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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF PATENTS

Eighth Session
Geneva, November 25 to 29, 2002

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The eighth session of the Standing Committee on the Law of Patents (SCP) was opened, on behalf of the Director General, by Mr. Francis Gurry, Assistant Director General, who welcomed the participants. Mr. Philippe Baechtold (WIPO) acted as Secretary.

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

2. The Standing Committee unanimously elected, for one year, Mr. Dave Herald (Australia) as Chair and Mr. Yin Xintian (China) and Ms. Natalya Sukhanova (Belarus) as Vice-Chairs.

Agenda Item 3: Adoption of the Draft Agenda

3. The draft agenda (document SCP/8/1) was adopted with the deletion of the reference to document SCP/8/6.

Agenda Item 4: Accreditation of a Non-governmental Organization

4. The SCP approved the accreditation of the Genetic Resources Action International (GRAIN) as an *ad hoc* observer (document SCP/8/7).

Agenda Item 5: Adoption of the Draft Report of the Seventh Session

5. The draft report of the seventh session (document SCP/7/8 Prov.2) was adopted with one amendment proposed by the Delegation of Ireland.

Agenda Item 6: Draft Substantive Patent Law Treaty and Draft Regulations Under the Substantive Patent Law Treaty

6. The SCP discussed draft provisions on substantive patent law harmonization, based on the Draft Substantive Patent Law Treaty (SPLT) (document SCP/8/2), Draft Regulations under the Substantive Patent Law Treaty (document SCP/8/3), Practice Guidelines under the Substantive Patent Law Treaty (document SCP/8/4) and Proposals by the Delegations of the Dominican Republic and Brazil concerning Articles 2, 13 and 14 of the draft Substantive Patent Law Treaty (document SCP/8/5).

7. The SCP discussed the draft articles, together with the corresponding draft rules and draft practice guidelines. It gave a 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. Three delegations requested that the working documents, at least in English, be available two months before the meeting. A brief summary of the discussions follows:

Matters Relating to Article 1

Article 1(x)

8. On the term “claim date,” the discussion revealed divided opinions on whether the said term should be maintained or whether the terms “filing date” and “priority date” should be re-introduced. The SCP agreed that, if the term “claim date” were to be abandoned, although Article 4F of the Paris Convention covered the issue of multiple priorities, that Article did not address certain details, such as the situation where several alternatives were contained in one claim.

Article 1(xii) and Rule 2

9. A number of delegations expressed concerns about the order between Article 1(xii) and Rule 2, and whether both provisions should be merged into one provision. Some delegations questioned the meaning of the phrase “or matters clear from empirical rules” in Article 1(xii), and suggested its deletion. It was further felt that both provisions read together constituted a circular definition.

Matters Relating to Article 2

Article 2(1)

10. There was general support for this provision.

Article 2(2) and document SCP/8/5

11. It was agreed that the proposal by the Delegation of the Dominican Republic, made on behalf of the Delegations of Chile, Colombia, Cuba, Ecuador, Honduras, Nicaragua, Peru, Venezuela and its own country, on draft Article 2(2), and the proposal by the Delegation of Brazil on draft Articles 2(3), 13 and 14 would be included in the draft Treaty in square brackets, together with the following footnote: “The SCP agreed at its eighth session to include the paragraphs within square brackets, but to postpone substantive discussions on these provisions.”

Matters Relating to Article 3

Article 3(1)(iii)

12. Concerns were expressed by some delegations on the present duplication of definitions between Articles 1(v), 3(1)(iii) and 8(2).

Article 3(2) and Rule 3

13. A proposal was made to include, in Rule 3(ii), wording along the lines of “Except for Article 7bis, applications for re-issue.” There was some discussion about whether such a provision should not only cover applications for re-issue, but also re-issued patents, but the conclusion was to include only re-issue applications at this stage. One delegation further stated that it found difficulties of a constitutional nature with the fact that the exceptions were contained in Rule 3 rather than in the Article itself.

Article 4

Article 4(1)

14. The SCP agreed that this provision was intended primarily to deal with the prohibition of improper derivation or theft of the invention.

Article 4(2)

15. One delegation stated that this paragraph should cover research activities in a university and arrangements between an inventor and a firm concluded outside the scope of an employment arrangement.

Article 4(3)

16. There were some concerns about what was meant by the expression “an equal and undivided right.” The fundamental question as to whether paragraph (3) was appropriate to be included in the draft SPLT was raised, since that paragraph concerned the entitlement to the right by joint inventors.

