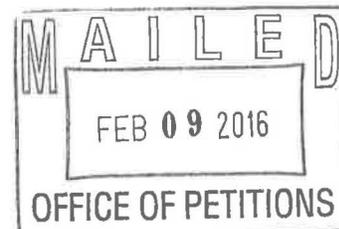




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In re Patent No. 9,068,980 : DECISION ON REQUEST
Hufton et al. : FOR RECONSIDERATION OF
Issue Date: June 30, 2015 : PATENT TERM ADJUSTMENT
Application No. 13/170,438 :
Filing Date: June 28, 2011 :
Attorney Docket No. D0617.70026US05 :

This is a response to patentee's "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. SEC. 1.705(B)" filed September 28, 2015, requesting that the Office correct the patent term adjustment (PTA) from 133 days to 216 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 June 30, 2015, the Office determined that patentee was entitled to 133 days of PTA.

On September 28, 2015, patentee filed the instant request for redetermination of PTA under 37 CFR 1.705(b), seeking an adjustment of the determination to 216 days. This request was made timely by an accompanying petition for extension of time within the first month.

DECISION

Upon review, the Office finds that patentee is entitled to **one hundred thirty-three (133) days of PTA.**

Patentee and the Office are in agreement 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), the amount of overlap under 35 U.S.C. 154(b)(2)(A), and the amount of PTA reduction due to

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applicant delay under 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704.

Patentee and the Office are in disagreement regarding the amount of "B" delay under 35 U.S.C. 154(b)(1)(B).

"A" Delay

Patentee and the Office agree that there are 352 days of "A" delay.

"B" Delay

The Office has determined that there are 47 days of "B" delay.

Patentee contends that there are 130 days of "B" delay.

The Office's calculation of "B" delay is in accordance with the decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

Pursuant to *Novartis*, the amount of "B" delay is 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 35 U.S.C. 154(b)(1)(B)) and determining the extent to which the result exceeds three years. *Novartis*, 740 F.3d at 601.

The length of time between application and issuance is 1464 days, which is the number of days beginning on the June 28, 2011 filing date and ending on the June 30, 2015 date of patent issuance.

The time consumed by continued examination is 320 days. The time consumed by continued examination includes the following period(s):

- A period of 320 days, beginning on April 7, 2014 (the filing date of the RCE) and ending on February 20, 2015 (the mailing date of the notice of allowance).

The number of days beginning on the filing date (June 28, 2011) and ending on the date three years after the filing date (June 28, 2014) is 1097 days.

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The result of subtracting the time consumed by continued examination (320 days) from the length of time between the filing date and issuance (1464 days) is 1144 days, which exceeds three years (1097 days) by 47 days.

Therefore, the period of "B" delay is 47 days.

Patentee contends that the USPTO's determination of PTA was improper because it miscalculated B delays and failed to include the correct time period from allowance to issuance. Patentee calculated the B delay as 130 days, beginning on February 21, 2015 (the day after the notice of allowance was mailed) and ending on June 30, 2015 (the date of patent issuance).

This contention is without merit. Following *Novartis*, the Office's calculation takes into account the period from allowance to issuance. However, the period is not simply calculated as the time from allowance to issuance. As detailed above, the amount of "B" delay is 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 35 U.S.C. 154(b)(1)(B)) and determining the extent to which the result exceeds three years. *Novartis*, 740 F.3d at 601. This method of calculation properly takes into account, instances such as this, when the RCE is filed prior to the 3-year anniversary of the application filing date and additional 3-year pendency has to accrue after the mailing of the notice of allowance before "B" delay accrues.

In this instance, considering time consumed by continued examination, this application had not been pending for 3 years for purposes of calculating PTA until May 14, 2015 [1097 days (or 3 years)] = {June 28, 2011 (filing date) to April 6, 2014 (day before RCE filed) = 1014 days] + [February 21, 2015 (day after notice of allowance mailed) to May 14, 2015 = 83 days]. Thus, "B" delay begins to accrue on May 15, 2015.

In view thereof, the Office finds that "B" delay includes the following period(s):

- (1) A period of 47 days, beginning on May 15, 2015, and ending on June 30, 2015 (the date of patent issuance).

"C" Delay

Patentee and the Office agree that there are 0 days of "C" delay.

Overlap

Patentee and the Office agree that the total number of overlapping days of Office delay is 0 days.

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

Patentee and the Office agree that, under 37 CFR 1.704, the amount of PTA should be reduced by 266 days.

OVERALL PTA CALCULATION

Formula:

"A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X days of PTA

USPTO's Calculation:

352 + 47 (i.e., 1464 - 320 - 1097) + 0 - 0 - 266 = 133 days

Patentee's Calculation:

352 + 130 + 0 - 0 - 266 = 216 days

CONCLUSION

The patent term adjustment (PTA) remains one hundred thirty-three (133) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: 352 + 47 + 0 - 0 - 266 = 133 days.

As the patent issued with 133 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

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

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