

From: Sundby, Suzannah
Sent: Thursday, January 29, 2009 7:00 AM
To: Bahr, Robert; AC6/Comments
Subject: Deferred Examination - Request to Participate and Comments

Dear Robert,

I would like to participate in the Roundtable discussion on Deferred Examination on 12 February 2009.

I also have a few preliminary comments:

1. In order to make such an expanded deferred examination program viable, there should not be a risk of prosecution laches by participating.
2. However, in order to be fair to third party/would be infringers, any and all provisional rights in a published application must automatically be forfeited when examination is deferred.
3. Also there should be a regularly updated searchable online database that lists all published applications which examination has been deferred.
4. The current rule is useless for my biotech clients as examination usually doesn't start until 2-3 years from the priority date. In the biotech arena, we often have to file multiple continuing applications in order to have enough time to obtain experimental evidence/affidavits for overcoming a rejection.
5. Thus, deferral should be allowed after an Office action on the merits.
6. Thus, deferral should be allowed for a period longer than 3 years beyond the priority date. Perhaps, up to 3 years after the expected date of the first Office action on the merits (because of the difference in pendency between different types of inventions, e.g. biotech v. semiconductors).

Best regards,
Suzannah

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