Chapter 16

Patent Expiration Dates

(how long Alex's fences actually lasted—and what could shorten or extend them)

Alex decided that getting a patent wasn't the end of the story; knowing **how long it would live** (and what could change that length) was just as important. Investors asked simple questions: "How many years of protection do you have?" Competitors asked a different one: "When does this expire?" This chapter turns those questions into clear answers. We'll cover the default terms for U.S. **utility**, **design**, and **plant** patents; what starts the clock; what **shortens** term (terminal disclaimers, applicant delay, missed fees); what can **extend** term (USPTO delay adjustments and, in a few industries, regulatory extensions); and how filing choices (provisional, non-provisional, continuation, CIP, PCT) affected Alex's dates.

First principles: term is measured one way, enforceability another

- **You can't enforce** a patent until it **issues.**

- The **term** (how long the right lasts) is **measured** from specific filing dates, not from grant.
- After **publication** (~18 months from first non-provisional filing), you *may* have limited **provisional rights**—potential "reasonable royalty" from publication to grant—**only** if the infringer had **actual notice** of the published application and your **issued** claims are "substantially identical" to the published ones. It's useful leverage, not a substitute for an issued patent.

(AI)deas — Advisory:
Write a one-liner for your deck: "Filed [month, year], published [month, year], expected first action [range], typical grant [range], projected expiry [year]." It turns a foggy topic into a business timeline.

Utility patents: the 20-year rule (and the important fine print)

Default term.
For utility patents filed **on or after June 8, 1995**, the term is **20 years** from the **earliest effective U.S. non-provisional filing date** (or from the **PCT international filing date** if you entered the U.S. national stage), **not** from the provisional date, and **not** from grant.

What started Alex's clock.
Alex filed a robust provisional, then a non-provisional **nine months** later. The term ran **20 years** from the **non-provisional's**

effective filing date (or the PCT date if Alex had taken that path), regardless of the provisional.

Pre-1995 filings (rare but useful context).
Older cases (filed before June 8, 1995) generally have **17 years from grant**. That matters mostly when assessing very old patents in due diligence; it didn't affect Alex's new filings.

Maintenance fees.
Utility patents require maintenance payments at ~**3.5, 7.5, and 11.5 years** after **grant**. Miss them and the patent **lapses** early. (Chapter 13 covered the cadence and "pay-or-prune" decisions.)

Design patents: 15 years from grant

Design patents don't measure term from filing. For U.S. design applications filed **on or after May 13, 2015**, the term is **15 years from grant** (older ones: 14 years). There are **no maintenance fees** for designs. That made Alex's design filings an attractive, predictable complement to utility rights: quick allowance in many cases and a clean 15-year runway from the day the certificate arrived.

(AI)deas — Action:
If you expect the **industrial design** to be stable, file design protection as soon as the look is locked. The 15-year meter won't start until grant.

Plant patents: 20 years from filing, no maintenance

Plant patents (asexually reproduced varieties) run **20 years** from the **filing date** of the application and, like design patents, have **no maintenance fees**. Alex worked in electronics, so plant didn't apply—but if your world includes cultivars, the timing and evidence rules are different enough that you should plan early.

Two kinds of "extensions": PTA and PTE (don't mix them up)

1) Patent Term Adjustment (PTA) — USPTO delay credit (utility only)

If the USPTO takes longer than certain benchmarks, the patent can get extra days **added to the end** of term. Three broad categories contribute (in simplified English):

- **A-delay:** the Office misses early processing benchmarks (e.g., first action not mailed by a set time window).
- **B-delay:** the case isn't in condition for allowance within **three years** of actual U.S. filing (with carve-outs for applicant actions, RCEs, appeals, etc.).
- **C-delay:** unusual situations (secrecy orders, successful appeals, interferences/derivations).

Important: PTA days are **reduced** by **applicant delay** (your extensions, late replies, certain formatting fixes). And the categories don't simply stack—there's an overlap calculus.

