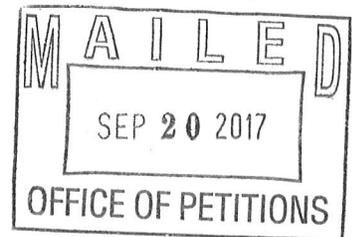




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In re Patent of Carlson et al.	:	
Patent No. 9,443,253	:	FINAL AGENCY DECISION ON
Issue Date: September 13, 2016	:	REQUEST FOR INFORMATION
Application No. 13/774,139	:	OF PATENT TERM ADJUSTMENT
Filing Date: February 22, 2013	:	
Attorney Docket No. 18US02/119945-	:	
201801/US	:	

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(B)” (“Request”), filed November 14, 2016, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent from three hundred ninety-nine (399) days to four hundred eighty (480) 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 three hundred ninety-nine (399) 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 399 days on September 13, 2016. The present request seeking a PTA of 480 days was timely filed on Monday, November 14, 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 358 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 144 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 103 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 399 days (358 days of A Delay + 144 days of B Delay + 0 days of C Delay - 0 days of Overlap - 103 days of Applicant Delay).

The Request asserts the Office should have entered a 3 day period of reduction, not an 84 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of an Information Disclosure Statement (“IDS”) on June 22, 2016, after a Notice of Allowance was mailed on May 9, 2016. The Request asserts the period of Applicant Delay is 22 days (19 + 3) days.

The Request argues the correct PTA is 480 days (358 days of A Delay + 144 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 Applicant Delay is 103 days.

Therefore, the correct PTA is 399 days (358 days of A Delay + 144 days of B Delay + 0 days of C Delay - 0 days of Overlap - 103 days of Applicant Delay).

A Delay

The Request does not dispute the Office’s prior determination of the period A Delay is 358 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 358 days.

B Delay

The Request does not dispute the Office’s prior determination the period of B Delay is 144 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 144 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 103 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 103 days.

The Request only disputes one instance of Applicant Delay, as previously determined by the Office. The Request asserts the Office should have entered a 3 day period of reduction, not an 84 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of an IDS on June 22, 2016, after a notice of allowance was mailed on May 9, 2016.

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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It is undisputed that a Notice of Allowance was mailed on May 9, 2016, and an IDS was subsequently filed on June 22, 2016.

The Request asserts the Office should have entered a 3 day period of reduction, not an 84 day period of reduction, pursuant to 37 CFR 1.704(c)(10). The Request argues the Office should consider June 24, 2016 as the end date of the 37 CFR 1.704(c)(10) calculation because, "The PAIR shows that the "List of References cited by applicant and considered by examiner" mailed on June 24, 2016 is the notice mailed in response to the IDS of June 22, 2016."

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 IDS, filed June 22, 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, associated with a June 24, 2016 mailing. Office databases show the June 24, 2016 examiner annotated first page of the IDS and the accompanying documents were 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 June 22, 2016 IDS.

Pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 84 days, beginning on June 22, 2016, the date the IDS was filed, and ending on and including September 13, 2016, the date the patent issued. The 84 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 103 days (19 + 84).

Conclusion

The Request asserts the correct PTA is 480 days (358 days of A Delay + 144 days of B Delay + 0 days of C Delay - 0 days of Overlap - 22 days of Applicant Delay).

As previously discussed, the period of Applicant Delay is 103 days. Therefore, the PTA is 399 days (358 days of A Delay + 144 days of B Delay + 0 days of C Delay - 0 days of Overlap - 103 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