



JOSEPH F. SHIRTZ  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

Inventors: Davis et al.	:	
Patent No. 9,133,439	:	FINAL AGENCY DECISION ON
Issue Date: September 15, 2015	:	REQUEST FOR RECONSIDERATION
Application No. 12/970,365	:	OF PATENT TERM ADJUSTMENT
Filing Date: December 16, 2010	:	
Attorney Docket No. CEN5280USNP	:	

This is a decision on the request under 37 C.F.R. § 1.705 filed January 15, 2016, which requests the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) set forth on the patent from 339 days to 462 days.

The request is **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).

The request is signed by Toni-Junell Herbert. Ms. Herbert does not appear to be an attorney or agent of record in this case, and the address listed in the request is different than the address of record. A courtesy copy of this decision is being mailed to Ms. Herbert at the address in the Response. However, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

**Relevant Procedural History**

The patent issued with a PTA determination of 339 days on September 15, 2015.

The instant request seeking an adjustment of 462 days was filed on January 15, 2016, which is four months after the date the patent issued. The \$600 fee necessary to obtain a two-month extension of time has been charged to Deposit Account No. 22-0261 pursuant to the general fee authorization language set forth in the request.

### Decision

The PTA set forth on the patent is based on the following determinations previously made by the Office:

- (1) The period of delay under 35 U.S.C. § 154(b)(1)(A) (“A Delay”) is 339 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 0 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) (“C Delay”) is 0 days;
- (4) The number of days of overlapping delay (“Overlap”) between the periods of A Delay, B Delay, and C Delay is 0 days; and
- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) (“Applicant Delay”) is 0 days.

The PTA to be set forth on a patent is the sum of the days of A Delay, B Delay, and C Delay reduced by the number of days of Overlap and Applicant Delay. In other words, the following formula may be used to calculate the PTA:

$$\text{PTA} = \text{A Delay} + \text{B Delay} + \text{C Delay} - \text{Overlap} - \text{Applicant Delay}$$

The patent sets forth a PTA of 339 days (339 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 0 days of Applicant Delay).

The periods of A Delay, C Delay, Overlap, and Applicant Delay are not in dispute.

The request asserts the Office incorrectly calculated the period of B Delay, and as a result, incorrectly calculated the PTA set forth on the patent. The request asserts the correct period of B Delay is 123 days. The request asserts the correct PTA is 462 days.

The following facts are relevant to the calculation of the period of B Delay:

- (1) The application was filed on December 16, 2010;
- (2) The first request for continued examination (“RCE”) filed for the application was filed on May 31, 2012;
- (3) The Office issued a notice of allowance on May 15, 2015; and
- (4) The patent issued on September 15, 2015.

The impact the submission of a RCE has on the calculation of B Delay is addressed in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. Jan. 15, 2014).

The *Novartis* decision holds time consumed by continued examination does not include the time period after allowance unless examination on the merits of the application resumes.<sup>1</sup> In view of *Novartis*, the number of days consumed by continued examination is 1,080 days, which is the

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<sup>1</sup> *Novartis*, 740 F.3d at 602 (“The common-sense understanding of ‘time consumed by continued examination,’ 35 U.S.C. § 154(b)(1)(B)(i), is time up to allowance, but not later, unless examination on the merits resumes[.]”).

number of days beginning on the date the first RCE was filed (May 31, 2012) and ending on the date the Office issued the notice of allowance (May 15, 2015).

The *Novartis* decision includes a “formula” 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.<sup>2</sup>

The length of time between application and issuance is 1,735 days, which is the number of days beginning on the filing date (December 16, 2010) and ending on the issue date (September 15, 2015). The time consumed by continued examination is 1,080 days. The number of days beginning on the filing date (December 16, 2010) and ending on the date three years after the filing date (December 16, 2013) is 1,097 days. The result of subtracting the time consumed by continued examination (1,080 days) from the length of time between application and issuance (1,735 days) is 655 days, which does *not* exceed three years (1,097 days). Therefore, pursuant to the “formula” in *Novartis*, the period of B Delay is 0 days.

The request states, “*Novartis*’ formula does not address B-Delay calculations for patents in which continued examination [is] requested prior to the three-year pendency date.”<sup>3</sup> However, the *Novartis* decision does *not* include language indicating the “formula” can only be used if a RCE is not filed within three years of the date on which an application was filed under 35 U.S.C. § 111(a) or the date the national stage commenced under 35 U.S.C. §§ 371(b) or (f) in an international application.

The request states,

When the three-year pendency period is subtracted from the total pendency of the application (excluding time in continued examination) and the result is less than the time from allowance to issuance, the patentee is entitled to those days from allowance to issuance rather than the lesser days.<sup>4</sup>

The request appears to be arguing the period of B Delay will always be the greater of (1) the number of days resulting from the application of the formula set forth above or (2) the number of days beginning on the date a notice of allowance is issued and ending on the date the patent is issued. However, B Delay will not always include time after allowance. For example, B Delay will not accrue after allowance when a patent is issued less than three years after an application is filed.

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<sup>2</sup> *Id.* at 601.

<sup>3</sup> Request, footnote 2.

<sup>4</sup> *Id.* at 1.

35 U.S.C. § 154(b)(1)(B) provides the Office with a three-year “allotment” to issue an application as a patent prior to the accrual of B Delay. As recognized in *Novartis*, absent resumption of examination on the merits, time after allowance counts towards the three-year allotment.<sup>5</sup> In this case, the period of B Delay includes the time after allowance to the extent, *and only to the extent*, the time does not fall within the three-year allotment.

The number of days in the Office’s three-year allotment in this case is 1,097 days, which is the number of days beginning on the filing date (April 29, 2011) and ending on the date three years after the filing date (April 29, 2014).

The Office used 532 days of the 1,097-day allotment prior to the submission of the RCE. Specifically, the number of days beginning on the filing date (December 16, 2010) and ending on the day before the date the RCE was filed (May 30, 2012) is 532 days. In other words, the number of days remaining in the Office’s three-year allotment on the date the RCE was filed is 565 (1,097 - 532) days.

The Office did not use any of the remaining 565 days during the 1,080-day time period consumed by continued examination. Specifically, as recognized in *Novartis*, “[T]ime spent in a continued examination does not deplete the PTO’s allotment of three years for application processing before a resulting patent has its term extended[.]”<sup>6</sup>

The last date in the period of time consumed by continued examination was the date the Office issued the notice of allowance (May 15, 2012). The 123-day period after allowance counts towards and falls completely within the 565 days remaining in the Office’s three-year allotment. Therefore, the period of B Delay does not include any of the days after allowance.

In view of the prior discussion, the correct period of B Delay is 0 days.

### Conclusion

The correct period of B Delay is 0 days.

The correct PTA is 339 days (339 days of A Delay + 0 days of B Delay + 0 days of C Delay - 0 days of Overlap - 0 days of Applicant Delay).

Telephone inquiries specific to this decision should be directed to Attorney Advisor Steven Brantley at (571) 272-3203.

/ROBERT CLARKE/  
Robert A. Clarke  
Patent Attorney  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>5</sup> *Novartis*, 740 F.3d at 602.

<sup>6</sup> *Id.* at 601.

cc: Toni-Junell Herbert  
VENABLE LLP  
PO Box 34385  
Washington, DC 20043-9998