

**SOLICITOR****MAR 21 2000****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE U.S. PATENT & TRADEMARK OFFICE**

Written Comments on the

Revised Interim Guidelines for Examination of Patent Applications  
Under the 35 U.S.C. § 112 ¶ 1 "Written Description Requirement",  
64(244) FED. REG. 71427 (21-Dec-1999), 1231 PTO OFFICIAL GAZETTE 123 (29-Feb-2000)  
Docket No. 991027288-9288-01  
(hereinafter the "Revised Interim Guidelines")

submitted by

Dr. Jesús Juanós i Timoneda, J.D.<sup>1</sup>

Workman, Nydegger & Seeley  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone 801 5339800  
Facsimile 801 3281707

to

Mr. Stephen Walsh  
Box 8  
Commissioner of Patents and Trademarks  
Washington, DC 20231  
Facsimile transmission to 703 3059373

---

<sup>1</sup> Member American Intellectual Property Law Association (AIPLA), American Bar Association (ABA), American Chemical Society (ACS), and American Physical Society (APS). The comments expressed herein are those of the author alone, and should not be imputed to any employer or organization, past, present or future.

## COMMENT 1

### 1.1. PROPOSED REVISIONS

On p. 71436, col. 1, after reference to n.46, replace “emerging and unpredictable technologies,” by --inventions characterized by factors which are not reasonably predictable in terms of the ordinary skill in the art,--. The revised sentence would then read as follows: In contrast, in [emerging and unpredictable technologies] inventions characterized by factors which are not reasonably predictable in terms of the ordinary skill in the art, more evidence is required to show possession. (Where the text in brackets is to be deleted and the underlined text is to be added).

On p. 71436, col. 2, beginning of the sentence that ends with reference to n.50, replace “unpredictable art,” by --invention characterized by factors which are not reasonably predictable in terms of the ordinary skill in the art,--. The revised sentence would then read as follows: In an [unpredictable art] invention characterized by factors which are not reasonably predictable in terms of the ordinary skill in the art, adequate written description of a genus which embraces widely variant species *cannot* be achieved by disclosing only one species within the genus.<sup>4</sup> (Where the text in brackets is to be deleted and the underlined text is to be added).

### 1.2. REASONS

1.2.1. The proposed revisions would generally preserve consistency with the remaining text of the Revised Interim Guidelines, which refer in numerous instances to the skill in the art.<sup>2</sup>

1.2.2. The proposed revisions would specifically preserve consistency with the text of the Interim Revised Guidelines stating that “[a] general allegation of ‘unpredictability in the art’ is not sufficient reason to support a rejection for lack of adequate written description.”<sup>3</sup>

### 1.3. BENEFITS

---

<sup>2</sup> See 64 FED. REG. at 71434, col. 2, sentence that ends with reference to n.4, sentence that ends with reference to n.7, col. 3, sentence that ends with reference to n.11, sentence that ends with reference to n.14, sentence that ends with reference to n.18, sentence that ends with reference to n.21; 64 FED. REG. at 71435, col. 1, sentence immediately preceding the sentence that contains reference to n.22, col. 2, sentences that contain references to n.31-32 and sentence therebetween, first sentence in subsection II.A.3, sentence that contains reference to n.33, col. 3, sentence that contains reference to n.41, sentence that contains reference to n.42; 64 FED. REG. at 71436, col. 1, three instances preceding ref. to n.46, col. 2, two instances preceding reference to n.50, sentence that contains reference to n.52, col. 3, instance at the beginning of subsection III.A(2).

<sup>3</sup> 64 FED. REG. at 71436-71437.

The Revised Interim Guidelines with the proposed revisions would provide more clear and more effective guidance because consistency in the terminology would be preserved throughout. Failing to incorporate the proposed revisions would lead to guidelines that, on the one hand, would instruct not to use the terms “unpredictability in the art” for supporting a rejection for lack of written description,<sup>4</sup> and on the other hand, would categorize certain art as “unpredictable” or “emerging”.

#### 1.4. RATIONALE AND LEGAL AUTHORITY

Terms that refer to the predictability or unpredictability of an art or technology in general do not seem to rely on the established legal precedent that is articulated in terms of the level of skill in the art. This characterization also applies to terms that refer to the “emerging” character of an art or technology.

In *In re Bowen*, it was reasoned that it is the factors on which an invention depends what can be characterized as predictable or unpredictable depending on the skill in the art, but that the art or technology itself should not be generically catalogued as predictable or unpredictable.<sup>5</sup> Because terms that refer to the level of skill in the art are part of the formulation of legal standards that are well known and supported by legal precedent in patent examination and prosecution practice, these terms should replace undefined generic characterizations that single out individual arts or technologies and improperly label them as “unpredictable” regardless of the specific characteristics of the invention at issue.

---

<sup>4</sup> See 64 FED. REG. at 71436-71437.

<sup>5</sup> See *In re Bowen*, 492 F.2d 859, 861-62, (C.C.P.A. 1974) (analyzing the enablement requirement and reasoning that showings concerning the ability of one skilled in the art to use the invention as broadly as it is claimed, and concerning the operational capacity in the claimed process of materials other than those disclosed by applicant do not “hinge[] on whether the case is denominated ‘chemical’ or ‘mechanical’” and generally stating that “we would prefer to see the dichotomy which lawyers find in the chemical and mechanical cases ‘denominated a dichotomy between predictable and unpredictable factors in any art.’”, comparing *In re Cook*, 439 F.2d 730, 58 C.C.P.A. 1049 (C.C.P.A. 1971) with *In re Marzocchi*, 439 F.2d 220, 58 C.C.P.A. 1069 (C.C.P.A. 1971), and quoting *In re Cook*, 439 F.2d at 734, 58 C.C.P.A. at 1054).

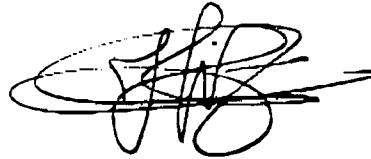
**COMMENT 2****2.1. PROPOSED REVISION**

On p. 71434, col. 3, end of the sentence that contains reference to n.12, replace "conventional in the art." by --part of the knowledge of one of ordinary skill in the art.-- The revised sentence would then read as follows: The claimed invention as a whole may not be adequately described if the claims require an essential or critical element which is not adequately described in the specification and which is not [conventional in the art] part of the knowledge of one of ordinary skill in the art. (Where the text in brackets is to be deleted and the underlined text is to be added).

**2.2. REASONS AND BENEFITS**

The Revised Interim Guidelines do not define the meaning of the terms "conventional in the art". Because of this lack of definition, these terms might lead to different examination standards when they are interpreted by different examiners. For example, a first examiner might wonder whether "conventional in the art" refers to a standard that is not the same as "ordinary skill in the art", whereas a second examiner might identify something that is conventional in the art as being the same as what is part of the ordinary skill in the art. To avoid this potential for confusion, the Revised Interim Guidelines should not use the terms "conventional in the art" if what is meant is to refer to ordinary skill in the art.

Respectfully submitted by facsimile transmission on this 20<sup>th</sup> day of March, 2000.



Jesús Juanós i Timoneda  
Reg. No. 43332