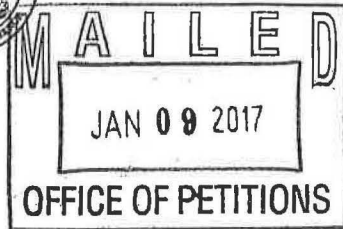




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Inventors: Tomesch et al.	:	
Patent No. 8,648,077	:	FINAL AGENCY DECISION ON
Issue Date: February 11, 2014	:	REQUEST FOR RECONSIDERATION
Application No. 12/922,056	:	OF PATENT TERM ADJUSTMENT
Filing Date: January 19, 2011	:	
Attorney Docket No. IT-29-US	:	

This is a decision on the request for reconsideration under 37 C.F.R. § 1.705 filed April 10, 2016, which requests the United States Patent and Trademark Office ("Office") correct the patent term adjustment ("PTA") on the patent to indicate the term of the patent is extended or adjusted by 287 days.

The request is **DENIED**.

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 104 days. A request under 37 C.F.R. § 1.705 seeking an adjustment of 287 days was filed on April 11, 2014. The Office issued a Redetermination of Patent Term Adjustment ("Redetermination") on September 10, 2015. The Redetermination states the correct PTA is 264 days. The instant request for reconsideration seeking an adjustment of 287 days was filed on April 10, 2016.

Decision

The PTA set forth in the Redetermination issued on September 10, 2015, is based on the following determinations made by the Office:

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 255 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 151 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 142 days.

The PTA for 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 Redetermination states the correct PTA is 264 days (255 days of A Delay + 151 days of B Delay + 0 days of C Delay - 0 days of Overlap - 142 days of Applicant Delay).

The Office’s prior calculations of the period of C Delay and the period of Overlap are not in dispute.

The request for reconsideration states the period of A Delay is 256 days, the period of B Delay is 152 days, the period of Applicant Delay is 121 days, and the PTA is 287 days (256 days of A Delay + 152 days of B Delay + 0 days of C Delay - 0 days of Overlap - 121 days of Applicant Delay).

A Delay

The period of A Delay consists of a single period of delay under 37 C.F.R. § 1.703(a)(1), which states,

[The period of A Delay includes 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[.]

The calculation of the period of A Delay in the Redetermination is based on a determination the date of commencement is September 13, 2010. The calculation of the period of A Delay in the request for reconsideration is based on an assertion the date of commencement is September 12, 2010.

The Redetermination states the period of A Delay is 255 days, which is the number of days in the period beginning on November 14, 2011 (the day after the date that is fourteen months after the national stage commencement date) and ending on July 25, 2012 (the date an action under 35 U.S.C. § 132 was mailed).

The request for reconsideration states the correct period of A Delay is 256 days, which is the number of days in the period beginning on November 13, 2011 (the day after the date that is

fourteen months after September 12, 2010) and ending on July 25, 2012 (the date an action under 35 U.S.C. § 132 was issued).

35 U.S.C. § 371(b) states,

Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty.

The “applicable time limit” for the instant application consists of a 30-month time period beginning on the earliest claimed priority (March 12, 2008).

The date 30 months after the earliest claimed priority fell on *Sunday*, September 12, 2010.

PCT Rule 80.5 states, with emphasis added,

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:

- (i) **on which such Office or organization is not open to the public for the purposes of the transaction of official business;**
- (ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;
- (iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or
- (iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day;

the period **shall** expire on the next subsequent day on which none of the said four circumstances exists.

The request for reconsideration argues that PCT Rule 80.5 allows an applicant the option of filing the papers and fees necessary to enter the national stage on the next subsequent business day if the 30-month date falls on weekend or holiday, but does not actually change the date of commencement. The date of commencement is the expiration date of the 30-month time period.

The provisions of PCT Rule 80.5 apply to the expiration of any time period. Therefore, the provisions of PCT Rule 80.5 apply to the 30-month time period at issue in this case.

If the last date in the 30-month period falls on a date that the Office was “not open to the public for the purposes of the transaction of official business,” the time period *shall* expire on the next subsequent day on which none of the four circumstances identified in sections (i) to (iv) of PCT Rule 80.5 exists.

The last date of the 30-month period fell on Sunday, September 12, 2010. The Office was “not open to the public for the purposes of the transaction of official business” on September 12, 2010. The next subsequent day on which none of the four circumstances identified in sections (i) to (iv) of PCT Rule 80.5 existed was Monday, September 13, 2010. As a result, the 30-month time period expired on September 13, 2010.

Pursuant to 35 U.S.C. § 371(b), the commencement date for the instant application is the date the 30-month time period expired. The 30-month time period expired on September 13, 2010. Therefore, the date of commencement is September 13, 2010.

In view of the prior discussion, the correct period of A Delay is 255 days, which is the number of days in the period beginning on November 14, 2011 (the day after the date that is fourteen months after the national stage commencement date) and ending on July 25, 2012 (the date an action under 35 U.S.C. § 132 was mailed).

B Delay

The request for reconsideration asserts the period of B Delay is 152 days, not 151 days as set forth in the Redetermination.