What this meant for Alex.
Alex kept prosecution **tight**: respond early, interview examiners, avoid unnecessary extensions. That preserved PTA, which could add months—sometimes more—at the back end. PTA does **not** apply to design patents.

Terminal disclaimers and PTA.
If you file a **terminal disclaimer** to overcome an obviousness-type double patenting issue, the disclaimed patent's term is **tied** to another patent's **earlier** expiration. Practically, that can **wipe out** much or all PTA benefit; your patent can't outlive the one it's tied to. Translation: draft families smartly to **avoid** needless terminal disclaimers if term matters.

2) Patent Term Extension (PTE) — regulatory delay credit (narrow industries)

Separate from PTA, **PTE** (often in pharma/medical devices) can extend a patent that covers an FDA-regulated product to compensate for time lost in regulatory review. The cap is tightly controlled (commonly **up to 5 years**, and overall **≤14 years** of post-approval patent life). PTE didn't apply to Alex's lighting product, but if you're in therapeutics, diagnostics, or certain devices, ask counsel early which claims might be PTE-eligible and how to sequence filings.

(A) Idea Tip — Advisory:

PTA is about **USPTO delay**; PTE is about **regulatory delay**.

Different statutes, different clocks, different eligibility. Don't assume one gives you the other.

Things that shorten term (often quietly)

- **Terminal disclaimers.** Tying a later patent to an earlier one cuts the later patent's term to match the earlier expiration and requires **common ownership** for enforceability. Use only when truly needed to overcome double-patenting; plan claim scope up front to avoid the trap.

- **Applicant delay.** Every day you take past the standard response window can reduce PTA. Alex answered early and scheduled interviews quickly to preserve days.

- **Missed maintenance fees (utility).** Lapse ends enforceability. Revival is sometimes possible (with surcharge and standards for "unintentional delay"), but don't bank on it.

- **Disclaimers or corrections done carelessly.** Most corrections don't change term, but a strategy misstep can interact badly with PTA or family timing. Keep a paper trail and get counsel eyes on anything that touches ownership or disclaimers.

Filing choices that move—or don't move—the clock

- **Provisional applications** do **not** start the patent term. They secure **priority** for supported subject matter. The clock starts with the **non-provisional** (or PCT) you file within **12 months**.

- **PCT (international) filing** date **does** start the U.S. utility term when you later enter national stage.

- **Continuations** (CON): term is measured from the **earliest U.S. non-provisional** you claim priority to. A continuation keeps the family alive but **doesn't give you a later term.**

- **Divisionals** (DIV): same—term measured from the earliest non-provisional in the chain. Divisionals split inventions per restriction practice; they don't reset the 20-year clock.

- **Continuations-in-part** (CIP): the entire patent's term is measured from the **earliest non-provisional** you rely on—even if the claims mainly cover **new matter** added in the CIP. CIPs can **shorten** your term relative to a brand-new standalone filing. Use CIPs sparingly and intentionally.

(AI)deas — Avoidance:
If the **new** material will carry the commercial load, consider a **fresh, standalone** application (no priority claim) for a **fresh 20-year** term—accepting that you can't back-date priority for the old subject matter in that case. It's a strategic trade.

Alex's example: turning dates into a plan

Suppose Alex filed:

- **Provisional:** March 1, 2026
- **Non-provisional:** December 1, 2026 (three months before the 12-month deadline)
- **Grant:** April 10, 2029 (dates here are illustrative)

Utility term baseline: 20 years from **Dec 1, 2026 → Dec 1, 2046**, **plus** any PTA, **minus** any applicant delay.
Design grant (filed mid-2026): if it issues on January 15, 2028, the term runs to **January 15, 2043** (15 years from grant).
Maintenance (utility): fees due roughly **Oct 2032**, **Oct 2036**, and **Oct 2040** (3.5/7.5/11.5 years from grant).
Continuation filed before parent issue: it will **share** the Dec 1, 2026 term date (no fresh 20-year term), but lets Alex pursue different claim angles as the market evolves.

