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PRACTICE GUIDELINES UNDER THE 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 Practice Guidelines under the Substantive Patent Law Treaty (SPLT). The views expressed in the Standing Committee on the Law of Patents (SCP) at its ninth session from May 12 to 16, 2003, were taken into account when revising this document.

2. At its ninth session, the SCP discussed the status of the Practice Guidelines Under the draft SPLT (see document SCP/9/6). All intervening delegations expressed the view that the Practice Guidelines should not have a legally binding character. It was, however, agreed that the SCP would deal with the status of the Practice Guidelines at a later stage (see paragraph 25 of the draft Report of the ninth session (document SCP/9/8 Prov.2)).

3. By provisionally incorporating the whole contents of the former Notes into the Practice Guidelines, it is intended to provide a comprehensive set of explanations in one document in order to assist the SCP in deciding which issues should be contained in the Practice Guidelines and which ones in the Notes, if any. The parts of the text which were contained in the former Practice Guidelines (document SCP/7/4) are **highlighted** in this document.

4. As regards the Practice Guidelines under Articles 1 to 10 and Rules 1 to 9, differences between the former text of the draft Practice Guidelines Under the SPLT contained in document SCP/9/4 and the revised text contained in the present document have been highlighted as follows:

(i) words which did not appear in document SCP/9/4 but appear in the present text are underlined, and

(ii) words which appeared in document SCP/9/4 but which are omitted from the present document are shown as struck through.

5. Concerning the Practice Guidelines under Articles 11 to 16 and Rules 10 to 16, since no discussion was held on these provisions at the ninth session of the SCP, the text contained in document SCP/9/4 is kept unchanged, except for some consequential changes and corrections of typographic errors, which are highlighted with double underlining.

PRACTICE GUIDELINES

Guidelines Under Article 1 and Rule 1 (Details Concerning Abbreviated Expressions)

6. Article 1, item (i). The term “Office” includes both the national Office of any State which is a Contracting Party to the Treaty, and the regional Office of any intergovernmental organization which is a Contracting Party. For example, the Treaty will apply to the European Patent Office only if; the European Patent Organisation is a Contracting Party. The term also includes branch offices of such national and regional Offices. The reference to “other matters covered by this Treaty” covers the situation in which the Office of a Contracting Party is in charge of other procedures in respect of patents, for example, a post-grant opposition or the invalidation of a granted patent.

7. Article 1, item (ii). Where the term “application” refers to an application on which a right of priority is based, such as “earliest application” in draft Article 1(ix)(a) or “previous application” in draft Article 8(2)(ba)(ii), that term shall be construed as referring to an application for the grant of a patents, a utility models, a petty patents, an innovation patents, an industrial design or any other title ~~protecting an invention that may give rise to the right of priority~~ under the applicable law. It also includes provisional applications where they may serve as a basis for claiming priority. Reference is made to draft Rule 3(i). Reference is also made to the term “patent” in draft Article 1(v).

8. Article 1, item (v). The terms “patent for invention” and “patent of addition” are to be construed in the same sense as these terms in PCT Article 2(ii). Accordingly, the Treaty and the Regulations do not apply to the titles of protection listed in that Article other than patents for invention and patents of addition, namely, inventors’ certificates, utility certificates, utility models, certificates of addition, inventors’ certificates of addition, and utility certificates of addition. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and the Regulations to such other titles, even though it is not obliged to do so. Similarly, the Treaty and the Regulations do not apply to “plant patents” or “design patents” which are not patents for invention.

9. Article 1, item (vi). The term “claimed invention” is used in the Treaty and the Regulations, since it is more precise than the term “invention,” which is often used in relation to patents in a general sense. In short, the expression “claimed invention” refers unambiguously to the subject matter for which protection is sought as it is contained and defined in a claim. It may be noted that the words “claimed invention” are also used in the PCT in relation to substantive matters of patentability (see for instance PCT Articles 33 to 35). The second sentence of this item covers the situation where ~~multiple priorities or partial priority (see Article 4F of the Paris Convention) are claimed in accordance with the applicable law, and where a claim contains several alternatives which claim the said priorities.~~ In that situation, each alternative would be considered to be a separate “claimed invention.” Therefore, when determining the “priority date of a claimed invention” in accordance with draft Article 1(ix), such date should be established separately for each alternative, i.e., each claimed invention. The term “alternative” means, according to the Webster’s Collegiate Dictionary (tenth edition), “a situation offering a choice between two or more things only one of which may be chosen”. It covers both clear and self-evident alternatives, such as Markush-type claims, and the case where the claim contained in the earlier application covers only a part of the claimed invention defined by a broad expression. ~~Reference is also made to the definition of the term “priority date of the claimed invention” in Article 1(ix).~~

10. Article 1, items (vii) and (viii). The terms “applicant” and “patentee” are used in the Treaty and the Regulations to refer only to the person who is indicated as such in the records of the Office. Accordingly, any other person who might have, or purports to have, a legal claim of ownership or other rights is not considered an applicant or patentee for the purposes of this Treaty or the Regulations. The question of who may apply for a patent remains a matter for the applicable law of the Contracting Party concerned. Where the applicable law provides that a patent must be applied for in the name of the actual inventor or inventors, the “person who is applying for the patent” could be the inventor or joint inventors. Where a person is permitted under the applicable law to apply for a patent in place of an inventor who, for example, is dead, or legally incapacitated, that person is the “person who is applying for the patent.” “Another person who is filing the application” could, for example, under certain circumstances, be the inventor’s legal representative or sole heir in the United States of America. Where the applicable law provides that an application may be submitted by any natural or legal person, the applicant is the person submitting the application. Where the applicable law of a Contracting Party provides that several persons may jointly be applicants

or patentees, the term “applicant” or “patentee” is to be construed as including “applicants” or “patentees” (see Article 1, item (xi)). “Another person who is prosecuting the application” could, in particular, be an assignee of record of the right, title and interest in an application, where the applicable law of a Contracting Party requires the patent to be applied for in the name of the actual inventor and also provides that such an assignee is entitled to conduct the prosecution of the application to the exclusion of the named inventor.

11. Article 1, item (ix). The priority date of an “application” is the filing date of the earliest application the priority of which is claimed, and is used for setting time limits. However, the priority date is not always the date that determines the prior art for a particular claim, for example, where the claim contains elements that were not included in the application in respect of which the earliest priority is claimed. Taking into consideration the definition of the term “claimed invention” in draft Article 1(vi), the term “priority date of a claimed invention” takes into account the situation where an application contains more than one invention, and the application claims the priority of different earlier applications (multiple priorities). It also takes into account the situation where a subsequent application in respect of the same invention, for which the priority of the first application is claimed, contains elements of the invention which were not disclosed in the first application (partial priority). This reflects the practice of many Offices, which consider each claim on a case-by-case basis. The priority date of ~~the~~ a claimed invention relates to a particular claimed invention, as defined in draft Article 1(vi), not to the application as a whole, and establishes the date for the determination of the patentability of the particular invention contained in the claim. Thus, different claimed inventions in an application may have different priority dates of the claimed invention. The priority date of a claimed invention in an application is, ~~therefore, either~~ the actual filing date of that application ~~(paragraph (b)) or, where a right of priority based on an earlier application has been claimed in accordance with the applicable law, unless there is an earlier application the priority of which is claimed in accordance with the applicable law and which discloses the claimed invention. In the latter case, the priority date of the claimed invention is the filing date of the earliest application that discloses the claimed invention (paragraph (a)).~~ A similar structure defining the term “priority date” is also found in Article 2(xi) of the PCT. It follows from the words “priority is claimed in accordance with the applicable law” that the claimed invention in question is entitled to ~~the~~ priority under the applicable law, which should be in conformity with Article 4 of the Paris Convention. This, however, does not mean that an Office would be obliged to check the validity of the priority

in each and every case, since many Offices do not carry out such an examination, but leave this assessment to court (or other post-grant) procedures. One of the situations under which an Office may need to check the validity of the priority could be the case where the office finds an item of prior art, which was made available to the public on a date before the filing date, but after the priority date, during the examination procedure. The word “discloses” implies neither an enabling disclosure of the claimed invention in the previous application, nor the publication of the previous application. The term “filing date” means the filing date of an application, as provided for under the applicable law.

~~12. — Together with the definition of the term “claimed invention” in the second sentence of Article 1(vi), this provision also covers the situation where a claim defines its subject matter in the alternative, where multiple priorities or partial priority are claimed in respect of each alternative of the claimed invention.~~

12. Article 1, item (x). Since the Treaty and the Regulations would also be applicable to divisional, continuation and continuation-in-part applications (see paragraph 20), for these particular types of applications, the term “priority date of a claimed invention” must be defined as the priority date of the claimed invention in the relevant parent application, where the benefit of the filing date of the parent application is preserved for that claimed invention. Since the conditions regarding the preservation of the filing date of the parent application are left to the applicable law, where there is a chain of applications with respect to a divisional, continuation or continuation-in-part application, and thus there is more than one “parent” application, the applicant may, if the applicable law so permits, claim the benefit of the priority date of the claimed invention disclosed in any one of the parent applications, which may not necessarily be the first parent application in the chain.

Guidelines Under Rule 2

(Details Concerning Person Skilled in the Art)

13. The person skilled in the art as defined under this provision is a hypothetical person, who has general knowledge and ordinary skills to comprehend and use the prior art on the relevant date. This means that a—this person having ordinary skills in the art—has at his/her disposal the ordinary-normal means and capacity used by an ordinary practitioner in the

relevant field to conduct experimentation and analysis. The general knowledge should be considered as the knowledge that an average experienced person in the relevant field(s) of the art can reasonably be expected to have, or at least to be aware of to the extent that he knows which references could be consulted. It may include, in particular, well-known knowledge contained in handbooks or textbooks or commonly used information. The information, however, does not become general knowledge through publication in handbooks or textbooks. Rather, the information is usually already generally known by the time it appears in such books. Therefore, ~~the~~ the general knowledge does not need to exist in writing, but may form part of the general body of know-how of the average skilled person, such as well-known laboratory techniques. In any event, the person skilled in the art shall not be deemed to possess any inventive capability in addition to the conditions set forth in draft Rule 2. The reference to the “relevant date” takes into account the fact that, in the cases relating to the disclosure, i.e., draft Articles 10(1) and 11(4)(a) and draft Rules 4(1)(vii) , 10(iii), 11(1) and 12, the relevant date is the actual filing date, while in the cases relating to the determination of inventive step (non-obviousness), i.e., draft Article 12(3) and draft Rule 15(2), (3) and (4), that date is the priority date of the claimed invention. As regards the reference to the “relevant date” in conjunction with draft Rule 14(1)(a) and (2), since it concerns the prior art relevant to the determination of novelty, that date is the [priority date of the claimed invention] [the date on which the relevant prior art was made available to the public]. With respect to draft Rule 13(5)(ii) concerning the doctrine of equivalents, the relevant date is the date of the alleged infringement.

14. The term “the relevant field of the art” may cover more than one field of the art, if the nature of the claimed invention suggests a link to other fields of the art. It is not necessarily limited to the specific field of the claimed invention, but may include the neighboring fields of the art as well as general (non-specific) fields dealing with general problems commonly applicable to the specific fields. The person skilled in the art may also refer to other fields which are neither neighboring nor general fields, as long as a person skilled in the art would be expected to take those fields into account in view of, in particular, the factors indicated in items (i) to (iii) below. In determining the prior art in the relevant field of the art, the following factors, in particular, shall be taken into account:

(i) the nature and the characteristics of the field or fields of the art to which the claimed invention relates;

(ii) the type of problems encountered in the art;

(iii) the prior art solutions to those problems.

In view of the previous explanations, a person skilled in the art may be deemed to have the knowledge of a team of persons, for example a research team or a number of persons skilled in different fields of the art. This may apply, for example, ~~in certain advanced technologies,~~ in respect of combination inventions involving different fields ~~and in or~~ highly specialized processes.

15. The definition under this provision is applicable to the term “person skilled in the art” throughout the Treaty and the Regulations. However, the relevant information at his/her disposal may differ between the determination of novelty and inventive step (non-obviousness) and of sufficiency of disclosure. For novelty and inventive step (non-obviousness) purposes, the person skilled in the art makes that determination based on his/her knowledge of the prior art, while for sufficiency of disclosure purposes, the person skilled in the art knows the disclosure of the claimed invention in the application in addition to the prior art.

Guidelines Under Article 2¹

(Details Concerning General Principles and Exceptions)

16. Paragraph (1). This provision states, in express terms, the principle that the Treaty and the Regulations do not deal with any requirements related to infringement issues. The Treaty and the Regulations therefore apply, as a general rule, to questions of patentability and validity (during both the pre-grant and post-grant stages). The words “Subject to Articles 9(54) and 11(4),” however, provide exceptions to this principle: the provisions concerning the interpretation of claims (see draft Article 11(4) and draft Rule 13) for the determination of the scope of protection conferred by patents, and the provision concerning

¹ No Guidelines on paragraphs (2) and (3), which are included in square brackets, are proposed to be included in this document, since the SCP agreed to postpone substantive discussions on these provisions.

third party rights with respect to the grace period (see draft Article 9(54)) shall be applicable to infringement issues. It is to be noted that the SPLT does not interfere with other types of laws, such as antitrust and unfair competition laws, or general rules relating to fraud.

17. Paragraph (2). A similar provision is contained in Article 73(b) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) and in Article 4 of the PLT. The “essential security interests” of a Contracting Party which is an intergovernmental organization refers to the essential security interests of its member States.

Guidelines Under Article 3 and Rule 3

(Details Concerning Applications and Patents to Which of the Treaty Applies)

18. Article 3, paragraph (1). In principle, and subject to paragraph (2), this provision applies the Treaty and the Regulations to national and regional applications which are filed with or for the Office of a Contracting Party and to patents ~~for invention and patents of addition~~, which have been granted with effect for a Contracting Party. As regards international applications under the Patent Cooperation Treaty, the Treaty and the Regulations apply to international applications once they enter the “national or regional phase.” No distinction is made between applications filed by, and patents granted to, nationals of Contracting Parties and applications filed by, and patents granted to, other nationals. Reference is made to the definitions of the terms “application” and “patent” under draft Article 1(ii) and (v).

19. Items (i) and (ii). The expression “national applications ~~...~~ which are filed ~~...~~ with or for the Office of that Contracting Party” covers, in particular, national applications for a patent that are filed with the Office of another State X for onward transmission to the Office of the Contracting Party. A regional application which designates State X is an application filed with the Office of the regional organization but not an application filed for the Office of State X. The expression “regional applications ~~...~~ which are filed ~~...~~ with or for the Office of the regional patent organization which is that Contracting Party” covers, in particular, regional applications for a patent that are filed with the Office of a State X, which is a member State of a regional organization that is a Contracting Party, for onward transmission to the Office of that organization. Accordingly, where, for example, State X were party to the

Treaty, but the European Patent Organisation (EPO) were not, the Treaty and the Regulations would apply to national applications filed with or for the Office of State X, but not to European applications, even if State X were designated. Conversely, if the EPO were party to the Treaty, but State X were not, the Treaty and the Regulations would apply to European applications, including those designating State X, but would not apply to national applications filed with or for the Office of State X.

