

**From:** Sundby, Suzannah <Y!a UJ`UXXfYggfYXUMWX>  
**Sent:** Monday, March 26, 2012 8:56 PM  
**To:** supplemental\_examination  
**Subject:** Supplemental Examination (Response to Proposed Rules)

ATTN: Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Associate Commissioner for Patent Examination Policy

Dear Ms. Nessler,

With regard to the proposed Supplemental Examination rules, I have the following questions:

1. Is there a page limit on the Supplemental Examination Request itself?
2. Will the same or a different examiner decide whether there is a substantial new question of patentability?
3. What post grant proceeding proceeds if multiple ones filed, e.g. Supplemental Examination Request filed first, then a third party files a Request for Ex parte Reexam or a Petition for Post-Grant Review?
4. What if Supplemental Examination is necessary because the USPTO conducted a poor initial examination?
5. With regard to proposed Section 1.620(d) how would one know if their Notice of a post grant proceeding is improper and has to be resubmitted?

In addition, my understanding is that the AIA does not limit Supplemental Examination to a specifically indicated issue and/or aspect. However, according to the proposed rules, it seems that a Supplemental Examination certification is limited in scope to the aspects, issues, and combinations of items of information as specified in the Supplemental Examination Request. Thus, what if one wants consideration, reconsideration or correction based on a given document alone and in combination with all existing prior art for purposes of 35 U.S.C. 103? In other words, the proposed rules seem to make it such that in order for a Supplemental Examination certificate to be worthwhile, one would have to provide everything one can find that could be combined with a given document, every piece of known prior art to be considered in combination with the given document. Such would not only be cost prohibitive, but would also be logistically impossible.

With regard to the prohibition against proposed claim language and/or amendments, sometimes proposed claim language and/or amendments assist one in the understanding of an issue and/or relevance of a prior art document. Thus, will such a discussion of alternative claim language in the Request be considered a prohibited proposed amendment?

In my opinion, the fees are ridiculously prohibitive. Such ridiculously high fees result in the possibility of creating two different types and/or standards of patents, i.e. if one has money, one can get a good patent, if one does not have money, then one may have a lesser patent as compared to his wealthy counterpart. Further, a poor patentee could more likely be subjected to post grant proceedings by others. Thus, I recommend a discount in fees when it is clear that the Supplemental Examination Request is needed due to a USPTO mistake such as overlooking or not fully appreciating the disclosure of a document that was presented to the Examiner during prosecution. I

