



March 23, 2012

**Comments on Proposed Changes to Implement the  
Supplemental Examination Provisions of the Leahy-Smith America Invents Act  
and to Revise Rereamination Fees, 77 Fed. Reg. 3666 (January 25, 2012)**

Attn: Cynthia L. Nessler, Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Dear Commissioner for Patents:

In response to the Request for comments published January 25, 2012, at Federal Registrar, Vol. 77, No. 16, p.3666-3681, GlaxoSmithKline ("GSK") submits the following comments.

**Executive Summary:**

As one of the world's leading research-based pharmaceutical and healthcare companies, GSK has taken a keen appreciation for the importance of a strong and effective patent system that efficiently produces patents of the highest quality. GSK is encouraged that the Patent Office has requested comments on ways to improve the quality and consistency of the new Supplemental Examination. While it appears that Supplemental Examination will provide opportunities to improve the quality of granted patents, GSK proposes that there may be a potential prejudice to the patent holder in proposed rule §1.610(d) and (e), due to the non-confidential treatment of an incomplete supplemental examination request that does not receive a filing date.



## **Comments on Proposed Changes to Implement the Supplemental Examination Provisions of the Leahy-Smith America Invents Act and to Revise Reexamination Fees**

**PTO proposal:** According to §1.610(d): The filing date for the request for supplemental examination will not be granted if the request is not in compliance with §1.605, §1.610, and §1.615. §1.610(e) further proposes that the patent owner will be so notified and given an opportunity to complete the request within a specified time. Only after the request complies with the notice, “the filing date of the supplemental examination request will be the receipt date of the corrected request.”

**The Issue:** If it is assumed that the information filed with the incomplete supplemental examination request is publically available on PAIR’s Image File Wrapper, there is a potential harm that a third party could exploit this information to file a civil action before the patent holder completed the supplemental examination request and is granted a filing date.

GSK believes this practice could risk a patent holder’s ability to invoke the protections of 35 USC §257(c)(1) if an allegation of unenforceability is made after an initial, incomplete supplemental examination request is filed but before the filing of a completed supplemental examination request meriting a filing date.

**Possible Solutions:** GSK recommends that a filing date be granted for an incomplete supplemental examination request along with notification and an opportunity to complete the request within a specified time. The granting of the filing date will provide protections of 35 USC §257(c)(1) without invoking the exception under 35 USC §257(c)(2)(A) Prior Allegations. Alternatively, the PTO could provide a means to file supplemental examination requests under seal until the filing date is granted.

Sincerely,

Jason Fedon  
Senior Counsel (Patents)  
GlaxoSmithKline