

-----Original Message-----

From: Katrina Leonardi [mailto:kleonardi@gbclaw.net]

Sent: Wednesday, May 03, 2006 11:43 AM

To: AB93Comments

Subject: Comments

Docket No. 2005-P-066

COMMENTS ON PROPOSED RULES REGARDING CONTINUATIONS

The rules proposed in Docket No. 2005-P-066 raise significant legal issues, and will have a negative impact on prosecution for reasons given in other comments to the proposed rules. Moreover, the proposed rules will have little positive impact, because there will be more appeals, more work for the Office by having to decide petitions for leave to file additional continuations, etc.

I suggest the following alternatives, which would reduce the burden on the Office without undue prejudice to patent applicants.

- (1) The Office should consider adopting a policy of relying on a European search report, Japanese search report, or searches from other countries considered to be reasonably thorough. At the very least, examiners should be encouraged to rely on "X" and "Y" references in foreign search reports, without additional searching.
- (2) Fees for filing Information Disclosure Statements could be related to the number of references in the IDS. Many references cited by applicants are cumulative or even immaterial, but are still provided to assure compliance with the duty of disclosure. Perhaps more importantly, there is almost no incentive for the client to pay an attorney to seriously consider the materiality of references cited in related applications, for example. An IDS charge based on the number of references would provide such an incentive, and relieve the examiner of this burden. The duty of candor should be tempered in this regard, though, lest it defeat the purpose of reducing the burden on examiners.
- (3) Instead of limiting the number of continuations and RCEs, the filing fee for later RCEs and continuations could be increased. This would discourage improperly motivated filings, without prejudice to applicants who seek to avoid the unnecessary surrender of rights forced by the "all or nothing" mentality of the proposed rules.
- (4) Reference numerals could be placed in claims for demonstrative purposes, not claim construction purposes. This should make examination easier, and improve the quality of applications, by better assuring that every claim element is described in the specification and shown in the drawings.
- (5) The Office could propose new guidelines for rejections based on undue multiplicity. M.P.E.P. § 2173.05(n). This would better address abuses of the system, without penalizing the innocent.

I hope my suggestions are constructive. Thank you for your continuing efforts to improve our patent system.

Respectfully submitted,
Patrick G. Burns

Katrina M. Leonardi
Assistant to Patrick G. Burns
GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive
Suite 2500
Chicago, IL 60606
Telephone: 312.360.0080
Facsimile: 312.360.9315
e-mail: kleonardi@gbclaw.net
www.gbclaw.net