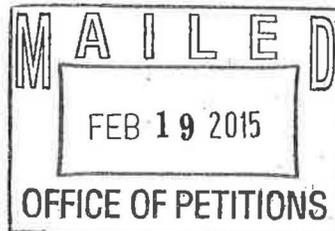




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In re Patent No. 8,277,500 :
Schmid et al. : DECISION ON REQUEST
Issue Date: 10/02/2012 : FOR RECONSIDERATION OF
Application No. 11/455,986 : PATENT TERM ADJUSTMENT
Filed: 06/20/2006 :
Attorney Docket No: REVAMD.027CP1 :

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT UNDER 37 C.F.R. § 1.705(b),” filed on August 20, 2014. The request is treated as one in which patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand three hundred eighty (1380) days to one thousand six hundred fifty-four (1654) days. This is also a decision on the concurrently-filed petition under 37 CFR 1.182 requesting that the redetermination of the patent term adjustment be stayed until the completion of *Gilead Sciences, Inc. v. Lee*, Case No. 2014-1159 (Fed. Cir. 2014).

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 patent adjustment determination under 35 U.S.C. 154(b) of 1380 days. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. 704 and for purposes of seeking judicial review. See MPEP 1002.02.

The petition under 37 CFR 1.182 is **DISMISSED**.

BACKGROUND

On October 2, 2012, the above-identified application matured into U.S. Patent No. 8,277,500, with a revised patent term adjustment of 1580 days. On November 29, 2012, an application for patent term adjustment was filed. On May 20, 2014, a decision on Redetermination of Patent Term Adjustment was mailed, stating that the Office had re-determined the PTA to be 1380

days. This redetermination included entry of a period of reduction of 251 days pursuant to 37 CFR 1.704(c)(8) for the filing of a supplemental reply or other paper on 251 days after the day after the date a reply was filed and entry of a period of reduction of 23 days pursuant to 37 CFR 1.704(c)(8) for the filing of a supplemental reply or other paper 23 days after the day after the date a reply was filed.

On August 20, 2014, the subject request for reconsideration was filed. Patentee asserts that the reductions of 251 days and 23 days should be withdrawn. Specifically, patentee states that the 251-day delay involved a series of supplemental IDSs filed after an RCE had been filed. Patentee asserts that because nearly 7 months passed between the filing of the supplemental IDSs and the review of the prior art by the Examiner, the filing of the IDSs should not be considered undue delay by the applicant, and that the reduction of 251 days is not warranted.

Likewise, patentee asserts that the 23 day reduction for the filing of an IDS after a non-final Office action should not be considered undue delay because the supplemental IDS filed 23 days after the reply was filed contained only a single reference, and the Examiner reviewed the single reference on that same day, along with the references filed with the reply to the Office action.

STATUTE AND REGULATION

35 U.S.C. 154(b)(2)(C) as amended by the Leahy-Smith America Invents Act (AIA)¹ provides:

REDUCTION OF PERIOD OF ADJUSTMENT.—

- (i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.
- (ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.
- (iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

¹ Public Law 112-29, 125 Stat. 284 (Sept. 16, 2011).

37 CFR 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.704(c) states, in pertinent part:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

37 CFR 1.704(d) states:

(1) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement:

(i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

(2) The thirty-day period set forth in paragraph (d)(1) of this section is not extendable.

OPINION

Patentee's argument has been considered, but is not persuasive. It is undisputed that on December 14, 2010, a reply (an RCE and submission) were filed, and that on August 22, 2011, 251 days after the day after the date the reply was filed, a supplemental reply or other paper (an IDS) was filed. The IDS was neither expressly requested by the examiner nor accompanied by a statement under 37 CFR 1.704(d). As such, the filing of the IDS constitutes a failure to engage in reasonable efforts to conclude processing or examination. Whether or not applicant believes the filing of the IDSs constituted "undue delay" is not relevant.

Furthermore, it is undisputed that on July 12, 2012, a supplemental reply or other paper (an IDS) was filed, 23 days after the day after the date a reply was filed, and that IDS was also neither expressly requested by the examiner nor accompanied by a statement under 37 CFR 1.704(d). In this regard, the number of references contained in the IDS is not at issue. 37 CFR 1.704(c)(8) states that an IDS filed as a supplemental reply will be considered a failure to engage in reasonable efforts to conclude processing or examination if the IDS is not accompanied by a statement under 37 CFR 1.704(d).

With regard to the petition under 37 CFR 1.182, the petition is dismissed. Under the circumstances of this case, patentee may file a renewed petition (no fee required) within two months of the issuance of an opinion by the Federal Circuit on the matter referenced in the petition under 37 CFR 1.182. No extensions of the two (2)-month time period are permitted.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

$1324 + 615 + 0 - 283 - 276 = 1380$

Patentee's Calculation

$1324 + 615 + 0 - 283 - 2 = 1654$

In view of the redetermination, the petition is granted to the extent that the PTA calculation has been revised, but is denied with respect to any change in redetermination of the PTA.

CONCLUSION

The request for reconsideration of the revised patent term adjustment is denied.

The petition under 37 CFR 1.182 is dismissed.

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e) and the \$400.00 fee set forth in 37 CFR 1.17(f).

Telephone inquiries specific to this matter should be directed to Attorney Advisor Douglas I. Wood at 571-272-3211.



John Cottingham
Director
Office of Petitions