original patent term under section 156. In other words, their entitlement to a 20-year term rests on a patent term extension. It is not reasonable, therefore, to ascribe to the end of such 20-year term the appellation ''original expiration'' which under the provisions of section 156(a) was supposed to have been achieved without the aid of an extended term.

Moreover, in cases where the 17-year term expires before June 8, 1995, and the patent is kept in force on that date by virtue of an extension under section 156, transposing such extension to the end of the 20-year term would have resulted in applying at least some of the extended period twice to the term of the patent. This result would have been especially curious in instances where both the original 17 and the 20-year terms expired before June 8, 1995.

Another vexing problem that would have arisen had the PTO proposal been adopted, concerns the question of the rights that a patent holder derives during the period of extension under section 156. If this period had been added to the 20-year term, a patentee would have had full exclusionary rights until the end of the 17-year term, followed by rights only to equitable remuneration with respect to a certain class of infringers during the period from the end of the 17-year term to the end of the 20-year term, and followed by a restoration of full exclusionary rights with respect to the approved product during the continuing period of extension under section 156. A more reasonable solution, such as a continuation of limited patent rights during the period of extension, has no statutory foundation, because section 154(c)(2) added by the URAA does not address extensions under section 156, which itself contains an explicit provision regarding a patentee's rights during the period of extension.

In analyzing section 156(a), it must be remembered that at the time of its enactment in 1984, only one patent term—seventeen years from grant—was available and that all extensions granted under section 156 until now were added to that patent term. Because the URAA does not address the question of patent term extension under section 156, the extensions of all patents issued before June 8, 1995, must continue to be calculated by the PTO on the basis of the 17-year term from grant and added to that term. This is necessitated by the fact that all patents in that category have an original expiration of 17 years from grant, even though they may be entitled to a term of 20 years from filing under the URAA. Further, where the 20-year term from filing exceeds the original term of 17 years from grant, the provisions of the URAA are satisfied in cases where the extension under section 156, added to the 17-year term, expires later than 20 years from the filing date.

All patents in force on June 8, 1995, were originally issued with a term of 17 years from grant. The fact that on June 8, 1995, these patents are entitled to a term of 20 years from filing, if that term exceeds the 17-year term, does not move the original expiration date from which a period of extension continues, if granted under section 156. It only provides a new—albeit not original—expiration date. Accordingly, all patents in this category are entitled either to the 17-year term, as augmented by an extension under section 156, or to a 20-year term from the relevant filing date, whichever is longer. This determination is fully consistent with section 154(c)(1) of title 35, as added by the URAA, because extensions under section 156 are not addressed by section 154(c)(1) and are, therefore, left untouched.

Of course, all patents issued after June 8, 1995, on applications filed before that date, are also entitled to a term that is the greater of 17 years from grant or 20 years from their relevant filing date. Extensions under section 156 granted to these patents must be calculated with reference to whatever term is applicable at their time of issue and will then be added to that term. As these patents have only one term at issue, there is no question regarding their original expiration date.

Further, under the provisions of section 155 of title 35, 33 patents were extended, each for a length of time to be measured from the date a ''stay of regulation of approval was imposed'' (December 5, 1975) to the date commercial marketing was permitted (October 22, 1981). This time period amounts to 2,148 days. One of these 33 patents expired in 1992, leaving 32 in force on June 8, 1995.

Section 155 differs from section 156 in providing that ''the term of a patent * * * shall be extended * * * by a length of time * * *'', rather than that the term of a patent shall be extended ''from the original expiration date.'' This difference, however, has no practical effect because the 33 patents that originally were eligible for extension under section 155 already have been extended, as required by that provision. The provisions of section 154(c)(1), therefore, would only have had an effect, if the 20-year term to which 21 patents are entitled, exceeded the 17-year patent term, as extended by 2,148 days. Applying the provisions of section 154(c)(1) to these patents, however, reveals that its requirements are already satisfied, because all previously extended terms exceed a term of 20 years from the patents' relevant filing dates. Accordingly, section 154(c)(1) does not benefit any of the patents already extended under section 155.

Comments

Nine written comments were received in response to PTO's request for comments mentioned above. Responses to significant comments follow.

1. Comment: One comment urged that any period of patent term extension used to keep a patent in force on June 8, 1995, not be added to the 20-year term and that only the portion of the extended patent term past June 8, 1995, be added.

Response: The suggestion has not been adopted because neither section 156 of title 35, nor section 154(c)(1), as added by the URAA, contains a provision that would permit apportioning a term of patent extension in the manner suggested.

2. Comment: Two comments suggested that all patents that received an extension under section 156 prior to June 8, 1995, were extended from an ''original expiration date'' and that neither the URAA nor section 156 authorizes any alteration. It was suggested, therefore, that any patent in force on June 8, 1995, should expire either at the end of the term extension under section 156 as added to the 17-year term, or at the end of 20 years from filing, whichever is longer.

Response: The suggestion has been adopted for the reasons given above.

3. Comment: Four comments endorsed the PTO's proposal to move the term of extension from the original expiration date of the patent to its new expiration date, although two of the comments took issue with the proposal that the period of extension comply with the limitation proposed by section 156(c)(3).

Response: In light of the fact that the original PTO proposal has not been followed, the question of the applicability of section 156(c)(3) is moot. Nevertheless, it appears anomalous that some supporters of the original PTO proposal would have looked to section 156 for support of transposing the period of extension, while disclaiming the validity of other provisions in section 156 that materially affect that extension.

4. Comment: One comment suggested that the PTO certify the new patent expiration date upon the patentee's request.

Response: The suggestion has not been adopted, as this final determination of the expiration dates of