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STANDING COMMITTEE ON THE LAW OF PATENTS

First Session

Geneva, June 15 to 19, 1998

REVISED DRAFT REPORT

prepared by the International Bureau

INTRODUCTION*

1. The Standing Committee on the Law of Patents (hereinafter referred to as “the Standing Committee”) held its first session, first part, in Geneva from June 15 to 19, 1998.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Andorra, Argentina, Australia, Austria, Bangladesh, Barbados, Belgium, Brazil, Burundi, Canada, Chile, China, Costa Rica, Côte d’Ivoire, Croatia, Cuba, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, Finland, France, Georgia, Germany, Ghana, Greece, Guatemala, Hungary, India, Indonesia, Iran (Islamic Republic of), Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kenya, Kyrgyzstan, Latvia, Lesotho, Lithuania, Luxembourg, Madagascar, Malaysia, Mali, Malta, Mexico, Mauritius, Morocco, Netherlands, Nigeria, Norway, Panama, Philippines, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Senegal, Slovakia, Slovenia, South Africa, Spain, Sudan, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, United Kingdom, United States of America, Ukraine, Venezuela and Viet Nam (76).

* **Differences between the text of the provisional draft report (document SCP/1/7 Prov.1) and the revised draft report contained in the present document have been highlighted in bold font. The frame in the margin shows the source of the changes.**

3. Representatives of the World Trade Organization (WTO), the European Communities (EC), the European Patent Office (EPO), the African Regional Industrial Property Organization (ARIPO) and the Organization of African Unity (OAU) took part in the meeting in an observer capacity.

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Asociación de Agentes Españoles autorizados ante Organizaciones Internacionales de Propiedad Industrial e Intelectual (AGESORPI), Asian Patent Attorneys Association (APAA), Brazilian Association of Intellectual Property (ABPI), Brazilian Association of Industrial Property Agents (ABAPI), Chartered Institute of Patent Agents (CIPA), Committee of National Institutes of Patent Agents (CNIPA), Federal Chamber of Patent Attorneys (FCPA), Federation of German Industry (BDI), Institute of Professional Representatives before the European Patent Office (EPI), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Inventors' Associations (IFIA), International Federation of Industrial Property Attorneys (FICPI), International League of Competition Law (LIDC), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Korea Patent Attorneys Association (KPAA), Licensing Executives Society (LES), Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI), New York Intellectual Property Law Association, Inc. (NYIPLA), Pacific Intellectual Property Association (PIPA), Patent and Trademark Institute of Canada (PTIC), Trade Marks, Patents and Designs Federation (TMPDF), Union of European Practitioners in Industrial Property (UEPIP) and World Association for Small and Medium Enterprises (WASME) (26).

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

6. Discussions were based on the following documents prepared by the International Bureau of WIPO: "Revised Agenda" (document SCP/1/1 Rev.), "Organizational Matters and Overview of the Issues to be Considered by the Standing Committee on the Law of Patents" (document SCP/1/2), "Draft Patent Law Treaty and Draft Regulations" (document SCP/1/3), "Notes" (document SCP/1/4) and "Model International Forms" (document SCP/1/5). In this report, references to "the draft Treaty," as well as to any given "draft Article" or "Article," "draft Rule" or "Rule" or "Note" are references to the draft Treaty, to the given draft Article or Rule or to the given Note as contained in documents SCP/1/3 and SCP/1/4.

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 by Mr. Albert Tramposch, Director, Industrial Property Law Division, who welcomed the participants.

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

9. The Standing Committee unanimously elected Mr. Alan Troicuk (Canada) as Chair, and Mr. Rimvydas Naujokas (Lithuania) and Mrs. Wen Xikai (China) as Vice-Chairs. Mr. Albert Tramposch (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 3: Adoption of the Revised Agenda

10. The Revised Agenda (document SCP/1/1 Rev.) was adopted without modification, on the understanding that the Summary by the Chair (Agenda item 10) would be presented to the Standing Committee in writing.

Agenda Item 4: Rules of Procedure

11. The Standing Committee discussed organizational and procedural matters, under Part II of document SCP/1/2.

12. Concerning membership and observers, the Delegation of the United Kingdom, speaking in its capacity as the Presidency of the European Union, noted that it was content that the European Communities had been invited to the present session of the Standing Committee as an observer, but that this was without prejudice to its position with respect to other Standing Committees within WIPO. The Representative of the European Communities expressed support for this statement.

13. Concerning languages, the Delegation of Jordan observed that Arabic has been accepted as an international language by the United Nations, and proposed that the working procedures for the Standing Committee include interpretation from and into Arabic. The International Bureau pointed out that the question of language in meetings of WIPO bodies would be discussed in a global context by the Assemblies of the Member States of WIPO.

14. Concerning sessions, in particular, the preparation of the Summary by the Chair and the Report, delegations expressed the desire that a written summary be read out and discussed prior to the conclusion of the meeting, and requested information on how the comments on the draft Report provided after the conclusion of the meeting would be incorporated into the final Report, expressing a preference that the procedures be able to be modified based on experience. The International Bureau explained that the intention was that a draft Report would be distributed and comments received, then a revised draft Report incorporating those comments would be issued and would be discussed and adopted at the next meeting. Future modifications of this procedure, in particular in the context of an electronic forum, were anticipated.

15. Concerning working groups, it was suggested that it could be possible to coordinate the work of WIPO concerning Patent Cooperation Treaty (PCT) automation, PCT reform, information technology and the work of the Standing Committee on Information Technologies (SCIT), perhaps in the form of joint working groups. Concerns were expressed about financing for participation of officials from selected countries, with one possible solution being to schedule working group meetings immediately before or after regular meetings of the

Standing Committee. Some delegations stated that working group discussions should take place in all official languages, and one delegation suggested that the discussions by the working group could be accomplished in an electronic forum.

16. As invited in paragraph 11 of document SCP/1/2, the Standing Committee adopted the special rules of procedure proposed in paragraph 5 of that document, and noted the working arrangements described in paragraphs 6 to 10 of that document with the following understandings:

17. The question of languages (paragraph 7 of document SCP/1/2) would be revisited at a future meeting of the Standing Committee in the light of any decision taken by the Assemblies of the Member States of WIPO on that issue.

18. The summary of the conclusions of the Standing Committee provided by the Chair at the conclusion of each session would be in writing, and presented prior to the end of the session.

19. In the process of circulating the draft Report for comments following the sessions of the Standing Committee (paragraph 8 of document SCP/1/2), the International Bureau would, if possible, circulate the first draft within one week of the meeting, and would make arrangements for participants to have the opportunity to comment on proposed changes to the report. Until the Committee decides otherwise, the revised report would be submitted to the Standing Committee at the next meeting for adoption.

20. The question of languages and funding for participation of delegates at any future Working Group of the Standing Committee (paragraph 10 of document SCP/1/2) would follow any procedures decided by the Assemblies of the Member States of WIPO on those issues, and meetings of the Working Group would be scheduled, if possible, on dates adjoining the dates of a meeting of the Standing Committee.

