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DRAFT SUBSTANTIVE PATENT LAW TREATY

prepared by the International Bureau

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INTRODUCTION

1. At its fourth session, held from November 6 to 10, 2000, the Standing Committee on the Law of Patents (SCP) agreed that the International Bureau should submit draft provisions for a future legal instrument on the substantive harmonization of patent law. The present document contains a first draft of a Treaty, presently called the “Substantive Patent Law Treaty (SPLT).” It takes into account the views expressed at the fourth session of the SCP.
2. The SCP further expressed the wish that the International Bureau should submit two distinct versions of draft provisions on the SPLT: one version should be based on existing texts, such as the “Draft Treaty Supplementing the Paris Convention as Far as Patents Are Concerned” (“1991 Draft”; see documents PLT/DC/3 and 69) or the Patent Cooperation Treaty (PCT), while the second version should use new and plain language. In the course of drafting the present document, it became apparent that it may be more appropriate to establish a single text containing two alternatives. Thus, the document contains, where appropriate, an Alternative A, which is based upon, but is not necessarily identical to, existing texts as explained above, and an Alternative B, which uses more contemporary language. Where the text of Alternative A is not identical to earlier existing texts, such as, for example, the 1991 Draft, this is to take into account the international developments that occurred since the establishment of these texts, and to reflect the wish of the SCP to achieve full harmonization, without permitting territorial differences between countries. As agreed by the SCP at its fourth session, the draft provisions are limited to certain determined issues, in particular those contained in paragraph (9) of document SCP/4/2.
3. It should be noted that certain of the suggested provisions (for example draft Article 9) reflect a first-to-file system, since their origin is to be found in existing texts. This approach does, however, not prejudice the future drafting of the relevant provisions in any way, but was chosen merely to reflect certain provisions of existing texts, such as the 1991 Draft.
4. Draft Regulations and Draft Practice Guidelines under the SPLT are contained in document SCP/5/3. These provisions are presented without an alternative and are based on existing texts only, since their future wording will depend on the choice of the SCP with respect to the drafting style of the Articles.

PART I: GENERAL PROVISIONS

Article 1

Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:

(i) except where the context indicates otherwise, words in the singular include the plural, and *vice versa*, and masculine personal pronouns include the feminine.

...

Article Ibis

Applications [and Patents] to Which the Treaty Applies

(1) [*Principle*] Subject to paragraph (2), the provisions of this Treaty and the Regulations shall apply to[

(i)] applications for patents for invention and for patents of addition, which are filed with or for the Office of a Contracting Party[;

(ii) patents for invention, and to national and regional patents of addition, which have been granted with effect for a Contracting Party].

(2) [Reserved]

Article 2

Right to a Patent

Inspired by Art. 9, 1991 Draft, as amended by PLT/DC/69
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The right to a patent shall belong to the inventor or his successor in title, as prescribed in the Regulations.

PART II: APPLICATION

Article 3

Contents of Application

[Alternative A]

[No provision.]

[End of Alternative A]

[Alternative B]

An application shall contain

- (i) a request, as provided for in the Patent Law Treaty,
- (ii) a description,
- (iii) one or more claims,
- (iv) one or more drawings, where required, and
- (v) an abstract.

[End of Alternative B]

[Article 4¹

Lengthy Applications

A Contracting Party may prescribe special requirements in respect of lengthy applications, as prescribed in the Practice Guidelines.]

¹ This provision is placed in square brackets, since its inclusion has not been specifically requested by the SCP. The SCP may consider the option of moving this provision to the Regulations under Article 5.

Article 5

Contents, and Order of Contents, of Description

The description part of the application shall be in writing and have the contents, and be presented in the order, prescribed in the Regulations.

Inspired by
Art. 3(2)(b),
1991 Draft

Article 6

Contents, Style and Manner of Presentation of Claims

Parts of Art. 4, 1991 Draft

(1) [*Contents of the Claims*] The claims shall define the matter for which protection is sought[, as prescribed in the Regulations].

