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STANDING COMMITTEE ON THE LAW OF PATENTS

Eighth Session
Geneva, November 25 to 29, 2002

REPORT

adopted by the Standing Committee

INTRODUCTION

1. The Standing Committee on the Law of Patents (“the Committee” or “the SCP”) held its eighth session in Geneva from November 25 to 29, 2002.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Albania, Algeria, Antigua and Barbuda, Argentina, Australia, Austria, Bangladesh, Belarus, Belgium, Brazil, Bulgaria, Canada, Central African Republic, China, Costa Rica, Côte d’Ivoire, Croatia, Czech Republic, Democratic People’s Republic of Korea, Denmark, Dominican Republic, Egypt, Eritrea, Estonia, Finland, France, Gambia, Germany, Greece, Guatemala, Hungary, India, Indonesia, Iraq, Ireland, Japan, Jordan, Kazakhstan, Kenya, Latvia, Lithuania, Malta, Mauritius, Mexico, Morocco, Netherlands, Nicaragua, Nigeria, Norway, Oman, Pakistan, Panama, Peru, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Tajikistan, Thailand, Tunisia, Turkey, United Kingdom, United Republic of Tanzania, United States of America, Uruguay and Yugoslavia (76).
3. Representatives of the African Intellectual Property Organization (OAPI), the Eurasian Patent Office (EAPO), the European Commission (EC) and the European Patent Office (EPO) took part in the meeting in an observer capacity (4).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Bar Association (ABA), American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Biotechnology Industry Organization (BIO), Centre for International Industrial Property Studies (CEIPI), Chartered Institute of Patent Agents (CIPA), Committee of National Institutes of Patent Agents (CNIPA), Federal Chamber of Patent Attorneys (FCPA), Genetic Resources Action International (GRAIN), German Association for Industrial Property and Copyright Law (GRUR), Institute of Professional Representatives before the European Patent Office (EPI), Intellectual Property Brazilian Association (ABPI), Intellectual Property Institute of Canada (IPIC), Intellectual Property Owners Association (IPO), International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Max-Planck-Institute for Intellectual Property, Competition and Tax Law (MPI), Médecins sans frontières (MSF), Pacific Intellectual Property Association (PIPA), Union of European Practitioners in Industrial Property (UEPIP), South Centre (SC) and the Trade Marks, Patents and Designs Federation (TMPDF) (24).

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

6. Discussions were based on the following documents prepared by the International Bureau: “Draft Agenda” (SCP/8/1), “Accreditation of a Non-governmental Organization (SCP/8/7), “Draft Substantive Patent Law Treaty” (SCP/8/2), “Draft Regulations under the Substantive Patent Law Treaty” (SCP/8/3), “Practice Guidelines under the Substantive Patent Law Treaty” (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” (SCP/8/5).

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, 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

9. 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

10. The International Bureau informed the Committee that document SCP/8/6, as indicated in the draft agenda, was cancelled and that the relevant reference should therefore be deleted from the draft agenda.

11. The Delegation of Algeria, supported by the Delegations of Brazil and Uruguay, pointed out that the dates of the meeting coincided with a meeting of the Council for the Trade-Related Aspects of Intellectual Property Rights (TRIPS) at the World Trade Organization, and that, for some delegations, it was impossible to attend both meetings. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, proposed the postponement of the discussion on document SCP/8/5 on the grounds of a need for EC internal coordination. Following a suggestion by the Chair, the Committee agreed to postpone the discussion of document SCP/8/5 and the provisions related thereto until the morning of Friday, November 29, 2002.

12. The draft agenda (document SCP/8/1) was adopted, with the change proposed by the International Bureau.

Agenda Item 4: Accreditation of a Non-Governmental Organization

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

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

14. The International Bureau indicated that document SCP/7/8 Prov.2 took into account the comments received earlier from members of the Committee on document SCP/7/8 Prov.

15. The Delegation of France, supported by the Delegation of Belgium and the Representative of the EPO, noted that it had taken two months for the French version of the draft report of the last session to be made available and that this time limit should be reduced to one month. The Delegation also pointed out that document SCP/8/4 was not yet available in French. The Delegation further requested that the English version of documents be made available two months before the session at which they were to be considered. The Secretariat responded that it would make its best endeavors to make documents available in English two months in advance, as well as to improve the situation in respect of translations.

16. Regarding the last line of paragraph 163 of document SCP/7/8 Prov.2, the Delegation of Ireland stated that the words “of the European Commission” should be deleted and the words “European Parliament and Council” should be included before the word “Directive.”

17. The Committee adopted the draft report of its seventh session, subject to the change referred to in paragraph 16, above, the final report being contained in document SCP/7/8.

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

18. The Chair noted that the Practice Guidelines and Notes had been amalgamated into one document and that the Committee would have to decide, at some stage, which parts should be moved to the Rules and which parts should remain in the Practice Guidelines.

Draft Article 1: Abbreviated Expressions

Item (v)

19. The International Bureau noted that the definition in this item omitted any reference to the date of the earlier application and suggested that this might be remedied by adding relevant text from draft Article 8(2). Alternatively, item (v) could be deleted and its substance incorporated into draft Article 8.

20. The Chair explained that, under the first alternative presented in square brackets, the prior art effect of an earlier PCT application would apply in all designated States. Under the second alternative, it would only apply if and when national processing started in the designated Office.

21. The Delegations of Brazil, Germany, the Russian Federation and Sweden and the Representatives of the EPO, FICPI and JIPA expressed support for the second alternative. The Delegation of the Republic of Korea also supported the second alternative since, if the PCT application did not enter the national phase before a designated Office, that Office and third parties would not have access to a translation of the earlier application in a language accepted by that Office.

22. The Delegation of the United States of America and the Representative of EPI supported the first alternative in the interest of maximum harmonization. The same Delegation stated that, if the second alternative were to be retained, recognizing actual entry into national systems in determining prior art effects, there should also be an accommodation for the so-called *Hilmer* doctrine, which based prior art effect for a published patent application on the actual date of filing in a particular country.

23. The Chair summarized the discussions on Article 1(v) as follows: Concerning the alternative texts within square brackets in Article 1(v), 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.

Items (x) and (xi)

24. The Delegation of the United States of America supported the retention of the concept of “claim date.” Regarding the expressions “filing date of the application” and “filing date of the earliest application whose priority is claimed,” it expressed the wish for accommodation

of provisional applications, since these applications were excluded from the scope of the draft Substantive Patent Law Treaty (SPLT) in draft Rule 3. The Delegation, supported by the Delegation of China, further reserved its position on the possibility of there being multiple claim dates for alternatives covered by one claim, since that would put additional burden on Offices, especially in respect of mega-applications, and on third parties when assessing the scope of the patent.

25. The Representative of the EPO, supported by the Delegations of Germany, Romania, Spain and Sweden and by the Representative of OAPI, expressed the view that the term “claim date” did not improve the quality of the text and would not require any change of its practice, and therefore proposed the deletion of both items (x) and (xi). In response to the International Bureau, which noted that the deletion of items (x) and (xi) would result in Article 4F of the Paris Convention governing this issue, the Representative of the EPO did not oppose the concept expressed in the bracketed language, but stated that the problem lay in the use of the term “claim date” as such.

26. The Delegation of Colombia expressed some difficulties with the term “alternatives.”

27. The Delegation of Canada, supported by the Delegations of Australia, the Russian Federation and the United States of America, was of the opinion that, since the objective of the draft SPLT was to achieve harmonization, the language should be clear. The Delegation felt that, while use of the term “claim date” as such was not so important, some details were relevant and these should be reflected in the text of the draft Treaty. The Delegation thus did not support deletion of items (x) and (xi) entirely, but was prepared to consider alternative wording. It observed that novelty and inventive step were assessed on a claim-by-claim basis and, if a claim contained several alternatives, each alternative would be considered separately as to the relevant date for assessing prior art. The Delegation, supported by the Delegation of the Russian Federation and the Representative of EPI, was in favor of maintaining the concept of multiple claim dates for alternatives covered by one claim. The Delegations of Canada, Colombia and the Russian Federation, and the Representative of EPI, expressed preference for the second bracketed text.

28. The Delegation of Australia, supported by the Delegation of Canada, proposed that, for reasons of consistency with draft Article 10, the word “contains” be replaced by the word “discloses” in item (x).

29. The Chair summarized the debate by stating that the discussion on the term “claim date” had 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.

Item (xii) and Draft Rule 2

30. The Delegation of Japan, supported by the Delegations of the Republic of Korea and the United States of America, noted a discrepancy between the definition of the “general knowledge of a person skilled in the art” in draft Article 1(xii) and the concept of “general knowledge” in draft Rule 2 and suggested that the order of these provisions should be reviewed.

31. The Delegation of the United States of America, supported by the Representative of the EPO, suggested deletion of the phrase “or matters clear from empirical rules.”

32. The Delegation of Germany, supported by the Delegation of the Russian Federation and the Representative of the EPO, pointed out that item (xii) and draft Rule 2 contained a circular definition in respect of the term “general knowledge.”

33. The Representative of CEIPI proposed to include the two definitions in the same provision, for example, in draft Rule 2, and further pointed out that the title of draft Rule 2 referred to Article 1(xi) instead of referring to Article 1(xii).

34. The Delegation of Mexico expressed a preference for including the definitions in the Treaty, whereas the Representative of the EPO preferred them to be in the Rules or the Practice Guidelines, rather than the Treaty itself.

Draft Rule 1: Abbreviated Expressions

35. This provision was not discussed.

Draft Article 2: General Principles and Exceptions

Paragraph (1)

36. There was general support for this provision.

Paragraph (2) and document SCP/8/5

37. The Chair noted that this provision should be considered together with the contents of document SCP/8/5 prepared by the International Bureau.

38. The International Bureau explained that the document related to two proposals, presented at the seventh session of the Committee, for the inclusion of certain public interest exceptions in Article 2. The first, contained in Annex I, was made by the Delegation of the Dominican Republic, on behalf of itself and the Delegations of Chile, Colombia, Cuba, Ecuador, Honduras, Nicaragua, Peru and Venezuela. The second, contained in Annex II, was a proposal by the Delegation of Brazil for the inclusion of additional grounds for refusal of an application and revocation of a granted patent in Articles 13 and 14 for failure to comply with the applicable law on public health and other matters. The document attempted to contextualize these proposals in two ways: first, with reference to developments that were taking place in the framework of, in particular, the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), the TRIPS Agreement and Convention on Biodiversity (CBD); and second, to relate those proposals to the objectives set out by the competent organs of WIPO for the work of the SCP in respect of patent law harmonization.

