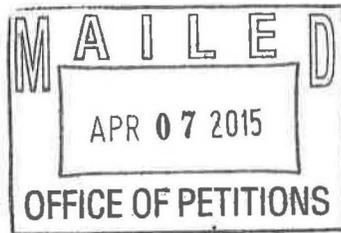




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In re Patent No. 8,716,867
Issue Date: May 6, 2014
Application No. 12/778,867
Filing or 371(c) Date: May 12, 2010
Attorney Docket No. TSM10-0046

: DECISION DENYING 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 June 6, 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 406 days to 539 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 May 6, 2014, this patent issued with a PTA of 406 days. On June 6, 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 539 days of PTA. Patentee solely disputes the calculation of "B" delay. Patentee requests 133 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 133 days (*e.g.*, the period between May 12, 2013 (*e.g.*, the day after three years after the filing date listed in paragraph 1) and May 6, 2014 (*e.g.*, the issue date listed in paragraph 14), but excluding the period between December 26, 2012 (*e.g.*, the filing date of the Request for Continued Examination listed in paragraph 10) and December 23, 2013 (*e.g.*, the

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mailing date of the Notice of Allowance listed in paragraph 12)). Before *Novartis*, the Office excluded the period between December 23, 2013 and May 6, 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, 06/06/14, pp. 2-3.

Decision

The Office has carefully considered patentee's arguments. Upon review, the Office finds that patentee is entitled to **406** days of PTA. The Office and patentee are in agreement regarding the calculation of 436 days of "A" delay, 0 days of "C" delay, 0 days of overlap, and 30 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 May 12, 2010, and the patent issued on May 6, 2014. Thus, the application was pending for 1456 days. During this time, applicant filed a RCE on December 26, 2012. The Office mailed a Notice of Allowance on December 23, 2013. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on December 26, 2012, and ended on December 23, 2013 – *i.e.*, 363 days. Subtracting the RCE period from the total number of days the application was pending results in $1456 - 363 = 1093$ days. Thus, for purposes of "B" delay, the application was pending for $1093 - 1097$ [*i.e.*, 3 years (including a leap year) from the actual filing date] = 0 days beyond the three-year anniversary of the filing date.

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Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

$436 + 0 + 0 - 0 - 30 = 406$

Patentee’s Calculation

$436 + 133 + 0 - 0 - 30 = 539$

Conclusion

The Office affirms that patentee is entitled to PTA of four hundred six (406) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $436 + 0 + 0 - 0 - 30 = 406$ days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 539 days is not merited. As the front page of the patent properly reflects the PTA determination of 406 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