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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF PATENTS

Fourth Session
Geneva, November 6 to 10, 2000

REPORT

*adopted by the Standing Committee**

INTRODUCTION

1. The Standing Committee on the Law of Patents (hereinafter referred to as “the Standing Committee” or “the SCP”) held its fourth session in Geneva from November 6 to 10, 2000.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Algeria, Argentina, Armenia, Australia, Austria, Belarus, Belgium, Botswana, Brazil, Canada, Chile, China, Côte d’Ivoire, Croatia, Czech Republic, Democratic People’s Republic of Korea, Denmark, Dominican Republic, Egypt, El Salvador, Finland, France, Gabon, Germany, Ghana, Guatemala, Holy See, Hungary, India, Indonesia, Iraq, Ireland, Jamaica, Japan, Jordan, Latvia, Luxembourg, Malaysia, Mauritius, Mexico, Mongolia, Morocco, Netherlands, Nigeria, Norway, Pakistan, Panama, Peru, Philippines, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Slovakia, Slovenia, Spain, Sudan, Swaziland, Sweden, Switzerland, Trinidad and Tobago, Turkey,

* Paragraphs 32, 55, 64, 81, 115, 143, 148 and 159 incorporate further changes to the report as adopted at the Report session. These changes were submitted by the European Patent Office, on the day of the Report session, and were accepted by the Chairman subsequent to the Report session.

Ukraine, United Kingdom, United Republic of Tanzania, United States of America, Uruguay and Venezuela (70).

3. Representatives of the United Nations (UN), the World Trade Organization (WTO), the European Patent Office (EPO), the European Commission (EC), the African Intellectual Property Organization (OAPI) and the Organization of African Unity (OAU) took part in the meeting in an observer capacity (6).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Associated Chambers of Commerce and Industry of India (ASSOCHAM), Biotechnology Industry Organization (BIO), Brazilian Association of Industrial Property (ABPI), Brazilian Association of Industrial Property Agents (ABAPI), Institute of Professional Representatives before the European Patent Office (EPI), Intellectual Property Owners Association (IPO), International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Federation of Inventors' Associations (IFIA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA) and International League of Competition Law (LIDC) (13).

5. The list of participants is contained in the Annex of this report.

6. Discussions were based on the following documents prepared by the International Bureau of WIPO: "Agenda" (SCP/4/1), "Suggestions for the Further Development of International Patent Law" (SCP/4/2), "Text of the Basic Proposal for the Treaty and the 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" (SCP/4/3), "Notes on the Basic Proposal for the Treaty and the 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" (SCP/4/4), and "Disclosure of Technical Information on the Internet and its Impact on Patentability" (SCP/4/5).

7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

GENERAL DISCUSSION

Agenda Item 1: Opening of the session

8. The session was opened by Mr. Shozo Uemura, Deputy Director General, who welcomed the participants and underlined the importance of this first meeting of the SCP after the conclusion of the Patent Law Treaty (PLT). In view of the many different systems to accommodate when discussing substantive harmonization of patent law, he appealed to the delegations to address the issues at stake with an open mind, but in a cautious way, taking into account all the interests involved, and to work in a spirit of friendliness and goodwill.

Agenda Item 2: Election of a Chair and two Vice-Chairs

9. The Standing Committee unanimously elected, for one year, Mr. Dave Herald (Australia) as Chair, and Mr. Eugen Stashkov (Republic of Moldova) and Mr. Chaho Jung (Republic of Korea) as Vice-Chairs. Mr. Philippe Baechtold (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 3: Adoption of the Agenda

10. The draft Agenda (document SCP/4/1) was adopted as proposed.

11. Regarding the procedure for adopting the Report, the SCP adopted the suggestion of the International Bureau to follow, as of the next session, the same approach as the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). The Report will, therefore, be adopted at the session following the session to which the Report relates. The International Bureau will circulate the English, French and Spanish versions of the draft Report on the SCP Electronic Forum as soon as they are completed. The English version at least will be posted on the electronic forum one week after the session. The deadline for submission of comments will be two weeks after the date of circulation of the French and Spanish versions of the Report.

Agenda Item 4: Further Development of International Patent Law

12. The Chair suggested that, in order to structure the discussion, a first round of comments should address general matters relating to the issues identified in document SCP/4/2 and possible additional issues, and that, subsequently, each individual issue could be addressed in detail with a view to provide the International Bureau with clear directions for a first draft harmonization treaty. He stated that such harmonization should be meaningful, but not too extensive, so that work could be completed during the next three to four years.

General issues

13. The Delegation of the United States of America stated that the previous effort to harmonize substantive patent law in 1991 had been wide-ranging and had involved almost all of the issues associated with the processes of obtaining and exploiting patents, and might have been too ambitious. The Delegation also pointed out that the “Basic Proposal for a Treaty Supplementing the Paris Convention as far as Patents are Concerned” (1991 Draft), while providing a good starting point for consideration of the specific issues addressed in document SCP/4/2, would not have resulted in genuine harmonization for all of the issues raised. In some instances, the provisions of the 1991 Draft were superficial and would not have given rise to truly harmonized requirements. In other instances, exceptions and accommodations were made for the disparate laws and practices found throughout the world.

14. The Delegation further stated that it might be appropriate for the SCP to take a different approach to substantive harmonization. This approach should build upon the success of the recently concluded PLT without attempting to achieve too much. The SCP should, therefore, move forward with fewer issues than the 1991 Draft. These issues should, for the time being, be limited to the drafting, filing and examination of patent applications. In this respect,

document SCP/4/2 provided a good overview of what could be regarded as an appropriate subset of the issues addressed in the 1991 Draft. The SCP should strive for genuine harmonization of this limited number of issues with the objective of facilitating work-sharing, full faith and credit, cost reduction and the like. The Delegation pointed out that genuine harmonization would have to be result-oriented, with no exceptions. Patent applicants should have the benefit of predictability from Office to Office on all issues associated with a given application. They should be able to draft an application once and use it, without the need for initial amendments to the specification, drawings or claims as they go from country to country throughout the world, and they should be able to assess their chances for success throughout the world. In this context, harmonization should focus on economic benefits because a truly harmonized system would provide benefits to users, the public and patent Offices alike. In summary, the Delegation supported moving forward, in the near term, with an effort to harmonize the issues presented in document SCP/4/2. In the long term, the Delegation could also support the objective of more complete harmonization, which could include further issues, such as any remaining issues from the 1991 Draft, excluding of course those issues already resolved by the TRIPS Agreement, PLT, or other relevant agreements.

15. The Delegation of Japan stressed the importance of substantive patent law harmonization in the context of accelerated globalization and stated that such harmonization could provide an international infrastructure for research and development carried out in a global business environment. Together with a possible reform of the Patent Cooperation Treaty (PCT), substantive patent law harmonization could form the basis of a future global patent system.

16. It stated that further harmonization should contribute to a reduction in the cost of obtaining and exploiting patents. Reducing the procedural differences of obtaining patents would lead to a reduction of the direct costs resulting from the need to prepare totally different patent documents for different patent Offices. Further harmonization would also increase the predictability in the process of obtaining and using patents in different countries, thereby reducing the risks of patent applications and, indirectly, also the cost of such applications. Finally, harmonization would facilitate mutual recognition of search and examination results between patent Offices, which would reduce the workload of those Offices and eventually reduce costs for the benefit of users.

17. The Delegation of Japan fully agreed that the SCP should discuss harmonization of the six basic issues identified in document SCP/4/2 and proposed to include a number of following additional issues:

18. First, in the context of harmonizing the concepts of novelty and inventive step, it was necessary to also address the differences between laws that adhere to a first-to-file system and those that adhere to a first-to-invent system. An element of prior art which might not destroy novelty and inventive step of an invention under a first-to-invent system, could, under the first-to-file system, nevertheless be considered as opposing novelty and inventive step.

