

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 8,733,556 B2
APPLICATION NO. : 12/387576
DATED : May 27, 2014
INVENTOR(S) : Giglia et al.

Page 1 of 1

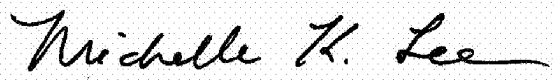
It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title Page:

The first or sole Notice should read --

Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 533 days.

Signed and Sealed this
Thirtieth Day of May, 2017



Michelle K. Lee

Director of the United States Patent and Trademark Office



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/387,576	05/05/2009	Sal Giglia	MCA-972/1	3919

42754 7590 05/06/2015
Niels, Lemack & Frame, LLC
176 E. Main Street
Suite #5
Westborough, MA 01581

EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1777

MAIL DATE	DELIVERY MODE
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05/06/2015

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.



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In re Patent No. 8,733,556 :
Giglia et al. :
Issue Date: May 27, 2014 : ON REDETERMINATION OF
Application No. 12/387,576 : PATENT TERM ADJUSTMENT
Filed: May 5, 2009 :
Attorney Docket No. MCA-972/1 :

This is a response to patentee's "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed June 25, 2014, requesting that the Office adjust the patent term adjustment from 505 days to 534 days. The Office has re-determined the patent term adjustment to be 533 days.

This redetermination of patent term adjustment is not the Director's decision on the applicant'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 May 27, 2014, this patent issued with a patent term adjustment determination of 505 days. On June 25, 2014, patentee timely filed this "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" seeking an adjustment of the determination to 534 days.

Redetermination

Patentee does not dispute the Office's calculation of "A" delay of 809 days, "C" delay of 0 days, overlap of 0 days or applicant delay of 304 days. At issue is the period of "B" delay.

Art Unit: OPET

Patentee respectfully requests reconsideration of the patent term adjustment in view of the decisions in *Novartis AG v. Lee*, No. 2013-1160 and 2013-1179 (Fed. Cir. Jan. 15, 2014) and *Exelixis, Inc. v. Lee*, 2013-1175 (Fed. Cir. Jan. 15, 2014). Patentee asserts that the time consumed between the mailing of the Notice of Allowance on January 16, 2014 and the issuance of the patent on May 27, 2014 should be included as part of 35 USC § 154(b) (i) (B) (i) delay. This additional period of time is believed to be 131 days. When this time is added to the time defined between the filing of the application (May 5, 2009) and the filing of the RCE (January 24, 2012), the total time is now greater than 3 years. Patentee argues that the Patent Office's erroneous interpretation of 35 U.S.C. §154(b) (i)(B) incorrectly decreased the patent term adjustment for this application by 29 days.

The Office accorded 0 days of "B" delay based upon the Office's former interpretation of rule 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.

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.

Patentee's attention is further directed to *Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee*, 80 FR 1346 (January 9, 2015)¹, which provides:

¹The Office has been deciding requests for reconsideration of a patent term adjustment filed pursuant to 37 CFR 1.705 consistent with the Federal Circuit decision in *Novartis* since January 15, 2014 (the date the Federal Circuit issued its decision in *Novartis*).

Art Unit: OPET

If a first request for continued examination is filed before a notice of allowance has been mailed and a second request for continued examination is filed after a notice of allowance has been mailed, the time consumed by continued examination of the application under 35 U.S.C. 132(b) is the number of days in the period beginning on the date on which the first request for continued examination was filed and ending on the date of mailing of the notice of allowance following the first request for continued examination, plus the number of days in the period beginning on the date on which the second request for continued examination was filed and ending on the date of mailing of the notice of allowance following the second request for continued examination. If a second request for continued examination is filed without a notice of allowance having been mailed between the filing of the first and second requests for continued examination and a notice of allowance is mailed after the second request for continued examination, the time consumed by continued examination of the application under 35 U.S.C. 132(b) is the number of days in the period beginning on the date on which the first request for continued examination was filed and ending on the date of mailing of the notice of allowance.

Pursuant to the *Novartis* decision, the USPTO has determined that patentee is entitled to 28 days of "B" delay (with 0 days of overlap).

In this case, the filing date of the application is May 5, 2009, and the patent issued on May 27, 2014; thus, the application was pending for 1849 days.

A request for continued examination (RCE) was filed on January 24, 2012. A Notice of Allowance issued on January 16, 2014. Under 35 U.S.C. § 154(b)(1)(B)(i), there was one time period consumed by continued examination ("RCE period"). The RCE period began on January 24, 2012 and ended on January 16, 2014. - i.e., 724 days.

Subtracting the RCE period from the total number of days the application was pending results in $1849 - 724 = 1125$ days.

Art Unit: OPET

Thus, for purposes of "B" delay, the application was pending for 1125 - 1097 [i.e., 3 years from the actual filing date] = 28 days beyond the 3-year anniversary of the filing date.

In view thereof, "B" delay is 28 days.

There remains 0 days of overlap between "A" and "B" delay.

