



UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

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In re Application of	:	
GLOVINSKI	:	
Application No. 13/338,330	:	DECISION ON REQUEST
Filed: December 28, 2011	:	FOR RECONSIDERATION OF
Patent No. 8,957,645	:	PATENT TERM ADJUSTMENT
Issue Date: February 17, 2015	:	and DECISION ON PETITION
Attorney Docket No.: 007841.00042	:	PURSUANT TO
Title: ZERO VOLTAGE SWITCHING	:	37 C.F.R. § 1.183

This is a response to applicant’s “second request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(b)” and “petition under 37 C.F.R. § 1.183,” both filed on May 25, 2016, requesting that the Office adjust the patent term adjustment from sixty-two (62) days to two hundred and nine (209) days.

The petition pursuant to 37 C.F.R. § 1.183 is **GRANTED**. Receipt of the \$400 petition fee is acknowledged. On July 19, 2013 and September 4, 2013, Information Disclosure Statements were filed without a 37 C.F.R. §1.704(d) statement. On November 18, 2013, an IDS was filed with a statement that has language which differs from the meaning of the language set forth in 37 C.F.R. §1.704(d). On May 25, 2016, a 37 C.F.R. §1.704(d) statement was submitted to the Office for each of these three Information Disclosure Statements. The petition pursuant to 37 C.F.R. § 1.183 is granted to the extent that the three 37 C.F.R. §1.704(d) statements submitted concurrently with this petition on May 25, 2016 will be accepted, despite the fact that each was not submitted contemporaneously with the corresponding IDS.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of sixty-two (62) days.

This is the Director’s decision on the applicant’s request for reconsideration under 35 USC 154(b)(3)(B)(ii). Any appeal from this decision is pursuant to 35 U.S.C. § 154(b)(4)(A).

Relevant Procedural History

On February 17, 2015, the Office determined that applicant was entitled to 81 days of PTA.

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On May 15, 2015, Patentee filed a request for redetermination of patent term adjustment requesting a PTA of 207 days, pursuant to 37 C.F.R. § 1.705(b), along with both the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) and a one-month extension of time so as to make timely the petition.

On March 25, 2016, the USPTO mailed an “on redetermination of patent term adjustment,” which indicates the Office has re-determined the patent term adjustment to be 62 days.

Decision

Upon review, the USPTO finds that Patentee is entitled to sixty-two (62) days of PTA.

Patentee and the Office are in agreement regarding the amount of “A” delay under 35 U.S.C. § 154(b)(1)(A).

Patentee and the Office *appear to be* in agreement regarding the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B), the amount of “C” delay under 35 U.S.C. § 154(b)(1)(C), and the amount of overlap under 35 U.S.C. § 154(b)(2)(A).

The sole issue in dispute *appears to be* the amount of reduction of PTA under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704.

“A” Delay

The Patentee and Office agree are 410 days of “A” delay. The period of “A” delay is 410 days under 37 C.F.R. § 1.703(a)(3) beginning on August 17, 2013 (the day after the date that is four months after the date the RCE was filed) and ending on September 30, 2014 with the mailing of the second notice of allowance.

“B” Delay

The Patentee and Office *appear to agree* that there are zero days of “B” delay.

The Novartis decision includes “instructions” for calculating the period of “B” delay. Specifically, the decision states,

The better reading of the language is that the patent term adjustment time [for “B” delay] should be calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of (b)(1)(B)) and determining the extent to which the result exceeds three years.

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The length of time between application and issuance is 1148 days, which is the number of days beginning on the filing date of the application (December 28, 2011) and ending on the date the patent issued (February 17, 2015).

The time consumed by continued examination is 533 days. The time consumed by continued examination includes the 533-day period beginning on the filing date of the RCE (April 16, 2013) and ending on the mailing date of the second notice of allowance (September 30, 2014).

The number of days beginning on the filing date of application (December 28, 2011) and ending on the date three years after the filing date of the application (December 28, 2014) is 1097 days.

The result of subtracting the time consumed by continued examination (533 days) from the length of time between the application's filing date and issuance (1148 days) is 615 days, which exceeds three years (1097 days) by negative 482 days; however, the "B" delay cannot be negative as the Office does not accord negative "B" delay, and therefore negative 482 days corresponds to zero days of "B" delay.¹ In other words, considering the time consumed by continued examination, this application was not pending beyond the 3-year period. Therefore, the period of "B" delay is zero days.