19. Second, it would be necessary to discuss the issue of 18-month publication of patent applications. In a country without an early publication system, an applicant would be unaware of earlier applications for identical or similar inventions and might, therefore, duplicate research and development as well as patent filings, which would lead to unnecessary costs. The lack of early publication could also lead to “submarine patents” which create serious risks for the users of the patent system.

20. Third, post-grant opposition should be discussed, because sometimes a patent was erroneously granted for an invention which was not patentable. A post-grant opposition system could provide a remedy for such a situation and should, as far as possible, be open to arguments that could have been asserted during the pre-grant examination procedure.
21. Finally, future harmonization should address all relevant issues at the same time, in order to take due account of all conflicting interests, and it should be realized by means of a legally binding international convention, not by means of a resolution or a recommendation.
22. The Delegation of the Russian Federation supported the suggestion to harmonize the issues identified in document SCP/4/2, but emphasized the need for setting priorities. First, all issues should be addressed that could facilitate the filing of applications. These issues included minimum standards for the sufficiency of a disclosure and the drafting of claims. Harmonization should proceed with a view to enabling applicants to use the same application in several countries. As a next step, the conditions of patentability could be harmonized. In this context, “non-traditional” patents, such as patents on business methods, could be addressed. Other issues included the possibility of including several inventions in one application, facilitating amendments of an application, a proportionate reduction of fees in cases where the applicant provided an international search report, the adoption of the first-to-file system as a standard for the international patent system, and the harmonization of utility models.
23. The Delegation of France cautioned against an overly ambitious approach to harmonization and recommended addressing only the issues identified in document SCP/4/2.
24. The Delegation of Canada stated that harmonization should not be overly ambitious, but supported the proposal made by the Delegation of Japan to include other issues, in particular the issues relating to the first-to-file system and to the early publication of patent applications.
25. The Delegation of Brazil noted that some of the issues mentioned in document SCP/4/2 would also be discussed in the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore and stated that duplication of work should be avoided. This was supported by the Delegation of the United States of America. The Delegation of Brazil also supported the proposal of the Delegation of Japan to address additional issues.
26. The Delegation of Hungary supported international harmonization of substantive patent law because it would reduce costs and increase the predictability of obtaining patent protection in several countries. Such harmonization should be ambitious by including all important issues, but realistic by not addressing the issues where progress would not seem feasible at the moment. The Delegation proposed to start with the items identified in document SCP/4/2 and to take up other issues at a later date.
27. The Delegation of Australia generally supported the goal of further harmonizing patent law and said that document SCP/4/2 provided a good basis. While cautioning against an overly ambitious approach, the Delegation nevertheless supported the Delegations of Canada and Japan who had proposed to include additional issues in the agenda.

28. The Delegation of Germany stated that the goals of substantive harmonization identified in document SCP/4/2 were to facilitate mutual recognition of search and examination results and to reduce costs. The Delegation advocated a cautious approach to harmonization which would be a necessary first step, and stated that mutual recognition could only be a further step in the process. Harmonization should create a common basis without addressing too many details. The Delegation pointed to the limits of harmonization of laws, which could not always harmonize the practice, such as in the case of “inventive step,” where the same wording was applied differently in different jurisdictions. Some issues could and should therefore be left to practice.

29. With regard to the goal of reducing costs, the Delegation stated that the costs of patent applications were only one element, and that developments occurring outside the patent system could also contribute to an increase in the costs of using the patent system. The SCP and the International Bureau should therefore monitor current developments and participate in those discussions as well. The SCP, however, should focus on patent issues. The Delegation stated that the most important items had been identified in document SCP/4/2 and that the 1991 Draft provided a useful starting point for discussions. The Delegation also supported the proposal made by the Delegation of Japan to address additional issues, even if it might be more appropriate to do so at a later stage.

30. With reference to the proposal to address the issue of “first-to-file” versus “first-to-invent,” the Delegation of the United States of America stated that this issue had derailed the first effort to harmonize substantive patent law in 1991 and that the issue was very controversial in the United States of America. A substantial part of users in the United States of America were very much attached to the first-to-invent system. The Delegation said that, presently, a discussion on this issue was taking place in the United States of America, and that it might be in a position to assess the feasibility of including this issue in the discussion in about one year. The Delegation therefore advocated giving priority to the issues identified in document SCP/4/2, and revisiting the first-to-file issue after these other issues were fully addressed.

31. The Delegation of the Netherlands stated that it had always supported substantive harmonization. It noted that, even though the process of harmonization came to a halt in 1991, the problems of patent applicants persisted. The Delegation stated that no issue should be excluded from the outset, but that discussions should start with the issues identified in document SCP/4/2. The Delegation supported the view of the Delegation of the United States of America that it was necessary to achieve real and meaningful harmonization on a limited number of issues, but stated that it was also necessary to listen to the users of the patent systems and to address additional issues suggested by them.

32. The Representative of the EPO noted that patent protection was becoming increasingly important, which had led to an increase in the number of applications and in the amount of costs. The Representative stated that cost reduction could be achieved through meaningful harmonization, which was also a pre-condition for mutual recognition of search and examination results. In the opinion of the Representative, document SCP/4/2 had identified the most essential points. The discussion should, however, not be limited to these issues at this stage. He supported the view of the Delegation of Japan that the issues relating to the 18 months publication of applications and to post grant opposition were very important and welcomed the statement of the Delegation of the United States of America that it could consider the issue of “first-to-file” versus “first-to-invent” in the near future.

33. The Representative of AIPLA welcomed the resumption of discussions on the harmonization of substantive patent law. He said that progress had clearly been made since the Diplomatic Conference held in The Hague in 1991. As noted in document SCP/4/2, several of the provisions of that draft treaty had been resolved in the TRIPS Agreement, and others were addressed in the PLT which was concluded in June 2000. The Representative believed that there were lessons to be learned from both the 1991 and 2000 Diplomatic Conferences. The 1991 Conference demonstrated that trying to achieve harmonization on a large scale entailed a high risk of failure. The 2000 Diplomatic Conference showed that concrete results that advance the harmonization of patent laws could be achieved if the goals and objectives were realistically selected. The Representative said that his organization was pleased that some consideration was given to the question of what could be accomplished in the new harmonization exercise. In the view of AIPLA, the answer was to reduce the burden on examining patent Offices and on inventors. In order to reduce the burden of examining patent Offices, AIPLA would urge the SCP to focus on the definition of prior art and criteria for patentability that would permit real, meaningful work sharing between such Offices. The harmonization required to achieve that goal would require the development of a single, harmonized patent application that could be used in every country without any change or amendment to reflect a variant national practice. A fully harmonized approach to the drafting of the specification and claims, unity of invention, entitlement to file and the like would significantly benefit inventors seeking to patent their inventions in several countries or regions. There were many provisions in the 1991 Draft that, while important, did not contribute to these objectives. Provisions harmonizing the rights of prior users, the extent of protection and interpretation of claims, administrative revocation, or time limits for search and examination merited consideration, but should not be included in the current exercise. The harmonization effort to be initiated should be narrowly focused on the limited objectives of facilitating work sharing among patent Offices and reducing the burdens and costs on inventors protecting their inventions in a number of countries. Although the Representative urged a focused, narrow harmonization effort, his organization was fully aware of the challenges such an approach presented. There should be a single set of standards that an invention should have to satisfy to qualify for being patentable. Stated in other words, there should be no provision that would state, as did Article 11(1) of the 1991 Draft, that an invention, in order to be patentable “shall be novel, shall involve an inventive step (shall be non-obvious) and shall be, at the option of the Contracting Party, either useful or industrially applicable.” Similarly, there should be no exceptions from the definition of prior art or reservations from unity of invention. This did not mean that the practice of one country or region should prevail over the practice of another country or region, but that it was necessary to openly confront and make such difficult choices.

