



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DW sep-10

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

MAILED
SEP 16 2010
OFFICE OF PETITIONS

In re Patent No. 7,579,099 : FINAL AGENCY DECISION
Lee et al. : ON
Issue Date: 08/25/2009 : REQUEST FOR RECONSIDERATION
Application Number: 11/514,251 : OF
Filed: 09/01/2006 : DECISION ON APPLICATION
Attorney Docket Number: : FOR
SAMSDI.000GEN : PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION REQUESTING RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(D)" filed on April 14, 2010, requesting reconsideration of the decision of April 6, 2010, and requesting that the patent term adjustment determination under 35 U.S.C. § 154(b) be increased by 120 days, from 85 days to 205 days.

The request for reconsideration of the decision of April 6, 2010, is granted to the extent that the decision of April 6, 2010, has been reconsidered; however, the request for reconsideration is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of 85 days indicated in the decision of April 6, 2010. This decision is a final agency action within the meaning of 5 U.S.C. § 704 and for purposes of seeking judicial review. See MPEP 1002.02.

BACKGROUND

On September 18, 2008, a notice of allowance was mailed in the subject application.

On September 26, 2008, an amendment under 37 CFR 1.312 was filed.

On October 1, 2008, the issue fee was paid.

On July 23, 2009, the Office mailed a letter in response to the amendment under 37 CFR 1.312.

On August 25, 2009, the above-identified application matured into U.S. Patent No. 7,579,099. The Patent issued with a revised Patent Term Adjustment of 85 days.

On September 1, 2009, the initial request for reconsideration was filed. On April 6, 2010, the request for reconsideration was dismissed.

On April 14, 2010, the subject request was filed.

Patentees again disputes the reduction of 120 days under 37 CFR 1.704(c)(10) in connection with the amendment filed after the mailing of the notice of allowance.

In particular, patentees state that the amendment was filed to correct typographical errors in the claims as set forth in the Examiner's Amendment mailed on September 18, 2008, and, therefore, should not be considered to constitute a "failure to engage."

Petitioners further state, in pertinent part:

MPEP 2732's basic statement is inconsistent with other directions from the PTO. First, the Examiner specifically required any corrections to the Examiner's Amendment to be submitted as a 312 Amendment (see beginning of the Examiner's Amendment, Attachment 2). Second, a comment does not lead to entry of an amendment to claims that are in error, but is merely placed in the file for the Examiner to use as she sees fit. Third, applicants were correcting an unauthorized amendment by the Examiner as the language in the Examiner's Amendment was at odds with the authorized amendment (compare claims 8 and 10 in Attachments 1 and 2). Fourth, in filing a Rule 705(d) Request for Reconsideration, MPEP 2734 asks for an affirmative statement that there are no circumstances constituting Applicant's failure to engage in reasonable efforts to conclude processing or examination. In the Rule 705(d) request, Applicants made such an affirmation, and the undisputed facts support that affirmation. That affirmation should rebut any presumption of Applicant's delay that would be covered by 37 CFR 1.704(c)(10). Lastly, as cited by Petitions Attorney Wood, MPEP 2732

lists reasons that are not considered a failure to engage in reasonable efforts to conclude processing or examination of an application. Reason (6) states "a 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[.]" This situation is exactly reason (6).

(emphasis in original)

STATUTE, REGULATIONS AND POLICY

35 U.S.C. 154(b)(2)(C) states:

REDUCTION OF PERIOD OF ADJUSTMENT.

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

...

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

37 CFR 1.704(c)(10) states:

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: Submission of an amendment under § 1.312 or other paper 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: (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.

MPEP 2732 states, in pertinent part:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). 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 (small/not small entity status); (6) a 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;" and (7) letters related to government interests (e.g., those between NASA and the Office). Papers that **will** be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations. 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 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.

(emphasis in original)

OPINION

Petitioners' argument that the filing of the amendment after the mailing of the notice of allowance, filed on September 26, 2008, should not be considered a failure to engage in reasonable efforts to conclude processing or examination, is not well taken.

At the outset, it is undisputed that petitioners filed an amendment or other paper after the mailing of the notice of allowance, and that the Office did not mail a reply to the amendment or other paper within 120 days of the date the amendment or other papers was filed.

