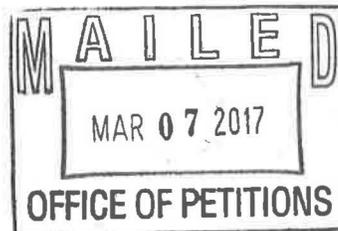




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In re Patent No. 9,169,299 :
Lisowski et al. :
Issue Date: 10/27/2015 : ON REDETERMINATION OF
Application No. 13/594,773 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 08/24/2012 :
Attorney Docket No.: 091511-0562/8273. :
.US02 :

This is a response to applicant’s “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)”, filed February 29, 2016, requesting that the Office adjust the patent term adjustment (“PTA”) to 407 days. The Office has confirmed the PTA to be 332 days.

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 October 27, 2015, the above-identified application matured into U.S. Patent No. 9,169,299. The patent issued with a PTA of 332 days. A petition for a two month extension of time pursuant to 37 CFR 1.136(a) and the present request for redetermination of the patent term adjustment were timely filed on Monday, February 29, 2016.

Decision

Patentee’s arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to 332 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) and 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 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(c).

As to Applicant Delay, patentee avers that the Office erred in calculating a reduction of 75 days in connection with the filing of an amendment to correct drawings, filed August 14, 2015, after the mailing of a Notice of Allowance, mailed June 16, 2015. Patentee asserts that the mailing by the Examiner of the Notice to File Corrected Application Papers should be considered a paper filed in response to a request to correct an error or omission in the Notice of Allowability, and

Art Unit: OPET

pursuant to the MPEP 2732, not considered a failure to engage in reasonable efforts to conclude processing or examination of an application.

Patentee's argument has been carefully considered. Initially, it is noted that the Notice to File Corrected Application Papers was issued in the Publications Branch to correct informalities in the drawings. The Notice to File Corrected Application Papers was not issued by the Examiner. As such, the Notice to File Corrected Application Papers is not a paper filed in response to the examiner's reasons for allowance or a request to correct an error or omission in the Notice of Allowance or Notice of Allowability, and the filing of the amendment under 37 CFR 1.312 is not one of the enumerated specific papers submitted after the mailing of a Notice of Allowance that are not considered a failure to engage in reasonable efforts to conclude processing or examination of an application. Moreover, the Notice to File Corrected Application Papers required correction of an error made by the applicant, not an error made by the Office. Accordingly, 37 CFR 1.704(c)(10) applies.

Regarding 37 CFR 1.704(c)(10), patentees' attention is directed to 35 U.S.C. § 154(b)(2)(C), REDUCTION OF PERIOD OF ADJUSTMENT, and section (iii), which 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." Pursuant to 35 U.S.C. § 154(b)(2)(C)(iii), the Director prescribed, *inter alia*, 37 CFR 1.704(c)(10), which states that the submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, shall reduce the period of adjustment set forth in § 1.703 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;

The MPEP 2732 provides, in relevant part:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper, other than a request for continued examination in compliance with 37 CFR 1.114, after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. (Emphasis added).

Under 37 CFR 1.704(c)(10), papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) an amendment under 37 CFR 1.312; (2) a paper containing a claim for priority or benefit or request to correct priority or benefit information (e.g., a new or supplemental application data sheet filed to correct foreign priority or domestic benefit information); (3) a request

Art Unit: OPET

for a corrected filing receipt; (4) a certified copy of a priority document; (5) drawings; (6) a letter related to biologic deposits; (7) a request to change or correct inventorship; and (8) an information disclosure statement not accompanied by a statement in compliance with 37 CFR 1.704(d). (Emphasis added).

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.

In this instance, Office records confirm that an amendment under 37 CFR 1.312 was filed August 14, 2015, after the mailing of a Notice of Allowance, mailed June 16, 2015. Office records further confirm that no Office action or notice in response to the amendment was mailed to Patentee. The Office therefore treated the issuance of the patent as the response to the paper that triggered the delay. Accordingly, pursuant to 35 U.S.C. § 154(b)(2)(C)(iii), and 37 CFR 1.704(c)(10)(i), the period of patent term reduction was properly reduced 75 days, beginning on the date of filing of the triggering paper, August 14, 2015, and ending on the date of patent grant, October 17, 2015, or 75 days.

Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

343 + 64 + 0 - 0 - 75 = 332

Patentee’s Calculation

343 + 64 + 0 - 0 - 0 = 407

Conclusion

Art Unit: OPET

The present REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) has been considered; however, the REQUEST FOR REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b), is **DENIED**.

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

/ROBERT CLARKE/

Robert A. Clarke

Patent Attorney

Office of the Deputy Commissioner
for Patent Examination Policy