34. The Delegation of Sweden welcomed harmonization of substantive patent law and said that it attached great importance to that issue. There was a current need for harmonization of this kind which had the full support of the industry of its country. In order to achieve successful harmonization, it appeared to be reasonable to focus on the issues outlined in document SCP/4/2. Topics that deserved particular attention were the question of publication of patent applications after 18 months and post-grant opposition. From the point of view of the users, it was important that harmonization encompass the first-to-file principle.

35. The Delegation of Ireland stated that, at the May 2000 Diplomatic Conference on the PLT, its Delegation had already called for substantive harmonization of patent law. Among the issues which should be addressed with priority were the questions of the cost of patenting

and mutual recognition of search and examination results. As regards the six issues identified in document SCP/4/2, the Delegation recalled that those topics had already been harmonized within the framework of the European Patent Organisation. If progress was made on those issues on the multilateral level, the topics suggested by the Delegation of Japan could be considered.

36. The Representative of IFIA said that his organization shared the view with other delegations that the issues outlined in document SCP/4/2 deserved the full attention of the Committee. In particular, the reduction of the cost of obtaining patent protection in multiple jurisdictions, and the reduction of the risk of losing protection because of the increasing legal uncertainty were among the main concerns of IFIA. Before it was possible to discuss the ultimate dream of the inventor's community, namely a worldwide patent, it was necessary to work towards harmonization of the patent system. In order to be reasonable, it was necessary to limit the work to a number of important basic issues, since a treaty limited in scope was preferable over not having a treaty at all. The Representative recalled that nearly ten years had elapsed since the failure of the 1991 Draft which, in turn, was a continuation of the Paris Revision Conference. Harmonization could not be achieved by one country imposing its standards on other countries, but had to be reached through genuine compromises between countries. In that respect, the Representative referred to the first-to-invent principle, which was at present only applied in the United States of America. Mentioning the strong support of that principle among small inventors in the United States of America, the Representative offered IFIA's cooperation in working towards finding an acceptable solution to that issue.

37. The Delegation of Spain said that it was in favor of harmonizing substantive patent law on the basis of document SCP/4/2. Likewise, it expressed support to giving priority to exploring ways of reducing the cost of patenting and achieving mutual recognition of search and examination results of different patent Offices.

38. The Representative of JIPA said that with respect to the harmonization of patent law, it was necessary to take account of four points, namely cost reduction, speed, legal certainty and fairness in achieving international harmonization regardless of countries or languages. In particular, JIPA considered the issues of legal certainty and fairness to be very important for international patent law. The Representative recalled Article 27.1 of the TRIPS Agreement, stating that patents shall be available and patent rights enjoyable without discrimination as to the place of invention.

39. The Representative of FICPI said that his organization was generally in favor of harmonization of intellectual property laws as a means to achieving a cost-effective, user-friendly system. In the long-term perspective, the organization believed in a harmonized patent law system substantially corresponding to the 1991 Draft. In particular, users would benefit from a patent system based on the principles of first-to-file and an international 12-month grace period. However, the Representative suggested, as a start, to focus on some practical matters that were important to the users, in particular, for the drafters of multinational applications, most of which were being filed today under the PCT system. One single specification had to be filed with the PCT application. It was not easy or even possible to draft such a specification, at reasonable cost, so that the various national requirements were complied with. Although, there were some general rules under the PCT concerning the description, the claims and the drawings, many key questions had to be dealt with as a compromise when drafting the description and claims. In practice, the lowest common denominator principle had to be used, relying on possible amendments during the national and

regional prosecution. As to the description, some jurisdictions required that a disclosure include at least one mode of working the invention so as to enable others to use the invention across the width of the broadest claims. In other national patent systems, and also according to the present PCT Rule 5.1(v), the best mode contemplated by the applicant had to be included. In practice, also in view of current developments of claim interpretation, this requirement forced applicants to draft very lengthy specifications with very detailed information, even on aspects which were not necessarily related to the essence of the inventive concept. The length of an average specification had increased considerably during the last decades, and this was one important reason why patent applications had become more expensive. Moreover, FICPI did not think that the best mode requirement was beneficial to the system. A straightforward enablement requirement should be sufficient to establish a reasonable balance of interests between the patent holders and third parties. Some laws required a comprehensive discussion of the technical background and all pertinent prior art in the description, whereas others did not. However, in a PCT application, one had to include such a discussion, and this information also had to be partially duplicated during national prosecution where information disclosure statements had to be filed. Claim drafting was also an art that required much effort and care. In many systems, additional fees had to be paid for any claim exceeding a certain number, usually 10. It was normally practical to use multiple dependencies to keep down the number of claims. However, in other jurisdictions, multiple dependent claims were not permitted or required an extra fee. For the PCT claim drafter, it was hardly possible to arrive at a cost-effective single set of claims providing a good scope of protection. With regard to the wording and structure of claims, some countries required a two-part format, and others did not. Reference numerals had to be inserted in some countries, but were not permitted in others. Some required technical features, and others required economic and other features. Certain countries allowed closely related independent claims, and others did not. Some allowed a collection of subject matters, for example, products, processes and apparatus, others did not. Functional language was permitted in some countries, but not permitted in others. Therefore, in multinational patent applications, whether they were filed under the PCT or not, extensive amendments had to be made during the prosecution before the national or regional patent Office, at great cost to the applicant. Even the possibilities of making such amendments varied a great deal. In some countries, amendments could be made at any time during the life of the application and the patent, whereas amendments could only be made in very limited time intervals in other countries. Therefore, FICPI would welcome any changes in law and practice that would simplify the drafting and prosecution of patent applications.

40. Accordingly, in order to foster a more cost-effective patent system even in the short term, the Representative suggested that the SCP deal with the following issues: removal of the best mode requirement, allowance of multiple claim dependencies, allowance of insertion of reference signs (between parentheses) into the claims, and application of the “problem and solution” approach to the inventive step requirement. That latter approach had proven to work very well where it had been practiced. It was also referred to in PCT Rule 5.1 relating to the description. It related closely to the basic questions of prior art, novelty and inventive step, but it also offered good solutions to many of the practical problems discussed above, such as references to background art in the description, claims format, claims language, claim support and even unity of invention. Those issues could hopefully be dealt with without fundamental changes of national patent law. Nevertheless, they would cut patenting costs and be very beneficial to the users of the system. A simplification of the patenting system also had an indirect cost reduction effect, since it sped up the patenting process and saved time and effort for all parties involved.

41. The Representative of BIO said that his organization strongly supported the harmonization of patent law. However, the Representative considered it to be more than a simple harmonization exercise, and therefore the opportunity should be seized in order to link substantive harmonization to mutual recognition of search and examination results. This would constitute an efficient way to reduce the complexity of patent procedures. However, the Representative said that established international norms and, in particular, the TRIPS Agreement, had to be respected.

42. The Representative of IPO said that his organization welcomed harmonization of substantive patent law. However, the Representative urged the Committee to limit the number of issues with regard to which it intended to initiate work. In particular, work should be concentrated on questions concerning patentability and validity, and filing procedure. The Representative recalled that the best template for a successful outcome of the work appeared to be the adoption of the first-to-file principle, supplemented by a general twelve months grace period for disclosures of the invention by the inventor.

43. The Representative of AIPPI said that his organization was in favor of the harmonization of substantive patent law, and that the six issues as outlined in document SCP/4/2 seemed to constitute a good basis for discussion. However, he recalled that the discussion of issues such as novelty, prior art and inventive step depended directly on the position that was taken with regard to the issue first-to-file versus first-to-invent. He therefore suggested that discussion on those subjects be initiated once the position of the Delegation of the United States of America was known with regard to that topic.

44. The Representative of JPAA said that the most important issues of harmonization concerned the granting of patents at a reasonable cost and questions concerning patentability and legal certainty. Discussion of the six issues outlined in document SCP/4/2 appeared to be a good starting point. However, the first-to-file principle, post-grant opposition and the publication of applications after 18 months were the subjects which should be discussed with priority.

45. In response to the intervention made by the Representative of AIPPI, the International Bureau said that, although the issues such as the definition of prior art would relate to some aspects of first-to-file versus first-to-invent, they could still be discussed separately from other issues such as priority as between independent inventors, which could be discussed in future. Further, the International Bureau stated that, if the Standing Committee desired to achieve full harmonization, no territorial distinctions would be able to be included in the treaty.

46. The Delegation of the United States of America shared the view of the International Bureau with respect to the first-to-invent question, and said that harmonization could be attained without addressing the critical issues of this question.

47. The Chair summarized the discussion and suggested the following conclusions:

(a) During the next two sessions, which will be held in May and November 2001, the SCP will focus on the six issues described in document SCP/4/2;

(b) At the meeting in November 2001, the SCP will review whether additional issues such as first-to-file, 18-month publication and post-grant opposition, should be included;

(c) The draft treaty would include no territorial restrictions.

48. The Delegation of Japan supported starting with the six issues identified in document SCP/4/2. It welcomed the readiness of the Delegation of the United States of America to consider the question of “first-to-file” versus “first-to-invent,” but expressed its disappointment with the fact that other delegations were not yet in a position to consider additional issues. The Delegation urged that any additional issues should be taken up at the earliest opportunity in order to maintain the momentum of harmonization.

49. In reply, the Chair said that additional issues were still on the agenda, but that the SCP had decided to limit discussion to the six issues singled out in document SCP/4/2 for the next 12 months.

Document SCP/4/2

50. The Chair opened the discussion on the individual issues in document SCP/4/2.

Prior Art

51. The Chair invited comments on the issue of “prior art” (paragraphs 11 to 14 of document SCP/4/2).

52. The Delegation of the United States of America was of the opinion that the language contained in Article 11(2)(b) of the 1991 Draft could be used if it were made generally applicable. In addition, the SCP would have to determine the criteria for information to rise to the level of prior art. The Delegation mentioned in particular the verification, authentication, corroboration and certainty of such information, and the ability to affix a date certain. With regard to the grace period, Article 12 of the 1991 Draft provided a good starting point. The Delegation stated that it could support a truly international grace period.

53. The Delegation of Australia supported the introduction of an international concept of prior art. It also supported a 12-month grace period provided that it was part of an international harmonized system. The Delegation said that it could accept the wording of Article 12 of the 1991 Draft.

54. The Delegation of Canada supported the concepts contained in the 1991 Draft. It mentioned in particular Article 12, providing for an internationally recognized grace period, and Article 13.

55. The Representative of the EPO supported the concept in Article 12 of the 1991 Draft as a starting point, but stated that it would have to be adapted to publications on the Internet. The Delegation expressed doubts as to whether the elements mentioned by the Delegation of the United States of America were sufficient, in particular with regard to the need for proof. The Delegation stated that it was open to the inclusion of a grace period and informed delegations that the EPO had published on its homepage two expert opinions on the issue, and that it was in the process of building a consensus regarding the matter. The Delegation therefore hoped to be able to indicate its position in about one year. The Delegation cautioned, however, that a grace period could only work if it was established on a worldwide

level. In sum, Articles 11, 12 and 13 of the 1991 Draft constituted a reasonable basis for a more detailed discussion.

56. The Representative of IFIA said that inventors strongly supported a general, worldwide grace period of 12 months. He stated that an increasing number of countries had introduced a grace period in their national law, and that the current status of international harmonization in this area, which dated back over 100 years, was insufficient and put inventors in an unbearable position.

57. The Delegation of Germany supported the statements made in paragraphs 11 to 13 of document SCP/4/2 and Articles 11 and 12 of the 1991 Draft. The Delegation emphasized that they supported absolute novelty which should not be subject to exceptions as currently provided in Article 11(2)(c) of the 1991 Draft. The Delegation expressed doubts as to whether additional definitions could add greater clarity to the concept, which might, therefore, better be left to the practice of courts and Offices.

58. The Delegation of France said that, while it had had reservations concerning the concept of a grace period in the past, it was now open to discuss the issue. The Delegation informed the Committee that an intergovernmental conference established in its country had, in 1999, come to the conclusion that a grace period would be advantageous. The Delegation could, therefore, accept a grace period, which could be six months or 12 months, provided that it was supported by a worldwide consensus.

59. The Delegation of Ireland supported the concept of novelty without any exclusions from the prior art. The Delegation stated that it could also support a grace period, but that its final position depended on future developments within the EPO.

Novelty

60. The Chair invited comments on the issue of “novelty” (paragraphs 15 to 18 of document SCP/4/2).

61. The Delegation of the United States of America held that Article 11(2) of the 1991 Draft was a good starting point. It emphasized that there was a need for true harmonization of the concept of novelty including its application, because practices might continue to diverge even under the harmonized wording in the 1991 Draft. The Delegation referred to document PLT/DC/69 which contained additional material relating, *inter alia*, to loss of rights.

62. The Delegation of the Russian Federation supported the Delegation of the United States of America and pointed to the need of amending the 1991 Draft in a way that would lead to a truly harmonized practice.

63. The International Bureau stated that, while it was possible to harmonize laws in a treaty, it was much more difficult to harmonize different practices in the application of those laws. Full harmonization of such practices might require, in the distant future, some form of common appeals body, if that would be desired by the Member States.

64. The Representative of the EPO considered Article 11(2)(a) of the 1991 Draft a good starting point. He informed delegates that such a provision would no longer allow the EPO to

retain the exception contained in Article 54(5) of the EPC. Since the Contracting Parties of the EPC were currently in the process of revising this provision, the Representative could not yet take a final position regarding that matter.

Inventive step (non-obviousness)

65. The Chair invited comments on the issue of “inventive step” (paragraphs 19 to 22 of document SCP/4/2).

66. In view of the fact that the terms “inventive step” and “non-obviousness” already had a distinct established meaning in various jurisdictions, the International Bureau suggested to explore the possibility of using a neutral phrase instead, such as “patentable advance over the state of the art.”

67. The Delegation of the United States of America supported the inclusion of the issue of “inventive step (non-obviousness)” in the discussion and emphasized that it was important to address the conceptual differences between “non-obviousness” and “inventive step.” Using a neutral term, as suggested by the International Bureau, might be a way to achieve that, even though the Delegation preferred the phrase “patentable difference over the state of the art.” In this context, it was essential to address the required level of the skill in the art. The Delegation held that Article 11(3) of the 1991 Draft provided a good starting point, even though much would have to be added in order to achieve meaningful harmonization.

68. The Delegation of Australia supported the statements made by the Delegation of the United States of America and added that Article 11(3) of the 1991 Draft was inadequate to achieve real harmonization. It welcomed the suggestion made by the International Bureau to use a neutral term, but stated that it required further thought.

69. The Delegation of Germany generally supported Article 11(3) of the 1991 Draft. The Delegation objected to the suggestion made by the International Bureau and said that it preferred a term with a clear and established meaning in national law and international treaties rather than a new term that had not been used in a particular jurisdiction, and that might give rise to confusion.

70. In reply, the International Bureau said that it was concerned that countries in which a given term already had an established meaning might simply continue their practice without taking account of any international harmonization of the meaning of the term.

71. The Delegation of Morocco supported Article 11(3) of the 1991 Draft and stated that the use of new terms might complicate matters, particularly in view of the fact that the TRIPS Agreement was already using the established terms.

72. The Chair added that a footnote to Article 27 of the TRIPS Agreement allowed Members to equate the concepts of “inventive step” and “non-obviousness.”

73. The Delegation of Romania proposed to follow the “problem and solution” approach which had proven beneficial for determining the scope of patent claims. Without such an approach, it could happen that several inventions in one application were not linked by a common inventive concept. The Delegation also informed delegates that under Romanian

patent law only one document could be accepted for the determination of novelty, whereas an assessment of inventive step could be based on more than one document.

