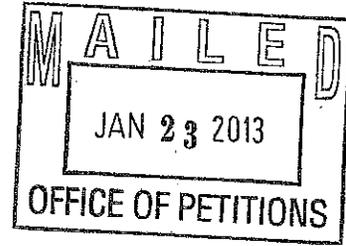




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Arnold & Porter LLP (24126)
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1801 Page Mill Road
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Palo Alto CA 94304

In re Patent No. 8,329,172 :
Grillo-Lopez :
Issue Date: December 11, 2012 : DECISION
Application No. 11/840,956 : ON APPLICATION FOR
Filed: August 18, 2007 : PATENT TERM ADJUSTMENT
Atty Docket No. : GNE- :
0375R1C2 US :
Title: COMBINATION THERAPIES :
FOR B-CELL LYMPHOMAS :
COMPRISING ADMINISTRATION OF :
ANTI-CD20 ANTIBODY :

This is a decision on the "RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)," filed January 8, 2013. Patentees request that the patent term adjustment be corrected from eight hundred and twenty-seven (827) days to one thousand and seven (1007) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED**¹ with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of 180 days.

THERE WILL BE NO FUTHER RECONSIDERATION OF THIS MATTER BY THE OFFICE.

On June 26, 2012, the Office mailed a "Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)," which indicated that

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of seeking judicial review. See MPEP § 1002.02.

the Patent Term Adjustment to date was 40 days. An original petition pursuant to 37 CFR 1.705(b) was filed on September 24, 2012, was timely filed as it was submitted concurrently with the issue fee. See § 1.705(b).

On November 7, 2012, the \$200.00 fee set forth in 37 CFR 1.18(e) was charged to Deposit Account No. 50-2387 in due course, as authorized on the sixth page of the original petition. No additional fees are required.

On November 8, 2012, the original petition pursuant to 37 CFR 1.705(b) was dismissed via the mailing of a decision, which set a two month period for response.

On December 11, 2012, the above-identified application matured into US Patent No. 8,329,172 with a patent term adjustment of 827 days.

The record supports a conclusion that this patent is not subject to a terminal disclaimer.

With this renewed petition, a single period of reduction is in dispute. A discussion follows.

A reduction of 180 days was assessed, associated with the filing of a supplemental response. Patentees assert the reduction should total 0 days. At issue is the alleged presence of the statement contained within 37 C.F.R. § 1.704(d) in the Information Disclosure Statement (IDS) submitted on February 28, 2012.

Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply after a reply has been filed is a failure to engage in reasonable efforts to conclude prosecution. However, pursuant to 37 CFR § 1.704(d), "[a] paper containing only an information disclosure statement in compliance with Sec. Sec. 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement:

- (i) Was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in Sec. 1.56(c) more than thirty days prior to the filing of the information disclosure statement; or

(ii) Is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in Sec. 1.56(c) more than thirty days prior to the filing of the information disclosure statement."

See <http://www.gpo.gov/fdsys/pkg/FR-2011-12-01/html/2011-30933.htm>

A non-final Office action was mailed on March 3, 2011, a response was received on June 6, 2011, a Notice of Non-Responsive Amendment was mailed on August 26, 2011, a response was received on September 1, 2011, and an IDS was received 180 days later on February 28, 2012. Consequently, a 180-day reduction was assessed, pursuant to 37 CFR § 1.704(c)(8).

With the original petition, Applicants asserted, *inter alia*, that the reduction was improper, since the statement contained in 37 CFR § 1.704(d) was allegedly included on the first page of the IDS.²

The decision on the original petition indicated that the statement contained in the IDS that was submitted on February 28, 2012 therein is not the same statement as that required by 37 C.F.R. § 1.704(d). More specifically, the relevant language contained in 37 CFR § 1.704(d) is as follows:

[The reference w]as first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in Sec. 1.56(c) more than thirty days prior to the filing of the information disclosure statement;

or

[The reference i]s a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in Sec. 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

Whereas the relevant language contained on the first page of the submission of February 28, 2012 is as follows:

This reference listed on the attached form PTO-1449 was cited in the Canadian Office Action from the related CA 2,340,091 mailed 01/31/2012.

² Original petition, page 5.

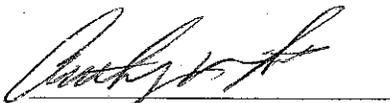
With this renewed petition, Patentee argues the substantive requirements of 37 CFR § 1.704(d) were not only met but exceeded. However, 37 CFR § 1.704(d) makes it clear that a paper containing only an information disclosure statement in compliance with 37 CFR §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 C.F.R. § 1.704(c)(8) if it is accompanied by one of the two statements reproduced above. The supplemental IDS does not contain either of these two statements, and as such the submission of the same constitutes a failure to engage in reasonable efforts to conclude prosecution, and the 180-day reduction was properly assessed.

The request for reconsideration of the revised patent term adjustment is denied.

The Office acknowledges that Patentees previously submitted the \$200 fee set forth in § 1.18(e). As the present request pertains only to 180-day reduction, no additional fees are required. It follows that the \$200 fee submitted on January 8, 2013 with this renewed petition is unnecessary and will be refunded to Deposit Account No. 50-2387 in due course.

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 Senior Attorney Paul Shanoski at (571) 272-3225.³



Anthony Knight
Director
Office of Petitions/
Petitions Officer

³ Petitioner 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, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.