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## **STANDING COMMITTEE ON THE LAW OF PATENTS**

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DRAFT SUBSTANTIVE PATENT LAW TREATY

*prepared by the International Bureau*

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## INTRODUCTION

1. The present document contains a revised version of the draft Substantive Patent Law Treaty (SPLT). It takes into account the views expressed in the Standing Committee on the Law of Patents at its eighth session (November 25 to 29, 2002).

2. Differences between the former text of the draft SPLT contained in document SCP/8/2 and the revised text contained in the present document, except where an existing provision or paragraph as a whole has been moved from another provision or paragraph, have been highlighted as follows:

(i) words which did not appear in document SCP/8/2 but appear in the present text are underlined, and

(ii) words which appeared in document SCP/8/2 but which are omitted from the present document are shown as struck through.

3. It should be noted that certain of the suggested provisions (for example, draft Article 8(2)) reflect a first-to-file system. This approach does, however, neither prejudice the future drafting of the SPLT, nor the discussion by the Committee on the inclusion of additional issues into the Treaty.

4. Draft Regulations under the draft SPLT are contained in document SCP/9/3. Draft Practice Guidelines under the draft SPLT are contained in document SCP/9/4. In addition, document SCP/9/5 contains a study regarding the “industrial applicability” and the “utility” requirements. Further, document SCP/9/6 contains a study concerning the status of the Practice Guidelines.

*Article 1*

*Abbreviated Expressions*

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

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

(ii) “application” means an application for the grant of a patent, as referred to in Article 3-; where the term “application” refers to an application which serves as a basis for claiming priority, that term shall mean an application for any title protecting an invention under the applicable law;

*[COMMENT: Where the term “application” refers to an application on which the right of priority is based, such as the “earliest application” in Article 1(ix)(a) and the “previous application” in Article 8(2)(b), that term shall be construed as referring to an application for patents, utility models or any other title protecting an invention under the applicable law.]*

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

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

~~(v) “earlier application filed with effect in a Contracting Party” means:~~

~~(a) — where the Contracting Party is a State, a national application for a patent for invention or for a patent of addition filed with or for the Office of the Contracting Party, a regional application for a patent for invention or for a patent of addition filed with or for the Office of a regional patent organization in which patent protection in the Contracting Party is sought, or an international application, for a patent for invention or for a patent of addition, under the Patent Cooperation Treaty, [which designates the Contracting Party][the processing or examination of which has started in the Contracting Party under Article 23 or 40 of that Treaty];~~

~~(b) — where the Contracting Party is a regional patent organization, a regional application for a patent for invention or for a patent of addition filed with or for the Office of the Contracting Party or an international application, for a patent for invention or for a patent of addition, under the Patent Cooperation Treaty, [which designates the Contracting Party][the processing or examination of which has started in the Contracting Party under Article 23 or 40 of that Treaty];~~

[COMMENT: The substance of former item (v) has been moved to Article 8(2)(c).]

(vi) “patent” means a patent as referred to in Article 3;

[Article 1, continued]

(vii) “claimed invention” means the subject matter of a claim for which protection is sought; where multiple priorities or partial priority are claimed in accordance with the applicable law, each alternative of the claimed invention in respect of which such multiple priorities or partial priority are claimed shall be considered to be a separate claimed invention;

*[COMMENT: The second part of this item clarifies that, if a claim contains several alternatives which enjoy the benefits of different priority dates, each alternative should be considered separately. The term “priority date of a claimed invention” is defined in item (ix).]*

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

~~(ixviii)~~ (ix) “patentee” means the person whom the records of the Office show as the owner of the patent;

(ix) ~~“claim date”~~ “priority date of for a claimed invention” in an application means, subject to item (xi); ~~the filing date of the application or,~~

(a) where priority is claimed in accordance with the applicable law, [the filing date of the earliest application whose priority is claimed and which contains discloses the claimed invention or, if none of the applications whose priority is claimed discloses the claimed invention, the filing date of the application concerned; where a claim defines its subject matter in the alternative, [the claim date for the claimed invention in respect of each alternative shall be the claim date to which that alternative is entitled] [each alternative shall

~~be considered to be a separate claimed invention for the purposes of determining the claim date]~~

(b) where no priority is claimed in accordance with the applicable law, the filing date of the application.

