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June 7, 2007

The Honorable Jon Dudas  
Under Secretary of Commerce for Intellectual Property  
and Director of the U.S. Patent and Trademark Office  
600 Dulany Street  
Madison West Bldg, Suite No. 10D44  
Alexandria, VA 22314

Dear Mr. Secretary:

The Intellectual Property Law Section of the American Bar Association is pleased to provide the following information in response to the Request for Comments on International Efforts to Harmonize Substantive Requirements of Patent Laws as published in the Federal Register, Vol. 72, No. 85, May 3, 2007. The views expressed herein are being presented on behalf of the Section of Intellectual Property Law. This letter has not been approved by the House of Delegates or Board of Governors of the American Bar Association, and, according, should not be construed as representing the position of the Association. However, as noted, some of the views described in this letter have been approved by the House of Delegates or Board of Governors of the American Bar Association.

The Intellectual Property Law Section of the ABA is the world's largest organization of intellectual property professionals, with approximately 19,000 members including lawyers, associates, and law students. In recognition of the importance of patent law, the ABA established the Section in 1894 as the first ABA section to deal with a special branch of the law. The Section has contributed significantly to the development of the American system for the protection of intellectual property rights. The Section is composed of lawyers of diverse backgrounds who represent patent owners, accused infringers, individual inventors, large and small corporations, universities and research institutions, all across a wide range of technologies and industries.

The Section is pleased with the progress that appears to be taking place on harmonization efforts both within the World Intellectual Property Office ("WIPO") and during meetings of the "Group B+" countries. Our Section has always favored harmonization of patent laws as a means for reducing costs of patent systems around the world, obtaining more uniform treatment of patent applications and patent grants,

eliminating redundancy, and providing more efficiencies in patent systems. In that regard, over the past number of years, our Section, and in some cases the House of Delegates of the ABA, have passed numerous resolutions in an effort to promote harmonization of patent laws. Some of these resolutions are in the nature of “best practices,” areas in which we believe United States Patent Law should change regardless of harmonization efforts, and other resolutions have been passed in the context of harmonization efforts.

Based upon those resolutions, we provide you the following comments on each of the areas requested in the Federal Register notice.

### 1. Priority of Invention

The Section is pleased to report that the American Bar Association, favors enactment of legislation providing that the right to a patent shall belong to the first inventor to file. This resolution has been passed by the ABA House of Delegates in 2005 as follows:

RESOLVED, that the Association supports enactment of legislation providing that the right to a patent shall belong to the inventor who first files an application for patent containing an adequate disclosure under 35 U.S.C. § 112 of the inventor or, in the event of an assignment of rights, shall belong to the assignee thereof.

This resolution has been passed in the nature of “best practices” where our Section, and the ABA, believes that our U.S. law should be changed even independent of harmonization activities.

### 2. Prior Art Effective Date of Published US Patent Applications

The Section favors, as part of a first-inventor-to-file system, defining prior art according to “best practices,” which would provide for the elimination of the *In Re Hilmar* doctrine relating to 35 U.S.C. 102(e) by considering earlier filed, subsequently published prior art effective as of their filing date or where priority is claimed as of its priority date.

Additionally, the Section favors eliminating the English language requirement currently in 35 U.S.C. § 102(e) relating to published international applications for patent that qualify as prior art as of their respective filing dates.

### 3. Scope of Prior Art Effect of Published Patent Applications

The Section favors as part of a first-inventor-to-file system defining prior art according to “best practices,” which would provide a definition of prior art which is to be used for both novelty and non-obviousness determinations that would include the description in an issued patent or in an application for patent published as provided in 35 U.S.C. § 122

or 35 U.S.C. § 374, in which the application or the patent names another inventor and was effectively filed before the effective filing date of the claimed invention.

However, the Section favors that subject matter that would otherwise qualify as prior art only because of the filing of a published patent application or patent shall not be prior art to a claimed invention if the subject matter and the claimed invention were, not later than the effective filing date of the claimed invention, owned by the same person or subject to an obligation of assignment to the same person. Thus, no self-collision.

Similarly, the Section favors that subject matter that would otherwise qualify as prior art only because of the filing of a published patent application or patent shall not be prior art for purposes of determining novelty and non-obviousness of a claimed invention if the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention or if such subject matter was developed and such claimed invention was made as a result of activities undertaken within the scope of the joint invention agreement and the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

#### 4. Grace Period

The Section favors, as part of a first-inventor-to-file system, defining prior art according to “best practices” to provide inventors a 1-year grace period in which to file an application for patent against disclosures made by the inventor or a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

However, the Section favors that during the 1-year grace period after an inventor’s direct or indirect public disclosure of the invention, any intervening public disclosures made by and or intervening applications for patents filed by others, including disclosures or filing based upon derivation from the inventor are excluded as prior art.

Effectively, the Section favors what is commonly referred to as a “first to publish system,” i.e. if two independent inventors file, the one who filed first may be trumped if the other inventor disclosed first. The one who disclosed first may still be able to obtain a valid patent. Likewise, if both inventors publish, the first to publish may be able to obtain a valid patent but not the second. The idea is that an independent inventor cannot see another inventor’s publication and try to prevent the disclosing inventor from taking advantage of a one-year grace period either by, during the one-year grace period of the publication, publishing independently to create published prior art, or filing a patent on the invention (notwithstanding the application would not be validly patentable in view of the prior disclosure) to create a first-filer bar to the disclosing inventor taking advantage of the one-year grace period.

