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In re Application of :
Gass, Stephen, F. : DECISION ON RENEWED
Application No. 12/806,829 : APPLICATION FOR
Filed: 20 Aug 2010 : PATENT TERM ADJUSTMENT
For: Power equipment with detection and : UNDER 37 CFR 1.705(b)
reaction systems :

This is a request for reconsideration of the redetermination issued December 18, 2017, which was timely filed on February 8, 2018. Patentee is requesting a determination of at least 1034 days of Patent Term Adjustment be issued.

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).

Relevant Procedural History

On December 20, 2016, the above-identified application issued as U.S. Patent No. 9,522,476 with 193 days of Patent Term Adjustment (PTA). On February 13, 2017, patentee filed a request for patent term adjustment under 37 CFR 1.705(b) requesting that the Office revise the amount of PTA to at least 1034 days. On December 18, 2017, the Office mailed a redetermination of the amount of PTA and recalculated the PTA to be 193 days. On February 8, 2018, patentee filed the Renewed Application for Patent Term Adjustment Under 37 CFR 1.705(b) seeking reconsideration.

Decision

Patentee and the Office are in agreement as to the amount of "A" delay under 35 U.S.C. §154(b)(1)(A), "B" delay under 35 U.S.C. §154(b)(1)(B), overlapping periods under 35 USC §154(b)(2)(A), and applicant delay under 35 U.S.C. §154(b)(2)(C)(ii) and (iii). Patentee and the Office are in disagreement as to the amount of Patent Term delay awarded under the "C" delay 35 U.S.C. §154(b)(1)(C).

“A” delay

The Office and Patentee agree that the amount of “A” delay is 78 days. The “A” delay of 78 days was calculated as follows:

(1) 69 days under 37 CFR 1.702(a)(1) beginning on October 21, 2011 (day after the date that is fourteen months from the filing date of the application) and ending on December 28, 2011 (mail date of the first Office action).

(2) 9 days under 37 CFR 1.702(a)(4) beginning on December 12, 2016 (day after the date that is four months from the date the issue fee was paid) and ending on December 20, 2016 (the issue date).

“B” delay

The Office and Patentee agree that the amount of “B” delay is 218 days.

The Office has calculated **218** days of “B” delay.

The amount of “B” delay is calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of 35 U.S.C. 154(b)(1)(B)) and determining the extent to which the result exceeds three years. *Novartis*, 740 F.3d at 601.

The length of time between application filing and issuance is [###] days, which is the number of days beginning October 22, 2012, the date the application was filed, and ending June 5, 2018, the date of patent issuance.

The time consumed by continued examination is **Basis document by asharples on 2017-09-18T12:23:48 via C:/FpNormalDir-git/build/perl/make_basis_docs.pl** days. The time consumed by continued examination includes the following period(s):

- A period of **159** days, beginning February 11, 2016 (the filing date of the first RCE) and ending July 18, 2016 (the mailing date of a notice of allowance).

The number of days beginning on filing date (August 20, 2010) and ending on the date three years after the filing date (August 20, 2013) is **[1096/1097]** days.

The result of subtracting the time consumed by continued examination (Basis document by asharples on 2017-09-18T12:23:48 via C:/FpNormalDir-git/build/perl/make_basis_docs.pl days) from the length of time between the application filing date and issuance ([###] days) is 2156 days, which exceeds three years ([1096/1097] days) by 1059 days. In addition, the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). Here, the period consumed by appellate review was 841

days, which is excluded from the calculated 1059 days. Therefore, the period of “B” delay is 218 days.

“C” delay

The Office calculated “C” delay as 0 days. Patentee disagrees, and asserts that “C” delay should be 841 days.

At issue is “C” delay and the Patent Trial and Appeal Board (Board) decision mailed August 31, 2015. In that decision, the Board affirmed the rejection of claims 1, 2, 5, and 9 – 11, but denominated their affirmance of claim 11 as a new ground of rejection.

Petitioner argues that the Board reversed the examiner’s rejection of claim 11, by stating that “the Examiner has not made the initial factual findings required to demonstrate a prima facie case of obviousness of claim 11.”

Petitioner asserts that under 35 U.S.C. §154(b)(1)(C)(iii), the term of the patent should be adjusted because “the patent was issued under a decision in the review reversing an adverse determination of patentability.” Patentee argues that the rejection of claim 11, which was denominated as a new ground of rejection in the Board’s decision of August 31, 2015, constituted an adverse determination of patentability. Accordingly, the patentee asserts that the Office should have been assessed 841 days of “C” delay for the mailing of a decision by the Patent Trial and Appeal Board on August 31, 2015.

