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In re Application of
Wolcott

Application No. 13/155,464

Filed: June 8, 2011

Patent No. 8,971,394

Issue Date: March 3, 2015

Attorney Docket No.: 007412.01374

Title: INDUCING RESPONSE

SIGNATURES IN A COMMUNICATION

NETWORK

:
: DECISION ON REQUEST
: FOR RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: and DECISION ON PETITION
: PURSUANT TO
: 37 C.F.R. § 1.183
:
:

This is a response to applicant’s “second request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(b)” and “petition under 37 C.F.R. § 1.183,” both filed on July 28, 2016, requesting that the Office adjust the patent term adjustment from four hundred and sixty-four (464) days to four hundred and ninety-seven (497) days.

The petition pursuant to 37 C.F.R. § 1.183 is **GRANTED**. Receipt of the \$400 petition fee is acknowledged. On February 26, 2014, an IDS was filed with a statement that has language which differs from the meaning of the language set forth in 37 C.F.R. §1.704(d). On July 28, 2016, a 37 C.F.R. §1.704(d) statement was submitted to the Office for this IDS. The petition pursuant to 37 C.F.R. § 1.183 is granted to the extent that the 37 C.F.R. §1.704(d) statement submitted concurrently with this petition on July 28, 2016 will be accepted, despite the fact that it was not submitted contemporaneously with the corresponding IDS.

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 four hundred and sixty-four (464) days.

This is the Director’s decision on the applicant’s request for reconsideration under 35 USC 154(b)(3)(B)(ii). Any appeal from this decision is pursuant to 35 U.S.C. § 154(b)(4)(A).

Relevant Procedural History

On March 3, 2015, the Office determined that applicant was entitled to 464 days of PTA.

Art Unit: OPET

On May 4, 2015, Patentee filed a request for redetermination of patent term adjustment requesting a PTA of 497 days, pursuant to 37 C.F.R. § 1.705(b), along with the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). It is noted that May 3, 2015 fell on a Sunday.

On June 27, 2016, the USPTO mailed a “request for information patent term adjustment,” explaining the statement provided on February 26, 2014 contains language which differs from the meaning of the language set forth in 37 C.F.R. § 1.704(d), and providing Patentee with an opportunity to file both a petition pursuant to 37 C.F.R. § 1.183 and a statement containing the language set forth in 37 C.F.R. § 1.704(d).

Decision

Upon review, the USPTO finds that Patentee is entitled to four hundred and sixty-four (464) days of PTA.

Patentee and the Office are in agreement regarding the amount of “A” delay under 35 U.S.C. § 154(b)(1)(A), the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B), and the amount of “C” delay under 35 U.S.C. § 154(b)(1)(C).

Patentee and the Office *appear to be* in agreement regarding the amount of overlap under 35 U.S.C. § 154(b)(2)(A).

The sole issue in dispute *appears to be* the amount of reduction of PTA under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704.

“A” Delay

The Patentee and Office agree are 410 days of “A” delay. The periods of “A” delay are:

- (1) 363 days under 37 C.F.R. § 1.703(a)(1) beginning on August 9, 2012 (the day after the date that is fourteen months after the day the application was filed and ending on August 6, 2013 (the date the first Office action was mailed);
- (2) 19 days under 37 C.F.R. § 1.703(a)(2) beginning on May 25, 2014 (the day after the date that is four months after the date a reply under § 1.111 was filed) and ending on June 12, 2014 (the date of mailing of an action under 35 U.S.C. 132).

“B” Delay

The Patentee and Office agree that there are 242 days of “B” delay.

Art Unit: OPET

The *Novartis* decision includes “instructions” for calculating the period of “B” delay. Specifically, the decision states,

The better reading of the language is that the patent term adjustment time [for “B” delay] 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.

The length of time between application and issuance is 1365 days, which is the number of days beginning on the filing date of the application (June 8, 2011) and ending on the date the patent issued (March 3, 2015).

The time consumed by continued examination is 26 days. The time consumed by continued examination includes the 26-day period beginning on the filing date of the RCE (September 12, 2014) and ending on the mailing date of the notice of allowance (October 7, 2014).

The number of days beginning on the filing date of application (June 8, 2011) and ending on the date three years after the filing date of the application (June 8, 2014) is 1097 days.

The result of subtracting the time consumed by continued examination (26 days) from the length of time between the application’s filing date and issuance (1365 days) is 1339 days, which exceeds three years (1097 days) by 242 days. Therefore, the period of “B” delay is 242 days.

“C” Delay

The Patentee and the Office *appear to agree* that the amount of “C” delay under 35 U.S.C. § 154(b)(1)(C) is zero days.

Overlap

The Patentee and the Office agree that the amount of “C” delay under 35 U.S.C. § 154(b)(2)(A) is four days.

In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the “A” and “B” delays. Under this interpretation, the Office finds that the overlapping period of “A” delay and “B” delay is four days.

The Office finds that the periods of “B” delay are:

Art Unit: OPET

- (1) beginning on June 9, 2014 (date that is the day after the three year anniversary of the filing date of the application and ending on September 11, 2014 (date that is the day before the RCE was filed) for a period of 95 days; and
- (2) beginning on October 8, 2014 (date that is the day after the notice of allowance was mailed) and ending on March 3, 2015 (date of patent issuance) for a period of 147 days.