Article 4(4)

17. No discussion was held on this provision, which was reserved for discussion at a future session.

Matters Relating to Article 5

Article 5(1)

18. The discussion focussed on the question of drawings under item (iv). In response to the question as to who would decide on the necessity of submitting drawings, a few delegations suggested that the current wording, which also appeared in the PCT, was satisfactory. A number of delegations expressed the view that the need for drawings should be entirely left to the applicant. Three delegations stated that there might be circumstances in which an Office should be able to require drawings. Given the divergent views, an alternative set of suggestions, including the possibility of clarifying the matter in the Explanatory Notes, would be developed by the International Bureau for further discussion.

Article 5(2)

19. There was general support for this provision. Issues relating to the link to other treaties should be dealt with in the final provisions.

Rule 4(1), Introductory Words, and Item (i)

20. A couple of interventions suggested that the presence or absence of the word “technical” went beyond the issue of patentable subject matter. On the other hand, it was recognized that the term “technical” was a fundamental issue for a number of delegations. It was agreed that the discussion concerning the term “technical” in Rules 4 and 5 should be postponed until the SCP reached a conclusion regarding patentable subject matter under draft Article 12(1).

Rule 4(1)(ii)

21. The Chair concluded from the discussion that the square brackets surrounding the word “preferably” should be removed and that this term should be retained.

Rule 4(1)(iii)

22. The SCP agreed that the provision did not allow the refusal of an application based on non-compliance with the problem-solution approach, but that it should provide adequate incentives for applicants to use the problem-solution approach in order to describe the claimed invention.

Rule 4(1)(iv) and (v)

23. There was general support for these provisions.

Rule 4(1)(vi)

24. One delegation, supported by the representative of one intergovernmental organization, advocated that the requirement of the “best mode,” which was considered to be a substantive disclosure requirement, be included in the draft SPLT since it would result in a better quality of the disclosure. The majority of delegations, however, was of the opinion that this requirement should not be imposed on applicants.

Rule 4(1)(vii) and (2)

25. There was general support for these provisions.

Rule 5(1)

26. There was general support for this provision.

Rule 5(2)

27. Several delegations requested clarification on the difference between the terms “features” and “limitations.” After some discussion, a majority of delegations agreed that the term “features” should be retained throughout the provisions. The International Bureau was further mandated to examine whether the first part of this provision could be inserted in Article 11(1), and whether, in this case, the second part of Rule 5(2) could be deleted.

Rule 5(3) and (4)

28. There was general support for these provisions.

Rule 5(5)

29. No discussion was held on this provision, the substance of which was discussed by the Working Group on Multiple Invention Disclosures and Complex Applications (“Working Group”), a summary of the discussions of which was presented by the Chair to the SCP.

Article 5(3)

30. A majority of delegations supported the text as contained in document SCP/8/2, while certain delegations advocated that the abstract should form part of the disclosure.

Article 6 and Rule 6

31. No discussion was held on these provisions, the substance of which was referred to the Working Group.

Matters Relating to Article 7

Article 7(1)

32. One delegation requested that a clear distinction be made between amendments of a substantive character and corrections. Another delegation pointed out that there was a contradiction between the expression “errors and defects” in subparagraph (b) and the term

“requirement” in subparagraph (a). One delegation opposed the inclusion of subparagraph (b).

Rule 7

33. It was agreed that the minimum time limit of both three months and two months would be presented as alternatives within square brackets for the next session.

Article 7(2)

34. The discussion focussed on the question whether subparagraph (b) was required at all. The SCP agreed that the International Bureau should explore the possibility of drafting a general provision relating to time limits which would be applicable throughout the draft SPLT.

Article 7(3)

35. As regards the amendment of an application by adding prior art references, it was agreed that those references should not form a basis for broadening the scope of the disclosure, for example, an amendment would not be permissible if the prior art reference constituted a basis for the enabling disclosure. There was general consensus that the use of the term “obvious error” as in PCT Rule 91 should be considered. With reference to the abstract, concerns about the appropriateness of amending the abstract under paragraphs (2)(a) and (3)(a) were raised. A majority of delegations stated that the abstract should not form a basis for amendments, while a number of delegations expressed a contrary view. As regards subparagraph (b), it should be clarified that the mistake should be clear from the face of the document to which the public had access. Finally, the reference to the PLT should be reviewed so as to include an express reference to the filing date accorded in accordance with the PLT.

Article 7bis

36. Many delegations expressed concerns in respect of this provision and reserved their position, while a few other delegations expressed support in principle. Certain of the concerns raised were of a general nature, such as whether the provision fitted into the context and the objectives of the draft SPLT, how the provision in fact would operate, which changes would be allowed and at which point in time they could be requested, or whether courts would be bound by this provision. More specific concerns related to paragraph (1)(b) and also to paragraph (3), in connection with “re-issue” practice. The Chair concluded that another attempt at drafting the provision should be undertaken by the International Bureau for discussion at the next meeting, during which the maintaining or deletion of the provision could be decided.

