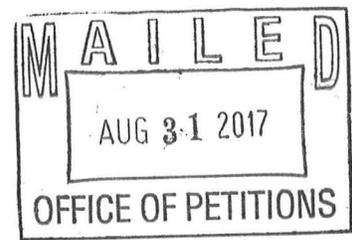




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In re Application of :
Gross et al. :
Application No. 13/508,020 :
Filed: September 14, 2012 : DECISION ON REQUEST FOR
Patent No. 9,284,332 : RECONSIDERATION OF
Issue Date: March 15, 2016 : PATENT TERM ADJUSTMENT
Attorney Docket No.: 11825-075- :
999/246978-076 :
Title: PROCESS FOR THE :
PREPARATION OF IMIDAZO[2,1- :
B][1,3]BENZOTHIAZOLE :
DERIVATIVES :

This is a decision on Patentee's request for reconsideration pursuant to 37 C.F.R. § 1.705(b) filed October 12, 2016, requesting that the Office adjust the patent term adjustment from six hundred and fifty-one (651) days to six hundred and fifty-five (655) days.

The Office acknowledges the submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) on October 12, 2016 as well as a five-month extension of time so as to make timely this petition. No additional fees are required.

This Decision on Request for Reconsideration of Patent Term Adjustment of patent term adjustment 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 March 15, 2016, the Office determined that applicant was entitled to 651 days of PTA.

On April 11, 2017, Patentee filed a request for redetermination of patent term adjustment along with \$200.00 fee set forth in 37 C.F.R. § 1.18(e), requesting a PTA of 655 days, pursuant to 37 C.F.R. § 1.705(b).

Decision

Upon review, the USPTO finds that Patentee is entitled to six hundred and fifty-one (651) days of PTA.

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Patentee and the Office are in agreement regarding the amount of “C” delay under 35 U.S.C. § 154(b)(1)(C), overlap under 35 U.S.C. § 154(b)(2)(A), and reduction of PTA under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704.

The items in dispute are the amount of “A” delay under 35 U.S.C. § 154(b)(1)(A) and “B” delay under 35 U.S.C. § 154(b)(1)(B),

“A” Delay

The Office finds there are 348 days of “A” delay. The period of “A” delay is 348 days under 37 C.F.R. § 1.703(a)(1) beginning on July 8, 2013 (the day after the date that is fourteen months after the date the national stage commenced) and ending on June 20, 2014 (the date the first Office action was mailed).

Patentee argues the date of commencement is May 5, 2012, which would result in a 350 day period of “A” delay beginning on July 6, 2013 (the day after the date that is fourteen months after the day the application commenced) and ending on June 20, 2014 (the date the first Office action was mailed). However, the Office finds the date of commencement is May 7, 2012:

- This patent issued from an application that was a national stage entry pursuant to 35 U.S.C. § 371.
- Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). *See* 35 U.S.C. § 371(b) and 37 C.F.R. § 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. § 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c).
- The undersigned has reviewed the electronic file, and an express request for early commencement has not been located therein.¹ Therefore the national stage commenced 30 months from the priority date.

¹ *See* Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 U.S.C. 371, included on initial deposit.

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- On June 11, 2014, the Office mailed a Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495, which contains a priority date of November 5, 2009.² Accordingly, the 30-month period expired on Saturday, May 5, 2012. The Office finds that since May 5, 2012 fell on a Saturday, the commencement date moves forward to Monday, May 7, 2012. *See* PCT Rule 80.4, in view of PCT Rule 80.5. *See also Actelion v. Lee*, 1:16-cv-304 (E.D. Va. 2016).

“B” Delay

The *Novartis*³ decision includes “instructions” 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.

The length of time between application and issuance is 1409 days, which is the number of days beginning on the commencement date of the application (May 7, 2012) and ending on the date the patent issued (March 15, 2016).

The time consumed by continued examination is zero days. The time consumed by appellate review is zero days

The number of days beginning on the commencement date of application (May 7, 2012) and ending on the date three years after the commencement date of the application (May 7, 2015) is 1096 days.

The length of time between the application’s commencement date and issuance (1409 days) exceeds three years (1096 days) by 313 days. Therefore, the period of “B” delay is 313 days.

Patentee calculates the period of “B” delay to total 315 days, based calculating the commencement date to be Saturday, May 5, 2012.

“C” Delay

The Patentee and the Office agree that the amount of “C” delay under 35 U.S.C. § 154(b)(1)(C) is zero days.

² *See* International Publication Number WO 2011/056939 A1, included on initial deposit.

³ *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

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Overlap

The Patentee and the Office agree the number of overlapping days of Office delay is ten days.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

The Office finds that, under 37 C.F.R. § 1.704, the amount of PTA should be reduced by 10 days. The Office has determined that the Patentee failed to engage in reasonable efforts to conclude processing or examination of its application during a 10-day period pursuant to 37 C.F.R. § 1.704(b) because the Office mailed a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) on June 4, 2012. Accordingly, the three-month response date was September 4, 2012. However, the Patentee did not file its declaration and fee until September 14, 2012.

Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - overlap - applicant delay = X.

USPTO’s Calculation:

$348 + 313 (1409 - 1096) + 0 - 0 - 10 = 651$

Patentee’s Calculation:

$350 + 315 (1411 - 1096) + 0 - 0 - 10 = 655$

Conclusion

Patentee is entitled to PTA of six hundred and fifty-one (651) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $348 + 313 + 0 - 0 - 10 = 651$ days.

In view thereof, no adjustment to the patent term will be made. It follows that a certificate of correction is not required.

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Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.⁴

/ROBERT CLARKE/

Robert A. Clarke

Patent Attorney

Office of the Deputy Commissioner
for Patent Examination Policy

⁴ Patentee will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. *See* 37 C.F.R. § 1.2. As such, Patentee is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Patentee.