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STANDING COMMITTEE ON THE LAW OF PATENTS

Seventh Session Geneva, May 6 to 10, 2002

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The session was opened by Mr. Francis Gurry, Assistant Director General, on behalf of the Director General, who welcomed the participants. The meeting was chaired by Mr. Dave Herald (Australia). Mr. Volodomir Zharov (Ukraine) and Mr. Chaho Jung (Republic of Korea) served as Vice-Chairmen. Mr. Philippe Baechtold (WIPO) acted as Secretary to the Standing Committee on the Law of Patents (SCP).

Agenda Item 2: Adoption of the Agenda

2. The revised draft agenda (document SCP/7/1 Rev.) was adopted as proposed.

Agenda Item 3: Accreditation of an Intergovernmental Organization

3. The SCP approved the accreditation of the South Center as an *ad hoc* observer (document SCP/7/2).

Agenda Item 4: Adoption of the Draft Report of the sixth session

4. The draft Report of the sixth session (document SCP/6/9 Prov. 2) was adopted with a general observation concerning the French translation by one delegation and modifications proposed by another delegation.

Agenda Item 5: Draft Substantive Patent Law Treaty and Draft Regulations under the Substantive Patent Law Treaty

5. The SCP discussed draft provisions on substantive patent law harmonization, based on the Draft Substantive Patent Law Treaty (SPLT) (document SCP/7/3), the Draft Regulations and Practice Guidelines Under the Substantive Patent Law Treaty (document SCP/7/4), Notes (document SCP/7/5) and Requirements Concerning the Relationship of the Claims to the Disclosure (document SCP/7/6).

6. The SCP discussed the draft articles, together with the corresponding draft rules and draft practice guidelines. It gave the mandate to the International Bureau to redraft the provisions based on the discussions held during the present session, and to submit revised provisions for the next session of the SCP. The brief summary of the discussions is as follows:

Article 1 (except Article 1(viii) and (ix)) and Rule 1

7. No substantive discussion was held on these provisions.

Article 2

8. A proposal to amend paragraph (2) was made jointly by nine delegations, and was supported by some other delegations. One delegation, supported by several other delegations, proposed the inclusion of a new paragraph (3). One delegation suggested that these proposals be included in the draft Treaty, within square brackets for further discussion. Several delegations, however, did not support these proposals, and questioned their relevance for the SPLT. Other issues, for example, the inclusion of a provision similar to Article 2(1) of the Patent Law Treaty were raised in conjunction with paragraph (1). In relation to paragraph (2), one delegation asked for clarification on the words “any action.”

Article 3

9. This provision was generally accepted. Following the suggestion of one delegation to introduce transitional provisions, the International Bureau explained that this issue would be addressed in the final and administrative provisions. One delegation further mentioned that the expression “filed in or for” in paragraph (1)(i) needed further clarification, as discussed in relation to Article 8(2).

Rule 3

10. Although the majority of the delegations were in favor of deleting the phrase “[except for Article 8(2)],” since this matter related to an important issue, the SCP agreed on leaving the text in square brackets for future discussions and reviewing, together with Article 3, the wording of this Rule.

Article 4

11. While there was general support for this provision in principle, a majority of delegations expressed the wish to delete paragraph (2)(b), since it did not relate to substantive patent law. Two delegations, however, proposed to delete Article 4 in its entirety and one delegation proposed to include specific wording on improper derivation in paragraph (1).

Matters relating to Article 5

Article 5

12. There was general support for this provision. Some delegations suggested drafting changes in paragraph (1)(iv) concerning drawings. On paragraph (2), the Representative of one intergovernmental organization referred to the problem caused by the proposed deletion of the word “preferably” in Rule 4(1)(ii) in relation to Articles 13 and 14. Regarding paragraph (3), a majority of delegations expressed the view that the abstract should serve the purpose of information only.

Rule 4

13. The discussion showed the need to establish provisions which provide adequate flexibility for users to draft the description on the one hand and adequate support for the efficiency of offices on the other. Whether the provisions under this Rule should be grounds for invalidation or revocation of a patent or not should be carefully reviewed.

Rule 5

14. The SCP agreed that the word “[technical]” in paragraphs (2) and (3)(i) should be deleted. Concerning the terms “features” and “limitations,” the International Bureau would review the use of these terms in view of the explanation given in Note R5.03. A proposal to allow drawings being contained in a claim received little support.

Article 6 and Rule 6

15. No discussion was held on these provisions, since their substance was referred to the Working Group.

Matters relating to Article 7

Article 7(1) and (2) and Rule 7

16. Although there was general acceptance that paragraph (1)(b) should stay in some form, the drafting of that paragraph needed to be reviewed in terms of its applicability to divisional applications and in respect of the words “same requirement.” Concerning paragraph (2), a

number of delegations expressed the need to clarify the words “in order for grant” and “substantive examination.”

