



PATENT PROTECTION FOR HIGH TECHNOLOGY

TO: The Honorable David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office
FROM: Schwegman, Lundberg and Woessner, P.A.
DATE: April 9, 2012
RE: Comments to Various Proposed Rules to Implement the America Invents Act

Via Electronic Mail
patent_trial_rules@uspto.gov

Dear Under Secretary Kappos:

Below are our comments on the proposed changes to implement Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions in Fed. Reg. 77(27): 3666–81 (Jan. 25, 2012).

We have the following comments on proposed rule 42.73(d)(3):

(i) is reasonable because the Office should limit recapture of substantially similar claim limitations.

(ii) is not consistent with 35 U.S.C. § 120 and the limitation to only a reasonable number of substitute claims.

(iii) seems unnecessary, unless it is tied to a substantive issue, *e.g.*, lack of § 112 support. The patent owner should not be estopped unless the proposed amendments address the merits of the case and were not denied for some procedural issue, such as laches.

If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the Schwegman's leadership will respond to any inquiry.

Very truly yours,

Schwegman, Lundberg and Woessner, P.A.

Lissi Mojica
Stephen C. Durant
Kevin Greenleaf

Tim Bianchi
Tom Reynolds

Michael Lynch
Gary Speier

Bradley Forrest
Robin Chadwick