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STANDING COMMITTEE ON THE LAW OF PATENTS

Ninth Session
Geneva, May 12 to 16, 2003

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

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

Agenda Item 2: Adoption of the Draft Agenda

2. The draft agenda (document SCP/9/1) was adopted as proposed.

Agenda Item 3: Adoption of the Draft Report of the Eighth Session

3. The draft report of the eighth session (document SCP/8/9 Prov.2) was adopted as proposed.

Agenda Item 4: Draft Substantive Patent Law Treaty and Draft Regulations Under the Substantive Patent Law Treaty

4. The SCP discussed draft provisions on substantive patent law harmonization, based on the Draft Substantive Patent Law Treaty (SPLT) (document SCP/9/2) and Draft Regulations under the Substantive Patent Law Treaty (document SCP/9/3), referring, where appropriate, to

the Practice Guidelines under the Substantive Patent Law Treaty (document SCP/9/4), “Industrial Applicability” and “Utility” Requirements: Commonalities and Differences (document SCP/9/5) and Status of the Practice Guidelines under the draft Substantive Patent Law Treaty: Options for Discussion (document SCP/9/6).

5. The SCP discussed the draft articles, together with the corresponding draft rules and draft practice guidelines. The SCP agreed that provisions, the texts of which appeared to be acceptable, would be considered provisionally accepted and placed in a frame in the next draft, subject to the clear understanding that such provisions could be revisited at any time, on request of any delegation, and to the inclusion in accepted texts, where appropriate, of alternatives in square brackets reserved for further consideration. It invited the International Bureau to redraft the provisions based on the discussions held during the present session, and to submit revised provisions for the next session of the SCP.

6. The SCP held a first discussion on the status of the Practice Guidelines based on document SCP/9/6. All intervening delegations believed that the Practice Guidelines should not have a legally binding character. In particular, they should not form the basis for applicants or third parties to challenge any decisions by Offices or the courts. However, many delegations expressed the view that the guidelines should constitute guidance for examiners in the Offices in order to achieve a certain degree of uniformity. Some delegations stated that Offices should express some commitment to compliance with the Practice Guidelines. Some other delegations expressed the view that the status and effects of the Guidelines should be discussed once agreement on the SPLT itself had been reached. It was therefore agreed that the SCP would deal with the exact status of the Practice Guidelines at a later stage.

7. A brief summary of the discussions on the draft Articles and Rules follows:

Matters Relating to Article 1

Article 1(ii)

8. Concerning the second sentence, a concern was raised as to whether applications for design patents and plant patents were covered by this provision, since those applications could serve as a basis for claiming priority on the one hand, but were not, strictly speaking, “applications for any title protecting an invention.” Some delegations pointed out that the provision should be in line with the Paris Convention.

Article 1(vi) and (ix)

9. Discussions mainly focused on three issues: (i) alternatives in a claim; (ii) validity of priority claims; and (iii) multiple priorities and partial priority. The Delegations of Canada and Argentina made drafting proposals with respect to item (vi) (Paper No. 1) and the Representative of the EPO submitted a drafting proposal concerning item (ix) (Paper No. 2).

Article 1(x)

10. The Delegation of the United States of America submitted a drafting proposal regarding the possibility for an applicant to specify any parent applications for the purpose of determining the priority date of a claimed invention (Paper No. 3).

Matters Relating to Article 3

Article 3(1)

11. The Committee provisionally accepted the text as proposed by the International Bureau with the replacement of the words “a Contracting Party” in item (iv) by the words “the Contracting Party.”

Article 3(2) and Rule 3

12. As regards Article 3(2), several delegations raised concerns as to exceptions being dealt with in the Regulations. Concerning Rule 3, there was some debate about the inclusion of “second tier protection” and about the meaning of the term “reissue patent.”

Matters Relating to Article 4

Article 4(1)

13. The Committee provisionally accepted the text as proposed by the International Bureau with the deletion of the word “[the]” and the deletion of the square brackets surrounding the word “a.” The same changes were also made in the title of Article 4.

Article 4(2)

14. The Committee provisionally accepted the text as proposed by the International Bureau with the deletion of the words “of the inventor” in the last line, and the replacement of the words “the patent” by “a patent” in the third line.

