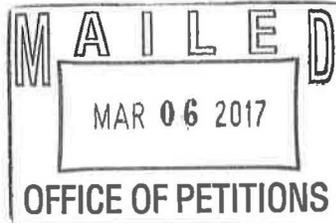




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In re Patent of Pacetti et al.	:	
Patent No. 9,289,319	:	FINAL AGENCY DECISION ON
Issue Date: March 22, 2016	:	REQUEST FOR INFORMATION
Application No. 13/471,263	:	OF PATENT TERM ADJUSTMENT
Filing Date: May 14, 2012	:	
Attorney Docket No. 062571.00629	:	

This is a decision on the “APPLICATION FOR PATENT TERM ADJUSTMENT” (“Request”), filed July 22, 2016, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent from four hundred forty-six (446) days to four hundred eighty-one (481) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of four hundred forty-six (446) days.

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 446 days on March 22, 2016. A petition for a two month extension of time pursuant to 37 CFR 1.136(a) and the present request seeking a PTA of 481 days were timely filed on July 22, 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 325 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 260 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

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- 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 139 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 446 days (325 days of A Delay + 260 days of B Delay + 0 days of C Delay - 0 days of Overlap - 139 days of Applicant Delay).

The Request asserts the Office should have entered a 12 day period of reduction, not a 47 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of an amendment under 37 CFR 1.312 on February 5, 2016, after a Notice of Allowance was mailed on November 13, 2015. The Request asserts the period of Applicant Delay is 104 days (31 + 61 + 12) days.

The Request argues the correct PTA is 481 days (325 days of A Delay + 260 days of B Delay + 0 days of C Delay - 0 days of Overlap - 104 days of Applicant Delay).

As will be discussed, the period of Applicant Delay is 139 days.

Therefore, the correct PTA is 446 days (325 days of A Delay + 260 days of B Delay + 0 days of C Delay - 0 days of Overlap - 139 days of Applicant Delay).

A Delay

The Request does not dispute the Office’s prior determination of the period A Delay is 325 days. The Office has recalculated the period of A Delay as part of the Office’s redetermination of the PTA and confirmed the period of A Delay is 325 days.

B Delay

The Request does not dispute the Office’s prior determination the period of B Delay is 260 days. The Office has recalculated the period of B Delay as part of the Office’s redetermination of the PTA and confirmed the period of B Delay is 260 days.

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C Delay

The Request does not dispute the Office's prior determination the period of C Delay is 0 days. The Office has recalculated the period of C Delay as part of the Office's redetermination of the PTA and confirmed the period of C Delay is 0 days.

Overlap

The Request does not dispute the Office's prior determination the number of days of Overlap is 0 days. The Office has recalculated the number of days of Overlap as part of the Office's redetermination of the PTA and confirmed the number of days of Overlap is 0 days.

Applicant Delay

The Request disputes the Office's prior determination the number of days of Applicant Delay is 139 days. The Office has recalculated the number of days of Applicant Delay as part of the Office's redetermination of the PTA and confirmed the number of days of Applicant Delay is 139 days. The Request does not dispute the other 2 instances of Applicant Delay, as previously determined by the Office.

The Request asserts the Office should have entered a 12 day period of reduction, not a 47 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of an amendment under 37 CFR 1.312 on February 5, 2016, after a notice of allowance was mailed on November 13, 2015.

37 CFR 1.704(c) 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;

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In this instance, a Notice of Allowance was mailed on November 13, 2015. An amendment under 37 CFR 1.312 was subsequently filed on February 5, 2016.

The Request asserts the Office should have entered a 12 day period of reduction, not a 47 day period of reduction, pursuant to 37 CFR 1.704(c)(10). The Request argues the Office should consider February 16, 2016 as the end date of the 37 CFR 1.704(c)(10) calculation because, "In the Image File Wrapper (IFW) on PAIR, the Patent Term Adjustment tab shows an entry on February 16, 2016, labeled "Response to Amendment under Rule 312."

The language of 37 CFR 1.704(c)(10) provides clear guidance as to the end date of the calculation. The end date is "...the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper or four months." As stated in MPEP 2732,

37 CFR 1.704(c)(10) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by 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. The phrase "lesser of ...or [f]our months" is to provide a four-month cap for a reduction under 37 CFR 1.704(c)(10) if the Office takes longer than four months to issue an Office action or notice in response to the amendment under 37 CFR 1.312 or other paper. If the Office does not mail a response to the paper that triggered the delay under this provision and the patent issues in less than four months, then the applicant delay under this provision will end on the date of the patent issuance. The Office will treat the issuance of the patent as the response to the paper that triggered the delay.

No Office action or notice was mailed in response to the Rule 312 amendment on February 16, 2016.

Applicants participate in the e-Office Action program. An e-mail notification is sent only when there is new Office communication that day for applications associated with the participant's Customer Number. Specific e-Office Action related events with corresponding dates are available in the Transaction History tab in Private PAIR. The Transaction Description events are self-explanatory and are labeled as "Email Notification," "Electronic Review," and if applicable "Mail Post Card." In addition, an OA.EMAIL document is placed in the file wrapper of the application notified that day. The OA.EMAIL document is a truncated version of the daily e-mail listing details of only that specific application number's new communication.

A review of the image file wrapper reveals that there is no document entitled OA.EMAIL, which is the code used for Private PAIR Correspondence Notifications. Office databases show the February 16, 2016 examiner annotated first page of the Rule 312 amendment was part of an internal Office document, a Printer Rush, and no mailing occurred.

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As such, the end date of the calculation is the date the patent issued, as it is earlier than 4 months from the filing date of the February 5, 2016 Rule 312 amendment.

Pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 47 days, beginning on February 5, 2016, the date the Rule 312 amendment was filed, and ending on and including March 22, 2016, the date the patent issued. The 47 day period of reduction pursuant to 37 CFR 1.704(c)(10) is proper and will not be altered.

The period of Applicant Delay is 139 days (31 + 61 + 47).

Conclusion

The Request asserts the correct PTA is 481 days (325 days of A Delay + 260 days of B Delay + 0 days of C Delay - 0 days of Overlap – 104 days of Applicant Delay).

As previously discussed, the period of Applicant Delay is 139 days. Therefore, the PTA is 446 days (325 days of A Delay + 260 days of B Delay + 0 days of C Delay – 0 days of Overlap – 139 days of Applicant Delay).

Telephone inquiries specific to this decision should be directed to Attorney Advisor Shirene Willis Brantley at (571) 272-3230.

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