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OFFICE OF PETITIONS

In re Patent No. 6,484,146
Issued: November 19, 2002
Application No.: 08/978,856
Filed (CPA): December 12, 2000
Inventor: Larry J. Day *et al.*

ON PETITION

This is a decision on the petition filed January 10, 2003, requesting reconsideration of the patent term adjustment determination indicated on the above-identified patent, and seeking that it be changed from ninety (90) days to four hundred (400) days.

The instant request for reconsideration of the patent term adjustment determination indicated on the notice of allowance mailed May 29, 2002 is untimely. In addition, neither the appeal in application No. 08/978,856 filed on November 26, 1997 nor the appeal in the continued prosecution application (CPA) filed on December 12, 2000 resulted in appellate review by the Board of Patent Appeals and Interferences or by a Federal court. Finally, any patent term extension accumulated in application No. 08/978,856 filed on November 26, 1997 would not have carried over to the CPA filed on December 12, 2000.

Accordingly, the petition requesting reconsideration of the patent term adjustment determination indicated on the above-identified patent, and seeking that it be changed to four hundred (400) days, is **DENIED**.

BACKGROUND

Application No. 08/978,856 was filed under 35 U.S.C. § 111(a) and former 37 C.F.R. § 1.60 on November 26, 1997. Application No. 08/978,856 claims the benefit (as a continuation) of application No. 08/514,467, filed August 11, 1995, now U.S. Patent No. 5,857,175.

A non-final Office action was mailed on January 4, 1999. A reply to the non-final Office action of January 4, 1999 was filed on July 12, 1999.

A final Office action was mailed on September 28, 1999. A notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 1.191 was filed on March 27, 2000. An appeal brief under 37 C.F.R. § 1.192 was filed on July 18, 2000.

The examiner reopened prosecution in response to the appeal brief of July 18, 2000,[1] and a non-final Office action was mailed on September 22, 2000.

A continued prosecution application (CPA) under 37 C.F.R. § 1.53(d)[2] was filed on December 12, 2000.

A non-final Office action in the CPA of December 12, 2000 was mailed on March 1, 2001. A reply to the non-final Office action of March 1, 2001 was filed on May 30, 2001.

A final Office action was mailed on July 30, 2001. A notice of appeal under 35 U.S.C. § 134 and 37 C.F.R. § 1.191 was filed on October 30, 2001. An appeal brief under 37 C.F.R. § 1.192 was filed on December 21, 2001.

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[1] If in responding to an appeal brief the examiner decides that he or she should apply a new ground of rejection against some or all of the appealed claims, the examiner may reopen prosecution to enter the new ground of rejection. See Manual of Patent Examining Procedure § 1208.01 (8th. ed. 2001) (Rev. 1, Feb. 2003) (MPEP). The examiner is not permitted to enter a new ground of rejection in the examiner's answer. See id. If the examiner reopens prosecution to enter a new ground of rejection in an application under appeal, the applicant may either continue prosecution before the examiner or request reinstatement of the appeal. See 37 C.F.R. § 1.193(b)(2) and MPEP § 1208.02.

[2] CPA practice is a streamlined continuing application practice that was adopted in December of 1997 to provide for continued examination of an application for a fee. See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, 68 Fed. Reg. 32376, 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143, 143 (June 24, 2003) (final rule). A CPA is a request to expressly abandon the prior application (application No. 08/978,856 filed on November 26, 1997) as of the filing date of the CPA. See 37 C.F.R. § 1.53(d)(2)(v). A CPA uses the file jacket and contents of the prior application and is assigned the application number of the prior application (application No. 08/978,856) for identification purposes. See 37 C.F.R. § 1.53(d)(2)(iv); see also Request for Continued Examination Practice and Changes to Provisional Application Practice, 65 Fed. Reg. 50091, 50093 (Aug. 16, 2000), 1238 Off. Gaz. Pat. Office 13, 15 (final rule). A CPA, however, is a new application and the filing date of a CPA is the date on which a request on a separate paper for a CPA is filed (*i.e.*, December 12, 2000). See 37 C.F.R. § 1.53(d)(2).

A notice of allowability and a notice of allowance were mailed on May 29, 2002. The notice of allowance mailed on May 29, 2002 indicated that the patent term adjustment accumulated to date is 90 days, and that if the patent issues on the Tuesday before the date that is 28 weeks after the mailing date of the notice of allowance (*i.e.*, December 10, 2002), the patent term adjustment will be 90 days. The issue fee was paid on August 27, 2002.