39. The Delegations of Brazil and the Dominican Republic expressed the view that their proposals should have been included in the draft SPLT in document SCP/8/2 rather than in a separate document. They also queried whether the International Bureau had a mandate to include, in document SCP/8/5, its analysis as to whether the SCP was the appropriate forum

in which to discuss those proposals. In addition, as regards document SCP/8/5, the Delegation of the Dominican Republic, supported by the Delegation of Peru, commented that the title of that document should have listed all the delegations on behalf of which it had made its proposal, and that paragraph 1 should have listed both those delegations that had, and those delegations that had not, supported the proposals at the seventh session of the Committee.

40. The International Bureau explained that, as stated in paragraph 203 of the report of the seventh session of the Committee (document SCP/7/8), the International Bureau had been given a mandate to reflect further on the issues. Document SCP/8/5 set out the results of those reflections with a view to sharing them with the Committee. In addition, as stated in paragraph 211 of that Report, the Committee had invited the International Bureau to prepare revised proposals for consideration at its eighth session, taking into account the discussions at the seventh session. The accepted practice of the Committee was that, where delegations made proposals for amendment of the draft Treaty or Regulations, the International Bureau sought to revise those proposals in such a way as to achieve compatibility with the other provisions. However, as the proposals made by the Delegations of Brazil and the Dominican Republic concerned such important matters, the International Bureau did not consider it appropriate to revise them at this stage but, instead, had included them *verbatim* in a separate document for further consideration by the Committee.

41. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, emphasized their commitment to the discussions in the IGC, the TRIPS Council and the CBD, and stated that they were working towards a successful outcome of those discussions on the issues contained in the proposals. They were of the view that, at this stage, the SCP was not the right forum to deal with subject matter such as the protection of genetic resources, biodiversity and tradition knowledge. It urged all delegations to make efforts in the IGC to achieve concrete and positive results, and suggested that reports on the progress made in those other fora be submitted regularly to the SCP. The Representative of the European Commission reported that it had already made proposals in respect of genetic resources to the TRIPS Council.

42. The Delegations of Bulgaria, the Czech Republic, Japan, the Russian Federation, Switzerland and the United States of America stated that they supported the statement made by the Delegation of Denmark. In their view, the IGC had been established to consider the issues in question, that those issues were outside the scope of the SPLT, which was directed to the harmonization of issues relating to the grant of patents, and that the SCP should avoid duplicating work done in other fora. The Delegations of Australia, Canada and Romania expressed similar views. The Delegation of the United States of America further emphasized that patent law was not the appropriate forum to deal with “misconduct” issues such as improper collection of genetic resources and advocated further discussion and development of access and benefit-sharing regimes that lay entirely outside of the patent system, such as an access and benefit-sharing regime for genetic resources already implemented in the United States of America.

43. The Delegation of Norway stated that it recognized the interface between patent law and the CBD and had some sympathy for the concerns expressed by the Delegation of the Dominican Republic and other developing countries. However, it seemed more expedient to evaluate the social and economic consequences of patents in areas of public policy at the stage of the exercise of patent rights, rather than at the stage of the grant of the patent. Accordingly, the question of whether or not the SPLT should contain a provision that permitted a State to

require an applicant to disclose the geographical origin of genetic resources, and the sanctions for non-compliance, should be scrutinized in the light of future discussions in other international fora, such as the IGC, the TRIPS Council and the CBD.

44. The Delegation of China, supported by the Delegation of Indonesia, welcomed the proposals made by the Delegations of Brazil and the Dominican Republic. In particular, the Delegation stated that public health, especially as regards serious diseases such as AIDS, was a very important issue which should be considered in both the TRIPS Council and under the draft SPLT.

45. The Delegation of the Dominican Republic contended that the SCP was a relevant forum for discussion of access to genetic resources and traditional knowledge. It asserted that, as set out in the proposals, a State should have the power to refuse and invalidate patents for activities based on subject-matter that had been obtained illicitly, for example, as a result of illicit access to genetic resources. It noted that draft Article 2 already provided for exceptions for patentability in respect of the preservation of security interests which were not directly linked to patents as such. The Delegation also emphasized the need for consistency in the different fora that had been mentioned, including those within WIPO, in considering the protection of genetic resources, tradition knowledge and folklore. It was also necessary to appreciate that the IGC was not specifically considering the precise issues contained in the two proposals before the SCP.

46. The Delegation of Brazil stated that document SCP/8/5 did not reflect a true understanding of its proposal or the proposal by the Delegation of the Dominican Republic, which it also supported. What had been proposed with respect to Article 2 was merely that a further exception be made for subject matter pertaining to the protection of public health and genetic resources. This issue could not be discussed in the IGC in isolation from the discussions on the grant of patents in the SCP. Also, it was not possible to fully harmonize patent law in respect of the grant of patents without taking account of this matter.

47. The Delegation of Peru confirmed its support for the proposals by the Delegations of Brazil and the Dominican Republic. It also did not agree with the analysis of the International Bureau as contained in document SCP/8/5, particularly in paragraphs 19 and 20. Although the Delegation did not overlook the importance of the IGC, it did not accept that genetic resources, traditional knowledge and folklore were subjects which should be exclusively dealt with in that particular forum. The Delegation further observed that the proposals were not directed to the best way of protecting traditional knowledge, nor the best way of controlling access to genetic resources, which the Delegation accepted were matters for the IGC. Instead, they sought to provide the right to refuse or invalidate the grant of a patent on inventions developed on the basis of genetic resources or traditional knowledge where the applicant did not comply with legislation concerning access to those genetic resources or traditional knowledge. Examples of such legislation were that, under Decision 486 of the Andean Community and the requirement under its own national law, the applicant should furnish a copy of a contract permitting access to genetic resources or traditional knowledge which had been used in developing an invention.

48. The Delegations of Argentina, Colombia, Costa Rica, Egypt, India, Indonesia, Nicaragua, Panama, South Africa and Uruguay, and the Representative of OAPI, also supported the inclusion of the proposals in the text of the draft Treaty for similar reasons to those stated by the Delegations of Brazil, China, the Dominican Republic and Peru. The

Delegation of Mexico stated that it believed that any State had the right to bring the issues that it deemed relevant to the table. Therefore, it supported the inclusion of the proposals, irrespective of the position it might have on their substance.

49. The Chair suggested that, since the number of delegations which supported the inclusion of those proposals in the draft SPLT and the number of delegations which opposed such inclusion were approximately equal, the text of the proposals by the Delegations of Brazil and the Dominican Republic should be included in the text of the draft Treaty in square brackets, as in the case of certain other provisions in respect of which there was currently no consensus. In addition, the text of those proposals should be accompanied by a footnote, similar to the existing footnotes to Articles 13 and 14, stating that further substantive discussions on those proposals would be postponed until further developments towards clarification of the issues in relation to the SPLT had been achieved. After some discussion, the Chair further noted that, as the Delegation of the Dominican Republic and certain other delegations were not in favor of deferring discussions on the substance of the proposals while the Delegation of the United States of America and certain other delegations were against including the proposals in the draft Treaty, it was agreed, in the spirit of compromise and following a proposal by the Delegation of Norway, to delete those parts of the footnote which referred to developments in other fora, that the proposals should be included in the text of the draft Treaty in square brackets, accompanied by the following footnote: “The SCP agreed at its eighth session to include the paragraphs in square brackets, but to postpone substantive discussions on these provisions.”

Draft Article 3: Applications and Patents to Which the Treaty Applies

Paragraph (1)

50. The Delegation of Germany questioned the need for repetition of definitions in draft Articles 1(v), 3(1)(iii) and 8(2) and proposed that the present text be simplified.

51. The Representative of CEIPI pointed out that, if the first alternative in square brackets, which had his preference, was retained in draft Article 1(v), it would be in contradiction with draft Article 3(1)(iii), in which case a phrase like “subject to Article 1(v)” should be included in draft Article 3(1)(iii).

52. Summarizing the discussion on draft Article 3(1), the Chair noted that concerns were expressed by some delegations on the present duplication of definitions between draft Articles 1(v), 3(1)(iii) and 8(2).

Paragraph (2) and Draft Rule 3

53. The Delegation of Canada proposed excluding applications for re-issue from the scope of the draft SPLT by adding the following words in draft Rule 3: “Except for Article 7*bis*, applications for re-issue.” The Delegation further expressed the view that there was no need to cover re-issued patents.

54. The Delegation of the United States of America stated that provisional applications should be excluded from the scope of the draft SPLT in general in draft Rule 3, but should be considered in the context of draft Article 8(2). The Delegation supported the exclusion of re-issues and re-examination issues, subject to further consideration of draft Article 7*bis*.

55. On a question raised by the Delegation of the Republic of Korea as to whether a provisional application could be converted into a normal application under the SPLT, the Chair responded that this was a matter which was left to national law, but that, after conversion, such an application would be subject to the SPLT.

56. The Delegation of Germany expressed concerns of a constitutional nature about the fact that the contents of draft Rule 3 were not included in the draft Article itself. Also, the Delegation pointed out that, under German law, if the independent patent lapsed, the patent of addition may become an independent patent.

57. The Delegation of Ireland stated that, under the former Irish law, it was not possible to convert a patent of addition into an independent patent, and that the patent of addition lapsed when the independent patent lapsed.

58. The Delegation of China suggested discussing draft Rule 3 together with draft Article *7bis*, in so far as patents of addition were concerned.

59. The Chair summarized the discussion as follows: A proposal was made to include, in draft 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 cover not only applications for re-issue but also re-issue patents; the conclusion was to cover only re-issue applications at this stage. One delegation further stated that it found difficulties of a constitutional nature arising from the fact that the exceptions were contained in draft Rule 3 rather than in the draft Article itself.

Draft Article 4: Right to a Patent

Paragraphs (1) and (2)

60. In response to the question by the Delegation of the United States of America whether paragraph (1) dealt with improper derivation or theft of an invention, the Chair confirmed that this was the aim of the provision.

61. The Delegation of the Russian Federation reaffirmed its opinion, expressed at the previous session, regarding the lack of the need for harmonization in relation to the right to a patent and that the conclusion of an agreement was desirable regarding the mutual recognition by Contracting Parties to the SPLT of the right to a patent for a person to whom this right belonged in accordance with the legislation of the country of origin of an invention. The Delegation also spoke in favor of a clearer explanation of the issue regarding the right to a patent for an invention made under a contract other than an employment contract. Supporting the latter issue, the Delegation of the United Kingdom also asked whether such a situation would be covered by draft Article 4(2). The International Bureau responded that the purpose of paragraph (1) was to create some limitations under national laws, while paragraph (2) respected the different existing systems.

62. The Delegation of the United Kingdom requested clarification regarding the inventor’s general freedom to contract the rights to his future inventions. To take this aspect into account, the Delegation suggested the following text:

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

(i) to the inventor; or

(ii) to any person who is entitled to the claimed invention or inventions as the result of an agreement with the inventor before the invention was made; or

(iii) to the successor in title of (i) or (ii).

