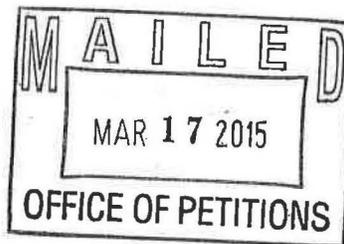




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In re Patent No. 8,546,403
Whitten, et al.
Issue Date: October 1, 2013
Application No. 13/085,324
Filing or 371(c) Date: April 1, 2011
Docket No.: 34510-724.201

:
: DECISION
: ON REQUEST FOR
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
:

This is a decision on the patent term adjustment in response to the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)” filed May 1, 2014, requesting that the patent term adjustment determination for the above-identified patent be changed from 172 days to 296 days.

The request is **DENIED**.

This decision on patent term adjustment is the Director's decision on the applicant's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

On October 1, 2013, the above-identified application matured into U.S. Patent No. 8,546,403. The patent issued with a PTA of 172 days. The present request for redetermination of the patent term adjustment was filed on May 1, 2014, with a request for an extension of time pursuant to 37 CFR 1.136, within the fifth month.

The present petition

Patentees avers that, pursuant to *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014), patentee is entitled to additional patent term adjustment under 37 CFR 1.702(b) and 37 CFR 1.703(b).

Discussion

Patentees’ arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **172** days of PTA. The Office has revisited the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B) and the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A) pursuant to the Federal Circuit’s decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

The Office and Patentees are in agreement that the total amount of “A” delay is 183 days. Furthermore, the Office and Patentees are in agreement that the total amount of Applicant delay is 11 days for two separate instances of Applicant delay of 3 days and 8 days.

As for the amount of “B” delay, the Federal Circuit reviewed the statutory interpretation of 35 U.S.C. § 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued Examination (“RCE”) on “B” delay in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). In *Novartis*, the Federal Circuit agreed with the Office that “no [“B” delay] adjustment time is available for any time in continued examination, even if the continued examination was initiated more than three calendar years after the application’s filing.” *Novartis*, 740 F.3d at 601. However, the *Novartis* court found that if the Office issues a notice of allowance after an RCE is filed, the period after the notice of allowance should not be excluded from the “B” delay period but should be counted as “B” delay. *Id.* at 602. The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

Pursuant to the *Novartis* decision, the USPTO has determined that the patentee is entitled to 0 days of “B” delay. In this case, the application was filed on April 12, 2011, and the patent issued on October 1, 2013; thus, the application was pending for 903 days. During this time, applicants did not file an RCE. Under 35 U.S.C. § 154(b)(1)(B)(i), there was no time period consumed by continued examination (“RCE period”). Thus, for purposes of “B” delay, the application was pending for 903 – 1097 [*i.e.*, the 3 year delay period from April 12, 2011, until April 12, 2014] = 0 days beyond the 3-year anniversary of the filing date.

Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - Overlap - applicant delay = X

USPTO’s Calculation:

183 + 0 + 0 – 0 – 11 = 172

Patentee’s Calculation:

183 + 124 + 0 – 0 – 11 = 296

Conclusion

Patentee is entitled to PTA of one hundred seventy-two (172) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: 183 + 0 + 0 – 0 – 11 = 172

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Attorney Advisor, at (571) 272-3222.



John Cottingham
Director
Office of Petitions