

**From:** Sundby, Suzannah [e-mail address redacted]  
**Sent:** Sunday, March 04, 2012 5:01 PM  
**To:** post\_patent\_provisions  
**Subject:** Citation of Prior Art in a Patent File (Response to Proposed Rules)

ATTN: Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Dear Mr. Schor:

1. With regard to proposed Sec. 1.501(b)(1), will the USPTO review and substantively determine whether a written explanation of pertinency is sufficient? If so, I respectfully request that the USPTO provides guidance and examples of sufficient and insufficient explanations and procedures for notifying the submitter of the deficient submission, as well as procedures for allowing the submitter to cure any defects.
2. With regard to the comment indicating that patent owners should regularly monitor the Image File Wrapper records for their patents in the event that a third party was unsuccessful in serving the patent owner under proposed Sec. 1.501(e), since many corporations and institutions have extremely large and diverse patent portfolios, such recommended monitoring of each patent in one's portfolio by accessing PAIR and reviewing the records would be unduly burdensome. Therefore, I recommend that the USPTO publishes such citations of prior art in the Official Gazette by patent number, serial number and assignee name. This would allow one to readily search for any such citations by patent number, serial number and/or assignee name.
3. With regard to proposed Sec. 1.501(c), please clarify whether the referenced sections, i.e. Sec. 1.502 and Sec. 1.509, refer to the old rules or the to be enacted new rules.
4. With regard to proposed Sec. 1.501(e), I recommend that service only be required where the submitter is a person other than the patent owner. In other words, the proposed rule should indicate that a "submission made under this section *by a person other than the patent owner* must reflect that a copy of the submission has been served upon the patent owner..." or something to that effect.

Thank you for this opportunity to comment on the proposed citation of prior art 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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