

**OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.**

ATTORNEYS AT LAW

FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VIRGINIA 22202 U.S.A.

(703) 413-3000

(703) 413-2220 FACSIMILE

OBLONPAT@OBLON.COM

WWW.OBLON.COM

PATENT, TRADEMARK AND COPYRIGHT LAW  
AND RELATED FEDERAL AND ITC LITIGATION

**SOLICITOR**

**FEB 23 2000**

**U.S. PATENT & TRADEMARK OFFICE**

NORMAN F. OBLON  
MARVIN J. SPIVAK  
C. IRVIN McCLELLAND  
GREGORY J. MAIER  
ARTHUR I. NEUSTADT  
RICHARD D. KELLY  
JAMES D. HAMILTON  
ECKHARD H. KUESTERS  
ROBERT T. POUS  
DAVID J. KERA  
CHARLES L. GHOLZ  
VINCENT J. SUNDERDICK\*  
WILLIAM E. BEAUMONT  
ROBERT F. GNUSE  
JEAN-PAUL LAVALLEY, PH.D.  
JEFFREY H. KAUFMAN  
BRIAN D. ANDERSON  
ROBERTA S. BREN  
STEPHEN G. BAXTER, PH.D.  
RICHARD L. TREATOR, PH.D.  
STEVEN P. WEIHROUCH  
JOHN T. GOOLKASIAN\*  
RICHARD L. CHINN, PH.D.  
STEVEN E. LIPMAN  
CARL E. SCHLIER  
P. JAY HINES  
JAMES J. KULBASKI  
RICHARD A. NEIFELD, PH.D.  
J. DEREK MASON, PH.D.  
SURINDER SACHAR  
JONATHAN HUDIS  
CHRISTINA M. GADIANO  
JEFFREY B. MCINTYRE\*  
WILLIAM T. ENOS\*  
MICHAEL E. McCABE, JR.\*  
STEVEN C. TABACKMAN

GERALD J. MOSSINGHOFF  
MILTON STERMAN  
SAMUEL H. BLECH\*  
JOHN O. TRESANSKY\*  
ALTON D. ROLLINS  
JAMES R. BOLER\*  
HARRIS A. PITLICK\*  
RAYMOND F. CARDILLO, JR.  
ROBERT W. HAHN, PH.D.  
JORDAN S. WEINSTEIN

MASAYASU IMORI\*†  
FRANK J. WEST\*  
BRADLEY D. LYTLE  
KATHLEEN COONEY-PORTER\*  
ANDREW M. OLLIS  
MARGO LIVESAY, PH.D.\*  
MICHAEL A. GUILIANA\*  
CORWIN P. UMBACH, PH.D.  
RON MYERS\*

W. TODD BAKER\*  
DAVID D'ZURILLA  
JOSEPH A. SCAFETTA, JR.  
CARLOS R. VILLAMAR  
ROBERT C. MATTSON  
MANDY M. PETROCELLI  
EDWIN D. GARLEPP  
ALEXANDER E. GASSER\*  
KETH DITTHAVONG  
CHRISTOPHER D. WARD  
THOMAS M. CUNNINGHAM, PH.D.  
FREDERICK D. VASTINE, PH.D.\*  
MICHAEL R. CASEY, PH.D.\*  
JOHN K. PIKE, PH.D.\*  
GEORGE E. LESMES\*  
JAMES J. KELLY, PH.D.\*  
DAVID A. BILODEAU\*  
STAMATIOS MYLONAKIS, PH.D.\*  
PHILIPPE J.C. SIGNORE, PH.D.\*  
KEVIN A. NORDBERG\*

\* BAR MEMBERSHIP OTHER  
THAN VIRGINIA  
† JAPANESE PATENT ATTORNEY  
° REGISTERED PATENT AGENT

February 15, 2000

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

Attention: Mr. Stephen Walsh

Dear Mr. Walsh:

The following is submitted in response to your request for comments on the Revised Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. §112, ¶1 "Written Description" Requirement dated December 16, 1999.

My comments are directed to two topics addressed in the Guidelines, i.e., level of skill and inherency.

