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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/404,050	03/13/2009	Chien-Chao Huang	TSM05-0261C1	1940

7590 04/09/2015
Intellectual Property Division
Taiwan Semiconductor Manufacturing Company, Ltd.
No. 8, Li-Hsin Rd. 6
Science-Based Industrial Park
Hsin-Chu, 300-77
TAIWAN

EXAMINER

ZHU, SHENG-BAI

ART UNIT	PAPER NUMBER
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2892

MAIL DATE	DELIVERY MODE
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04/09/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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In re Patent No. 8,835,291 :
Issue Date: September 16, 2014 : DECISION DENYING REQUEST
Application No. 12/404,050 : FOR REDETERMINATION OF
Filing or 371(c) Date: March 13, 2009 : PATENT TERM ADJUSTMENT
Attorney Docket No. TSM10-1233 :

This is in response to patentee's "APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705" filed October 10, 2014, which is being treated under 37 CFR 1.705(b) as a request that the Office correct the patent term adjustment determination ("PTA") from 900 days to 1024 days.

The request is **DENIED**.

This redetermination of patent term adjustment is the Director's decision on patentee's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

Relevant Procedural History

On September 16, 2014, this patent issued with a PTA of 900 days. On October 10, 2014, patentee timely filed the present request for redetermination of patent term adjustment within two months of the issue date of the patent.

Patentee seeks 1024 days of PTA. Patentee solely disputes the calculation of "B" delay. Patentee requests 124 days of "B" delay based on the Federal Circuit's interpretation of 35 U.S.C. § 154(b)(1)(B) set forth in *Novartis AG v. Lee*, No. 2013-1160 (Fed. Cir. Jan. 15, 2014). Patentee calculates the period of "B" delay as follows:

Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b) as modified by the Federal Circuit's decision in *Novartis*, a delay of 124 days (*e.g.*, the period between March 13, 2012 (*e.g.*, the day after three years after the filing date listed in paragraph 1) and September 16, 2014 (*e.g.*, the issue date listed in paragraph 14), but excluding the period between February 23, 2011 (*e.g.*, the filing date of the Request for Continued Examination listed in paragraph 7) and May 14, 2014 (*e.g.*, the mailing

Art Unit: OPET

date of the Notice of Allowance listed in paragraph 12)). Before *Novartis*, the Office excluded the period between May 14, 2014 and September 16, 2014 in the calculation of delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b).

Request, 10/10/14, pp. 2-3.

Decision

The Office has carefully considered patentee's arguments. Upon review, the Office finds that patentee is entitled to **900** days of PTA. The Office and patentee are in agreement regarding the calculation of 900 days of "A" delay, 0 days of "C" delay, 0 days of overlap, and 0 days of applicant delay. The Office has revisited the determination of the amount of "B" delay in view of the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

As to the amount of "B" delay, the Office notes that the interpretation of the "B" delay was based upon 37 CFR 1.703(b)(1) which excluded from the amount of "B" delay the period beginning on the date of filing of the continued examination and ending on the date of the issuance of the patent. However, the Federal Circuit reviewed the statutory interpretation of 35 U.S.C. § 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued Examination ("RCE") on "B" delay in the *Novartis* appeal. In *Novartis*, the Federal Circuit agreed with the Office that "no ["B" delay] adjustment time is available for any time in continued examination, even if the continued examination was initiated more than three calendar years after the application's filing." *Novartis*, 740 F.3d at 601. However, the *Novartis* court found that if the Office issues a notice of allowance after an RCE is filed, the period after the notice of allowance should not be excluded from the "B" delay period but should be counted as "B" delay. *Id.* at 602. The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

Pursuant to the *Novartis* decision, the USPTO has determined patentee is entitled to zero (0) days of "B" delay. In this case, applicant filed the application on March 13, 2009, and the patent issued on September 16, 2014. Thus, the application was pending for 2014 days. During this time, applicant filed a RCE on February 23, 2011. The Office mailed a Notice of Allowance on May 14, 2014. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on February 23, 2011, and ended on May 14, 2014 – *i.e.*, 1177 days. Subtracting the RCE period from the total number of days the application was pending results in $2014 - 1177 = 837$ days. Thus, for purposes of "B" delay, the application was pending for $837 - 1097$ [*i.e.*, 3 years (including a leap year) from the actual filing date] = 0 days beyond the three-year anniversary of the filing date.

