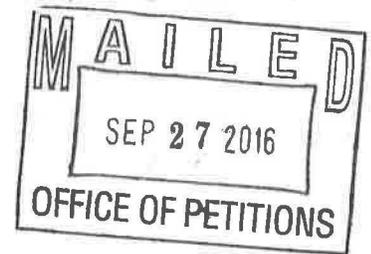




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In re Patent No. 9,249,454 :
Woolf et al. :
Issue Date: February 2, 2016 : DECISION ON PETITION
Application No. 14/206,950 :
Filed: March 12, 2014 :
Atty Docket No. 555891: FPC-003CON4:

This is a decision on patentee's "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)" filed February 10, 2016, requesting that the Office adjust the patent term adjustment from 0 days to 20 days. The Office has reviewed the calculations and determined that the patent term adjustment of 0 days is correct.

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 February 2, 2016, this patent issued with a patent term adjustment determination of 0 days. On February 10, 2016, patentee timely filed this REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT seeking an adjustment of the determination to 20 days.

Decision

Patentee and the Office are in agreement regarding the Office's calculation of "A" delay of 20 days, "B" delay of 0 days, "C" delay of 0 days and overlap of 0 days. At issue is the period of applicant delay.

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Patentee presents the issue as follows:

As set forth in 37 C.F.R. § 1.703(f), Patentee is entitled to a period of patent term adjustment equal to the period of A Delay and B Delay by the Office, reduced by the period of time during which Applicant failed to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. § 1.704 ("Applicant Delay"). As indicated on the PTA Sheet, the Office has calculated a period of Applicant Delay of 38 days. (See Exhibit A, line No. 73.) Patentee disagrees with the USPTO's calculation of the period of Applicant Delay of 38 days. Patentee submits that the total period of Applicant Delay is 0 days.

Patentee submits that the Office's mailing of a Response to Amendment under Rule 312, on November 13, 2015, is not a proper basis for Applicant Delay, because it is an event caused by the Office itself, rather than an Applicant response or submission.

Patentee further submits that the filing of the Response to the Notice to File Corrected Application Papers on October 7, 2015, did not constitute a "failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application." In addition, Patentee submits that the Response was timely filed within two months of the Notice, or by November 23, 2015.

ON APPLICANT DELAY

The Office has reviewed the disputed calculation of applicant delay and has determined that the period of reduction of 38 days for filing of an amendment after mailing of the Notice of Allowance is correct. Patentee's arguments have been considered but not found persuasive.

It is undisputed that after the mailing of the notice of allowance on September 15, 2015, patentee filed an amendment on October 7, 2015. It is immaterial to the calculation of patent term adjustment that the filing was in response to a Notice mailed by the Office on September 23, 2015 or that patentee responded within three months. These are factors relevant to the circumstances that constitute applicant delay pursuant to 37 CFR §§1.704(c)(8) and 1.704(b). The applicant delay at issue here is evaluated pursuant to 37 CFR 1.704(c)(10).

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37 CFR 1.704(c)(10)¹ provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(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 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;

This reduction is not predicated on whether the submission after the mailing of the notice of allowance was or was not requested by the Office. Upon promulgation of this rule, the Office explained the basis for this circumstance being an applicant "failure to engage in reasonable efforts to conclude examination or processing," as follows:

All papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait for payment of the issue fee to begin the process of preparing the application for publication as a patent. Section 1.704(c)(10) as adopted should deter applicants from filing papers after allowance which could have a

¹ Paragraph (c)(10) was revised to add the language "other than a request for continued examination in compliance with § 1.114." See *Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee*, 80 FR 1346, Jan. 9, 2015, effective Mar. 10, 2015.

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beneficial impact upon the Office's ability to publish applications as patents more quickly.

As further indicated in the AIPA patent term adjustment final rule, "[a]n applicant who is engaging in actions or inactions that prevent or interfere with the Office's ability to process or examine an application cannot reasonably be characterized as 'engag[ing] in reasonable efforts to conclude processing or examination of an application' (35 U.S.C. 154(b)(2)(C)(i))." See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR at 56379 (response to comment 17).

In this instance the Office advised applicant that a drawing was continued on a second page (or more) without proper labeling under 37 CFR 1.84(u)(1). On October 7, 2015, applicant filed an amendment under 1.312 along with the replacement drawings 24A-24H in compliance with 37 CFR 1.84(u)(1). In view of applicant's actions in filing in the first instance drawing figures not in compliance with the patent rules, the Office delay beginning on October 7, 2015, the date of filing of the replacement drawings and ending on November 13, 2015, the date the Office mailed a response stating that the amendment to add the drawings was entered, is properly attributed to applicant.

In view thereof, total applicant delay remains 38 days.

Overall PTA Calculation

Formula:

$$\text{"A" delay} + \text{"B" delay} + \text{"C" delay} - \text{Overlap} - \text{applicant delay} = X$$

USPTO's Calculation:

$$20 + 0 + 0 - 0 - 38 = 0$$

Patentee's Calculation

$$20 + 0 + 0 - 0 - 0 = 20$$

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Conclusion

The patent term adjustment (PTA) remains **zero (0)** days of PTA. Using the formula "A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X, the amount of PTA is calculated as follows:
 $20 + 0 + 0 - 0 - 38 = 0$ days.

As the patent issued with 0 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

Telephone inquiries specific to this matter should be directed to Attorney Advisor, Nancy Johnson at (571) 272-3219.

/ROBERT CLARKE/
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