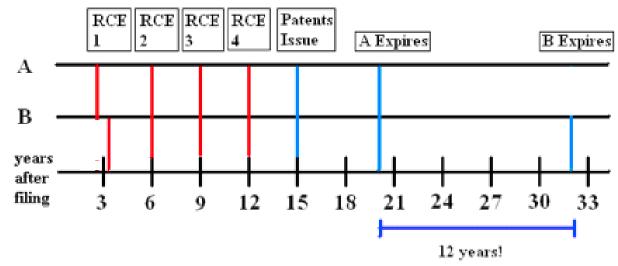
米国 Exelixis 事件で審査中に RCE があった場合、 早くに動けば PTA の追加分がもらえるかも

- 2012 年 11 月 1 日の米国バージニア州東部地区地方裁判所判例 Exelixis v. Kappos では、米国特許商標庁の特許存続期間(PTA)の計算に誤りがあるとして、米国出願日(PCT による国内移行の場合、国内移行日)から3年より後に継続審査請求(RCE)が提出された場合には、出願人が申し込めば更なる PTA がもらえるといった内容の判決を下した。
- 米国特許商標庁はどう受けるか、控訴された場合には控訴裁判所はどうするかなど、不明確な点は幾つかあるが、控訴裁判所に行っても支持される充分な見込みがあるので、米国出願後3年より後にRCEが提出された特許であれば、PTAの追加分がもらえるかどうかご検討をお勧め致します。
- 特に米国特許登録後まだ2ヶ月を経たない場合であれば、急いで37 CFR 1.705(d)に基づいてPTA 再計算申請をすれば、比較的に安価な方法で、控訴裁判所や米国特許商標庁の最終的な決断に備えて、存続期間調整の追加分をもらう権利を確保できる(PTA 再計算申請その他の処置をタイムリーに行わない場合、その権利を放棄したと見なされる可能性がある)。

This U.S. patent practice update was prepared by U.S. Patent Agent Gerry PETERS, of counsel at UNIUS Patent Attorneys Office in Shinosaka Japan http://www.unius-pa.com. Questions or comments regarding the content of this case summary may be directed to the author at gerrypeters@unius-pa.com. Permission is hereby given to reproduce this material provided proper attribution is given, but all other rights are reserved. © 2013 UNIUS Patent Attorneys Office.

Effect of RCE on PTA (Patent Term Adjustment)

- Recent case *Exelixis*, *Inc. v. Kappos* (CAFC; 2012). PTO incorrectly calculating PTA for RCEs filed after 3 years from filing date.
- Wyeth v. Kappos (CAFC; 2010) was similar case that resulted in Wyeth request/petition practice to request recalculation of PTA.
- At issue is interpretation of 35 USC 154



- ➤ If after receipt of Notice of Allowance but before payment of issue fee, apply for recalculation of PTA under 37 CFR 1.705(b).
- ➤ If after payment of issue fee but before 2 months from issue date, request recalculation of PTA under 37 CFR 1.705(d).
- ➤ If after 2 months but before 180 days from issue date, file lawsuit in Eastern District of Virginia under 35 USC 154 (b)(4)(A).

- Graphic at left is from article *The Ghost of Lemelson: PTA Consequences of Exelixis v. Kappos*, by Kip Werking, posted to IPWatchdog blog http://www.ipwatchdog.com on 26 November 2012 @ 9:05 am)
- PTO was ignoring delay due to RCEs filed <u>after</u> 3 years from filing date
- Court found that patentee entitled to PTA to compensate for delay due to RCEs filed <u>after</u> 3 years from filing date
- PTO and Court agree that patentee not entitled to PTA to compensate for delay due to RCEs filed <u>before</u> 3 years from filing date
- Advice: Where possible, delay filing of RCE until <u>after</u> 3 years from filing date
- Advice: Check recently allowed/issued patents for eligibility for recalculation of PTA (≤ 180 days from issue date)
- PTO also undercalculates PTA in PCT national stage applications due to differing interpretations of national stage entry date.