(2) [*Style of the Claims*] The claims, both individually and in their totality, shall be clear and concise, as prescribed in the Regulations.

(3) [*Manner of Presentation of the Claims*] The claims shall be presented as prescribed in the Regulations.

Article 7

Unity of Invention

Art. 5, 1991 Draft

[Alternative A]

(1) [*Requirement of Unity of Invention*] The application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”), as prescribed in the Regulations.

(2) [*Validity of Patent Not Affected by Lack of Unity of Invention*] The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

[End of Alternative A]

[Alternative B]

The claims in the application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept, as prescribed in the Regulations.

[Regulations with substance as in Alternative A]

[End of Alternative B]

PART III: PRIOR ART

Article 8

Definition of Prior Art

Art. 11(2)(b), 1991 Draft

[Alternative A]

The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world, as prescribed in the Regulations.

[End of Alternative A]

[Alternative B]

Subject to Articles 9 and 10, the prior art with respect to a particular claim shall consist of all information which has been made available to the public anywhere in the world, as prescribed in the Regulations, before the filing date or, where priority is claimed, the priority date of the application which discloses the subject matter of the claim.

[End of Alternative B]

Article 9

Prior Art Effect of Earlier Applications

[Alternative A]²

Inspired by Art. 13(1)(a), 1991 Draft

An application filed in, or with effect for, a Contracting Party before, but published after, the filing date or, where priority is claimed, the priority date of another application filed in, or with effect for, that Contracting Party shall form part of the prior art, as prescribed in the Regulations.

[End of Alternative A]

[Alternative B]

An application filed before, but published after, the filing date or, where priority is claimed, the priority date of the application under consideration shall form part of the prior art, as prescribed in the Regulations.

[End of Alternative B]

² If the Alternative A is chosen, a provision concerning prior art effect of earlier PCT international applications, which may be similar to Article 13(3) of the 1991 Draft, shall be included in Rule 7

[Article 10³

[Alternative A]

Disclosures Not Affecting Patentability (Grace Period)

Art. 12, 1991 Draft, as amended by PLT/DC/69
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(1) [*Circumstances of Disclosure Not Affecting Patentability*] Disclosure of information which otherwise would affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed during, or with effect under Article 9 on a date during, the 12 months preceding the filing date or, where priority is claimed, the priority date of the application,

- (i) by the inventor,
- (ii) by an Office and the information was contained
 - (a) in another application filed by the inventor and should not have been disclosed by the Office, or
 - (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information direct or indirectly from the inventor,

or

³ This provision is placed in square brackets, since its inclusion may be dependent on discussions to take place at a later stage.

[Article 10(1), continued]

(iii) by a third party which obtained the information directly or indirectly from the inventor.

(2) [*“Inventor”*] For the purposes of paragraph (1), “inventor” also means any person who, at or before the filing date of the application, had the right to the patent.

(3) [*No Time Limit for Invoking Grace Period*] The effects of paragraph (1) may be invoked at any time.

(4) [*Evidence*] Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving, or of making the conclusion likely, that the conditions of that paragraph are fulfilled.

[End of Alternative A]

[Alternative B]

Grace Period

The prior art shall not include information made available to the public during the 12 months preceding the filing date or, where priority is claimed, the priority date of the application, where that information was made available as prescribed in the Regulations.]

[Regulations with substance as in Alternative A]

[End of Alternative B]

PART IV: DISCLOSURE AND CLAIMS

Article 11

[Alternative A]

Inspired by Art. 3(1)(a), 1991 Draft
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Disclosure in Application as a Whole

The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art, as prescribed in the Regulations.

[End of Alternative A]

[Alternative B]

Adequacy of the Disclosure

The disclosure of the claimed invention shall be adequate if, taking into account the description, claims and drawings contained in the application on the filing date of the application, it provides information which is sufficient to allow the invention to be made and used by a person skilled in the art without undue experimentation, as prescribed in the Regulations.

[End of Alternative B]

Article 12

Relationship of Claims to the Disclosure

Inspired by Art. 4(4), 1991 Draft

[Alternative A]

The claims shall be supported by the description and the drawings.

