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. 9,457,024	:	
Riley, et al.	:	DECISION ON
Issue Date: October 4, 2016	:	APPLICATION FOR
Application No. 14/356,486	:	PATENT TERM ADJUSTMENT
Filing or 371(c) Date: May 6, 2014	:	

This is a decision in response to the application for patent term adjustment, filed November 30, 2016, requesting that the patent term adjustment determination for the above-identified patent be changed from 0 days to 44 days.

The application for patent term adjustment is **DENIED.**

This decision 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).

On October 4, 2016, the instant application issued as Patent No. 9,457,024, with a patent term adjustment of 0 days. The Office determined a patent term adjustment of 0 days based upon 0 days of "A" delay plus 0 days of "B" delay, reduced by 0 days of Applicant delay. The instant application for patent term adjustment was timely filed on November 20, 2016.

Patentees argue that the Office improperly calculated "A" delay, specifically 37 CFR 1.702(a)(1) delay. Patentees assert that because the Office vacated the Restriction Requirement mailed May 26, 2015, and mailed a new Restriction Requirement on August 19, 2015, the 37 CFR 1.703(a)(1) delay should be 44 days, rather than the 0 days presently accorded by the Office. It is noted that Patentees argued that the initial restriction requirement was withdrawn on May 26, 2015.

Discussion

Patentees' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **0** days of PTA.

Patentees argue that the Office should be accorded 44 days of PTO delay pursuant to 37 CFR 1.703(a)(1). Patentees assert that because the Office vacated the May 26, 2015, Restriction Requirement and issued a new Restriction Requirement mailed August 19, 2015, the clock should not have stopped under 37 CFR 1.703(a)(1) on May 26, 2015, but instead should have stopped on August 19, 2015. Patentees' argument has been considered, but is not persuasive. It is noted that the May 26, 2015 Restriction Requirement was not withdrawn until August 19, 2015. See Restriction Requirement of August 19, 2015.

In view of *Pfizer v. Lee*, 117 USPQ2d 1781, 811 F.3d 466 (Fed. Cir. 2016), and further review of the record, the Office finds that the first restriction requirement was sufficient to meet the notification requirement under 35 USC 132 to stop the accrual of A delay. In *Pfizer*, the Federal Circuit held that such notification under Section 132 merely requires that an applicant "at least be informed of the broad statutory basis for [the rejection] of his claims, so that he may determine what the issues are on which he can or should produce evidence." *Id.* at 471-472.

Here, in the first restriction requirement mailed May 26, 2015, the examiner restricted all of the pending claims into distinct invention groups that identified related products as discussed in MPEP 806.05(j). Patentee was sufficiently informed as to the statutory basis for the restriction requirement and on the issues on which he could or should have produced evidence to respond to the restriction requirement. Much like the restriction requirement in *Pfizer*, the first restriction requirement "provided adequate grounds on which the patentee could 'recognize and seek to counter the grounds for rejection.'" *Pfizer*, 811 F.3d at 472 (citing *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990)). Because the examiner clearly defined the invention groups in the first restriction requirement, the applicants were given sufficient notice of the reasons for the examiner's restriction. *Id.* While it is true that the Office did *sua sponte* withdraw and vacate the August 19, 2015, restriction requirement in the restriction requirement mailed August 19, 2015, the "underlying purpose of PTA is to compensate patent applicants for certain reductions in patent term that are not the fault of the applicant, not to guarantee the correctness of the agency's every decision." *Id.* at 476 (citing *University of Massachusetts v. Kappos*, 903 F.Supp.2d 77, 86 (D.D.C. 2012) ("*UMass*")). The restriction requirement here provided the applicant sufficient information about the statutory basis for the restriction and the grounds on which the restriction was based, such that the applicant was able to address and counter them.

Accordingly, the Office finds that the statutory requirement of 35 USC 154(b)(1)(A)(i)(II) was met as of the initial restriction requirement of May 26, 2015.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

0 + 0 + 0 – 0 – 0 = 0

Conclusion

Patentee is entitled to PTA of seven hundred nineteen (719) days. Using the formula "A" delay + "B" delay + "C" delay – overlap – applicant delay = X, the amount of PTA is calculated as follows: 0 + 0 + 0 – 0 – 0 = 0 days.

Receipt of the fee under 37 CFR 1.18(e) is acknowledged.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Attorney Advisor, at (571) 272-3222.

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