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Intellectual Property Developments

## SEEKING CORRECTED PATENT TERM OUTSIDE OF 180-DAY LIMIT, PATENTEE REQUESTS "EQUITABLE TOLLING"

The Federal Circuit recently ruled that the PTO had been improperly calculating patent term extensions. [\*Wyeth v. Kappos\*, 591 F.3d 1364 \(2010\)](#). Essentially, the PTO was improperly taking the greater of two PTO delays, rather than combining the two delays. Patentees have the right to challenge the PTO's patent term extension calculation in the U.S. District Court for the District of Columbia, but this must be done within 180 days of patent issuance. As can be appreciated, many patents that issued before the ruling in *Wyeth*, but outside of the 180-day limit, have an improperly calculated patent term extension.

A patentee faced with this issue filed a complaint in the U.S. District Court for the District of Columbia on January 29, 2010. *Idera Pharmaceuticals Inc. v. Kappos*, D.D.C., No. 1:10-cv-00166-EGS. In an amended complaint (attached), plaintiff-patentee Idera alleges that the PTO has improperly calculated patent term extensions for two of their patents (7,569,554 and 7,517,862). One of these patents, the '862 patent, issued on April 14, 2009, and is thus outside of the 180-day limit. Idera further alleges that the *Wyeth* decision

"constitutes a change in law sufficient to invoke the doctrine of equitable tolling" to allow recalculation of the patent term extension of the '862 patent. Notably, the doctrine of equitable tolling sets forth that a plaintiff may be entitled to relief, despite the expiration of a statute of limitations, when the plaintiff was unaware of their cause of action until after the statutory period had expired.

While we cannot predict the District Court's decision in *Idera*, the doctrine of equitable tolling may provide an avenue around the 180-day limit (of 35 U.S.C. § 154(b)(4)) if the lawsuit is filed in the near future. If one wishes to pursue an extension using the equitable tolling argument, a complaint should be filed promptly. For patents outside of the 180-day limit that have an improperly calculated patent term extension, one should consider the tradeoff between the cost of filing a lawsuit against the PTO, and the benefit of an extended patent term. Filing a lawsuit to extend a patent's term may not be appropriate in all circumstances, but it may make financial sense if the patent is particularly valuable.

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