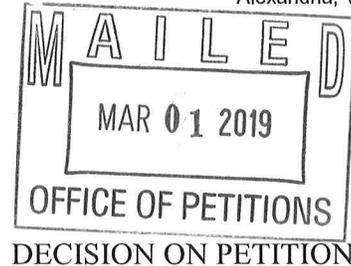




UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :
Chamberlain, Charles, R. :
Application No. 10/362,092 :
Filed: 21 Feb 2003 :
For: Systems and methods for soliciting :
secondary information while maintaining :
access to primary information :

This is a decision on the application for patent term adjustment, filed February 7, 2018, requesting that the patent term adjusted be corrected from 3250 days to 3267 days.

The request is **DENIED**.

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

Effective April 1, 2013¹, for any patent granted on or after January 14, 2013, 37 CFR 1.705(b) has been revised to no longer provide for a request for reconsideration of the Office's patent term adjustment determination prior to the grant of a patent. Rather, 37 CFR 1.705(b)² now provides:

(b) Any request for reconsideration of the patent term adjustment indicated on the patent must be by way of an application for patent term adjustment filed no later than two months from the date the patent was granted. This two month time period may be extended under the provisions of § 1.136(a). An application for patent term adjustment under this section must be accompanied by

(1) The fee set forth in § 1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

¹ Revisions to Patent Term Adjustment, Interim Final Rule, 78 FR 19416 (April 1, 2013).

² The former provisions of §§ 1.705(d) and (e) have been removed in view of the changes to 1.705(b).

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)

(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

On January 9, 2018, the instant application issued as Patent No. 9,864,997 with a patent term adjustment of 3,250 days, which consists of a 2,690 day period of delay under 37 C.F.R. § 1.703(a)(1) (“A Delay”), and a 1,465 day period of delay under 37 C.F.R. § 1.703(b) (“B Delay”), reduced by 754 days of overlap between “A” and “B” delay, and 151 days of Applicant delay.

The 151 days of Applicant delay and 0 days of “C” delay are not in dispute. At dispute is the calculation of “A” and “B” delay arising from an alleged miscalculation of the commencement date. Patentees argue that the commencement date is February 21, 2003, the date the application papers were filed, not March 10, 2003, the date recognized by the Office. Below the Office will explain how it arrived at a commencement date of March 10, 2003.

Background

Commencement Date

The Office has calculated the commencement date as March 10, 2003. Patentee asserts that the commencement date of the instant application is February 21, 2003. Patentees argue, based on a February 21, 2003 commencement date, that the amount of “A” delay is 2707 days and not 2690 days as calculated by the Office. Similarly, Patentees argue that the amount of “B” delay is 1482 days and not 1465 days as calculated by the Office.

The instant application is the national stage of International Application No. PCT/US01/27482, filed September 6, 2001, which claims priority to provisional Application No. 60/231,298, filed September 8, 2000.

National stage papers were filed in this case on February 21, 2003. The papers did **not** include an express request to begin national examination procedures.

The Office issued a Notice of Acceptance of Application under 35 USC 371 on March 20, 2003, which stated that the “Date of Receipt of All 35 U.S.C. 371 Requirements” is March 20, 2003.

On January 14, 2013, President Obama signed into law H.R. 6621, which makes technical corrections to the Leahy-Smith America Inventors Act and title 35 of the United States Code. The Office amended several regulations in order to implement changes made by the AIA Technical Corrections Act (H.R. 6621). See Revisions to Patent Term Adjustment (Interim Final Rule), 78 Fed. Reg. 19416 (April 1, 2013).

The Office amended 37 C.F.R. § 1.703(a) to read as follows, with emphasis added:

The period of adjustment under § 1.702(a) is the sum of the following periods:

- (1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.³

The changes made to 37 C.F.R. § 1.703(a) apply to all patents issued on or after January 14, 2013, and the instant application issued as a patent on January 9, 2018. Therefore, the changes made to 37 C.F.R. § 1.703(a) apply to this case.

In view of the prior discussion, the Office agrees the period of A delay should be based on the date the national stage commenced (“Commencement Date”) instead of the Date of Completion.

The date the national stage of an international application commences is addressed in MPEP § 1893.01, which states, with emphasis added,

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, *in the absence of an express request for early processing* of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, *the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application.*

The February 21, 2003 papers do not include a request for early processing. Therefore, the national stage commenced upon the expiration of 30 months from the priority date of the international application.

³ See Revisions to Patent Term Adjustment (Interim Final Rule), 78 Fed. Reg. 19416, 19420 (April 1, 2013).

The date 30 months after September 8, 2000, which is the priority date of the international application, is March 8, 2003. As March 8, 2003 fell on a Saturday, the commencement date began on the next succeeding business day. See PCT Rule 80.5. See Actelion v. Matal, 2017-1238 (Fed. Cir. 2018). Therefore, the commencement date is Monday, March 10, 2003. This commencement date of March 10, 2003 was used in the calculation of 2690 days of “A” delay and 1465 days of “B” delay as set forth above.