GENERAL DECLARATIONS

21. The Chair then opened the floor for any delegations that wished to make a general declaration.

22. The Delegation of the United States of America stated that, pursuant to the 1998-99 Program and Budget, the purpose of the WIPO Standing Committees was to deal with clusters of interlocking issues rather than working in isolation on single issues, and that it regarded this as a critical aspect of the mandate of the Standing Committee on the Law of Patents. To that end, it felt strongly that the draft Patent Law Treaty (PLT), which, upon agreement of the former Committee of Experts, was to make maximum reference to the PCT, and which included provisions relating to electronic filing, could not go forward in isolation. Rather, the draft Treaty, PCT reform and provisions on electronic filing, including those under discussion in the SCIT, must move forward together. Concerning the draft Treaty, the Delegation stated that it had continued to gauge domestic support for this effort, and the support that it had previously reported upon remained. To that end, it was interested in pursuing a successful conclusion to the discussions on the draft PLT, leading to a Diplomatic Conference, as suggested by the International Bureau, possibly in 2000. However, the Delegation reiterated

its concerns regarding the distinction to be made between formal matters, properly under consideration, and substantive matters, which were beyond the mandate of the draft Treaty. The Delegation also expressed the view that consideration of the draft Model International Forms by the Standing Committee should be deferred to enable them to be first considered within the framework of the SCIT, PCT automation and national filing automation, and that the focus should be on information formatting, not forms. Finally, the Delegation reiterated its view that the Standing Committee should consider undertaking conclusion of the draft PLT in coordination with an effort to modernize the PCT, taking into account the manner in which evolving information technologies might be the driving, and unifying force behind the solutions that were sought.

23. The Delegation of Spain hoped to achieve a fruitful agreement which would result in a consensual text. The draft text presented for this session had been examined in detail and the Delegation agreed that its contents reflected the spirit which had prevailed at the 5th session of the Committee of Experts on the Patent Law Treaty. It wished nevertheless to recall that it had expressed a number of reservations on certain items of that text. However, in a spirit of cooperation, those reservations had been subjected to in-depth reflection and this had led to the conclusion that some of them could be withdrawn, with the exception of, in particular, those items that were in contradiction with the present fiscal legislation of the country. The country's interest for the future was to reach a consensual text which would satisfy all participants, but without prejudice to any national interest.

24. The Delegation of Japan expressed its support for the Standing Committees on the laws of patents, industrial designs, trademarks and copyright, which were approved by the Assemblies of the Member States of WIPO, to carry out discussion on priority issues. The Delegation hoped that these Committees could produce results in a timely, flexible and effective manner. With so many delegations participating in the Standing Committee from all over the world, the Delegation stated that it could surely be said that the dawn of the new WIPO had come. The Delegation stated that the draft PLT should be discussed with priority, in view of the hopes of users for harmonization of intellectual property systems on an international level in the age of economic globalization and increased information-intensiveness. It noted that standardization and simplification of procedures and systems were current keywords worldwide, not only in the intellectual property arena, but also in most fields of economic activity. The Delegation indicated that there should be strategies for genuine international harmonization of intellectual property rights. The first goal was to enact the Treaty for the standardization of patent formalities, which would be discussed by the Standing Committee, as soon as possible. The second goal was to substantially harmonize intellectual property systems, including the first-to-file system. The Delegation hoped that discussion of this issue, which had been postponed in 1994, would be resumed as soon as the draft PLT was concluded. Believing that harmonization of formalities and substantive matters could be taken as a reflection of the recent trends towards exchanges across national borders, the Delegation intended to compromise on some points to realize prompt enactment of the draft PLT as its first goal.

25. The Delegation of the Republic of Korea expressed strong support for WIPO's new administrative operations and strategic policy approach and the launch of this new Standing Committee, in particular, to monitor the impact of the Internet and consequent changes within the intellectual property environment, as well as meeting challenges in the 21st century. The Delegation was satisfied by the fact that the Standing Committee would cover not only the

draft PLT but also substantive issues, such as biotechnological inventions, disclosure of technical information on the Internet and its impact on patentability and other possible issues. It hoped for an early conclusion of the PLT and observed that, even though the draft Treaty was restricted to the harmonization of formalities, future discussions would progress to matters of substantive patent law.

26. The Delegation of India welcomed the establishment of the Standing Committee on the Law of Patents. While expressing hope for an early conclusion to this exercise, which would be of benefit to researchers, inventors and applicants, it emphasized the need for striking a balance between the interest of the users, patent offices and other stakeholders in the patent community. The Delegation also reported that India had recently initiated domestic measures to make its patent administration more user-friendly. In particular, it had planned to modernize and strengthen its Patent Office, re-engineer business practices, and rationalize and simplify patent granting procedures, including reducing the number of forms from 69 to 26, providing jurisdictional flexibility in filing of applications, rationalizing the fee structure, and introducing an advance fee deposit system.

27. The Delegation of Australia expressed appreciation for the clarity of the draft PLT, but stated that it still had some questions concerning what was covered by the Treaty and what was not. In relation to the items submitted for consideration by the Standing Committee, the Delegation noted two items which had not been mentioned at all, namely substantive law harmonization, and the necessary corollary of enforcement, in that there would be no point in having harmonized processes for granting patents if those patents were to be held invalid in one country and valid in another.

28. The Delegation of Switzerland expressed its satisfaction at the setting-up of the Standing Committee. The new structure proposed by WIPO, comprising four Standing Committees, appeared efficient and up-to-date. It added its conviction that the new structure would render work even more effective, whilst ensuring a more interdisciplinary approach to future work. On that point, the Delegation associated itself with the statement made by the Delegation of the United States of America. It stated its intention to return subsequently in more detail on individual points in the draft PLT during the discussions and referred to its position, which was well known, simply repeating that, in the interests of users, it hoped for speedy conclusion of the Treaty without dwelling on formal questions that would delay the exercise.

29. The Delegation of Germany noted that the present draft of the PLT seemed to have reached a level such that the convening of a Diplomatic Conference should be envisaged in the near future, but that it should not be forgotten that the long term aim was to harmonize substantive patent law issues. Harmonizing formality aspects was the first necessary step, but that alone would not be sufficient to keep legal standards in line with rapidly developing technologies. In addition, the Delegation observed that there were still a few provisions which could be amended in terms of user-friendliness, and to which further consideration should be given during the course of the meeting.

30. The Delegation of Cuba indicated that it hoped that the negotiations relating to the draft PLT could be concluded as soon as possible, noting that a rapid conclusion of the Treaty was also of importance to developing countries which were envisaging amendments to their legislation in view of the the Agreement on Trade-Related Aspects of Intellectual Property

Rights (the TRIPS Agreement). It was, therefore, of paramount importance, for reasons of legislative economy, that the provisions of the Treaty could be incorporated in the national legislations simultaneously with the provisions of TRIPS. The Delegation renewed Cuba's support of WIPO's harmonization efforts, as WIPO was the organization specialized in this field with appropriate competence and vast experience in this subject matter.

31. The Delegation of Lesotho offered its support to the Standing Committee and expressed its hope that fruitful discussions would lead to finalization of the draft PLT and preparations for a Diplomatic Conference. The Delegation concluded by thanking WIPO for facilitating its participation in this session of the Standing Committee on the Law of Patents.

