

Cain, Brigit

From: Sundby, Suzannah <ssundby@sgrlaw.com>
Sent: Tuesday, April 10, 2012 9:58 PM
To: Post_Grant_Review
Subject: Post Grant Review (Response to Proposed Rules)
Attachments: image08e483.JPG

ATTN: Lead Judge Michael Tierney
Post-Grant Review Proposed Rules

Dear Judge Tierney:

With regard to the Post-Grant Review proposed rules, I have the following comments and questions.

The USPTO notes that the Board expects to consider patent owner preliminary responses under in all but exceptional cases. What are considered to be exceptional cases?

Proposed Sec. 42.206(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 the earlier of either one month from the notice of an incomplete petition, or the expiration of the statutory deadline in which to file a petition for post-grant review. Will the USPTO mail a Notice indicating the completion of the statutory requirements of the petition? What is the longest amount of time from filing the petition that the USPTO expects to mail a Notice which indicates whether or not the petition is complete? Assuming that the expected time is not immediate, I recommend that where the petition is incomplete, the petitioner has two months from the mail date of the Notice, even if the two month period goes beyond 9 months from the date of grant, to complete the petition as it is possible that a petitioner files the petition, but is unaware that the petition is incomplete.

With regard to the two month time periods for Secs. 42.207(b) and 42.220(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. 42.207(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. 43.221 be allowed and not considered to be an amendment.

Thank you for this opportunity to comment on the proposed Post Grant Review rules.

Best regards,
Suzannah K. Sundby, Esq.

Reg. No. 43,172

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