The Section also favors that the grace period be essentially continued procedurally as it currently exists, which would mean maintaining the period of 12 months as the time for the grace period and not having any requirement for any declarations of intent to invoke the grace period.

Additionally, the Section supports that in the context of ratification of an international harmonization treaty involving at least Japan and major European countries that is based on a first-inventor-to-file system, and includes an international type grace period eliminating from prior art disclosures made by an inventor or by others who obtained the subject matter, disclosed either directly or indirectly from the inventor during the 12 months preceding the filing date, that there be limitations on the application of the grace period and specifically that such grace period should not apply to a publication resulting from the 18 month publication after filing of an application for a patent by an inventor or on his behalf.

#### 5. Geographical Limitations in Definition of Prior Art

The Section favors as part of a first-inventor-to-file system, defining prior art according to “best practices,” wherein the geographic restrictions on prior art currently in 35 U.S.C. §102(a) and (b) that require proof of knowledge or use in the United States be eliminated.

#### 6. ‘Loss of Right’ Provisions

The Section favors as part of a first-inventor-to-file system, defining prior art according to “best practices,” wherein “loss of right” provisions would be eliminated. Specifically, the Section favors eliminating patent law provisions relating to:

- (1) abandonment as set forth in 35 U.S.C. §102(c) as a basis for a loss of right to patent;
- (2) premature foreign patenting as set forth in 35 U.S.C. §102(d) as an element of prior art or a basis for a loss of right to patent;
- (3) an inventor’s forfeiture of his or her right to patent an invention once placed “in public use or on sale” as set forth in 35 U.S.C. §102(b), by providing that no such loss of right to patent an invention can arise unless the invention had become reasonably and effectively accessible to persons of ordinary skill in the art more than one year before the inventor sought a patent for the invention;
- (4) prior art as set forth in 35 U.S.C. §102(f), under which non-public knowledge of the inventor, not otherwise qualifying as prior art, can render an invention made by such inventor obvious, by:

(A) repealing section 102(f) and

(B) codifying elsewhere in title 35, United States Code, that the right to seek and obtain a patent is solely the right of the individual or individuals who made the invention for which a patent is sought (or, where applicable, the assignee of such inventor);

(5) the provisions currently in 35 U.S.C. §102(g) providing that “secret prior art” (and/or loss of right to patent) can exist as from the date an invention of another inventor was made.

#### 7. ‘Experimental Use’ Exception to Prior Art

The Section favors as part of a first-inventor-to-file system, defining prior art according to “best practices” whereby subject matter would be regarded as publicly known for the purposes qualifying as prior art only when it becomes reasonably and effectively accessible, either through its use or through its disclosure by other means where;

(A) reasonable accessibility requires that the subject matter can be accessed by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts; and

(B) effective accessibility requires that its content can be comprehended by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts.

Accordingly, the experimental use exception should not be a limitation on prior art.

#### 8. Prior User Rights

The Section favors as part of a first-inventor-to-file system, as “best practices,” amending our existing statutory prior user rights to include all categories of patented subject matter, and would support a system that would permit commercial use (including substantial preparations for commercial use) of a patented invention to be recognized as a personal defense to patent infringement, if undertaken in good faith by a person who has reduced the invention to practice prior to the effective filing date of the patent.

The Section favors such prior user rights provided that as a minimum:

1. such rights shall be in the nature of a personal defense against a claim based on any patent alleged to cover an activity of the prior user;

2. the prior user activity began prior to the earliest filing date to which the patent is entitled and, at the time of said earliest filing date such activity had not been abandoned;

3. the prior user activity was not based on information obtained or derived from the patentee or those in privity with the patentee;

4. the prior user activity took place within the United States;

5. prior to said earliest filing date the prior user had demonstrated operability of the invention covered by the patent and had taken significant steps toward its commercialization; and

6. such rights shall be available only to the party performing the activity on which the defense is based and to those in privity with such party; and shall be nonassignable and nontransferable except with a transfer of that part of the business of the party to which the activity pertains.

#### 9. Assignee Filing

The Section favors permitting the owner of an invention, whether or not the owner is the inventor, to file a patent application covering that invention, provided that the inventors are named in the application.

Specifically, the Section favors revision of our patent laws to provide that any person to whom an inventor has assigned or agreed, in writing, to assign an invention, may make application for patent on behalf of and as agent for the inventor, and that the Commissioner may grant a patent to such person upon such notice to the inventor as the Commissioner deems sufficient.

#### 10. 18 Month Publication of Patent Applications

The Section favors publication of all patent applications 18 months after filing.

Specifically, the Section supports the elimination of special exceptions to and redactions from published United States patent applications as currently permitted under the American Inventors Protection Act.

#### 11. Other Comments

In addition to the issues raised in the Federal Register Notice, it is believed that at least the issue of ‘best mode’ requirement should also be addressed as this is continuously present in harmonization issue discussions.

In that regard, the Section favors as part of a first-inventor-to-file system, repeal of the requirement that the ‘best mode’ of practicing the claimed invention be disclosed in a patent application.

## CONCLUSION

Our Section continues to support legislation modifying our existing patent laws to conform to those items indicated as 'best practices' for United States law. In addition, it also continues to encourage ongoing harmonization efforts in order to obtain those 'best practices' in an international context. To that extent, our Section is available for any further discussions in order to expedite the possibility of a harmonized system of patent laws.

Sincerely,



Susan Barbieri Montgomery  
Chair  
Section of Intellectual Property Law  
American Bar Association