



Via Email

May 4, 2007

United States Patent and Trademark Office  
Office of International Relations  
Madison West Building, 10<sup>th</sup> Floor  
600 Dulany Street  
Alexandria, VA 22313  
ATTN: Jon P. Santamauro

ATTORNEYS AT LAW  
CHARLES L. GHOLZ  
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Re: Request for Comments on International Efforts to Harmonize  
Substantive Requirements of Patent Laws

Dear Mr. Santamauro:

I am writing this strictly on my own behalf and not as a representative of either my firm or any client of my firm's. I am an interference specialist and hence most interested in the first category.

(1) *Priority of Invention*

It is unacceptable even in the first-to-file countries for the first to file to get the patent if it stole (or even simply derived) the invention from the second to file. Hence, the first-to-file countries have rudimentary procedures to deal with what we would call "derivation" and "inventorship" disputes. See generally "Interference Issues in a First-to-File World," 18 AIPLAQJ No. 1 (1990). However, those procedures are very unsatisfactory because they do not permit either discovery or cross-examination of witnesses. I urge you to seek to compel the other parties to set up procedures that are at least generally similar to the procedures of the "Derivation Proceedings" that would be provided for by amended 35 USC 135(a) under the Patent Reform Act of 2007 and 37 CFR 41.100 et seq.

(6) *"Loss of Rights" Provisions*

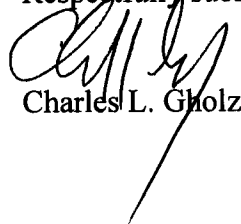
(a) I do not think that "[c]urrent U.S. patent law" requires an invention to "remain[] 'on sale,'" either at the time that patentability is being considered or at any other time. It is enough if the invention was on sale at any time prior to the critical date.

(b) Similarly, I do not think that "[c]urrent U.S. patent law" requires that "successful commercial exploitation" of the invention continue on beyond the critical date.



(c) Finally, I do not think that “[c]urrent U.S. patent law” requires that the commercial exploitation have been “successful.” It is enough that the invention was “on sale” even if it was never sold.

Respectfully submitted,



Charles L. Gholz

CLG/feb