Article 4(3)

15. The SCP agreed that this provision should be deleted. The Practice Guidelines would clarify that matters concerning the entitlement to the right by joint inventors were left to the national laws.

Matters Relating to Article 5

Article 5(1) and (2)

16. As regards Article 5(1), two main issues were addressed. The first concerned the exhaustive or non-exhaustive nature of the list under paragraph (1). The second related to whether additional elements not listed in paragraph (1) should be expressly addressed or whether such additional elements were already incorporated within the current list.

17. Concerning Article 5(2), many delegations stated that this provision was an essential part of having a harmonizing treaty. There was strong support, however, for the deletion of Article 5(2). Some delegations emphasized the importance of the phrase “except where otherwise provided for by this Treaty and the Regulations,” and noted that these important issues should be explicitly addressed in the text. In order to find a solution that would ensure that, on the one hand, the specific issues of concern would be addressed and, on the other hand, the harmonizing effect of Article 5(2) would be safeguarded, delegations who thought the list of elements in Article 5(1) should be expanded were invited to submit proposals

consistent with the continuing presence of Article 5(2) to the SCP electronic forum for discussion at the next session. The Chair concluded that Article 5(2) would be surrounded by square brackets in the next draft.

Rule 2

18. Although a small number of delegations expressed a clear preference for placing the provision either in the Treaty or in the Regulations, a large number of delegations did not have a strong preference concerning the location of the provision. Although a substantial majority of delegations supported the text as proposed by the International Bureau, a number of delegations expressed concerns about the draft. It was agreed that the delegations who had concerns would submit alternative drafting proposals to the SCP electronic forum for discussion at the next session.

Rule 4

19. The Chair concluded that this Rule, except paragraph (1)(iv), could be considered provisionally accepted, subject to the following:

Paragraph (1)(i)

The term “technical” should be kept within square brackets, pending the discussion on this issue in conjunction with Article 12.

Paragraph (1)(ii)

The term “preferably” should be maintained.

Paragraph (1)(iii)

The term “preferably” should be maintained.

Paragraph (1)(iv)

Concerning this rule, there was a divergence of opinion as to whether a requirement relating to the disclosure of the geographical origin of genetic resources should be included. A majority of delegations opposed that proposal, while a number of delegations supported it. The Chair concluded that this issue would be better addressed by way of proposal for a further subparagraph within Rule 4(1) and invited interested delegations to submit proposals for such a new provision to the SCP electronic forum prior to the next session of the SCP.

Paragraph (1)(vi)

In relation to the “best mode” requirement, the two following alternatives would be included in square brackets after the words “set forth” in the first line: [a mode][the best mode known to the applicant at the time of filing].

Rule 5(1)

20. One delegation suggested that the provision be amended so as to ensure that the numbering of the claims would start with “1” and that a Contracting Party could require applicants to use a particular kind of numerals.

Rule 5(2)

21. It was concluded that the term “technical” should be inserted within square brackets in relation to the term “features” throughout the provision. The Chair suggested that the use of the term “[technical]” throughout the Treaty and the Regulations should best be addressed in connection with a discussion of Article 12(1), following which consequential changes throughout the text would be considered. Concerning the question as to whether claims should be drafted in two parts or in a single part, while a few delegations expressed a preference for leaving the option to Offices, the majority of delegations favored leaving the option to the applicant.

Rule 5(3)

22. The Committee provisionally accepted the text as proposed.

Rule 5(4)

23. A number of delegations supported the inclusion of a new provision specifying that a dependent claim should only refer to a preceding claim or claims. Views differed as to whether an Office should be allowed to renumber the claims or whether this should be the responsibility of the applicant. The second issue discussed under this provision reflected the existing differences in respect of the possibility of multiple dependent claims depending on multiple dependent claims.

Article 5(3)

24. In view of the divergent views expressed, it was agreed that the words “[Subject to Article 7(5)]” would remain in the text for further discussion.

Matters Relating to Article 6 and Rule 6

25. The Delegation of the United States of America noted that its Office would conduct a study regarding its restriction practice, and suggested that the discussion of unity of invention be postponed. No further discussion was held on these provisions.