“(2) [unchanged]

“(3) [*Joint Entitlement to a Patent*] Where a patent is owned jointly by more than one person, each person shall have an equal and undivided right to the patent, except where otherwise agreed by each of them among themselves.”

63. Regarding the proposal of the United Kingdom, the Representative of GRUR, supported by the Representative of the EPO, pointed out that a distinction had to be made between the right to a patent and the ownership of a patent, and that draft Article 4 dealt only with the first of these issues. The International Bureau recalled that the SPLT dealt with the right to a patent (that is, as it existed before a patent had been granted).

64. With regard to draft Article 4(2), the Delegation of the Netherlands pointed out that the Dutch Patent Law contained a similar provision for researchers in universities and suggested that the Notes clarify that the term “employee” could be interpreted in a broad way.

65. The Representative of the EPO stated that draft Article 4(2) was necessary, but that, in the Notes, it could be explained that contractual freedom would not be affected by this provision, since entitlement issues were not a matter to be dealt with by Patent Offices, but should be left to systems of civil law.

Paragraph (3)

66. The Delegation of Canada queried the meaning of the terms “equal and undivided right” and requested the inclusion of clear guidance in the provision or in the Practice Guidelines, while the Delegation of Colombia suggested the deletion of the term “undivided” or its replacement by another term.

67. The Delegation of the United States of America explained that, under the law of its country, if there was no specific agreement among the inventors, each one of the inventors could licence the invention individually, however, the other co-inventors might take action against that inventor. The Delegation of Canada expressed the opinion that each joint inventor should be entitled to sell his part without the permission of the other inventors. The Chair stated that, under Australian law, no sale was possible without the prior approval of the other inventors.

68. The Chair summarized the discussion by noting that the term “equal and undivided right” should be clarified and that the question had been raised whether paragraph (3) was appropriate, since it dealt with ownership of granted patents.

Draft Article 5: Application

Paragraph (1)(iv)

69. In response to the Delegation of Germany, which suggested replacing the words “where they are necessary” by “as may be the case,” the International Bureau explained that the present wording was used in the Patent Cooperation Treaty (PCT).

70. The Delegations of China, Ireland and Morocco stated that the question of whether or not drawings were necessary should be left to the applicant.

71. The Representative of the EPO supported this view, on the grounds that it was up to the applicant to ensure that his description was enabling. If the applicant was required to file additional drawings, the problem of adding new matter might arise. The Representative, therefore, suggested inclusion of the words “shall contain drawings if they have been referred to by the applicant in the description or the claims.” This suggestion was supported by the Delegation of the Russian Federation.

72. The Delegation of Germany noted, however, that draft Article 10 dealt with the enablement requirement. The Delegation of Costa Rica expressed the view that the submission of drawings should not be left to the discretion of the applicant.

73. The Delegation of Canada noted that draft Article 5(2) included by reference PCT Articles 3 and 7 containing provisions on drawings and that it might not be necessary to maintain item (iv).

74. The Delegations of China, Colombia, Mexico, Morocco, Romania and the Representatives of the EAPO and OAPI supported maintaining item (iv).

75. The Delegation of Mexico, supported by the Delegation of the United States of America, suggested that the words “where necessary” be further clarified in the Notes.

76. The Delegation of the United States of America, supported by the Delegations of Canada and Romania, noted that there might be situations where the Office would need to require drawings, while the Delegations of Brazil, Canada and the United States of America reserved their position on the provision.

77. The International Bureau explained that it had been the intention that drawings could be filed at the option of the applicant, rather than enabling Offices to require drawings if the applicant had not filed any.

78. The Chair summarized the debate as follows: 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.

Paragraph (2)

79. The Delegation of Germany requested deletion of the words “and the Regulations” in subparagraph (a), since the core concept should be contained in the Treaty itself rather than in the Regulations.

80. The Representative of TMPDF suggested deletion of subparagraph (b) for the benefit of harmonization, while the Delegation of Uruguay expressed concerns about the application of paragraph (2) to countries not being a party to the Patent Law Treaty (PLT) and the PCT.

81. The Chair summarized the discussion by concluding that there was general support for provision and that issues relating to the link to other treaties should be dealt with in the final provisions.

Paragraph (3)

82. The Delegation of Japan and the Representative of the EPO supported the text as proposed, while the Delegation of the United States of America advocated that abstracts prepared by the applicant should form part of the disclosure.

*Draft Rule 4: Further Requirements Concerning Contents and Order of Description
Under Article 5(2)*

Paragraph (1)(i)

83. The Delegation of Romania was in favor of deleting the square brackets around the word “technical,” while the Delegation of the Russian Federation and the Representative of EPI supported the deletion of the word “technical.”

84. The Delegation of the United States of America and the Representative of the EPO suggested postponing the discussion concerning the term “technical” in draft Rules 4 and 5, in view of its link to the question of patentable subject matter.

85. The Chair summarized the discussion as follows: A few 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 draft Rules 4 and 5 should be postponed until the SCP had reached a conclusion regarding patentable subject matter under draft Article 12(1).

Paragraph (1)(ii)

86. The Delegation of Japan supported the deletion of the term “preferably,” while the Delegations of Canada, China, Sweden and the United States of America, and the Representatives of the EPO, ABA, CIPA, EPI, FICPI, IPIC, JIPA and TMPDF, were in favor of maintaining the term “preferably.”

87. Whereas the Delegation of the United States of America, supported by the Representatives of ABA and AIPLA, stated that the citation of documents need not be in the

description, the Representative of the EPO expressed the view that documents which were relevant to the invention should be cited in the application itself, and that a provision could be included to that effect.

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

Paragraph (1)(iii)

89. The Delegation of Romania suggested the deletion of the word “preferably” and the addition of the word “technical” before the word “problem.”

90. The Delegation of the United States of America strongly supported the provision as proposed and keeping the word “preferably” since the problem-solution presentation was not always the best approach, and because no application should be refused on the grounds of not using that approach. The Delegations of Australia, Canada, Germany, Japan, the Russian Federation, Spain and the United Kingdom, and the Representatives of AIPPI, EPI, FICPI, IPO and JIPA, shared this point of view.

91. The Representative of the EPO, supported by the Delegations of China, France, Greece, Ireland and Sweden expressed preference for the previous wording, stating that the EPO would not refuse an application just because the description was not written in a particular way.

92. In response to the Representative of the EPO, the Delegation of the United States of America observed that the previous wording made the problem-solution approach mandatory thereby requiring refusal of an application on that basis alone.

93. The Delegation of the Netherlands expressed support for the proposal made by the Delegation of Ireland at the seventh session of the SCP reflected in paragraph 47 of document SCP/7/8.

94. The Chair summarized the discussion as follows: The SCP agreed that the provision should not provide for 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.

Paragraph (1)(iv) and (v)

95. There was general support for these provisions.

Paragraph (1)(vi)

96. In connection with this provision, the Delegation of the United States of America stated that the best mode requirement, which was, in its view, a substantive disclosure requirement, should be included in draft Article 10 or in a new draft Article. The Delegation noted that the best mode requirement, which provided a better quality of disclosure, was an important element in achieving an appropriate balance in the patent system. The Representative of OAPI stated that the indication of the best mode was an important requirement.

97. The Representative of the EPO, seconded by the Delegations of Denmark, Germany, Greece, Ireland, Japan, the Netherlands, Norway, Romania, Slovakia, Sweden and the United Kingdom and the Representative of the EAPO, supported the text as proposed and opposed the inclusion of the best mode requirement. In her view, the enabling disclosure requirement was sufficient for the purpose of disclosure and the best mode requirement would adversely affect legal certainty.

98. The Chair summarized the discussion on paragraph (1)(vi) as follows: 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.

Paragraph (1)(vii)

99. There was general support for this provision.

Paragraph (2)

100. There was general support for this provision.

Draft Rule 5: Further Requirements Concerning Claims Under Article 5(2)

Paragraph (1)

101. There was general support for this provision.

Paragraph (2)

102. The Delegation of Canada, supported by the Delegation of Romania and the Representatives of the EPO and FICPI, stated that the difference between the terms “feature” and “limitation” was ambiguous, even taking into account the definition of those terms in draft Rule 1(1)(c), and suggested using the term “feature” throughout the draft Treaty. Indicating that the term “feature” referred to broader characteristics of the claimed invention, while the term “limitation” referred to the specific wording of the claims, the Delegation of the United States of America noted that these notions should not be confused.

103. The Representative of the EPO proposed that paragraph (2) be deleted and that the words “, in terms of the features of the invention” be included at the end of draft Article 11(1).

104. The Chair indicated that the second part of draft Rule 5(2) “, which shall be expressed in the form of one or more limitations” might be deleted.

105. The Chair summarized the discussion on paragraph (2) as follows: 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 draft Article 11(1), and whether, in this case, the second part of draft Rule 5(2) could be deleted.

Paragraph (3)

106. There was general support for this provision, except that the Delegation of Canada pointed out that, since this provision referred to the “features of the invention,” draft Rule 5(2) might be deleted.

Paragraph (4)

107. There was general support for this provision.

Paragraph (5)

108. 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”) at its second session (see paragraphs 344 to 346, below).

Draft Article 6: Unity of Invention

Draft Rule 6: Details Concerning the Requirements of Unity of Invention Under Article 6

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

Draft Article 7: Observations, Amendments or Corrections of Application

Paragraph (1)

110. As regards subparagraph (a), the Delegation of Brazil suggested that the reference to “Article 13(1)” should appear in square brackets, noting the connection with the subject matter of document SCP/8/5.

111. The Chair pointed out that the comment by the Delegation of Brazil would be equally applicable to all references to draft Article 13(1) and noted that, although the contents of that draft Article were not agreed, the link between this provision and draft Article 13(1) would need to be highlighted.

112. The Delegation of Argentina noted that the word “*delegación*” in subparagraph (a) of the Spanish text should be replaced by the word “*denegación*.”

113. Concerning subparagraph (b), while supporting the provision in general, the Delegation of the United States of America requested clarification in respect of the words “error or defect” and as regards the reference to subparagraph (a), which contained the term “requirement.”

114. The Representative of the EPO requested that the notions of “amendment,” which referred to matters of substance, and of “correction,” which related to the rectification of clear mistakes, be distinguished throughout draft Article 7.

115. In response to a suggestion by the same Representative that the words “obvious error,” which was the terminology used in Rule 91.1 of the Regulations under the PCT, be utilized in the draft SPLT, the International Bureau noted that, since that Rule was under review by the Working Group on Reform of the PCT, some coordination between the two fora should be envisaged.

116. The Representative of EPI opposed the inclusion of subparagraph (b) on the grounds that, where a divisional application had been filed without changing the subject matter of the parent application, the Office should object to such a division rather than rejecting the divisional application.

117. The Chair summarized the discussion on paragraph (1) as follows: 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).

Paragraph (2)

118. The Delegation of the United Kingdom questioned whether subparagraph (b) was required at all.

119. 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.

