

Reitter, Breck

From: Sundby, Suzannah <ssundby@sgrlaw.com>
Sent: Tuesday, April 10, 2012 10:13 PM
To: Derivation
Subject: Derivation Proceedings (Response to Proposed Rules)

ATTN: Lead Judge Michael Tierney
Derivation Proposed Rules

Dear Judge Tierney:

With regard to the Derivation proposed rules, I have the following comments and questions.

What are examples of sufficient corroboration?

What are examples of sufficient rebuttal evidence in accordance with proposed Section 42.405?

Proposed Sec. 42.407 indicates that where a party files an incomplete petition, no filing date will be accorded and the Office will dismiss the request if the deficiency in the petition is not corrected within the earlier of either one month from the notice of an incomplete petition, or the expiration of the statutory deadline in which to file a petition for derivation. Will the USPTO mail a Notice indicating the completion of the statutory requirements of the petition? What is the longest amount of time from filing the petition that the USPTO expects to mail a Notice which indicates whether or not the petition is complete? Assuming that the expected time is not immediate, I recommend that where the petition is incomplete, the petitioner has two months from the mail date of the Notice, even if the two month period goes beyond the one year after the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the allegedly derived invention, to complete the petition as it is possible that a petitioner files the petition, but is unaware that the petition is incomplete.

Thank you for this opportunity to comment on the proposed Derivation rules.

Best regards,
Suzannah K. Sundby, Esq.
Reg. No. 43,172

The views expressed herein are mine and are not to be attributed to any other person or entity including Smith, Gambrell & Russell, LLP or any client of the firm.

SUZANNAH K. SUNDBY | Partner

202-263-4332 phone
202-263-4352 fax
www.sgrlaw.com
ssundby@sgrlaw.com

1130 Connecticut Avenue, N.W.
Suite 1130
Washington, D.C. 20036

IRS Circular 230 Disclosure:

To ensure compliance with requirements imposed by the IRS, we inform you that any U.S. federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein.

Confidentiality Notice

This message is being sent by or on behalf of a lawyer. It is intended exclusively for the individual or entity to which it is addressed. This communication may contain information that is proprietary, privileged or confidential or otherwise legally exempt from disclosure. If you are not the named addressee, you are not authorized to read, print, retain, copy or disseminate this message or any part of it. If you have received this message in error, please notify the sender immediately by e-mail and delete all copies of the message.