*[COMMENT: Instead of the term “claim date”, the words “priority date of a claimed invention” are used throughout the draft Treaty. These words avoid the use of the term “claim date” and are more precise than the terms “filing date, or where applicable, priority date.” The structure of the provision is inspired by PCT Article 2(xi). See also the proposal by the Delegation of Australia of January 31, 2003 on the SCP Electronic Forum.]*

~~(xi) “claim date” for a claimed invention in a divisional, continuation or continuation-in-part application shall be the filing date of the parent application. Where the benefit of the filing date of the parent application which is preserved for the claimed invention in accordance with the applicable law, “priority date of a claimed invention” in a divisional, continuation or continuation-in-part application shall be the date that would have been the priority date of the claimed invention in the parent application or, where that parent application claims priority in accordance with the applicable law, the filing date of the earliest application whose priority is claimed and which contains the claimed invention contained in the divisional, continuation or continuation-in-part application;~~

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

[Article 1(x), continued]

[*COMMENT: A “person skilled in the art” is defined in draft Rule 2. What constitutes the “general knowledge of a person skilled in the art” is elaborated in the Practice Guidelines.*]

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

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

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

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

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

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



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

(xiii~~x~~) “Organization” means the World Intellectual Property Organization;

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

(xx~~ii~~) “Director General” means the Director General of the Organization.

Article 2<sup>1</sup>

*General Principles and Exceptions*

(1) [*Requirements Relating to Infringement*] Subject to Articles 9(5) and 11(4), nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to apply any requirements in relation to infringement.

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

[(2) [*Exceptions*] Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to take any action it deems necessary for the preservation of essential security interests or to comply with international obligations, including those relating to the protection of genetic resources, biological diversities, traditional knowledge and the environment.]<sup>1</sup>

[(3) [*Public Interest Exceptions*] Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to protect public health, nutrition and the environment or to take any action it deems necessary to promote the public interest in sectors of vital importance to its socio-economic, scientific and technological development.]<sup>1</sup>

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<sup>1</sup> See paragraph 4 of the Introduction and document SCP/8/5. The SCP agreed at its eighth session to include this paragraph in square brackets, but to postpone substantive discussions on this provision.

*Article 3*

*Applications and Patents to Which the Treaty Applies*

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

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

(ii) to regional applications for patents for invention and for patents of addition which are filed with or for the Office of a ~~the~~ regional patent organization ~~that~~ which is a that Contracting Party;

(iii) to international applications, for patents for invention and for patents of addition, under the Patent Cooperation Treaty, the processing or examination of which has started before the Office of that Contracting Party in its capacity as a designated Office under Article 23 or 40 of that Treaty;

[*COMMENT: These changes are proposed in order to avoid the references to specific Article numbers of the PCT.*]

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

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

*Article 4*

*Right to [a][the] Patent*

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

(i) to the inventor; or

(ii) to the successor in title of the inventor.

*[COMMENT: As regards the proposal made by the Delegation of the United Kingdom at the eighth session of the SCP relating to the assignment of the rights to future inventions, the SCP may wish to further explore the necessity of such a provision. Even if an assignment contract is concluded before the invention is made, as is often the case, one could consider that the effects of such a contract would apply from the date on which the invention is made, and would result in the right to the patent passing immediately from the inventor to the other party of the contract. In that case, item (ii) would seem to be sufficient.]*

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

*[COMMENT: The term "employee" shall be understood in a broad sense, and may in particular be interpreted as covering types of work relationships which are not based on written labor contracts or do not imply a hierarchical relationship, for example researchers in universities.]*

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

*[COMMENT: The expression “equal and undivided right to the patent” means that each inventor has a right to the whole invention. This right is not divided into fractions among the inventors and can only be enjoyed commonly, that is, the single inventors may, for instance, not sell or license the (or parts of the) invention without agreement of all the other inventors. However, each inventor would be entitled to use the invention or to perform administrative acts in order to maintain the right, such as the payment of annual fees.]*

(4) *[Inventions Made Independently by more than One Inventor]*

*[Reserved]*

*[COMMENT: This paragraph is currently reserved since it relates to the first-to-file/first-to-invent issue.]*

*Article 5*

*Application*

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

(i) a request;

(ii) a description;

(iii) one or more claims;

(iv) one or more drawings, [where they are necessary for the understanding of the claimed invention][where they are referred to in the description or claims]; and

[*COMMENT: The expression “drawings, where they are necessary” in the first bracketed text is to be understood as meaning only those drawings without which the invention would not be sufficiently disclosed.*]

(v) an abstract.

