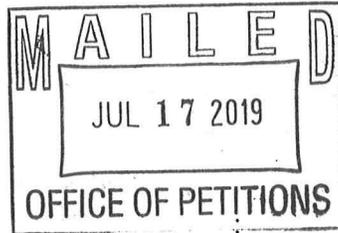




UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
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In re Patent of Pech et al.
Application No. 14/020,103 : DECISION ON REQUEST FOR
Filed: 6 Sep 2013 : RECONSIDERATION OF
For: METHOD AND SYSTEM FOR : REDETERMINATION OF
USING JSON WITH A CLI FOR : PATENT TERM ADJUSTMENT
MANAGING NETWORK DEVICES :

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)” (Request), filed July 12, 2018, which requests the United States Patent and Trademark Office (Office) correct the patent term adjustment (PTA) determination set forth on the patent from three hundred thirty-nine (339) days to three hundred sixty-eight (368) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED** with respect to making any change in the PTA determination under 35 U.S.C. § 154(b) of three hundred thirty-nine (339) days.

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).

Relevant Procedural History

The patent issued with a PTA determination of 339 days on June 19, 2018. The present request seeking a PTA of 368 days was timely filed on July 12, 2018.

Decision

Upon review, the USPTO finds that patentee is entitled to three hundred thirty-nine (339) days of PTA. Patentee and the Office are in agreement regarding the amount of “A” delay under 35 U.S.C. § 154(b)(1)(A), “C” delay under 35 U.S.C. § 154(b)(1)(C), Overlap under 35 U.S.C. § 154(b)(2)(A), and Applicant Delay under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704.

The sole disagreement between patentee and the Office is with respect to the amount of reduction of PTA under B” delay under 35 U.S.C. § 154(b)(1)(B).

“A” Delay

The patentee and Office agree that there are 366 days of “A” delay. The periods of “A” delay are:

- (1) 287 days under 37 CFR 1.703(a)(1), beginning on November 7, 2014 (the day after the date that is fourteen months after the day the application was filed) and ending on August 20, 2015 (the date the first Office action was mailed); and
- (2) 79 days under 37 CFR 1.703(a)(4), beginning on December 10 2017 (the day after the date that is four months after the date an appeal brief was filed) and ending on February 26, 2018 (the date of mailing of a notice of allowance).

“B” Delay

The patentee and Office disagree over the period of “B” delay. Patentee asserts the period of “B” delay is 30 days, not 1 day as the Office has calculated.

Novartis AG v. Lee, 740 F.3d 593 (Fed. Cir. 2014) 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

The length of time between application filing and issuance is 1748 days, which is the number of days beginning on the filing date of the application (September 6, 2013) and ending on the date the patent issued (June 19, 2018).

The Request argues the continued examination time should begin on June 15, 2016, the date the May 18, 2016 RCE was forwarded to the examiner, rather than May 18, 2016, the date the RCE was actually filed. The Office historically has maintained that time consumed by continued examination begins when an RCE is filed, not when it is forwarded to the examiner.

The Request references *Ariad Pharmaceuticals, Inc. v. Matal*, 283 F.Supp. 3d 503, 511 (E.D. Va. Jan. 5, 2018) in support of the argument that continued examination time begins when an RCE is forwarded to the examiner. In *Ariad*, the Office abandoned the application, despite the fact that a proper RCE had been filed. The court held “in computing ‘time consumed by continued examination,’ the PTO should not include time where the PTO was plainly not conducting continued examination, but instead negligently concluded that the patent application had been abandoned” (*Ariad* at 512). The Office has narrowly interpreted that language to apply to the

¹ *Novartis*, 740 F.3d at 601.

instance where a RCE was filed, but not acknowledged, and the application was subsequently improperly abandoned. In this application, a proper RCE was filed and acknowledged, and the application was never erroneously abandoned. At no point was the May 18, 2016 RCE mishandled. This application's fact pattern simply does not follow the specific scenario in *Ariad*.

Therefore, the time consumed by continued examination is 650 days, beginning on the filing date of the RCE (May 18, 2016) and ending on the mailing date of the notice of allowance (February 26, 2018).

The number of days beginning on the filing date of application (September 6, 2013) and ending on the date three years after the filing date of the application (September 6, 2016) is 1097 days.

The result of subtracting the time consumed by continued examination (650 days) from the length of time between the application's filing date and issuance (1748 days) is 1098 days, which exceeds three years (1097 days) by 1 day. Therefore, the period of "B" delay is 1 days.

"C" Delay

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

Overlap

The patent and the Office agree that the amount of overlap under 35 § USC 154(b)(2)(A) is zero days.

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

The patentee and the Office agree that the amount of Applicant delay is 28 days. The period of Applicant delay is:

- (1) 28 days pursuant to 37 CFR 1.704(b) for the period beginning May 15, 2017 and ending June 12, 2017. The Office mailed a final Office action on February 13, 2017. Accordingly, the three-month response date was Monday, May 15, 2017. However, patentee did not file a proper reply, in the form of a notice of appeal, until June 12, 2017.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X days of PTA

USPTO's Calculation:

$$366 \text{ (i.e., } 287 + 79) + 1 \text{ (i.e., } 1748 - 650 - 1097) + 0 - 0 - 28 = 339$$

Patentee's Calculation:

$$366 \text{ (i.e., } 287 + 79) + 30 \text{ (i.e., } 1748 - 621 - 1097) + 0 - 0 - 28 = 368$$

Patentee is entitled to PTA of three hundred thirty-nine (339) days. Using the formula "A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X, the amount of PTA is calculated as following: $366 + 1 + 0 - 0 - 28 = 339$ days.

Telephone inquiries regarding this decision may be directed to Attorney Advisor Shirene Willis Brantley at (571) 272-3230.

/ROBERT CLARKE/

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