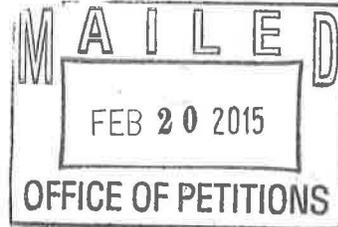




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In re Patent No. 8,759,088 :  
Steidler et al. : DECISION FOR REQUEST  
Issue Date: 06/24/2014 : FOR RECONSIDERATION  
Application No. 12/522,527 : OF PATENT TERM  
Filed: 07/08/2009 :  
Attorney Docket No: DECL.132.007APC :

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT,” which is treated as a request under 37 CFR 1.705(b), filed on July 8, 2014. 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 sixty-two (862) days to nine hundred ninety-eight (998) 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 862 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 June 24, 2014, the above-identified application matured into U.S. Patent No. 8,759,088, with a revised patent term adjustment of 862 days. This revised determination included a period of adjustment for Office delay of 410 days for the Office taking in excess of 14 months after the commencement date of the national stage of the application to issue an Office action under 35 U.S.C. 132 (restriction requirement). Specifically, the Office mailed an Office action under 35 U.S.C. 132 on October 25, 2011, fourteen months and 410 days after July 13, 2009, the date the application commenced the national stage.

Additionally, the revised determination included (1) a reduction of 72 days for applicant delay in connection with the filing of a reply correcting an omission on May 24, 2012, 72 days after a reply containing an omission had been filed, pursuant to 37 CFR 1.704(c)(7), and (2) a reduction of 70 days for applicant delay in connection with the filing of a reply correcting an omission on

September 16, 2013, 70 days after a reply containing an omission had been filed, pursuant to 37 CFR 1.704(c)(7), and (3) an adjustment of 196 days for Office delay in connection with the mailing of an action under 35 U.S.C. 132 on April 8, 2013, 4 months and 196 days after a reply was filed on May 24, 2012.

Lastly, the revised determination included an adjustment of 711 days pursuant to 37 CFR 1.702(b), for the Office's issuance of the patent three years and 711 days after the date the application commenced the national stage.

On July 8, 2014, patentee filed the present request for reconsideration. Patentee disputes the adjustment of 410 days in connection with 37 CFR 1.702(a), stating the adjustment should be 415 days.

Patentee further asserts that the 72 day reduction for applicant delay should be 0 days, because patentee timely replied on September 24, 2012 to the Notice to Comply mailed on May 18, 2012.

Patentee also disputes the 196-day adjustment in connection with the mailing of the Office action mailed on April 8, 2013, stating that the adjustment should be 0 days, and the 70-day reduction in connection with the reply filed on September 16, 2013, because a reply was timely filed to the requirement, mailed on September 10, 2013, to comply with status identifier rules.

Patentee further asserts that there should be an additional 29-day reduction for applicant delay in connection with the request for reconsideration of patent term adjustment filed on April 17, 2014, 29 days after the date the notice of allowance was mailed.

Lastly, patentee asserts that the adjustment pursuant to 37 CFR 1.702(b) should be 716 days rather than 711 days.

### STATUTE AND REGULATION

35 U.S.C. 154(b)(1) provides, in pertinent part:

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 or a notice of allowance under section 151 not later than 14 months after—

(I) the date on which an application was filed under section 111(a); or

(II) the date of commencement of the national stage under section 371 in an international application;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Patent Trial and Appeal Board under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) 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);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Patent Trial and Appeal Board or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) 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.

The implementing regulation, 37 CFR 1.702, as revised, applies to any patent granted on or after January 14, 2013.<sup>1</sup>

(a) *Failure to take certain actions within specified time frames.* 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:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than 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;

(b) *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);

(2) Any time consumed by an interference or derivation proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

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<sup>1</sup> *Revisions to Patent Term Adjustment*, 78 Fed. Reg. 19416, 20 (April 1, 2013).

In pertinent part, 37 CFR 1.703 provides for calculation of the periods, as follows:

*Period of adjustment of patent term due to examination delay.*

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) 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 fulfilled the requirements of 35 U.S.C. 371 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;

(b) 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<sup>2</sup>:

37 CFR 1.703(f) provides that:

The adjustment will run from the expiration date of the patent as set forth in 35 U.S.C. 154(a)(2). To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

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<sup>2</sup> (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 the patent was issued;

(2)(i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and (ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3)(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181; (ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed; (iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order was removed; and (iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or 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, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. The date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

37 CFR 1.704 states, in pertinent part:

(c) 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:

...

(7) 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;

(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;

...

(d) (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.

### OPINION

Patentees' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to 862 days of PTA. The Office has revisited the amount of "B" delay under 35 U.S.C. § 154(b)(1)(B) and the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A).

The priority date in this application is January 12, 2007. Applicant did not file an express request under 35 U.S.C. 371(f). The date which is 30 months from the priority date is July 12, 2009, which fell on a Sunday. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a weekend or Federal Holiday, the period expired on the subsequent business day. See PCT Rule 80.5. Accordingly, the commencement date is Monday, July 13, 2009. On June 24, 2014, the patent issued; thus, the application was pending for 1808 days. Thus, for purposes of "B" delay, the application was pending for 1808 – 1097 [i.e., 3 years (including a leap year) from the actual filing date] = 711 days beyond the 3-year anniversary of the filing date. Accordingly, the B-delay period of 711 days is correct.

