

Director of the United States Patent and Trademark Office
Box 4
United States Patent and Trademark Office
Washington, D C 20231

April 23, 2001

Re: Comments on the International Effort to Harmonize the Substantive
Requirements of Patent Laws.

Dear Mr. Santamauro:

As you know, an effort to achieve international harmonization of substantive patent laws was undertaken under WIPO auspices from the mid 1980's to 1992 when it was suspended in the early days of the Clinton Administration. I participated in that effort and attended many of the working sessions representing the views of various associations and the corporation with which I was affiliated. I retired in early 1994 and aligned myself with an independent small inventors organization which I serve in an officer capacity. These experiences have enabled me to view the changes from the points of view of both the very large and the smallest inventive entity. Quite frankly, the changes benefit all inventive entities regardless of size, as they should. However, I will approach the commentary with the small inventor particularly in mind since that sector has not been well represented. Rather, self appointed spokesmen for the small inventor have turned the debates in the U.S. into class warfare and achieved a victory of paralyzing the political process. This is likely to happen again unless special strategies are developed to address the concerns of the small inventor.

Turning to the issues identified for public comment I offer the following:

1.) Priority of Invention

As noted, the breakdown between first to invent and first to file priority systems is pretty much a case of the U.S. on the one side and the rest of the World on the other. That was not always the case, but

the trend is towards first to file and now we stand alone. It seems clear that if harmonization is to occur we are the ones that will have to move. This issue was raised to huge proportions in the past debates. Such importance is not warranted. The deviation between priority results between the two systems is very small. In the U.S. only a small proportion of the cases filed generate a priority contest and most of those are won by the first to file. I have not heard from one inventor in the organization I serve who has been involved in a priority contest. It is true that a small inventor does not like the concept of losing out to a later inventor who filed first. Moreover, it is visualized that comparatively speaking large corporations have unlimited resources and can rush to the Patent Office on a whim and that first to file would thus disadvantage the small inventor in theory. He is not told that under the first to invent system his chances of overcoming a well healed resistant first filer are slim and the cost of the attempt is likely out of his reach. He is not told that even if he invents first and files first in the U.S. he runs a risk of being spent into submission or losing because he is not a sophisticated record taker. The great benefit of first to file is the certainty of the system and the elimination of expensive interference contests which on the whole will benefit small inventors.

2.) Patentable Inventions

A broad definition of patentable inventions seems in the interest of a creative society which often thinks outside the box such as the U.S. Other countries seem to move in our direction in time (i e living matter and software) so I think we should retain our leadership position. Harmonization should not mean stultification. Society benefits from innovation across the broadest front possible.

3.) Disclosure Requirements

Our disclosure requirements, while intended to foster full disclosure have become a source for breeding expensive discovery and excessive litigations. The patent system is in danger of being priced beyond the reach of the small inventor. European standards are more practical and cost effective than ours and movement in that direction would seem desirable. However, where it is provable that an inventor intentionally suppressed and concealed matter critical to understanding the invention, he should be held accountable.

4.) Content of Claims

Naming of applicable technical fields should not be a limitation on the invention and imposing it as a claim element tends towards that interpretation. Would the earliest computer innovators who thought in terms of big adding machines have thought to name machine tools and automobiles as part of the relevant technical field? An inventor should be entitled to protection in all fields his invention may be applied even if beyond the particular application he is applying himself. Technical fields may be nonrestrictively added to assist searching or understanding, but not to give infringers the ability to appropriate.

5.) Unity of Invention

The PCT unity standard is applicable in 109 countries including the U.S. for cases filed via the PCT route and in most of those countries regardless of by what route they are filed. The U.S. applies one standard if a case is first filed nationally and a different standard if by the international PCT route giving us two standards to confuse our inventors. We agreed in the trilateral context to bring our standard in line with that of Europe and Japan (which essentially is the PCT standard) and then failed to follow through. It is time to put this international embarrassment behind us and accept the de facto World wide PCT standard whether or not we do it as part of a harmonization effort.

6.) Utility

The utility vs industrial applicability debate is similar to the claim based technical fields issue and consistently we should urge the broader treatment, i e our current law.

