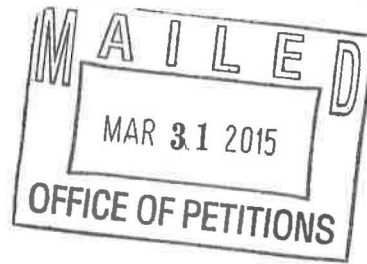




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In re Patent No. 8,645,105 : DIRECTOR'S DECISION ON
Issued: February 4, 2014 : PATENT TERM ADJUSTMENT
Application No. 12/271,372 :
Filed: November 14, 2008 :
Atty. Dkt. No.: 58083-368475 (B915) :

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R § 1.705(b)," filed April 23, 2014, requesting that the patent term adjustment be increased from 1326 days to 1437 days.

The redetermination of patent term adjustment is **DENIED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 1326 days.

THERE WILL BE NO FURTHER CONSIDERATION OF THIS MATTER BY THE OFFICE.

This redetermination of patent term adjustment is the Director's decision on the applicant's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

Relevant Procedural History

On February 4, 2014, this patent issued with a patent term adjustment determination of 1326 days. On April 23, 2014, patentee timely filed an application for patent term adjustment under 37 CFR 1.705(b) seeking an adjustment of the determination to 1437 days.

Decision

Patentee does not dispute the Office's calculation of "A" delay of 922 days, the Office's calculation of "B" delay of 813 days, or the Office's calculation of "C" delay of 0 days. Patentee does not dispute the applicant delay of 31 days under 37 CFR 1.704(b) or the applicant delay of 14 days under 37 CFR 1.704(c)(10). At issue is the applicant delay of 111 days assessed under 37 CFR 1.704(c)(7) in connection with the reply filed December 13, 2012.

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In this regard, a restriction requirement was mailed July 24, 2012. A non-compliant reply was filed August 24, 2012. A Notice of Non-Compliance was mailed November 14, 2012. A compliant reply was filed December 13, 2012.

In accordance with 37 CFR 1.704(c)(7), submission of a reply having an omission (§ 1.135(c)) constitutes a failure to engage in reasonable efforts to conclude prosecution or processing. Accordingly, the period of patent term adjustment is reduced by the number of days beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. Hence, the 111 day period of reduction commenced August 25, 2012 and ended December 13, 2012.

However, patent asserts:

“On December 13, 2012, the undersigned and Examiner Omar F. Fernandez Rivas (supervisor for Examiner Hugh M. Jones) conducted a telephone interview to discuss the subject matter of the Notice mailed on November 14, 2014. A Response to the Restriction Requirement and erroneous Notice were filed on December 13, 2012 and attached as Exhibit B. It is noted during the interview, **Examiner Fernandez Rivas agreed that the Response filed August 24, 2012 included a sufficient election of the species as required by the Restriction Requirement. Examiner Fernandez Rivas also agreed that a supplemental reply curing informalities of the Response, including corrections to the status of the claims, could be filed no later than December 14, 2012 without requiring a petition under 37 C.F.R. 1.136(a) for an extension of time or associated fees. (see Exhibit B).**

As the response to the Restriction Requirement filed on August 24, 2012 was compliant and considered timely filed pursuant to 35 U.S.C. § 21(b), Applicants submit that attributing a 111-day delay for patent term adjustment purposes is inappropriate. Therefore, the period of adjustment under § 1.704(a) should be 45 days.”

Patentee’s arguments have been carefully considered, but are not found persuasive. Patentee’s arguments are inconsistent with the written record, specifically, the Examiner’s Interview Summary and attachment dated April 1, 2013.

Further, there is no indication in the record that the Notice of Noncompliance was vacated and expunged from the record. Thus, for the purpose of calculating the reduction of patent term adjustment, the reply filed December 13, 2012 was properly used to determine whether applicant failed to engage in reasonable efforts to conclude prosecution or processing within the meaning of 37 CFR 1.704(b) and 1.704(c)(7). See, also, Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366 (Sept. 18, 2000) (final rule).

In view thereof, the reduction of 111 days will not be restored.

Overall PTA Calculation

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Formula:

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

USPTO’s Calculation:

$922 + 813 + 0 - 253 - 156 = 1326$

Patentee’s Calculation

$922 + 813 + 0 - 253 - 45 = 1437$

Conclusion

Patentee remains entitled to PTA of 1326 days, as reflected on the patent. Using the formula “A” delay + “B” delay + “C” delay - overlap - applicant delay = X, the amount of PTA is calculated as follows: $922 + 813 + 0 - 253 - 156 = 1326$ days.

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

/JOHN COTTINGHAM/

Director

Office of Petitions/

Petitions Officer