

**Chambers, Scott**

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**From:** gkt%Sughrue@MCIMAIL.COM[SMTP:gkt%Sughrue@MCIMAIL.COM]  
**Sent:** Friday, June 19, 1998 5:38 PM  
**To:** Chambers, Scott  
**Subject:** Interim Guidelines for Examination of Applications (112 Written Description)

Dear Mr. Chambers,

I am writing to provide a comment on the recently promulgated Interim Guidelines for Examination of Applications under 35 U.S.C. 112, first paragraph.

In Section II.B. of the Interim Guidelines, there is a discussion of the transitional phrases "comprising", "consisting essentially of" and "consisting of". However, in the example section, mention is only made of "comprising" and "consisting of" type claims. I have routinely found that Examiners object to a claim reciting, e.g., "a DNA molecule consisting essentially of..." or "a vector consisting essentially a gene X", on the basis that the preamble renders the claim vague and indefinite. When I've traversed the rejection in light of the case law, the Examiners still fail to remove the rejection, and respond by saying that the claims must recite "comprising" or "consisting of". I believe their position is contrary to case law, but do not want to spend years up on appeal on this issue. I believe that it would greatly assist the patent bar if the "final" guidelines clearly indicate that "consisting essentially of" is clearly proper, and does not per se render DNA/vector claims vague and indefinite, and to instruct Examiners to stop issuing 112 rejections based on the use of "consisting essentially of" language in such claims.

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