

Mr. Santamauro

In response to FR 72, #85, @pg 24566, would you please record the following comments for consideration:

1. I am a patent attorney and holder of multiple US patents. I have recently begun practicing in Canada, and I very enthusiastically support a first-to-file rule, if harmonized with limited prior user rights rule.

2. America's weak prior user rights rule is a reflection of its first-to-invent position. In fact, a prior user rights rule is somewhat redundant within a FTI system since the prior user can, presumably, protect his right to use an invention he first made but did not patent by challenging the validity of any patent that may be used against him. But in shifting to a FTF system, a prior user rights rule may be a constitutional necessity in the US.

3. I do not believe that any patent system should allow a second inventor to foreclose a first inventor from making and using the invention, regardless of who holds the patent. Specifically with respect to the US, I do not believe that the Constitution grants Congress the power to deprive a first inventor from the right to use his own invention, even if he never applied for letters patent. A contorted version of this argument is currently being used against establishment of a FTF system in the US -- that the right to exclude is granted to the "inventor," who is, according to the argument, by definition the first to invent.

4. However, Article I, Section 8 does not prohibit a FTF system because Section 8 does not specify that the rights to be secured for limited times are to be secured for "first" inventors. It only says "inventors."

5. If two people make the same invention independently, then there is no Constitutional prohibition against limiting patent protection to the first inventor to file. It is the universal deletion of "inventor" from the phrase "first inventor to file" that encourages an improper Constitutional argument.

6. However, I would argue that there is a Constitutional prohibition under the Vth Amendment against taking away from an inventor his right to use,

make, and sell his own invention, so long as he reduced the invention to practice independently of a patentee and before the date upon which the patentee applied for a patent. I would also add the provision that prior rights cannot be expanded beyond what they were at the time the application was filed.

7. In other words, if I invent first and I am selling 5000 units a month at the time you file a provisional application, a regular application, or any PCT filing, you could enforce the patent against me only to the extent of preventing me from increasing production beyond 5000, or from licensing etc. It would be for the courts, not the PTO, to determine the facts and enforce this provision, as it is now.

8. In summary, I would contemplate three classes of persons with respect to invention X.

The first class comprises those who did not invent X. A patent for X is enforceable against any of these persons.

The second class comprises non-patentee inventors who invented X before a patent application was filed. A patent for X is not enforceable against these persons for the level and scope of their use of X as of the time of filing.

The final group comprises the patentees of X.

9. Of course, it would go without saying that a patent would be enforceable against licensees or assignees of the non-patentee prior use inventors. In other words, prior use rights must not be made assignable.

A FTF system is both workable and constitutional in the US, but not without a lot of careful consideration. I applaud your office for making this effort.

Please note that these are my own opinions and do not reflect the opinion of my employer.

Thank you,

Denis O'Brien

Denis O'Brien, PhD
Vermette & Co
Suite 320 -- 1177 W. Hastings St.
Vancouver, B.C. CANADA
V6E 2K3

604-331-0381
FAX 604-331-0382
dobrien@vermetteco.com

This message is confidential, intended only for the person to whom it is addressed and may contain information that is privileged and exempt from disclosure under applicable law. If you have received this message in error, please notify us by return email and delete this message without making a copy.