The CPA filed on December 12, 2000 issued as U.S. Patent No. 6,484,146 (the above-identified patent) on November 19, 2002. The front page of U.S. Patent No. 6,484,146 indicates that:

> Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 90 days..

A petition under 37 C.F.R. § 1.182 was filed on January 10, 2003.[3] The petition of January 10, 2003 requests reconsideration of the patent term adjustment determination indicated on the above-identified patent, and requests that it be changed from ninety (90) days to four hundred (400) days.

A civil action was commenced in the United States District Court for the District of Columbia on June 3, 2003 (Catalina Marketing Int'l., Inc. v. Rogan, Civil Action No. 03-1198 (RMC)). The action was remanded to the USPTO on September 5, 2003 to permit the USPTO to consider the petition filed on January 10, 2003.

STATUTE AND REGULATION

35 U.S.C. § 154(b) as amended by § 532(a) of the Uruguay Round Agreements Act[4] (URAA) (former 35 U.S.C. § 154(b)) provided that:

> (1) INTERFERENCE DELAY OR SECRECY ORDERS.— If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

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[3] The petition filed on January 10, 2003 cannot be located within the United States Patent and Trademark Office (USPTO). Nevertheless, since petitioners have provided a copy of a date-stamped post card receipt indicating that a petition under 37 C.F.R. § 1.182 to correct patent term was filed in the USPTO on January 10, 2003, the copy of the petition submitted by facsimile on April 21, 2003 will be treated as filed in the USPTO on January 10, 2003. See MPEP § 503.

[4] Public Law 103-465, 108 Stat. 4809 (1994).

(2) EXTENSION FOR APPELLATE REVIEW.— If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.— The period of extension referred to in paragraph (2)—

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.— The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

35 U.S.C. § 154(b) as amended by § 4402 of the American Inventors Protection Act of 1999[5] (AIPA) provides that:

ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) 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;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

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[5] Public Law 106-113, 113 Stat. 1501, 1501A-557 through 1501A-560 (1999).

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied,

the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability,

the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(2) LIMITATIONS.—

(A) IN GENERAL.— To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

(B) DISCLAIMED TERM.— No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

(C) 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.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(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.

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

(A) The Director shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

(B) Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

(C) The Director shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

(4) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.—

(A) An applicant dissatisfied with a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. Chapter 7 of title 5 shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

(B) The determination of a patent term adjustment under this subsection shall not be subject to appeal or challenge by a third party prior to the grant of the patent.

37 C.F.R. § 1.705 provides that:

§ 1.705 Patent term adjustment determination.

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance. An application for patent term adjustment under this section must be accompanied by:

(1) The fee set forth in § 1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(c) Any application for patent term adjustment under this section that requests reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) for failing to reply to a rejection, objection, argument, or other

request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must also be accompanied by:

(1) The fee set forth in § 1.18(f); and

(2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) If the patent is issued on a date other than the projected date of issue and this change necessitates a revision of the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section.

(e) The periods set forth in this section are not extendable.

(f) No submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

OPINION

Petitioners argue (*inter alia*) that: (1) the instant petition under 37 C.F.R. § 1.182 is appropriate because rules of practice do not provide for reconsideration of patent term adjustment after the grant of a patent; (2) the appeal in application No. 08/978,856 filed on November 26, 1997 (the first appeal) qualifies for patent term extension as a successful appeal under the URAA patent term extension provisions; (3) the appeal in the CPA filed on December 12, 2000 (the second appeal) qualifies for patent term adjustment as a successful appeal under the AIPA patent term adjustment provisions; and (4) the filing of a CPA does not affect term extension due to the first appeal because the issue of the patent was delayed due to the first appeal and the URAA patent term extension provisions of former 35 U.S.C. § 154(b) states that "a patent's term shall be extended if 'the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences.'" See petition of January 10, 2003 at 3-4.

