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Old-School Submarine Patents

Old-school submarine patents were serious business. Throughout the late 20th Century, more than a handful of patent applicants kept patent applications pending for years-and-years until the claimed invention became market-ready. Once the patent issued, the patent would then be enforceable for seventeen-years from the issue date.

Two legal changes have eliminated most of the concerning submarine issues for newly filed applications. Patents granted on applications filed after June 7, 1995 have a term of twenty-years from the priority filing date.* In 2000, the PTO began publishing pending patent applications and now the vast majority of pending applications are published 18-months after filing.

Old patent applications, new patents: I e-mailed with a USPTO official who identified that there are about 600 still-pending patent applications that were filed before the 1995 cut-over (excluding classified applications). These old cases are all being treated as "special" and the oldest one-hundred cases are receiving special attention. In 2010, the USPTO issued patents on just over 60 of these old applications. The majority of the 2010 patents were granted to a company known as [Personalized Media Communications](#) (PMC). According to its website, PMC still has "over 100 pending patent applications" that were filed prior to the 1995 cut-over. These patents and applications are all based on a pair of applications filed in 1981 and 1987 but will be in force until at least 2027 — 46 years later.

I looked through the prosecution history of PMC's recently issued patent No. 7,734,251. The final six years of prosecution involved an appeal that was fully briefed (over a 16-month period) and then returned to the examiner for re-briefing. The BPAI eventually decided the case – affirming the rejection in-part – then, on re-hearing reversed and agreed with PMC that all of its pending claims were patentable. The prosecution is also notable for the handful of R.132 affidavits filed by various experts supporting patentability. In the end, the cases were also being handled at the SPE level. PMC is represented by Tom Scott at [Goodwin Procter](#).

Notes:

* The twenty-year term is not triggered by priority claims to either foreign national or provisional patent applications. Most patent terms are lengthened based on statutory patent-term-adjustment (PTA) due to unreasonable USPTO delays in issuing the patent.

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