



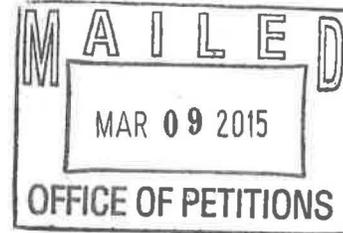
UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 8,431,567
Geneste et al.
Issue Date: April 30, 2013
Application No. 12/438,696
Filed or 371(c): August 31, 2009
Attorney Docket No. 057977-140250
(8331USO1)
Title: SUBSTITUTED OXINDOLE
DERIVATIVES AND THEIR USE AS
VASOPRESSIN AND/OR OXYTOCIN
RECEPTOR LIGANDS

:
: DIRECTOR'S DECISION ON
: PATENT TERM ADJUSTMENT

:
:
:
:
:
:
:
:
:
:



This is a response to applicants "Request for Reconsideration of Patent Term Adjustment" filed pursuant to 37 CFR 1.705(b) on November 11, 2014 requesting that the Office adjust the PTA from 418 days to 566 days.

The redetermination of patent term adjustment is **DENIED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 418 days.

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

This redetermination of patent term adjustment is the Director's decision on the applicant's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

Relevant Procedural History

On April 30, 2013, this patent issued with a patent term adjustment determination of 0 days. On June 27, 2013, patentee timely filed a request for redetermination of patent term adjustment, requesting that patentee be granted a patent term adjustment of 578 days. The Office issued a redetermination of patent term adjustment in the amount of 418 days on September 23, 2014. On November 11, 2014, patentee timely requested reconsideration of the patent term.

Decision

Patentee agrees with the Office's calculation of A delay of 266 days, C delay of 0 day, 25 days of overlap and 92 days of applicant delay. Patentee disputes B delay.

Art Unit: OPET

Patentee contends that the USPTO failed to properly account for the delay under 35 U.S.C. §154(b)(1)(B), referred to as the “B delay.” Patentee maintains that the B delay is 417 days (not 269 days). Patentee maintains the exclusion period ends at allowance unless examination on the merits resumes. In this instance petitioner contends the exclusion period should be calculated from the filing of the Request for Continued Examination (RCE) until the mailing of the non-final Office action on April 11, 2012. With a B delay of 417, Patentee states that the correct PTA is 566 days.

Pursuant to the Novartis decision, the USPTO has determined that the patentee remains entitled to 269 days of “B” delay. In this case, the commencement date of the application is February 26, 2009 and the patent issued on April 30, 2013. Thus, the application was pending for 1525 days. During this period, applicant filed an RCE on March 30, 2012. The Office mailed two Notices of Allowance on January 19, 2012 and September 5, 2012. Under 35 USC 154(b)(1)(B)(i), the time period consumed by continued examination (“RCE period”) began on March 30, 2012 and ended on September 5, 2012, i.e., 160 days. Subtracting the RCE period from the total number of days the application was pending results in $1525 - 160 = 1365$ days. Thus, for purposes of “B” delay, the application was pending for $1365 - 1096$ [i.e., 3 years from the actual filing date] = 269 days beyond the three-year anniversary of the filing date.

Any period of examination after the mailing of a notice of allowance resulting from the filing of a subsequent request for continued examination would be considered “time consumed by continued examination” but a period of examination after the mailing of a notice of allowance resulting from the Office *sua sponte* reopening prosecution would not be considered “time consumed by continued examination”. See 80 Fed. Reg. 1346, 1349 (January 9, 2015).

The time period between a request for continued examination and a notice of allowance is “time consumed by continued examination of the application requested by the applicant under section 132(b)” regardless of whether the Office issues an Office action under 35 U.S.C. 132. See 80 Fed. Reg. 1346, 1350 (January 9, 2015).

The Office finds that there are 25 days of overlapping days of Office delay. In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the United States Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the “A” and “B” delays. The days of overlap begin on April 6, 2013 and ends on April 30, 2013.

Overall PTA Calculation

Formula:

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

Art Unit: OPET

USPTO's Calculation:

$$266 + 269 + 0 - 25 - 92 = 418$$

Patentee's Calculation

$$266 + 417 + 0 - 25 - 92 = 566$$

Conclusion

Patentee remains entitled to PTA of four hundred eighteen (418) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $266 + 269 + 0 - 25 - 92 = 418$ days.

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

/JOHN COTTINGHAM/
Director
Office of Petitions/
Petitions Officer