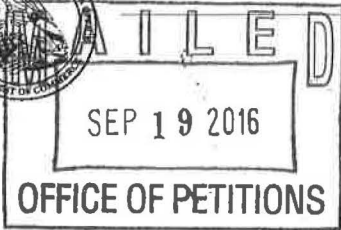




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In re Patent of Falco et al. :
Patent No.: 8,993,562 : DECISION ON REQUEST
Issue Date: March 31, 2015 : FOR RECONSIDERATION OF
Application No.: 13/282,926 : REDETERMINATION OF PATENT
Filing date: October 27, 2011 : TERM ADJUSTMENT
Attorney Docket No.: 2294-0148PUS2 :

This is a response to Patentee’s “REQUEST FOR RECONSIDERATION OF PTA,” filed June 1, 2015, pursuant to 37 CFR 1.705(b), requesting that the Office adjust the patent term adjustment from one hundred and fifty-five (155) days to two hundred and fourteen (214) 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 (“PTA”) is DENIED with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of one hundred and fifty-five (155) days.

This is the Director’s decision on the applicant’s request for reconsideration under 35 USC 154(b)(3)(B)(ii). Any appeal from this decision is pursuant to 35 U.S.C. § 154(b)(4)(A).

Relevant Procedural History

The patent issued with a PTA determination of 155 days on March 31, 2015. On Monday, June 1, 2015, patentee filed the present request for reconsideration of PTA under 37 CFR 1.705(b) seeking reconsideration of the patent term adjustment and requesting that the Office grant PTA in an amount of 214 days.

Decision

Upon review, the USPTO finds that patentee is entitled to one hundred and fifty-five (155) days of PTA. Patentee and the Office are in agreement regarding the amount of “B” delay under 35 U.S.C. § 154(b)(1)(B), “C” delay under 35 U.S.C. § 154(b)(1)(C), overlap under 35 § U.S.C. § 154(b)(2)(A), and Applicant delay under 35 U.S.C. § 154(b)(2)(C)(iii) and 37 CFR 1.704..

The sole disagreement between patentee and the Office is with respect to the amount of “A” delay under 35 § USC 154(b)(1)(A).

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### **“A” Delay**

Patentee argues the Office should be assessed a 59 day period of adjustment pursuant to 37 CFR 1.702(a) due to the delay in mailing a non-final Office action on July 7, 2014, after a Notice of Withdrawal from Issue was mailed on May 13, 2014.

The Office does not concur.

37 CFR 1.702 discusses the grounds for adjustment of patent term due to examination delay. 37 CFR 1.702(a) states, in pertinent part:

- (a) *Failure to take certain actions within specified time frames.* 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:
- (1) ...;
  - (2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

On November 22, 2013, the Office mailed a Notice of Allowance. On January 13, 2014, the Office mailed a Notice of Withdrawal from Issue under 37 CFR 1.313(b). On July 7, 2014, the Office mailed a non-final Office action.

Patentee argues the Office should have acted on the application within 4 months of the date the Office withdrew the application from issue. Patentee calculates a 59 day period of adjustment pursuant to 37 CFR 1.702(a), beginning on May 14, 2014, the day after four months after the Office mailed the Notice of Withdrawal from Issue under 37 CFR 1.313(b) and ending on July 7, 2014, the date the Office mailed a non-final Office action.<sup>1</sup>

However, a Notice of Withdrawal from Issue under 37 CFR 1.313(b) is not a reply under 35 U.S.C. 132 or an appeal taken under 35 U.S.C. 134. The Office was not on a four month clock following the Office’s mailing of a Notice of Withdrawal from Issue.

Accordingly, no adjustment under 37 CFR 1.702(a)(2) is warranted in connection with the mailing of a non-final Office action on July 7, 2014, and the period of “A” delay remains zero days. Patentee is reminded that although no adjustment is warranted under 37 CFR 1.702(a)(2), this delay was taken into consideration in the calculation of “B” Delay.

### **“B” Delay**

The patentee and Office agree that there are 155 days of “B” delay.

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<sup>1</sup> The Office finds this calculation yields 55 days, not 59 days.

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*Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014) includes “instructions” for calculating the period of “B” delay. Specifically, the decision states,

The better reading of the language is that the patent term adjustment time [for “B” delay] should be calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of (b)(1)(B)) and determining the extent to which the result exceeds three years.<sup>2</sup>

The length of time between application filing and issuance is 1252 days, which is the number of days beginning on the filing date of the application (October 27, 2011) and ending on the date the patent issued (March 31, 2015).

The time consumed by continued examination is zero days.

The number of days beginning on the filing date of application (October 27, 2011) and ending on the date three years after the filing date of the application (October 27, 2014) is 1097 days.

The result of subtracting the time consumed by continued examination (0 days) from the length of time between the application’s filing date and issuance (1252 days) is 1252 days, which exceeds three years (1097 days) by 155 days. Therefore, the period of “B” delay is 155 days.

#### **“C” Delay**

The patentee and the Office agree that the amount of “C” delay under 37 CFR 1.703(e) is zero days

#### **Overlap**

The patentee and the Office agree that the amount of overlap under 35 § USC 154(b)(2)(A) is zero days.

#### **Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]**

The patentee and the Office agree that the amount of Applicant delay under 37 CFR 1.704 is zero days.

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<sup>2</sup> *Novartis*, 740 F.3d at 601.

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**Overall PTA Calculation**

**Formula:**

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

**USPTO’s Calculation:**

$0 + 155$  (i.e.,  $1252 - 0 - 1097$ )  $+ 0 - 0 - 0 = 155$

**Patentee’s Calculation:**

$59 + 155$  (i.e.,  $1252 - 0 - 1097$ )  $+ 0 - 0 - 0 = 214$

Patentee is entitled to PTA of one hundred and fifty-five (155) days. Using the formula “A” delay + “B” delay + “C” delay - Overlap - Applicant delay = X, the amount of PTA is calculated as following:  $0 + 155 + 0 - 0 - 0 = 155$  days.

Telephone inquiries regarding this decision may be directed to Attorney Advisor Shirene Willis Brantley at (571) 272-3230.

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