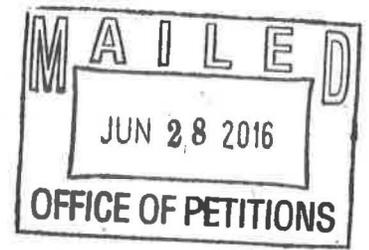




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In re Patent No. 8,691,161 :
Roger Fleming : DECISION ON REQUEST
Issue Date: 04/08/2014 : FOR RECONSIDERATION OF
Application No. 11/792,360 : PATENT TERM ADJUSTMENT
Filed: 06/05/2007 :
Attorney Docket No: :
MSE-2737/247082-000146USPX :

This is a decision on the “RENEWED APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b),” filed June 25, 2015, in which patentee requests that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand six hundred twenty-one (1621) days (and from one thousand six hundred thirteen (1613) days indicated in the April 30, 2015 decision) to one thousand seven hundred thirty-four (1734) 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 1613 days. This decision is the Director’s decision on the applicant’s request for reconsideration for purposes of seeking judicial review under 35 U.S.C. § 154(b)(4).

BACKGROUND

On April 8, 2014, the above-identified application matured into U.S. Patent No. 8,691,161, with a patent term adjustment of 1621 days.

On June 30, 2014, an application for patent term adjustment was filed. On April 30, 2015, the Office re-determined the PTA to be 1613 days.

On June 25, 2015, the subject request for reconsideration was filed. Patentee asserts that the reduction of 121 days, under 37 CFR 1.704(c)(8) for the filing of an information disclosure statement (IDS) filed after a request for continued examination (RCE) was filed, is incorrect. Specifically, patentee asserts that § 1.704(c) provides that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination will result in a reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping. Patentee argues that the reduction under 1.704(c)(8) for the filing of the IDS after the RCE was filed overlaps with the period excluded from the B delay period starting on January 25, 2011, the date the RCE was filed, and ending on December 16, 2013, the date a notice of allowance was mailed.

Art Unit: OPET

Patentee further asserts that an IDS filed before the first Office action or a notice of allowance after an RCE is properly characterized as a preliminary paper pursuant to § 1.704(c)(6), and therefore the filing thereof should not result in a period of reduction for applicant delay.

STATUTE AND REGULATION

35 U.S.C. 154(b)(1)(B) as amended by the Leahy-Smith America Invents Act (AIA)¹ provides:

GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.—

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

35 U.S.C. 154(b)(2)(C) as amended by the Leahy-Smith America Invents Act (AIA)² 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.

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

² Public Law 112-29, 125 Stat. 284 (Sept. 16, 2011).

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37 CFR 1.702(1) states:

Three-year pendency.

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within 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, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

37 CFR 1.703(b)(1) states:

The period of adjustment under § 1.702(b) 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 following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date of the mailing of the notice of allowance under 35 U.S.C. 151;

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 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:

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(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 25, 2011, a reply (an RCE and submission) was filed, and that on May 26, 2011, 121 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.

Patentee's assertion that the 121 day reduction for applicant delay for the filing of the IDS after the filing of the RCE overlaps with a reduction in the B-delay period has been considered, but is not persuasive.

The period excluded from adjustment under 1.703(b) between the filing of the RCE and the mailing of the Notice of Allowance ("RCE period") is not a circumstance which constitutes a failure to engage in reasonable efforts pursuant to 1.704, further, and is not a period of reduction for applicant delay. Rather, the RCE period is a period excluded from adjustment for Office delay. As the RCE period is not a period of applicant delay, by definition, it is not an overlapping period of applicant delay and cannot overlap with the period of reduction under 1.704(c)(8).

Patentee further argues that the IDS filed after the filing of the RCE is a preliminary paper, and that the period of delay should be calculated under 1.704(c)(6). Patentee cites 37 CFR 1.115(a) in support of the argument that the IDS should be considered a preliminary paper.

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Patentee's argument has been considered, but is not persuasive. An RCE is not the filing of a new application. See MPEP 706.07(h). Rather, an RCE is a reply. An RCE is a request by an applicant for continued examination which is effectuated by filing a submission and paying a specified fee. As used in this instance, the RCE was the reply to a final Office action. Thus, the IDS filed after the RCE was an "other paper, ... after a reply has been filed," within the meaning of 37 CFR 1.704(c)(8). Accordingly, the period of reduction for applicant delay in filing the IDS after the filing of the RCE was properly calculated pursuant to 37 CFR 1.704(c)(8), not 37 CFR 1.704(c)(6).

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

$1462 + 338 + 0 - 2 - 185 = 1613$

Patentee's Calculation

$1462 + 338 + 0 - 2 - 64 = 1734$

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.

/ROBERT CLARKE/
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for Patent Examination Policy