7.) Global Priority Date

If we are ever to have a break through in having patent offices work cooperatively in an efficient manner we need a global standard of priority so that a prior art reference means the same thing to different people. It is difficult to imagine how this can be done other than by giving a patent its full prior art effect from its first international filing date. This may not be in the perceived interest of the small inventor to give up the home advantage of *In re Hilmer*, but the issue commented on in the next paragraph may be considered a partial offset at least for small inventors who sell outside our national boundaries.

8.) Prior Art Effect

I would not think the U.S. would be willing to accept Europe's novelty only test as applied to earlier filed applications. This practice breeds secondary patents which differ in only trivial ways from an earlier one. Thus one marketing a product in a country having such system may have to contend with multiple patents in the hands of different owners which are virtually identical yet insulated from one another.

9.) Grace Period

A grace period is a desirable feature of a patent system particularly for independent or first time inventors who may have publicly disclosed an invention before they understand the significance of such a disclosure. It is because much of the international community lacks this provision that they have resorted to the novelty only test mentioned above. The much sounder direction is the U.S. pattern in this connection of having a grace period and U.S.C. 102(e) applied in both a novelty and unobviousness context.

10.) Prior Art Geographical Restrictions

While some prior art in the U.S. has geographical restrictions, much of it does not. There is really no way to have an internationally coherent system if different countries impose different restrictions which have effect only within their own national boundaries. This provision in our law may have made sense in our early history, but in the era of global communications, commerce, Internet communications, etc it makes much less sense. Often when one detects prior art outside the country which is restricted, it will merely mark the beginning of an exhaustive and expensive investigation to determine if the same disclosure was transmitted into the country or converted to published format where it does qualify. First time inventors probably benefit from the geographical restrictions in our law in so far as obtaining a patent is concerned, but suffer when marketing a product and facing the patents of others.

11.) Loss of Rights

There should be a global standard controlling loss of rights, however, an international system would still be workable if the U.S. deviated with respect to secret commercial use. This could probably be determined based on our own perceived national interest.

12.) Combining References

References should be combinable under certain circumstances of the type indicated. It needs to be borne in mind that a great body of inventions are of the combination variety consisting of entirely old elements combined in a new combination or a new way or interaction to achieve a new result. Combining references should not negate such a combination invention unless the combining is suggested in one of the references or the public literature. Artificial limitations on combining references should not be imposed such as the European novelty only practice which permits only one reference and is simply blind to the fact that deviations may be notoriously old.

13.) Obviousness

The U.S. originated obviousness test is still the best test known to man. The international trend is to recognize that fact and many countries have evolved in this direction. The problem - solution test is of Germanic origin and is overly technical to deal with many classes of inventions.

14.) Multiple Dependent Claims

This is a procedural rather than substantive issue. A World standard should be agreed upon to facilitate foreign filing. However, the inventors have less at stake with respect to this issue than do the examining offices.

15.) Claim Interpretation

It would be a great contribution to develop World standards for claim interpretation. It is likely that even if standards were set forth, national courts would still interpret them to satisfy their individual sense of justice. For example, even though we have a peripheral claim interpretation system that periphery is violated by the Doctrine of Equivalents. It is unlikely we could accept a standard that would exclude the Doctrine. There is room for great progress in this area,

both internationally and nationally. We need certainty in claim interpretation so that those seeking to market products can know where they stand. On the other hand rigid claim interpretation tends to breed our prolix claiming system which imposes a heavy cost on the system. This item could probably be the subject of an international treaty by itself and should probably have jurists involved in the process.

16.) Doctrine of Equivalents

A theory of this type is needed in a rigid peripheral claiming such as ours. However, it needs to be reigned in so that it is not asserted in every litigation in an attempt to recapture ground given up in the examination process.

17.) Filing by Inventors

Naming of the inventors is a traditional part of our system and I favor its retention. However, I see nothing wrong in permitting filing in the name of the assignee and catching up with the inventors names later in the patenting process.

Please forward copies of the WIPO Treaty draft text to the address as follows:

William S Thompson
20817 Santorini Way
North Fort Myers, FL 33917
(prior to May 5th)

7274 Aarwood Trail N W
Rapid City, MI 49676
(May 5th to Sept 25th)

Respectfully submitted


William S Thompson