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MAILED
JUN 01 2010
OFFICE OF PETITIONS

In re Application of :
Barbosa et al. :
Application No. 11/175,476 : LETTER REGARDING
Patent No. 7,601,714 : PATENT TERM ADJUSTMENT
Filed: July 6, 2005 :
Issued: October 13, 2009 :
Attorney Docket No. 09-0317 :
Title: PYRIMIDINE DERIVATIVES :
USEFUL AS INHIBITORS OF PKC-THETA:

This is a decision on the "PETITION UNDER 37 C.F.R. §1.181, §1.182 OR §1.183 FOR RECONSIDERATION OF MODIFIED PATENT TERM ADJUSTMENT," filed January 28, 2010. Applicants request that the patent term adjustment be corrected from one hundred and sixty-three (163) days to two hundred and fifty-nine (259) days. This submission is being treated as a second renewed request for reconsideration of the patent term adjustment.

The second renewed request for reconsideration of the patent term adjustment is **DENIED**.¹

THERE WILL BE NO FURTHER RECONSIDERATION OF THIS MATTER BY THE OFFICE.

On February 25, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 272 days.

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of seeking judicial review. See MPEP § 1002.02.

On May 6, 2009, Applicants filed an "APPLICATION FOR PATENT TERM ADJUSTMENT," requesting that the patent term adjustment indicated on the initial determination of patent term adjustment be corrected from two hundred and seventy-two (272) days to two hundred and fifty-nine (259) days: Applicants correctly indicated that a 13-day reduction should be assessed as associated with the submission of the Rule 312 Amendment which was filed on July 9, 2008, pursuant to 37 CFR 1.704(c)(10).

A decision was mailed on September 1, 2009, which agreed with this 13-day reduction, and further indicated that a second reduction pursuant to 37 CFR 1.704(c)(10) of 96-days was in order:

A review of the application history supports a conclusion that a second reduction pursuant to 37 CFR 1.704(c)(10) is warranted. A Request for Continued Examination (RCE) with an amendment and a Petition to Withdraw from Issue were each filed concurrently on August 11, 2008. The RCE was responded to via the mailing of a non-final Office action on November 14, 2008 (a 96-day reduction), and the Petition to Withdraw from Issue was granted via the mailing of a decision on August 12, 2008 (a 2-day reduction). Since the 2-day reduction for the petition to withdraw from issue overlaps with the 96-day reduction for the RCE and amendment, a total period of reduction of 96 days for this applicant delay is being entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 163 (334 days of Office delay minus 171 (62 + 13 + 96) days of Applicant delay) days.

Decision on original petition, page 2.

As such, the decision on the original petition indicated that the PAIR screen was updated to reflect that the correct Patent Term Adjustment (PTA) at the time of the mailing of the notice of allowance is 163 days.

A renewed petition was filed on September 23, 2009, where Petitioner asserted that this second reduction pursuant to 37 CFR 1.704(c)(10) of 96-days was erroneous, since "the RCE was not counted as an applicant delay in the original PTA indicated in the Notice of Allowance mailed 25 February 2009."²

² Renewed petition, page 2.

The renewed petition was dismissed via the mailing of a decision on December 24, 2009, which indicated, *in pertinent part*:

Despite the fact that the 96-day reduction associated with the submission of the RCE was not contained in the "Determination of Patent Term Adjustment under 35 U.S.C. 154(b)" which was mailed concurrently with the notice of allowance, the reduction is proper, for it is controlling that the RCE is an "other paper" within the meaning of 37 CFR 1.704(c)(10). Since this "other paper" was submitted "after a notice of allowance has been given or mailed,"³ the 96-day reduction was proper.

Pursuant to the above discussion, the PTA remains 163 days.

Decision on renewed petition, pages 2-3.

With this second renewed petition, Petitioner takes the position that the filing of an RCE cannot give rise to a reduction pursuant to 37 CFR 1.704(c)(10), due to the perception that an RCE is not an "other paper" within the meaning of the Rule.

Petitioner's assertion is not accurate. The issue is not the fact that an RCE was filed, but rather the timing of the same. On April 22, 2008, the Office mailed a Notice of Allowance and Issue Fee Due, indicating that claims 1-6 and 11 were allowable. As such, this application was set to mature into a patent, predicated on the timely submission of the issue and publication fees. However, in lieu of submitting the issue and publication fees so that this case would proceed towards issuance without any further delay, Petitioner submitted two new claims (numbered 12 and 13) via the filing of an after-final amendment pursuant to 37 CFR 1.312, along with the issue and publication fees. This resulted in the mailing of a "Response to Rule 312 Communication," which indicated "[t]he two new claims added by the instant amendment required substantial amount of additional work that goes beyond a cursory review of the record." The Examiner added "[t]here is no clear reason stated on record why the claims were not presented earlier," and the entry of the two new claims was not approved.

So as to enable the examination of these two new claims via the entry of the same, Petitioner filed a petition to withdraw this application from issuance concurrently with an RCE on August 11,

³ 37 C.F.R. § 1.704(c)(10).

Application No. 11/175,476
Patent No. 7,601,714

Page 4

2008, and a non-final Office action was mailed 96 days later on November 14, 2008.

In short, Petitioner prosecuted this application to allowance, and then delayed the issuance of the same via obtaining the withdrawal of this application from issuance, so as to secure the examination of two new claims.

Pursuant to the discussion above, the PTA remains 163 days.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Anthony Knight
Director
Office of Petitions