Art Unit: OPET

Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - Overlap - applicant delay = X

USPTO’s Calculation:

$900 + 0 + 0 - 0 - 0 = 900$

Patentee’s Calculation

$900 + 124 + 0 - 0 - 0 = 1024$

Conclusion

The Office affirms that patentee is entitled to PTA of nine hundred (900) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $900 + 0 + 0 - 0 - 0 = 900$ days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 1024 days is not merited. As the front page of the patent properly reflects the PTA determination of 900 days, no further action is required. Accordingly, the request for redetermination of patent term adjustment is **denied**. This decision may be viewed as a final agency action. See MPEP 1002.02(b).

The Office acknowledges receipt 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 Christina Tartera Donnell, Attorney Advisor at (571) 272-3211.

/JOHN COTTINGHAM/

Director

Office of Petitions

Office of Petitions: Decision Count Sheet

Mailing Month **3**

Application No.

12404050



For US serial numbers: enter number only, no slashes or commas. Ex: 10123456

For PCT: enter "51+single digit of year of filing+last 5 numbers", Ex. for PCT/US05/12345, enter 51512345

Deciding Official:

DONNELL, CHRISTINA

Count (1) - Palm Credit

12/404,050

Decision: DENIED

FINANCE WORK NEEDED

Select Check Box for YES



Decision Type: 547 - PTA Recalculation - Novartis Decision (2015)



Notes:

Count (2)

Decision: n/a

FINANCE WORK NEEDED

Select Check Box for YES

Decision Type: NONE

Notes:

Count (3)

Decision: n/a

FINANCE WORK NEEDED

Select Check Box for YES

Decision Type: NONE

Notes:

Initials of Approving Official (if required)

If more than 3 decisions, attach 2nd count sheet & mark this box

Printed on: 3/31/2015

Office of Petitions: Routing Sheet



Application No. 12/404,050

This application is being forwarded to your office for further processing. A decision has been rendered on a petition filed in this application, as indicated below. For details of this decision, please see the document PET.OP.DEC filed on the same date as this document.

GRANTED

DISMISSED

DENIED



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/404,050	03/13/2009	Chien-Chao Huang	TSM05-0261C1	1940

7590 03/03/2015
Intellectual Property Division
Taiwan Semiconductor Manufacturing Company, Ltd.
No. 8, Li-Hsin Rd. 6
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TAIWAN

EXAMINER

ZHU, SHENG-BAI

ART UNIT	PAPER NUMBER
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2892

MAIL DATE	DELIVERY MODE
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03/03/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 8,835,291 :
Issue Date: September 16, 2014 :
Application No. 12/404,050 : DECISION ON PETITION
Filing or 371(c) Date: March 13, 2009 :
Attorney Docket No. TSM10-1233 :

This is a decision on the “WITHDRAWAL OF APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705 AND REQUEST FOR REFUND” filed February 2, 2015.

Patentee seeks to withdraw the request for reconsideration of the patent term adjustment under 37 CFR 1.705(b) filed October 10, 2014, contingent upon the Office refunding the \$200.00 fee set forth in 37 CFR 1.18(e) charged to the Deposit Account.

As explained in MPEP 607.02:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. *See Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the “by mistake” clause is applicable only to a mistake relating to the fee payment).

When an applicant or patentee takes an action “by mistake” (e.g., files an application or maintains a patent in force “by mistake”), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a “fee paid by mistake” within the meaning of 35 U.S.C. 42(d).

37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

In this instance, patentee has made no assertions that patentee paid the \$200.00 fee set forth in 37 CFR 1.18(e) by mistake or in excess of the amount of fee that is required. Therefore, it appears that patentee wishes to withdraw the request for reconsideration of the patent term adjustment and obtain a refund of the \$200.00 fee due to a change of purpose after payment of the fee. As stated above, a change of purpose is not a circumstance entitling patentee to a refund.

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Moreover, the fee specified in 37 CFR 1.18(e) is required for a request for reconsideration under 37 CFR 1.705(b). The Office may only refund fees paid by mistake or in excess of the amount that is required (35 U.S.C. 42(d)). The \$200.00 fee set forth in 37 CFR 1.18(e) and any fee for a petition under 37 CFR 1.136(a) required for a timely request for reconsideration under 37 CFR 1.705 (§ 1.705(b)(1)) are not fees paid by mistake or in excess.

Patentee has not demonstrated, and the record does not show, that patentee paid the \$200.00 fee in error or in excess of the amount required. Pursuant to 35 U.S.C. 42(d) and 37 CFR 1.26, patentee is not entitled to a refund of the \$200.00 fee. As patentee's request to withdraw the request for reconsideration of the patent term adjustment under 37 CFR 1.705(b) filed May 23, 2014, is contingent upon the Office refunding the \$200.00 fee set forth in 37 CFR 1.18(e), the Office will not withdraw the request. A decision on the request for reconsideration of the patent term under 37 CFR 1.705(b) filed October 10, 2014, will be forthcoming under separate cover.