32. The Delegation of Israel noted the great importance of concluding harmonization of patent formalities, procedure and practice as soon as was practically possible, which would ease the burden placed on patent applicants across international boundaries and bring such formalities into the technological modernity of the 21st century, while also achieving a workable and equitable balance between the users of the patent system and national offices. The Delegation associated itself with the statement of the Delegation of Australia regarding enforcement, without which a Treaty of this kind was not workable and observed, further, that consideration would have to be given to a "grey" area within which it might prove difficult to determine the distinction between procedures and substantive issues.

33. The Delegation of Canada stated that, as it had already mentioned in the past, it would continue to give its active support to the work on harmonization of laws and practice with respect to patents undertaken by the Committee of Experts and its successor, the Standing Committee on the Law of Patents. It nevertheless expressed the wish that the work should be carried out as rapidly as possible in order to reach, in the short term, a final text for the draft PLT. It further repeated certain concerns that it had already expressed on the complexity of the texts and also the wish that progress should be achieved on the questions concerning harmonization of the substantive patent law provisions. It believed that the harmonization of practice with respect to patents was a most important objective and wished to assure the Committee of its constructive participation in the work.

34. The Delegation of France noted that the task before the Standing Committee was considerable and that its program was ambitious, which it welcomed for two reasons, both on account of the new work structure and also on account of the work program. With regard to the new structure, to begin with, the decision to set up Standing Committees, that had been suggested by the Director General and approved by the Member States of WIPO, was in response to a need to deal with international industrial property law as a whole. The interdependence of law, the massive implication of the information society and the development of projects affecting intellectual property that now arose in numerous intergovernmental organizations, all those factors required an overall vision and a multidisciplinary approach to industrial property law. The Committee would doubtlessly, that was in any event the feeling of the Delegation, rise to those multiple challenges. The second reason for which the Delegation was content was the agenda item currently under discussion, the program of work awaiting the Committee. A concentrated, highly diversified and ambitious program which included, of course, to begin with, the PLT, with respect to which the Delegation noted that the first two sessions of this Standing Committee would be almost exclusively devoted to it, with the prospect of the convening of a Diplomatic Conference in the year 2000. This work program, or rather this calendar, raised one question: were four sessions of the Committee

necessary? Would it not be possible to act more rapidly in finalizing the draft to enable, as had always been desired by the Delegation of France, the Committee to devote itself to the second aspect of patent law: the harmonization of substantive issues? Such harmonization of substantive matters constituted a quite normal element in the Committee's terms of reference. The other questions submitted for examination by the Committee could also appear just as important and the Delegation welcomed the proposals made by the International Bureau in that respect. Such was the case, in particular, of issues affecting biotechnological inventions that were fundamental in France and henceforth practically unavoidable within the framework of the European Community. When the WIPO Program and Budget had been drawn up, the Delegation of France had strongly supported the entry of this extremely sensitive item on the agenda in view of the fact that the question was assuming true international dimensions in various international forums and would certainly do so next year within the Council for TRIPS of the World Trade Organization (WTO). Nor should it be forgotten, in this international context, that there were aspects—also highly sensitive—of this issue of biotechnology in the field of biodiversity. The International Bureau was proposing to consider the setting-up of a system of deposit of DNA sequence listings referred to in patent applications. The Delegation of France supported that proposal that was extremely useful for applicants and which entered into the PLT philosophy of facilitating procedures and formalities for filing patent applications. The Delegation said that it nevertheless wished that the problems of biotechnology, that it had previously mentioned, should also be the subject—where appropriate and with the agreement, of course, of the participants in this Committee—of discussions, in particular to ensure, with respect to the transfer of biological material, the indispensable link with the Protocol on Biosafety. The Delegation also supported the other points mentioned in item 5 of the agenda: central recording of changes in patents—where a certain number of items required clarification—which was again fully integrated in the ambit and philosophy of the PLT. The disclosure of technical information on the Internet and its impact on patentability would no doubt constitute a key problem in the development of electronic trade and, in that respect, it was extremely satisfactory to note that the International Bureau was actively anticipating future developments—particularly the legal implications—in the field of the Internet with respect to patents. Indeed, other intergovernmental organizations that also dealt with patents would be taking up the matter next year. To conclude, the Delegation confirmed its support for the proposals of the International Bureau as expressed in item 5 of the draft agenda and congratulated the International Bureau on the excellence of its proposals.

35. The Delegation of Austria expressed interest in the harmonization of substantive patent law and offered its support of the Standing Committee as one mechanism that could focus on clusters of interlocking patent law issues. The Delegation was convinced that the new version of the Treaty was formulated very precisely and created a balanced and necessary instrument that would harmonize the formal aspects of patent law. As to the detailed discussions, it expressed a view on the essential aim of the Treaty, namely, to achieve an international standard of procedural rules in the area of patent law especially for the benefit of applicants and would be a first step toward ensuring technical and industrial progress.

36. The Delegation of Kenya expressed its conviction that the amalgamation of the various Committees of Experts within WIPO to form Standing Committees of Member States was appropriate and desirable. The Delegation hoped that, during the first session of the Standing Committee on the Law of Patents and its subsequent sessions, the Member States would continue to aim at achieving a harmonized PLT within a reasonable time scale. It observed

that Kenya had completed the revision of its Industrial Property Act Cap. 509 of 1989. The bill which included provisions which were in line with harmonization of patent law and the TRIPS Agreement, was to be enacted soon by the Parliament of Kenya. The Delegation thanked WIPO for facilitating attendance of participants, including Kenya.

37. The Delegation of Greece observed that the Standing Committee was a very useful tool for the development and improvement of industrial property law. The Delegation expressed regret at the fact that harmonization of substantive law issues could not have been included in the Treaty, however, the present proposed simplification of formalities was a major step toward creating a more user-friendly system.

38. The Delegation of the United Kingdom noted that there had been five meetings of the Committee of Experts on the Patent Law Treaty prior to this meeting of the Standing Committee on the Law of Patents and that a great deal of progress had been made. It further observed that the discussions had been both very complex and important, and anticipated an enhanced contribution by the Standing Committee. The Delegation noted that this Committee could complement the work of the International Bureau, and could assist delegations in a quick and effective consensus towards a new treaty, stressing the utility of the Chairman's summary as a guide for the next session. The Delegation supported the observation that the system of Standing Committees across the work of WIPO could be of great use to ensure progress on common and coherent fronts with particular consideration of the work under the PCT, and the work of the SCIT. The Delegation remarked that progress made in this Committee should be seen in light of the work programs and discussions in those other areas of WIPO. The Delegation concluded by suggesting that it may be premature to proceed too far into the discussion of a particular format for the Model International Forms, but that they could be revisited in the future.

39. The Delegation of Andorra noted that the draft PLT and its Regulations focused on manual processes of paper communications with offices, and that this involved problems of transcription, slowness, cost and inefficiencies which were inherent to manual processes based on paper. It was the Delegation's view that the historical opportunity to establish harmonization on the basis of digital communication should not be lost. In the field of industrial property, Andorra had a completely automated trademark office that did not accept paper applications. Its experience over the years had shown that this was an excellent solution for countries with low resources, or for any Office requiring effective management.