Patentee’s argument has been considered, but is not persuasive. It is undisputed that the Board decision mailed August 31, 2015 subjected claim 11 to a new rejection. The Office has previously set forth its interpretation §154(b)(1)(C)(iii) in a response to comments published in the Federal Register that a “final decision in favor of applicant is understood to include any final decision of the Board...that reverses all of the rejections of at least one claim (without subjecting the claim to a new rejection)”.¹ This interpretation was done shortly after the statutory provision was enacted and before the provision was effective. Specifically, the comments included the following example:

If claims 1 and 2 are pending, claims 1 and 2 stand rejected under 35 U.S.C. §102, the rejection of claims 1 and 2 under 35 U.S.C. §102 is reversed, and the decision by the Board of Patent Appeals and Interferences enters a new ground of rejection of claims 1 and 2 under 35 U.S.C. §103 (§1.196(b)), and a patent is issued as a result of further prosecution before the examiner, the patent was not issued under a decision in the review reversing an adverse determination of patentability.²

The statutory requirements relating to Office Delay for Appeal time do not, therefore, include the scenario where the claim remains under rejection after the Board decision as is the case in the case at issue. In those situations, the patent only issues after further prosecution has occurred

¹ Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 181 (September 18, 2000), at 56376.

² Id at 56370.

including in this case an amendment to the claim after the new ground was introduced in the Patent Trial and Appeal Board decision. Accordingly, the claim was not issued under a decision in the review reversing an adverse determination of patentability. Claim 11 was only issued after it was amended and only as a result of further prosecution of the application before the examiner. Moreover, it is further noted that appellant's submission of an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board under a new grounds of rejection, the argument will be treated as a request for rehearing under 37 CFR 41.52. See MPEP 1214.01. Thus, if the petitioner believed the new grounds was not appropriate and sought to obtain term adjustment for the period of appellate review, petitioner may have requested reconsideration of the new grounds of rejection. Petitioner in this case opted to have additional prosecution of an amended claim before the examiner and obtained a patent for the amended claim. Making that choice resulted in the loss of term adjustment for the period of appellate review.

It is noted that Congress has revised 35 U.S.C. § 154 several times³ after the Office set forth its interpretation of 35 U.S.C. §154(b)(1)(C)(iii) in 2000. The serial reenactment of 35 U.S.C. § 154 with no change to §154(b)(1)(C)(iii) is strong evidence that the Office interpretation is correct. See Zemel v. Rusk, 85 S.Ct. 1271, 1278.

Overlap between “A” and “B” delay

The Office and Patentee agree that the amount of overlap between “A” and “B” delay is 9 days. The overlapping period begins on 12-12-2019(day after the date that is four months from the payment of the issue fee and all other requirements being satisfied) and ending on December 20, 2019(date of issuance of the patent). During this time patent term adjustment was occurring both under the “A Delay” (37 CFR 1.702(a)(4)) and under the “B delay” for not issuing within three years of the filing date.

Reduction under 37 CFR 1.704 (Applicant Delay)

Petitioner does not dispute the Offices prior determination of the days of Applicant Delay. Applicant delay of 94 days was calculated as follows:

(1) 87 days under 37 CFR 1.704(b) for filing a reply on August 17, 2012, in response to an Office action mailed on February 22, 2012. The delay was for the period beginning on May 23, 2012(day after the date that is three months from the mailing of the non-final rejection) and ending on August 17, 2012 (date of filing of the reply to the non-final rejection).

(2) 2 days under 37 CFR 1.704(b) for filing an RCE on February 11, 2016, in response to a final Office action mailed on November 9, 2015. The delay began on February 10, 2016 (day after the

³ Subsection (b)(4) was amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904; subsection (d)(4)(A) was amended Nov. 2, 2002, Public Law 107-273, sec. 13204, 116 Stat. 1902; subsection (b)(4)(A) was amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011), 20(j) (effective Sept. 16, 2012), and 3(j) (effective March 16, 2013), 125 Stat. 284; subsection (b) was amended Jan. 14, 2013, Public Law 112-274, sec. 1(h), 126 Stat. 2456; and subsections (a) and (d)(1) were amended Dec. 18, 2012, Public Law 112-211, sec. 102(6) (effective May13, 2015), 126 Stat. 1531.

date that is three months from the mailing of the final rejection) and ending on February 11, 2016(date of filing of the RCE).

(3) 5 days under 37 CFR 1.704(c)(10) for filing a Rule 312 Amendment on August 4, 2016. The delay began on August 4, 2016 (date of submission of the 312 amendment) and ending on August 8, 2016 (date of mailing of a response to the 312 amendment).

Conclusion

Patentee is entitled to PTA of one hundred ninety-three (193) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $78 + 218 + 0 - 9 - 94 = 193$ days.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Cliff Congo at (571) 272-3207.

/ROBERT CLARKE/
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