Patentee is incorrect in stated that "B" delay is 29 days. At the time of the filing of the RCE on January 24, 2012, this application filed May 5, 2009 had not been pending for 3 years. As of January 23, 2012, this application was pending 994 days. As such, 103 [1097 - 994] of the days determined "not to be consumed by continued examination" had to accumulate before this application was pending for 3 years [1097 days] and before days were counted as the Office taking in excess of three years to issue this patent, i.e., "B" delay). In other words, the 131 days not consumed by continued examination minus 103 days of pendency to reach 3 years equals the Office's "B" delay calculation of 28 days.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

809 + 28 + 0 - 0 - 304 = 533

Patentee's Calculation

809 + 29 + 0 - 0 - 304 = 534

Conclusion

Patentee is entitled to PTA of five hundred thirty-three (533) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: 809 + 28 + 0 - 0 - 304 = 533 days.

Art Unit: OPET

Patentee has **two (2) months** from the date of the Office's redetermination of patent term adjustment to request reconsideration of the patent term adjustment if patentee continues to disagree with this determination (no petition fee). This two month period is extendible under 37 CFR 1.136(a). The new/renewed request for reconsideration may be filed without any additional fee. However, patentee who responds more than two months after the mail date of the redetermination is required to pay the extension of time fee. After the period of time to respond has expired, the Office will *sua sponte* issue a certificate of correction adjusting the PTA to five hundred thirty-three (533) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

/Nancy Johnson/

Nancy Johnson
Attorney Advisor
Office of Petitions

Enclosures: Adjusted PTA calculation
DRAFT Certificate of Correction

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12/387,576 Method for reducing performance variability of multi-layer filters MCA-872/H

Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Fees	Published Documents	Address & Attorney Agent	Supplemental Content	Assignments	Display Preferences
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Patent Term Adjustment

Filing or 371(c) Date:	05-05-2009	Overlapping Days Between {A and B} or {A and C}:	0
Issue Date of Patent:	05-27-2014	Non-Overlapping USPTO Delays:	809
A Delays:	809	PTO Manual Adjustments:	28
B Delays:	0	Applicant Delays:	304
C Delays:	0	Total PTA Adjustments:	533

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
84	05-01-2015	Adjustment of PTA Calculation by PTO	28		0
84	05-01-2015	Adjustment of PTA Calculation by PTO	28		0
80.5	01-23-2012	PTA 36 Months			0.5
80	05-27-2014	Patent Issue Date Used in PTA Calculation			0
79	04-24-2014	Export to Final Data Capture			0
78	04-23-2014	Dispatch to FDC			0
77	04-23-2014	Application Is Considered Ready for Issue			0
76	04-10-2014	Issue Fee Payment Verified			0
75	04-10-2014	Issue Fee Payment Received			0
74	03-26-2014	Printer Rush- No mailing			0
73	03-26-2014	Mail Miscellaneous Communication to Applicant		63	68
72	03-24-2014	Office Action Review			0
71	03-20-2014	Miscellaneous Communication to Applicant - No Action Count			0
70	03-20-2014	Information Disclosure Statement considered			0
69	03-18-2014	Pubs Case Remand to TC			0
68	01-23-2014	Information Disclosure Statement (IDS) Filed			0
67	02-25-2014	Finished Initial Data Capture			0
66	01-23-2014	Information Disclosure Statement (IDS) Filed			0
65	01-17-2014	Export to Initial Data Capture			0
64	01-16-2014	Add FAOM 1.25 Count			0
63	01-16-2014	Subtract FAOM 1.00 Count			0
62	01-16-2014	Mail Notice of Allowance	602		48
61	01-15-2014	Office Action Review			0
60	01-15-2014	Issue Revision Completed			0
59	01-15-2014	Document Verification			0
58	01-15-2014	Notice of Allowance Data Verification Completed			0
57	01-15-2014	Case Docketed to Examiner in GAU			0
56	01-15-2014	Allowability Notice			0
55	01-24-2012	Information Disclosure Statement considered			0
54	04-30-2012	Information Disclosure Statement considered			0
53	04-30-2012	Electronic Information Disclosure Statement		97	48
52	04-30-2012	Information Disclosure Statement (IDS) Filed			0
51	01-24-2012	Electronic Information Disclosure Statement			0
50	01-27-2012	Date Forwarded to Examiner			0
49	01-24-2012	Amendment Submitted/Entered with Filing of CPA/RCE			0
48	01-24-2012	Request for Continued Examination (RCE)		60	43
47	01-27-2012	Disposal for a RCE / CPA / R129			0
46	01-24-2012	Request for Extension of Time - Granted			0
45	01-24-2012	Information Disclosure Statement (IDS) Filed			0
44	01-24-2012	Workflow - Request for RCE - Begin			0
43	08-25-2011	Mail Final Rejection (PTOL - 326)			0
42	08-24-2011	Office Action Review			0
41	08-24-2011	Final Rejection			0
40	04-06-2011	Information Disclosure Statement considered			0
39	04-11-2011	Information Disclosure Statement considered			0
38	08-07-2011	Date Forwarded to Examiner			0

