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In re Patent No. 9,005,660 :
Tygesean, et al. : FINAL AGENCY DECISION
Issue Date: April 14, 2015 : ON REQUEST FOR
Application No. 12/701,248 : RECONSIDERATION OF
Filing or 371(c) Date: February 5, 2010 : PATENT TERM ADJUSTMENT
Docket No.: 108221-0118 :

This is a response to applicants' "Request for Reconsideration of Patent Term Adjustment" filed October 7, 2015, requesting that the Office reconsider the patent term adjustment (PTA) of 473 days to 819 days. The Office has re-determined the PTA to be 473 days.

The request is **DENIED**.

This decision is the Director's decision on the applicant's request for reconsideration for purposes of seeking judicial review under 35 U.S.C. § 154(b)(4).

On April 14, 2015, the above-identified application matured into U.S. Patent No. 9,005,660. The patent issued with a patent term adjustment (PTA) of 473 days. On June 10, 2015, patentees filed a request to reconsider the patent term adjustment. On August 14, 2015, the Office mailed a communication by which the Office determined that the patent term adjustment is 473 days. The present request for redetermination of the patent term adjustment was timely filed.

The present petition

Patentee dispute the reduction to the patent term adjustment of 346 days for the filing of an Information Disclosure Statement (IDS) on October 3, 2013. In summary, patentees maintain that the filing of an IDS after the filing of a Request for Continued Examination under 37 CFR 1.114, but prior to the mailing of an Office action does not amount to a delay in prosecution and is the same as filing an IDS after filing a new application. Patentee further argues that the USPTO has applied that the provisions of 37 CFR 1.704(c)(8) inconsistently.

Governing Statutes, Rules, and Regulations

35 U.S.C. 154(b)(2)(A) (C)

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

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(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

37 CFR 1.704(c)(8)

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

Discussion

The Office has revisited the reduction to the patent term adjustment of 346 for the filing of an IDS on October 3, 2013, three hundred and forty-six days after a RCE was filed on October 22, 2012. Patentees' arguments have been considered but are not persuasive. Congress expressly delegated authority to the Director to "prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application." 35 U.S.C. 154(b)(2)(C)(iii). The basis for the reduction of PTA for the submission of the IDS on October 3, 2013, after filing a reply to final Office action on October 22, 2012, is 37 CFR 1.704(c)(8) which allows for a reduction to the patent term adjustment for submission of a supplemental reply, or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed. In the case of an IDS, the IDS may not subject the application to a reduction of the patent term if the IDS is

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accompanied by a statement under 37 CFR 1.704(d). A review of the application file did not reveal that the examiner expressly requested the IDS to be filed and that the IDS was not accompanied by a statement under 37 CFR 1.704(d). A reduction to the patent term adjustment of 346 days was entered with the period being calculated beginning on October 23, 2012, the day after the date the RCE was filed, and ending on October 3, 2013, the date the IDS was filed. The reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(8).

With respect to determining the applicable provisions for calculating applicant delay, the designation in PAIR after the filing of the RCE of the application as “Docketed New Case – Ready for Examination” is not controlling. What is material is that an RCE is not the filing of a new application. *See* 35 U.S.C. 132(b), 37 CFR 1.114 and MPEP 706.07(h). Rather, an RCE is a reply authorized under 35 U.S.C. 132(b), while filing an application is authorized under 35 U.S.C. 111. An RCE is a request by an applicant for continued examination which is effectuated by filing a submission and paying a specified fee. As used in this instance, the RCE was the reply to a final Office action. Thus, the IDS filed after the RCE was an “other paper ... after a reply has been filed,” within the meaning of 37 CFR 1.704(c)(8) and constituting applicant delay. Accordingly, the period of reduction for applicant delay for the submission of the IDS after the filing of the RCE was properly calculated pursuant to 37 CFR 1.704(c)(8), not 37 CFR 1.704(c)(6).

Moreover, as the applicant delay at issue involves an IDS (other paper) filed after a RCE (reply) to an Office action, the situation is analogous to decision in *Gilead Sciences, Inc. v. Lee*, 778 F.3d 1341 (Fed. Cir. 2015), which involved an IDS filed after a reply to a restriction requirement. In *Gilead*, the court noted that the filing of an IDS after an initial reply to a restriction requirement makes it increasingly difficult for the USPTO to satisfy the statutory-mandated time requirement in 35 U.S.C. § 154(b)(1)(A)(ii) to conclude the application process because of significant time constraints faced by the USPTO. *See Gilead* at 1350-51. “Because the A Delay provision of the statute penalizes the PTO if the examiner fails to respond within four months of the applicant’s response to the restriction requirement, any relevant information received after an initial response to a restriction requirement ‘interferes with the [PTO’s] ability to process an application.’” *Id.* at 1350 (quoting *Gilead Scis, Inc. v. Rea*, 976 F.Supp.2d 833, 837 (2013) (“*Gilead I*)). “[A] supplemental IDS ... [may] force[] an examiner to *go back* and review the application again, while still trying to meet his or her timeliness obligations under § 154.” *Id.* at 1350 (quoting *Gilead I* at 837-38).

The same analysis applies to the submission of an IDS document after filing a RCE and submission in response to a final rejection. The Office must respond to the reply in the form of a RCE and submission under § 1.114(c) within four months of its filing or provide additional “A” delay. The submission of an IDS after the filing of a response in the form of an RCE “interferes” with the USPTO’s ability to process an application because it adds additional documents the examiner must consider before responding to the reply. *See Gilead* at 1351. Patentee’s related argument that the deduction is inconsistent with the statute because an IDS reflects an effort to advance prosecution is not persuasive since the submission of an IDS after an RCE has been

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submitted interferes with the Office's ability to process the application as the examiner may be forced to go back and review the application again.

Patentee's final argument that the deduction is not consistent with the Office's practice because the Office has not consistently charged an Applicant Delay when an IDS is filed subsequent to an RCE and before an action has been mailed in reply to the RCE is not persuasive as no delay would accrue if the IDSs were accompanied by a proper statement under 37 CFR 1.704(d) or the IDSs were expressly requested by the examiner. Moreover, assuming *arguendo*, that the Office has not consistently applied 37 CFR 1.704(c)(8), the Office possess inherent authority to reconsider its decision. See *Japanese Found. for Cancer Research v. Lee*, F.3d 1300 (Fed. Cir. 2014). Moreover, the Office is not compelled to continue to make errors that it may have made in the past once the Office recognizes its prior errors. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016) ("The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect."); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) ("Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant's marks.") (citation omitted); *In re Ric-Wil Co.*, 87 F.2d 516, 32 USPQ 396 (CCPA 1937) ("The applicant cites a large number of marks registered by the office recently, which are claimed to be more descriptive than the one here involved. Even if this be true, it constitutes no reason why the registration of appellant's mark should be allowed, if it be descriptive. Administrative errors cannot change the law.")

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

783 + 64 + 0 - 0 - 374 = 473

Applicants' Calculation:

783 + 64 + 0 - 0 - 28 = 819

Conclusion

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Patentee is entitled to PTA of four hundred and seventy-three (473) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $783 + 64 + 0 - 0 - 374 = 473$

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Attorney Advisor, at (571) 272-3222.

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