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**From:** Boundy, David - Cantor Fitzgerald

**Sent:** Thursday, September 27, 2007 10:51 AM

**To:** BPAI Rules; Dudas, Jon; Robet.Clarke@uspto.gov; McKelvey, Fred;  
Allen.MacDonal@uspto.gov; Markush.Comments

**Subject:** Request for extension of Notice and Comment

Here is a formal letter requesting extension of the Notice and Comment periods for the Appeal and Markush rules

<<070927 Dudas extension request.pdf>>

David E. Boundy

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The Honorable Jon W. Dudas  
Under Secretary of Commerce for Intellectual Property  
Director, U.S. Patent and Trademark Office  
P.O. Box. 1450  
Alexandria, VA 22313

Judges Fred McKelvey and Allen R. MacDonald  
Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office

Robert Clarke, as Paperwork Reduction Act administrator  
Office of Patent Legal Administration  
U.S. Patent and Trademark Office

RE: RIN 0651–AC12 (Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals”), 71 FR 41472 (July 30, 2007) (Appeals Rule)

RIN 0651–AC00 (“Examination of Patent Applications That Include Claims Containing Alternative Language”), 71 FR 44992 (August 10, 2007) (Markush Practice Rule)

Dear Mr. Dudas,

I am writing to formally request that you significantly extend the public comment period for these recently published Notices of Proposed Rulemaking. Although the U.S. Patent and Trademark Office (USPTO) designated each as “not significant” under Executive Order 12866, both proposed rules appear to be very significant, and plausibly economically significant, under Section 2(f)(2) of the Executive Order.

The Appeals Rule would dramatically restructure the procedures used by the Board of Patent Appeals and Interferences (BPAI). These new procedures would significantly increase the cost of appealing first Office action rejections and reduce the likelihood that appellants can obtain a full and fair adjudication of patentability. USPTO provided a 60-day public comment period, which expires on September 28.

The Markush Practice Rule would radically change 50 years of practice in this important area. Many pharmaceutical and biotechnology patents would be difficult or impossible to prosecute under the proposed rules. USPTO provided a 60-day public comment period, which expires on October 9.

Recent Patent Office regulations have generated considerable controversy. The public comment process for these rules has been handicapped, as it has been in other recent cases, by the dearth of supporting documentation and policy analysis in USPTO's docket. Some of the analysis the Patent Office does report is problematic. For example, the Patent Office asserts that only 0.9% of small business patent applicants would be affected by the Appeals Rule. That ratio is obtained by taking the 4,000 appeals filed by small businesses in FY 2006 and dividing it by the 443,000 patent applications submitted that year. But these 4,000 appeals were 22% of the total number of appeals filed in FY 2006. Clearly, 22% is much different from 0.9% (71 Fed. Reg. 41484). If an appeals-to-applications ratio is meaningful at all, FY 2006 appeals should be compared to circa FY 2002 applications, not FY 2006 applications. Finding all the methodological flaws of this sort to assist the Office in preparing sound Paperwork Reduction and Regulatory Flexibility analyses will require significant work.

For these reasons, we respectfully request that you significantly extend the public comment period. That would not harm the Patent Office in any way, while better assuring that the public has a full opportunity to comment on these rules' vast implications for the U.S. patent system.

Sincerely,

/s/ David E. Boundy

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