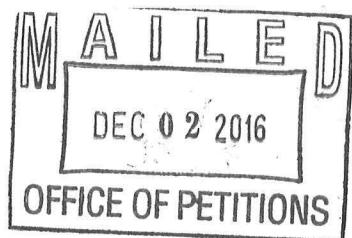




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In re Patent No. 9,393,272 :
Opara et al. : DECISION DENYING REQUEST
Issue Date: July 19, 2016 : FOR REDETERMINATION OF
Application No. 14/237,214 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: May 13, 2014 :
Attorney Docket No. 9865-164TS :

This is in response to patentee's "REQUEST FOR RECONSIDERATION FOR PATENT TERM ADJUSTMENT" filed September 19, 2016, which is being treated under 37 CFR 1.705(b) as a request that the Office adjust the patent term adjustment ("PTA") from 216 days to 221 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 July 19, 2016, this patent issued with a PTA in the amount of 216 days. On September 19, 2016, patentee timely filed the present request for redetermination of patent term adjustment, seeking an adjustment of the determination to 221 days. Patentee solely disagrees with the USPTO's calculation of "A" delay. Specifically, patentee asserts:

"14 Month" Delay. A first Office Action was due on or before April 5, 2015, which was fourteen months after February 5, 2014, the date on which the application was filed under 35 U.S.C. §371. The first Office Action was mailed on November 12, 2015, thereby according a delay of 221 days. 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

Patentee calculates the total "A" delay to be 221 days, which differs from the Office's calculation of 216 days by 5 days.

Request, 09/19/16, p. 2.

Decision

Upon review, the Office finds that patentee is entitled to **216** days of PTA. The Office and patentee are in agreement regarding 0 days of “B” delay under 35 U.S.C. 154(b)(1)(B), 0 days of “C” delay under 35 U.S.C. 154(b)(1)(C), 0 days of overlap under 35 U.S.C. 154(B)(2)(A), and 0 days of applicant delay under 35 U.S.C. 154(b)(2)(C)(iii). However, the Office and patentee are in disagreement regarding the amount of “A” delay under 35 U.S.C. 154(b)(1)(A). Accordingly, the Office will address the only outstanding issue in dispute, the amount of “A” delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.704.

The Office has carefully considered patentee’s argument, but does not find it persuasive. For patents issuing from international applications that are granted on or after January 14, 2013, the date that begins the 14-month measurement pursuant to 37 CFR 1.703(a)(1) is the date the national stage commenced under 35 U.S.C. 371(b) or (f). *See MPEP 2731.*

In the transmittal letter filed February 5, 2014, applicant made an express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1). 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). *See MPEP 1893.01.* That is, an express request to begin national examination procedures under 35 U.S.C. 371(f) will not be effective unless an applicant meets the requirements under 35 U.S.C. 371(c)(1), (2), and (4) for payment of the basic national fee, submission of a copy of the International Application and English translation thereof (if required), and receipt of the oath or declaration.

On March 18, 2014, the Office mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US), indicating that applicant must submit an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date, within two months from the date of the Notice or by 32 months from the priority date for the application, whichever was later, to complete the requirements for acceptance under 35 U.S.C. 371 and avoid abandonment. The Notification advised applicant that the time period was extendable under the provisions of 37 CFR 1.136(a).

The early national stage entry under 35 U.S.C. 371(f) requires the submission of the oath or declaration required by 35 U.S.C. 371(c)(4). In the present case, applicant did not submit an oath or declaration in compliance with requirements of 35 U.S.C. 371(c)(4) until May 13, 2014, after the expiration of the 30-month period. Therefore, in the absence of compliance with the conditions provided in 35 U.S.C. 371(f) for early processing of an international application, the U.S. national stage commenced on the expiration of 30 months from the priority date of the international application. The priority date of the international application is August 9, 2011. The date 30 months from August 9, 2011, is Sunday, February 9, 2014. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Sunday, the period expired on the

subsequent business day. *See Actelion Pharms. LTD. v. Lee*, 2016 U.S. Dist. LEXIS 146393 (E.D. Va. Oct. 19, 2016) and PCT Rule 80.5. Accordingly, the national stage commenced on February 10, 2014, not February 5, 2014, as patentee suggests.

Pursuant to 37 CFR 1.703(a)(1), the period of adjustment under § 1.702(a) is 216 days, the number of days in the period beginning on the day after the date that is fourteen months after the date the national stage commenced under 35 U.S.C. 371(b), April 11, 2015, and ending on the date of mailing of the Restriction Requirement, November 12, 2015.

The Office concludes the correct amount of “A” delay remains 216 days.

Overall PTA Calculation

Formula:

$$\text{“A” delay} + \text{“B” delay} + \text{“C” delay} - \text{Overlap} - \text{applicant delay} = X$$

USPTO’s Calculation:

$$216 + 0 + 0 - 0 - 0 = 216$$

Patentee’s Calculation

$$221 + 0 + 0 - 0 - 0 = 221$$

Conclusion

The Office affirms that patentee is entitled to PTA in the amount of two hundred sixteen (216) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: $216 + 0 + 0 - 0 - 0 = 216$ days. A correction of the determination of patent term adjustment under 35 U.S.C. 154(b) to 221 days is not merited. Accordingly, the request for redetermination of patent term adjustment is denied.

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

/ROBERT CLARKE/
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