In view of the above, the petition is **DISMISSED**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell
Attorney Advisor
Office of Petitions

Office of Petitions: Routing Sheet



Application No. 12/404,050

This application is being forwarded to your office for further processing. A decision has been rendered on a petition filed in this application, as indicated below. For details of this decision, please see the document PET.OP.DEC filed on the same date as this document.

GRANTED

DISMISSED

DENIED

Office of Petitions: Decision Count Sheet

Mailing Month **3**

Application No.

12404050



For US serial numbers: enter number only, no slashes or commas. Ex: 10123456

For PCT: enter "51+single digit of year of filing+last 5 numbers", Ex. for PCT/US05/12345, enter 51512345

Deciding Official:

DONNELL, CHRISTINA

Count (1) - Palm Credit

12/404,050

Decision: **DISMISSED**

FINANCE WORK NEEDED

Select Check Box for YES



Decision Type: **515 - 37 CFR 1.181 for REVIEW OF NON-EXAMINING MAT**



Notes:

[Notes area for Count 1]

Count (2)

Decision: **n/a**

FINANCE WORK NEEDED

Select Check Box for YES

Decision Type: **NONE**

Notes:

[Notes area for Count 2]

Count (3)

Decision: **n/a**

FINANCE WORK NEEDED

Select Check Box for YES

Decision Type: **NONE**

Notes:

[Notes area for Count 3]

Initials of Approving Official (if required)

If more than 3 decisions, attach 2nd count sheet & mark this box

Printed on: 3/2/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Inventor: Huang Docket No.: TSM05-0261C1
Serial No.: 12/404,050 Filed: 3/13/2009
Patent No.: 8835291B2 Issue Date: 9/16/2014
Conf. No.: 1940
Title: Strained Gate Electrodes in Semiconductor Devices

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**WITHDRAWAL OF APPLICATION FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705 AND REQUEST FOR REFUND**

Dear Sir:

Patent Owner hereby withdraws the Application for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. § 1.705 filed October 10, 2014, contingent upon the previously paid fee of \$200 under 37 C.F.R. § 1.18(e) being refunded to Deposit Account 50-1065.

Patent Owner respectfully requests a refund of the previously paid fee of \$200 under 37 C.F.R. § 1.18(e) to Deposit Account 50-1065. The previously paid fee of \$200 was charged from Deposit Account 50-1065 on October 14, 2014, as indicated in the attached deposit account statement.

Should any issues remain outstanding or any questions arise, it is respectfully requested that the Attorney for Patentee below be contacted.

Respectfully submitted,

2 February 2015
Date

/Adam C. Davenport/
Adam C. Davenport
Attorney for Patentee
Reg. No. 66,311

SLATER & MATSIL, L.L.P.
17950 Preston Rd., Ste. 1000
Dallas, Texas 75252
Tel.: 972-732-1001
Fax: 972-732-9218
docketing@slater-matsil.com

