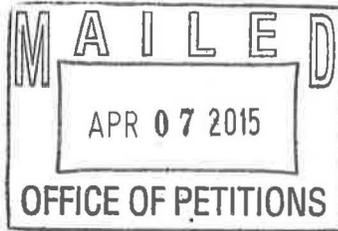




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In re Patent No. 8,866,301

Issue Date: October 21, 2014

Application No. 12/781,960

Filing or 371(c) Date: May 18, 2010

Attorney Docket No. TSM10-0138

: 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 December 1, 2014, which is being treated under 37 CFR 1.705(b) as a request that the Office adjust the patent term adjustment determination (PTA) from 217 days to 319 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 October 21, 2014, this patent issued with a PTA of 217 days. On December 1, 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 319 days of PTA. Patentee solely disputes the calculation of "B" delay. Patentee requests 126 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 126 days (*e.g.*, the period between May 18, 2013 (*e.g.*, the day after three years after the filing date listed in paragraph 1) and October 21, 2014 (*e.g.*, the issue date listed in paragraph 18), but excluding the period between February 5, 2013 (*e.g.*, the filing date of the Request for Continued Examination listed in paragraph 7) and June 16, 2014 (*e.g.*, the mailing

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date of the Notice of Allowance listed in paragraph 16)). Before *Novartis*, the Office excluded the period between June 16, 2014 and October 21, 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, 12/01/14, pp. 2-3.

Decision

The Office has carefully considered patentee's arguments. Upon review, the Office finds that patentee is entitled to 217 days of PTA. The Office and patentee are in agreement regarding the calculation of 248 days of "A" delay, 0 days of "C" delay, 0 days of overlap, and 55 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 24 days of "B" delay. In this case, applicant filed the application on May 18, 2010, and the patent issued on October 21, 2014. Thus, the application was pending for 1618 days. During this time, applicant filed the first RCE on February 5, 2013. The Office mailed a Notice of Allowance on June 16, 2014. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on February 5, 2013, and ended on June 16, 2014 – *i.e.*, 497 days. Subtracting the RCE period from the total number of days the application was pending results in $1618 - 497 = 1121$ days. Thus, for purposes of "B" delay, the application was pending for $1121 - 1097$ [*i.e.*, 3 years (including a leap year) from the actual filing date] = 24 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:

$248 + 24 + 0 - 0 - 55 = 217$

Patentee’s Calculation

$248 + 126 + 0 - 0 - 55 = 319$

Conclusion

The Office affirms that patentee is entitled to PTA of two hundred seventeen (217) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $248 + 24 + 0 - 0 - 55 = 217$ days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 319 days is not merited. As the front page of the patent properly reflects the PTA determination of 217 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/
Acting Director of Technology Center OP
Director
Office of Petitions