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DRAFT SUBSTANTIVE PATENT LAW TREATY

prepared by the International Bureau

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INTRODUCTION

1. The present document contains a revised version of the draft Substantive Patent Law Treaty (SPLT). It takes into account the views expressed in the Standing Committee on the Law of Patents at its ninth session which was held from May 12 to 16, 2003.

2. As regards Articles 1 to 10, differences between the former text of the draft SPLT contained in document SCP/9/2 and the revised text contained in the present document, except where an existing provision or paragraph as a whole has been moved from another provision or paragraph, have been highlighted as follows:

(i) words which did not appear in document SCP/9/2 but appear in the present text are underlined, and

(ii) words which appeared in document SCP/9/2 but which are omitted from the present document are shown as struck through.

3. Concerning Articles 11 to 16, since no discussion was held on these provisions at the ninth session of the SCP, the text of the draft SPLT contained in document SCP/9/2 is kept unchanged, except for some consequential changes and corrections of obvious and typographic errors, which are highlighted in grey.

4. As agreed by the SCP at its ninth session, provisions which the Committee has considered provisionally accepted are indicated within a frame. Such provisions are closed for further discussion, except at the express request of a Member of the Committee or to approve consequential modifications when redrafting other provisions.

5. It should be noted that certain of the suggested provisions (for example, draft Article 8(2)) reflect a first-to-file system. This approach does, however, neither prejudice the future drafting of the SPLT, nor the discussion by the Committee on the inclusion of additional issues into the Treaty.

6. Draft Regulations under the draft SPLT are contained in document SCP/10/3. Draft Practice Guidelines under the draft SPLT are contained in document SCP/10/4. In addition, document SCP/9/5 contains a study regarding the “industrial applicability” and the “utility” requirements.

Article 1

Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:

(i) “Office” means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty;

(ii) “application” means ~~an~~ national, regional and international application for the grant of a patent, ~~as referred to in Article 3; and, where it the term “application” refers to an application which serves as a basis for claiming priority, that term shall mean an application for any title protecting an invention that may give rise to the right of priority under the applicable law;~~

[COMMENT: Where the term “application” refers to an application on which the right of priority is based, such as the “earliest application” in Article 1(ix) and the “previous application” in Article 8(2)(a)(ii), that term shall be construed as referring to an application for a patent, utility model, industrial design or any other title that may give rise to the right of priority under the applicable law. Alternatively, the second part of this item could be transferred to the relevant provisions relating to applications on which a right of priority is based, e.g., Articles 1(ix) and 8(2)(a)(ii).]

(iii) “international application” means an application filed under the Patent Cooperation Treaty;

(iv) “parent application” means an application from which a divisional, continuation or continuation-in-part application is derived in accordance with the applicable law;

(v) “patent” ~~means a patent as referred to in Article 3~~ means a patent for invention and patent of addition, within the meaning of those terms under the Patent Cooperation

Treaty;

[COMMENT: The expression “patent for invention and patent of addition” is to be construed in the same sense as in PCT Article 2(ii). Therefore, it does not include, for example, inventors’ certificates, utility certificates, utility models, certificates of addition, inventors’ certificates of addition and utility certificates of addition. In the previous draft, such a clarification was made in the Practice Guidelines.]

(vi) “claimed invention” means the subject matter of a claim for which protection is sought; where ~~multiple priorities or partial priority are claimed in accordance with the applicable law~~ a claim defines its subject matter in the alternative, each alternative of the claimed invention in respect of which such multiple priorities or partial priority are claimed shall be considered to be a separate claimed invention;

[COMMENT: The second part of this item deals with the issue of alternatives in one claim. Item (ix) deals with the definition of the critical date for the determination of patentability of the claimed invention (“priority date of the claimed invention”) and with the issue of claiming multiple priorities and partial priority. The word “separate” does not seem to have any material effect.]

(vii) “applicant” means the person whom the records of the Office show, pursuant to the applicable law, as the person who is applying for the patent, or as another person who is filing or prosecuting the application;

[Article 1, continued]

(viii) “patentee” means the person whom the records of the Office show as the owner of the patent;

[*COMMENT: In view of the obviousness of items (vii) and (viii), the SCP may wish to consider their deletion.*]

(ix) “priority date of a claimed invention” in an application means, subject to item (x),

~~(a) where priority is claimed in accordance with the applicable law, the filing date of the earliest application whose priority is claimed in accordance with the applicable law and which discloses the claimed invention or, if none of the applications whose priority is claimed discloses the claimed invention, the filing date of the application concerned;~~

~~(b) where no priority is claimed in accordance with the applicable law, and, otherwise, the filing date of the application.~~

[*COMMENT: See the comment under Article 1(vi). The provision covers different cases: firstly, the case where a claimed invention, as defined in Article 1(vi), was disclosed in a previous application whose priority is claimed in accordance with the applicable law. Secondly, the provision covers all the other situations, such as where no priority is claimed or where a priority is claimed but the claimed invention was not disclosed in the previous application[s] whose priority is [priorities are] claimed, e.g., in the case of partial priority. The expression “claimed in accordance with the applicable law” does not mean that an Office would be obliged to check the priority in each and every case (although it would be free to do so in appropriate cases), since many Offices do not perform such an examination, but leave this assessment to court (or other post-grant) procedures. The word “discloses” neither implies an enabling disclosure of the claimed invention in the previous application nor suggests the publication of the previous application.*]

(x) ~~W~~where the benefit of the filing date of the parent application is preserved for the claimed invention in accordance with the applicable law, “priority date of a claimed invention” in a divisional, continuation or continuation-in-part application ~~shall be~~means the date that would have been the priority date of the claimed invention in the parent application;

[COMMENT: In accordance with the phrase “where the benefit of ... with the applicable law” the conditions regarding the preservation of the filing date of the parent application are left to the applicable law. Therefore, where there is a chain of applications with respect to a divisional, continuation or continuation-in-part application, and thus there are more than one “parent” applications, if the applicable law so permits, the applicant may claim the benefit of the priority date of the claimed invention disclosed in one of the parent applications, which may not necessarily be the first parent application in the chain.]

(xi) words in the singular include the plural, and *vice versa*, and masculine personal pronouns include the feminine, except where the context indicates otherwise;

(xii) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;

(xiii) “Patent Law Treaty” means the Patent Law Treaty, signed on June 2, 2000, together with the Regulations under that Treaty, as revised and amended;

(xiv) “Patent Cooperation Treaty” means the Patent Cooperation Treaty, signed on June 19, 1970, together with the Regulations and the Administrative Instructions under that Treaty, as revised, amended and modified;

[Article 1, continued]

(xv) “Contracting Party” means any State or intergovernmental organization that is party to this Treaty;

(xvi) “applicable law” means, where the Contracting Party is a State, the law of that State and, where the Contracting Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;

(xvii) “instrument of ratification” shall be construed as including instruments of acceptance or approval;

(xviii) “Organization” means the World Intellectual Property Organization;

(xix) “International Bureau” means the International Bureau of the Organization;

(xx) “Director General” means the Director General of the Organization.

General Principles and Exceptions

(1) [*Requirements Relating to Infringement*] Subject to Articles 9(54) and 11(4), nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to apply any requirements in relation to infringement.

(2) [*Security Exception*] Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to take any action it deems necessary for the preservation of essential security interests.

[(2) [*Exceptions*] Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to take any action it deems necessary for the preservation of essential security interests or to comply with international obligations, including those relating to the protection of genetic resources, biological diversities, traditional knowledge and the environment.]¹

[(3) [*Public Interest Exceptions*] Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to protect public health, nutrition and the environment or to take any action it deems necessary to promote the public interest in sectors of vital importance to its socio-economic, scientific and technological development.]¹

¹ The SCP agreed at its eighth session to include this paragraph in square brackets, but to postpone substantive discussions on this provision.

Article 3

Applications and Patents to Which of the Treaty Applies

(1) [*Principle*] Subject to paragraph (2), a Contracting Party shall apply the provisions of this Treaty and the Regulations:

(i) to national applications ~~for patents for invention and for patents of addition~~ which are filed with or for the Office of that Contracting Party;

(ii) to regional applications ~~for patents for invention and for patents of addition~~ which are filed with or for the Office of the regional patent organization which is that Contracting Party;

(iii) to international applications, ~~for patents for invention and for patents of addition, under the Patent Cooperation Treaty~~, the processing or examination of which has started before the Office of that Contracting Party in its capacity as a designated Office under that Treaty;

(iv) to patents ~~for invention and to patents of addition~~ which have been granted with effect for that Contracting Party.

[*COMMENT: Although paragraph (1) was previously accepted by the SCP at its ninth session, it is not placed in a frame due to the changes suggested following the amendment of Article 1(ii) and (v).*]

(2) [*Exceptions*] This Treaty and the Regulations shall not apply to the applications and patents that are prescribed in the Regulations.

Article 4

Right to ~~a~~~~the~~ Patent

(1) [*Principle*] The right to ~~a~~~~the~~ patent shall belong:

(i) to the inventor; or

(ii) to the successor in title of the inventor.

(2) [*Employee's Inventions and Commissioned Inventions*] Notwithstanding paragraph (1), any Contracting Party shall be free to determine the circumstances under which and the extent to which the right to ~~the~~ patent shall belong to the employer of the inventor or to the person who commissioned the work of ~~the inventor~~ which resulted in the invention.

