Comment 36 Harris A. Pitlick

February 28, 2000

Box 8
Commissioner of Patents & Trademarks
Washington, D.C. 20231

Attention: Stephen Walsh

Dear Mr. Walsh:

The enclosed comments address the "Request for Comments on Revised Interim Guidelines for Examination of Patent Applications Under 35 U.S.C. §112 ¶1 "Written Description" Requirement," 64 Fed. Reg. 71427 (1999).

The comments are my own personal views, and do not necessarily represent the views of the above-referenced law firm or any of its clients.

Finally, this letter and the above-mentioned enclosure are also being submitted as a WordPerfect 7.0 attachment to an e-mail addressed to stephen.walsh@uspto.gov.

Very truly yours,

Harris A. Pitlick

HAP:bj
Enclosure: Personal Comments of Harris A. Pitlick

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As will be discussed in further detail below, the revised interim guidelines should be withdrawn at worst, as an incorrect statement of the law, and at best, as premature.

The "Written Description Guidelines" (guidelines) are stated as "based on the Office's current understanding of the law . . . and [are] believed to be fully consistent with binding precedent of the U.S. Supreme Court, as well the U.S. Court of Appeals for the Federal Circuit and its predecessor courts."

As the Office appears to recognize, it is charged with applying the law, i.e., the US Constitution, relevant statutes, and relevant precedent of tribunals of highest authority. While the Office concludes that it is "believed" that the guidelines are fully consistent with binding precedent, it has made no analysis.

The Office states that "[an objective of the written description requirement] is to put the public in possession of what the applicant claims as the invention." It is submitted that this is **not** an objective of the written description requirement; rather, it is the objective of the second paragraph of 35 U.S.C. §112 that an applicant particularly point and distinctly claim the invention, and perhaps of the enablement requirement of the first paragraph of 35 U.S.C. §112 to the extent the Office intends the possession by the public means how to practice the claimed invention, as opposed to what the invention is. The function of the written description requirement is to assure that the applicant was in possession of the claimed invention as of the filing date sought by the applicant. The written description requirement is not directed to providing information to the public other than to prevent an inventor from later claiming an invention that the inventor was not in possession of as of the filing date.

As argued by this writer in Harris A. Pitlick, *The Mutation on the Description Requirement Gene,* 80 J. Pat. & Trademark Off. Soc'y 209 (1998), cases such as *University of California v. Eli Lilly* (citation omitted) (*Lilly*), and *Fiers v. Revel* (citation omitted) (*Fiers*) do not correctly state the law regarding the written description requirement of 35 U.S.C. §112. As noted in the above article, the court in the above cases ignored the doctrine of constructive reduction to practice and, in effect, held that with regard to certain inventions in the biotechnological area, only actual reduction to practice constitutes possession of the invention with regard to satisfying the written description requirement. Since the above cases are the decisions of three-judge panels only, they cannot overrule precedent of the CCPA (which always sat en banc) or an en banc panel of the Federal Circuit. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

At note 4 of the guidelines, the Office discusses *Vas-Cath*, and other cases, and then concludes that "[t]hese early opinions did not address the quality or specificity of particularity that was required in the description, i.e., how much description is enough." Of course these so-called "early" opinions did not address this issue, because it never was an issue until the *Lilly* line of cases invented it. Under 35 U.S.C. §112, the only issue where "amount" of description is important is the enablement requirement, i.e., the statute requires a written description of the invention, and how to make and use it, "in such full, clear, concise, and exact terms as to **enable** any person skilled in the art ... to make and use the same (emphasis added)." So long as the **invention** described is claimed in the **same or equivalent terms**, the written description requirement has always been found to be satisfied. It is clear from an analysis of all the so-called early cases on the issue that an invention claimed in the same language used to describe the invention in the originally filed disclosure, i.e., specification and original claims, has *never* resulted in a finding that the written description requirement was not satisfied.

In discussing how original claims are to be treated, the guidelines also omit, and thus ignore, the concept of constructive reduction to practice. Indeed, except for the aberration in the biotechnology area as embodied by *Lilly* and *Fiers*, there is no justification for this omission. Indeed, the term *constructive reduction to practice* does not even appear in the guidelines.

This writer stated in the above article with regard to the naming of the requirement now known as the written description requirement (80 J. Pat. & Trademark Off. Soc'y at 224):

> Instead of focusing on the word *description*, the court should have been focusing on the word *invention*. In other words, the question is, with regard to a claimed invention: Is the *invention*, i.e., the invention now being claimed, described? And not, is the invention *described*?
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> It is unfortunate that the CCPA adopted the name "description requirement" to characterize this requirement. In retrospect, and especially in view of the misapplication of the requirement in *Fiers* and *Lilly*, perhaps the court should have named it the *invention* requirement (to use the most pertinent word actually appearing in the statute) or some other name to indicate that the purpose of the requirement is to determine whether there is identity between the *invention* described and the *invention* being claimed. The *possession* test is, in essence, the other side of the same coin.

The Office perpetuates this misunderstanding of the written description requirement. Indeed, it makes the matter worse, since by writing the guidelines "in a technology neutral manner which is broadly applicable to all areas of technology," it will cause the pernicious effect of *Lilly* and *Fiers* to be expanded into nonbiotechnology areas.

As noted above, a three-judge panel of the Federal Circuit cannot overrule long-standing precedent that the filing of a patent application is a constructive reduction to practice of subject matter disclosed therein. Because the Office is relying only on the decisions of three-judge panels, which decisions are inconsistent with binding precedent, the guidelines are at best premature. The Office cannot predict that the holding in *Lilly*, for example, will become binding precedent. Another panel of the court could conceivably arrive at a different result under a similar fact pattern. *Compare YBM Magnex Inc. v. ITC*, __ F.3d ___, 46 USPQ2d 1843 (Fed. Cir. 1998) (holding that disclosed but unclaimed subject matter is not necessarily dedicated to the public domain, contrary to the holding in *Maxwell v. Baker*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996)). Indeed, *YBM* highlights the fact that a decision of a three-judge panel, like *Maxwell* cannot overrule binding precedent. Until the Supreme Court, or an en banc panel of the Federal Circuit, or Congress, changes the law, the Office should not be publishing guidelines conflicting therewith.

If the Office believes published guidelines are necessary, the Office should instead state that constructive reduction to practice is still the law with regard to inventions claimed in the same terms as described in the disclosure, and that it will not follow cases like *Lilly* until binding precedent causes it to make exceptions for certain classes of inventions. Otherwise, if it feels constrained to follow the *Lilly* line of cases, at least until overruled, it should at least indicate that they represent a judicially-created exception for certain biotechnology cases and that they should not be expanded to other technology areas.