The Office finds that the overlapping period of "A" delay is the terminal four days of the 19-day period of "A" delay pursuant to 37 C.F.R. § 1.703(a)(2) which began on May 25, 2014 (the day after the date that is four months after the date a reply under §1.111 was filed) and ended on June 12, 2014 (the date of mailing of an action under 35 U.S.C. 132).

The total number of overlapping days of Office delay is four days.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

The Office finds that, under 37 C.F.R. § 1.704, the amount of PTA should be reduced by 348 days. The Office has determined that the Patentee failed to engage in reasonable efforts to conclude processing or examination of its application during the following periods.

- (1) A 79-day period pursuant to 37 C.F.R. § 1.704(b) from November 7, 2013 until January 24, 2014 because the Office mailed a non-final Office action on August 6, 2013. Accordingly, the three-month response date was November 6, 2013. However, the Patentee did not file its amendments to the claims and remarks until January 24, 2014.
- (2) A 33-day reduction pursuant to 37 C.F.R. § 1.704(c)(8) from January 25, 2014 until February 26, 2014 because the Patentee filed an IDS document on February 26, 2014 after Patentee had filed a reply on January 24, 2014. *See Gilead Sciences Inc. v. Lee*. The Patentee submitted a statement with the IDS which contains language that is not sufficient to meet the requirements of 37 C.F.R. § 1.704(d).

Along with the submission of July 28, 2016, Patentee submitted a 37 C.F.R. §1.704(d) statement. The certification statement submitted on July 28, 2016 has been reviewed, and **the Office finds this certification statement** contains language that is **not sufficient to meet the requirements of 37 C.F.R. § 1.704(d)**. A discussion follows.

37 C.F.R. § 1.704(d) sets forth, *in toto*:

- (d)(1) A paper containing only an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section, and a request for

Art Unit: OPET

continued examination in compliance with §1.114 with no submission other than an information disclosure statement in compliance with §§1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(12) of this section, if the paper or request for continued examination is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the information disclosure statement.

The certification submitted on July 28, 2016 that is associated with the IDS document filed on February 26, 2014 contains the following statement:

The undersigned certifies that the information contained in the information disclosure statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and the communication received in related U.S. Appl. Ser. No. 12/917,001 (available on PAIR) mailed February 5, 2014, was not received by an individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. See 37 C.F.R. § 1.704(d).¹

Footnote language: *See* 76 Fed Reg. 74700-01; 76 Fed. Reg. 18990-01; Comments on Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements (2011) (referencing the scope of 37 C.F.R. § 1.704(d) to include prompt citation of reference(s) cited from the Office in a related application, which will not result in a reduction of patent term adjustment).

This statement fails to indicate that each item of information contained in the IDS was first cited in any communication from the Office or in any communication issued by a patent office in a counterpart foreign or international application, and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of the IDS. The usage of the word “an” instead of “any” in the certification does not rule out the possibility that that at least one individual designated in 37 C.F.R. § 1.56(c) did in fact receive the communication more than thirty days prior to the filing of the IDS. The reference contained in the IDS consists of one patent that

Art Unit: OPET

issued in 2005. Therefore, it is entirely possible that at least one individual designated in 37 C.F.R. § 1.56(c) received the reference (a patent which issued in 2005) more than thirty days prior to the filing of the IDS in 2014.

Therefore, **the statement has a meaning which differs from the language of 37 C.F.R.**

§ 1.704(d)(i). It follows that the submission of each of the IDS document is considered a failure to engage in reasonable efforts to conclude prosecution under 37 C.F.R. § 1.704(c)(8), and the aforementioned 33-day reduction pursuant to 37 C.F.R. § 1.704(c)(8) is warranted.

- (4) A 44-day period pursuant to 37 C.F.R. § 1.704(c)(10)(i) from December 23, 2014 until February 4, 2015 because the Office mailed a notice of allowance on October 7, 2014, an IDS was filed on December 23, 2014, an amendment was filed on January 7, 2015, and the Office mailed both a miscellaneous communication which indicates the aforementioned IDS has been considered and a “response to rule 312 communication” on February 4, 2015.¹

Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - overlap - applicant delay = X.

USPTO’s Calculation:

$$382 (363 + 19) + 242 (1365 - 26 - 1097) + 0 - 4 - 156 (79 + 33 + 44) = 464$$

Patentee’s Calculation *appears to be:*

$$382 (363 + 19) + 242 (1365 - 26 - 1097) + 0 - 4 - 123 (79 + 44) = 497$$

Conclusion

Patentee is entitled to PTA of four hundred and sixty-four (464) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $382 + 242 + 0 - 4 - 156 = 464$ days.

In view thereof, no adjustment to the patent term will be made. It follows that a certificate of correction is not required.

¹ It is noted the period of reduction associated with the filing of the Rule 312 amendment begins on January 7, 2015, ends on February 4, 2015, and totals 29 days. However, since the 29-day period falls within the 44-day period, a single reduction of 44 days is warranted.

Art Unit: OPET

Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.²

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² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.