

**From:** John Mitchell [mailto:john.mitchell@uspto.gov]  
**Sent:** Monday, February 13, 2012 12:31 PM  
**To:** supplemental\_examination  
**Subject:** comments to proposal to change ex parte reexamination request fees

These comments are made by a lawyer with over twenty five years of broad experience in the patent field, ranging from patent prosecution to patent portfolio management to licensing to litigation, for individual inventors, start-up companies, small companies, and large companies. I have directed the filing of a significant number of reexamination requests, a fair number of which have had profound effects in the market.

Ex parte reexamination has been a cost effective tool to ensure that issued patents meet the intended standard of patentability. The rules and process are fairly simple which also makes it an accessible and practical tool for a wide range of requesters. Raising the fee for ex parte reexamination requests will likely preclude many from using the process, including those who least can afford the other possible processes such as litigation. Further, altering the ex parte reexamination rules or process could result in the diminished effectiveness of the tool.

As I see it, if the threshold of a substantial new question of patentability has been met, then the Patent Office should undertake to reexamine the patent and it should not cost the requester anything because the requester has performed a public service and the requester has assisted the Patent Office with quality control. A modest fee, as is presently the case, is an acceptable cost for a requester to bear -- it is high enough to preclude spurious requests but low enough to allow even individual inventors access.

Patents are an exception to the general rule against monopolies and should, to be granted and sustained, be subject to high standards. Ex parte reexamination, as it is presently arranged, is an excellent check to ensure that the high standard is met. I urge the Patent Office to keep the ex parte reexamination request fees modest and further urge the Patent Office to proceed with caution and reserve in considering and implementing any ex parte reexamination rule or process changes.

Respectfully submitted,

John Mitchell  
John.Mitchell@uspto.gov  
202-278-0882