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In re Patent No. 9,238,687 :
Tabuchi et al. :
Issue Date: 01/19/2016 :
Application No. 12/226195 : ON REDETERMINATION OF
Filing or 371(c) Date: 10/10/2008 : PATENT TERM ADJUSTMENT
Atty. Docket No.: :
LFS5163USNP :

This is a response to applicants "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT UNDER 37 C.F.R. § 1.705(d)", filed February 26, 2016, requesting that the Office adjust the PTA to 562 days. The Office has re-determined the PTA to be zero (0) 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 January 19, 2016, the above-identified application matured into U.S. Patent No. 9,238,687. The patent issued with a PTA of zero (0) days. The present request for redetermination of the patent term adjustment was timely filed with a one (1) month extension of time request and fee.

Decision

Patents' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **zero (0)** 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); 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).

Regarding patentee delay, Office records confirm that the patentee filed a Request for Continued Examination ("RCE") on June 16, 2011, and thereafter filed Information Disclosure Statements ("IDSs") on May 3, 2012, March 1, 2013, June 3, 2013, and September 19, 2013. A review of the IDSs, confirms that the IDSs did not contain the language required by 37 CFR 1.704(d)¹. As

¹ (1) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the

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such, pursuant to 37 CFR 1.704(c)(8), the application was assessed reduction of 826 days, commencing June 17, 2011, the day after the date that the RCE was filed, and ending on September 19, 2013, the date the last IDS was filed after the RCE was filed and before an response to the RCE was made.

Patentee avers that the Office improperly charged Applicant Delay for IDSs filed while the application was awaiting examination after the RCE was filed.

Patentee's arguments have been considered, but has been found to be unpersuasive, for the reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(8).

The Office notes recently the Federal Circuit determined that submission of an IDS after the filing of a response to an election or restriction requirement is a reduction under 37 CFR 1.704(c)(8). See *Gilead Sciences, Inc. v. Lee* cv 14-1159 (Fed. Cir. 2015). In *Gilead*, the court noted that the conduct of filing an IDS after the submission of a response to an election or restriction requirement interferes with the PTO's ability to conclude the application process because of significant time constraints faced by the PTO. See *Gilead* at page 15. Because the "A" Delay provision of the statute penalizes the PTO if the examiner fails to respond within four months of the applicant's response to the restriction requirement, any relevant information received after an initial response to a restriction requirement "interferes with the [PTO's] ability to process an application. *Id.* A supplemental IDS may force an examiner to go back and review the application again, while still trying to meet his or her timeliness obligations under § 154. *Id.*

The same analysis applies to submission of an IDS document after the filing of an RCE. The Office must respond to the submission of an RCE within four months of the filing of the RCE or provide additional "A" delay. Any IDS submission by patentee after the filing of a RCE "interferes" with the [PTO's ability] to process an application because the examiner may be forced to go back and review the application again. The IDSs did not include a 1.704(d) statement. Accordingly, the Office maintains the reduction of applicant delay for the IDS submissions after the filing of an RCE.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement:

- (i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement; or
- (ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

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USPTO's Calculation:

$$900 + 0 + 0 - 0 - 1164 = 0$$

Patentee's Calculation

$$900 + 0 + 0 - 0 - 338 = 562$$

Conclusion

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

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

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