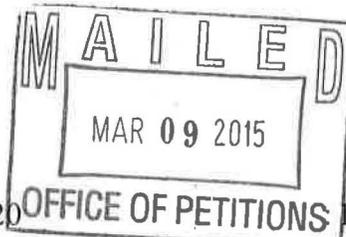




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In re Patent No. 8,637,520 :
Issued: January 28, 2014 :
Application No. 12/828,883 :
Filed: July 1, 2010 :
Atty. Dkt. No.: PRD2678USCNT1 :

DIRECTOR'S DECISION ON
PATENT TERM ADJUSTMENT

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(d) AFTER PATENT ISSUANCE," filed March 19, 2014, requesting that the patent term adjustment be increased from 441 days to 553 days.

The redetermination of patent term adjustment is **DENIED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 441 days.

THERE WILL BE NO FURTHER CONSIDERATION OF THIS MATTER BY THE OFFICE.

This redetermination of 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.

Relevant Procedural History

On January 28, 2014, this patent issued with a patent term adjustment determination of 441 days. On March 19, 2014, patentee timely filed an "Application for Reconsideration of Patent Term Adjustment under 37 C.F.R. §1.705(d)" seeking an adjustment of the determination to 553 days.

Decision

Patentee does not dispute the Office's calculation of "A" delay of 441 days, "C" delay of 0 days, overlap of 0 days or applicant delay of 0 days. At issue is the period of "B" delay.

Patentee's basis for requesting the recalculation of the determination of patent term adjustment is the ruling in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). Patentee asserts that the "B" delay is at least 112 days (not 0 days).

The Federal Circuit reviewed the USPTO's statutory interpretation of 35 U.S.C. § 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued

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Examination (“RCE”) on “B” delay in the Novartis appeal. 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.

Pursuant to the Novartis decision, the USPTO has determined that patentee remains entitled to 0 days of “B” delay. Patentee’s calculation of 112 days of “B” delay fails to account for the fact that pursuant to the Novartis decision the period of time from the filing of the RCE to the mailing of the notice of allowance continues to be subtracted from “B” delay as time consumed by continued examination. In this instance, the RCE period was 241 days, resulting in the Office continuing to determine that this application was pending 0 days beyond 3 years from the actual filing date.

The redetermination is calculated as follows: In this case, the filing date of the application is July 1, 2010, and the patent issued on January 28, 2014; thus, the application was pending for 1308 days. A request for continued examination (RCE) was filed on January 21, 2013. A Notice of Allowance issued on September 18, 2013. Under 35 U.S.C. § 154(b)(1)(B)(i), there was one time period consumed by continued examination (“RCE period”). The RCE period began on January 21, 2013 and ended on September 18, 2013 – i.e., 241 days. Subtracting the RCE period from the total number of days the application was pending results in $1308 - 241 = 1069$ days. Thus, for purposes of “B” delay, the application was not pending beyond the 3-year anniversary of the filing date, $1069 - 1097$ [i.e., 3 years from the actual filing date] = 0 days.

Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

$411 + 0 + 0 - 0 - 0 = 411$

Patentee’s Calculation

$441 + 112 = 553$

Conclusion

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Patentee remains entitled to PTA of 441 days, as reflected on the patent. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: $441 + 0 + 0 - 0 - 0 = 441$ days.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Alesia M. Brown at (571) 272-3205.

/JOHN COTTINGHAM/

Director

Office of Petitions/

Petitions Officer