40. The Delegation of China stated that it supported the aim of the draft PLT to simplify procedures and to be user-friendly, and agreed that harmonizing requirements as to form, as a first step, and then proceeding to harmonization of substantive requirements, was acceptable. Although it supported the user-friendly provisions in the draft PLT, it said that too much emphasis on user-friendliness for inventors and applicants, while neglecting the interests of third parties and efficient administration and operation of the Office, might go against the interests of users. Therefore, it proposed that the International Bureau listen very carefully to the views expressed by all parties concerned. The Delegation stated that it was most concerned about Articles 4 and 7 and that further clarification was needed, for example, as regards the provisions of intervening rights in Article 14. Noting that the draft PLT was emerging against a background of fast development of information technology, it added that the provisions relating to the rules and standards of applications in electronic forms were not

clear enough and should include more detail. Lastly, the Delegation said that it would make due efforts for the early conclusion of the draft PLT.

41. The Delegation of the Czech Republic expressed its full support for the presented list of issues to be considered by the Standing Committee and stated that work on finalization of the draft PLT was of great importance and should be completed as soon as possible. It also welcomed the issue of biotechnological inventions, whose importance had grown considerably in recent years, since further improvement in that area would be very helpful to all users of the patent system.

42. The Delegation of the Ukraine expressed its support of the harmonization of patent law, hoping that it would be possible to agree on the text of a draft Treaty for subsequent adoption at a Diplomatic Conference within the framework of the Standing Committee. It also emphasized the importance of other issues to be considered by the Committee, in particular, as regards the protection of biotechnological inventions.

43. The Delegation of Jamaica noted that its country was currently revising its intellectual property legislation to take into account the TRIPS Agreement and other international commitments into which it had entered. It expressed its hope that the draft PLT would provide a proper balance between inventors and users of patented inventions and would contribute to future technological development.

44. The Delegation of Malta associated itself with the declarations of those delegations who saw this Treaty as a first step toward the harmonization of substantive issues.

45. The Delegation of Venezuela declared its interest in an early finalization of the negotiations leading to the adoption of the draft PLT, and in harmonization with the PCT. The Delegation stated that, once the negotiations on the draft PLT were concluded, its Government would initiate consideration of those two texts in conjunction. The Delegation further considered that the TRIPS provisions should be taken into account in the negotiation of the text of the PLT, and that approval of the draft text should take place as early as possible in view of the expiration of the TRIPS transitional period in the year 2000, to avoid the overlapping of the two processes. In addition, the Delegation declared that it supported the proposal of Sudan relating to a reduction of patent application fees. Referring to the concern that had been expressed as to a possible conflict with Article 3 of the TRIPS Agreement, the Delegation was of the view that Article 4 of the TRIPS Agreement provided for an exception from the "most-favoured nation" principle, which was applicable in the framework of WIPO, and it was therefore the Delegation's wish that work could go ahead on this proposal.

46. The Delegation of Georgia stated that, while all of the issues to be considered by the Standing Committee were very topical, in view of the increasing importance of biotechnology in present day science, it particularly welcomed the consideration of the protection of biotechnological inventions, which involved a different approach from traditional inventions.

47. The Delegation of Romania fully supported the list of questions proposed for examination by the Standing Committee and expressed its satisfaction at the establishment of a Standing Committee on the Law of Patents, whose work would be highly effective. Aware of the importance of the field of patents, the Delegation expressed its hope that the PLT would lead to effective harmonization and the adoption of generally applicable rules. The

Delegation added its full support to the working documents. It further attached great importance to the matter of biotechnological inventions since Romania was on the point of acceding to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

48. The Delegation of Portugal gave its assurance that, although matters of substance were not addressed in the draft Patent Law Treaty as it would have wished, it was still willing to participate in discussions in an altogether positive spirit. It expressed its hope that, through intensive work, a common and harmonized solution could be found to facilitate the procedure for granting patents throughout the world.

49. The Delegation of Hungary supported the development of the draft PLT and consideration of biotechnological inventions, including the revision of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

50. The Representative of the European Patent Office (EPO) welcomed the establishment of the Standing Committee and looked forward to participating in its meetings.

51. The Delegation of Morocco welcomed with satisfaction the proposals for harmonization of patent formalities since such harmonization could but be beneficial to all users of the patent system. It expressed its wish that the establishment of the Standing Committee on the Law of Patents would enable the adoption of the draft PLT and its Regulations to be achieved. It considered that the disclosure of technical information on the Internet and its impact on patentability assumed great importance and, further, went along with the proposal by Sudan.

52. The Delegation of the European Community, referring to the statement made by the Delegation of France, stressed the importance it attached to discussion, within this Standing Committee, of all the issues linked to biotechnology and the need for biotechnology to remain well protected by industrial property. Those issues arose increasingly in the forefront of discussions within other international organizations and it would be unsatisfactory for WIPO to remain on the sidelines. The Delegation therefore welcomed the possibilities for discussion offered within the Standing Committee and which could only confirm the natural and traditional place of WIPO in conducting a calm reflection on matters of industrial and intellectual property. Finally, the Delegation confirmed that the Council of the European Communities would give final adoption to the Parliament and Council Directive on the legal protection of biotechnological inventions, which demonstrated that, even with respect to a complex matter and after 10 years of discussions, it was possible to reach agreement within a democratic framework.

53. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) welcomed the initiative taken by the Director General in the setting-up of Standing Committees, in the area of patents, trademarks, information technology and other areas, as he saw great advantages in being able to discuss a broad range of interrelated topics in parallel. He noted that there was a heightened willingness to improve the patent system at present, driven by concerns of cost and efficiency and fueled by the advent of new information technology. The Representative explained that his organization had adopted a resolution raising concern about the trend to bilateral agreements and urging continued discussion in the multilateral environment. In this connection, he said that the Standing Committee provided a

true multilateral forum for proper and careful discussion of these options. With respect to the draft PLT, the Representative stressed that the substantive issues previously included in the basic proposal should not be forgotten or ignored, pointing out that the discussion on other topics in the agenda would reveal that the substantive issues under the PLT were the key aspects to advance these topics. In that regard, he said that enforcement was a key issue needing harmonization in view of its direct impact on the value of patents. Lastly, the Representative noted that it was difficult for his organization to have all the relevant representatives participating in a week-long meeting and that an early development of agenda items and a schedule was needed.

54. The Representative of the Federation of German Industry (BDI) stated that, as regards the draft PLT, less than three more sessions should be necessary prior to a Diplomatic Conference, since good progress had been made in the previous sessions. He added that the harmonization of laws required delegations to go beyond their own national patent laws in order to achieve a compromise with each other and suggested that the International Bureau provide a time frame in the forthcoming meetings that could serve to accelerate the discussions.

55. The Representative of the Pacific Intellectual Property Association (PIPA) expressed support for the draft PLT. Though the harmonization of formality matters would simplify application procedures and would reduce costs for obtaining patents, he stressed the importance of harmonizing substantive matters as well and hoped that harmonization of formality matters would be completed as soon as possible and that the discussions concerning harmonization of substantive issues would be reopened.

56. The Representative of the Union of European Practitioners in Industrial Property (UEPIP) said that, though all agenda items were important, he particularly looked forward to taking part in discussions on the topic of the impact of disclosure of technical information on the Internet on patentability. In addition, he suggested that the draft PLT should also include substantive harmonization of patent laws and enforcement of patent rights. The Representative noted his appreciation that the working documents for the present meeting had been published on the Internet.

