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## **STANDING COMMITTEE ON THE LAW OF PATENTS**

**Tenth Session**  
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DRAFT SUBSTANTIVE PATENT LAW TREATY  
[CLEAN TEXT]

*prepared by the International Bureau*

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## INTRODUCTION

The present document is a clean version of the draft Substantive Patent Law Treaty (SPLT) as contained in document SCP/10/2. All underlinings, strike-throughs and comments have been removed from the text in order to facilitate the reading of the text.

*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 a national, regional and international application for the grant of a patent, and, where it refers to an application which serves as a basis for claiming priority, that term shall mean an application for any title that may give rise to the right of priority under the applicable law;

(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 for invention and patent of addition, within the meaning of those terms under the Patent Cooperation Treaty;

(vi) “claimed invention” means the subject matter of a claim for which protection is sought; where a claim defines its subject matter in the alternative, each alternative shall be considered to be a claimed invention;

(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;

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

(ix) “priority date of a claimed invention” in an application means, subject to item (x), the filing date of the earliest application whose priority is claimed in accordance with the applicable law and which discloses the claimed invention and, otherwise, the filing date of the application.

(x) 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 means the date that would have been the priority date of the claimed invention in the parent application;

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

[Article 1, continued]

(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;

(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.

*Article 2*

*General Principles and Exceptions*

(1) [*Requirements Relating to Infringement*] Subject to Articles 9(4) 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.]<sup>1</sup>

[(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.]<sup>1</sup>

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



*Article 3*

*Application of the Treaty*

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

(i) to national applications which are filed with or for the Office of that Contracting Party;

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

(iii) to international applications, 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 which have been granted with effect for that Contracting Party.

(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 Patent*

(1) [*Principle*] The right to a 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 a patent shall belong to the employer of the inventor or to the person who commissioned the work which resulted in the invention.

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

[Reserved]

*Article 5*

*Application*

[(1) [*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.]

(2) [*Abstract*] The abstract 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.

*Article 6<sup>2</sup>*

*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]<sup>3</sup>.

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<sup>2</sup> The SCP agreed at its ninth session that the discussion concerning unity of invention should be postponed.

<sup>3</sup> 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*] 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)<sup>4</sup>, 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[, as prescribed in the Regulations].

(2) [*Amendments or Corrections on Applicant's Initiative*] The applicant shall have the right to make, on his own initiative, amendments and corrections in the description, the claims, the abstract and any drawings [, as prescribed in the Regulations].

(3) [*Limitation of Amendments or Corrections*] [Subject to paragraph (4),] no amendment or correction of the description, the claims[, the abstract] and any drawings 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

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<sup>4</sup> See the footnote under Article 13.

[Article 7(3), continued]

(ii) included in the application 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.

[(4) [*Abstracts 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 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).]

*Article 7bis*

*Amendments or Corrections of Patents*

(1) [*Limitation of Extent of Protection*] At the request of the patentee, the 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.

(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 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.

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

*Article 8*

*Prior Art*

(1) [*Definition*] 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.

(2) [*Prior Art Effect of Certain Applications*] (a) The following subject matter in another application (“the other 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) if the filing date of the other application is prior to the priority date of the claimed invention, the whole contents of the other application;

(ii) if the other application has a filing date that is the same as, or later than, the priority date of the claimed invention, but 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 the other application and that previous application.

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



[Alternative A]

(i) where the Contracting Party is a State, an application referred to in Article 3(1)(i) and (iii) 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;

(ii) where the Contracting Party is a regional patent organization, an application referred to in Article 3(1)(ii) and (iii).

[End of Alternative A]

[Alternative B]

(i) where the Contracting Party is a State, an application referred to in Article 3(1)(i) and (ii), or an international application which designates the said Contracting Party;

(ii) where the Contracting Party is a regional patent organization, an application referred to in Article 3(1)(ii) or an international application which designates the said Contracting Party.

[End of Alternative B]

*Article 9*

*Information Not Affecting Patentability (Grace Period)*

(1) [*General Principle*] An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as that item was included in the prior art 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 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.

(2) [*Invoking Grace Period*]

[Alternative A]

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

[End of Alternative A]

[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]

(3) [*“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.

[Article 9(4), continued]

(4) [*Third Party Rights*]

[Alternative A]

A person who in good faith had, between the date on which the item of prior art was included in the prior art under paragraph (1) and the 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.

[End of Alternative A]

[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.

[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 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 that invention to be made and used by a person skilled in the art 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 contained in the description, claims and drawings, as amended and corrected, shall be taken into account.

*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]<sup>5</sup> features of the invention.

(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].

(4) [*Interpretation of Claims*] (a) The scope of the claims shall be determined by their wording. 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.

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<sup>5</sup> 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 12*

*Conditions of Patentability*

(1) [*Subject Matter Eligible for Protection*]<sup>6</sup> (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].

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

[Article 12, continued]

(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 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, as in the Paris  
Convention.

[Alternative C]

has a specific, substantial  
and credible utility.

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

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



*Article 13<sup>8</sup>*

*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).

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<sup>8</sup> 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.

[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.]

(3) [*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.]<sup>9</sup>

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

*Article 14<sup>10</sup>*

*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(1)(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.]<sup>11</sup>

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<sup>10</sup> 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.

<sup>11</sup> 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)<sup>12</sup> shall be subject to review by a judicial or quasi-judicial authority.

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<sup>12</sup> See the footnote regarding Article 13.

*Article 16*

*Evidence*

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

[End of document]