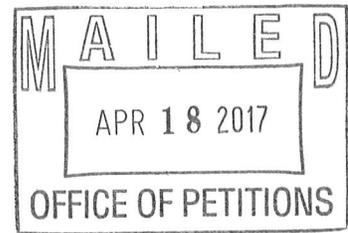




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In re Patent No. 9,468,761 :  
Frei et al. :  
Issue Date: October 18, 2016 : DECISION ON  
Application No. 14/177,066 : PATENT TERM ADJUSTMENT  
Filed: February 10, 2014 :  
Atty Docket No. 1000.207CON2 :  
/2113.010496 :

This is a decision on patentee's "PETITION UNDER 37 C.F.R. 1.705(d) AND REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION" filed December 13, 2016, requesting that the Office adjust the patent term adjustment from 127 days to 189 days. The Office has reviewed the calculations and determined that the patent term adjustment of 127 days is correct.

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

On October 18, 2016, this patent issued with a patent term adjustment determination of 127 days. On December 13, 2016, patentee timely filed this "PETITION UNDER 37 C.F.R. 1.705(d) AND REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION" seeking an adjustment of the determination to 189 days.

#### Decision

Patentee and the Office are in agreement regarding the Office's calculation of "A" delay, "B" delay, "C" delay and overlap. At issue is the period of applicant delay.

Patentee asserts that the 62 days of Applicant delay arising from the submission of drawings received August 18, 2016 should not result in a reduction of patent term adjustment. Patentee's

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basis for this conclusion is that the drawings were filed within three months of the mailing of the Notice to File Corrected Application Papers mailed June 17, 2016. Accordingly, patentee maintains under 37 CFR 1.704(b), applicant engaged in a reasonable effort to conclude processing of the application. Therefore, there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 CFR 1.704.

#### ON APPLICANT DELAY

The Office has reviewed the disputed calculation of applicant delay and has determined that the period of reduction of 62 days for filing of the drawing after mailing of the notice of allowance is correct. Patentee's arguments have been considered but not found persuasive.

Patentee fails to appreciate that the basis of the 62-day applicant delay is 37 CFR 1.704(c)(10), not 37 CFR 1.704(b). Applicant failed to engage in reasonable efforts to conclude processing or examination of this application by filing drawings after the mailing of the notice of allowance.

It is undisputed that after the mailing of the notice of allowance on June 6, 2016, patentee filed a replacement sheet of drawings on August 18, 2016. It is immaterial to the calculation of patent term adjustment that the filing was in response to a Notice mailed by the Office on June 17, 2016 or that patentee responded within three months. These are factors relevant to the circumstances that constitute applicant delay pursuant to 37 CFR §§1.704(c)(8) and 1.704(b). The applicant delay at issue here is evaluated pursuant to 37 CFR 1.704(c)(10).

37 CFR 1.704(c)(10)<sup>1</sup> 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

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<sup>1</sup> Paragraph (c)(10) was revised to add the language "other than a request for continued examination in compliance with § 1.114." See *Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee*, 80 FR 1346, Jan. 9, 2015, effective Mar. 10, 2015.

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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 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. See MPEP 2732.

Moreover, this reduction is not predicated on whether the submission after the mailing of the notice of allowance was or was not requested by the Office. Upon promulgation of this rule, the Office explained the basis for this circumstance being an applicant "failure to engage in reasonable efforts to conclude examination or processing," as follows:

All papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait for payment of the issue fee to begin the process of preparing the application for publication as a patent. Section 1.704(c)(10) as adopted should deter applicants

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from filing papers after allowance which could have a beneficial impact upon the Office's ability to publish applications as patents more quickly.

It is well-established that the submission of drawings after a notice of allowance has been given or mailed is a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application because the submission of amendments after an application is allowed causes substantial interference with the patent issue process. Applicants have been advised since at least the 2001 OG Notice entitled *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 OG 111 (June 26, 2001), that under 37 CFR 1.704(c)(10), papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: ... (5) drawings.

The burden is on applicant to prevent incurring applicant delay pursuant to 37 CFR 1.704(c)(10). It is applicant's responsibility to ensure that all outstanding requirements are met for issuance of the patent. This includes ensuring that compliant drawings are filed prior to the mailing of the notice of allowance.

Accordingly, it is concluded that 62 days of applicant delay pursuant to 37 CFR 1.704(c)(10) was properly entered for the period beginning on August 18, 2016 (the date of filing of the replacement drawing after the mailing of the notice of allowance) and ending on October 18, 2016 (the date of issuance of the patent as no paper was mailed in reply to the filing of the drawing).

In view thereof, total applicant delay remains 62 days.

#### Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay =  
X

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USPTO's Calculation:

$$189 + 0 + 0 - 0 - 62 = 127$$

Patentee's Calculation

$$189 + 0 + 0 - 0 - 0 = 189$$

**Conclusion**

The patent term adjustment (PTA) remains **one hundred twenty-seven (127)** days of PTA. Using the formula "A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X, the amount of PTA is calculated as follows:  $189 + 0 + 0 - 0 - 62 = 127$  days.

As the patent issued with 127 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

Telephone inquiries specific to this matter should be directed to Attorney Advisor, Nancy Johnson at (571) 272-3219.

/ROBERT CLARKE/  
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