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NOTES ON THE BASIC PROPOSAL FOR THE TREATY AND REGULATIONS AS
SUBMITTED TO THE DIPLOMATIC CONFERENCE FOR THE CONCLUSION OF A
TREATY SUPPLEMENTING THE PARIS CONVENTION AS FAR AS PATENTS ARE
CONCERNED, THE HAGUE, JUNE 3 TO 28, 1991

Document prepared by the International Bureau

The present document reproduces, in the Annex, for information purposes, the Notes on the Basic Proposal for the Treaty and Regulations (document PLT/DC/4), dated December 21, 1990, as submitted to the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned, held in The Hague, from June 3 to 28, 1991.

[Annex follows]

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ANNEX

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DIPLOMATIC CONFERENCE FOR THE CONCLUSION
OF A TREATY SUPPLEMENTING THE PARIS CONVENTION
AS FAR AS PATENTS ARE CONCERNED

The Hague
June 3 to 28, 1991

NOTES
ON THE BASIC PROPOSAL
FOR THE TREATY AND REGULATIONS

prepared by the Director General of WIPO

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CONTENTS

I. GENERAL EXPLANATIONS ON THE NOTES

II. NOTES ON THE DRAFT TREATY

Note on Preamble

Note on Article 1 (Establishment of a Union)

Note on Article 2 (Definitions)

Note on Article 3 (Disclosure and Description)

Note on Article 4 (Claims)

Note on Article 5 (Unity of Invention)

Note on Article 6 (Identification and Mention of Inventor;
Declaration Concerning the Entitlement of the Applicant)

Note on Article 7 (Belated Claiming of Priority)

Note on Article 8 (Filing Date)

Note on Article 9 (Right to a Patent)

Note on Article 10 (Fields of Technology)

Note on Article 11 (Conditions of Patentability)

Note on Article 12 (Disclosures Not Affecting Patentability (Grace Period))

Note on Article 13 (Prior Art Effect of Certain Applications)

Note on Article 14 (Amendment or Correction of Application)

Note on Article 15 (Publication of Application)

Note on Article 16 (Time Limits for Search and Substantive Examination)

Note on Article 17 (Changes in Patents)

Note on Article 18 (Administrative Revocation)

Note on Article 19 (Rights Conferred by the Patent)

Note on Article 20 (Prior User)

Note on Article 21 (Extent of Protection and Interpretation of Claims)

Note on Article 22 (Term of Patents)

Note on Article 23 (Enforcement of Rights)

Note on Article 24 (Reversal of Burden of Proof)

Note on Article 25 (Obligations of the Right Holder)

Note on Article 26 (Remedial Measures Under National Legislation)

Note on Article 27 (Assembly)

Note on Article 28 (International Bureau)

Note on Article 29 (Regulations)

Note on Article 30 (Settlement of Disputes)

Note on Article 31 (Revision of the Treaty)

Note on Article 32 (Protocols)

Note on Article 33 (Becoming Party to the Treaty)

Note on Article 34 (Effective Date of Ratifications and Accessions)

Note on Article 35 (Reservations)

Note on Article 36 (Special Notifications)

Note on Article 37 (Denunciation of the Treaty)

Note on Article 38 (Languages of the Treaty; Signature)

Note on Article 39 (Depositary)

III. NOTES ON THE DRAFT REGULATIONS

- Note on Rule 1 (Definitions (ad Article 2))
- Note on Rule 2 (Contents and Order of Description (ad Article 3(2)))
- Note on Rule 3 (Manner of Claiming (ad Article 4(5)))
- Note on Rule 4 (Details Concerning the Requirement of Unity of Invention (ad Article 5(1)))
- Note on Rule 5 (Divisional Applications (ad Article 5(1)))
- Note on Rule 6 (Manner of Identification and Mention of Inventor (ad Article 6))
- Note on Rule 7 (Details Concerning the Filing Date Requirements (ad Article 8))
- Note on Rule 8 (Announcement in the Gazette of the Publication of an Application (ad Article 15(1)))
- Note on Rule 9 (Announcement in the Gazette of the Publication of a Change in a Patent (ad Article 17(5)))
- Note on Rule 10 (Announcement in the Gazette of the Grant of a Patent (ad Article 18(1)(b)))
- Note on Rule 11 (Absence of Quorum in the Assembly (ad Article 27))
- Note on Rule 12 (Requirement of Unanimity for Amending Certain Rules (ad Article 29(3)))
- Note on Rule 13 (Settlement of Disputes (ad Article 30))

I. GENERAL EXPLANATIONS ON THE NOTES

0.01 This document contains notes on the Draft Treaty Supplementing the Paris Convention as far as Patents are Concerned (Patent Law Treaty) and the Draft Regulations under that Treaty contained in document PLT/DC/3 (hereinafter referred to as the “Draft Treaty” and the “Draft Regulations,” respectively).

0.02 Notes have been prepared only with respect to those provisions of the Draft Treaty and the Draft Regulations which seem to require comments.

