This topic is presented on behalf of the Section of Intellectual Property Law of the American Bar Association ("ABA"). The views have not been approved by the House of Delegates or the Board of Governors of the ABA and, accordingly, should not be construed as representing the position of the ABA.

Proposal for study: A quality review of the proper use, or in most cases, the lack of use, of Section 112(a) rejections, especially in view of recent Federal Circuit case-law.

Explanation: A quick survey of recent allowed cases in the biotech field has identified a large number of granted patents that have either misapplied or not applied clear precedent from the Federal Circuit regarding a proper written description. For example, the representative number of species test as recently described in *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc*., 759 F.3d 1285, 1300, 111 U.S.P.Q.2d 1780, 1790 (Fed. Cir. 2014) and in Section 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. § 112(a) or Pre-AIA 35 U.S.C. § 112, para. 1, "Written Description" Requirement [R-07.2015] does not seem to be considered in recently allowed biotech cases. A quality review of recently granted cases may highlight the need to develop and implement proper training materials for the Examiners to continue to improve their skills, which will lead to improved quality of granted US patents.

Mike Winkler
Section Director
ABA Section of Intellectual Property Law
321 N. Clark St., 19th Fl.
Chicago, IL 60654
312-988-5639
www.americanbar.org/iplaw
mike.winkler@americanbar.org