~~21. The terms “applications for patents for invention” and “applications for patents of addition” are to be construed in the same sense as these terms in PCT Article 2(i). Accordingly, the Treaty and the Regulations do not apply to the applications listed in that Article other than applications for patents for invention and applications for patents of addition, namely, applications for inventors’ certificates, utility certificates, utility models, certificates of addition, inventors’ certificates of addition, and utility certificates of addition. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and the Regulations to such other applications, even though it is not obliged to do so. Similarly, the Treaty and the Regulations do not apply to applications for “plant patents” or “design patents” which are not patents for invention, although they do apply to applications for patents in respect of plants which are inventions, for example plants which are the result of genetic engineering.~~

20. Subject to paragraph (2), the Treaty and Regulations apply to all types of applications for the grant of a patents for invention and patents of addition, including divisional applications and applications for continuation or continuation-in-part of an earlier application. It is to be noted that these items do not regulate the types of national or regional applications that a Contracting Party shall accept; this remains a matter for the applicable law of the Contracting Party concerned.

21. However, the Treaty and the Regulations do not apply to applications for patent term extension, for example, in respect of patents for pharmaceutical products under the laws of Japan, the United States of America and the European Community, since these are not applications for the grant of a patent. Similarly, they do not apply to applications for patent term adjustment, for example, as in the United States of America, in respect of the determination of additional patent term for delays in the issuance of a patent. In addition, they do not apply to an application for the conversion of an application for a European patent

into a national application for one or more designated States since this is a request for a different type of treatment rather than an application for the grant of a patent. However, the Treaty does apply to the application once it has been converted to a national application, if the country concerned is party to the Treaty. A Contracting Party is free to apply some or all of the provisions of the Treaty and Regulations to any type of applications not covered by items (i) and (ii), although it is not obliged to do so.

22. Item (iii). Under this item, the provisions of the Treaty and Regulations apply to international applications ~~for patents of invention and patents of addition under the PCT~~ which have entered the “national or regional phase” ~~in~~ before a national or regional Office.

23. Item (iv). The Treaty and the Regulations apply ~~both to both~~ both national and regional patents granted by the Office of a Contracting Party and to patents granted on behalf of a Contracting Party by another Office, in particular, the regional Office of an intergovernmental organization, irrespective of whether that intergovernmental organization is party to the Treaty. For example, if State X referred to in paragraph 19, were party to the Treaty, the Treaty and the Regulations would apply both to patents granted by the Office of State X and to patents granted by the European Patent Office in so far as they have effect in State X, irrespective of whether the EPO were party to the Treaty. If the EPO were party to the Treaty, the Treaty and the Regulations would apply to all European patents for the purposes of any procedures before the European Patent Office, for example, the revocation of patents in opposition proceedings, even if State X were not party to the Treaty.

~~26. The terms “patents for invention” and “patents of addition” are to be construed in the same sense as those expressions in PCT Article 2(ii). Accordingly, the Treaty and the Regulations do not apply to patents which are listed in that Article other than patents for invention and patents of addition, namely, inventors’ certificates, utility certificates, utility models, certificates of addition, inventors’ certificates of addition, and utility certificates of addition (see also paragraph 18). However, a Contracting Party is free to apply some or all of the provisions of the Treaty and the Regulations to such other patents, even though it is not obliged to do so. In addition, the Treaty and the Regulations apply to patents for inventions and patents of addition granted on international applications with effect for a Contracting Party.~~

24. Article 3, paragraph (2) and Rule 3. The types of applications and patents excepted under draft Article 3(2) are contained in draft Rule 3. The Treaty and the Regulations would not apply to provisional applications ~~for patents for inventions and for patents of addition and~~ to applications for re-issue. Under the law of the United States of America, where a patent is deemed wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had the right to claim in the patent, the patentee may file an application for re-issue. On the surrender of such a patent and the payment of a fee, the Office would re-issue the patent in accordance with a new and amended application for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for re-issue. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and the Regulations to applications referred to in draft Rule 3, even though it is not obliged to do so.

25. In accordance with draft Article 1(ii), where the Treaty and the Regulations refer to an application on which a right of priority is based, that application may be a provisional application, depending on where the applicable law so permits, ~~may be a provisional application. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and the Regulations to such other applications, even though it is not obliged to do so.~~

Guidelines Under Article 4

(Details Concerning the Right to ~~a~~the Patent)

26. This provision deals with the question of who has the right to ~~a~~the patent. Matters concerning the entitlement to the right to a patent by joint inventors are left to the applicable law.

27. Paragraph (1). The basic principle provided by the Treaty is that the right to ~~the~~a patent shall belong to the inventor or to his successor in title. The term “inventor” means the person who actually invented the claimed subject matter. Therefore, a person who is not ~~a~~the true and original inventor is not considered as the “inventor.” A person who misappropriated the claimed invention from the true inventor is not an inventor, even if his name appears in the application as the inventor or if the records of the Office show him as the inventor. The term “successor in title” covers any natural person or legal entity who, pursuant to the applicable

law, is entitled to the right to a patent by virtue of transfer of the right from the inventor, such as through assignment, employment contract, donation, inheritance, bankruptcy and the like. The representative of a deceased or legally incapacitated inventor (or his successor in title) is not covered by this provision, since such a representative would, in general, not act in his own name, but in the name of the person he/she represents. In relation to item (ii), it may be noted that, where an assignment contract was concluded in accordance with the applicable law before the invention is made, one could consider that the effect of such a contract would apply from the date on which the invention ~~is~~ was made, and would not result in the right to the patent passing immediately from the inventor to the other party of the contract.

28. Paragraph (2). According to this provision, a Contracting Party is free to decide how it wishes to regulate the right to a patent in the case of employee's inventions and commissioned inventions. The terms "employee's inventions" and "commissioned inventions" should be interpreted in a broad sense so ~~that~~ as to cover types of work relationships which are not based on written labor contracts or which do not imply a hierarchical relationship. ~~For~~ For example, researchers in universities, are also covered by this provision. Further, this provision does not affect the contractual freedom as it may be provided ~~in~~ under the applicable law of a Contracting Party.

~~32. Paragraph (3). This paragraph contains the applicable rules under the Treaty concerning the right to a patent where several inventors have jointly made the invention. In such a case, the inventors may agree on how the right to the patent shall be divided among them by way of, for example, a contract. In the absence of such an agreement, each inventor would have an equal and undivided right to the patent. The expression "equal and undivided right to the patent" means that each inventor has a right to the whole invention. This right is not divided into fractions among the inventors and can only be enjoyed commonly, that is, the single inventors may, for instance, not sell or license the (or parts of the) invention without agreement of all the other inventors. However, each inventor would be entitled to use the invention or to perform administrative acts in order to maintain the right, such as the payment of annual fees.~~

Guidelines Under Article 5
(Details Concerning Application)

29. ~~Paragraph (1). This paragraph contains a list of the different parts an application must contain. The terms “where they are necessary for the understanding of the claimed invention” in item (iv) are not the same as the words “where required” used in Article 3(2) of the PCT, but are in line with PCT Article 7(1). The intention is to make it clear that they are not meant to allow Offices to require drawings, but rather to allow applicants to submit such drawings where this appears necessary for the understanding of the claimed invention. In other words, drawings under this item are to be understood as meaning only those drawings without which the claimed invention could not be sufficiently disclosed. The second text in square brackets would leave it entirely to the applicant whether he/she wants to file drawings referred to in the description or claims, or whether he/she prefers to delete the reference to the drawings in the other parts of the application. The term “drawings” in item (iv) shall be construed as including photographs and other forms of graphic representations using new technologies. As expressly provided for in paragraph (1), this Article applies to the request, description, claims, drawings and abstract. Nothing in this Treaty prevents a Contracting Party from requiring that the applicant submit other information than 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 applicable law. It should be noted that those pieces of information are not requirements as to the “form or contents of an application” under PLT Article 6(1) (see paragraph 6.03 of the Explanatory Notes on the PLT), and that paragraph (1) does therefore not apply to the items listed above by way of the reference to the PLT in that paragraph. 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.~~

30. Paragraph (21)(a). This paragraph provides for the interface between the draft SPLT, the PLT and the PCT. Detailed explanations are contained in document SCP/6/5 (“Study on the Interface between the SPLT, the PLT and the PCT”). In principle, the requirements under the PCT relating to the request, description, claims, drawings and abstract, both formality requirements and substantive requirements, are incorporated by reference into the SPLT.

However, if the PLT, the SPLT or the Regulations under those Treaties provide any other requirements different from or additional to the PCT requirements concerning the request, description, claims, drawings and abstract, the former shall apply. In particular, draft Rules 4 and 5 of the SPLT provide further requirements concerning the description and claims which are not identical to the PCT requirements. In other words, 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 modifications; (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. Issues relating to the link to other treaties, in particular, the applicability of this paragraph to countries not being a party to the PLT or the PCT, will be dealt with in the administrative and final provisions.

31. In accordance with Rule 5.2 of the PCT, nucleotide and/or amino acid sequence listings are part of the description. Therefore, the requirements concerning such sequence listings under the PCT are incorporated by reference into the SPLT unless otherwise provided for in the SPLT.

32. Paragraph (21)(b). This provision ensures the freedom of a Contracting Party to provide requirements relating to form or contents of an application which are, from the viewpoint of applicants, more favorable than those referred to in paragraph (2)(a). It is modeled after Article 2(1) of the PLT.

33. Paragraph (32). This paragraph contains the generally accepted principle that the abstract shall only serve informational purposes, and shall, in particular, not be used for the purposes of interpreting the claims, determining the sufficiency of the disclosure or the patentability of the claimed invention. In the same context, attention is ~~further~~ drawn to draft Article 10(2) relating to the disclosure of the claimed invention. This paragraph does not conflict with draft Article 7(4) that allows for amendments or corrections of the description,

the claims and any drawings based on the contents of the abstract on the filing date, since the status of the abstract *as such* is to serve information purposes only.

34. The SPLT does not regulate the question of who should establish the abstract. Therefore, the Office of a Contracting Party is free to establish the abstract itself or to amend the abstract, or to choose any figures that better characterize the claimed invention *ex-officio*. Further, WIPO Standard ST.12 provides the Guidelines for the preparation of abstracts, including a check list and sample abstracts. The said standard provides that: “An abstract of a patent document is a concise statement of its technical disclosure. The abstract should enable the reader thereof, regardless of his degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure. The abstract should constitute an efficient scanning tool for searching in the particular technical field, particularly by making it possible to assess whether there is a need to consult the patent document itself.”

Guidelines Under Rule 4

(Further Requirements Concerning Contents, Manner and Order of Description
Under Article 5(21))

35. This Rule provides further requirements concerning the contents, manner and order of the description which are not identical to the PCT requirements and, therefore, constitute exceptions under draft Article 5(21). For reference, Rule 5.1 of the PCT provides the requirements concerning the manner of description of PCT international applications.

36. It follows from the wording of paragraph (1) that, as long as an applicant prepares the description with the contents in the manner and the order as prescribed in paragraph (1), the description would meet the requirement with respect to the contents of the description in any Contracting Party. In addition, according to paragraph (2), a Contracting Party shall accept the contents of the description presented in a manner or an order different from the one that is prescribed in paragraph (1), where such a different manner or a different order would afford a better understanding, or a more economical presentation, of the claimed invention. It goes without saying that, ~~by all means~~, the substantive patentability requirements as set forth in draft Articles 10 to 12 must be complied with. Reference is also made to draft Articles 13

and 14, according to which the failure to comply with the requirements under Rule 4 shall be a ground for the refusal of the application, but may not be a ground for the invalidation or revocation of the patented claim or patent.

37. Paragraph (1), item (iii). In view of providing adequate flexibility for applicants in drafting the description on the one hand and adequate support for the efficiency of offices' operation on the other, it is suggested that, as a general ~~rule~~ principle, the claimed invention may be described in any terms ~~as long as the substantive patentability requirements as set forth in draft Articles 10 to 12 are complied with.~~ However, since the so-called “~~problem-and-solution~~ approach,” ~~which has been~~ is applied in many, ~~but~~ although not in all, cases when determining the inventive step because of its practicality, the indication of the problem and its solution is presented ~~suggested~~ as ~~a~~ the preferable way of describing the invention. The Office of a Contracting Party could, however, not refuse an application only because the “~~problem-and-solution~~ approach” was not used to describe the claimed invention.

38. Paragraph (1), item (vi). According to the first bracketed text, ~~The~~ description of any mode (not necessarily the best mode contemplated by the applicant) for carrying out the claimed invention shall be furnished ~~under this item.~~ This means that the applicant may describe the invention in any mode allowing to carry out the invention, provided that the substantive requirements, such as the enabling disclosure requirement, are complied with.

39. The second bracketed text provides that the best mode known to the applicant at the time of filing should be described. The applicant does not need to point out which of the embodiments or examples are considered to constitute the best mode. In determining compliance with the best mode requirement, it must first be determined whether, at the time the application was filed, the applicant contemplated the best mode for practicing the invention. This is a subjective inquiry which focuses on the applicant's state of mind at the time of filing. Second, if the inventor did, in fact, contemplate a best mode, it must be determined whether the description disclosed the best mode in such a way that a person skilled in the art could carry it out. This is an objective inquiry, focusing on the scope of the claimed invention and the level of skill in the art. It should be assumed that the best mode is disclosed in the application, unless evidence is presented that it is inconsistent with that assumption.

40. Paragraph (1), item (vii). Since an applicant shall comply with the requirement concerning industrial applicability/utility under draft Article 12(4), he/she should demonstrate how that requirement is satisfied by way of indicating explicitly in the description the way(s) the claimed invention is useful or industrially applicable. Such an indication, however, is not necessary if a person skilled in the art can clearly understand the industrial applicability/utility of the claimed invention without any explicit indication.

41. Paragraph (2). Regardless of this paragraph, where the information concerning the source or geographical origin of the deposited biological material corresponds to the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the claimed invention, such information would be required under paragraph (1)(ii). Further, where such information is essential for complying with the enabling disclosure requirement, it would be required in accordance with draft Article 10.

42. Paragraph (23). The words “a different manner” are intended to also cover the cases where additional contents, which are not provided under paragraph (1), are included in the description, ~~or where not all the contents under paragraph (1) are included in the description.~~ Consequently, if an applicant includes additional contents, which are not listed in paragraph (1), in the description, a Contracting Party should accept such a description provided that the additional contents provides a better understanding of the claimed invention.

Guidelines Under Rule 5

(Further Requirements Concerning Claims Under Article 5(~~21~~))

43. This Rule provides further requirements concerning the claims which are not identical to the PCT requirements and, therefore, constitute exceptions under draft Article 5(~~21~~). For reference, Rule 6 of the PCT provides the requirements concerning claims in respect of PCT international applications. It goes without saying that, in any event, the substantive requirements under draft Articles 10 to 12 (which include the requirement that the claims should be clear and concise under Article 11) shall be complied with. Reference is made to draft Articles 13 and 14, according to which the failure to comply with the requirements under

Rule 5 shall be a ground for the refusal of the application, but may not be a ground for the invalidation or revocation of the patented claim or patent.

44. Paragraph (1). It follows from the words “whole numerals” that the numbering of the claims, which start with “1”, is not necessarily limited to Arabic numerals. A Contracting Party may require that a particular kind of whole numerals, such as Arabic numerals or Chinese numerals, be used by applicants.

