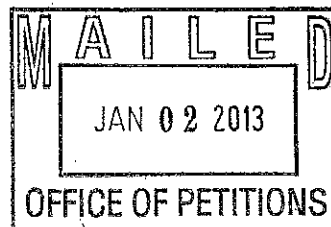




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In re Application of :
Faller et al. :
Patent Number: 8,213,641 : DECISION ON REQUEST
Issue Date: 07/03/2012 : FOR RECONSIDERATION OF
Application No. 11/744156 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 05/03/2007 :
Attorney Docket Number: :
24622-0018001 :

This is a decision on the "Petition Under 37 CFR § 1.181(a)(3) to Invoke the Supervisory Authority of the Director," filed on October 29, 2012, renewing a request that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by 1303 days. The petition is properly treated as a renewed petition under 37 CFR 1.705(d).

The petition is **DENIED**.

This decision is a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review.

Background

Patentees filed an Application for Patent Term Adjustment Under 37 CFR 1.705(d) on September 4, 2012, requesting, *inter alia*, an adjustment of the patent term in connection with the filing of an Information Disclosure Statement ("IDS"), filed April 26, 2012, after the mailing of a Notice of Allowance, and in connection with the filing of an IDS on May 3, 2012, after the mailing of a Notice of Allowance. Patentees aver that the Office mailed a response to the IDS on May 11, 2012, and the period of reduction is properly calculated at 10 days.

Regarding the IDS filed April 26, 2012, Patentees asserted that the Office mailed a response to the IDS on April 30, 2012, and the period of reduction is properly calculated at five (5) days.

Regarding the IDS filed May 3, 2012, Patentees aver that the Office mailed a response to the IDS on May 11, 2012, and the period of reduction is properly calculated at 10 days.

The petition was dismissed in a Decision mailed September 27, 2012. The Decision noted that a review of the application history reveals that no response to the IDS was mailed¹, and that pursuant to CFR 1.704(c)(10), the patent term shall be reduced by the lesser of: (1) the number of days, if any, beginning on the date the IDS 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. (Emphasis added). In this instance, the period of reduction was properly calculated beginning on April 26, 2012, and ending on the issue date of the patent, July 3, 2012, and is 69 days. However, it was noted that this period of reduction overlaps with the period of reduction in connection with the IDS filed May 3, 2012, discussed infra, for a period of 62 days.

Regarding the filing of the Information Disclosure Statement (“IDS”), filed May 3, 2012, a review of the application history also confirmed that no response to the IDS was mailed, and that pursuant to CFR 1.704(c)(10), the period of reduction was properly calculated beginning on May 3, 2012, and ending on the issue date of the patent, July 3, 2012, and is 62 days.

The present renewed petition

Patentees file the present renewed petition and provide that the record shows that a “List of References cited by the Applicant and considered by the examiner” (“List of References”) was mailed by this Office on April 30, 2012, and May 11, 2012. Renewed Petition at p.2. Patentees aver that the List of References should be considered a “Notice in response to the § 1.312 or other paper” under 37 CFR 1.704(c)(10). Id. Patentees assert that the Notices were mailed electronically to Patentees on April 30, 2012, and May 11, 2012, and submit that periods of reduction of five (5) and 10 days are appropriate in connection with the filing of the IDS’s.

Patentees’ arguments have been carefully considered. Patentees’ attention is directed to 35 U.S.C. § 154(b)(2)(C), REDUCTION OF PERIOD OF ADJUSTMENT, and section (iii), which states: “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.” Pursuant to 35 U.S.C. § 154(b)(2)(C)(iii), the Director prescribed, inter alia, 37 CFR 1.704(c)(10), which states that the submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, shall reduce the period of adjustment set forth in § 1.703 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

¹ The Decision informed petitioner that if petitioner had evidence of the mailing of a response to the IDS petitioner should include said evidence in a request for reconsideration of this decision.

(ii) Four months;

Analysis

Initially it is noted that Patentees were requested to include evidence of the putative mailing of Notices in response to the Information Disclosure Statements in any renewed petition. Here, Patentees refer to the Office record as evidence of the putative mailing of Notices in response to the Information Disclosure Statements, and aver that Notices were mailed electronically to Patentees on April 30, 2012, and May 11, 2012. A review of the Office record confirms the no Notices or responses to the Information Disclosure Statements were mailed to Patentees².

In this instance, and pursuant to 35 U.S.C. § 154(b)(2)(C)(iii), and 37 CFR 1.704(c)(10), the patent term was properly reduced in connection with the IDS filed on April 26, 2012, beginning on April 26, 2012, and ending on the issue date of the patent, July 3, 2012, and is 69 days, and properly reduced in connection with the IDS filed on May 3, 2012, beginning on May 3, 2012, and ending on the issue date of the patent, July 3, 2012, and is 62 days.

Conclusion

The previous decision has been reconsidered as requested. However, the petition is denied.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to attorney Derek Woods at (571) 272-3232.


Anthony Knight
Director
Office of Petitions

² Patentees are advised that the USPTO file is the official record of the papers actually sent or received/filed. Patentees attention is directed to the emails dated June 15, 2012 and October 3, 2012, informing Patentees that the application has new outgoing correspondence. No emails dated April 30, 2012 or May 11, 2012 are present in the file.