

WIPO



SCP/7/3

ORIGINAL: English

DATE: March 6, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

STANDING COMMITTEE ON THE LAW OF PATENTS

Seventh Session
Geneva, May 6 to 10, 2002

DRAFT SUBSTANTIVE PATENT LAW TREATY

prepared by the International Bureau

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INTRODUCTION

1. The present document contains a revised version of the draft Substantive Patent Law Treaty (SPLT). It takes into account the views expressed in the Standing Committee on the Law of Patents at its sixth session (November 5 to 9, 2001).
2. Differences between the former text of the draft SPLT contained in document SCP/6/2 and the revised text contained in the present document, except where an existing provision or paragraph as a whole has been moved from another provision or paragraph, have been highlighted as follows:
 - (i) words which did not appear in document SCP/6/2 but appear in the present text are underlined, and
 - (ii) words which appeared in document SCP/6/2 but which are omitted from the present document are shown as struck through.
3. It should be noted that certain of the suggested provisions (for example, draft Article 8(2)) reflect a first-to-file system. This approach does, however, neither prejudice the future drafting of the SPLT, nor the discussion by the Committee on the inclusion of additional issues into the Treaty.
4. Draft Regulations and Draft Practice Guidelines under the draft SPLT are contained in document SCP/7/4. Explanatory Notes on the provisions of the draft SPLT and the Regulations are contained in document SCP/7/5.

Article 1

Abbreviated Expressions

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

(i) “Office” means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty;

(ii) “application” means an application for the grant of a patent, as referred to in Article 3;

(iii) “international application” means an application filed under the Patent Cooperation Treaty;

(iv) “parent application” means an application from which a divisional, continuation or continuation-in-part application is derived in accordance with the applicable law;

~~(iii)~~ (v) “patent” means a patent as referred to in Article 3;

(vi) “claimed invention” means the subject matter of a claim for which protection is sought;

(vii) “applicant” means the person whom the records of the Office show, pursuant to the applicable law, as the person who is applying for the patent, or as another person who is filing or prosecuting the application;

~~(vi) “filing date” means the filing date of an application as provided for in the applicable law of the Contracting Party in accordance with [Article 5 of] the Patent Law Treaty;~~

~~(vii) reference to the “time of filing” means the [precise time] [time expressed in hours and minutes] at which the application is filed with the Office on a particular date;~~

~~(viii) the “priority date” for an application means, where a right of priority is claimed, the filing date of the earliest filed application whose priority is claimed under the applicable law in accordance with the Paris Convention;~~

~~(ix-viii) the “claim date” for a claim in an application means, subject to item (ix), the filing date of the application ~~containing the claim~~, or, where priority is claimed in accordance with the applicable law, the filing date of the earliest application whose priority is claimed and which contains the subject matter of the claim (“priority date”) ~~whose priority the claim is entitled to under the applicable law~~; where a claim defines its subject matter in the alternative there is more than one alternative limitation in one claim, and different of those~~

[Article 1, continued]

~~limitations are entitled to different claim dates, [the claim date for the claim in respect of each alternative shall be the claim date to which that alternative is entitled latest of those dates] [the claim date for the claim in respect of each alternative limitation shall be considered to be a separate claim for the purposes of determining the claim date the claim date to which that limitation is entitled];~~

(ix) the “claim date” for a claim in a divisional, continuation or continuation-in-part application shall be the filing date of the parent application which contains the subject matter of the claim in the divisional, continuation or continuation-in-part application or, where that parent application claims priority in accordance with the applicable law, the filing date of the earliest application whose priority is claimed and which contains the subject matter of the claim in the divisional, continuation or continuation-in-part application;

~~(x) —“general knowledge of a person skilled in the art” means the common knowledge generally known to a person skilled in the art, including well known or commonly used information, or matters clear from empirical rules;~~

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

(xii) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;

(xiii) “Patent Law Treaty” means the Patent Law Treaty, signed on June 2, 2000, together with the Regulations under that Treaty, as revised and amended;

(~~xiii~~iv) “Patent Cooperation Treaty” means the Patent Cooperation Treaty, signed on June 19, 1970, together with the Regulations and the Administrative Instructions under that Treaty, as revised, amended and modified;

(xiv) “Contracting Party” means any State or intergovernmental organization that is party to this Treaty;

(xvi) “applicable law” means, where the Contracting Party is a State, the law of that State and, where the Contracting Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;

(xvii) “instrument of ratification” shall be construed as including instruments of acceptance or approval;

(xviii) “Organization” means the World Intellectual Property Organization;

(~~xix~~xviii) “International Bureau” means the International Bureau of the Organization;

(xix) “Director General” means the Director General of the Organization.

