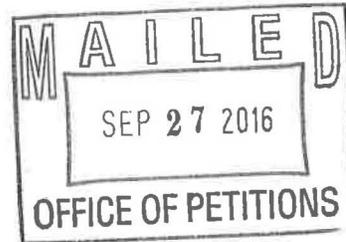




UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent of Teeling et al. :
Patent No. 8,529,902 : DECISION ON REQUEST FOR
Issue Date: September 10, 2013 : REDETERMINATION OF PATENT
Application No. 10/687,799 : TERM ADJUSTMENT
Filing Date: October 17, 2003 :
Attorney Docket No. 12166.0005-00000 :

This is a decision on the “PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT REDETERMINATION,” (“Request 2”) filed August 7, 2015, which requests the United States Patent and Trademark Office (“Office”) correct the patent term adjustment determination (“PTA”) set forth on the patent to indicate the term of the patent is extended or adjusted by two thousand eight hundred ninety-nine (2899) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered and the 32 day applicant delay pursuant to 37 CFR 1.704(c)(7) for the filing of a reply with an omission on May 3, 2004 is removed; however, the request for reconsideration of patent term adjustment (“PTA”) is **DENIED** with respect to making any change to the 139 day applicant delay pursuant to 37 CFR 1.704(c)(7) for the filing of a reply with an omission on February 11, 2008. The patent adjustment determination under 35 U.S.C. § 154(b) is two thousand seven hundred sixty (2760) days.

This is the Director’s decision on the applicant’s request for reconsideration under 35 USC 154(b)(3)(B)(ii). Any appeal from this decision is pursuant to 35 U.S.C. § 154(b)(4)(A).

Relevant Procedural History

The patent issued with a PTA determination of 2481 days on September 10, 2013. The first request seeking an adjustment of 2946 days was timely filed November 12, 2013, November 10, 2013 being a Sunday and November 11, 2013 being a federal holiday. The updated request seeking an adjustment of 2901 days and a four month extension of time were timely filed on March 10, 2014. The Office mailed a redetermination of patent term adjustment on January 13, 2015, which concluded the PTA on the face of the issued patent should be amended to 2728 days. Request 2 and a petition under 37 CFR 1.136(a) for a five month extension of time were timely filed on August 7, 2015.

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Decision

The following determinations regarding PTA were previously set forth in the January 13, 2015 redetermination of patent term adjustment:

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 1767 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 2473 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) ("C Delay") is 0 days;
- (4) The number of days of overlapping delay ("Overlap") between the periods of A Delay, B Delay, and C Delay is 1098 days; and
- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) ("Applicant Delay") is 414 days.

The PTA to be set forth on a patent is the sum of the days of A Delay, B Delay, and C Delay reduced by the number of days of Overlap and Applicant Delay. In other words, the following formula may be used to calculate the PTA:

$$\text{PTA} = \text{A Delay} + \text{B Delay} + \text{C Delay} - \text{Overlap} - \text{Applicant Delay}$$

The January 13, 2015 redetermination of PTA calculates a PTA of 2728 days (1767 days of A Delay + 2473 days of B Delay + 0 days of C Delay - 1098 days of Overlap - 414 days of Applicant Delay).

Request 2 asserts no reduction, not a 32 day period of reduction, is warranted under 37 CFR 1.704(c)(7) in connection with the filing of replacement drawings on May 3, 2004, which corrected the purported omission in the reply filed April 1, 2004.

In addition, Request 2 argues no reduction, not a 139 day reduction is warranted under 37 CFR 1.704(c)(7) for the filing of a reply on November 10, 2008 that corrected the purported omission in a reply filed June 24, 2008. Request 2 argues the June 24, 2008 reply did not contain an omission.

Request 2 argues the period of Applicant Delay is 243 days (63 + 6 + 24 + 150).

Request 2 asserts the correct PTA is 2899 days (1767 days of A Delay + 2473 days of B Delay + 0 days of C Delay - 1098 days of Overlap - 243 days of Applicant Delay).

On decision on request for reconsideration of patent term adjustment mailed January 13, 2015, a 32 day period of reduction, was entered pursuant to 37 CFR 1.704(c)(7) in connection with the filing of replacement drawings on May 3, 2004, following the filing of initial drawings on April 1, 2004. Upon further review, it is determined that the delay at issue was controlled by 37 CFR 1.704(b), and as a complete and proper reply was filed within three months to the Notice to File Missing Parts of Application, no reduction pursuant to 37 CFR 1.704(b) (or any other section) was warranted. The 32 day period of reduction has been removed.

