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OFFICE OF PETITIONS

In re Application of	:	
Todd A. Brady	:	
Patent No. RE39462	:	FINAL AGENCY DECISION
Issued: 9 January, 2007	:	ON
Application No. 11/052,018	:	REQUEST FOR RECONSIDERATION
Filed: 5 February, 2005	:	OF
Reissue of	:	DECISION ON APPLICATION
Patent No. 5,127,760	:	FOR
Issued: 7 July, 1992	:	PATENT TERM ADJUSTMENT
Application No. 07/557,755	:	
Filed: 26 July, 1990	:	

This is a decision in response to the "REPLY TO THE DECISION ON THE PETITION FOR PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b)," filed October 3, 2007, requesting reconsideration of the decision of September 4, 2007, and requesting that the subject patent be considered eligible for Patent Term Adjustment. Applicants again request that the determination of patent term adjustment of zero (0) days in this application be corrected to a determination of patent term adjustment of one hundred thirty-eight (138) days.

The request for reconsideration of the decision of September 4, 2007, is granted to the extent that the decision of September 4, 2007, 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) indicated in the decision of September 4, 2007. 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.

On June 26, 2006, the Office mailed the Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that a reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. § 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Petitioner again argues that the subject patent is eligible for Patent Term Adjustment under 35 U.S.C. § 154(b). In particular, petitioner argues that the patent statute does not preclude reissues; that legislative intent shows an intent to cover reissue applications, and that the agency has been arbitrary and capricious in barring reissue applications from Patent Term Adjustment.

35 U.S.C. 154(b) states, in pertinent part:

(1) PATENT TERM GUARANTEES. -

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES. - 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 -

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after -

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title;

(ii) 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;

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a

decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) 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.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY. - Subject to the limitations under paragraph (2), if the issue of an **original patent** is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS. - Subject to the limitations under paragraph (2), if the issue of an **original patent** is delayed due to -

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181;
or

(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(emphasis added)

37 CFR 1.702 states:

Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) 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:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or

(4) 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.

(b) Failure to issue a patent within three years of the actual filing date of the application. 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 within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or;

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) Delays caused by interference proceedings. 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 interference proceedings under 35 U.S.C. 135(a).

(d) Delays caused by secrecy order. 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 application being placed under a secrecy order under 35 U.S.C. 181.

(e) Delays caused by successful appellate review. 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 review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability. If an application is remanded by a panel of the Board of Patent Appeals and Interferences and the remand is the last action by a panel of the Board of Patent Appeals and Interferences prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision by the Board of Patent Appeals and Interferences as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e). A remand by a panel of the Board of Patent Appeals and Interferences shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(f) The provisions of this section and §§ 1.703 through 1.705 apply only to **original applications**, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

(emphasis added)

At the outset, a reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. § 251. Accordingly, a reissue application is not eligible for Patent Term Extension or Adjustment Under 35 U.S.C. § 154(b). Petitioner's argument that, despite the statute's plain language, that Congress did not intend to preclude patent term adjustments, is without merit because such would violate the

plain meaning of the words. Any term adjustment would be in addition to the unexpired part of the term, and is therefore precluded.

The Patent Term Guarantee Act of 1999 amended 35 U.S.C. § 154 to include § 154(b), which provides for adjustment of patent term due to examination delay. The provisions of § 154(b) related to adjustment of patent term due to administrative delays apply only to original applications, other than designs, filed on or after May 29, 2000. The Final Rule published in the Federal Register specifically states that the provisions of 37 CFR §§ 1.701 - 1.705, which implement § 154(b) apply only to original (non-reissue)¹ patents. In particular, 37 CFR 1.702(f) provides that the provisions of §§ 1.702 through 1.705 apply only to original (i.e., non-reissue) applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications. See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366, 56368 (September 18, 2000). The regulation as promulgated clearly states that reissue applications are not original applications, and are therefore ineligible for Patent Term Adjustment. See also Comment 5 to *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000) (reiterating that an "original application" is any application other than a reissue application).

Petitioner's artfully pled argument that the USPTO lacks the rulemaking authority to determine which types of applications are eligible for Patent Term Adjustment clearly overlooks the fact that 37 CFR 1.701-1.705 is a validly promulgated regulation. More to the point, petitioners' citation of *Texaco, Inc. v. Federal Power Comm.* 412 F.2d 740, 743 (3d Cir. 1969), indicates that petitioners improperly assumed that 37 CFR 1.701 - 1.705 was simply an agency determination. To the contrary, the Patent Term Adjustment provisions specified in 37 CFR 1.701 through 1.705 were promulgated pursuant to 5 U.S.C. § 553(b) and

¹ As petitioner correctly points out, the language of 37 CFR 1.702 et seq. does not include, as above, the clarification that an original patent or application is a "non-reissue" patent or application. Nonetheless, as explained *infra*, an analysis of the case law, statute, Office policy, and MPEP lead to a conclusion that an original patent or application is a patent, or application or patent, which is not a reissued patent or reissue application for patent.