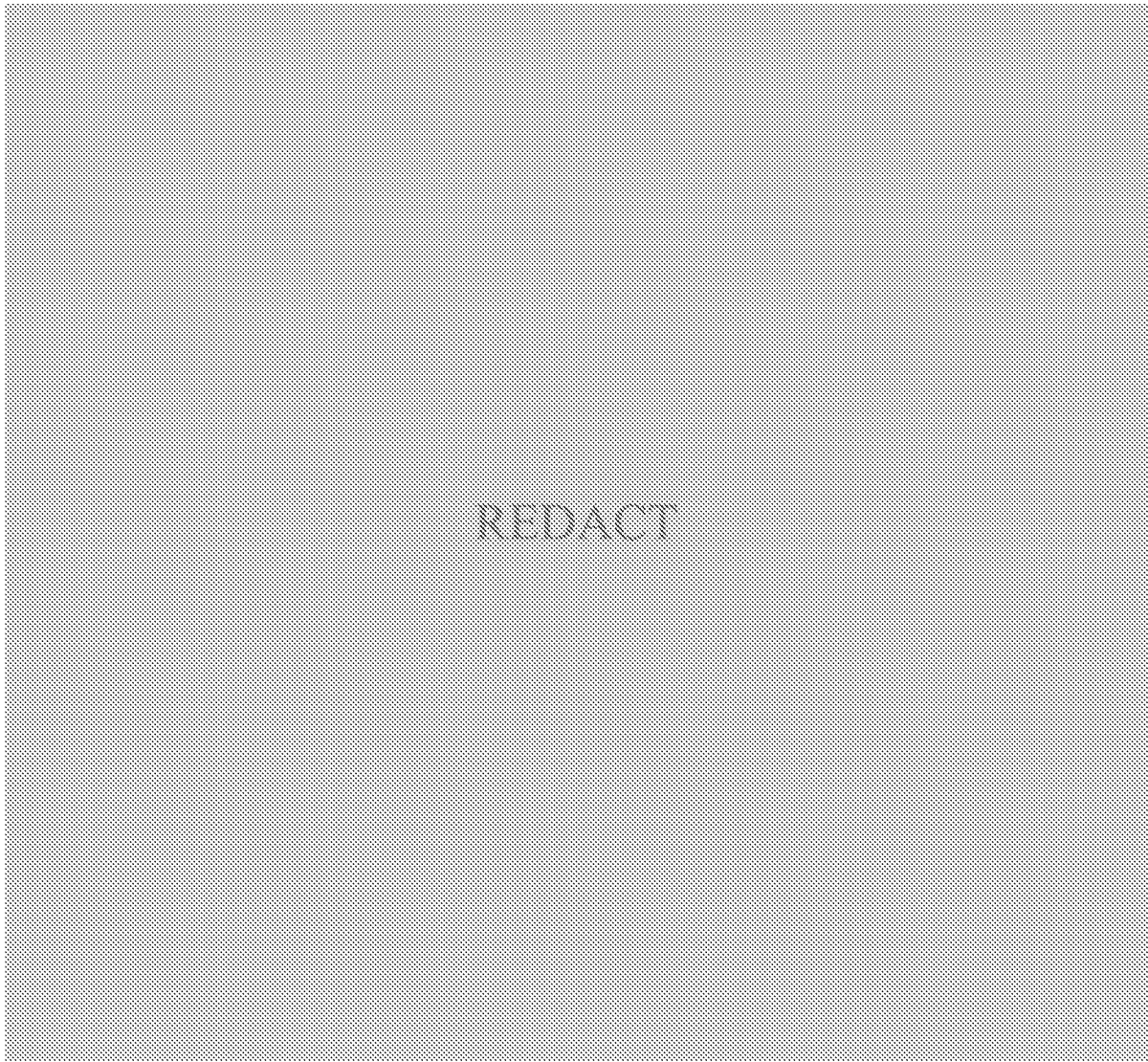


**United States
Patent and
Trademark Office**

Deposit Account Statement

Requested Statement Month: October 2014
 Deposit Account Number: 501065
 Name: SLATER & MATSIL, LLP
 Attention: IRA S MATSIL
 Street Address 1: 17950 PRESTON RD
 Street Address 2: SUITE 1000
 City: DALLAS
 State: TX
 Zip: 75252
 Country: UNITED STATES

DATE SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
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REDACT						
10/14	7653	12404050	TSM05-0261C1	1455	\$200.00	REDACT
REDACT						

Electronic Acknowledgement Receipt

EFS ID:	21377171
Application Number:	12404050
International Application Number:	
Confirmation Number:	1940
Title of Invention:	STRAINED GATE ELECTRODES IN SEMICONDUCTOR DEVICES
First Named Inventor/Applicant Name:	Chien-Chao Huang
Correspondence Address:	Intellectual Property Division Taiwan Semiconductor Manufacturing Company, Ltd. No. 8, Li-Hsin Rd. 6 Science-Based Industrial Park Hsin-Chu - 300-77 TW 886036665106 -
Filer:	Adam Cole Davenport/Cindy Stouten
Filer Authorized By:	Adam Cole Davenport
Attorney Docket Number:	TSM05-0261C1
Receipt Date:	02-FEB-2015
Filing Date:	13-MAR-2009
Time Stamp:	19:07:42
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Withdrawal of Application for PTE	TSM05-0261 C1-Withdrawal-PTA_and_Request-Refund.pdf	65404 1bfde32a0c924290736175ffadb699c123b18f55	no	3

Warnings:

Information:

Total Files Size (in bytes): 65404

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Inventor:	Huang	Docket No.:	TSM05-0261C1
Serial No.:	12/404,050	Filed:	3/13/2009
Patent No.:	8835291B2	Issue Date:	9/16/2014
Conf. No.:	1940		
Title:	Strained Gate Electrodes in Semiconductor Devices		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705**

