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From: Harry Brown [mailto:Harry@WRB-IP.com]

Sent: Tuesday, March 07, 2006 1:32 PM

To: AB93Comments

Subject: Comments on proposed Changes to Practice fo Continuing Applications...

Sirs:

For several reasons, the proposed continuation rules would conflict with past guidance from the USPTO and reasonable expectations of applicants, particularly with respect to applicants who have filed PCT applications. For example, many applicants who file applications in the PCT enter the U.S. by filing "bypass continuations" such that they enter the U.S. under 35 USC 111(a) instead of under 35 USC 371. An applicant's filing of a bypass continuation should not place that applicant at a disadvantage with respect to another applicant who enters the U.S. by filing a national stage application under 35 USC 371.

Filing a bypass continuation is desirable for several reasons:

- . Permits applicants to file an application in a form different than the form in which the application was filed with WIPO. For example, an application that was filed with WIPO with claims drafted in a "European" style (e.g., reference numerals, "characterized in that" language, multiple dependencies) can be revised prior to entering the U.S.
- o While there do not appear to be any decisions from U.S. courts that address this precise issue, this may avoid problems with disclaimer of subject matter or prosecution history estoppel that would not be avoided if the same amendments were made by preliminary amendment
- o The USPTO has encouraged pre-filing revisions instead of preliminary amendments. See Pre-Grant Publication Helpful Hint: File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application O.G. October 9, 2001.
- . Permits applicants to file using EFS. EFS is unable to accept filings under 35 USC 371.
- o The USPTO has encouraged the use of EFS by, for example, financial incentives to small entities.
- o As of a recent inquiry, there is an approximately 5 month backlog at the USPTO before issuance of a serial number for paper filings under 35 USC 371, while an EFS filing immediately gets a serial number.

Filing a bypass continuation does not result in the burdens alleged to arise from filing other continuing applications.

If rules such as the proposed rules are adopted, I sincerely hope that bypass continuations are not counted toward any limits on continuing applications or requesting continued examination. It is further strongly recommended that any rules that are adopted be applicable only to applications filed after the date on which the rules become effective to ensure that applicants can make informed filing decisions.

Very truly yours,
Harold R. Brown III

Harold R. Brown III
WRB-IP LLP
1217 King Street
Alexandria, VA 22314

Main Extension: (703) 299-0035
Harry Brown Extension: (703) 299-0953
Harry Brown Cell Phone: (571) 276-6338
Fax: (703) 299-0036