The calculation of the period of B Delay in the request for reconsideration is based on an assertion the date of commencement is September 12, 2010. However, as previously discussed, the date of commencement is September 13, 2010.

37 C.F.R. § 1.703(b) states,

The period of [B Delay] is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of [the periods of time set forth in sections (1)-(4) of this paragraph].

The number of days beginning on September 14, 2013 (the day after the date that was three years after the date of commencement) and ending on February 11, 2014 (the issue date) is 151 days. The sum of the periods set forth in sections (1)-(4) of 37 C.F.R. § 1.703(b) is 0 days. The correct period of B Delay is 151 (151 - 0) days.

Applicant Delay

The Redetermination states the period of Applicant Delay is 142 days.

The request for reconsideration states the correct period of Applicant Delay is 121 days.

The Redetermination states the period of Applicant Delay consists of the following four periods of delay:

- (1) A 90-day period of delay under 37 C.F.R. § 1.704(b);
- (2) A 10-day period of delay under 37 C.F.R. § 1.704(c)(10);
- (3) A 21-day period of delay under 37 C.F.R. § 1.704(c)(10); and
- (4) A 21-day period of delay under 37 C.F.R. § 1.704(b).

The first three periods of delay set forth above, which include a total of 121 (90 + 10 + 21) days, are not in dispute.

The fourth period of delay set forth above is in dispute.

The Office issued a final Office action on April 17, 2013.

A submission including an amendment was filed on July 17, 2013. The submission fails to comply with 37 C.F.R. § 1.113.

MPEP § 714.03 states, with emphasis added,

Where a submission after a final Office action (e.g., an amendment under 37 CFR 1.116) does not place the application in condition for allowance, the period for reply under 37 CFR 1.113 continues to run until a reply under 37 CFR 1.113 (i.e., a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the **omission** (e.g., whether the amendment raises new issues, or would place the application in condition for allowance but for it being unsigned or not in compliance with 37 CFR 1.121) is immaterial. The examiner cannot give the applicant a time period under 37 CFR 1.135(c) to supply the omission; however, applicant may obtain additional time under 37 CFR 1.136(a) to **file another or supplemental amendment in order to supply the omission.**

The Office issued an advisory action on July 26, 2013. The advisory action indicates the July 17, 2013 submission fails to overcome all the rejections of record. The advisory action objects to new claim 34 based on an informality.

A supplemental amendment was filed on August 7, 2013.

The extent to which the prior facts warrant entry of a reduction in patent term adjustment for Applicant Delay is in dispute.

35 U.S.C. § 154(b)(2)(C)(ii) states, with emphasis,

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.

37 C.F.R. § 1.704(b) states,

[A]n 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 three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, 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 that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

Pursuant to 37 C.F.R. § 1.704(c)(7), circumstances that will result in a reduction in the period of adjustment include:

Submission of a reply having an omission (§1.135(c)), 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 reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

MPEP § 2732 states,

The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies also when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 *et seq.*

The July 17, 2013 submission includes an omission in so far as the submission fails to place the application in condition for allowance. In other words, the submission fails to constitute a proper reply to the final Office action.

The Office did not treat the submission filed July 17, 2013, as a "reply" under 37 C.F.R. §§ 1.704(b) and 1.704(c)(7). As a result, the Office entered a reduction in patent term adjustment under 37 C.F.R. § 1.704(b) in the amount of 21 days, which is the number of days beginning on the day after the date three months after the Office issued the final Office action (July 18, 2013) and ending on the date the supplemental amendment was filed (August 7, 2013). The Office did not enter a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(7).

The request argues the entry of the 21-day reduction in patent term adjustment was improper because the submission filed July 17, 2013, constitutes a reply under 37 C.F.R. § 1.704(b).

If the submission is a reply under 37 C.F.R. §§ 1.704(b) and 1.704(c)(7), entry of a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(7) is warranted in the amount of 21 days, which is the number of days beginning on the day after the date the reply having an omission was filed (July 18, 2013) and ending on the date a reply correcting the omission was filed (August 7, 2013).

It is unnecessary for the Office to determine if the submission constitutes a reply under 37 C.F.R. § 1.704(b) because entry of a 21-day reduction in patent term adjustment is warranted, albeit under 37 C.F.R. § 1.704(c)(7), even if the submission constitutes a reply.

In view of the prior discussion, the request for reconsideration fails to establish the Office's entry of the 21-day reduction in patent term adjustment is improper.

The correct total period of Applicant Delay is 142 days, as set forth in the Redetermination.

Conclusion

The request for reconsideration asserts the correct PTA is 287 days (256 days of A Delay + 152 days of B Delay + 0 days of C Delay - 0 days of Overlap - 121 days of Applicant Delay).

As previously discussed, the correct period of A Delay is 255 days, the correct period of B Delay is 151 days, and the correct period of Applicant Delay is 142 days. Therefore, the correct PTA is 264 days (255 days of A Delay + 151 days of B Delay + 0 days of C Delay - 0 days of Overlap - 142 days of Applicant Delay).

Telephone inquiries specific to this decision should be directed to Attorney Advisor Steven Brantley at (571) 272-3203.

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