Matters Relating to Articles 7 and 7bis

Article 7(1)

26. The discussion focussed on subparagraph (b). While no delegation of a State raised objections to the inclusion of this provision, some non-governmental organizations expressed concern about the fact that applicants would not be given another opportunity to make amendments or corrections. A further question was raised as to whether this provision should apply to the applicant in respect of the divisional, continuation or continuation-in-part application or only to the applicant in respect of the parent application. One delegation

further inquired about the link between the expressions “error or defect” and “requirements under Article 13(1).” The Chair concluded that subparagraph (a) could be provisionally accepted, while subparagraph (b) required further thought in respect of the above-mentioned issues.

Rule 7(1)

27. The Committee provisionally accepted the text as proposed.

Rule 7(2)

28. In view of the ongoing review of PCT Rule 91.1 by the Working Group on Reform of the PCT, which would meet during the following week, the Committee agreed to defer the discussion pending the outcome of that review.

Article 7(2)

29. A number of delegations supported the retention of a distinction between “amendments” and “corrections” and suggested that the terms should be clarified, either in the Articles or in the Rules. In view of the division of opinion as to whether the abstract should be covered by this provision, it was agreed to retain that term within square brackets. It was further concluded that the words “Subject to paragraph (4)” should be inserted at the beginning within square brackets.

Article 7(3)

30. The SCP agreed to the following modifications: (i) insert the words “Subject to paragraph (5)” at the beginning of the paragraph; (ii) delete the words “, other than the correction of a clear mistake as prescribed in the Regulations, may” and re-insert the word “shall” after the deleted words. It was also agreed that the International Bureau would review the draft with respect to the reference to a missing part of the description or a missing drawing under the Patent Law Treaty (PLT). In view of the division of views as to whether the abstract should also be governed by the rule prohibiting the inclusion of new matter, the SCP agreed that the word “abstract” should be included within square brackets in the second line for further discussion.

Article 7(4)

31. The Chair noted that this provision was inherently linked to Article 7(2). The applicability of this provision to cases in the national phase where the abstract had been prepared by an International Searching Authority under the PCT needed further consideration.

Article 7(5)

32. While a number of delegations opposed the inclusion of this provision, the majority of delegations agreed to its inclusion, subject to the following modifications: the words “, where the applicant is responsible for the preparation of the abstract,” in the second line should be deleted; the words “be allowed taking account of” in the third line should be replaced by the words “shall take into account”; and the words “where the abstract was submitted by the applicant” should be included after the word “abstract” in the fourth line.

Article 7bis

33. Although a number of delegations believed that this Article should be deleted, a number of other delegations considered that it would have the effect of providing a post-grant limitation procedure in all Contracting Parties. The International Bureau noted that paragraphs (2) and (3) should be brought into line with Article 7(3) when redrafting these provisions.

Matters Relating to Article 8

Article 8(1)

34. A number of delegations supported the inclusion of a loss of rights provision in the context of secret commercial use. A majority of delegations, however, opposed this proposal. One delegation suggested dealing with the issue on an optional basis in the framework of Article 13. The Chair concluded that the provision could be provisionally accepted, subject to the inclusion, in the next draft of the Treaty, of new draft text within square brackets addressing the issue of secret commercial use, in the context either of Article 8 or of Articles 13 and 14.

Rule 8(1)

35. The SCP provisionally accepted the text as proposed.

Rule 8(2)

36. Based on paragraphs 76 and 77 of the Practice Guidelines, the International Bureau was requested to further elaborate what would be a “reasonable possibility” in the Regulations. The Chair invited delegations to submit written proposals to the electronic forum to assist the International Bureau. The use of the term “obligation” should be reviewed in order to cover circumstances outside strictly contractual relations.

Rule 8(3)

37. In light of the divergent views, it was agreed that, in the last line, the word “[first]” should be inserted before the word “last,” which should also be surrounded by square brackets. The discussion should be reflected in the next draft of the Practice Guidelines in order to assist the delegations in clearly recognizing the issues at stake. A proposal by one delegation concerning the inclusion of a general provision according to which Offices would, when considering an application, resolve any doubt in favor of the applicant received very limited support.