With regard to petitioners' first contention, that the examiner "required" corrections to be submitted by amendment under 37 CFR 1.312, a careful reading of the regulations, MPEP, and the examiner's amendment reveals that petitioners' argument is not persuasive. At the outset, it is noted that the Examiner's Amendment mailed on September 18, 2008, states that "[s]hould the changes and/or additions be unacceptable to applicant, an amendment **may** be filed as provided by 37 CFR 1.312."¹ Contrary to petitioner's assertion, there was no requirement from the examiner that an amendment under 37 CFR 1.312 be filed. Rather, as noted on Page 5 of the Examiner's Amendment, "[a]ny comments considered necessary by applicant must be submitted no later than the payment of the issue fee, and to avoid processing delays, should preferably accompany the issue fee." As such, the proposed corrections could have been filed as a comment, or request for correction of an error or omission in the "Notice of Allowance" or "Notice of Allowability", as specified in MPEP 2732, *supra*, to avoid a reduction in patent term adjustment.

With regard to petitioners' argument that a comment does not lead to entry of an amendment, and, thus, that the filing of an amendment under 37 CFR 1.312 was necessary in order to ensure the corrections were entered, patentee's argument is also

¹ See Examiner's Amendment mailed September 18, 2008, page 2 of 6.

unpersuasive.² As noted in MPEP 2732, *supra*, a request for correction of an error or omission in the "Notice of Allowance" or "Notice of Allowability", may be filed to correct an error yet avoid a reduction in patent term adjustment for failure to engage in reasonable efforts to conclude processing or examination. Petitioners have not shown that the error could not have been adequately addressed by a means other than filing an amendment under 37 CFR 1.312.

Turning to petitioners' assertion that there were no circumstances constituting Applicants' failure to engage in reasonable efforts to conclude processing or examination, petitioners are reminded that MPEP 2732 further states:

37 CFR 1.704 implements the provisions of 35 U.S.C. 154(b)(2)(C) which provides that the period of patent term adjustment under 35 U.S.C. 154(b)(1) "shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application," and specifies certain circumstances as constituting a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Further, 35 U.S.C. 154(b)(2)(C)(iii) gives the Office the authority to prescribe regulations establishing circumstances that constitute "a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application." 35 U.S.C. 154(b)(2)(C) does not require the applicant's action or inaction (that amounts to a failure to engage in reasonable efforts to conclude prosecution of the application) to have caused or contributed to patent term adjustment for the period of adjustment to be reduced due to such action or inaction.

As such, whether or not, in fact, the filing of a paper of the type identified as a "failure to engage in reasonable efforts to conclude processing or examination of an application" actually results in a delay, or whether petitioners believe the paper did, or did not, result in a delay, is not at issue. MPEP 2732 states only that the filing of a paper which is of a type specified as a paper constituting a "failure to engage in reasonable efforts to conclude processing or examination of an application" if said

² Furthermore, it should be noted that amendments filed after allowance under 37 CFR 1.312 are not entered as a matter of right and must be approved by the examiner.

type of paper has been determined by the Director to constitute a "failure to engage in reasonable efforts to conclude processing or examination of an application". Simply put, the question of whether or not the Rule 1.312 amendment filed on September 26, 2008 delayed processing or examination is not relevant to the determination that the filing of the Rule 1.312 amendment requires a reduction in patent term adjustment for applicant delay.

Lastly, petitioners argue that the amendment was essentially a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability" and should be treated as such. While the relief ultimately sought may have been correction of an error or omission in the Notice of Allowance or Notice of Allowability, the showing of record is that the paper filed on September 26, 2008, was filed and processed as an amendment after the mailing of the notice of allowance, not a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability." In this regard, the paper is titled "AMENDMENT UNDER 37 CFR 1.312," and requests that Claims 8 and 10 be amended. As such, the reduction for applicant delay under 37 CFR 1.704(c)(10) is warranted and will not be removed.

In summary, petitioners assert that they had no choice but to file a Rule 1.312 amendment to correct the errors in the Examiner's Amendment accompanying the notice of allowance, and thus the Rule 1.312 should not be considered a "failure to engage in reasonable efforts to conclude processing or examination." Petitioners' assertion is without merit, however, as patentees could have filed a request for correction of an error or omission in the "Notice of Allowance" or "Notice of Allowability", which is not considered a "failure to engage in reasonable efforts to conclude processing or examination." As such, the reduction for applicant delay occurred as a result of petitioners' action in filing an amendment, rather than because of an error on the part of the Office. The request for reconsideration is therefore denied.

CONCLUSION

Accordingly, the decision on application for patent term adjustment has been reconsidered and the request for additional patent term is DENIED.

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.



Anthony Knight
Director, Office of Petitions