0.03 The Draft Treaty and the Draft Regulations contain, in respect of 12 provisions, alternatives: in respect of 11 provisions, they are designated with two letters, namely, “A” and “B” (Preamble; Articles 8(4), 10, 19, 20(1), 22, 24, 25, 26 and 35; Rule 2(2)), and in respect of one provision (Article 19) with three letters, namely, “A,” “B,” and “C.” Draft Rule 29(1)(b) of the Draft Rules of Procedure of the Diplomatic Conference contains the following provision dealing with such alternatives:

“Where, for any given Article, there are two or three alternatives in the basic proposal, consisting of either two or three texts, or one or two texts and an alternative that there should be no such Article, the alternatives shall be designated with the letters A, B and, where applicable, C, and shall have equal status. Discussions shall take place simultaneously on the alternatives and, if voting is necessary and there is no consensus on which alternative should be put to the vote first, each Member Delegation shall be invited to indicate its preference among the two or three alternatives. The alternative supported by more Member Delegations than the other alternative or, where there are three alternatives, any of the other alternatives, shall be put to the vote first.”

0.04 The Draft Treaty contains, in respect of six provisions, text which appears in square brackets, namely, in Articles 7(2), 11(2)(c), 13(4)(b), 19(3)(a)(iii) (Alternative B), 27(4)(b) and (c). Draft Rule 29(1)(c) of the Draft Rules of Procedure of the Diplomatic Conference contains the following provision concerning such texts:

“Wherever the basic proposal contains words within square brackets, only the text that is not within square brackets shall be regarded as part of the basic proposal, whereas words within square brackets shall be treated as a proposal for amendment if presented as provided in paragraph (2).”

II. NOTES ON THE DRAFT TREATY

Note on the Preamble

P.01 Article 19 of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the “Paris Convention”) reads as follows:

“It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.”

Note on Article 1

(Establishment of a Union)

1.01 There are two kinds of unions established by special agreements under the Paris Convention: those which entail financial obligations for the members and those without such obligations. The union to be established by the present Treaty would be of the latter kind.

Note on Article 2

(Definitions)

2.01 It is to be noted that the terms “official language” and “inventor” are not included in Article 2 because each is used for the purposes of one provision of the Treaty only, namely, Articles 8(5) and 12(1), respectively. The terms are defined in Articles 8(5)(d) and 12(2), respectively.

2.02 The terms defined in Article 2 are listed in the order of their first appearance in the Treaty (starting with Article 3).

2.03 Item (i) does not attempt to define the constituent elements of an application. Usually, an application would be considered to comprise a request (for the grant of a patent), a description, one or more claims, one or more drawings (where required) and an abstract (see, for example, Article 3(2) of the Patent Cooperation Treaty (PCT)). In the present Treaty, however, this matter is not regulated so that, subject to the requirements of this Treaty (such as, for example, the requirements to accord a filing date when the conditions of Article 8 are satisfied or to comply with the stipulations of Article 3 and Rule 2 concerning the description), each Contracting Party would be free to decide what elements constitute an application.

2.04 The terms “application” and “application for a patent” are used in Articles 2(ii) and (ix); 3(1) and (2)(a); 4(1); 5; 6(1), (2) and (3); 7; 8; 9(2); 11(2)(b) and (3); 12(1) and (2); 13; 14; 15; 16(1)(a) and (b) and (2); 17(4); 18(2)(c); 20(1); 22(2) (Alternative B); 23(2); 25(1)(i), (ii) and (iv) (Alternative B); 37(2). They also appear in Rules 1(3); 2(1)(vi) and (3); 3(1) and (4)(c); 5(1) and (2); 6(2); 7(1)(b), (2), (3) and (5); 8; 10.

2.05 Item (ii): The term “priority date” is used in Articles 3(1)(b); 9(2)(ii); 11(2)(b) and (3); 12(1); 13(1)(b); 15(1); 20(1); 25(1)(i); as well as in Rule 2(1)(vi).

2.06 Item (iii): The term “prescribed” is used in Articles 3(2)(b); 4(5); 6(1); 8(2), (4) and (5)(b); 29(1)(i); 30(1)(b) and (3)(c); as well as in Rule 7(2).

2.07 Item (iv): The term “patent” is used in the Treaty to refer only to patents for inventions and to exclude other titles of industrial property that are sometimes referred to in national laws as “patents,” such as patents for designs, patents for utility models, petty patents and plant patents.

2.08 The term “patent” is used in the Preamble, Articles 2(i), (ii), (iv) and (v); 5(2); 6(1)(b) and (2); 8(1)(i) and 8(6)(b); 9; 10(1) and (2) (Alternative A) and 10 (Alternative B); 12(2); 13(1)(a) and (b) and (3); 17; 18(1)(a), (b) and (e) and (2); 19 (Alternatives A and B); 20(1) (Alternatives A and B); 21(1), (3), (4) and (5); 22 (Alternatives A and B); 23; 24(1) (Alternative B); 25(1) and (2) (Alternative B); 26 (Alternative B); 33(1)(i) and (iii); 35(2) and (4)(a); 36(1)(a); 37(2); as well as in Rules 1(1)(a) and (3); 5(1)(b); 7(4); 8; 9; 10.