Article 8(2)(a) and (b)

38. Some delegations proposed combining subparagraphs (a) and (b), while some other delegations wished to maintain the present structure to clearly express the concepts involved. One delegation expressed the view that the prior art effect of earlier applications should apply to both novelty and inventive step. There was some discussion on the possible introduction of a provision on the publication of applications after 18 months, either in the framework of this provision or as a separate provision in the draft Treaty. This concept was supported by some delegations and opposed by some others. It was concluded that the International Bureau

would reflect upon the need for such a provision. It was further decided that the International Bureau would reconsider the use of the term “earlier applications,” since this expression as used in the draft text also covered applications the filing date of which was later than the filing date of the application under consideration.

Article 8(2)(c)

39. One delegation suggested that the reference to Article 3(1)(i) to (iii) in this provision did not cover all the cases envisaged. The Delegation of the United States of America noted that the issue of the Hilmer doctrine was still under consideration in its country. With respect to the term “filed with effect in” in item (i), one delegation suggested that either the term “filed with or for” be used for consistency or this term be defined. As regards the alternative texts presented in the draft, a majority of delegations supported Alternative A, while a smaller number of delegations spoke in favor of Alternative B. Taking into account the long standing issue under the PCT concerning the effect of international applications in the context of Article 8(2), the SCP decided that both alternatives should remain in the next draft.

Rule 9(1)

40. The SCP provisionally accepted the text as proposed.

Rule 9(2)

41. While the majority of delegations expressed preference for the second alternative in square brackets, there was some support for the first alternative as well. One delegation proposed retention of the first alternative, but deleting the words “and should not have been published under the applicable law.” A proposal to include, in the second alternative, the words “or considered withdrawn” did not receive support. The SCP further agreed to refer expressly to Article 8(2) in the last line.

Rule 9(3)

42. While a number of delegations considered this provision to be a very important one, other delegations either opposed or felt no need for it. One delegation pointed out that this paragraph would need to be revisited in light of the outcome of the consideration of the grace period provision. As regards the options presented at the previous session, one delegation wished to reinsert the deleted option. It was agreed that this provision should be placed within square brackets in view of the division of views about its purpose. The reference to paragraphs (1) to (3) should be corrected to refer to paragraphs (1) and (2).

Matters Relating to Article 9

43. The Delegation of Greece, speaking on behalf of the European Community and its Member States, stated that the introduction of a grace period provision in the SPLT could be beneficial to the users of the patent system, provided that it was introduced in the framework of a general first-to-file system. Such a grace period should, in particular, constitute only a safety net, be limited to six months prior to the priority date, and be claimed by the applicant, unless the applicant was not, and could not, be aware of the disclosure. In addition, third party rights should not be affected. Two delegations expressed concern about the introduction of a grace period in principle, but expressed willingness to accept a solution in the framework of an international consensus. All the other delegations supported the introduction of a grace

period, but opinions were split among delegations as to whether the duration of the grace period should be six or twelve months, on whether the provision on third party rights should be mandatory or optional, and on whether the grace period should have to be claimed by the applicant. Doubts were further raised as to the appropriateness of paragraph (3), since it was a provision relating to evidence. The SCP decided that the International Bureau would include alternatives in the next draft.

Matters Relating to Article 10

Article 10(1)

44. As regards the relationship between the term “claimed invention” in the first line and the term “invention” in the second and fourth lines, many delegations stated that the latter term should refer to the claimed invention. One delegation proposed that the words “in the granting country” be added after the words “person skilled in the art” in the first sentence. While some delegations reserved their position, a majority of delegations opposed that proposal which, according to their view, would run counter to international harmonization.

Article 10(2)

45. There was a debate about whether the words “on the filing date” and the words “as amended and corrected under the applicable law” should be deleted or not. There was agreement, however, that, for the purpose of complying with the enabling disclosure requirement, an applicant could not rely on matter going beyond the disclosure on the filing date.

Agenda Item 5: Future work

46. The International Bureau informed the SCP that its tenth session was tentatively scheduled to be held during the first half of 2004, in Geneva.

47. The SCP noted that the present document was a summary established under the responsibility of the Chair and that the official record would be contained in the report of the session. The report would reflect all the relevant interventions made during the meeting, and would be adopted in accordance with the procedure agreed by the SCP at its fourth session (see document SCP/4/6, paragraph 11), which provided for the members of the SCP to comment on the draft report made available on the SCP Electronic Forum. The Committee would then be invited to adopt the draft report, including the comments received, at its following session.

48. The SCP noted the contents of this summary by the Chair.

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