New PTO Error in Decisions on Requests for Recalculation of Patent Term Adjustments

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For those who filed Requests For Recalculation of Patent Term Adjustments in view of the *Wyeth* case, the PTO has begun to mail out decisions on the Requests. Unfortunately, in doing so, the PTO has introduced a new error in some of its recalculations. The error has been introduced in patents in which an after-allowance filing occurred, such as an Information Disclosure Statement or Amendment under 37 C.F.R. § 1.312. The PTO has been erroneously docking the applicants for the time from the filing of these documents until the grant date of the patent. Instead the PTO should be docking applicants from the filings only until the date on which the after-allowance filings received response from the PTO, as required under 37 C.F.R. § 1.704(c)(10)(i).

In a telephone call originated by a Banner & Witcoff lawyer, a PTO official acknowledged the new PTO error and indicated that they are working to issue new decisions for patents with the errors to replace the mistaken decisions as soon as possible. The intent is that applicants will not need to file Requests For Reconsideration of Decision under 37 C.F.R. § 1.705(b)(2). (Such a request has a period for filing of the longer of 30 days or one month from the date of decision, is not extendible and inclusive of a fee.)

The PTO official suggested that those in need wait until the last possible days before filing a Request For Reconsideration, in hopes that the PTO will have mooted the need to do so by issuing a new Decision on Request For Recalculation.

For more information, please contact your B&W attorney or send an email to info@bannerwitcoff.com.

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