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FACSIMILE COVER SHEET

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To: Robert Clarke
United States Patent and Trademark Office

From: Anonymous

FAX: 571-273-7735

Date: May 3, 2006

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Re: Proposed rules re continuation patent applications (71 FR 61)

Dear Mr. Clarke:

I have the following comments concerning the above-mentioned PTO proposal

1. I strongly object to the PTO's plans to apply the proposed rules to applications filed before the proposed rules become final. Many practitioners have filed cases over the past couple of years employing strategies based on the existing rules. It is fundamentally unfair to change the rules for these cases. To the best of my knowledge, the USPTO has not done this before.

2. The proposed rules violate 35 USC 131.

3. Applicants should have more than 1 month to provide or fix a defective statement under 1.261. It is likely that supplemental searches must be done as well as detailed analysis. It might not be feasible to do that in one month.

4. Suppose a) Applicant files a parent; b) Applicant files a continuation; c) the parent issues; and d) the claims of the parent are patentably indistinct from the claims of the continuation. Does 37 CFR 1.75(b)(4) permit the Commissioner to require Applicant to eliminate the patentably indistinct claims from the Continuation? Wouldn't this effectively enable the Commissioner to use this rule to ban continuations with patentably indistinct claims, merely based on these facts? Is this really what the USPTO intended? Suppose one discovers an unnecessary limitation in the claims of the parent. Does this rule permit the Commissioner to prevent Applicants from fixing such errors with a continuation?

5. The phrase "may require elimination" in 1.75(b)(4) is confusing. May the Examiner make this requirement arbitrarily?

6. Suppose a) Applicant files a parent with (for example) 10 claims; b) Applicant files a continuation; c) the parent issues; and d) the continuation claims are not "patentably distinct" from the parent.

a) Does the USPTO expect Applicant to file the statement under rule 1.261?

b) Is this burden imposed regardless of whether Applicant has a legitimate reason for filing the continuation?

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- c) If the continuation claims are patentably indistinct from the parent, why can't Applicant simply use the issued parent's examination to satisfy this requirement?
- d) Do I understand this rule correctly? There is nothing in the law that enables the Commissioner to impose this burden.