(c) and issued in a Final Rule on September 18, 2000. Further, petitioner has provided no factual or legal bases which would in any way support its contention that reissue applications are eligible for Patent Term Adjustment.

To be sure, petitioner is correct that neither the statute nor the legislative history defined the phrase "original patent" or "original application". Nevertheless, on April 11, 2000, the U.S. Patent and Trademark Office published a Notice in its Official Gazette setting out its interpretation of "original application":

The phrase original application is interpreted to encompass utility, plant and design applications, including first filed applications, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications. This interpretation is consistent with the use of the phrase in 35 U.S.C. 251 and the federal rules pertaining to re-examination. **In addition section 201.04(a) of the Manual of Patent Examination and Procedure (MPEP) defines an original application as "an application which is not a reissue application."**²

(emphasis added)

Accordingly, the USPTO's longstanding policy, as set forth in both the Official Gazette and the Manual of Patent Examination Procedure, is that an original application is not a reissue application.

Further, the "starting point in every case involving construction of a statute is the language itself." Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425 (Fed. Cir. 1988) (internal quotation and citation omitted). Here, petitioner argues that the Office has incorrectly construed the statute to preclude reissue applications.

Petitioner's argument, in essence, is that Congress has not clarified whether reissue applications are or are not "original applications."

² 1233 O.G. 54 (IV)

Petitioner's point is not well taken: The term "original application" must be read in tandem with other parts of the patent statute.³ 35 U.S.C. § 154(b). Here, 35 U.S.C. § 252, states

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

As such, an analysis of the Patent Act shows that an "original patent" is one surrendered in favour of a "reissued patent." As such, reissued patent and an original patent cannot be one and the same, as one necessarily follows from the other. One must have an original patent in order to obtain a reissued patent, and, therefore, a reissued patent is a patent which is reissued from an original patent.

Placing "original patent" in context, the question is what Congress intended when it limited Patent Term Adjustment to "original applications and patents issued on such applications." If the Office were to adopt petitioner's construction, it would be forced to conclude that the original patent, U.S. Patent No. 5,127,760, issued July 7, 2002, of which the subject patent is a reissue, in fact was never validly issued as a patent. However, the record is clear that the original patent, U.S. Patent No. 5,127,760, issued July 7, 2002, and that a reissue application was filed on February 5, 2005. In the reissue declaration filed on February 5, 2005, petitioner admits that U.S. Patent No. 5,127,760, was granted [issued] on July 7, 2002, but that petitioner "[V]erily believe[s] the **original patent** to be wholly

³ See 2A Sutherland Statutory Construction § 47.16 (7th ed. 2007) ("[T]he meaning of doubtful words may be determined by references to their relationship with other associated words and phrases.") (footnote omitted).

or partially inoperative or invalid." (emphasis added). Rather, the record unambiguously demonstrates that the subject patent was reissued from the original patent, U.S. Patent No. 5,127,760, issued July 7, 2002. As such, petitioner concedes, in the above-identified declaration, that the subject patent is a reissue of an original patent. Given that the prior patent was unquestionably an original patent, petitioner cannot reasonably argue that the subject reissued patent, which was "reissued" from the original patent, is also an "original patent:" such an interpretation strips the term "original," as it appears in the reissue application declaration, of meaning.

Further, petitioner's position ignores the settled meaning of the term "original application" as used by practitioners in patent law. Before the enactment of the American Inventors Protection Act of 1999, which enacted the Patent Term Adjustment provisions of 35 U.S.C. § 154(b), the Patent Office announced a clear definition of "original application" for purposes of evaluating patent applications:

"Original" is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a first filing or a continuing application. MPEP § 201.04(a) (5th ed. 1983).

The same definition continues to be used today. See MPEP § 201.04(a) (8th ed. 2001). Given this consistent usage, the obvious conclusion is that the USPTO's definition in the MPEP has entered the modern parlance of patent law. See Patlex Corp. v. Mossinghoff, 758 F.2d 594, 606 (Fed. Cir. 1985) (noting the detailed rules and regulations in the MPEP "describe procedures on which the public can rely"). It must also presume that Congress was aware of this definition and that it adopted it in the AIPA. See 2A Sutherland Statutory Construction § 47.29 ("In the absence of legislative intent to the contrary, or overriding evidence of a different meaning, technical terms or terms of art used in a statute are presumed to have their technical meaning.") (footnotes omitted).

Accordingly, petitioner's argument lacks merit in that the USPTO's interpretation of "original application" in the AIPLA is fully consistent with the term's established meaning in patent law.

With regards to legislative intent, one must examine other provisions in the patent code to see whether "Congress meant something other than what it said statutorily." Ethicon, 849 F.2d at 1426. The USPTO's definition of "original application" is not inconsistent with other statutory pronouncements.

