



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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In re Patent No. 9,021,283	:	
Watts et al.	:	DECISION ON REQUEST
Issue Date: 04/28/2015	:	FOR RECONSIDERATION OF
Application No. 10/837,106	:	PATENT TERM ADJUSTMENT
Filed: 04/30/2004	:	
Attorney Docket No:	:	
TI-14669F.1	:	

This is a decision on the “REQUEST FOR RECONSIDERATION OF DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT -- 37 C.F.R. § 1.705(b),” filed October 31, 2016, in which patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from two thousand seven hundred ninety-four (2794) days to three thousand fifty-one (3051) 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 changes in the patent term adjustment determination under 35 U.S.C. 154(b) 2859 days as determined in the decision mailed October 3, 2016.

BACKGROUND

On April 28, 2015, the above-identified application matured into U.S. Patent No. 9,021,283, with a patent term adjustment of 2794 days.

On May 7, 2015, an application for patent term adjustment was filed. Patentee asserts that the B delay should be, alternatively, 1093 days, 1124 days, 1348 days, or 1725 days. Patentee asserts that the C delay should be, alternatively, 2084 days, 2053 days, 1829 days, or 1452 days. Patentee asserts that the non-overlapping period of B and C delay is 3177 days. Patentee does not dispute the A delay determination of 1813 days or the applicant delay determination of 126 days.

On October 3, 2016, a decision to redetermine patent term adjustment was mailed, stating that the PTA had been redetermined to be 2859 days.

On October 31, 2016, the subject request for reconsideration was filed. Patentee asserts that the period of adjustment of 65 days for applicant delay is incorrect and resulted from a math error. Patentee points out that the period as stated in the October 2016 decision begins on June 28, 2008, the day after the date that is four months from the mailing of a final decision from the Patent Trial and Appeal Board, and ends August 31, 2012, the date a non-final rejection was mailed. Patentee point out that this is more than 65 days.

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Patentee further argues that the statement in the October 2016 decision regarding the A determination set forth in PAIR in the decision of October 3, 2016 was erroneous in that the previous A determination set forth in PAIR did NOT incorrectly include a 1,439 day period of applicant delay.

STATUTE AND REGULATION

35 U.S.C. 154(b)(1) provides that:

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(iii) act on an application within 4 months after the date of a decision by the Patent Trial and Appeal Board under section 134 or 135 or a decision by a Federal court under section 141 , 145 , or 146 in a case in which allowable claims remain in the application; or

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application not including—

(ii) any time consumed by a proceeding under section 135(a) , any time consumed by the imposition of an order under section 181 , or any time consumed by appellate review by the Patent Trial and Appeal Board or by a Federal court;

37 CFR 1.702(a) states:

The period of adjustment under § 1.702(a) is the sum of the following periods:

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 , whichever occurs first; and

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37 CFR 1.702(b), as revised, applies to any patent granted on or after January 14, 2013.¹

Three-year pendency. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference or derivation proceeding under 35 U.S.C. 135(a);
- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Patent Trial and Appeal Board or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

37 CFR 1.702(e) states, in pertinent part:

Delays caused by successful appellate review. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Patent Trial and Appeal Board under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued under a decision in the review reversing an adverse determination of patentability.

The implementing regulation, 37 CFR 1.703 provides for calculation of the periods, as follows:

Period of adjustment of patent term due to examination delay.

...

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods²:

¹ *Revisions to Patent Term Adjustment*, 78 Fed. Reg. 19416, 20 (April 1, 2013).

² (1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued;

(2)(i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and (ii) The number of days, if any, in the period beginning on the date prosecution in the

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(4) The number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date that jurisdiction by the Patent Trial and Appeal Board ends under § 41.35(b) of this chapter or the date of the last decision by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 , whichever is later.

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the Patent Trial and Appeal Board under § 41.35(a) of this chapter and ending on the date of a final decision in favor of the applicant by the Patent Trial and Appeal Board or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

OPINION

Patentee's argument has been carefully considered. Upon review, the USPTO finds that patentee is entitled to **2859** days of PTA.

Patentee and the Office are in disagreement regarding the amount of "A" delay under 35 U.S.C. § 154(b)(1)(A), the amount of "C" delay under 35 U.S.C. § 154(b)(1)(C), and the amount of reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 (Applicant Delay).

The Office has revisited the amount of "B" delay under 35 U.S.C. § 154(b)(1)(B) and the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A) pursuant to the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3)(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181; (ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed; (iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order was removed; and (iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

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A” Delay

The Office finds that there are **687** days of “A” delay. The periods of “A” delay are:

65 days under 37 CFR 1.703(a)(5) beginning on June 28, 2012 (the day after the date that is four months from the filing of the mailing of a final decision from the Patent Trial and Appeal Board) and ending on August 31, 2012, (the date the non-final rejection was mailed);

It is noted that as applicant pointed out, the previous decision did contain an error. The error, however, was in identifying the date which was four months from the mailing of a final decision from the Patent Trial and Appeal Board. The final decision of the Patent Trial and Appeal Board was mailed February 27, 2012. The day after the date four months from that final decision is June 28, 2012, not June 28, 2008. A non-final rejection was mailed August 31, 2012, 65 days after the date four months after the final decision of the Patent Trial and Appeal Board. Therefore, the 65-day period is correct and will not be removed.

