



UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED
SEP 30 2016
OFFICE OF PETITIONS

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SCHWEGMAN LUNDBERG & WOESSNER/BSC
PO BOX 2938
MINNEAPOLIS MN 55402

In re Patent of Stubbs et al. :
Patent No. 8,639,331 : FINAL AGENCY DECISION ON
Issue Date: January 28, 2014 : REQUEST FOR RECONSIDERATION
Application No. 12/639,848 : OF PATENT TERM ADJUSTMENT
Filing Date: December 16, 2009 :
Attorney Docket No. 32469-384378 :

This is a decision on the “RESPONSE TO REQUEST FOR INFORMATION REGARDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)”, filed May 22, 2015, and the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)” (“Request”), filed March 28, 2014, (collectively, “Request 2”), which request the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent from nine hundred thirteen (913) days to nine hundred eighty-eight (988) 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 nine hundred thirteen (913) days.

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

Relevant Procedural History

The patent issued with a PTA determination of 913 days on January 28, 2014. A request seeking a PTA of 988 days was filed on March 28, 2014. The sole issue in dispute was the length of reduction warranted pursuant to 37 CFR 1.704(c)(10) for the filing of an Information Disclosure Statement (“IDS”) on October 18, 2013, after a notice of allowance was mailed on September 19, 2013. The Office mailed a Request for Information on March 24, 2015, requesting applicants

Art Unit: OPET

submit evidence that an actual mailing was received at the correspondence address of record. On May 22, 2015, applicants timely responded.

Decision

The PTA set forth on the patent is based on the following determination previously made by the Office:

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 616 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 408 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) ("C Delay") is 0 days;
- (4) The number of days of overlapping delay ("Overlap") between the periods of A Delay, B Delay, and C Delay is 0 days; and
- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) ("Applicant Delay") is 111 days.

The PTA to be set forth on a patent is the sum of the days of A Delay, B Delay, and C Delay reduced by the number of days of Overlap and Applicant Delay. In other words, the following formula may be used to calculate the PTA:

$$\text{PTA} = \text{A Delay} + \text{B Delay} + \text{C Delay} - \text{Overlap} - \text{Applicant Delay}$$

The patent sets forth a PTA of 913 days (616 days of A Delay + 408 days of B Delay + 0 days of C Delay - 0 days of Overlap - 111 days of Applicant Delay).

The Request 2 does not dispute the Office's calculations of the periods of A Delay, B Delay, C Delay, and Overlap set forth in the Redetermination.

Request 2 asserts the Office should have entered a 28 day period of reduction, not a 103 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of an IDS on October 18, 2013, after a Notice of Allowance was mailed on September 19, 2013. Request 2 asserts the period of Applicant Delay is 36 days (8 + 28) days.

Request 2 argues the correct PTA is 988 days (616 days of A Delay + 408 days of B Delay + 0 days of C Delay - 0 days of Overlap - 36 days of Applicant Delay).

As will be discussed, the period of Applicant Delay is 111 days.

Therefore, the correct PTA is 913 days (616 days of A Delay + 408 days of B Delay + 0 days of C Delay - 0 days of Overlap - 111 days of Applicant Delay).

Art Unit: OPET

A Delay

Request 2 does not dispute the Office's prior determination of the period A Delay is 616 days. The Office has recalculated the period of A Delay as part of the Office's redetermination of the PTA and confirmed the period of A Delay is 616 days.

B Delay

Request 2 does not dispute the Office's prior determination the period of B Delay is 408 days. The Office has recalculated the period of B Delay as part of the Office's redetermination of the PTA and confirmed the period of B Delay is 408 days.

C Delay

Request 2 does not dispute the Office's prior determination the period of C Delay is 0 days. The Office has recalculated the period of C Delay as part of the Office's redetermination of the PTA and confirmed the period of C Delay is 0 days.

Overlap

Request 2 does not dispute the Office's prior determination the number of days of Overlap is 0 days. The Office has recalculated the number of days of Overlap as part of the Office's redetermination of the PTA and confirmed the number of days of Overlap is 0 days.

Applicant Delay

Request 2 disputes the Office's prior determination the number of days of Applicant Delay is 111 days. The Office has recalculated the number of days of Applicant Delay as part of the Office's redetermination of the PTA and confirmed the number of days of Applicant Delay is 111 days. Request 2 does not dispute the other instance of Applicant Delay, as previously determined by the Office.

Request 2 asserts the Office should have entered a 28 day period of reduction, not a 103 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of an IDS on October 18, 2013, after a notice of allowance was mailed on September 19, 2013.

