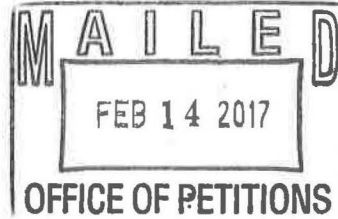




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In re Patent No. 8,498,820  
Semizarof et al.

Issue Date: 07/30/2013

Application No. 12/607,079

Filing or 371(c) Date: 10/28/2009

Atty. Docket No.: 029996-1668-01 (9670USO1)

:  
: ON REDETERMINATION OF  
: PATENT TERM ADJUSTMENT  
:  
:

This is a response to patentees "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT", filed December 18, 2014, requesting that the Office adjust the PTA from 495 days to 496 days. The Office has re-determined the PTA to be 495 days.

This petition is hereby **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).

### Relevant Procedural History

On July 30, 2013, the above-identified application matured into U.S. Patent No. 8,498,820. The patent issued with a PTA of 370 days. Patentee timely filed a request for reconsideration of patent term adjustment on September 30, 2013. On October 31, 2014, the Office redetermined the patent term adjustment to be 495 days. Included in the redetermination was a second period of "B" delay, calculated to be 125 days, beginning on March 28, 2013 (the day after the mail date of the Notice of Allowance), and ending on July 30, 2013, the issue date of the patent.

Patentee requests recalculation of the Patent Term Adjustment in view of *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). Petitioner avers that the exclusion period should only be calculated from the filing of a Request for Continued Examination ("RCE"), up to the mailing of the Notice of Allowance, but not including the day of the mailing of the Notice of Allowance. Under petitioner's calculation, second period of "B" delay, calculated to be 126 days, beginning on March 29, 2013 (the mail date of the Notice of Allowance), and ending on July 30, 2013, the issue date of the patent.

### Decision

Patents' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **495** days of PTA. The Office has revisited the amount of "B" delay under 35 U.S.C. § 154(b)(1)(B) and the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A) pursuant to

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the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). Patentee and the Office are in agreement regarding the amount of "A" delay under 35 U.S.C. § 154(b)(1)(A) and 37 CFR 1.702(a), and as to the amount of "applicant delay" under 35 U.S.C. § 154(b)(2)(C) and 1.704(b).

As for the amount of "B" delay, the 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 *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014). 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. However, the *Novartis* court 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. *Id.* at 602. Specifically, the court stated that *allowance-to-issuance time* is not to be distinguished according to whether there is a continued examination in a prosecution. (Emphasis added). The court continued:

The language of "examination" used in § 154(b)(1)(B) reflects that underlying principle. An "examination" presumptively ends at allowance, when prosecution is closed and there is no further examination on the merits in the absence of a special reopening. The Notices of Allowance for the '155, '518, and '031 patents here read: "THE APPLICATION . . . HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED." J.A. 291 (the '155 patent); J.A. 367 (the '518 patent); J.A. 488 (the '031 patent). And the Manual of Patent Examining Procedure, in §§ 1305, 1309, indicates that, when a notice of allowance is mailed, the application moves from the examiner to the office of publication. The common-sense understanding of "time consumed by continued examination," 35 U.S.C. § 154(b)(1)(B)(i), is time up to allowance, but not later, unless examination on the merits resumes.

*Id.*, at 602.

The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

As the court stated, examination ends *at allowance*. *Id.* (Emphasis added). Further to this, the court noted that "the Manual of Patent Examining Procedure, in §§ 1305, 1309, indicates that, *when a notice of allowance is mailed*, the application moves from the examiner to the office of publication. . . ." not the day before the notice of allowance is mailed. *Id.* (Emphasis added). As the court stated, [t]he common-sense understanding of "time consumed by continued examination," 35 U.S.C. § 154(b)(1)(B)(i), is time up to allowance. . . ." not before allowance. *Id.*

As the *Novartis* court stated, "examination" presumptively ends at allowance, when prosecution is closed and there is no further examination on the merits in the absence of a special reopening Pursuant to the *Novartis* decision, the USPTO calculated the second period of "B" delay

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beginning on March 28, 2013 (the day after examination ended - the day after the mail date of the Notice of Allowance), and ending on July 30, 2013, the issue date of the patent, calculated to be 125 days.

The court provided that “[t]he common-sense understanding of ‘time consumed by continued examination,’ 35 U.S.C. § 154(b)(1)(B)(i), is time up to allowance, but not later...,” which includes allowance, and not the day before allowance, and not the day after allowance. *Id.*

Pursuant to the Novartis decision, the USPTO determined that the patentee is entitled to 183 days of “B” delay. In this case, it was previously determined that the application filing date is October 28, 2009, and the issue date of the patent is July 30, 2013. Accordingly, the total pendency of the application was 1372 days. Thus, the application was pending for  $1372 - 1097 = 275$  days beyond the three-year anniversary of the application’s filing date. This three-year pendency period began on October 29, 2012, and ended on July 30, 2013. During this time, applicant filed an RCE on December 26, 2012. Under 35 U.S.C. § 154(b)(1)(B)(i), the first period of “B” delay was 58-days, beginning on October 29, 2012, and ending on December 25, 2012 (the day before the RCE was filed), and the second period of “B” delay was 125 days, beginning on March 28, 2013 (the day after the mail date of the Notice of Allowance), and ending on July 30, 2013, the issue date of the patent. The sum of these two “B” periods is 183 days. Thus, for purposes of “B” delay, the application was pending for 183 days. Alternatively, reducing for the RCE period of 92 days (December 26, 2012 to March 27, 2013), the amount of “B” delay amounted to 183 days ( $1372 - 1097 - 92 = 183$ ).

### **Overall PTA Calculation**

#### **Formula:**

“A” delay + “B” delay + “C” delay - Overlap - applicant delay = X

#### **USPTO’s Calculation:**

$$395 + 183 + 0 - 0 - 83 = 495$$

#### **Patentee’s Calculation**

$$395 + 184 + 0 - 0 - 83 = 496$$

### **Conclusion**

The present REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT has been considered; however, the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT, is DENIED.

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Telephone inquiries specific to this decision should be directed to Attorney Advisor Derek Woods at (571) 272-3232.

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Office of the Deputy Commissioner  
for Patent Examination Policy