December 3, 2019

Via email: AD38.comments@uspto.gov

The Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Mail Stop: Comments—Patents, Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Request for Comments on “Patent Term Adjustment
Reductions in View of the Federal Circuit Decision in
Supernus Pharm., Inc. v. Iancu” 84 FR 193 (Oct. 4, 2019)

Dear Director Iancu:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (“Section”) to respond to the request for comments in the “Patent Term Adjustment Reductions in View of the Federal Circuit Decision in Supernus Pharm., Inc. v. Iancu” (“Patent Term Adjustment”). See 84 FR 193 (Oct 4, 2019) (the “Notice”). The views expressed herein are the views of the Section; they have not been approved by the House of Delegates or the Board of Governors of the American Bar Association, and accordingly should not be construed as representing the position of the Association.

The Section applauds the efforts of the United States Patent and Trademark Office (the “Office”) to revise rules of practice pertaining to patent term adjustment to further align the rules with the Federal Circuit decision in Supernus. The proposed amendments address patent term adjustment reductions associated with deferral of issuance (37 C.F.R. 1.704(c)(2)), abandonment of an application (37 C.F.R. 1.704(c)(3)), submission of a preliminary amendment (37 C.F.R. 1.704(c)(6)), submission of papers after a decision by the Patent Trial and Appeal Board or by a federal court (37 C.F.R. 1.704(c)(9)), and submission of papers after a notice of allowance under 35 U.S.C. 151 (37 C.F.R. 1.704(c)(10)).

In each instance, the proposed amendments align with Supernus by deducting only the number of days by a period that does not exceed the “time during which the applicant failed to engage in reasonable efforts” to conclude prosecution and
that minimizes or avoids instances during which there is no action that the applicant could take to conclude prosecution of the patent. Accordingly, the Section generally supports the proposed amendments and appreciates the Office’s effort to minimize patent term adjustments that are potentially inconsistent with *Supernus*. That said, at least the proposed change to Section 1.704(c)(6) may benefit from further study of its implications. The Section also appreciates the Office’s previous amendment of 37 C.F.R. 1.704 (c)(8) to address the reduction of patent term adjustment resulting from the submission of an information disclosure statement after the filing of a request for continued examination.

The Section appreciates the opportunity to provide these comments. If you have any questions regarding the above comments, please feel free to contact me.

Sincerely,

George W. Jordan III
Chair, ABA Section of Intellectual Property Law