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 Application of	:	
Remenar et al.	:	
Application No. 12/823,007	:	
Filed: June 24, 2010	:	DECISION ON REQUEST
Patent No. 8,431,576	:	FOR RECONSIDERATION OF
Issue Date: April 30, 2013	:	PATENT TERM ADJUSTMENT
Attorney Docket No.: 4165.3028 US2	:	
Title: HETEROCYCLIC COMPOUNDS FOR	:	
THE TREATMENT OF NEUROLOGICAL	:	
AND PSYCHOLOGICAL DISORDERS	:	

This is a response to Patentee's "third request for reconsideration of patent term adjustment," filed December 9, 2015 pursuant to 37 C.F.R. § 1.705(b), requesting that the Office adjust the patent term adjustment from one hundred and twenty-four (124) days to two hundred and thirty-four (234) days.

The concurrent receipt of a three-month extension of time so as to make timely this submission is acknowledged.

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 one hundred and twenty-four (124) days.

This redetermination of patent term adjustment 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

On April 30, 2013, the Office determined that applicant was entitled to 88 days of PTA.

On June 3, 2013, Patentee filed a request for redetermination of patent term adjustment requesting a PTA of 234 days, pursuant to 37 C.F.R. § 1.705(b). On June 4, 2013, the $200.00 fee set forth in 37 C.F.R. § 1.18(e) was received.

On June 30, 2014, the Office mailed a redetermination of patent term adjustment, which indicates the Office has re-determined the patent term adjustment to be 96 days.

On August 14, 2014, Patentee filed a second request for redetermination of patent term adjustment requesting a PTA of 234 days, pursuant to 37 C.F.R. § 1.705(b).

On July 17, 2015, the Office mailed a redetermination of patent term adjustment, which indicates the Office has re-determined the patent term adjustment to be 124 days.

Decision

Upon review, the USPTO finds that Patentee is entitled to one hundred and twenty-four (124) days of PTA. Patentee and the Office are in agreement regarding the amount of "A" delay under 35 § USC 154(b)(1)(A), "B" delay under 35 U.S.C. 154(b)(1)(B), "C" delay under 35 U.S.C. 154(b)(1)(C), and overlap under 35 § USC 154(b)(2)(A).

The sole issue in dispute is the amount of reduction of PTA under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704.

"A" Delay

The Patentee and Office agree that there are 234 days of "A" delay. The periods of "A" delay are:

(1) 121 days under 37 C.F.R. § 1.703(a)(1) beginning on August 25, 2011 (the day after the date that is fourteen months after the day the application was filed and ending on December 23, 2011 (the date the first Office action was mailed);

(2) 113 days under 37 C.F.R. § 1.703(a)(6) beginning on January 8, 2013 (the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied) and ending on April 30, 2013 (the date a patent was issued).

"B" Delay

The Patentee and the Office agree that the amount of B delay under 35 U.S.C. § 154(b)(1)(B) is zero days: this patent issued less than three years after it was filed, and therefore there is no over-three year period.

"C" Delay

The Patentee and the Office agree that the amount of "C" delay under 37 C.F.R. § 1.703(e) is zero days.

Overlap

The Patentee and the Office agree that the amount of overlap under 35 U.S.C. § 154(b)(2)(A) is zero days.

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

The Office finds that under 37 C.F.R. § 1.704, the amount of PTA should be reduced by 110 days.

The Office has determined that Patentee failed to engage in reasonable efforts to conclude processing or examination of its application during the following periods.

(1) A 94-day period pursuant to 37 C.F.R. § 1.704(c)(10)(i) beginning on October 3, 2012 and ending on January 4, 2013. A notice of allowance was mailed on July 20, 2012. A notice to file corrected application papers was mailed on September 12, 2012. Amendments to the drawings were received on October 3, 2012, and a "response to Rule 312 communication" was mailed on January 4, 2013, which indicates "[t]he amendment filed on 03 October 2012 under 37 CFR 1.312 has been considered, and has been: entered."

Patentee argues that no reduction is warranted, and makes three arguments. First, Patentee concedes "Applicants inadvertently filed an extra Figure identified as Figure 10,"[1] asserts the filing error which necessitated the notice to file corrected application papers of September 12, 2012 occurred on September 22, 2010 (Patentee introduced a drawing that is not described in the specification), and argues the Office should have informed Patentee of its own filing error earlier.

Second, Patentee argues the period of reduction associated with the amendment should not terminate with the "response to Rule 312 communication" which was mailed on January 4, 2013, but rather with two internal entries in the PTA Calculations that do not correspond to any documents that were mailed (specifically, line 83 which is "workflow – drawings finished" and is dated October 3, 2012, and line 86 which is "Pubs Case Remand to TC" and is dated December 19, 2012.")[2]

Third, Patentee argues the amendment to the drawings that were submitted on October 3, 2012 after the mailing of a notice of allowance "was filed within three months following receipt of the notice to which it responded" and asserts "[t]he USPTO may not lawfully adjust Patentee's PTA for Paper No. 85 under 35 U.S.C. § 154(b)(2)(C)(ii). Hence, to be lawful, any adjustment to Patentee's PTA must satisfy 35 U.S.C. § 154(b)(2)(C)(i)."[3]

Each of Patentee's arguments has been carefully considered but has not been found to be persuasive.