72 days under 37 CFR 1.702(a)(2) beginning on May 15, 2013 (the day after the date that is four months from the mailing of the response to the non-final) and ending on July 25, 2013 (the date of mailing of the final rejection); and

302 days under 37 CFR 1.702(a)(2) beginning on May 28, 2014 (the day after the date that is four months from the response under 37 CFR 1.113(c)) and ending on March 25, 2015 (date of mailing of the notice of allowance).

248 days under 37 CFR 1.702(a)(2) beginning on August 28, 2007, the day after the date corrections were filed in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed August 3, 2007, and ending on May 1, 2008, the date a paper was mailed in response to the corrections to the appeal brief. As no examiner’s answer was mailed in response to the corrections to the appeal brief, in accordance with 37 CFR 1.703(a)(4), the paper mailed May 1, 2008 will be considered as a constructive examiner’s answer.

Upon review, it is noted that the A delay determination set forth in PAIR incorrectly included a 1439-day period of *Office* delay. As noted by patentee, the prior decision inadvertently referred to this period of Office delay as “applicant” delay. Nevertheless, the prior decision did properly indicate that this period was incorrectly included, and the 1439-day period of Office delay was properly removed from the PTA calculation.

“B” Delay

The *Novartis* decision 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

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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.³

The length of time between application and issuance is 4016 days, which is the number of days beginning on the filing date of the application (April 30, 2004) and ending on the date the patent issued (April 28, 2015).

The time consumed by appeal is 2022 days beginning on August 16, 2006 (date of filing of the request for reply brief) and ending on February 27, 2012 (date of final decision by the Patent Trial and Appeal Board).

The number of days beginning on the filing date of application (April 30, 2004) and ending on the date three years after the filing date of the application (April 30, 2007) is 1994 days.

The result of subtracting the time consumed by appeal (2022 days) from the length of time between the application filing date and issuance (4016 days) is 1994 days, which exceeds three years (1096 days) by **898** days. Therefore, the period of "B" delay is **898** days.

C" Delay

The Office finds that the amount of "C" delay is 2022 days for appeal time. The appeal delay began on August 16, 2006⁴ (filing of the reply brief) and ending on February 27, 2012 (date of decision on rehearing under 37 CFR 41.52.).⁵

Overlap

The Office finds that the number of overlapping days of Office delay is **622** days. In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the "A" and "B" delays.

Under this interpretation, the Office finds that two overlapping period(s) of "A" delay and "B" delay occurred during the pendency of this patent application. The first period is 302 days beginning on May 28, 2014 and ending on the mail date of the March 25, 2014. The second period is 72 days beginning on May 15, 2013 and ending on July 25, 2013.

³ *Novartis*, 740 F.3d at 601.

⁴ The decision mailed on October 3, 2016 inadvertently stated that the appeal delay began on August 16, 2016.

⁵ The Office had previously calculated the delay to end on the date of the decision under 37 CFR 41.50 (December 15, 2011) rather than the correct date under 37 CFR 1.703(e),

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The overlapping A and C delay period is 248 days. The 248-day period under 37 CFR 1.702(a)(2) in connection with the mailing of a constructive examiner's answer in response to an a corrected appeal brief occurred after the date jurisdiction passed to the Board on August 16, 2006, and before February 27, 2012, the date on which the jurisdiction of the Board ended.

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

Patentee and the Office are in agreement on the following reductions under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704:

(a) **29** days under 37 CFR 1.704(c)(7) for the period beginning on April 26, 2005 (day after the date that that response containing the omission was filed) and ending on May 24, 2005 (date of filing the compliant response to the restriction requirement);

(b) **3** days under 37 CFR 1.704(b) beginning on November 19, 2005 (day after the date that is three months from the Office's mailing of a final rejection) and ending on September 7, 2010 (date of filing the notice of appeal);

(c) **94** days under 37 CFR 1.704(b) beginning on October 26, 2013 (day after the date of the that is three months from the mailing of the final rejection) and ending on March 16, 3020 (date of filing of the response to the final rejection);

Accordingly, the overall amount of Applicant Delay is 126 (94 + 3 + 29) days.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

687 + 898 + 2022 - 622 - 126 = 2859

Patentee's Calculation

Alternative A

1813 + 1093 + 2084 - 1813 - 126 = 3051

Alternative B

1813 + 1124 + 2053 - 1813 - 126 = 3051

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Alternative C

$$1813 + 1348 + 1829 - 1813 - 126 = 3051$$

Alternative D

$$1813 + 1725 + 1452 - 1813 - 126 = 3051$$

Patentee is entitled to PTA of two thousand eight hundred fifty-nine (2859) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $687 + 898 + 2022 - 622 - 126 = 2859$ days.

In view of the redetermination, the petition is granted to the extent that the PTA calculation has been reconsidered, but is denied with respect to any change in redetermination of the PTA.

CONCLUSION

The request for reconsideration of the revised patent term adjustment is **denied**.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Douglas I. Wood at 571-272-3231.

/ROBERT CLARKE/

Robert A. Clarke

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Office of the Deputy Commissioner
for Patent Examination Policy