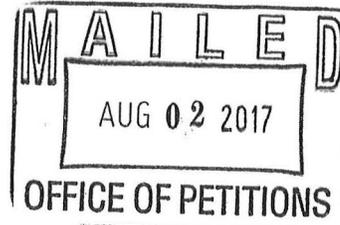




WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206



Inventors: Laeremans et al.	:	
Patent No. 9,260,508	:	FINAL AGENCY DECISION ON
Issue Date: February 16, 2016	:	REQUEST FOR RECONSIDERATION
Application No. 12/643,286	:	OF PATENT TERM ADJUSTMENT
Filing Date: December 21, 2009	:	
Attorney Docket No. A0848.7009US01	:	

This is a decision on the request under 37 C.F.R. § 1.705 filed July 15, 2016, which requests the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) set forth on the patent from 240 days to 249 days.

The request is **DENIED**.

This decision is the Director’s decision on applicants’ 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 240 days on February 16, 2016. The instant request seeking an adjustment of 249 days was timely filed a payment for a three-month extension of time on July 15, 2016.

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 424 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 207 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 391 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 240 days (424 days of A Delay + 207 days of B Delay + 0 days of C Delay - 0 days of Overlap - 391 days of Applicant Delay).

The periods of A Delay, B Delay, C Delay, and Overlap are not in dispute.

The request asserts the Office's calculation of the period of Applicant Delay incorrectly includes a 9-day period of delay based on the submission of an amendment after allowance. The request asserts the correct period of Applicant Delay is 382 days. The request asserts the correct PTA is 249 days.

The Office issued a Notice of Allowance on September 30, 2015.

The Office issued a Notice to File Corrected Application Papers ("NFC") on October 6, 2015. The NFC requires the submission of an amendment amending the drawings and the specification.

The issue fee was paid on December 30, 2015.

An amendment under 37 C.F.R. § 1.312 was filed in response to the NFC on January 6, 2016.

The Office issued a Response to Rule 312 Communication on January 14, 2016.

The Office issued a 9-day reduction in patent term adjustment based on the submission of the amendment.

The request states the submission of the amendment does not warrant entry of a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include, with emphasis added,

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[.]

The request asserts "no Applicant delay should have been assessed for the January 6, 2016 Response" because the Office expressly requested the submission of the amendment.

The Office entered the 9-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10), *not* 37 C.F.R. § 1.704(c)(8).

The provisions of 37 C.F.R. § 1.704(c)(10) do not include an “exception” for papers expressly requested by an examiner.

37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... 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.

The submission of the amendment after allowance warrants entry of a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10) in the amount of 9 days, which is the number of days beginning on the date the amendment was filed (January 6, 2016) and ending on the date the Office issued the Response to Rule 312 Communication (January 14, 2016).

In view of the prior discussion, the Office’s entry of a 9-day reduction in patent term adjustment based on the submission of the amendment after allowance was proper.

Conclusion

The correct PTA is 240 days (424 days of A Delay + 207 days of B Delay + 0 days of C Delay - 0 days of Overlap - 391 days of Applicant Delay).

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

/ROBERT CLARKE/
Robert A. Clarke
Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy