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Inventors: Alexander et al.	:	
Patent No. 9,197,597	:	FINAL AGENCY DECISION ON
Issue Date: November 24, 2015	:	REQUEST FOR RECONSIDERATION
Application No. 11/770,978	:	OF PATENT TERM ADJUSTMENT
Filing Date: June 29, 2007	:	
Attorney Docket No. OID 2006-055-01	:	

This is a decision on the request under 37 C.F.R. § 1.705 filed January 25, 2016, which requests the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) set forth on the patent from 981 days to 2,438 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).

**Relevant Procedural History**

The patent issued with a PTA determination of 981 days on November 24, 2015.

The instant request seeking an adjustment of 2,438 days was timely filed on January 25, 2016. A request under 37 C.F.R. § 1.705 must include the fee set forth in 37 C.F.R. § 1.18(e) (\$200). The required \$200 fee has been charged to Deposit Account No. 50-1105 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 504 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 517 days;
- (3) The period of delay under 35 U.S.C. § 154(b)(1)(C) (“C Delay”) is 40 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 40 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 981 days (504 days of A Delay + 517 days of B Delay + 0 days of C Delay - 0 days of Overlap - 40 days of Applicant Delay).

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

The request asserts the correct period of B Delay is 1,974 days. The request asserts the correct PTA is 2,438 days.

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

1. The application was filed on June 29, 2007;
2. A notice of appeal was filed on October 13, 2010;
3. Jurisdiction over the appeal passed to Patent Trial and Appeal Board (“Board”) on May 23, 2011, which is the date a reply brief was filed;
4. The first request for continued examination (“RCE”) filed for the application was filed on November 3, 2014;
5. The Office issued a notice of allowance on July 17, 2015; and
6. The patent issued on November 24, 2015.

The request asserts the period of B Delay is 1,947 days, which is the number of days beginning on the day after the date three years after the filing date (June 30, 2010) and ending on the issue date (November 24, 2015).

The difference between the calculation of the period of B Delay in the request and the Office’s prior calculation of the period of B Delay is the result of the requesting including time consumed by continued examination and time consumed by appellate review in the period of B Delay.

#### The Period Consumed by Continued Examination

The request asserts the period of B Delay includes the time consumed by continued examination because the first RCE was filed more than three years after the filing date.<sup>1</sup>

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 indicates time

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<sup>1</sup> Request, p. 2 (citing *Exelixis, Inc. v. Kappos*, 906 F. Supp. 2d 474 (E.D. Va. 2012)).

consumed by continued examination is not part of the period of B Delay *even if* the RCE is filed more than three years after the filing date.<sup>2</sup>

In view of *Novartis*, the period of B Delay in this case does not include time consumed by continued examination.

Pursuant to 37 C.F.R. § 1.703(b)(1), the time consumed by continued examination is 257 days, which is the number of days beginning on the date the first RCE was filed (November 3, 2014) and ending on the date the Office issued the notice of allowance (July 17, 2015).

#### The Period Consumed by Appellate Review

The calculation of the period of B Delay in the request includes time consumed by appellate review. However, pursuant to 35 U.S.C. § 154(b)(1)(B)(ii), the period of B Delay does not include “any time consumed by appellate review by the Patent Trial and Appeal Board.” Therefore, the period of B Delay does *not* include the time consumed by appellate review.

Pursuant to 37 C.F.R. § 1.703(b)(4), the period consumed by appellate review is 1,200 days, which is the number of days beginning on the date jurisdiction over the application passed to the Board (May 23, 2011) and ending on the date the Board issued a decision on the appeal (September 3, 2014).

#### The Correct Period of B Delay

37 C.F.R. § 1.703(b) states,

The period of [B Delay] is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of [the periods of time set forth in sections (1)-(4) of this paragraph].

The number of days beginning on the day after the date that was three years after the filing date (June 30, 2010) and ending on the issue date (November 24, 2015) is 1,974 days. The sum of the periods set forth in sections (1)-(4) of 37 C.F.R. § 1.703(b) is 1,457 days, which consists of 257 days consumed by continued examination and 1,200 days consumed by appellate review. The correct period of B Delay is 517 (1,974 - 1,457) days.

#### Conclusion

The correct period of B Delay is 517 days.

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<sup>2</sup> *Id.* at 601 (“[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, no matter when the continued examination begins.”).

The correct PTA is 981 days (504 days of A Delay + 517 days of B Delay + 0 days of C Delay - 0 days of Overlap - 40 days of Applicant Delay).

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

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for Patent Examination Policy