57. The Representative of the Japan Intellectual Property Association (JIPA) expressed its support for the draft PLT. He observed, in particular, that the new draft Treaty had become more user-friendly, since some stringent requirements had been deleted. The Representative further expressed the hope that the draft PLT covering formalities would be concluded at an early stage, and that discussions on substantive issues of patent law harmonization would be resumed.

58. The Representative of the Japan Patent Attorneys Association (JPAA) stated that, since the PCT provided a model for a system which would enable users to prepare applications in a single format, provisions under the PCT should be extended to the draft PLT. As regards the provisions on electronic filing, the Representative said that, according to his country's eight years' experience in filing electronic applications, such filing was effective for communications between the patent office and patent attorneys. He expressed support, in principle, for some of the provisions in the draft Treaty in view of their user-friendliness, and reiterated the importance of applying high quality throughout, in order to obtain effective and sufficient protection for inventors. In this respect, he expressed the view that, at the national

level, efficient cooperation between the patent office and qualified representatives served to encourage a high quality of applications and examination. Lastly, the Representative hoped that the draft PLT would be concluded at an early stage, and that the objective concerning substantive harmonization should not be forgotten.

59. The Representative of the Korean Patent Attorneys Association (KPAA) expressed the opinion that the draft PLT would provide substantial benefits to inventors and applicants by way of simplifying and harmonizing the provisions of national laws relating to formalities. Her organization had long seen the necessity of certain changes as proposed in the draft Treaty, such as, in particular, restoration of priority claims. She added however, that, although this Treaty was intended to provide great benefits to applicants and inventors, such as convenience and cost reduction, applicants and inventors would not agree to the simplification of procedures if their rights were compromised, undermined or damaged. In this context, the Representative expressed concern regarding the problems relating to representation by non-professionals in procedures to obtain patents.

60. The Delegation of Mali stated that it was its third participation in sessions devoted to the harmonization of patent law and that it had not yet had the opportunity to consult the representatives of the African Intellectual Property Organization (OAPI). It added that, for its part, it considered those meetings as the framework for continuing education.

GENERAL DISCUSSION (Continued)

Agenda Item 5: Issues to be considered by the Standing Committee

61. The Standing Committee then discussed the issues to be considered by that Committee, under Part III of document SCP/1/2:

Patent formalities harmonization (draft PLT)
(paragraphs 14 to 18 of document SCP/1/2)

62. The observation was made, with general support, that a number of other issues being discussed within WIPO intersect with the work on the PLT, and that there was a need for the convergence of these efforts, perhaps through an intersection of working groups, with the goal of establishing a single electronic filing solution that would be appropriate for both PCT and national office filings. One delegation expressed the position that a discussion of electronic filing requirements should not be left out of the PLT at this time.

63. The Chair concluded that this issue should be discussed with highest priority at its first meeting, and that it should be included on the agenda and discussed with highest priority at the next meeting. He also concluded that the discussions concerning the PLT should be undertaken in close coordination with discussions concerning PCT reform, electronic filing and information technology in other relevant WIPO bodies, including in particular bodies under the PCT, and the SCIT, and that a recommendation to that effect should be made to the SCIT and to the Assemblies of the Member States of WIPO.

Central recording of changes in patents and patent applications
(paragraphs 19 to 23 of document SCP/1/2)

64. Several delegations considered this work to be important, but expressed concern that more information was needed. The delegations considered that Member State participation would be essential. Several representatives of non-governmental organizations considered that the lack of substantive patent harmonization made the work more difficult.

65. The Chair concluded that further information concerning this issue would be provided to the Standing Committee before deciding whether a second Consultative Meeting should be convened, as proposed by the International Bureau in paragraph 23 of document SCP/1/2. He also concluded that this issue would be discussed at the next session, and that the question of whether a second Consultative Meeting should be convened and, if so, what its terms of reference, including the participation of Member States, should be, would be revisited at that time.

Disclosure of technical information on the Internet and its impact on patentability
(paragraphs 24 and 25 of document SCP/1/2)

66. This was considered to be an important issue, which potentially could involve broader issues in the context of the Internet. However, before broadening the issue, the delegations desired to receive additional information from the current literature concerning patents and the Internet, **especially as regards what is required for information contained on the Internet to qualify as a printed publication or another form of prior art. A representative of one non-governmental organization stated that** ~~Other~~ other forms of communication, such as television and radio, could also be considered, in the context of a grace period. ~~A~~ **Another** representative of a non-governmental organization stated that his organization had studied the problem of disclosure of technical information on the Internet, and had concluded that there might be more important issues relating to the Internet that should be addressed first.

67. The International Bureau pointed out that WIPO was in the process of clarifying its overall approach to questions of electronic commerce, and that it may be appropriate for the time being to collect information from the existing literature, pending that clarification.

68. A non-paper on ~~this issue~~ **what constitutes prior art on the Internet was distributed** by the Delegation of the United States of America ~~was distributed.~~

69. The Chair concluded that the International Bureau should collect information from the existing literature on this subject for presentation at the next session, and that this issue should be placed on the agenda for discussion at the next session, in particular with respect to whether the issue should be broadened to include related issues such as infringement of patents through use of the Internet.

Biotechnological inventions
(paragraphs 26 to 31 of document SCP/1/2)

70. There was general support for continuing the studies being undertaken by the International Bureau. Work concerning sequence listing databases should be done in coordination with other work in that same area in the context of the PCT, SCIT and trilateral

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discussions, and more information on work that had previously been done in other fora should be provided to the Standing Committee. **One delegation observed that the fifth session of the Meeting of International Authorities under the PCT was entirely devoted to matters related to sequence listings.**

Australia

71. The question of incorporation of sequence listings into a patent application through a reference to a deposit of the sequence listing was also considered to be an important aspect of this issue. One delegation offered to provide a non-paper on this issue, and a representative of a non-governmental organization stated that it would be important that any sequence listings mentioned in a patent application be accessible to the public.

72. The Chair concluded that the International Bureau would continue the studies referred to in paragraphs 29 and 30 of document SCP/1/2, and that it would bring this issue before the Standing Committee when appropriate. He also noted the desire of the Standing Committee that these studies should be coordinated with any related work of other WIPO bodies, including the SCIT and PCT bodies.

Other possible issues
(paragraph 32 of document SCP/1/2)

73. Possible additional issues for consideration by the Standing Committee that were mentioned were enforcement, substantive patent **law** issues, and reducing the costs of patenting.

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74. The Chair concluded that the Standing Committee would revert to this discussion at the next session.

Agenda Item 6: Proposal by the Delegation of Sudan presented at the fifth session of the Committee of Experts on the Patent Law Treaty

75. The Standing Committee discussed the Proposal by the Delegation of Sudan presented at the fifth session of the Committee of Experts on the Patent Law Treaty under Part IV of document SCP/1/2.