2.09 Item (v): The term “Office” is used in Articles 2(ii) and (ix); 6(2); 7; 8(1), (2), (3), (4) and (5); 12(1)(ii); 14(1) and (2); 15(1)(a), (2) and (4); 16(1)(a), and (2); 17(1), (2), (3) and (5); 18(1)(a), (d) and (e) and (2); 25(1)(ii); 33(1)(i) and (iii); 35(2) (Alternative B); 36(1); as well as in Rules 1(3)(i) and (ii); 5(2); 6(2); 7(1) to (4); 8(iv); 10(iv).

2.10 Item (vi): The term “person” is used in Articles 9(1); 12(2); 18(1)(a) and (d); 19(4) (Alternative B) and 19(3)(c) (Alternative C); 20(1); 23(1) and (2)(a); 26(3) (Alternative B); as well as in Rule 1(3).

2.11 Item (vii): The term “Director General” is used in Articles 10(3) (Alternative A); 15(1)(b); 18(2)(c); 21(2)(c); 24(1)(b) (Alternative B); 27(2)(a)(v) and (vi), (4)(c) and (7); 28(1)(ii), and (2) to (5); 30(3)(b) and (c); 33(3)(b); 36(4)(b); 37; 38(1)(b); 39; as well as in Rule 13(2).

2.12 Item (viii): The term “published” is used in Articles 13(1)(a) and (2); 15(2) and (4); 16(1); 17(3); 23(2). The definition is to be read in conjunction with Rule 1(3), which indicates the means which must be considered as making an application, search report, a patent or a change in a patent accessible to the public and, therefore, as rendering the application, search report, patent or change “published.”

2.13 Item (ix): The term “substantive examination” is used in Articles 14(2); 16(1)(a) and (2); 18(1)(a).

2.14 Item (x): The term “instrument of ratification” is used in Articles 15(1)(b); 21(2)(c); 24(1)(b) (Alternative B); 33(2)(i) and 3(a); 35(1)(a) (Alternative B); 36(4)(a).

- 2.15 Item (xi): The term “Assembly” is used in Articles 27; 28(1), (3) to (5); 29(2); 30(3)(a) and (f) and (4); 38(1)(b); as well as in Rules 11; 12.
- 2.16 Item (xii): The term “Union” is used in Articles 1; 2(xi); 27(1)(a) and (c), (2)(a)(i), (vi), (vii) and (ix) and (b); 28(1)(i) and (ii) and (2) to (4).
- 2.17 Item (xiii): The term “Organization” is used in Articles 27(2)(b) and (7)(a); 28(1); 38(2).
- 2.18 Item (xiv): The term “Regulations” is used in Articles 3(3); 18(2)(c); 27(2)(a)(iii) and (9)(a); 29; as well as in Rules 1(1) and (2); 12.
- 2.19 It is to be noted that Rule 1(3) contains the definition of the term “accessible to the public.”

Note on Article 3
(Disclosure and Description)

- 3.01 Paragraph (2): It is to be noted that Rule 2 contains further details concerning the contents and the order of the description.
- 3.02 Paragraph (3): It is understood that the prohibition of additional or different requirements does not prevent a Contracting Party from requiring compliance with certain formal requirements, such as, in the case of paper filings, the use of a special form and the dimensions of text matter and drawings or, in the case of electronic filings, technical standards regarding the input and output of data.
- 3.03 It is to be noted that Rule 2(3) allows Contracting Parties to provide for special requirements in respect of the disclosure of nucleotides or amino acid sequences.

Note on Article 4
(Claims)

- 4.01 Paragraph (3): The number of claims per se cannot be the subject of an objection on the basis of the requirement of conciseness. The requirement of clarity would provide a basis for disallowing any claim that merely paraphrased another claim, since it would not be clear how such a claim differed from the earlier claim.
- 4.02 Since a trademark does not define a product, a reference in a claim to a trademark would be considered to impair the clarity of the claim and should, save in the exceptional case where such a reference may be unavoidable, be eliminated.
- 4.03 Paragraph (5): It is to be noted that Rule 3 contains further details concerning the manner of claiming.
- 4.04 Paragraph (6): As to the scope of the prohibition, see note 3.02, above.

Note on Article 5
(Unity of Invention)

5.01 Paragraph (1): It is to be noted that Rules 4 and 5 contain further details concerning the requirement of unity of invention.

5.02 Paragraph (2): The essential purpose of the requirement of unity of invention is to facilitate the administration and the search of applications. Accordingly, paragraph (2) provides that, while paragraph (1) requires that applications must conform to the requirement of unity of invention, if a patent happens to be granted on an application that does not comply with that requirement, the failure to comply with the requirement of unity of invention cannot be a ground for the invalidation or revocation of the patent. In other words, and as already stated, since the purpose of the requirement of unity of invention is to facilitate the administration and the search of applications, failure to comply with the requirement can and needs only be redressed at the application stage. At that stage, the sanction for non-compliance is the refusal of the grant of a patent unless the application is restricted through the elimination of certain claimed subject matter. The subject matter so eliminated may then be included in one or more “divisional” applications.