The instant petition requesting reconsideration of the patent term adjustment determination indicated on the above-identified patent, and seeking that it be changed from ninety (90) days to four hundred (400) days, will **not** be granted because the instant petition is an untimely request for reconsideration of the patent term adjustment determination indicated on the notice of allowance mailed May 29, 2002. In addition, the instant request to change the patent term adjustment determination indicated on the above-identified patent from ninety (90) days to four hundred (400) days **cannot** be granted because: (1) the appeal in application No. 08/978,856 filed on November 26, 1997 did not result in appellate review by the Board of Patent Appeals and Interferences or by a Federal court under the URAA patent term extension provisions of former 35 U.S.C. § 154(b)(2); (2) any URAA patent term extension under former 35 U.S.C. § 154(b) accumulated in application No. 08/978,856 filed on November 26, 1997 would not have carried over to the CPA filed on December 12, 2000; and (3) the appeal in the CPA filed on December 12, 2000 did not result in appellate review by the Board of Patent Appeals and Interferences or by a Federal court under the AIPA patent term adjustment provisions of 35 U.S.C. § 154(b)(1)(C)(iii).

Background of Patent Term Extension and Adjustment

Before June of 1995, 35 U.S.C. § 154 provided that the term of a utility or plant patent ended seventeen years from the date of patent grant.[6] To comply with Article 33 of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement resulting from the Uruguay Round Agreements of the General Agreement on Tariffs and Trade (GATT), the United States was required to establish a minimum term for patent protection ending no earlier than twenty years from the date the application was filed. Thus, the URAA amended 35 U.S.C. § 154 effective June 8, 1995 to change the end of the term of utility and plant patents from seventeen years from the date of patent grant to twenty years from the filing date of the application (or twenty years from the earliest filing date claimed under 35 U.S.C. §§ 120, 121, or 365(c)).[7] With this change, 35 U.S.C. § 154 was also amended to provide for patent term extension in the event that issuance of the application as a patent was delayed due to secrecy order, interference or successful appellate review, subject to a five-year cap on any patent term extension under 35 U.S.C. § 154(b). The USPTO implemented the patent term extension provisions of the URAA in a final

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[6] A patent term of seventeen years from the date of patent grant was introduced into the patent system by the Patent Act of 1861, Act of March 2, 1861, ch. 88, § 16, 12 Stat. 246, 249. Thus, patent term of seventeen years from the date of grant was a mainstay of the patent system for over 130 years prior to being changed in June of 1995.

[7] The URAA also provided that utility and plant patents in force on June 8, 1995 or resulting from applications filed before June 8, 1995 would have a term ending on the later of: (1) seventeen years from the date of patent grant; or (2) twenty years from the filing date of the application (or twenty years from the earliest filing date claimed under 35 U.S.C. §§ 120, 121, or 365(c). See 35 U.S.C. § 154(c).

rule published in April of 1995. See Changes to Implement 20-Year Patent Term and Provisional Applications, 60 Fed. Reg. 20195 (Apr. 25, 1995), 1174 Off. Gaz. Pat. Office 15 (May 2, 1995) (final rule).

The AIPA (enacted in 1999) further amended 35 U.S.C. § 154(b) to expand the list of administrative delays which may give rise to patent term adjustment. Original utility and plant patents issuing from applications filed on or after May 29, 2000 are eligible for patent term adjustment if issuance of the patent is delayed due to one or more of the enumerated administrative delays listed in 35 U.S.C. § 154(b)(1). The USPTO implemented the patent term adjustment provisions of the AIPA in a final rule published in September of 2000. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56365 (Sept. 18, 2000), 1239 Off. Gaz. Pat. Office 14 (Oct. 2000) (final rule). The patent term adjustment provisions of the AIPA apply to original (*i.e.*, non-reissue) utility and plant applications filed on or after May 29, 2000, which include continuation (*e.g.*, a continued prosecution application (CPA)), divisional, or continuation-in-part applications. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56375, 1239 Off. Gaz. Pat. Office at 22 (response to comment 5). The patent term extension provisions of the URAA (for delays due to secrecy order, interference or successful appellate review) continued to apply to utility and plant applications filed on or after June 8, 1995 and before May 29, 2000. Thus, the amendments to 35 U.S.C. § 154(b) in the URAA and the AIPA resulted in two co-existing patent term extension or adjustment systems: one that applies to applications filed on or after June 8, 1995 but before May 29, 2000 (the URAA patent term extension provisions of former 35 U.S.C. § 154(b) implemented in 37 C.F.R. § 1.701); and one that applies to applications filed on or after May 29, 2000 (the AIPA patent term adjustment provisions of current 35 U.S.C. § 154(b) implemented in 37 C.F.R. §§ 1.702 through 1.705). See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56367-68, 1239 Off. Gaz. Pat. Office at 14-15.