76. The proposal was fully supported by a number of delegations and representatives, some of which referred in their statements to fee reductions for independent inventors and small enterprises. Other delegations and representatives supported granting fee reductions to independent inventors and small enterprises, which would be in line with the current practice in a number of countries. Some delegations expressed the concern that the proposal would not conform to the “most-favoured-nation” requirements of the TRIPS Agreement, but one delegation stated that it believed that there was no conflict, referring to Article 5 of that Agreement. One delegation believed that the proposal would not conform to the national treatment principles of the TRIPS Agreement and the Paris Convention.

77. A proposal that this issue be included in the draft PLT was opposed for the following reasons: (i) the issue concerns financial matters, not formalities; (ii) possible conflict with the TRIPS Agreement; (iii) a reduction in fees should depend on the applicant’s ability to pay, not

on the country of nationality; and (iv) inclusion of this issue could delay finalization of the draft PLT.

78. The desire was expressed to receive more information on this issue from the International Bureau, in particular, concerning the current practice in the various countries, the relationship with the PCT, and the application of the TRIPS Agreement.

79. Several delegations stated that this issue would more properly be within the competence of the Assemblies of the Member States of WIPO.

80. The Chair concluded that this issue would properly be considered by the Assemblies of the Member States of WIPO, but that, prior to referring the issue to those Assemblies, the International Bureau would collect information on the current practices of countries and regional organizations in this area of fee reductions, that it would consult with the World Trade Organization on the TRIPS-consistency of the proposal, and that it would present that information to the next session of the Standing Committee.

Agenda Item 7: Establishment of a PLT Electronic Forum

81. The Standing Committee discussed establishment of a PLT Electronic Forum, under Part V of document SCP/1/2.

82. There was support expressed for the establishment of an Electronic Forum, along with concern that some countries faced budgetary or technological restrictions that would require a progressive introduction of electronic communications. One delegation requested the provision of basic assistance and equipment.

83. The Chair concluded that the proposal to establish an Electronic Forum as presented in paragraphs 44 to 50 of that document had been adopted, on the following understanding: (i) that the Forum would be broadened to include all of the work of the Standing Committee, and that therefore it would be referred to as the “SCP Electronic Forum”; (ii) that the Forum would be restricted for the time being to distribution of the draft report and draft working documents and receipt of comments on those documents; (iii) that the International Bureau would establish specific procedures for the Forum in consultation with other relevant committees, **such as SCIT**, and information technology experts within WIPO; (iv) that no decisions on substance would be taken; and (v) that documents would be distributed in English, French and Spanish, but that comments could be sent to the International Bureau in any of the six official WIPO languages.

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Agenda Item 8: Draft Patent Law Treaty

84. The Standing Committee discussed the documents concerning the draft Patent Law Treaty and the accompanying Regulations (documents SCP/1/3 to 5).

85. The Committee agreed that a decision would be taken at this session on the text of each provision, as to whether that provision was adopted, adopted with modifications, deleted, reserved for further discussion or referred to the International Bureau for further study.

Provisions which have been adopted, adopted with modifications or deleted would be closed for further discussions, except at the express request of a Member of the Standing Committee or to approve consequential modifications made by the International Bureau when redrafting other provisions. The revised text of provisions which were adopted with modification by the Standing Committee are contained in Annex III of the present document.

86. The Delegation of the United States of America underlined the importance of maximum conformity with the PCT **and the opportunity to effect reasonable changes to the PCT without delaying the timing of this effort.** In view of the importance of the Notes as an interpretative tool, that Delegation suggested that the Notes should be incorporated in the draft Treaty by way of a reference in Article 17. In response, the Chair noted that a proposal at the Diplomatic Conference for the Conclusion of the Trademark Law Treaty to incorporate the Notes into that Treaty had been rejected. However, a Diplomatic Conference may adopt Agreed Statements, which could serve the same purpose.

United States of America

87. It was agreed that the International Bureau would present proposals for transferring specific provisions of the draft Treaty to the draft Regulations, and that it would study the inclusion of a provision in the draft Final Clauses relating to the effect of the Treaty with respect to rights and obligations under the Paris Convention.

Draft Article 1: Abbreviated Expressions

88. One delegation suggested that the International Bureau should review the necessity of each definition in Article 1.

89. Item (i). One delegation, supported by another delegation, suggested that the words “and with all other matters pertaining to this Treaty” be inserted at the end of the sentence. It was agreed that the International Bureau should study the suggestion, taking into account that the scope of the draft Treaty included, for example, requests for recordal of changes in Office registers.

90. *Items (ii) to (v).* These items were adopted as proposed.

91. *Item (vi).* For the purpose of clarification, it was agreed that the words “and including” be inserted after the words “relating to” in line 2. This item was adopted with the modification.

92. *Item (vii).* This item was adopted as proposed.

93. *Item (viii).* In order to avoid using the term “entitled,” which has other meanings in the context of patent law, it was agreed that the phrase “another person, entitled under the applicable law, who is submitting or prosecuting the application” would be modified to “another person who, pursuant to the applicable law, is submitting or prosecuting the application.” This item was adopted with the modification.

94. *Item (ix).* In response to a suggestion by one delegation that the definition of the “owner” should include a reference to the owner of the application, the International Bureau explained that for the purposes of some national laws, it was necessary to use the term “applicant” as defined in item (viii). This item was adopted as proposed.

95. *Item (x)*. A suggestion to delete the words “firm or partnership” was not accepted, as a “firm or partnership” might not be a legal entity under some national laws. One delegation indicated that the Spanish term “empresa” always meant a legal entity. Subject to a re-examination of this term in the Spanish text, this item was adopted as proposed.
96. *Item (xi)*. A majority of the delegations and representatives who intervened on this item supported Alternative C. The International Bureau explained that, under Alternative C, the question of what constitutes the receipt of the communication and the evidence of receipt would be determined under national law. A number of delegations supported Alternative A, on the grounds that the definition should be consistent with the Paris Convention. However, it was pointed out that Alternative A was still ambiguous since the Paris Convention itself did not define, but simply referred to, the term “address for service.” It was agreed that Alternative B would be deleted, as it had no support.
97. A representative of a non-governmental organization questioned whether the term “any procedure before the Office” in Alternative C included procedures in respect of applications for compulsory licensing. In this respect, one delegation suggested that the words “any matter arising in the Treaty” could be used. One delegation, supported by another delegation, indicated that the Spanish term “domicilio” should be replaced by “dirección”.
98. Many delegations pointed out that this item should be considered in conjunction with the discussion under draft Article 7. A suggestion of the Chair to replace the term “address for service” with “address for communication” throughout the Treaty was welcomed by one delegation and one non-governmental organization. However, one delegation said that an “address for service” and an “address for communication” had different legal effects, so that perhaps both should be defined.
99. After some discussion, it was agreed that this item would be referred to the International Bureau for further study, taking into account the discussions under draft Article 7.
100. *Item (xii)*. A number of non-governmental organizations pointed out that “a language accepted by the Office” could include a language in which an application may be filed, which, under draft Article 4, would include all languages. In response, the International Bureau suggested that the words “for the relevant procedure before the Office” be added at the end of the sentence. This item was adopted with the modification, subject to reservations by the Delegations of Finland and Belgium.
101. *Item (xiii)*. This item was adopted as proposed, noting that the revised definition in item (xii) would be incorporated by reference.
102. *Item (xiv)*. In response to a suggestion by one non-governmental organization, supported by another non-governmental organization, that this definition should be limited to procedures under this Treaty, the International Bureau explained that the definition should cover all procedures before the Office in view of draft Article 7. This item was adopted as proposed.

