

Comment 49 American Bar Association, Section of Intellectual Property Law
/ Gregory J. Maier

Attached are comments of the Section of Intellectual Property Law of the American Bar Association on Revised Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. Sec. 112, paragraph 1 "Written Description" Requirement. These comments are submitted at the direction of IPL Section Chair Gregory J. Maier, and in response to the Request for Public Comments published in the Federal Register of December 21, 1999 (Volume 64, Number 244, Page 71427).

AMERICAN BAR ASSOCIATION
SECTION OF INTELLECTUAL PROPERTY LAW

Comments Regarding

Revised Interim Guidelines for
Examination of Patent Applications
Under the 35 U.S.C. § 112 Para. 1
"Written Description Requirement"

(Federal Register Notice
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1. The Section of Intellectual Property of the American Bar Association ("IPL Section") applauds the action of the PTO in requesting comments from interested parties. The IPL Section agrees that in view of the comments and testimony that were provided in response to the Request published at 63 FR 32,639, there is a need to clarify and modify the previously published Interim Guidelines regarding the "written description" requirement. The comments that follow represent the views of the Section of Intellectual Property Law of the American Bar Association. The comments have not been approved by the Board of Governors or the House of Delegates of the American Bar Association, and therefore, should not be construed as representing the policy of the Association.
2. The IPL Section concurs with the overall approach taken in the preparation of the proposed Revised Interim Guidelines; however, there are some parts of the Interim Guidelines that should be clarified as set forth below.
3. The IPL Section also agrees that the Guidelines should be technologically neutral. This encourages fairness and uniformity in prosecution, regardless of the art or the subject matter of the invention.
4. The IPL Section does recommend that the Guidelines provide some explanation or example of how the Pfaff concept of "ready for patenting" should be used in ascertaining whether the

"written description" requirement has been complied with in a patent application. Specifically, the guidelines should explain or give examples of what, if anything, should be stated in an application regarding an actual reduction to practice, an embodiment undergoing testing or an invention that is "ready for patenting", in order to comply with the "written description" requirement.

5. Section I.A. of the Revised Guidelines should be clarified to show, with examples, situations where an application which provides an enabling disclosure nevertheless does not comply with the "written description" requirement. In addition, representative examples should be given to illustrate situations where an application does comply with the "written description" requirement without providing an enabling disclosure.
6. Section II.A. of the Revised Guidelines should be revised to make especially clear that determinations of compliance with the "written description" requirement must be made on a case-by-case basis. The Revised Guidelines should also emphasize that they are not to be applied woodenly and that they do not excuse the examiner from a full analysis of whether, in a particular case, the "written description" requirement has been met. For example, the Guidelines should state that the number of disclosed species necessary to support a generic claim may be different from case to case.
7. The Revised Guidelines should also point out that a written description may be adequate to support a sub-genus claim even where the specification does not contain a specific recitation of the sub-genus, provided that the sub-genus is enabled and an appropriate number of species of the sub-genus are disclosed.
8. The revised Guidelines should make clear that the number of "representative species" needed to provide a "written description" of a genus will vary from case to case. Further, the Revised Guidelines should emphasize that the question of compliance with the "written description" requirement cannot be resolved simply by counting the number of disclosed species.