(I) The instant request for reconsideration of the patent term adjustment determination indicated on the notice of allowance mailed May 29, 2002 is untimely

Section 4405(a) of the AIPA provides that its patent term adjustment provisions shall take effect on the date that is six months after the date of enactment of the AIPA (*i.e.*, May 29, 2000) and shall apply to any application (other than reissue or design) filed on or after the date that is six months after the date of enactment of the AIPA (*i.e.*, May 29, 2000). See 113 Stat. at 1501A-560. Therefore, patents (other than reissue or design) issued on applications filed on or after June 8, 1995, but before May 29, 2000, are subject to the URAA patent term extension provisions of former 35 U.S.C. § 154(b) (implemented in 37 C.F.R. § 1.701), whereas patents (other than reissue or design) issued on applications filed on or after May 29, 2000, are subject to the AIPA patent term adjustment provisions of 35 U.S.C. § 154(b) (implemented in 37 C.F.R. §§ 1.702 through 1.705). See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56367, 1239 Off. Gaz. Pat. Office at 14-15.

The above-identified patent resulted from a CPA filed on December 12, 2000 under 37 C.F.R. § 1.53(d). As indicated in the final rule to implement the patent term adjustment provisions of the AIPA:

> The filing date of a continued prosecution application (CPA) under [37 C.F.R.] § 1.53(d) is the date that the request for CPA is filed ([37 C.F.R.] § 1.53(d)(2)), even though the Office uses the filing date of the prior application for identification purposes. Therefore, the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by § 4402 of the American Inventors Protection Act of 1999 apply to any CPA filed on or after May 29, 2000, regardless of the filing date of the prior application of the CPA. While an applicant may file a continuing application under [37 C.F.R.] § 1.53(b) on or after May 29, 2000, for the application to be subject to the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by § 4402 of the American Inventors Protection Act of 1999, an applicant need only file a CPA under [37 C.F.R.] § 1.53(d) on or after May 29, 2000, for the application to be subject to the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by § 4402 of the American Inventors Protection Act of 1999. The filing of a CPA on or after May 29, 2000, does not, however, entitle an applicant to receive term adjustment for Office delays before the filing date of the CPA (*i.e.*, before May 29, 2000).

See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56367, 1239 Off. Gaz. Pat. Office at 15.

The above-identified patent resulted from an application (CPA) filed on December 12, 2000. Therefore, the above-identified patent is subject to the patent term adjustment provisions of the AIPA, and is not eligible for the patent term extension provisions of former 35 U.S.C. § 154(b).

35 U.S.C. § 154(b)(3) provides that the USPTO shall: (1) prescribe regulations establishing procedures for the application for and determination of patent term adjustments under 35 U.S.C. § 154(b); (2) make a determination of any patent term adjustment under 35 U.S.C. § 154(b) and transmit a notice of that determination with the notice of allowance under 35 U.S.C. § 151; and (3) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination. Pursuant to the mandate and authority in 35 U.S.C. § 154(b)(3), the USPTO promulgated 37 C.F.R. § 1.705, which provides that: (1) the notice of allowance will include notification of any patent term adjustment under 35 U.S.C. § 154(b) (37 C.F.R. § 1.705(a)); (2) any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except as provided in 37 C.F.R. § 1.705(d)) must be by way of an application for patent term adjustment filed no later than the payment of the issue fee and accompanied by (*inter alia*) the fee set forth in 37 C.F.R. § 1.18(e) (37 C.F.R. § 1.705(b)); and (3) if the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, any request for reconsideration of the patent term

adjustment indicated in the patent must be filed within thirty days of the date the patent issued (37 C.F.R. § 1.705(d)).[8] Accordingly, any request for reconsideration of the patent term adjustment determination indicated in the notice of allowance mailed May 29, 2002 (which is the same as the patent term adjustment determination indicated on the above-identified patent) was due no later than the date on which the issue fee was paid on the above-identified application, *i.e.*, August 27, 2002. See 37 C.F.R. § 1.705(b).