120. The Delegation of Argentina proposed that the phrase “only up to the time allowed for the reply to the first substantive communication” be replaced by the phrase “up to the effective date of the notification of the first substantive communication.”

Paragraph (3)

121. Referring to paragraph 60 of the Practice Guidelines, the Delegation of the United States of America raised concerns about amending an application by adding newly discovered references to the prior art. Under the practice of its Office, the addition of subject matter, even if originating from existing prior art references, might constitute adding new matter.

122. The Representative of the EPO explained that, according to the practice of his Office, in general, if a particular item of prior art which reflected the closest prior art in respect of a claim was found during the course of examination, a reference to that item of prior art could be included in the description. However, if the reference to the prior art was used as a basis for complying with the enabling disclosure requirement, his Office would require replacing the reference with its specific disclosure, which was very difficult to achieve without adding new matter.

123. The Delegation of Australia, supported by the Delegation of the United States of America, stated that subject matter contained in the abstract as of the filing date should be allowed to be moved to the description after that date.

124. The Delegation of Canada suggested the re-insertion, in square brackets, of the deleted words in subparagraph (a), “and, where prepared by the applicant, the abstract” for the purpose of further discussion by the Committee.

125. The Delegation of Germany, supported by the Representative of the EPO, suggested the deletion of the words “the abstract” in the second line of subparagraph (a), noting that abstracts were in some cases prepared by Offices.

126. Supporting the Delegation of Germany, the Delegation of Canada pointed out that amendments or corrections under draft Article 7(2)(a) also applied to abstracts.

127. With respect to a missing part of the description or a missing drawing included after the filing date, the Delegation of Peru, supported by the Delegation of Argentina, proposed that a reference to the specific Article under the PLT be included in the draft SPLT.

128. In order to avoid a direct reference to Article numbers, the Representative of the EPO suggested that the reference to the PLT be replaced by an express reference to the filing date accorded in accordance with the PLT.

129. Concerning subparagraph (b), the Delegation of the United States of America proposed that the phrase “Notwithstanding subparagraph (a),” be deleted, since subparagraph (b) should not be viewed as an exception to the new matter standard. Referring to paragraph 62 of the Practice Guidelines, the Delegation of Canada, supported by the Representative of IPIC, stated that the mistake should be clear from the face of the document to which the public had access, without relying on extraneous documents.

130. As regards the test for rectifying a mistake, the Representative of the EPO, supported by the Delegation of the United States of America, suggested that the criteria for correction in the draft SPLT should be expressed in wording similar to that used in PCT Rule 91.1 concerning obvious errors. The Delegation recalled that the term “obvious error” had not been used in the draft SPLT in order to avoid confusion with the term “obviousness” in relation to inventive step (non-obviousness).

131. The Chair observed that the question of whether this provision should be in the Treaty or in the Regulations should be addressed.

132. In response, the Representative of the EPO expressed her preference for including the provision in the Regulations.

133. The Chair summarized the discussion on paragraph (3) as follows: The SCP agreed that prior art references added through amendments should not form a basis for broadening the scope of the disclosure. For example, an amendment should 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 were raised about the appropriateness of using the abstract as the basis for amending the other parts of the application. 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.

Draft Rule 7: Time Limit Under Article 7(1)

134. The Delegation of Germany, supported by the Delegation of China and the Representatives of AIPPI, GRUR and IPIC, proposed that the minimum time limit under this Rule be three months rather than two months.

135. The Delegation of Mexico expressed its preference for the current draft, since the provision allowed a Contracting Party to provide for a longer time limit.

136. Upon discussion, it was agreed that both three months and two months would be presented as alternatives within square brackets for the next session.

137. In response to an observation by the Delegation of the Russian Federation, the International Bureau explained that, in view of the different existing legal principles regarding offer and acceptance of a contract, what constituted the date of notification for the purpose of determining the duration of a time limit was left to the applicable law, as was the case in the PLT.

Draft Article 7bis: Changes in Patents

General Discussion

138. The International Bureau explained that draft Article 7bis was based on draft Article 17 of the Draft Treaty Supplementing the Paris Convention as Far as Patents are Concerned (the "1991 Draft" set out in documents PLT/DC/3 and 69).

139. The Delegation of the Netherlands stated that it wished to reserve its position on the inclusion of draft Article 7bis. It explained that its national law did not permit a patentee to make changes in the patent in order to limit the extent of protection: such a limitation could only be effected by partial abandonment of the patent.

140. The Delegations of Argentina, Finland, Spain, Sweden and the United Kingdom also reserved their position on this provision to allow more time for consideration.

141. The Delegation of Ireland stated that it did not support draft Article 7bis and wished to reserve its position on its inclusion. It noted that the procedures under paragraphs (2) and (3) were not compatible with the provisions of the European Patent Convention.

142. The Delegation of the United States of America stated that it needed more time to fully consider the draft Article, particularly with regard to its re-issue practice, which it wished to retain.

143. The Representative of AIPLA also referred to the need to consider re-issue practice.

144. In response to comments by the Delegations of Canada, Japan and the United States of America, as to whether the draft Treaty should regulate changes in patents, the International Bureau explained that the inclusion of this provision did not appear to conflict with the

mandate for the draft Treaty, since the dividing line for such inclusion was not between pre- and post-grant procedures, but between the grant and validity of patents on the one hand and the enforcement of patent rights on the other.

145. The Delegation of Germany, supported by the Delegation of Finland, commented that the draft Article should not affect opposition proceedings.

146. The Representative of OAPI reported that his organization had adopted legislation regulating amendments following publication of a patent that would enter into force in February 2003, and observed that an important issue under draft Article *7bis* was to take into account the stability in international texts.

147. The Representative of GRUR stated that he was of the view that the time was not ripe to introduce the draft Article. In addition, the provisions as proposed would introduce extra complexity and costs. He suggested that, if the draft Article were retained, it should be restricted to a quick, inexpensive limitation procedure with retrospective effect, similar to that under the European Patent Convention.

Paragraphs (1) and (2)

148. The Delegations of Canada, China and Japan suggested that it was necessary to include further details in respect of the procedure for making changes under paragraph (1).

149. The Representative of the EPO stated that paragraph (1) should permit the Office to examine a request to make changes to the patent and to refuse such request if the change would result in the claims being broadened, not being clear or concise, or not being supported by an enabling disclosure.

150. In response to a comment by the Representative of the EAPO that it was necessary to clarify the basis for changes, for example, that they must be based on information disclosed in the description and drawings, the International Bureau noted that it was intended that this matter should be covered by paragraph (4) and national law.

151. The Delegations of Canada and Ireland commented that it was not clear whether the term “changes” in paragraph (1) was intended to have a meaning different from that of the term “amendments” in draft Article 7.

152. The Delegation of France noted that the French text used the same terminology in both draft Articles.

153. The International Bureau explained that the English term “changes” had been taken from the 1991 Draft and suggested that, for consistency with draft Article 7, it could be replaced in draft Article *7bis* by the term “amendments.”

154. The Delegations of China and Germany stated that only changes to the claims should be permitted under paragraph (1).

155. In response to a comment by the Delegation of Ireland as to what was meant by the term “the competent Office” in paragraph (1), for example, in the case of a regional patent granted

with effect for a Member State, the International Bureau explained that this was a matter for the national or regional law concerned.

156. The Delegation of Ireland further commented that paragraph (1) did not appear to apply to courts even though most proceedings referred to in paragraph 63 of the Practice Guidelines would be expected to be before a court.

157. The Delegation of Pakistan, while expressing support for the draft Article, similarly questioned whether the provisions covered the powers of a court to amend a patent.

158. The Delegation of China observed that making changes to a patent was a quasi-judicial matter.

159. The Representative of AIPLA stated that, in order to take account of third party interests, changes under this paragraph should only be determined by a court.

160. In response to the above, the International Bureau confirmed that, in accordance with the definition of “Office” in draft Article 1(i) and the explanation in paragraph 3 of the Practice Guidelines, paragraph (1) as drafted did not seem to apply to courts, but that this could be further clarified; it noted that certain provisions of the PLT also did not apply to courts.

161. The Delegation of Ireland also stated that it was not clear whether a change under paragraph (1) limiting the extent of protection conferred by the patent would have retroactive effect or would have effect only from the date of the change. In its view, the effect should be retroactive.

162. The Delegation of Morocco stated that it supported paragraph (1), which was in conformity with its national law.

163. In response to a question by the Representative of EPI, the Chair stated that a change in order to limit the extent of protection under paragraph (1)(a) could, for example, be by way of a disclaimer.

164. The Representative of PIPA, supported by the Delegations of Finland and Germany and the Representative of GRUR, opposed paragraph (1)(b) since it would be difficult to determine whether, at the prescribed time, the applicant was aware of the item of prior art in question. The Representative of AIPLA also referred to the problem of the case in which an applicant was aware of the existence of an item of prior art but not of the need to amend the application because of it. The Representative of PIPA suggested that paragraph (1)(b) should be limited to prior art that had been cited and in respect of which the applicant had been given an opportunity to amend the claims.

165. The Delegation of the Russian Federation stated that, in accordance with Russian legislation, amendments might be made to a patent in order to correct mistakes.

166. The Delegation of Morocco expressed concerns as to this provision. The Representative of OAPI explained that the regional law of his Organization permitted corrections that did not affect substance.

Paragraphs (3) and (4)

167. The Delegations of Argentina, Finland, Germany, Spain, Sweden, and the United Kingdom stated that they opposed the inclusion of paragraph (3).

168. The Delegation of Mexico stated that its national law provided only for the limitation of the extent of protection. The Delegation, seconded by the Delegation of Norway, therefore reserved their positions on the inclusion of draft paragraphs (3) and (4).

169. The Chair summarized the discussions on draft Article 7*bis* as follows: 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, and 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 session during which the maintenance or deletion of the provision could be decided.

Draft Article 8: Prior Art

Paragraph (1)

170. The Delegation of the United States of America, supported by the Delegation of Australia, suggested that a further provision be included in paragraph (1) to provide for loss of patent rights where the applicant or patentee had made secret prior commercial use of an invention or previously offered a product for sale without disclosing the invention.

171. The Representative of the EPO recalled that this matter had been discussed at a previous session and that the Committee had decided by a clear majority not to include such a provision in the SPLT.

172. The Chair summarized the discussions on paragraph (1) as follows: 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 were noted.

Paragraph (2)(a)

173. The Delegation of the United States of America, supported by the Representatives of ABA, AIPLA and IPO, stated that the prior art effect of an earlier application under paragraph (2)(a) should be extended to cover lack of inventive step or obviousness in order to avoid the grant of two patently indistinguishable rights. The Delegation commented that the difference in practice between applying novelty only and applying both novelty and obviousness would depend on the criteria under draft Rule 14(2) for determining novelty, particularly in respect of inherently disclosed information.

