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In re Patent No. 9,167,659 :  
Coe-Sullivan et al. :  
Issue Date: 10/20/2015 : ON REDETERMINATION OF  
Application No. 12/940,355 : PATENT TERM ADJUSTMENT  
Filing or 371(c) Date: 11/05/2010 :  
Atty. Docket No.: QDV129US :

This is a response to applicants "APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION", filed February 22, 2016, requesting that the Office adjust the PTA from 190 days to zero (0) days. The Office has re-determined the PTA to be 190 days.

This petition is hereby **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).

**Relevant Procedural History**

On October 20, 2015, the above-identified application matured into U.S. Patent No. 9,167,659. The patent issued with a PTA of 190 days. The present request for redetermination of the patent term adjustment was timely filed.

**Decision**

Patents' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **190 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) and the amount of overlapping days under 35 U.S.C. § 154(b)(2)(A) pursuant to the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014); and the amount of "A" delay under 35 U.S.C. § 154(b)(1)(A) and 37 CFR 1.702(a), however, patentee and the Office continue to disagree as to the amount of "applicant delay" under 35 U.S.C. § 154(b)(2)(C) and 1.704(c).

As to applicant delay, patentee avers that the Office erred in failing to calculate a reduction in connection with the filing of an Information Disclosure Statement ("IDS"), filed with a Request for Continued Examination ("RCE") on January 2, 2015, in reply to a Notice of Allowance mailed October 1, 2014. Patentee notes that the submission of the IDS on January 2, 2015 was made 194 days beyond the period specified in 37 CFR 1.704(d)(1)(i) or (ii).

Patentee also notes that an IDS filed on February 14, 2014 also cites to Office actions received more than 30 days before the February 4, 2014 IDS was filed.

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Patentees' argument has been carefully considered. Regarding the reduction, pursuant to 37 CFR 1.704(c)(10), Patentees' attention is directed to 37 CFR 1.704(c)(10), which states that the submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, shall reduce the period of adjustment set forth in § 1.703 by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months;

MPEP 2732 provides, in relevant part:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper, other than a request for continued examination in compliance with 37 CFR 1.114, after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. (Emphasis added).

Petitioner's attention is further directed to 37 CFR 1.704(d), which provides that a paper containing only an information disclosure statement in compliance with 37 CFR 1.97 and 1.98 will not be considered (result in a reduction) under 37 CFR 1.704(c)(6), 1.704(c)(8), 1.704(c)(9), or 1.704(c)(10) if it is accompanied by a statement...."

Petitioner is advised that the failure of an IDS to comply with 1.704(d)(1) does not in itself require entry of a period of reduction: 37 CFR 1.704(d)(1) provides a safe harbor which permits an applicant to avoid a reduction under 37 CFR 1.704(c). The paper (i.e., the RCE and IDS) filed on January 2, 2015 is not a type of paper which requires a reduction pursuant to 37 CFR 1.704(c)(6), (c)(8), (c)(9), or (c)(10). Therefore, no additional reduction for applicant delay is warranted in connection with the filing of this paper.

As noted above, an exception to the reduction pursuant to 37 CFR 1.704(c)(10) is provided where the submission is a request for continued examination in compliance with 37 CFR 1.114 (including a submission such as an IDS after a notice of allowance), after a notice of allowance has been given or mailed. Petitioner filed a request for continued examination in compliance with 37 CFR 1.114 (including a submission, i.e. an IDS), after a notice of allowance had been mailed, and neither a reduction under 37 CFR 1.704(c), nor the safe harbor provisions of 37 CFR 1.704(d) apply. Moreover, the RCE of January 2, 2015 was not subject to a reduction under 1.704(c)(12) as amended because the RCE was filed before March 10, 2015<sup>1</sup>.

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<sup>1</sup> Petitioner's attention is directed to 37 CFR 1.704(c)(12), effective applications in which a request for continued examination was filed on or after March 10, 2015. 37 CFR 1.704(c)(12) was amended to provide a new provision that establishes the submission of a request for continued examination under 35 U.S.C. 132(b) after any notice of allowance under 35 U.S.C. 151 has been mailed as constituting a failure of an applicant to engage in reasonable

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### **Overall PTA Calculation**

#### **Formula:**

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

#### **USPTO’s Calculation:**

168 + 368 + 0 – 0 – 346 = 190

#### **Patentee’s Calculation**

168 + 368 + 0 – 0 – 540 = 0<sup>2</sup>

### **Conclusion**

The present APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION has been considered; however, the APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION, is DENIED.

Telephone inquiries specific to this decision should be directed to Attorney Advisor Derek Woods at (571) 272-3232.

/ROBERT CLARKE/  
Robert A. Clarke  
Patent Attorney  
Office of the Deputy Commissioner  
for Patent Examination Policy

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efforts to conclude processing or examination of an application. See the final rule Changes to Patent Term Adjustment in view of the Federal Circuit Decision in *Novartis v. Lee*, 80 FR 1346 (January 9, 2015). (Emphasis added).

<sup>2</sup> Patentee’s calculation did not include a reduction in connection with the IDS filed February 4, 2015 because the calculation including the reduction in connection with the RCR filed January 2, 2015 resulted in zero (0) days of PTA, and the reduction would have remained zero (0) if the reduction in connection with the IDS filed February 4, 2015 had been included.