74. The Delegation of the United States of America reported that users in the United States of America had serious concerns with the “problem and solution” approach and that this approach should therefore be avoided.

75. The Delegation of Japan said that Article 11(3) of the 1991 Draft provided a good starting point, except that the two alternative terms, “inventive step” and “non-obviousness,” co-existed. The Delegation proposed to focus on the methodology of determining inventive step, rather than on terminology. Further, it stated that the detailed methodology might have to be elaborated as binding provisions, in view of the big differences of actual practice with respect to the determination of inventive step among Trilateral Offices in a specific technological field, such as biotechnology.

76. This was supported by the Delegation of the Russian Federation, which stated that it could support any of the terms and asked the International Bureau to inform delegations about the different methodological approaches.

77. The International Bureau agreed to present an explanatory analysis for the next session.

78. The Delegation of the Netherlands stated that differences in practice could hardly be overcome by harmonized wording, and that the focus should be on methodology, even though a treaty might not be the right place for harmonizing methods.

79. This was supported by the Delegation of Germany, which stated that methods could not be conclusively defined in a treaty. Since different inventions might call for different methods, details of methodology should not be determined in the treaty.

80. The Delegation of the United States of America said that there should be harmonization of the methodology to guide Offices and jurisprudence ensuring the same result all over the world. Such a methodology would not necessarily have to be included in the treaty, but could be part of guidelines or similar instruments.

81. The Representative of the EPO emphasized the need to provide for coherence with the PCT and, for this reason, objected to the use of new terms or diverging terminology. The Representative also pointed out that inventive step was the core issue in substantive examination and that it should necessarily be addressed in the treaty. However, the method for determining inventive step was an issue to be dealt with in the implementing regulations or future practice guidelines.

82. The Delegation of Hungary cautioned that questions of terminology were not completely irrelevant either. It could accept the language used in Article 27(1) of the TRIPS Agreement as well as the one in Article 11(3) of the 1991 Draft or a neutral term. The Delegation agreed with other delegations that the issues of methodology were most important because they were instrumental in ensuring a uniform application of the treaty. The Delegation held that one of the core concepts to be harmonized was the notion of “a person skilled in the art.”

Industrial applicability (utility)

83. The Chair invited comments on the issue of “industrial applicability (utility)” (paragraphs 23 to 25 of document SCP/4/2).

84. The Delegations of Canada and the United States of America sought clarification on the meaning of the phrase “which may only be used for private purposes” that appeared at the end of paragraph 23 of document SCP/4/2, while noting the different meaning of the terms “industrial applicability” and “utility.” The International Bureau explained that this phrase related to the term “industrial applicability,” and not to the term “utility.”

85. The Delegation of the United States of America emphasized the importance of achieving true harmonization on this item. As regards the legal instrument, the Delegation said that this item could be included either in a treaty or in guidelines. It further stated that, whatever standards would be established, they should not be considered in a way to exclude certain categories of invention from patentable subject matter.

86. The Delegation of Ireland indicated that the term “capable of industrial application,” but not the term “utility,” was used in Article 27.1 of the TRIPS Agreement. The Chairman drew attention to the fact that the footnote to the said provision allowed a Member to consider the term “capable of industrial application” to be synonymous with the term “useful.”

87. The Delegation of the Russian Federation explained that, under its practice, the term “industrial applicability” included two meanings. First, the claimed invention should be used for a certain economic purpose. Second, in order to exclude inventions which were mere ideas, the technical solution should be reached and the function claimed should be actually performed. The Delegation suggested that further study be undertaken on how this requirement was applied in practice in various countries and that, in addition to the example of the *perpetuum mobile*, more examples be provided.

88. In connection with the intervention made by the Delegation of the Russian Federation, the Delegation of Germany said that the term “industrial applicability” was linked to the notion of the term “invention,” which encompassed technical teaching. The Delegation, supported by the Delegation of France, suggested the use of the term “industrial applicability” rather than the term “utility.” The Delegation of the United States of America stated that, as regards the definition of the term “invention,” the requirement of technical teaching was an unnecessary limitation.

89. The Delegation of Morocco supported the view expressed by the Delegation of the United States of America, and said that it preferred the use of the term “utility,” the notion of which was explained in paragraph 24(b) of document SCP/4/2.

90. The Delegation of Japan suggested that a definition be included for the purpose of full harmonization, and that, in any event, the discussion should be focused on substance rather than on terminology. It also pointed out that the requirement of industrial applicability was linked to the disclosure requirements, which could be found, for example, in PCT Rule 5.1(a)(vi).

91. The Delegation of France noted that, in the French text, the term “possibilité d’application” should be used instead of the term “applicabilité industrielle.”

Sufficiency of disclosure

92. The Chair invited comments on the issue of “sufficiency of disclosure” (paragraphs 26 to 32 of document SCP/4/2).

93. The Delegation of the United States of America suggested that further discussion on this item be based on Article 3(1) of the 1991 Draft rather than on Article 25, which had been resolved by Article 29.1 of the TRIPS Agreement.

94. The Delegation of Germany said that, according to its experience, the best mode requirement did not cause any problem during the procedure before the patent Office, since the disclosure of the best embodiment of the invention would lead to the best opportunity to get a patent. However, at the litigation stage, the alleged infringer often argued the validity of the patent on the basis of the best mode requirement.

95. Agreeing with the observation made by the Delegation of Germany, the Delegation of the United States of America stated that it was willing to consider the deletion of the requirement from its national law. It explained that the best mode requirement under the law of the United States of America, as well as Article 29.1 of the TRIPS Agreement, was a subjective requirement in order to avoid intentional concealment of the invention. It also stated that the expansion of such a requirement in other countries from a subjective to an objective requirement should be avoided.

96. The Representative of OAPI said that, since sufficient disclosure would be a prerequisite for the transfer of technology from the inventor to the society, the best mode should be disclosed in the description, which was the requirement under its regional law. The Chairman recalled that, under the Patent Law Treaty, a claim was not a required element to determine the filing date, since the scope of the invention would be limited to what had been disclosed on the filing date. He wondered whether different conditions on disclosure would be provided for in respect of the filing date requirements and regarding the requirements for the grant of a patent.

97. The Delegation of Australia indicated that, although its national law contained the best mode requirement, the Delegation was ready to remove that requirement which had been rarely utilized. The key factor would be that the disclosure should be made in such a manner that the invention could be carried out by a person skilled in the art, as contained in Article 3(1) of the 1991 Draft.

98. The Delegation of Japan suggested that the flexibility of the manner and order of the elements of the description be maintained for the benefit of users, as contained in PCT Rule 5.1(b).

Drafting and interpretation of claims

99. The Chair invited comments on the issue of “drafting and interpretation of claims” (paragraphs 33 to 38 of document SCP/4/2).

100. The Delegation of the United States of America supported the inclusion of the issues relating to the drafting of claims. However, the Delegation reiterated its opposition to any

inclusion of aspects relating to the “technical feature” requirement. Further, the Delegation raised concerns about claim conciseness. As regards the utility of the invention, the Delegation supported the provision under the 1991 Draft. It also indicated that the private sector of its country requested to resolve the questions concerning two-part claims and a fee structure with regard to multiple dependent claims.

101. In response to a concern raised by the Delegation of the United States of America that the issues on interpretation of claims were post-grant issues which should be discussed at a later stage, the International Bureau explained that certain aspects of the interpretation of claims, such as defining the scope of the claims, support of the claims by the specification, and the doctrine of equivalents in the context of the rights granted by a published application before the grant of the patent, were, at least in part, pre-grant issues.

102. The Delegation of Japan stated that this issue was closely related to the issue of patentable subject matter and reported that a study on the treatment of business methods in the United States of America, the EPO and Japan had revealed substantial differences which were related to differences in national laws, rather than mere differences in practice. Therefore, the Delegation said that substantive harmonization which enabled changes in national laws should be considered. The Delegation referred to Rule 3(2) of the 1991 Draft and to Rule 6(3)(a) of the PCT which required that the claim be defined “in terms of the technical features of the invention” and informed delegates that Japanese law defined an “invention” as a “highly advanced creation of technical ideas by which a law of nature is utilized,” but that there was no such restriction concerning claims. Under Japanese law, it was therefore possible to describe an invention in whatever wording the applicant wished to use if claims described technical ideas as a whole. Similarly, Rule 3(3)(i) and (ii) of the 1991 Draft and Rule 6(3)(b) and (c) of the PCT required that the claims be written in two parts, whereas Japanese law did not contain such a requirement. The Delegation held that the future harmonization treaty should give applicants maximum liberty with regard to the drafting of claims. The Delegation also stated that the interpretation of claims, at least pre-grant interpretation, should be included in the discussion.

Draft Provisions on Harmonization of Substantive Patent Law

103. The Chair invited comments concerning the preparation of draft provisions on harmonization of substantive patent law for the next meeting, based on an informal paper prepared by the International Bureau. He stated that the relevant interrelationships of the issues under consideration could, in the future, be explained in the Notes.

104. The Delegation of the Russian Federation asked for an explanation of the meaning of the term “prosecution history” and the meaning of “a person skilled in the art” in the context of novelty. The Delegation stated that the Russian Federation did not use the definition of a person skilled in the art in the context of novelty.

105. The International Bureau stated that the definition of “prosecution history” referred, *inter alia*, to any amendments made by the applicant during the prosecution of the application that might narrow the claim, and that the definition of a person skilled in the art with respect to novelty referred to the general principle that an invention must be disclosed in such a way that the invention could be made and used by a person skilled in the art.

106. The Delegation of the United States of America did not feel any urgency to consider post-grant issues such as interpretation of claims, but recognized the desire of other delegations to do so. The Delegation also stated that the definition of a person skilled in the art may also require consideration of the issue of whether the novelty defeating reference is enabling in and of itself.

107. The Delegation of Japan welcomed the inclusion of prior art effect of previously filed applications, and stated that Article 13 of the 1991 Draft should be the starting point for discussion. The Delegation stated that Article 13(1)(b) of that Draft provided that the whole content of an earlier application should have a priority effect from the priority date and not from the filing date. The Delegation also noted two territorial distinctions in Articles 13(1)(a) and 13(4) of the 1991 Draft that should be eliminated. The Delegation stated that although interpretation of claims seemed to focus on post-grant claim interpretation, the Committee should also address claim interpretation in the pre-grant stage, since it was very important for the harmonization of the patent granting process.

108. The Chair requested the Delegations of Japan and the United States of America to explain why pre-grant and post-grant interpretations of claims should be different.

109. The Delegation of Japan stated that examples of pre-grant claim interpretation would be means-plus-function claims, product-by-process claims, and use claims. The Delegation stated that, under Japanese practice, means-plus-function claims included any possible means capable of carrying out that function, but that means plus function claims might be interpreted differently in the United States of America and in Europe.

110. The Delegation of the United States of America stated that means-plus-function claims would be a valuable pre-grant issue to be addressed, and noted that, in the United States of America, there was a statutory provision which required means-plus-function claims to be interpreted more narrowly than one would otherwise think they should be. The Delegation, in responding to the question raised by the Chair regarding the distinction between pre-grant and post-grant claim interpretation, stated that their interpretation was very different. The Delegation also noted that issues relating to prosecution history and equivalents have no bearing on any pre-grant interpretation of a claim, and could be dealt with at a later time.

111. The International Bureau indicated that prosecution history and equivalents might be pre-grant issues in the context of the rights that exist under a published application. However, it would be careful to limit a first set of draft provisions to pre-grant issues.

112. The Delegation of Canada noted that, with regard to a definition of invention, when comparing the language of the statutes between Canada and the United States of America, which were virtually identical, the courts had interpreted subject matter quite differently and usually by split decisions. The Delegation inquired as to the scope of the subject matter intended to be covered by amendments of the description and amendments of claims.

113. The International Bureau, in responding to the intervention by the Delegation of Canada, noted that the definition of invention could be retained for the purposes of drafting, and that it might be decided later whether it should be included in the treaty. The International Bureau stated that amendments of the description and amendments of claims were included in the 1991 Draft, and it would be useful to assess if it was appropriate to keep them in the treaty.

114. The Delegation of the Netherlands stated that the discussion between the Delegations of Japan and the United States of America had clarified its question as to why interpretation of claims was a patent application issue instead of a patent registration issue. In the view of his Delegation, the interpretation of claims was normally a post-grant issue.

115. The Representative of the EPO stated that the EPO had lived for years without a definition of invention in its Convention, which allowed for flexibility, but that it was ready to discuss the issue. The Representative stated that the concept of unity of invention had been dealt with in the PLT by referring to the concept under the well-established practice of the PCT, which relationship should be kept in mind. The Representative stated that the interpretation of claims was an important issue for the EPO when determining whether an amendment to a claim was allowable under Article 123(3) EPC.

116. The Chair noted that there was at least one country where unity of invention was viewed as substantive law rather than procedural law, which meant that the issue should be included in the discussion.

117. The International Bureau stated that interpretation of claims was intended to refer to issues regarding the examination of claims, and suggested that, in view of the discussion, it might be better to talk of examination of claims instead of interpretation of claims. The International Bureau also noted, however, that there were some pre-grant situations relating to interpretation of claims, so that it might be best to refer to both.

118. The Delegation of Sweden stated that, since the Committee was waiting for more definite positions from certain delegations regarding the issue of first-to-file, it would perhaps be best to wait to discuss other issues as well, for example, the issue of prior art.

119. The International Bureau stated that the drafting work of the Committee could perhaps continue with respect to certain issues on the understanding that the final treaty will need to be acceptable as a whole to all the delegations.

120. The Delegation of China requested general clarification as to external sources of support for claims, and methodology for determining inventive step/non-obviousness. The Delegation also asked whether there were well-defined differences between the three examples of methodology, namely regulations, guidelines and Administrative Instructions.

121. The International Bureau, in responding to the questions of the Delegation of China, stated that external sources of support referred to the possibility of demonstrating to an examiner that specific information, in addition to that disclosed in the specification, was generally available to, and would be known by, those skilled in the art in practicing the disclosed invention. The International Bureau noted that this would be made clear in the drafting. With regard to the methodology for determining inventive step/non-obviousness, the examples were different legal instruments through which the issue of methodology for determining inventive step/non-obviousness could be dealt with.

122. The Delegation of the Republic of Korea, in commenting on the grace period, noted that the PCT was using the term "exceptions to lack of novelty" while some countries were using the term "exceptions to lack of patentability." As a result, there was uncertainty as to which term was proper in dealing with the issue. The Delegation stated that the grace period related

only to the time limit between the disclosure and the filing of the application, but not the rights it conferred.

123. The International Bureau noted that the term “grace period” was used in the 1991 Draft, but that the term did not need to be retained in the final provisions. The International Bureau pointed out that prior art would be considered in relation to novelty and inventive step/non-obviousness, since even with a grace period, the prior art that was considered for novelty and inventive step could differ.

124. The Delegation of Australia stated that it had reservations with regard to limiting the treaty to “pre-grant” issues in respect of disclosure, structure of claims and interpretation of claims. The Delegation noted, in particular, that prior art, novelty, inventive step, and industrial applicability were being considered generally and not in the environment of the “pre-grant” process. However, it would not insist on its objection, noting that pre-grant harmonization would be an achievement in itself.

125. The International Bureau acknowledged that, if there were a difference between pre-grant and post-grant interpretation in the context of a global patent system, there was a risk of forum shopping where one would seek the most beneficial pre-grant interpretation at examination and the most beneficial post-grant interpretation where a product was marketed.