5.03 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.

5.04 Occasionally, in cases of lack of unity of invention, particularly if noted only after assessment of the prior art, the examiner will be able to make a complete search and examination for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. It is understood that, in those cases, the search and examination for the additional invention(s) should be completed in respect of the whole application, and no objection of lack of unity of invention should be raised.

Note on Article 6
(Identification and Mention of Inventor;
Declaration Concerning the Entitlement of the Applicant)

6.01 Paragraphs (1) to (3): It is to be noted that Rule 6 contains further details concerning the manner of the identification and mention of the inventor.

6.02 Paragraph (2) extends the right of the inventor, established by Article 4^{ter} of the Paris Convention, to be mentioned in the patent to any publication of the Office containing the application. Article 4^{ter} of the Paris Convention reads as follows: “The inventor shall have the right to be mentioned as such in the patent.”

6.03 As regards the meaning of “publication,” see Article 2(vii) and Rule 1(3).

6.04 Paragraph (3) allows a Contracting Party to require the indication--as opposed to the production of evidence--of the legal grounds of the applicant's entitlement. Such legal grounds might be, for example, assignment, employment or inheritance. Proof of the correctness of the indicated grounds of entitlement could not be required by the Office ex officio.

6.05 Paragraph (4): This paragraph does not affect such general, formal requirements as a requirement to furnish a transliteration of the inventor's name.

Note on Article 7
(Belated Claiming of Priority)

7.01 Paragraph (1) addresses the situation in which an application which could claim the priority of an earlier application does not, when filed, contain such a claim. The paragraph allows the claiming of priority in a separate declaration filed later than the application. This is permissible since the Paris Convention does not require that the priority claim ("the declaration" containing the priority claim, according to the terminology of Article 4D(1) of that Convention) be contained in the subsequent application itself.

7.02 Paragraph (2): It is to be noted that, if paragraph (2) is adopted, paragraphs (1) and (2) would not be mutually exclusive. Any applicant could invoke both paragraphs, as implied by the words "claims or could have claimed" in the opening of paragraph (2).

7.03 It is understood that an Office could require the payment of a special fee in either of the situations contemplated in paragraphs (1) and (2).

Note on Article 8
(Filing Date)

8.01 It is to be noted that certain details concerning the matter of filing date are provided for in Rule 7.

8.02 Paragraph (1) applies regardless of the medium (whether paper, electronic impulses or otherwise) in which the elements specified in it are or may be submitted to the Office. The manner of compliance may, however, take into account the particular medium required or allowed by an Office. For example, a Contracting Party whose Office requires or allows electronic filings may require that, in the case of such filings, the applicant identify himself by reference to an identification code which permits entry into the Office system. Such a requirement would be considered to comply with item (ii) of paragraph (1).

8.03 Paragraph (2)(a): The time limit is fixed in Rule 7(1)(a).

8.04 Paragraph (3) accords with Article 14(2) of the Patent Cooperation Treaty (PCT).

8.05 Paragraph (4): The time limit is fixed in Rule 7(1)(b).

8.06 Paragraph (5)(b): The time limit is fixed in Rule 7(1)(c).

Note on Article 9
(Right to a Patent)

9.01 Paragraph (1): It is understood that the ordinary rules in each Contracting Party applicable to the sale, transfer, devolution or other transmission of property rights, as well as rules on bankruptcy, apply to the right to a patent and are not affected by paragraph (1). Thus, if, in a given case, the inventor (or the employer or the person having commissioned the work of the inventor) has sold his right to a patent for a particular invention, the right to the patent would belong to the successor-in-title of the inventor (or of the employer or of the said person).

9.02 Paragraph (2): The result produced by paragraph (2) (namely, that where there are several inventors who have independently made the same invention, the right to a patent belongs to the one who was the first to file an application) applies regardless of when each of the inventors made the invention.

9.03 The prior art effect of an application in relation to a later application results from Articles 11 (Conditions of Patentability) and 13 (Prior Art Effect of Certain Applications).

9.04 The relationship of two applications filed by the same person with the same Office in respect of the same invention is regulated by the provision on self-collision in Article 13(4).

Note on Article 10
(Fields of Technology)

10.01 The Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (hereinafter referred to as the “Committee of Experts”) decided at its June 1990 meeting that this Article should contain two alternatives. Alternative A reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

Note on Article 11
(Conditions of Patentability)

11.01 Paragraph (2)(a): The second sentence means 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, cannot be used.

11.02 Paragraph (2)(b): It goes without saying that, in this subparagraph, as in all articles of the Draft Treaty, the term “priority date” means a priority date that is valid.