Article 2

General Principles

(1) [Requirements Relating to Infringement] Subject to Article 11(4), ~~Nothing~~ in this Treaty and the Regulations shall limit the freedom of a Contracting Party to apply any ~~substantive~~ requirements in relation to infringement.

(2) [Security Exception] Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to take any action it deems necessary for the preservation of essential security interests.

Article 3

Applications and Patents to Which the Treaty Applies

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

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

~~{(ii) to international applications, for patents for invention and for patents of addition, under the Patent Cooperation Treaty; divisional applications of the applications referred to in item (i);}~~

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

(2) [*Exceptions*] This Treaty and the Regulations shall not apply to the applications ~~{and patents}~~ that are prescribed in the Regulations.

Article 4

Right to a Patent

(1) [Principle] The right to a patent shall belong:

(i) to the inventor; or

(ii) to the ~~inventor's~~ successor in title of the inventor, ~~or;~~

~~(iii) to any third party, who is in a contractual relationship with the inventor, and who owns the claimed invention under another legal title,~~

~~as prescribed in the Regulations.~~

(2) [Employee's Inventions and Commissioned Inventions] [(a)] Notwithstanding paragraph (1), Any Contracting Party shall be free to determine the circumstances under which and the extent to which the right to the patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention.

[(b)] ~~Notwithstanding subparagraph (a), the law of the Contracting Party applicable to the State in which the employee performs his^{the} main activity under the employment contract for which he is employed shall be applicable apply~~ for the determination of the right to the patent, except where the employment contract provides

otherwise; where the State in which the employee performs the main activity for which he is employed cannot be determined, the law applicable to the State in which the employer has a real and effective industrial or commercial establishment to which the employee is attached shall apply.]

(23) [~~Right to Invention Made Jointly by Several Inventors~~] Where a claimed invention was made jointly by several inventors, each inventor shall have an equal and undivided right to the patent under paragraph (1), except where otherwise agreed by each of the inventors.

{Reserved}

(34) [~~Inventions Made Independently by More Than One Inventor~~]

[Reserved]

Article 5

Application

(1) [*Parts of Application*] An application shall contain the following parts:

(i) a request;

(ii) a description;

(iii) one or more claims;

(iv) one or more drawings, where ~~required~~ they are necessary for the understanding of the claimed invention; and

(v) an abstract.

(2) [*Requirements Concerning Parts of Application*] Except where otherwise provided for by this Treaty and the Regulations or the Patent Law Treaty, no Contracting Party shall require compliance with any requirement relating to the request, description, claims, drawings or abstract of an application different from or additional to:

(i) the requirements relating to the request, description, claims, drawings or abstract which are provided for ~~in respect of international applications~~ under the Patent Cooperation Treaty in respect of international applications;

[Article 5, continued]

~~(ii) any further requirements prescribed in the Regulations.~~

(3) [Abstract] Subject to Article 7(3)(a), ~~The~~ abstract referred to in paragraph (1)(v) shall merely serve the purpose of information and ~~cannot be taken into account for any other purpose. In particular, it shall not be taken into account for the purpose of interpreting the scope of the protection sought~~ or of determining the sufficiency of the disclosure and the patentability of the claimed invention.

Article 6¹

Unity of Invention

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.

¹ The text of this Article is subject to the outcome of the Working Group on Multiple Invention Disclosures and Complex Applications.

Article 7

Observations, Amendments or Corrections of Application

(1) [Opportunity to Make Observations, Amendments or Corrections in Case of Intended Rejection or Refusal Following Office Findings] (a) Wherever the Office finds intends to reject or refuse an application on the grounds that the application does not comply with any requirements under Article 13(1) this 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 make observations on the intended rejection or refusal, and to make amendments and corrections of the application, within the time limit prescribed in the Regulations.

(b) No Contracting Party shall be obliged to apply subparagraph (a) in respect of divisional, continuation or continuation-in-part applications, where the opportunity provided for in that subparagraph was already given in respect of the same requirement which was not complied with in the parent application.

(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 under Article 13(1) applicable to the application up to the time when the application is in order for grant; however, any Contracting Party which provides for substantive examination may provide that, except for the correction of a clear mistake under

[Article 7(2), continued]

paragraph (3)(b), the applicant shall have the right to amend or correct, on his own initiative, the description, the claims, the abstract 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) An amendment or correction of the description, the claims, the abstract and any drawings shall be permitted, provided that the amendment or correction would not 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 description, the claims, any drawing and, where prepared by the applicant, the abstract at the time of on the filing date, or included in the missing part of the description or the missing drawing, in accordance with the Patent Law Treaty.