Regarding the first argument, it was Patentee's filing error which resulted in the need for corrected drawings, as opposed to the Office's failure to inform Patentee of its filing

[1] Petition, page 2.
[2] *Id.* at 3.
[3] *Id.*

error. Patentee asserts that the issue involving the erroneous Figure "was obvious on its face and could have easily and summarily dealt with in a phone call and Examiner's amendment to cancel the figure" and further asserts "Issuing a Notice and necessitating an amendment to cancel the figure was not required."[4] On the fourth page of the petition, Patentee argues that the Examiner should have caught Patentee's error earlier during prosecution. However, this is not the standard for determining whether a reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(10)(i). Patentee filed an amendment to the drawings after the mailing of a notice of allowance, and as such, a reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(10)(i).

Regarding the second argument, the language of 37 C.F.R. § 1.704(c)(10) sets forth:

> 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:
>
> Submission of an amendment under § 1.312 or other paper, other than a request for continued examination in compliance with § 1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
>
> (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper (emphasis added); or
>
> (ii) Four months;

37 C.F.R. § 1.704(c)(10)(i) requires a document to have been mailed in order to stop the period of reduction. Therefore, the period of reduction pursuant to 37 C.F.R. § 1.704(c)(10)(i) terminates not with the entry of either of the two aforementioned internal notations that does not correspond to any document that was mailed, but rather with the mailing of the "response to Rule 312 communication" on January 4, 2013. It follows that the period of reduction associated with the amendment terminates with the "response to Rule 312 communication" which was mailed on January 4, 2013.

Regarding the third argument, the Office agrees that the amendment to the drawings that was submitted on October 3, 2012 was filed less than three months after the mailing of the notice to file corrected application papers on September 12, 2012. As a result, no reduction is warranted pursuant to 37 C.F.R. § 1.704(b). However, it is controlling that

[4] Renewed petition, page 3.

the amendment to the drawings was submitted subsequent to the mailing of a notice of allowance on July 20, 2012, and as such, a reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(10)(i) – not 37 C.F.R. § 1.704(b) - and the fact that a response to the notice was received in less than three months is not relevant to the reduction that was accorded pursuant to 37 C.F.R. § 1.704(c)(10)(i).

2) A 16-day period pursuant to 37 C.F.R. § 1.704(c)(10)(i) beginning on March 18, 2013 and ending on April 2, 2013. A notice of allowance was mailed on July 20, 2012. A notice to file corrected application papers was mailed on March 15, 2013. An amendment to the specification was received on March 18, 2013, and a "response to Rule 312 communication" was mailed on April 2, 2013, which indicates "[t]he amendment filed on 18 March 2013 under 37 CFR 1.312 has been considered, and has been: entered."

Patentee argues that no reduction is warranted, and makes three arguments. First, Patentee argues the amendment to the specification that was submitted on March 18, 2013 after the mailing of a notice of allowance "was filed within three months following receipt of the notice to which it responded" and asserts "[t]he USPTO may not lawfully adjust Patentee's PTA for Paper No. 101 under 35 U.S.C. § 154(b)(2)(C)(ii). Hence, to be lawful, any adjustment to Patentee's PTA must satisfy 35 U.S.C. § 154(b)(2)(C)(i)."[5]

Second, Patentee argues that the Office should have informed Patentee of its filing error earlier.[6]

Third, Patentee disputes the appropriateness of the notice to file corrected application papers of March 15, 2013.[7]

Each of Patentee's arguments has been carefully considered but has not been found to be persuasive.

Regarding the first argument, the Office agrees that the amendment to the specification that was submitted on March 18, 2013 was submitted less than three months after the mailing of the notice to file corrected application papers on March 15, 2013. As a result, no reduction is warranted pursuant to 37 C.F.R. § 1.704(b). However, it is controlling that the amendment to the specification was submitted subsequent to the mailing of a notice of allowance on July 20, 2012, and as such, a reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(10)(i) – not 37 C.F.R. § 1.704(b) - and the fact that a response to the notice was received in less than three months is not relevant to the reduction that was accorded pursuant to 37 C.F.R. § 1.704(c)(10)(i).

