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In re Patent of Schaeffer et al.	:	
Patent No. 8,662,805	:	REDETERMINATION OF PATENT
Issue Date: March 4, 2014	:	TERM ADJUSTMENT
Application No. 13/369,713	:	
Filed: February 9, 2012	:	
Attorney Docket No. 24844US01	:	
(PAT04139USNP)	:	

This is a decision on the “APPLICATION FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b) INDICATED IN THE PATENT (37 CFR § 1.705(d)”, filed April 25, 2014, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent to indicate the term of the patent is extended or adjusted by eighty-five (85) days.

The request for reconsideration for the Office to correct the PTA set forth on the patent to indicate the term of the patent is extended or adjusted by 85 days is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

Relevant Procedural History

The patent issued with a PTA determination of 28 days on March 4, 2014. The instant request seeking an adjustment of 85 days was timely filed on April 25, 2014.

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 85 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 0 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 57 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 28 days (85 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 57 days of Applicant Delay).

The Request asserts the period of Applicant Delay is 0 days, not 57 days, because there should be no reduction under 37 CFR 1.704(c)(10) for a request for corrected filing receipt and supplemental application data sheet, both filed on January 7, 2014, after a notice of allowance was mailed on October 22, 2013. The Request asserts the correct PTA is 85 days (85 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 0 days of Applicant Delay).

As will be discussed, the period of A Delay is 57 days.

The correct PTA is 28 days (85 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 57 days of Applicant Delay).

A Delay

The Request does not dispute the Office’s prior determination the period of A Delay is 85 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 85 days.

B Delay

The Request does not dispute the Office’s prior determination the period of B Delay is 0 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 0 days.

C Delay

The Request 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

The Request 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

The Request disputes the Office's prior determination the period of Applicant Delay is 57 days. The Office has recalculated the period of Applicant Delay as part of the Office's redetermination of the PTA and confirmed the period of Applicant Delay is 57 days.

The Request argues no reduction is warranted pursuant to 37 CFR § 1.704(c)(10) for the request for corrected filing receipt and the supplemental application data sheet, both mailed January 7, 2014, after a notice of allowance was mailed on October 22, 2013.

The Office recently amended 37 CFR § 1.704(c)(10). *Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee*, Final Rule, 80 Fed. Reg. 1346 (January 9, 2015.) ("notice") The changes to 37 CFR 1.703 in this final rule apply to any patent granted before, on, or after January 9, 2015. Therefore, the rule applies to the present patent.

37 CFR § 1.704(c)(10) provides that:

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.

Page 1346 of the notice states:

[T]he Office is clarifying what papers may be submitted after a notice of allowance without the applicant being considered to have failed to engage in reasonable efforts to conclude processing or examination of the application.

Page 1354 of the notice indicates the following types of papers will not result in a reduction under 37 CFR § 1.704 (c)(10):

1. Issue fee transmittal;
2. Power of attorney;
3. Change of address;
4. Change of status;
5. Power to inspect;
6. Response to examiner's reasons for allowance;
7. An IDS with a statement in compliance with 1.704(d);
8. Resubmission of previously filed papers that cannot be located in the file;
9. Request to correct error or omission in notice of allowance or notice of allowability;
10. Status letters;
11. Requests for a refund;
12. An inventor's oath/declaration;
13. A request for acknowledgement of an IDS in compliance with 1.97 and 198 in certain circumstances;
14. Comments of the substance of an interview where the applicant-initiated interview resulted in a the mailing of a notice of allowance; and
15. Letters related to government interests.

Page 1354 of the notice states, with emphasis added:

The Office reminds applicants that the submission of other types of papers after a notice of allowance has been given or mailed **constitutes a "failure to engage in reasonable efforts to conclude processing** or examination of an application [under 37 C.F.R. § 1.704 (c)(10))}.

Pages 1354-1355 state,

An exemplary listing of such papers includes:

1. An amendment under 1.312;
2. A paper containing a claim for priority or benefit or request to correct priority or benefit information (e.g., a new or supplemental application data sheet filed to correct foreign or domestic benefit information);
3. A request for a corrected filing receipt;
4. A certified copy of a priority document;
5. Drawings;
6. A letter relating to biologic deposits;
7. A request to change or correct inventorship; and
8. An information disclosure statement not accompanied by a statement in compliance with § 1.704(d).

Turning to the patent at hand, on October 22, 2013, the Office mailed a Notice of Allowance. On January 7, 2014, applicants filed a request for corrected filing receipt and a supplemental application data sheet to correct foreign priority information. Both items are explicitly listed, #3 and #2 above, as examples of papers that if filed after a notice of allowance has been mailed constitute a failure to engage in reasonable efforts to conclude processing or examination of an application under 37 CFR § 1.704 (c)(10).

Under § 1.704(c)(10), any patent term adjustment in this application is subject to a period of reduction of 57 days, for Applicant Delay for the period beginning on January 7, 2014, the date request for corrected filing receipt and a supplemental application data sheet were filed, and ending on March 4, 2014, the date the patent issued. The 57 day period of reduction is proper and will not be removed.

The period of Applicant Delay is 57 days.

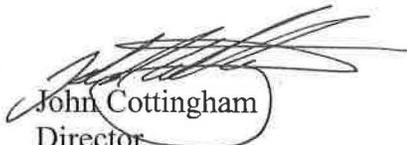
Conclusion

The Request asserts the correct PTA is 85 days (85 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 0 days of Applicant Delay).

As previously discussed, the period of Applicant Delay is 57 days.

Therefore, the correct PTA is 28 days (85 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 57 days of Applicant Delay).

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


John Cottingham
Director
Office of Petitions/Petitions Officer