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OFFICE OF PETITIONS

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In re Patent No. 7,928,120 :
Arend et al. : DECISION ON REQUEST FOR
Issue Date: April 19, 2011 : RECONSIDERATION OF
Application No. 11/627,906 : PATENT TERM ADJUSTMENT
Filed: January 26, 2007 :
Attorney Docket No. 310477-1351 :
Title: CYANOISOQUINOLINE :
COMPOUNDS AND METHODS OF USE :
THEREOF :

This is a decision on the "PETITION FOR RECONSIDERATION OF DECISION REGARDING PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)". Patentees request that the determination of patent term adjustment under 35 U.S.C. § 154(b) be corrected from 508 days to 536 days.

The petition to change patent term adjustment determination under 35 U.S.C. § 154(b) from 508 days to a 536 days is **DENIED**.

BACKGROUND

On April 19, 2011, the above-identified application matured into U.S. Patent No. 7,928,120, with a revised patent term adjustment of 508 days. On June 13, 2011 the initial request for reconsideration was filed. On June 17, 2011 the request for reconsideration was dismissed. On August 5, 2011, patentees submitted this request for reconsideration of patent term adjustment.

Patentees continue to dispute the reduction of 28 days under 37 CFR 1.704(c)(10) in connection with the supplemental declaration filed March 8, 2011 after the mailing of the Notice of Allowance.

Patentees contend the supplemental declaration was filed as part of and discussed in applicants' §312 amendment under 37 CFR §1.67(a)(2) to correct the primary citizenship of inventor Flippin. Patentees argue that the supplemental declaration does not constitute a failure to engage in reasonable efforts to conclude processing or examination of the application. Instead applicants state the filing of a supplemental declaration to correct an error that could not have been corrected earlier demonstrates diligence, not delay. Patentees also argue that the filing of the supplemental oath or declaration does not appear in the list of actions contained in 37 CFR 1.704(c) that constitute per se failure of an applicant to engage in reasonable efforts. Lastly, patentees maintain that the supplemental declaration was not a separate paper but was filed with the 312 amendment. Thus, any reduction ended with the mailing of the response to the 312 amendment mailed March 18, 2011.

RELEVANT STATUTE AND REGULATIONS

35 U.S.C. 154(b)(2)(c) states:

REDUCTION OF PERIOD OF ADJUSTMENT. -

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

...

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

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:

37 CFR 1.704 (c)(10) provides:

(10) Submission of an amendment under § 1.312 or other paper 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;

MPEP 2732 states, in pertinent part:

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. Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See 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 Off.Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or

"Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office). Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) **oaths or declarations**. 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 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.

OPINION

Patentees' argument has been considered and determined to be not persuasive. It is undisputed that patentees filed an amendment and a supplemental declaration on March 8, 2011 after the mailing of the Notice of Allowance. While a "Response To Rule 312 Communication" was mailed on March 22, 2011, the response addressed entry of the 312 amendment.

The record shows a reduction pursuant to 37 CFR 1.704(c)(10) of 15 days for the submission of the 312 amendment on March 8, 2011 is required. The reduction is calculated beginning March 8, 2011 and ending on March 22, 2011, the date the communication in response to the 312 amendment was mailed. Further review shows an additional reduction pursuant to 37 CFR 1.704(c)(10) of 43 days for the submission of the supplemental declaration on March 8, 2011 is required. The reduction is calculated beginning March 8, 2011 and ending on April 19, 2011, the date of the issuance of the patent. Since the 15 days for the 312 amendment overlaps with the 43 days for the submission of drawings a total (c)(10) reduction of 43 (15 + 28) days is warranted.

Contrary to patentees' argument, the 312 amendment and the supplemental declaration pursuant to 37 CFR 1.67 are two distinct documents. The 312 amendment involved amendments to the claims that did not involve a requirement to submit a supplemental declaration. Thus, the submission of the supplemental declaration was not in support of the 312 amendment. The mere reference of the declaration in the 312 amendment and the fact the two documents were submitted on the same day does not make the supplemental declaration part of the 312 amendment. Further MPEP 2732 clearly states that the submission of a declaration is indeed one of the papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application. Patentees had the length of prosecution to submit a supplemental declaration which may have not resulted in a patent term reduction.

CONCLUSION

For the above-stated reasons, a review of the petition and file wrapper of the above-identified patent reveals that the above-identified patent is not entitled to a patent term extension or adjustment of 536 days. Therefore, the petition to change the patent term adjustment indicated on the above-identified patent to 536 days is **denied**.

This decision may be viewed as final agency action. See MPEP § 1002.02(b).

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney at (571) 272-3215.



Anthony Knight
Director
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