

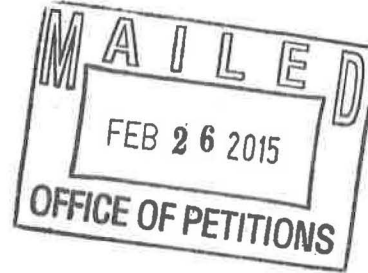


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In re Patent No. 8,685,233
Subramaniyam
Issue Date: April 1, 2014
Application No. 12/376,962
Filed or 371(c): August 4, 2009
Attorney Docket No. 2123-02200
Title: METHOD OF REMOVAL OF
CALCIUM FROM HYDROCARBON
FEEDSTOCK

:
: DIRECTOR'S DECISION ON
: PATENT TERM ADJUSTMENT



This is a response to applicants "Request for Reconsideration of Patent Term Adjustment" filed pursuant to 37 CFR 1.705(b) on November 25, 2014 requesting that the Office adjust the PTA from 900 days to 927 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 927 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 April 1, 2014, this patent issued with a patent term adjustment determination of 632 days. On May 30, 2014 a Request For Recalculation of Patent term Adjustment in View of AIA Technical Corrections was filed. A petition for request of reconsideration of the patent term was filed on June 25, 2014. A decision was mailed on September 29, 2014 granting patentee 900 days of patent term adjustment. On November 25, 2014, patentee filed this request for redetermination of patent term adjustment, requesting that patentee be granted a patent term adjustment of 927 days.

Art Unit: OPET

Decision

Patentee agrees with the Office's calculation of applicant delay of 147 days, C delay of 0 days, and 0 days of overlap. Patentee disputes the calculations for the period of A delay 746 and B delay of 301 days.

The Office disagrees with patentees' calculations regarding "A" delay. The Office amended 37 C.F.R. § 1.703(a) to read as follows, with emphasis added:

The period of adjustment under § 1.702(a) is the sum of the following periods:

- (1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]¹

The changes made to 37 C.F.R. § 1.703(a) apply to all patents issued on or after January 14, 2013, and the instant application issued as a patent on April 1, 2014. Therefore, the changes made to 37 C.F.R. § 1.703(a) apply to this case.

In view thereof, the period of A-1 delay should be based on the date the national stage commenced ("Commencement Date") instead of the Date of Completion.

The correct Commencement Date is February 23, 2009. The date the national stage of an international application commences is addressed in MPEP § 1893.01, which states, with emphasis added,

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, *in the absence of an express request for early processing* of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, *the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application.*

¹ See Revisions to Patent Term Adjustment (Interim Final Rule), 78 Fed. Reg. 19416, 19420 (April 1, 2013).

Art Unit: OPET

The February 9, 2009 papers did include a request for early processing. However, early processing was not met with the submission of the declaration on August 4, 2009. Since the commencement date falls on a weekend (February 22, 2009) and early commencement was not met, the next business day (February 23, 2009) is used for calculating delay pursuant to 37 CFR 1.703(b). See PCT Rule 80.5.

Accordingly, the commencement date is Monday, February 23, 2009. The correct period of A-1 Delay is 644 days, which is the number of days beginning April 24, 2010, the day after the date 14 months after the Commencement Date, and ending January 27, 2012.

“A” delay totals 746 (644 + 102) days.

Pursuant to the Novartis decision, the USPTO has determined that the patentee is entitled to 301 days of “B” delay. In this case, the commencement date of the application is February 23, 2009 and the patent issued on April 1, 2014. Thus, the application was pending for 1864 days. During this period, applicant filed an RCE on September 10, 2012. The Office mailed one Notice of Allowance on December 20, 2013. Under 35 USC 154(b)(1)(B)(i), the time period consumed by continued examination (“RCE period”) began on September 10, 2012 and ended on December 20, 2013, i.e., 467 days. Subtracting the RCE period from the total number of days the application was pending results in $1864 - 467 = 1397$ days. Thus, for purposes of “B” delay, the application was pending for $1397 - 1096$ [i.e., 3 years from the actual filing date] = 301 days beyond the three-year anniversary of the filing date.

The Office finds that there are 0 days of overlapping days of Office delay. In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the United States Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the “A” and “B” delays.

Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

$746 + 301 + 0 - 0 - 147 = 900$

Patentee’s Calculation

$760 + 316 + 0 - 0 - 147 = 929$

(It is noted that patentee calculates the total as 927 days)

Art Unit: OPET

Conclusion

Patentee remains entitled to PTA of nine hundred (900) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: $746 + 301 + 0 - 0 - 147 = 900$ days.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Charlema Grant at (571) 272-3215.

/JOHN COTTINGHAM/
Director
Office of Petitions/
Petitions Officer