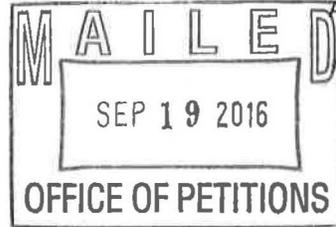




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In re Application of
Morgan et al.
Application No. 12/894,339
Filed: September 30, 2010
Patent No. 8,840,003
Issue Date: September 23, 2014
Attorney Docket No.: END6847USNP/100532
Title: SURGICAL STAPLING
INSTRUMENT WITH COMPACT
ARTICULATION CONTROL
ARRANGEMENT

DECISION ON REQUEST
FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT

This is a response to Patentee’s “request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(b)” filed August 24, 2015, pursuant to 37 CFR 1.705(b), requesting that the Office adjust the patent term adjustment from four hundred and seventy-two (472) days to five hundred and thirteen (513) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of four hundred and seventy-two (472) days.

This is the Director’s decision on the applicant’s request for reconsideration under 35 USC 154(b)(3)(B)(ii). Any appeal from this decision is pursuant to 35 U.S.C. § 154(b)(4)(A).

Relevant Procedural History

On September 23, 2014, the Office determined that applicant was entitled to 428 days of PTA. On November 20, 2014, patentee filed an Application for Patent Term Adjustment under 37 CFR 1.705(d) seeking reconsideration of the patent term adjustment and requesting that the Office grant PTA in an amount of 474 days. On June 24, 2015, the USPTO mailed a redetermination of patent term adjustment, indicating that the Office has re-determined the patent term adjustment to be 472 days.

On August 24, 2015, patentee filed the aforementioned “request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(b),” seeking reconsideration of the patent term adjustment and requesting that the Office grant PTA in an amount of 513 days.

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Decision

Upon review, the USPTO finds that patentee is entitled to four hundred and seventy-two (472) days of PTA. Patentee and the Office are in agreement regarding the amount of “A” delay under 35 § USC 154(b)(1)(A), “B” delay under 35 U.S.C. 154(b)(1)(B), “C” delay under 35 U.S.C. 154(b)(1)(C), and overlap under 35 § USC 154(b)(2)(A).

The Office will address the amount of reduction of PTA under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704.

“A” Delay

The patentee and Office agree that there are 469 days of “A” delay. The periods of “A” delay are:

- (1) 306 days under 37 CFR 1.703(a)(1) beginning on December 1, 2011 (the day after the date that is fourteen months after the day the application was filed) and ending on October 1, 2012 (the date the first Office action was mailed); and,
- (2) 163 days under 37 CFR 1.703(a)(2) beginning on August 26, 2013 (the day after the date that is four months after the date a reply under 37 C.F.R. § 1.111 was filed) and ending on February 4, 2014 (the date of mailing of a notice of allowance under 35 U.S.C. § 151).

“B” Delay

The patentee and Office agree that there are 44 days of “B” delay. *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014) includes “instructions” for calculating the period of “B” delay. Specifically, the decision states,

The better reading of the language is that the patent term adjustment time [for “B” delay] should be calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of (b)(1)(B)) and determining the extent to which the result exceeds three years.¹

The length of time between application and issuance is 1455 days, which is the number of days beginning on the filing date of the application (September 30, 2010) and ending on the date the patent issued (September 23, 2014).

The time consumed by continued examination is 314 days. The time consumed by continued examination includes the following periods:

¹ *Novartis*, 740 F.3d at 601.

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- (1) the period of 286 days, beginning on the filing date of the first RCE (April 25, 2013) and ending on the mailing date of the first notice of allowance (February 4, 2014); and,
- (2) the period of 28 days, beginning on the filing date of the second RCE (May 2, 2014) and ending on the mailing date of the second notice of allowance (May 29, 2014).

The number of days beginning on the filing date of the application (September 30, 2010) and ending on the date three years after the filing date of the application (September 30, 2013) is 1097 days.

The result of subtracting the time consumed by continued examination (314 days) from the length of time between the application's filing date and issuance (1455 days) is 1141 days, which exceeds three years (1097 days) by 44 days. Therefore, the period of "B" delay is 44 days.

"C" Delay

The patentee and the Office agree that the amount of "C" delay under 37 CFR 1.703(e) is zero.

