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In re Patent No. 9,235,834	:	
BRADLEY et al.	:	DECISION DENYING REQUEST
Issue Date: January 12, 2016	:	FOR REDETERMINATION OF
Application No. 12/792,952	:	PATENT TERM ADJUSTMENT
Filing or 371(c) Date: June 3, 2010	:	
Attorney Docket No. 07451.0050-15000	:	

This is in response to patentee's "APPLICATION FOR PATENT TERM ADJUSTMENT – POST GRANT" filed Monday, March 14, 2016, which is being treated under 37 CFR 1.705(b) as a request that the Office adjust the patent term adjustment ("PTA") from 50 days to 174 days.

The request is **DENIED**.

This decision is the Director's decision on patentee's request for reconsideration for the purposes of seeking judicial review under 35 U.S.C. § 154(b)(4).

Relevant Procedural History

On January 12, 2016, this patent issued with a PTA in the amount of 50 days. On Monday, March 14, 2016, patentee timely filed the present request for redetermination of patent term adjustment seeking an adjustment of the determination to 174 days. Specifically, patentee solely disagrees with the USPTO's calculation of "B" delay. Patentee asserts that the correct amount of "B" delay is 124 days.

Decision

Upon review, the Office finds that patentee is entitled to 50 days of PTA. The Office and patentee are in agreement regarding the amounts of 748 days of "A" delay under 35 U.S.C. § 154(b)(1)(A), zero (0) days of "C" delay under 35 U.S.C. § 154(b)(1)(C), zero (0) days of overlap under 35 U.S.C. § 154(B)(2)(A), and 698 days of applicant delay under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704. However, the Office and patentee are in disagreement regarding the amount of "B" delay under 35 U.S.C. § 154(b)(1)(B).

The Office will revisit the amount of "B" delay in view of the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014) and pursuant to 35 U.S.C. § 154(b)(1)(B).

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As to the amount of “B” delay, the U.S. Court of Appeals for the Federal Circuit (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 the *Novartis* appeal. 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. That is, the Federal Circuit determined that any time consumed by continued examination under 35 U.S.C. § 132(b) is subtracted in determining the extent to which the period of “B” delay defined in 35 U.S.C. § 154(b)(4)(1)(B) exceeds three years, regardless of when the continued examination was initiated. *See* MPEP 2731. Nevertheless, the Federal Circuit 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, unless the Office actually resumes examination of the application after allowance. *Id.* at 602; *see* MPEP 2731.

The *Novartis* decision includes “instructions” for calculating the period of “B” delay.

Specifically, the decision states,

The better reading of the language is that the patent term adjustment time [for “B” delay] should be calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of (b)(1)(B)) and determining the extent to which the result exceeds three years.¹

Pursuant to the *Novartis* decision, the USPTO has determined patentee is entitled to zero (0) days of “B” delay. In this case, applicant filed the application on June 3, 2010, and the patent issued on January 12, 2016. Thus, the application was pending for 2050 days. During this time, applicant filed a RCE on October 15, 2012. The Office mailed a Notice of Allowance on September 10, 2015. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination (“RCE period”) began on October 15, 2012, and ended on September 10, 2015 – *i.e.*, 1061 days. The number of days beginning on the application filing date, June 3, 2010, and ending on the date three years after the filing of the application, June 3, 2013, is 1097 days. Subtracting the RCE period from the total number of days the application was pending results in $2050 - 1061 = 989$ days. Thus, for purposes of “B” delay, the application was pending for $989 - 1097$ [*i.e.*, 3 years from the actual filing date] = zero (0) days beyond the three-year anniversary of the filing date.

The Office notes that applicant filed a RCE on October 15, 2012, prior to June 3, 2013, the three-year date. As of the day before the date applicant filed the RCE, the application was only pending 865 day (*i.e.* June 3, 2010 – October 14, 2012). However, before “B” delay could begin

¹ *Novartis*, 740 F.3d at 601.

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to accrue, this application had to be pending an additional 232 days ($865 + 232 = 1097$) after the end of the period consumed by continued examination (*i.e.* the date of mailing of the Notice of Allowance on September 10, 2015). Accordingly, the period for calculating "B" delay would begin on April 29, 2016 (the day after the date that is 232 days from the mail date the Notice of Allowance). As April 29, 2016, is after the date the patent issued on January 12, 2016, no "B" delay accrued.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

$$748 + 0 + 0 - 0 - 698 = 50$$

Patentee's Calculation

$$748 + 124 + 0 - 0 - 698 = 174$$

Conclusion

The Office affirms that patentee is entitled to PTA in the amount of fifty (50) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $748 + 0 + 0 - 0 - 698 = 50$ days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 174 days is not merited. Accordingly, the request for redetermination of patent term adjustment is **denied**. This decision may be viewed as a final agency action. See MPEP 1002.02(b).

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

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Attorney Advisor at (571) 272-3211.

/ROBERT CLARKE/

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