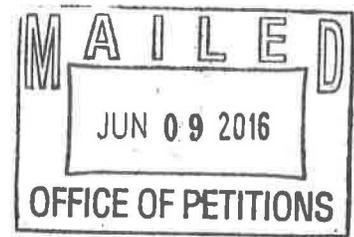




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| In re Patent No. 9,208,623 | : | |
| BAUMERT et al. | : | DECISION DENYING REQUEST |
| Issue Date: December 8, 2015 | : | FOR REDETERMINATION OF |
| Application No. 13/544,725 | : | PATENT TERM ADJUSTMENT |
| Filing or 371(c) Date: July 9, 2012 | : | |
| Attorney Docket No. 1011.191US1 | : | |

This is in response to patentee’s “PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)” filed February 8, 2016, requesting that the Office adjust the patent term adjustment (“PTA”) from 264 days to 384 days.

The request is **DENIED**.

This decision is the Director’s decision on patentee’s request for reconsideration for the purposes of seeking judicial review under 35 U.S.C. § 154(b)(4).

Relevant Procedural History

On December 8, 2015, this patent issued with a PTA in the amount of 264 days. On February 8, 2016, patentee timely filed the present request for redetermination of patent term adjustment seeking an adjustment of the determination to 384 days. Specifically, patentee solely disagrees with the USPTO’s calculation of “B” delay. Patentee asserts that the correct amount of “B” delay is 120 days based on the Federal Circuit’s holding in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

Decision

Upon review, the Office finds that patentee is entitled to 264 days of PTA. The Office and patentee are in agreement regarding the amounts of 264 days of “A” delay under 35 U.S.C. § 154(b)(1)(A), zero (0) days of “C” delay under 35 U.S.C. § 154(b)(1)(C), zero (0) days of overlap under 35 U.S.C. § 154(B)(2)(A), and zero (0) days of applicant delay under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704. However, the Office and patentee are in disagreement regarding the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B).

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The Office will revisit the amount of “B” delay in view of the Federal Circuit’s decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014) and pursuant to 35 U.S.C. § 154(b)(1)(B).

As to the amount of “B” delay, the Federal Circuit reviewed the statutory interpretation of 35 U.S.C. § 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued Examination (“RCE”) on “B” delay in the *Novartis* appeal. In *Novartis*, the Federal Circuit agreed with the Office that “no [“B” delay] adjustment time is available for any time in continued examination, even if the continued examination was initiated more than three calendar years after the application’s filing.” *Novartis*, 740 F.3d at 601. However, the *Novartis* court found that if the Office issues a notice of allowance after an RCE is filed, the period after the notice of allowance should not be excluded from the “B” delay period but should be counted as “B” delay. *Id.* at 602. The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

Pursuant to the *Novartis* decision, the USPTO has determined patentee is entitled to zero (0) days of “B” delay. In this case, applicant filed the application on July 9, 2012, and the patent issued on December 8, 2015. Thus, the application was pending for 1248 days. During this time, applicant filed a RCE on December 17, 2014. The Office mailed a Notice of Allowance on August 10, 2015. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination (“RCE period”) began on December 17, 2014, and ended on August 10, 2015 – *i.e.*, 237 days. Subtracting the RCE period from the total number of days the application was pending results in $1248 - 237 = 1011$ days. Thus, for purposes of “B” delay, the application was pending for $1011 - 1096$ [*i.e.*, 3 years from the actual filing date]¹ = zero (0) days beyond the three-year anniversary of the filing date.

It is noted that applicant filed a RCE on December 17, 2014, prior to July 9, 2015, the three-year date. As of the day before the date applicant filed the RCE, the application was only pending 891 day (*i.e.* July 9, 2012 – December 16, 2014). However, before “B” delay could begin to accrue, this application had to be pending an additional 205 days ($891 + 205 = 1096$) after the end of the period consumed by continued examination (*i.e.* the date of mailing of the Notice of Allowance on August 10, 2015). Accordingly, the period for calculating “B” delay would begin on March 2, 2016 (the day after the date that is 205 days from the mail date the Notice of Allowance). As March 2, 2016, is after the date the patent issued on December 8, 2015, no “B” delay was accrued.

Overall PTA Calculation

Formula:

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

¹ July 9, 2012 – July 9, 2015 = 1096 days

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USPTO's Calculation:

$$264 + 0 + 0 - 0 - 0 = 264$$

Patentee's Calculation

$$264 + 120 + 0 - 0 - 0 = 384$$

Conclusion

The Office affirms that patentee is entitled to PTA in the amount of two hundred sixty-four (264) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $264 + 0 + 0 - 0 - 0 = 264$ days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 384 days is not merited. As the front page of the patent properly reflects the PTA determination of 264 days, no further action is required. Accordingly, the request for redetermination of patent term adjustment is **denied**. This decision may be viewed as a final agency action. See MPEP 1002.02(b).

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Attorney Advisor at (571) 272-3211.

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