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OFFICE OF PETITIONS

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In re Patent No. 7,939,629 : DECISION ON APPLICATION FOR
Issued: May 10, 2011 : PATENT TERM ADJUSTMENT
Application No. 11/665,541 :
Filing or 371(c) Date: April 17, 2007 :
Dkt. No.: BJS-4145-56 :

This is a decision on the request for reconsideration of decision mailed April 4, 2011 with respect to the application for patent term adjustment under 37 CFR 1.704(b) filed February 28, 2011. This request, filed May 12, 2011, is deemed timely filed within the meaning of 37 CFR 1.181(f).

Patentee requests that the patent term adjustment of 366 days accorded pursuant to 37 CFR 1.703(a)(1) be increased to 510 days. Such an increase would result in the applicant delay under 37 CFR 1.704 being decreased from 110 days to 93 days. Were patentee granted the relief sought, the final determination of patent term adjustment would result in an overall patent term adjustment of 805 days (510 days pursuant to 37 CFR 1.703(a)(1) plus 388 days pursuant to 37 CFR 1.703(b) less 93 days of applicant delay pursuant to 37 CFR 1.704(b).

The petition to change patent term adjustment determination under 35 U.S.C. § 154(b) from 644 to 805 days is **DENIED**.

RELEVANT BACKGROUND

The United States Patent and Trademark Office (USPTO) entered an Office action under 35 U.S.C. § 132(a) (a restriction requirement) on June 18, 2009 resulting in an Office delay of 366 days under 37 CFR 1.703(a)(1). A reply to the Office action of March 12, 2009 was filed on September 18, 2009. A supplemental reply to the Office action of March 12, 2009 was filed October 5, 2009, resulting in an applicant delay of 17 days under 37 CFR 1.704(c)(8). Applicant's response of October 5, 2009 informed the examiner of the improper amendment filed April 17, 2007. Claims 1-7 were originally filed in the application and the amendment cancelled claims 1-20 and added claims 21-36, since claims 8-22 were not pending in the application at that time. Therefore, the amendment was improper. See, 37 CFR 1.126.

Notwithstanding the improper amendment, the USPTO entered a subsequent Office action under 35 U.S.C. § 132(a) on November 9, 2009. The Office action of November 9, 2009 stated that: "The Previous election of species requirement is vacated in favor of a new election of species

requirement (due in part to applicant's argument with respect to the examiner inadvertently stating claims 1-20, which were cancelled, in view of new claims 21-36) as set forth below." A reply to the Office action of November 9, 2009 was filed on November 13, 2009.

The USPTO entered a notice of allowance on November 30, 2010, which included a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 256 days.¹ On February 28, 2011, patentee timely submitted an application for patent term adjustment under 37 CFR 1.704(b),² arguing that a USPTO delay of 510 days should have been accorded pursuant to 37 CFR 1.703(a)(1). The matter was dismissed by a decision entered April 4, 2011.

By the instant petition, patentee again asserts that the patent term should be adjusted by 510 days, pursuant to 37 CFR 1.702(a)(1). In summary, patentee asserts that the Office action entered June 18, 2009, failed to meet the requirements of 35 U.S.C. § 132(a) and was vacated by a Primary Examiner. Further, patentee notes that the June 18, 2009, restriction requirement was replaced by the restriction requirement entered November 9, 2009. Patentee contends that the period of adjustment to the patent term under 37 CFR 1.702(a)(1) and 1.703(a)(1) is properly calculated using the November 9, 2009 restriction requirement, rather than the June 18, 2009 restriction requirement.

RELEVANT STATUTES

35 U.S.C. § 131 provides that:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 132 provides that:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

¹ The initial determination of patent term adjustment of 256 days, included 366 days of Office delay and 110 days of applicant delay. At the time of issuance of the patent, the application was entitled to an additional 388 days of patent term adjustment pursuant to 37 CFR 1.702(b). Accordingly, the patent issued with an overall patent term adjustment of 644 days.