45. Paragraph (2). According to this provision, an applicant has the option to draft the claims either in two parts or in a single part. The applicant, however, should describe the subject matter for which protection is sought in the claims in a manner compliant with other substantive requirements, for example, the claims shall be clear and concise in accordance with draft Article 11(2). This means that, where a claim drafted in a single part is not clear and concise as prescribed in draft Article 11(2), a Contracting Party may refuse the application on the grounds of non-compliance with “clearness and conciseness” of the claims but not on the grounds of the form of the claims.

46. Paragraph (3)(a). A reference to the description or any drawings in a claim is allowed where it is absolutely necessary, since, in some cases, such a reference may be necessary for a clear description of the claimed invention.

47. Paragraph (3)(b). Graphs may be contained in the claims, since they constitute pictorial representation of tables. However, no claim may contain drawings, since the drawings, which constitute general graphic representations, may not be appropriate to define the boundaries of the claim.

48. Paragraph (3)(c). In accordance with draft Rule 13(3), any reference signs to the applicable part of the drawing shall not be construed as limiting the claim.

49. Paragraph (4).² ~~[Reserved]~~ Subject to draft Article 6 (unity of invention), an application may contain one or more independent claims, which may be followed by a “dependent

² ~~The text of this paragraph will be added once the results of the discussions in the Working Group on Multiple Invention Disclosures and Complex Applications are known.~~

claim(s)” or a “multiple dependent claim(s)” that include all the features of one or more other claims. A dependent claim or a multiple dependent claim refers to one or more other claims and then states the features that are additional to the features in the claims to which reference is made. Therefore, dependent (multiple dependent) claims define specific forms of the invention in the claims to which reference is made.

50. By drafting claims in a dependent form, applicants may avoid repeating all the features that are already defined in preceding claims. Particularly, using a multiple dependent form allows an applicant to simplify the claims and reduce the number of claims. Thus, in some countries, applicants may enjoy benefits in terms of claim fees. Further, since dependent claims stipulate the additional features which are not contained in the claims to which reference is made, it may be easier for third parties to understand the differences between each claim. On the other hand, an excessive use of multiple dependent claims may create confusion in determining the scope of the claims, and thus result in obscure and ambiguous claims. Although there is no limitation *per se* in terms of the number of dependent claims, the substantive requirement concerning claims, in particular, clearness and conciseness of the claims, shall be always complied with (see also the Practice Guidelines under Article 11).

51. A dependent claim may depend on an independent claim, on another dependent claim or on a multiple dependent claim.

[Example 1]

Claim 1: A display with features A + B.

Claim 2: A display according to claim 1 with additional feature C.

Claim 3: A display according to claim 1 or 2 with additional feature D.

Claim 4: A display according to claim 3 comprising a LCD panel.

Claim 2 depends on an independent claim, claim 1. Claim 3 is a multiple dependent claim. Claim 4 is a dependent claim depending on a multiple dependent claim, claim 3.

52. A multiple dependent claim may depend on an independent claim, a dependent claim or a multiple dependent claim. A multiple dependent claim may refer in the alternative to the claims on which it depends (for example, “A machine as in claim 3 or 4, further comprising...”). It may also refer in the cumulative to the claims on which it depends (for example, “A machine as in claims 3 and 4, further comprising...”).

[Example 2]

Claim 1: A transmitter characterized by feature X.

Claim 2: A transmitter as in claim 1, further comprising ...

Claim 3: A transmitting station comprising a transmitter as in claim 1 or 2.

Claim 4: A receiver characterized by corresponding feature X.

Claim 5: A receiver as in claim 4, further comprising ...

Claim 6: A receiving station comprising a receiver as in claim 4 or 5.

Claim 7: A communication system comprising a transmitting station according to claim 3 and a receiving station according to claim 6.

Claims 3 and 6 are multiple dependent claims in the alternative form. Claim 7 is an example of a multiple dependent claim which is in the cumulative form.

[Example 3]

Claim 1: A process for treating textiles comprising spraying the material with a particular coating composition under special conditions (e.g., as to temperature, irradiation etc.)

Claim 2: A process according to claim 1 comprising the step of coating at 200 - 210°C.

Claim 3: A process according to claim 1 comprising an irradiation period of 30 - 35 seconds.

Claim 4: A process according to claims 2 and 3 characterized by the coating composition X.

Claim 4 is another example of a multiple dependent claim in the cumulative form.

53. A dependent claim and a multiple dependent claim shall refer back to a preceding claim or claims. All dependent or multiple dependent claim referring back to the same claim or claims should be grouped together to the extent and in the most practical way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed.

54. A Contracting Party is free to allow a claim that contains a reference to another claim even if it is not a dependent claim as defined in draft Rule 5(4). One example of this type of claim is a claim referring to a claim of a different category (for example, “An apparatus for carrying out the process of claim 1...” or “A process for the manufacture of the product of claim 1...”). Similarly, a claim to the one part referring to the other cooperating part, for example, “A plug for cooperation with the socket of claim 1...” is not a dependent claim as it does not expressly contain the all the features of the preceding claim 1, rather it only has a functional relationship to the preceding claim.

Guidelines Under Article 6 and Rule 6³
(Details Concerning Unity of Invention)

[55. Article 6 contains the widely accepted principle of unity of invention. The terms “the claims in the application” make it clear that the claims as such must fulfill the requirement of unity of invention, since they define the invention.

³ The text of these Guidelines should be reviewed once the results of the discussions in the Working Group on Multiple Invention Disclosures and Complex Applications are known. The SCP agreed at its ninth session that the discussion concerning unity of invention should be postponed.

56. The essential purpose of the requirement of unity of invention is to facilitate the administration and the search of applications. Accordingly, reference is made to draft Articles 13 and 14, according to which the failure to comply with the requirement of unity of invention shall be a ground for the refusal of an application, but may not, if a patent has been granted on an application that does not comply with that requirement, be a ground for the invalidation or revocation of the patented claim or patent. In other words, failure to comply with the requirement can and needs only be corrected at the application stage. At that stage, the sanction for non-compliance is the refusal of the grant of a patent unless the claimed invention is restricted through the elimination of certain claimed subject matter. The subject matter so eliminated may then be included into one or more “divisional” applications.

57. An objection of lack of unity should only be made when lack of unity seriously disturbs the procedure and, if made, it should be made as soon as possible, that is, normally at the latest at the stage of the first examination based on the prior art. At a later stage of procedure, it should not be raised unless as a consequence of amendment of claims or for other clearly justified reasons.

58. Rule 6, paragraph (1) contains the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an application. According to that method, unity of invention will be complied with only when there is a certain relationship among the inventions involving one or more of the same or corresponding “special technical features.” The terms “special technical features” contained in Rule 4(1) of the draft Treaty Supplementing the Paris Convention as Far as Patents Are Concerned (“1991 Draft”), have been replaced by a description of those terms, originating from the last sentence of Rule 4(1) of the 1991 Draft and PCT Rule 13.2.

59. Rule 6, paragraph (2) is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in draft Rule ~~76~~(1)) remains the same regardless of the form of claim used.

60. This provision does not prevent an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or setting up a claims fee system applicable in that Office.]

Guidelines Under Article 7 and Rule 7

(Details Concerning Observations, Amendment or Correction of Application)

61. Article 7(1)(a). This provision obliges the Office to provide, where it intends to reject or refuse an application based on the fact that the application does not meet any requirements provided under draft Article 13(1), at least one opportunity to make observations on the intended rejection or refusal and to subsequently remedy such non-compliance by way of, for example, an amendment or a correction. The term “amendment” refers to changes regarding matters of substance of the application, while the term “correction” relates to changes with respect to formality matters and rectification of clear mistakes. Therefore, the expression “amendments and corrections” covers any kind of modifications made in the application. As regards formality mistakes which are not related to search or substantive examination, Rule 8 of the PLT provides formal requirements and procedures concerning the request for correction of such a mistake. The Office cannot reject or refuse the application on the grounds of non-compliance with certain requirements, unless at least one opportunity to comply, within the time limit prescribed in draft Rule 7(1), with each and every of those requirements has been given to the applicant. It is to be noted that this provision does not require the Office to check the application as regards the compliance with all the requirements under the Treaty and the Regulations before the grant of a patent. Concerning the scope of amendments and corrections permitted, reference is made to paragraph (3) (see paragraphs 72 to 80). Where, despite the opportunity to amend or correct the application, the application still fails to comply with the requirements, the consequence of such non-compliance is provided in draft Article 13 (see paragraphs 172 to 174).

62. It is to be noted that, as far as formality requirements are concerned, the PLT provides that the Office shall notify the applicant and shall give at least one opportunity to comply with certain formality requirements. For example, where the filing date requirements under PLT Article 5(1) and (2) are not complied with, according to PLT Article 5(3), the Office shall notify the applicant, giving the opportunity to comply with any such requirements.

63. Rule 7(1). In view of the different existing legal practices regarding offer and acceptance of a contract, what constitutes “the date of the notification” for the purpose of determining the duration of a time limit is left to the applicable law. Two alternative time limits are presented in square brackets, i.e., two months and three months. The argument supporting the minimum time limit of three months is that the PLT provides minimum time limits of two months for formality matters. The main reasoning put forward by the delegations who support minimum time limit of two months is that the shorter minimum time limit of two months would balance the interests of the applicant and third parties, and would accommodate those Offices which apply a longer time limit.

64. ~~Article (1)(b)~~ Rule 7(2). This provision provides an exception to the obligation of an Office under ~~subparagraph (a) draft Article 7(1)~~ as far as divisional, continuation and continuation-in-part applications are concerned: where, in the case of divisional, continuation or continuation-in-part applications, the Office gave the opportunity to make observations and to correct or amend such applications has already been granted in respect of an error or defect in the parent application, for remedying a certain error or defect, and but the same error or defect was has nevertheless not been corrected and is still contained in the divisional, continuation or continuation-in-part application, the Office does not need to give a further opportunity for such observation, correction or amendment, although it may do so at its own discretion.

65. Article 7(2). ~~According to paragraph (1), an applicant has the possibility to make observations and to~~ This provision provides the principle that an applicant has a right to make amendments and corrections in the description, the claims, the abstract and any drawings following a notification from the Office on the non-compliance with any requirements under Article 13(1) (see, however, draft Article 7(4)). In addition, this provision permits on his own initiative in a manner prescribed in draft Rule 7(3).

66. Rule 7(3)(a). In general, an applicant has the right to remedy any non-compliance with the requirements defects in the description, the claims and any drawings on his own initiative at least up to the time when the application is in order for grant. The expression “when the application is in order for grant” is to be understood as the time when the Office completes the technical preparation of the notification that the application is in order for grant and that the

required fee for grant and/or printing, if any, is due. Once these preparations of the notification are completed, i.e., when the notification is ready to be sent by the Office, the Office would not need to allow the applicant to make an amendment or correction.

Abandoning a claim would be considered to be an amendment of the application.

67. However, where the Office provides a substantive examination by its own or through the Office of another State or intergovernmental organization, it may, except for clear mistakes as prescribed in draft Rule 7(24), further limit the period during which the applicant may amend or correct the application on his own initiative. This covers the cases where the Office of a Contracting Party utilizes the search or examination results of other Offices in order to grant patents or refuse patent applications filed with the Office of the Contracting Party. The words “substantive examination” under this provision are to be understood as an examination of a patent application with respect to at least one of the following requirements: novelty, inventive-step/non-obviousness, industrial applicability/utility, patentable subject matter and sufficiency of disclosure. “The first substantive communication from the Office” may be, for example, a communication from the Office to the applicant notifying the Office’s finding with respect to the non-compliance with any substantive requirements after, in particular, the substantive examination. It may also be a communication that the application is in order for grant and that the required fee for grant is due. Once the substantive examination has started, allowing the applicant to amend or correct the application on his/her initiative at any time may run counter an effective procedure to process patent applications. For example, a substantive examiner may, while conducting search and examination in respect of a claim, receive an amendment to that claim initiated by the applicant, which would oblige the examiner to repeat the whole search and examination process.

68. It follows from the words “at least up to the time” that, if the applicable law so permits, the applicant may amend or correct the application description, claims and any drawings on his own initiative at a later stage than is provided in this paragraph-(2). Concerning the scope of amendments and corrections permitted, reference is made to paragraph-draft Article 7(3) and draft Rule 7(2) (see paragraphs 72 to 80).

69. Rule 7(3)(b). Although draft Article 7(2) provides the right of the applicant to make amendments and corrections in the abstract on his own initiative, the Treaty and Regulations do not provide any time limits applicable to such amendments and corrections. They are left

to the applicable law. In view of the status of the abstract, i.e., mere information to the public, publishing an abstract of high quality would meet the interests of all parties concerned, including applicants. Therefore, the applicant may wish to make amendments and corrections in the abstract on his own initiative.

70. In order to ensure a high quality of abstracts, certain Offices may make amendments and corrections in the abstract, although it was initially prepared and submitted by the applicant, *ex officio* before its publication in a manner it deems appropriate. Such changes made by the Office could be substantive ones (for example, the claimed invention concerns a special kind of telephone while the initial abstract describes a telephone in general) or they may be of a pure editorial nature. As regards international applications under the PCT, the abstracts of such applications may be established by the International Searching Authority (ISA) before the international publication in accordance with PCT Rule 38. This means that at the time the SPLT applies to the PCT international applications in accordance with draft Article 3(1)(iii), i.e., after entering the national/regional phase, the abstracts of those international applications have already been established. In these situations where the applicant is not responsible for the preparation of the final contents of the abstract to be published, the Office may restrict the right of the applicant to make amendments and corrections in the abstract on his own initiative as referred to in draft Article 7(2) and draft Rule 7(3) in order to avoid a possible duplication of work.

