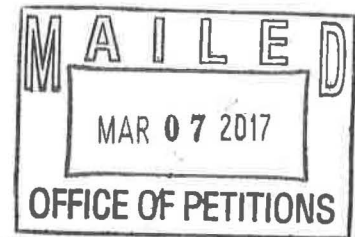




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In re Patent No. 9,369,742 :
Bengi Karacali-Akyamac : ON
Issue Date: June 14, 2016 : PATENT TERM ADJUSTMENT
Application No. 13/706,383 :
Filed: December 6, 2012 :
Attorney Docket No. :
512113-US-NP/AVA051PA :

This is a response to patentee's "PETITION REQUESTING RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed June 14, 2016, requesting that the Office adjust the patent term adjustment from 620 days to 689 days. The Office has reviewed the calculations and determined that the patent term adjustment of 620 days is correct.

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

On June 14, 2016, this patent issued with a patent term adjustment determination of 620 days. On June 14, 2016, patentee timely filed this "PETITION REQUESTING RECONSIDERATION OF PATENT TERM ADJUSTMENT" seeking an adjustment of the determination to 689 days.

Decision

Patentee does not dispute the Office's calculation of "A" delay of 498 days, "B" delay of 191 days, "C" delay of 0 days, or overlap of 0 day. At issue is the period of applicant delay.

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ON APPLICANT DELAY

Patentee disputes the reduction of 69 days attributed to the filing of an application data sheet filed April 7, 2016 after the mailing of the notice of allowance on February 16, 2016. Patentee contends that the failure to file a properly signed ADS does not constitute a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 CFR 1.704. Patentee contends that a failure to submit a properly signed ADS is not an applicant delay, as an unsigned ADS, wherein the rest of the ADS is completed, should not impact the patent issuance process as the originally filed ADS had all the information needed to prepare for and print the patent. Further, patentee submits that upon receiving a communication from the Office regarding the need to file a properly signed ADS, mailed March 31, 2016, the applicant timely and reasonably filed a properly signed ADS on April 7, 2016, such that the applicant believes that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application.

Patentee's arguments have been considered, but not found persuasive i) that the filing of a properly signed ADS on April 7, 2016 does not constitute "a failure to engage in reasonable efforts" within the meaning of 37 CFR 1.704(c)(10) or ii) that the period of reduction of 69 days is not warranted.

Patentee implicitly acknowledges that the submission of an "other paper" after an application is allowed may cause substantial interference with the patent issue process, and thus, properly may be considered a failure to engage in reasonable efforts to conclude processing or examination. In fact, all papers filed after the mailing of a notice of allowance give rise to a period of reduction for applicant delay, unless the Office has determined that the filing of the paper does not substantially interfere with the patent issue process. Applicants have been advised that the Office has determined that the submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) power of attorney; (3) power to inspect; (4) change of address; (5) change of status (micro/small/not small entity status); (6) a

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response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" (7) status letters; (8) requests for a refund; (9) an inventor's oath or declaration; (10) an information disclosure statement with a statement in compliance with 37 CFR 1.704(d); (11) the resubmission by applicant of unlocatable paper(s) previously filed in the application (37 CFR 1.251); (12) a request for acknowledgment of an information disclosure statement in compliance with 37 CFR 1.97 and 1.98, provided that the applicant had requested that the examiner acknowledge the information disclosure statement prior to the notice of allowance, or the request for acknowledgement was applicant's first opportunity to request that the examiner acknowledge the information disclosure statement; (13) comments on the substance of an interview where the applicant-initiated interview resulted in a notice of allowance; and (14) letters related to government interests (e.g., those between NASA and the Office). Patentee does not address that the submission of an "unsigned ADS, wherein the rest of the ADS is completed" is not among the enumerated papers the Office has advised applicants will not be considered a failure to engage in reasonable efforts to conclude processing or examination.

Rather, patentee maintains that the filing for the first time of a properly signed ADS after the mailing of a notice of allowance is not a paper that substantially interferes with the patent issue process. Patentee argues that the filing of the completed ADS should not impact the patent issuance process as the originally filed ADS had all the information needed to prepare for and print the patent. However, in this argument, patentee discounts the difference between an unsigned and a signed ADS. The rules require that an ADS be properly signed. An unsigned ADS merely acts as a transmittal letter. See 37 CFR 1.76(e). Thus, as to the information provided in an ADS, the unsigned ADS is not effective to use for all information therein to prepare for and print the patent. The requirement for a signed ADS is appropriate, and as the patent issuance process is delayed for acting on the submission of the signed ADS after the mailing of the notice of allowance, such submission is properly considered "a failure to engage in reasonable efforts to conclude processing or examination of the application."

Furthermore, entry of a period of reduction of 69 days is warranted. 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

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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.

As no response was mailed to the signed ADS filed on April 7, 2016, the period of reduction was properly calculated as 69 days, counting the number of days beginning on the date of filing of the ADS (April 7, 2016) and ending on the date of issuance of the patent (June 14, 2016).

In view thereof, the period of reduction of 69 days is retained.

Total applicant delay is 69 days.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

498 + 191 + 0 - 0 - 69 = 620

Patentee's Calculation

498 + 191 + 0 - 0 - 0 = 689

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Conclusion

Patentee is entitled to PTA of six hundred twenty (620) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows:
 $498 + 191 + 0 - 0 - 69 = 620$ days.

As the patent issued with a patent term adjustment of 620 days, no further action will be undertaken in this matter.

Telephone inquiries specific to this decision should be directed to Attorney Advisor Nancy Johnson at (571) 272-3219.

/ROBERT CLARKE/
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for Patent Examination Policy - USPTO