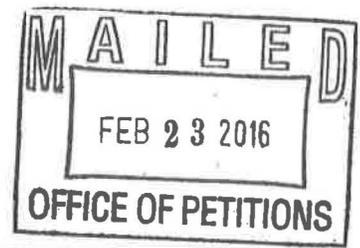




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In re Patent No. 8,862,180 :
Vendrow et al. : DIRECTOR'S DECISION ON
Issue Date: October 14, 2014 : PATENT TERM ADJUSTMENT
Application No. 12/423,723 :
Filed: April 14, 2009 :
Attorney Docket No. 18166- :
0008001 :
Title: INSTANT ACTIVATION AND :
PROVISIONING FOR :
TELECOMMUNICATION SERVICES ON A :
MOBILE DEVICE :

This is a response to the "Request for Reconsideration of Patent Term Adjustment" filed pursuant to 37 CFR 1.705(b) on December 22, 2014 requesting that the Office adjust the PTA from 1281 days to 1404 days.

The request for 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 1281 days.

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

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).

Relevant Procedural History

On October 14, 2014, this patent issued with a patent term adjustment determination of 1281 days. On December 22, 2014, patentee filed this request for redetermination of patent term adjustment with a one month extension of time, requesting that patentee be granted a patent term adjustment of 1404 days.

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Decision

Patentee agrees with the Office's calculation of A delay of 1309 days, C delay of 0 day and 28 days of applicant delay. Patentee disputes B delay calculated as 0 days and 0 days of overlap.

Patentee contends that the USPTO failed to properly account for the delay under 35 U.S.C. §154(b)(1)(B), referred to as the "B delay." Patentee maintains that the B delay is 124 days (not 0 days). With a B delay of 124 and overlap of 1 day, Patentee states that the correct PTA is 1404 days.

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 *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). 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 B delay is calculated as follows: the application was filed on April 14, 2009 and the patent issued on October 14, 2014. Thus, the application was pending for 2100 days. During this period, applicant filed one RCE on October 19, 2011. The Office mailed two Notices of Allowance, the first on September 21, 2011 and the second on June 13, 2014. Under 35 USC 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on October 19, 2011 and ended on June 13, 2014 i.e., 969 days. Subtracting the RCE period from the total number of days the application was pending results in 2100 - 969 = 1131 days. Thus, for purposes of "B" delay, the application was pending for 1131 - 1097 [i.e., 3 years from the actual filing date (including a leap year)] = 134 days beyond the three-year anniversary of the filing date.

Since applicant was not accruing B delay on June 13, 2014, because it is part of the RCE period there is no overlap of A and B delay. Therefore the Office finds that there are 0 days of overlapping days of Office delay. In *Wyeth v. Kappos*, 591 F.3d

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1364 (Fed. Cir. 2010), the United States Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the "A" and "B" delays.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

1309 + 0 + 0 - 0 - 28 = 1281

Patentee's Calculation

1309 + 124 + 0 - 1 - 28 = 1404

Conclusion

Patentee remains entitled to PTA of one thousand two hundred eighty-one (1,281) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: 1309 + 0 + 0 - 0 - 28 = 1281 days.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Charlema Grant at (571) 272-3215.

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