71. Rule 7(4). This provision provides a definition of “clear mistake” under draft Article 7(2)(a)Rule 7(3). Since the relevant person for the determination of the term “clear mistake” is a person skilled in the art on the filing date, clear mistakes would also cover mistakes of a technical nature, such as mistakes in chemical or mathematical formulas, if they were clear to a person skilled in the art on that the filing date. The expression “person skilled in the art” is contained in draft Rule 2 (see paragraphs 13 to 15). In order to meet the conditions of this paragraph, a person skilled in the art must be able to determine that a the alleged mistake is clearly a mistake and that what is offered as correction is also clear the meaning resulting from the proposed correction is clearly the same as the meaning intended in the application containing the alleged mistake, without relying on extraneous documents. In accordance with draft Article 16, in order to support such a determination, any evidence may be taken into account. [Alternative B: If a person skilled in the art could immediately realize that a certain indication in the application could be nothing else than what is offered as

~~correction, the person skilled in the art must obviously have recognized that something else than what was clearly intended was written in the application.]~~

72. Article 7(3). This provision is based on the principle that the applicant should not obtain patent protection for something which he did not disclose as of the filing date. The consequence of the failure to comply with this requirement is provided in draft Article 13(1)(iii) (see paragraphs 172 and 173). This paragraph does not cover the amendment and correction of the request, since that matter is expressly covered by PLT Article 6. The phrase in item (i) “the disclosure in the description, the claims and any drawing on the filing date” includes matters that had been disclosed in the claims, description, and drawings on the filing date, but subsequently deleted during the prosecution of the application before the Office. The phrase in item (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” is necessary, since Article 5(6)(b) of the Patent Law Treaty provides that, under certain conditions, a part of the description or a drawing, which was omitted from the application as filed, could be included in the application later without having any effect on the filing date. [Subject to draft Article 7(54),] this provision does not allow for the possibility to amend the description, the claims and any drawings on the basis of what had been disclosed in the abstract as of the filing date, ~~since the general rule established in draft Article 5(3) would apply, i.e., that the abstract shall serve information purposes only.~~ Further, where an application claims the priority of a previous application, the provision does not allow an amendment or correction on the basis of what had been disclosed in the previous application, but was omitted from the application claiming the priority on the filing date, except in the case of the correction of a clear mistake as prescribed in draft Rule 7(24). ~~However, this paragraph does not prevent the applicant from amending the application by adding newly discovered references to a particular item of prior art in respect of the claimed invention where such references would contribute to a better understanding of the claimed invention. However, such an added reference to the item of prior art could not supplement the disclosure of the claimed invention, and consequently, could not be used as a basis for complying with the enabling disclosure requirement.~~

73. ~~This paragraph does not cover the amendment and correction of the request, since that matter is expressly covered by PLT Article 6.~~ There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant, nor

should the straightforward clarification of an obscurity, or the resolution of an inconsistency, be objected to. An amendment or correction is considered to go beyond the disclosure on the filing date, if the changes made to the disclosure of the invention, by way of addition, alteration or excision, result in the presentation of information which is not, for a person skilled in the art, directly and unambiguously derivable from the disclosure on the filing date. The phrase “included, in accordance with the Patent Law Treaty, in a missing part of the description or a missing drawing” is necessary, since Article 5(6)(b) of the Patent Law Treaty provides that, under certain conditions, a part of the description or a drawing, which was omitted from the application as filed, could be included in the application later without having any effect on the filing date. In other words, an amendment or correction should be regarded as introducing subject matter which extends beyond the content of the application as filed, and therefore as unacceptable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in a person skilled in the art being presented with information, which was not expressly or inherently presented in the application as filed even when taking into account matter which is implicit to a person skilled in the art in what has been expressly mentioned. The term “inherently” requires that the missing descriptive matter is necessarily present in the disclosure, and that it would be recognized by a person skilled in the art. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

74. The subject matter newly presented may be introduced by explicitly mentioning matter, which was either not previously mentioned at all, or only implied. For example, if in an application relating to a rubber composition comprising several ingredients the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be regarded as going beyond the disclosure in the application as originally filed. Likewise, if in an application which describes and claims apparatus “mounted on resilient supports,” without disclosing any particular kind of resilient support the applicant seeks to add specific information that the supports are, or could be, for example, helical springs (see, however, paragraph 73), then the amendment should normally be regarded as going beyond the disclosure in the application as originally filed.

75. If, however, the applicant can show convincingly that the subject matter in question would, in the context of the claimed invention, be so well known to the person skilled in the art that its introduction could be regarded as an obvious clarification and, therefore, as not

extending the content of the application, it is permissible. For example, if in the above-mentioned case of the resilient supports the applicant were able to demonstrate that drawings, as interpreted by the person skilled in the art, showed helical springs, or that the person skilled in the art would naturally use helical springs for the mounting in question, then specific reference to helical springs should be regarded as permissible.

76. Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description might not contravene draft Article 7(3).

77. Amendment by the introduction of further examples, for example, in the chemical field, should always be looked at very carefully, since *prima facie* any further example to illustrate a claimed invention may extend the disclosure of the application as originally filed.

78. Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets draft Article 7(3). For example, it may happen that, following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem to emphasize an effect attainable by the thus restricted invention but not by the prior art. It must be remembered that such revision is only permissible if the effect emphasized is one deducible by a person skilled in the art without difficulty from the application as filed (see paragraphs 73 to 75).

79. As indicated in paragraphs 73 to 75, alteration or excision of the text, as well as the addition of further text, may introduce new subject matter. For instance, suppose a claimed invention related to a multi-layer laminated panel and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene, amendment either to alter the outer layer to polypropylene or to omit this layer altogether would not normally be regarded as permissible. In each case, the panel disclosed by the amended example would be quite different from that originally disclosed and hence the amendment would be considered as introducing new subject matter.

~~84. Rule 7(2). This provision provides a definition of “clear mistake” under draft Article 7(3). Since the relevant person for the determination of the term “clear mistake” is a~~

~~person skilled in the art on the filing date, clear mistakes would also cover mistakes of a technical nature, such as mistakes in chemical or mathematical formulas, if they were clear to a person skilled in the art on that date. The expression “person skilled in the art” is contained in draft Rule 2 (see paragraphs 11 to 13). In order to meet the conditions of this paragraph, a person skilled in the art must be able to determine that a mistake is clear and that what is offered as correction is also clear, without relying on extraneous documents. In accordance with draft Article 16, in order to support such a determination, any evidence may be taken into account. [Alternative B: If a person skilled in the art could immediately realize that a certain indication in the application could be nothing else than what is offered as correction, the person skilled in the art must obviously have recognized that something else than what was clearly intended was written in the application.]~~

~~85. Article 7(4). This paragraph provides that, where the Office of a Contracting Party is responsible for the final preparation of the abstract for its publication, the Contracting Party is not obliged to provide an opportunity to the applicant to amend or correct the abstract on his own initiative as provided for in draft Article 7(2). In this situation, even if the applicant prepared and submitted an abstract to the Office, the Office may amend or correct that abstract in a manner it deems appropriate. The Office, however, is free to accept amendments or corrections to the abstract by the applicant at its own discretion.~~

80. 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.

[81. Article 7(54). This paragraph is included in square brackets for further consideration by the Committee. It provides that, where the applicant prepared the abstract, the disclosure in the abstract on the filing date [may][shall] be taken into account when in determining whether an amendment or correction of the description, the claims and any drawings under draft Article 7(3) is permissible. For example, the subject matter exclusively contained in the abstract as of the filing date could be moved, after the filing date, to the part of the description or the claims part of the application after the filing date, if that subject matter was contained in the abstract is prepared that was submitted by the applicant on the filing date.]

Guidelines Under Article *7bis* and Rule *7bis*
(Details Concerning Amendments or Corrections of Patents)

82. During the course of post-grant opposition or revocation proceedings, a new item of prior art which affects the patentability of the patented invention may be discovered. In that case, the patentee may wish to make amendments or corrections in the patent in order to avoid the invalidity of his patent on the basis of the newly discovered prior art. On the other hand, for the purpose of legal certainty, it may not be feasible to allow a patent owner to make any amendments or corrections on his patent after grant. Draft Article *7bis* provides certain conditions upon which the patentee could correct and/or amend his patent after grant.

83. Article 7bis, Paragraph (1). As a general rule, a competent authority shall, upon request by the patentee, make amendments or corrections in the patent, where the amendments or corrections would limit the scope of the claims, i.e., where the extent of the protection conferred by the patent would be limited by the changes made. This provision establishes the right of the patentee to request the limitation of the patent before the Office, i.e., the Office shall provide a possibility for such amendments or corrections of patents before the Office. According to draft Article 1(1), the term “Office” means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty competent authority. Therefore, where a Contracting Party entrusts a patent Office with the task of making amendments or corrections of patents under the conditions provided under the applicable law, the Office “competent authority” referred to in draft Article *7bis* is the patent Office of the Contracting Party. Where a Contracting Party entrusts courts (but not the patent Office) to decide on amendments or corrections of patents, a Contracting Party shall provide a possibility for such amendments or corrections before the court under the conditions provided under the applicable law. In view of the various post-grant procedures under existing national/regional laws, however, further details concerning the conditions and time limits applicable to such procedures are left to the applicable law. In order to limit the extent of the protection, amendments in the patent may be made by way of a disclaimer.

84. Article 7bis, Paragraph (42). This provision is based on the principle that the patentee should not extend his exclusive right over what he did not disclose as of the filing date.

~~Except in the case of the correction of a clear mistake under paragraph (3), a~~ Amendments or corrections in patents should not be permitted, if they would result in the disclosure contained in the patent going beyond the disclosure contained in the description, the claims and any drawings on the filing date, or included in the application by way of filing, after the filing date, in accordance with the Patent Law Treaty, in the a missing part of the description or ~~the~~ a missing drawing in accordance with the Patent Law Treaty. Reference is made to draft Article 7(3) which provides a similar provision as regards amendments or corrections of the description, the claim and any drawings in an application (see paragraphs 72 to 80).

85. ~~Article 7bis, P~~paragraph (3) and Rule 7bis. The patentee has the right to request the competent authority to make corrections of clear mistakes. The term “clear mistake” ~~should~~ must be given the same meaning as in draft Rule 7(~~24~~) (see paragraph 71).

Guidelines Under Article 8 and Rules 8 and 9 (Details Concerning Prior Art)

86. Definition of Prior Art. The definition of prior art is of fundamental importance for the determination of patentability, since novelty and inventive step are examined on the basis of existing art, i.e., prior art. According to draft Article 8(1), first, the prior art with respect to the subject matter of a particular claim shall consist of all information which has been made available to the public anywhere in the world, before the priority date of the claimed invention. Therefore, information made available on the same day, even though earlier than the time of filing of the claim in question, would not form part of the prior art. The expression “information” is to be understood as encompassing anything which can be captured by the five human senses through, for example, hearing, reading, study or instruction.

87. Second, the prior art shall consist of information that has been made available to the public in any form, whether it is in written form or not (see draft Rule 8(1) and paragraph 88). Consequently, for example, no Contracting Party may exclude from the prior art information that has been made available to the public by oral presentation, regardless of the country in which the presentation was made. Third, in accordance with the reference to draft Article 8(2), the prior art with respect to a certain claimed invention shall also include ~~earlier~~

other applications that are filed with effect in the same Contracting Party before, but are published after, the priority date of that claimed invention (reference is made to the fact that prior art includes ~~earlier other~~ applications claiming priority, if a previous application on which the right of priority is based has a filing date that is earlier than the priority date of that claimed invention), although the contents of the ~~earlier other~~ application have not been made available to the public before the priority date of the claimed invention. ~~Fourth, in accordance with the reference to draft Article 9, information which meets the conditions of that Article is not considered to be prior art, even if that information has been made available to the public before the priority date of the claimed invention.~~

88. Form of Prior Art. Draft Rule 8(1) obliges a Contracting Party to accept, as prior art under draft Article 8(1), any information that has been made available to the public in any form, including written form, electronic form, oral communication, display or use. Use may consist of producing, offering, marketing or exploiting a product, or offering or marketing a process or its application, or applying the process. Marketing may be effected, for example, by sale, offering for sale or exchange. Display may take the form of, for example, demonstrating a product or process in public or on television. **Information that has been made available to the public through communication by electronic means, in particular, via an electronic database or the Internet, also forms part of the prior art.** Since this is not an exhaustive list, other forms of making available information to the public would be covered by this provision as well.

89. Information Made Available to the Public. Draft Rule 8(2)(a) provides for the interpretation of the words “made available to the public” under draft Article 8(1). It follows from the explicit language of draft Article 8(1) that, if the relevant information was actually accessed by the public, and therefore, made available to the public, it forms part of the prior art. In addition, if there is a reasonable possibility that the information could be accessed by the public, it would also form part of the prior art.

90. **The means by which the information was made accessible may offer some guidance on the interpretation of the words “a reasonable possibility that the information could be accessed by the public.”**

(a) *By oral communication:* The information shall be deemed to be made available to the public if the information was unconditionally brought to the knowledge of the public through oral communication, such as a lecture or by means of radio or sound reproduction equipment (e.g., tapes and records).

(b) *By display or through use:* The information shall be deemed to be made available to the public if, on the relevant date, it was possible for the public to gain knowledge of that information through the display or the use of the medium. For example, if a person sells an object unconditionally to the public without limitation or restriction, or injunction or obligation of secrecy, the object shall be deemed to be made available to the public, since the buyer acquires unlimited possession of any knowledge which may be obtained from that object. Whether the information is considered to be available to the public is determined by the extent of control placed on its access by the person initially possessing the information.

(c) *In written form:* A document shall be regarded as made available to the public if, at the relevant date, it was possible for the public to gain knowledge of the contents of the document. Therefore, the public shall have not only the possibility of gaining access, in the technical sense, to the information contained in the document, but also the possibility of acquiring possession of such information. Whether the absence of an index or a catalogue of the information constitutes inaccessibility of the information to the public or not shall be determined in accordance with this principle.

(d) *Via an electronic database or the Internet:* The availability of information disclosed via an electronic database or the Internet shall be considered in the same manner as other forms of disclosure, i.e., whether it was reasonably possible for the public to gain knowledge of the information concerned or not. Accordingly, where the information disclosed on the Internet was made available to a limited circle of people, it is considered being made available to the public, provided no obligation to maintain secrecy was imposed. In order to determine whether the information disclosed on the Internet was made available on a particular date or not, the following factors, in particular, shall be taken into account:
(i) public availability of the URL; (ii) possibility of search by a search engine;
(iii) credibility of the web site.

91. As illustrated above, the “reasonable possibility” implies that the public should not be required to make excessive efforts in order to gaining access to the information. Similarly, it implies that the public’s access to the information is legitimate. In other words, if the public needs to break a law in order to gain access to the information, that information is not deemed to be reasonably accessible to the public.

92. “Public”. Draft Rule 8(2)(b) provides for the interpretation of the word “public” for the purposes of the definition of “prior art.” It follows from the words “any person” that the public may be one or more persons who does not need to be a person skilled in the art and who, therefore, does not necessarily have the capability of understanding the prior art in the relevant field or may be more than one of such a person. It may be a single person. However, such person (or persons) must not be bound by an explicit or implicit confidentiality obligation of confidentiality to maintain the information secret, and, therefore, must be free to disseminate the information to others, whether he (they) understand(s) the information or not. Thus, where information was made available to a limited circle of persons, as long as these persons are free to disclose the information and, therefore, to pass the knowledge to others, they fall under the term “public” under this provision. The obligation of confidentiality does not need to be expressly stated in a confidentiality agreement. Such an obligation may also be an tacit or implicit one. , resulting from the nature of tThe relationship between the inventor and the third party to which the invention is was disclosed should be of such a nature that a reasonable expectation existed that the information concerned should be kept secret (and which implies confidentiality e.g., such as the relationship within a couple or between an employee and his/her employer).

93. Evidence. In accordance with draft Article 16, evidence may be submitted to the Office in order to demonstrate that the information concerned qualifies as prior art. Such evidence may include the establishment of the date of disclosure and the contents of the disclosed information, or the existence of a reasonable possibility that the public could access the information. What constitutes evidence is left to the applicable law of Contracting Parties. It may consist of written evidence, testimonial evidence or any other kind of evidence allowed under the law of Contracting Parties.

94. Date of Availability to the Public. Draft Rule 8(3) aims at harmonizing the determination of the date on which the information was made available to the public for the

purposes of prior art, where only the year or the month, but not the date, is specified. It follows from this provision that, in such a case, the information is presumed to have been made available to the public on a certain date. Two alternative proposals are made regarding the presumed date, i.e., the first day of the month or the year and the last day of the month or the year. the last day of the year or the month should be considered as the date on which the information was made available to the public. However, a Contracting Party would be, however, free to consider any evidence which establishes another date as the date on which the information was made available to the public. In other words, that this provision is applicable only where the exact date on which the information was made available to the public cannot be established.

