FINNEGAN

April 2010 Issue

PTA Still Pestering USPTO

As reported in the February 2010 edition of "Full Disclosure," the Federal Circuit in *Wyeth v. Kappos* recently found fault with the USPTO's method of calculating patent term adjustment (PTA). In response, the USPTO established an interim procedure for requesting PTA recalculation in accordance with the framework set forth in that decision. Under the procedure, patentees can request recalculation of PTA for any patent issued before March 2, 2010, within 180 days of the patent's issuance. The interim procedure, however, is not without flaws, and the *Wyeth* decision continues to pester USPTO officials.

In one example, requesting PTA recalculation due to "*Wyeth* errors" under the interim procedure does not preserve the patentee's right to have the PTA calculation reviewed by a court. A statutory 180-day window for seeking judicial review continues to run from patent issuance. Thus, a patentee requesting PTA recalculation under the interim procedure may find that the USPTO does not respond within the 180-day period for seeking judicial review. Although not operating under the interim procedure, this is the position Arius Two, Inc. (Arius) found itself in. Arius's patent issued on August 25, 2009, and Arius requested PTA recalculation on September 8, 2009. But, as of early February 2010, Arius had not heard from the USPTO. Realizing that its 180-day window for seeking judicial review was going to expire on February 25, 2010, Arius commenced suit against Director Kappos in the U.S. District Court of the District of Columbia on February 16, 2010. *See Arius Two, Inc. v. Kappos*, No. 1:10-cv-00225-RMU

(D.D.C. filed Feb. 16, 2010).

In another example, Idera Pharmaceuticals, Inc. (Idera) found that it was unable to request PTA recalculation for its patent that issued on April 14, 2009, because the 180-day window set by the USPTO's interim procedure had expired even before the USPTO announced the interim procedure.
Similarly, judicial review of the USPTO's PTA calculations for the Idera patent was not available because the 180-day period for seeking such review had expired by the time the Federal Circuit announced its decision in *Wyeth*.
Unwilling to accept these circumstances, Idera turned to the doctrine of "equitable tolling." According to the Federal Circuit, the doctrine of equitable tolling provides that "a statute of limitations does not run against a plaintiff who is unaware of his cause of action." *Serdarevic v. Advanced Med. Optics Inc.*, 532 F.3d 1352 (Fed. Cir. 2008). Idera then sued Director Kappos, alleging that the *Wyeth* decision "constituted a change in law sufficient to invoke the doctrine of equitable tolling . . . ." *See Idera Pharms. Inc. v. Kappos*, No. 1:10-cv-00166-EGS (D.D.C. filed Feb. 4, 2010).

Although the USPTO now calculates PTA in accordance with *Wyeth*, these two cases illustrate unsettled issues with the newly enacted interim procedure, which are likely to keep USPTO officials busy in the coming months.