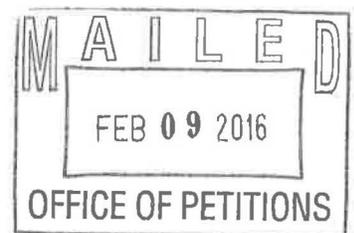




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In re Patent No. 9,111,030 :
Dunn et al. : DECISION ON REQUEST
Issue Date: August 18, 2015 : FOR RECONSIDERATION OF
Application No. 12/573,680 : PATENT TERM ADJUSTMENT
Filing Date: October 5, 2009 :
Attorney Docket No. 05997.0059 :

This is a response to patentee's "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)" filed November 18, 2015, requesting that the Office correct the patent term adjustment (PTA) from 1143 days to 1144 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 August 18, 2015, the Office determined that patentee was entitled to 1143 days of PTA.

On November 18, 2015, patentee filed the instant request for redetermination of PTA under 37 CFR 1.705(b), seeking an adjustment of the determination to 1144 days. This request was made timely by an accompanying extension of time for response within the first month.

DECISION

Upon review, the Office finds that patentee is entitled to one thousand one hundred forty-three (1143) 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 applicant delay under 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704.

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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 **726** days of "A" delay.

"B" Delay

The Office has determined that there are **564** days of "B" delay.

Patentee contends that there are 565 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 **2144** days, which is the number of days beginning on the October 5, 2009 filing date and ending on the August 18, 2015 date of patent issuance.

The time consumed by continued examination is **483** days. The time consumed by continued examination includes the following period(s):

- A period of 483 days, beginning on December 12, 2013 (the filing date of the RCE) and ending on April 8, 2015 (the mailing date of the notice of allowance).

The number of days beginning on the filing date (October 5, 2009) and ending on the date three years after the filing date (October 5, 2012) is **1097** days.

The result of subtracting the time consumed by continued examination (483 days) from the length of time between the filing date and issuance (2144 days) is 1661 days, which exceeds three years (1097 days) by 564 days.

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Therefore, the period of "B" delay is 564 days.

The Office finds that "B" delay includes the following period(s):

- (1) A period of 432 days, beginning on October 6, 2012 (the day after the date that is the three year anniversary of the filing date) and ending on December 11, 2013 (the day before the RCE was filed); and
- (2) A period of 132 days, beginning on April 9, 2015 (the day after the notice of allowance was mailed) and ending on August 18, 2015 (the date of patent issuance).

Patentee contends that the first period of "B" delay is 433 days and that the total amount of "B" delay should therefore be 565 days. Patentee incorrectly ends the first period of "B" delay on December 12, 2013 (the day the RCE was filed). However, the accumulating of "B" delay ends on the day before the RCE was filed, December 11, 2013, as December 12, 2013 (the day the RCE was filed) is time consumed by continued examination, and therefore, is not time included in "B" delay.

"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 56 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 91 days.

OVERALL PTA CALCULATION

Formula:

Art Unit: OPET

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

USPTO's Calculation:

726 + 564 (i.e., 2144 - 483 - 1097) + 0 - 56 - 91 = 1143 days

Patentee's Calculation:

726 + 565 + 0 - 56 - 91 = 1144 days

CONCLUSION

The patent term adjustment (PTA) remains one thousand one hundred forty-three (1143) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: 726 + 564 + 0 - 56 - 91 = 1143 days.

As the patent issued with 1143 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.

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