95. The two alternative proposals in square brackets may be viewed in terms of the following aspects:

(i) Possibility of granting a patent to an invention in respect of which a patent should not be granted and of refusing a patent to an invention which should be granted

If the presumption was made that the information was made available to the public on the first day of, for example, the year, it would eliminate the possibility of granting a patent to an invention which was filed in the same year but, in fact, was filed after the actual date on which the information was made available to the public. Such a presumption, however, would maximize the risk of not granting a patent to an invention which was filed in the same year, but was filed earlier than the actual date on which the information was available. On the other hand, if the presumption was based on the last day of, for example, the year, it would eliminate the risk of refusing the grant of a patent for an invention which should be patented, since, at the latest on the last date of the year, the information was made available to the public. The second presumption, however, would increase the risk of granting a patent to an invention which, in fact, was filed later than the actual date of availability of the information.

(ii) Possibility of abuse by third parties

If the presumption was based on the first day of the year in which the date of availability of the information was not specified, third parties, such as competitors, may abuse the system by way of intentionally hiding the date on which the information was made

available to the public. There will be no incentive for a person who disclosed the information to the public to specify the date of disclosure, since according to this presumption, the less the date can be identified, the more the earlier date of disclosure would be assumed. Such an abuse may be facilitated by, for example, the disclosure of the information via the Internet.

(iii) Possibility of rebuttal

As indicated in item (i) above, either presumption may cause undesirable situations, i.e., a patent may/may not be granted to an invention which is not/is patentable. Therefore, it is important that a way to rectify such undesirable results is provided. If the presumption was based on the first day of the year, the possibility exists that an application which was filed before the actual date of disclosure of the relevant information is refused. In this case, the applicant has to prove that the information was in fact disclosed on the later date and not on the first date of the year. It may be very difficult, if not impossible, for the applicant, who might be in another country, to prove the date of disclosure made by the third party who could often be a competitor. This is why many patent systems place the burden of proof for demonstrating the existence of a ground for refusal on patent offices.

On the other hand, if the presumption was based on the last day of the year, the risk is that a patent may be granted to an invention which was filed after the actual date of disclosure of the relevant information. In this case, in order to revoke the patent, the third party who disclosed the information, and who would often be a competitor, may have an incentive and enough evidence to prove the actual disclosure date.

96. Prior Art Effect of Earlier-Certain Applications. Draft Article 8(2) provides that the prior art with respect to a certain claim also comprises ~~earlier-certain other~~ applications filed with effect in the same Contracting Party, the filing date (or where applicable, the priority date) of which is earlier than the priority date of that claim, provided that the ~~earlier-other~~ application, or the patent granted on the ~~earlier-other~~ application, is ~~published-made available to the public~~ subsequently by the competent authority on or after the priority date of the claimed invention. More precisely, draft Article 8(2)(a)(i) deals with the cases where the filing date of ~~an earlier-the other~~ application is earlier than the priority date of a claimed invention under consideration, and draft Article 8(2)(~~ba~~)(ii) deals with the cases where the ~~earlier-other~~ application claims priority and where a previous application on which the priority

is based has a filing date earlier than the priority date of the claimed invention under consideration. Typically, the other application may be made available to the public through publication by the Office. It may be made available to the public through public inspection of the application at the Office. It goes without saying that, if the ~~earlier-other~~ application is published before the priority date of the claimed invention under consideration, it forms part of the prior art under draft Article 8(1). The ~~earlier-other~~ applications referred to in this provision form part of the prior art for the purpose of the determination of novelty, but not of inventive step.

97. What constitutes an “~~earlier-the other application filed with effect in a Contracting Party~~” is defined in draft Article 8(2)(e**b**). Where the Contracting Party is a State, ~~an earlier the other application filed with effect in the Contracting Party~~ means: (i) a national application filed with or for the Office of ~~the-that~~ Contracting Party; (ii) if the Contracting Party is a member of a regional patent organization, a regional application ~~in~~ filed with or for the Office of that regional patent organization through which protection is sought in the said Contracting Party; and (iii) an international application under the PCT [Alternative A: which has entered the so-called national/regional phase in ~~the-that~~ Contracting Party] [Alternative B: which designates ~~the-that~~ Contracting Party]. Where the Contracting Party is a regional patent organization, ~~an earlier-the other application filed with effect in the Contracting Party~~ means: (i) a regional application filed with or for the Office of the regional patent organization which is that Contracting Party; and (ii) an international application under the PCT [Alternative A: which has entered the so-called national phase in ~~the-that~~ regional patent organization] [Alternative B: which designates ~~the-that~~ regional patent organization]. The difference between Alternative A and B is that, in the former case, international applications would be considered as from their entry into the national phase, while in the latter case, these applications would be covered as from the date of designation.

98. Although the contents of ~~an earlier-the other~~ application have not been made available to the public before the priority date of the claimed invention under consideration, that application forms part of the prior art in order to avoid any possibility of double patenting, since the subject matter disclosed in the ~~earlier-other~~ application as of the filing date could lead to a separate patent. In addition, since the whole contents of the ~~earlier-other~~ application is published later, if the subject matter of the claim disclosed in the later application is not

new having regard to the ~~earlier~~-other application, that claim would not add any new contribution to the existing art.

99. The expression in draft Article 8(2)(~~ba~~)(ii) “subject matter that is contained in both ~~that~~ ~~earlier~~-the other application and ~~the~~-that previous application” does not mean that the subject matter has to be literally identical in both applications or that it has to be contained in a specific part of the application (for example, the claims). It rather means that the elements or features of the subject matter must be clearly identifiable, for a person skilled in the art, in both the ~~earlier~~-other application and the previous application as a whole.

100. Draft Rule 9 provides further conditions to be fulfilled for ~~an earlier~~-the other application to be considered as part of the prior art under draft Article 8(2). First, the “whole contents” of the ~~earlier~~-other application, that is, the claims, description and any drawings, of the ~~earlier~~-other application shall be considered as prior art. Second, the prior art consists of the whole contents of ~~an earlier~~-the other application as of the filing date. This means that subject matter which had been contained in, for example, the description as of the filing date, but was subsequently deleted during the prosecution of the application before the Office, also forms part of the prior art.

101. According to draft Articles 1(ii) and (v) and 3(1), the provisions of ~~this~~-the Treaty and the Regulations shall apply to applications for patents for invention and for patents of addition, including divisional, continuation and continuation-in-part applications of these applications. However, where a Contracting Party provides any other titles of protection for an invention under the applicable law of the Contracting Party, such as a utility model, a short-term patent or an innovation patent, draft Rule 9(1)(b) obliges that Contracting Party to consider ~~earlier~~-the other applications filed under these titles of protection as part of the prior art under draft Article 8(2), provided that the other conditions under draft Article 8(2) and draft Rule 9 are met. However, if the Contracting Party does not prohibit double protection of the same invention by more than one title of protection, that Contracting Party is not obliged to consider ~~earlier~~-the other applications filed under other titles of protection as part of the prior art. Plant patents and design patents are not considered to be “other titles of protection for an invention.”

102. Draft Rule 9(2) covers the situation where the ~~earlier-other~~ application is no longer pending before the Office on the date ~~of its publication~~ on which it was made available to the public. In view of the period which is necessary for, in particular the preparation of the publication and for the administrative procedure, there could be cases where the ~~earlier-other~~ application ~~is was still published~~ made available despite its withdrawal, abandonment or refusal before the ~~publication available~~ date. Further, there could be other cases where the ~~earlier-other~~ application had been erroneously published despite the fact that it was already withdrawn, abandoned or refused before the publication date. According to the first bracketed text, this provision therefore provides that, if the ~~earlier-other~~ application has been ~~published~~ made available to the public even if it was no longer pending and should not have been ~~published publicly available~~ under the applicable law, the ~~earlier-other~~ application shall not be considered prior art for the purposes of draft Article 8(2). It follows from the words “and should not have been published under the applicable law” that, where the applicable law of the Contracting Party provides for, for example, the publication of all applications filed with the Office, any published application is considered as prior art for the purposes of draft Article 8(2), even if the application was no longer pending before the publication date. Under certain circumstances, the case may occur where an application was no longer pending (for example, it was refused) before the date of publication, but is revived by way of, for example, a reinstatement of rights procedure after the publication date. Potentially, such right to reinstate the refused application may exist up to, according to Rule 13(2) of the PLT, at least 12 months from the date of expiration of the time limit for the action with which the applicant failed to comply. In view of the rare occurrence of such cases, draft Article 8(2) does not regulate the prior art effect of ~~an earlier-the other~~ application which was published even if it was no longer pending on the date of publication, and was subsequently revived after the publication date. These matters are left to the applicable law of a Contracting Party.

103. According to the second bracketed text, this provision provides that, if the ~~earlier-other~~ application has been ~~published~~ made available to the public although it had been withdrawn before the date ~~of publication~~ on which it was publicly available, it shall not form part of the prior art. Since the application of this provision is limited to the withdrawal of the ~~earlier other~~ application before its publication, there would normally be no possibility of reinstatement of rights after the publication.] ~~On the other hand, where the earlier application was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected on or~~

~~after the date of its publication, that earlier application shall be considered as prior art, provided it was still pending before the publication date.~~

104. Draft Rule 9(3) obliges a Contracting Party to provide the so-called “anti-self-collision.” Although the whole contents of ~~an earlier~~ the other application shall be considered as prior art in accordance with draft Rule 9(1), if an applicant has claimed invention X in the ~~earlier~~ other application, and the same applicant claims invention Y, which has been disclosed in the description or the drawings of the ~~earlier~~ other application, in the subsequently filed application, the ~~earlier~~ other application shall not form part of the prior art with respect to the latter application. In addition, where a Contracting Party allows internal priority, the applicant would have the possibility to claim the internal priority and to withdraw the ~~earlier~~ other application. In the case of internal priority, the applicant may file a subsequent application within one year from the filing date of the ~~earlier~~ other application, while the introduction of the anti-self-collision would allow the applicant to file a subsequent application by the time of publication of the ~~earlier~~ other application (for example, 18 months from the filing date of the ~~earlier~~ other application), which is normally longer than the internal priority period.

105. It follows from the words “or the inventor identified in” that the benefit of this paragraph excluding self-collision would be available also in the cases where the inventor named in two applications is the same, but the applicants of these applications are different because, for example, the inventor changed employer. The term “inventor” means the true inventor who has the right to the patent.

106. The effect of the phrase “at the filing date of the application under examination” is that this paragraph excluding self-collision would not be applicable in the cases where the applicants were not originally the same, but became the same as a consequence of, for example, an assignment.

107. The phrase “one and the same person” means that, where there are more than one applicant, or inventor, all the applicants, or inventors, of the earlier application and the application under examination must be the same. Further, the term “same claimed invention” means that the main elements or features of the claimed invention must be clearly identifiable for a person skilled in the art, as being contained in both applications taken as a whole.

Guidelines Under Article 9

(Details Concerning Information Not Affecting Patentability (Grace Period))

108. In accordance with Article 8(1), in principle, all information which has been made available to the public anywhere in the world in any form before the priority date of the claimed invention shall constitute prior art. Further, in accordance with draft Article 8(2), certain applications which are filed before, but published after, the priority date of the claimed invention also constitute part of the prior art. However, under certain circumstances, such a broad definition of prior art may run counter to the objective of a patent system, i.e., to strike an appropriate balance between the inventor and the general public. For example, it may not be justified if any disclosure, even if it was beyond the control of the inventor, leads to a loss of rights. Inventors may need to disclose the invention as soon as it is realized (even before the priority date of the claimed invention, since it requires some time to prepare a patent application) to potential future partners or investors in order to develop the invention further. Under other circumstances, public research organizations, universities and certain firms may wish to disclose the results of their research to the public as early as possible, which may facilitate access to research results for third parties. Therefore, draft Article 9 provides certain kinds of disclosures which do not affect patentability, even if the disclosure was made before the priority date of the claimed invention. It is important to establish a uniform grace period at the international level so that a disclosure made under certain conditions at one place would not affect the patentability in other countries. Otherwise, the applicant would be obliged to file patent applications before the public disclosure with the Offices which do not recognize the grace period. Further, even if Offices recognize the grace period, if the duration of the period is different among different Offices, the applicant would be forced to prepare an application on the basis of the shortest grace period, and would need to be familiar with different rules under different national/regional laws.

109. Paragraph (1)(a). This provision provides the duration and the calculation of the grace period and the ~~kinds of applicable disclosures situations where certain items of prior art do not affect the patentability of a claimed invention.~~ The words “the information was made available to the public anywhere in the world in any form” in the preamble shall be interpreted in the same manner as the corresponding text What constitutes “prior art” is

defined in draft Article 8(4). Therefore, the grace period may be invoked on the basis of a disclosure made in written form, in electronic form, by oral communication, by display or through use or in any other form. For example, the information may be disclosed through a presentation at an exhibition and through public experimental use. Further, the provision is applicable to both intentional and unintentional disclosures, i.e., disclosures made by mistake[, except in the case of Article 9(1)(ii)(a)].

110. ~~The words “included in the prior art under Article 8(2) on a date during”~~ The prior art under draft Article 8 also covers the cases where ~~an earlier another~~ application has a prior art effect under draft Article 8(2). In such a case, draft Article 9(1) applies if the filing date of the ~~earlier other~~ application (in the case of draft Article 8(2)(a)), or the filing date of the previous application (in the case of draft Article 8(2)(b)), is within the period of [12][6] months preceding the priority date of the claimed invention to which the grace period applies.

Duration and calculation of the grace period

111. The duration of the grace period is [12][6] months from the priority date of the claimed invention. Therefore, where an application claims priority in accordance with the applicable law, the grace period starts from the filing date of the earliest application whose priority is claimed and which discloses the claimed invention (see draft Article 1(ix)). At the international level, in cases where the disclosure was made during the 12 months preceding the filing date of the previous application for which priority is claimed, if the grace period were calculated from the filing date of the subsequent application claiming priority, the applicant would not be able to enjoy the benefit of the grace period in respect of the subsequent application. This would mean that, in practice, where priority is claimed, it would not be possible to invoke the effects of the grace period based on a disclosure made before the original filing date.

Kinds of disclosure

112. ~~The disclosures that would trigger the grace period could be made~~ An item of prior art could be included in the prior art by the inventor (see draft Article 9(1)(i)), by an Office (see draft Article 9(1)(ii)) or by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor (see draft Article 9(1)(iii)).

113. As regards ~~the disclosure by a third party~~ draft Article 9(1)(iii), the acquisition of the information or the disclosure of the information by the third party may occur either with or without the knowledge or consent of the inventor (e.g., a breach of a confidentiality agreement). Similarly, it may be a legal or illegal act (e.g., against the law relating to the test data of medicinal products). It also covers certain applications under draft Article 8(2), filed by a third party which obtained the information contained in such applications directly or indirectly from the inventor.

114. Concerning the disclosure by an Office, the provision deals with the cases where (i) the information contained in another application filed by the inventor was disclosed by the Office during the grace period, and (ii) the information contained in an application filed without the knowledge or consent of the inventor by a third party was disclosed by the Office during the grace period. [As regards the first case, the grace period provisions apply where another application filed by the inventor was made available to the public by the Office (for example, published or laid open to public inspection) during the grace period, although the Office should not have done so. Therefore, the grace period provisions are applicable only where the application was disclosed to the public due to a mistake made by the Office.] [As regards the first case, the grace period provisions apply where another application filed by the inventor was made available to the public by the Office (for example, published or laid open to public inspection) during the grace period. Therefore, the grace period provisions cover any earlier applications filed by the inventor, which were publicly disclosed during the grace period.] The second case is applicable to both cases where the third party obtained the information directly from the inventor and filed a patent application, and where the third party, who filed a patent application, obtained the information indirectly from the inventor, such as through another person who acquired the information directly from the inventor.