(2) [*Requirements Concerning Parts of Application*] (a) Except where otherwise provided for by this Treaty and the Regulations or the Patent Law Treaty, no Contracting Party shall require compliance with any requirement relating to the request, description, claims, drawings or abstract of an application different from or additional to the requirements relating to the request, description, claims, drawings or abstract which are provided for under the Patent Cooperation Treaty in respect of international applications.

(b) A Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants and patentees, are more favorable than the requirements referred to in subparagraph (a) in so far as they relate to the form or contents of an application.

(3) [*Abstract*] [Subject to Article 7(5), ]The abstract referred to in paragraph (1)(v) shall merely serve the purpose of information and shall not be taken into account for the purpose of interpreting the scope of the protection sought or of determining the sufficiency of the disclosure and the patentability of the claimed invention.

*Article 6<sup>2</sup>*

*Unity of Invention*

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

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<sup>2</sup> The text of this Article is subject to the outcome of the Working Group on Multiple Invention Disclosures and Complex Applications.



Article 7

*Observations, Amendments or Corrections of Application*

(1) [*Opportunity to Make Observations, Amendments or Corrections in Case of Intended Rejection or Refusal*] (a) Wherever the Office intends to reject or refuse an application on the grounds that the application does not comply with any requirement under Article 13(1)<sup>3</sup>, it shall give the applicant at least one opportunity to make observations on the intended rejection or refusal, and to make amendments and corrections of the application, within the time limit prescribed in the Regulations.

[*COMMENT: The words “amendments and corrections” are clarified in the Practice Guidelines.*]

(b) No Contracting Party shall be obliged to apply subparagraph (a), ~~in respect of where the intended rejection or refusal of a divisional, continuation or continuation-in-part application is based on the non-compliance with any requirement under Article 13(1)<sup>3</sup> any error or defect in divisional, continuation or continuation-in-part applications, where in respect of which~~ the opportunity provided for in that subparagraph was already given in ~~respect of~~ relation to the same error or defect contained in the parent application.

(2) [*Amendments or Corrections on Applicant’s Initiative*] ~~(a)~~ The applicant shall have the right, on his own initiative, to amend or correct the ~~application~~ description, the claims, the abstract and any drawings or to comply with a requirement under Article 13(1)<sup>3</sup> at least up to the time when the application is in order for grant; however, any Contracting Party

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<sup>3</sup> See the footnote under Article 13.

[Article 7(2), continued]

which provides for substantive examination by its Office or through another Office may provide that, except for the correction of a clear mistake under paragraph (3)(b), the applicant shall have the right to amend or correct, on his own initiative, the description, the claims, the abstract and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

~~(b) — A Contracting Party shall be free to provide for time limits which, from the viewpoint of applicants, are more favorable than the time limits referred to in subparagraph (a).~~

*[COMMENT: Former subparagraph (b) is no longer necessary in view of the insertion of the words “at least” in paragraph (2). Since, in general, the SPLT does not regulate time limits, a general provision allowing a Contracting Party to provide longer time limits does not appear to be necessary at this stage.]*

(3) *[Limitation of Amendments or Corrections]* ~~(a)~~ AmNo amendment or correction of the description, the claims, ~~the abstract~~ and any drawings, other than the correction of a clear mistake as prescribed in the Regulations, may shall be permitted, provided that where the amendment or correction would ~~not~~ result in the disclosure in the amended or corrected application going beyond the disclosure in the description, the claims and any drawing on the filing date, or, included, in accordance with the Patent Law Treaty, ~~included~~ in a missing part of the description or a missing drawing.

~~(b) — Notwithstanding subparagraph (a), the correction of a clear mistake shall be permitted. A mistake shall be considered clear only where what is corrected would have been clearly wrong, and the correction would have been clear, to a person skilled in the art on the filing date.~~

[COMMENT: The substance of the second sentence of former subparagraph (b) has been moved to Rule 7(2).]

(4) [Abstracts Prepared by the Office] A Contracting Party may provide that, where the Office is responsible for the preparation of the final contents of the published abstract, paragraph (2) shall not apply to amendments or corrections of the abstract.

[COMMENT: This provision provides that, where the Office of a Contracting Party is responsible for the final preparation of the abstract, the Contracting Party is not obliged to apply paragraph (2) to the abstract.]

[(5) [Abstracts Prepared by the Applicant] A Contracting Party [may][shall] provide that, where the applicant is responsible for the preparation of the abstract, amendments or corrections referred to in paragraph (3) shall be allowed taking account of the disclosure in the abstract on the filing date.]

[COMMENT: Following the discussion at the eighth session of the SCP, this provision is included in square brackets for further consideration by the Committee. This provision provides that, where the applicant prepared the abstract, the disclosure in the abstract on the filing date [may][shall] be taken into account when amending or correcting the description, the claims and any drawings under paragraph (3).]

Article 7bis

*Changes in Amendments or Corrections of Patents*

(1) [*Limitation of Extent of Protection*] ~~(a)~~ At the request of the patentee, the competent Office shall, upon request by the patentee, make, under the conditions provided under the applicable law, changes amendments or corrections in the patent in order to limit the extent of the protection conferred by it.

~~(b) Notwithstanding subparagraph (a), the competent Office may refuse a request where the purpose of the limitation is to take into consideration an item of prior art of which the patentee was aware at a time when he could still amend or correct the application.~~

[*COMMENT: The revised text establishes the right of the patentee to request the limitation of patents before the Office, i.e., the Office shall provide a possibility for such an amendment or correction of patents before the Office; such a procedure would facilitate the resolution of disputes over potential infringement and revocation of patents. In view of the various post-grant systems under existing national/regional laws, however, further details concerning the conditions and time limits that apply to such amendments or corrections are left to the applicable law.*]

(42) [*Changes Amendments or Corrections Affecting the Disclosure*] No change amendment or correction in a patent may shall be permitted under paragraph (1) ~~or (3)~~ where the change amendment or correction would result in the disclosure contained in the patent going beyond the disclosure contained in the description, the claims and any drawings on the filing date, or included, in accordance with the Patent Law Treaty, ~~included~~ in a missing part of the description or a missing drawing.

~~(3) [Additional Changes That May be Allowed] A Contracting Party may provide that the patentee shall have the right to request the competent Office to make changes in the patent in order to correct mistakes other than those referred to in paragraph (2), provided that, where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two years from the grant of the patent and the change shall not affect the rights of any third party which has relied on the patent as published.~~

[COMMENT: Since the draft Treaty does not cover applications for re-issue (see Rule 3), this provision is no longer necessary.]

~~(23) [Clear Mistakes] The patentee shall have the right to request the competent Office shall, at the request of the patentee, to make changes in the patent in order to correct, in the patent, clear mistakes referred to in Article 7(3)(b).~~

Article 8

Prior Art

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

[*COMMENT: The reference to paragraph (2) is proposed to be deleted, since Article 12(3) refers to prior art under Article 8(1) (which should not include prior art under Article 8(2)).*]

(2) [*Prior Art Effect of Earlier Applications*] (a) ~~If the filing date of an earlier application filed with effect in a Contracting Party is earlier than the claim date of a particular claimed invention contained in another application filed with effect in the same Contracting Party, the whole contents of the~~ earlier application shall also form part of the prior art for the purpose of determining the novelty of the claimed invention disclosed in another application filed with effect in the same Contracting Party, if the filing date of the earlier application is prior to the priority date of the claimed invention, provided that, to the extent that the earlier application or the patent granted thereon is published subsequently by the competent authority, as prescribed in the Regulations.

(b) If the filing date of an earlier application filed with effect in a Contracting Party is the same as, or later than, the ~~claim date of~~ priority date of a particular claimed invention ~~contained~~ disclosed in another application filed with effect in the same Contracting Party, but the earlier application claims the priority of a previous application having a filing date that is earlier than the ~~claim date of~~ priority date of the claimed invention, subject matter that is contained in both that earlier application and the previous application shall form part of

the prior art for the purpose of determining the novelty of the claimed invention, ~~to the extent~~ provided that the earlier application or the patent granted thereon is published subsequently by the competent authority, as prescribed in the Regulations.

(c) For the purpose of this provision, “earlier application” means:

[Alternative A]

(i) where the Contracting Party is a State, an application pursuant to Article 3(1)(i) to (iii) filed with effect in that Contracting Party;

(ii) where the Contracting Party is a regional patent organization, an application pursuant to Article 3(1)(ii) that has been filed with or for the Office of that regional patent organization, or an application pursuant to Article 3(1)(iii) for the grant of a regional patent by that regional patent organization.

