



Considerations, concerns and recommendations in calculating patent expiry dates for United States patents



Frazer McLennan*

Shelston IP, Level 21, 60 Margaret St, Sydney, NSW 2000, Australia

ABSTRACT

Keywords:

USA
Patent expiry
Earliest effective filing date
Benefit claiming
Patent term adjustment
Terminal disclaimer

Calculating United States patent expiries for continuing applications involves determining the earliest effective filing date, and is by no means straightforward, especially for chains of applications stretching over 20 years. The United States Patent and Trademark Office provides many definitive answers to the factors determining an expiry date, but leaves one as a great unknown, the earliest effective filing date. A summary of the requirements for claiming the benefit of an earlier filed application is provided, along with examples highlighting the difficulty experienced.

© 2014 Elsevier Ltd. All rights reserved.

1. Introduction

Calculating patent expiries for most countries is relatively straightforward. Some countries even calculate it for you and display it in a field in their online databases. In many cases it is a matter of adding 20 years to the filing date of the application. For example, AU 747547 has a filing date of 16 July 1999, and adding 20 years gives an expiry date of 16 July 2019. Why then, is it so difficult to accurately calculate expiry dates for US patents, and be confident in your answer?

The commonly held view of how to calculate US patent expiry dates is as follows:

- (1) For applications filed prior to, and still in force or pending on, 8 June 1995, the expiry date is the later of 17 years from the issue date, and 20 years from the filing date.
 - a. For example, US 5219846 has a filing date of 20 December 1991 and an issue date of 15 June 1993. Adding 20 years to the filing date gives 20 December 2011, and adding 17 years to the issue date gives 15 June 2010. The expiry date is the later date, 20 December 2011.
- (2) For applications filed on or after 8 June 1995, the expiry date is 20 years from the date of the earliest related application, or where there are no earlier applications, the filing date.
 - a. For example, US 6472448 has a filing date of 27 March 2001. There are no earlier related applications, so adding 20 years to the filing date gives 27 March 2021 as the expiry date.

- b. A further example, US 7105503 has a filing date of 15 February 2002, but in this case there are earlier related applications. These are a continuation-in-part, filed on 22 December 2000, of US 6436915, which is a continuation-in-part, filed on 7 April 2000, of US 6214813. The earliest related application has a filing date of 7 April 2000, so adding 20 years gives 7 April 2020 as the expiry date, and not 15 February 2022.

These examples however conveniently ignore a number of additional factors that may influence the expiry date such as terminal disclaimers or patent term adjustments.

These dates can be obtained from a number of expiry date calculators or guides found online, and they also ignore the additional factors as I have done as they require a bit of manual digging around in the USPTO's PAIR (Patent Application Information Retrieval) [1] to discover what the particular terminal disclaimer is or the size of the patent term adjustment. I can happily say that my expiry date estimates for the three patents above correspond with those provided by two free patent term calculators located online (PatentLens [2] and MaxVal [3]), such is the extent of these commonly held views.

Why then am I not confident in my estimations?

With simple examples such as these I am confident, but as the number of continuations or continuations-in-part or divisionals grows, my confidence starts to fall. Situations where the continuing applications span more than 20 years are particularly troublesome.

2. The law, MPEP advice, and relevant decisions

Before I provide some specific examples we should consider the requirements for claiming the benefit of an earlier filed application in the United States.

* Corresponding author.

E-mail address: FrazerMcLennan@shelstonip.com.

35 USC 120 states [4]

An application for [a] patent for an invention disclosed ... in an application previously filed in the United States, which is filed by an inventor or inventors named in the previously filed application shall have the same effect ... as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

MPEP 201.11 discusses the requirements of an application that is claiming the benefit of the filing date of an earlier filed application under 35 USC 120. Part III Reference to Prior Applications states in its introduction [5]

The third requirement of the statute is that the later-filed application must contain a specific reference to the prior application. This should appear as the first sentence of the specification following the title preferably as a separate paragraph and/or in an application data sheet.

Further, in Part III C. Benefit Claims to Multiple Prior Applications, it states

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications.

In relation to the term of a patent resulting from a benefit claim to an earlier filed application, 35 USC 154(a)(2) states [6]

TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120 ... from the date on which the earliest such application was filed.

Particularly in relation to continuing applications, MPEP 2701 Patent Term, in discussing 35 USC 154, further states [7]

A patent granted on a continuation, divisional, or continuation-in-part application that was filed on or after June 8, 1995, will have a term which ends twenty years from the filing date of earliest application for which a benefit is claimed under 35 U.S.C. 120 ... regardless of whether the application for which a benefit is claimed under 35 U.S.C. 120 ... was filed prior to June 8, 1995.

The language used to differentiate earlier filed applications is important. 35 USC 120 makes reference to a “previously filed

application” and an “earlier filed application”, and not to the “first filed application” which appears in MPEP 201.11 Part III C. 35 USC 154 refers to “an earlier filed application” and MPEP 2701 refers to the “earliest application for which a benefit is claimed” rather than the first filed application thus leaving it open to be other than the first filed application.

This is discussed in *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968) [8]

Congress may well have thought that Section 120 was necessary to eliminate the burden on the public to engage in long and expensive search of previous applications in order to determine the filing date of a later patent. Indeed, the fact that each application in a long chain grows out of the one immediately preceding it does not necessarily mean that the invention finally described in the last application could properly claim the filing date of the first application even if the cross-references were complete. This also explains why the last clause of Section 120 refers to ‘the earlier filed application’ rather than the ‘first application’. Although Section 120 may not be ideally drafted, it is clear to us that the ‘earlier filed application’ means the first application whose filing date is being claimed by the applicant. The inventor is the person best suited to understand the relation of his applications, and it is no hardship to require him to disclose this information.

35 USC 120 further states [4]

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section.

After The Patent Act of 1952 was enacted, the Examiner-in-Chief, P J Federico, produced a commentary on the new Act [9], and stated, in relation to the specific reference to an earlier filed application,

The third requirement of the statute is that the second application must contain a specific reference to the first application. In view of this requirement the right to rely upon a prior application may be waived or refused by an applicant by refraining from inserting a reference to the prior application in the later case, although it is difficult to imagine a situation in which this right would be deliberately waived.

In a Q & A session entitled *Questions and Answers Regarding the GATT Uruguay Round and NAFTA Changes to U.S. Patent Law and Practice*, published by the USPTO on 23 February 1995, in the subsection “20-year Patent Term”, it was asked [10]

3. Does an applicant have to claim the benefit of an earlier filed application? Can you adjust the start of the period of the 20-year patent term by not claiming the benefit of a parent application?

The answer was

An applicant has full control over claims to the benefit of an earlier filing date under 35 U.S.C. 120. The 20-year term will be based upon the filing date of the earliest U.S. application that the applicant makes reference to under 35 U.S.C. 120. Whether an applicant is entitled to the benefit of the filing date of an earlier application is something that an applicant should examine before the patent is

Download English Version:

<https://daneshyari.com/en/article/37914>

Download Persian Version:

<https://daneshyari.com/article/37914>

[Daneshyari.com](https://daneshyari.com)