Matters Relating to Article 8

Article 8(1)

37. Two delegations sought the inclusion of the concept of secret prior commercial use. It was recalled that this issue had been discussed at length at previous meetings and that a large majority of delegations had refused the inclusion of that concept into the draft SPLT. The

Chair concluded that the provision would remain unchanged for the next draft, but that the concerns raised would be included in the records.

Rule 8(1)

38. There was general support for this provision.

Rule 8(2)

39. Several delegations raised concerns about the meaning of the words “reasonable possibility” in subparagraph (a). A suggestion by one delegation that paragraph 73 of the Guidelines be moved into the Regulations did not receive general support. As regards subparagraph (b), a majority of delegations spoke in favor of the text within the square brackets with the words “of confidentiality” added after the words “an obligation.” There was broad agreement on the underlining principles of this provision.

Rule 8(3)

40. There was general support for this provision.

Article 8(2)(a)

41. The essence of the discussions concentrated on whether this provision should be applicable in relation to the determination of novelty only or whether it should also apply to the determination of inventive step. Views continued to be divided. The question was raised whether that division was in fact tied up with the criteria for assessing novelty.

Article 8(2)(b)

42. Concerning the alternative texts within square brackets, a large number of delegations expressed the view that the prior art effect of PCT applications as earlier applications should only apply as from the national phase entry because of the possibility that PCT applications could be filed in a foreign language and because there was no necessity to consider “double patenting” if an earlier application did not enter the national phase. Two delegations spoke in favor of according prior art effect as from the time of designation with a view to achieving harmonization of prior art effect around the world.

Rule 9(3)

43. The discussion focussed mainly on the expression “with no rights outstanding.” Two delegations queried how this concept would work in the case of restoration. One of these delegations referred to its law, where that concept would only apply in the case of withdrawal of the application. Another delegation stated that, during 12 months from the filing date of the first application, there would always be a priority right outstanding. The SCP agreed that these comments should be taken into consideration in preparing a revised draft.

Rule 9(4)

44. One delegation raised a concern about the alternative phrases within square brackets. One delegation explained its practice regarding non-distinct patents, and suggested that the International Bureau redraft the second alternative phrase.

Article 9

45. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, requested that the discussion on this provision be postponed on the grounds that a common position of the European Community had not been finalized yet. The Delegation hoped that such a common position would be ready for the next session of the SCP. While one delegation expressed the view that paragraphs (3) and (5) should be deleted, since they did not relate to substantive patent law, the SCP agreed to postpone discussion of Article 9 to its next session.

Matters Relating to Article 10

Article 10(1)

46. There was general support for this provision.

Article 10(2)

47. Some delegations proposed to include wording which would ensure that the amendments and corrections would not extend the disclosure as compared to the filing date. One delegation, supported by another, proposed that the words “as amended and corrected under the applicable law” be deleted and replaced by a reference to the disclosure on the filing date, which would be sufficient to include the filing date requirements of the PLT. This proposal was considered problematic by one delegation, since, in certain cases, for example during invalidation proceedings, the disclosure was assessed on the basis of the application as amended. In particular, concerns were raised as to the situation where subject matter was deleted from the application during examination, but could still be referred to for the purposes of sufficiency of disclosure.

Rule 10

48. There was general support for this provision.

Rule 11(1)

49. While this provision found agreement in principle, there was some discussion on the question of whether the last sentence referring to the deposit being part of the description was appropriate. Some delegations stated that the deposit was always part of the description, and that the sentence should be deleted, while others opposed that view. The SCP concluded that the sentence in question would require some review, in order to decide either on its amendment or its deletion.

Rule 11(2)(a)

50. There was general agreement on this provision. The term “filing date” and the issue of claiming the priority of an earlier application containing deposited biologically reproducible material should be clarified in the Explanatory Notes.

Rule 11(2)(b)

51. A large majority agreed that the deposit should be required to be made no later than the filing date, as stated in subparagraph (a), mainly on the ground that, if the description contained a sufficient disclosure, the deposit would always, in effect, add new matter. A few delegations and some user groups spoke in favor of allowing a deposit after the filing date in certain circumstances. Among these delegations, some spoke in favor of alternative B, while a few favored alternative A. The SCP concluded that the next draft should contain two alternative texts taking into account the discussions held on the subject.

Rule 11(3)

52. There was general support for this provision.

Matters Relating to Article 11

Article 11(1)

53. In relation to the suggestion that a part of the Practice Guidelines be moved to the Regulations, the concern was raised as to whether the exact meaning of this provision and the relevant part of the Practice Guidelines were consistent. Two different approaches to the term “claim,” namely, the definition of the subject matter for which the applicant sought patent protection on the one hand and the determination of the scope of patent protection on the other, were discussed.

