



QUALCOMM Incorporated

5775 Morehouse Drive
San Diego, California 92121

www.qualcomm.com

Comments for the USPTO Request on Matters Related to the Harmonization of Substantive Patent Law

Background: The USPTO is seeking comments relating to international harmonization in particular for the following areas: 1) grace period, 2) publication of applications, 3) the treatment of conflicting applications, and 4) prior user rights.

Introductory Comments:

Qualcomm applauds the USPTO for its continued transparency with respect to patent law issues that are critical to US innovators in general, as well as the leadership role it continues to demonstrate in driving the improvement of other countries' patent laws and patent office practices, including the harmonization of the world's substantive patent laws. These efforts have already led to improvements in examination of patent applications through work sharing efforts with many of the largest and most experienced patent offices around the globe. Harmonization of the various global substantive patent laws can only help to build upon some of the improvements that have already been made, and Qualcomm welcomes the opportunity to provide its comments regarding the four areas that the USPTO has solicited comments on.

In our comments, we understand that these identified opportunities for harmonization are stepping stones along the way to significant substantive harmonization of international patent laws. We recognize that companies operate in a global economy. We not only invest and innovate internationally, but also participate in international markets. Through our innovation, Qualcomm promotes economic development, enables technologies, and advances the wireless experience for people around the world. Rigid adherence to historic local laws results in a fragmented global patent system. Substantive harmonization of patent laws is not a zero-sum game. Rather, international harmonization provides savings of time and cost for international patent filers, as well as improving the quality of patents; leading to more legal certainty and predictability for both patent holders and implementers of technology. However, we also believe that there are other key areas to consider that may even have a larger positive impact on patent filers.

International harmonization of substantive patent laws creates an environment for even greater levels of work sharing for patent offices and legal certainty for patent holders. The Patent Prosecution Highway (PPH) systems recognize the potential gains and efficiencies from work sharing. However, the PPH systems do not adequately address issues that result from serial prosecution of patent applications in multiple international jurisdictions. The WIPO collaborative

search and examination pilots attempt to address the inefficiencies and legal uncertainties largely attributable to later discovered prior art references.

Global harmonization of substantive patent laws is a basis for a patent system appropriate for today's global economies. Harmonization of substantive laws is but one step in creating an international system that reduces legal uncertainties for the patent holders while enabling innovation and economic growth. Local offices need to take the complementary, but equally important, improvement of true work sharing and collaborative search and examination. Collaborative search and examination leads to greater legal certainty, lower costs, and reduced efforts for patent applicants, while simultaneously enabling increased work sharing and efficiencies in participating patent offices.

Proposed Comments:

Establishment of an international grace period is an important component of patent harmonization. A grace period of one year from the initial disclosure of the invention claimed in the patent application is believed to offer a good compromise between the public policy of encouraging prompt filing of patent applications and the practical needs of university researchers and small inventors to publish or otherwise disclose their inventions in order to obtain the funds needed to prepare and file a patent application.

Formalities and other restrictions on the types of disclosures qualifying for the safe harbor provided by a grace period should be eliminated as part of international harmonization. Qualifying disclosures should include written and non-written disclosures (i.e. oral, prior use and sale). Disclosures that trigger the grace period should include those made by the applicant for any reason, as well as any disclosures by others who had access to the applicant's invention information or whose disclosure was derived from the applicant's disclosure. Independently created prior art that is disclosed during the grace period should not be excluded as prior art. The present US Patent law, which does not require an applicant to advise the PTO of the existence of any prior disclosure, should be advocated to be adopted for the harmonized approach.

The 18-Month publication requirement is an important one for international patent filers. The ability to conduct searches and identify applications that are published because of this requirement is a valuable tool in managing filing strategies and portfolios. Mandatory 18-Month publication allows applicants using the PCT system to delay international filing decisions in order to identify relevant prior art that was not publicly available at the time the priority application was filed. The ability to identify relevant prior art, that was not available when the priority application was filed, facilitates more informed national stage filing decisions, resulting in both cost and time savings for applications, the patentability of which may be impacted by the newly discovered prior art.

Regarding the treatment of conflicting applications, and especially in view of the present heightened scrutiny of patent quality, it is our belief that the US approach is the best way to prevent the granting of multiple patent applications that would otherwise be obvious or lacking inventive step from earlier filed, but later published patent applications. Coupled with the 18th month publication requirement and delayed national stage entry permitted under the PCT system, the negative effects

of the so-called secret prior art is greatly mitigated. We also support “anti-collision” provisions that could be similar to those that presently exist under US law.

Finally, the US, just a short time ago with the promulgation of the AIA, added prior user rights to the US Patent Laws. There were many varying viewpoints on this topic among the active stakeholders in the AIA debate, with the current law representing a compromise among those diverse views. Additionally, it should be kept in mind that many activities that might fall under a broader prior user right defense, also might constitute invalidating prior art, for example under prior use or sale theories, which is not necessarily taken into account in existing international prior user right laws. Thus, any harmonized law in this area should be perhaps revisited ab initio to be more precisely defined. Furthermore, prior user rights is a defense to patent infringement and will have no impact on improving patent application filing requirements and examination procedures. In the event this subject impedes progress on harmonization of the other topics under consideration, it would be more prudent at this time to remove this topic from the Patent Harmonization debate. This would increase the chances of succeeding in completing an acceptable harmonization agreement that includes the other topics we have commented on.

Respectfully Submitted,

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