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From: Tom Brody [mailto:tom_brody@cerus.com]

Sent: Wednesday, March 01, 2006 8:43 PM

To: AB93Comments

Subject: Comments to proposed changes in Rule 1.78.

There is a special situation in biotechnology where CONTINUATION and CIP applications are used, and I suggest that the filing of a CONTINUATION or CIP in this situation should be facilitated by means of a CHECK BOX (rather than by a more cumbersome and less predictable-outcome petition).

This special situation is as follows:

Many inventors submit claims to nucleic acid sequences. The claim will in its entirety read: A polynucleotide sequence of SEQ ID NO:25.

The special situation that I describe is one where the inventor has no intention of ever reciting the utility (function of the gene) in the claim itself.

However, often the claim will be rejected, because data supporting utility was not available and had not yet been submitted.

The consequence, often, is that inventor must file a CONTINUATION or a CIP, where the CONTINUATION (by way of a Declaration) or the CIP (by new data in the patent specification) provides convincing data supporting utility.

I think it is unfair that an inventor might LOSE THE EARLIEST PRIORITY DATE merely on the basis of this heightened utility standard that is specific to biotechnology.

The notion that claims to newly discovered genes have a heightened utility standard is my own. The problem is that Company A might be the first to discover a new gene, and Company B might be second to discover the gene but first to find its utility, where the outcome is that Company A's patent is rejected, and Company B's patent is accepted.