(b) Notwithstanding subparagraph (a), the correction of a clear mistake ~~within the meaning of subparagraph (c)~~ shall be permitted.

~~(c)~~ For the purposes of subparagraph (b), a A mistake shall be considered clear where what is corrected would have been clearly wrong, and the amendment or correction would have been clear, to [a person skilled in the art][anyone] ~~at the time of~~ on the filing date.

Article 8

Prior Art

(1) [*Definition*] Subject to paragraph (2) and Article 9, the prior art with respect to ~~the subject matter of a particular claim~~ a claimed invention shall consist of all information which has been made available to the public anywhere in the world in any form, as prescribed in the Regulations, before the ~~[time of filing on the]~~ relevant claim date of that claim.

(2) [*Prior Art Effect of ~~Former~~Earlier Applications*] If the filing date or, where applicable, the priority date, of an application (“~~former~~earlier application”) filed in, or with effect for, a Contracting Party is earlier than the claim date of a particular claim contained in another application (“later application”) filed in, or with effect for, the same Contracting Party, the ~~former~~earlier application shall, for the purpose of determining the novelty of an invention claimed in the later application, form part of the prior art with respect to the ~~subject matter of that particular claim~~ claimed invention, provided that the ~~former~~earlier application or the patent granted thereon is published subsequently, as prescribed in the Regulations.

[Alternative A]

Information Not Affecting Patentability (Grace Period)

(1) [*General Principle*] Information which otherwise would affect the patentability of ~~an~~ claimed invention ~~claimed in the application~~ shall not affect the patentability of that invention, ~~where~~ in so far as the information was made available to the public anywhere in the world in any form during, or with effect under Article 8(2) on a date during, the 12 months preceding the filing~~claim~~ 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 made available to the public 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 directly or indirectly from the inventor,

or

² ~~This provision is placed in square brackets, since its inclusion may be dependent on discussions to take place at a later stage.~~

(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.~~

(4) [*Intervening Rights*] A third person who in good faith had, between the date on which the information was made available to the public under paragraph (1) and the claim date, used the invention for the purpose of his business or started effective and serious preparations for such use shall have the right to use the invention for that purpose.

[End of Alternative A]

[Article 9, continued]

[Alternative B]

Grace Period

The prior art shall not include information made available to the public anywhere in the world in any form during the 12 months preceding the filing-claim date ~~or, where priority is claimed, the priority date of the application where~~ in so far as that information was made available as prescribed in the Regulations.}]

[Regulations with substance as in Alternative A]

[End of Alternative B]

Article 10

Enabling Disclosure

(1) [*General Principle*] The application shall disclose the claimed 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.~~ The disclosure of the claimed invention shall be considered sufficiently clear and complete if it provides information which is sufficient to allow the invention to be made and used by a person skilled in the art as of the filing date, without undue experimentation, ~~as prescribed in the Regulations.~~

(2) [*Parts of Application to be Taken Into Account for Assessing Disclosure*] For the purposes of assessing sufficiency of disclosure under paragraph (1), the disclosure on the filing date contained in the description, claims and drawings ~~contained in the application on the filing date~~, as amended and corrected in ~~a manner consistent~~ accordance with Article 7, shall be taken into account.

Article 11

Claims

(1) [*Contents of the Claims*] The claims shall define the subject matter for which protection is sought.

(2) [*Style of the Claims*] The claims, both individually and in their totality, shall be clear and concise.³

(3) [*Relationship of Claims to the Disclosure*] (a) Each claims shall be fully supported by the description and the drawings.⁴

(b) The claimed invention shall be supported by the disclosure of the application as filed in a manner allowing a person skilled in the art to recognize from such disclosure that the applicant was, as of the filing date, in possession of the claimed invention.

(4) [*Interpretation of Claims*] ~~(a) Each claim shall be interpreted in light of the description and drawings~~ The wording of the claims shall provide the primary basis for their interpretation. The description, and the drawings ~~and the general knowledge of a person skilled in the art at the time of~~ as amended and corrected in accordance with Article 7,

³ The text of this Article is subject to the outcome of the Working Group on Multiple Invention Disclosures and Complex Applications.

