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VIA FACSIMILE AND FIRST CLASS MAIL

United States Patent and Trademark Office
Box 4
Washington, DC 20231

Attn: Mr. Jon P. Santamauro

Re: Docket No. 010307056-1056-01

Dear Mr. Santamauro:

The questions asked are almost impossible to answer in the framework of the your sole objective - harmonization.

The easiest answer, obviously, is the total elimination of the patent system (except of course there would be the Constitutional issue, but that doesn't seem to bother anyone). On the other extreme is absolute harmonization so that our system is denigrated to harmonizing with patent systems that never protected a significant invention. We will then revert six hundred years to the middle ages and a system of trade secrets, which in today's climate may be best anyway. But then, I guess an effort will be started harmonize trade secret laws.

An alternative is to offer maximum protection to large multinational corporations to help build monopolies. Of course, another alternative objective could be to encourage disclosure and advancement of the useful arts and sciences as provided in the Constitution, but that, of course, flies in the face of harmonization. So, if maintaining the provisions the U.S Constitution is a primary objective (as it should be), then harmonization is likely impossible and is not even an objective. For many companies and countries, obtaining free licenses to someone

else's technology is a principal objective. In short, the issues raised are nonsensical. The objectives of harmonization and the provisions of the U.S. Constitution are largely mutually exclusive.

You commented about harmonization being a reason to be to reduce the cost. The U.S. already has some of the lowest taxes (fees) on inventors. Harmonization would mean raising our inventor tax while benefiting other countries so that fees would be harmonized. It would help the international corporation to the disadvantage of the American independent inventor that does not have millions of dollars to waste paying invention taxes.

At some point, the PTO and Congress should recognize that the inventor is the reason for the party. Without the inventor, there simply is no party. The beneficiary of the patent system is not the inventor taxpayer, but commerce and the public. Taxing the inventor is fundamentally wrong. Making it impossible for the inventor to protect his invention (for such a lame reason as "harmonization") kills the guest of honor. There will be no party, but you won't know it for a decade or two)

On another point, you should start working with the Federal Circuit. They are trashing and confusing any and all laws and precedent, while you people in the PTO sit and just collect inventor taxes. You should be an advocate for consistent patent policy, as opposed to special decisions that are regularly defeating good patents. The PTO has become emasculated. It took a great deal of pushing to get the PTO to go to the Supreme Court on Zurko, and then the PTO effectively let the matter die by letting the CAFC sidetrack the decision.

Lastly, if any patent laws are to be written, they should be written with a modicum of specificity so that two people can agree on what the laws mean. Until you can write meaningful and clear laws, and can convince the Federal Circuit to adhere to the patent laws, any revision of the Laws just confuses everyone, makes the laws meaningless, and makes litigation increasingly expensive and meaningless.

Harmonization means averaging the best patent system with the worst. The average patent system, therefore, would become mediocre, along with every other country.

Now on to your specific questions.

1. The first to invent is the only way, if the purpose of the patent system is to advance technology. An inventor often does not know what he/she has invented until substantial work, often over several years, has been expended. Now, if your purpose is to assist major corporations, then by all means switch to the first to file. A major corporation can get wind of what someone else is trying to get working, and quickly file an application while the poor inventor is working out the final details. That is what is done internationally, but then they don't develop much technology. If you want to stop technological development in the United States **dead**, go for first to file. It has done that elsewhere, and it can do it here.

2. Again, the question of "useful arts" or "technical contribution" depends on the objective. Certainly a "windsurfer" adds no technical contribution to sailing. In-line skates don't add a significant contribution technically. I'm not even certain that the concept of air brakes is a technical contribution since the concept was well known technically that if a brake pad is held back by air pressure, and then if the air pressure were released, the pad would fall on the wheel and act as a brake (Westinghouse). You need to decide whether these inventions deserved the benefit of a patent. Maybe they didn't.

   You need to also determine whether the PTO, or the courts, are sufficiently clairvoyant to know what is "technical". As an engineer, lawyer, patentee and small businessman, I don't know. I don't know for sure whether an observation that the earth circling around a sun, rather than the other way around is just an observation or a technical contribution. Lawyers would be able to argue either way, particularly after the observation had become common knowledge.

3. What is the objective? It would be a lot easier if we could just disclose trash, the worst mode – just sufficient to cover claims. That way we could leave out necessary details for the commercial exploitation of the invention. Obfuscate and confuse. That would promote trade secrets. We could, with one great leap, go back 600 years to the middle ages.

4. The problem with "technical fields" again relates to the issue of clairvoyance. In your wisdom, do you know what years in advance the technical fields pioneering inventions relate to? What technical field would a laser have been in? Measurement?

Cutting? Medical? Retail? Scanning? What technical field would Velcro be in? Could you determine the answer in advance so as to avoid taking away the inventor's rights. What about an invention that has no current technical field (For a frame of reference, look at the USOC codes and see how obsolete they are today).

5. A unity of invention concept, if I understand it correctly, will significantly help infringers, and so might be good. By defeating one claim, the entire patent could be defeated.

