



PATENT PROTECTION FOR HIGH TECHNOLOGY

TO: The Honorable David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

FROM: Schwegman, Lundberg and Woessner, P.A.

DATE: April 10, 2012

RE: Comments to Various Proposed Rules to Implement the America Invents Act

*Via Electronic Mail*  
**derivation@uspto.gov**

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Dear Under Secretary Kappos:

Below are our comments on the proposed changes to implement derivation proceedings in Fed. Reg. 77(28): 7028–41 (February 10, 2012).

Generally, discovery afforded by derivation proceeding should be expanded, relative to post-grant proceedings, because the alleged deriver is likely to have information unavailable to the petitioner. For example, the deriver may have received information from a third party confidant of the petitioner. Thus, without expanded discovery, the petitioner would have no way of knowing that the confidant divulged confidential information.

Very truly yours,

Schwegman, Lundberg and Woessner, P.A.

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