

Revisions to Patent Term Adjustment Rules

December 6, 2011

Effective December 1, 2011, the United States Patent and Trademark Office (PTO) revised its rule governing the effect of submitting an IDS on patent term adjustment (37 C.F.R. § 1.704(d)). Under the old rule, the PTO did not deduct from an applicant's patent term adjustment for an Information Disclosure Statement (IDS) filed to list information cited in a foreign counterpart application, provided the IDS was filed within 30 days of receiving the information. The revised rule is expanded to include an IDS filed to cite Office Actions and references from a co-pending U.S. patent application or a counterpart international application.

The revised rule reads:

§ 1.704 Reduction of period of adjustment of patent term.

(d)(1) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement:

- i.** Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement; or
- ii.** Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendable.

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