~~(3) [*Inventions Made Jointly by Several Inventors*] Where a claimed invention was made jointly by several inventors, each inventor shall have an equal and undivided right to the patent under paragraph (1), except where otherwise agreed by each of the inventors among themselves.~~

(43) [*Inventions Made Independently by More Than One Inventor*]

[Reserved]

[*COMMENT: This paragraph is currently reserved since it relates to the first-to-file/first-to-invent issue.*]

Article 5

Application

~~(1) — [Parts of Application] (a) An application shall contain the following parts:~~

~~(i) — a request;~~

~~(ii) — a description;~~

~~(iii) — one or more claims;~~

~~(iv) — one or more drawings, [where they are necessary for the understanding of the claimed invention][where they are referred to in the description or claims]; and~~

~~(iv) — an abstract.~~

[COMMENT: This paragraph would appear to be superfluous in view of former paragraph (2) (current paragraph (1)), and thus its deletion is proposed. Firstly, current paragraph (1) incorporates by reference any requirements under the PCT relating to the request, description, claims, drawings and abstract of an application except where otherwise provided for by the SPLT or the PLT, including the corresponding provision under the PCT (PCT Article 3(2)). Secondly, current paragraph (1) clearly applies, and is limited, to the requirements in respect of the request, description, claims, drawings or abstract of an application.]

Accordingly, nothing in this Treaty prevents a Contracting Party from requiring that the applicant submit other information that does not form part of the request, description, claims, drawings and abstract, such as information concerning the duty of disclosure, the applicant's corresponding foreign applications and grants, indications as to whether an application was

prepared with the assistance of an invention marketing company or requirements relating to foreign investments, public concessions or public contracts under the national law. It is to be noted that requirements to submit such information are not requirements as to the “form or contents of an application” for the purposes of PLT Article 6(1) (see paragraph 6.03 of the Explanatory Notes on the PLT). Further, a Contracting Party may require other formalities, such as the payment of fees or a power of attorney, which are not relevant to the SPLT but are regulated under the PLT.]

[~~(2)~~] *[Requirements Concerning Parts of Application]* (a) Except where otherwise provided for by this Treaty and the Regulations or the Patent Law Treaty, no Contracting Party shall require compliance with any requirement relating to the request, description, claims, drawings or abstract of an application different from or additional to the requirements relating to the request, description, claims, drawings or abstract which are provided for under the Patent Cooperation Treaty in respect of international applications.

(b) A Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants and patentees, are more favorable than the requirements referred to in subparagraph (a) in so far as they relate to the form or contents of an application.]

[COMMENT (1): As regards the interface between the SPLT, the PLT and the PCT, see document SCP/6/5. In essence, subparagraph (a) provides that: (i) formality requirements concerning a complete application (PLT Article 6(1)) and the requirements for the contents and presentation of the request part of the application (PLT Article 6(2)) are governed by the PLT, incorporating by reference the relevant requirements of the PCT, with some modification; (ii) formality requirements strongly linked to the substance concerning, for example, the contents and presentation of the claims, description, drawings and abstract, for the purposes of search, examination and grant, are governed by the SPLT, incorporating by reference the relevant requirements of the PCT, with some modifications; (iii) substantive requirements are governed by express provisions in the SPLT. It should be noted that this paragraph covers the “requirements relating to the request, description, claims, drawings or abstract” but not the requirements relating to other parts of the application.]

[COMMENT (2): Subparagraph (b) is included in order to align the text with Article 2(1) of the PLT.]

[Article 5, continued]

(32) [Abstract] ~~{Subject to Article 7(5),}~~ The abstract referred to in paragraph (1)(v) shall merely serve the purpose of information and shall not be taken into account for the purpose of interpreting the scope of the protection sought or of determining the sufficiency of the disclosure and the patentability of the claimed invention.

[COMMENT: WIPO Standard, ST.12 provides the Guidelines for the preparation of abstracts, including a check list and sample abstracts.]

Article 6²

Unity of Invention

The claims in the application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept[, as prescribed in the Regulations]³.

² The text of this Article is subject to the outcome of the Working Group on Multiple Invention Disclosures and Complex Applications. The SCP agreed at its ninth session that the discussion concerning unity of invention should be postponed.

³ The expressions “as prescribed in the Regulations” and “in accordance with the Regulations” appear 15 times throughout the draft Treaty. The SCP is invited to consider the possible deletion of those expressions, since the administrative and final provisions of the Treaty would provide a general reference to the Regulations, which could specify that they will contain details relevant for the implementation of the Articles (see for a similar provision PCT Article 58). In view of this discussion, the mentioned references in the SPLT are presented in square brackets.

Article 7

Observations, Amendments or Corrections of Application

(1) [*Opportunity to Make Observations, Amendments or Corrections in Case of Intended Rejection or Refusal*] (a) Wherever the Office intends to reject or refuse an application on the grounds that the application does not comply with any requirement under Article 13(1)⁴, it shall give the applicant at least one opportunity to make observations on the intended rejection or refusal, and to make amendments and corrections of the application[, ~~within the time limit as~~ prescribed in the Regulations].

[*COMMENT: The words “amendments and corrections” are clarified in the Practice Guidelines. It is intended that the expression “amendments and corrections” encompass both substantive changes and non-substantive changes, for example typographic errors and clear mistakes, made in the application. Since the terms “amendments” and “corrections” are always used together in this Treaty, it may not be necessary to make a clear distinction between them. Rather, the Practice Guidelines could clarify the general concepts covered by the words “amendments and corrections”.*]

~~(b) No Contracting Party shall be obliged to apply subparagraph (a), where the intended rejection or refusal of a divisional, continuation or continuation-in-part application is based on the non-compliance with any requirement under Article 13(1)³ in respect of which the opportunity provided for in that subparagraph was already given in relation to the same error or defect contained in the parent application.~~

[*COMMENT: The substance of this provision is moved to Rule 7(2).*]

⁴ See the footnote under Article 13.

(2) [*Amendments or Corrections on Applicant's Initiative*] The applicant shall have the right to make, on his own initiative, ~~to amend~~ and correct in the description, the claims, the abstract and any drawings ~~or to comply with a requirement under Article 13(1)³[, as prescribed in the Regulations].~~ at least up to the time when the application is in order for grant; however, any Contracting Party which provides for substantive examination by its Office or through another Office may provide that, except for the correction of a clear mistake under paragraph (3), the applicant shall have the right to amend or correct, on his own initiative, the description, the claims, the abstract and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

[*COMMENT: Details concerning amendments and corrections in the description, the claims, the abstract and any drawings on the applicant's initiative are dealt with in Rule 7(3).*]

(3) [*Limitation of Amendments or Corrections*] [Subject to paragraph (4).] ~~No~~ amendment or correction of the description, the claims[, the abstract] and any drawings, ~~other than the correction of a clear mistake as prescribed in the Regulations,~~ may be permitted, where the amendment or correction would result in the disclosure contained in the amended or corrected application going beyond the disclosure:

(i) contained in the description, the claims and any drawings on the filing date,

or;

[Article 7(3), continued]

(ii) included in the application in accordance with the Patent Law Treaty, in by way of filing, after the filing date, a missing part of the description or a missing drawing in accordance with the Patent Law Treaty.

[COMMENT: The words “the abstract” are included in square brackets in the second line, since, on the one hand, in light of ensuring a high quality of the abstract, it could be argued that no new matter should be added in the abstract. On the other hand, since the abstract merely serves information purposes, it could be claimed that the abstract might not need to be governed by the rule prohibiting the inclusion of new matter.]

(4) ~~[Abstracts Prepared by the Office] A Contracting Party may provide that, where the Office is responsible for the preparation of the final contents of the published abstract, paragraph (2) shall not apply to amendments or corrections of the abstract.~~

[COMMENT: The substance of this paragraph is moved to Rule 7(3)(b).]

~~[(54) [Abstracts Prepared Submitted by the Applicant] In determining whether an amendment or correction referred to in paragraph (3) is permissible, A Contracting Party [may][shall] provide that, where the applicant is responsible for the preparation of the abstract, amendments or corrections referred to in paragraph (3) shall be allowed taking account of the disclosure in the abstract submitted by the applicant on the filing date shall form part of the disclosure referred to in paragraph (3)(i).]~~

[COMMENT (1): Although the contents of the abstract on the filing date may be transferred to, for example, the claims by virtue of amendments or corrections, the status of the abstract as such is to serve information purposes only.]

[COMMENT (2): If the word “shall” is accepted, the entire provision could be replaced by the inclusion of the words “the abstract” after the words “the claims” in paragraph (3)(i).]

Article 7bis

Amendments or Corrections of Patents

(1) [*Limitation of Extent of Protection*] At the request of the patentee, the ~~Office~~ competent authority shall make, under the conditions provided under the applicable law, amendments or corrections in the patent in order to limit the extent of the protection conferred by it.

[COMMENT: The revised text establishes the right of the patentee to request the limitation of the patent before the competent authority, which could be the Office, a court or any authority provided by the applicable law. The competent authority shall provide a possibility for such an amendment or correction of patents before that authority; such a procedure would facilitate the resolution of disputes over potential infringement and revocation of patents. In view of the various post-grant systems under existing national/regional laws, however, further details concerning the conditions and time limits that apply to such amendments or corrections are left to the applicable law.]

(2) [*Amendments or Corrections Affecting the Disclosure*] No amendment or correction in a patent may be permitted under paragraph (1) where the amendment or correction would result in the disclosure contained in the amended or corrected patent going beyond the disclosure:

(i) contained in the description, the claims and any drawings on the filing date,

or

(ii) included in the application, ~~in accordance with the Patent Law Treaty, in by way of filing, after the filing date,~~ a missing part of the description or a missing drawing in accordance with the Patent Law Treaty.

[COMMENT: The changes are proposed in order to ensure that the text is in line with the wording of Article 7(3).]

[Article 7bis, continued]

(3) [*Clear Mistakes*] The ~~Office~~competent authority shall, at the request of the patentee, correct, in the patent, clear mistakes [as prescribed in the Regulations].

[*COMMENT: Rule 7(4) shall apply mutatis mutandis to clear mistakes in the patent.*]

Article 8

Prior Art

(1) [*Definition*] ~~Subject to Article 9, †~~The prior art with respect to a claimed invention shall consist of all information which has been made available to the public anywhere in the world in any form[, as prescribed in the Regulations,] before the priority date of the claimed invention.

[*COMMENT: Issues relating to a loss of right provision in the context of prior secret commercial use is dealt with in Article 13(1). The words “Subject to Article 9” are not necessary, since Article 9 does not affect the definition of the prior art as such.*]

(2) [*Prior Art Effect of ~~Earlier~~Certain Applications*] (a) The following subject matter in another application (“the other application”) ~~whole contents of an earlier application~~ shall also form part of the prior art for the purpose of determining the novelty of a claimed invention, provided that the other application or the patent granted thereon is made available to the public subsequently by the Office[, as prescribed in the Regulations]:

(i) ~~disclosed in another application filed with effect in the same Contracting Party,~~ if the filing date of the ~~earlier~~other application is prior to the priority date of the claimed invention, ~~provided that the earlier application or the patent granted thereon is published subsequently by the competent authority, as prescribed in the Regulations.~~the whole contents of the other application;

[Article 8(2)(a), continued]

(~~bi~~) ~~If the filing date of an earlier~~ the other application has a filing date that
~~filed with effect in a Contracting Party~~ is the same as, or later than, the priority date of ~~the~~
~~particular~~ claimed invention disclosed in another application filed with effect in the same
~~Contracting Party, but the earlier application claims, in accordance with the applicable law,~~
the priority of a previous application having a filing date that is earlier than the priority date of
the claimed invention, subject matter that is contained in both ~~that earlier~~ the other application
and ~~the~~ that previous application ~~shall form part of the prior art for the purpose of determining~~
~~the novelty of the claimed invention, provided that the earlier application or the patent granted~~
~~thereon is published subsequently by the competent authority, as prescribed in the~~
Regulations.

[COMMENT: A Contracting Party would be free to choose the means to make the other application (or the patent granted thereon) available to the public, for example, the Office may publish the application (or the patent) in the Gazette, or the application (or the patent) may be made available via public inspection at the Office.]

(~~b~~) For the purpose of this provision, “~~earlier~~ the other application” means:

[Alternative A]

(i) where the Contracting Party is a State, an application ~~pursuant~~ referred to
in Article 3(1)(i) to and (iii) filed with effect in that Contracting Party or, if that Contracting
Party is a member of a regional patent organization, a regional application filed with or for the
Office of that regional patent organization through which patent protection in the said
Contracting Party is sought;

[Article 8(2)(b), continued]

(ii) where the Contracting Party is a regional patent organization, an application ~~pursuant~~referred to in Article 3(1)(ii) ~~and (iii) that has been filed with or for the Office of that regional patent organization, or an application pursuant to Article 3(1)(iii) for the grant of a regional patent by that regional patent organization.~~

[End of Alternative A]

[Alternative B]

(i) where the Contracting Party is a State, an application ~~pursuant~~referred to in Article 3(1)(i) and (ii) ~~filed with or for that Contracting Party, or an international application, for a patent for invention or for a patent of addition, under the Patent Cooperation Treaty, which designates the said Contracting Party;~~

(ii) where the Contracting Party is a regional patent organization, an application ~~pursuant~~referred to in Article 3(1)(ii) ~~that has been filed with or for the Office of that regional patent organization, or an international application, for a patent for invention or for a patent of addition, under the Patent Cooperation Treaty, which designates the said Contracting Party.~~

[End of Alternative B]

[COMMENT: According to Alternative A, earlier international applications under the PCT have prior art effect under Article 8(2) only where those international applications enter into the national phase of the Contracting Party concerned. Alternative B provides that earlier international applications under the PCT which designate the Contracting Party concerned are part of prior art under Article 8(2). The draft is simplified, since, in Article 3(1), the relevant applications already expressly relate to the Contracting Party concerned.]

Article 9

Information Not Affecting Patentability (Grace Period)

(1) [*General Principle*] ~~Information which otherwise would affect the patentability of a claimed invention~~ An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as ~~the information was made available to the public anywhere in the world in any form during, or that item was~~ included in the prior art ~~under Article 8(2)~~ on a date during, the [12][six] months preceding the priority date of the claimed invention,

(i) by the inventor,

(ii) by an Office and the ~~information~~ item of prior art was contained

(a) in another application filed by the inventor [and should not have been made available to the public by the Office], or

(b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor,

or

(iii) by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor.

[Article 9(1), continued]

[COMMENT (1): Subparagraph (a) concerns an item of prior art under Article 8(1) and (2) which otherwise would affect the patentability of the claimed invention. Item (i) covers information publicly disclosed by the inventor and earlier applications under Article 8(2) filed by the inventor. Item (ii)(a) relates to the public disclosure of information which was contained in the inventor's previous application [that should not have been published]. Item (ii)(b) deals with the public disclosure of information contained in an application filed by an unauthorized third party. Item (iii) concerns information publicly disclosed by a third party which obtained that information directly or indirectly from the inventor. It also covers earlier applications under Article 8(2), filed by a third party which obtained the information contained in the earlier application directly or indirectly from the inventor.]

[COMMENT (2): Alternative texts with a different scope are presented within square brackets. One possibility would be a grace period with a broad scope: 12 months from the priority date of the claimed invention and applicability to any previous application which was filed by the inventor and which was disclosed during the grace period by the Office. This means that the patentability of a claimed invention, which is an obvious modification of an invention disclosed in an earlier application filed by the inventor, would not be affected by the publication of the earlier application up to 18 (assuming that the earlier application is published after 18 months from its priority date) plus 12[6] months from the priority date of the earlier application. Another possibility would be, as regards the disclosure of information in another application filed by the inventor, to limit the applicability of the grace period provisions to those applications which should not have been disclosed by the Office. If this possibility is provided in connection with Rule 9(3), i.e., it is intended to cover the cases where an earlier application by the same applicant or inventor, which should not be a part of the prior art under Rule 9(3), was erroneously published by the Office before the priority date of the subsequent application, the wording of item (ii)(a) should be in line with Rule 9(3). One other possibility would be to limit the period to 6 months.]

(2) [~~No Time Limit for Invoking Grace Period~~]

[Alternative A]

The effects of paragraph (1) may be invoked at any time.

[End of Alternative A]

[COMMENT: The SCP may wish to consider the need for this provision, since the effect of the grace period (certain information which otherwise would form part of the prior art shall not affect the patentability) is present as long as the conditions under paragraph (1) are met.]

[Article 9(2), continued]

[Alternative B]

A Contracting Party may require that the applicant submit a declaration invoking the effect of paragraph (1) [as prescribed in the Regulations].

[End of Alternative B]

[COMMENT: The SCP may consider, for example, whether and why a declaration invoking the effect of the grace period is necessary, for example, on, or within a certain period from, the filing date. If such a declaration is for third parties to be informed that a certain disclosure does not affect the patentability of the claimed invention, the said declaration may not necessarily need to be submitted on the filing date. Further, as regards the public disclosure by the inventor before the priority date, even without such a declaration, third parties would know that the said public disclosure does not affect the patentability of the claimed invention once the application is published. Concerning the public disclosure by the Office or a third party under paragraph (1)(a)(ii) and (iii), if an applicant is aware of such a disclosure, it is generally in the interest of the applicant to inform the Office that the said disclosure does not affect the patentability of his invention even if there was no requirement concerning a declaration.]

~~(3) [Evidence] [Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving, or of making the conclusion likely, that the conditions of that paragraph are fulfilled.] [A Contracting Party may require that evidence be filed with the Office by the party invoking the effects of paragraph (1), where that Office reasonably doubts the applicability of that paragraph.]~~

[COMMENT: This paragraph may not be necessary, since Article 16(1) applies if the Office reasonably doubts the applicability of the grace period.]

~~(4) [“Inventor”] For the purposes of paragraph (1), “inventor” also means any person who, at or before the filing date of the application, had the right to the patent.~~

(54) [Third Party Rights]

[Alternative A]

A person who in good faith had, between the date on which the ~~information was made available to the public~~ item of prior art was included in the prior art under paragraph (1) and the ~~claim~~ priority date of the claimed invention, used the claimed invention for the purpose of his business or started effective and serious preparations for such use shall have the right to start or continue to use the invention for that purpose. The claimed invention shall be considered to be used where the person performed any acts that would otherwise constitute an infringement under the applicable law.

[COMMENT: Although this provision relates to the rights conferred by patents and the infringement of such rights, in accordance with the interventions of a number of delegations at the seventh session, it is kept in the draft SPLT. The changes are suggested in order to clarify the link between the “information” and the “claimed invention”. A person “in good faith” includes a third party who obtained the information directly or indirectly from the inventor, for example, the audience of a conference. It should be noted that, between the date on which the item of prior art was included in the prior art and the priority date of the claimed invention, third parties have no clue about whether a patent application relating to that information had already been filed before the date of public disclosure or whether it would be filed after the disclosure by way of invoking the effect of the grace period. Therefore, the matters underlying this provision seem to address general issues concerning what kind of rights should be accorded to a third party using the invention prior to the priority date of the claimed invention.]

[End of Alternative A]

[Article 9(4), continued]

[Alternative B]

No provision in the Treaty and the Regulations.

The Practice Guidelines would clarify that the issues concerning third party rights remain a matter for the applicable law of the Contracting Party concerned.

[COMMENT: PLT Articles 12 and 13 take this approach in relation to intervening rights.]

