Request for Comments on the International Effort to Harmonize the Substantive Requirements of Patent Laws

1. Priority of invention: United States is a first-to-invent system while the remainder of the world uses a first-to-file system.

I prefer first to invent although first to file may be more universal or compatible with other countries. First to invent should not be abandoned entirely, for compatibility perhaps a first to file can be implemented with a seven year statute of limitations rule for any potential infringement.

2. Patenable subject matter: United States has a "useful" test, that is, the claimed invention must have a useful, concrete, and tangible result, while many countries require that the invention provide a "technical contribution".

If "useful arts" has worked so far, then I say leave it alone.

3. Specification, 35 U.S.C. 112, first par.: United States provides for a written description, enablement, and best mode requirement, while the standards vary among the other patent systems as to disclosure requirements.

"One of Ordinary Skill in the Art" should remain, don't leave it up to the examiner.

4. Claims: United States has no requirement to identify the technical field to which the claimed invention relates, while some countries require the identification of a technical field that in some ways limits the claim to that category of invention.

"Identification of Technical Field" limitation is not a good idea in my opinion.

5. Restriction: when there are multiple inventions claimed in a single patent application, the United States uses a restriction practice based on independence and patentable distinctness between the claimed inventions, while most of the world uses the Patent Cooperation Treaty (PCT) standard of "unity of invention".

Multiple inventions under one patent? U.S. should maintain one patent for one invention.

6. Utility under 35 U.S.C. 101: the United States requires that the utility of an invention must be specific, substantial, and credible, while most other countries use a narrower standard called industrial applicability, meaning that the invention must be usable in any industry.

U.S. broad utility is better than a limiting industrial applicability requirement, surely many patents can apply to more than one industry.

7. Priority date: the United States limits the prior art effective date of U.S. patents and applications to their effective filing date in the U.S.; and limits the prior art date as to foreign patent publications to their publication date, although international publications are available as of their filing date. The draft treaty would implement a global priority date based upon an agreed to publication or patent grant date.

Published/granted patents should become prior art. Applications however are just that i.e. applications, not yet issued patents.

8. Use of patent applications as prior art: the United States allows the use of patent applications as prior art for both novelty and obviousness considerations, provided the application is earlier
filed and is published or granted, while other systems restrict the use of these applications to questions of novelty only.

If publications of prior art in non-granted applications keeps others from receiving patents on variations, then keep it that way.

9. Disclosure during the "grace period": the United States has a grace period [usually one year] prior to filing the patent application during which the inventor may make disclosures about his invention and NOT risk defeat of his patent application, while other systems prohibit any disclosures prior to the date the application is filed.

This method has worked thus far then keep the grace period, especially since technology and the economy can change sooner than the two years required to receive a patent.

10. Geographical limits on defining prior art: in certain situations the United States limits disclosures to acts within a particular geographical area, e.g. within the territory of the U.S., while the draft would eliminate any geographical limitation associated with prior art.

How would prior art geographical restriction limitations affect U.S. patent applications? Would this mean patent searches must extend to all WPO countries?

11. Loss of rights: the United States provides for loss of rights for certain acts committed under 35 U.S.C. 102(b), (c), and (d), while most other patent systems do not have such provisions.

Perhaps should make "public use" equal to the time it takes to receive a patent i.e. two years.

12. Anticipating a claim using multiple references: the United States permits multiple references under 35 U.S.C. 102, for example, incorporation by reference, while other patent systems have stricter requirements for the use of additional references as to the determination of novelty.

For "novelty practice" I understand that if something is NOT listed in the claims it is patentable. Would not stricter requirements of reference use make things more difficult?

13. Obviousness: the United States follows the practice set forth in Graham v. John Deere and what would have been obvious to one of ordinary skill in the art, while other patent systems utilize a wide variety of determinations.

Requiring the identification of a technical problem is not required by U.S. law. Are we any the worst for it? Must a technology already exist to patent?

14. Multiple dependent claims: the United States has rules governing the formatting and dependency of multiple dependent claims, while other patent systems have no restrictions regarding formatting or claim dependency.

If it reduces complexity, discard the limits.

15. Claim interpretation: the United States and the rest of the patent systems differ on claim interpretation and claim construction in both the pre-grant and post-grant time periods. Is there a "best practice" available?

"Broader interpretation of claims" may be beneficial in settling disputes due to language/interpretations.
16. Doctrine of equivalents: the United States and some other patent systems apply a doctrine of equivalents when appropriate in interpreting claims in post-grant infringement cases, while some countries do not provide for such equivalents.

A "claim interpretation" universal doctrine of equivalents may facilitate post-grant infringement cases.

17. Applicants: the United States requires that the application be applied for in the name(s) of the inventor(s), while some patent systems allow for the direct filing by assignees. The draft treaty is silent on this issue but it may arise in future discussions.

Is there any advantage to direct filing by the assignee? Would this restrict the inventor(s) from obtaining proper credit legally?

ADDITIONAL COMMENTS

A. The alternative 'B' text style sounds better to me if it is truly simpler and more logical.
B. Is there any way to guarantee that the monies spent on filing a patent remains with the USPTO and are not siphoned off by other government agencies? If not the cost of filing a patent application and resulting maintenance fees should be reduced accordingly. I don't want to pay for something I'm not getting!