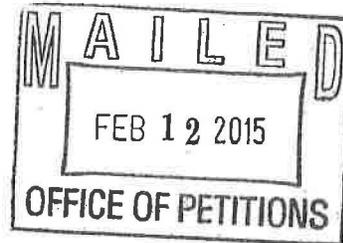




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In re Patent No. 8,631,030
Bhattacharjee, et al.
Issue Date: 01/14/2014
Application No. 12/979,639
Filing or 371(c) Date: 12/28/2010
Docket No.: 16113-2395001

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

This is a decision on the request for reconsideration of patent term adjustment, filed March 11, 2014, requesting that the patent term adjustment determination for the above-identified patent be changed from 93 days to 110 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 January 14, 2014, the above-identified application matured into U.S. Patent No. 8,585,499. The patent issued with a PTA of 93 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 filing of a Request for Continued Examination ("RCE") after the three-year pendency period has passed has no impact on PTA.

Discussion

Patentee's arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **93** 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 Patentee are in agreement that the total amount of "A" delay is 198 days, and the total amount of Applicant delay is 93 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, the application was filed on December 28, 2010, and the patent issued on January 14, 2014; thus, the application was pending for 1114 days. During this time, Applicants filed an RCE on August 5, 2013, and the Office mailed a Notice of Allowance on September 5, 2013. Under 35 U.S.C. § 154(b)(1)(B)(i), there was one time period consumed by continued examination ("RCE period") – from August 5, 2013 until the Notice of Allowance was issued on September 5, 2013 – *i.e.* 32 days. Subtracting the RCE period from the total number of days the application was pending results in $1114 - 32 = 1082$ days. Thus, for purposes of "B" delay, the application was pending for $1082 - 1097$ [*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:

$$198 + 0 + 0 - 0 - 105 = 93$$

Patentee's Calculation:

$$198 + 17 + 0 - 0 - 105 = 110$$

Conclusion

Patentee is entitled to PTA of ninety-three (93) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $198 + 0 + 0 - 105 = 93$ days.

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 Attorney Advisor Cliff Congo at (571) 272-3207.



John Cottingham
Director
Office of Petitions