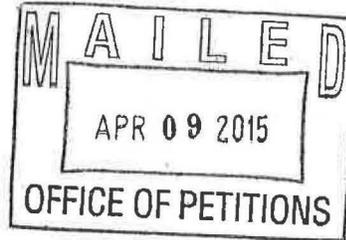




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In re Patent No. 8,602,640	:	
Chiarello et al.	:	DECISION ON REQUEST
Issue Date: 12/10/2013	:	FOR RECONSIDERATION OF
Application No. 12/469,662	:	PATENT TERM ADJUSTMENT
Filed: 05/20/2009	:	
Attorney Docket No: ENTG2110	:	

This is a decision on the “RESPONSE TO REDETERMINATION OF PATENT TERM ADJUSTMENT/REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b),” filed on March 13, 2015. The request is treated as one in which patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from eight hundred twenty (820) days to nine hundred seventy-one (971) 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 is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. 154(b) of 820 days. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. 704 and for purposes of seeking judicial review. See MPEP 1002.02.

**BACKGROUND**

On December 10, 2013, the above-identified application matured into U.S. Patent No. 8,602,640, with a revised patent term adjustment of 847 days. On February 10, 2014, an application for patent term adjustment was filed. On January 13, 2015, a decision on Redetermination of Patent Term Adjustment was mailed, stating that the Office had re-determined the PTA to be 820 days. This redetermination included entry of a period of reduction of 151 days pursuant to 37 CFR 1.704(c)(8) for the filing of a supplemental reply or other paper 151 days after the day after the date a reply was filed.

On March 13, 2015, the subject request for reconsideration was filed. Patentee asserts that the reduction of 151 days is incorrect. Specifically, patentee states:

The Information Disclosure Statement rules under 37 CFR § 1.704(d) are not applicable to this case. When an information disclosure statement is filed after the filing of an RCE, but before the next office action, Applicant is not required to submit either a statement or a fee. Since the 06/28/13 IDS in this case was filed after the 01/28/13 RCE, but before the next action by the U.S. Patent Office, the rules that govern 37 CFR § 1.704(d) do not apply to this instance and therefore, the Office of Petitions should not reduce the patent term in this case by 151 days.

### STATUTE AND REGULATION

35 U.S.C. 154(b)(2)(C) as amended by the Leahy-Smith America Invents Act (AIA)<sup>1</sup> provides:

#### REDUCTION OF PERIOD OF ADJUSTMENT.—

- (i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.
- (ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.
- (iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

37 CFR 1.704(c) states, in pertinent part:

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:

- (8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been

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<sup>1</sup> Public Law 112-29, 125 Stat. 284 (Sept. 16, 2011).

filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

37 CFR 1.704(d) states:

(1) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendable.

### OPINION

Patentee's argument has been considered, but is not persuasive. It is undisputed that on January 28, 2013, a reply (an RCE and submission) was filed, and that on June 28, 2013, 151 days after the day after the date the reply was filed, a supplemental reply or other paper (an IDS) was filed. The IDS was neither expressly requested by the examiner nor accompanied by a statement under 37 CFR 1.704(d). As such, the filing of the IDS constitutes a failure to engage in reasonable efforts to conclude processing or examination.

It appears that, in stating that an applicant that submits an IDS filed after an RCE has been filed but before the next Office action is not required to submit a statement and/or fee, applicant is referring to the provisions of § 1.97. Simply put, the rules governing a supplemental reply under § 1.704(c)(8) are different than those governing the requirements for an IDS under § 1.97. Whether a statement and or fee are required under § 1.97 is not relevant to the determination of whether an IDS which is filed after an RCE has been filed but before an Office action has been mailed constitutes a "failure to engage" within the meaning of § 1.704(c)(8).

**Overall PTA Calculation**

**Formula:**

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

**USPTO’s Calculation:**

625 + 376 + 0 - 0 - 181 = 820

**Patentee’s Calculation**

625 + 376 + 0 - 0 - 30 = 971

In view of the redetermination, the petition is granted to the extent that the PTA calculation has been revised, but is denied with respect to any change in redetermination of the PTA.

**CONCLUSION**

The request for reconsideration of the revised patent term adjustment is **denied**.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Douglas I. Wood at 571-272-3211.



John Cottingham  
Director  
Office of Petitions