103. *Item (xv)*. It was agreed that the words “, and masculine personal pronouns include the feminine” should be added at the end of the sentence, and that the words “for the purposes of this Treaty,” should be deleted. This item was adopted with the modification.

104. *Items (xvi) and (xvii)*. These items were adopted as proposed.

105. *Item (xviii)*. This item remained reserved for future consideration.

106. *New item*. The Delegation of the United States of America proposed the inclusion of a new item, stating that the determination of who is an inventor **or the issue of inventorship as raised in Articles 10 and 12** is a matter of national law. It was agreed that this item would be referred to the International Bureau for further study.

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Draft Rule 1: Abbreviated Expressions

107. This Rule was adopted as proposed.

Draft Article 2: Applications and Patents to Which the Treaty Applies

108. *Paragraph (1)(a)*. It was agreed that the intention was that the PLT should apply to divisional applications. This would automatically be the case under paragraph (1)(a) if proposed amendments to the PCT were adopted. If those proposals are not adopted, Article 2 would be amended to include divisional applications.

109. In response to a concern of an intergovernmental organization, it was agreed that the words “, or for,” should be added after the words “which are filed with” in line 2. This provision was adopted with the modification.

110. *Paragraph (1)(b)*. This provision was adopted with the modification, proposed by the International Bureau, that the words “for patents for invention” be added after the words “international applications” in line 2.

111. *Paragraph (2)*. This paragraph was adopted with the modification, proposed by the International Bureau, that the words “patents, resulting from the applications referred to in paragraph (1)” be modified to “patents for invention.” **One delegation The Delegation of the United States of America expressed concern about the applicability to re-issue patents, which were referred to in Note 2.04 as not being covered by the Treaty, of the provisions regulating the correction of patents under draft Article 12, and whether the Delegation would be required to accommodate, in addition to their reissue and reexamination procedures, corrections of mistakes in patents that were consistent with the constraints imposed by Article 12.**

United States of America

Draft Article 3: National Security

112. In response to a question raised by one delegation as to the necessity of this Article in a draft Treaty restricted to formal matters, the International Bureau explained that this provision was intended for the avoidance of doubt and for the preservation of national security requirements in certain countries. One delegation suggested that the word “procedures” should be used instead of the word “measures,” while another delegation supported the

original draft. The wording in Article 73 of the TRIPS Agreement was also suggested by one delegation. After some discussion, it was agreed that this Article would be referred to the International Bureau for further study.

Draft Article 4: Filing Date

United
States of
America

113. Concerning Note 4.01, the Delegation of the United States of America stated that, since **the Note indicated that** draft Article 4(1)(a) now contained both minimum and maximum requirements, **it would presumably preclude a Contracting Party from according a filing date if fewer than all items enumerated in Article 4(1)(a) were filed. That Delegation stated that it would not want to be so limited. Further, that Delegation stated that it was not appropriate to refer to an international filing date standard ~~or to the effect concerning in~~ the context of the** Paris Convention **priority**. It was agreed that the International Bureau would review this Note. **The Delegation of Portugal expressed its reservation with respect to this Article.**

Portugal

114. *Paragraph (1)(a)*. A number of delegations were still in favor of the inclusion of claims as a filing date requirement, as required by PCT Article 11(1)(iii)(e), and one delegation expressed its preference to include payment of fees. The Standing Committee agreed that **this provision it** had been well settled **that claims and fees would not be required for a filing date** after lengthy discussions at the Committee of Experts on the Patent Law Treaty.

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States of
America

115. A suggestion by one delegation that the date on which the Office had received the elements should be the date on which the applicant submitted the elements to the postal service, as allowed under draft Rule 6(2), was not supported by any other delegation. In response to a comment by one delegation that an application filed by means not permitted by the Office, such as electronic means, should still be accorded a filing date, the International Bureau observed that an Office which did not accept electronic filing might have great difficulty in processing an application which was submitted, for example, by e-mail. This provision was adopted as proposed.

116. *Paragraph (1)(b)*. The Delegation of the United States of America expressed support for this provision, noting that it was in conformity with a recently litigated case in that country in respect of a design patent. In reply to a question on whether a drawing under this subparagraph included photographs, the International Bureau observed that the determination of what constituted a drawing would be a matter for national law.

117. One delegation and one intergovernmental organization observed that it could be problematical to require every Office to recognize a priority claim based on an application which had been granted a filing date by another Office, in which the description was merely a drawing. The International Bureau observed that any filing which was equivalent to a regular national filing under the domestic legislation of any country of the Paris Union must already be recognized as giving rise to the right of priority under Article 4A(2) of the Paris Convention. Therefore, this was not a new difficulty evoked by this paragraph.

118. For purposes of clarity, the International Bureau proposed to delete the words “provide that”; and to modify the phrase “a drawing may replace the part” to “accept a drawing as the element.” This provision was adopted with the modification.

119. *Paragraph (2)(a)*. This provision was adopted as proposed.

120. *Paragraph (2)(b)*. Following the suggestion by one delegation, supported by five delegations, and three representatives of intergovernmental and non-governmental organizations, that the requirement in the second sentence was a trap for the applicant, and served no useful purpose, it was agreed that the second sentence should be deleted. This provision was adopted with the modification.

121. *Paragraph (3)(a)*. The Delegation of China reserved its position on this provision, in view of the requirement under its law that an application be re-submitted if the applicant did not comply with the filing date requirements, pointing in particular to the burden on the Office of maintaining such applications on file. A proposal by one delegation that the word “promptly” be deleted was opposed by three delegations and a representative of one non-governmental organization. A proposal to replace the word “promptly” by the word “within a reasonable time limit” was not adopted and, after some discussion, it was agreed to retain the word “promptly,” as used under the PCT.

122. A proposal by one delegation to ~~delete the~~ **modify this provision to exclude** reference to draft item (1)(a)(ii) was accepted. It was agreed that this provision would be referred to the International Bureau for further study.

United States of America; Int’l Bureau

123. *Paragraph (3)(b)*. A proposal by one delegation, supported by another delegation and one non-governmental organization, that this provision should also cover the case where a part of the description was missing was accepted. The International Bureau explained that this provision did not oblige a Contracting Party to check for missing drawings, but only applied in a case where the Office in fact found that the drawings were missing. It was agreed that this provision would be referred to the International Bureau for further study.

124. *Paragraph (4)(a)*. This provision was adopted as proposed.

125. *Paragraph (4)(b)*. One delegation suggested that Note 4.22 should be amplified to make it clear that the effect of this provision was that an application which did not comply with the requirements referred to in paragraphs (1) and (2) would not have to be re-filed if those requirements were complied with within the prescribed time limit. This provision was adopted with a drafting modification, suggested by the International Bureau, to delete the word “missing.”

126. *Paragraph (5)(a)*. In conjunction with the proposal under draft Article 4(3)(b), a proposal by one delegation, supported by several other delegations and one non-governmental organization, was accepted that this provision should also cover the case where a part of the description was missing. One delegation pointed out that the legal consequence of a missing part of the description and of missing drawings might be different. It was agreed that this provision would be referred to the International Bureau for further study in conjunction with paragraph (3).

