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In re Patent No. 9,185,975 :
Franklin :
Issue Date: 11/17/2015 : ON REDETERMINATION OF
Application No. 13/371,727 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 02/13/2012 :
Atty. Docket No.: 123568-001UT1 :

This is a response to applicants "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)", filed January 19, 2016, requesting that the Office adjust the patent term adjustment ("PTA"), from 723 days to 792 days. The Office has re-determined the PTA to be 723 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 November 17, 2015, the above-identified application matured into U.S. Patent No. 9,185,975. The patent issued with a PTA of 723 days. Patentee requests redetermination of the Patent Term Adjustment to 792 days.

Discussion

Patentees' arguments have been carefully considered. Upon review, the USPTO finds that patentee is entitled to **723** days of PTA.

Patentees argue that the Office should be accorded 544 days of PTO delay pursuant to 37 CFR 1.703(a)(1). Patentees assert that because the Office vacated the August 1, 2014 Restriction Requirement with a new Restriction Requirement mailed October 9, 2014, the clock should not have stopped under 37 CFR 1.703(a)(1) on August 1, 2014, but instead should have stopped on October 9, 2014. 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 August 1, 2014, the examiner required restriction between product or apparatus claims and process claims into distinct invention groups as discussed in MPEP 806.05(j) and also required applicant to elect a species for examination. 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)).

After a discussion between the Patentee and the Examiner on September 17, 2014, the Examiner agreed to issue another restriction requirement. The decision to issue a second restriction requirement was based upon the interview between the Patentee and the Examiner. In *Pfizer*, the court, referring to *University of Massachusetts v. Kappos*, 903 F. Supp. 2d (D.D.C. Nov. 9, 2012), noted that the prosecution process involves a "back and forth" process wherein applicants advocate for the broadest and strongest claims, and examiners provide reasons for rejecting unsupported or unpatentable claims. *Id.*, at 86. The UMass court stated that [w]hile the process of patent prosecution often involves changes in both the applicant's and examiner's positions, an examiner's reissuance of an office action in response to an applicant's suggestion does not automatically mean that an application has been "delayed" for purposes of patent term adjustment. *Id. Pfizer*, 811 F.3d at 475

As stated in *Pfizer*,

> [h]ere, similar to UMass, * * * the applicants' and examiner's exchanges concerning the challenged restriction requirement were part of the typical "back and forth" process of patent prosecution. 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." *UMass*, 903 F. Supp. 2d at 86 (citing H.R.Rep. No. 106464, at 125 (1999) (Conf.Rep.)) (emphasis added). As explained above, because the initial restriction requirement placed the applicants on notice of "the broad statutory basis for [the rejection of their] claims," *Chester v. Miller*, 906 F.2d at 1578, the restriction requirement satisfied the notice requirement of Section 132. *Pfizer*, 811 F.3d at 475-76.

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 August 1, 2014.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

475 + 277 + 0 – 0 – 29 = 723

Patentee's Calculation

544 + 277 + 0 – 0 – 29 = 792

Conclusion

The present APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) has been considered; however, the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d), is DENIED.

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

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