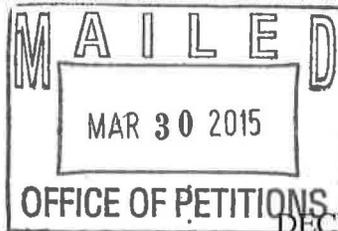




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In re Patent No. 8,643,149  
Ming-Fa Chen

Issue Date: February 4, 2014

Application No. 12/683,604

Filing or 371(c) Date: January 7, 2010

Attorney Docket No. TSM09-0024

DECISION ON REQUEST  
FOR REDETERMINATION OF  
PATENT TERM ADJUSTMENT

This is in response to patentee’s “APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705” filed March 25, 2014, which is being treated under 37 CFR 1.705(b) as a request that the Office correct the patent term adjustment determination (“PTA”) from 300 days to 424 days.

The request is **DENIED**.

This redetermination of patent term adjustment is the Director’s decision on patentee’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 February 4, 2014, this patent issued with a PTA of 300 days. On March 25, 2014, patentee timely filed the present request for redetermination of patent term adjustment within two months of the issue date of the patent.

Patentee seeks 424 days of PTA. Patentee solely disputes the calculation of “B” delay. Patentee requests 130 days of “B” delay based on the Federal Circuit’s interpretation of 35 U.S.C. § 154(b)(1)(B) set forth in *Novartis AG v. Lee*, No. 2013-1160 (Fed. Cir. Jan. 15, 2014). Patentee calculates the period of “B” delay as follows:

Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b) as modified by the Federal Circuit’s decision in *Novartis*, a delay of 124 days (*e.g.*, the period between January 8, 2013 (*e.g.*, the day after three years after the filing date listed in paragraph 1) and February 4, 2014 (*e.g.*, the issue date listed in paragraph 13), but excluding the period between May 24, 2012 (*e.g.*, the filing date of the Request for Continued Examination listed in paragraph 6) and October 3, 2013 (*e.g.*, the mailing date of the Notice of Allowance listed in paragraph 11)). Before *Novartis*, the Office

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excluded the period between October 3, 2013 and February 4, 2014 in the calculation of delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b).

*Request, 03/25/14, pp. 2-3.*

## Decision

The Office has carefully considered patentee's arguments. Upon review, the Office finds that patentee is entitled to 300 days of PTA. The Office and patentee are in agreement regarding the calculation of 354 days of "A" delay, 0 days of "C" delay, 0 days of overlap, and 54 days of applicant delay. The Office has revisited the determination of the amount of "B" delay in view of the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

As to the amount of "B" delay, the Office notes that the interpretation of the "B" delay was based upon 37 CFR 1.703(b)(1) which excluded from the amount of "B" delay the period beginning on the date of filing of the continued examination and ending on the date of the issuance of the patent. However, 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 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. The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

Pursuant to the *Novartis* decision, the USPTO has determined patentee is entitled to zero (0) days of "B" delay. In this case, applicant filed the application on January 7, 2010, and the patent issued on February 4, 2014. Thus, the application was pending for 1490 days. During this time, applicant filed a RCE on May 24, 2012. The Office mailed a Notice of Allowance on October 3, 2013. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on May 24, 2012, and ended on October 3, 2013 – *i.e.*, 498 days. Subtracting the RCE period from the total number of days the application was pending results in  $1490 - 498 = 992$  days. Thus, for purposes of "B" delay, the application was pending for  $992 - 1097$  [*i.e.*, 3 years (including a leap year) from the actual filing date] = 0 days beyond the three-year anniversary of the filing date.

## Overall PTA Calculation

### Formula:

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

**USPTO's Calculation:**

$$354 + 0 + 0 - 0 - 54 = 300$$

**Patentee's Calculation**

$$354 + 124 + 0 - 0 - 54 = 424$$

**Conclusion**

The Office affirms that patentee is entitled to PTA of three hundred (300) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following:  $354 + 0 + 0 - 0 - 54 = 300$  days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 424 days is not merited. As the front page of the patent properly reflects the PTA determination of 300 days, no further action is required. Accordingly, the request for redetermination of patent term adjustment is **denied**. This decision may be viewed as a final agency action. See MPEP 1002.02(b).

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Attorney Advisor at (571) 272-3211.

/JOHN COTTINGHAM/  
Director  
Office of Petitions