The patent term adjustment determination procedures set forth in 35 U.S.C. § 154(b)(3) contemplate that patent adjustment proceedings before the USPTO will be completed prior to issuance of the patent. See 35 U.S.C. § 154(b)(3)(D) ("[t]he Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination"). The provisions in 35 U.S.C. § 154(b)(4) tying the period for seeking judicial review of a USPTO patent term adjustment determination to the date the patent is granted (rather than the date of the determination is completed) further indicates that Congress contemplated that the USPTO patent term adjustment determinations provided for in 35 U.S.C. § 154(b)(3) would be completed prior to issuance of the patent. The USPTO requires that any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except in situations covered by 37 C.F.R. § 1.705(d)[9]) be filed no later than the payment of the

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[8] The patent at issue (U.S. Patent No. 6,484,146) does **not** involve the situation covered by 37 C.F.R. § 1.705(d) in which the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue: *i.e.*, the above-identified patent and the notice of allowance mailed on May 29, 2002 each indicate that the term of the above-identified patent is adjusted under 35 U.S.C. § 154(b) by 90 days. Therefore, the provisions of 37 C.F.R. § 1.705(b) apply to any request for reconsideration of the patent term adjustment determination indicated in the notice of allowance mailed May 29, 2002.

[9] Since 35 U.S.C. §§ 154(b)(1)(A)(iv) and 154(b)(1)(B) provide for the possibility of patent term adjustment if the patent is not issued within a specified time period, and the date a patent will issue is unknown at the time the notice of allowance is mailed, the USPTO must make the patent term adjustment determination required by 35 U.S.C. §§ 154(b)(3)(B)(i) on the basis of a projected date of issue. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56374, 1239 Off. Gaz. Pat. Office at 21. If the patent issues on a date other than the projected date of issue and this change necessitates a revision of the patent term adjustment determination indicated in the notice of allowance (a situation not at issue in the above-identified patent), any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued. See 37 C.F.R. § 1.705(d). The USPTO requires that any request for reconsideration under 37 C.F.R. § 1.705(d) be filed within thirty days of the date the patent issued to permit the USPTO to complete patent term adjustment determination in sufficient time for the applicant to determine whether judicial review of the Office's determination is appropriate. See Changes to

issue fee to ensure that a patent term adjustment determination under 37 C.F.R. § 1.705(b) can be completed before the patent issues.

Petitioners appear to be of the opinion that 35 U.S.C. § 154(b)(3) requires the USPTO to correct patent term adjustment determinations prior to issuance of the patent, and that 35 U.S.C. § 154(b)(4) requires the U.S. District Court for the District of Columbia to correct patent term adjustment determinations after issuance of the patent without the patentee having first sought reconsideration of the USPTO's patent term adjustment determination. Under 35 U.S.C. § 154(b)(4), 5 U.S.C. chapter 7 (the judicial review provisions of the Administrative Procedure Act) expressly applies to civil actions by applicants dissatisfied with the USPTO's patent term adjustment determinations. It is a fundamental principle of administrative law that (absent unusual circumstances) a claimant must first exhaust his or her administrative remedies before resort is had to the courts, and that the failure to seek administrative relief within the prescribed time period forecloses right to judicial relief. See Barrington Manor Apartments Corp. v. United States, 392 F.2d 224, 227-28 (Ct. Cl. 1968); see also Mackay v. Commissioner of Patents and Trademarks, No. 99-1305, 1999 U.S. App. LEXIS 25718, at *4-5 (Fed. Cir., Oct. 18, 1999). Therefore, 35 U.S.C. § 154(b)(3) provides that the USPTO shall prescribe procedures for applicants to request reconsideration of an initial patent term adjustment determination provided with the notice of allowance under 35 U.S.C. § 151, and 35 U.S.C. § 154(b)(4) provides a judicial review remedy in the event that an applicant requests reconsideration of the initial patent term adjustment determination and is dissatisfied with the USPTO's final (or completed) patent term adjustment determination rendered in its decision on reconsideration under 35 U.S.C. § 154(b)(3).

Finally, 37 C.F.R. § 1.182 applies only where other rules are inapplicable, and an applicant may not use it as a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903). The patent term adjustment provisions of the AIPA have been implemented in 37 C.F.R. §§ 1.702 through 1.705, and requests for reconsideration of patent term adjustment determinations are provided for in 37 C.F.R. § 1.705. Here, petitioners simply failed to submit a timely request for reconsideration of the patent term adjustment determination indicated in the notice of allowance mailed May 29, 2002.