[End of Alternative A]

[Alternative B]

The claims shall be supported by the disclosure as prescribed in the Regulations.

[End of Alternative B]

Article 13

Scope of Claims

[Alternative A]

[No provision.]

[End of Alternative A]

[Alternative B]

The scope of the claim shall not exceed the scope of the disclosure of the application.
However, the claim shall not be limited to what is expressly disclosed in the application.

[End of Alternative B]

Article 14

[Alternative A]

Scope of Protection

Parts of Art. 21, 1991 Draft.

(1) [*Scope*] The scope of protection conferred shall be determined by the claims, which are to be interpreted in the light of the description and drawings, as prescribed in the Regulations.

[(2) [*Equivalents*] For the purpose of determining the scope of protection conferred by the application, due account shall be taken of elements which are equivalent to the elements expressed in the claims, as prescribed in the Regulations.]

[End of Alternative A]

[Alternative B]

Interpretation of Claims

For the purposes of examination, and of determining rights under a published application, each claim shall be interpreted in light of the [description, drawings] [disclosure] and the prior art, as prescribed in the Regulations.

[End of Alternative B]

PART V: SUBSTANTIVE CONDITIONS OF PATENTABILITY

Article 15

Patentable Subject Matter

[Alternative A]

[Reserved]

[End of Alternative A]

[Alternative B]

The claimed invention shall [contain] [be] patentable subject matter, as prescribed in the Regulations.

[Regulations reserved.]

[End of Alternative B]

Article 16

Industrial Applicability/Utility

Inspired by PCT Art. 33(4) (in part)
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[Alternative A]

An invention shall be considered industrially applicable (useful) if, according to its nature, it can [be made or used in any kind of industry][have a specific, substantial and credible utility], as prescribed in the Regulations.

[End of Alternative A]

[Alternative B]

[Delete industrial applicability/utility requirement.]

[End of Alternative B]

Article 17

Novelty

Inspired by Art. 11(2)(a), 1991 Draft

[Alternative A]

An invention shall be considered novel if it does not form part of the prior art, as prescribed in the Regulations.

[End of Alternative A]

[Alternative B]

A claimed invention shall be considered novel unless every limitation of the claimed invention is found in a single item of prior art, as prescribed in the Regulations.

[End of Alternative B]

Article 18

Inventive Step/Non-Obviousness

Art. 11(3), 1991 Draft

[Alternative A]

An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in Article 8, it would not have been obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date of the application claiming the invention, as prescribed in the Regulations.

[End of Alternative A]

[Alternative B]

A claimed invention shall be considered to involve an inventive step (be non-obvious) unless the differences between the claimed invention and the prior art, at the filing date or, where priority is claimed, the priority date of the application which discloses the subject matter of the claim, were obvious to a person skilled in the art, as prescribed in the Regulations.

[End of Alternative B]

PART VI: PATENTABILITY

Article 19

Patentability of Claimed Invention

- (1) [*Determination of Patentability of Claim*] A claimed invention shall be patentable, unless:
- (i) it does not meet the requirements in Articles 2, 6(2) and (3), 7 and 15 to 18;
 - (ii) the application does not meet the requirements of the Patent Law Treaty, as implemented in the applicable law, and of Articles 3, [4], 5 and 11 to 13, herein; or
 - (iii) it relies on disclosure that resulted from an amendment or correction prohibited by Article 20(3)(a).
- (2) [*Prohibition of Other Requirements*] No requirement of patentability additional to or different from those provided for in paragraph (1) may be imposed.

PART VII: AMENDMENTS AND CORRECTIONS

Article 20

Amendment or Correction of Application

Art. 14,
1991 Draft

(1) [*Amendments or Corrections Following Office Findings*] Wherever the Office finds that the application does not comply with any requirements under the Treaty or the Regulations applicable to it, it shall give the applicant at least one opportunity to amend or correct the application or to comply with the said requirements.

