To, scpcomments@uspto.gov

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
BOX 4, USPTO,
WASHINGTON, DC20231
USA
KIND ATTN. MR. JON P. SANTAMAURO

Dear Sirs,
Please find the following as my humble submission on 'International Effort to Harmonize the Substantive Requirements of Patent Laws', point by point, according to your questions from (1) to (17).
With sincere regards,
Kalhan Kumar Sanyal
20th. April, 2001

Samir1942@yahoo.com

(1) I select to subscribe to "First To File".
Why?

a. In the legal domain/system, a 'child is born' as recorded in the registration of birth in the appropriate government office, that means, when the child becomes known in the 'public domain'. That date of registration must be the 'date of actual birth' according to the medical certificate, the day, the child comes out from the mother and meets the 'public'. This mechanism of meeting the 'public domain' is the "moment of utmost importance" for the legal system, to 'take care' of the 'phenomenon'. At this very moment, the clock starts and the 'specific incident' become the legal entity for which the society becomes responsible to record it in the public system. Otherwise, actually, in the physiology, the child is born in the moment when the heart starts working in the mother's womb, say.

b. 'First To Invent' may be a very important aspect to offer the moral right to the actual inventor. But, to protect and to allow such ethical aspect of the invention should be a subject matter of another group of law created for the jurisprudence of ethical survival of the society, not the IP Law. The matter of 'first to invent' can be investigated for historical reason and through history-related tools. IP law should not burden itself with this aspect. IP Law should start its clock as soon as the application is filed in its office. If someone claims that she/he is being treated through 'unfair root' by not allowing her/him the credit of the invention, he/she should be advised by the Patent Office to record the case in the main legal system of the country, like the case of cheating. If proved, the government can always offer justice, by not allowing the IP to come into practice, even if, it was granted by the patent office. This is like a dispute related to any other type of property and the national legal system can always take care by allowing public notification of the fact. After all, the 'moral right' related to IP or related to any other domain is the highest aspect of respect in the public mind/life and the entire legal machinery is to protect and maintain such value in the society.

c. It is a normal suggestion to maintain a 'Record Book' to prove the 'First to Invent' point. But let such mechanism/device be the subject matter/freedom of the organizations concerned, if at all required. This is a good discipline-imposing tool in the research climate, but this type of attitude also create not Only a cumbersome way of performing but also it creates a trustless climate in research. Let the Organizations decide their needfulness of honoring the 'true' inventor....,IP law should not create a 'doubtful' notion by imposing the 'first to invent' point. Actually, it should be a criminal matter not an IP subject matter to 'investigate' who really invented the invention. The procedure of 'first to file' is Much more respectable attitude to the inventors for it does not disbelieve the applicant, from the Beginning.

d. Only USA has been following the notion of 'first to invent', for the entire world it is 'first to file'. The harmonization will be more harmonized if care is offered to the believes of the global Community.

(2) In the approving of the 'patentable subject matter' three points should be tested, to allow full freedom to Creativity.

(a) Did the subject matter existed prior to 'human intervention'. If required, route of historical studies, Globally, should be conducted, before granting the patent as well as after granting the patent, (to make The patent null and void, if required).

(b) Does the subject matter is against the 'morality' and 'ethics' according to UN Charter.

(c) Is it possible to modify the physical existence of the entity under consideration, to another level of Physical existence, through further human intervention.

(3) The level of 'disclosure' in the description of the complete specification should be such that , to a 'qualified person in the concerned discipline' can see a 'possibility' of the application (of the patent) to reduce to practice. It is only 'possibility' but not a 'certainty'. Because, there should be a gap between the 'patent specification' and the know-how /show-how /technical expertise associated with implementation of a technique/technology/machine to reality. Patent specification in the respect of the disclosure should not be burdened with such details which comes under the subject matter of technical implementation secured through formal qualification and experience in a specific field.

(4) Claim should reflect the specific 'technical field' say, according to the methods followed in the Library Science. Then the subject matter of the patent specification will be more reachable to the researchers as they are more exposed to the domain of library than to the patent database.

(5) This matter should be left to the freedom of the applicant. She/he is free to apply in the matter and in Manner related to her/his inventions.

(6) This should be 'utility' based. The scale of utility; individual or industrial, is 'not' the consideration of the Patent examiner. Whether the invention can prove the tangibility of just utility , that should be enough.

(7) As in the PCT, for filing an international patent, the 'global' priority date should be the date on which the applicant actually files the first application in any patent office in the national system, provided that Application, in full text, reaches the public domain, eventually, in any member country. That 'global date' should be honoured, that is, the date of first application.

(8) 'Nonobviousness' as tested in the canvas of public domain/knowledge already existing in the public access, globally, should be the point of consideration. What is already in the private/secrete domain should be ignored.

(9) There should not be any 'grace period'. If one has to disclose additional information, let that be a subject matter of another patent application. This procedure will ease the management of the document in the patent office and reduce the possibility of additional litigation.

(10) 'Prior Art' is the created heritage of global mankind. Anything being created anywhere in the global domain, in this electronic connectivity age, in the speed of light, has a potential influence for the immediate creation, any where. 'Prior Art' canvas should be not only global but universal not to be restricted geographically. So, when the 'prior art' aspect has be tested, for novelty, it should be tested, "globally".

(11) As soon as the invention is there in 'public domain' in 'any form', it is a prior art, on the date of the application for granting a patent, so, the date of application and prior art on that date, to be considered for testing the novelty. This prior art should be global.

(12) As in (11).

(13) "Nonobviousness" should be tested by the "freedom" of the examiner of the patent. However, the patent examiner should be trained intensively, in all possible means, to examine and judge a patent claim, with the mind and eye equivalent to that of a chief justice of a supreme court. But, once it is assigned to her/him, let it become her/his "freedom" to use her/his judgement, if necessary, she/he can take the help of expert technical consultations.

(14) US practice is fine, otherwise, it shall create unnecessary complication. As usual, main claim should be the first claim, next claims should be the successive extensions of the first claim only. That is, the first claim is like the 'main tree' and the successive claims, like the branches of that tree, should 'only' to expand that main tree, if necessary. That is, even if the successive claims are absent, the main tree stands perfectly on its own foundation (roots).

(15) "Centrally focused view" of the interpretation, instead of peripheral view of interpretation should be encouraged. Both pre-grant and post-grant practices should be allowed to allow the global public Legally democratize the proceedings related to any patent. The patent claims must have the strength To stand on its feet over a time scale, the challenge, in the form of interpretation is to be there every Moment, in course of its term. Creativity cannot stagnate, it is ever expanding.

(16) As in (15)

(17) It should be always the responsibility of the system (global harmonization) to device a method so that The "Moral Right" of the inventor is never disturbed and she/he always can claim and receive the respect as the creator of the IP. So, the patent application always has to be in the 'name of the inventor' and not in the name of the agent/assignee. It is always the Moral Right which should come first and then only the Economic Right may come.

Kalhan Kumar Sanyal
Scientist/IP
CMERI
Durgapur 713209, WB
INDIA
[http://www.cmeri.com]

20th. April, 2001, Friday.

e-mail, samir1942@yahoo.com

Homepage, http://homepages.talkcity.com/terminus/ramakrishnadeva

http://communities.msn.com/creativityforacause

http://communities.msn.com/vedantathelifeskill

http://communities.msn.com/researchcreativitythroughvedanta