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**From:** Steve Cahill [mailto:sjc@eecspatents.com]

**Sent:** Wednesday, March 08, 2006 3:24 PM

**To:** AB93Comments

**Subject:** Suggestion for Proposed Rule Effecting RCE Practice

To the U.S. Patent Office,

I agree with the proposed rule change that would limit the number of non-RCE continuations to one filing.

However, I feel that it is too restrictive to limit the number of RCEs to only one filing per application. Such a restriction would give a patent applicant 3 chances to make amendments to the claims to get a typical application allowed. The 3 amendments could be made in response to the first non-final office action, in response to a second final office action with an RCE, and in response to a third non-final office action after the RCE filing.

I have been prosecuting patents with the USPTO for over 7 years, and I have found that in some cases it takes more than 3 amendments to address all of the examiner's rejections. This is partly because examiners often perform a new prior art search and come up with new prior art after an applicant submits amendments to the claims. Also, it often takes one phone interview with the examiner to explain the invention to him/her so that the examiner can perform a more relevant prior art search.

If an applicant is limited to filing only one RCE per application, it will greatly increase the number of Appeals that applicants will file with the Board of Patent Appeals. Although such a limitation will reduce the backlog of applications in front of the examiners, it will greatly increase the number of appeals pending before the Board of Patent Appeals. Also, more of the examiners' time will be tied up responding to appeals.

Examination before a patent examiner is generally more efficient, faster, and lower cost than the appeals process. Therefore, to limit the number of applications that would have to be appealed, I suggest that an applicant be allowed to file **no more than 2 RCEs** in each patent application, to afford applicants more time to get the claims amended into an allowable format. Such a limitation should allow enough time for applicants to make amendments to respond to prior art discovered during examination in almost all applications. It would also limit the number of additional applications that have to be appealed because of the rule changes.

Because an applicant would be faced with a limit of 2 RCEs, it would create an incentive to get the claims into an allowable format as soon as possible. Applicants would avoid delaying prosecution, because they would understand that a final rejection after the second RCE would leave an appeal as the only option.

Also, filing a first RCE would count as a continuation application. Therefore, an applicant would not be able to file a non-RCE continuation for an application after filing

an RCE.

Thank you,

Steven Cahill