

Untitled

From: John Pegram [e-mail address redacted]
Sent: Thursday, February 02, 2012 2:38 PM
To: supplemental_examination
Subject: Supplemental Examination (Response to Proposed Rules)

The following are my personal views following my initial review of the proposed supplemental examination rules:

1. I suggest that sect. 1.620 and 1.625 be reorganized, referring—for example—to stage 1 and stage 2 of supplemental examination. The supplemental examination proceedings contemplated by the statute do not conclude with the initial determination certificate, as may be suggested to non-experts by proposed rule 1.620. (See 2 below).

2. Two types of certificates will be involved in a full supplemental examination: one finding that there is a substantial new issue of patentability warranting reexamination and the other at the conclusion of reexamination proceedings. The first should not be called a supplemental examination certificate. I suggest that the final certificate, following reexamination, be called a Supplemental Examination Certificate, so that it will be immediately apparent that it is entitled to the effects specified in 35 USC 257(c).

3. I suggest that the use of the term “ex parte reexamination” in the proposed rules to refer to reexamination under new 35 USC 257, which is the second stage of supplemental examination, is confusingly similar to normal “ex parte reexamination” under 35 USC 302 et seq. Use of the term “ex parte reexamination” in connection with supplemental examination will be a problem because (a) a different statute is involved, (b) the rules necessarily will specify some different procedures and (c) the resulting certificate has a different effect. I suggest that proposed sec. 1.625(d) is sufficient to specify the ex parte nature of the supplemental -type reexamination. If necessary, words could be added to say that supplemental examination is conducted on an ex parte basis.

Keep up the good work !

John B. Pegram - Senior Principal
Fish & Richardson P.C. | 52nd Floor, 601 Lexington Avenue, New York, NY 10022-4611 |
[phone redacted]
[e-mail address redacted]