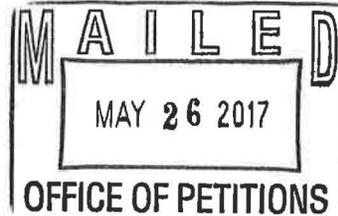




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Inventor: Hassan Mostafavi :
Patent No. 9,232,928 : FINAL AGENCY DECISION ON
Issue Date: January 12, 2016 : REQUEST FOR RECONSIDERATION
Application No. 11/116,699 : OF PATENT TERM ADJUSTMENT
Filing Date: April 27, 2010 :
Attorney Docket No. VM 98-086-US-C1 :

This is a decision on the request under 37 C.F.R. § 1.705 filed March 11, 2016, which requests the United States Patent and Trademark Office (“Office”) adjust the patent term adjustment (“PTA”) set forth on the patent from 1,723 days to 3,282 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 1,723 days on January 12, 2016.

The instant request seeking an adjustment of 2,438 days was timely filed on March 11, 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 2,167 days;
- (2) The period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 1,257 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 398 days; and
- (5) The period of delay under 35 U.S.C. § 154(b)(2)(C) (“Applicant Delay”) is 1,303 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 1,723 days (2,167 days of A Delay + 1,257 days of B Delay + 0 days of C Delay - 398 days of Overlap - 1,303 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 2,816 days. The request asserts the correct PTA is 3,282 days.

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

1. The application was filed on April 27, 2005;
2. A request for continued examination (“RCE”) was filed on May 26, 2011;
3. The Office issued a notice of allowance on August 31, 2015; and
4. The patent issued on January 12, 2016.

The asserts the period of B Delay is 2,816 days, which is the number of days beginning on the day after the date three years after the filing date (April 28, 2008) and ending on the issue date (January 12, 2016).

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 request including time consumed by continued examination in the period of B Delay.

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.¹

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 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.²

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

² *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.”).

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 1,559 days, which is the number of days beginning on the date the first RCE was filed (May 26, 2011) and ending on the date the Office issued the notice of allowance (August 31, 2015).

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 three years after the filing date (April 28, 2008) and ending on the issue date (January 12, 2016) is 2,816 days. The sum of the periods set forth in sections (1)-(4) of 37 C.F.R. § 1.703(b) is 1,559 days, which consists of the 1,559 days consumed by continued examination. The period of B Delay is 1,257 (2,816 - 1,559) days.

Conclusion

The correct period of B Delay is 1,257 days.

The correct PTA is 1,723 days (2,167 days of A Delay + 1,257 days of B Delay + 0 days of C Delay - 398 days of Overlap - 1,303 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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Office of the Deputy Commissioner
for Patent Examination Policy