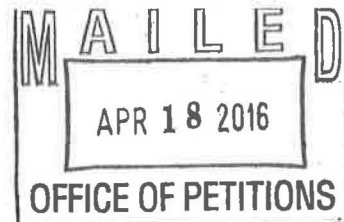




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In re Patent No. 9,102,614 : DECISION ON  
Babaoglu et al. :  
Issue Date: August 11, 2015 :  
Application No. 13/806,067 :  
Filing Date: April 26, 2013 :  
Attorney Docket No. 823-PFUS :  
Title: NAPHTH-2-YLACETIC ACID :  
DERIVATIVES TO TREAT AIDS :

This is a response to patentee's "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR UNDER 37 CFR 1.705" filed October 9, 2015, requesting that the Office correct the patent term adjustment (PTA) from 216 days to 226 days.

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).

**RELEVANT PROCEDURAL HISTORY**

On August 11, 2015, the Office determined that patentee was entitled to 216 days of PTA.

On October 9, 2015, patentee timely filed the instant request for redetermination of PTA under 37 CFR 1.705(b), seeking an adjustment of the determination to 226 days.

**DECISION**

Upon review, the Office finds that patentee remains entitled to two hundred sixteen (216) 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), the amount of "C" delay under 35 U.S.C. 154(b)(1)(C), the amount of overlap under 35 U.S.C. 154(b)(2)(A), and the amount of PTA reduction due to applicant delay under 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704.

Art Unit: OPET

Patentee and the Office are in disagreement regarding the amount of "A" delay under 35 U.S.C. 154(b)(1)(A). Patentee maintains that the "A" delay is 272 days. Patentee bases this calculation on the national stage commencing on December 20, 2012, and a restriction requirement being mailed on November 19, 2014. The Office calculates the 37 CFR 1.702(a)(1) delay as 262 days based on a national stage commencement date of January 2, 2013.

Patentee's calculation is based on an incorrect commencement date. Section 1(h)(1) of the AIA Technical Corrections Act revises the patent law to provide that the fourteen-month patent term adjustment period and the three-year patent term adjustment period are measured from the same date: the date on which an application was filed under 35 U.S.C. 111(a) in an application under 35 U.S.C. 111; or the date of commencement of the national stage under 35 U.S.C. 371 in an international application. However, this change does not affect the Office's interpretation of the "actual filing date" of an international application. Since the patent term adjustment provisions of 35 U.S.C. 154(b) were implemented in September 2000, the Office has interpreted the phrase "actual filing date of application in the United States" in 35 U.S.C. 154(b)(1)(B) as the date of commencement of the national stage under 35 U.S.C. 371 in an international application. See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 FR 56365, 56382-84 (Sept. 18, 2000) (explaining why the phrase "actual filing date of the application in the United States" in 35 U.S.C. 154(b)(1)(B) must mean the date the national stage commenced under 35 U.S.C. 371(b) or (f) in the case of an international application).

Papers were received in this application on December 20, 2012; however, the commencement date of this application is January 2, 2013. 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. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months

Art Unit: OPET

from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c).

In this case, no express request for early processing was made<sup>1</sup>. The priority date of the international application is July 2, 2010. Accordingly, the 30-month period expired January 2, 2013.

The Patent Term Adjustment calculation of "A" delay is properly calculated using the January 2, 2013 commencement date.

Specifically, the "A" delay pursuant to 37 CFR 1.702(a)(1)<sup>2</sup> was properly calculated as 262 days counting the number of days beginning on the day after the 14 month date, March 3, 2014, and ending on the date of mailing of the first Office action, November 19, 2014.

#### OVERALL PTA CALCULATION

##### Formula:

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

##### USPTO's Calculation:

262 + 0 + 0 - 0 - 46 = 216 days

##### Patentee's Calculation:

272 + 0 + 0 - 0 - 46 = 226 days

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<sup>1</sup> It is noted that even if an express request for early processing had been made, the requirements of 371 were not met prior to the 30 month date. The declaration for patent application was not filed in this application until April 26, 2013.

<sup>2</sup> (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;

Art Unit: OPET

**CONCLUSION**

The patent term adjustment (PTA) remains two hundred sixteen (216) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as follows:  $262 + 0 + 0 - 0 - 46 = 216$  days.

As the patent issued with 216 days of PTA, no further action will be undertaken by the Office with respect to the patent term adjustment.

Telephone inquiries specific to this matter should be directed to Attorney Advisor, Nancy Johnson at (571) 272-3219.

/ROBERT CLARKE/  
Patent Attorney  
Office of the Deputy Commissioner  
For Patent Examination Policy