

Revision of Certificate of Extension Language Regarding Original Expiration Date

35 U.S.C. § 156 provides for the extension of the term of a patent which claims a product, a method of using a product, or a method of manufacturing a product where such product (defined in 35 U.S.C. § 156(f)) was subject to a pre-marketing regulatory review period (defined in 35 U.S.C. § 156(g)), upon application by the patent owner.

Currently, the language on a Certificate of Extension states, in part:

Since it appears that the requirements of the law have been met, this certificate extends the term of the patent for the period of

(94) [number of days]

from MM DD, YYYY, the original expiration date of the patent, subject to the payment of maintenance fees as provided by law, with all rights pertaining thereto as provided by 35 U.S.C. § 156.

The USPTO is changing this language on the Certificate of Extension to read as follows:

According to United States Patent and Trademark Office records, the original expiration date of the patent as of the date of issuance of this certificate is MM DD, YYYY. Because it appears that the requirements of the law have been met, this certificate extends the term of the patent for the period of

(94) [number of days],

subject to the payment of maintenance fees as provided by law, with all rights pertaining thereto as provided by 35 U.S.C. § 156.

The resolution of double patenting issues during the patent application examination process commonly results in the submission of a terminal disclaimer pursuant to 35 U.S.C. § 253 and 37 C.F.R. § 1.321. When a Certificate of Extension is granted in such a case, the original expiration date reflects the terminal disclaimer submitted during the patent application examination process.

The Office is clarifying language in its Certificate of Extension to address situations where issues of double patenting arise after the patent issues (e.g., during patent enforcement proceedings). The original expiration date listed on the granted Certificate of Extension does not take into account a later filed terminal disclaimer. The later filed terminal disclaimer may result in an earlier expiration date. Thus, the Office is changing

the Certificate of Extension language to clarify that it reflects the original expiration date according to the records of the Office at the time the Certificate of Extension is granted.

Implementation of changes to the Certificate of Extension language shall become effective on the date of this notice.

Any inquiry regarding this notice may be directed to Mary C. Till, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7755 or (571) 272-7701, or by electronic mail at Patent.Practice@uspto.gov.

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Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office