115. Paragraph (2). [Alternative A] The phrase “at any time” means that the effect of paragraph (1) can be claimed at any stage of the patent granting procedure or thereafter, for example, during invalidation proceedings. It would prevent third parties from raising, during invalidation proceedings, the prior art effect of a publication made by the inventor. [Alternative B] A Contracting Party is free to require that, unless the applicant submits a declaration as prescribed in the Regulations, he/she may not be able to enjoy the effects of the grace period.

~~122. Paragraph (3). If the applicability of the grace period is contested either by the Office or by the third party, [a person who invokes the effect of the grace period has the burden of proving that he is entitled to enjoy such effect] [a Contracting Party is free to require that, under the applicable law, evidence as proof of the identity of the information disclosed and the date of disclosure be filed with the Office by the Party invoking the effect of the grace period, if the Office doubts the applicability of the grace period.] The second bracketed text is intended to focus on the procedures before the Office. Reference is made to Article 11(3) of the Paris Convention concerning temporary protection afforded to patentable inventions in respect of goods exhibited at official or officially recognized international exhibitions.~~

116. Paragraph (43). It follows from the words “or before” that the provision covers the cases where a person had the right to a patent only before, but no longer on, the filing date of the application concerned (for example, the case of an assignment of that right).

117. Paragraph (54). [Alternative A] This provision introduces intervening rights of third parties, who were using the claimed invention or had started effective and serious preparations for such use, in good faith, between the date on which the ~~invention, or information related to it, was made available to the public~~ item of prior art was included in the prior art under paragraph (1) and the priority date of the claimed invention. The party enjoying such intervening rights has the right to use (or to continue to use) the invention for the purposes of his/her business. A Contracting Party is, however, free to provide any remuneration mechanism for such use. For the purpose of this provision, the use of the invention consists of any acts which would otherwise be considered as infringement under the applicable law, such as making, using, offering for sale, selling or importing for these purposes the invention. As regards the limitation to the priority date of the claimed invention, reference is made to Article 4B of the Paris Convention, which states that third-party rights or any right of personal possession cannot be acquired during the priority period based on any of the acts referred to in that provision.

[Alternative B] The Treaty and the Regulations do not regulate the rights, if any, acquired by a third party who was using the claimed invention or had started effective and serious preparations for such use, in good faith, 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. These remain a matter for the applicable law of the Contracting Party concerned.

Guidelines Under Article 10 and Rule 10
(Details Concerning Enabling Disclosure)

118. Article 10, paragraph (1). In addition to the so-called patentability requirements such as novelty, inventive-step (non-obviousness) and industrial applicability (utility), the claimed invention shall be fully disclosed in the application in such a manner as to allow a person skilled in the art to carry out the invention. Where the application refers to biologically ~~reproducible~~ material which cannot otherwise be disclosed in the application to meet the requirements prescribed in this paragraph and draft Article 11(3), to the extent that those requirements cannot otherwise be complied with, they shall be considered to be complied with by a deposit of such material. Details concerning the deposit of biologically ~~reproducible~~ material are prescribed in draft Rule 11 (see paragraphs 126 to 129). The notion of “a person skilled in the art” is prescribed in draft Rule 2 (see paragraphs 13 to 15).

119. The second sentence of this paragraph clarifies the phrase “sufficiently clear and complete for ~~the~~that invention to be carried out by a person skilled in the art.” First, the disclosure is aimed at a person skilled in the art. This person shall, if necessary, use its general knowledge to supplement the information contained in the application (see draft Rule 2). Second, the disclosure must allow a person skilled in the art to both make and use the claimed invention. Therefore, if the disclosure of a claimed invention, for example, of a chemical compound or biological material which is isolated and purified, allows a person skilled in the art to reproduce such chemical compound or biological material, but is not sufficient to teach how it can be used, such a disclosure does not comply with the requirement under draft Article 10. Third, although a reasonable amount of trial and error is permissible, a person skilled in the art must, on the basis of the disclosure of the claimed invention and the general knowledge, be able to carry out the invention without “undue experimentation.” This is applicable particularly in the field of unexplored technologies. Factors to be considered in order to assess the absence of “undue experimentation” are listed in draft Rule 10 (see paragraphs 121 to 125). Fourth, it follows from the phrase “~~as of~~on the filing date” that the disclosure shall be sufficient to carry out the invention on the basis of the knowledge of a person skilled in the art at the time of the filing date, not at the time of the examination or the grant of the patent.

120. Article 10, paragraph (2). For the purposes of assessing sufficiency of disclosure, the description, claims and drawings shall be examined on the basis of the disclosure made in the description, claims and drawings ~~on the filing date~~, as amended and corrected ~~under the applicable law~~. It goes without saying that amendments and corrections of applications should be in compliance with draft Article 7. In accordance with draft Article 5(32), the abstract shall not be taken into account for the purpose of determining sufficiency of the disclosure. The sufficiency of disclosure shall be assessed on the basis of the claims, description and drawings as a whole. Therefore, where a claimed invention is sufficiently disclosed in the claims, description and drawings, but the description and drawings alone do not disclose the invention in a sufficiently clear and complete manner, the enablement requirement under draft Article 10 is met. However, in this case, the requirement concerning the relationship of the claims to the disclosure under draft Article 11(3), i.e., that the claims shall be fully supported by the disclosure of the description and drawings, may not be met.

Undue Experimentation

121. Draft Rule 10 provides a non-exhaustive list of factors to be considered when assessing whether “undue experimentation” is required in order to carry out the invention on the basis of the disclosure in the application. Those factors are the following:

122. Item (i). The breadth of the claims is relevant to the determination of undue experimentation, since a person skilled in the art must be able to make and use the entire scope of the claimed invention. For example, the applicant is not entitled to claim everything within the scope of the invention, if the application only discloses how to make and use part of the claimed invention.

123. Items (ii) and (iii). The nature of the claimed invention, i.e., the subject matter to which the claimed invention pertains, is essential to determine the general knowledge of a person skilled in the art and the state of the art. For example, if the selection of the values for various parameters is a matter of routine for a person skilled in the art, such a selection may not be considered as requiring undue experimentation.

124. Items (iv) and (v). “The amount of direction provided in the application” refers to the information explicitly or implicitly contained in the description, claims and drawings, including working examples and references to other applications or documents. The more is known in the prior art by a person skilled in the art about the nature of the invention and the more the art is predictable, the less information in the application itself is needed in order to carry out the claimed invention. For example, there is predictability in the art if a person skilled in the art can readily anticipate the effect of a feature of the claimed invention.

125. Item (vi). In addition to the time and expenses needed for carrying out the experimentation, the character of the experimentation, for example, whether it constitutes merely routine work or goes beyond such routine, should also be considered.

Guidelines Under Rule 11

(Details Concerning Deposit of Biologically ~~Reproducible~~ Material)

126. Paragraph (1). This provision establishes the legal effect of a deposit of biologically ~~reproducible~~ material referred to in an application. ~~The deposit shall be considered part of the description to the extent that the requirement[s] regarding sufficiency of disclosure under draft Article 10 [and the relationship of claims to the disclosure under draft Article 11(3)] cannot otherwise be complied with so that it would be taken into account in determining the compliance with such requirement[s].~~ Therefore, Where an application refers to biologically ~~reproducible~~ material which is not available to the public, the applicant may not be able to comply with draft Article 10 because that material cannot be described in the application in such a way as to enable a person skilled in the art to carry out the claimed invention without having access to that material. Similarly, the applicant may not be able to comply with draft Article 11(3) because such material cannot be described in the application in such a way as to describe the claimed invention in a manner allowing a person skilled in the art to extend the teaching in the [claims,] description and drawings to the entire scope of the claim without having access to that material. In these cases, to the extent that the material cannot be described otherwise, the applicant may remedy the non-compliance with ~~these~~ those Articles by depositing the material with a depository institution in accordance with the applicable law. Mere reference to the deposited material in an application cannot simply replace the disclosure of such material in the application in order to comply with ~~the~~ those

requirement[s]. It should be noted, however, that a reference to the deposit in the application would not create the presumption that the deposit is necessary or required to comply with ~~the~~ [those] requirement[s].

127. In accordance with draft Article 5(~~2~~1), the SPLT incorporates by reference Rule 13*bis* of the PCT, which provides detailed requirements concerning the reference to deposited biological material. A Contracting Party is free to determine what constitutes “a depository institution” under this provision. However, in accordance with paragraph (3), any Contracting Party shall ~~accept~~ recognize the effect of a deposit made with the International Depository Authority under the Budapest Treaty.

128. ~~Paragraph (2)(a) and (b). According to subparagraph (a), the general rule is that the deposit must be made at the latest on the filing date of the application.~~

[Alternative A]

~~The general rule is that the deposit must be made, without any exception, at the latest on the filing date of the application. However, where the disclosure of the deposited biologically reproducible material, to the extent to which it is taken into account for the purpose of draft Article 10, is compliant with draft Article 7(3), i.e., it does not add new matter to the application as of the filing date, subparagraph (b) provides for the possibility to make the deposit after the filing date. However, where a deposit is made after the filing date, the applicant would have to submit evidence that the deposited biological material and the material described in the application as filed are the same. Subparagraph (b) may be applicable to the case where, for example, the biologically reproducible material, which was not made available to the public, was used to make a claimed invention. In this case, even if the biologically reproducible material was fully and specifically identified in the description as filed and the claimed invention was clearly and completely disclosed, a physical access to the deposited biologically reproducible material may be nevertheless necessary for a third party to work on the deposited material in order to make and use the claimed invention without undue experimentation. It also covers the case where the deposit as of the filing date was made with a depository institution which was not an authorized institution for the purpose of the disclosure requirement under the applicable patent law, and therefore the applicant~~

~~should re-deposit the biologically reproducible material with an authorized depositary institution after the filing date.~~

[Alternative B]

The general rule is that the deposit must be made at the latest on the filing date of the application. Alternative B, however, obliges a Contracting Party to accept a deposit after the filing date in the two cases~~under two situations~~ described in subparagraph (b), items (i) and (ii). Item (i) refers to the case where a third party needs to access ~~to~~ the sample of the material in order to make and use, without undue experimentation, the claimed invention that was made by utilizing that material, even if the material was fully and specifically disclosed in the application. In this case, the issue of adding “new matter” would not arise since the material was fully identified in the application and evidence showing that the later deposited material is identical to the material identified in the application should be required. Item (ii) refers to the case where the deposit which was made no later than the filing date was not made with a depositary institution recognized in the context of the disclosure requirement under the patent law. The mere fact that the deposit was made with ~~at~~ the depositary institution that does not comply with the patent law as of the filing date is a kind of formality defect rather than a substantive failure to comply with the patentability requirements.

129. Paragraph (3). In order to facilitate the recognition of the effects of the deposit of ~~biologically reproducible~~ material contained in a patent application at the international level, the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (Budapest Treaty; see also draft Rule 1(1)(c)) was signed in 1977. The Budapest Treaty requires Contracting Parties to recognize a deposit with any International Depositary Authority. This paragraph obliges a Contracting Party of the SPLT to ~~accept~~ recognize the effect of a deposit made with an International Depositary Authority, even if that Contracting Party is not a party to the Budapest Treaty.

Guidelines Under Article 11 and Rules 12 and 13
(Details Concerning Claims)

130. Article 11, paragraph (1). The requirement under this paragraph is a subjective one, since the provision clarifies that it is the applicant, and not the Office, who determines what he regards as his invention and what the subject matter for which he seeks for patent protection is. Therefore, non-compliance with this requirement is not a ground for refusal of a claimed invention or for revocation or invalidation of a claim or a patent (see draft Articles 13 and 14). However, it goes without saying that, in order to obtain a patent, the claimed invention shall comply with other requirements, such as novelty, inventive-step (non-obviousness), industrial applicability (utility) and the claims shall comply with the requirements concerning the drafting of the claims.

131. Article 11, paragraph (2) and Rule 12(1). The requirement that the claims shall be clear is important since, once a patent is granted, the claims define the scope of its protection. This requirement applies to individual claims as well as to the claims as a whole. Since the interpretation of the claims shall be made ~~primarily~~ on the basis of the wording of the claims (see draft Article 11(4)(a)), the meaning of the terms of a claim should, as far as possible, be clear for a person skilled in the art on the basis of the wording of the claim alone. According to draft Rule 12(1)(a), ¶the claim is deemed to be clear enough if a person skilled in the art can determine the boundaries of the claimed invention with a reasonable degree of certainty. A claim should not include vague or equivocal forms of wording which leave the reader in doubt as to the scope of the claim. For example, inconsistency between the terms of a claim and the description or prior art teaching, the use of terms such as “essentially,” “relatively” or “similar” in the claim, or absence of the basis of reference, where a word or a phrase refers to an earlier citation, could be considered as not complying with the clarity requirement. Similarly, in general, ~~relevant~~ relative terms, such as “thin,” “wide” or “strong” should not be used in a claim unless the term has a well-recognized meaning in the particular art, e.g., “high-frequency” in relation to an amplifier, and this is the meaning intended.

132. The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention, or a feature thereof, by a result to be achieved should be objected to as lacking clarity. Objections may also be raised under lack of support, ~~because~~ where the claimed scope is broader than what the description enables.

However, no objection should be raised if the invention can only be defined in such terms and if the result is one which can be achieved without undue experimentation, e.g., directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error. For example, the invention may relate to an ashtray in which a smoldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define whilst still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved, provided that the specification includes adequate directions to enable the reader to determine the required dimensions by routine test procedures.

133. Where the invention relates to a chemical compound, it may be characterized in a claim in various ways, ~~viz~~ namely, by its chemical formula, as a product of a process or by its parameters. Characterization of, for example, a chemical compound solely by its parameters may be appropriate in those cases where the invention cannot be adequately defined in any other way, provided that those parameters can be clearly and reliably determined either by indications in the description or by objective procedures which are ~~usual~~ recognized in the art. The same applies to a process-related feature which is defined by parameters. ~~If this is not the case, then an objection for lack of clarity arises. This can arise, for example, in the case of macromolecular chains. The examiner should be aware of the possibility that applicants may attempt to employ unusual parameters to disguise lack of novelty. Cases in which non-art recognized parameters are employed, or a non-accessible apparatus for measuring the parameter(s) is used, may be objectionable on grounds of lack of clarity.~~

134. Where a claim for an apparatus or a product seeks to define the invention by reference to features of the use to which the apparatus or product is to be put, a lack of clarity may result. This ~~is~~ may particularly be the case where the claim not only defines the product itself but also specifies its relationship to a second product which is not part of the claimed invention (for example, a cylinder head for an engine, where the former is defined by features of where it is connected in the latter). Such a claim must either set forth a clear definition of the individual product being claimed by wording the claims appropriately (for example, by substituting “connectable” for “connected”), or be directed to a combination of the first and second products (for example, “engine with a cylinder head” or “engine comprising a cylinder

head”). It may also be permissible to define the dimensions and/or shape of a first product in an independent claim by general reference to the dimensions and/or corresponding shape of a second product that is not part of the claimed first product but is related to it through use (for example, in the case of a mounting bracket for a vehicle number-plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate).

