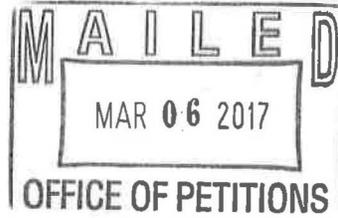




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In re Patent of Biedermann et al. :
Patent No. 9,198,702 : FINAL AGENCY DECISION ON
Issue Date: December 1, 2015 : REQUEST FOR INFORMATION
Application No. 13/034,574 : OF PATENT TERM ADJUSTMENT
Filing Date: February 24, 2011 :
Attorney Docket No.: 66013/B884 :

This is a decision on the “REQUEST FOR RECONSIDERATION OF THE REDETERMINATION OF PATENT TERM ADJUSTMENT (37 C.F.R. §1.705(b))” (“Request 2”), filed June 13, 2016, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent to six hundred thirty-five (635) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment (“PTA”) is **DENIED**. The patent adjustment determination under 35 U.S.C. § 154(b) is six hundred and two (602) days.

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).

Relevant Procedural History

The patent issued with a PTA determination of 553 days on December 1, 2015. A Request seeking a PTA of 635 days was timely filed on February 1, 2016. The Office issued a REDETERMINATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION (“Redetermination”) on April 14, 2016, which calculated a PTA of 602 days. Request 2 was timely filed on June 13, 2016.

Art Unit: OPET

Decision

The PTA set forth in the April 14, 2016 Redetermination is based on the following calculations previously made by the Office:

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 281 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 637 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) ("C Delay") is 0 days;
- (4) The number of days of overlapping delay ("Overlap") between the periods of A Delay, B Delay, and C Delay is 0 days; and
- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) ("Applicant Delay") is 316 days.

The PTA is the sum of the days of A Delay, B Delay, and C Delay reduced by the number of days of Overlap and Applicant Delay. In other words, the following formula may be used to calculate the PTA:

$$\text{PTA} = \text{A Delay} + \text{B Delay} + \text{C Delay} - \text{Overlap} - \text{Applicant Delay}$$

The Redetermination sets forth a PTA of 602 days (281 days of A Delay + 637 days of B Delay + 0 days of C Delay - 0 days of Overlap - 316 days of Applicant Delay).

Request 2 does not dispute the Office's calculations of the periods of A Delay, B Delay, C Delay, and Overlap.

Request 2 argues a 4 day period of reduction, not a 37 day period of reduction, is warranted pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on October 26, 2015, after a Notice of Allowance was mailed on July 24, 2015. The Request asserts the period of Applicant Delay is 283 days (91 + 89 + 8 + 91 + 4) days.

Request 2 argues the correct PTA is 635 days (281 days of A Delay + 637 days of B Delay + 0 days of C Delay - 0 days of Overlap - 283 days of Applicant Delay).

As will be discussed, the period of Applicant Delay is 316 days.

Therefore, the correct PTA is 602 days (281 days of A Delay + 637 days of B Delay + 0 days of C Delay - 0 days of Overlap - 316 days of Applicant Delay).

A Delay

Request 2 does not disputes the Office's prior determination the period of A Delay is 281 days. The Office has recalculated the period of A Delay as part of the Office's redetermination of the PTA and confirmed the period of A Delay is 281 days.

Art Unit: OPET

B Delay

Request 2 does not dispute the Office's prior determination the period of B Delay is 637 days. The Office has recalculated the period of B Delay as part of the Office's redetermination of the PTA and confirmed the period of B Delay is 637 days.

C Delay

Request 2 does not dispute the Office's prior determination the period of C Delay is 0 days. The Office has recalculated the period of C Delay as part of the Office's redetermination of the PTA and confirmed the period of C Delay is 0 days.

Overlap

Request 2 does not dispute the Office's prior determination the number of days of Overlap is 0 days. The Office has recalculated the number of days of Overlap as part of the Office's redetermination of the PTA and confirmed the number of days of Overlap is 0 days.

