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From: Jim Kulbaski [mailto:jimlaurak@yahoo.com]
Sent: Wednesday, May 03, 2006 5:14 PM
To: AB93Comments
Subject: Comments on Proposed Patent Office Rules

To: The U.S. Patent and Trademark Office
AB93Comments@uspto.gov

Date: May 3, 2006

Dear Sirs,

These comments are being submitted in response to the proposed patent rule changes entitled "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims," Federal Register / Vol. 71, No 1 / January 3, 2006. The comments are the personal comments of James Kulbaski, Reg. No. 34,648, and are not to be attributed to any client of James Kulbaski or his firm.

If the U.S. Patent and Trademark Office issues a restriction requirement, the Applicant should under any circumstance have a right to file a new divisional application directed to the non-elected invention, without the loss of any rights. There should be no requirement to file a petition and pay a petition fee in order to file a divisional application, when the restriction requirement was made by the PTO.

Take the following example:

- Japanese priority application ("JP") filed January 1, 2000
- First U.S. Application ("US1") filed January 1, 2001
- Japanese priority application published on June 30, 2001
- Restriction requirement issued by USPTO on June 1, 2003 for US1, because of separate inventions A and B.
- Applicant elects invention A in US1 on July 1, 2003, and cancels claims directed to B.
- Second U.S. Application ("US2") filed as a divisional of US1 directed to invention B on January 1, 2004
- US1 issues on February 1, 2004 with claims to invention A
- USPTO issues a restriction requirement on February 1, 2007 in US2, saying that the invention B in US2 is two separate inventions, C and D.
- Applicant elects invention C in US2 on March 1, 2007.
- RCE filed in US2 on April 1, 2007.

Assuming the proposed rules go into effect in 2006, Applicant cannot file after April 1 a divisional application ("US3") directed to invention C having the necessary priority claim, in response to the February 1, 2007 restriction requirement. Under proposed rule 1.78(d)(ii), the divisional can claim priority to only a single application which must be

US2 as that is the only co-pending application. However, a priority claim just to US2 will not work, because published JP will serve as a statutory bar without a priority claims to both US1 and US2. The problem with proposed rule 1.78(d)(ii) is that the applicant can only claim priority to one application, and cannot claim priority to US1.

Further, even assuming that the Applicant is willing to pay the petition fee and file a petition under rule 1.78(d)(iii), this rule only permits a petition for a continuation application. However, what is being filed is not a continuation application but a divisional application as defined in proposed rule 1.78(a)(3), so it is not clear even if the petition route is available under proposed rule 1.78(d)(iii) for an involuntary divisional in this situation.

I believe that the proposed rules must be written to automatically permit the filing of a divisional application whenever the PTO issues a restriction requirement, and there should be no requirement to petition in order to file a divisional application in response to a PTO issued restriction requirement.

James Kulbaski