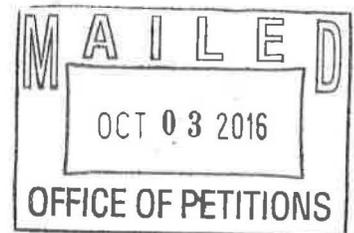




UNITED STATES PATENT AND TRADEMARK OFFICE



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In re Patent No. 8,940,695 : DIRECTOR'S DECISION ON PATENT
Issued: January 27, 2015 : TERM ADJUSTMENT and NOTICE OF
Application No. 11/327,075 : INTENT TO ISSUE CERTIFICATE OF
Filed: January 6, 2006 : CORRECTION
Atty. Dkt. No.: 28967/34891A2 :

This decision is in response to the "REQUEST FOR RECONSIDERATION/CLARIFICATION OF DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT RECALCULATION UNDER 37 CFR § 1.705(B)," filed August 5, 2015.

The request for reconsideration is granted to the extent that the determination has been reconsidered and found to be 2121 days; 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 2121 days.

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 January 27, 2015, this patent issued with a patent term adjustment determination (PTA) of 1980 days. On March 3, 2015, patentees filed a request for reconsideration of patent term adjustment seeking alternative amounts of patent term adjustment, including 2121 days. On March 3, 2015, a decision on patent term adjustment was granted, according the instant patent the requested 2121 days of patent term adjustment PTA.

Patentees herein assert dissatisfaction with the redetermination of 2121 days and assert that the decision on petition did not discuss the alternative amounts of patent term adjustment suggested by patentees. Patentees specifically calls the Office's attention to the patentees' assertion that the patent is entitled to an additional two days of patent term adjustment "on account of a filing deadline falling on a Saturday, and a paper being filed on a Monday. At least one district court has concluded that a patentee's PTA should not be reduced (as it was here) under similar circumstances. See, ArQule v. Kappos, 793 F.Supp.2d 214 (D.D.C. 2011)."

Patentees further direct the Office's attention to patentees' assertion that the reduction of 90 days pursuant to 37 CFR 1.704(b) is in error as the period of reduction occurred during the period of continued examination. Patentees seemingly argue that applicant delay pursuant to 35 USC

154(b)(2)(C) and the implementing provisions of 37 CFR 1.704 does not occur during the period of continued examination. In this regard, on March 3, 2015, patentees argued in relevant part:

“It was improper under the statute to reduce accumulated PTA by the 90 days of alleged “Applicant delay” that occurred following the filing of an RCE and before payment of the issue fee, because such Applicant delay did not occur during a period of time that could contribute to “B delay.” The plain wording of the statute only authorizes adjustments to patent term made “under the authority of paragraph (1)(B).” The only Applicant delay that can result in a reduction of “paragraph (1)(B) adjustment” is delay that accrued during a period that would otherwise accrue toward “B delay.” In this case, 90 days of alleged “Applicant delay” occurred after the Applicants filed an RCE, during a time window when “B delay” had stopped accruing. It is improper for the Office to impose a reduction in PTA due to Applicant activity during continued examination when such continued examination cannot, by statute, constitute an “adjustment to patent term made under the authority of paragraph (1)(B).””

Decision

The Office is in agreement with Patentees' alternative finding of “A” delay under 35 § USC 154(b)(1)(A), “B” delay under 35 USC 154(b)(1)(B), “C” delay under 35 U.S.C. 154(b)(1)(C), the overlap under 35 § USC 154(b)(2)(A), and the amount of reduction of PTA under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704, which alternative calculation leads to the determination of patent term adjustment of 2121 days.

At issue is Patentees' alternative finding of patent term adjustment which leads to a determination of patent term adjustment of 2213 days.

“A” Delay

The patent is entitled to an adjustment of 829 days pursuant to 37 CFR 1.703(a)(1) with respect to the non-final Office action mailed June 12, 2009. The adjustment commenced March 7, 2007 and ended June 12, 2009.

The patent is entitled to 461 days of adjustment, not 322 days of adjustment, pursuant to 37 CFR 1.703(a)(2) with respect to the final Office action mailed April 20, 2011. The adjustment commenced January 15, 2010 and ended April 20, 2011.

The patent is entitled to an adjustment of 449 days pursuant to 37 CFR 1.703(a)(3) with respect to the final Office action mailed March 15, 2013. The adjustment commenced December 23, 2011 and ended March 15, 2013.

The patent is entitled to an adjustment of nine days pursuant to 37 CFR 1.703(a)(2) with respect to the non-final Office action mailed October 23, 2013. The adjustment commenced October 15, 2013 and ended October 23, 2013.

The patent is entitled to an adjustment of 19 days pursuant to 37 CFR 1.703(a)(2) in connection with the non-final Office action mailed September 11, 2014. The adjustment commenced August 24, 2014 and ended September 11, 2014.

