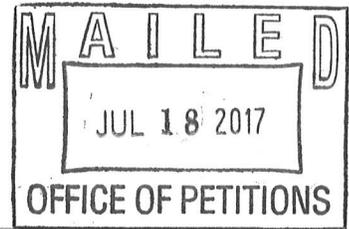




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In re Application of	:	
Beernink et al.	:	
Application No. 13/467,381	:	
Filed: May 9, 2012	:	DECISION ON REQUEST FOR
Patent No. 9,439,957	:	RECONSIDERATION OF
Issue Date: September 13, 2016	:	PATENT TERM ADJUSTMENT
Attorney Docket No.: CHOR-057CON	:	
Title: FACTOR H BINDING PROTEINS	:	
(FHBP) WITH ALTERED PROPERTIES	:	
AND METHODS OF USE THEREOF	:	

This is a decision on Patentee’s request for reconsideration pursuant to 37 C.F.R. § 1.705(b) filed November 11, 2016, requesting that the Office adjust the patent term adjustment from zero (0) days to one hundred and forty-one (141) days.

The Office acknowledges the submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) on November 11, 2016. 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 September 13, 2016, the Office determined that applicant was entitled to zero days of PTA.

On November 11, 2016, 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 146 days, pursuant to 37 C.F.R. § 1.705(b).

**Decision**

Upon review, the USPTO finds that Patentee is entitled to zero (0) days of PTA. Patentee and the Office are in agreement regarding the amount of “A” delay under 35 § U.S.C. § 154(b)(1)(A), “B” delay under 35 U.S.C. § 154(b)(1)(B), “C” delay under 35 U.S.C. § 154(b)(1)(C), and overlap under 35 U.S.C. § 154(b)(2)(A).

The sole issue in dispute is the amount of reduction of PTA under 35 U.S.C.

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§ 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704.

### **“A” Delay**

The Patentee and Office agree are 248 days of “A” delay. The period of “A” delay is 248 days under 37 C.F.R. § 1.703(a)(3) beginning on February 22, 2014 (the day after the date that is four months after the date the RCE was filed) and ending on October 27, 2014 with the mailing of a notice of non-compliant amendment.

### **“B” Delay**

The Patentee and Office agree that there are zero days of “B” delay.

The *Novartis* 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 1589 days, which is the number of days beginning on the filing date of the application (May 9, 2012) and ending on the date the patent issued (September 13, 2016).

The time consumed by continued examination is 926 days. The time consumed by continued examination includes the 429-day period beginning on the filing date of the RCE (October 21, 2013) and ending on the mailing date of the notice of allowance (May 3, 2016).

The number of days beginning on the filing date of application (May 9, 2012) and ending on the date three years after the filing date of the application (May 9, 2015) is 1096 days.

The result of subtracting the time consumed by continued examination (926 days) from the length of time between the application’s filing date and issuance (1589 days) is 663 days, which exceeds three years (1096 days) by negative 433 days; however, the “B” delay cannot be negative as the Office does not accord negative “B” delay, and therefore negative 433 days corresponds to zero days of “B” delay.<sup>1</sup> In other words, considering the time consumed by

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<sup>1</sup> 35 U.S.C. § 154(b)(1)(B) provides that if the pendency of an application is more than three years from the actual filing date of the application, the term of the patent issuing from the application shall be extended one day for each day after the end of the three-year period, but that certain time periods are excluded from the three-year period. However, if the sum of the excluded time periods exceed the over-three years period, the “B” delay will not be reduced past zero, as this would result in a reduction to the term of the patent.

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continued examination, this application was not pending beyond the 3-year period. Therefore, the period of “B” delay is zero days.

Put another way, the Office’s calculation of “B” delay reflects that the RCE was filed prior to the three year pendency date of the application. Considering time consumed by continued examination (and appellate review, which in this case is not applicable), this application was not pending for more than three years. As of the filing of the RCE on October 21, 2013, this application which was filed on May 9, 2012 had been pending 530 days (which is the period beginning on the filing date of the application and ending on the day before the RCE was filed). The RCE period is not included in counting the three-year pendency period. Accordingly, prior to “B” delay accruing for the Office taking in excess of three years to issue the patent, this application had to be pending for an additional 566 (1096 – 530) days after the mailing of the notice of allowance on May 3, 2016. As this application was only pending for an additional 133 days after the mailing of the notice of allowance (the period beginning on the day after the mailing of the notice of allowance – May 4, 2016 - and ending with the issuance of the patent on September 13, 2016), “B” delay is zero days.

Therefore, the period of “B” delay is zero days.