Article 11(2)

54. One delegation suggested that the terms “clear” and “concise” be clarified. To this end, although a reservation was made by one delegation, there was no opposition to moving the relevant part of the Practice Guidelines to the Regulations.

Article 11(3)

55. The main debate in relation to this paragraph focused on the question as to whether the claimed invention, or the claim, should be required to be supported by the disclosure in general (i.e., including the claims) or by the description and drawings. The text should be reviewed in view of the fundamental objective of this provision.

Rule 12

56. One delegation requested the International Bureau to review paragraph 113 of the Practice Guidelines concerning the consistency of the references to the claim and the claimed invention.

Article 11(4)(a)

57. It was agreed that the words “Where the wording of the claim is not immediately [clear][evident]” should be deleted. In response to the proposal by one delegation that the provision be replaced with the text contained in Article 21(1)(a) of the 1991 Basic Proposal and that the details be moved to the Regulations, one delegation noted that the words “the extent of protection” contained in the 1991 Basic Proposal should be carefully reviewed in the context of the draft SPLT.

Article 11(4)(b)

58. Although one delegation opposed the inclusion of this provision in the SPLT, a majority of delegations expressed support for its inclusion with a view to ensuring a common drafting standard.

Rule 13(1)

59. There was general support for this provision.

Rule 13(2)

60. There was general support for this provision. One delegation queried the meaning of the term “embodiment.” Several delegations suggested correcting the Spanish translation of that term.

Rule 13(3)

61. There was general support for this provision.

Rule 13(4)

62. One delegation expressed the view that, if the provision was to be binding on the courts, it was too detailed. A number of delegations requested clarification as to the different types of claims, as well as the inclusion of certain amendments to the text of the Rule.

Rule 13(5)

63. In general, there was a clear preference for alternative B over alternative A, although some delegations reserved their positions. Concerning alternative B, several delegations expressed concern about item (ii) in relation to file wrapper estoppel and the proposed timing for the determination of equivalents, i.e., the time of infringement.

Matters Relating to Article 12

Article 12(1), (5) and Rule 16

64. It was agreed that the discussion on these provisions be postponed. In the meantime, the texts of the provisions, as well as the footnotes, would be retained.

Article 12(2)

65. While there was support in general for this provision, one delegation stated that the first sentence was not clear in respect of the case where one claim contained several alternatives. In addition, that delegation opposed the conclusion of the last sentence of paragraph 134 of document SCP/8/4, according to which all alternatives would be anticipated. One other delegation pointed out that, at least in the case of Markush-type claims, if one of the alternatives was anticipated, the whole claim should be rejected.

Rule 14(1)

66. There was general support for this provision. Some drafting issues were raised, such as the expression “primary item of prior art” and a proposal to replace the words “make and use” with the words “carry out.” One delegation expressed concern about item (ii).

Rule 14(2)

67. There was some discussion on whether the relevant date for the determination of the scope of the item of prior art should be the claim date or the date on which the item of prior art was made available to the public. The SCP agreed that the text which would be submitted to the next session should contain two alternatives reflecting these different approaches.

Rule 14(3)

68. There was general support for this provision.

Article 12(3)

69. There was general support for this provision.

Rule 15(1)

70. There was general support for this provision.

Rule 15(2)

71. It was agreed that the word “implicitly” should be replaced with the word “inherently.” It was also agreed that the Spanish text should be reviewed.

Rule 15(3)

72. There was general support for this provision.

Rule 15(4)

73. One delegation made a drafting proposal for amending this provision, without using the term “motivated.” Following the intervention of another delegation to the effect that the concept of motivation was an important one, and that the mentioned proposal needed further reflection, the SCP agreed that the proposed text be added as an alternative to the existing text. In addition, a proposal was made to add, in what is presently paragraph 142 of the Practice Guidelines, wording which would allow Offices to apply the so-called

“problem-solution approach.” After some discussion, the SCP agreed to include such wording in square brackets in paragraph 142 of the Practice Guidelines.

Article 12(4)

74. Three delegations supported alternative A, while a majority of delegations expressed their preference for alternative B. A suggestion by one delegation that alternative C be retained as a possible methodology for the implementation of alternative A or B was welcomed by some delegations. Several proposals were made to modify alternatives A and B. It was suggested that the International Bureau prepare a study regarding commonalities and differences between the “industrial applicability” and the “utility” standards.

Articles 13 and 14

75. Discussion of these provisions was postponed.

Articles 15 and 16

76. There was general support for these provisions.

Agenda Item 7: Future work

77. The International Bureau informed the SCP that its ninth session was tentatively scheduled to be held from May 12 to 16, 2003, in Geneva.

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