

05/03/2006 13:10 4087367052

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PAGE 01

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To: Robert Barr  
United States Patent and Trademark Office  
From: Anonymous  
FAX: 571-273-7735  
FAX: 226-9195  
Date: May 3, 2006  
Pages: 3  
Re: Proposed rules re continuation patent applications (71 FR 48)

Dear Mr. Barr:

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

1. Preliminarily, I generally oppose the proposal. I assume that you will be inundated with objections to the proposal. In the interest of minimizing the mountain of comments that I suspect you will encounter, I will limit my comments to more specific issues. Nonetheless, I want you to know that I do not support the proposal.
2. 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.
3. This next group of comments pertains to the situation in which an applicant files several applications with the same disclosure but different claims.
  - a) I heard a rumor (although I did not see it in the rules) that if one files several applications with a common specification but patentably distinct claims, the PTO will require amendment of the specifications so that they become tailored to (i.e. support) just the claims that they contain. For example, if I file applications A and B with the same specification, but patentably distinct claims directed to subject matter 1 and subject matter 2, respectively, the rumor I heard is that the office may require amendment of application A to remove disclosure of subject matter 2, and amendment of application B to remove disclosure of subject matter 1. I assume/hope that the PTO does not plan to require such amendments, as they will create a completely useless hassle.
  - b) Undoubtedly, numerous disputes will arise regarding whether the claims in applications A and B are patentably indistinct. Query: is this decided on appeal or petition? I think it should be decided by appeal, since this is the sort of issue that the Appeals Board handles.

05/03/2006 13:10 4087367052

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PAGE 02

c) Any USPTO resources saved by enacting this aspect of the rules will almost certainly be wasted by arguments over whether claims are patentably distinct. This aspect of the rules is a bad idea.

4. Query: What constitutes good and sufficient cause for filing a second continuation? The USPTO should establish several "safe harbors":

a) Applicant just learned of a new reference, e.g. because the new reference was just cited by the Examiner or through other means. Applicant wants claims that are examined in light of this new reference.

b) It only recently came to Applicant's attention that the Examiner was interpreting the claims in some unusual way that wasn't apparent to Applicant before. (This happens quite often.)

c) It only recently came to Applicant's attention that the Examiner was under some basic misimpression that wasn't apparent to Applicant before. (This also happens quite often.)

d) Applicant only recently discovered that there was a limitation in the allowed claims that was unduly limiting. (Note that this is good and sufficient cause for filing a broadening reissue. It should likewise suffice for filing a continuation.)

e) Any other event that would serve as good and sufficient reason for filing a reissue.

These safe harbors should not be the only good and sufficient reasons for filing a second continuation. Rather, they should merely be safe harbor provisions.

5. Suppose Applicant discovers a competitor's apparatus, and realizes that his claims are not sufficiently broad to cover that apparatus. If Applicant could add claims to cover that apparatus by reissue, there is no valid legal reason why he should not be able to add claims by continuation. Any effort by the USPTO to prevent that would contradict substantive patent law.

6. I believe the USPTO has failed to take into account why people file numerous continuations. I suspect that numerous continuations are issued under three completely different situations:

a) Applicant believes that there are infringers, and he wants to make it difficult for the infringers to invalidate his vast number of claims.

b) Applicant wants to keep a submarine patent pending for a decade or so to see how the technology develops.

c) Applicant is having a tough time getting the case through prosecution.

The USPTO has not provided the public with an evaluation as to which of these situations causes problems for the public and the USPTO. I suspect that situation 6(a)

05/03/2006 13:10 4087367052

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PAGE 03

is the only one that creates a burden for the USPTO. I further suspect that situation 6(b) rarely occurs. Situation 6(b) might create problems for the public, but it creates no burden to the USPTO. I believe that the rules should be tailored to eliminate the specific situations that are problematic. For example, if it is situation 6(a) that is causing the burden to the USPTO, the rule should be limited to continuations if the parent has issued. For situation 6(b), there should be a rule pertaining to applicants who merely keep repeating the same arguments over, and make no real effort to push things forward. **Anybody who files continuations in a legitimate effort to get a case allowed should be allowed to do so, particularly if it appears that he is employing a reasonable strategy and trying different tactics to get the case allowed. Further, the "one continuation" rule is too narrow, arbitrary and unfair.**

7. Normally the burden is on the USPTO to prove that an application should not be granted. That rule should apply when there are numerous continuations. In other words, it ought to be the USPTO's burden to prove someone is abusing the system. A "one continuation" rule violates the principle that it is the USPTO's burden of proof to come up with grounds for rejecting an application.

I hope that my comments have been useful.

Regards,

Anonymous

05/03/2006 16:52 4087367052

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PAGE 01/01

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Re: Proposed rules re continuation patent applications (71 FR 48)

Dear Mr. Barr:

I have a follow-up comment. If one files several applications with a substantially common disclosure, there is no reason it should be the Applicant's burden to show that the claims are patentably distinct. The burden of proof is placed by law on the Commissioner concerning this sort of issue. What authority does the Commissioner have for shifting the burden of proof, and why should it be shifted? Why is this issue different from any other issue?

I hope my comment has been useful.