Regarding the second argument, it was Patentee's filing error which resulted in the need for an amendment to the specification, as opposed to the Office's failure to earlier inform

[5] *Id.* at 4.
[6] *Id.* at 5.
[7] *Id.*

Patentee of its filing error. Applicants have a responsibility to file papers which comply with the relevant regulations, and Patentee filed chemical formulae which fail to comply with 37 C.F.R. § 1.58(b). Patentee takes issue with the "belated"[8] notification that an amendment to the specification were required, however this is not the standard for determining whether a reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(10)(i). This Rule clearly states that the submission of an amendment under § 1.312 or other paper, other than a request for continued examination in compliance with § 1.114, after a notice of allowance has been given or mailed will result in a patent term reduction. As Patentee concedes on page 27 of the submission received on March 18, 2013, Patentee submitted figures which were cut-off. It follows the Office mailed a notice requiring figures that are not cut-off, and the subsequent submission of figures after the mailing of a notice of abandonment warrants a reduction pursuant to 37 C.F.R. § 1.704(c)(10)(i).

Regarding the third argument, it is noted the notice to file corrected application papers which was mailed on March 15, 2013 set forth, *in pertinent part*:

> Applicant must provide missing information on the following page(s) of the specification by amending the specification to add the missing text. No new matter may be added. Pages 23, 24, 26-28, 30, 31 and 37-40 contains cut off data, (please see Table 1).

Patentee's third argument has not been found to be persuasive for the following two reasons.

First, the Office notes that on page 27 of the submission received on March 18, 2013, Patentee disputes the assertion that the specification is missing text, but also *appears to agree with the assertion set forth in the notice that the figures contain cut off data.* The full text of the relevant paragraph is as follows:

> *[t]ables 1 and 2 are resubmitted with indicated figures resized to avoid cut-off as indicated in the notice to file corrected application papers* (emphasis added). The Applicants disagree that the specification is missing text. The structures are clear from the tables and the context in which they are presented. For the sole purpose of expediting issuance of the application, the indicated structures in Tables 1 and 2 are resized. No new matter is added by the filing of the replacement papers.

With this petition, Patentee asserts on the fifth page that "[t]here is nothing in the language that suggests that patent agreed with the requirement." While it is true that Patentee expressly disagreed that the specification is missing text, Patentee expressly conceded that the figures were cut-off. As such, the submission of March 18, 2013 was submitted so as to correct an error set forth in the notice.

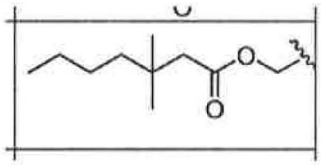
---

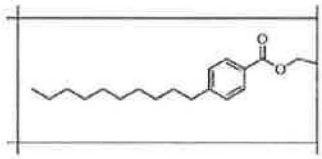
[8] *Id.*

On second renewed petition, Patentee argues on the fifth page that "there is no PTO rule that says the contents of a table cell cannot touch or contact the borders of a cell." Patentee will note 37 C.F.R. § 1.58(b) sets forth, *in toto*:

> Chemical and mathematical formulae and tables
>
> Tables that are submitted in electronic form (§§1.96(c) and 1.821(c)) must maintain the spatial relationships (e.g., alignment of columns and rows) of the table elements when displayed so as to visually preserve the relational information they convey. Chemical and mathematical formulae must be encoded to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning.

Two chemical formulae representative of the issue at hand are as follows:





Due to the fact that the chemical formulae touch the borders of the cells, they were cut-off, as asserted by the Office of Data Management in the notice of March 15, 2013 and conceded by Patentee page 27 of the submission received on March 18, 2013. As such, it is unclear whether there might be more to the molecule, and it is not immediately apparent whether or not these formulae are incomplete. It is for this reason that the chemical formulae fail to comply with 37 C.F.R. § 1.58(b): the chemical formulae failed to maintain the proper positioning of their characters when displayed, and did not preserve their intended meaning.

Second, it is noted that each of the pages set forth in the notice comprise material that lies within Table 1. The amendment submitted on March 18, 2013 however contains amendments to Table 1 and Table 2.[9] As such, *the submission of March 18, 2013 contains amendments to material in the specification that is in addition to that which was explicitly required by the notice.*

[9] *See* pages numbered "page 24 of 27" through "pages 27 of 27" of the amendment received on March 18, 2013.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

234 (121 + 113) + 0 + 0 – 0 – 110 (94 + 16) = 124

Patentee's Calculation:

234 (121 + 113) + 0 + 0 – 0 – 0 = 234

Conclusion

Patentee is entitled to PTA of one hundred and twenty-four (124) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - Applicant delay = X, the amount of PTA is calculated as following: 234 + 0 + 0 – 0 -110 = 124 days.

The Office will *sua sponte* issue the certificate of correction in an amount of 124 days. The Office notes that it did not issue the certificate of correction after the redeterminations mailed on June 24, 2014 and July 15, 2015 because Patentee timely filed a request for reconsideration. Accordingly, the Office will now have a certificate of correction mailed adjusting the amount of PTA.

Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.[10]

/ /
Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

Encl: Adjusted PTA calculation
DRAFT Certificate of Correction

[10] Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT	:	8,431,576 B2
DATED	:	Apr. 30, 2013
INVENTOR(S)	:	Remenar et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 96 days.

Delete the phrase "by 96 days" and insert – by 124 days--