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In re Patent No. 7,820,677 :  
Issued: October 26, 2010 : DECISION ON PATENT TERM  
Application No. 11/359,152 :  
Filed: February 22, 2006 :  
Atty. Dkt. No.: 13425-116002 :

This is a decision on the request for reconsideration of decision mailed March 1, 2011 with respect to the application for patent term adjustment under 37 CFR 1.704(d) filed December 27, 2010. This request, filed May 2, 2011, is deemed timely filed within the meaning of 37 CFR 1.181(f).

**RELEVANT BACKGROUND**

Patentees request that a decision on this request for reconsideration of patent term adjustment be deferred or delayed until after a final decision has been rendered in Japan Tobacco, Inc. v. Kappos, No. 1:10-cv-01023 (D.D.C. filed Jun. 17, 2010). The request is hereby DENIED. This decision is a final agency action within the meaning of 5 USC §704 for purposes of seeking judicial review. See MPEP 1002.02.

The above-identified application matured into U.S. Patent No. 7,820,677 on October 26, 2010 with a revised patent term adjustment of 517 days. On March 1, 2011, a decision on patentees' application for patent term adjustment under 37 CFR 1.705(d), filed December 27, 2010, was mailed. The decision under 37 CFR 1.705(d) mailed March 1, 2011 dismissed patentees' request for increase in patent term adjustment from 517 days to 684 days.

Patentees herein request that the patent term adjustment for the above-identified patent be increased from 517 days to 684 days (391 days pursuant to 37 CFR 1.703(a) plus 611 days pursuant to 37 CFR 1.703(b) less 46 overlapping days less 272 of applicant delay pursuant to 37 CFR 1.704(b)).

Patentees maintain that the Office incorrectly calculated Office delay pursuant to 37 CFR 1.702(b). Patentees contend that the Office erred in subtracting from the "B delay" a period of time that was not "encompassed by actual appellate review." Specifically, patentees argue that subsequent to the filing of the Notice of Appeal December 29, 2009, but prior to jurisdiction of the case passing to the Board of Patent Appeals and Interferences, the examiner withdrew the finality of the final rejection mailed June 29, 2009 and mailed a Notice of Allowance on June 14,

2010. Thus, patentees argue that no time was consumed by review by the Board of Patent Appeals and Interferences or a Federal court within the meaning of 37 CFR 1.702(b)(4) during the 168 day period from December 29, 2009 (the filing date of the Notice of Appeal) until June 14, 2010 (the mail date of the Notice of Allowance). As such, patentees maintain that the "B delay" should be increased 444 days to 611 days. Thus, patentees conclude that the correct patent term adjustment is thus 684 days (the sum of 391 days of "A delay" and 611 days of "B delay" minus 46 overlapping days minus 272 days of "applicant delay").

### RELEVANT STATUTES

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

The implementing regulation, 37 CFR 1.702(b) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

### DECISION

Patentees do not dispute that time consumed by appeal under 37 CFR 41.31 is properly excluded the B delay and that the calculation of the excluded period begins on the date of filing of the Notice of Appeal. Instead, patentees argue that in the case at issue, no appellate review took place between the date of filing of the Notice of Appeal to the date of mailing of a Notice of Allowance.

Patentees' argument has been considered, but not found persuasive. The period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See, 35 U.S.C. 154(b)(1)(B)(ii). An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. See, 35 U.S.C. 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination).

The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by appeal to the Board of Patent Appeals and Interferences under 35 U.S.C. 134. So, with respect to calculating the "B delay" where applicant has filed a Notice of Appeal, the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a Notice of Appeal is filed and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

Thus, counting the period of time excluded from the "B delay" for the filing of a Notice of Appeal, from the date on which the Notice of Appeal is filed to the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35

U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences is proper. In this instance, the period consumed by appellate review is 168 days, beginning on December 29, 2009, the date of filing of the notice of appeal, and ending on June 14, 2010, the subsequent date of the mailing of a notice of allowance. Thus, the instant patent is entitled to an overall B delay is 444 (612 – 168) days.

### CONCLUSION

For the above-stated reasons, a review of the petition and file wrapper of the above-identified patent reveals that the above-identified patent is not entitled to a patent term extension or adjustment of 684 days. Therefore, the petition to change the patent term adjustment indicated on the above-identified patent to 684 days is **DENIED**.

This decision may be viewed as final agency action. See, MPEP 1002.02(b).

Telephone inquiries specific to this matter should be directed to Attorney Advisor Alesia M. Brown at (571) 272-3205.



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