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OFFICE OF PETITIONS

In re Application of
[redacted]
Application No. 09/[redacted]
Filed: [redacted]
Attorney Docket No. 7791-0036-22

: DECISION ON
: PATENT TERM ADJUSTMENT
: RESPONSE DUE: 5/16/04
: REMINDER: 5/2/04

This is a decision on the "37 CFR 1.705 APPLICATION FOR PATENT TERM ADJUSTMENT," filed June 13, 2003. Applicants request that the initial determination under 35 USC 154(b) be corrected from two hundred fifty-seven (257) days to four hundred seventy-seven (477) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is four hundred twenty-six **(426)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Applicants are given **thirty (30) days** to respond to this decision. No extensions of time will be granted under § 1.136(a).

On May 8, 2003, the Office mailed the 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 257 days. On June 13, 2003, applicants timely submitted an application for patent term adjustment (with required fee), requesting that the Director change the notice of term extension due to delay caused by successful appellate review[1]. Specifically, applicants contend that based on "pendency of the proceeding" that there were three periods of adjustment: I) 32 days based upon the date of filing of a Notice of Appeal (and Appeal Brief), April 19, 2001, to the date the Examiner reversed all rejections and reopened prosecution, May 21, 2002; ii) 416 days based upon the date of filing of a supplemental Notice of Appeal, August 20, 2001, to the date (the Board of Appeals and Interferences reversed all rejections,

[1] Office records indicate that the Issue Fee payment was also received in the Office on June 13, 2003.

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September 9, 2002) the Examiner re-opened prosecution, October 10, 2002; and iii) 29 days based upon the date of filing of a Notice of Appeal (and appeal brief), December 9, 2002, to the date the Examiner allowed all pending claims and mailed Notice of Allowance, May 8, 2003.

The record indicates that the patent issuing from the application is not subject to a terminal disclaimer.

The instant application became eligible for patent term adjustment by virtue of the filing of a continued prosecution application on April 19, 2001.

Pursuant to 35 U.S.C. 154(b)(1)C(iii) and 37 CFR 1.702(e), a patent is entitled to patent term adjustment if the issuance of the patent was delayed by successful appellate review under 35 U.S.C. 134, 141 or 145. 37 CFR 1.703(e) provides that the period of adjustment under § 1.702(e) is the sum of:

> the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 1.191 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

A review of the record confirms that a notice of appeal was filed on April 19, 2001. However, the notice was not proper. 35 U.S.C. 134(a) provides that an applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal. See also § 1.191(a)(Every applicant for a patent ..., any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply). The notice of appeal was filed the day after the day the CPA under § 1.53(d) was filed and prior to the rejection of any claims in the CPA. As such, the notice of appeal was not properly filed pursuant to § 134(a) or § 1.191(a).

In view thereof, the date of filing of the improper notice of appeal, April 19, 2001, will not be used in the calculation of patent term adjustment pursuant to § 1.703(e). Furthermore, applicants are not entitled, as argued, to a period of adjustment for the 32 days from the filing of the improper notice of appeal to the mailing of the non-final Office action on May 21, 2001.

However, on August 20, 2001, applicants requested to reinstate the appeal and filed an appeal brief. As a non-final rejection had been filed in the CPA on May 21, 2001, the appeal was now proper. Under the circumstances, it is appropriate to use the August 20, 2001 in calculating the period under § 1.703(e). A final decision by the Board of Patent Appeals and Interferences, reversing all grounds for rejection of at least one claim was issued on September 20, 2002.

Accordingly, the period of adjustment delay caused by successful

appellate review is 397 days (e.g., beginning on August 20, 2001 and ending on September 20, 2002).

In addition, the application became eligible for a patent term adjustment of 29 days, pursuant to § 1.703(The Office did not mail a notice of allowance under 151 until May 8, 2003, which is four months and 29 days after applicants' filing of an appeal brief on December 9, 2002.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is four hundred twenty-six (426) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.

Kerry A. Fuqua for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen