IDEA: The Journal of Law & Technology
1994

Fourth Biennial Patent System Major Problems Conference Saturday, May 22, 1993

Transcript

"CLOSING"

MR. BENSON: I thank all of you. I think that it's too bad Alan Lourie left, as I sat here and listened and I thought if I had asked the same question ten years ago, almost everyone of you would have said that the lack of predictability of what the courts of appeals are going to do in a patent case and there's no uniformity in decisions so you can't make any judgments on the law and only one of you even hinted that that was still a problem. So I think at least in one area, with the Court of Appeals for the Federal Circuit, we have made some progress and brought some uniformity to the law. Okay, we still have a few minutes. Is there any other subject that you'd like to toss out for the group to talk about? Hal?

MR. WEGNER: Just one thing of a structural nature. I think that Franklin Pierce is really to be congratulated for having this kind of forum and I'm excited about your new facilities and I hope that you will be able to increase the frequency of doing things, that we'll be able to bring in several schools together to have combined force in things and it's a tremendous structural vehicle that you have at Franklin Pierce and I can tell you that the national trend in law schools is where do we find students and to have the courage and money to build as you're doing is really remarkable and I want to congratulate you on that.

MR. BENSON: Thank you. We were baiting you a little bit, you see. One of the things that we discussed at our advisory committee is whether this particular program, which is held every other year, should be held every year if there is sufficient interest, so that's one of the reasons I went around the table to find out if there was interest. Anybody else? Heinz?

MR. BARDEHLE: Heinz Bardehle. Thank you Bob. Bill Thompson gave me the incentive to raise one point here again. I think our international patent system is running in a way with features with which no company could really survive. First, the multiplication of the same work, that has already been said. One patent office does the

same that the other one has already done. Second, the obligation to use a greater number of languages. We are used to it and we are obliged to do that. Nor can we avoid that and this refers to that what Bill Pravel has said, the enormous expenses in foreign filing, for all of us, not only for the Americans. First, would you be prepared in the near future to accept the grant of a patent in the European Patent Office or even of the Japanese Patent Office as a granted patent in this country, with possibly the condition that each granted patent coming from an examining patent office from abroad, would go through a possible, opposition for clarification, whether that's really a valid patent for that country or not. Would you accept that? And this is an open question that's now more and more debated also in Europe because we think that our patent offices cannot cope with their work. Wouldn't it be better to accept reasonable examination from other patent offices? Would we and you be prepared to accept that? Second point, the language problem. Of course, it's easier for me than you to propose English as the only language which is used throughout the world. If an English speaking country submits that question, it looks very selfish, of course. This has to come from other sources. But I believe you can very much contribute to that. An example: we expect that in Europe we will have within our community soon possibly the Turks, the Hungarians, the Czechs, and possibly also the Finns, all speaking very complicated languages which are only spoken in their particular country. Would it be acceptable as the community patent stands now that all these languages would be obligatory for getting a community patent? That would, of course, kill the community patent from the very beginning and shows the nonsense in that system. What can we do in order to at least within the transition period convince all members of the major member states of the Paris Convention to accept patent applications first at least in one language and that is, of course, English. I believe that your Patent Office can also contribute something within the trilateral corporation because as far as I know within that trilateral corporation the working language is, of course, not Japanese but English, so this is a fact. Of course, I am not so fluent as you, in your mother tongue, but nevertheless we can learn that and many people learn that. I would like to give you another example. I represent a Swiss company and that Swiss company has introduced the obligation that every paper which has to be established, a report or whatever it may be, has to be written in English. This happens in the German speaking part of Switzerland. They use for their written internal documentation English because they know that goes abroad. So this is already a contribution, an acknowledgement of that need. What can we do to promote for foreign filings at least as a first step the use of one language, that's English. It may be that in an immediate stage, translation would have to follow to some extent. If you don't do the first step, you can never do the second step to use English also in prosecution. That is not new. We spoke about that, Bill, you remember in China when the new Patent Office building was inaugurated. We have to make an effort from all sides to use at least for foreign filings one language and that's English. Now, what can we do? I cannot give you a solution, but again just put it on the table and hope that it will find very much support. Thank you.

MR. BENSON: I'll answer your second question and let somebody else answer your first one. As far as using English as the universal language, we accept. Now, the first question, is anybody willing to accept the results of the European patent examination and

automatically make it a U.S. patent without any further examination in the U.S.? You stirred them up, see. Bill first.

MR. THOMPSON: Yes, as matter of fact I made a proposal like that once that we each recognize in the trilateral region each others patent as a provisional right; that is, without examination except all of them being subject whatever our safety net is on re-examination or opposition or that sort of thing. One of the points that I made in this connection is that for the most part we recognize patents in this area without real scrutiny anyway; that is, if somebody has a patent that gives us a problem and it gives us a problem in Europe and gives us a problem in the United States or Japan, wherever it gives us a problem, we come to terms with that collection of patents. We end up in negotiation, throwing in all the counterparts anyway, without independent scrutiny at that point in time. So we really recognize one hardcore right that somebody presents to us. When they find that we're at the end of their muzzle on that one and have to do something, why, of course, then we want a complete solution worldwide and we do it without secondary scrutiny.

MR. BENSON: I'm going to tell you a story and I don't know whether Heinz is bating me or not. He's probably the only guy in the room who's older than I am, but in 1967 I was invited to a meeting at the Commerce Department and Ed Brenner was then the Commissioner of Patents and Jerry O'Brien ... Assistant Commissioner of Patents .... And they invited a lot of corporate patent counsel to a meeting in Washington. They proposed a new worldwide patent system having only two or three offices in the world, that would examine patent applications. Upon completion of the examination the applicant would receive a Certificate of Patentability to any of the other countries that he had designated and give it to them with the appropriate translations and that country would issue a patent. That proposal went over like a lead balloon, but out of it came the Patent Cooperation Treaty and the European Patent Office.

MS. SHAPER: I might have a concern about giving the presumption of validity to a Japanese ... to every Japanese patent.

MR. BENSON: But would you do it ... if you had the opportunity to ... re- examine the patent in the PTO on the basis of new prior art?

MS. SHAPER: You're saying utilize the patent office re-examination process ...

MR. BENSON: Yeah, for those patents that rise to that level of importance, yeah.

MS. SHAPER: I think you might well do that, that's right, and is that cost- effective in the long run?

MR. BENSON: Probably very cost-effective.

MR. WEGNER: There are a lot of modifications that have to be made in principle, we can agree. Some of the modifications would be an examiner exchange where you'd have twenty or thirty examiners exchanged back and forth. You would absolutely need a tough opposition system that would have no presumption of validity at the end of the proceedings and a few other changes.

MR. BENSON: You really have to have better access to prior art.

MR. WEGNER: Well, you need a nine-month opposition system in the first instance so you have time to evaluate, you have time to weed out. After all, if you have too many oppositions, you've defeated the whole purpose of it.

MR. BENSON: Yeah, and you know I'm opposed to oppositions. I think we're better off to ... wait until the ... patent becomes important.

MR. WEGNER: We'll call it re-examination, but I've got a whole chapter in my book on it and I'm getting good response for this parallel proposal.

MR. BENSON: I really appreciate all of you coming.

"ADJOURNMENT"

(4:45 P.M.)