

Prosecution Time Spent After a Request for Continued Examination, Followed by an Interference, All Prior to a Notice of Allowance, Does Not Count for Purposes of Extending Patent Life Under a Patent Term Adjustment Calculation

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Mayo Foundation for Medical Education and Research v. Iancu, No. 2018-2031 (Fed. Cir. Sep. 16, 2019)

The Federal Circuit affirmed the Patent and Trademark Office's (PTO) interpretation regarding Patent Term Adjustment (PTA) calculations. PTA allows patentees to add days to a patent's lifespan based on certain delays by the PTO during prosecution. One type of prosecution delay—B Delay—entitles patentees to PTA for each day the application is pending beyond three years. However, B Delay is subject to several limitations, including time consumed by a request for continued examination (RCE). The patent applicant had filed an RCE, and months later, the PTO declared an interference. After the interference, the PTO reopened prosecution before finally issuing a Notice of Allowance. The disputed timeframe was the span between the interference and the Notice of Allowance. The applicant argued that the reopening of prosecution was not "requested," and therefore not part of the RCE. The PTO asserted that the RCE time continued to run up until the Notice of Allowance, reducing the patentee's PTA. The Federal Circuit found that although at least one claim must be in a condition for allowance before an interference is declared, a declaration of interference is *not* tantamount to a Notice of Allowance. When calculating B Delay, an interference does not terminate the RCE time, and additional examination after an interference is included as RCE time. The same reasoning also applies to cases where an examiner reopens prosecution following a successful appeal by a patent applicant.

[A copy of the opinion can be found here.](#)

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