“A” Delays

Patentees argue that “A” delay should be 2707 days, asserting that the commencement date is February 21, 2003. The Office calculated “A” delay as 2690 days and asserts that the commencement date is March 10, 2003. The “A” delay was calculated based on the following:

- (a) 1408 days under 37 CFR 1.702(a)(1) beginning on May 11, 2004 (day after the date that is fourteen months from the commencement date of the application, March 10, 2003) and ending on March 18, 2008 (mail date of the restriction requirement);
- (b) 15 days under 37 CFR 1.702(a)(2) beginning on May 29, 2009 (day after the date that is 4 months from the filing of the response to non-final rejection) and ending on June 12, 2009 (date of mailing of final rejection);
- (c) 775 days under 37 CFR 1.702(a)(2) beginning on January 30, 2011 (day after the date that is four months from the filing of the RCE filed September 29, 2010) and ending on March 14, 2013 (date of mailing of the final rejection);
- (d) 321 days under 37 CFR 1.702(a)(2) beginning on April 25, 2014 (day after the date that is four months from the filing of the RCE filed December 24, 2013) and ending on March 11, 2014 (date of mailing of the non-final rejection);
- (e) 80 days under 37 CFR 1.702(a) beginning on February 17, 2016 (day after the date that is four months from the filing of the RCE filed October 16, 2015) and ending on May 16, 2016 (date of mailing of the non-final rejection); and
- (f) 91 days under 37 CFR 1.702(a)(2) beginning on June 10, 2017 (day after the date that is four months from the filing of the RCE filed February 9, 2017) and ending on September 8, 2017 (date of mailing of the notice of allowance).

“B” Delays

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.⁴

The length of time between application and issuance is 5420 days, which is the number of days beginning on the commencement date of the application (March 10, 2003) and ending on the date the patent issued (January 9, 2018).

The time consumed by continued examination is 2858 days beginning on the date of November 12, 2009 (date of filing of the first RCE) and ending on September 28, 2017 (date of mailing of the notice of allowance).

The number of days beginning on the filing date of application (March 10, 2003) and ending on the date three years after the filing date of the application (March 1, 2006) is 1097 days.

The result of subtracting the time consumed continued examination (2858 days) from the length of time between the application's filing date and issuance (5420 days) is 2562 days, which exceeds three years (1097 days) by **1465** days. Therefore, the period of "B" delay is **1465** days.

"C" Delay

The patentee and the Office agree that the amount of "C" delay under 37 CFR 1.703(e) is **zero**.

Overlap

The Office and patentee disagree as to the amount of overlapping delay. Patentee asserts that the amount of overlap is 771 days. The Office maintains that the amount of overlap is 754 days. In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the "A" and "B" delays. Under this interpretation, the Office finds that the overlapping period of "A" delay and "B" delay is 754 days. The first overlapping period begins on March 11, 2006 (day after the date that is three years from the commencement date of the application) and ends on March 18, 2008 (day of mailing of the restriction requirement). The second overlapping period begins on May 29, 2009 (day after the date that is four months from the response to the non-final) and ending on June 12, 2009 (date of mailing of the final rejection).

Applicant asserts that the overlap would begin on February 23, 2006 rather than March 11, 2006 because the commencement of the application was inadequately established as March 10, 2006 rather than February 22, 2006. However, as mentioned supra, the commencement of the application was not February 22, 2006 because patentee did not expressly request early entry into the national stage.

⁴ *Novartis*, 740 F.3d at 601.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

The patentee and the Office agree as to the amount of reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704. The reductions for applicant delay include the following:

- (a) 61 days under 37 CFR 1.704(b) beginning on June 19, 2008 (day after the date that is three months from the mailing of the restriction requirement and ending on August 18, 2008 (day of filing of the response to the restriction requirement);
- (b) 59 days under 37 CFR 1.704(b) beginning on September 15, 2009 (day after the date that is three months from the mailing of the final rejection) and ending of November 12, 2009 (date of filing of the first RCE); and
- (c) 31 days under 37 CFR 1.704(b) beginning on March 10, 2010 (day after the date that is three months from the mailing of the non-final rejection) and ending on April 9, 2010 (date of filing of the response to the non-final rejection).

Overall PTA Calculation**Formula:**

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

USPTO’s Calculation:

2690 + 1465 + 0 – 754 – 151 = 3250

Patentees’ Calculation:

2707 + 1482 + 0 – 771 – 151 = 3267

Conclusion

Patentees are entitled to PTA of **three thousand two hundred fifty (3250)** days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: 2690 + 1465 + 0 – 754 – 151 = 3250 days.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Cliff Congo at (571) 272-3207.

/ROBERT CLARKE/
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