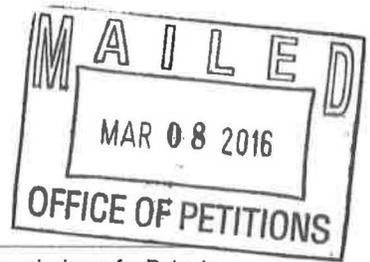




UNITED STATES PATENT AND TRADEMARK OFFICE



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In re Patent No. 9,129,954 :
Yen et al. :
Issue Date: 09/08/2015 : ON REDETERMINATION OF
Application No. 13/789382 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 03/07/2013 :
Atty. Docket No.: 102351-0207 :

This is in response to applicants “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT UNDER 37 CFR 1.705(d)”, filed November 3, 2015, requesting that the patent term adjustment determination for the above-identified patent be changed from six “6” days to 69 days. The Office has re-determined the PTA to be six (6) days.

Patentee also requests a refund of fees charged to patentee’s deposit account on September 16, 2013, and a refund of the petition fee.

This petition is hereby **DENIED**. 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).

Relevant Procedural History

On September 8, 2015, the above-identified application matured into U.S. Patent No. 9,129,954. The patent issued with a PTA of six (6) days. Patentee requests redetermination of the Patent Term Adjustment to 69 days.

Discussion

Patentee’s arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **six (6)** days of PTA. Patentee and the Office are in agreement regarding the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B); the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A) pursuant to the Federal Circuit’s decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014), and as to the amount of “A” delay under 35 U.S.C. § 154(b)(1)(A) and 37 CFR 1.702(a); however, patentee and the Office continue to disagree as to the amount of “applicant delay” under 35 U.S.C. § 154(b)(2)(C) and 1.704(b).

As to the amount of applicant delay, patentee argues that the Office erred in calculating a reduction of 63 days in connection with the filing of an Application Data Sheet (“ADS”), filed September 16, 2013. Patentee provides that the Office mailed a Notice to File Missing Parts of Nonprovisional Application (“Notice”), on April 15, 2013, requiring an oath or declaration or an ADS. In reply to the Notice, applicant timely filed a Declaration for each of the four (4)

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inventors identified in the application. Applicant thereafter filed the ADS on September 16, 2013. The Office charged applicant's deposit account a three (3) month extension of time fee of \$1400, pursuant to a general authorization to charge any additional fees contained in the Utility Patent Application Transmittal Letter filed with the application papers on March 7, 2013.

Patentee avers that the Notice did not indicate that there was any discrepancy in the calculation of the fees paid with the filing of the application. However, the Office charged an additional \$1400 of application filing fees. Moreover, patentee asserts that the additional \$1400 was charged in the amount in effect after the filing date of the application, said fees having increased between the filing of the application on March 7, 2013, and the date of the fee increase, March 19, 2013. Patentee requests this Office add back the 63 days of PTA assessed against applicant in connection with the filing of the ADS, and a refund of the \$1400 fee.

Office records

A review of Office records and of the application file confirm that in reply to the Notice to File Missing Parts of Nonprovisional Application ("Notice"), on April 15, 2013, applicant filed an oath or declaration for each of four (4) inventors, using PTO/AIA/01(modified), Declaration (37 CFR 1.63) for Utility or Design Application Using an Application Data Sheet. The Form notes that "An application data sheet (PTO/SB/14 or equivalent), including naming the entire inventive entity, must accompany this form or must have been previously filed. Use an additional PTO/AIA/01 for each inventor."

Office records further confirm that no application data sheet was filed with the four Declarations on May 2, 2013.

Applicant subsequently filed an application data sheet on September 16, 2013. As noted above, the Office charged applicant's deposit account a four (4) month extension of time fee of \$1400, pursuant to the general authorization to charge any additional fees filed in the Utility Patent Application Transmittal Letter filed with the application papers on March 7, 2013.

Petitioner's attention is directed to 37 CFR 1.63(b), which states:

Unless the following information is supplied in an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

- (1) Each inventor by his or her legal name; and
- (2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

In this instance, applicant filed a Declaration for each of four (4) inventors. Each of the Declarations named a single inventor, and did not identify each inventor by his or her legal name. The Declaration Form noted that "An application data sheet (PTO/SB/14 or equivalent),

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including naming the entire inventive entity, must accompany this form or must have been previously filed. Use an additional PTO/AIA/01 for each inventor.” Applicant used an additional PTO/AIA/01 for each inventor; however, applicant did not file an application data sheet with the Declarations. As such, the reply to the Notice, in the form of four PTO/AIA/01 Declarations, was not a complete and proper reply to the Notice. Applicant subsequently filed an ADS on September 16, 2013, however, the ADS required a three (3) month extension of time and fee to render the ADS, and the reply, complete and proper (including timely). Applicant is advised that the fees that are due are the fees in effect at the time of fee payment. Accordingly, no refund of the extension of time fee is appropriate.

Regarding the PTA of 63 days, patentee’s attention is directed to 37 CFR 1.704(b), which states that an applicant shall be deemed to have failed to engage in reasonable efforts to conclude prosecution for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant. As noted above, applicant filed a complete and proper (including timely), reply to the Notice on September 16, 2013.

Pursuant to 37 CFR 1.704(b), patentee was properly assessed a reduction of 63 days, beginning on the day after the date that is three months after the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request, July 16, 2013, and ending on the date the reply was filed, September 16, 2013.

Regarding patentee’s request for a refund of the petition fee, patentee is advised that the fee is a prerequisite prior to treatment on the merits of any application for patent term adjustment. 35 U.S.C. 41(d) authorizes the Office to establish a fee to recover the estimated average cost of treating applications for patent term adjustment (as well as a fee for treating a request for reinstatement of patent term adjustment), and the cost of treating an application for patent term adjustment is about the same regardless of whether the Office’s initial determination of patent term adjustment indicated in the notice of allowance is correct. Even when the application for patent term adjustment is correct, refunding the fee would require the Office to raise the fee set forth in § 1.18(e) (to enable the Office to recover the same aggregate amount); and (2) add further complication to a review process that must take place in a limited period of time¹. Moreover, and contrary to petitioner’s assertion, there is no error in interpreting or applying the PTA statute, and the request for a refund of the petition fee also denied.

Overall PTA Calculation

Formula:

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

¹ See, Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 56,366, 53,374 (September 18, 2000), 1239 Off. Gaz. Pat. Office 14 (October 3, 2000).

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USPTO's Calculation:

$$69 + 0 + 0 - 0 - 63 = 6$$

Patentee's Calculation

$$69 + 0 + 0 - 0 - 0 = 69$$

Conclusion

The present REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT has been considered; however, the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT, is DENIED.

Telephone inquiries specific to this decision should be directed to Attorney Advisor Derek Woods at (571) 272-3232.

/ROBERTCLARKE/
Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy