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From: Iver Cooper [SMTP:ICooper@browdyneimark.com]
Sent: Tuesday, March 21, 2000 11:58 AM
To: linda.therkorn@uspto.gov
Subject: comments on revised written description guidelines

On Written Description Revised Guidelines:

1. I understand why you deleted the examples dealing with "gene" vs. "DNA". However, if the term "gene" is used, the specification must be consulted to ascertain whether it is intended to include regulatory elements, and whether it is intended to refer just to the naturally occurring coding sequence. Hence, it would be appropriate to indicate, perhaps in an endnote, that use of the term "DNA", instead of "gene", is recommended to avoid these issues, and that the office is still of the opinion that claims to DNA are less likely to raise description issues than are gene claims.

Also, in deleting the other examples, you should indicate that they are being deleted merely because it is thought appropriate to keep the guidelines "technology-neutral", and not because the PTO has rethought the merits of those examples. The examples that have been deleted should, if not there already, be moved into the training materials. Or perhaps they could be moved into endnotes in the current guidelines. Endnotes 5, 13, 18, 39 and 48 all contain biotech-specific language.

2. The treatment of "consisting essentially of" is not entirely consistent. Moreover, I do not think that you have statutory authority for treating this term as the equivalent of "comprising" as suggested by the last sentence of endnote 27. There may be extrinsic evidence of what persons skilled in the art would consider to be the basic and novel characteristics of the claimed subject matter. If you replace "clear indication in the specification" with --explicit or implicit indication--, the statement would be more acceptable.

In some instances, it may at least be clear what ISN'T a basic and novel characteristic. For example, in an expression vector claim, nucleotides which are not part of the coding sequence, and which are not part of a known regulatory element, could not normally be said to alter the basic and novel characteristics of the claimed subject matter.

3. I believe that it is time for the PTO to formally acknowledge, in accordance with *In re Johnson*, that it is proper to amend a claim to excise prior art. Surely it is implicit in any patent specification that the claims are not intended to cover what it in the prior art. Hence, it should be possible to excise a prior art species from an otherwise impeccable genus, as was done in *In re Johnson*.

In making such a finding, it would be bringing itself into accord with the EPO, where the Guidelines for Examination expressly permit prior art disclaimers.

4. The PTO concedes that the "original claim doctrine continues to be viable". However, it argues that a description issue can still arise for an original claim. I am at a loss to understand how the PTO harmonizes these two statements. If Koller is good law, how can an original claim be rejected for lack of description?

I think that the kinds of original claims which the PTO considers to be problematic are actually properly rejected on other grounds, like enablement, or definiteness.

5. While actual RTP is not required for description, the Guidelines still place great emphasis on it. But what about constructive RTP? Suppose an application discloses a chemical formula, and a proposed synthesis for the chemical. Isn't that a full description of the species in question? Why should it be necessary to actually make the compound?

If there are doubts as to whether the compound could be made, an enablement rejection would be appropriate.

6. There is a general problem, which I wish the guidelines would address, of examiners using "enablement" language in description rejections, leading to confusion as to whether the rejection is for lack of description, lack of enablement, or both.