174. The Delegation of Canada agreed that it was necessary to take account of the criteria for novelty; it explained that, although prior art effect under its national law was restricted to novelty, this was not restricted to the situation where there was strict identity of subject matter.

175. The Representative of the EPO, supported by the Representatives of FICPI and GRUR, stated that the prior art effect of an earlier unpublished application was an exception to the general rule that only information made available to the public before the claim date should be taken into account for the purposes of prior art; it was therefore appropriate to apply this exception narrowly by restricting it to novelty. In response to a question of interpretation, the International Bureau confirmed that paragraph (2)(a) as drafted was intended to restrict the prior art effect to novelty.

Paragraph (2)(b)

176. The Representative of the EPO, supported by the Delegations of Germany and Romania, stated that paragraph (2)(b) should be considered together with paragraph (2)(a) and draft Article 1(v). The Representative commented that the earlier applications that should be considered for prior art effect were those listed under draft Article 3. Although the Representative agreed that the earlier applications had to be published, she stated that the expression “to the extent” was not clear in this context since it could be considered to mean that only the published text of the earlier application can be considered as forming part of the prior art. She suggested that the wording of paragraph (2) as a whole should be clarified and simplified, for example, by amending it to read as follows:

“(2) The whole contents of an earlier application shall form part of the prior art for the purpose of determining the novelty of subject-matter claimed in an application filed subsequently with effect in the same Contracting Party provided that the earlier application or the patent granted thereon is published, as prescribed in the Regulations.”

177. The Delegation of Canada agreed with the view expressed by the Representative of the EPO that it was only necessary for the relevant disclosure in the earlier application to be subsequently published, not the complete text. However, it did not support the text suggested by the Representative of the EPO since it did not appear to adequately address situations in which a claim had multiple claim dates or different parts of a claim had different claim dates.

178. The Delegation of Australia also referred to the importance of the relevant disclosure being in the earlier application both as filed and as published.

179. The Chair summarized the discussions on Article 8(2) as follows: The essence of the discussions on Article 8(2)(a) 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 on that matter continued to be divided. The question was raised whether that division of opinion was in fact tied up with the criteria for assessing novelty.

Draft Rule 8: Availability to the Public Under Article 8(1)

Paragraph (1)

180. In response to a question by the Delegation of Pakistan, the International Bureau confirmed that the definition of “prior art” under paragraph (1) covered all expressions of traditional knowledge. The International Bureau also reported that work was proceeding on the establishment of a data base and on the international classification system in respect of traditional knowledge to facilitate its availability for prior art purposes.

181. In the absence of other comments, the Chair concluded that there was general support for this provision.

Paragraph (2)

182. The Delegations of Colombia, Ireland and Peru, and the Representative of CIPA, stated that the expression “if there is a reasonable possibility that it [information] could be accessed by the public” was not clear. The Delegation of the Russian Federation reiterated its proposal, previously expressed on several occasions, to replace the word “reasonable” with the term “legitimate.”

183. The Representative of CIPA expressed its disagreement with the suggestion by the Chair that the substance of paragraph 72 of the Practice Guidelines be transferred to the Regulations on the grounds that the wording of that paragraph was not sufficiently precise for the purpose of the Regulations.

184. A similar suggestion by the Delegation of Peru that the substance of paragraph 73 of the Practice Guidelines should be transferred to the Regulations was opposed by the Delegation of Germany.

185. The Delegation of Ireland suggested that the word “reasonable” be deleted.

186. The Delegation of the United States of America recalled that it wished the Practice Guidelines to have a binding effect.

187. The Delegations of Argentina and the Russian Federation expressed a preference for the second alternative presented in square brackets in paragraph (2)(b).

188. The Delegation of Romania, supported by the Delegations of Ireland and Spain and the Representative of the EPO, also expressed a preference for the second alternative but with the words “of confidentiality” added after “obligation.”

189. The Delegation of Germany stated that it also preferred the second alternative since it placed the burden of proof on the applicant to establish that there existed an obligation to maintain the information secret.

190. The Delegation of the United States of America stated that it favored the first alternative since, in its view, it was clearer; it suggested that, if the second alternative were chosen, what constituted an obligation should be explained in the Practice Guidelines.

191. The Delegations of Colombia and Norway also expressed a preference for the first alternative.

192. The Delegation of the United States of America questioned whether paragraph (2) covered information made available by the applicant to, for example, a spouse or close friend in the expectation of secrecy, but without a specific agreement to that effect and stated that such disclosures should not constitute prior art.

193. The Representative of the EPO explained that its practice recognized both express and tacit obligations of secrecy, so that such information would not normally be considered as prior art.

194. The Chair summarized the discussions on paragraph (2) as follows: 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.

Paragraph (3)

195. There was general support for this provision.

Draft Rule 9: Prior Art Effect of Earlier Applications Under Article 8(2)

Paragraph (1)(a)

196. There was general support for this provision.

Paragraph (1)(b)

197. In response to a question by the Representative of EPI, also speaking as the Representative of TMPDF, the International Bureau explained that the purpose of this provision was, as explained in more detail in paragraph 81 of the Practice Guidelines, to cover the situation in which a Contracting Party did not provide for double protection of the same invention by more than one title of protection.

Paragraph (2)

198. There was general support for this provision.

Paragraph (3)

199. The Delegation of the United States of America noted that it was not clear how this paragraph might apply in the case where an earlier application was erroneously published after it had been withdrawn. The Delegation also referred to the need to take account of the right of restoration of a lapsed application.

200. The Delegation of Canada explained that, under its law, only applications that had been withdrawn before publication were not considered for the purposes of prior art effect. The Delegation, supported by the Delegation of Australia, suggested that a similar approach be considered under paragraph (3).

201. The Delegation of the Russian Federation expressed its support for clearer drafting but noted that the situation referred to by the Delegation of Canada was not the only one in which an earlier application was no longer pending with no rights outstanding.

202. The Representative of the EPO raised the issue of whether a priority right derived from an earlier application which was then withdrawn would constitute an “outstanding right.”

203. The Chair summarized the discussion on paragraph (3) as follows: 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.

Paragraph (4)

204. The Delegation of the United States of America, supported by the Representative of BIO, stated that it supported the inclusion of an anti-self-collision provision, in order to give the Office the power to refuse the grant of two patents for the same invention. However, the Delegation, supported by the Representative of TMPDF, was concerned that the expression “the same claimed invention” in the first alternative presented in square brackets was not clear and noted that this would depend on the test for novelty that was to be applied. It also questioned what would be considered “patently distinct” in the second alternative and whether this alternative would cover its national practice under which a second patent for the later application could be granted subject to a disclaimer to the claimed invention of the earlier application, to a common patent term and to common ownership.

205. The Chair summarized the discussions on paragraph (4) as follows: 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.

Draft Article 9: Information Not Affecting Patentability (Grace Period)

206. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, requested that the discussion on this provision be postponed since those States had still not reached a common position on draft Article 9, but that they were aiming to do so before the next session of the Committee.

207. The Delegation of the United States of America agreed to postponing the matter. The Delegation also stated that it opposed the inclusion of paragraph (3) on the grounds that it related to evidential procedure rather than substantive patent law. It also opposed the inclusion of paragraph (5) on the grounds that it concerned infringement proceedings.

208. The Representative of AIPPI reported that it had sent out a questionnaire on grace period to its members and would report the results to the Committee in due course.

209. The Chair summarized the discussion on draft Article 9 as follows: 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 within the European Community had not been finalized yet. The Delegation hoped that there would be such a common position by 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 the discussion of draft Article 9 to its next session.

Draft Article 10: Enabling Disclosures

Paragraph (1)

210. In response to a question by the Representative of EPI, the Chair agreed that the expression “allow the invention to be made” was intended to cover allowing the invention to be made over the whole of its claimed range.

211. The Chair concluded that there was general support for this provision.

Paragraph (2)

212. In response to a suggestion by the Delegation of Argentina that it should be stated that no account should be taken of an amendment or correction that went beyond the disclosure in the application as filed, the International Bureau noted that such amendments and corrections were not possible under draft Article 7(3).

213. The Representative of the EPO, supported by the Delegations of Germany and the Russian Federation, suggested that the words “as amended and corrected under the applicable law” be deleted. The Representative also suggested that where a missing part of the description or missing drawing was filed to rectify its omission from the application as originally filed, the filing date for the purposes of paragraph (2) should be that accorded under the PLT.

214. The Representative of the EAPO also referred to the need to take account of missing parts of the description.

215. The Delegation of Canada, supported by the Representative of EPI, stated that the reference to “the disclosure on the filing date” was not appropriate. Although the disclosure on the filing date was relevant to the allowability of amendments and corrections under draft Article 7(3), the sufficiency of the disclosure had to be determined on the basis of the disclosure at the time of such determination, for example, at the time of substantive examination or invalidation proceedings; this was of particular relevance where enabling disclosure had been deleted by way of amendment or correction.

216. The Chair summarized the discussions on paragraph (2) as follows: Some delegations proposed the inclusion of wording which would ensure that the amendments and corrections would not extend the disclosure as compared to the filing date. Two delegations 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.

Draft Rule 10: Sufficiency of Disclosure Under Article 10

217. There was general support for this provision.

*Draft Rule 11: Deposit of Biologically Reproducible Material Under Article[s] 10
[and 11(3)]*

Paragraph (1)

218. The Delegation of Germany, supported by the Delegation of China and by the Representative of the EPO, stated that in its view deposits of biologically reproducible material were always considered part of the description, contrary to what was stated in paragraph (1), second sentence. The Delegation of the Russian Federation spoke in favor of a deposit being considered part of the description only insofar as it served the purpose of disclosing an invention.

219. The Delegation of Canada, supported by the Delegation of the United States of America, suggested that the second sentence be reviewed to take account of the fact that the application should describe as much as possible by way of text and that the deposit could not simply substitute the description.

220. The Delegation of the United States of America suggested that the references to draft Article 11(3) in square brackets should be retained to ensure that the interpretation of claims was covered. The Delegation also proposed that the phrase “and describe” be added after “enable.”

221. The Delegation of Mexico suggested that, for greater precision, the reference to draft Article 5(2) should be replaced by a reference to draft Rule 4(1)(iv).

222. The Chair summarized the discussions on paragraph (1) as follows: 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 sentence in question would therefore require some review in order to decide on either its amendment or its deletion.

Paragraph (2)(a)

223. The Delegation of Canada, supported by the Representative of the EAPO, suggested that the deposit should be made no later than the priority date in order that the disclosure in the earlier application on that date should be enabling.

224. The Chair suggested that this be explained in the Practice Guidelines.

225. The Chair summarized the discussion on paragraph (2)(a) as follows: 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 Practice Guidelines.

