bases for adjustment (the "pre-Wyeth" interpretation of 35 U.S.C. § 154(b)(2)(A)). See Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004). The Federal Circuit, however, recently held that the USPTO's interpretation of 35 U.S.C. § 154(b)(2)(A) was too strict, and that periods of delay overlap under 35 U.S.C. § 154(b)(2)(A)

only if the periods which measure the amount of adjustment under 35 U.S.C. § 154(b)(1) occur on the same calendar day. Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

The new procedure permits eligible patentees to request a recalculation of their patent term adjustment in lieu of the petition and fee required by 37 CFR 1.705(d). Undue public harm would be caused by delaying eligible patentees' access to the streamlined procedure.

The USPTO asks the OMB to conclude its review of this information collection request by Wednesday, January 27, 2009.

Thank you for your consideration and assistance in this matter.