[End of Alternative A]

[Alternative B]

(i) where the Contracting Party is a State, an application pursuant to Article 3(1)(i) and (ii) filed with or for that Contracting Party, or an international application, for a patent for invention or for a patent of addition, under the Patent Cooperation Treaty, which designates the Contracting Party;

[Article 8(2), continued]

(ii) where the Contracting Party is a regional patent organization, an application pursuant to Article 3(1)(ii) that has been filed with or for the Office of that regional patent organization, or an international application, for a patent for invention or for a patent of addition, under the Patent Cooperation Treaty, which designates the Contracting Party.

[End of Alternative B]

*[COMMENT: According to Alternative A, earlier international applications under the PCT have prior art effect under Article 8(2) only where those international applications enter into the national phase of a Contracting Party concerned. Alternative B provides that earlier international applications under the PCT which designate the Contracting Party concerned are part of prior art under Article 8(2).]*



*Article 9*

*Information Not Affecting Patentability (Grace Period)*

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

(i) by the inventor,

(ii) by an Office and the information was contained

(a) in another application filed by the inventor [and should not have been made available to the public by the Office], or

(b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor,

or

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

[Article 9(1), continued]

*[COMMENT: Alternative texts with a different scope are presented within square brackets. One possibility would be a grace period with a broad scope: 12 months from the claim date and it is applicable to any previous applications which was filed by the inventor and which was disclosed during the grace period by the Office. Another possibility would be, as regards the disclosure of information in another application filed by the inventor, to limit the applicability of the grace period provisions to those applications which should not have been disclosed by the Office. One other possibility would be to limit the period to 6 months.]*

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

*[COMMENT: In connection with invoking the grace period, the SCP may wish to explore further details.]*

(3) *[Evidence]* [Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving, or of making the conclusion likely, that the conditions of that paragraph are fulfilled.] [A Contracting Party may require that evidence be filed with the Office by the party invoking the effects of paragraph (1), where that Office reasonably doubts the applicability of that paragraph.]

*[COMMENT: The second alternative text is intended to focus on the procedures before the Office.]*

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

(5) [*Third Party Rights*] A person who in good faith had, between the date on which the information was made available to the public under paragraph (1) and the claim date, used the invention for the purpose of his business or started effective and serious preparations for such use shall have the right to start or continue to use the invention for that purpose. The invention shall be considered to be used where the person performed any acts that would otherwise constitute an infringement under the applicable law.

*[COMMENT: Although this provision relates to the rights conferred by patents and the infringement of such rights, in accordance with the interventions of a number of delegations at the seventh session, it is kept in the draft SPLT. If the SCP agrees to the inclusion of such a provision, draft Article 2(1) may need to expressly exclude draft Article 9(5) from the non-applicability of the SPLT to infringement. The second sentence is intended to clarify what constitute a use of the invention under this paragraph.]*

*Article 10*

*Enabling Disclosure*

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

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

Article 11

Claims

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

[*COMMENT: The added words have been moved from former draft Rule 5(2).*]

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

(3) [*Relationship of Claims to the Disclosure*] The claimed invention shall be fully supported by the disclosure of the [claims], description and drawings, as prescribed in the Regulations.

[*COMMENT: Following the discussion at the eighth session of the SCP, the word “claims” is added, in square brackets, for further consideration by the Committee. The insertion of the word “claims” would mean that the basis of the subject matter of every claim may not always be found in the description and that the scope of the claims may be broader than that of the description. Further, since many offices that do not examine novelty and inventive step examine the disclosure requirement and the requirements concerning claims, subject matter which is disclosed only in the claims could be included in the description through an amendment. On the other hand, it should be noted that, according to draft Article 10, the “application” (not the “description”) shall disclose the claimed invention in an enabling manner. If the word “claims” was deleted and draft Rule 12(2) maintained, a patented claim may be revoked on the sole grounds that the teaching in the description and the drawings is not extended to the entire scope of that claim (even if the teaching in the description, drawings and other claims show that the applicant does not claim subject matter which he had not recognized and described on the filing date).*]

[Article 11, continued]

(4) [*Interpretation of Claims*] (a) The scope of the claims shall be determined by their wording. ~~Where the wording of the claims is not immediately [clear][evident],~~ ~~the~~ description and the drawings, as amended or corrected under the applicable law, and the general knowledge of a person skilled in the art on the filing date shall, in accordance with the Regulations, be taken into account for the interpretation of the claims.

