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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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In re Patent No. 6,994,854 :
Betsou et al. :
Issue Date: 7 February, 2006 :
Application No. 09/907,951 : FINAL AGENCY DECISION
Filed: 19 July, 2001 : ON
For: PROTECTIVE EPITOPES OF : REQUEST FOR RECONSIDERATION
ADENYL CYCLASE-HAEMOLYSIN (AC- : OF
HYL), THEIR APPLICATION TO THE : DECISION ON APPLICATION
TREATMENT OR TO THE PREVENTION : FOR
OF BORDETELLA INFECTIONS : PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed on 28 July, 2006, requesting reconsideration of the decision of 30 May, 2006, and requesting that the patent term adjustment determination under 35 U.S.C. § 154(b) in the decision of 30 May, 2006, be changed from 403 days to 523 days.

The request for reconsideration of the decision of 30 May, 2006, is granted to the extent that the decision of 30 May, 2006, 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 403 days indicated in the decision of 30 May, 2006. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 and for purposes of seeking judicial review. See MPEP 1002.02.

Patentee states in accordance with 37 C.F.R. §§ 1.705(b)(2)(iii) that this patent is not subject to a Terminal Disclaimer.

On 7 February, 2006, the above-identified application matured into U.S. Patent No. 6,994,854. A request for reconsideration filed 6 April, 2006, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 403 days. This revised

determination was calculated as follows: The initial determination of PTA of 396 days was increased by 88 days and 39 days for Office delay in issuing the patent, but reduced by 120 days for then applicants filing of a "supplemental paper(s)-oath or declaration" on 30 September, 2005, filed after the mailing of a notice of allowance on 12 April, 2005. The Request for Reconsideration of Patent Term Adjustment filed on 6 April, 2006, was dismissed on 30 May, 2006.

Patentee again contends that there should have been no reduction for the filing, after the mailing of the notice of allowance, of the declaration filed on 30 September, 2005. Patentee contends that this paper is an example of submissions after a Notice of Allowance that are not considered a failure to engage in reasonable efforts to conclude processing or examination of an application, in accordance with the "Clarification of 37 C.F.R. §1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance Has Been Mailed," 1247 OG 111 (June 27, 2001).

Patentee's contention is not well taken.

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.

The OG Notice states that:

Accordingly, the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee 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, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

Patentee states that the papers filed on 30 September, 2005, were filed in response to the Office's request for a supplemental oath or declaration made by telephone on 12 August, 2005, subsequent to the mailing of the Notice of Allowance. Patentee further asserts that since applicants were not previously notified that a supplemental oath or declaration was required, the filing of the declaration on 30 September, 2005, should not be considered a failure to engage in reasonable efforts to conclude processing or examination of the application. Further, a review of the official file reveals a printer rush query requesting the supplemental declaration listing the first name of the first inventor.

A supplemental oath or declaration is not among the examples noted above. Other than those papers identified in the OG Notice and the MPEP, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office.

Patentee asserts, in the instant request for reconsideration, that 37 CFR 1.704(c)(10) does not apply to the situation at hand because the supplemental declaration was not filed in anticipation of receiving a response from the Office, and that no response from the Office to the supplemental declaration was received. Furthermore, patentee asserts that the submission of the supplemental declaration of 30 September, 2005, should not be considered failure to engage in reasonable efforts to conclude processing or examination of the application because patentee did not delay response to the Notice to File Missing Parts; because the substitute declaration was requested by telephone call rather than a Notice, and because the Office could have earlier notified patentee that a supplemental oath or declaration was required.

Patentee's arguments have been considered, but are not persuasive. At the outset, 37 CFR 1.704(c)(10) does not distinguish between papers filed in anticipation of receipt of a response from the Office and those papers not filed in anticipation of a response from the Office. Rather, any papers filed after the mailing of the Notice of Allowance which are not specifically enumerated as papers which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. A supplemental declaration is not among the examples provided, and

therefore is not within the exception noted in the OG Notice and the MPEP quoted above.

Furthermore, whether or not the supplemental declaration was requested by telephone or by a written Notice to applicants is not relevant to the inquiry under 37 CFR 1.704(c)(10). While the Office occasionally requests the submission of papers by telephone to expedite the processing of applications, the submission of supplemental papers in response to a telephone call, as opposed to a written Notice from the Office, does not in itself, excuse a failure to engage in reasonable efforts to conclude processing or examination of the application within the meaning of 37 CFR 1.704(c)(10).

Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office. Filing of a declaration after allowance will be treated as a failure to engage in reasonable efforts to conclude prosecution.

Furthermore, since the first named inventor's given name is printed on the front page of the patent, the failure of patentee to timely provide the first inventor's given name would have substantially delayed the Office's ability to process the application into a patent. Further to this point, the responsibility for the error which lead to the requirement for the supplemental declaration is that of the applicant rather than the Office: if applicant had more timely provided the first inventor's given name (i.e., at the time the original declaration was filed), there would not have been a need for a supplemental declaration to be filed. In summary, applicant has provided no persuasive argument supporting a conclusion that the instant situation should be considered to be within the exception noted in the OG Notice and the MPEP quoted above.

Lastly, patentee's ultimate contention, that any lack of diligence on the part of the patentee was offset by the Office's not notifying patentee at an earlier time that the declaration was defective, is simply not persuasive: it is applicant's responsibility to file timely and complete papers in the Office when those papers are required. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify

applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction). It is further noted that 37 CFR 1.63(a)(2) states that an oath or declaration must identify each inventor by full name, including the family name and at least one given name without abbreviation together with any other given name or initial. As such, the full name of each inventor is required on filing. Had patentee provided the proper information on filing, the situation described above would not have occurred.

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.

A handwritten signature in black ink, appearing to read "Charles A. Pearson". The signature is fluid and cursive, with a long horizontal stroke at the end.

Charles A. Pearson
Director, Office of Petitions