



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 9,144,441 :
Biedermann, et al. : FINAL AGENCY DECISION
Application No. 13/631,503 : DISMISSING REQUEST FOR
Issue Date: September 29, 2015 : RECONSIDERATION OF
Filed: September 28, 2012 : PATENT TERM ADJUSTMENT
Attorney Docket No. 69842/B884 : UNDER 37 CFR 1.705(b)

This is a decision on the “REQUEST FOR RECONSIDERATION OF THE REDETERMINATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b),” filed June 17, 2016, requesting that the patent term adjustment determination for the above-identified patent be changed from two hundred and eight (208) days to two hundred and thirty-seven (237).

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 208 days.

This 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 September 29, 2015, the above-identified application matured into U.S. Patent No. 9,144,441, with a patent term adjustment of 208 days.

On November 30, 2015, patentees filed a “Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(b)” requesting that the patent term adjustment be changed from 208 days to 237 days.

On April 19, 2016, a communication responsive to the “Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(b)” was mailed indicating that the patent term adjustment is 208 days.

On June 17, 2016, patentees filed the instant “Request for Reconsideration of the Redetermination of Patent Term Adjustment under 37 CFR 1.705(b)”. Patentees again assert that the reduction to the patent term adjustment under 37 CFR 1.704(c)(10) for the filing of an

Art Unit: OPET

amendment under 37 CFR 1.312 on August 31, 2015, should be 6 days beginning on August 31, 2015—the date the amendment under 37 CFR 1.312 was filed—and ending on August 31, 2015—the date that the examiner initialed the amendment under 37 CFR 1.312. Alternatively, applicant maintains that the reduction to the patent term adjustment under 37 CFR 1.704(c)(10) should end on September 9, 2015, which is the date the Issue Fee Notification was mailed. In support, patentees argue that: 1) Section 714.16(d) of the *Manual of Patent Examining Procedure* requires the examiner to prepare and sign a response to amendment under 37 CFR 1.312 and patentees should not be penalized for the failure of the examiner to follow guidance of MPEP 714.16(d); 2) patentee should not be penalized for the Supervisory Patent Examiner's failure to adhere to the guidance set for the MPEP 714.16(d) directing the Supervisory Patent Examiner to mail a reply to the amendment under 37 CFR 1.312 where the patent examiner has not done so.

Patentee does not disagree with the 270-day period of A delay, or the B delay period of 1 day.

STATUTE AND REGULATION

35 U.S.C. 154(b)(1)(C) provides that:

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)(10) states:

(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

Art Unit: OPET

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;

OPINION

Patentee's arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to 208 days of PTA.

A review of the file history reveals that a Notice of Allowance and Issue Fee Due was mailed May 26, 2015. On August 26, 2015, applicants filed an amendment under 37 CFR 1.312 for which the Office entered a reduction to the patent term adjustment under 37 CFR 1.704(c)(10) of 35 days. Patentees maintain that the appropriate reduction is 6 days. The Office reaffirms that the appropriate reduction under 37 CFR 1.704(c)(10) is 35 days. The period of reduction under 37 CFR 1.704(c)(10) is 35 days, with said period beginning on the date the amendment under 37 CFR 1.312 was filed, August 26, 2015, and ending on September 29, 2015, the date the patent issued. If the Office does not mail a response to the paper that triggered the delay under 37 CFR 1.704(c)(10) 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. See MPEP 2732.

Patentee argues that the period of reduction under 37 CFR 1.704(c)(10) should be tolled on August 31, 2015, or alternatively on September 9, 2015, yet no paper responsive to the amendment under 37 CFR 1.312 was mailed to patentees on August 31, 2015, nor September 9, 2015. It is noted that the issue notification, mailed on September 9, 2015, does not in any way respond to the amendments to the specification requested in the amendment under 37 CFR 1.312 and is not considered responsive to the same. Further, relative to the calculation of patent term adjustment and the reduction thereof, the USPTO is authorized, pursuant to 35 USC 154(b)(1)(C)(iii), to prescribe regulations that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application, and to set forth rules governing the calculation of period of reduction of the patent term adjustment. Exercising the aforementioned mandate, the USPTO prescribed in 37 CFR 1.704(c)(10) that the period for reduction of the patent term adjustment for the filing of amendment under 37 CFR 1.312, or other paper, after the mailing of a notice of allowance begins on the date the amendment under 37 CFR 1.312 is received and ends on the date of mailing of a paper responsive to the amendment under 37 CFR 1.312 or other paper or 4 months, whichever occurs first. In prescribing 37 CFR 1.704(c)(10), the Office contemplated that, in certain circumstances, the failure of the Office to mail an Office action or notice within four months of submission of the paper would prevent additional reduction in PTA beyond the four month limit. The rules do not, however, contemplate limiting the reduction prescribed by 37 CFR 1.704(c)(10) at a period less

Art Unit: OPET

than 4 months other than by mailing of an Office action or notice in response to the paper filed after a notice of allowance was mailed.

The record reflects that, on August 31, 2015, the examiner considered the amendment under 37 CFR 1.312, however, no communication responsive to the amendment under 37 CFR 1.312 was mailed on that date. As no communication responsive to the amendment under 37 CFR 1.312 filed on August 26, 2015, was mailed, the reduction to the patent term adjustment under 37 CFR 1.704(c)(10) for the filing of the amendment under 37 CFR 1.312 on August 26, 2015, ended on the date the patent issued—September 29, 2015, or four months, whichever occurred first. The period of reduction under 37 CFR 1.704(c)(10) for the filing of the amendment under 37 CFR 1.312 on August 26, 2015, is 35 days.

Overall PTA Calculation

Formula

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

USPTO’s Calculation:

$$270 + 1 + 0 - 0 - 63 = 208$$

Patentee’s Calculation:

$$270 + 1 + 0 - 0 - 34 = 237$$

Conclusion

Patentee is entitled to PTA of two hundred and eight (208) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $270 + 1 + 0 - 0 - 63 = 208$.

CONCLUSION

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

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

Application/Control Number: 13/631,503

Page 5

Art Unit: OPET

Telephone inquiries specific to this matter should be directed to Kenya McLaughlin, Attorney Advisor, at 571-272-3222.

/ROBERT CLARKE/

Patent Attorney

Office of the Deputy Commissioner
for Patent Examination Policy