The sole paragraph of II, 2, states that the review of an application is to be conducted from the standpoint of "one of skill in the art" at the time that the application was filed. Since an "art" contains a broad spectrum of skill levels - from that of the designer to that of the user of an invention - I consider this designation of skill level to be meaningless. My suggestion is to substitute therefor "one of ordinary skill in the art." Judicial support for this skill level may be found in opinions by both the CAFC and the CCPA, i.e., In re Gostelli, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) and In re Wertheim, 191 USPQ 90, 96 (CCPA 1976).

In the fourth paragraph of II, 3, a., the applicable skill level is designated as being that of a "skilled artisan." I consider this nonstatutory and, to my knowledge, judicially coined and undefined, expression to be even less helpful. I view it as being more ambiguous than the statutory language used in the first paragraph of Section 112, i.e., "any person skilled in the art."

Regrettably, the "authoritative" patent courts have not been helpful in more specifically identifying the applicable skill level. However, there is an old Supreme Court opinion - seemingly lost in history - which may provide a degree of specificity as to the applicable skill

level. In Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 437 (1866), the accused infringer asserted invalidity of the allegedly infringed patent on a method of uniformly mixing molten metal in the manufacture of steel because of an insufficient specification. The Supreme Court disagreed stating, "The specification of the patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel." This statement suggests to me that the skill level to apply in determining the sufficiency of a written description is that of the user of the claimed invention.

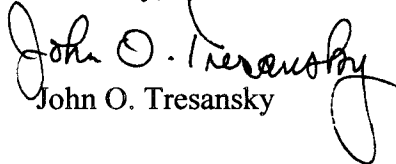
The first paragraph of II, 3, b. states that compliance with the written description requirement, support for newly added or amended claims, or entitlement to an earlier priority or filing date may be based on that which is inherently supported in the originally filed disclosure. In re Robertson is cited as authority for what constitutes inherency in the written description. Endnote 56 makes clear that the cited case applies to inherency in the description of a reference, and not that of an application. Although inherency in both an application and a reference may require more than a probability or a possibility, I believe that recognition by persons of ordinary skill of the inherency is not a requirement to establish inherent support in the written description. In making this point, I am aware of the dearth of case law regarding the nature of inherency in satisfying the written description requirement. Hyatt v. Boone, cited in Endnote 57, is one, but, regrettably, does not set forth the need for more than mere probability or possibility to establish inherency.

As a possible solution to this dilemma, I suggest that in lieu of citing Robertson, that Hansgirk v. Kemmer, 40 USPQ 665 (CCPA 1939), be cited. This case was cited in In re Oelrich, which was partially quoted by the Robertson court, but also involved the issue of inherency in a reference. In turn, Hansgirk v. Kemmer involves the issue of whether an applicant's specification can inherently support a claim copied from a patent to provoke an interference with the patent. The court expressly stated that, in this context, inherency may not be established by probabilities or possibilities; that the disclosure must be sufficient to show that the natural result flowing from that which is taught would result in the performance of the questioned subject matter. No mention is made of a requirement for inherency of recognition by persons of ordinary skill.

I hope that these comments may be of some value to you.

The views expressed herein are solely those of the undersigned and do not represent those of the firm.

Sincerely,

  
John O. Tresansky

**OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.**

ATTORNEYS AT LAW

FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VIRGINIA 22202 U.S.A.