135. The requirement that the claims shall be concise ~~also~~ applies to the individual claims as well as to the claims in their entirety. As prescribed in draft Rule 12(1)(b), ~~F~~for example, undue repetition of words or a multiplicity of claims of a trivial nature which render it unduly burdensome to determine the matter for which protection is sought, could be considered as not complying with this requirement. However, it is not the intention of this provision to form a basis for allowing Offices to reduce the number of claims where there is no absence of clarity or conciseness in respect of the claims.

Relationship of Claims to the Disclosure

136. Article 11, paragraph (3) and Rule 12(2). ~~Draft Article 11(3) provides that the description and drawings should provide a basis for the claimed invention and that the scope of the claims must not be broader than the extent of the description and drawings. In other words, the claimed invention must be fully supported by the disclosure in the description and drawings in a manner allowing a person skilled in the art to extend the teaching of such disclosure to the entire scope of the claim, thereby showing that the applicant does not claim subject matter which he had not recognized and described on the filing date.~~ The underlying legal principle as regards the relationship of the claims to the disclosure is that exclusive rights should be justified by the contribution to the art through the disclosure to the public of what the inventor had invented. Therefore, the protection conferred by the patent should not extend to subject matter which was not recognized and not described by the inventor as of the filing date. One example where the claimed invention ~~are~~^{is} not consistent and not commensurate with the disclosure in the description and drawings application would be that, after reading the application, the claimed invention is still not at the disposal of the a person skilled in the art, because the essential element for the function or operation of the invention is missing from the claim. Another example would consist in the claimed invention not being consistent with the disclosure, for instance, due to contradictions between the elements contained in the claims and the description. One other example would be that, having regard

to the description and the drawings disclosure in the application, the scope of the claimed invention covers an area which was not recognized by the inventor, for example, mere speculation of possibilities that have not been explored yet. Accordingly, since the key objective of this requirement is that the claimed invention should be disclosed in a manner allowing a person skilled in the art to extend the teaching of the disclosure in the application to the entire scope of the particular claim, thereby showing that the applicant does not claim subject matter which he had not recognized and described on the filing date, not only the teaching of the description and the drawings but also the teaching of other claims could be considered when determining compliance with this requirement.

137. In respect of this requirement, however, another aspect should be highlighted. Many national/regional laws require that the description and drawings should provide a basis for the claimed invention and that the scope of the claims must not be broader than the extent of the description and drawings. Consequently, third parties who wish to consult published patents could expect that the description and drawings would cover and explain the whole scope of the claimed invention. If the applicant recognized and described his invention over the whole scope of the claims on the filing date, subject matter which was disclosed only in the claims could be included later in the description through an amendment during the pre-grant procedure. Such kind of discrepancy between the claims and the disclosure could easily be rectified in pre-grant proceedings. In certain cases, this may even be rectified by way of “copying” the texts appearing in the claims to the description part of the application. According to draft Rule 4(1)(iii), the claimed invention should be described in the description. In other words, if the subject matter of the claims is neither described nor implied in the description, it does not comply with draft Rule 4(1)(iii). It should be noted, however, that non-compliance with the requirements under Rule 4 is a ground for refusal, but not a ground for revocation.

138. Where the claimed invention is too broad to be supported by the description and drawings, the disclosure may also be insufficient to enable a person skilled in the art to carry out the claimed invention. Therefore, in that case, non-compliance with both the requirement concerning the relationship of the claims to the disclosure under this paragraph and the enablement requirement under draft Article 10 may be invoked. However, these two requirements are distinct and separate requirements.

Interpretation of Claims

139. Article 11, paragraph (4)(a). This paragraph provides the basis for the manner of interpretation of claims for the purposes of determining compliance with the requirements in respect of the claims (see draft Article 11, paragraphs (2) and (3)), enabling disclosure (see draft Article 10), patentable subject matter (see draft Article 12(1)), novelty (see draft Article 12(2)), inventive step/non-obviousness (see draft Article 12(3)) and industrial applicability/utility (see draft Article 12(4)). Details concerning the manner of interpretation of claims are prescribed in draft Rule 13. It follows from the wording of draft Article 2(1) that draft Article 11(4) and draft Rule 13 are also applicable to the interpretation of patented claims during infringement procedures.

140. The scope of the claimed invention, i.e., the scope of the subject matter for which patent protection is sought, shall be determined on the basis of the wording of the claims. As prescribed in Rule 13, paragraph (1)(a), the words of a claim must be read as they would be understood by a person skilled in the art in accordance with the meaning and scope which they normally have in the relevant art, and should not be ~~limited in their meaning by what is explicitly disclosed in the description and drawings~~ interpreted as being necessarily confined to their strict literal meaning. Further, ~~if the wording of the claims needs interpretation,~~ 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 be taken into account. Where the description provides a special meaning by way of, for example, defining a term appearing in the claim, the description should be used for the interpretation of the claim.

141. Rule 13, paragraph (2). This subparagraph is included for avoidance of doubt. It follows from paragraph (2)(a) that the claims should not be interpreted in a limited manner by what is explicitly disclosed in the description and drawings, except where the applicant introduces or agrees to a specific limitation (“disclaimer”). In particular, the interpretation of the claims should by no means be limited by the scope of the examples of the claimed invention contained in the description.

142. Rule 13, paragraph (4)(a). This subparagraph relates to the interpretation of a claim which defines the structure or material of a product, or the steps of a process, by their function, work or characteristics (means or step-plus-function claim). For the purposes of the

interpretation of the claims, in principle, such a claim should be construed as any structure or material or act which is capable of performing the defined function or has the defined characteristics. For example, a claim aimed at “a building material incorporating a layer which insulates heat” should be interpreted as a building material incorporating any “product” that is “a layer which insulates heat.” It should be noted, however, that the issues of whether such means-(steps)-plus-function claims are clear and concise or not and whether the disclosure of the claimed invention is sufficient for a person skilled in the art or not should be determined separately in accordance with draft Articles 10 and 11.

143. For the purposes of determining novelty/inventive step (non-obviousness) of means-~~or~~ (step)-plus-function claims, where the defined function or character is essentially derived from a certain structure, material or act of the claimed invention, such a claimed invention would not involve novelty/inventive step (be obvious) over prior art which describes that structure, material or act as such. For example, concerning a claim such as “chemical compound X having anti-cancer effect,” where the anti-cancer effect is a characteristic which is inherent in the chemical compound X, the claim would not involve novelty/inventive step (be obvious) having regard to prior art which refers to the “chemical compound X” *per se*.

144. Rule 13, paragraph (4)(b). This subparagraph concerns a claim defining a product by its manufacturing process (product-by-process claim). Such a claim should be construed as the final product *per se* that possesses the characteristics derived from the manufacturing process stated in the claim. ~~Therefore, the patentability of a product defined by a product by process claim does not depend on its method of production.~~ If the product defined in such a claim is the same as, or obvious from, a product described in an item of prior art which was made by a different process but which also possesses the characteristics derived from the process stated in the claim, the claimed invention is unpatentable ~~even though the product described in the item of prior art was made by a different process~~. For example, as regards a claim “protein Z which is obtained by process P (steps P1, P2, ... and Pn),” if protein Z manufactured by a different process Q is identical to the claimed protein and possesses the same characteristics derived from the process P, and if it is part of the prior art, the claimed protein is not considered novel whether or not the process P has been publicly known as of the ~~claim~~ priority date of the claimed invention. As another example, in assessing the patentability of a claim “a two-layer structured panel which is made by welding together an iron sub-panel and a nickel sub-panel,” the process of “welding” would be considered in determining the patentability of

the claimed invention, since the process of welding may produce physical properties in the end product which are different from those produced by processes other than welding.

145. Rule 13, paragraph (4)(c). This subparagraph concerns a claim defining a product by its particular use (product-by-use claim). Such a claim should be construed as the product being limited to the particular use. Whether the product is new or not and whether the particular use of such product is new or not having regard to the prior art are not a question of interpretation, but a question of patentability of the claimed invention. In assessing the patentability of such a product-by-use claim, whether the claimed product is particularly suitable for the stated use or is applied only for the purpose of the stated use may be taken into consideration. ~~For example, a claim aimed at “a chemical compound Z for insecticidal use” may be patentable having regard to prior art which refers to the “chemical compound Z” as such, if the insecticidal use of the chemical compound Z is a new use. However, if the claim recites a new use of a composition or structure which is found in the item of prior art, and the use is directed to a result or property of that composition or structure, then the claim is anticipated by that item of prior art.~~ A known product which *prima facie* is the same as the product defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty, but if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty. For example, a claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods that is presented in a form such as: “substance or composition X” followed by the indication of the use, for instance “...for use as a medicament”, “...as an antibacterial agent” or “...for curing disease Y” would be regarded as restricted to the substance or composition when presented or packaged for the use.

Doctrine of Equivalents

146. Article 11, paragraph (4)(b). The background for the inclusion of the so-called “doctrine of equivalents” was the fact that, if certain Contracting Parties were to apply the doctrine of equivalents, while others would not, applicants would be forced to draft their claims in a different manner in different countries. Details are contained in draft Rule 13(5) and (6).

147. Rule 13, paragraph (5). This provision provides that Contracting Parties shall take into account equivalent elements when interpreting claims for the purpose of the determination of infringement. In accordance with draft Article 11(1) and (4), the wording of the claim shall determine the scope of protection conferred by a patent. However, if this rule were always strictly applied, a patentee may not be able to prevent third parties from making unimportant and insubstantial changes and substitutions to the patent, which, though adding nothing substantial, are outside of the scope of the patented claim. Therefore, under certain circumstances, the scope of a patent may embrace equivalents to the claims described. On the other hand, third parties should be able to rely on the definitional and public notice function of the claims so that they could recognize the clear boundary of the scope of the patent. In this regard, the doctrine of equivalents should take account of the public's need for clarity of patent coverage and the patentee's need for fair protection from infringement.

148. The provision provides that the doctrine of equivalents shall be applied to individual elements of the claim, not to the equivalent of the claimed invention as a whole, since each element contained in the claim is deemed essential to define the scope of protection. As regards the timing for the determination of an "equivalent" element, if an element of the alleged infringing good meets certain conditions at the time of the alleged infringement, i.e., at the time when the act of the alleged infringement was committed, that element would be considered as being equivalent to the claimed item. It is not possible for an applicant to draft a claim that literally encompasses all the allegedly equivalent elements derived from later developed technologies that were not known to a person skilled in the art at the time of filing the patent application. However, taking into account of the technological development which had taken place between the filing date and the time of the alleged infringement, third parties may, for example, substitute a claimed element (e.g., a vacuum tube) with an equivalent element (e.g., a transistor) without any innovative effort. If the equivalents were determined on the ~~claim~~ priority date of the claimed invention or on the date of the grant of the patent, the patentee may not be able to prevent third parties from, for example, simply replacing the claimed vacuum tube with the transistor, even if such a replacement was a general common knowledge at the time of alleged infringement.

149. An element is considered as being equivalent to the claimed element if it passes the following two tests. The first test is that the difference between the claimed element and the equivalent element is not substantial and the equivalent element produces substantially the

same result as the claimed element. Whether the difference between the claimed element and the equivalent element is substantial or not may be determined taking into account, for example, the following factors: (a) the function of the claimed element and the equivalent element; (b) the way the claimed element and the equivalent element perform; and (c) whether the substitution is predictable to a person skilled in the art. This is not an exhaustive list. Depending on each case, other factors may be taken into account. The second test is that a person skilled in the art had no reason to assume that the equivalent element had been excluded from the claimed invention. Factors such as: (a) whether the element falls within the scope of prior art with respect to the claimed invention and (b) acts and statements made with respect to the claimed invention to obtain and maintain a patent, may be taken into account in order to determine whether a person skilled in the art could reasonably assume that the element concerned had been excluded from the scope of the claimed invention. Again, these factors are not of an exhaustive nature.

150. Rule 13, paragraph (6). This provision provides the so-called “prosecution history estoppel” and aims at preventing applicants from extending the scope of protection of a claim to what the applicant or the patentee has explicitly excluded from the scope of the claim during prosecution. In view of the definitional and public notice functions of the claims, prosecution history ~~[shall][may]should~~ be taken into account for determining the scope of patented claims so that third parties would be able to rely on limitations made to the claimed invention during ~~the~~ prosecution under certain circumstances having regard to the prior art. In any event, whether a particular prior statement with respect to a particular patented claim would affect the determination of the scope of that claim or not should be considered on a case by case basis by the Office or a court. The term “any statement” includes amendments or corrections of the application or the patent.

151. The statement limiting the scope of the claims shall be taken into account only within the jurisdiction for which the statement has been made. Further, if a statement made during the prosecution of a parent application of a divisional or continuation-in-part application is relevant to the claims contained in the divisional or continuation-in-part application, such a statement may be taken into account for the purposes of determining the scope of those claims contained in the divisional or continuation-in-part application.

Guidelines Under Article 12(1) and (5) and Rule 16
(Details Concerning Subject Matter Eligible for Protection and Exceptions)

Subject Matter Eligible for Protection

[Reserved]

Exceptions

[Reserved]

Guidelines Under Article 12(2) and Rule 14
(Details Concerning Novelty)

152. Article 12, paragraph (2). This paragraph provides the condition of novelty. The novelty requirement is considered to be complied with where the invention does not form part of the prior art. The definition of prior art is contained in draft Article 8, draft Rules 8 and 9. Article 9 which relates to the grace period should also be taken into account. Details on an item of prior art relevant to the determination of lack of novelty are contained in draft Rule 14.

Item of Prior Art

153. Rule 14, paragraph (1)(a) and (b). ~~This paragraph~~ These provisions contains two widely recognized principles with respect to the assessment of novelty: firstly, subparagraph (a) contains the self-evident principle according to which the item of prior art must enable a person skilled in the art to make and use the claimed invention, since otherwise, lack of novelty could not be justified. Secondly, ~~item (i)~~ subparagraph (b) states that a “mosaic” approach to assessing novelty, whereby a plurality of items in the prior art are combined to defeat the novelty of an invention, may not be used. ~~Secondly, item (ii) contains the self-evident principle according to which the primary item of prior art must enable a person skilled in the art to make and use the claimed invention, since otherwise, lack of novelty could not be justified.~~

154. It should be noted that the words “any item of prior art” do not mean a particular physical item, such as a book, a journal or a patent application, which contains a teaching that forms part of the prior art. Rather, they should be considered as a reference to the particular teaching itself. Therefore, in accordance with this paragraph, where a book contains more than one teaching, each teaching should be taken into account individually for the determination of lack of novelty.

155. Rule 14, paragraph (1)(c). Where there was a specific reference in the item of prior art contains a specific reference to one or more other items of prior art, the teachings of the items of prior art which were referred to should be considered as being incorporated by reference in the item of prior art; if the items of prior art referred to were also available to the public on the date on which the item of prior art was made available to the public. The same principle applies to an item of prior art in electronic form or made available to the public in by electronic means, such as hyperlinks in an Internet publication.