11.03 Paragraph (2)(c): It is left to general principles of international law to determine what areas of space, land, the sea and the sea-bed fall within and outside the sovereignty of each State.

Note on Article 12
(Disclosures Not Affecting Patentability (Grace Period))

12.01 Paragraph (1): The disclosure may have been made by any means and in any form: in writing, orally or in some other form (such as display at an exhibition or information via an electronic data base).

12.02 Paragraph (2): Persons, other than the inventor, who may have the right to a patent are, for example, the inventor's successor-in-title, his employer, the person commissioning the work that resulted in the invention, or a trustee in bankruptcy.

12.03 Paragraph (3): The phrase "at any time" means that the effects of paragraph (1) can be claimed at any stage of the patent-granting procedure or thereafter, for example, during invalidation proceedings.

Note on Article 13
(Prior Art Effect of Certain Applications)

13.01 Paragraph (1)(a): Since the term "application" only means an application for a patent (see Article 2(i)), applications for other titles protecting inventions (for example, utility models) do not have the prior art effect provided for in Article 13. However, where an application for a patent invokes the priority of an earlier application for a utility model, or other title protecting an invention, the prior art effect of the said application for a patent commences (for matter in both the application and the earlier application for a utility model, or other title protecting an invention, which has been invoked) from the priority date (see paragraph(1)(b)).

Note on Article 14
(Amendment or Correction of Application)

14.01 Paragraph (1): The "requirements" referred to in this paragraph may result from the Treaty, the applicable national or regional law or both the Treaty and such law.

14.02 The last sentence of paragraph (1) is intended to make it clear that the opportunity to amend or correct that must be provided under this paragraph arises independently of, and need only be given after, any opportunity to amend or correct, required under Article 8 and its corresponding rule (Rule 7(2)), in respect of elements submitted to obtain a filing date.

14.03 Paragraph (2): Abandoning a claim falls under the notion of amendment of an application.

Note on Article 15
(Publication of Application)

15.01 Paragraph (1): It is to be noted that Rule 8 requires that the publication of the application be announced by the competent Office in its official gazette. That Rule reads as follows:

“The publication of an application shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the applicant,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) if available, the symbols of the International Patent Classification.”

15.02 The said paragraph does not deal with the determination of the commencement of the 18-month or 24-month time limit in the case of divisional applications, continuation applications, or continuation-in-part applications. Such a determination is left to applicable national or regional law.

15.03 Paragraph (1)(a): As to the term “publish,” see Article 2(viii) and Rule 1(3). In particular, it may be noted that there is no obligation for the Office to distribute pamphlets containing the application, since publication may be effected by allowing inspection of the application and providing paper copies of it on request (Rule (1)(3)(ii)) or through an electronic communication which also permits a paper copy to be made (Rule (1)(3)(iii)).

15.04 The term “as soon as possible” would permit any unavoidable delays caused as a result of strikes, natural disasters or other cases of vis major, but not delays resulting merely from understaffing or inappropriate management arrangements.

15.05 Paragraph (1)(b): Naturally, the reservation referred to in this subparagraph may be withdrawn at any time.

Note on Article 16
(Time Limits for Search and Substantive Examination)

16.01 Paragraph (1): As to the term “publish,” see Article 2(viii) and Rule 1(3).

Note on Article 17
(Changes in Patents)

17.01 Paragraph (2): While the Treaty does not define “obvious mistakes” or “clerical errors,” they are understood to encompass defects in translations.

17.02 Paragraph (3): The last two words (“as published”) cover each successive text of any patent that has been the subject of changes.

17.03 Paragraph (5): As to the term “publish,” see Article 2(viii) and Rule 1(3).

17.04 It is to be noted that Rule 9 requires that the publication of a change of a patent be announced by the competent Office in its official gazette. That Rule reads as follows:

“The publication of a change in a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the serial number of the patent,
- (iii) the date of the change,
- (iv) the nature of the change.”

Note on Article 18
(Administrative Revocation)

18.01 Paragraph (1)(a): The term “document” means any permanent record of information such as, for example, information recorded on paper or information stored in an electronic form.

18.02 Paragraph (1)(b): It is to be noted that Rule 10 requires that the grant of a patent be announced by the competent Office in its official gazette. That rule reads as follows:

“The grant of a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) the serial number of the patent,
- (vi) if available, the symbols of the International Patent Classification.”

18.03 Paragraph (1)(d): The words “departing from the request” signify that an opportunity to present arguments must be accorded on the terms indicated in this provision wherever the decision of the Office does not exactly correspond to the decision requested. Thus, if it is requested that claims A and B be revoked, a proposed decision to revoke only claim B or to revoke claims A, B and C would constitute a “departing from the request” and would require that an opportunity be given to the person making the request to present arguments on the grounds on which the Office intends to depart from the request.

Note on Article 19
(Rights Conferred by the Patent)

19.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain three alternatives. Alternative C reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

19.02 Paragraph (3)(a)(iii): The words in square brackets (“or for the purpose of seeking regulatory approval for marketing”) cover, in particular, acts performed towards the end of a patent term in order to obtain approval of the competent authority for the marketing, following the expiration of the patent term, of a product protected by the patent.

