

extension that is granted pursuant to § 1.701.

121. Comment: One comment suggested that the word "interference" be inserted before the word "proceedings" in § 1.701(a)(1).

Response: The suggestion has been adopted.

122. Comment: One comment stated that the last sentence of § 1.701(b) is confusing because it suggests that patent term extension will be available in cases of terminal disclaimer and that the extension begins on the terminal disclaimer date rather than the original expiration date. This statement is contrary to 35 U.S.C. 154(b)(2) which does not permit any patent term extension for appellate delay if the patent is subject to a terminal disclaimer.

Response: In order to reduce confusion, the last sentence of § 1.701(b) is being amended to state that the extension will run from the expiration date of the patent. The reference to "terminal disclaimer" is being deleted.

123. Comment: Two comments stated that if an application involved in an interference proceeding contains uninvolved claims, those uninvolved claims should not be entitled to extension of patent term under proposed § 1.701 because applicant could cancel those uninvolved claims from the application and refile those claims in a continuation application. It is suggested that if an applicant leaves conclusively uninvolved claims (where no § 1.633(c)(4) motion is filed) in the application in interference, applicant does not get the benefit of the extension for any claim.

Response: The suggestion has not been adopted. The statute, 35 U.S.C. 154(b), grants patent term extension to a patent if the issuance of the patent was delayed due to interference proceeding under 35 U.S.C. 135(a). The statute does not exclude applications containing uninvolved claims. The Commissioner does not have the authority to establish regulations which are inconsistent with the law. Therefore, an application involved in an interference which contains uninvolved claims will be entitled to patent term extension if the issuance of the patent was delayed due to interference proceeding under 35 U.S.C. 135(a).

124. Comment: One comment asked whether applicant is entitled to patent term extension regardless of whether an interference involving applicant's application is ultimately declared.

One comment asked if the PTO ends the suspension without declaring an interference, and continued prosecution results in filing of a continuation or

divisional application, are such subsequent cases entitled to the extension.

Response: An application will not be suspended unless it is decided that an interference can be declared involving that application. If prosecution of applicant's application is suspended due to an interference not involving applicant's application and an interference involving applicant's application is later declared, applicant will be entitled to patent term extension under § 1.701(c)(1)(ii) for the suspension period and under § 1.701(c)(1)(ii) for the interference period. However, if prosecution of applicant's application is suspended due to an interference not involving applicant's application and if the PTO ends the suspension of the application without declaring an interference involving applicant's application, that application will be entitled to patent term extension under § 1.701(c)(1)(ii). If prosecution results in filing of a continuing application and if the delay in the parent application contributed to a delay in the issuance of a patent on the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. 154(b).

125. Comment: One comment stated that delays in the issuance of a patent can exceed the five-year limit provided for in proposed § 1.701(b). Where the delay was not the fault of the applicant, why should there be this maximum?

Another comment stated that in a biotechnology application, if suspension of the application results in a declared interference, the period of delay calculated under § 1.701(c)(1)(i) will likely consume most of the five-year maximum extension. This renders the value of any time period measured under § 1.701(c)(1)(ii) negligible, thus diminishing the rights of applicant due to the unregulated suspension powers of the PTO.

Response: The five-year limit for patent term extension set forth in § 1.701(b) is required by statute, 35 U.S.C. 154(b).

126. Comment: One comment suggested that § 1.701(c)(1)(i) be amended to state that an application added after an interference is declared is entitled to an extension measured only from the date of redeclaration.

Response: The suggestion has not been adopted. The language in § 1.701(c)(1)(i) is clear that for an application that is added to an interference, that application is entitled to an extension measured from the date of redeclaration of the interference.

127. Comment: One comment stated that § 1.701(c)(1)(ii) does not address the

case where a suspended application is added to the interference without the suspension being lifted.

Response: Section 1.701(c)(1)(ii) is being amended to reference the endpoint for the suspension period to the date of termination of the suspension. Where prosecution of an application is suspended due to interference proceedings not involving the application, the suspension is made pursuant to § 1.103(b). When that application is added to an interference, the suspension pursuant to § 1.103(b) will be automatically lifted. The application is entitled to patent term extension for the period of suspension pursuant to § 1.701(c)(1)(ii) and for the period of interference pursuant to § 1.701(c)(1)(i). Under § 1.701(c)(1)(ii), the period of suspension begins on the date the application is suspended and ends on the date the suspension under § 1.103(b) is terminated, which in this case would be the same date as the date of redeclaration of the interference.

128. Comment: One comment suggested that the phrase ", if any," in § 1.701(c)(1)(i) and (ii) is unnecessary.

Response: The suggestion has not been adopted. However, § 1.701(c)(1)(i) is being amended for clarity by deleting the phrase "if any" after the first occurrence of "interference" and by inserting the same phrase after the phrase "the number of days."

129. Comment: Several comments suggested that the phrase "was declared or redeclared" in § 1.701(c)(1)(i) be changed to—was first declared—.

Response: The suggestion has not been adopted. The language of the rule reads "with respect to each interference in which the application was involved, the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference.* * *" An interference may be declared as A vs. B and later redeclared as A vs. B vs. C. Under the rule, the period of extension would be counted, with respect to applications A and B, from the date the interference was declared to involve the applications A and B. With respect to application C, the period of extension would be counted from the date the interference was redeclared to involve the application C. No ambiguity is seen in the language as originally proposed.

130. Comment: One comment suggested that the use of the phrase "appellate review" in reference to an action under 35 U.S.C. 145 or 146 is incorrect, since an action under 35 U.S.C. 145 or 146 is not considered as an "appellate review" and suggests that § 1.701(a)(3) be amended so that the