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In re Patent No. 9,355,295 :  
Jones et al. :  
Issue Date: May 31, 2016 : DECISION ON PATENT  
Application No. 13/794,189 : TERM ADJUSTMENT  
Filing Date: March 11, 2013 :  
Attorney Docket No. :  
247171-000532USC1 :

This is a decision on patentee's "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)" filed July 26, 2016, requesting that the Office adjust the patent term adjustment from 190 days to 271 days. The Office has reviewed the calculations and determined that the patent term adjustment of 190 days is correct.

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 May 31, 2016, this patent issued with a patent term adjustment determination of 190 days. On July 26, 2016, patentee timely filed this "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)" seeking an adjustment of the determination to 271 days.

**Redetermination**

Patentee does not dispute the Office's calculation of "A" delay of 220 days, "C" delay of 0 days, or applicant delay of 30 days. At issue is the period of "B" delay.

Patentee asserts that:

[U]nder 37 C.F.R. § 1.703(b), Patentee is entitled to the number of days beginning on the day that is three (3) years

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after the date on which the application was filed (namely beginning on March 11, 2016-the the day after the three-year from filing date) and ending on the day the patent issued (namely, May 31, 2016) which is 81 days.

Patentee further argues that:

The numbers of days is NOT to be reduced by the period consumed by continued examination beginning on October 17, 2014 and ending on February 4, 2016 when a notice of allowance was mailed, because this period occurred prior to the date that is three (3) years after the filing date and therefore was not included in calculating the delay.

#### ON "B" DELAY

The Office properly calculated "B" delay as 0 days, pursuant to the Federal Circuit decision in *Novartis AG v. Lee*.<sup>1</sup> Patentee in calculating 81 days of "B" delay does not take into account the *Novartis* decision. Instead, patentee argues that the 37 CFR 1.703(b) period is not reduced by the period consumed by continued examination beginning on October 17, 2014 and ending on February 4, 2016 when a notice of allowance was mailed, because this period occurred prior to the date that is three (3) years after the filing date and therefore was not included in calculating the delay.

Pursuant to *Novartis*, the Office calculates "B" delay, 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 35 U.S.C. 154(b)(1)(B)) and determining the extent to which the result exceeds three years. *Novartis*, 740 F.3d at 601. The Federal Circuit did not accept the calculation of "B" delay which distinguished between time consumed by continued examination occurring prior to as opposed to after three (3) years after the filing date. The Federal Circuit confirmed in *Novartis* that any time consumed by continued examination is subtracted in determining the extent to which the period of application pendency exceeds three years, regardless of when the continued examination was initiated. The Federal Circuit, however, decided that the time consumed by continued examination does not include

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<sup>1</sup> 740 F.3d 593 (Fed. Cir. 2014).

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the time after a notice of allowance, unless the Office actually resumes examination of the application after allowance<sup>2</sup>.

Calculating "B" delay pursuant to *Novartis* in this instance:

The filing date of this application is March 11, 2013, and the patent issued on May 31, 2016; thus, the application was pending for 1178 days.

A request for continued examination (RCE) was filed on October 17, 2014. A Notice of Allowance issued on February 4, 2016. Under 35 U.S.C. § 154(b)(1)(B)(i), there was one time period consumed by continued examination ("RCE period"). The RCE period began on October 17, 2014 and ended on February 4, 2016 - i.e., 476 days.

The result of subtracting the time consumed by continued examination (476 days) from the length of time between the application's filing date and issuance (1178 days) is 702 days, which does not exceed three years (1097 days).

Therefore, "B" delay is 0 days.

As "B" delay is 0 days, there is no issue of overlap with "A" delay.

Formula:

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

USPTO's Calculation:

220 + 0 (i.e., 1178 - 476 - 1097) + 0 - 0 - 30 = 190

Patentee's Calculation

220 + 81 + 0 - 0 - 30 = 271

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<sup>2</sup> See also *Changes to Patent Term Adjustment in view of the Federal Circuit Decision in Novartis v. Lee*, 80 FR 1346 (January 9, 2015).

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**Conclusion**

Patentee remains entitled to PTA of one hundred ninety (190) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows:  $220 + 0 + 0 - 0 - 30 = 190$  days.

As the patent issued with 190 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

Telephone inquiries specific to this matter should be directed to Attorney Advisor, Nancy Johnson at (571) 272-3219.

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