

WIPO



SCP/10/8.

ORIGINAL: English

DATE: March 17, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

STANDING COMMITTEE ON THE LAW OF PATENTS

Tenth Session

Geneva, May 10 to 14, 2004

INFORMATION ON CERTAIN RECENT DEVELOPMENTS
IN RELATION TO THE DRAFT SUBSTANTIVE PATENT LAW TREATY (SPLT)

Memorandum by the International Bureau

INTRODUCTION

1. At its fourth session in November 2000, the Standing Committee on the Law of Patents (SCP) initiated its work on substantive patent law harmonization, and mandated the International Bureau of WIPO to establish first draft provisions for a future legal instrument. Since then, the SCP has held five sessions between May 2001 and May 2003 devoted to discussing a draft Substantive Patent Law Treaty (SPLT), including draft Regulations and Practice Guidelines.

2. During those sessions, the SCP has taken into account information about various national and regional practices and has discussed the possibility of achieving a common approach to certain concepts of patent law and practice. However, while the discussions have highlighted the importance of the issues at stake and considerable progress on a number of provisions contained in the draft SPLT has been achieved, it has also become apparent that certain issues are subject to considerable debate. Examples are: the broader question of the

benefits of harmonization on all aspects of substantive patent law, existing systemic differences in how countries address the question of patent protection (including the balance between right-holders and third parties), the perception by some that broad harmonization of the international patent system may lead to a loss of flexibilities available under the existing international patent framework, and the relationship between the patent system and other policy and regulatory mechanisms, such as public health, for example. This debate, which continued during the ninth session of the SCP in May 2003, suggests that the original objective of the SCP to achieve broad and deep harmonization of patent laws might be too ambitious and not easily achieved.

3. Against this background, a number of developments have taken place outside the context of WIPO, initiated by various interested parties and bodies with a view to overcoming the difficulties mentioned above and to paving the way for further progress in the area of patent law harmonization. This document provides information on some of the initiatives, insofar as they have come to the attention of the International Bureau, that have been undertaken since the International Bureau issued a revised draft SPLT and Regulations (documents SCP/10/2, 3, 4, and 5) in early October 2003 for consideration at the present session of the SCP. These initiatives have revealed a common desire of a considerable number of stakeholders to limit, although not necessarily to the same extent in all cases, the scope of the draft SPLT.

SPECIFIC DEVELOPMENTS SINCE THE ISSUANCE OF THE REVISED DRAFT SPLT AND REGULATIONS IN EARLY OCTOBER 2003

4. The International Bureau is aware of the following developments relating to the draft SPLT that have been initiated by different user groups and members of the SCP between October 2003 and February 2004:

AIPPI Resolution Q170 on the SPLT of October 27, 2003, and Seminar of January 29 and 30, 2004

5. During its 2003 Executive Committee meeting, held from October 25 to 28, 2003, in Lucerne, Switzerland, the International Association for the Protection of Intellectual Property (AIPPI) adopted Resolution Q170 on the Substantive Patent Law Treaty of October 27, 2003 (see <http://www.aippi.org/>). The International Bureau was represented as an observer.

6. The contents of the resolution can be summarized as follows:

(a) In view of its importance for the users, work on substantive patent law harmonization should continue, but it should be divided into an “SPLT 1,” which would form the basis of the discussions in the SCP at this stage, and an “SPLT 2,” whereby the latter should be addressed at a later stage only.

(b) The scope of “SPLT 1” should be limited as follows: it would comprise the provisions of the draft SPLT as contained in document SCP/9/2, with the exception of Articles 2(2) and (3) (Exceptions), 3(1)(iv) (Patents to which the Treaty applies), 4(4) (Inventions Made Independently by more than One Inventor), 7*bis* (Amendments or Corrections of Patents), 12(4) (Industrial Applicability/Utility) and 13 to 15 (Grounds for Refusal of a Claimed Invention; Grounds for Invalidation or Revocation of a Claim or a Patent; Review), the discussion of which should be postponed to a possible “SPLT 2.”

