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In re Patent No. 8,620,758	:	
Stephen C. Wren	:	DECISION ON REQUEST
Issue Date: 12/31/2013	:	FOR RECONSIDERATION OF
Application No. 12/124,027	:	PATENT TERM ADJUSTMENT
Filed: 5/20/2008	:	
For: SYSTEM FOR MARKETING GOODS AND SERVICES UTILIZING COMPUTERIZED CENTERAL AND REMOTE FACILITIES	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed on April 6, 2015. The request is treated as a request for reconsideration in which patentee requests that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand seven (1,007) days to seven thousand eight hundred thirty four (7,834) days.

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 783 days. This decision is the Director's decision on the applicant's request for reconsideration for purposes of seeking judicial review under 35 U.S.C. § 154(b)(4).

BACKGROUND

On December 31, 2013, the above-identified application matured into U.S. Patent No. 8,620,758, with a patent term adjustment of 1007 days. On February 28, 2014, an application for patent term adjustment was filed. On February 5, 2015, a decision on Redetermination of Patent Term Adjustment was mailed, stating that the Office had re-determined the PTA to be 783 days. On April 6, 2015, the present request for reconsideration of patent term adjustment was filed.

Patentee does not dispute the Office's calculation of the A and C delays of 1071 days. Patentee asserts that the B delay is 6763 days. Specifically, patentee asserts that the B delay period includes the pendency of other applications to which the patent claims benefit under 35 U.S.C. 120. Patentee does not address the applicant delay found by the Office.

STATUTE AND REGULATION

35 U.S.C. 154(b)(1)(pre-AIA) states, in pertinent part:

> (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 under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application not including—
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> (i) any time consumed by continued examination of the application requested by the applicant undersection 132(b);
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> (ii) any time consumed by a proceeding undersection 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
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> (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.
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> (C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO DERIVATION PROCEEDINGS, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—
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> (i) a proceeding under section 135(a);
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> (ii) the imposition of an order under section 181; or
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> (iii) appellate review by the Patent Trial and Appeal Board 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.

37 CFR 1.702 states, in pertinent part:

> (b) *Three-year pendency.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:
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> (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
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> (2) Any time consumed by an interference or derivation proceeding under 35 U.S.C. 135(a);
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> (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
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> (4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or
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> (5) Any delay in the processing of the application by the Office that was requested by the applicant.

37 CFR 1.703, the implementing regulation, states, in pertinent part:

> (b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:
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> (1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date of the mailing of the notice of allowance under 35 U.S.C. 151;
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> (2)
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> (i) The number of days, if any, in the period beginning on the date an interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding under 35 U.S.C. 135(a) and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference or derivation proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3)

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;
(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference or derivation proceeding under 35 U.S.C. 135(a) would be instituted but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under § 41.35(b) of this chapter or the date of the last decision by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, whichever is later.

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

37 CFR 1.704(c)(12),[1] as it applies to applications filed under 35 USC 111 before December 18, 2013, states, in pertinent part:

[1] See *Revision of Patent Term Adjustment Provisions Relating to Appellate Review*, 77 Fed. Reg. 49354, 360 (Aug. 16, 2012).

> Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
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> > (12) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

OPINION

Patentee argues, in pertinent part:

> From The CAFC Wyeth decision-
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> "Accordingly, subtitle D removes the 10-year caps from the existing provisions, adds a new provision to compensate applicant fully for uspto-caused administrative delays, and for good measure, includes a new provision guaranteeing diligent applicants at least a 17-year term by extending the term of any patent not granted within three years of filing. Thus no patent applicant diligently seeking to obtain a patent will receive a term of less than 17 years as provided under the pre-gatt standard; in fact, most will receive considerably more." *Wyeth v. Kappos*, (Fed. Cir, 2010)
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> ...
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> The PTO already calculated the parts A and C adjustments as 1071 days. For the part B adjustment, the parent application was filed March 20, 1992. The full pendancy [*sic*] to issue on December 31, 2013 was then 7956 days. Backing out the time on appeal at the Board of Patent Appeals which the PTO calculated as 1193 days, the part B adjustment would be 6763 days. Adding that to the parts A and C adjustment of 1071 days as calculated by the PTO gives a total patent term adjustment for parts A, B and C of 7834 days, or 21 years and 169 days. Relevant dates: the filing date of the earliest referenced parent application is March 20, 1992; issue date of this patent is 12/31/2013; minimal 17 year guaranteed expiration date is 12/31/2030. The combined part A and C adjustment as calculated by the PTO was 1071 days. The full § 1.703(f) adjustment as above is 7834 days, or 21 years and 169 days.
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> (emphasis in original)

The sole area of dispute on renewed petition is the B delay.

Patentee's argument has been carefully considered, but is not persuasive. As noted above, § 1.704(c)(12) states that "[f]urther prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent." It is undisputed that the parent applications were filed on March 20, 1992, which was prior to the filing of the subject application on May 20, 2008. As such, this continuation application is not entitled to an adjustment for an examination delay which occurred prior to the actual filing date of this continuation application. Put another way, the aforementioned examination delay which occurred in the parent application does not carry over into this continuation application.

In *Mohsenzadeh v. Lee*, 790 F.3d 1377 (Fed. Cir. 2015), the patentee argued that he was entitled to additional patent term adjustment in a continuing application based on Office delay in issuance of a restriction requirement during the prosecution of a parent application. In rejecting patentee's argument for additional PTA, the Court of Appeals for the Federal Circuit held that "the term of any patent arising from a continuing application is not restored for delay in the prosecution of the parent patent's application" in interpreting 35 U.S.C. 154(b)(1)(A). *Id.* at 1381.

Similar to 35 USC 154(b)(1)(A), § 154(b)(1)(B) also refers to "an original patent," "an application" and "the patent". While patentee has not explained what periods of delay from the parent application(s) are asserted to apply to the patent term adjustment determination in the subject patent, the rationale applied in *Mohsenzadeh* in the interpretation of § 154(b)(1)(A) would be applicable to the interpretation of § 154(b)(1)(B).

Moreover, assuming, *arguendo*, any of the delay did occur after the filing of this continuation application, the application of which this application claims benefit, Application No. 09/504,374, was filed on February 15, 2000, which is before May 29, 2000. The patent term adjustment provisions of 37 CFR 1.702-1.705 do not apply to patents which issued from applications filed before May 29, 2000. As such, the parent applications are not entitled to patent term adjustment. Therefore, there is no patent term adjustment that accrued in the parent applications.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

0 + 0 + 969 – 0 – 186 = 783

Patentee's Calculation

0 + 6763 + 1071 – 0 – 186 = 7648

In view of the redetermination, the petition is granted to the extent that the PTA calculation has been reconsidered, but is denied with respect to any change in redetermination of the PTA.

CONCLUSION

The request for reconsideration of the revised patent term adjustment is **denied**.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Douglas I. Wood at 571-272-3231.

/ROBERT CLARKE/
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