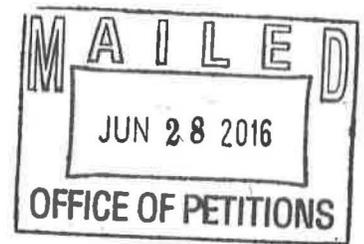




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In re Patent No. 9,068,212 :
Tabuchi et al. : DECISION ON REQUEST
Issue Date: 06/30/2015 : FOR RECONSIDERATION OF
Application No. 12/734,283 : PATENT TERM ADJUSTMENT
Filed: 04/22/2010 :
Attorney Docket No: :
0833531-0108 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT UNDER 37 C.F.R. § 1.705(d)," filed on July 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 zero (0) days to three hundred sixty-nine (369) 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 0 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 June 30, 2015, the above-identified application matured into U.S. Patent No. 9,068,212, with a patent term adjustment of 0 days.

On July 10, 2015, the subject request for reconsideration was filed. Patentee asserts that the reduction of 0 days is incorrect. Specifically, patentee asserts that the reduction of 472 days for an Information Disclosure Statement (IDS) filed on September 19, 2013, 472 days after the date a Request for Continued Examination (RCE) was filed on June 4, 2012 is in error. Patentee states that no reduction is due under § 1.704(c)(6) for a preliminary amendment or other preliminary paper submitted less than one month before the mailing of an Office action because the IDS was not filed less than one month before the mailing of an Office action. Patentee further avers that no reduction is due under 1.704(c)(8) for a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, that is filed after a reply has been filed because the IDS filed on September 19, 2013 was not a supplemental paper, but was made in a independent effort to comply with the duty of disclosure.

Art Unit: OPET

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).

Art Unit: OPET

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 June 4, 2012, a reply (an RCE and submission) was filed, and that on September 19, 2013, 472 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.

As noted above, petitioner asserts that the IDS was not "supplemental" to the submission, but was filed in accordance with petitioner's duty of disclosure. Patentee's argument, however, is not persuasive. The IDS filed on September 13, 2013 was clearly a supplemental paper or other paper filed after a reply (i.e., the RCE filed on June 4, 2012), had been filed. Accordingly, a reduction under 37 CFR 1.704(c)(8) is warranted. Furthermore, 37 CFR 1.704(c)(8) includes the safeguard that if the IDS is accompanied by a statement in accordance with 37 CFR 1.704(d), the submission of the IDS will not be considered a failure to engage in reasonable efforts to conclude processing or examination of the application. As such an applicant may file an IDS in accordance with the duty of disclosure and not incur a reduction for applicant delay, provided a statement under 37 CFR 1.704(d) can be included.

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.

Art Unit: OPET

Petitioner's argument that the Federal Register notice at 65 Fed. Reg. 56366-94 (September 18, 2000) does not directly discuss post-RCE submissions and therefore does not support "the invocation of [§ 1.704(c)(8)] in the context of a post-RCE submission" is also without merit. In this regard Comment 35 and its response discussed supplemental replies. Further, the failure of a Federal Register Notice to discuss a given situation cannot reasonably be interpreted to mean that the plain language of a regulation does not apply to that situation simply because the application of that regulation results in a detriment to petitioner.

Further, the designation of the application as "Docketed New Case—Ready for Examination" in PAIR has no bearing on 37 CFR 1.704(c)(8) delay. This is an internal processing code within the USPTO and is not part of the official record. As noted above, the showing of record that applicant filed an IDS after a reply had been filed, and did not provide a statement in accordance with 37 CFR 1.704(d).

Lastly, patentee's argument that the present situation is analogous to the situation set forth in § 1.704(c)(6) rather than § 1.704(c)(8) is not persuasive. The IDS was not filed less than one month before the mailing of an Office action and, in any event, did not require the mailing of a supplemental Office action.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

$579 + 0 + 0 - 0 - 682(88+92+472+30) = 0$

Patentee's Calculation

$579 + 0 + 0 - 0 - 210(88+92+30) = 369$

CONCLUSION

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

Application/Control Number: 12/734,283

Page 5

Art Unit: OPET

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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Office of the Deputy Commissioner
for Patent Examination Policy