



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: March 26, 2010

RE: Comments on Proposed Rules to Implement Supplemental Examination

*Via Electronic Mail*

**Supplemental\_examination@uspto.gov**

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Dear Under Secretary Kappos:

Our comments on the proposed changes to implement supplement examination are as follows:

**I. CHANGES TO IMPLEMENT SUPPLEMENTAL EXAMINATION FED. REG. 77(18): 3666–81 (JAN. 25, 2012).**

1. We agree with proposed rule § 1.601 that only the patent owner, and not a licensee, may request a supplemental examination.
2. 37 CFR § 1.501 states, “At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications.” Proposed rule § 1.601(c) states, “Any party other than the patent owner (i.e., any third party) is prohibited from filing papers or otherwise participating in any manner in a supplemental examination proceeding” The rules should make clear whether prior art submitted by a third party during a supplemental examination will be held in abeyance or returned. Rule § 1.620(b) states that action on any petition or other paper filed in the supplemental examination until after the proceeding is concluded. The Office should consider revising this to state that any petition filed “during” supplemental reexamination to include other third-party papers.
3. The rules should clarify that supplemental examination is only available during a patent’s period of enforceability.
4. Rule § 1.605 defines an “item of information” as “a document submitted as part of the request.” The rules should clarify whether using the same document as a §§ 102 and 103 reference constitutes one or two items.
5. The fee of \$16,120 for *ex parte* reexamination is too high. The fee was calculated based on the size of an average *ex parte* request, which typically involves hundreds of pages more than what is currently being proposed under the rules. Further, post-grant proceedings are supposed to be an alternative to litigation. Increasing the cost by 500% will have a twofold effect: first, it will create more litigation as *ex parte* reexams are

being utilized as a means to thwart litigation for unreasonable licensing requests. Second the fees will force companies into licenses they would not normally take rather than bearing the time and cost of a reexam. Further, the reexam process is a correction process for the PTO; therefor the third party requester should not bear the complete cost of the correction process.

6. The rules should require the patent owner to make a statement about why an item is not material. This is similar to reissue where the patent owner must identify an error in the patent.
7. The rules should make clear that supplemental examination certificates will only apply to litigations filed after the filing date of the request for supplemental examination.
8. Supplemental examination should still be available after a litigation is filed, but should not apply to litigations filed before the supplemental examination is filed. *See* 35 USC § 257(2)(B).
9. Supplemental examination should be made public, just as patent owner requests for reexamination and reissues are public.
10. Rule 1.610(b)(11) requires a summary of the relevant portions of the submitted document. The Office should consider loosening the requirement to avoid creating additional opportunities for allegations of inequitable conduct. For example, the Office could simply require a summary of the item, and later identification of the relevant portion.
11. The Office should consider providing examples of situations in which the Office will forward evidence of fraud to the attorney general. This can provide clarity to patent owners afraid to file for supplemental examination when fraud might be implicated.

## II. CONCLUSION

In closing, Schwegman appreciates the opportunity to comment on the proposed rules. 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