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Date: May 24, 2000

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May 24, 2000

Via Facsimile

Ms. Karin L. Tyson
United States Patent and Trademark Office
Washington, D.C. 20231

Re: Question Regarding Proposed Rule 1.704

Dear Ms. Tyson:

We are preparing a seminar for Boston attorneys regarding the proposed new rules for implementing patent term adjustment under the AIPA of 1999. We have carefully read the notice in the Federal Register of March 31, 2000 (Vol. 65, No. 63, pp. 17215-17229), and have a question based on the following hypothetical:

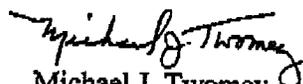
- 05/30/00: An original application (no priority claims) is filed.
- 09/30/00: A restriction requirement is mailed, restricting the claims into 2 Groups.
- 12/30/00: Applicant files a response electing the claims of Group 1.
- 12/30/02: Applicant files a divisional application drawn to the claims of Group 2.

Is the period between applicant's response to the restriction requirement (12/30/00) until the filing of the divisional application (12/30/02) considered a period during which applicant "failed to engage in reasonable efforts to conclude prosecution" under proposed 1.704(a)?

In addition, we note that proposed 1.704(c)(16) specifies that, upon filing a continuing application, any period of adjustment set forth in 1.703 (Office delays) from a prior application shall not be included in the patent term adjustment, but is silent as to whether any periods of adjustment set forth in 1.704(a), (b) or (c)(1)-(15) (applicant's delays) from a prior application shall not be included in the patent term adjustment of the continuation. Are applicant's delays from a prior application also NOT included in calculating the patent term adjustment of a continuing application?

Thank you very much for your attention to this matter, and any insight you can provide. Please feel free to respond in whatever manner is most convenient for you: By telephone to (617) 248-7362, by facsimile to (617) 248-7100, or by e-mail to twomey@tht.com.

Yours sincerely,


Michael J. Twomey