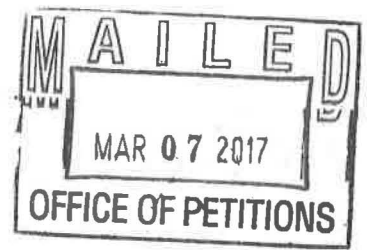




UNITED STATES PATENT AND TRADEMARK OFFICE



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In re Patent of Wang et al. :
Patent No. 9,283,100 : FINAL AGENCY DECISION ON
Issue Date: March 15, 2016 : REQUEST FOR RECONSIDERATION
Application No. 13/473,031 : OF PATENT TERM ADJUSTMENT
Filing Date: May 16, 2012 :
Attorney Docket No. 062571.00627 :

This is a decision on the “APPLICATION FOR PATENT TERM ADJUSTMENT” (“Request”), filed May 16, 2016, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent from eight (8) days to thirty-nine (39) 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 eight (8) 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).

Relevant Procedural History

The patent issued with a PTA determination of 8 days on March 15, 2016. The Request seeking a PTA of 39 days was timely filed on Monday, May 16, 2016. The sole issue in dispute is the length of reduction warranted pursuant to 37 CFR 1.704(c)(10) for the filing of an amendment under 37 CFR 1.312 (“Rule 312 amendment”) on February 4, 2016, after a Notice of Allowance was mailed on November 5, 2015.

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Decision

The PTA set forth on the patent is based on the following determinations previously made by the Office:

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) (“A Delay”) is 80 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 0 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) (“C Delay”) is 0 days;
- (4) The number of days of overlapping delay (“Overlap”) between the periods of A Delay, B Delay, and C Delay is 0 days; and
- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) (“Applicant Delay”) is 72 days.

The PTA to be set forth on a patent is the sum of the days of A Delay, B Delay, and C Delay reduced by the number of days of Overlap and Applicant Delay. In other words, the following formula may be used to calculate the PTA:

$$\text{PTA} = \text{A Delay} + \text{B Delay} + \text{C Delay} - \text{Overlap} - \text{Applicant Delay}$$

The patent sets forth a PTA of 8 days (80 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap – 72 days of Applicant Delay).

The Request does not dispute the Office’s calculations of the periods of A Delay, B Delay, C Delay, and Overlap.

The Request asserts the Office should have entered a 10 day period of reduction, not a 41 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on February 4, 2016, after a Notice of Allowance was mailed on November 5, 2015. The Request asserts the period of Applicant Delay is 41 days (31 + 10) days.

The Request argues the correct PTA is 39 days (80 days of A Delay + 0 days of B Delay + 0 days of C Delay – 0 days of Overlap – 41 days of Applicant Delay).

As will be discussed, the period of Applicant Delay is 72 days.

Therefore, the correct PTA is 8 days (80 days of A Delay + 0 days of B Delay + 0 days of C Delay – 0 days of Overlap - 72 days of Applicant Delay).

A Delay

The Request does not dispute the Office’s prior determination of the period A Delay is 80 days. The Office has recalculated the period of A Delay as part of the Office’s redetermination of the PTA and confirmed the period of A Delay is 80 days.

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B Delay

The Request does not dispute the Office's prior determination the period of B Delay is 0 days. The Office has recalculated the period of B Delay as part of the Office's redetermination of the PTA and confirmed the period of B Delay is 0 days.

C Delay

The Request does not dispute the Office's prior determination the period of C Delay is 0 days. The Office has recalculated the period of C Delay as part of the Office's redetermination of the PTA and confirmed the period of C Delay is 0 days.

Overlap

The Request does not dispute the Office's prior determination the number of days of Overlap is 0 days. The Office has recalculated the number of days of Overlap as part of the Office's redetermination of the PTA and confirmed the number of days of Overlap is 0 days.

Applicant Delay

The Request disputes the Office's prior determination the number of days of Applicant Delay is 72 days. The Office has recalculated the number of days of Applicant Delay as part of the Office's redetermination of the PTA and confirmed the number of days of Applicant Delay is 72 days. The Request only disputes the length of reduction warranted pursuant to 37 CFR 1.704(c)(10) for the filing of a Rule 312 amendment on February 4, 2016, after a Notice of Allowance was mailed on November 5, 2015. The Request does not dispute the other instance of Applicant Delay, as previously determined by the Office.