37	07-21-2011	Response after Non-Final Action	84	31
36	07-21-2011	Request for Extension of Time - Granted		0
35	04-11-2011	Electronic Information Disclosure Statement		0
34	04-11-2011	Information Disclosure Statement (IDS) Filed		0
33	04-06-2011	Information Disclosure Statement (IDS) Filed		0
32	04-06-2011	Electronic Information Disclosure Statement		0
31	01-28-2011	Mail Non-Final Rejection	207	0.5
30	01-27-2011	Non-Final Rejection		0
29	07-10-2009	Information Disclosure Statement considered		0
28	09-24-2009	Information Disclosure Statement considered		0
23	10-20-2010	Case Docketed to Examiner in GAU		0
22	03-11-2010	Case Docketed to Examiner in GAU		0
21	07-20-2009	New or Additional Drawing Filed		0
20	07-10-2009	Reference capture on IDS		0
19	07-10-2009	Information Disclosure Statement (IDS) Filed		0
18	11-12-2009	PG-Pub Issue Notification		0
17	09-24-2009	Reference capture on IDS		0
16	09-24-2009	Information Disclosure Statement (IDS) Filed		0
15	09-24-2009	Information Disclosure Statement (IDS) Filed		0
14	08-19-2009	Application Dispatched from OIPE		0
13	07-30-2009	Change in Power of Attorney (May Include Associate POA)		0
12	07-30-2009	Sent to Classification Contractor		0
11	07-30-2009	Filing Receipt - Updated		0
10	07-20-2009	Additional Application Filing Fees		0
9	07-20-2009	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic		0
8	07-20-2009	Applicant has submitted new drawings to correct Corrected Papers problems		0
7	07-20-2009	Applicants have given acceptable permission for participating foreign		0
6	07-10-2009	Information Disclosure Statement (IDS) Filed		0
5	05-22-2009	Filing Receipt		0
4	05-22-2009	Notice Mailed--Application Incomplete--Filing Date Assigned		0
3	05-12-2009	Cleared by OIPE CSR		0
2	05-12-2009	IFW Scan & PACR Auto Security Review		0
1	05-06-2009	Initial Exam Team nn		0
0.5	05-05-2009	Filing date		0

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Office of Petitions: Routing Sheet



Application No. 12/387,576

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

Application No.

12387576



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:

JOHNSON, NANCY

Count (1) - Palm Credit

12/387,576

Decision:

DISMISSED

FINANCE WORK NEEDED

Select Check Box for YES



Decision Type:

547 - PTA Recalculation - Novartis Decision (2014)



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: 5/4/2015

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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 8,733,556
DATED : May 27, 2014
INVENTOR(S) : Giglia et al.

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 505 days.

Delete the phrase “by 505 days” and insert – by 533 days--

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Sal Giglia
Serial No. : 12/387,576
Filed : May 5, 2009
For : Method for Reducing Performance
Variability of Multi-Layer Filters
Examiner : Menon, Krishnan S
Art Unit : 1777
Confirmation No. : 3919
Customer No. : 42754
Attorney Docket No. : MCA-972/1

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

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Sir:

The applicant respectfully requests reconsideration of the patent term adjustment for the above-identified application. This patent is not subject to a terminal disclaimer.

The patent term adjustment indicated on the Notice of Allowance is 665 days. The applicant agrees that this total of 665 days was correct. However, the patent term adjustment indicated on the Issue Notification is 505 days. The applicant believes that this term should be 534 days, as explained below. This request is filed pursuant to Rule §1.705(d).

The United States Patent Office calculated the delay associated with 35 U.S.C §154(b)(1)(B) as beginning on the filing date and ending on the date that a Request for Continued Examination (RCE) was filed. In this application, an RCE was filed on January 24, 2012, which was less than 3 years after the filing date of the application.

Based on this, the delay associated with 35 U.S.C §154(b)(1)(B) was computed to be 0 days, as reflected in PAIR.

However, as decided in *Novartis AG v. Lee*, No. 2013-1160 and 2013-1179 (Fed. Cir. Jan. 15, 2014) and *Exelixis, Inc. v. Lee*, 2013-1175 (Fed. Cir. Jan. 15, 2014), the period consumed by a Request for Continued Examination ends when a Notice of Allowance is mailed. Specifically, as stated in *Novartis*:

"The better reading of the language is that the patent term adjustment time 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. Such a reading ensures that applicants recover for any "delay[s] due to the failure of the [PTO]," without allowing the applicant to recover for "any time consumed by continued examination," as the statute requires".

Thus, using this methodology, the time consumed between the mailing of the Notice of Allowance on January 16, 2014 and the issuance of the patent on May 27, 2014 should be included as part of 35 USC § 154(b)(1)(B)(i) delay. This additional period of time is believed to be 131 days. When this time is added to the time defined between the filing of the application (May 5, 2009) and the filing of the RCE (January 24, 2012), the total time is now greater than 3 years.

The Patent Office's erroneous interpretation of 35 U.S.C. §154(b)(1)(B) incorrectly decreased the patent term adjustment for this application by 29 days.

The applicant respectfully requests reconsideration of the patent term adjustment in view of the aforementioned.

Respectfully submitted,

/Robert Frame/

Robert Frame

Reg. No. 54,104

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