From: James Longfellow [redacted]
Sent: Monday, August 18, 2014 11:48 PM
To: AC96.comments
Subject: Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee, 79 FR 34681 (June 18, 2014)

Dear Mr. Fries:

In the final rule making notice, I would appreciate if the Office would consider and provide clarification on the following issues:

(1) In proposed Rule 1.703(b)(1), the day of allowance is excluded from B-Delay, which seems contrary to the Novartis holding ("[**A]llowance**-to-issuance time is not to be distinguished according to whether there is a continued examination in a prosecution.... The common-sense understanding of "time consumed by continued examination ... is time **up to** allowance, but not later, unless examination on the merits resumes.") (emphasis added). The Office should allow B-Delay on the day of allowance, which is consistent with the reasoning of Novartis that "[s]uch time from allowance to issuance undisputedly would count toward the PTO's three-year allotment in a case not involving a continued examination." Note that proposed Rule 1.704(c)(12), which potentially subtracts the day of allowance as applicant delay, would be a double penalty if B-Delay is not even available on that day.

(2) In proposed Rule 1.704(c)(12), the Office creates a new type of PTA reduction by characterizing the filing of an RCE after allowance as per se unreasonable applicant delay (i.e., "a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application"). This filing (common in some types of applications to submit an IDS) was not previously considered to be unreasonable delay. The stated purpose of the new reduction is to ensure an applicant does not obtain multiple periods of B-Delay for the time after a notice of allowance as a consequence of delaying issuance of the application by filing an RCE after allowance. However, multiple periods of B-Delay are permissible under the statute, and how the filing of an RCE reduces B-Delay is already provided for in 35 USC 154(b)(1)(B)(i) as interpreted in light of Novartis. It would be helpful for the Office to provide further explanation of how an RCE (compared to other methods of submitting an IDS) causes delay, and why such a submission is now per se unreasonable.

(3) In applications where there is no B-Delay (or less B-Delay than the PTA reduction), based on its stated purpose, proposed Rule 1.704(c)(12) will over penalize some patentees.

(4) The notice suggests that applicants use the QPIDS pilot program to submit an IDS after the payment of the issue fee. Under QPIDS, if the conditional RCE is processed and prosecution is reopened, please clarify whether the RCE will still be considered applicant delay--this seems problematic under an unreasonable delay standard since the applicant will have followed the suggested procedure.

(5) In setting the applicability date of proposed Rule 1.704(c)(12), please consider a prospective date to ensure applicants are given adequate time to adapt their prosecution practice to avoid the

new reduction. See 79 FR at 34684 (“[A]pplicants may avoid any consequences from [proposed Rule 1.704(c)(12)] simply by refraining from filing a request for continued examination under 35 USC 132(b) after a notice of allowance under 35 USC 151 has been mailed.”).

(6) Please confirm that the filing of an RCE after allowance does not generate applicant delay pursuant to 37 CFR 1.704(c)(10), which appears to be the current Office interpretation.

Thank you for your consideration.

Sincerely,

James P. Longfellow
Reg. No. 37,665