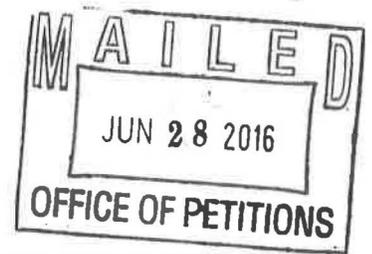




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In re Patent No. 8,926,638 :
Marshall et al. : DECISION ON REQUEST
Issue Date: 01/06/2015 : FOR RECONSIDERATION OF
Application No. 12/938,398 : PATENT TERM ADJUSTMENT
Filed: 11/03/2010 :
Attorney Docket No: :
H-US-01411 DIV (1700-8 DIV) :

This is a decision on the “RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT,” filed on November 10, 2015, which is considered as a request for reconsideration under § 1.705(b) in which patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from three hundred eighteen (318) days to six hundred forty-two (642) 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 642 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 January 6, 2015, the above-identified application matured into U.S. Patent No. 8,926,638, with a patent term adjustment of 47 days.

On February 20, 2015, an application for patent term adjustment was filed. On September 15, 2015, the Office re-determined the PTA to be 318 days.

On November 20, 2015, the subject request for reconsideration was filed. Patentee asserts that the reduction of 324 days, for the filing of an information disclosure statement (IDS) filed after a request for continued examination (RCE) was filed, is incorrect. Specifically, patentee states that the IDS filed on January 29, 2014, after the RCE was filed, was filed in compliance with § 1.97(b)(4). Petitioner notes the decision in *Arqule v. Kappos*, 793 F.Supp.2d 214, 225-26 (D.D.C. 2011), in which the court stated that the Office had “functionally negated” the grace period required by 35 U.S.C 21(b). Petitioner states that the situation at issue in *Arqule* is analogous to the situation of an IDS filed after an RCE.

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STATUTE AND REGULATION

35 U.S.C. 154(b)(2)(C) as amended by the Leahy-Smith America Invents Act (AIA)¹ 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.

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:

(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

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

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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 March 11, 2013, a reply (an RCE and submission) was filed, and that on January 29, 2014, 324 days after the day after the date the reply was filed, a supplemental reply or other paper (an IDS) was filed.² 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.

It appears that, in stating that an applicant that submits an IDS filed after an RCE has been filed but before the next Office action is not required to submit a statement and/or fee, applicant is referring to the provisions of § 1.97. Simply put, the rules governing a supplemental reply under § 1.704(c)(8) are different than those governing the requirements for an IDS under § 1.97. Whether a statement and or fee are required under § 1.97 is not relevant to the determination of whether an IDS which is filed after an RCE has been filed but before an Office action has been mailed constitutes a "failure to engage" within the meaning of § 1.704(c)(8).

Further, applicant's comparison of the situation at hand with the situation discussed in *Arqule* is also not persuasive. In *Arqule*, the court stated that the grace period set forth in 35 USC 21(b) applies to the calculation of applicant delay in determination of the patent term adjustment. There is no similar statute regarding the filing of an IDS after an RCE is filed, however.

² It is additionally noted that on May 16, 2013, a supplemental reply or other paper (an IDS) was filed, 343 days after the day after the date the reply was filed. This IDS was not accompanied by a statement under 37 CFR 1.704(d) and was not expressly requested by the examiner. The 343 days completely overlaps, however, with the 494-day period of applicant delay discussed herein.

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Additionally, 37 CFR 1.97(b) does not address the timeliness of an IDS, rather, it states the conditions under which the Office will consider the IDS.

Lastly, the Office notes recently the Federal Circuit determined that submission of an IDS after the filing of a response to an election or restriction requirement is a reduction under 37 CFR 1.704(c)(8). See *Gilead Sciences, Inc. v. Lee* cv 14-1159 (Fed. Cir. 2015). In *Gilead*, the court noted that conduct of filing an IDS after the submission of a response to an election or restriction requirement interferes with the PTO's ability to conclude the application process because of significant time constraints faced by the PTO. See *Gilead* at page 15. Because the "A" Delay provision of the statute penalizes the PTO if the examiner fails to respond within four months of the applicant's response to the restriction requirement, any relevant information received after an initial response to a restriction requirement "interferes with the [PTO's] ability to process an application. *Id.* A supplemental IDS may force an examiner to go back and review the application again, while still trying to meet his or her timeliness obligations under § 154. *Id.*

The same analysis applies to submission of an IDS document after the filing of an RCE. The Office must respond to the submission of an RCE within four months of the filing of the RCE or provide additional "A" delay. Any IDS submission by patentee after the filing of a RCE "interferes" with the [PTO's ability] to process an application because the examiner may be forced to go back and review the application again. Accordingly, the Office maintains the reduction of applicant delay for the IDS submission after the filing of an RCE.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

$677 + 0 + 0 - 0 - 359 = 318$

Patentee's Calculation

$677 + 0 + 0 - 0 - 35 = 642$

In view of the redetermination, the petition is granted to the extent that the PTA calculation has been reviewed, 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**.

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Telephone inquiries specific to this matter should be directed to Attorney Advisor Douglas I. Wood at 571-272-3211.

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Office of the Deputy Commissioner

for Patent Examination Policy