### **“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.

### **Overlap**

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

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

As a preliminary matter, the Office accorded three reductions pursuant to 37 C.F.R. § 1.704(c)(8) associated with the filing of an IDS after the filing of a reply (a 68-day reduction associated with the filing of an IDS on January 14, 2013 after a response to a restriction requirement was filed on November 7, 2012, and a 350-day reduction associated with the filing of Information Disclosure Statements on January 27, 2014 and October 6, 2014 after a RCE was filed on October 21, 2013). The Office agrees<sup>2</sup> that neither reduction is warranted due to the submission of a certification pursuant to 37 C.F.R. § 1.704(d)(1)(i) with each IDS.

It follows that the 68-day reduction and the 350-day reductions have been removed.

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<sup>2</sup> Patentee does not expressly dispute the 68-day reduction associated with the filing of an IDS on January 14, 2013. Patentee also does not reveal the calculations which result in the requested 107 days of Applicant delay. However, it appears that Patentee intended to dispute this reduction and the failure to dispute the 68-day reduction was an unintended oversight, since the requested Applicant delay of 107 days appears to include said 68-day reduction.

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The Office finds that, under 37 C.F.R. § 1.704, the amount of PTA should be reduced by 541 days. The Office has determined that the Patentee failed to engage in reasonable efforts to conclude processing or examination of its application during the following periods.

- (1) A 22-day period pursuant to 37 C.F.R. § 1.704(b) from May 14, 2013 until June 4, 2013 because the Office mailed a non-final Office action February 13, 2013. Accordingly, the three-month response date was May 13, 2103. However, the Patentee did not file its amendment and remarks until June 4, 2013.
- (2) A 31-day period pursuant to 37 C.F.R. § 1.704(b) from September 21, 2013 until October 21, 2013 because the Office mailed a final Office action on June 20, 2013. Accordingly, the three-month response date was September 21, 2013. However, the Patentee did not file its first RCE and amendment until October 21, 2013.
- (3) The Office finds that a 434-day reduction is warranted pursuant to 37 C.F.R. § 1.704(c)(7) from October 22, 2013 until December 29, 2014 because the Office mailed a final Office action on June 20, 2013, a reply having an omission was filed on October 21, 2013 in the form of a RCE and an amendment which was not properly marked to indicate the changes that were made relative to the immediate prior compliant version that was entered,<sup>3</sup> and on December 29, 2014, an amendment was filed correcting the omission.

A reduction of 434 days has been added.

- (4) A 23-day period pursuant to 37 C.F.R. § 1.704(b) from September 10, 2015 until October 2, 2015 because the Office mailed a non-final Office action on June 9, 2015. Accordingly, the three-month response date was September 9, 2015. However, the Patentee did not file its amendment and remarks until October 2, 2015.
- (5) A 31-day period pursuant to 37 C.F.R. § 1.704(b) from March 19, 2016 until April 18, 2016 because the Office mailed a final Office action on December 18, 2015. Accordingly, the three-month response date was March 18, 2016. However, the Patentee did not file its amendment and remarks until April 18, 2016.

### Overall PTA Calculation

#### Formula:

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

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<sup>3</sup> See notice of non-compliant amendment mailed on October 27, 2014.

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USPTO's Calculation:

$248 + 0 (1589 - 926 - 1096) + 0 - 0 - 541 (22 + 31 + 434 + 23 + 31) = \text{negative } 293$ , which corresponds to zero.<sup>4</sup>

Patentee's Calculation *appears to be*:

$248 + 0 (1589 - 926 - 1096) + 0 - 0 - 107 (22 + 31 + 23 + 31) = 141$ .

**Conclusion**

Patentee is entitled to PTA of zero (0). Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following:  $248 + 0 + 0 - 0 - 541 = \text{zero}$ .

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

Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.<sup>5</sup>

/ROBERT CLARKE/  
Robert A. Clarke  
Patent Attorney  
Office of the Deputy Commissioner  
for Patent Examination Policy

Encl: Adjusted PTA calculation

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<sup>4</sup> 35 U.S.C. § 154 provides that the term of a patent shall be 20 years from the date on which the application was filed in the United States, and the patent term will be adjusted if the Office fails to provide prompt patent and trademark office responses or to issue the patent within 3-years of pendency. Additional adjustments are guaranteed for delays due to derivation proceedings, secrecy orders, and appeals. Said Patent term adjustments are subject to reduction for instances where the applicant fails to engage in reasonable efforts to conclude prosecution of the application. However, if the reductions exceed the adjustments, the patent term adjustment will not be reduced past zero, as this would result in a reduction to the term of the patent.

<sup>5</sup> 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.