Overlap

The patent and the Office agree that the amount of overlap under 35 § USC 154(b)(2)(A) is zero.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

The Office has determined that the patentee failed to engage in reasonable efforts to conclude processing or examination of its application during a 41-day reduction that was assessed pursuant to 37 C.F.R. § 1.704(c)(10)(i). 37 C.F.R. § 1.704(c)(10) sets forth, *in toto*:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

...

Submission of an amendment under §1.312 or other paper, other than a request for continued examination in compliance with §1.114, after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in §1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under §1.312 or other paper was filed and ending on

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the mailing date of the Office action or notice in response to the amendment under §1.312 or such other paper; or

(ii) Four months;

The Office mailed a second notice of allowance on May 29, 2014, a letter was filed on August 14, 2014 which sets forth the status of a plurality of other applications, and the patent issued on September 23, 2014. The period beginning on August 14, 2014 with the filing of the letter and ending on September 23, 2014 totals 41 days. It follows that a 41-day reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(10)(i), and the Office assessed a reduction of 41 days.

An example that is representative of the statuses contained within the letter is as follows:

Status of Co-Owned Applications

Applicant has previously provided the status of the following co-owned applications. The Applicant believes that the Examiner has continued access to these applications and their status through PAIR. To the extent that the Examiner wishes to further discuss these applications with the Applicant, the Applicant invites the Examiner to contact the undersigned Attorney.

U.S. Patent Application Serial No. 12/894,360, entitled SURGICAL STAPLING INSTRUMENT WITH A VARIABLE STAPLE FORMING SYSTEM;

U.S. Patent Application Serial No. 12/894,322, entitled SURGICAL STAPLING INSTRUMENT WITH INTERCHANGEABLE STAPLE CARTRIDGE ARRANGEMENTS;

U.S. Patent Application Serial No. 12/894,351, entitled SURGICAL CUTTING AND FASTENING INSTRUMENTS WITH SEPARATE AND DISTINCT FASTENER DEPLOYMENT AND TISSUE CUTTING SYSTEMS;

With this renewed petition, patentee asserts that no reduction is warranted, and cites to *Changes to the Patent Term Adjustment in view of the Federal Circuit Decision in Novartis v. Lee*, 80 Fed. Reg. 1346, 1354(January 9, 2015) which sets forth, *in pertinent part*:

... the submission of the following papers after a notice of allowance will not be considered a failure to engage in reasonable efforts to conclude processing of examination of the application under § 1.704(c)(10):

...

(7) status letters

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Patentee's argument has been carefully considered, but has been deemed to be unpersuasive. The reference to status letters in *Changes to the Patent Term Adjustment in view of the Federal Circuit Decision in Novartis v. Lee* is a reference to the status letter described in MPEP § 203.08:

Inquiries as to the status of applications, by persons entitled to the information, should be answered promptly. Simple letters of inquiry regarding the status of applications will be transmitted from the Office of Patent Application Processing to the TCs for direct action. Such letters will be stamped "Status Letters."

The letter filed on August 14, 2014 is not a status letter of the type described in MPEP § 203.08: it was not an inquiry regarding the status of application number 12/894,339, but rather a disclosure document which lists the status of a plurality of applications.

It follows that the exemption set forth in *Changes to the Patent Term Adjustment in view of the Federal Circuit Decision in Novartis v. Lee* does not apply, and a reduction of 41 days is warranted.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X days of PTA

USPTO's Calculation:

469 (*i.e.*, 306 + 163) + 44 (*i.e.*, 1455 - (286 + 28) - 1097) + 0 - 0 - 41 = 472

Patentee's Calculation:

469 (*i.e.*, 306 + 163) + 44 (*i.e.*, 1455 - (286 + 28) - 1097) + 0 - 0 - 0 = 513

Patentee is entitled to PTA of four hundred and seventy-two (472) days. Using the formula "A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X, the amount of PTA is calculated as following: 469 + 44 + 0 - 0 - 41 = 472 days.

The Office will *sua sponte* issue the certificate of correction in an amount of 472 days. The Office notes that it did not issue the certificate of correction after the redetermination mailed on June 24, 2015 because patentee timely filed a request for reconsideration. Accordingly, the Office will now have a certificate of correction mailed adjusting the amount of PTA.

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Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.²

/ROBERT CLARKE/
Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

Encl. Copy of DRAFT Certificate of Correction
Adjusted PTA calculation

² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 8,840,003 B2

DATED : **Sep. 23, 2014**

DRAFT

INVENTOR(S) : **Morgan et al.**

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 428 days

Delete the phrase "by 428 days" and insert – by 472 days --