Comment 35 Valerie J. Phillips

Dear Commissioner Walsh:

Attached below please find my personal comments regarding the Revised Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, para 1:

<<PTOEST.doc>>
Thank you,

Valerie J. Phillips
****

Valerie J. Phillips
Assistant Professor of Business Law
Washington State University
School of Accounting, Information Systems, and
Business Law
P.O. Box 644729
Pullman, WA 99164-4729
DIRECT 509-335-4446 SCHOOL 509-335-8541
FAX 509-335-4275
EMAIL vphillips@wsu.edu

March 21, 2000

Stephen Walsh
Commissioner of Patents and Trademarks
Patent and Trademark Office
Washington, DC 20231

RE: Public Comments on Revised Interim Guidelines for Examination of Patent Applications under 35 U.S.C. 112, para. 1, "Written Description"

Dear Commissioner Walsh:

I am submitting this letter as my personal commentary on the Revised Interim Guidelines for Examination of Patent Applications under 35 U.S.C. Sec. 112, para. 1, "Written Description." I am an attorney and an Assistant Professor in the College of Business and Economics at Washington State University (WSU). At WSU, I teach business law and conduct research in indigenous intellectual property rights.

The PTO should neither allow the patenting of Expressed Sequence Tags (ESTs) nor even consider allowing Written Descriptions as part of patent procedure under the Revised Interim Guidelines currently under consideration. Allowing such Written Descriptions is premised on the assumption that patenting ESTs will or should be allowed in this country. Such a premise is flawed for a variety of reasons, summarized below:

1. On July 25, 1999, indigenous peoples organizations from more than 30 different countries, **including the United States**, were signatories to the Indigenous Peoples Statement (Statement) on the Trade-Related Aspects of Intellectual Property Rights (TRIPS) of the World Trade Organization (WTO) Agreement.[35] In this Statement, signatories clearly stated that they understood Western notions of intellectual property and the implications of the TRIPS Agreement. They called for the disallowance of patenting of all life forms and natural processes as contrary to indigenous law and the creation of a *sui generis* system that recognizes indigenous customary laws regarding the protection of indigenous knowledge, heritage and resources. Recognition by the PTO that ESTs are patentable is a flagrant violation of this country's Trust Responsibility to the more than 500 indigenous tribes that are federally recognized within this country, violates the moral utility requirement of the patent code, and eviscerates the PTO's most recent decision to revoke the trademark of the Washington Redskins.

2. Diamond v. Chakrabarty,[36] the landmark case upon which the frenzy for patenting life is apparently based, was a bare 5-to-4 decision that the PTO and other courts should have subsequently applied very narrowly, if at all. The PTO itself initially refused to extend patentability to a genetically-modified organism on the grounds that such organisms were "products of nature" and therefore unpatentable. In the years since the Chakrabarty decision, the PTO and other courts have completely ignored the fact that the case was a 5-to-4 decision and instead impermissibly construed it too broadly to accommodate the biotech industry and its proponents.

3. Allowing the patenting of ESTs violates the Thirteenth Amendment of the U.S. Constitution prohibiting human slavery.

4. Patenting ESTs is imitating nature in a way that fundamentally violates the novelty requirement of the patent laws.

5. Allowing the patenting of ESTs fails to consider fully the ramifications of emerging legal developments in the relationships between indigenous knowledge and western notions of intellectual property, as represented by the successful challenge to the ayuhuasca patent.

6. Allowing patenting of ESTs will further exacerbate existing tensions between the indigenous and western academic/research communities as a flagrant example of how far this country is willing to go in ignoring the voices and concerns of indigenous peoples.

---

[35] Reprinted in GeneWatch, A Bulletin of the Council for Responsible Genetics, Vol. 12, No. 5, October 1999.

[36] 447 U.S. 303 (1980).

This can only have a very negative effect on work being conducted by other federal agencies, such as the current collaborations between NASA and indigenous peoples on global warming[37] and NSF work being conducted with indigenous peoples in the Arctic Circle.[38]

7. Indigenous peoples are developing research and academic institutions of their own which will work toward the benefit of future generations, not just immediate corporate interests. To be effective, such institutions must be within the context of indigenous laws. Patenting of ESTs will seriously undermine, if not completely destroy, their efforts because it strikes at the heart of indigenous law in a world that is dominated by corporate interests.

The PTO should not allow the patenting of ESTs, nor should it even be considering written descriptions for such patents. At the very least, the PTO should institute an immediate moratorium on all patenting of life forms and natural processes until the concerns expressed by indigenous peoples around the world and within the United States are adequately addressed.

Very truly yours,

Valerie J. Phillips
Assistant Professor

[37] See the Fall/Winter 1999 issue of Native Americas, currently available online at http://nativeamericas.aip.cornell.edu/

[38] www.arcus.org/Arctic_Opportunities/Arctic/Opp.html