

Patent Term Adjustment: Not available solely in the U.S.

Article By:

Lisa L. Mueller

Patent term adjustment (PTA) is a process of extending the term of a U.S. patent as a result of delays caused by the **U.S. Patent Office (USPTO)** during the prosecution. The total PTA is added to the 20 year term of a patent. The PTA provisions of the American Inventors Protection Act of 1999 allow for term adjustment if: (1) the USPTO fails to initially act on an application within fourteen months of its filing date; (2) the USPTO fails to respond to a reply or appeal by applicant within four months of the reply or appeal; (3) the USPTO fails to act on an application within four months of a Board of Patent Appeals and Interferences or court decision in an application containing allowable claims; (4) the USPTO fails to issue a patent within four months of the date the issue fee was paid; (5) the USPTO fails to issue a patent within three years of its filing date; (6) the issuance of a patent is delayed due to imposition of a secrecy order; (7) the issuance of a patent is delayed due to an interference proceeding; or (8) the issuance of a patent is delayed due to successful appellate review. A patent term is extendible for a period equivalent to the delay.

PTA can be complicated and requires both the USPTO and Patentee to monitor several events during prosecution. The USPTO calculates PTA and includes a notification of the PTA in the Notice of Allowance. The PTA is printed on the cover sheet of the patent. A Patentee must file a request for reconsideration of the PTA within two months from the date the patent was granted (although this due date is extendible with the payment of extension fees).

Unlike the U.S., Europe, Canada, Mexico, Japan, Russia, China, Australia and India do not provide any PTA for patent office delays. However, South Korea, El Salvador and Columbia provide PTA for delays caused by their respective patent offices in issuing a patent.

PTA in South Korea

In 2012, the South Korean Patent law was amended to introduce a PTA system pursuant to the provisions of the Korea-U.S. Free Trade Agreement. Specifically, PTA is available for any patent application filed after March 15, 2012 if the registration of a patent is delayed more than:

1. Four years from the filing date of the application; or
2. Three years from the date of filing a request for examination.

A patent term is extendible for a period equivalent to the delay. Any delays attributable to the applicant (such as delays by the applicant in responding to a notice from Korean Intellectual Property Office (KIPO)) will not be included in the PTA period. Also, unlike the U.S., PTA is not automatically granted by the KIPO, but is only awarded after request by the Patentee. Such a request must be filed within three months from the date of issuance of a patent.

PTA in El Salvador

As a result of the ratification by El Salvador of the DR-CAFTA Dominican Republic – Central America Free Trade Agreement (DR-CAFTA), it is possible to request PTA of a patent in El Salvador for up to an additional 550 days due to delays in the granting of a patent by the Patent Office in El Salvador. Specifically, PTA is available for any patent application filed after January 20, 2006, if the registration of a patent is delayed more than:

1. Five years from the filing date of the application; or
2. Three years from the date of filing a request for examination.

A Patentee must request file a request for extension of a patent term that includes the circumstances and reasons that lead to the delay in registration.

PTA in Columbia

On September 29, 2014, the Colombian government issued Decree 1873 providing “compensation” (namely, PTA) in the event of unjustified delay by the Colombian Patent Office in issuing patents. Unfortunately, this compensation does not apply to pharmaceutical patents. According to the decree, a patent term is extendible for each day of “unreasonable delay” in the granting of a patent. An “unreasonable delay” exists when a decision to grant a patent takes longer than:

1. Five years from the filing date of the application; or
2. Three years from the date of filing a request for examination.

A Patentee must request restoration of the patent term within two months of the date of issuance of a patent.

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