Put another way, the Office's calculation of "B" delay reflects that the RCE was filed prior to the three year pendency date of the application. Considering time consumed by continued examination (and appellate review, which in this case is not applicable), this application was not pending for more than three years. As of the filing of the RCE on April 16, 2013, this application which was filed on December 28, 2011 had been pending 475 days (which is the period beginning on the filing date of the application and ending on the day before the RCE was filed). The RCE period is not included in counting the three-year pendency period. Accordingly, prior to "B" delay accruing for the Office taking in excess of three years to issue the patent, this application had to be pending for an additional 622 (1097 – 475) days after the mailing of the second notice of allowance on September 30, 2014. As this application was only pending for an additional 140 days after the mailing of the second notice of allowance (the period beginning on the day after the mailing of the second notice of allowance – October 1, 2014 - and ending with the issuance of the patent on February 17, 2015), "B" delay is zero days.

"C" Delay

The Patentee and the Office *appear to agree* that the amount of "C" delay under 35 U.S.C. § 154(b)(1)(C) is zero days.

¹ 35 U.S.C. § 154(b)(1)(B) provides that if the pendency of an application is more than three years from the actual filing date of the application, the term of the patent issuing from the application shall be extended one day for each day after the end of the three-year period, but that certain time periods are excluded from the three-year period. However, if the sum of the excluded time periods exceed the over-three years period, the "B" delay will not be reduced past zero, as this would result in a reduction to the term of the patent.

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Overlap

The Patentee and the Office *appear to agree* that the amount of “C” delay under 35 U.S.C. § 154(b)(2)(A) is zero days.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

The Office finds that, under 37 C.F.R. § 1.704, the amount of PTA should be reduced by 348 days. The Office has determined that the Patentee failed to engage in reasonable efforts to conclude processing or examination of its application during the following periods.

- (1) An 89-day period pursuant to 37 C.F.R. § 1.704(b) from October 6, 2012 until January 2, 2013 because the Office mailed a non-final Office action on July 5, 2012. Accordingly, the three-month response date was October 5, 2012. However, the Patentee did not file its amendments to the specification and claims, as well as remarks until January 2, 2013.
- (2) A 21-day period pursuant to 37 C.F.R. § 1.704(c)(8) from January 3, 2013 until January 23, 2013 because the Patentee filed IDS documents on January 4, 2013 and January 23, 2013 after Patentee had filed a reply on January 2, 2013. *See Gilead Sciences Inc. v. Lee*, 778 F.3d 1341 (Fed. Cir. 2015). The Patentee did not submit a statement under 37 C.F.R. § 1.704(d) along with either IDS document.
- (3) A 216-day reduction pursuant to 37 C.F.R. § 1.704(c)(8) from April 17, 2013 until November 18, 2013 because the Patentee filed IDS documents on April 25, 2013, May 30, 2013, June 14, 2013, June 24, 2013, July 19, 2013, September 4, 2013, and November 18, 2013 after Patentee had filed a reply on April 16, 2013.² *See Gilead Sciences Inc. v. Lee*. The Patentee did not submit a statement under 37 C.F.R. § 1.704(d) along with any of these IDS documents.

Along with the submission of May 25, 2016, Patentee submitted three 37 C.F.R. § 1.704(d) statements. Each of these certification statements submitted on May 25, 2016 has been reviewed, and **the Office finds these certification statements** contain language that is **not sufficient to meet the requirements of 37 C.F.R. § 1.704(d)**. A discussion follows.

37 C.F.R. § 1.704(d) sets forth, *in toto*:

(d)(1) A paper containing only an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section, and a request for continued examination in compliance with §1.114 with no

² It is noted these periods of reduction consist of nine days, 44 days, 59 days, 69 days, 94 days, 141 days, and 216 days, respectively. However, since the 44-day period, the 59-day period, the 69-day period, the 94-day period, and the 141-day period each falls within the 216-day period, a single reduction of 216 days is warranted.

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submission other than an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(12) of this section, if the paper or request for continued examination is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the information disclosure statement.