Paragraph (2)(b)

226. The Delegation of the United States of America, supported by the Representative of BIO, stated that it supported the inclusion of a provision that permitted a deposit to be made after the filing date in certain circumstances. One example was where a material contained in a private deposit at the filing date was subsequently re-deposited with a depositary institution that complied with the applicable law, as provided under Alternative B, item (ii). The Delegation also noted that Article 4 of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedures provided for a new deposit of a microorganism to be made where the furnished sample of such microorganism was no longer viable.

227. The International Bureau noted that, since the draft Treaty did not regulate what constituted a “depositary institution,” a Contracting Party was free to regulate the situation of re-deposit under the applicable law.

228. The Delegations of Bulgaria, China, the Czech Republic, Denmark, Finland, Germany, Ireland, Japan, Norway, the Russian Federation and Spain, and the Representatives of the EAPO, EPO, EPI and AIPPI, stated that they opposed the inclusion of paragraph (2)(b) on the grounds that an applicant should not be permitted to rely on a deposit made after the filing date since such a deposit would introduce additional matter.

229. The Representative of the EPO noted that, the Directive of the European Parliament and of the Council on the legal protection of biotechnological inventions dealt with the timing of the deposit, and that it would be politically very difficult in Europe to re-open such issues contained in the Directive.

230. The Delegation of the Republic of Korea stated that it could accept Alternative A with the word “may.”

231. The Delegation of Romania stated that it had no preference for Alternative A or Alternative B but noted that draft Rule 4(1)(iv) referred in the past tense to “the fact that the deposit has been made.”

232. The Delegation of Argentina suggested that Alternative B be retained for further consideration.

233. The Chair summarized the discussion on paragraph (2)(b) as follows: A large majority of delegations 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 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 next draft should therefore

contain two alternative texts taking into account the discussions held on the subject. These alternatives, however, should not be discussed at the next meeting.

Paragraph (3)

234. There was general support for this provision.

Draft Article 11: Claims

Paragraph (1)

235. The Delegation of the United States of America suggested that the reference to matter which the applicant regarded as his invention should be transferred, with or without square brackets, from paragraph 110 of the Practice Guidelines to draft Rule 12. This suggestion was opposed by the Delegations of Canada and Germany, which noted that the wording of paragraph (1) was based on PCT Article 6.

236. The Chair and the Delegation of the Russian Federation suggested that paragraph (1) be reviewed to take account of the fact that, although the claims in an application as filed define the subject matter for which protection is sought, the claims in the patent define the scope of protection that has been granted.

237. The Chair summarized the discussions on paragraph (1) as follows: 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.

Paragraph (2)

238. The Delegation of the United States of America stated that the reference to the claims “in their totality” was not clear. The Delegation suggested that, in order to clarify this term and the terms “clear” and “concise,” the explanations in respect of these terms should be moved from paragraph 111 of the Practice Guidelines to the Regulations.

239. The Delegation of Argentina suggested that the words “and shall be self-explanatory” be added after the word “concise.”

240. The Representative of the EPO stated that it wished to reserve its position on the suggestion by the Delegation of the United States of America and noted that the Committee had yet to agree on the status of the Practice Guidelines.

241. The International Bureau explained that the status of the Practice Guidelines would need to be defined in the Final Clauses and that a proposal could be prepared for the next session based on any suggestions by Delegations.

242. The Chair summarized the discussions on paragraph (2) as follows: 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.

Paragraph (3)

243. The Delegation of the United States of America, supported by the Representative of AIPLA, expressed concern at the deletion of the reference to “claims.” It stated that, in its view, an applicant should be permitted to rely on any disclosure in the application as filed, including any disclosure in the claims themselves, as support for the claims.

244. The Representative of the EPO, supported by the Delegations of France, Ireland, Slovakia, Spain and Sweden and the Representative of the EAPO, contended that the reference to “claims” was not necessary: if the application as filed contained a disclosure in the claims that was not in the description, it would be possible for the applicant to incorporate that disclosure in the description by way of amendment without adding new subject-matter to the application.

245. The Delegation of Canada stated that there were two separate issues to be considered. The first issue was whether, on the filing date, the applicant recognized his invention over the whole scope of the claims; this required account to be taken of the disclosure in the application as filed, including that in the claims. Accordingly, in its view, the reference to “claims” should be re-instated. The second issue was whether the claims were supported by the description. As regards this, the Delegation noted that, in many jurisdictions, lack of support in the description was not a ground for invalidation and also that the requirement in pre-grant proceedings was usually complied with by including in the description “consistency” clauses worded in precisely the same terms as the claims. The Delegation commented that the inclusion of such clauses did not seem to serve a useful purpose and queried whether, in view of the related requirement for enabling disclosure, it was necessary to retain the requirement for support by the disclosure.

246. The Delegation of China expressed the view that it was necessary to separate the requirement for enabling disclosure from the requirement that the claimed invention be supported by the disclosure in the description and drawings. It was therefore of the view that the latter requirement should be retained.

247. The Representative of OAPI also referred to the need for the claims to be supported by the description and drawings.

248. The Chair summarized the discussions on paragraph (3) as follows: 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 (that is, including the claims) or by the description and drawings. The text should be reviewed in view of the fundamental objective of this provision.

Paragraph (4)(a)

249. The Delegation of China stated that, in interpreting the claims, it was always necessary to take account of the description and drawings and the general knowledge of a person skilled in the art, not just when the wording was immediately clear. It therefore suggested that the second sentence be deleted.

250. The Delegation of the United States of America, supported by the Delegation of Canada, agreed that due account of the description and drawings must always be taken but suggested instead that the words “Where the wording of the claims is not immediately [clear][evident]” be deleted.

251. The Representative of the EPO, supported by the Delegations of Germany and Romania, suggested that the provision be replaced by the text contained in Article 21(1)(a) of the 1991 Basic Proposal, namely, “The extent of protection conferred by the patent shall be determined by the claims, which are interpreted in the light of the description,” and that the details be moved to the Regulations.

252. The Delegation of Canada commented that the use of the expression “extension of protection conferred by the patent” in that text should be carefully reviewed, particularly in respect of the protection conferred on the product of a process patent under Article 28.1 of the TRIPS Agreement.

253. The Chair summarized the discussions on paragraph (4)(a) as follows: 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.

Paragraph (4)(b)

254. The Delegation of the Russian Federation stated that it did not support the concept of equivalence in infringement proceedings since the scope of the patent for the purpose of those proceedings should not extend beyond the scope of the protection at the time of grant when equivalence was not taken into account. In addition, the Delegation was of the view that the draft Treaty should not cover infringement.

255. The Representative of the EPO, supported by the Delegations of Canada and China, recalled that the Committee had already agreed to include the doctrine of equivalents and stated that this doctrine was relevant to pre-grant procedures.

256. The Chair summarized the discussions on paragraph (4)(b) as follows: Although one delegation opposed the inclusion of this provision in the SPLT, a majority of delegations supported its inclusion with a view to ensuring a common drafting standard.

Draft Rule 12: Relationship of Claims to Disclosure Under Article 11(3)

257. The Delegation of Germany suggested that paragraph 113 of the Practice Guidelines be reviewed to ensure that references to “the claim” and “the claimed invention” were consistent.

258. The Representative of OAPI agreed that this terminology should be reviewed but suggested that the term “the claimed invention” should not be used.

259. The Delegation of the Russian Federation expressed the view that the term “teaching” was unclear and noted that it was not explained in the Practice Guidelines. The Delegation suggested that a more transparent term be used.

260. In response to a query of the Representative of the EPO as to the practical impact of the addition of the term “and described,” the International Bureau explained that the words “and described” were based on the suggestion of the Delegation of the United States of America at the seventh session of the Committee. The Delegation of the United States of America stated that these words were necessary to make it clear that the applicant could not claim subject matter which he had not both recognized and described on the filing date.

Draft Rule 13: Interpretation of Claims Under Article 11(4)

Paragraph (1)

261. The Chair concluded that, in the absence of any comments, there was general support for this provision.

Paragraph (2)

262. The Delegation of the Russian Federation commented that the term “embodiments” was not clear and suggested that it should be replaced or explained in the Practice Guidelines.

263. The Delegations of Colombia and Peru stated that the Spanish term “*incorporaciones*” did not correspond to the English term “embodiments.”

264. The Delegation of Argentina suggested “*alternativas de realización de la invención*” as an alternative, while the Delegation of Uruguay suggested “*realizaciones*.”

265. The Delegation of Argentina stated that the expression “or does not achieve every objective or possess every advantage cited or inherent in such examples” in subparagraph (b) was too restrictive and suggested that it be deleted, or at least presented in square brackets.

266. The Delegation of the Russian Federation queried whether the term “features” in subparagraph (b) had the same meaning as in other provisions and suggested that this term be used instead of “limitations” throughout the draft Treaty and Regulations.

267. The Representative of the EPO reserved its position on paragraph (2).

268. The Chair summarized the discussions on paragraph (2) as follows: There was general support for this provision. One delegation queried the meaning of the term “embodiment” and several delegations suggested correcting the Spanish translation of that term.

Paragraph (3)

269. There was general support for this provision.

Paragraph (4)

270. The Delegation of China stated that “means-plus-function” claims, as referred to in subparagraph (a), should be interpreted in the same way in pre- and post-grant proceedings for the purposes of determining inventive step. The Delegation also suggested that with reference to “product-by-process” claim, as referred to in subparagraph (b), where the product possessed characteristics imported by the process, the claim should relate to a product possessing those characteristics, not a product prepared by the process, since third parties would be unable to determine whether or not a product possessing those characteristics had been obtained through the process concerned.

271. The Delegation of Japan expressed the view that the provisions were too detailed, if they were to be binding on the courts.

272. The Delegation of Canada, supported by the Delegation of Australia, noted with respect to subparagraph (b) that its legislation recognized two types of claims, namely, a claim to a product *per se* defined in terms of characteristics resulting from the process and a claim to a product when made by the process. In its view, an applicant should be permitted to choose which type he wanted.

273. The Delegation of the United States of America stated that the provisions of subparagraph (c) were too broad, particularly in respect of mechanical products.

274. The Delegation of Australia explained that, under its law, a claim to a product for a particular use was interpreted as a claim to a product with a capability for, or limited to, that use.

275. The Delegation of Germany stated that paragraph (4) required further study.

276. The Representative of the EPO stated that the EPO wished to reserve its position on the provision.

277. The Chair summarized the discussions on paragraph (4) as follows: 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 draft Rule.

Paragraph (5)

278. The Delegations of Germany, Romania and the United States of America stated that they favored Alternative B.

279. The Delegation of the United States of America also considered that it was more equitable to apply the test of equivalence based on the situation at the time of the alleged infringement than at any other time. It also supported Alternative B, item (ii), which would cover the doctrine of file wrapper estoppel.

280. The Delegation of the United Kingdom, supported by the Delegation of Australia and the Representative of the EAPO, opposed applying the test of equivalence at the time of infringement on the grounds that this extended the scope of protection to subject matter not

recognized by the applicant at the filing date and could unfairly prejudice the interests of third parties.