Note on Article 20
(Prior User)

20.01 Paragraph (1): The definition of “good faith” is left to applicable national or regional law. In particular, it would be for that law to determine whether a prior use based on information obtained from a non-prejudicial disclosure made during the grace period (that is, a disclosure that does not affect patentability), as opposed to independent invention, constituted a use in good faith.

20.02 The term “territory” is to be interpreted in its broadest sense to cover any and all places and areas where the patent has effect.

Note on Article 21
(Extent of Protection and Interpretation of Claims)

21.01 Paragraph (2)(b): The phrase “at the time of any alleged infringement” may be regarded as meaning at any time during the occurrence of the alleged infringement or only at the start of the alleged infringement.

Note on Article 22
(Term of Patents)

22.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

22.02 Alternative B, paragraph (2)(a): Where priority is claimed under the Paris Convention, Article 4**bis**(5) of that Convention applies. Article 4**bis**(5) reads as follows: “Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority.” The present provision treats applications claiming internal priority in the same manner.

22.03 Alternative B, paragraph (2)(b): This provision covers the term of patents granted on divisional applications, continuation applications and applications for continuation in part. In

the case of patents of addition, the term would run from the filing date of the parent application.

Note on Article 23
(Enforcement of Rights)

23.01 Paragraphs (1) and (2) are presently drafted by reference to Article 19, which sets out the rights conferred by a patent. If Alternative A of Article 19 were adopted, which would leave the rights conferred by the patent to be determined by each Contracting Party, the present Article would have to be re-drafted to refer to those acts recognized by the concerned Contracting Party as constituting an infringement of the rights of the owner of the patent.

23.02 It is understood that national or regional procedural requirements relating to litigation are not affected by this Article.

23.03 Since paragraphs (1) and (2) establish minimum rights (see the words “at least” in the opening clause of each paragraph), any Contracting Party could provide for an exclusive or other licensee to have the right to enforce patent rights or rights arising from published applications.

23.04 Paragraph (2): Where a Contracting Party provides for more measures than those required by paragraph (2) (by, for example, making available injunctions or damages in respect of rights conferred by published applications), it may naturally continue such additional measures. Such measures as are continued must, because of the principle of national treatment, be available to eligible nationals and residents of other States party to the Paris Convention.

23.05 Paragraph (2)(a): As regards the meaning of “published,” see Article 2(viii) and Rule 1(3).

23.06 Paragraph (2)(b): Contracting Parties are free to provide other mechanisms to enhance the enforcement of rights based upon published applications such as, for example, accelerated processing of the application.

23.07 A provision ensuring that the statute of limitations could not commence to run until after the grant of a patent where legal proceedings may not be initiated before the grant of the patent would satisfy the requirement of the proviso that the owner of the patent be accorded a “reasonable” time to initiate such proceedings.

23.08 Paragraph (2)(c): It is understood that the phrase “claims of the patent” refers to the claims appearing in the granted patent on the date of any decision by the court to award compensation.

Note on Article 24
(Reversal of Burden of Proof)

24.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

Note on Article 25
(Obligations of the Right Holder)

25.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative B reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/31, para 336).

Note on Article 26
(Remedial Measures Under National Legislation)

26.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative B reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

Note on Article 27
(Assembly)

27.01 Paragraph (1): Subparagraph (c) does not preclude the Assembly from requesting financial assistance for the expenses of the participation of all or some delegations from sources outside the Union.

27.02 Paragraph (4)(b) and (c): The words in square brackets (“whether ... or absent”) in these subparagraphs are based on a proposal made by the member States of the Organisation africaine de la propriété intellectuelle (OAPI). OAPI has 14 member States.

27.03 Paragraph (4)(e): This subparagraph will have to be omitted if Alternative A (rather than Alternative B) of Article 35 is adopted, that is, if there will be no Article 35.

Note on Article 28
(International Bureau)

Note on Article 29
(Regulations)

Note on Article 30
(Settlement of Disputes)

Note on Article 31
(Revision of the Treaty)

Note on Article 32
(Protocols)

Note on Article 33
(Becoming Party to the Treaty)

33.01 Paragraph (1)(ii): The words “that affect the national laws of the States constituting the said organization,” which qualified the term “norms” in the proposal made in the last session of the Committee of Experts on which the present provision is based (see document HL/CE/VIII/30), have been omitted. They would seem to be superfluous since any norm in the field of the treaty that is binding on the member States of an intergovernmental organization necessarily affects the national law of those member States.

Note on Article 34
(Effective Date of Ratifications and Accessions)

Note on Article 35
(Reservations)

35.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VII/22).

