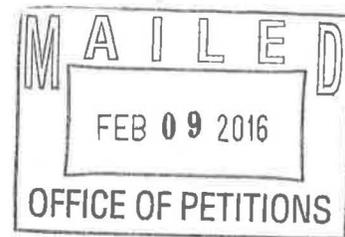




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In re Patent No. 9,040,258 :
Hufton et al. :
Issue Date: May 26, 2015 : DECISION ON REQUEST
Application No. 13/170,362 : FOR RECONSIDERATION OF
Filing Date: June 28, 2011 : PATENT TERM ADJUSTMENT
Atty Docket No.D0617.70026US06 :

This is a decision on patentee's "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. SEC. 1.705(B)" filed September 28, 2015, requesting that the Office adjust the patent term adjustment from 126 days to 209 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 May 26, 2015, this patent issued with a patent term adjustment determination of 126 days.

On (Monday) September 28, 2015, patentee timely filed this "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. SEC. 1.705(B)" seeking an adjustment of the determination to 209 days. Receipt of the extension of time for response within the second month is acknowledged.

Decision

The Office finds that "B" delay is 42 days, and the patent remains entitled to 126 days of patent term adjustment.

Patentee does not dispute the Office's calculation of "A" delay of 352 days, "C" delay of 0 days, overlap of 0 days or applicant delay of 268 days. At issue is the period of "B" delay.

Patentee maintains that the period of "B" delay is 125 days, not 42 days, as follows:

Pursuant to *Novartis v. Lee*, the period from allowance to issuance is "plainly attributable to the PTO." Slip Opinion, page 15, 2nd paragraph. Thus, the examination delays under 35

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U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b) are 125 days, from allowance (January 21, 2015) to issuance (May 26, 2015) ("B delays"). This period does not include any time consumed by continued examination and thus meets the standard of B delays set forth under 35 U.S.C. § 154(b)(1)(B) ("... not including - (i) any time consumed by continued examination of the application requested by the applicant under section 132(b) ...").

The patent term adjustment calculations have been reviewed and it has been determined that the Office accorded 42 days of "B" delay consistent with the decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

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 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.¹

The length of time between application and issuance is the 1,429 days, which is the number of days beginning on the filing date of the application (June 28, 2011) and ending on the date the patent issued (May 26, 2015).

The number of days beginning on the filing date of the application (June 28, 2011) and ending on the date three years after the filing date of the application (June 28, 2014) is 1,097 days.

The time consumed by continued examination is 290 days. The period of time consumed by continued examination begins on the date of the filing of the first RCE (April 7, 2014) and ends on the date of the mailing of the notice of allowance thereafter (January 21, 2015).

$$1429 - 1139 - 1097 = 42$$

Therefore, "B" delay is 42 days.

Patentee's method of calculating "B" delay by counting the number of days from the day after the mailing of the notice of allowance to the date of issuance of the patent is inaccurate. This method does not take into consideration that this application filed June 28, 2011 was not pending for three years when the request for continued examination was filed on April 7, 2014. Consequently, this application had to reach three years pendency after the mailing of the notice of allowance before "B" delay could accrue. The *Novartis* method of calculating patent term

¹ *Novartis*, 740 F.3d at 601.

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adjustment, used by the Office, takes into account that the RCE was filed before the three year anniversary of the application filing date, and that the accrual of pendency for purposes of calculating "B" delay was paused until after the mailing of the notice of allowance.

In view thereof, it is concluded that this patent remains entitled to 126 days of patent term adjustment.

Overall PTA Calculation

Formula:

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

USPTO's Calculation:

$352 + 42 + 0 - 0 - 268 = 126$

Patentee's Calculation

$477 - 268 = 209$

Conclusion

The PTA remains zero (0) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: $352 + 42 + 0 - 0 - 268 = 126$ days.

As the patent issued with 126 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

Telephone inquiries specific to this matter should be directed to Attorney Advisor, Nancy Johnson at (571) 272-3219.

/ROBERT CLARKE/

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Office of the Deputy Commissioner
for Patent Examination Policy