[End of Alternative B]

Article 10

Enabling Disclosure

(1) [*General Principle*] The application shall disclose the claimed invention in a manner sufficiently clear and complete for ~~the~~that invention to be carried out by a person skilled in the art. The disclosure of the claimed invention shall be considered sufficiently clear and complete if it provides information which is sufficient to allow ~~the~~that invention to be made and used by a person skilled in the art ~~as of~~on the filing date, without undue experimentation [as prescribed in the Regulations].

(2) [*Parts of Application to be Taken Into Account for Assessing Disclosure*] For the purposes of assessing sufficiency of disclosure under paragraph (1), the disclosure ~~on the~~
~~filing date~~ contained in the description, claims and drawings, as amended and corrected ~~under~~
~~the applicable law~~, shall be taken into account.

[*COMMENT: Amendments and corrections of applications are regulated in Article 7. In particular, Article 7(3) provides that the application should not be amended or corrected in a way that would add new matter to the disclosure contained in the description, claims and drawings on the filing date.*]

Article 11

Claims

(1) [*Contents of the Claims*] The claims shall define the subject matter for which protection is sought in terms of the [technical]⁵ features of the invention.

[*COMMENT: The added words have been moved from former draft Rule 5(2).*]

(2) [*Style of the Claims*] The claims, both individually and in their totality, shall be clear and concise[, as prescribed in the Regulations].

(3) [*Relationship of Claims to the Disclosure*] The claimed invention shall be fully supported by the disclosure of the [claims], description and drawings[, as prescribed in the Regulations].

[*COMMENT(1): According to Rule 4(1)(iii), the claimed invention shall be described in the description. In other words, if the subject matter of the claims is neither stated nor implied in the description, it does not comply with Rule 4(1)(iii) (which could be viewed as encompassing lack of support in the description). It should be noted that non-compliance with the requirements under Rule 4 is a ground for refusal, but not a ground for revocation (see Article 14(1)). On the other hand, Article 11(3) and Rule 12(2) deal with the issue of whether, on the filing date, the applicant recognized his invention over the whole scope of the claims. See also document SCP/7/6 (Requirements Concerning the Relationship of the Claims to the Disclosure).*]

[*COMMENT (2): Following the discussion at the eighth session of the SCP, the word “claims” is added, in square brackets, for further consideration by the Committee. The insertion of the word “claims” would mean that the basis of the subject matter of every claim may not always be found in the description and that the scope of the claims may be broader than that of the description. Further, since many offices that do not examine novelty and inventive step examine the disclosure requirement and the requirements concerning claims, subject matter which is disclosed only in the claims could be included in the description through an amendment. On the other hand, it should be noted that, according to draft*

⁵ At its ninth session, the SCP agreed that the use of the term “[technical]” throughout the Treaty and the Regulations should best be addressed in connection with the discussion of draft Article 12(1), following which consequential changes might be considered throughout the Treaty and the Regulations.

Article 10, the “application” (not the “description”) shall disclose the claimed invention in an enabling manner. If the word “claims” was deleted and draft Rule 12(2) maintained, a patented claim may be revoked on the sole grounds that the teaching in the description and the drawings is not extended to the entire scope of that claim (even if the teaching in the description, drawings and other claims shows that the applicant does not claim subject matter which he had not recognized and described on the filing date).]

(4) [Interpretation of Claims] (a) The scope of the claims shall be determined by their wording. ~~Where the wording of the claims is not immediately [clear][evident],~~ ~~the~~ description and the drawings, as amended or corrected under the applicable law, and the general knowledge of a person skilled in the art on the filing date shall[, in accordance with the Regulations,] be taken into account for the interpretation of the claims.

(b) For the purpose of determining the scope of protection conferred by the patent, due account shall be taken[, in accordance with the Regulations,] of elements which are equivalent to the elements expressed in the claims.

Article 12

Conditions of Patentability

(1) [*Subject Matter Eligible for Protection*]⁶ (a) A claimed invention shall fall within the scope of subject matter eligible for protection. Subject matter eligible for protection shall include products and processes [, in all fields of technology,] which can be made and used in any field of activity.

(b) Notwithstanding subparagraph (a), the following shall not be considered as subject matter eligible for protection:

- (i) mere discoveries;
- (ii) abstract ideas as such;
- (iii) scientific and mathematical theories and laws of nature as such;
- (iv) purely aesthetic creations.

(2) [*Novelty*] A claimed invention shall be novel. It shall be considered novel if it does not form part of the prior art[, as prescribed in the Regulations].

⁶ The SCP agreed at its eighth session to postpone the discussion on paragraph (1).

(3) [*Inventive Step/Non-Obviousness*] A claimed invention shall involve an inventive step. It shall be considered to involve an inventive step (be non-obvious) if, having regard to the differences and similarities between the claimed invention and the prior art as defined in Article 8(1), the claimed invention as a whole would not have been obvious to a person skilled in the art at the ~~claim date~~ priority date of the claimed invention], as prescribed in the Regulations].

