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*INTERNATIONAL CENTER FOR TECHNOLOGY ASSESSMENT*  
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*WASHINGTON DC 20003*

JANUARY 12, 2001

Hon. Q. Todd Dickinson  
Director/Commissioner of the United States Patent and Trademark Office  
Washington DC 20231

Attn: Elizabeth Shaw

Re: ICTA Comments on Preliminary Draft Convention on Jurisdiction and Foreign Judgements in Civil and Commercial Matters, Request for Comments first posted in Federal Register 17 October 2000 (Volume 65, Number 201, Page 61306).

Dear Honorable Mr. Dickinson:

The International Center for Technology Assessment (ICTA) wishes to thank the USPTO for providing the public with an extended opportunity to comments upon the Preliminary Draft Convention on Jurisdiction and Foreign Judgements in Civil and Commercial Matters (hereafter the 'draft Hague Convention'). ICTA is a non-profit, 501(C) 3 public interest organization based in Washington DC, committed to providing the public with full analyses of technological impacts on society, and to assisting policy-makers in understanding how technology affects society.

The overarching view of the ICTA is that the draft Hague Convention is a dangerous and unnecessary instrument for American citizens to adhere to, and it is our hope that the United States does not become a signatory to any such broad Convention on Jurisdiction and Foreign Judgements. The implications of this draft Hague Convention upon fundamental civil rights heretofore enjoyed by all Americans, are serious and dangerous, especially with regards to how foreign libel and slander laws can circumscribe the rights of free speech and expression protected by the First Amendment to the Constitution. We do not wish to even imagine how, for example, a published letter to the editor of a US newspaper which has an online/internet edition (e.g., the Post) could conceivably form the basis of a libel or slander judgement handed down in some foreign country lacking in the protections of the 1<sup>st</sup> amendment.

With regards to the specific issue of intellectual property (IP), it is further the view of the ICTA that judgements relating to IP rights be excluded from the draft Hague Convention. In this regard we join the AIPLA and other organizations in opposing the inclusion of IP rights from the convention. Our specific reasons for this opposition, and answer to certain questions posed by the USPTO, are outlined below.

Question: Are uniform rules for international enforcement of judgements desirable?

Answer: Absolutely not. In the realm of IP rights, the development of US law has been guided by public policy considerations from the very outset. For instance, it is unquestionable that section 112 of the US Patent Code (Title 35) is the embodiment of the quid-pro-quo whereby the American public ideally receives an enabling disclosure, and in return grants the limited monopoly right of a patent. It can never be ensured that a grant of patent coverage given in some foreign country can ever duplicate the delicate public policy considerations enshrined in US patent legal traditions. Another exemplar of this is the first-to-file consideration in the US. It is no accident that US law contains this provision; it is simple equity that the first to invent should be the one rewarded. Uniform rules for international enforcement of IP judgements pre-supposes uniformity in IP law itself, something which in and of itself is also very undesirable.

What effect, if any, could this Convention have on other international intellectual property obligations, including, but not limited to, TRIPs?

The TRIPs agreement itself, although deeply flawed and still subject to substantive review, provides for certain exclusions from the scope of what is considered "patent-eligible" subject matter. Article 27.3(b) of the TRIPs allows for sovereign nation states signatory to that agreement, to exclude from patentability plants and animals per se and what are called "essentially nonbiological" methods of producing plants and animals. However, the patent offices of some countries have to their discredit not excluded these from patent-eligible subject matter, and it would be an impediment to the just development of those sovereign nations that did so make an exclusion, to be subjected to a long-arm-type of jurisdiction of present US patent policy. Such patents on plants and animals should not be imposed upon the whole world.

In an analogous way, the relatively thorough examination system of the US, which excludes any obvious subject matter from patent protection, should not be subverted by jurisdiction exercised by the courts of nations which effectively have only a patent registration system (from the standpoint of comparison with the US).

Suffice it to say that there are tremendously compelling reasons to exclude all IP rights from any sort of draft Hague Convention on Jurisdiction in Private International Law. More importantly, there should not even be such trans-national jurisdiction. The US State Department should be advised by the USPTO to halt its implementation of any sort of draft Hague Convention on Jurisdiction in Private International Law.

Thank you for your attention.

Sincerely yours,

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