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Sent: Monday, November 07, 2011 5:22 PM  
To: ai\_a\_implementation  
Subject: Supplemental examination

MIPLA Suggestions for Group 2 Rulemakings:  
Subgroup 3 – Supplemental Examination

The Minnesota Intellectual Property Law Association (MIPLA) is grateful for the opportunity to provide input with respect to the Request by Janet Gongola for Public Comments Urged for Group 2 Proposed Rule Makings, dated October 28, 2011 on the USPTO America Invents Act (AIA) website. The suggestions contained in this email are submitted with respect to Group 2 Rulemakings – Subgroup 3 – Supplemental Examination.

MIPLA is an independent organization of nearly 500 members in and around the Minnesota area representing all aspects of private and corporate intellectual property practice, as well as the academic community. MIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent law before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of the Board of MIPLA after consultation and input from the IP Law, Patent Practice and Patent Litigation Committees, and do not necessarily reflect the view of opinions of any individual members or firms of the committees or MIPLA, or any of their clients. MIPLA understands that the USPTO will not directly respond to these suggestions, and MIPLA reserves the right to formulate specific comments pursuant to formal rule promulgation with respect to the Group 2 Rulemakings.

With respect to Subgroup 3 – Supplemental Examination, MIPLA has the following suggestions:

3.1 Base fee plus per reference fee and only IDS submission  
We suggest that the Office adopt a base fee for Supplemental Examination that would be similar to ex parte reexamination fees to review up to given number of references (e.g., 20 references), plus a per reference charge for any references above that given number, along with no requirement for the patent owner to do anything more than merely identify the references on a PT0-1449 Information Disclosure Statement (IDS) form.

3.2 Optional Patent Owner statement permitted  
We suggest that, if a decision is made by the Office to initiate an ex parte reexamination in response to a Supplemental Examination, the patent owner should continue to have an opportunity to submit a patent owner statement as is now provided in an ex parte reexamination.

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Patent Practice Chair

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