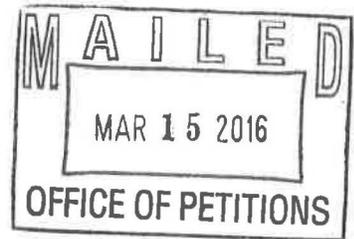




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In re Patent No. 9,133,275 :
Ab et al. :
Issue Date: 09/15/2015 : ON REDETERMINATION OF
Application No. 13/800835 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 03/13/2013 :
Atty. Docket No.: 2921.0020005/EKS/MSS/R-G :

This is a response to applicants "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", filed November 10, 2015, requesting that the Office adjust the PTA to 207 days. The Office has re-determined the PTA to be 169 days.

This petition is hereby **DENIED**. 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 September 15, 2015, the above-identified application matured into U.S. Patent No. 9,133,275. The patent issued with a PTA of 169 days. The present request for redetermination of the patent term adjustment was timely filed within two months of the issue date of the patent.

Decision

Patents' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **169 days** of PTA. Patentee and the Office are in agreement regarding 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); and the amount of "A" delay under 35 U.S.C. § 154(b)(1)(A) and 37 CFR 1.702(a), however, patentee and the Office continue to disagree as to the amount of "applicant delay" under 35 U.S.C. § 154(b)(2)(C) and 1.704(c).

As to applicant delay, patentee avers that the Office erred in calculating a reduction of 38 days in connection with the filing of an amendment to correct drawings, filed June 10, 2015, after the mailing of a Notice of Allowance, mailed May 1, 2015. Patentee provides that the drawings were accepted by the Examiner as indicated in an Office action mailed December 31, 2014, and that thereafter, the Office mailed a Notice to File Corrected Application Papers requesting the amendment to the drawings. Patentee asserts that patentee did not fail to engage in reasonable efforts to conclude processing or examination of the application because this Office's request to amend the drawings was made after the mailing of the Notice of Allowance. Patentee could therefore not have reasonably expected that the amendment would be required, and any delay

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due to the filing of the amendment was not due to the failure of patentee to engage in reasonable efforts to conclude processing or examination of the application.

Patentees' argument has been carefully considered. Regarding the reduction, pursuant to 37 CFR 1.704(c)(10), Patentees' attention is directed to 35 U.S.C. § 154(b)(2)(C), REDUCTION OF PERIOD OF ADJUSTMENT, and section (iii), which states: "The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application." Pursuant to 35 U.S.C. § 154(b)(2)(C)(iii), the Director prescribed, *inter alia*, 37 CFR 1.704(c)(10), which states that the submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, shall reduce the period of adjustment set forth in § 1.703 by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months;

The MPEP 2732 provides, in relevant part:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper, other than a request for continued examination in compliance with 37 CFR 1.114, after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. (Emphasis added).

Under 37 CFR 1.704(c)(10), papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) an amendment under 37 CFR 1.312; (2) a paper containing a claim for priority or benefit or request to correct priority or benefit information (e.g., a new or supplemental application data sheet filed to correct foreign priority or domestic benefit information); (3) a request for a corrected filing receipt; (4) a certified copy of a priority document; (5) drawings; (6) a letter related to biologic deposits; (7) a request to change or correct inventorship; and (8) an information disclosure statement not accompanied by a statement in compliance with 37 CFR 1.704(d). (Emphasis added).

In this instance, Office records confirm that an amendment under 37 CFR 1.312 was filed June 10, 2015, after the mailing of a Notice of Allowance, mailed May 1, 2015. Office records further confirm that an Office action or notice in response to the amendment was mailed to Patentee on July 17, 2015, and pursuant to 35 U.S.C. § 154(b)(2)(C)(iii), and 37 CFR 1.704(c)(10)(i), the period of patent term reduction was properly reduced 38 days, beginning on June 10, 2015, the date that the amendment under 37 CFR 1.312 was filed, and ending on the mailing date of the Office action or notice in response to the amendment, July 17, 2015, and is 38 days.

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Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - Overlap - applicant delay = X

USPTO’s Calculation:

232 + 0 + 0 - 0 - 63 = 169

Patentee’s Calculation

232 + 0 + 0 - 0 - 25 = 207

Conclusion

The present REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) has been considered; however, the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b), is DENIED.

Telephone inquiries specific to this decision should be directed to Attorney Advisor Derek Woods at (571) 272-3232.

/ROBERT CLARKE/
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Office of the Deputy Commissioner
for Patent Examination Policy