

From: Hillis, Sanders [mailto:shillis@brinkshofer.com]
Sent: Monday, January 23, 2012 12:51 PM
To: AC63.comments
Cc: Fletcher, Heather
Subject: comments [Docket No. PTO-P-2011-0058] RIN 0651-AC63

Dear Commissioner for Patents,

- 1) As part of the notice of appeal process, a request for pre-appeal review may be filed by an Applicant. An answer to the request from the USPTO is supposed to be received by the Applicant within 45 days (see <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>) The USPTO should incur delay when the answer to the request is received beyond the 45 day limit.
- 2) When an appeal brief is filed, it is sometimes months before a notice of non-compliant appeal brief is mailed to the Applicant by the USPTO. The USPTO should incur delay after two months if either an examiner's answer, or a notice of non-compliant appeal brief is not mailed.
- 3) Will a response to a non-compliant appeal brief be considered a supplemental response?
- 4) After the Examiner's answer, there is a 2 month period of time where the Examiner awaits Applicant's reply brief (if one is filed). Following this two month period, there is sometimes an extended period of time before the Applicant receives indication that the appeal has been forwarded to the board, or a supplemental answer is mailed. What is the period of time after the Examiner's answer is mailed before delay by the PTO is incurred when a) a reply brief is not filed by the Applicant? b) a reply brief is filed by the Applicant?
- 5) The point of transfer of jurisdiction occurs when the file is transferred to the appeal board. (see mpep 1210) Will Applicant be made aware of the transfer of jurisdiction?
- 6) How will amendments or affidavits filed before an appeal brief be treated by the office for purposes of calculating PTA? (see mpep 1206)
- 7) In the event the Examiner re-opens prosecution and provides a non-final office action without ever forwarding the appeal to the appeal board, will the USPTO incur all of the delay from the time the notice of appeal is filed since the entire delay caused by the appeal process was incurred due to the Examiner's rejections being without merit?
- 8) At what point is jurisdiction remanded from the Board to the Examiner when: a) the Examiner is reversed? b) the Examiner is affirmed? c) the Examiner is partially affirmed and partially reversed?
- 9) After the board reverses and remands to the Examiner, Applicant can file an information disclosure statement or other paper. How will these filings be treated for purposes of PTA?

Thank you!

Sanders
(reg. no. 45,712)

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