Since the instant petition is a request for reconsideration of the patent term adjustment determination indicated in the notice of allowance mailed May 29, 2000, and was not filed until after the issue fee was paid on the above-identified application, it is **DENIED** as untimely.

Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56388, 1239 Off. Gaz. Pat. Office at 33 (response to comment 49).

(II) The appeal in application No. 08/978,856 filed on November 26, 1997 did not result in appellate review by the Board of Patent Appeals and Interferences or by a Federal court under former 35 U.S.C. § 154(b)(2)

Petitioners argue that they are entitled to patent term extension under former 35 U.S.C. § 154(b)(2) because the examiner reversed himself in reopening prosecution and issuing a non-final Office action in response to the appeal brief of July 18, 2000. Former 35 U.S.C. § 154(b)(2) provided for the possibility of patent term extension in the event that "the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability" See 35 U.S.C. § 154(b)(2)(1994). The plain meaning of this provision requires that the decision reversing the adverse patentability determination be a decision by the Board of Patent Appeals and Interferences or by a Federal court. Furthermore, the Administrative Action Statement[10] accompanying the URAA indicates that former 35 U.S.C. § 154(b)(2) provided for extensions based upon appellate review only where "a patent is issued after an adverse determination of patentability has been reversed on appeal **by either the Board of Patent Appeals and Interferences or a Federal court.**" See Uruguay Round Agreements Act: Statement of Administrative Action, H.R. Doc. No. 103-316, at 1002 (1994), reprinted in 1994 U.S.C.C.A.N. 4040, 4296 (emphasis added). Thus, a decision by the examiner or his or her supervisor to withdraw a rejection in an application on appeal alone is not sufficient to result in the possibility of patent term extension under the provisions of former 35 U.S.C. § 154(b)(2).

The appeal in application No. 08/978,856 filed on November 26, 1997 did not result in appellate review by either the Board of Patent Appeals and Interferences or by a Federal court. Former 35 U.S.C. § 154(b)(2) did not provide for patent term extension simply because an examiner reopens prosecution in an application, or withdraws the rejection of certain claims, in response to an appeal brief being filed in an application. Therefore, any patent issuing on application No. 08/978,856 filed on November 26, 1997 would not have been entitled to patent term extension under 35 U.S.C. § 154(b) as amended by § 532(a) of the URAA (former 35 U.S.C. § 154(b)(2)) on the basis of the examiner reopening prosecution in application No. 08/978,856 filed on November 26, 1997 in response to the appeal brief of July 18, 2000.

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[10] Section 102(d) of the URAA (19 U.S.C. § 3512(d)) provides that "[t]he statement of administrative action approved by the Congress under section 101(a) shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application." See also RHP Bearings, Ltd. v. United States, 288 F.3d 1334, 1344 n.7 (Fed. Cir. 2002).

(III) Any patent term extension under the URAA patent term provisions of former 35 U.S.C. § 154(b) due to any successful appellate review in application No. 08/978,856 filed on November 26, 1997 would not have carried over to the CPA filed on December 12, 2000

Patent term extension under 35 U.S.C. § 154(b) as amended by § 532(a) of the URAA (former 35 U.S.C. 154(b)) or patent term adjustment under 35 U.S.C. 154(b) as amended by the AIPA does not carry over from a prior application to a continuing application because: (1) 35 U.S.C. § 154(b) and its legislative history do **not** indicate that an applicant may "carry-over" patent term extension or patent term adjustment accumulated in a prior application to a continuing application; and (2) it would be incongruous with the patent term adjustment scheme set forth in 35 U.S.C. § 154(b)(1) and its purpose for an applicant to be able to "carry-over" patent term extension or patent term adjustment accumulated in a prior application to a continuing application.[11]

Where patent term is contingent upon events in a prior application, the patent statute expressly so provides. See 35 U.S.C. § 154(a)(2) ("such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, **if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed**") (emphasis added) and § 154(a)(3) ("[p]riority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent). The express language of 35 U.S.C. § 154(b) and its legislative history,[12] however, do **not** indicate that delays or other events in a prior application have any impact on the patent term adjustment in a patent issuing on a continuing application, or that an

