



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 8,926,638 :
Marshall et al. : DECISION ON REQUEST
Issue Date: 01/06/2015 : FOR RECONSIDERATION OF
Application No. 12/938,398 : PATENT TERM ADJUSTMENT
Filed: 11/03/2010 :
Attorney Docket No: :
H-US-01411 DIV (1700-8 DIV) :

This is a decision on the “RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT,” filed on November 10, 2015, which is considered as a request for reconsideration under § 1.705(b) in which patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from three hundred eighteen (318) days to six hundred forty-two (642) days.

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DENIED** with respect to making any change in the patent adjustment determination under 35 U.S.C. 154(b) of 642 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).

BACKGROUND

On January 6, 2015, the above-identified application matured into U.S. Patent No. 8,926,638, with a patent term adjustment of 47 days.

On February 20, 2015, an application for patent term adjustment was filed. On September 15, 2015, the Office re-determined the PTA to be 318 days.

On November 20, 2015, the subject request for reconsideration was filed. Patentee asserts that the reduction of 324 days, for the filing of an information disclosure statement (IDS) filed after a request for continued examination (RCE) was filed, is incorrect. Specifically, patentee states that the IDS filed on January 29, 2014, after the RCE was filed, was filed in compliance with § 1.97(b)(4). Petitioner notes the decision in *Arqule v. Kappos*, 793 F.Supp.2d 214, 225-26 (D.D.C. 2011), in which the court stated that the Office had “functionally negated” the grace period required by 35 U.S.C 21(b). Petitioner states that the situation at issue in *Arqule* is analogous to the situation of an IDS filed after an RCE.