From:

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Sent:

Monday, March 26, 2012 8:56 PM

To:

supplemental examination

Subject:

Supplemental Examination (Response to Proposed Rules)

ATTN: Cynthia L. Nessler

Senior Legal Advisor

Office of Patent Legal Administration

Office of the Associate Commissioner for Patent Examination Policy

Dear Ms. Nessler,

With regard to the proposed Supplemental Examination rules, I have the following questions:

- 1. Is there a page limit on the Supplemental Examination Request itself?
- 2. Will the same or a different examiner decide whether there is a substantial new question of patentability?
- 3. What post grant proceeding proceeds if multiple ones filed, e.g. Supplemental Examination Request filed first, then a third party files a Request for Ex parte Reexam or a Petition for Post-Grant Review?
- 4. What if Supplemental Examination is necessary because the USPTO conducted a poor initial examination?
- 5. With regard to proposed Section 1.620(d) how would one know if their Notice of a post grant proceeding is improper and has to be resubmitted?

In addition, my understanding is that the AIA does not limit Supplemental Examination to a specifically indicated issue and/or aspect. However, according to the proposed rules, it seems that a Supplemental Examination certification is limited in scope to the aspects, issues, and combinations of items of information as specified in the Supplemental Examination Request. Thus, what if one wants consideration, reconsideration or correction based on a given document alone and in combination with all existing prior art for purposes of 35 U.S.C. 103? In other words, the proposed rules seem to make it such that in order for a Supplemental Examination certificate to be worthwhile, one would have to provide everything one can find that could be combined with a given document, every piece of known prior art to be considered in combination with the given document. Such would not only be cost prohibitive, but would also be logistically impossible.

With regard to the prohibition against proposed claim language and/or amendments, sometimes proposed claim language and/or amendments assist one in the understanding of an issue and/or relevance of a prior art document. Thus, will such a discussion of alternative claim language in the Request be considered a prohibited proposed amendment?

In my opinion, the fees are ridiculously prohibitive. Such ridiculously high fees result in the possibility of creating two different types and/or standards of patents, i.e. if one has money, one can get a good patent, if one does not have money, then one may have a lesser patent as compared to his wealthy counterpart. Further, a poor patentee could more likely be subjected to post grant proceedings by others. Thus, I recommend a discount in fees when it is clear that the Supplemental Examination Request is needed due to a USPTO mistake such as overlooking or not fully appreciating the disclosure of a document that was presented to the Examiner during prosecution. I

also recommend small and micro entity fees. I also recommend that if more than one Supplemental Examination Request is filed, only one reexamination fee be required. In addition, since an Ex parte Reexamination might not be ordered, requestors should receive interest on their prepaid reexamination fee. Alternatively, I recommend that instead of prepaying the reexamination fee, a requestor must pay the reexamination fee within a given time, e.g. 1 month, or else the patent is revoked/abandoned. This way, a patentee may simply choose to abandon the patent, thereby decreasing the administrative burden on the USPTO, and decrease the number of unworthy patents.

When an Ex parte Reexamination is ordered as a result of the Supplemental Examination Request, I recommend that the order for the reexamination be published in the Official Gazette so as to put third parties on notice that they are prohibited from making a submission or otherwise participating in the reexamination.

Thank you for this opportunity to comment on the proposed Supplemental Examination 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.

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