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OFFICE OF PETITIONS

In re Patent No. 8,377,009
Sullivan et al. : DECISION ON RENEWED
Issue Date: February 19, 2013 : REQUEST FOR
Application No. 11/971,471 : RECONSIDERATION OF
Filed: January 9, 2008 : PATENT TERM ADJUSTMENT
Attorney Docket No. MYS300/4-003US2:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed September 24, 2013, requesting that the patent term adjustment determination for the above-identified patent be changed from zero (0) days to four hundred and thirty-seven (437) 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** with respect to making any change in the patent adjustment determination under 35 U.S.C. § 154(b) of zero days.

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

An applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3)may consider filing an appeal pursuant to 35 USC 154(b)(4)(A).

On February 19, 2013, the above-identified application matured into US Patent No. 8,377,009 with a patent term adjustment of zero days. A petition pursuant to 37 C.F.R. § 1.705(b) was filed on April 19, 2013 along with the $200.00 fee set forth in 37 C.F.R. § 1.18(e), and it was timely filed as it was submitted "no later than two months from the date the patent was granted." On petition, Patentee requested recalculation of the patent term adjustment to include a 639-day period of adjustment pursuant to 37 C.F.R. § 1.703(b). The Office dismissed the request on July 24, 2013. On September 24, 2013, patentee requested reconsideration of the dismissal which is the subject of this decision.

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

Patentee agrees with the Office's calculation of "A" delay of 153 days, "C" delay of zero days, and applicant delay of 335 days. At issue are the period of "B" delay and the period of overlap.

"B" Delay

The *Novartis* decision 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.[1]

The length of time between application and issuance is 1869 days, which is the number of days beginning on the filing date of the application October 9, 2008 and ending on the date the patent issued February 19, 2013.

The time consumed by continued examination is 642 days. The time consumed by continued examination includes the following period):

- The period of 642 days, beginning on the filing date of the RCE January 7, 2011 and ending on the mailing date of the notice of allowance October 9, 2012.

The number of days beginning on the filing date of application (January 9, 2008 and ending on the date three years after the filing date of the application January 9, 2011 is 642 days.

The result of subtracting the time consumed by continued examination (*642* days) from the length of time between the application filing date and issuance (1869 days) is 1227 days, which exceeds three years (1097 days) by 130 days. Therefore, the period of "B" delay is 130 days.

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[1] *Novartis*, 740 F.3d at 601.

Applicant's request for 772 days was submitted prior to the decision by the United States Court of Appeals for the Federal Circuit (Novartis) in which the court outlined the parameters of subtracting the periods of continued examination from the "B" delay period.

Overlap

Regarding the third item in dispute, the Office has determined the overlap between "A" delay and "B" delay is zero days. for the period of B delay that occurs on the same days as the two periods of A delay beginning on the day after May 7, 2011 and ending on October 5, 2011 (151 days) and the period beginning on the day after July 1, 2012 and ending on July 3, 2012 (two days). These two periods total 153 days.

The Office finds that the number of overlapping days of Office delay is zero (0) days. In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the "A" and "B" delays. Under this interpretation, the Office finds that the overlapping period of "A" delay and "B" delay is **0** days.

The Office finds that the periods of "B" delay are:

(1) beginning on October 13, 2012 and ending on February 19, 2013 (date of patent issuance) for a period of **130** days.

The Office finds that the periods of "A" delay are:

"A" delay pursuant to 37 CFR 1.703(a), which began on May 8, 2011 (day after date that is four months from filing of RCE) and ended on October 5, 2011 (date of Office mailing of non-final rejection) (151) days AND beginning on July 2, 2012(day after date which is four months from applicant's reply) and ending on the date of July 3, 2012 (date of mailing of final rejection) (2 days). The period of "A" delay is 153 days

The total number of overlapping days of Office delay is zero (0) days.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - overlap - applicant delay = X.

USPTO's Calculation:

153 (151 + 2) + 130 + 0 - 0 - 335 (60 + 127 + 92 + 56) = 0, which corresponds to zero.

Patentee's Calculation

153 (151 + 2) + 772[2] + 0 - 153 (151 + 2) - 335 (60 + 127 + 92 + 56) = 437

Conclusion

Patentee is entitled to PTA of zero days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: 153 + 130 + 0 - 0 - 335 = zero days.

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 Attorney Advisor Paul Shanoski at (571) 272-3225.[3]

/Kery A. Fries/

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Office of Deputy Commissioner
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[2] The period beginning on the day after January 9, 2011 and ending on February 19, 2013.

[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.