Dear Sir:

Patent Owner respectfully requests reconsideration of the patent term adjustment of the above-referenced patent pursuant to 37 C.F.R. § 1.705 and in view of the Federal Circuit’s decision in *Novartis AG v. Lee*, No. 2013-1160 (Fed. Cir. Jan. 15, 2014) interpreting 35 U.S.C. § 154(b)(1)(B). This application is timely filed within two months of the issue date of above-referenced patent pursuant to 37 C.F.R. § 1.705(b). The fee of \$200 under 37 C.F.R. § 1.18(e) is submitted herewith. Please charge any other fees that may be deemed due, or credit any overpayment, to Deposit Account 50-1065. For the reasons presented herein, Patent Owner submits that additional patent term adjustment is appropriate, and respectfully requests that such adjustment be added to the term of the above-referenced patent.

STATEMENT OF FACTS

1. The application that matured into the above-referenced patent was filed on March 13, 2009.
2. A first non-final rejection was mailed on June 9, 2010.
3. A response to the first non-final rejection was filed on September 8, 2010.
4. A first final rejection was mailed on November 26, 2010.
5. A response to the first final rejection was filed on January 25, 2011.
6. An advisory action was mailed on February 7, 2011.
7. A Request for Continued Examination was filed on February 23, 2011.
8. A second non-final rejection was mailed on November 12, 2013.
9. A response to the second non-final rejection was filed on January 31, 2014.
10. A second final rejection was mailed on February 24, 2014.
11. A response to the second final rejection was filed on April 24, 2014.
12. A Notice of Allowance and Fees Due was mailed on May 14, 2014.
13. The issue fee was paid on August 13, 2014.
14. The above-reference patent issued on September 16, 2014.
15. Based upon the foregoing facts, the following delays are attributable to the Office:
 - A. Under 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1), a delay of 27 days (*e.g.*, the difference between May 13, 2010 (fourteen months after the filing date listed in paragraph 1) and June 9, 2010 (the mailing date of the rejection listed in paragraph 2)).
 - B. Under 35 U.S.C. § 154(b)(1)(A)(ii) and 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2), a delay of 873 day (*e.g.*, the difference between June 23, 2011 (four months after the filing date of the Request for Continued Examination listed in paragraph 7) and November 12, 2013 (the mailing date of the rejection listed in paragraph 8)).
 - C. Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b) as modified by the Federal Circuit's decision in *Novartis*, a delay of 124 days (*e.g.*, the period between March 13, 2012 (the date three years after the filing date listed in paragraph 1) and September 16, 2014 (the issue date listed in paragraph 14), but excluding the period between February 23, 2011 (the filing date of the Request for Continued Examination listed in paragraph 7) and May 14, 2014 (the mailing date of the Notice of Allowance listed in paragraph 12)). Before *Novartis*, the Office excluded the period between May

14, 2014 and September 16, 2014 in the calculation of delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b).

16. None of the periods listed in paragraph 15 overlap.
17. The above-referenced patent is not subject to a terminal disclaimer.
18. There are no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704.
19. Based on the facts and bases listed in paragraphs 15 through 18, Patent Owner is entitled to a patent term adjustment of 1,024 days for the above-reference patent.

REMARKS

As stated above, Patent Owner is entitled to a patent term adjustment of 1,024 days for the above-referenced patent. The Office previously granted a patent term adjustment of 900 days. Hence, Patent Owner respectfully requests that the patent term adjustment granted be adjusted accordingly.

Should any issues remain outstanding or any questions arise, it is respectfully requested that the Attorney for Patentee below be contacted.

Respectfully submitted,

8 October 2014
Date

/Adam C. Davenport/
Adam C. Davenport
Attorney for Patentee
Reg. No. 66,311

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17950 Preston Rd., Ste. 1000
Dallas, Texas 75252
Tel.: 972-732-1001
Fax: 972-732-9218
docketing@slater-matsil.com

Electronic Patent Application Fee Transmittal

Application Number:	12404050
Filing Date:	13-Mar-2009
Title of Invention:	STRAINED GATE ELECTRODES IN SEMICONDUCTOR DEVICES
First Named Inventor/Applicant Name:	Chien-Chao Huang
Filer:	Adam Cole Davenport/Cindy Stouten
Attorney Docket Number:	TSM05-0261 C1

Filed as Large Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Application for patent term adjustment	1455	1	200	200

Patent-Appeals-and-Interference:

Post-Allowance-and-Post-Issuance:

Extension-of-Time:

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				200