

New Rule 37 CFR 1.704(d)(3), Effective 7/17/2023

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Effective 7/17/2023, new rule 1.704(d)(3) provides that any 1.704(d)(1) certification will be ignored when the PTO calculates Patent Term Adjustment (PTA), unless (1) the 1.704(d)(1) certification is made by submission of form PTO/SB/133; and (2) that form submission is associated with document description code "PTA.IDS." See "Standardization of the Patent Term Adjustment Statement Regarding Information Disclosure Statements," 88 FR 39172 (6/15/2023).

The FR notice states that new rule 1.704(d)(3) is "effective July 17, 2023, and is applicable to any statement under 37 CFR 1.704(d) filed on or after July 17, 2023."

Rule 1.704(d)(1) is the rule specifying that certain IDS submissions will not result in a deduction to PTA due to the PTO's prosecution delays, if accompanied by the noted certification (that information in the IDS was very recently received from specified sources.)

If you do not comply with new 1.704(d)(3) (by filing form PTO/SB/133 and setting its document description to "PTA.IDS." for an associated IDS), then you can still file an application for PTA, post issuance (rule 1.705(b)), to exclude deductions to PTA due to the filing of the IDS containing a 1.704(d)(1) certification made without using PTO/SB/133. But of course that requires paying the fee for an application for PTA and complying with the other rule 1.705(b) requirements for such an application for PTA.

New rule 1.704(d)(3) reads:

§ 1.704 Reduction of period of adjustment of patent term.

* * * * * (d) * * * (3) The statement under paragraph (d)(1) of this section must be submitted on the Office form (PTO/SB/133) provided for such a patent term adjustment statement using the appropriate document code (PTA.IDS). Otherwise, the paper or request for continued examination will be treated as not accompanied by a statement under paragraph (d)(1) of this section unless an application for patent term adjustment, in compliance with § 1.705(b), is filed, establishing that the paper or request for continued examination was accompanied by a statement in compliance with paragraph (d)(1) of this section. No changes to statements on this Office form may be made. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of this form, whether by a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on this form have not been altered.

Therefore, in the rare instances where you decide to make a rule 1.704(d)(1) certification, make the certification by filing form PTO/SB/133 and selecting document description code "PTA.IDS" for that form.

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