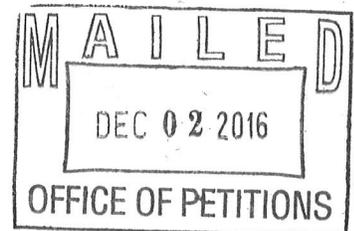




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In re Patent No. 9,396,025 :
SHUSHUAI ZHU : DECISION DENYING REQUEST
Issue Date: July 19, 2016 : FOR REDETERMINATION OF
Application No. 13/627,843 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: September 26, 2012 :
Attorney Docket No. ORA130118-US-NP :

This is in response to patentee's "REQUEST FOR RECONSIDERATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d) IN VIEW OF *EXELIXIS*" 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 746 days to at least 794 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 746 days. On September 19, 2016, patentee timely filed the present request for redetermination of patent term adjustment, seeking an adjustment of the determination to at least 794 days. Specifically, patentee solely disagrees with the USPTO's calculation of "B" delay. Patentee asserts that the correct amount of "B" delay is 298 days based on the decision in *Exelixis, Inc. v. Kappos*, 906 F. Supp. 2d 474 (E.D. Va. 2012).

Decision

Upon review, the Office finds that patentee is entitled to 746 days of PTA. The Office and patentee are in agreement regarding 505 days of "A" delay under 35 U.S.C. § 154(b)(1)(A), 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 9 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).

Art Unit: OPET

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 250 days of “B” delay. In this case, applicant filed the application on September 26, 2012, and the patent issued on July 19, 2016. Thus, the application was pending for 1393 days. During this time, applicant filed a RCE on January 29, 2016. The Office mailed a Notice of Allowance on March 15, 2016. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination (“RCE period”) began on January 29, 2016, and ended on March 15, 2016 – *i.e.*, 47 days. Subtracting the RCE period from the total number of days the application was pending results in $1393 - 47 = 1346$ days. Thus, for purposes of “B” delay, the application was pending for $1346 - 1096$ [*i.e.*, 3 years from the actual filing date]¹ = 250 days beyond the three-year anniversary of the filing date.

Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

$505 + 250 + 0 - 0 - 9 = 746$

¹ September 26, 2012 – September 26, 2015 = 1096 days

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Patentee's Calculation

$$505 + 298 + 0 - 0 - 9 = 794$$

Conclusion

The Office affirms that patentee is entitled to PTA in the amount of seven hundred forty-six (746) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $505 + 250 + 0 - 0 - 9 = 746$ days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 794 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).

The Office has charged the \$200.00 fee set forth in 37 CFR 1.18(e) to the Deposit Account as authorized. No additional fees are required.

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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