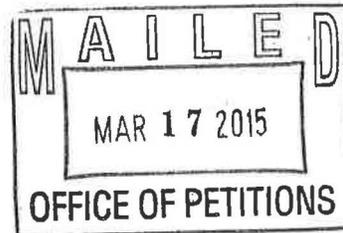




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In re Patent No. 8,546,450
Singh, et al.
Issue Date: 10/01/2013
Application No. 12/459,998
Filing or 371(c) Date: 07/10/2009
Atty. Docket No.: HOR0020-201-US

:
: ON REQUEST FOR
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
:
:

This is a decision in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)", filed November 27, 2013, requesting that the patent term adjustment determination for the above-identified patent be changed from 395 days to 416 days.

The request is **DENIED**.

This decision on patent term adjustment is the Director's decision on the applicant's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

On October 1, 2013, the above-identified application matured into U.S. Patent No. 8,546,450. The patent issued with a PTA of 395 days. On November 27, 2013, Patentees timely filed the instant application for patent term adjustment.

The Office determined a patent term adjustment of 395 days on the basis of 419 days of "A" delay plus 114 days of "B" delay, reduced by 37 days of overlap between "A" and "B" delay, and 101 days of Applicant delay.

The present petition

Patentee and the Office are in agreement regarding the amount of “A” delay under 35 U.S.C. § 154(b)(1)(A), the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B)(i), and the amount of overlapping days between “A” and “B” delay. At issue is the assessment of Applicant delay of 21 days under 37 CFR 1.704(c)(10).

Discussion

Patentees’ arguments have been carefully considered. Upon review, the USPTO finds that Patentees are entitled to **395** days of PTA.

The Office assessed 21 days of Applicant delay under 37 CFR 1.704(c)(10) for Applicants’ filing of an Amendment on August 8, 2013, subsequent to the Notice of Allowance mailed on June 20, 2013. Patentees assert that because they filed the Amendment in response to a Notice to File Corrected Application Papers, they should not be assessed any Applicant delay. Patentees assert that when the Office of Patent Publication requires an amendment to the specification or drawings, 37 CFR 1.312 is waived.

Patentees’ argument has been considered, but is not persuasive. 37 CFR 1.312 states that any Amendment filed after a Notice of Allowance will not be entered as a matter of right, and that no Amendment will be entered after payment of the issue fee, without withdrawing the application from issue. In the *Waiver of 37 CFR 1.312 for Documents Required by the Office of Patent Publication* (1280 Off. Gaz. Patent Office 918 (March 23, 2004), the Office of Patent Publication was delegated the authority of 37 CFR 1.312 to accept an amendment filed after payment of the issue fee. However, this delegation of authority has no impact on the calculation of the patent term adjustment. 37 CFR 1.704(c)(10) states that the submission of an Amendment under 37 CFR 1.312 or other paper after the mailing of a Notice of Allowance will result in the assessment of Applicant delay. While certain exceptions have been made (e.g. filing a Power of Attorney after the mailing of a Notice of Allowance will not result in 37 CFR 1.704(c)(10) reduction), the submission of an Amendment after the mailing of a Notice of Allowance will result in Applicant delay.¹ Here, the Amendment filed on August 8, 2013 was necessary to correct Applicants’ specification filed on July 10, 2009. As such, the assessment of 21 days of Applicant delay under 37 CFR 1.704(c)(10) was proper.

Overall PTA Calculation**Formula:**

“A” delay + “B” delay + “C” delay - Overlap - applicant delay = X

Patentees’ Calculation:

419 + 114 + 0 = 37 – 80 = 416

¹ See MPEP 2732.

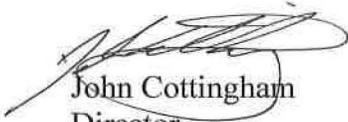
USPTO's Calculation:

$$419 + 114 + 0 - 37 - 101 = 395$$

Conclusion

Patentee is entitled to PTA of three hundred ninety-five (395) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $419 + 114 + 0 - 37 - 101 = 395$ days.

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



John Cottingham
Director
Office of Petitions