126. The Chair, noting that no other delegation wished to take the floor, stated that there appeared to be general agreement with the direction proposed by the International Bureau. The Chair invited the delegations to make general comments concerning the drafting style of the provisions.

127. The Delegation of the United States of America, noting its willingness to show flexibility on a number of major points of contention in the United States such as the first-to-file and best mode requirements, expressed its hope that all the delegations also had an open mind in terms of achieving real harmonization and were willing to change their systems where that may be appropriate. The Delegation stated that, while the 1991 Draft was a good starting point, the United States of America preferred that any attachment to the language of that Draft or to the laws of the United States of America, the European Patent Convention, Japan or any other system throughout the world be abandoned in favor of adopting new language that was plain, precise, neutral with respect to other systems as well as to technology, and direct in order to express the concepts for which there appeared to be common ground.

128. The Chair noted that it must be assumed by all that national laws may have to change. The Chair also stated that it was appropriate to try to work from a fresh basis in order to use clear and plain language, and that any attempt to model the law after the law of any one country or group of countries would disenfranchise the others. The Chair also stated that there was some language which should be retained, for example generally accepted terms for basic concepts.

129. The International Bureau noted the proposal made by the Delegation of the United States of America and the Chair concerning the style of drafting, and stated that it was prepared to go forward on that basis. The International Bureau noted that similar goals guided the work on the PLT. Further, it asked whether the deviation from the language of the PCT was also contemplated.

130. The Delegation of the United States of America stated that, while it was not appropriate to deviate from the language of the PCT in adopting the PLT, especially since certain provisions of the PCT were incorporated in the PLT, that was not the case with the envisaged new treaty. The Delegation also indicated that it had not intended to suggest that terms such as “novelty,” “inventive step,” or “non-obviousness” should be abandoned, but rather that plain, simple, and direct language should be used.

131. The Representative of the EPO proposed a different approach than that outlined by the Delegation of the United States of America, while acknowledging the necessity of a fresh start. The Representative stated that the 1991 Draft was a solid basis for starting the discussion and for checking whether or not the positions developed in the years before the 1991 Diplomatic Conference are still valid. The Delegation also stated that the SCP should look at the PCT provisions and follow the line of thinking when drafting the PLT. The Representative, noting that legal and political environments changed very quickly, recommended keeping the present treaty as flexible as possible by putting in only the basics and leaving the details for the regulations.

132. The Delegation of Japan, while expressing its sympathy with the proposal of the Delegation of the United States of America that language be plain, precise, and neutral in terms of territory as well as technology, agreed with the Representative of the EPO that the 1991 Draft be the starting point for the discussion. The Delegation also stated that the SCP should be flexible to accept changes to the language at a later stage.

133. The Delegation of the United States of America noted that, if the stated objectives could be achieved, i.e., mutual recognition and full faith and credit between the national Offices, perhaps the role of the PCT might change in the future.

134. The Delegation of Spain stated that it would submit proposals on drafting points in the Spanish text.

135. The Delegation of Germany stated that simple and clear language should be looked for and, if found, should be adopted over the existing language.

136. The International Bureau, in order to accommodate the full range of views expressed, offered to prepare a document which contained, on facing pages, a text utilizing new language and a text utilizing existing language. The International Bureau pointed out that this would allow the SCP to compare and contrast the two versions.

137. The Chair stated that the proposal of the International Bureau seemed to address all concerns expressed.

138. In response to an intervention of one delegation, the International Bureau said that, while preparing the draft, the question of the priority date or filing date of an application versus multiple priorities was discussed, and, in the future, reference would have to be made to the priority or filing date of the invention as claimed in a certain claim, and not of the application. It pointed out the difficult challenges that would arise in balancing the desires to have flexibility on the one hand and to achieve harmonization on the other, or to use neutral language on the one hand and to keep the old standards that everyone knew how to apply on the other.

139. The Representative of the JPAA said that issues surrounding prior disclosure on the Internet might be extremely difficult, e.g., when information regarding an invention was downloaded and printed out, or when prior art once posted on the Internet was subsequently removed. The Representative urged further discussion regarding clarification of the difference between the Internet and paper environments and suggested that it be explicitly mentioned.

140. The Delegation of the Russian Federation observed that, although the meaning of the words “availability to public” was interpreted more or less similarly in various patent systems, it would be useful to elaborate a uniform presentation of the term within the context of the Treaty. In particular, the Delegation suggested that “availability” should refer to the availability to the general public, as in the law of Japan, or availability to unspecified persons, and not to a tangible or concrete person.

141. The Delegation of Austria noted that a general provision on prior art should cover all possible kinds of publications since it was the task of the examiner, or the court, to decide in each case whether or not there had been a relevant publication. The Delegation noted that, although it was a matter of evidence in each case, there was no need for a regulation of the means of evidence.

142. The International Bureau noted that the provisions had to be viewed in light of all the existing systems, many of which would have to change if the goal of harmonization was to be achieved. The International Bureau stated that, with regard, e.g., to the acceptance of oral prior art, practitioners and examiners in countries that do not now recognize oral prior art would need some guidance as to what methodology would have to be applied. The International Bureau also stated that the acceptance of such decisions on a case by case basis under different systems and traditions would defeat the goal of harmonization.

143. The Representative of the EPO stated that the issues under discussion, e.g., the meaning of “available to the public,” were best dealt with in the Rules or practice guidelines and not in the Articles, an approach which the Representative maintained was consistent with the goal of harmonization. Care should be taken not to be too precise in the treaty because there should be room for flexibility and individual cases to be dealt with.

144. The Delegation of Germany supported the intervention of the Delegation of Austria. The Delegation cautioned against drafting provisions that were too complicated or detailed for fear of failing to include something or failing to anticipate new developments.

145. The International Bureau noted that the Committee would have to draw a line between what was to be included in the treaty and what was to be left to the interpretation of the individual Offices, since provisions that were easy to understand may nonetheless be understood in different ways by different people. The International Bureau stated that it may be advisable to start with detailed provisions which could later be simplified, as opposed to starting with simple provisions with multiple interpretations, which could defeat the goal of mutual recognition of search and examination results. It noted that a generally worded treaty would only be effective if each Office was flexible enough to accept search and examination results from another Office that differed from those that it would have reached itself.

146. The Delegation of Germany noted that, after consideration of the comments of the International Bureau, it wished to state that the harmonization of practice could only be achieved as a second step, after harmonization of the law.

147. The International Bureau requested clarification from the Committee with regard to its goals concerning the present treaty, and asked whether the intent was to harmonize the law only, or law and practice. The International Bureau also asked whether, after the entry into force of a future treaty, mutual recognition should be then possible, or if it would require another step. If the latter, would that second step take the form of another treaty, regulations or administrative instructions on this treaty, a common court to interpret the practices of the offices or decisions of the courts in individual countries, or something else.

148. The Representative of the EPO stated that the aim to come to mutual recognition shortly after having finalized this treaty was ambitious and hardly achievable. The Representative said that there appeared to be a broad consensus to achieve concrete results soon, which, as stated by the Delegation of Germany, would be the harmonization of substantive patent law, a necessary first step to the later harmonization of the practice that is governed by substantive law. The Representative cited the European experience of having spent twenty years in fully harmonizing the various national patent laws in Europe, but without having achieved a totally harmonized practice yet. The European approach for harmonizing practice was the so-called Roundtable on Patent Practice, where Offices exchanged their views on a regular basis.

149. The Delegation of the United States of America, in responding to the question of the International Bureau, stated that it understood that the Committee was working toward the goal of mutual recognition or full faith and credit, and that it had a strong preference to attempt to harmonize both law and practice in the present treaty, in order to achieve genuine harmonization or at least to lay a very good groundwork for mutual recognition.

