

Checklist: When does a patent expire?

By Jay Sandvos, Bromberg & Sunstein LLP -- 8/15/2007

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When does a patent expire? After about 20 years. Oh, you mean *exactly* when does a given patent expire? Draw up a chair.

First, no one can just look at a patent and tell at a glance when it expires. In answer to the question when does this patent expire, you should hear some lawyer waffle-words: "It looks like this patent may have expired." But to say for sure takes more than a quick look at the front page. Still, that is the right place to start, looking at the front page of the patent for the filing date.

1. Look at the filing date.

If the patent application filing date is after June 8, 1995, the *nominal* expiration date is 20 years from the earliest non-provisional priority claim upon which the patent is based. On the other hand, if the patent application filing date was on or before June 8, 1995, the *nominal* expiration date is the longer of 17 years from the date of issue or 20 years from the earliest non-provisional priority claim. Usually, but not always, the priority claim is listed on the front page of the patent. To be sure, a patent lawyer needs to review the complete file history of the patent. If you're in a hurry (it may take a couple of days to get the file history), I would log onto the public Patent Application Information Retrieval (PAIR) system and check the "continuity" information to figure out the priority claim.

2. Determine if the patent's basic term was extended.

The front page of the patent just gives a starting point for figuring out when the patent expires. There are several other things which may have happened to change that. For example, the basic term of the patent may have been extended. Why? Because the law makes some effort to be fair (in a capricious way) and everyone, even Congress, knows that sometimes the Patent Office can labor along exceptionally slowly. If delays at the Patent Office mean that the patent did not issue until 10 years after it was filed, then is it fair to cheat the inventor out of so many years of patent protection? The law says, no, at least for patent applications filed on or after May 29, 2000, which may have had their terms extended for PTO-caused delays beyond three years (which is a reasonable amount of delay ...). Such term extension should be indicated on the front page of the patent and be marked with a

"*". But this is not always the case. If you need to be sure, you need to check the file history. If you want to be pretty sure, but not completely sure, check PAIR.

3. Determine if the patent term was shortened.

Having considered the potential for term extension, you also need to consider the opposite-- that the term of the patent may have been shortened due to a terminal disclaimer. This occurs when the claims of a patent are obvious from the claims of a commonly owned earlier issued patent, such as a parent application of a continuation application. Sometimes (but not always) this is also marked by an asterisk after the patent issue date. Other times, there may not be an asterisk, but maybe a statement on the front page or the first page of description. Or, sometimes there is no indication, but there is a terminal disclaimer in the file history. You should be alert for this in any application that is designated as a continuation, continuation-in-part, or divisional.

4. Was the patent changed due to a reissue or reexamination proceeding?

Another possibility you need to consider is that some or all of the claims in a patent may have been lost or changed in a reissue or reexamination proceeding. These are processes that the Patent Office offers to reconsider patents which have previously issued. A reissue is typically for a mistake made by the applicant not accurately claiming their invention. When a reissue is commenced within two years of the patent issuing, the claims are allowed to be made even broader to correct the "mistake" (oops! my invention was actually for more than I realized at the time) as long as they can argue their way over the prior art. After two years, reissue claims cannot be broadened, but even "narrowing" of the claims in a reissue can be a useful way to address newly discovered prior art or newly appreciated flaws in the original claims.

Re-examinations are different from reissues, and basically correct over-broad patent claims that should not have issued in the first place because there is prior art that makes them anticipated or obvious. Again, reissues and reexams are indicated in PAIR, and the claims that emerge from either process may be very different from the claims printed in the patent in your hand.

5. Have maintenance fees been paid?

Don't forget to check if all of the required maintenance fees been paid. Maintenance fees have to be paid to the Patent Office at 3.5 years, 7.5 years and 11.5 years from the date of issue. The fees must be paid within six months before the due date, and may be paid up to another six months after that with a surcharge. This information is also available on PAIR, but these payment windows are actually rather complicated to figure out even when you are looking at the information. And it is not uncommon to see that at some point, a maintenance fee was not paid and a patent has died.

6. Was the patent in litigation?

You have to consider the possibility that one or more of the claims in a patent have been declared invalid in court. Maybe the patent you are looking at has been the subject of previous litigation and little or nothing may remain. This probably would not be apparent from a visit to PAIR, and requires a bit of checking of electronic databases such as Lexis or Westlaw.

Based on the above, I would then form my *opinion* or *belief* as to when a patent expires. But sometimes, it can get a little complicated.

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