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Inventors: Edwards et al.	:	
Patent No. 9,150,619	:	FINAL AGENCY DECISION ON
Issue Date: October 6, 2015	:	REQUEST FOR RECONSIDERATION
Application No. 12/439,054	:	OF PATENT TERM ADJUSTMENT
Int'l Filing Date: August 31, 2007	:	
Attorney Docket No. 017227-0212	:	

This decision is being issued in response to the request filed pursuant to 37 C.F.R. § 1.705 on December 7, 2015, which requests the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) from 0 days to 316 days.

The request is **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

The patent issued with a PTA determination of 0 days on October 6, 2015.

The instant request seeking an adjustment of 316 days was filed on December 7, 2015.

Decision

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

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) (“A Delay”) is 617 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 129 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) (“C Delay”) is 0 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 750 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.

The sum of 617 days of A Delay, 129 days of B Delay, and 0 days of C Delay reduced by 0 days of Overlap and 750 days of Applicant Delay is *negative* 4 days. However, the PTA for a patent cannot be less than 0 days. As a result, the instant patent sets forth a PTA of 0 days.

The Office's prior calculations of the periods of A Delay, B Delay, C Delay, and Overlap are not in dispute.

The request asserts the correct period of Applicant Delay is 430 days, not 750 days.

The request asserts the correct PTA is 316 days, not 0 days.

The Office's prior calculation of the period of Applicant Delay includes a 320-day period of delay under 37 C.F.R. § 1.704(c)(8) based on the following facts:

- (1) A reply to an Office action, which includes a request for continued examination ("RCE") and an amendment, was filed on February 24, 2012;
- (2) An information disclosure statement ("IDS") was filed without a statement under 37 C.F.R. § 1.704(d) on January 9, 2013; and
- (3) The Office did not issue an Office action or a notice of allowance in response to the reply on or before the date the IDS was submitted.

The request states the submission of the January 9, 2013 IDS does not warrant entry of a reduction in patent term adjustment for Applicant Delay. The Office acknowledges the correct period of Applicant Delay is 430 days and the correct PTA is 316 days *if* the submission of the IDS does not warrant entry of a reduction in patent term for Applicant Delay.

35 U.S.C. § 1.154(b)(2)(C)(iii) states, "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 C.F.R. § 1.704(c) states in part,

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include ...

- (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 C.F.R. § 1.704(d)(1) states,

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 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 Sec. 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 Sec. 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

In view of 37 C.F.R. § 1.704(c)(8) and 37 C.F.R. § 1.704(d), the submission of an IDS after the submission of a reply and prior to the issuance of an Office action or notice in response to the reply will warrant entry of a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8) unless at least one of the following is true:

- (1) The examiner expressly requested the submission of the IDS; and
- (2) The IDS is accompanied by a statement under 37 C.F.R. § 1.704(d)(1).

The request does not argue the examiner expressly requested the submission of the IDS or argue the IDS was accompanied by a statement under 37 C.F.R. § 1.704(d)(1). Instead, the request argues the provisions of 37 C.F.R. § 1.704(c)(8) do not apply to “post-RCE submissions.” In other words, the request appears to be arguing the provisions of 37 C.F.R. § 1.704(c)(8) do not apply if the reply includes a RCE.

The Office has long-held the position that submission of supplemental replies or other papers after an applicant’s reply has been filed impacts the ability of the Office to respond to the applicant’s reply within the four month period as required under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(2). *See* Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56385 (Sept. 18, 2000) (responses to comments 35 and 36). The Office is tasked with responding to the applicant within four months of the filing of its reply and not within four months of the filing of an IDS that is filed thereafter. *See* 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(2). The Office has recognized the Office the filing of an IDS after the filing of a reply “will significantly interfere with the Office’s ability to meet the time frame set forth in 35 U.S.C. 154(b)(1)(A)(ii). . . .” *Id.* (response to comment 36). The Office has expressly identified a post-reply IDS as a paper that interferes with the Office’s ability to examine an application in its discussion of 37 C.F.R. § 1.704(c)(8). *Id.* (response to comment 36). The provisions of 37 C.F.R. § 1.704(c)(8) do not distinguish between an IDS filed

after a reply, which includes a RCE, and an IDS filed after a reply, which does not include a RCE, because each IDS interferes with the abilities to examine the application.

The request states the entry of a reduction in patent term adjustment based on the IDS is inconsistent with 35 U.S.C. § 154(b)(2)(C) in view of the “timing (i.e. before an Office action)” of the submission of the IDS. The Office acknowledges the IDS was timely filed after the submission of the reply and before the issuance of an Office action or notice of allowance in response to the reply. However, the fact an IDS is timely filed with the Office does not preclude the entry of a reduction in patent term adjustment for Applicant Delay based on the submission of the IDS. Indeed, the statute itself expressly contemplates that timely responses by an applicant (e.g., those that are made between three and six months after an Office action) will nevertheless be considered to be applicant delay. *See* 35 U.S.C. § 154(b)(2)(C)(ii). By measuring the amount of applicant delay under 37 C.F.R. § 1.704(c)(8) from the filing date of the earlier reply to the filing date of the later supplemental reply or paper, the Office encourages early submission of such papers (by minimizing the amount of applicant delay imposed) while properly balancing the effect of such submissions against the Office’s requirement to respond to the earlier reply within four months under 35 U.S.C. § 154(b)(1)(A). *See* 65 Fed. Reg. at 56385 (responses to comments 35 and 36).

Patentee’s final argument that the deduction is not consistent with Office’s practice because the Office has not consistently charged an applicant delay when an IDS is filed subsequent to an RCE and before an action has been mailed in reply to the RCE is not persuasive as no delay would accrue if the IDS was accompanied by a proper statement under 37 CFR 1.704(d) or the IDS was expressly requested by the examiner. Moreover, assuming *arguendo*, that the Office has not consistently applied 37 CFR 1.704(c)(8), the Office has inherent authority to reconsider its decision. *See Japanese Found. for Cancer Research v. Lee*, 773 F.3d 1300, (Fed. Cir. 2014). Moreover, the Office is not compelled to continue to make errors that it may have made in the past once the Office recognizes its prior errors. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant’s marks.”) (citation omitted); *In re Ric-Wil Co.*, 87 F.2d 516, 32 USPQ 396 (CCPA 1937) (“The applicant cites a large number of marks registered by the office recently, which are claimed to be more descriptive than the one here involved. Even if this be true, it constitutes no reason why the registration of appellant’s mark should be allowed, if it be descriptive. Administrative errors cannot change the law.”)

A reply to an Office action was filed on February 24, 2012. An IDS was filed without a statement under 37 C.F.R. § 1.704(d) on January 9, 2013. Pursuant to 37 C.F.R. § 1.704(c)(8), the period of Applicant Delay resulting from the submission of the IDS on a date after the reply was filed is 320 days, which is the number of days beginning on the day after the date the reply was filed (February 25, 2012) and ending on the date the IDS was filed (January 9, 2013).

In view of the prior discussion, the Office's entry of the 320-day reduction in patent term adjustment based on the submission of the January 9, 2013 IDS was proper. Therefore, the correct period of Applicant Delay is 750 days, as previously calculated by the Office.

Conclusion

The total period of Applicant Delay is 750 days.

The correct PTA is 0 days.

Telephone inquiries specific to this decision should be directed to Attorney Advisor Steven Brantley at (571) 272-3203.

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