150. The Delegation of Japan stated that differences in practice were connected to differences in national law, including case law. The Delegation noted that the Trilateral Offices had reached a common understanding that there was a limitation in their cooperation since there were differences in practice which stemmed mainly from differences in national law, including case law. The Delegation stated that it expected national and regional laws to change in response to the efforts of the Committee. The Delegation stated that the final goal was mutual recognition, but that, in the absence of consensus with regard to mutual recognition, the harmonization of substantive law was the first step.

151. The Chair stated that if different practices in different Offices yielded the same result, e.g., with regard to whether a patent would be granted and be valid, then there would be no need to discuss practice, but that if different practices yielded different results concerning the grant or the validity of patents, then the difference in those practices must embody an element of substantive law which should be considered.

152. The Delegation of the Russian Federation stated that it was premature and unrealistic to expect to achieve the aim of mutual recognition. The Delegation questioned whether a patent which was granted without search and examination should be endorsed and recognized by another system where such examination was obligatory. The Delegation stated, with respect to what should be harmonized, practice or law, that it was difficult to draw a line between the two. The Delegation stated that some degree of harmonization should be attempted with regard to the six points contained in document SCP/4/2.

153. The International Bureau, in responding to the comments of the Delegation of the Russian Federation, noted that mutual recognition referred to the mutual recognition of the results of substantive examination, and not of the registration of patents. It suggested that a “harmonized” national office, from the point of view of the user, could be viewed as a “black box” with an “in” door and an “out” door: the “in” door would represent the ability to file a single application with a single set of claims that could be filed with confidence in every office of every country that is a party to the treaty. This would require harmonization of legal principles. The “out” door would represent the uniformity of search and examination results, which would require the harmonization of practice. The International Bureau suggested that a way of moving forward with the treaty would be to pursue three levels of drafting: a treaty, which should be as short as possible; regulations, which could be changed by the Assemblies as times change; and practice guidelines, which would offer guidance as to how an application should be treated by an Office. The treaty and regulations would be drafted towards the goal of harmonizing law, and permitting a patent application to be drafted along with the claims so that they would be acceptable in all Offices that adhered to the treaty. The practice guidelines could, step-by-step, be built up to suggest harmonization solutions concerning Office practices. At a later stage, the Committee could decide whether the guidelines should be part of the treaty, or a document updated and distributed by the Assembly as a binding instrument, or a non-binding supplement.

154. The Delegations of Japan, the United States of America and the Representative of the EPO stated that they fully agreed with the suggestion of the International Bureau.

155. The Chair noted that the Committee had accepted the suggestion by the International Bureau, and declared that the Committee would proceed in that way.

Agenda Item 5: Disclosure of Information on the Internet

156. The discussion was based on document SCP/4/5.

157. The Delegation of Japan explained that a recent revision of the patent law of Japan was undertaken primarily to extend the scope of the grace period, which had not covered disclosures that occurred on the Internet. Further, disclosures on the Internet were not included under the prior art provisions of Japanese patent law. However, in practical terms, such disclosures rarely destroyed novelty or inventive step. The Delegation said that, in its view, disclosures that took place on the Internet should be dealt with in a general manner and along the lines of Article 11(2)(b) of the 1991 Draft, rather than being addressed in specific terms.

158. The Delegation of the United States of America said that it was necessary to apply principles for the establishment of prior art to disclosures in electronic format. In that context, the determination of the date of availability was of paramount importance. The Delegation announced that it was currently working on guidelines for its Office concerning that matter and that those guidelines would be made available as soon as they were adopted.

159. The Representative of the EPO said that the particular problem related to Internet disclosures were under consideration in the EPO. No case involving an Internet disclosure had been brought before the EPO Boards of Appeal yet. At present, established practices developed with regard to non-written disclosures, such as oral disclosures or prior uses, were applied to disclosures on the Internet. Therefore, three issues were of main importance, namely the questions of what was disclosed, when it was disclosed and how it was disclosed. Since an Internet publication could be changed at any time, the exact content of such a disclosure and the exact date of publication could be questionable. Similar problems existed in opposition procedures and in connection with the determination of prior use. In accordance with EPO practice, it was sufficient that, in order to be considered as having been disclosed, information was available on the Internet for a person skilled in the art, even if the information was not actually accessed. However, if the document was only very shortly available on the Internet, it could be concluded that it was not really made available to the public.

160. The Delegation of Sweden declared that, although disclosures on the Internet created problems for search and examination, a need for new legal principles or an amendment of existing principles did not exist. Issues that deserved attention for practical purposes were the validity of a citation of a non-patent-literature document, the authenticity of documents, and the question of copyright, where a copy of the citation was attached to the search report.

161. The Delegation of Germany stated that it did not consider it necessary to establish treaty provisions dealing specifically with disclosures on the Internet. That subject could be better dealt with in guidelines.

162. The Delegation of Australia said that the main issue appeared to be the question of what the requirement for citations in search reports of disclosures that occurred on the Internet should be. In that context, the question of the burden of proof was also important. The Delegation explained that, in its country, the burden of proof worked in favor of the applicant in cases where the Office could not establish a date of actual publication.

163. The Delegation of Uruguay said that, before work on the subject under consideration could advance, it would be useful to study the various types and categories of documents that were published on the Internet, such as databases or patent documents. This could help to define minimum standards for determining a date of publication.

164. Noting that the Guidelines of the Japanese Patent Office covered a two-way transmission line, but not broadcasting, the Representative of FICPI wondered whether general problems also existed in relation to a disclosure through broadcasting. In response, the Delegation of Japan said that disclosures through broadcasting were dealt with under "public knowledge or "public use," and that the term "telecommunication line" was chosen in order to avoid the narrow term "Internet."

165. The Delegation of the Netherlands said that, although it did not have specific experience with disclosures that had occurred on the Internet, it felt that it was useful to harmonize the definition of prior art in a manner that would also be applicable to documents that existed in electronic format.

166. The Chair suggested that a questionnaire to the member States could be prepared by the International Bureau in order to gather information concerning practices on various scenarios in the Internet environment and to compare it with existing practices.

167. The Representative of the EPO supported the suggestions by the Chair concerning the establishment of a questionnaire. The Representative further suggested to draft treaty language on prior art as a first step, and to look at the practical issues at a later stage.

168. The Chair invited delegations to consider whether other issues in the context of patents and the Internet should be included in the work of the Committee.

169. The Delegation of Japan stated that there were two categories of issues in this area. The first category included issues of jurisdiction and applicable law and should, because of its cross-cutting nature, more properly be addressed in a horizontal forum. The second category comprised genuine patent issues, such as patent infringement on the Internet. These issues should be addressed in the SCP. An appropriate way of moving forward would be first to determine the issues and then discuss in the SCP whether they called for a change of the international legal framework, while taking due account of the cross-cutting issues.

170. The Chair concluded that a majority of the delegations considered publication on the Internet as merely a special case of publication which could be addressed under traditional principles of law. However, there was a need to assure, on an ongoing basis, that any criteria for “prior art” in the draft treaty would take account of recent and future developments in information technology. The International Bureau would circulate a questionnaire on current national and regional practices in Internet-related issues, in particular with regard to publications on the Internet, and including questions regarding the infringement of patents on the Internet.

CONCLUSION OF THE MEETING

Agenda Item 6: Future work

171. The International Bureau stated that the main item on the agenda of the coming sessions would be substantive harmonization of patent law. The next session would tentatively be held from May 14 to 18, 2001, and would comprise five full days of discussion. At the end of the session, a Summary by the Chair containing only the results of the discussion would be adopted. As soon as possible, preferably within one week after the meeting, the International Bureau would circulate a draft Report in English. The French and Spanish versions would be circulated as soon as they were available. The deadline for comments would start to run as soon as all language versions had been circulated. Any comments received during that period would be incorporated and the final Report could be adopted at the following session.

[Annex follows]

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