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DEC 13 2010

OFFICE OF PETITIONS

In re Patent No. 7,572,126	:	FINAL AGENCY DECISION
Bihua Liu	:	ON
Issue Date: 08/11/2009	:	REQUEST FOR RECONSIDERATION
Application Number: 10/634,526	:	OF
Filed: 08/05/2003	:	DECISION ON APPLICATION
Attorney Docket Number:	:	FOR
1365-US	:	PATENT TERM ADJUSTMENT

This is a decision on the "RESPONSE TO APRIL 30, 2010 DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed on May 28, 2010, requesting reconsideration of the decision of April 30, 2010, and requesting that the patent term adjustment determination under 35 U.S.C. § 154(b) be increased by 212 days, from 1229 days to 1441 days.

The request for reconsideration of the decision of April 30, 2010, is granted to the extent that the decision of April 30, 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 1229 days indicated in the decision of April 30, 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 June 17, 2005, a notice of allowance was mailed in the subject application.

On September 8, 2005, the issue fee was paid.

On June 20, 2007, a Notice of Withdrawal From Issue Under 37 CFR 1.313 was mailed, stating that the application had been withdrawn from issue after payment of the issue fee to permit reopening of prosecution.

On July 16, 2007, a non-final Office action was mailed, stating, that the indication of allowability of Claims 16-25 was withdrawn in view of newly discovered references.

On January 14, 2009, a notice of allowance was mailed.

On February 27, 2009, the issue fee was paid.

On August 11, 2009, the application issued as U.S. Patent No. 7,572,126.

On August 21, 2009, an application for patent term adjustment was filed.

On April 30, 2010, the application for patent term adjustment was granted-in-part.

On May 28, 2010, the subject request for reconsideration was filed.

Patentee asserts, in pertinent part,

> [T]he Office took more than twenty-one (21) months from the date the issue fee was paid (September 8, 2005) to issue a Notice of Withdrawal from Issue. According to the logic of the decision, the Office could have taken any amount of time to issue a Notice of Withdrawal from Issue without having to compensate Applicant with any patent term adjustment as long as the Notice is mailed by the date that is three years after the application filing date. This kind of delay is clearly a mistake of the Office, and is similar to the delay when the Office takes more than four months to issue an action after a reply under § 1.111 has been filed. Therefore, Applicant submits that a period of adjustment of patent term due to examination delay starts from the day after the date that is four months after the date on which the issue fee was paid (i.e. January 8, 2006) and ending on the date that is three years after the application filing date (August 5, 2006), totalling 212 days.

STATUTE, REGULATIONS AND POLICY

35 U.S.C. 154(b)(1)(A)(iv) states:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to – issue a patent within 4 months after the date on which the issue fee was paid under section 151 **and all outstanding requirements were satisfied**, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

37 CFR 1.702(a)(4) states:

> *Failure to take certain actions within specified time frames.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to: Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 **and all outstanding requirements were satisfied**.

37 CFR 1.703(a)(6) states:

> The period of adjustment under § 1.702(a) is the sum of the following periods: The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid **and all outstanding requirements were satisfied** and ending on the date a patent was issued.

MPEP 2731 states, in pertinent part:

> 37 CFR 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv) and specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued. The date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied.

> Note that the filing of a priority document (and processing fee) is not considered an outstanding requirement under 35 U.S.C. 154(b)(1)(A)(iv) and 37 CFR 1.703(a)(6) because if the priority document is not filed the patent simply issues without the priority claim (the application is not abandoned) and since no petition is required to add a priority claim after payment of the issue fee. **If prosecution in an application is reopened after allowance (see MPEP § 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP § 1308).**
>
> (emphasis added)

OPINION

Petitioner's argument that an additional period of adjustment for Office delay is due in connection with the withdrawal of the application from issue, and the subsequent allowance of the application, has been considered, but is not persuasive.

As noted in the *Federal Register*, Section 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv). Section 1.703(a)(6) specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued. The date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. **If prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308).**[1]

On September 8, 2005, the issue fee was paid. On June 20, 2007, however, a Notice of Withdrawal from Issue 37 CFR 1.313 was mailed, indicating that the application is withdrawn from issue to permit reopening of prosecution. On July 16, 2007, an Office action was mailed stating that the allowability of claims 16-25 is withdrawn in view of newly discovered references. As such,

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[1] See 65 Fed. Reg. 56366, at 56369 (Sep. 18, 2000).

the showing of record is that prior to issuance of the patent, the claims were found not to be allowable. Accordingly, the showing of record is that not all outstanding requirements were satisfied pursuant to 37 CFR 1.703(a)(6). Therefore, no adjustment is due in connection with the payment of the issue fee on September 8, 2005.

Pursuant to 35 U.S.C. 154(b)(1)(A)(iv), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the failure of the Office to issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied. The Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

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