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OFFICE OF PETITIONS

In re Application of : DECISION ON APPLICATION
HUFFORD et al. : FOR PATENT TERM ADJUSTMENT
Application No. 09/825,533 :
Filed: 04/02/2001 :
Atty Docket No. 31886-705.201 :

This is a decision on the "RESPONSE TO DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R § 1.705(D) AND REQUEST FOR RECONSIDERATION" filed August 12, 2011, which is being treated as a petition under 37 CFR 1.705(b). Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 915 days to 1276 days.

The request reconsideration of the patent term adjustment to correct the initial determination of patent term adjustment under 35 U.S.C. 154(b) from 915 days to 1276 days is **DENIED**.

RELEVANT BACKGROUND

The United States Patent and Trademark Office (USPTO) entered an Office action under 35 U.S.C. § 132(a) (a final rejection) on September 8, 2006. Applicants filed a reply to the final Office action in the form of an amendment on November 8, 2006, which failed to place the application in condition for allowance. On January 5, 2007, applicants filed a reply in the form of an RCE and a request for an extension of time for response within the first month (and fee). The USPTO mailed a Notice of Non-Compliant Amendment on April 3, 2007, stating that the amendment filed on November 8, 2006, was considered non-compliant. Applicants filed a corrected reply in the form of a compliant amendment on April 17, 2007.

The USPTO entered an Office action under 35 U.S.C. § 132(a) (a restriction requirement) on July 20, 2007. The USPTO entered a subsequent Office action under 35 U.S.C. § 132(a) (a non-final Office action) on May 20, 2008. The Office action of May 20, 2008 stated: "Per SPE James Trammell, pursuant to the interview held on 01/18/08 between Ms. Ester Kepplinger (Applicant's representative) and Mr. Trammell, and recorded in the Interview Summary posted on 01/24/2008, the Requirement for Election/Restriction mailed 07/20/2007 is vacated." A reply to the Office action of May 20, 2008, was filed on August 18, 2008.

Additionally, the USPTO entered an Office action under 35 U.S.C. § 132(a) (a final rejection) on April 29, 2010. Applicants filed a reply to the final Office action of April 29, 2010, in the form of an amendment and Request for Continued Examination on September 24, 2010. The USPTO entered an Office action under 35 U.S.C. § 132(a) (a final rejection) on November 26, 2010. The USPTO mailed a letter on April 8, 2011, stating: "The communication serves to withdrawal the finality of the Office action mailed 11/26/2010. The application will be returned to the examiner for consideration of the claims and response filed on 9/24/2010. Applicant is not required to respond to this action."

The USPTO entered a notice of allowance on May 19, 2011, which included a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 915 days.[1] On June 21, 2011, applicants timely submitted an application for patent term adjustment under 37 CFR 1.704(b),[2] arguing that a period of adjustment of 246 days for Office delay should have been accorded pursuant to 37 CFR 1.702(a)(2) for the Office's failure to respond to the reply of April 17, 2007, within four months of its filing. Additionally, applicants asserted that a period of adjustment of 115 days for Office delay should have been accorded pursuant to 37 CFR 1.702(a)(2) for the Office's failure to respond to the reply of September

[1] The initial determination of patent term adjustment of 915 days included 1271 days of Office delay and 356 days of applicant delay.

[2] The Office records show that the issue fee and publication fee were received on August 18, 2011.

24, 2010, within four months of its filing. The matter was dismissed by a decision entered July 19, 2011.

By the instant petition, applicants again assert that they are entitled to an additional patent term adjustment of 246 days for Office delay under 37 CFR 1.702(a)(2). In summary, applicants asserts that the Office action entered July 20, 2007, failed to meet the requirements of 35 U.S.C. § 132(a) and was vacated by a Supervisory Patent Examiner. Further, applicants indicate that the Restriction Requirement of July 20, 2007, was replaced by a non-final Office action entered May 20, 2008. Applicants contend that the period of adjustment to the patent term under 37 CFR 1.702(a)(2) and 1.703(a)(2) is properly calculated using the non-final Office action of May 20, 2008, rather than the Restriction Requirement of July 20, 2007. [3]

Additionally, applicants again argue that they are entitled to an additional patent term adjustment of 115 days for Office delay under 37 CFR 1.702(a)(2). In summary, applicants asserts that the Office action entered November 26, 2010, failed to meet the requirements of 35 U.S.C. § 132(a) and was withdrawn by a Supervisory Patent Examination. Further, applicants contend that the final Office action of November 26, 2010, was replaced by a notice of allowance entered May 19, 2011. Applicants contend that the period of adjustment to the patent term under 37 CFR 1.702(a)(2) and 1.703(a)(2) is properly calculated using the notice of allowance of May 19, 2011, rather than the final Office action of November 26, 2010. [4]

RELEVANT STATUTES

35 U.S.C. § 131 provides that:

> The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is

[3] The number of days beginning on the beginning on the day after the date that is four months after the reply was filed, August 18, 2007, and ending on the date of the mailing of the non-final Office action, May 20, 2008, is 246 days.

