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Inventor: William K. McVicar :
Patent No. 9,278,991 : FINAL AGENCY DECISION ON
Issue Date: March 8, 2016 : REQUEST FOR RECONSIDERATION
Application No. 13/750,389 : OF PATENT TERM ADJUSTMENT
Filing Date: January 25, 2013 :
Attorney Docket No. ITJ-053 :

This is a decision on the request under 37 C.F.R. § 1.705 filed May 9, 2016. In practical terms, the request seeks to have the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) set forth on the patent from 100 to 120 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 100 days on March 8, 2016. The instant request was timely filed with the required fee of \$200 on May 9, 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 182 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 43 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 100 days (182 days of A Delay + 43 days of B Delay + 0 days of C Delay - 0 days of Overlap - 125 days of Applicant Delay).

The Office's calculation of the period of Applicant Delay includes the following three periods of delay:

- (1) A 31-day period of delay under 37 C.F.R. § 1.704(b),
- (2) A 32-day period of delay under 37 C.F.R. § 1.704(b), and
- (3) A 62-day period of delay under 37 C.F.R. § 1.704(c)(10).

The sole issue in dispute is the number of days in the period of Applicant Delay under 37 C.F.R. § 1.704(c)(10).

Patentee states the correct period of delay under 37 C.F.R. § 1.704(c)(10) is 42 days, not 62 days as previously calculated by the Office.

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 Office issued a Notice of Allowance on October 26, 2015. Corrected drawings were filed on January 7, 2016. The Office issued an Issue Notification on February 17, 2016. The Office issued the application as patent using the corrected drawings on March 8, 2016.

The Office determined the period of delay under 37 C.F.R. § 1.704(c)(10) is 62 days, which is the number of days beginning on the date the drawings were filed and ending on the date the patent issued.

Patentee states the Issue Notification is the Office's "actual response" to the submission of the corrected drawings. Patentee states the correct period of delay 37 C.F.R. § 1.704(c)(10) is 42 days, which is the number of days beginning on the date the drawings were filed and ending on the date the Office issued the Issue Notification.

The request fails to establish that the submission of the corrected drawings on January 7, 2016, caused or contributed to the issuance of the Issue Notification. In other words, the request fails to establish the Issue Notification was issued in "response to" the correct drawings.

The Issue Notification does not discuss, or even mention, the corrected drawings. In other words, the Issue Notification does not constitute a response to the submission of corrected drawings.

In view of the prior discussion, the Issue Notification is not an Office action or notice issued in response to the submission of corrected drawings, and the correct period of delay under 37 C.F.R. § 1.704(c)(10) is 62 days, as previously calculated by the Office.

Conclusion

The period of delay under 37 C.F.R. § 1.704(c)(10) is 62 days.

The total period of Applicant Delay is 125 (31 + 32 + 62) days.

The correct PTA is 100 days (182 days of A Delay + 43 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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