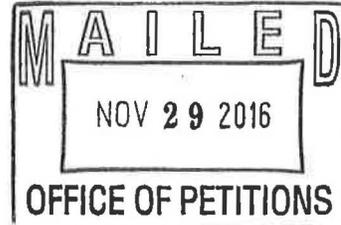




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Inventors: Basu et al. :
Patent No. 9,212,134 :
Issue Date: December 15, 2015 :
Application No. 13/821,682 :
Int'l Filing Date: September 13, 2011 :
Attorney Docket No. MBX-311.1P US :

FINAL AGENCY DECISION ON
REQUEST FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT

This is a decision on the request under 37 C.F.R. § 1.705 filed January 8, 2016, which requests the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) set forth on the patent from 93 days to 109 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 93 days on December 15, 2015.

The instant request seeking an adjustment of 109 days was timely filed on January 8, 2016.

A request under 37 C.F.R. § 1.705 must include the \$200 fee set forth in 37 C.F.R. § 1.18(e). The required \$200 fee has been charged to Deposit Account No. 50-0268 pursuant to the general fee authorization in the petition.

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 218 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 0 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 125 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. In other words, the following formula may be used to calculate the PTA:

$$\text{PTA} = \text{A Delay} + \text{B Delay} + \text{C Delay} - \text{Overlap} - \text{Applicant Delay}$$

The patent sets forth a PTA of 93 days (218 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 125 days of Applicant Delay).

The request asserts the Office incorrectly calculated the periods of A Delay and Applicant Delay, and as a result, incorrectly calculated the PTA set forth on the patent.

The request asserts the correct PTA is 109 days, which is 223 days of A Delay reduced by 114 days of Applicant Delay.

A Delay

The period of A Delay consists of single period of A Delay under 37 C.F.R. § 1.703(a)(1).

37 C.F.R. § 1.703(a)(1) states, with emphasis added,

[The period of A Delay includes the] number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) **or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application** and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

The instant application is the national stage of International Application No. PCT/US11/51389.

The Office previously determined the national stage commenced on March 13, 2013. The Office also determined the period of delay under 37 C.F.R. § 1.703(a)(1) is 218 days, which is the number of days beginning on May 14, 2014 (the day after the date 14 months after the date of commencement of March 13, 2013) and ending on December 17, 2014 (the day the Office issued a restriction requirement).

The petition asserts the date of commencement is March 8, 2013, and requests the period of A Delay be increased by 5 days.

The Office acknowledges the period of A Delay is 223 days, not 218 days, *if* the correct date of commencement is March 8, 2013.

35 U.S.C. § 371(b) states,

Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39(1)(a) of the treaty.

The date the “applicable time limit” expired is March 13, 2013, which is the date 30 months after the earliest claimed priority date.

The date of commencement is March 13, 2013 (“30-Month Date”), unless the application is entitled to an earlier date under 35 U.S.C. § 371(f).

35 U.S.C. § 371(f) states, with emphasis added,

At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose **and** the applicable requirements of subsection (c) of this section have been complied with.

A request for early processing was submitted with the application papers on March 8, 2013. However, the applicable requirements of 35 U.S.C. § 371(c) were not satisfied until August 15, 2013.

The instant application’s international filing date is September 13, 2011. For applications with an international filing date prior to September 16, 2012, the “applicable requirements” of 35 U.S.C. § 371(c) include the submission of an oath or declaration.

MPEP 1893.01(e)(II) states,

Applicants entering the national stage under 35 U.S.C. 371 for an international application having an international filing date prior to September 16, 2012 are required to file an oath or declaration of the inventor in accordance with pre-AIA 37 CFR 1.497(a) and (b)....

In general, the requirement for an oath or declaration in compliance with 37 CFR 1.497(a) - (b) will have been previously satisfied if a declaration in compliance with PCT Rule 4.17(iv) executed by all the inventors was submitted within the time limits provided in PCT Rule 26ter.1 in the international phase.

The requirement for an oath or declaration was not satisfied prior to the submission of application papers on March 8, 2013, because an oath or declaration in compliance with PCT Rule 4.17(iv) was not timely filed in the international application.