The certification submitted on May 25, 2016 that is associated with the IDS documents filed on July 19, 2013 contains the following statement:

The undersigned certifies that the information contained in the information disclosure statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and the communication received in related U.S. Appl. Ser. No. 13/661,496 (available on PAIR) mailed June 19, 2013, was not received by an individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. See 37 C.F.R. § 1.704(d).¹

Footnote language: *See* 76 Fed Reg. 74700-01; 76 Fed. Reg. 18990-01; Comments on Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements (2011) (referencing the scope of 37 C.F.R. § 1.704(d) to include prompt citation of reference(s) cited from the Office in a related application, which will not result in a reduction of patent term adjustment).

The certification submitted on May 25, 2016 that is associated with the IDS documents filed on September 4, 2013 contains the following statement:

The undersigned certifies that the information contained in the information disclosure statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and the communication received in related U.S. Appl. Ser. No. 13/743,581 (available on PAIR) mailed August 7, 2013, was not received by an individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. See 37 C.F.R. § 1.704(d).¹

Footnote language: *See* 76 Fed Reg. 74700-01; 76 Fed. Reg. 18990-01; Comments on Revision of Patent Term Extension and Adjustment Provisions

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Relating to Appellate Review and Information Disclosure Statements (2011) (referencing the scope of 37 C.F.R. § 1.704(d) to include prompt citation of reference(s) cited from the Office in a related application, which will not result in a reduction of patent term adjustment).

The certification submitted on May 25, 2016 that is associated with the IDS documents filed on November 18, 2013 contains the following statement:

The undersigned certifies that the information contained in the information disclosure statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and the communication received in related U.S. Appl. Ser. No. 11/950,271 (available on PAIR) mailed October 18, 2013, was not received by an individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. See 37 C.F.R. § 1.704(d).¹

Footnote language: *See* 76 Fed Reg. 74700-01; 76 Fed. Reg. 18990-01; Comments on Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements (2011) (referencing the scope of 37 C.F.R. § 1.704(d) to include prompt citation of reference(s) cited from the Office in a related application, which will not result in a reduction of patent term adjustment).

Each of these three statements fails to indicate that each item of information contained in the IDS was first cited in any communication from the Office, and this communication was not received by **any** individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of the IDS. The usage of the word “an” instead of “any” in each of these certifications does not rule out the possibility that that at least one individual designated in 37 C.F.R. § 1.56(c) did in fact receive the communication more than thirty days prior to the filing of the IDS. The references contained in the three Information Disclosure Statements consist of one patent that issued in 2003, one patent that issued in 2012, and one patent that issued in 2011, respectively. Therefore, it is entirely possible that at least one individual designated in 37 C.F.R. § 1.56(c) received the references (patents which issued in 2003, 2011, and 2012) more than thirty days prior to the filing of the Information Disclosure Statements in 2013.

Therefore, **each statement has a meaning which differs from the language of 37 C.F.R. § 1.704(d)(i)**. It follows that the submission of each of these three IDS documents is considered a failure to engage in reasonable efforts to conclude prosecution under 37 C.F.R. § 1.704(c)(8), and the aforementioned 216-day reduction pursuant to 37 C.F.R. § 1.704(c)(8) is warranted.

- (4) A 22-day period pursuant to 37 C.F.R. § 1.704(c)(10)(i) from December 30, 2014 until January 20, 2015 because the Office mailed a second notice of allowance on September

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30, 2014, an amendment was filed on December 30, 2014, and the Office mailed a “response to rule 312 communication” on January 20, 2015.

Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - overlap - applicant delay = X.

USPTO’s Calculation:

$410 + 0 + 0 - 0 - 348 (89 + 21 + 216 + 22) = 62.$

Patentee’s Calculation *appears to be:*

$410 + 0 + 0 - 0 - 201 (89 + 21 + 69 + 22) = 209.$

Conclusion

Patentee is entitled to PTA of sixty-two (62) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $410 + 0 + 0 - 0 - 348 = 62$ days.

The Office will *sua sponte* issue the certificate of correction in an amount of 62 days. The Office notes that it did not issue the certificate of correction after the redetermination mailed on March 25, 2016 because Patentee timely filed a request for reconsideration. Accordingly, the Office will now have a certificate of correction mailed adjusting the amount of PTA.

Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.³

/Kery A. Fries /

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Associate Commissioner
For Patent Examination Policy

³ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 8,957,645 B2
DATED : Feb. 17, 2015
INVENTOR(S) : Glovinski

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 81 days.

Delete the phrase "by 81 days" and insert – by 62 days--