17. Although the proposal made by one delegation to extend Article 7 to the post-grant stage did not receive wide support, the International Bureau was requested to explore the feasibility of including certain issues relating to the correction of patents.

Article 7(3)

18. The possibility of amendments or corrections on the basis of the abstract prepared by the applicant on the filing date received little support from the delegations who spoke.

19. Many delegations expressed their preference for the words “a person skilled in the art” over the word “anyone.”

Matters relating to Article 8

Article 1(viii) and (ix)

20. While there was general support for Article 1(viii) and (ix), a number of delegations expressed a reservation as to the need for introducing the term “claim date.” With respect to item (ix), the application of this provision to divisional or continuation applications will have to be further examined.

Article 8(1)

21. The main debate in relation to this provision focused on the issue of secret prior use, the inclusion of which was requested by one delegation. The Representative of one intergovernmental organization objected to this proposal. In view of the continuing divergences on this issue, and considering the fact that a majority of delegations had expressed their disapproval of the inclusion of secret prior use at the last session of the SCP, no agreement on this provision was reached.

Rule 8

22. The main part of the discussion focussed on the term “reasonable” in paragraph (2). Some delegations expressed the wish to further qualify or explain this term, for example, by replacing it with the expression “reasonable and legitimate.” Some other delegations raised concerns about the possibility of disclosure to one single person. A majority of intervening delegations, however, spoke in favor of maintaining the word “reasonable.” On the other hand, a number of delegations spoke in favor of deleting the reference to “reasonable.”

Guidelines under Rule 8

23. In addition to a number of drafting points raised by some delegations which will be given due consideration, the question was raised whether, in the second last line of G2.04, reverse engineering without undue burden was intended to be covered.

Article 8(2)

24. The provision found agreement in principle in the new version as submitted by the International Bureau in Paper 1. The following specific issues were raised: the first one concerned the phrase “filed in or with effect for” in relation to PCT international applications, and, in particular, to an international application which was filed in a country that was not designated. The second issue concerned the proposal by one delegation to expand the scope of the provision to include inventive step. The Chair recalled that the issue had been discussed at some length at the last session of the SCP, and that a strong majority had expressed the wish to limit the provision to novelty.

Rule 9

25. There was general agreement on this Rule. However, there were some concerns about the scope of the other titles protecting an invention referred to in paragraph (1)(b), the issue regarding the reference to abstracts under paragraph (2), and, in connection with paragraph (3), how a third party would determine an erroneous publication by an office. As regards paragraph (4), the Representative of one intergovernmental organization requested that that paragraph be included within square brackets, while a number of other delegations stated that this provision contained important issues.

Article 9

26. There was strong support for the inclusion of Alternative A. A number of delegations indicated, however, that considerable domestic concern still existed on this matter. The SCP concluded to further discuss various issues, including paragraph (4), which appeared to be a critical provision: while a majority of delegations considered it to be an indispensable part of a grace period provision, some other delegations wished to leave the matter to national law.

Matters relating to Article 10

Article 10

27. There was broad agreement with the principles contained in this Article. Concerning the allocation of provisions in the Treaty and the Regulations, the SCP expressed the view that no lengthy debate should be held at this stage.

Rule 10

28. The SCP considered that this Rule was ready for adoption, subject to the review of the terms “undue experimentation” and “expérimentation excessive.”

Rule 11

29. The SCP felt that the drafting of this provision did not clearly reflect the objectives to be achieved, and that the provision could be redrafted to better express the circumstances where a deposit was required. Concerning the words “may” and “shall” in paragraph (2)(b), most delegations and the Representatives of two intergovernmental organizations expressed a preference for the term “may.”

Rule 2

30. The SCP expressed agreement as to the concept contained in this Rule, including a suggestion by the International Bureau to delete the words “to have access to and to understand all prior art under Article 8, and”, and agreed to the conclusion of the Chair that this Rule was potentially ready to be recommended for adoption at a future meeting.

Guidelines Under Rule 2

31. There was basic agreement on this Guideline, subject to the following drafting issues raised by delegations: in G1.01, second last line, the phrase “not to be required” may be replaced by “not be deemed.” In G1.02, third last line, one delegation proposed to delete the word “average.” The Representative of one intergovernmental organization further proposed the inclusion of the following text at the end of the second last sentence of G1.02: “, in which case the specialized person in that field is the appropriate person skilled in the art.”

Matters relating to Article 11

Article 11(1) and (2)

32. A majority of delegations expressed support for the texts as proposed. However, it was suggested that the International Bureau reflect upon the desirability of providing further elaboration of these provisions in the Regulations on the basis of the explanations contained in the Notes.

