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PROPOSAL FROM THE UNITED STATES OF AMERICA, JAPAN
AND THE EUROPEAN PATENT OFFICE REGARDING
THE SUBSTANTIVE PATENT LAW TREATY (SPLT)

Document prepared by the International Bureau

1. The Annex to this document contains a proposal in respect of the draft Substantive Patent Law Treaty (SPLT) received by the United States of America, Japan and the European Patent Office.

2. *The Members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

ANNEX

**PROPOSAL IN RESPONSE TO DOCUMENT SCP/10/8 REGARDING
INFORMATION ON CERTAIN RECENT DEVELOPMENTS IN RELATION TO
THE DRAFT SUBSTANTIVE PATENT LAW TREATY (SPLT)**

by the United States, Japan, and the European Patent Office

Background

Since November 2000, the SCP has held five sessions to discuss the scope and content of the SPLT. This work has yielded many useful results. With respect to the scope of the SPLT, it was decided that the treaty should address issues related to the grant and validity of patents, such as prior art, novelty, inventive step/nonobviousness, industrial applicability, disclosure requirements, and claim interpretation. In addition, the SCP agreed that issues related to the exercise of patent rights or the impact of exploitation of patent rights fell outside the scope of the SPLT, and that infringement issues, for the most part, would not be covered by the SPLT.

While a good deal of progress has been achieved thus far, recent discussions in the SCP suggest that the current model for discussion is not as productive as it could and should be. There are several reasons for the recent lack of progress. One shortcoming is the sheer volume and complexity of issues to be covered at each SCP session. This leads to inadequate discussion of certain issues and continuous postponement of others. Second, several provisions included in the draft treaty have been extremely controversial and of a high political sensitivity. Discussions on these divisive issues have been the focus of much debate within the SCP and, as a result, have often hampered the desired progress.

Against this background and as noted by the International Bureau in SCP/10/8 several groups, including the Trilateral Offices (United States Patent and Trademark Office, Japan Patent Office, and the European Patent Office), have met since the May 2003 SCP meeting to discuss how to advance the SPLT at the upcoming May 2004 SCP.

Trilateral Efforts

The Trilateral Offices share the goals of the SCP in reducing the workload on applicants and patent offices and improving patent quality by harmonizing the substantive aspects of patent law governing the grant of a patent. It has become apparent, however, that an expansive SPLT, including all issues currently included in the draft SPLT documents for this May SCP meeting, might not be achievable in the near future. For this reason, the Trilateral Offices have come to the conclusion that their future harmonization efforts should be based on the following five guiding principles:

1. Take a pragmatic approach aimed at early and realistic results;
2. Aim towards a feasible package without adherence to a rigid framework;
3. Pursue best practice taking into account current practices;

4. Address users' interests as much as possible; and
5. Promote the discussion at the SCP.

In following these principles, the Trilateral Offices share the view that a more productive and effective way to proceed in the SCP would be to focus attention on a limited set of SPLT provisions likely to lead to near-term agreement. Hence, rather than attempt to resolve the entire text of the current draft at once, focusing attention on an appropriately selected "package" of provisions would have significant advantages. First, a limited number of provisions will permit more comprehensive discussions. Second, by reducing the number of issues to be addressed, progress may be achieved more rapidly. Third, an appropriately selected first package of provisions can serve to facilitate the objectives of enhancing patent quality and producing beneficial results for users of the patent system.

Proposed Framework for Harmonization

We propose a revised approach that focuses on an initial package of priority items. In doing this, it is suggested that a logical place to begin discussions is with prior art-related issues, more specifically, the following topics:

1. Definition of Prior Art
2. Grace Period*
3. Novelty
4. Non-obviousness/Inventive Step

We believe that the prior art-related provisions of the SPLT will provide the best opportunity for near-term agreement and results. Agreement on these issues would result in consistent examination standards throughout the world, improve patent quality, and reduce the duplication of work performed by patent offices. An internationally recognized definition of prior art would improve patent quality and address concerns regarding protection of traditional knowledge, as discussed by the WIPO Intergovernmental Committee on Traditional Knowledge, Genetic Resources and Folklore.

Another advantage to this approach is that certain contentious issues, which have divided the SCP, will be set aside initially. While proponents of this Proposal might prefer a more expansive treaty, it is with this spirit of compromise that we propose the aforementioned framework for proceeding within the SCP. This approach still provides sufficient flexibility required for national practices to continue or proceed at whatever pace or level is appropriate.

* *Since grace period and first-to-file are linked, grace period, although included in the first package for discussion, is subject to movement on first-to-invent.*

Once international agreement is reached on prior art issues, discussions in the SCP could then focus on other related issues which may include the following topics: (i) disclosure requirements, (ii) claim drafting and (iii) unity of invention/restriction. Also, to the extent that further related issues arise, it may be beneficial to broaden the discussion to include such topics.

We believe that twenty years is far too long to have dwelled on a subject so important to the global economy, to the users of the patent system and to patent offices worldwide. For this reason, it is further proposed that the SCP take up the above-identified topics for discussion at the May 2004 meeting with a view to reaching near-term agreement so that a Diplomatic Conference on a first package of items could be envisaged for the first half of 2006. Such a time frame will send a positive message to the users of the patent system as to the willingness of the Members to conclude a meaningful treaty as soon as possible.

Conclusion

It is our sincere hope that we can achieve meaningful progress at the May SCP meeting toward our shared objective of substantive patent law harmonization. We believe that the current proposal, outlined above, presents a constructive contribution to this end.

[End of Annex and of document]