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

*Article 12*

*Conditions of Patentability*

(1) [*Subject Matter Eligible for Protection*]<sup>4</sup> (a) A claimed invention shall fall within the scope of subject matter eligible for protection. Subject matter eligible for protection shall include products and processes [, in all fields of technology,] which can be made and used in any field of activity.

(b) Notwithstanding subparagraph (a), the following shall not be considered as subject matter eligible for protection:

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

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

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<sup>4</sup> The SCP agreed at its eighth session to postpone the discussion on paragraph (1).

[Article 12, continued]

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

(4) [*Industrial Applicability/Utility*] A claimed invention shall be industrially applicable (useful). It shall be considered industrially applicable (useful) if it

[Alternative A]

can be made or used for exploitation in any field of [commercial] [economic] activity.

[Alternative B]

can be made or used in any kind of industry. “Industry” shall be understood in its broadest sense, ~~and shall not be limited to industry and commerce proper, but include agricultural and extractive industries as in~~ the Paris Convention.

[Alternative C]

has a specific, substantial and credible utility.

[COMMENT: Alternative A intends to provide a single definition accommodating both “industrial applicability” and “utility”, although a Contracting Party may use either term under the applicable law. Alternative B is modeled after Article 33(4) of the PCT. Reference is made to document SCP/9/5.]



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

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<sup>5</sup> The SCP agreed at its eighth session to postpone the discussion on paragraph (5).

*Article 13<sup>6</sup>*

*Grounds for Refusal of a Claimed Invention*

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

(i) the applicant does not have the right to the patent referred to in Article 4;

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

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

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

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<sup>6</sup> The SCP agreed at its sixth session to postpone the discussion on this Article until a consensus regarding the substance of the provisions referred to in this Article is reached. ~~See also paragraph 4 of the Introduction and document SCP/8/5.~~

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

[(2) [*Compliance With Applicable Law on Other Matters*] A Contracting Party may also require compliance with the applicable law on public health, nutrition, ethics in scientific research, environment, access to genetic resources, protection of traditional knowledge and other areas of public interest in sectors of vital importance for their social, economic and technological development.]<sup>7</sup>

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<sup>7</sup> The SCP agreed at its eighth session to include this paragraph in square brackets, but to postpone substantive discussion on this provision.

*Article 14*<sup>8</sup>

*Grounds for Invalidation or Revocation of a Claim or a Patent*

(1) [*Grounds for Invalidation or Revocation of a Claim or a Patent*] Subject to the Patent Law Treaty, non-compliance with any of the requirements referred to in Article 13(1), except those referred to in Article 6 and the Regulations under Article 5(2)(a), shall be a ground for the invalidation or revocation of the patented claim or patent.

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

[(2) [*Compliance With Applicable Law on Other Matters*] A Contracting Party may also require compliance with the applicable law on public health, nutrition, ethics in scientific research, environment, access to genetic resources, protection of traditional knowledge and other areas of public interest in sectors of vital importance for their social, economic and technological development.]<sup>9</sup>

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<sup>8</sup> The SCP agreed at its sixth session to postpone the discussion on this Article until a consensus regarding the substance of the provisions referred to in this Article is reached. ~~See also paragraph 4 of the Introduction and document SCP/8/5.~~

<sup>9</sup> The SCP agreed at its eighth session to include this paragraph in square brackets, but to postpone substantive discussion on this provision.

*Article 15*

*Review*

The rejection or refusal of an application by the examining authority on the grounds referred to in Article 13(1)<sup>10</sup> shall be subject to review by a judicial or quasi-judicial authority.

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<sup>10</sup> See the footnote regarding Article 13.

*Article 16*

*Evidence*

(1) [*Request for Submission of Evidence by the Office*] Where an Office reasonably doubts the veracity of an alleged fact relating to the determination of patentability, it may request the submission of evidence in order to establish the veracity of that fact.

(2) [*Right of Applicants and Patentees to Submit Evidence*] A Contracting Party shall provide for the right of applicants and patentees to submit evidence with its Office in order to establish the veracity of an alleged fact relating to the determination of patentability.

[End of document]