



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 9,447,844 :
Paul Zheng : DECISION DENYING REQUEST
Issue Date: September 20, 2016 : FOR REDETERMINATION OF
Application No. 13/965,705 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: August 13, 2013 :
Attorney Docket No. 63313.19.4 :

This is in response to patentee's "PETITION REQUESTING RECONSIDERATION OF THE PATENT TERM ADJUSTMENT AFTER ISSUANCE OF THE PATENT" filed Monday, November 21, 2016, which is being treated under 37 CFR 1.705(b) as a request that the Office adjust the patent term adjustment ("PTA") from 165 days to at least 173 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 September 20, 2016, this patent issued with a PTA in the amount of 165 days. On Monday, November 21, 2016, patentee timely filed the present request for redetermination of patent term adjustment, seeking an adjustment of the determination to at least 173 days. Patentee solely disagrees with the USPTO's calculation of "B" delay. Specifically, patentee asserts the Office miscalculated the period between the date of filing the application and the date of issuance of the patent by 8 days. Patentee avers the total number of days from the filing date to the issue date, less three years, is 38 days. Therefore, patentee argues the correct amount of "B" delay is 38 days, not 30 days as calculated by the USPTO.

Decision

Upon review, the Office finds that patentee is entitled to 165 days of PTA. The Office and patentee are in agreement regarding 245 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), zero (0) days of overlap under 35 U.S.C. 154(B)(2)(A), and 110 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 30 days of “B” delay. In this case, applicant filed the application on August 13, 2013, and the patent issued on September 20, 2016. Thus, the application was pending for 1135 days. During this time, applicant filed a RCE on June 22, 2016. The Office mailed a Notice of Allowance on June 29, 2016. Under 35 U.S.C. 154(b)(1)(B)(i), the time period consumed by continued examination (“RCE period”) began on June 22, 2016, and ended on June 29, 2016 – *i.e.*, 8 days. Subtracting the RCE period from the total number of days the application was pending results in $1135 - 8 = 1127$ days. Thus, for purposes of “B” delay, the application was pending for $1127 - 1097$ [*i.e.*, 3 years from the actual filing date]¹ = 30 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:

$245 + 30 + 0 - 0 - 110 = 165$

¹ August 13, 2013 – August 13, 2016 = 1097 days

Art Unit: OPET

Patentee's Calculation

$$245 + 38 + 0 - 0 - 110 = 173$$

Conclusion

The Office affirms that patentee is entitled to PTA in the amount of one hundred sixty-five (165) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $245 + 30 + 0 - 0 - 110 = 165$ days. A correction of the determination of patent term adjustment under 35 U.S.C. 154(b) to 173 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 acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). 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/
Robert A. Clarke
Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy - USPTO