

Comments From

THE NATIONAL ASSOCIATION OF PATENT PRACTITIONERS

On The Revised Interim Guidelines for
EXAMINATION OF PATENT APPLICATIONS UNDER 35 U.S.C. 112, PARA. 1
“WRITTEN DESCRIPTION”

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In response to the Request for Comments appearing in the Federal Register: December 21, 1999 (Vol. 64, No. 244), the National Association of Patent Practitioners (NAPP) offers the following comments on the interim guidelines for “Written Description.” These comments were drafted by the Government Affairs committee of NAPP after solicitation of views from our members.

Deviation From Legal Precedent

The overarching issue of concern in the interim guidelines is the new scope and authority being given to the written description requirement. That the written description requirement is separate from the enablement and best mode requirements can not be disputed. *In re Barker*, 194 USPQ 470 (CCPA 1977); *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991). The issue is what is the substance of the requirement.

Traditionally, the written description requirement functioned to insure that applicant possessed, at the time of filing, that which he now claims. *In re Wertheim*, 191 USPQ 90 (CCPA). Possession in this context was simply that each element or limitation of the claim was somehow conveyed to the reader as being part of the invention. *In re Smythe*, 178 USPQ 279 (CCPA 1973); *Lockwood v. American Airlines, Inc.*, 41 USPQ2d 1961 (Fed. Cir. 1997) [“One shows that one is in possession of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious.”]. Thus, if the words of the claim are recited in the specification, then the written description requirement was satisfied in as much as the reader was informed that applicant was in possession of the elements and limitations now recited in the claim at the time of filing. Whether a worker skilled in the art reading the application was placed in possession of the invention was a different matter, namely one of enablement. *In re Howarth*, 210 USPQ 689 (CCPA 1981)[although the starting chemical compound was named in the specification -clavulonic acid- the skilled worker had no way of obtaining the starting compound other than by undue experimentation: therefore a lack of enablement]. The separate and distinct written description requirement was a low threshold bar that primarily prevented the introduction of new matter. Certainly in haec verba recitations of the claim language in the specification was sufficient, if not a safe haven, for compliance with the written description requirement. See *Smythe*; *Lockwood* for discussion that the more stringent in haec verba test is not required for satisfying written description. Indeed, the court has held that an originally presented claim is its own written description support. *In re Koller*, 204 USPQ 702 (CCPA 1980). This conclusion seems logically inescapable given the historical test for ‘possession’. An applicant can not more

clearly convey an element or limitation as being apart of the invention than by reciting that element or limitation in the original definition of the subject matter sought to be patented.

The interim guidelines change the substance of the written description requirement to require some level of enablement. This change is being implemented in order to accommodate the decision in *Regents of the University of California v. Eli Lilly*, 43 USPQ2d 1398 (Fed. Cir. 1997). To the extent that *Eli Lilly* holds that the quality of the description can prevent an otherwise in haec verba disclosure from meeting the written description requirement, it is in conflict with the earlier binding precedent of the Federal Circuit and its predecessor court. As a later inconsistent panel decision, *Eli Lilly* should not be followed and is simply bad law until an en banc panel of the Federal Circuit adopts the *Eli Lilly* view. The issue of the quality of the description falls under the enablement requirement and/or the definiteness requirement of the second paragraph of section 112; e.g. if the invention is a “wish” then it lacks enablement and if the invention as described is sufficiently vague to prevent “distinguishing” it from others, then the claimed invention lacks precision. In short, mere words have been and should continue to be sufficient to satisfy the written description requirement.

Methodology Concerns

While the methodology appears to be overly redundant and complicated, we will limit our comments to three specific items. Our comments are, however, generally applicable.

In section II.A.2., the Examiner is advised:

The analysis of whether the specification complies with the written description requirement requires the examiner to determine the correspondence between what applicant has described as the essential identifying characteristic features of the invention, i.e., what the applicant has demonstrated possession of, and what applicant has claimed.

The concern is that the Examiner will read the specification, decide what applicant should have claimed and then reject the application for applicant’s failure to claim what the Examiner considers to be the invention. Such a position is clearly contrary to establish law. *In re Borkowski*, 164 USPQ 642 (CCPA 1970). Further, to the extent that an “essential” feature is taught in the specification and not claimed, the proper rejection of the claim is for lack of enablement. See *In re Mayhew*, 188 USPQ 356 (CCPA 1976). Thus, this analysis is misplaced in a written description guideline. Instead the guideline should indicate that the claims are first read and then the specification reviewed to insure that each of the elements and limitations recited in the claims is set forth in the original disclosure.

In II.A.3.a. of the guidelines, the Examiner is instructed as to the meaning of “possession” of the invention. The third and final test set forth for proving possession is stated as:

or by a written description of the invention describing sufficient relevant identifying characteristics such that a person skilled in the art would recognize that the inventor had possession of the claimed invention.

Later in the section, this test is further described as :

An applicant may also show that an invention is complete by disclosure of sufficiently detailed relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. What is conventional or well known to one skilled in the art need not be disclosed in detail. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. (footnotes omitted)

The concern with this language is two-fold. First, these tests should be indicated as being non-limiting. That is, other tests or explanations should be permitted to show “possession” of the invention.

Secondly, the third test is unduly burdensome. The only “relevant identifying characteristics” that should be needed to show that applicant was in possession of the claimed invention are the features recited in the claim. The Examiner should not be able to reject a claim as lacking an adequate written description simply because the Examiner believes more data should have been presented; i.e. more identifying characteristics. If the Examiner can not determine the metes and bounds of the claim or can not differentiate the claimed subject matter from the prior art, then a rejection under 112, second paragraph or under 102 or 103 is appropriate.

Instead of referring to “relevant identifying characteristics,” the Guidelines should refer to the “limitations of the claim.” The purpose of the written description requirement is separate and distinct from the enablement requirement. This Guideline attempts to place the enablement burden into the written description requirement by requiring a certain quality of disclosure and by misapplying the notion of “possession” as set forth in the prior case law as explained above.

Finally, the entire section on original claims should be changed to indicate that originally filed claims are per se in compliance with the written description requirement. *Koller*.

Conclusion

In the absence of abandoning the new Guidelines in favor of the previous status quo, we request that original claims be deemed to have adequate written description support. Further, we request that a safe haven be incorporated into the Guidelines wherein in haec verba support is per se sufficient for 112, first paragraph written description. To the extent that these changes are perceived as being inconsistent with *Eli Lilly*, then *Eli Lilly* is in conflict with the prior precedent of the Federal Circuit and the CCPA and should not be followed.

Respectfully submitted,

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