281. The Delegation of the Russian Federation stated that, although its national law provided for the concept of equivalence, this was a matter concerning infringement that should not be included in the draft Treaty. The Delegation also noted that the matter of equivalents was not straightforward and should not be discussed in detail at this stage. The concept of equivalents as provided for in the draft SPLT, however, should be in a future agreement which would cover infringement issues.

282. The Delegation of Canada stated that it supported the inclusion of the doctrine of equivalents in the draft Treaty but wished to consider Alternatives A and B further. It suggested that the doctrine of file wrapper estoppel under item (ii) of Alternative B should not be mandatory but rather optional for Contracting Parties.

283. The Delegation of Argentina stated that it wished to reserve its position on paragraph (5).

284. The Delegation of Germany commented that the provision required further study.

285. The Chair summarized the discussions on paragraph (5) as follows: 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 the doctrine of file wrapper estoppel and the proposed timing for the determination of equivalents, that is, the time of infringement.

Paragraph (6)

286. The Delegation of the United States of America stated that it did not agree with the inclusion of the words “in the jurisdiction for which the statement has been made.” In its view, a court, when seeking the most important evidence to consider in order to determine the facts of a case, should be able to take account of statements limiting the scope of the claims made by the applicant in any jurisdiction in accordance with its existing doctrine of file wrapper estoppel.

287. The Delegation of China supported the inclusion of paragraph (6) on the grounds that it formed a balance with paragraph (5).

288. The Delegation of Germany, supported by the Delegations of the Russian Federation and the United Kingdom, and the Representatives of the EPO and IPIC, stated that it opposed this paragraph on the grounds that it created uncertainty for third parties. The Delegation of the Russian Federation also noted that this matter went beyond the scope of the draft SPLT, since it related to the infringement of a patent.

289. The Representative of the EPO noted that a proposal to include a similar provision in the European Patent Convention had been rejected by its Contracting States.

290. The Delegation of Canada suggested that provision for the doctrine of file wrapper estoppel should only be included on an optional basis. Also, it supported the restriction to the

jurisdiction concerned in order to avoid distorting proceedings in one jurisdiction because of the risk that any statements made in those proceedings might be used in other jurisdictions.

291. The Representative of the EPO stated that it might be able to consider an optional provision as suggested by the Delegation of Canada.

292. The Representative of FICPI stated that any provision should be restricted to statements made in the jurisdiction concerned.

293. The Chair summarized the discussions by stating that opinion was divided as to the inclusion of this provision, and that some delegations had suggested its inclusion on an optional basis only. There had also been some discussion on the issue of jurisdiction.

Draft Article 12: Conditions of Patentability

Paragraphs (1) and (5)

294. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, and supported by the Delegation of the United States of America, stated that it was in favor of the suggestion by the International Bureau that discussion of these provisions be deferred in order to allow more time for informal discussions.

295. The Delegations of Brazil and Mexico stated that they agreed to the postponement of the discussion on these provisions by the Committee.

296. In response to a suggestion by the Delegation of Pakistan that the corresponding provisions of the TRIPS Agreement be included in draft Article 12, the Chair noted that the need to take account of those provisions had already been well recognized.

297. The Delegation of Mexico suggested that, in the meantime, the relevant texts of the provisions, as well as the footnotes that were contained in the draft Regulations, be retained.

298. The Chair summarized the discussions on paragraphs (1) and (5) as follows: 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.

Paragraph (2)

299. The Delegation of Canada stated that it did not agree with the statement in paragraph 134 of the Practice Guidelines that, where a claim contained one or more alternatives, for example, a Markush-type claim, that claim was anticipated if at least one of those alternatives was described in the prior art. In its view, each of the alternatives should be considered separately for the purposes of assessing novelty.

300. The Representative of the EPO stated that, if one of the alternatives in a claim was not novel, the whole claim should be rejected.

301. The Representative of OAPI stated that paragraph 127 of the Practice Guidelines was not clear and suggested its deletion.

302. The Chair summarized the discussions on paragraph (2) as follows: 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.

Paragraph (3)

303. The Delegation of Argentina expressed support for paragraph (3) as drafted. The Chair concluded that there was general support for this provision.

Paragraph (4)

304. The Delegation of the United Kingdom, supported by the Delegation of the Netherlands, stated that it favored Alternative B. It suggested that, if Alternative A or B were adopted, the wording of Alternative C could provide a basis for setting out the methodology for implementing that alternative.

305. The Delegation of the United States of America stated that it preferred Alternative C. However, it also found the suggestion of the Delegation of the United Kingdom interesting. The Delegation also stated that it appeared that specific substantial and credible utility may be part of the industrial applicability requirement in some jurisdictions and that, before it could agree to support either Alternative A or B, it would need to know whether any jurisdictions which did not apply a utility standard had additional grounds of rejection under the industrial applicability standard.

306. The Delegation of Morocco and the Representatives of the EPO and OAPI stated that they preferred Alternative B without the reference to “commerce proper.”

307. The Representative of the EPO, supported by the Delegation of the United States of America, suggested that, in order to provide a basis for deciding on one of the alternatives, the International Bureau should carry out a study to identify those areas in which there was a substantial overlap of practices and those in which there were different practices.

308. The Delegation of the Russian Federation stated that it supported Alternative A.

309. The Delegation of Mexico stated that it also supported Alternative A, but suggested that the term “commercial” should be replaced by “economic” in order to more clearly encompass industrial activity.

310. The Delegations of Argentina and Colombia stated that they favored Alternative B. The Delegations of Brazil and Egypt stated that they also preferred Alternative B but did not understand the purpose of the underlined text that had been added.

311. The Delegation of Costa Rica stated that it was also in favor of Alternative B, but with the word “commercial” replaced by “economic,” as had been suggested by the Delegation of Mexico in the context of Alternative A.

312. The Delegation of Canada stated that it opposed Alternative C since what mattered was whether a claimed invention was useful, not whether it was credible. The Delegation requested that Alternative A be retained for further consideration.

313. The Chair summarized the discussions on paragraph (4) as follows: Three delegations supported Alternative A, while a majority of delegations expressed their preference for Alternative B. One delegation supported Alternative C. 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.

Draft Rule 14: Items of Prior Art Under Article 12(2)

Paragraph (1)

314. The Delegation of Germany, supported by the Representative of the EPO, stated that there was no need to refer to the expression “primary item of prior art.” The Delegation of the United States of America suggested that the wording of paragraph (1) should take account of items of prior art that were incorporated by explicit reference, as referred to in paragraph (2)(b).

315. The Delegation of the Russian Federation stated that the text under item (ii) was not applicable in all cases, for example, in the case of a simple mechanical invention, where the information as to how to make and use the claimed invention was available in the prior art as a whole, not just in the item of primary prior art concerned.

316. In response to a comment by the Delegation of Pakistan as to whether item (ii) covered the case of traditional knowledge, the International Bureau confirmed that it did and explained that traditional knowledge was not different from the other expressions of prior art.

317. The Representative of the EPO noted that the terminology “make and use” in item (ii) was not consistent with the term “to be carried out” in draft Article 10(1).

318. The Chair summarized the discussions on paragraph (1) as follows: 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).

Paragraph (2)

319. The Delegation of the United States of America stated that, in its view, this provision and the corresponding Practice Guidelines were confusing as to their intent. The Delegation was of the opinion that a strict interpretation of novelty should be applied based on the matter actually disclosed: equivalents within the general knowledge of a person skilled in the art should only be considered in connection with obviousness. The Delegation was also of the view that the scope of the prior art should be determined by what was disclosed on the claim date instead of the date on which the primary item of prior art was made available to the public.

320. The Representative of the EPO was also of the view that this provision was not clear and suggested that the second sentence be deleted and that the words “taking into account the common general knowledge of a person skilled in the art at that date” be added to the first sentence.

321. The Chair observed that, under this suggestion, the primary item of prior art and the common general knowledge of a person skilled in the art would both be assessed on the date on which the primary item of prior art was made available to the public.

322. The Chair summarized the discussions on paragraph (2) as follows: There was some discussion as to 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 text to be submitted to the next session should contain two alternatives reflecting these different approaches.

Paragraph (3)

323. There was general support for this provision.

Draft Rule 15: Items of Prior Art Under Article 12(3)

Paragraph (1)

324. There was general support for this provision.

Paragraph (2)

325. The Delegation of the Russian Federation suggested that the meaning of the term “explicitly or implicitly disclosed” in paragraph (2) should be clarified, for example, in paragraph 113 of the Practice Guidelines.

326. The Delegation of the United States of America, supported by the Representative of the EPO, suggested that the term “implicitly” be replaced by “inherently” for consistency with the terminology used in draft Rule 14(2).

327. The Delegation of Argentina stated that the Spanish text was not in conformity with the English text and suggested that the term “*a partir de*” should be changed to “*en*.” In addition, the Delegation suggested that the words “or from the priority date recognized for the claimed invention” should be added after the term “claim date.” It also suggested that similar amendments be made in paragraphs (3) and (4).

328. The Chair summarized the discussions on paragraph (2) as follows: 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.

Paragraph (3)

329. There was general support for this provision.

Paragraph (4)

330. The Representative of the EPO stated that it did not support this provision as presently worded, particularly with regard to the term “motivated.” It suggested that the provision be amended to read as follows:

“A [claimed] invention as a whole shall be considered obvious under Article 12(3), if a person skilled in the art, having regard to the prior art and the general knowledge, would have arrived at the [claimed] invention by substituting, combining or modifying one or more items of prior art.”

331. The Representative also expressed concern that the Practice Guidelines as currently worded might be interpreted so as to preclude an Office from using the “problem/solution” approach to examination and suggested, in order to preserve this option, adding the following sentence to paragraph 142, item (v), of the Practice Guidelines:

“This may be done through establishing the objective technical problem to be solved and whether the solution brought by the claimed invention would have been obvious to the person skilled in the art.”

332. The Delegation of the United States of America stated that it needed further time to consider paragraph (4), but was of the view that the motivation of a person skilled in the art was an important concept that should be taken into account. It also needed more time to consider the amendment to paragraph 142, item (v), of the Practice Guidelines suggested by the Representative of the EPO; however, it had an initial concern as to how the concept of “establishing the objective technical problem to be solved” would work in practice.

333. The Delegation of the Philippines queried whether the effect of the reference to draft Article 12(3) was to limit the prior art that could be considered under paragraph (4) to that defined in draft Article 8(1), and thus did include the prior art effect of earlier applications under draft Article 8(2).

334. The International Bureau explained that this was because, as draft Article 8(2) was presently drafted, the prior art effect under that Article was restricted to novelty.

335. The Delegation of the United States of America noted that this matter would need to be considered if draft Article 8(2) were to be amended to include inventive step.