37 CFR 1.704(c) provides that:

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:

Art Unit: OPET

- (10) Submission of an amendment under § 1.312 or other paper, other than a request for continued examination in compliance with §1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in §1.703 shall be reduced by the lesser of:
- (i) The number of days, if any, beginning on the date the amendment under §1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;
- or
- (ii) Four months;

In this instance, a Notice of Allowance was mailed on September 19, 2013. An IDS was subsequently filed on October 18, 2013. The October 18, 2013 IDS does not contain a proper statement under 37 CFR 1.704(d).

Request 2 asserts the Office should have entered a 28 day period of reduction, not a 103 day period of reduction, pursuant to 37 CFR 1.704(c)(10). Request 2 argues the Office should consider November 14, 2013 as the end date of the 37 CFR 1.704(c)(10) calculation because, "... regardless of whether the "List of References cited by applicant and considered by the examiner" was mailed in addition to being added to PAIR on or about November 14, 2013, either would seem to have the same effect as "Mailing" and/or qualify under the "notice" provision of 37 C.F.R. 1.704(c)(10) for the purpose of ending the delay period."

The language of 37 CFR 1.704(c)(10) provides clear guidance as to the end date of the calculation. The end date is "...the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper or four months." As stated in MPEP 2732,

37 CFR 1.704(c)(10) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the lesser of: (1) the number of days, if any, beginning on the date the amendment under 37 CFR 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under 37 CFR 1.312 or such other paper; or (2) four months. The phrase "lesser of ...or [f]our months" is to provide a four-month cap for a reduction under 37 CFR 1.704(c)(10) if the Office takes longer than four months to issue an Office action or notice in response to the amendment under 37 CFR 1.312 or other paper. If the Office does not mail a response to the paper that triggered the delay under this provision and the patent issues in less than four months, then the applicant delay under this provision will end on the date of the patent issuance. The Office will treat the issuance of the patent as the response to the paper that triggered the delay.

No Office action or notice was mailed in response to the IDS on October 18, 2013.

Art Unit: OPET

Applicants participate in the e-Office Action program. An e-mail notification is sent only when there is new Office communication that day for applications associated with the participant's Customer Number. Specific e-Office Action related events with corresponding dates are available in the Transaction History tab in Private PAIR. The Transaction Description events are self-explanatory and are labeled as "Email Notification," "Electronic Review," and if applicable "Mail Post Card." In addition, an OA.EMAIL document is placed in the file wrapper of the application notified that day. The OA.EMAIL document is a truncated version of the daily e-mail listing details of only that specific application number's new communication.

The March 24, 2015 Request for Information expressly requested "[a]pplicants submit evidence that an actual mailing was received at the correspondence address of record." However, Request 2 does not include any contemporaneous evidence to establish the Office sent applicants an Email Notification on or around November 14, 2013 alerting applicants that a new Office communication for this application was available for viewing. As discussed above, specific e-Office Action related events with corresponding dates are available in the Transaction History tab in Private PAIR.

Request 2 states the mail room date referred to in the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT was based on information contained in PAIR. Request 2 states, "...The November 14, 2013 "Mail Room Date" referenced in the Applicant's REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT was not based on a separate paper record of mailing." Thus, it appears applicants concede that the document at issue was not mailed or the subject of an e-mail notification.

A review of the image file wrapper reveals that there is no document entitled OA.EMAIL, which is the code used for Private PAIR Correspondence Notifications. Office databases show the November 14, 2014 annotated List of References Cited by Applicant and Considered by Examiner was part of an internal Office document, a Printer Rush, and no mailing occurred.

As such, the end date of the calculation is the date the patent issued, as it is earlier than 4 months from the filing date of the October 18, 2013 IDS.

Pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 103 days, beginning on October 18, 2013, the date the IDS was filed, and ending on and including January 28, 2014, the date the patent issued. The 103 day period of reduction pursuant to 37 CFR 1.704(c)(10) is proper and will not be altered.

The period of Applicant Delay is 111 days (8 + 103).

Conclusion

Request 2 asserts the correct PTA is 988 days (616 days of A Delay + 408 days of B Delay + 0 days of C Delay - 0 days of Overlap - 36 days of Applicant Delay).

Application/Control Number: 12/639,848

Page 6

Art Unit: OPET

As previously discussed, the period of Applicant Delay is 111 days. Therefore, the PTA is 913 days (616 days of A Delay + 408 days of B Delay + 0 days of C Delay – 0 days of Overlap – 111 days of Applicant Delay).

Telephone inquiries specific to this decision should be directed to Attorney Advisor Shirene Willis Brantley at (571) 272-3230.

/ROBERT CLARKE/

Robert A. Clarke

Patent Attorney

Office of the Deputy Commissioner

for Patent Examination Policy - USPTO