Article 11(3) and Rule 11bis

33. Although there was agreement on the general thrust of these provisions as proposed in document SCP/7/6, the SCP requested the International Bureau to review the texts with respect to, for example, the reference to the term “claims” in square brackets. A number of delegations suggested that guidelines be developed in order to elaborate some of the details.

Article 11(4)

34. The general concept of this provision was supported by all delegations who spoke, except for one delegation that expressed concerns about constraints on the courts. Suggestions were made with a view to improve the text as regards the phrase “as amended and corrected in accordance with Article 7” in subparagraph (a). Further, a clarification concerning the meaning of the terms “primary” and “secondary” in subparagraph (a) was requested by a number of delegations.

Rule 12(1) to (3)

35. The question of whether paragraph (1)(b) was already covered by Article 11(4)(a) was raised. Although there was a common view that the claims should not be limited to the embodiments, the draft of paragraph (2)(b) was considered to require further elaboration. As regards the statement by the applicant in paragraph (2)(b), further reflection was required.

Rule 12(4)

36. In the context of subparagraph (d), the need for further investigation of issues such as the novelty of the product, the use of the product and the second medical use was expressed by several delegations.

Rule 12(5)

37. There was wide support for inclusion of this provision, although a small number of delegations questioned the necessity of this provision in the SPLT. The following issues, in particular, were raised: the two elements in the test should be presented as alternatives; the applicability of the alternatives to each Contracting State; and the location of this provision. Concerning the time for assessing the equivalent elements, a large number of delegations expressed their support to taking into account the time of the infringement, while some were in favor of considering the filing date.

Rule 12(6)

38. Delegations expressed divided views about the inclusion of this provision. The Chair suggested that the principles behind the provision be further explored in the future.

Matters Relating to Article 12

Article 12(1), (4) and (5) and Rule 13

39. A large number of delegations strongly requested the retention of the words “in all fields of technology” and made reference to Article 27.2 and 3 of the TRIPS Agreement, in particular, in the context of paragraph (5). One delegation and a number of Representatives of non-governmental organizations expressed their strong view that no reference to the words “in all fields of technology” should be made and that this Treaty should not be bound by the wording of the TRIPS Agreement. The views of delegations were also divided concerning the three alternatives placed within square brackets in paragraph (4). The Chair concluded that, in view of the importance of the issues involved, two alternative provisions would be included in the next draft.

Article 12(2)

40. There was general agreement on this provision. One delegation stated that the substance of Rule 14 should be included in Article 12.

Rule 14(1)

41. A number of delegations stated that the date on which the person skilled in the art must be able to perform the claimed invention in the context of the prior art under item (ii) should be the claim date of the application under consideration, while some delegations expressed their support for the date on which the item of prior art was made available to the public.

Rule 14(2)

42. It was agreed that the issue concerning the timing of the determination of the disclosure in the item of prior art in subparagraph (a) should be further reviewed and that subparagraph (b) should be deleted. Concerning subparagraph (c), the cross reference issues, including the applicability to hyperlinks on the Internet, should be further explored.

Rule 14(3)

43. There was general agreement on this provision. The reference to the claim date and the priority date should be reviewed in conjunction with new Article 8(2).

Guidelines Under Rule 14

44. Further elaboration should be made in respect of Guideline 3.03 in the context of the claim date provisions and Guideline 3.02 concerning selection inventions and the words “clearly identified.”

Article 12(3)

45. There was general agreement on this provision.

Rule 15

46. There was broad agreement on the principles of this Rule, although a Representative of one intergovernmental organization expressed some doubts about the provision and the Guidelines under Rule 15.

Guidelines Under Rule 15

47. There was broad agreement on the principles of the Guidelines, although a range of drafting issues should be clarified.

Articles 13 and 14

48. One delegation, supported by a number of other delegations, requested the inclusion of an additional paragraph in both Articles 13 and 14. One delegation, supported by a few other delegations, suggested the inclusion of this additional paragraph in square brackets. Several delegations, however, did not support the proposal, and questioned its relevance for the SPLT. The Chair concluded that the matter should be further explored by the International Bureau.

Article 15

49. This provision was generally supported. It was clarified that the term “quasi-judicial” was needed to accommodate certain appeal bodies, which, in certain jurisdictions, were not considered to be judicial authorities.

Article 16

50. It was decided that the International Bureau would review this Article taking into account the comments made.

Article 17

51. The Chair stated that the issue concerning the interface between the SPLT, PLT and the PCT had been discussed at the sixth session of the SCP and drew delegates' attention to document SCP/6/5. It was concluded that issues relating to the final and administrative clauses should be discussed in that context.

Agenda Item 6: Future work

52. The SCP agreed that its eighth session would tentatively be held from November 18 to 22, 2002, in Geneva.

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