With regard to the "A Delay", pursuant to the AIA Technical Corrections Act (H.R. 6621), *see* Revisions to Patent Term Adjustment (Interim Final Rule), 78 Fed. Reg. 19416 (April 1, 2013), the period under 37 C.F.R. § 1.703(a)(1) is 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.

On July 13, 2009, the application commenced the national stage. On October 28, 2011, fourteen months and 410 days after the day after the date the application commenced the national stage, an action under 35 U.S.C. 132 (restriction requirement) was mailed. Accordingly, the period of adjustment of 410 days for Office delay is correct.

With regard to the period of reduction of 72 days for applicant delay in connection with the reply filed on May 24, 2012, patentee's argument has been considered persuasive, to the extent indicated.

On March 13, 2012, a reply was filed. On May 18, 2012, a Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice to Comply") was mailed, requiring correction of the Sequence Listing. On May 24, 2012, a reply correcting the Sequence Listing disclosure was filed.

It is noted that 65 Fed. Reg. 56366, 368 (Sep. 18, 2000) states, in pertinent part:

Office notices and letters issued as part of the pre-examination processing of an application are not notices issued as a result of an examination conducted pursuant to 35 U.S.C. 131, and thus are not notifications under 35 U.S.C. 132. Examples of such notices are: a Notice of Incomplete Nonprovisional Application (PTO-1123), a Notice of Omitted Item(s) in a Nonprovisional Application (PTO-1669), a Notice to File Missing Parts of Application (PTO-1533), a Notice of Informal Application (PTO-152), a Notice to File Corrected Application Papers Filing Date Granted (PTO-1660), or a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661).

As the Notice to Comply is not considered a notification under 35 U.S.C. 132, the reply filed on May 18, 2012 is not considered as a reply containing an omission pursuant to 37 CFR 1.704(c)(7). The 72-day period of reduction is therefore not warranted. Further, the period of Office delay pursuant to 37 CFR 1.702(a)(2) is the period beginning on July 14, 2012, the day after the date four months after the date the reply was filed, and ending on April 8, 2013, the date an Office action under 35 U.S.C. 132 was mailed, or 269 days. The 196-day period of adjustment for Office delay will be removed, and a 269-day period of adjustment will be entered.

Nevertheless, on September 5, 2012, a supplemental reply or other paper (an IDS) was filed, 176 days after the day after the date the reply was filed, March 14, 2012. The IDS was neither expressly requested by the examiner nor accompanied by a statement under 37 CFR 1.704(d). Accordingly, entry of a period of 176 days for applicant delay is warranted. The 72-day and 104-day periods of reduction will be removed, and a 176-day period of reduction will be entered.

With respect to the 70-day period of reduction for applicant delay, patentee's argument has been considered, but is not persuasive. Pursuant to 37 CFR 1.704(c)(7), the submission of a reply having an omission is considered a failure to engage in reasonable efforts to conclude processing or examination of an application and will result in a period of reduction for applicant delay equal to the number of days 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.

On July 8, 2013, a reply was filed. On September 10, 2013, a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed, stating that the status identifier for Claim 15 was incorrect in the amendment filed on July 8, 2013. On September 16, 2013, 70 days after the day after the date the reply containing the omission was filed, a reply correcting the omission was filed. Accordingly, entry of the 70-day period of reduction for applicant delay is warranted and will not be removed.

Lastly, patentee's disclosure that a 29-day period of reduction for applicant delay is due in connection with the filing of a request for reconsideration of patent term adjustment after the mailing of the notice of allowance has been considered, but is not persuasive.

MPEP 2732 states, in pertinent part:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (micro/small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office).

A request for reconsideration of the patent term adjustment is not among the types of papers which are considered a failure to engage in reasonable efforts to conclude processing or examination. As such, entry of a period of reduction for application delay in connection with the filing of a request for reconsideration of patent term adjustment is not warranted. Nevertheless, the Office thanks Applicants for their good faith and candor in bringing this matter to the attention of the Office.

Total "A" delay is 679 (410+269) days.

Total "B" delay is 711 days.

Total applicant delay is 259 (176+70+13) days.

The Office finds that the amount overlapping days of Office delay is 269 days. In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the United States Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the "A" and "B" delays. Under this interpretation, the Office finds that the following days of "A" delay and "B" delay overlap: the 269 days of "A" delay period starting on July 14, 2012, the day after the date

four months after a reply was filed on March 13, 2012, and ending on April 8, 2013, the date an action under § 132 (non-final Office action) was mailed.

### Overall PTA Calculation

#### Formula:

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

#### USPTO’s Calculation:

$679 + 711 + 0 - 269 - 259 = 862$

#### Patentee’s Calculation:

$611 + 716 + 0 - 196 - 133 = 998$

### Conclusion

Patentee is entitled to PTA of eight hundred sixty-two (862) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following:  $679 + 711 + 0 - 269 - 259 = 862$  days.

### CONCLUSION

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

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

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