Comment 39 Donald Sawyer

>>Commissioner of Patents and Trademarks
>>Box 8, Washington, D.C. 20231
>>Attn: Stephen Walsh
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>>
>>Dear Mr. Walsh
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>> I am writing in response to the Patent and Trademark Office Request
>>for Comments on the Revised Interim Guidelines for Examination of Patent
>>Applications Under the 35 U.S.C. 112 para. 1 "Written Description"
>>Requirement as published in the Federal Register on December 21, 1999.
>>
>> I am writing as a concerned citizen. My name is Donald Sawyer and I
reside in Brasilia, Brasil.
>> I support the views of the Council for Responsible Genetics (CRG) as
>>described below. I believe the PTO should further amend the revised
>>Guidelines before they are made final.
>> The CRG notes that US patent law excludes "Products of nature" from
>>patentable subject matter [35 USC 112; Diamond v Chakrabarty 100 S. Ct
>>2204, 2206]. We further note "The 'essential goal' of the description of
>>the invention requirement is to clearly convey the information that an
>>applicant has invented the subject matter which is claimed". One of the great
>>aspects of modern biology has been the recognition that the genetic material of
>>an individual is inherited from previous generations. Our genes are derived
>>from our parents, grandparents, and their progenitors through the
>>germline.
>>It is clear that human genes are products of nature. It therefore seems
>>that to be considered an "invention" the written description of a gene patent
>>claim would have to establish that the sequence does not occur in any
>>known organism.
>> Patent Office Guidelines should therefore instruct examiners clearly
>>that any descriptions which claim that the sequences to be patented are
>>present in the human genome, should be denied, since there would be no
>>inventive step. Such sequences may be accurately described as
>>'discovery', but not 'invention'.
>> The patent office may receive applications for nucleic acid
>>sequences that are claimed to be truly invented. In fact only a tiny fraction of
>>the genomes of the hundreds of thousands of animals, plants and microorganisms
>>species have had their gene sequences determined. It is therefore not
>>possible at the present time to ascertain that any nucleic acid sequence
>>is an invention.

>> The prudent course would therefore be to request clarification from
>>the U.S. Congress as to whether gene sequences do indeed fall in the realm of
>>patentable inventions. We note that the Supreme Court in the Chakrabarty
>>decisions did not identify genes as patentable subject matter, but rather
>>a reproducing and metabolically active genetically modified micro-organism
>>[Diamond v. Chakrabarty, 100 S.Ct].
>> We therefore believe that the tradition established for almost 200
>>years since Thomas Jefferson supervised the writing of the original Patent
>>Acts, remains valid. Patent examiners should be instructed to reject patent
>>claims whose written descriptions described nucleic acid sequences derived from
>>organisms.
>> Patents previously granted for gene sequences under the flawed
>>written description guidelines may have to be re-examined.
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>>Respectfully submitted,
>>
>>Donald Sawyer