35.02 Alternative A: In relation to the legal effect of the absence of a provision on reservations in a treaty, see Article 19 of the Vienna Convention on the Law of Treaties, which reads as follows:

“A State may, when signing, ratifying, accepting, approving or acceding to a treaty, formulate a reservation unless:

- (a) the reservation is prohibited by the treaty;
- (b) the treaty provides that only specified reservations, which do not include the reservation in question, may be made; or
- (c) in cases not falling under sub-paragraphs (a) and (b), the reservation is incompatible with the object and purpose of the treaty.” (Emphasis added)

It would follow from paragraph (c) that the most likely interpretation of the absence of a provision on reservations in this Treaty would be that reservations on any of the substantive provisions would not be permitted at all because the object and purpose of the Treaty is to establish harmonization, within the limits stated in the Treaty, and all the substantive provisions serve that object and purpose.

35.03 Alternative B, paragraph (2): This paragraph is applicable whether Alternative A or Alternative B of Article 10 is adopted.

35.04 Alternative B, paragraph (3): This paragraph is applicable only if Alternative B of Article 19 is adopted.

35.05 Alternative B, paragraph (4): This paragraph is applicable only if Alternative B of Article 22 is adopted.

35.06 Alternative B, paragraph (5): This paragraph is applicable only if Alternative B of Article 24 is adopted.

Note on Article 36
(Special Notifications)

Note on Article 37
(Denunciation of the Treaty)

Note on Article 38
(Languages of the Treaty; Signature)

Note on Article 39
(Depositary)

III. NOTES ON THE DRAFT REGULATIONS

Note on Rule 1 (Definitions (ad Article 2))

R1.01 Paragraph (3): Article 2(viii) defines “published” as meaning “made accessible to the public.”

Note on Rule 2 (Contents and Order of Description (ad Article 3(2)))

R2.01 Paragraph (1)(ii): The expression “background art” is used in the corresponding provision of the Regulations under the Patent Cooperation Treaty (PCT) (Rule 5.1(a)(ii)).

R2.02 Paragraph (1)(iv): Article 3(1)(b) reads as follows:

“Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. Any Contracting Party may require that the deposit shall be made on or before the filing date or, where priority is claimed, the priority date of the application.”

R2.03 Paragraph (1)(vi): As regards amendments of this provision, see Rule 12 which provides that amendment “of Rule 2(1)(vi) ... shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.”

Note on Rule 3 (Manner of Claiming (ad Article 4(5)))

R3.01 Paragraph (1) corresponds to Rule 6.1(b) of the Patent Cooperation Treaty (PCT).

R3.02 Paragraph (2) corresponds to Rule 6.2(a) of the Patent Cooperation Treaty (PCT).

R3.03 Paragraph (3): As regards amendments of this provision, see Rule 12 which provides that amendment “of Rule 3(3) ... shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.”

R3.04 Paragraph (5)(c) corresponds to Rule 6.4(c) of the Patent Cooperation Treaty (PCT).

Note on Rule 4
(Details Concerning the Requirement of
Unity of Invention (ad Article 5(1)))

R4.01 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 exist only when there is a technical relationship among the inventions involving one or more of the same or corresponding “special technical features.” The expression “special technical features” is defined in paragraph (1) as meaning those technical features that define a contribution that each of the inventions, considered as a whole, makes over the prior art.

R4.02 Independent and Dependent Claims. Unity of invention has to be considered in the first place only in relation to the independent claims in an application and not the dependent claims. In the context of Rule 4, “dependent” claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed--for example, product, process, use or apparatus or means, etc.).

R4.03 If the independent claims are patentable and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim is patentable. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim is patentable and the combination claim includes all the features of the subcombination.

R4.04 If, however, an independent claim is not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) should be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

R4.05 It is intended that the method contained in paragraph (1) for determining whether unity of invention exists should be able to be applied without it being necessary to search the prior art. Where the Office does search the prior art, an initial determination of unity of invention, based on the assumption that the claims are not invalidated by the prior art, might be reconsidered on the basis of the results of the search of the prior art. Where the Office does not search the prior art, unity of invention would be determined on the assumption that the claims are not invalidated by the prior art, unless it is obvious to the person making the determination that the claims are invalidated by the prior art.

R4.06 Illustrations of Particular Areas. There are three particular areas of practice where the application of the method for determining unity of invention contained in paragraph (1) of Rule 4 may be illustrated: (i) combinations of different categories of claims; (ii) so-called “Markush practice”; and (iii) the case of intermediate and final products. Principles for the interpretation of the method contained in paragraph (1) in the context of each of those areas are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of paragraph (1) of Rule 4. Contracting Parties that wish to adopt, in their patent legislation, more detailed provisions on unity of invention than those contained in Article 5 and Rules 4 and 5 could include the substance of the principles of interpretation set out below.

R4.07 In order to secure the greatest possible harmonization of practice, Article 27(2)(a)(iii) empowers the Assembly to adopt guidelines for the implementation of provisions of the Treaty and the Regulations. Under that procedure, the Assembly could adopt, and revise where necessary, the principles of interpretation on the three areas of special concern referred to in the preceding paragraph and set out below. Alternatively, those principles of interpretation could be adopted in the form of an agreed text or statement by the Diplomatic Conference when the Treaty is adopted. The latter method, however, is less flexible, since the text could probably not be later modified in the light of experience in the way that guidelines could be modified by the Assembly.