(4) [*Industrial Applicability/Utility*] A claimed invention shall be industrially applicable (useful). It shall be considered industrially applicable (useful) if it

[Alternative A]

can be made or used for exploitation in any field of [commercial] [economic] activity.

[Alternative B]

can be made or used in any kind of industry. “Industry” shall be understood in its broadest sense, ~~and shall not be limited to industry and commerce proper, but include agricultural and extractive industries as in the Paris Convention.~~

[Alternative C]

has a specific, substantial and credible utility.

[Article 12(4), continued]

[COMMENT: Alternative A intends to provide a single definition accommodating both “industrial applicability” and “utility”, although a Contracting Party may use either term under the applicable law. Alternative B is modeled after Article 33(4) of the PCT. Reference is made to document SCP/9/5.]

(5) *[Exceptions]* Notwithstanding paragraphs (1) to (4), a Contracting Party may[, in accordance with the Regulations,] exclude certain inventions from patentability.⁷

⁷ The SCP agreed at its eighth session to postpone the discussion on paragraph (5).

Article 13⁸

Grounds for Refusal of a Claimed Invention

(1) [*Grounds for Refusal of a Claimed Invention*] An application shall be refused where the Office finds that such application or a claimed invention in the application does not meet any of the following requirements:

- (i) the applicant does not have the right to the patent referred to in Article 4;
- (ii) the claimed invention does not meet the requirements of Articles 6, 11(2) and (3) and 12;
- (iii) the application does not meet the requirements of the Patent Law Treaty, as implemented in the applicable law, and of Articles 5 and 10; or
- (iv) an amendment or correction results in a disclosure as prohibited by Article 7(3)(a).

⁸ The SCP agreed at its sixth session to postpone the discussion on this Article until a consensus regarding the substance of the provisions referred to in this Article is reached. ~~See also paragraph 4 of the Introduction and document SCP/8/5.~~

[Article 13, continued]

[(2) *Other Grounds for Refusal of a Claimed Invention*] The Office may refuse an application where it finds that a claimed invention in the application, which was not available to the public on the priority date of that claimed invention, was on sale in the Contracting Party more than one year prior to the filing date of that application.]

[COMMENT: *Following the discussion at the ninth session of the SCP, subparagraph (b) is included in order to accommodate the refusal of an application on the grounds of secret commercial use of the claimed invention.*]

(23) *Prohibition of Other Requirements*] No Contracting Party may require compliance with any requirement relating to the examination of an application or the grant of a patent on a claimed invention different from or additional to the requirements provided for in paragraph (1).

[(4) *Compliance With Applicable Law on Other Matters*] A Contracting Party may also require compliance with the applicable law on public health, nutrition, ethics in scientific research, environment, access to genetic resources, protection of traditional knowledge and other areas of public interest in sectors of vital importance for their social, economic and technological development.]⁹

⁹ The SCP agreed at its eighth session to include this paragraph in square brackets, but to postpone substantive discussion on this provision.

Article 14¹⁰

Grounds for Invalidation or Revocation of a Claim or a Patent

(1) [*Grounds for Invalidation or Revocation of a Claim or a Patent*] Subject to the Patent Law Treaty, non-compliance with any of the requirements referred to in Article 13(1), except those referred to in Article 6 and the Regulations under Article 5(21)(a), shall be a ground for the invalidation or revocation of the patented claim or patent.

(2) [*Prohibition of Other Requirements*] No Contracting Party may require compliance with any requirement with respect to the grounds for invalidation or revocation of the patented claim or patent additional to or different from those provided for in paragraph (1).

[(3) [*Compliance With Applicable Law on Other Matters*] A Contracting Party may also require compliance with the applicable law on public health, nutrition, ethics in scientific research, environment, access to genetic resources, protection of traditional knowledge and other areas of public interest in sectors of vital importance for their social, economic and technological development.]¹¹

¹⁰ The SCP agreed at its sixth session to postpone the discussion on this Article until a consensus regarding the substance of the provisions referred to in this Article is reached. ~~See also paragraph 4 of the Introduction and document SCP/8/5.~~

¹¹ The SCP agreed at its eighth session to include this paragraph in square brackets, but to postpone substantive discussion on this provision.

Article 15

Review

The rejection or refusal of an application by the examining authority on the grounds referred to in Article 13(1)¹² shall be subject to review by a judicial or quasi-judicial authority.

¹² See the footnote regarding Article 13.

Article 16

Evidence

(1) [*Request for Submission of Evidence by the Office*] Where an Office reasonably doubts the ~~veracity-accuracy~~ of an alleged fact ~~relating to-relevant in~~ the determination of patentability, it may request the submission of evidence in order to establish the ~~veracity~~ accuracy of that fact.

(2) [*Right of Applicants and Patentees to Submit Evidence*] A Contracting Party shall provide for the right of applicants and patentees to submit evidence with its Office in order to establish the ~~veracity-accuracy~~ of an alleged fact ~~relating to-relevant in~~ the determination of patentability.

[End of document]