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In re Patent No. 9,101,607 : DECISION
Drew, et al. : ON REQUEST FOR
Issue Date: 08/11/2015 : REDETERMINATION OF
Application No. 13/637,828 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 02/26/2013 :
Docket No.: 50318-042001 :

This is a decision on the patent term adjustment in response to the “REQUEST FOR REDETERMINATION OF PATENT TERM ADJUSTMENT”, filed October 9, 2015, requesting that the patent term adjustment determination for the above-identified patent be changed from 162 days to 229 days.

The request is **DENIED**.

This decision on patent term adjustment is the Director's decision on the applicant's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

On August 11, 2015, the above-identified application matured into U.S. Patent No. 9,101,607. The patent issued with a PTA of 162 days. The present request for redetermination of the patent term adjustment was timely filed within two months of the issue date.

The present petition

Patentee asserts that he should not have been assessed Applicant delay of 70 days under 37 CFR 1.704(c)(10) for filing an Information Disclosure Statement (IDS) on June 3, 2015, subsequent to the Notice of Allowance mailed April 3, 2013. Patentee argues that an initialed copy of the SB08 posted in PAIR on June 5, 2015, and therefore he should have only been assessed 3 days of delay under 37 CFR 1.704(c)(10). In the alternative, Patentee argues that the clock should have stopped when the Office mailed an Issue Notification on July 22, 2015, for a delay under 37 CFR 1.704(c)(10) of 50 days.

Patentee's argument has been considered, but is not persuasive. 37 CFR 1.704(c)(10) states that a circumstance that will constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application is:

Submission of an amendment under § 1.312 or other paper 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; or
- (ii) Four months.

It is well-established that the filing of an amendment under 37 CFR 1.312 or other paper, other than a request for continued examination (RCE) in compliance with 37 CFR 1.114, after the mailing of a notice of allowance constitutes a failure to engage in reasonable efforts to conclude prosecution of the application, resulting in a reduction of patent term adjustment under 37 CFR 1.704(c)(10). The Office has calculated this period of reduction as 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. In the circumstance where the Office does not mail a response to the paper that triggered the delay and the patent issues in less than four months, the Office has treated the issuance of the patent as the response to the paper that triggered the delay. Accordingly, under such circumstance, the Office has calculated the period of reduction for applicant delay counting the number of days beginning on the date of filing of the triggering paper and ending on the date of patent grant. Here, the IDS was filed on June 3, 2015, and the patent issued on August 11, 2015. The number of days in the period beginning on June 3, 2015 and ending on August 11, 2015 is 70 days.

Conclusion

Patentee is entitled to PTA of one hundred sixty-two (162) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $232 + 0 + 0 - 0 - 70 = 162$ days.

The Office acknowledges 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 Cliff Congo at (571) 272-3207.

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