Practical result: Alex can talk about **design coverage** through 2043 and **utility coverage** projected to 2046 (+PTA). That framed partner negotiations and internal product roadmaps.

Portfolio strategy: staggering families so you're not "naked"

Because continuations and divisionals **don't** refresh term, Alex avoided a cliff by:

- Filing a **new** application (with truly new matter) at a logical product generation change, yielding a **new** 20-year clock for the next wave.

- Timing **design** filings for major face-lifts to get a fresh 15-year runway from each grant.

- Avoiding **unnecessary terminal disclaimers**, which can shackle a later patent's term to an earlier one and erase PTA benefit.

This way, the **overall** portfolio always had **claims in force** that matched what was on the market, even as older claims aged out.

Europe and abroad (quick perspective)

- Many jurisdictions measure **utility** term as **20 years from filing**, similar to the U.S. (without the exact same PTA rules).

- **Design/registered designs** abroad carry their own term structures (e.g., EU registered design up to 25 years with renewals).

- Timing still matters: public disclosures before filing can kill foreign options that the U.S. grace period would otherwise forgive. Alex coordinated filing dates to preserve both **term** and **eligibility**.

Common confusions (and Alex's plain-English fixes)

- **"Our provisional gives us 21 years, right?"** No. The provisional doesn't count toward term; the **non-provisional** starts the 20-year clock.
- **"A continuation will reset the clock."** No. It inherits the **earliest** non-provisional's date.
- **"We can always add PTA later."** You don't **add** it later; it accrues based on Office delay and is reduced by **your** delay. Preserve it by responding early.
- **"A CIP is always better because it carries old priority."** CIPs can **shorten** term for claims aimed at new material. Sometimes a **fresh** case is the smarter play.
- **"Designs expire too fast to matter."** 15 years from grant is real time—often overlapping the entire commercial life of a product look.

The (AI)deas thread: AI helps calendars, not doctrine

Alex used AI to **watch deadlines** and generate a simple **term dashboard** (filings → projected grants → expiry years) and to flag when terminal disclaimers might be lurking (based on claim comparisons). But AI didn't decide legal term questions. Human counsel checked: **which filing date actually governs**, whether PTA was calculated correctly, and whether a terminal disclaimer would quietly gut term on a child case.

(AI)deas — Action:
Keep a one-page **Term Sheet** per family: earliest non-provisional date, PCT date if any, grant date, maintenance windows, PTA tally (running), terminal disclaimer risk/links, and projected expiry. Glanceable beats guessable.

A short checklist you can run today

- Identify the **earliest non-provisional** date for each utility family (or PCT date). That's the **term anchor**.
- List **grant dates** for designs; add **+15 years** for quick expiry math.
- Note any **terminal disclaimers**; assume they tie term to an earlier case.
- Track **PTA** and **applicant delay**; aim to answer Office Actions **early**.
- Calendar utility **maintenance** windows now; decide **pay vs. prune** 60–90 days ahead.
- Decide whether the **next wave** of innovation deserves a **fresh** application to earn a **fresh** term.

- Keep your **Term Sheet** updated; use it in partner and investor conversations.

Why this chapter mattered to Alex

Term is leverage. Alex didn't just own a certificate; Alex owned a **timeline**—one that investors could underwrite, partners could plan around, and competitors had to respect. By understanding the default rules (20 years from the non-provisional for utility; 15 from grant for design), respecting what **shortens** term (terminal disclaimers, applicant delay, missed maintenance), and capturing what **extends** it (PTA where available, PTE where applicable), Alex kept the portfolio both honest and effective. The end result wasn't a surprise date circled on a far-off calendar—it was a **managed runway** that matched the product's life and the business's goals.