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[11] In addition, to conclude that petitioners may "carry-over" the URAA patent term extension under former 35 U.S.C. § 154(b) accumulated in prior application 08/978,856 filed November 26, 1997 to the continuing application (CPA) filed December 12, 2000 would require that the above-identified patent be subject to both the patent term extension provisions of § 532(a) of the URAA and the patent term adjustment provisions of 35 U.S.C.§ 154(b) as amended by the AIPA. The effective date provision for 35 U.S.C.§ 154(b), however, indicates that a patent resulting from an application filed on or after June 8, 1995 is subject to § 532(a) of the URAA if the patent resulted from an application filed on or after June 8, 1995 but before May 29, 2000, but is subject to 35 U.S.C. § 154(b) as amended by the AIPA if the patent resulted from an application filed on or after May 29, 2000.

[12] While the Conference Report resulting in Pub. L. 106-113 does not contain any discussion (other than the incorporated language) of the AIPA, a section-by-section analysis of the AIPA (among other provisions of Public Law 106-113) was printed in the Congressional Record at the request of Senator Lott. This section-by-section analysis does not indicate that an applicant may "carry-over" patent term extension or patent term adjustment accumulated in a prior application to a continuing application.

applicant may "carry-over" patent term extension or patent term adjustment accumulated in a prior application to a continuing application. Therefore, the USPTO finds that an applicant may **not** "carry-over" patent term extension or patent term adjustment accumulated in a prior application to a continuing application. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56367, 56373, 1239 Off. Gaz. Pat. Office at 15, 20 ("[t]he filing of a CPA on or after May 29, 2000, does not, however, entitle an applicant to receive term adjustment for Office delays before the filing date of the CPA (i.e., before May 29, 2000)" and "if the application that resulted in the patent is a continuing application (including a CPA), the period of adjustment set forth in [37 C.F.R.] § 1.703 (if any) will not include any period that is prior to the actual filing date of the application (in the case of a CPA, the filing date of the request for a CPA) that resulted in the patent").

In addition, it is well known that patent applicants may abuse continuing application practice to delay examination and issuance of patent.[13] The URAA patent term extension provisions of former 35 U.S.C. § 154(b) and the AIPA patent term adjustment provisions of 35 U.S.C. § 154(b) are designed to compensate applicants for certain examination delays by the USPTO. The patent term adjustment provisions of 35 U.S.C. § 154(b) would have included provisions taking continuing application practice into account if Congress had contemplated that an applicant may "carry-over" URAA patent term extension under former 35 U.S.C. § 154(b) or AIPA patent term adjustment under 35 U.S.C. § 154(b)(1)(C) accumulated in a prior application to a continuing application. Cf. 35 U.S.C. 154(b)(1)(B)(i) (excludes time consumed by continued examination under the request for continued examination procedures of 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114 from the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B)). There is, however, no mention in either 35 U.S.C. § 154(b) or its legislative history of any relationship between events or delays in a prior application and the patent term adjustment in a patent issuing on a continuing application.

Moreover, the examination time frames in 35 U.S.C. §§ 154(b)(1)(A) and 154(b)(1)(B) are measured from the filing date of the application which resulted in the patent at issue. See 35 U.S.C. § 154(b)(1)(A)(i) and 154(b)(1)(B). To provide that an applicant may "carry-over" URAA patent term extension under former 35 U.S.C. § 154(b) or AIPA patent term adjustment under 35 U.S.C. § 154(b)(1)(C) accumulated in a prior application to a continuing application would be at odds with the patent term adjustment time frames in 35 U.S.C. §§ 154(b)(1)(A) and 154(b)(1)(B) beginning with the filing date of the application. Again, there is nothing in either 35 U.S.C. § 154(b) or its legislative history to indicate that Congress intended the patent term adjustment scheme of 35 U.S.C. §§ 154(b) operate in such a peculiar manner.

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[13] See, e.g., In re Bogese, 303 F.3d 1362, 64 USPQ2d 1448 (Fed. Cir. 2002), Symbol Technologies, Inc. v. Lemelson Medical, 277 F.3d 1361, 61 USPQ2d 1515 (Fed. Cir. 2002), In re Hogan, 559 F.2d 595, 194 USPQ 527 (CCPA 1977), In re Henriksen, 399 F.2d 253, 158 USPQ 224 (CCPA 1968).