R4.08 Combinations of Different Categories of Claims. The method for determining unity of invention contained in paragraph (1) of Rule 4 should be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
- (iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

R4.09 As indicated in the last part of paragraph R4.08, above, a process should be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product. The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process. They are also not intended to imply that the same kind of process of manufacture could not also be used for the manufacture of other products.

R4.10 As also indicated in the last part of paragraph R4.08 above, an apparatus or means should be considered to be “specifically designed for carrying out” a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. On the other hand, the words “specifically designed” should not imply that the apparatus or means could not be used for carrying out another process, or that the process could not be carried out using an alternative apparatus or means.

R4.11 “Markush Practice.” The situation involving the so-called “Markush practice” wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Article 5 and Rule 4. In that special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in paragraph (1) of Rule 4 should be considered to be met when the alternatives are of a similar nature.

R4.12 When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where the following criteria are fulfilled:

(a) all alternatives have a common property or activity, and

(b)(i) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(ii) in cases where the common structure cannot be the unifying criterion, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

R4.13 In (b)(i), above, the words “significant structural element is shared by all of the alternatives” refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

R4.14 In (b)(ii), above, the words “recognized class of chemical compounds” mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

R4.15 The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

R4.16 When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel, unity should be reconsidered by the examiner. Reconsideration should not necessarily imply that an objection of lack of unity must be raised.

R4.17 Intermediate and Final Products. The situation involving intermediate and final products is also governed by Article 5 and Rule 4.

R4.18 The term “intermediate” is intended to mean intermediate or starting products. Such products have the ability to be used to produce patentable final products through a physical or chemical change in which the intermediate loses its identity.

R4.19 Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(a) the intermediate and final products have the same essential structural element, i.e.,

(i) the basic chemical structures of the intermediate and the final products are the same, or

(ii) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(b) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

R4.20 Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known--for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

R4.21 It should be possible to accept in a single application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

R4.22 The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new.

R4.23 If the same application claims different intermediates for different structural parts of the final product, unity should not be regarded as being present between the intermediates.

R4.24 If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

R4.25 As long as unity of invention can be recognized applying the above guidelines, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not affect the decision on unity of invention.

R4.26 Paragraph (2) requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

R4.27 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 Rule 4(1)) remains the same regardless of the form of claim used.

R4.28 Paragraph (2) 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 the claims fee system applicable in that Office.

Note on Rule 5
(Divisional Applications (ad Article 5(1)))

R5.01 The right to file divisional applications is established in Article 4G of the Paris Convention, which reads as follows:

“(1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

“(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the [Paris] Union shall have the right to determine the conditions under which such division shall be authorized.”

Note on Rule 6
(Manner of Identification and Mention of Inventor
(ad Article 6))

R6.01 Paragraph (1): The inventor may decide or require that instead of his home address the application should contain an address for service chosen by him.

Note on Rule 7
(Details Concerning the Filing Date Requirements
(ad Article 8))

Note on Rule 8
(Announcement in the Gazette of the Publication of an Application
(ad Article 15(1)))

Note on Rule 9
(Announcement in the Gazette of the Publication of a Change in a Patent
(ad Article 17(5)))

Note on Rule 10
(Announcement in the Gazette of the Grant of a Patent
(ad Article 18(1)(b)))

R10.01 The data required in items (i) and (ii) are already required to be published by Article 12 of the Paris Convention which, in its material part, reads as follows:

“(1) Each country of the [Paris] Union undertakes to establish a special industrial property service and a central office for communication to the public of patents ...

“(2) This service shall publish an official periodical journal. It shall publish regularly:

(a) the names of the proprietors of patents granted, with a brief designation of the inventions patented; ...”

Note on Rule 11

(Absence of Quorum in the Assembly (ad Article 27))

R11.01 Article 27(5)(b) reads as follows:

“In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence.”

Note on Rule 12

(Requirement of Unanimity for Amending Certain Rules
(ad Article 29(3))

R12.01 The two Rules identified (Rule 2(1)(vi), concerning the mode of carrying out the invention that must be disclosed, and Rule 3(3), concerning the form of claims) contain provisions of fundamental importance. Therefore, those Rules may not be amended without unanimity.

Note on Rule 13

(Settlement of Disputes (ad Article 30))

R13.01 Paragraph (1): Article 30(1)(b) provides that a Contracting Party that is requested to enter into consultations with another Contracting Party “shall provide within the prescribed time limit an adequate opportunity for the requested consultations.”

R13.02 Paragraph (2): Article 30(3)(c) provides that the parties to the dispute shall agree upon the terms of reference of the panel but that “if such agreement is not achieved within the prescribed time limit, the Director General shall set the terms of reference of the panel after having consulted the parties to the dispute and the members of the panel.”

[End of Annex and of document]