From: Brad Pedersen [e-mail address redacted]
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To: aia_implementation
Subject: Supplemental examination

Patterson Thuente Suggestions for Group 2 Rulemakings:
Subgroup 3 – Supplemental Examination

The law firm of Patterson Thuente Christensen Pedersen ("Patterson Thuente") appreciates 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.

Patterson Thuente is a firm with significant experience in the areas of ex parte reexamination, inter partes reexamination and interference practice. The firm is also nationally recognized for its expertise with respect to the AIA. Patterson Thuente represents a wide and diverse spectrum of individuals, companies, and institutions before the United States Patent and Trademark Office.

The comments submitted herewith reflect the general views of Patterson Thuente and do not necessarily reflect the view of opinions of any individual members of the firm, or any of their clients. Patterson Thuente understands that the USPTO will not directly respond to these suggestions, and Patterson Thuente 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, Patterson Thuente has the following suggestions:

3.1 Base fee of 2X EPX plus per reference fee and only IDS submission
We suggest that the Office adopt a base fee for Supplemental Examination that would be about twice that of ex parte reexamination (EPX) 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 PTO-1449 Information Disclosure Statement (IDS) form. If the EPX is not initiated, then one-half of the fee would be refunded.

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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