

To: USPTO
From: Francis C. Hand (Reg. No. 22,280)
Re: Proposed Changes to Practice for Continuing Applications

I have read the Proposed Rules published in the Federal Register/Vol. 71, No.1/Tuesday, January 3,2006.

The proposed rule appears to address the issue of Prosecution Laches that arises when an applicant obtains a series of patents over an extended period of time each of which is based upon a consecutively filed continuation application. See, for example, the situation discussed in *A&E Products Group, L.P. v Mainetti USA Inc. et al*, 2004WL345841 (S.D.N.Y.2004), 70 U.S.P.Q.2d 1080.

Issuance of a series of patents based on continuation applications of a single original application allows an applicant to obtain broader claims in the later filed applications. As recognized in the Summary to the proposed Rules, this tends to defeat the public notice function of patent claims in the initial application.

If a "continuation" application is truly for the same invention as claimed in an initial application, then if a patent is issued on the initial application, a "continuation" application should not be available to the patent holder. His/her only recourse would be to file for a Reissue of the patent.

A "continuation" application should only be permitted when the parent application is abandoned.

Thank you for considering my comments.

Respectfully,

Francis C. Hand, Esq.