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In re Patent of Scirica et al. :
Patent No. 9,039,736 : FINAL AGENCY DECISION ON
Issue Date: May 26, 2015 : REQUEST FOR INFORMATION
Application No. 12/036,828 : OF PATENT TERM ADJUSTMENT
Filing Date: February 25, 2008 :
Attorney Docket No. 2944DIVCON2 :
(203-4027 DIV CONII) :

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT” (“Request”), filed July 21, 2015, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent from one thousand six hundred and nine (1,609) days to one thousand six hundred and twenty-nine (1,629) days.

Pursuant to petitioners’ authorization, the petition fee of \$200 has been charged to deposit account no. 21-0550.

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 1609 days on May 26, 2015. A request seeking a PTA of 1629 days was timely filed on July 21, 2015. The sole issue in dispute is the length of reduction warranted pursuant to 37 CFR 1.704(c)(10) for the filing of replacement drawings on April 29, 2015, after a notice of allowance was mailed on March 16, 2015.

Decision

The PTA set forth on the patent is based on the following determination previously made by the Office:

Art Unit: OPET

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) (“A Delay”) is 145 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 563 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) (“C Delay”) is 988 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 87 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 1609 days (145 days of A Delay + 563 days of B Delay + 988 days of C Delay - 0 days of Overlap - 87 days of Applicant Delay).

The Request does not dispute the Office’s calculations of the periods of A Delay, B Delay, C Delay, and Overlap set forth in the Redetermination.

The Request asserts the Office should have entered an 8 day period of reduction, not a 28 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of replacement drawings on April 29, 2015, after a Notice of Allowance was mailed on March 16, 2014. The Request asserts the period of Applicant Delay is 67 days (30 + 29 + 8) days.

The Request argues the correct PTA is 1629 days (145 days of A Delay + 563 days of B Delay + 988 days of C Delay - 0 days of Overlap - 67 days of Applicant Delay).

As will be discussed, the period of Applicant Delay is 87 days.

Therefore, the correct PTA is 1609 days (145 days of A Delay + 563 days of B Delay + 988 days of C Delay - 0 days of Overlap - 87 days of Applicant Delay).

A Delay

The Request does not dispute the Office’s prior determination the period of A Delay is 145 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 145 days.

B Delay

The Request does not dispute the Office’s prior determination the period of B Delay is 563 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 563 days.

Art Unit: OPET

C Delay

The Request does not dispute the Office's prior determination the period of C Delay is 988 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 988 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 number of days of Applicant Delay is 87 days. The Office has recalculated the number of days of Applicant Delay as part of the Office's redetermination of the PTA and confirmed the number of days of Applicant Delay is 87 days. As previously stated, the sole issue in dispute is the length of reduction warranted pursuant to 37 CFR 1.704(c)(10) for the filing of replacement drawings on April 29, 2015, after a notice of allowance was mailed on March 16, 2015. The Request does not dispute the other two instances of Applicant Delay, as previously determined by the Office.

The Request asserts the Office should have entered an 8 day period of reduction, not a 28 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of replacement drawings on April 29, 2015, after a notice of allowance was mailed on March 16, 2015.

37 CFR 1.704(c) provides that:

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:

- (10) 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;

Art Unit: OPET

or

(ii) Four months;

In this instance, a Notice of Allowance was mailed on March 16, 2015. Replacement drawings were subsequently filed on April 29, 2015.

The Request asserts the Office should have entered an 8 day period of reduction, not a 28 day period of reduction, pursuant to 37 CFR 1.704(c)(10). The Request argues the Office should consider the date of the Issue Notification as the end date of the 37 CFR 1.704(c)(10) calculation.

The request argues the correct period of delay under 37 C.F.R. § 1.704(c)(10) is 8 days, which is the number of days beginning on April 29, 2015, the date the replacement drawings were filed and ending on May 6, 2015, the date the Office issued the Issue Notification.

MPEP 1306.03 states, "... A patent number and issue date will be assigned to an application and an Issue Notification will be mailed after the issue fee has been paid and processed by the USPTO." The issue fee having been paid and processed is the catalyst for the mailing of the Issue Notification. The Issue Notification of May 6, 2015 does not discuss, or even mention, the replacement drawings. In other words, the Issue Notification of May 6, 2015 does not constitute a response to the replacement drawings, filed April 29, 2015.

The language of 37 CFR 1.704(c)(10) provides clear guidance as to the end date of the calculation. The end date is "...the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper or four months." As stated in MPEP 2732,

37 CFR 1.704(c)(10) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the lesser of: (1) the number of days, if any, beginning on the date the amendment under 37 CFR 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 37 CFR 1.312 or such other paper; or (2) four months. The phrase "lesser of ...or [f]our months" is to provide a four-month cap for a reduction under 37 CFR 1.704(c)(10) if the Office takes longer than four months to issue an Office action or notice in response to the amendment under 37 CFR 1.312 or other paper. If the Office does not mail a response to the paper that triggered the delay under this provision and the patent issues in less than four months, then the applicant delay under this provision will end on the date of the patent issuance. The Office will treat the issuance of the patent as the response to the paper that triggered the delay.

As discussed above, no Office action or notice was mailed in response to the replacement drawings.

Art Unit: OPET

Pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 28 days, beginning on April 29, 2015, the date the replacement drawings were filed, and ending on and including May 26, 2015, the date the patent issued. The 28 day period of reduction pursuant to 37 CFR 1.704(c)(10) is proper and will not be altered.

The period of Applicant Delay is 87 days (30 + 29 + 28).

Conclusion

The Request asserts the correct PTA is 1629 days (145 days of A Delay + 563 days of B Delay + 988 days of C Delay – 0 days of Overlap – 67 days of Applicant Delay).

As previously discussed, the period of Applicant Delay is 87 days.

Therefore, the PTA is 1609 days (145 days of A Delay + 563 days of B Delay + 988 days of C Delay – 0 days of Overlap – 87 days of Applicant Delay).

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

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