156. Rule 14, paragraph (2). This paragraph deals with the questions of how, when and by whom the scope of the ~~primary~~ item of prior art shall be determined. As regards the words “inherently disclosed,” even if a certain characteristic is not disclosed explicitly in the item of prior art, such characteristic is inherent, where it could be recognized by a person skilled in the art that, taking into account his/her general knowledge, the characteristic is necessarily contained in the disclosure. Inherency requires that the extrinsic evidence should make it clear that the missing descriptive matter is necessarily present in the information described in the item of prior art, and that it would be so recognized by a person skilled in the art. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

[Alternative A: The scope of the ~~primary~~ item of prior art shall be determined by the explicit or inherent disclosure as of the date on which the ~~primary~~ item of prior art was made available to the public. The disclosure of the ~~primary~~ item of prior art shall be determined by a person skilled in the art on the claim date, i.e., a person skilled in the art on the claim date would determine the contents of the primary item of prior art as of the date on which the primary item of prior art was made available to the public. However, the person skilled in the art on the claim date should not interpret the contents of the primary item of prior art by using the knowledge which became available after the date on which the primary item of prior art was made available to the public (in other words, technical advancement) as of that date. Further,

~~even if a certain characteristic is not disclosed explicitly in the primary item of prior art, such characteristic is inherent, where it could be recognized by a person skilled in the art that, taking into account his/her general knowledge, the characteristic is necessarily contained in the disclosure.~~ The critical time for the determination of the general knowledge of a person skilled in the art is thus the date on which the ~~primary~~ item of prior art was made available to the public. Consequently, the general knowledge of a person skilled in the art as of that date is taken into account to determine what is explicitly or inherently “disclosed” in the item of prior art. However, it follows from draft Rule 14(1)(b) that the general knowledge of such a person cannot be combined with the explicit or inherent disclosure in the item of prior art for the purpose of assessing novelty. For example, where the ~~primary~~ item of prior art explicitly indicates a “vacuum tube,” even if replacing a vacuum tube with a transistor has become a part of the general knowledge of a person skilled in the art after the date on which the ~~primary~~ item of prior art was made available to the public, ~~a person skilled in the art on the claim date shall determine~~ the scope of the ~~primary~~ item of prior art as being is considered to be limited to the “vacuum tube.” In the cases where the ~~primary~~ item of prior art is another earlier application under draft Article 8(2), reference is made to draft Rule 14(3).] [Alternative B: The scope of the item of prior art shall be determined by what was explicitly or inherently disclosed to a person skilled in the art as of the priority date of the claimed invention. Consequently, this person would utilize his general knowledge as of the priority date of the claimed invention in order to determine the subject matter which is disclosed explicitly or inherently in the item of prior art. For example, where the item of prior art explicitly indicates a “vacuum tube,” if replacing the vacuum tube with a transistor was part of the general knowledge of a person skilled in the art as of the priority date of the claimed invention, the item of prior art inherently disclosed a transistor in the place of a vacuum tube.]

164. ~~Where there was a specific reference in the primary item of prior art to one or more other items of prior art, the teachings of the items of prior art which were referred to should be considered as being incorporated by reference in the primary item of prior art, if the items of prior art referred to were also available to the public on the date on which the primary item of prior art was made available to the public. The same principle applies to an item of prior art in electronic form or made available to the public in electronic means, such as hyperlinks in an Internet publication.~~

Methodology for Assessment of Novelty

157. For the assessment of novelty, the following steps shall be applied:

(i) determination of the [scope][elements] of the claimed invention;

(ii) determination of the [disclosure in][elements of] the a relevant item of prior art (“primary item of prior art”);

(iii) assessment whether every and each element or step of the claimed invention is found in the scope of the primary item of prior art as prescribed in Rule 14(2).

158. An item of prior art that discloses a genus does not always anticipate a claim to a species within the genus. In other words, where a claim contains a specific disclosure, for the determination of novelty, a generic disclosure in the item of prior art does not always anticipate the claim to a specific example falling within that generic disclosure. However, where the specific example is identified with sufficient specificity in the scope of the item of prior art, the species claim is anticipated no matter how many other species are additionally described in the item of prior art.

159. On the other hand, where a claim contains generic disclosure, for the determination of novelty, the disclosure of a specific example in the item of prior art falling within a claimed generic disclosure anticipates that generic disclosure. For example, the disclosure of “copper” in the item of prior art defeats the novelty of a claim comprising “metal” as a generic concept. Similarly, where a claim defines the genus of specific species in the alternatives, for example, Markush claims (P1, P2, P3 ... Pn), ~~the claim is anticipated and~~ if at least one of the alternatives (P1) is described in the item of prior art, the whole claim would be rejected unless the applicant delete the alternative P1 from the scope of that claim.

160. A specific example in the item of prior art which is within a claimed range anticipates the range claimed. Therefore, where, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is anticipated if one of them is described in the item of prior art. For example, a claim to titanium (Ti) alloy with 0.6 to 0.7% nickel (Ni) and 0.2 to 0.4% Molybdenum (Mo) would be anticipated by an item of prior art that describes a Ti alloy

containing 0.65% Ni and 0.3% Mo. Where an item of prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range was disclosed, a case by case determination must be made as to the novelty of the claim. In order to anticipate the claims, the claimed subject matter should be disclosed with sufficient specificity in the item of prior art. If the claims are directed to a narrow range and the item of prior art discloses a broad range, and if the selected narrow range is not merely one way of carrying out the teaching of the item of prior art (for example, there is evidence that the effect of the selection (e.g., unexpected results) occurred in all probability only within the claimed narrow range), depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with sufficient specificity in the item of prior art in order to anticipate the claims (a selection invention). The unexpected results may also render the claims unobvious.

161. In accordance with the general principle concerning the submission of evidence under Article 16, in order to determine the scope of the ~~primary~~-item of prior art referred to in Rule 14(2) and to ensure that the ~~primary~~-item of the prior art is enabling under Rule 14(1)(~~ii~~), the following evidence shall be taken into account, where appropriate:

- (i) evidence which explains the meaning of terms used in the ~~primary~~-item of prior art;
- (ii) evidence which shows that what is not disclosed in the ~~primary~~-item of prior art is inherent;
- (iii) evidence which contributes to determine whether the ~~primary~~-item of prior art was enabling.

Guidelines Under Article 12(3) and Rule 15
(Details Concerning Inventive Step/Non-Obviousness)

162. Article 12, paragraph (3). The condition of inventive step/non-obviousness is fulfilled if the claimed invention, compared to the prior art, would not have been obvious to a person skilled in the art at the priority date of the claimed invention. The terms “having regard to the

differences and similarities between the claimed invention as a whole and the prior art” point to the steps which are usually applied in practice when assessing the requirement, but also make it clear that the claimed invention as a whole must be inventive/non-obvious. ~~The definition of the prior art contained in d~~Draft Article 8(2) excludes the prior art effect of earlier applications with respect to the determination of inventive step/non-obviousness. Details on the requirement of inventive step/non-obviousness are contained in draft Rule 15.

163. Rule 15, paragraph (1). Unlike for the determination of novelty, multiple items of prior art may be combined for the determination of whether the requirement of inventive step (non-obviousness) is met. As regards the words “items of prior art,” reference is made to the explanation in paragraph 154. The terms “multiple items of prior art” intend to cover the different situations where there are several teachings contained in different prior art references, for example, different published patents, or several teachings contained in the same prior art reference, such as one particular book.

164. Rule 15, paragraph (2). In determining the scope of the disclosure of the items of prior art, in addition to the explicit disclosure, an implicit inherent disclosure, i.e., a teaching which a person skilled in the art could reasonably draw from the explicit disclosure, shall also be taken into account. The critical time for the determination of such disclosure is the ~~claim~~ priority date of the application-claimed invention concerned.

165. Rule 15, paragraph (3) contains the general and widely accepted principle that the general knowledge of the person skilled in the art shall be taken into account for the determination of inventive step (non-obviousness).

166. Rule 15, paragraph (4). This paragraph deals with the assessment of inventive step (non-obviousness). The combination, substitution or modification of one or more items of prior art may only lead to a lack of inventive step (non-obviousness), where a person skilled in the art would have been [motivated][prompted] by the prior art or his general knowledge, with a reasonable likelihood, to combine, substitute or modify one or more of the teaching of the items of prior art. Conversely, where such combination could not have been expected from a person skilled in the art, the requirement of inventive step (non-obviousness) would be met, even if each single item would have been obvious if taken individually.

Methodology for Assessment of Inventive Step/Non-Obviousness

167. For the assessment of inventive step (non-obviousness), the following steps shall be applied:

- (i) determination of the [scope][elements] of the claimed invention;
- (ii) determination of the [disclosure in][elements of] the relevant item(s) of prior art;
- (iii) determination of a person skilled in the art in the relevant case;
- (iv) identification of the differences and similarities between the relevant item(s) of prior art and the claimed invention;
- (v) assessment whether the claimed invention as a whole would have been obvious for a person skilled in the art having regard to the relevant item(s) of prior art and the general knowledge of a person skilled in the art. [This may be done through establishing the objective technical problem to be solved and whether the solution ~~brought~~ offered by the claimed invention would have been obvious to the person skilled in the art. The objective technical problem can always be formulated (“finding an alternative”, “making it easier to manufacture”, “cheaper to manufacture”) even in the case where there is no technical progress.]

168. In order to establish a *prima facie* case of obviousness and to determine whether there was any motivation, either in the prior art or in the general knowledge of a person skilled in the art as of the ~~claim~~ priority date of the claimed invention, to modify, substitute or combine the teachings of the prior art, the following factors, in particular, shall be considered:

- (i) relevance of the field of the art;
- (ii) relevance of the problem to be solved;
- (iii) relevance of the function or the characteristic of the art;

(iv) reasonable degree of predictability of the claimed invention, for example, the claimed invention does not involve an unexpected result.

169. According to Rule 2, a person skilled in the art is deemed to have the general knowledge and ordinary skills in the relevant field of the art. Common practices and experiments that normally require only the general knowledge and ordinary skills in the art are hence considered routine expedients by the person skilled in the art. Therefore, where, on the basis of the relevant items of prior art and the general knowledge, a person skilled in the art would reach the claimed invention by way of utilizing such routine expedients, the claimed invention shall be considered obvious. However, this would not apply if other evidence shows that the claimed invention does in fact involve an inventive step (is non-obvious).

170. In order to establish the positive assertion that the claimed invention involves an inventive step (non-obviousness), the following factors, in particular, shall also be taken into account as secondary considerations:

- (i) whether the claimed invention fulfils a long-felt need;
- (ii) whether the claimed invention overcomes a scientific prejudice;
- (iii) whether others have previously attempted, but failed to achieve what the claimed invention achieves;
- (iv) whether the claimed invention involves an unexpected result;
- (v) whether the claimed invention has a particular commercial success.

Guidelines Under Article 12(4)
(Details Concerning Industrial Applicability/Utility)

171. Article 12, paragraph (4). ~~This paragraph contains the condition of patentability of industrial applicability/utility. In order to reflect the debate at the SCP, three alternatives are proposed in this provision: the second and the third alternative reflect the standard contained~~

~~in many national/regional legislation concerning industrial applicability and utility, respectively. The first alternative attempts to take into consideration the essence of both requirements, including real practices, and reflects a more global approach, whereby an invention would have to be able to be made or used in any field of [commercial] activity. This alternative is intended to provide a single definition accommodating both “industrial applicability” and “utility”, since it contains the aspect of making or using the invention in any field of [commercial] activity and the aspect of exploitation, which implies a practical use of the invention. The term “commercial activity” covers any economic activity outside the sphere of a “private activity.” It should be noted, however, that, even if the word “commercial” was deleted from this paragraph, a Contracting Party would be free to allow the private use of a patented invention by third parties as an exception to the exclusive rights conferred by the patent, since the issue of the rights conferred by a patent is outside the scope of the SPLT. [Similarly, inventions concerning “methods for treatment of the human or animal body or surgery or therapy or of diagnosis practiced on the human or animal body” may be excluded from patentable inventions under applicable law of a Contracting Party.] The second sentence of Alternative B is modeled after Article 1(3) of the Paris Convention.~~

~~180. Although the requirement concerning industrial applicability/utility is closely related to other requirements such as the enabling disclosure requirement, patentable subject matter, and exceptions to the rights conferred by a patent, these requirements are distinct requirements. Further, the question concerning the technical character of an invention and the industrial applicability/utility requirement are also separate issues.~~

[Reserved pending the discussion based on document SCP/9/5]

Guidelines Under Article 13⁴

(Details Concerning Grounds for Refusal of a Claimed Invention)

172. Paragraph (1). This paragraph provides for the grounds on which an application shall be refused. It aims at covering all the requirements relating to the examination of an application and to the grant of a patent on a claimed invention. For that reason, the

⁴ The Guidelines under draft Articles 13 and 14 have not been revised, since the SCP agreed to postpone the discussion on these Articles.

requirements of the Patent Law Treaty, which relates to formality requirements, are also covered under this provision.

173. It follows from the words “where the Office finds that” that the Office is not obliged to examine all the requirements referred to in this paragraph before the grant of a patent. If, however, the Office finds that there is any non-compliance with one or more of those requirements during the examination procedure, it should refuse the application.

174. Paragraph (2). This paragraph explicitly provides that, as far as requirements relating to the examination of an application and to the grant of a patent on a claimed invention are concerned, a Contracting Party may not refuse an application on the basis of any requirements different from or additional to those prescribed in paragraph (1). Additional consequences of the non-compliance with the requirements contained in this provision are not regulated by the Treaty or the Regulations. For example, where new matter was included in the application after the original filing date, a Contracting Party would be free to provide the possibility of according a different filing date to the relevant parts relating to the new matter.

Guidelines Under Article 14⁴

(Details Concerning Grounds for Invalidation or Revocation of a Claim or a Patent)

175. Paragraph (1). This paragraph provides for the grounds on which a patent, or, where applicable, a patented claim, shall be revoked or invalidated. The words “subject to the Patent Law Treaty” are included to ensure that Article 10(1) of the Patent Law Treaty continues to apply, i.e., non-compliance with one or more of the formal requirements referred to in Articles 6(1) [form or contents of application], (2) [request form], (4) [fees] and (5) [priority document] and 8(1) to (4) [form and means of transmittal of communications, language of communications, model international forms and signature of communication] of the PLT with respect to an application may not be a ground for revocation or invalidation of a patent, either totally or in part, except where the non-compliance with the formal requirement occurred as the result of a fraudulent intention.

176. Similarly, this provision expressly provides that non-compliance with the requirements referred to in draft Articles 6 [unity of invention] and in the Regulations under draft

Article 5(~~2~~1)(a), namely draft Rules 4 and 5, may not be a ground for the revocation or invalidation of a patent or a claim. These requirements, although they may be needed for the processing of the application, are not essential to the patentability of the claimed invention.

177. This paragraph applies to these grounds independently of whether they are examined before the Office or before any other competent authority, including a court. The words “the invalidation or revocation” is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforceability of rights.

178. Paragraph (2). This paragraph explicitly provides that a Contracting Party may not invalidate or revoke a patented claim or a patent on the basis of any requirements different from or additional to those prescribed in paragraph (1). Concerning the words “the invalidation or revocation,” reference is made to the explanation under paragraph (1) (see paragraph 177).

Guidelines Under Article 15
(Details Concerning Review)

179. The term “quasi-judicial authority” aims to avoid any controversy as to whether, for example, the boards of appeal of a regional organization or an appeal body in a national Patent Office would be considered as judicial authorities.

Guidelines Under Article 16
(Details Concerning Evidence)

180. This Article provides the general principles with respect to the submission of evidence. Under these principles, an applicant or any third party may initiate, or the Office of a Contracting Party may require, the submission of evidence supporting the ~~veracity~~ accuracy of any alleged fact ~~in relation to~~ relevant in the determination of patentability of the claimed invention ~~and the validity of the patented claim.~~

[End of document]