Applicant Delay

Request 2 disputes the Office's prior determination the number of days of Applicant Delay is 316 days. The Office has recalculated the number of days of Applicant Delay as part of the Office's redetermination of the PTA and confirmed the number of days of Applicant Delay is 316 days. The sole calculation in dispute is the length of reduction warranted pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on October 26, 2015, after a Notice of Allowance was mailed on July 24, 2015.

The pertinent regulation to the analysis is 37 CFR 1.704(c)(10). 37 CFR 1.704(c) provides that:

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:

- (10) Submission of an amendment under § 1.312 or other paper, other than a request for continued examination in compliance with § 1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
 - (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

Art Unit: OPET

or

(ii) Four months;

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Applicant's attention is drawn to the rule itself which states an amendment under 37 CFR 1.312 is a paper that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application.

The Request asserts a 4 day period of reduction, not a 37 day period of reduction, is warranted pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on October 26, 2015. A Notice of Allowance was mailed on July 24, 2015. On October 26, 2015, applicants filed a Rule 312 amendment. Applicants argue the examiner's annotation on the first page of the Rule 312 amendment is the clock stopper for the calculation under 37 CFR 1.704(c)(10). Applicants concede no correspondence was mailed in response to the October 26, 2015 Rule 312 amendment. However, Request 2 asserts the Office failed to follow the procedures outlined in MPEP 714.16(d), which states, "...[W]hether the amendment is entered or not entered, the file, drawing, and unmailed notices are forwarded to the supervisory patent examiner for consideration, approval, and mailing." Request 2 argues the delay should not be considered to be Applicant Delay because the Office did not follow the procedures outlined in MPEP 714.16(d). Request 2 submits the 32 days of Applicant Delay (from the date of the Examiner's initialed copy of the Amendment under Rule 312 to the issue date) should be removed. Alternatively, Request 2 submits that the period from the mailing of the November 11, 2015 Issue Notification until the December 1, 2015 issue date should be removed.

The Office finds the 37 CFR 1.704(c)(10)(i) calculation begins on October 26, 2015, the date the Rule 312 amendment was filed, and ends on December 1, 2015, the date the patent issued.

Per 37 CFR 1.704(c)(10)(i) the end date of the calculation is the "mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper." The Office did not mail an Office action or notice in response to the amendment under § 1.312. The Examiner's initialed copy of the Amendment under Rule 312 is an internal document, used for communication between the Office of Data Management and the examiner. As noted in the PAIR screen, it was a "Printer Rush – No mailing". The November 11, 2015 Issue Notification was not mailed in response to the October 26, 2015 Amendment under Rule 312. An Issue Notification is mailed after the issue fee has been paid and processed by the USPTO. MPEP 1306.03 Practice After Payment of Issue Fee; Receipt of Issue Notification. An Issue Notification is not an Office action or notice mailed in response to a Rule 312 amendment.

Art Unit: OPET

In the circumstance where the Office does not mail a response to the paper that triggered the delay and the patent issues in less than four months, the Office has treated the issuance of the patent as the response to the paper that triggered the delay. Accordingly, under such circumstance, the Office has calculated the period of reduction for applicant delay counting the number of days beginning on the date of filing of the triggering paper and ending on the date of patent grant.

As nothing was mailed to applicant, the end date of the calculation is the issue date of the patent, December 1, 2015, which is less than 4 months. The period of reduction begins on October 26, 2015, the date the Rule 312 amendment was filed, and ends on December 1, 2015, the date the patent issued. No change will be made to the 37 day period of reduction assessed under 37 CFR 1.704(c)(10) in connection with the Rule 312 amendment, filed October 26, 2015.

The period of Applicant Delay is 316 days (91 + 89 + 8 + 91 + 37).

Conclusion

Request 2 asserts the correct PTA is 635 days (281 days of A Delay + 637 days of B Delay + 0 days of C Delay – 0 days of Overlap – 283 days of Applicant Delay).

As previously discussed, the period of Applicant Delay is 316 days.

Therefore, the PTA is 602 days (281 days of A Delay + 637 days of B Delay + 0 days of C Delay – 0 days of Overlap – 316 days of Applicant Delay).

Telephone inquiries specific to this decision should be directed to Attorney Advisor Shirene Willis Brantley at (571) 272-3230.

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