[4] The number of days beginning on the day after the date that is four months after the reply was filed, January 25, 2011, and ending on the date of the mailing of the Notice of Allowance, May 19, 2011, is 115 days.

entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 132 provides that:

> (a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

35 U.S.C. § 133 provides that:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. § 154(b)(1)(A), provides, in relevant part:

> Subject to the limitations under [35 U.S.C. § 154(b)(2)], if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

> respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;
>
> the term of the patent shall be extended 1 day for each day after the end of this [four-month period] until [the response] is taken.

DECISION

Applicants argue that the Restriction Requirement mailed on July 20, 2007, was "vacated" and should be treated as not having been issued for purposes of determining whether the issuance of a patent was delayed due to the failure of the USPTO to respond to applicants' reply of April 17, 2007, within four months after the date on which the reply was filed. Additionally, applicants in essence assert that the final Office action mailed November 26, 2010, was "vacated" and should be treated as not having been issued for purposes of determining whether the issuance of a patent was delayed due to the failure of the USPTO to respond to applicants' reply of September 24, 2010, within four months after the date on which the reply was filed.

Applicants' arguments have been considered but are not persuasive.

The vacatur of an Office action sets aside or withdraws any rejection, objection or requirement in an Office action, as well as the requirement that the applicant timely reply to the Office action to avoid abandonment under 35 U.S.C. § 133. The vacatur of an Office action signifies that the Office action has been set aside, voided, or withdrawn as of the date of the vacating Office action or notice. The vacatur of an Office action, however, does **not** signify that the vacated Office action is void *ab initio* and is to be treated as if the USPTO had never issued the Office action. The patent examination process provided for in 35 U.S.C. §§ 131 and 132 contemplates that Office actions containing rejections, objections or requirements will be issued, and that the applicant will respond to these Office action, "with or without amendment." (35 U.S.C. § 132(a)). The mere fact that an examiner or other USPTO employee upon further reflection determines that an Office action, or that a rejection, objection or requirement in an Office action, is not

correct and must be removed does not warrant treating the Office action as void *ab initio* and as if the USPTO had never issued the Office action.

The USPTO appreciates that there may be situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action. However, these would be extremely rare situations, such as the issuance of an Office action or notice by an employee who does not have the authority to issue that type of Office action or notice, the issuance of an Office action or notice in the wrong application, or the issuance of an Office action or notice containing language not appropriate for inclusion in an official document. In essence, the situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action are the situations in which it is appropriate to expunge an Office action or notice from the USPTO's record of the application. That is simply **not** the case in this situation.

Pursuant to 35 U.S.C. § 154(b)(1)(A)(ii), patentees are entitled to day-to-day adjustment if the USPTO delays the issuance of a patent by failing to respond to a reply by the applicant within four months from the filing of the reply. The record of the above-identified application indisputably indicates that the USPTO entered an Office action under 35 U.S.C. § 132, specifically a Restriction Requirement, on July 20, 2007, within four months of the filing of a reply on April 17, 2007. The fact that the Office later set aside the Restriction Requirement of July 20, 2007, does not negate the fact that the Office responded within the meaning of 35 U.S.C. § 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2) on July 20, 2007, to the reply filed on April 17, 2007.

Similarly, the record undeniably shows that the USPTO entered an Office action under 35 U.S.C. § 132, specifically a final Office action, on November 26, 2010, within four months of the filing of a reply on September 24, 2010. The fact that the Office later set aside the final Office action of November 26, 2010, does not negate the fact that the Office responded within the meaning of 35 U.S.C. § 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2) on November 26, 2010, to the reply filed on September 24, 2010.

Unless expunged from the record (which is not warranted in this situation), for purposes of calculating patent term adjustment, the Office actions entered by the examiner on July 20, 2007, and November 26, 2010, were properly used to determine whether the USPTO delayed the issuance of a patent by failing to respond to the replies of April 17, 2007, and September 24, 2010, respectively, within four months from the filing of the replies under of 35 U.S.C. § 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2). *See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 *Fed. Reg.* 54366 (Sept. 18, 2000) (final rule).

CONCLUSION

For the above-stated reasons, a review of the petition and file wrapper of the above-identified application reveals a correction of the initial determination of patent term adjustment under 35 U.S.C. 154(b) to 1276 days is not merited. Therefore, the request reconsideration of the patent term adjustment to correct the initial determination of patent term adjustment under 35 U.S.C. 154(b) from 915 days to 1276 days is **denied.**

This decision may be viewed as final agency action. *See* MPEP § 1002.02(b).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Anthony Knight
Director
Office of Petitions