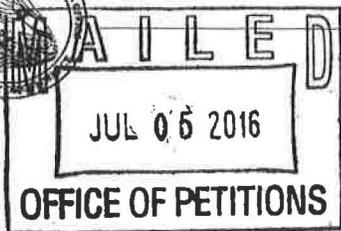




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In re Patent No. 6,762,180 :
Roth et al. :
Issue Date: July 13, 2004 : ON PETITIONS UNDER 37 CFR
Application No. 09/678,682 : 1.183 AND ON REQUEST FOR
Filed: October 3, 2000 : RECONSIDERATION OF
Attorney Dkt. No. 05-1275 : PATENT TERM ADJUSTMENT
Title: SUBSTITUTED INDOLINES :
WHICH INHIBIT RECEPTOR TYROSINE :
KINASES :

This is a decision on the 1) Petition under 37 C.F.R. 1.183, requesting that the Office suspend the rules and consider on the merits a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) filed more than two months from the date the above-referenced patent issued; and on the 2) Request for Determination of Patent Term Adjustment - Post Grant, both filed on April 8, 2013.

The petition under 37 CFR 1.183 is DENIED.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is DENIED.

On July 13, 2004, the above-identified application matured into U.S. Patent No. 6,762,180, with a revised patent term adjustment of 68 days. No request for reconsideration of the patent term adjustment indicated in the patent was filed within two months of the date the patent issued. Patentee now petitions under 37 C.F.R. § 1.183 to (i) suspend or waive the requirement of 37 C.F.R. § 1.705(d) that a Request for Reconsideration of Patent

Term Adjustment be filed within two months of the date the patent issued; and (ii) consider the enclosed Request for Reconsideration of Patent Term Adjustment.

**ON PETITION UNDER 37 CFR 1.183
TO WAIVE THE TWO-MONTH REQUIREMENT OF 37 CFR 1.705(d)**

The above-referenced patent issued on July 13, 2004. A request for reconsideration of the patent term adjustment indicated in the patent was not filed until April 8, 2013. Petitioner requests that the Office suspend the rules and consider on the merits the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) even though it was untimely filed more than two months from the date the patent issued.

35 U.S.C. 154 requires the Office to provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director, authorizes the Director to establish the procedures for requesting such reconsideration. [T]he USPTO promulgated 37 C.F.R. § 1.705(d), which required a patent holder dissatisfied with the USPTO's calculation of a patent term adjustment to file a request for reconsideration within two months after the patent issues. Roth did not do so. Additionally, under the version of Section 154(b) in effect in 2004, patent holders had 180 days from the patent's issuance to file suit challenging the calculation of a patent term adjustment. Roth also did not file such a suit for the '180 patent. Because Roth chose not to timely avail itself of either of these means to challenge the patent term adjustment determination of the '180 patent, it cannot belatedly seek to do so now—even if it styles its request as a Rule 1.183 petition seeking to suspend or waive the time limit of Rule 1.705(d) because Roth cannot show its untimeliness was due to an "extraordinary situation."

Instead, approximately 9 years after the patent issued and more than three years after the after the district court issued its decision in the *Wyeth* case, Roth filed Rule a 1.183 petition with the USPTO for the '180 patent asking the USPTO to waive its two-month time limit for Rule 1.705(d) requests and reconsider the patent term adjustment determinations for the '180 patent in view of the *Wyeth* district court decision. In support, Roth argued that the issuance of the *Wyeth* district court decision and its failure to realize the applicability of the decision to the '180 patent until after the passage of the 180-day period

from the patents' issue dates demonstrated an "extraordinary situation where justice requires remedial action" by the USPTO under 37 C.F.R. § 1.183. Roth's arguments failed to explain "why they could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date" the patent issued.

The USPTO's petition decision comports with the Federal Circuit's decisions in *Novartis v. Lee*, 740 F.3d 593 (Fed. Cir. 2014), and in *Daiichi Sankyo Co. v. Lee*, 791 F.3d 1373 (Fed. Cir. 2015). In its *Novartis* decision, the Federal Circuit emphasized that a party cannot sit back and wait for another litigant to bring a successful challenge and then resuscitate its own time-barred claim by relying on a theory of equitable tolling. *Novartis*, 740 F.3d at 600 ("A fortiori equitable tolling is unavailable where, as here, there is no reason even to doubt that the litigant knew the legal theory, but just waited until another person secured a favorable ruling on the theory in another case."). This is precisely what Roth admitted it did in this case when it claimed that its petition was untimely because it simply did not appreciate the applicability of the *Wyeth* decision until after the 180-day period of Section 154(b)(4) had passed.

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(d) is Denied.

Accordingly, consideration now turns to the Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d).

**ON REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)**

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed April 8, 2013. Therein, patentee requests correction of the patent term adjustment (PTA) indicated in the patent to three hundred ten (310) days.

The instant request for reconsideration was filed more than 9 years after the issuance of the patent on July 13, 2004. Since the request was not filed within two months of the issue date of the patent, the request is properly DENIED.

Receipt of the fees required for the petition under 37 CFR 1.183 and the application for patent term adjustment is acknowledged.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Attorney Advisor, at (571) 272-3215.

/Kery Fries/

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Office of the Deputy Commissioner for
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