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In re Patent of Lam et al.	:	
Patent No. 9,309,561	:	FINAL AGENCY DECISION ON
Issue Date: April 12, 2016	:	REQUEST FOR INFORMATION
Application No. 14/098,519	:	OF PATENT TERM ADJUSTMENT
Filing Date: December 5, 2013	:	
Attorney Docket No.: 093671.42	:	

This is a decision on the “REQUEST TO RECONSIDER PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(B)” (“Request”), filed April 29, 2016, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent from eighty-five (85) days to two hundred twenty-seven (227) 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 85 days on April 12, 2016. A request seeking a PTA of 85 days was timely filed on April 29, 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 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

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- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) (“Applicant Delay”) is 133 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 85 days (218 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 133 days of Applicant Delay).

The Request does not dispute the Office’s calculations of the periods of B Delay, C Delay, and Overlap.

The Request asserts the Office should have entered an 83 day period of adjustment, not a 52 day period of adjustment, pursuant to 37 CFR 1.702(a)(4), for the delay in issuing the patent after the issue fee was paid. This change results in a period of A Delay of 249 (166 + 83) days. The Request’s calculation of Applicant Delay removes without any discussion the 13 day period of reduction pursuant to 37 CFR 1.704(c)(10) for the filing of a Rule 312 amendment on September 4, 2015, after a Notice of Allowance was mailed on July 21, 2015. The Request asserts the Office should have entered a 9 day period of delay under 37 CFR 1.704(c)(10) because, “Applicants timely responded to the September 16, 2015 Rule 312 communication on September 25, 2015.” The Request argues a 13 day period of reduction, not a 120 day period of reduction, is warranted pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on September 25, 2015, after a Notice of Allowance was mailed on July 21, 2015. The Request asserts the period of Applicant Delay is 22 days (9 + 13) days.

The Request argues the correct PTA is 227 days (249 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 22 days of Applicant Delay).

As will be discussed, the period of A Delay is 218 days and the period of Applicant Delay is 133 days.

Therefore, the correct PTA is 85 days (218 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 133 days of Applicant Delay).

#### A Delay

The Request disputes the Office’s prior determination the period of A Delay is 218 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 218 days.

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The Request argues the Office should have entered an 83 day period of adjustment, not a 52 day period of adjustment, pursuant to 37 CFR 1.702(a)(4) for the delay in issuing the patent after the issue fee was paid. The Office does not concur.

37 CFR 1.702(a)(4) calls for an adjustment when the Office fails to issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied. In this case, the issue fee was paid on October 20, 2015. The Office had four months, not three months as the Request argues, to issue the patent. As calculated under 37 CFR 1.703(a)(6), the Office was properly assessed a 52 day period of adjustment for the period beginning on February 21, 2016, which is the day after four months after the issue fee was filed, and ending on April 12, 2016, the date the patent issued.

Accordingly, no change will be made with respect to the 37 CFR 1.702(a)(4) adjustment of 52 days. The period of A Delay is 218 (166 [undisputed] + 52) days.

#### B Delay

The Request does not dispute the Office's prior determination the period of B Delay is 0 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 0 days.

#### 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 133 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 133 days.

The pertinent regulation to the analysis is 37 CFR 1.704(c)(10). 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

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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;

The Request's calculation of Applicant Delay removes without any discussion the 13 day period of reduction pursuant to 37 CFR 1.704(c)(10) for the filing of a Rule 312 amendment on September 4, 2015, after a Notice of Allowance was mailed on July 21, 2015. The Request asserts the Office should have entered a 9 day period of delay under 37 CFR 1.704(c)(10) because, "[a]pplicants timely responded to the September 16, 2015 Rule 312 communication on September 25, 2015." The Request argues a 13 day period of reduction, not a 120 day period of reduction, is warranted pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on September 15, 2015, after a Notice of Allowance was mailed on July 21, 2015. The Request asserts the period of Applicant Delay is 22 days (9 + 13) days.

The Office does not concur with any of these assertions.

The Office finds applicant was properly charged with a 13 day period of reduction pursuant to 37 CFR 1.704(c)(10) for the filing of a Rule 312 amendment on September 4, 2015, after a Notice of Allowance was mailed on July 21, 2015. A Notice of Allowance was mailed on July 21, 2015. On September 4, 2015, applicant filed a Rule 312 amendment. The fact that the September 4, 2015 Rule 312 amendment was mailed in response to a Notice to File Corrected Application Papers, mailed August 21, 2015, is immaterial to the 37 CFR 1.704(c)(10) calculation.

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Applicant's attention is drawn to the rule itself which states an amendment under 37 CFR 1.312 is a paper that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an

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application. There is no “expressly requested by the examiner” exemption in 37 CFR 1.704(c)(10).

Accordingly, the Office properly entered a 13 day reduction, counting the number of days in the period beginning on the date the amendment under 37 CFR 1.312 was filed, September 4, 2015, and ending on September 16, 2015, the date the Office mailed a Response to Rule 312 Communication.

The Request asserts the Office should have entered a 9 day period of delay under 37 CFR 1.704(c)(10) because, “[a]pplicants timely responded to the September 16, 2015 Rule 312 communication on September 25, 2015.” The Office does not concur. The mailing of the Response to Rule 312 Communication did not begin any clock for applicant. A 9 day period of reduction is not warranted.

The Request asserts a 13 day period of reduction, not a 120 day period of reduction, is warranted pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on September 25, 2015, after a Notice of Allowance was mailed on July 21, 2015. The Request argues the delay in addressing the September 25, 2015 Rule 312 amendment was due to the death of Examiner Marschel, which was a circumstance beyond applicant’s control.

While Examiner Marschel passing was certainly an unfortunate circumstance beyond applicant’s control, the rules do not provide for special patent term adjustment calculation in this situation. Applicant does not explain how the proposed 13 day period of reduction is calculated, and indeed, it is impossible to determine the end date for the proposed calculation absent pure speculation.

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. ...

As stated above, a Notice of Allowance was mailed on July 21, 2015. A Rule 312 amendment was filed on September 25, 2015. The Office did not mail a response to the September 25, 2015 Rule 312 amendment until March 11, 2016, which amounts to a 169 day period of reduction. Only a 120 day/4 month period of reduction was entered, as 37 CFR 1.704(c)(10) provides the period of adjustment set forth in §1.703 shall be reduced by the lesser of the number of days, if

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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 four months.

Pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 120 days. The 120 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 133 days (13 + 120).

### Conclusion

The Request asserts the correct PTA is 227 days (249 days of A Delay + 0 days of B Delay + 0 days of C Delay – 0 days of Overlap – 22 days of Applicant Delay).

As previously discussed, the period of A Delay is 218 days, and the period of Applicant Delay is 133 days.

Therefore, the PTA is 85 days (218 days of A Delay + 0 days of B Delay + 0 days of C Delay – 0 days of Overlap – 133 days of Applicant Delay).

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

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