The Request asserts the Office should have entered a 10 day period of reduction, not a 41 day period of reduction, pursuant to 37 CFR 1.704(c)(10) in connection with the filing of a Rule 312 amendment on February 4, 2016, after a Notice of Allowance was mailed on November 5, 2015.

37 CFR 1.704(c) provides that:

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:

- (10) Submission of an amendment under § 1.312 or other paper, other than a request for continued examination in compliance with §1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in §1.703 shall be reduced by the lesser of:

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- (i) The number of days, if any, beginning on the date the amendment under §1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

- (ii) Four months;

In this instance, a Notice of Allowance was mailed on November 5, 2015. A Rule 312 amendment was subsequently filed on February 4, 2016.

The Request argues the Office should have entered a 10 day period of reduction, not a 41 day period of reduction, pursuant to 37 CFR 1.704(c)(10). The Request asserts the Office should consider February 13, 2016 as the end date of the 37 CFR 1.704(c)(10) calculation because the PAIR entry of February 13, 2016 indicates the Rule 312 amendment was "OK TO ENTER:/J.S./." "J.S." are examiner Julie Ann Szpira's initials. The Request argues the February 13, 2016 PAIR entry constitutes a response to the Rule 312 amendment and should be considered the end date for the 37 CFR 1.704(c)(10) calculation.

The language of 37 CFR 1.704(c)(10) provides clear guidance as to the end date of the calculation. The end date is "...the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper or four months." As stated in MPEP 2732,

37 CFR 1.704(c)(10) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the lesser of: (1) the number of days, if any, beginning on the date the amendment under 37 CFR 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under 37 CFR 1.312 or such other paper; or (2) four months. The phrase "lesser of ...or [f]our months" is to provide a four-month cap for a reduction under 37 CFR 1.704(c)(10) if the Office takes longer than four months to issue an Office action or notice in response to the amendment under 37 CFR 1.312 or other paper. If the Office does not mail a response to the paper that triggered the delay under this provision and the patent issues in less than four months, then the applicant delay under this provision will end on the date of the patent issuance. The Office will treat the issuance of the patent as the response to the paper that triggered the delay.

No Office action or notice was mailed in response to Rule 312 amendment on February 13, 2016.

Applicants participate in the e-Office Action program. An e-mail notification is sent only when there is new Office communication that day for applications associated with the participant's Customer Number. Specific e-Office Action related events with corresponding dates are available in the Transaction History tab in Private PAIR. The Transaction Description events are self-explanatory and are labeled as "Email Notification," "Electronic Review," and if applicable "Mail Post Card." In addition, an OA.EMAIL document is placed in the file wrapper of the

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application notified that day. OA.EMAIL is the code used for Private PAIR Correspondence Notifications. The OA.EMAIL document is a truncated version of the daily e-mail listing details of only that specific application number's new communication.

A review of this application's image file wrapper reveals the only OA.EMAIL sent to applicant in February 2016 was the February 25, 2016 OA.EMAIL that alerted applicant to the mailing of the Issue Notification on February 24, 2016. The Issue Notification is not an Office action or notice *in response* to the amendment under § 1.312. Rather, an Issue Notification is mailed after the issue fee has been paid and processed by the USPTO. MPEP 1306.03 Practice After Payment of Issue Fee; Receipt of Issue Notification.

A review of this application's image file wrapper reveals the February 13, 2016 examiner annotated first page of the Rule 312 amendment is part of an internal Office document, a Printer Rush, and no mailing occurred. In short, the February 13, 2016 document was not mailed or the subject of an e-mail notification. As such, the end date of the calculation is the date the patent issued, as it is earlier than 4 months from the filing date of the February 4, 2016 Rule 312 amendment.

Pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by 41 days, beginning on February 4, 2016, the date the Rule 312 amendment was filed, and ending on and including March 15, 2016, the date the patent issued. The 41 day period of reduction pursuant to 37 CFR 1.704(c)(10) is proper and will not be altered.

The period of Applicant Delay is 72 days (31 + 41).

Conclusion

The Request asserts the correct PTA is 39 days (80 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 41 days of Applicant Delay).

As previously discussed, the period of Applicant Delay is 72 days. Therefore, the PTA is 8 days (80 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 72 days of Applicant Delay).

Telephone inquiries specific to this decision should be directed to Attorney Advisor Shirene Willis Brantley at (571) 272-3230.

/ROBERT CLARKE/

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for Patent Examination Policy - USPTO