6. Although there is a utility portion of the patent code, it is seldom argued in court or before the PTO. The problem with "utility" is that at the time of an invention, no one knows whether there is utility. If you required utility, then you must give the inventor an unlimited time to develop the invention. Industrial applicability is a super standard for petty inventions that do not substantially add to the technical body.

   What is often not commonly understood, is that a technological invention which the inventor thinks is good as a bra cup, has no utility for that purpose, but winds up being outstanding for a breathing mask. A lousy batch of glue on a piece of paper has no technical benefit for its original purpose. It just happens that its subsequently discovered utility as a note on a document is very useful. If you think the 3M masks and Postits should not be patentable, then you should go the harmonization route. It depends on your objective. I think these ideas, if effected, will kill the U.S. technological edge – twenty years from now.

7. The filing date is the relevant date. End of discussion. That is when the patent was fully disclosed.

8. This is a very complex subject, and without any discussion as to what the objective is, whether it is to take away inventor rights, to complicate the entire patent process, to increase litigation costs, or to increase uncertainty of the patent process, any discussion is absurd and appropriate for fools only.

9. The grace period is specifically beneficial to the independent inventor and the small business. If the purpose is to defeat those two major sources of invention to benefit the international corporation and large business, take the grace period away.

Harmonization is a super objective justifying the destruction of the U.S. Patent system.

10. No comment

11. The objective is the key here. If the objective is to promote trade secrets as was common in the middle ages, then there is no reason to require the statutory bar. The patent system was designed then to advance commerce by encouraging inventors to make trade secrets public by granting protectin in return. That was part of the deal. Is it to be part of the deal any more? Or is the PTO and Congress assuming that inventors are irrational?

    An inventor or his corporation will keep everything secret (not even publishing in a patent application), until it see someone else publishes the technology, comes out with a competitive product or receives a patent. Then the inventor's corporation will call the patent lawyer and have him/her work over the weekend to draft a patent application. Why not? This helps the struggling patent law profession. Furthermore, by not letting the PTO in on what industry is doing (as was done with the software patents), the PTO will save library fees for storing all the technical information. Because the PTO will not have the expertise in its technical reference library, patents will be easier to obtain, and litigation will be more common, further assisting the struggling legal community and burdening the already understaffed judiciary.

12. I have no opinion, except that anything that makes a patent more certain, so that funds can be obtained to develop the idea with a degree of confidence that if it works, a patent will provide a degree of protection, is mandatory if the patent system is to work. A working patent system, however, appears not to be an objective.

13. See item 2. Obviousness is a real problem in the US patent system, since neither the judges nor the jury understand the concept and the CAFC doesn't review obviousness findings. It is the subjective way to defeat a patent without any substantive support other than hindsight. Virtually every infringement defendant argues obviousness because it is so vague. If there is no substantive defense, the battle is based on the verbal battles of two lawyers, neither of which may understand the technology

involved, arguing before a judge and jury that doesn't have a clue about what was available at the time of the invention.

14. The current situation with dependent claims becomes quite complicated. The jury and the judge must understand the meaning of the claims. Anything that further complicates their task must be discouraged.

15. This whole area has been so mucked up by the CAFC (as in Festo) that no one today knows the scope of a patent claim. The idea of a patent is so that someone can take a patent and have a reasonable idea of what the patent claim covers without spending several hundred thousand dollars for research and legal services. A claim should be viewed broadly as possible, since it should be assumed that the patentee has more technical expertise than legal or wordsmithing expertise. Furthermore, hopefully some people looking at this issue will recognize that the English language is ambiguous, and not particularly precise, even when exercised by the greatest of wordsmiths.

16. Equivalents are absolutely necessary for an effective patent system. You can not expect an inventor, his attorney, or anyone to be so clairvoyant as to know what the disclosure of the technology will lead to. For those that don't understand this concept, consider the accuracy of forecasts of the weathermen or economists, who have expertise in forecasting, and forecast for only short periods.

17. The patent must be applied for in the name of an inventor, not a corporation or a "standee". The inventor is the person who created the idea, not the assignee. The inventor should get the credit. The patent system was designed to benefit the inventor. By taxing the inventor, the government has become the beneficiary of the inventor's work product. If the assignee becomes the filing party, the inventor even loses the remaining somewhat dubious honor of being the publicly named inventor. We then are in a system where GM would have 10,000 patents covering inventions made by nameless and unrewarded employees. This is going the wrong way. Why would anyone bother to invent under these conditions other than to have a piece of wallpaper to satisfy an ego.

IN SUMMARY

The PTO should spend a modicum of its effort to determine what the objectives are. What you are doing is equivalent to going on a trip, the objective of which is to take a vacation as everyone else does, without knowing where you are going, what you want to do, how long you will be gone or how much you want to spend. The fundamentals are necessary. Some of us still believe in the U.S. Constitution, but apparently that is not longer a reputable or recognized authority.

Although this is not the time or the forum to make this absurd request, it might be appropriate before discussing harmonization, to discuss what could be done to make the U.S. Patent system more certain, more easily understood, make patents more defendable, and thereby give some utility to the PTO's work product other than being a major provider of wallpaper.

Sincerely,

THEIS RESEARCH, Inc.

Peter F. Theis
President