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The Office disagrees that no reduction, rather than a 139 day reduction is warranted under 37 CFR 1.704(c)(7) for the filing of a reply on November 10, 2008 that corrected an omission in a reply filed June 24, 2008.

The Office finds the period of Applicant Delay is 382 days (63 + 6 + 139 + 24 + 150).

Therefore, the correct PTA is 2760 days (1767 days of A Delay + 2473 days of B Delay + 0 days of C Delay - 1098 days of Overlap - 382 days of Applicant Delay).

A Delay

Request 2 does not dispute the Office's prior determination the period of A Delay is 1767 days. The Office has recalculated the period of A Delay as part of the Office's redetermination of the PTA and confirmed the period of A Delay is 1767 days.

B Delay

Request 2 does not dispute the Office's prior determination the period of B Delay is 2473 days. The Office has recalculated the period of B Delay as part of the Office's redetermination of the PTA and confirmed the period of B Delay is 2473 days.

C Delay

Request 2 does not dispute the Office's prior determination the period of C Delay is 0 days. The Office has recalculated the period of C Delay as part of the Office's redetermination of the PTA and confirmed the period of C Delay is 0 days.

Overlap

Request 2 does not disputes the Office's prior determination the number of days of Overlap is 1098 days. The Office has recalculated the number of days of Overlap as part of the Office's redetermination of the PTA and confirmed the number of days of Overlap is 1098 days.

Applicant Delay

Request 2 disputes the Office's prior determination the period of Applicant Delay is 414 days. The Office has recalculated the period of Applicant Delay as part of the Office's redetermination of the PTA and determined the period of Applicant Delay is 382 days.

Request 2 asserts no reduction, not a 32 day period of reduction, is warranted under 37 CFR 1.704(c)(7) in connection with the filing of replacement drawings on May 3, 2004, which corrected the purported omission in the reply filed April 1, 2004. The arguments presented in Request 2 regarding the propriety of the 32 day period of reduction under 37 CFR 1.704(c)(7)

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have been considered and found persuasive. The Office has removed the 32 day period of reduction.

The Office does not concur that no reduction, rather than a 139 day reduction is warranted under 37 CFR 1.704(c)(7) for the filing of a reply on November 10, 2008 that corrected an omission in a reply filed June 24, 2008.

A restriction requirement was mailed on May 21, 2008, which required election between the following patentably distinct species: a) The claimed antibody, antibody fragment or bispecific molecule and b) The claimed molecule elected above which is unlabeled, conjugated with a drug, conjugated to a cytotoxic agent or conjugate to a radioisotope.

The June 24, 2008 election states, "Applicant hereby elects a) an antibody and b) which is in labeled, as the species. ..."

The October 27, 2008 communication from the Office states, "The reply filed on 6/24/08 is not fully responsive to the prior Office action because of the following omission(s) or matter(s). The previous Office Action required a species election between: b) The claimed molecule elected above which is unlabeled, conjugated with a drug, conjugated to a cytotoxic agent or conjugate to a radioisotope. It is unclear as to what "labeled" as per applicants response refers to (aka does it refer to conjugated to a drug or conjugated to a cytotoxic agent or conjugated to a radioisotope)."

The election of June 24, 2008 failed to fully reply to the election of species because the election of "which is in labeled" did not elect one of the species to which the application was directed. The November 10, 2008 election completed the reply of June 24, 2008 by providing a fully responsive election. The 139 day period of reduction under 37 CFR 1.704(c)(7) is calculated beginning on the day after the date the initial reply was filed, June 25, 2008, and ending on the date that the compliant election was filed, November 10, 2008. The 139 day period of reduction is proper and has not be removed.

The period of Applicant Delay is 382 days (63 + 6 + 139 + 24 + 150).

Conclusion

Request 2 asserts the correct PTA is 2899 days (1767 days of A Delay + 2473 days of B Delay + 0 days of C Delay - 1098 days of Overlap - 243 days of Applicant Delay).

As previously discussed, the correct period of Applicant Delay is 382 days. Therefore, the correct PTA is 2760 days (1767 days of A Delay + 2473 days of B Delay + 0 days of C Delay - 1098 days of Overlap - 382 days of Applicant Delay).

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After the mailing of this decision, the application will be referred to Certificate of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **two thousand seven hundred sixty (2760)** days.

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

/ROBERT CLARKE/

Robert A. Clarke

Patent Attorney

Office of the Deputy Commissioner

for Patent Examination Policy – USPTO

Enclosure: Draft Certificate of Correction

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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 8,529,902 B2
DATED : September 10, 2013
INVENTOR(S) : Teeling 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 2481 days.

Delete the phrase "by 2481 days" and insert – by 2760 days--