

Reitter, Breck

From: Sundby, Suzannah <ssundby@sgrlaw.com>
Sent: Tuesday, April 10, 2012 10:47 PM
To: Inter_Parties_Review
Subject: Inter Partes Review (Response to Proposed Rules)

ATTN: Lead Judge Michael Tierney
Inter partes Review Proposed Rules

Dear Judge Tierney:

With regard to the Inter partes Review (IPR) proposed rules, I have the following comments and questions.

How does the USPTO interpret "reasonably could have raised" in the estoppel provision? Hypothetical examples are respectfully requested.

What will be the length and scope of discovery for IPR? What will be the limitations on discovery, e.g. time period, document length, number of available motions, etc.? Who will oversee the discovery process?

How will hearings be conducted and what will be their length?

With regard to the two month time periods for Secs. 42.107(b) and 42.120(b), it is respectfully submitted that two months is not sufficient. In particular, two months is not sufficient for foreign cases which require processing and docketing the USPTO correspondence, analyzing the USPTO correspondence, reporting to the foreign associate, obtaining any requisite translations of the correspondence, reporting the correspondence to the client (by the foreign associate); and internal processing by the client, forwarding such to the foreign associate, obtaining any English translations, docketing and forwarding instructions to the US counsel, and docketing the instructions and acting accordingly. Thus, I recommend that these time periods be extendible by at least 1 month.

Proposed Sec. 42.106(b) indicates that where a party files an incomplete petition, no filing date will be accorded and the Office will dismiss the request if the deficiency in the petition is not corrected within one month from the notice of an incomplete petition. As indicated above, one month is too short especially for foreign origin patents. Therefore, I recommend that these time periods be extendible by at least 3 months.

Proposed Sec. 42.107(d) provides that the preliminary patent owner response is not allowed to include any amendment. Sometimes providing claim limitations as examples of how a particular claim or disclosure should be interpreted is valuable for a proper interpretation of the claim(s) and/or disclosure. Thus, it is recommended that examples of claim language in papers other than a motion to amend the patent under proposed Sec. 42.121 be allowed and not considered to be an amendment.

Thank you for this opportunity to comment on the proposed Inter partes Review 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.

SUZANNAH K. SUNDBY | Partner

202-263-4332 phone
202-263-4352 fax
www.sgrlaw.com
ssundby@sgrlaw.com

1130 Connecticut Avenue, N.W.
Suite 1130
Washington, D.C. 20036



IRS Circular 230 Disclosure:

To ensure compliance with requirements imposed by the IRS, we inform you that any U.S. federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein.

Confidentiality Notice

This message is being sent by or on behalf of a lawyer. It is intended exclusively for the individual or entity to which it is addressed. This communication may contain information that is proprietary, privileged or confidential or otherwise legally exempt from disclosure. If you are not the named addressee, you are not authorized to read, print, retain, copy or disseminate this message or any part of it. If you have received this message in error, please notify the sender immediately by e-mail and delete all copies of the message.