² The Office records show that the issue fee was received on February 28, 2011.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

35 U.S.C. § 133 provides that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. § 154(b)(1)(A)(i), provides, in relevant part:

Subject to the limitations under [35 U.S.C. § 154(b)(2)], if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to— provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after — (I) the date on which an application was filed under section 111(a) of this title; or (II) the date on which an international application fulfilled the requirements of section 371 of this title;.

DECISION

Patentee in essence argues that the restriction requirement of November 9, 2009 “vacated” the restriction requirement of June 18, 2009, and as such the restriction requirement of June 18, 2009 should be treated as not having been issued for purposes of determining the period of time by which issuance of the patent was delayed due to the USPTO’s failure to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application.

Patentee’s arguments have been considered but are not persuasive. The vacatur of an Office action sets aside or withdraws any rejection, objection or requirement in an Office action, as well as the requirement that the applicant timely reply to the Office action to avoid abandonment under 35 U.S.C. § 133. The vacatur of an Office action signifies that the Office action has been set aside, voided, or withdrawn as of the date of the vacating Office action or notice. The vacatur of an Office action, however, does **not** signify that the vacated Office action is void *ab initio* and is to be treated as if the USPTO had never issued the Office action. The patent examination process provided for in 35 U.S.C. §§ 131 and 132 contemplates that Office actions containing rejections, objections or requirements will be issued, and that the applicant will respond to these

Office action, “with or without amendment.” (35 U.S.C. § 132(a)). The mere fact that an examiner or other USPTO employee upon further reflection determines that an Office action, or that a rejection, objection or requirement in an Office action, is not correct and must be removed does not warrant treating the Office action as void *ab initio* and as if the USPTO had never issued the Office action.

The USPTO appreciates that there may be situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action. However, these would be extremely rare situations, such as the issuance of an Office action or notice by an employee who does not have the authority to issue that type of Office action or notice, the issuance of an Office action or notice in the wrong application, or the issuance of an Office action or notice containing language not appropriate for inclusion in an official document. In essence, the situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action are the situations in which it is appropriate to expunge an Office action or notice from the USPTO’s record of the application. That is simply **not** the case in this situation.

Pursuant to 35 U.S.C. § 154(b)(1)(A)(i), patentees are entitled to day-to-day adjustment if the USPTO delays the issuance of a patent by the USPTO failing provide at least one of the notifications under 35 USC 132 or a notice of allowance under 35 USC 151 not later than 14 months after (I) the date on which an application was filed under 35 USC 111(a) or (II) the date on which an international application fulfilled the requirements of 35 USC 371.

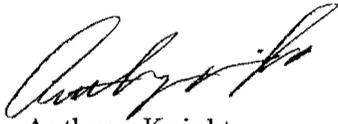
The record of the above-identified patent indisputably indicates that the USPTO entered an Office action under 35 U.S.C. § 132, specifically a restriction requirement, on June 18, 2009, 14 months and 366 days after the date that the application fulfilled the requirements of 35 USC 371 in an international application. The fact that the Office later set aside the restriction requirement of June 18, 2009 does not negate the fact that the Office entered an action within the meaning of 35 U.S.C. § 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1). Unless expunged from the record (which is not warranted in this situation), for purposes of calculating patent term adjustment, the Office action entered by the primary examiner on June 18, 2009, was properly used to determine whether the USPTO delayed the issuance of the above-identified patent by failing to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application; See, Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 54366 (Sept. 18, 2000) (final rule).

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 the relief sought of 510 days a patent term extension or adjustment pursuant to 37 CFR 1.703(a)(1) rather than the 366 days as determined at the time of mailing of the issue notification. Therefore, the petition to accord 805 days of patent term adjustment 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 Alesia M. Brown, Attorney Advisor, at (571) 272-3205.



Anthony Knight
Director
Office of Petitions