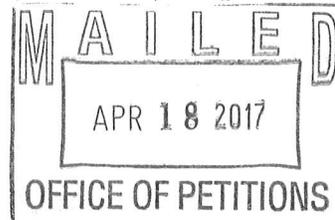




UNITED STATES PATENT AND TRADEMARK OFFICE



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

In re Patent No. 9,492,422 : DECISION ON
Takahashi et al. : PATENT TERM ADJUSTMENT
Issue Date: November 15, 2016 :
Application No. 13/509,483 :
Filing Date: June 18, 2012 :
Attorney Docket No. TAN-12-1141 :
Title: THERAPEUTIC OR PROPHYLACTIC :
AGENT FOR DIABETES :

This is a response to patentee's "APPLICATION FOR PATENT TERM ADJUSTMENT" filed January 10, 2017, requesting that the Office correct the patent term adjustment (PTA) from 36 days to 23 days.

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).

RELEVANT PROCEDURAL HISTORY

On November 15, 2016, the Office determined that patentee was entitled to 36 days of PTA.

On January 10, 2017, patentee timely filed this "APPLICATION FOR PATENT TERM ADJUSTMENT," seeking an adjustment of the determination to 23 days.

DECISION

Upon review, the Office finds that patentee remains entitled to **thirty-six (36)** days of PTA.

First, Patentee disagrees with the amount of PTA reduction due to applicant delay under 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704. Patentee asserts that the applicant delay, pursuant to 37 CFR 1.704(b), for the filing of a request for continued

Art Unit: OPET

examination (RCE) on January 22, 2015 should be corrected from 80 days to 82 days.

Second, Patentee maintains that the commencement date of this application is June 18, 2012, and not May 14, 2012, as calculated by the Office. Patentee does not specify how this affects the determination of patent term adjustment. Nonetheless, a review of the record reveals that using the June 18, 2012 commencement date, in light of the patent issue date of November 15, 2016 (and the RCE period beginning on January 22, 2015 and ending on July 14, 2016), the correct "B" delay would be 0 days, not 11 days.

Patentee is incorrect on both points.

ON APPLICANT DELAY

The 80-day reduction for the filing of a RCE on January 22, 2015 in response to a final Office action mailed August 1, 2014 is correct. Patentee fails to consider that the three-month time period from the Office communication fell on a Saturday.

As stated in MPEP 2732, regarding calculation of applicant delay pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b):

If the last day of the three-month time period from the Office communication notifying the applicant of the rejection, objection, argument, or other request falls on a Saturday, Sunday, or federal holiday within the District of Columbia, then action, may be taken, or fee paid, on the next succeeding secular or business day without loss of any patent term adjustment under 37 CFR 1.704(b). See *ArQule v. Kappos*, 793 F.Supp2d 214 (D.D.C. 2011). For example, no reduction in patent term adjustment would occur if an applicant's three-month reply time period expires on a Saturday and the applicant files a reply that is received by the Office on the following Monday, which is not a federal holiday within the District of Columbia. In this case, any patent term adjustment would not be reduced under 37 CFR 1.704(b) because the reply was received on Monday, the next succeeding secular or business day after the expiration of the three-month reply time. If applicant files his reply on Tuesday, then any patent term adjustment for the patent issuing from the application would be reduced under 37 CFR 1.704(b) by one day.

Art Unit: OPET

In this instance, the three-month period expired on November 1, 2014, a Saturday. The patent term adjustment was properly reduced by 80 days, counting the number of days beginning on the next succeeding business day after the expiration of the three-month reply time (November 4, 2014) and ending on that date of filing of the RCE (January 22, 2015).

In view thereof, total applicant delay is 117 [24 + 80 + 13] days.

ON "B" DELAY

The "B" delay of 11 days is correct. Patentee's calculation is based on an incorrect commencement date. June 18, 2012 is the date the application fulfilled the requirements of 35 U.S.C. 371. See Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495.

The Office properly calculated "B" delay based on a commencement date of May 14, 2012. Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c).

In this case, no express request for early processing was made. The priority date of the international application is November 13, 2009. The 30-month date fell on May 13, 2012, which was a Sunday. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Sunday, the period expired on the subsequent business day, May 14, 2012. See PCT Rule 80.5.

The Patent Term Adjustment calculation of "B" delay was properly calculated using the May 14, 2012 commencement date. The patent

Art Unit: OPET

issued on November 15, 2016; thus, the application was pending for 1647 days.

A request for continued examination (RCE) was filed on January 22, 2015. A notice of allowance issued on July 14, 2016. Under 35 U.S.C. § 154(b)(1)(B)(i), there was one time period consumed by continued examination ("RCE period"). The RCE period began on January 22, 2015 and ended on July 14, 2016 - i.e., 540 days.

Subtracting the RCE period from the total number of days the application was pending results in $1647 - 540 = 1107$ days.

Thus, for purposes of "B" delay, the application was pending for $1107 - 1096$ [i.e., 3 years from the actual filing date] = 11 days beyond the 3-year anniversary of the filing date.

"B" delay is 11 days.

OVERALL PTA CALCULATION

Formula:

"A" delay + "B" delay + "C" delay - Overlap - Applicant delay = X days of PTA

USPTO's Calculation:

$142 + 11$ [i.e., $1647 - 1096 - 540$] + 0 - 0 - 117 [i.e., $24 + 80 + 13$] = 36 days

Patentee's Calculation:

$142 + 0 + 0 - 0 - 119$ [i.e., $24 + 82 + 13$] = 23 days

CONCLUSION

The patent term adjustment (PTA) remains thirty-six (36) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: $142 + 11 + 0 - 0 - 117 = 36$ days.

Art Unit: OPET

As the patent issued with 36 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

Telephone inquiries specific to this matter should be directed to Attorney Advisor, Nancy Johnson at (571) 272-3219.

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