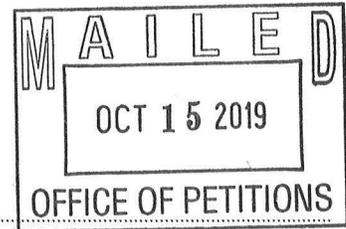




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In re Application of :  
Coffey et al. :  
Application No. 14/391,643 : DECISION ON PETITION  
Filed: 9 Oct 2014 :  
For: MICROFLUIDIC DEVICE, SYSTEM :  
AND METHOD :

This is a decision in response to application for patent term adjustment filed January 31, 2019, requesting that the patent term adjustment determination for the above-identified patent be changed from 741 days to 745 days.

The application for patent term adjustment is **DENIED**.

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

**RELEVANT PROCEDURAL HISTORY**

On December 4, 2018, the Office determined that Patentee was entitled to **741** days of patent term adjustment.

On January 31, 2019, Patentee timely filed the instant request for reconsideration of the patent term adjustment under 37 CFR 1.705(b), seeking an adjustment of the determination to **745** days.

**DECISION**

Upon review, the Office finds that Patentee is entitled to **seven hundred forty-one (741) days** of patent term adjustment.

Patentee and the Office are in disagreement regarding **424** days of delay under 35 USC 154(b)(1)(A) ("A" delay) in connection with the first Office action issued on February 10, 2017. Patentee and the Office are not in disagreement regarding the amount of "B" delay under 35 U.S.C. 154(b)(1)(B); the amount of "C" delay under 35 U.S.C. 154(b)(1)(C); the amount of overlap under 35 U.S.C. 154(b)(2)(A), or applicant delay under 35 U.S.C. 154(b)(2)(C).

“A” Delay

The request under 37 CFR 1.705(d), filed January 31, 2018, asserts that the Office incorrectly calculated the period of A delay. Specifically, the request asserts that correct period of A delay is 428 days, not 424 days previously calculated by the Office.

The “A” delay was calculated as follows:

(1) **424 days** under 37 CFR 1.702(a)(1) beginning on December 15, 2016 (the day after the date 14 months after the Commencement Date) and ending on February 10, 2017 (mail date of the first Office action).

Patentee argues that the Office should be accorded 428 days of PTO delay pursuant to 37 C.F.R. 1.703(a)(1). Patentee asserts that in calculating 424 days, the Office used the date the first Office action was entered in PAIR (February 6, 2017), and not the date it was mailed (February 10, 2017). Patentee’s argument has been considered, but is not persuasive.

On January 14, 2013, President Obama signed into law H.R. 6621, which makes technical corrections to the Leahy-Smith America Inventors Act and title 35 of the United States Code.

The Office amended several regulations in order to implement changes made by the AIA Technical Corrections Act (H.R. 6621). See Revisions to Patent Term Adjustment (Interim Final Rule), 78 Fed. Reg. 19416 (April 1, 2013).

The Office amended 37 C.F.R. § 1.703(a) to read as follows, with emphasis added:

The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]<sup>1</sup>

The changes made to 37 C.F.R. § 1.703(a) apply to all patents issued on or after January 14, 2013, and the instant application issued as a patent on December 4, 2018. Therefore, the changes made to 37 C.F.R. § 1.703(a) apply to this case.

In view of the prior discussion, the period of A-1 delay should be based on the date the national stage commenced (“Commencement Date”) instead of the Date of Completion.

The date the national stage of an international application commences is addressed in MPEP § 1893.01, which states, with emphasis added,

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<sup>1</sup> See Revisions to Patent Term Adjustment (Interim Final Rule), 78 Fed. Reg. 19416, 19420 (April 1, 2013).

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, *in the absence of an express request for early processing* of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, *the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application.*

The October 9, 2014 papers do not include a request for early processing. Therefore, the national stage commenced upon the expiration of 30 months from the priority date of the international application.

The date 30 months after April 11, 2012, which is the priority date of the international application, is October 11, 2014. As October 11, 2014 fell on a Saturday, and October 13, 2014 fell on a federal holiday, the Commencement Date began on the next succeeding business day. See PCT Rule 80.5. See also *Actelion v. Matal*, 881 F.3d 1339, 1344-6 (Fed. Cir. 2018). Therefore, the Commencement Date is Tuesday, October 14, 2014.

The correct period of A-1 Delay is **424 days**, which is the number of days beginning December 15, 2015, the day after the date 14 months after the Commencement Date, and ending February 10, 2017, the date the Office mailed the first Office action.

#### “B” Delay

Patentee and the Office agree that the “B” delay is **351 days**.

The amount of “B” delay is calculated by determining the length of the time between application filing and patent issuance, then subtracting and 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. See *Novartis v. Lee*, 740 F.3d 593 at 601 (Fed. Cir. 2014).

The length of time between application filing and issuance is **1513 days**, which is the number of days beginning on the Commencement Date of the application (October 14, 2014) and ending on the date the patent issued (December 4, 2018).

The time consumed by continued examination is **65 days**, beginning on the date of May 23, 2018 (date of filing of the RCE) and ending on July 26, 2018 (date of mailing of the notice of allowance).

The number of days beginning on the Commencement Date of the application (October 14, 2014) and ending on the date three years after the Commencement Date of the application (October 14, 2017) is **1513 days**.

The result of subtracting the time consumed by continued examination (65 days) from the length of time between the application's Commencement Date and issuance (**1513** days) is **1448** days, which exceeds three years (**1097** days) by **351** days. Therefore, the period of "B" delay was properly calculated as **351** days.

#### "C" Delay

The Office and Patentee agree that the amount of "C" delay is **0** days, as jurisdiction never passed to the Board.

#### Overlap

Patentee and the Office agree that the total number of overlapping days of Office delay is 0 days.

#### Reduction under 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704 [Applicant Delay]

Patentee and the Office agree that Applicant delay is **34** days.

Applicant delay was calculated as follows:

- (1) **4** days under 37 CFR 1.704(b) for filing an Amendment on October 23, 2017, in response to a non-final Office action mailed July 19, 2017. Patentee agrees with this calculation.
- (2) **30** days under 37 CFR 1.704(b) for filing a Request for Continued Examination (RCE) on May 23, 2018, in response to a final Office action mailed January 23, 2018. Patentee agrees with this calculation.

### **OVERALL PTA CALCULATION**

#### Formula:

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

#### USPTO's Calculation:

$424 + 351 + 0 - 0 - 34 = 741$

#### Patentees' Calculation:

$428 + 351 + 0 - 0 - 34 = 745$

### **CONCLUSION**

Patentee is entitled to PTA of **seven hundred forty-one (741)** days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following:  $424 + 351 + 0 - 0 - 34 = 741$  days. A correction of the determination of patent

term adjustment under 35 U.S.C. 154(b) to 745 days is not merited. The PTA determination of 741 days listed on the Issue Notification mailed November 14, 2018 and the face of the issued patent dated December 4, 2018 remains appropriate. Accordingly, the request for redetermination of the patent term adjustment is **DENIED**. This decision may be viewed as a final agency action. *See* MPEP 1002.02(b).

Receipt of the petition fee paid January 31, 2019 is acknowledged. No further fee is due in connection with this decision.

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

/ROBERT CLARKE/  
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