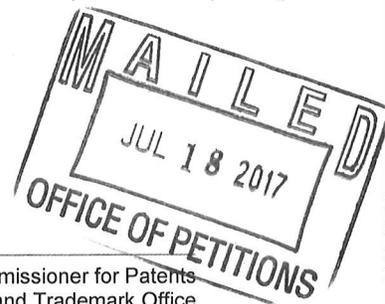




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In re Application of	:	
Vaarkamp et al.	:	
Application No. 14/208,928	:	
Filed: March 13, 2014	:	
Patent No. 9,468,915	:	DECISION ON REQUEST FOR
Issue Date: October 18, 2016	:	RECONSIDERATION OF
Attorney Docket No.: B248 2060US.1	:	PATENT TERM ADJUSTMENT
(0055.0)	:	
Title: SELECTIVE CATALYTIC	:	
REDUCTION CATALYST SYSTEM	:	

This is a decision on Patentee’s request for reconsideration pursuant to 37 C.F.R. § 1.705(b) filed November 9, 2016, requesting that the Office adjust the patent term adjustment from sixty-one (61) days to either one hundred and sixty-four (164) days or one hundred and forty-six (146) days.

The Office acknowledges the submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) on November 9, 2016. No additional fees are required.

This Decision on Request for Reconsideration of Patent Term Adjustment of patent term adjustment 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, the Office determined that applicant was entitled to 61 days of PTA.

On November 9, 2016, Patentee filed a request for redetermination of patent term adjustment along with \$200.00 fee set forth in 37 C.F.R. § 1.18(e), requesting a PTA of either 164 or 146 days, pursuant to 37 C.F.R. § 1.705(b).

Decision

Upon review, the USPTO finds that Patentee is entitled to sixty-one (61) days of PTA.

Patentee and the Office are in agreement regarding the amount of “A” delay under 35 § U.S.C. § 154(b)(1)(A), “B” delay under 35 U.S.C. § 154(b)(1)(B), “C” delay under 35 U.S.C. § 154(b)(1)(C), and overlap under 35 U.S.C. § 154(b)(2)(A).

The sole issue in dispute is the amount of reduction of PTA under 35 U.S.C.

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§ 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704.

“A” Delay

The Patentee and Office agree are 225 days of “A” delay. The period of “A” delay is 225 days under 37 C.F.R. § 1.703(a)(1) beginning on May 14, 2015 (the day after the date that is fourteen months after the day the application was filed) and ending on December 24, 2015 (the date the first Office action was mailed).

“B” Delay

The Patentee and Office agree that there are zero days of “B” delay, since the patent issued on October 18, 2016, which is less than three years after the application was filed on March 13, 2014.

“C” Delay

The Patentee and the Office agree that the amount of “C” delay under 35 U.S.C. § 154(b)(1)(C) is zero days.

Overlap

The Patentee and the Office agree the number of overlapping days of Office delay is zero days.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

The Office finds that, under 37 C.F.R. § 1.704, the amount of PTA should be reduced by 164 days. The Office has determined that the Patentee failed to engage in reasonable efforts to conclude processing or examination of its application during the following periods.

- (1) A 61-day period pursuant to 37 C.F.R. § 1.704(b) from March 25, 2016 until May 24, 2016 because the Office mailed a non-final Office action December 24, 2015. Accordingly, the three-month response date was March 24, 2016. However, the Patentee did not file its amendment and remarks until May 24, 2016.
- (2) A 103-day period pursuant to 37 C.F.R. § 1.704(c)(10)(i) from July 8, 2016 until October 18, 2016 because Patentee filed a terminal disclaimer on July 8, 2016 after a notice of allowance was mailed on June 20, 2016, and the patent issued on October 18, 2016.

Patentee takes issue with the 103-day reduction, and makes two arguments. First, Patentee argues that since the terminal disclaimer was filed less than three months after the mailing of the notice of allowance, there was no failure on the part of the applicant to engage in reasonable efforts to conclude processing or examination of the application.

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Second, Patentee argues in the alternative that if 37 C.F.R. § 1.704(c)(10) is applicable to the present set facts, the period of reduction should total 18 days, beginning with mailing of the notice of allowance on June 20, 2016 and ending with the filing of the terminal disclaimer on July 8, 2016.¹

Patentee's arguments have been carefully considered, but have been determined to be unpersuasive.

Regarding Patentee's first argument, 37 C.F.R. § 1.704(c)(10) sets forth, *in toto*:

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:

...

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 Office mailed a notice of allowance on June 20, 2016, a terminal disclaimer was filed on July 8, 2016, and the patent issued on October 18, 2016. 37 C.F.R. § 1.704(c)(10) clearly states that the filing of an amendment under §1.312 or other paper after a notice of allowance has been given or mailed is a circumstance that constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application. The filing of a terminal disclaimer after allowance may account for delay in issuing the patent in that the Office must necessarily review the disclaimer and have such terminal disclaimer processed by the Office.

Regarding Patentee's second argument, 37 C.F.R. § 1.704(c)(10)(i) clearly sets forth the manner in which the reduction is calculated, in that the period begins with the date on which the amendment under §1.312 or other paper was filed and ends with the mailing date of the Office action or notice in response to the amendment under §1.312 or such other paper.

¹ The Office calculates this period to total 19 days.

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Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - overlap - applicant delay = X.

USPTO’s Calculation:

$$225 + 0 + 0 - 0 - 164 (61 + 103) = 61$$

Patentee’s Calculations:

$$225 + 0 + 0 - 0 - 61 = 164$$

$$225 + 0 + 0 - 0 - 79 (61 + 18) = 146$$

Conclusion

Patentee is entitled to PTA of sixty-one (61) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $225 + 0 + 0 - 0 - 164 = 61$ days.

In view thereof, no adjustment to the patent term will be made. It follows that a certificate of correction is not required.

Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.²

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

² Patentee will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Patentee is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Patentee.