⁴ ~~The SCP may wish to discuss the need of this paragraph in view of draft Article 10.~~

if applicable, and the general knowledge of a person skilled in the art on the filing date shall, in accordance with the Regulations, form the secondary basis for the interpretation of the claims.

(b) For the purpose of determining the scope of protection conferred by the patent, due account shall be taken, in accordance with the Regulations, of elements which are equivalent to the elements expressed in the claims.

*Article 12**Conditions of Patentability*

(1) [~~Patentable Subject Matter~~ Eligible for Protection] (a) A claimed invention shall fall within the scope of ~~patentable~~ subject matter eligible for protection. ~~Patentable s~~Subject matter eligible for protection shall include products and processes [in all fields of technology] which can be made and used in any field of activity, ~~except as prescribed in the Regulations.~~

(b) Notwithstanding subparagraph (a), the following shall not be considered as ~~inventions under Article 12(1)~~ subject matter eligible for protection:

- (i) mere discoveries;
- (ii) abstract ideas as such;
- (iii) scientific and mathematical theories and laws of nature ~~mathematical methods~~ as such;
- (iv) purely aesthetic creations.

(2) [*Novelty*] A claimed invention shall be ~~new~~novel. It shall be considered ~~new~~novel if it does not form part of the prior art, as prescribed in the Regulations.

(3) [*Inventive Step/Non-Obviousness*] A claimed invention shall involve an inventive step. It shall be considered to involve an inventive step (be non-obvious) if, having regard to the differences and similarities between the claimed invention as a whole and the prior art as defined in Article 8(1), ~~that invention~~ would not have been obvious to a person skilled in the art at the claim date, as prescribed in the Regulations.

(4) [*Industrial Applicability/Utility*] A claimed invention shall be industrially applicable (useful). It shall be considered industrially applicable (useful) if it [can be made or used for exploitation in any field of commercial activity][can be made or used in any kind of industry][has a specific, substantial and credible utility].

(5) [*Exceptions*] Notwithstanding paragraphs (1) to (4), a Contracting Party may, in accordance with the Regulations, exclude certain inventions from patentability.

Article 13⁵

Grounds for Refusal of a Claimed Invention

(1) [*Grounds for Refusal of a Claimed Invention*] An application shall be refused where the Office finds that such application or a claimed invention in the application does not meet any of the following requirements:

(i) the applicant does not have the right to the patent referred to in

Article 4;

(ii) the claimed invention does not meet the requirements of Articles ~~4~~-6, 11(2) and (3) and 12;

(iii~~v~~) the application does not meet the requirements of the Patent Law Treaty, as implemented in the applicable law, and of Articles 5 and 10; or

(~~iii~~iv) an amendment or correction results in a disclosure as prohibited by Article 7(3)(a).

(2) [*Prohibition of Other Requirements*] No Contracting Party may require compliance with any requirement relating to the examination of an application or the grant of a patent on a claimed invention different from or additional to the requirements provided for in paragraph (1).

⁵ The SCP agreed in its sixth session to postpone the discussion on this Article until a consensus regarding the substance of the provisions referred to in this Article is reached.

Article 14⁶

Grounds for Invalidation or Revocation of a Claim or a Patent

(1) [*Grounds for Invalidation or Revocation of a Claim or a Patent*] Subject to paragraph (2) and the Patent Law Treaty, non-compliance with any of the requirements referred to in Article 13(1), except those referred to in Articles 6 and 11(3)(a), shall be a ground for the invalidation or revocation of the patented claim or patent.

(2) [*Prohibition of Other Requirements*] No Contracting Party may require compliance with any requirement with respect to the grounds for invalidation or revocation of the patented claim or patent additional to or different from those provided for in paragraph (1).

⁶ The SCP agreed in its sixth session to postpone the discussion on this Article until a consensus regarding the substance of the provisions referred to in this Article is reached.

Article 15

Observations and Review

~~(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 notified and 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 referred to in Article 13(1) shall be subject to review by a judicial or quasi-judicial authority.~~

Article 16

Evidence

(1) [Principle] (a) Where an Office reasonably doubts the veracity of an alleged fact relating to the determination of patentability, it may request the submission of evidence in order to establish the veracity of that fact.

(b) A Contracting Party shall provide for the right of applicants and patent owners to submit evidence with its Office in order to establish the veracity of an alleged fact relating to the determination of patentability.

(2) [Burden of Proof] Where a party invokes a legal consequence from a particular fact, that party shall have the burden of proving the veracity of that fact.

Article 16Z

Relationship to PLT

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

[End of document]