Patent Office Professional Association
Box 25287, Alexandria, VA 22313

March 26, 2012

David J. Kappos
Under Secretary of Commerce for Intellectual Property
And Director,
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act, RIN 0651-AC69.

Dear Mr. Kappos,

This letter sets forth the formal Comments of the Patent Office Professional Association (POPA) in response to the Notice of Proposed Rulemaking, RIN 0651-AC69, regarding Supplemental Examination. Comments are due on or before March 26, 2012. Therefore, these Comments are timely filed.

POPA is the exclusive representative of the more than 7,000 patent examiners and other patent professionals at the U.S. Patent and Trademark Office (USPTO). Patent examiners examine patent applications within the constraints of a very rigorous performance appraisal system that measures examiners' production in six-minute increments. Because of these rigorous constraints, examiners have a vested interest in any changes that would result in additional work for examiners, such as the preissuance submission of prior art by third parties.

POPA has two concerns with the proposed Supplemental Examination rule package. First, the proposed rule package does not specify who at the USPTO will be given the responsibility to carry out the Supplemental Examination. Second, POPA considers the proposed rule package to be far too liberal regarding the amount of information (up to ten (10) items per request) a patent owner may submit for supplemental examination.

A review of the rules package suggests that Supplemental Examination should be performed by examiners in the Central Reexamination Unit (CRU) since a possible outcome of Supplemental Examination is an order for *ex parte* reexamination – the purview of the CRU. POPA believes this is the intent of the Agency, but it is not expressly set forth in the rule package. POPA suggests that this information be specifically set forth in the rule package so that both the Agency and its stakeholders are fully aware of who will be responsible for Supplemental Examination.

Regarding the amount of information allowed in a Request for Supplemental Examination, POPA proposes that the amount of information permitted in such a Request should be limited to no more than three (3) items per Request and corresponding fee. This proposal is consistent with our Comments regarding the amount of information provided for in the proposed rule package concerning Pre-Issuance Submissions By Third Parties (Notice of Proposed Rule Making, RIN 0651-AC67).

POPA is very concerned that, without adequate constraints on this provision, the Supplemental Examination process could quickly become a *de facto* substitute for proper and compact prosecution during regular examination. Supplemental Examination should be a rarely used process by a patent owner to correct an unintentional oversight or to address an issue that was unknown or unforeseen during prosecution. It should not be allowed to be used as a regular means of post-grant prosecution of the patent application.

In addition, Supplemental Examination has a very tight statutory three (3) month window for completion of the Supplemental Examination. Because there are no statutory limits on the number of Requests for Supplemental Examination that may be filed by a patent owner, inadequate limitations on the amount of information permitted in a single Request for Supplemental Examination would likely result in a serious burden on the examiner and the Agency and prevent the examiner from completing a proper supplemental examination of the patent within the statutory time period. Second and subsequent Requests by the patent owner should be equally limited in scope, but require an escalating fee per subsequent submission.

The above proposed limitations would fulfill the purpose of the statute by permitting the patent owner to correct the patent file record where necessary, while not overburdening the examiner or the Agency, or unintentionally discouraging proper and compact pre-grant prosecution.

If you have further questions or wish to discuss our position further, please contact me and I will be happy to talk with you.

Sincerely,

/Robert D. Budens/

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