



BANNER & WITCOFF, LTD.
INTELLECTUAL PROPERTY LAW

1001 G STREET, N.W.
WASHINGTON, D.C. 20001-4597

TEL: 202.508.9100
FAX: 202.508.9299
www.bannerwitcoff.com

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Director of the United States Patent and Trademark Office
Box 4
United States Patent and Trademark Office
Washington, D.C. 20231
Attention: Mr. Jon T. Santamauro

Gentlemen:

I am puzzled why the United States Patent and Trademark Office should find it necessary to seek comments on substantive issues of U.S. patent practice which have been in effect for a great many years. Further, the method of requesting comments on this important matter, namely by publishing the request in the Federal Register, requiring a response in a month and a half is further surprising; it is well known most Americans don't regularly read the Federal Register. The result of this curious nature of inquiry will be that only a truncated view of inventing Americans will be received -- unfortunately. While the opening sentence of your "background" states that "the United States has been involved in an effort to harmonize the substantive patent laws in the different countries of the world." I am sure this effort is being conducted by the PTO in light of what is best for all inventors in the United States of America. This, of course, is paramount and far more important than "uniform treatment of patent applications and patent grants", given as the presumed basis for reducing "costs for patent owners in obtaining and preserving their rights for inventions in many countries of the world." Surely you must know that a large number of patent applicants are not interested in extensive foreign filing of their applications as about 30% of the patent applications filed in the United States are not filed extensively abroad.

Turning now to the "issues for public comment", issue one relates to priority of invention, and comment is requested "as to which standard is 'the best practice' for a harmonized, global patent system." The choice is between the United States system of first to invent and the system used in other parts of the world which is "first to file". This was a question under discussion as early as twenty years ago and the first-to-invent system has been consistently chosen by the majority of inventors. Many of the very large corporations would prefer "a first to file" rule but they are obviously not the U.S. patent system. The U.S. patent system was designed to be available to all Americans, not just to large corporations.

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Issue 2 relates to patentable subject matter. The present system involving a "useful arts" test is much to be provided over the "technical contribution" used in many other countries.

3. The U.S. system involving an enablement requirement, a written description requirement, and a best mode requirement for patent disclosure is excellent and far better than anything other countries have.

4. There is no reason to require that claims identify "technical fields" to which the claimed invention relates. The U.S. law is better.

5. With regard to the issue of multiple inventions contained in a single patent application, this is really more of PTO financial importance than it is to most inventors.

6. The U.S. law providing a utility requirement is much broader and more desirable than limiting inventions to a specific "industrial applicability".

7. We have for well over twenty-five years operated under the In re Hilmer doctrine, which provides for an effective filing date in the U.S. as the prior art effective date. Any change to this system so that, for example, a foreign originating patent application would have a prior art effect as of its foreign filing date would merely serve to invalidate more United States patents. The present U.S. practice is preferred.

8. United States patent applications should be considered as prior art for both novelty and obviousness in the manner applied in U.S. law.

9. This paragraph raises the question of eliminating the "grace period". This is a totally unacceptable matter because many inventors, particularly small inventors, or individual inventors, like to have the time to see if their invention has commercial practicability before filing the patent application which involves an expenditure of considerable sums of money. The grace period is essential to many U.S. inventors.

10. The SCP have indicated a willingness of many members to eliminate any geographical restrictions that limit the definition of prior art. The United States system is far more practical than any arrangement like that. For example, I was at one time involved in a law suit which would have required the possibility of depositions in five foreign countries the practice we have in the United States. The U.S. system is far better.

11. Relates to certain bars contained in 35 U.S.C. 102(b)(c) and (d). These must be preserved. There is no reason given why it should not be the case.

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12. The use of multiple references for the anticipation of a claim such as under 15 U.S.C. 102 should be continued.

13. The U.S. patent system following the practice of *Graham v. Deere* has shown its great usefulness. It should be retained in any patent system.

14. The filing of multiple dependent claims is, once again, primarily a PTO economic determination. It also, however, is important in considering infringement. I believe the present U.S. system is better.

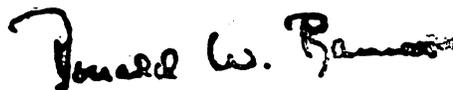
15. The peripheral claiming approach followed by the United States and the operation of 35 U.S.C. 112, paragraph 6, has shown to be highly useful and desirable.

16. The "doctrine of equivalence" should be retained although the recent *Festo* case ruling should not be a part of it.

17. The U.S. practice of naming the inventor or inventors is an essential part of our patent system. It is an encouragement to invention. There is no need for direct filing by assignees even though certain large corporations have desired this arrangement.

The next section relates to the text of the draft treaty, rules and practice guidelines and refers to "new style" and "old style" language. While it would seem that retention of the old style would prevent easier reference to former actions, I am not sufficiently knowledgeable about this issue to comment about it.

Yours very truly,

A handwritten signature in black ink that reads "Donald W. Banner". The signature is written in a cursive style with a large initial 'D'.

Donald W. Banner

DWB/lis