The Patent Act references two types of patents - original patent and reissue patents. Unlike an original patent, which discloses a new invention, a reissue patent is a patent that corrects errors in a previously issued patent. When filing a reissue application, a patent owner essentially asks the Patent Office to fix a mistake in an issued patent, and "the Director shall . . . reissue the patent for the invention disclosed in the original patent." 35 U.S.C. § 251; see also § 252 {"The surrender of the original patent shall take effect upon the issue of the reissued patent"} (emphasis added). The Act's fee provision also adopts this distinction between applications for patents. Compare 35 U.S.C. § 41(a)(1)(A) (establishing the filing fee for "each application for an original patent") with § 41(a)(4)(A) (establishing the filing fee for "each application for a reissue of a patent." There is no distinction made between first filed application and continuation applications.

As such, the USPTO's interpretation of the term "original application" in MPEP § 201.04(A) - that any application that is not a "reissue application" is, by default, an "original application" - is entirely consistent with the Patent Act. As shown by the Official Gazette's citation to 35 U.S.C. § 251, the USPTO is simply using "original application" and "reissue application" as shorthand for "an application for an original patent" and "an application for a reissue patent." This nomenclature was present in other Patent Office regulations existing at the time. Compare 37 CFR 1.16(a) (1999) ("each application for an original patent") with § 1.16(b), (c), (d) ("an original application"); see also 37 CFR 1.179 (1999) (interchanging "an application for a reissue" and "the reissue application").

Under this established understanding, the subject reissue application is not an original application.

In this regard, petitioner's assertion that the Office has "misquoted" 37 CFR 1.702(f) in the prior decision by stating that original applications are non-reissue applications simply

has no merit. Rather, the Office has included the clarification to remind applicants that original applications are applications, other than reissue applications.

Likewise, petitioner's argument that the Office has not properly interpreted legislative intent is not well taken. See Chevron U.S.A., Inc. v. National Resources Defense Council, Inc., 467 U.S. 837, 842-843 (1984) (first, always, is the question whether Congress has directly spoken to the precise question at issue; however, if court determines Congress has not directly addressed the precise question at issue, question for the court is whether the agency's answer is based on a permissible construction of the statute). While petitioner may assert that "it is unconscionable" to believe "that the legislature meant to single out reissue applications for 'bureaucratic abuse'," (emphasis added) petitioner's argument lacks any rational basis: As stated above, the USPTO's interpretation of "original patent" as excluding a "reissue patent" is an entirely reasonable construction.

The USPTO's statutory interpretation of a law it is charged with administering is entitled to deference. See Lacavera v. Dudas, 441 F.3d 1380, 1383 (Fed. Cir. 2006) (explaining that the USPTO is entitled to Chevron deference when Congress has charged it with administering the statute) (citing United States v. Mead Corp., 533 U.S. 218 (2001); Chevron U.S.A., Inc. v. Natural Res. Def. Council, 467 U.S. 837 (1984)). Likewise, the USPTO's interpretation of its own regulations is entitled to substantial deference. See Custom Computer Servs., Inc. v. Paychex Props., Inc., 337 F.3d 1334, 1336 (Fed. Cir. 2003) ("[T]he USPTO's interpretation must be given controlling weight unless it is plainly erroneous or inconsistent with the regulation.") (internal quotes and citation omitted) (citing Bowles v. Seminole Rock & Sand Co., 325 U.S. 410, 414 (1945)). When interpreting "narrow technical and specialized statutory and regulatory provisions" the USPTO's interpretation is entitled to "considerable deference." In re Morganroth, 885 F.2d 843, 848 (Fed. Cir. 1989). This Court also must "accord particular deference to an agency interpretation of 'longstanding' duration." North Haven Bd. of Ed. v. Bell, 456 U.S. 512, 522, n. 12 (1982). The USPTO's interpretation need not be the only possible construction. Chemical Mfrs. Ass'n v. Natural Res. Def. Council, Inc., 470 U.S. 116, 125 (1985).

Lastly, petitioner's reference of Patent No. RE 34,712 as evidence that "there are examples where the term of a reissue patent has been extended" is not convincing. U.S. Patent No. RE 34,712 is a patent in which the term was extended pursuant to 35 U.S.C. § 156 due to delays relating to regulatory review by the Food and Drug Act. While 35 U.S.C. § 156 permits reissue applications to obtain patent term extension pursuant to such delays, petitioner has filed for patent term adjustment under 35 U.S.C. § 154, and has not claimed the delay was due to regulatory review. Rather, petitioner claims that the delay was due to processing and examination at the USPTO. As such, the reissue patent petitioner cites as an example supporting its conclusion involves a different statute as well as a different source of delay, and is therefore inapplicable to the situation at hand.

In summary, it is clear that the provisions of 37 CFR 1.702 and 35 U.S.C. § 154(b) are not an appropriate vehicle for seeking the relief petitioner desires. To the contrary, for the USPTO to grant the relief requested would be not only an abuse of discretion, but also contrary to law.

Since the above-identified application is a reissue application, and as such, is clearly not an original application, this application is not eligible for the adjustment of patent term under 35 U.S.C. § 154. The Office has no authority to grant an adjustment of the patent term due to administrative delays except as authorized by 35 U.S.C. § 154.

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

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



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