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In re Patent No. 9,393,735 :
Pham et al. : DECISION DENYING REQUEST
Issue Date: July 19, 2016 : FOR REDETERMINATION OF
Application No. 13/144,575 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: December 30, 2011 :
Attorney Docket No. 72225-0048 :

This is in response to patentee’s “Request for Reconsideration of Patent Term Adjustment Under 35 U.S.C. § 154 and 37 C.F.R. § 1.705(b)” filed November 22, 2016, which is being treated under 37 CFR 1.705(b) as a request that the Office adjust the patent term adjustment (“PTA”) from 1216 days to 1274 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 1216 days. On November 22, 2016, patentee timely filed the present request for redetermination of patent term adjustment, accompanied by a three-month extension of time, a \$1400 extension of time fee, and a \$200.00 fee set forth in 37 CFR 1.18(e).

Patentee seeks an adjustment of the patent term determination to 1274 days. Patentee solely disagrees with the USPTO’s calculation of “B” delay. Specifically, patentee maintains:

The PTO is wrong on its PTA 36 month calculation, which caused the 58-day difference in calculated intervals. . . .

....

The PTO “start date” of 7/15/2011 is correct. Thirty-six months from that date is 7/15/2014 when the patent should have issued. The actual issue date is 7/19/2016 which is correct, which results in an overage of 735 days of Patent Office delay under part B, not 677 days as the Patent Office calculated. Once Applicant delays for the 312

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Amendment and the RCE are factored in, the net PTA Extension is 58 days more than the PTO's original calculation.

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Decision

Upon review, the Office finds that patentee is entitled to 1216 days of PTA. The Office and patentee are in agreement regarding 908 days of "A" delay under 35 U.S.C. 154(b)(1)(A), zero (0) days of "C" delay under 35 U.S.C. 154(b)(1)(C), 240 days of overlap under 35 U.S.C. 154(B)(2)(A), and 129 days of applicant delay under 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704. However, the Office and patentee are in disagreement regarding the amount of "B" delay under 35 U.S.C. 154(b)(1)(B). The Office will revisit the amount of "B" delay in view of the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014) and pursuant to 35 U.S.C. 154(b)(1)(B).

As to the amount of "B" delay, the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") reviewed the statutory interpretation of 35 U.S.C. 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued Examination ("RCE") on "B" delay in the *Novartis* appeal. In *Novartis*, the Federal Circuit agreed with the Office that "no ["B" delay] adjustment time is available for any time in continued examination, even if the continued examination was initiated more than three calendar years after the application's filing." *Novartis*, 740 F.3d at 601. That is, the Federal Circuit determined that any time consumed by continued examination under 35 U.S.C. 132(b) is subtracted in determining the extent to which the period of "B" delay defined in 35 U.S.C. 154(b)(1)(B) exceeds three years, regardless of when the continued examination was initiated. *See* MPEP 2731. Nevertheless, the Federal Circuit found that if the Office issues a notice of allowance after an RCE is filed, the period after the notice of allowance should not be excluded from the "B" delay period, but should be counted as "B" delay, unless the Office actually resumes examination of the application after allowance. *Id.* at 602; *see* MPEP 2731.

Pursuant to the *Novartis* decision, the USPTO has determined patentee is entitled to 677 days of "B" delay. In this case, the national stage commenced on July 15, 2011, and the patent issued on July 19, 2016. Thus, the application was pending for 1832 days for purposes of 35 U.S.C. 154(b)(1)(B). During this time, applicant filed a RCE on January 6, 2016. The Office mailed a Notice of Allowance on March 3, 2016. Under 35 U.S.C. 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on January 6, 2016, and ended on March 3, 2016 – *i.e.*, 58 days. Subtracting the RCE period from the total number of days the application was pending results in $1832 - 58 = 1774$ days. Thus, for purposes of "B" delay, the application was pending for $1774 - 1097$ [*i.e.*, 3 years from the actual filing date]¹ = 677 days beyond the three-year anniversary of the commencement date.

¹ July 15, 2011 – July 15, 2014 = 1097 days

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Overall PTA Calculation

Formula:

“A” delay + “B” delay + “C” delay - Overlap - applicant delay = X

USPTO’s Calculation:

$908 + 677 + 0 - 240 - 129 = 1216$

Patentee’s Calculation

$908 + 735 + 0 - 240 - 129 = 1274$

Conclusion

The Office affirms that patentee is entitled to PTA in the amount of one thousand two hundred sixteen (1216) days. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $908 + 677 + 0 - 240 - 129 = 1216$ days. A correction of the determination of patent term adjustment under 35 U.S.C. 154(b) to 1274 days is not merited. Accordingly, the request for redetermination of patent term adjustment is **denied**. This decision may be viewed as a final agency action. *See* MPEP 1002.02(b).

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

/ROBERT CLARKE/

Robert A. Clarke

Patent Attorney

Office of the Deputy Commissioner

for Patent Examination Policy - USPTO