

07/12/00

Honorable Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Dear Commissioner:

This communication is in response to the U.S. Patent and Trademark Office's request for comments relating to proposed changes in the rules of practice in patent cases to implement certain provisions of the "American Inventor's Protection Act of 1999," specifically, the Optional *Inter Partes* Reexamination Proceedings. We, the undersigned patent attorneys and agent, request consideration of the following comment:

37 C.F.R. § 1.973

Proposed Rule 1.973(b) requires that a written request for an oral hearing in an *inter partes* reexamination appeal be filed, along with the fee, "within two months after the date of the examiner's answer." Proposed Rule 1.969(a) further provides that the primary examiner may furnish a written statement in answer to the patent owner's and/or third-party requestor's appellant brief or respondent brief. In the event that the primary examiner determines not to furnish an answer, the triggering event for the two-month deadline within which to request oral argument cannot occur. Thus, under a strict reading of proposed Rule 1.973(b), a request for oral argument could not then be filed.

Accordingly, the undersigned patent attorneys and agent respectfully suggest that the language be amended to provide that the request for oral argument be due "within two months after the date of the examiner's answer or the period within which the examiner's answer must be furnished."

The undersigned are also mindful of the provisions of 37 C.F.R. § 1.194(b), where currently the deadline for filing a request for an oral argument in an appeal is also triggered by the date of the examiner's answer to the appellant's brief, which under 37 C.F.R. § 1.193(a) "may" be furnished. The Manual of Patent Examiners Procedures, Section 1208, currently requires that an examiner's answer should be furnished within two months after the receipt of

Honorable Commissioner for Patents
July 12, 2000
Page 2

the appellant's brief. The undersigned patent attorneys and agent respectfully submit that the clarifying language addressed herein should also be applied to 37 C.F.R. § 1.194(b).

Respectfully submitted,

By: PRICE, HENEVELD, COOPER,
DEWITT & LITTON

July 12, 2000
Date

Brian E. Ainsworth, Registration No. 45,808
Carl S. Clark, Registration No. 28,288
William W. DeWitt, Registration No. 22,300
Gunther J. Evanina, Registration No. 35,502
Troy A. Groetken, Registration No. 46,442
Michael R. Long, Registration No. 42,808
James A. Mitchell, Registration No. 25,120
Eugene J. Rath III, Registration No. 42,094
Harold W. Reick, Registration No. 25,438
Steven L. Underwood, Registration No. 35,727
Todd A. Van Thomme, Registration No. 44,285

695 Kenmoor SE
P.O. Box 2567
Grand Rapids, Michigan 49501-2567
616/949-9610

SLU/saw