7. Following the adoption of the above-mentioned resolution, AIPPI organized a seminar on the SPLT on January 29 and 30, 2004, in Geneva, Switzerland, which the States participating in the sessions of the SCP and the International Bureau, as well as a number of intergovernmental and non-governmental organizations, were invited to attend, with a view to sharing AIPPI's position on the future work related to the draft SPLT. The list of participants and the presentations given at that seminar can be found on the AIPPI website at <http://www.aippi.org/>.

Roundtable of non-governmental organizations in London, November 10 and 11, 2003

8. On November 10 and 11, 2003, 24 non-governmental organizations participated in a roundtable entitled "Patent Law Harmonization: Is There a Way Forward?" in London, convened by the American Intellectual Property Law Association (AIPLA) and the United Kingdom Chartered Institute of Patent Agents (CIPA). The purpose of this roundtable was to discuss how to proceed with WIPO's work on substantive patent law harmonization in the framework of the SPLT and, more specifically, whether it might be possible for the non-governmental organizations present at the roundtable to agree on a limited subset of four topics (first-to file, grace period, prior art, applicability of pending applications as prior art) in the discussions on the SPLT. The International Bureau was represented by observers. There appeared to be a consensus among the participating NGOs that these four topics might constitute an acceptable package of topics to give priority to in the discussions on the SPLT at the next session of the SCP scheduled for May 10 to 14, 2004 (for further information see http://www.aipla.org/Content/NavigationMenu/IP_Issues_and_Advocacy/NGO_Roundtable/Roundtable_of_NGOs-Nov_2003.htm).

Trilateral cooperation

9. At their meeting held in Tokyo from November 3 to 7, 2003, the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office reached the understandings on cooperation between the Offices which includes, *inter alia*, a project on the harmonization of patent law. The Offices identified two categories of items for consideration in the framework of patent law harmonization in the SCP. The first category, which appeared to the Offices to be likely to produce agreement in a near future, would comprise prior art (including Hilmer doctrine, anti-self-collision, prior art effect of international applications under the Patent Cooperation Treaty (PCT) and prior art effect of earlier applications for inventive step), grace period, novelty, inventive step/non-obviousness, sufficiency of disclosure, claim drafting, unity of invention and amendments/corrections. The second category of items, which would be discussed at a later stage, would cover first-to-file/first-to-invent, patentable subject matter/technical character and utility/industrial applicability. The Offices will continue their discussions in a working group, which would give priority to the items relating to prior art, grace period, novelty and inventive step.

FICPI Resolution "SPLT Harmonization" of February 3, 2004 (EXCO/SG04/RES/2002)

10. At its meeting held in Singapore from February 1 to 3, 2004, the Executive Committee of the International Federation of Intellectual Property Attorneys (FICPI) adopted a resolution on SPLT harmonization on February 3, 2004 (see <http://www.ficpi.org/>). The International Bureau was represented by an observer. The resolution stated that the harmonization of substantive patent law should continue on the basis of a reduced package including the following items: the first-to-file system, a harmonized international grace period, and a clear

definition of the state of the art that is compatible with a first-to-file system including an international grace period, affording certainty for all users of the patent system, and solving *inter alia* the “double patenting” problem.

11. The above-mentioned developments offer a promising possibility for achieving the objective underlying the substantive patent law harmonization discussions, while respecting the views of those delegations that have expressed reservations about certain of the proposed provisions in the draft of the treaty that has been under discussion. That objective is to create the conditions for improved quality of patents granted and for work-sharing between offices by achieving a uniform understanding of certain underlying operational concepts (such as the prior art) that are deployed in all patent systems. The International Bureau commends to the Member States the exploration of the more limited approach suggested in the various developments described above.

12. The Members of the SCP are invited to take note of the contents of this document and to provide any comments or responses that they may wish to communicate.

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