To: Editor of the JPTOS

RE: A 37 CFR 1.193(b)(2)(ii) Request to reinstate an appeal withdrawn by the examiner pursuant to 37 CFR 1.193(b)(2) **DOES** preserve the PTA for the resulting patent!

Dear Colleagues:

I have a decision mailed from the Office of Petitions on April 16, 2004 granting a request for patent term extension. The decision reversed an initial USPTO determination of patent term adjustment that discounted the applicant's filing under 37 CFR 1.193(b)(2)(ii) requesting an appeal be reinstated.

The decision is precedential to the extent that it concludes that an applicant responding with a 37 CFR 1.193(b)(2)(ii) request to reinstate an appeal to an examiner's action under 37 CFR 1.193(b)(2) withdrawing the appeal, preserves patent term adjustment. Specifically, the decision concludes that the 37 CFR 1.193(b)(2)(ii) request results in the period of time from the applicant's filing the notice of appeal and brief to the through the date the applicant files the 37 CFR 1.193(b)(2)(ii) request is included in any patent term adjustment resulting from a successful appeal.

This issue is of particular concern to me because many of my clients' business method patent applications have had their appeals repeatedly withdrawn by examiners acting pursuant to 37 CFR 1.193(b)(2). I have generally *promptly* appealed business method cases, and responded to 37 CFR 1.193(b)(2) withdrawals of my clients' appeals by acting under 37 CFR 1.193(b)(2)(ii) to request reinstatement of the appeals. The reason for my strategy is my recognition that the "second look" policy has resulted in many improper rejections in business method patent applications, and the "second look" policy has removed the examiners authority to withdraw or not make such rejections. However, the Board is not subject to the "second look" policy, and its authority has, so far, remained intact. Accordingly, in order to reduce pendency and cost for my clients, I have attempted to appeal in business method applications as soon as legally possible.

However, I have been concerned that the USPTO could "run out the clock" on these applications' potential patent term if in law 37 CFR 1.193(b)(2)(ii) requests did not result in preserving patent term adjustment from the time when an appeal is first filed. In fact, I have at least one application in which the examiner has already withdrawn the appeal three times.

I assume that other practitioners have or will face the same problem. Therefore, I am posting a redacted pdf formatted image copy of the decision (redacted to remove identification of the party) on my firm's web site, www.Neifeld.com so that other practitioners can rely upon this decision in supporting applications for patent term adjustment in similar situations.

If you read the decision, please note, however, one complication in the decision. The decision denies patent term adjustment for an initial period of time prior to a first office action in the subject application. The basis for that denial was a conclusion that 35 USC 134(a) required that the *application* be twice or more rejected in order for the applicant to have a right to appeal, and the subject application had not yet been twice or more rejected. However, 35 USC 134(a) was construed in the precedential Board decision Ex parte Lemoine 46 USPQ2d 1420, ___

(PTOBPAI 1994)(precedential decision of an expanded panel including APJ Schafer, APJ Meister, SAPJ McKelvey, and CAPJ Stoner) to apply to two or more rejections of ***a claim for a patent***, not rejections of an application.

In my case, the applicant made the same claim for a patent within the meaning of Ex parte Lemoine in the parent application, and the parent application was twice rejected. I have requested reconsideration of that part of the decision relying upon an interpretation of 35 USC 134(a) that appears to be contradictory to binding Board precedent. When I get that decision, I will also post it in redacted form on www.Neifeld.com.

Truly,

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