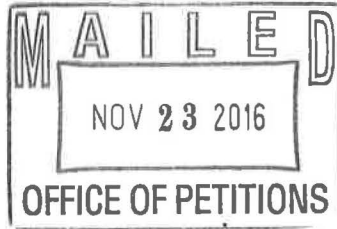




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In re Patent No. 8,992,919
Dixit, et al.
Issue Date: 03/31/2015
Application No. 13/086,941
Filing or 371(c) Date: 04/14/2011

: DECISION ON
: APPLICATION FOR
: PATENT TERM ADJUSTMENT
:

This is a decision in response to the application for patent term adjustment, filed August 31, 2015, requesting that the patent term adjustment determination for the above-identified patent be changed from 719 days to 885 days.

The application for patent term adjustment is **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).

On March 31, 2015, the instant application issued as Patent No. 8,992,919 with a patent term adjustment of 719 days. The Office determined a patent term adjustment of 719 days based upon 399 days of "A" delay plus 351 days of "B" delay, reduced by 31 days of Applicant delay. The instant application for patent term adjustment was timely filed with a three month extension of time.

Patentees argue that the Office improperly calculated "A" delay, specifically 37 CFR 1.702(a)(1) delay. Patentees assert that because the Office vacated the Restriction Requirement mailed July 18, 2013 and mailed a new Restriction Requirement on December 31, 2013, 37 CFR 1.703(a)(1) delay should be 565 days, rather than the 399 days presently accorded by the Office.

Discussion

Patentees' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **719** days of PTA.

Patentees argue that the Office should be accorded 565 days of PTO delay pursuant to 37 CFR 1.703(a)(1). Patentees assert that because the Office vacated the July 18, 2013 Restriction Requirement with a new Restriction Requirement mailed December 31, 2013, the clock should not have stopped under 37 CFR 1.703(a)(1) on July 18, 2013, but instead should

have stopped on December 31, 2013. Patentees' argument has been considered, but is not persuasive.

In view of *Pfizer v. Lee*, 117 USPQ2d 1781, 811 F.3d 466 (Fed. Cir. 2016), and further review of the record, the Office finds that the first restriction requirement was sufficient to meet the notification requirement under 35 USC 132 to stop the accrual of A delay. In *Pfizer*, the Federal Circuit held that such notification under Section 132 merely requires that an applicant "at least be informed of the broad statutory basis for [the rejection] of his claims, so that he may determine what the issues are on which he can or should produce evidence." *Id.* at 471-472.

Here, in the first restriction requirement mailed July 18, 2013, the examiner restricted all of the pending claims into distinct invention groups that identified related products and related methods as discussed in MPEP 806.05(j) and (h) as well as made a requirement to select a species to be examined. Patentee was sufficiently informed as to the statutory basis for the restriction requirement and on the issues on which he could or should have produced evidence to respond to the restriction requirement. Much like the restriction requirement in *Pfizer*, the first restriction requirement "provided adequate grounds on which the patentee could 'recognize and seek to counter the grounds for rejection.'" *Pfizer*, 811 F.3d at 472 (citing *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990)). Because the examiner clearly defined the invention groups in the first restriction requirement, the applicants were given sufficient notice of the reasons for the examiner's restriction. *Id.* Indeed, the applicants replied to the restriction requirement by electing to prosecute Group I (claims 1-26 and 32-34) without traverse. In response to the applicants' election of Group I, the examiner issued a second restriction requirement on December 31, 2013, further restricting the claims of Group I into two additional groups – such that Group I consisted of claims 1, 24-26, and 32-34, Group II consisted of claim 2, and Group III consisted of remaining claims 3-23. In response to the second restriction requirement, the applicants elected to prosecute Group I and amended its application to add several new claims to its elected group. Prosecution of this group of claims proceeded on the merits. As the Federal Circuit explained, the "underlying purpose of PTA is to compensate patent applicants for certain reductions in patent term that are not the fault of the applicant, not to guarantee the correctness of the agency's every decision." *Id.* at 476 (citing *University of Massachusetts v. Kappos*, 903 F.Supp.2d 77, 86 (D.D.C. 2012) ("*UMass*")). The restriction requirement here provided the applicant sufficient information about the statutory basis for the restriction and the grounds on which the restriction was based, such that the applicant was able to address and counter them.

Moreover, the Office actions and applicants' responses regarding the restriction requirements issued by the examiner with respect to the claims placed in Group I are part of the "back and forth" process of patent prosecution that does not give rise to additional A delay. *See Pfizer*, 811 F.3d at 475-76. While it is less common to issue more than one restriction requirement in an application, it is permissible for an examiner to do so. *See MPEP* 811.02.

Accordingly, the Office finds that the statutory requirement of 35 USC 154(b)(1)(A)(i)(II) was met as of the initial restriction requirement of July 18, 2013.

Overall PTA Calculation

Formula:

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

USPTO’s Calculation:

399 + 351 + 0 – 0 – 31 = 719

Conclusion

Patentee is entitled to PTA of seven hundred nineteen (719) days. Using the formula “A” delay + “B” delay + “C” delay – overlap – applicant delay = X, the amount of PTA is calculated as follows: 399 + 351 + 0 – 0 – 31 = 719 days.

Receipt of the \$200 PTA fee is acknowledged.

Telephone inquiries specific to this matter should be directed to Attorney Advisor Cliff Congo at (571) 272-3207.

/ROBERT CLARKE/
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