Accordingly, the "A" delay totals 1767 days, as alternatively agreed by patentees (829 days + 461 days + 449 days + 9 days + 19 days).

"B" Delay

The Office and Patentees are in agreement with respect to the "B" delay. The application was filed January 6, 2006 and issued January 27, 2015. Thus, the application was pending 3309 days. A request for continued examination was filed August 22, 2011 and a Notice of Allowance issued September 11, 2014. Thus, the period of continued examination totaled 1117 days. The period of time from the day that the application was filed on January 6, 2006 to the date that is three years thereafter, i.e., January 6, 2009, totaled 1097 days. Accordingly, the period of "B" delay totals 1095 days (3309 days – 1117 days – 1097 days = 1095 days).

"C" Delay

The Office and Patentees are in agreement with respect to "C" delay of zero days.

Overlap

The Office is in agreement with Patentees' alternative calculation of overlap which totaled 618 days. The overlapping days occurred from January 7, 2009 to June 12, 2009 (157 days) and January 15, 2010 to April 20, 2011 (461 days).

Applicant Delay

The Office is in agreement Patentees' alternative calculation of applicant delay totaling 123 days. The Office errantly entered a reduction of 141 days with respect to the reply filed February 2, 2010. The reduction of 141 days has been restored as applicants timely replied to the Office action mailed June 12, 2009 within three months on September 14, 2009.

The patent is, however, subject to a reduction of 33 days pursuant to 37 CFR 1.704(b) in connection with the reply filed August 22, 2011 in response to the final Office action mailed April 20, 2011. The reduction commenced July 21, 2011 and ended 33 days later on August 22, 2011.

Patentees' alternative argument that this reduction should be reduced to 31 days in view of ArQule v. Kappos, 793 F.Supp.2d 214 (D.D.C. 2011), is found to be without merit. The final Office action was mailed April 20, 2011, making a reply due on or before Wednesday, July 20, 2011. Applicants, however, filed an RCE in response to the final Office action on August 22,

2011, 33 days later. ArQule v. Kappos, *supra*, is not applicable herein as the due date for reply did not fall on the weekend or a federal holiday. Accordingly, the reduction of 33 days assessed in connection with the reply filed August 22, 2011 will not be reduced.

Patentees' argument that the reduction of 90 days assessed pursuant to 37 CFR 1.704(b) should be removed as the period of reduction occurred during the period of continued examination is not found to be persuasive. Applicant reductions occur during the course of prosecution without exception, including during a period of continued examination. Patentees' attention is directed to 35 USC 154(b)(2)(C)(ii) which states:

“[w]ith respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.”

Accordingly, the adjustment is subject to an additional reduction of 90 days pursuant to 37 CFR 1.704(b) in connection with the reply filed April 23, 2014. The reduction commenced January 24, 2013 and ended April 23, 2014.

Accordingly, the applicant delay totals 123 days (33 days + 90 days).

In view thereof, the patent term adjustment remains 2121 days, as alternatively agreed upon by patentees in the application for patent term adjustment filed March 3, 2015 and as recalculated by the Office by way of decision on application for patent term adjustment mailed July 13, 2015.

Overall PTA Calculation

Formula:

$$\text{“A” delay} + \text{“B” delay} + \text{“C” delay} - \text{Overlap} - \text{applicant delay} = X$$

$$\text{Calculation: } 1767 + 1095 + 0 - 618 - 123 = 2121$$

$$\text{Patentees' Alternative Calculation No. 1: } 1767 + 1095 + 0 - 618 - 123 = 2121$$

$$\text{Patentees' Alternative Calculation No. 2: } 1767 + 1095 + 0 - 618 - 121 = 2123$$

$$\text{Patentees' Alternative Calculation No. 3: } 1767 + 1095 + 0 - 618 - 262 = 1982$$

$$\text{Patentees' Alternative Calculation No. 4: } 1767 + 1095 + 0 - 618 - 174 = 2070$$

$$\text{Patentees' Alternative Calculation No. 5: } 1767 + 1095 + 0 - 618 - 172 = 2072$$

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Patentees' Alternative Calculation No. 6: $1767 + 1095 + 0 - 618 - 33 = 2211$

Conclusion

Patentee is entitled to PTA of 2121 days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $1767 + 1095 + 0 - 618 - 123 = 2121$ days.

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 2121 days.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Alesia M. Brown at (571) 272-3205.

/ROBERT CLARKE/

Robert A. Clarke

Patent Attorney,

Office of the Deputy Commissioner

for Patent Examination Policy - USPTO

Enclosure: Draft Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 8,940,695

DATED : January 27, 2015

INVENTOR(S) : Alitalo, 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 1980 days

Delete the phrase "by 1980 days" and insert – by 2121 days--