(703) 413-3000

(703) 413-2220 FACSIMILE

OBLONPAT@OBLON.COM

WWW.OBLON.COM

PATENT, TRADEMARK AND COPYRIGHT LAW  
AND RELATED FEDERAL AND ITC LITIGATION

February 15, 2000

Box 8

Commissioner of Patents & Trademarks

Attention: Mr. Stephen Walsh

Washington, D.C. 20231

**SOLICITOR**

**FEB 29 2000**

**U.S. PATENT & TRADEMARK OFFICE**

NORMAN F. OBLON  
MARVIN J. SPIVAK  
C. IRVIN McCLELLAND  
GREGORY J. MAIER  
ARTHUR I. NEUSTADT  
RICHARD D. KELLY  
JAMES D. HAMILTON  
ECKHARD H. KUESTERS  
ROBERT T. POUS  
DAVID J. KERA  
CHARLES L. GHOLZ  
VINCENT J. SUNDERDICK\*  
WILLIAM E. BEAUMONT  
ROBERT F. GNUSE  
JEAN-PAUL LAVALLEY, PH.D.  
JEFFREY H. KAUFMAN  
BRIAN D. ANDERSON  
ROBERTA S. BREN  
STEPHEN G. BAXTER, PH.D.  
RICHARD L. TREATOR, PH.D.  
STEVEN P. WEIROUCH  
JOHN T. GOOLKASIAN\*  
RICHARD L. CHINN, PH.D.  
STEVEN E. LIPMAN  
CARL E. SCHUER  
P. JAY HINES  
JAMES J. KULBASKI  
RICHARD A. NEIFELD, PH.D.  
J. DEREK MASON, PH.D.  
SURINDER SACHAR  
JONATHAN HUDIS  
CHRISTINA M. GADIANO  
JEFFREY B. MCINTYRE\*  
WILLIAM T. ENOS\*  
MICHAEL E. McCABE, JR.\*  
STEVEN C. TABACKMAN

GERALD J. MOSSINGHOFF  
MILTON STERMAN  
SAMUEL H. BLECH\*  
JOHN O. TRESANSKY\*  
ALTON D. ROLLINS  
JAMES R. BOLLER\*  
HARRIS A. PITLICK\*  
RAYMOND F. CARDILLO, JR.  
ROBERT W. MAHL, PH.D.  
JORDAN S. WEINSTEIN  
MASAYASU MORI\*  
FRANK J. WEST\*  
BRADLEY D. LYTLE  
KATHLEEN COONEY-PORTER\*  
ANDREW M. OLLIS  
MARGO LIVESAY, PH.D.\*  
MICHAEL A. GULLIANA\*  
CORWIN P. UMBACH, PH.D.  
RON MYERS\*  
W. TODD BAKER\*  
DAVID D'ZURILLA  
JOSEPH A. SCAFETTA, JR.  
CARLOS R. VILLAMAR  
ROBERT C. MATTSON  
MANDY M. PETROCELLI  
EDWIN D. GARLEPP  
ALEXANDER E. GASSER\*  
KETH DITTHAVONG  
CHRISTOPHER D. WARD  
THOMAS M. CUNNINGHAM, PH.D.  
FREDERICK D. VASTINE, PH.D.\*  
MICHAEL R. CASEY, PH.D.\*  
JOHN K. PIKE, PH.D.\*  
GEORGE F. LESMES\*  
JAMES J. KELLY, PH.D.\*  
DAVID A. BILODEAU\*  
STAMATIOS MYLONAKIS, PH.D.\*  
PHILIPPE J. C. SIGNORE, PH.D.\*  
KEVIN A. NORDBERG\*

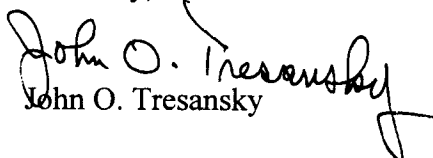
\* BAR MEMBERSHIP OTHER  
THAN VIRGINIA  
† JAPANESE PATENT ATTORNEY  
\* REGISTERED PATENT AGENT

Re: Revised Interim Written Description Guidelines

Dear Mr. Walsh:

In my prior letter of February 15th commenting on the subject Guidelines, I suggested substitution of Hansgirk v. Kemmer, 40 USPQ 665 (CCPA 1939) in lieu of In re Robertson cited in Endnote 56. Subsequently, I discovered Pingree and Batman v. Hull, 186 USPQ 248 (CCPA 1975) which not only quoted the portion of Hansgirk set forth in my previous letter, but also added that inherency requires inevitability. I believe that this addition provides a more complete picture of what constitutes inherency. In addition, Pingree is a more current case than is Hansgirk. I suggest that consideration be given to substituting Pingree for Robertson.

Sincerely,

  
John O. Tresansky