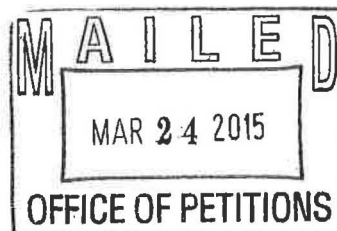




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In re Patent No. 8,637,499
Aay et al.
Issue Date: 01/28/2014
Application No. 13/322160
Filing or 371(c) Date: 06/29/2012
Atty. Docket No.:
224990/09-003C-US/319163

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: ON REDETERMINATION OF
: PATENT TERM ADJUSTMENT
:
:
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This is a response to applicants "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", requesting that the Office adjust the PTA to 69 days. The Office has re-determined the PTA to be zero (0) days.

This petition is hereby **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. *See*, MPEP 1002.02.

Relevant Procedural History

On December 17, 2013, the above-identified application matured into U.S. Patent No. 8,609,436. The patent issued with a PTA of zero (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. Patentee requests recalculation of the Patent Term Adjustment in view of *Exelixis v. Kappos*.

Decision

Patents' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **zero (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). Patentee and the Office agree as to the amount of "A" delay under 35 U.S.C. § 154(b)(1)(A) and 37 CFR 1.702(a), however, patentee and the Office continue to disagree as to the amount of "applicant delay" under 35 U.S.C. § 154(b)(2)(C) and 1.704(b).

The correct Commencement Date is November 28, 2011. The date the national stage of an international application commences is addressed in MPEP § 1893.01, which states, with emphasis added,

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. *Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application.* (Emphasis added).

The November 23, 2011 papers did not include a request for early processing. Therefore, the national stage commenced upon the expiration of 30 months from the priority date of the international application.

The date 30 months after May 26, 2009, which is the priority date of the international application, is November 26, 2011. See PCT Rule 80.5. Since the 30-month date fell on a Saturday, the 30-month time period expired on Monday, November 28, 2011. See PCT Rule 80.5. In other words, the Commencement Date is November 28, 2011.

The correct period of A-1 Delay is 67 days, which is the number of days beginning January 29, 2013, the day after the date 14 months after the Commencement Date, and ending April 5, 2013.

Regarding applicant delay, a review of the application history confirms that this Office errantly failed to assess a reduction of 113 days pursuant to 37 CFR 1.704(b) in connection with the filing of a reply to a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), mailed December 8, 2011. Applicants filed a reply to the Notification on June 29, 2012, three (3) months and 113 days after the mail date of the Notification. Accordingly, a reduction of 113 days is properly attributed to Applicants pursuant to 37 CFR 1.704(b).

Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

$$67 + 0 + 0 - 0 - 113 = 0$$

Patentee's Calculation

$$69 + 0 + 0 - 0 - 0 = 69$$

Conclusion

The present REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) has been considered; however, the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b), is DENIED.

Telephone inquiries specific to this decision should be directed to Attorney Advisor Derek Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read "John Cottingham", is written over a rectangular box.

John Cottingham
Director
Office of Petitions
Office of Deputy Commissioner
For Patent Examination Policy