The application papers submitted on March 8, 2013, are accompanied by a declaration. However, as stated in a Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) issued on March 19, 2013, the “declaration does not comply with 37 CFR 1.497(a) and (b) in that it ... is missing the PCT International Application number in the body of the declaration.”

A reply to the March 19, 2013 notification including a new declaration was filed on June 18, 2013. The Office issued a Notification of Defective Response on July 8, 2013, indicating the June 18, 2013 declaration fails to comply with 37 C.F.R. §§ 1.497(a) and (b).

A declaration in compliance with 37 C.F.R. §§ 1.497(a) and (b) was filed on August 15, 2013.

As previously stated, the date of commencement is March 13, 2013, unless the application is entitled to an earlier date under 35 U.S.C. § 371(f). The application is not entitled to an earlier date of commencement under 35 U.S.C. § 371(f) because an oath or declaration in compliance with 37 C.F.R. §§ 1.497(a) and (b) was not filed until August 15, 2013.

In view of the prior discussion, the period of delay under 37 C.F.R. § 1.703(a)(1) is 218 days, which is the number of days beginning on May 14, 2014 (the day after the date 14 months after the date of commencement of March 13, 2013) and ending on December 17, 2014 (the day the Office issued a restriction requirement).

Applicant Delay

The Office previously determined the period of Applicant Delay is 125 days.

The Office’s prior calculation of the period of Applicant Delay includes a 11-day period of delay under 37 C.F.R. § 1.704(c)(8) based on the following facts:

- (1) A reply to a restriction requirement was filed on February 13, 2015;
- (2) An information disclosure statement (“IDS”) was filed without a statement under 37 C.F.R. § 1.704(d) on February 24, 2015; 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 asserts the Office’s entry of an 11-day reduction in patent term adjustment based on the submission of the IDS is erroneous. Specifically, the request asserts the submission of the 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 114 days, not 125 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) provides an “exception” to the provisions of 37 C.F.R. § 1.704(c)(8). Specifically, 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.

The February 24, 2015 IDS was submitted after a reply to a restriction requirement was filed and prior to the Office issuing an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 in response to the reply. Therefore, the submission of the IDS warrants 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 “exception” set forth in 37 C.F.R. § 1.704(d)(1) applies to the IDS.

The request does not assert, and a review of the record fails to indicate, the examiner expressly requested the submission of the IDS.

As will be discussed, the exception set forth in 37 C.F.R. § 1.704(d)(1) does not apply to the IDS.

37 C.F.R. § 1.704(d)(1) states a paper that only contains an IDS in compliance with 37 C.F.R. §§ 1.97 and 1.98 will not result in delay under 37 C.F.R. § 1.704(c)(8) *if* the IDS is accompanied by a statement under 37 C.F.R. § 1.704(d)(1). The IDS submitted on February 24, 2015, is *not* accompanied by a statement under 37 C.F.R. § 1.704(d)(1). Therefore, the exception set forth in 37 C.F.R. § 1.704(d)(1) does not apply to the IDS.

The request asserts a statement under 37 C.F.R. § 1.704(d)(1) was unnecessary because the IDS was submitted in compliance with 37 C.F.R. § 1.97(b)(3). The Office acknowledges the submission of a statement under 37 C.F.R. § 1.704(d)(1) is not necessary for an IDS to be considered timely under 37 C.F.R. § 1.97(b)(3). However, the fact an IDS is timely submitted 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 PTA statute 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).

The February 24, 2015 IDS was submitted after a reply to a restriction requirement was filed and prior to the Office issuing an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 in response to the reply. The record fails to indicate the examiner expressly requested the submission of the IDS, and a statement under 37 C.F.R. § 1.704(d)(1) was not submitted with the IDS. Pursuant to 37 C.F.R. § 1.704(c)(8), the period of Applicant Delay resulting from the submission of the IDS is 11 days, which is the number of days beginning on February 14, 2015 (the day after the date the reply was filed) and ending on February 25, 2015 (the date the IDS was filed).

In view of the prior discussion, the correct total period of Application Delay is 125 days.

Conclusion

The period of A Delay is 218 days.

The period of B Delay is 0 days.

The period of C Delay is 0 days.

The period of Overlap is 0 days.

The period of Applicant Delay is 125 days.

The correct PTA is 93 days (218 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 125 days of Applicant Delay).

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

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