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In re Patent No. 8,853,260 ;
Desaid, et al. : DECISION ON APPLICATION
Issue Date: 10/07/2014 : FOR
Application No. 11/520,479 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 09/12/2006 ;

This is a decision on the request for reconsideration of patent term adjustment, filed November 17, 2015, requesting that the patent term adjustment determination for the above-identified patent be changed from 1127 days to 1215 days.

The application for patent term adjustment is **DENIED**.

This decision is the Director's decision on the applicant's request for reconsideration for purposes of seeking judicial review under 35 U.S.C. §154(b)(4).

Background

On October 7, 2014, the instant application issued as Patent No. 8,853,260 with a patent term adjustment (PTA) of 1070 days. The Office determined a patent term adjustment of 1070 days based upon 477 days of "A" delay plus 1102 days of "B" delay, reduced by 103 days of overlap between "A" and "B" delay and 406 days of Applicant delay.

On December 2, 2014, Patentees timely filed an application for patent term adjustment. Patentees argued that the Office improperly calculated "A" delay, specifically 37 CFR 1.702(a)(1) delay. Patentees asserted that because the Office vacated the Restriction Requirement mailed September 26, 2007 (within 14 months of the application's filing date) and mailed a new Restriction Requirement on February 8, 2008, the 37 CFR 1.703(a)(1) delay should be 88 days, rather than the 0 days presently accorded by the Office. In addition, Patentees asserted that they should not have been assessed Applicant delay of 57 days for a supplemental Information Disclosure Statement filed February 26, 2014. Patentees argued that the IDS contained a 37 CFR 1.704(d) statement, and as such, no Applicant delay should have been assessed for its filing.

In a redetermination of patent term adjustment mailed on August 25, 2015, the Office indicated that the PTA was 1127 days. The Office agreed that Patentees should not have been assessed a reduction of 57 days under 37 CFR 1.704(c)(8), because the IDS of February 26, 2014 did contain a 37 CFR 1.704(d) statement. However, the Office did not agree with Patentees

assertion that the Office should have been assessed 88 days of delay pursuant to 37 CFR 1.702(a)(1).

On November 17, 2015, Patentees filed this request for reconsideration, reasserting entitlement to the 88 days of delay pursuant to 37 CFR 1.702(a)(1). This request was made timely by an accompanying extension of time for response within the first month.

Discussion

Patentees' arguments have been carefully considered. Upon review, the USPTO affirms the August 25, 2015 redetermination that patentee is entitled to **1127** days of PTA.

Patentees argue that the Office should be accorded 88 days of PTO delay pursuant to 37 CFR 1.703(a)(1). Patentees assert that because the Office vacated the September 26, 2007 Restriction Requirement with a new Restriction Requirement mailed February 8, 2008, the clock should not have stopped under 37 CFR 1.703(a)(1) on September 26, 2007, but instead should have stopped on February 8, 2008. Patentees' argument has been considered, but is not persuasive.

In view of *Pfizer v. Lee*, 117 USPQ2d 1781, 811 F.3d 466 (Fed. Cir. 2016), and further review of the record, the Office finds that the first restriction requirement was sufficient to meet the notification requirement under 35 USC 132 to stop the accrual of "A" delay. In *Pfizer*, the Federal Circuit held that such notification under Section 132 merely requires that an applicant "at least be informed of the broad statutory basis for [the rejection] of his claims, so that he may determine what the issues are on which he can or should produce evidence." *Id.* at 471-472.

Here, in the first restriction requirement mailed September 26, 2007, the examiner restricted all of the pending claims into distinct invention groups that identified related products and related methods as discussed in MPEP 806.05(j). Patentee was sufficiently informed as to the statutory basis for the restriction requirement and on the issues on which he could or should have produced evidence to respond to the restriction requirement. Much like the restriction requirement in *Pfizer*, the first restriction requirement "provided adequate grounds on which the patentee could 'recognize and seek to counter the grounds for rejection.'" *Pfizer*, 811 F.3d at 472 (citing *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990)). Because the examiner clearly defined the invention groups in the first restriction requirement, Applicants were given sufficient notice of the reasons for the examiner's restriction. *Id.* In response to the second restriction requirement that was mailed subsequent to a telephonic interview, Applicants elected to prosecute Group I. Prosecution of this group of claims proceeded on the merits. As the Federal Circuit explained, the "underlying purpose of PTA is to compensate patent applicants for certain reductions in patent term that are not the fault of the applicant, not to guarantee the correctness of the agency's every decision." *Id.* at 476 (citing *University of Massachusetts v. Kappos*, 903 F.Supp.2d 77, 86 (D.D.C. 2012) ("*UMass*")). The restriction requirement here provided the applicant sufficient information about the statutory basis for the restriction and the

grounds on which the restriction was based, such that the applicant was able to address and counter them.

Moreover, the two Office actions and Applicants' response (i.e. the telephone interview) regarding the first restriction requirement issued by the examiner with respect to the claims placed in Group I are part of the "back and forth" process of patent prosecution that does not give rise to additional "A" delay. *See Pfizer*, 811 F.3d at 475-76. While it is less common to issue more than one restriction requirement in an application, it is permissible for an examiner to do so. *See MPEP* 811.02.

Accordingly, the Office finds that the statutory requirement of 35 USC 154(b)(1)(A)(i)(II) was met as of the initial restriction requirement of September 26, 2007.

Overall PTA Calculation

Formula:

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

Patentees' Calculation:

565 + 1102 + 0 - 103 - 349 = 1215

USPTO's Calculation:

477 + 1102 + 0 - 103 - 349 = 1127

Conclusion

Patentees are entitled to PTA of one thousand one hundred twenty-seven (1127) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: 477 + 1102 + 0 - 103 - 349 = 1127 days.

On October 13, 2015, the Office issued a certificate of correction correcting the patent term adjustment to 1127 days. Accordingly, no further action is required.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Cliff Congo at (571) 272-3207.

/ROBERT CLARKE/
Robert A. Clarke
Patent Attorney,
Office of the Deputy Commissioner
for Patent Examination Policy