**Patent Term Adjustment Reform: A Cure for *Celanese* Monopoly-Extension Concerns**

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Imagine this: you have invented your wonderful, new widget and filed a patent application. You are eager to start negotiating licensing deals with widget manufacturers, but you are stuck in a holding pattern until the United States Patent and Trademark Office (USPTO) grants your patent application. Without knowing the exact scope of your patent claims, it is difficult to convince potential licensees of the value of your invention and of the necessity of a license.[1]

While you wait patiently, you can rest assured that your patent term will not be unfairly shortened by USPTO delays during prosecution, thanks to the Patent Term Adjustment (PTA) statute.[2] For example, an otherwise 20-year patent term is extended day-for-day when the USPTO takes longer than 14 months to issue a first office action.[3]

But do not rest on your laurels. A patent's term is *reduced* when the applicant fails to "engage in reasonable efforts to conclude processing or examination."[4] However, a patentee's delay in filing a patent application is unlikely to fit within these grounds for patent term reduction. After all, one cannot fail to conclude examination of an application that has not yet been filed.

This disconnect may catch Congress's eye if the Supreme Court agrees to review the Federal Circuit's holding in *Celanese Int'l Corp. v. Int'l Trade Comm'n*, 111 F.4th 1338, 1344 (Fed. Cir. 2024) that the on-sale bar to a process patent is triggered by selling a product secretly made by that process.[5]

If the Supreme Court finds that such a sale does not bar patenting the secret process, Congress should consider amending the PTA statute to resolve policy concerns on both sides of the *Celanese* case. For example, Congress could amend the PTA statute to require patent term reduction to equal the number of days elapsed between a patentee's first sale of a secretly-made product and the patentee's later application for a patent on the secret manufacturing process. This approach may resolve the policy concerns raised in *Celanese* by (1) encouraging disclosure while (2) precluding inventors from effectively extending their statutorily-allotted 20-year monopoly by secretly profiting from their invention for several years before being granted an ordinary patent term of 20 years.[6]

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[1] Rouget F. (Ric) Henschel, *The State of the Law of Claim Construction and Infringement*, *in* DRAFTING PATENTS FOR LITIGATION AND LICENSING 1, 1 (H. Wayne Porter, ed., 2021), https://www.americanbar.org/content/dam/aba-cms-dotorg/products/inv/book/414967736/chap1-5370253-excpt.pdf [https://perma.cc/5ESA-CWFL].

[2] 35 U.S.C. § 154(b); Dennis Crouch, *Patent Term Adjustments Cut by Applicant Delays: A 23,000 Year Impact*, PATENTLY-O (Jan. 7, 2025), https://patentlyo.com/patent/2025/01/patent-adjustments-applicant.html [https://perma.cc/7FDA-VN9J].

[3] 35 U.S.C. § 154(b)(1)(A)(i).

[4] 35 U.S.C. § 154(b)(2)(C)(i).

[5] *See* Dennis Crouch, *Text vs Precedent: Celanese and the Secret Process On-Sale Bar*, PATENTLY-O (Oct. 28, 2024), https://patentlyo.com/patent/2024/10/precedent-celanese-process.html [https://perma.cc/W839-GKQQ].

[6] *See* Dennis Crouch, *Policy Considerations: The On-Sale Bar for Secret Processes*, PATENTLY-O (Aug. 15, 2024), https://patentlyo.com/patent/2024/08/secret.html [https://perma.cc/82JS-9SU5].