

From: Boundy, David - Cantor Fitzgerald
Sent: Thursday, April 10, 2008 12:04 AM
To: Markush-irfa.comments; Markush.Comments
Cc: Carrol.Barnes@sba.gov; Clarke, Robert (OPLA); David_Rostker@omb.eop.gov
Subject: USPTO Markush Rule - RIN 0651-AC00, and ICR's 0651-0031 and -0032 - take 2

[Microsoft moments - try again. Please replace the version I sent 20 minute ago with this one.](#)

<<080409 Markush Rule NPRM and IRFA.pdf>>

David E. Boundy
Vice President, Assistant General Counsel Intellectual Property
Cantor Fitzgerald LP
110 East 59th St
New York, NY 10022
(212) 294-7848
(917) 677-8511 (FAX)

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David E. Boundy
c/o Cantor Fitzgerald, L.P.
499 Park Ave.
New York, NY 10022

April 9, 2008

By Email Markush-IRFA.comments@uspto.gov
By Email Markush.Comments@uspto.gov
Kathleen Kahler Fonda,
Legal Advisor, Office of Patent Legal Administration
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

cc: Carrol.Barnes@sba.gov, Office of Advocacy, U.S. Small Business Administration
(Regulatory Flexibility Act issues discussed in § III at page 8 and § V at page 20)

cc: Robert.Clarke@uspto.gov, David_Rostker@omb.eop.gov (Paperwork Reduction
and Information Collection Requests 0651-0031 and -0032 discussed in § IV at
page 14 and § V at page 20)

Re: RIN 0651-AC00, Examination of Patent Applications that Include Claims
Containing Alternative Language, 72 Fed. Reg. 44992 (Aug 10, 2007) ("Markush
Rule") and Initial Regulatory Flexibility Analysis 73 Fed.Reg. 12679 (March 10,
2008) ("IRFA") and Paperwork ICR's 0651-0031 and -0032

Dear Ms. Fonda:

We appreciate the opportunity to comment on the proposed Markush Rules and
the PTO's Initial Regulatory Flexibility Analysis (IRFA) and Paperwork Reduction Act
Information Collection Request.

Our comments fall into four general categories:

1. Some of the proposed rules are contrary to law.
2. Others of the proposed rules are ambiguously drafted. This poor drafting will
result in arbitrary enforcement, or renders the rules simply unintelligible, so
that compliance is impossible.
3. The "analysis" in the Initial Regulatory Flexibility Analysis and the PTO's most
recent Information Collection Request does not comply with the requirement
to "describe the impact of the proposed rule on small entities," 5 U.S.C. § –
the "analysis" ignores more of the "impact" than it describes.