(2) [*Amendments or Corrections on Applicant's Initiative*] The applicant shall have the right, on his own initiative, to amend or correct the application or to comply with a requirement applicable to the application up to the time when the application is in order for grant, as prescribed in the Regulations; however, any Contracting Party which provides for substantive examination may provide that the applicant shall have the right to amend or correct, on his own initiative, the description, the claims and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

(3) [*Limitation of Amendments or Corrections*] (a) No amendment or correction, other than the correction of a clear mistake [or of a clerical error] within the meaning of subparagraph (b), shall be permitted where the amendment or correction would result in the disclosure of the invention contained in the amended or corrected application going beyond the disclosure of the invention contained in the application as filed for the purposes of the filing date.

Art. 14(3),
1991 Draft, as
amended by
PLT/DC/69

(b) For the purposes of subparagraph (a), a mistake shall be considered clear[, and an error shall be considered clerical,] where what is corrected would have been clearly wrong, and the correction would have been clear, to a person skilled in the art at the time of filing.

PART VIII: REMEDIES AGAINST REJECTION OR REFUSAL OF APPLICATION

Article 21

Observations and Review

Inspired by
Art. 10(2)
PLT

(1) [*Opportunity to Make Observations, Amendments or Corrections in Case of Intended Rejection or Refusal*] An application may not be rejected or refused on the grounds of lack of patentability, either totally or in part, without the applicant being given the opportunity to make observations on the intended rejection or refusal, and to make amendments and corrections where permitted under the applicable law, within the time limit prescribed in the Regulations.

(2) [*Review After Rejection or Refusal*] The rejection or refusal of an application by the examining authority on the grounds of lack of patentability of the invention under Article 19 shall be subject to review by a judicial or quasi-judicial authority.

Inspired by
TRIPS
Art. 62.5

PART IX: RELATIONSHIP OF THE TREATY TO THE PATENT LAW TREATY

Article 22

Relationship to PLT

Each Contracting Party shall [implement the provisions of] [adhere to] the Patent Law Treaty.

PART X: ADMINISTRATIVE AND FINAL PROVISIONS

Article 23

Regulations

Inspired by PLT Art. 14

- (1) [*Content*] The Regulations annexed to this Treaty provide rules concerning:
- (i) matters which this Treaty expressly provides are to be “prescribed in the Regulations”;
 - (ii) details useful in the implementation of the provisions of this Treaty;
 - (iii) administrative requirements, matters or procedures.
- (2) [*Amending the Regulations*] Subject to paragraph (3), any amendment of the Regulations shall require [reserved].
- (3) [*Requirement of Special Majorities*] (a) The Regulations may specify provisions of the Regulations which may be amended only by [unanimity][a majority of nine tenths][a majority of four fifths] [, provided that [none of the Contracting Parties whose Offices have received at least yy applications according to the most recent annual statistics published by the International Bureau dissent] [at least xx Contracting Parties whose Offices have received at least yy applications according to the most recent annual statistics published by the International Bureau do not dissent]].

[Article 23(3), continued]

(b) Any amendment of the Regulations resulting in the addition of provisions to, or the deletion of provisions from, the provisions specified in the Regulations pursuant to subparagraph (a) shall require [unanimity][a majority of nine tenths][a majority of four fifths] [, provided that [none of the Contracting Parties whose Offices have received at least yy applications according to the most recent annual statistics published by the International Bureau dissent] [at least xx Contracting Parties whose Offices have received at least yy applications according to the most recent annual statistics published by the International Bureau do not dissent]].

(c) In determining whether unanimity is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(4) [*Conflict Between the Treaty and the Regulations*] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 24
Practice Guidelines

Inspired by PLT Art. 14 and PCT Rule 89

(1) [*Content*] The Practice Guidelines annexed to this Treaty and the Regulations provide guidelines concerning:

(i) matters which this Treaty or the Regulations expressly provides are to be “prescribed in the Practice Guidelines”;

(ii) details useful in the implementation of the provisions of this Treaty and the Regulations.

(2) [*Amending the Practice Guidelines*] [*Reserved*]

[End of document]