



February 1, 2010

CLIENT ALERT

*USPTO issues interim procedures for recalculating patent term under *Wyeth v. Kappos**

In view of the Federal Circuit's recent ruling in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010), the USPTO has issued interim procedures giving patentees a new way to request recalculation of patent term adjustment ("PTA") in accordance with *Wyeth*. See USPTO Docket No. PTO-P-2010-0006, available at http://www.uspto.gov/patents/announce/pta_wyeth.pdf. In *Wyeth*, the Federal Circuit invalidated the Office's previously established procedure for calculating PTA under 35 U.S.C. § 154(b), allowing some patent applicants to obtain more PTA. The PTO has announced that it does not intend to seek review of this decision.

Instead, the PTO is modifying its software for calculating PTA, and in the meantime is providing a simplified procedure for seeking revised PTA in view of the *Wyeth* decision. This procedure involves submitting a form available at <http://www.uspto.gov/forms/sb0131.pdf>. The PTO's instructions state that the form may only be used for patents issued prior to March 2, 2010 in which the sole basis for requesting a recalculation is the Office's pre-*Wyeth* interpretation of § 154(b)(2)(A). Furthermore, requests under this new procedure must be filed within 180 days of the day the patent was granted. The Office also claims that this new procedure has no effect on § 154(b)(2)(4)(A), which provides that a patentee has 180 days after the grant of a patent to file a civil action against the Director of USPTO to revise a PTA calculation.

In view of the availability of this procedure, patentees should consider reviewing all patents issued within the past 180 days to determine whether the *Wyeth* decision may have an impact on the amount of available PTA. To take advantage of this interim procedure, no recalculation is required; the patentee need only submit the form stating that it is requesting reconsideration in view of the *Wyeth* decision. Patentees are reminded that this procedure only applies to adjustments to PTA resulting from the *Wyeth* decision; the rules for requesting reconsideration of PTA for any other reason remain unchanged.

Patent term adjustment calculations can be complex. If we can be of assistance in recalculating or double-checking PTO calculations, please contact us.

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