

**From:** Lester Rules  
**Sent:** Tuesday, March 01, 2011 10:26 AM  
**To:** track\_1\_comments  
**Subject:** Comments re: Docket No. PTO-P-2010-0092] RIN 0651-AC52

Dear Track 1 Comments:

Regarding:[Docket No. PTO-P-2010-0092] RIN 0651-AC52

Please consider and respond to the following before implementing The Track 1 procedure as proposed.

It is submitted that this provision:

"Prioritized examination under this paragraph will not be accorded to a design application or reissue application, and will not be accorded to any application that contains or is amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim."

is problematic.

This provision would mean that if an application is filed under Track 1, with 2 independent claims and 18 dependent claims each directly depending from an independent claim, and the examiner finally rejects the independent claims but found the dependent claims to be allowable, the applicant would be unable to amend the claims to place them in independent form. It would require the applicant to either file an appeal or to do without the full protection to which the examiner has indicated he/she is entitled.

It would also limit the applicants ability to place claims in independent form during prosecution to emphasis the allowability of a claimed aspect. The allowability of dependent claims is often overlooked by examiners who sometimes consider dependent claims in isolation. Placing claims in independent form sometimes focuses the attention of the examiner on the combination as a whole.

Why would this outcome be appropriate? I submit that it is not appropriate. (Nor is the requirement that the applicant pay independent claim fees for simply placing allowed dependent claims in independent form).

It is submitted that a dependent claim placed in independent form is no more of a burden on the examiner that was the original dependent claim.

Limit the number of claims if that is appropriate (and since excess claims must be paid for, I submit it is not appropriate), but do not limit how many may be placed in independent form during prosecution.

This aspect:

Where, however, an applicant files a petition for an extension of time to extend the time period for filing a reply, the prioritized examination of the application will be terminated.

is also problematic.

Why should the applicant paying for better service from the USPTO be given less time to respond to Office Actions than anyone else? Does Federal Express require that those paying extra for overnight delivery come to the door and sign for packages more quickly than those using their ground service? Of course not.

Please reconsider the appropriateness of this penalty against applicants.

Regards

Lester Rules