

Comment 19

Thomas G. Field, Jr.

Dear Mr. Walsh,

Although I did not comment on the guideline published at 63 F.R. 32639 (1998), I was glad to see the revision in 64 F.R. 71440 (12/21/99) -- particularly the elimination of biotech-specific examples.

I was surprised to see no response to the question of whether the U.S. is meeting its TRIPS obligations as raised by CIPA. Yet, NAPP, at 8-9 in its earlier comment, seems to get to the heart of the matter by distinguishing (1) what can be claimed from (2) whether others can practice it. \*Gentry Gallery\* is a good illustration of the former; *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F.2d 546 (7th Cir. 1965), of the latter.

Indeed, the short answer to any argument that we do not honor TRIPS is: What one has invented, and hence can claim, is inherent in \*any\* patent law. As suggested in the revised guideline, the yardstick is usually "those skilled in the art": If they would accept one example as justifying some kind of range, it is justified. Otherwise not. That may be only part of the \*Lilly\* problem.

First, that concerns go beyond "written descriptions," despite a literal reading of Sec. 112, para. 1, seems clear from tolerance for deposits, e.g., under the Budapest Treaty (where names substitute at some level for structure.)

Moreover, *O'Reilly v. Morse*, 56 U.S. 62 (1853), arguably shows that views-of-those-skilled-in-the-art may not always be a good yardstick. That the first to temper steel cannot get all ways of tempering steel may have little to do with the views of those skilled in any specific art. Indeed, while \*Lilly\* involved a product not a process, the \*O'Reilly\* concern seemed to influence the Court.

Hence, it may be helpful, for purposes of addressing TRIPS and other concerns, to zero a bit more on fundamental problems for which "written description" may be a poor proxy.

I hope these comments are useful.

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