

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

USPTO Docket No. 000308064-0064-01

RIN 0651-AB04

For: ***Inter Partes* Reexamination**

***Comments In Reply To the Notice of Proposed Rulemaking Regarding
Rules To Implement Optional Inter Partes Reexamination Proceedings***

Commissioner for Patents
Washington, DC 20231

Attn: Mr. Kenneth M. Schor
Senior Legal Advisor

Sir:

In reply to the Notice of Proposed Rulemaking published April 6, 2000, at 65 Fed. Reg. 18154 (2000), Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments. Consideration of these comments is respectfully requested.

The proposed reexamination amendments to 37 C.F.R. §§ 1.113 and 116 are based on a version of those rules that is no longer in effect. Rules 113 and 116 were amended by virtue of the May 29, 2000 interim rule published March 20, 2000 at 65 Fed. Reg. 14865 to refer, *inter alia*, to the new section 37 C.F.R. § 1.114 and requests for continued examination. Compare, for example, the language of the proposed reexamination section 37 C.F.R. § 1.116(a) with the language of 37 C.F.R. § 1.116(a) as published in the interim rule, which simply states: “An amendment after final action or appeal must comply with § 1.114 or this section.”

It is not the intent of the reexamination rules to obviate the changes made by the May 29, 2000 interim rule. Therefore, changes made to rules 113 and 116 by the reexamination rules should be based on, and retain, at least the rule 114 language of rules 113 and 116 as amended by the interim rule of May 29, 2000.

Respectfully submitted,

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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