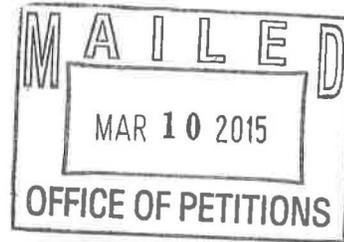




UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 8,550,492

Gwon

Issue Date: October 8, 2013

Application No. 13/128,006

Filing or 371(c) Date: May 6, 2011

Docket No.: CU-9126 JYP/AVL

:
: DECISION
: ON REQUEST FOR
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
:

This is a decision on the patent term adjustment in response to the “REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF NOVARTIS AND EXELIXIS”, filed April 4, 2014, requesting that the patent term adjustment determination for the above-identified patent be changed from 0 days to 106 days.

The request is **DENIED**.

This decision on 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.

On October 8, 2013, the above-identified application matured into U.S. Patent No. 8,550,492. The patent issued with a PTA of 0 days. The present request for redetermination of the patent term adjustment was timely filed within two months of the issue date of the patent.

The present petition

Patentees avers that pursuant to *Exelixis, Inc. v. Mr. David Kappos*, Case No. 1:12cv96 (E.D. Va. November 1, 2012), the patentees are entitled to an additional 106 days of patent term adjustment under 37 CFR 1.702(b) and 37 CFR 1.703(b).

Discussion

Patentees' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to 0 days of PTA. The Office has revisited the amount of "B" delay under 35 U.S.C. § 154(b)(1)(B) and the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A) pursuant to the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). The Office and Patentees are in agreement that the total amount of "A" delay is 0 days. Furthermore, the Office and Patentees are in agreement that the total amount of Applicant delay is 0 days.

As for the amount of "B" delay, the Federal Circuit reviewed the statutory interpretation of 35 U.S.C. § 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued Examination ("RCE") on "B" delay in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). In *Novartis*, the Federal Circuit agreed with the Office that "no ["B" delay] adjustment time is available for any time in continued examination, even if the continued examination was initiated more than three calendar years after the application's filing." *Novartis*, 740 F.3d at 601. However, the *Novartis* court found that if the Office issues a notice of allowance after an RCE is filed, the period after the notice of allowance should not be excluded from the "B" delay period but should be counted as "B" delay. *Id.* at 602. The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

Pursuant to the *Novartis* decision, the USPTO has determined that the patentee is entitled to 0 days of "B" delay. In this case, proceedings in the application commenced on May 6, 2011, and the patent issued on October 8, 2013; thus, the application was pending for 886 days. During this time, Applicants filed an RCE on January 18, 2013, and the Office mailed a Notice of Allowance on June 5, 2013. Under 35 U.S.C. § 154(b)(1)(B)(i), there was one time period consumed by continued examination ("RCE period") – from June 18, 2013, until the Notice of Allowance was issued on June 5, 2013 – *i.e.* 138 days. Subtracting the RCE period from the total number of days the application was pending results in $886 - 138 = 748$ days. Thus, for purposes of "B" delay, the application was pending for $748 - 1097$ [*i.e.*, the 3 year delay period] = 0 days beyond the 3-year anniversary of the filing date.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

$$0 + 0 + 0 - 0 - 0 = 0$$

Patentee's Calculation:

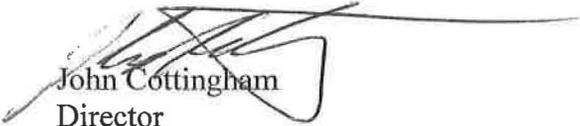
$$0 + 106 + 0 - 0 - 0 = 106$$

Conclusion

Patentee is entitled to PTA of zero (0) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $0 + 0 + 0 - 0 - 0 = 0$

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

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Attorney Advisor, at (571) 272-3222.



John Cottingham
Director
Office of Petitions