

## US: PATENTS



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rected in *Novartis*, it is critical to make a request as soon as possible. Timely requests for PTA must be made within two months from issuance, with extensions available for an additional five months.

## Patent term adjustment after *Novartis v Lee*

Patent Term Adjustment (PTA) under 35 USC § 154 allows patentees the right to recapture lost patent term due to certain application-processing delays caused by the USPTO. Pursuant to 35 USC § 154(b)(1)(B), a patent application taking more than three years to process (with certain exclusions) “shall be extended 1 day for each day after the end of that 3-year period until the patent is issued”.

One exclusion is for “time consumed by the continued examination of the application”. 37 CFR § 1.703(b)(1) states that “[t]he number of days, if any, in the period beginning on the date on which a request for continued examination of the application (“RCE”) . . . was filed and ending on the date the patent was *issued*” shall not count toward the three year examination requirement. This includes time between allowance and issuance following RCE.

However, in *Novartis v Lee* (Fed Cir January 15 2014), the Federal Circuit modified the USPTO’s methodology for calculating PTA in situations where a party has filed a RCE. While the Court affirmed the USPTO’s rule denying PTA for time spent during continued examination, it agreed with Novartis’s position that the time between *allowance* and *issuance* following a RCE does not constitute “continued examination”, and therefore should be recaptured by a patentee provided that total examination exceeded three years.

This change should allow a few additional weeks of PTA time to be added to numerous pending or recently issued patents. For recently issued patents that contain the PTA error cor-