336. The Delegation of the United Kingdom stated that, with respect to paragraph 142 of the Practice Guidelines, it supported the text of item (v) as presented in document SCP/8/4 since it was consistent and not overly restrictive. Although the Delegation appreciated the importance of the “problem-solution” approach to determining inventive step, this was only one of the methodologies that an Office might adopt in any particular case. Also with respect to paragraph 142, the Delegation suggested that reference be made in item (i) to the “scope of the claimed invention” and in item (ii) to “the disclosure of the relevant item of prior art.”

337. The Chair summarized the discussions on paragraph (4) as follows: One delegation made a drafting proposal for amending this provision, so as not to use 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 proposed

text should 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.

Draft Rule 16: Exceptions Under Article 12(5)

338. It was agreed in discussions of Article 12(1) and (5) that substantive discussion on draft Rule 16 be postponed. In the meantime, the text of this provision, as well as its footnotes, would be retained.

Draft Article 13: Grounds for Refusal of a Claimed Invention

339. Discussion on this provision was postponed as agreed by the Committee at its sixth session.

Draft Article 14: Grounds for Invalidation or Revocation of a Claim or a Patent

340. Discussion on this provision was postponed as agreed by the Committee at its sixth session.

Draft Article 15: Review

341. There was general support for this provision.

Draft Article 16: Evidence

342. There was general support for this provision.

WORKING GROUP ON MULTIPLE INVENTION DISCLOSURES AND COMPLEX APPLICATIONS

343. The second session of the Working Group on Multiple Disclosures and Complex Applications (“Working Group”) was held during the morning of November 26, 2002. The discussion was based on document SCP/WGM/2/1. The Working Group also had regard to the provisions contained in documents SCP/8/2 and 3.

344. The Chairman reported to the SCP on the work accomplished by the Working Group as follows:

“The Working Group discussed the four following issues:

Special Procedures to Treat Complex Applications, such as Mega-Applications or Large Sequence Listings

Although the treatment of complex applications raised operational concerns, discussions revealed that those Offices receiving such complex applications were effectively dealing with them by way of a strict application of existing rules.

Several delegations stated that a separate set of rules should not be created to cope with problems relating to new technologies, such as biotechnology. The primary issue of concern was to ensure the transparency on the search and examination process before the Offices. No delegation spoke in favor of including any provisions relating to complex applications in the SPLT. There was general agreement that the issue could be dealt with in other fora, such as among the Trilateral Offices or in the relevant PCT bodies.

Number of Claims/Clear and Concise Claims

There was a general understanding that the issue of limiting the number of claims closely related to other requirements such as clarity and conciseness of claims and unity of invention. As to the requirement that the number of claims should be reasonable in consideration of the nature of the invention claimed, the difficulty of assessing what would be a “reasonable” number was mentioned. Several user groups spoke against limiting the number of claims, and were in favor of other types of solutions, for example, a sliding fee mechanism. User groups, in particular, stated that a large number of claims was often included in a single application in view of the effective enforcement of patents and litigation after grant. Since the draft SPLT focused on the harmonization of requirements concerning the grant and validity of patents, matters which could be further discussed in the context of the draft SPLT should be reviewed by the SCP, as a number of different reasons motivated the filing of a large number of claims.

Linking of Claims

A number of delegations stated that they allowed the dependency of multiple dependent claims on other multiple dependent claims without any difficulty. User groups did not share the argument put forward by those delegations that were against such practice, according to which it increased the complexity in understanding the scope of the claims, in particular by third parties. The discussion also raised the question as to what was the objective of examination in the process of granting a patent in terms of the degree of certainty to achieve.

Unity of Invention

Two delegations explained the problems derived from the unity of invention requirement under Rule 6 of the Regulations under the draft SPLT. As pointed out by one delegation, some of the issues relating to unity of invention were relating to more fundamental issues of claim drafting. Therefore, further agreement on the related requirements concerning claims would facilitate a future review of Rule 6 of the Regulations under the draft SPLT.”

345. In response to the question by the Chair as to whether the Working Group should carry on with its work, the Delegations of Germany and the United States of America expressed support for the continuation of that work.

CONCLUSION OF THE MEETING

Agenda Item 7: Future Work

346. The Committee invited the International Bureau to prepare revised proposals, taking into account the discussion at the present session, for consideration at the next session.

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

Agenda item 8: Summary by the Chair

348. The draft Summary by the Chair (document SCP/8/8 Prov.) was adopted with certain amendments which will be included in the final version (document SCP/8/8).

Agenda Item 9: Closing of the Session

349. The Chair closed the session.

350. The SCP unanimously adopted this report, during its ninth session, on May 12, 2003.

[Annex follows]

ANNEXE/ANNEX

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Action internationale pour les ressources génétiques (GRAIN)/Genetic Resources Action International (GRAIN): Peter EINARSSON (Consultant, Sweden) <peter@einarsson.net>

Association allemande pour la propriété industrielle et le droit d'auteur (GRUR)/German Association for Industrial Property and Copyright Law (GRUR): Alfons SCHÄFERS (Attorney-at-Law (Rechtsanwalt), Bonn) <alfons.schaefers@t-online.de>

American Bar Association (ABA): Q. Todd DICKINSON (Chair, Special Committee on Patent Harmonization, Howrey, Simon, Arnold and White, Washington, D.C.) <dickinsont@howrey.com>

American Intellectual Property Law Association (AIPLA): Charles E. VAN HORN (Chairman, Harmonization Committee, Finnegan, Henderson, Farabow, Garrett and Dunner, Washington, D.C.) <charles.vanhorn@finnegan.com>

Association asiatique d'experts juridiques en brevets (APAA)/Asian Patent Attorneys Association (APAA): Takaaki KIMURA (Senior Partner/Patent Attorney, Sugiyama and Kimura, Tokyo); Kazuya SENDA (Patent Attorney, Kisaragi Associates, Tokyo) <senda@kisaragi.gr.jp>

Association de propriété intellectuelle du Pacifique (PIPA)/Pacific Intellectual Property Association (PIPA): Masayoshi URAYAMA (Second Governor of PIPA; General Manager, Nippon Ericsson K.K., Tokyo) <masayoshi.urayama@nrj.ericsson.se>

Association internationale pour la protection de la propriété intellectuelle (AIPPI)/International Association for the Protection of Intellectual Property (AIPPI): Alain GALLOCHAT (président, Commission Q170 SPLT, Paris) <alain.gallochat@wanadoo.fr>

Association japonaise des conseils en brevets (JPAA)/Japan Patent Attorneys Association (JPAA): Ichiro KUDO (Member, Patent Committee, Tokyo); Takuji YAMADA (Patent Attorney, Tokyo) <yamada@aoyamapat.gr.jp>

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Chambre fédérale des conseils en brevets (FCPA), Allemagne/Federal Chamber of Patent Attorneys (FCPA), Germany: Jost LEMPERT (Patent and Utility Committee, Karlsruhe) <lempert@lichti-patent.de>

Chartered Institute of Patent Agents (CIPA): John D. BROWN (President, London) <president@cipa.org.uk>

Committee of National Institutes of Patent Attorneys (CNIPA): Jost LEMPERT (Karlsruhe) <lempert@lichti-patent.de>; John D. BROWN (Delegate, London) <jbrown@forresters.co.uk>

Fédération internationale des conseils en propriété industrielle (FICPI)/International Federation of Industrial Property Attorneys (FICPI): Ivan AHLERT (Member, Group 3, Study and Work Commission, Brazil) <ahlert@dannemann.com.br>; Julian CRUMP (Partner, FJ Cleveland, London) <julian.crump@fjcleveland.co.uk>

Institut de la propriété intellectuelle du Canada (IPIC)/Intellectual Property Institute of Canada (IPIC): William R. EDGAR (Past President, Ontario) <wredgar@ridoutmaybee.com>; John BOCHNOVIC (Chair, Patent Law Harmonization Committee, Ontario) <jbochnovic@smart-biggarr.ca>

Institut des mandataires agréés près l'Office européen des brevets (EPI)/Institute of Professional Representatives before the European Patent Office (EPI): John D. BROWN (Secretary, Harmonization Committee, Munich) <jbrown@forresters.co.uk>; Klas NORIN (Member, Stockholm) <klas.norin@infineon.com>

Intellectual Property Brazilian Association (ABPI): Ivan AHLERT (Member, Rio de Janeiro) <ahlert@dannemann.com.br>

Intellectual Property Owners Association (IPO), U.S.A.: Herbert C. WAMSLEY (Executive Director, Washington, D.C.) <herb@ipo.org>; Lawrence T. WELCH (Delegate, Indianapolis) <ltw@lilly.com>

Japan Intellectual Property Association (JIPA): Takashi NAGAI (Patent Attorney, Senior Staff, Intellectual Property Department, Mitsubishi Gas Chemical Company, Inc., Tokyo) <takashi-nagai@mgc.co.jp>; Hideki KOBAYASHI (Intellectual Property Center, Teijin Limited, Tokyo) <hi.kobayashi@teijin.co.jp>

Max Planck Institute for Intellectual Property, Competition and Tax Law (MPI): Michael SCHNEIDER (Scientific Researcher, Munich) <m.schneider@intellecprop.mpg.de>

Médecins sans frontières (MSF): Christopher GARRISON (Legal Advisor, London) <christopher_garrison@london.msf.org>; Pascale BOULET (Ms.)(Legal Adviser, Geneva) <pascale.boulet@msf.org>; James LOVE (Advisor, Geneva) <james.love@cptech.org>

South Centre: Sisule Fredrick MUSUNGU (Geneva) <sisule@southcentre.org>

Trade Marks, Patents and Designs Federation (TMPDF): John D. BROWN (Delegate, London) <admin@tmpdf.org.uk>

Union des praticiens européens en propriété industrielle (UPEPI)/Union of European Practitioners in Industrial Property (UEPIP): François POCHART (Patent Commission, Chair, Cabinet Hirsch, Paris) <fp@cabinet-hirsch.com>

IV. BUREAU/OFFICERS

Président/Chairman: Dave HERALD (Australie/Australia)

Vice-présidents/Vice-Chairmen: YIN Xintian (Chine/China)
Natalya SUKHANOVA (Ms.)(Bélarus/Belarus)

Secrétaire/Secretary: Philippe BAECHTOLD (OMPI/WIPO)

V. BUREAU INTERNATIONAL DE L'ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/
INTERNATIONAL BUREAU OF THE
WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, sous-directeur général/Assistant Director General

Département des politiques en matière de brevets/Patent Policy Department:

Philip THOMAS, directeur/Director

Philippe BAECHTOLD, chef, Section du droit des brevets/Head, Patent Law Section

Tomoko MIYAMOTO (Mme/Mrs.), juriste principale, Section du droit des brevets/Senior
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Yolande COECKELBERGS (Mme/Mrs.), administratrice principale de programme, Section
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Leslie LEWIS, Consultant

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