In any event, 35 U.S.C. § 154(b)(2)(C)(iii) directs and authorizes the USPTO to 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 this authority, the USPTO established "[f]urther prosecution via a continuing application" as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application, "in which case the period of patent term adjustment shall not include any period that is prior to the actual filing date of the application that resulted in the patent." See 37 C.F.R. § 1.704(c)(11). The USPTO established further prosecution via a continuing application as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application because the USPTO recognizes the potential for patent term adjustment abuse in continuing application practice and the availability of request for examination procedures of 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114[14] as an alternative to continuing application practice for applicants to obtain further examination of an application. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. at 56373, 1239 Off. Gaz. Pat. Office at 20.

Therefore, the above-identified patent is not entitled to patent term adjustment (or extension) under 35 U.S.C. § 154(b) on the basis of any successful appellate review (or any other event) in application No. 08/978,856 filed on November 26, 1997.

(IV) The appeal in the CPA filed on December 12, 2000 did not result in appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. § 154(b)(1)(C)(iii)

Petitioners argue that they are entitled to patent term adjustment because the examiner reversed himself in issuing a notice of allowance in response to the appeal brief of December 21, 2001. 35 U.S.C. § 154(b) provides for the possibility of patent term adjustment in the event that "the issue of an original patent is delayed due to . . . appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability." See 35 U.S.C. § 154(b)(1)(C)(iii). While the language of 35 U.S.C. § 154(b)(1)(C)(iii) is not identical to the language of former 35 U.S.C. § 154(b)(2), there is nothing in the language of 35 U.S.C. § 154(b)(1)(C)(iii) or its legislative history suggesting that it provides for the possibility of patent term adjustment where a patent is issued after an adverse determination of patentability has been withdrawn by an entity other than either the Board of Patent Appeals and Interferences or a Federal court (*i.e.*, by the examiner or his or her supervisor).

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[14] While an applicant may **not** "carry-over" patent term extension or patent term adjustment accumulated in a prior application to a continuing application, a request for continued examination (RCE) under 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114 is not a new continuing application and does permit an applicant to preserve previously accumulated patent term extension or patent term adjustment.

The appeal in the CPA filed on December 12, 2000 did not result in appellate review by either the Board of Patent Appeals and Interferences or by a Federal court. 35 U.S.C. § 154(b)(1)(C)(iii) does not provide for patent term adjustment simply because an examiner changes his or her position on the patentability of the claims in an application as a result of an appeal brief being filed in an application. However, such delays in the examination process caused by an examiner changing his or her position on the patentability of the claims are taken into account in the patent term adjustment provisions of the AIPA in 35 U.S.C. § 154(b)(1)(A)(ii) (provides for the possibility of patent term adjustment if the USPTO fails to respond to an applicant reply within four months of the date a reply is filed), § 154(b)(1)(A)(iii) (provides for the possibility of patent term adjustment if the USPTO fails to respond to an appeal within four months of the date the appeal is taken),[15] and § 154(b)(1)(B) (provides for the possibility of patent term adjustment if the USPTO fails to issue a patent within three years of the actual filing date of the application).

Therefore, the above-identified patent is not entitled to patent term adjustment under 35 U.S.C. § 154(b)(1)(C)(iii) on the basis of the examiner changing his position on the patentability of the claims in response to the appeal in the CPA filed on December 12, 2000.

CONCLUSION

The instant petition is properly considered as a request for reconsideration under 37 C.F.R. § 1.705(b) of the patent term adjustment determination indicated on the notice of allowance mailed May 29, 2002. The instant petition requesting reconsideration of the patent term adjustment determination indicated on the notice of allowance mailed May 29, 2002 was not filed within the time period prescribed in 37 C.F.R. § 1.705(b) and is therefore untimely. In addition, a further 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 four hundred (400) days. Therefore, the request to change the patent term adjustment indicated on the above-identified patent to four hundred (400) days is **denied**. The USPTO will **not** publish the requested certificate of correction for the above-identified patent.

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

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[15] While petitioners are not entitled to patent term adjustment under 35 U.S.C. § 154(b)(1)(C)(iii) on the basis of a decision by the Board of Patent Appeals and Interferences or by a Federal court reversing an adverse determination of patentability, petitioners did obtain patent term adjustment under 35 U.S.C. § 154(b)(1)(A)(ii) as a result of the delay in responding to the appeal caused by the examiner changing his position on the patentability of the claims in the above-identified application.

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-8850.

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

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