127. *Paragraph (5)(b)*. The International Bureau explained that this provision did not oblige a Contracting Party to check whether or not the later-filed drawings contained new matter, but that it applied only when the Office had in fact made that determination. In this regard, the Chair suggested that the word “may” could be replaced by the word “shall.” This suggestion

was supported by one non-governmental organization on the grounds that there would be no reason to penalize the applicant once the Office had determined that the drawings did not contain new matter. Three delegations and one intergovernmental organization, however, supported retaining the wording “may.” Two delegations pointed out that, as the Office often determined the fact that the later-filed drawings did not contain new matter after the 18 month publication date, for example, during substantive examination, a change of the filing date or the priority date at that late stage would be problematic. A representative of one non-governmental organization, supported by one delegation, however, pointed out that a court could revoke the filing date at a much later stage in any case. The International Bureau suggested making the provision mandatory, but adding the words “before the publication of the application” after the word “where” in the first line. This suggestion was supported by one delegation.

128. One delegation explained that, under its law, a new filing date was accorded to the part which constituted new matter, while the original filing date was kept for the other part. Another delegation suggested that an applicant should be able to ask for a determination of whether there was new matter.

129. It was agreed that this provision would be referred to the International Bureau for further study in light of these observations.

130. *Paragraph (5)(c)*. It was agreed that this provision would be referred to the International Bureau for further study in conjunction with paragraph (5)(b).

131. *Paragraph (6)*. In response to a question raised by one delegation, the International Bureau explained that the time limit for an applicant to make a request was not regulated in the draft Treaty, and therefore, it was left to national law. It also clarified that the words “claims the priority of an earlier application” did not prejudice the claiming of multiple priorities accepted under the Paris Convention. Following the explanation by the International Bureau that this provision was not intended to determine the filing date, but rather to regulate what could be added in the application, one delegation suggested that the words “having been” in line 5 should be replaced by the word “being”, and the words “for the purposes of the filing date” in lines 6 and 7 should be replaced by the words “for the purposes of the allowability of amendment.” One delegation, however, supported the existing wording. In addition, one delegation suggested that the words “in determining, for the purposes of the filing date, whether that part of the description or the drawing contains new matter” should be deleted. Another delegation commented that the effect of this paragraph would be to permit inclusion of additional matter in an application, through incorporation by reference of an earlier application.

132. A representative of one non-governmental organization suggested that this paragraph should be re-examined in conjunction with paragraph (5), which covered later submission of missing drawings or a part of the description. In conclusion, it was agreed that this provision would be referred to the International Bureau for further study in light of these observations, including the possibility of combining this provision with paragraph (5).

133. *Paragraph (7)(a)*. A proposal by one delegation that this provision should be made mandatory by deleting the words “A Contracting Party may provide that” was agreed, subject to a reservation by the Delegation of Japan. Another suggestion that the words “in respect of

the same invention” should be deleted was also agreed. This provision was adopted with the modifications.

134. *Paragraph (7)(b)*. A suggestion by one delegation that the word “shall” should be replaced by the word “may” was agreed. This provision was adopted with the modification.

135. *Paragraph (8)*. In response to a question raised by one delegation, the International Bureau said that it would study the necessity of adding a provision concerning continuation and continuation-in-part applications. It was agreed that this paragraph should be retained in square brackets pending a decision on the inclusion in the PCT Regulations of a provision permitting a divisional application to be filed as an international application.

Draft Rule 2: Details Concerning Filing Date Under Article 4

136. *Paragraph (1), item (i)*. Concerning the time limit under draft Article 4(4)(b), a suggestion by one delegation that the date of the notification should be the date on which the notification was received was supported by one delegation, but was opposed by several other delegations and one intergovernmental organization. After some discussion, it was agreed that the date of a notification would be left to be determined under national law. A proposal by one delegation, supported by another delegation, that the time limit should be two months was adopted. In response to a question by one delegation, the Chair explained that the extension of time limits under draft Article 13 would be applicable to the time limit under this paragraph if it was a time limit fixed by the Office. In conclusion, this item, as it applied to draft Article 4(4)(b), was adopted with the modification of the time limit from one month to two months.

137. As regards the time limit under draft Article 4(5)(a), it was agreed that this provision would be referred to the International Bureau for further study in light of the discussions in relation to draft Article 4(5)(a).

138. *Paragraph (1), item (ii)*. Concerning the time limit under draft Article 4(4)(b), after some discussion, it was agreed that this item only applied to cases where the indications allowing the Office to contact the applicant were not sufficient, and that therefore the words “because indications allowing the applicant to be contacted by the Office have not been furnished” should be added after the words “where a notification has not been made.” The Chair pointed out that the result of this would be that, in other situations, the application would remain pending until a notification was made, or forever if no notification was made. As regards the time limit, a representative of one non-governmental organization said that the two month period was too short. Another non-governmental organization suggested that, in the case where neither the Office nor the applicant recognized that the application did not comply with the filing date requirements, a longer time period, for example, six months, should apply. This item, as it applied to draft Article 4(4)(b), was adopted with the modification.

139. As regards the time limit under draft Article 4(5)(a), it was agreed that this provision would be referred to the International Bureau for further study in light of discussions under draft Article 4(5)(a).

140. *Paragraph (2)*. It was agreed that this paragraph would be referred to the International Bureau for further study in conjunction with draft Article 4(6).

141. *Paragraph (3)(a)*. One delegation, supported by a number of delegations and non-governmental organizations, suggested that the reference to the previously filed application under draft Article 4(7)(a) needed to indicate only the Office with which the previously filed application was filed and the number of the previously filed application. Another delegation, also supported by a number of delegations, suggested that the filing date of the previously filed application was also necessary. After some discussion, the International Bureau suggested the following text:

“(a) The reference to the previously filed application under Article 4(7)(a) shall indicate the Office with which the previously filed application was filed and the number of the previously filed application. A Contracting Party may require that the reference ~~under subparagraph (a)~~ also indicate the filing date of the previously filed application.”

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The representatives of several non-governmental organizations expressed their preference for full harmonization in this respect and pointed out that an optional requirement would, in practice, have the same effect as a mandatory requirement. It was agreed that this provision would be redrafted as suggested by the International Bureau, but would be reserved for further discussion.

142. *Paragraph (3)(b) and (c)*. A suggestion to delete these provisions was adopted, subject to a reservation expressed by the Delegation of the Russian Federation.

143. *Paragraph (3)(d)*. This provision was adopted as proposed.

144. *Paragraph (3)(e)*. The International Bureau suggested a drafting change to include the words “or a certified copy” after the words “furnishing of a copy” in the first line. One delegation suggested that the term “official form” should be replaced by the term “official certified form” with a view to legal certainty for electronic filing. One delegation, however, opposed that suggestion since an international standard for an official “certified” form had not yet been established. It was agreed that this provision would be referred to the International Bureau for further study together with other similar provisions, in particular, draft Article 5(7)(c), in consultation with the relevant SCIT and PCT bodies.

Draft Article 5: Application

145. *Paragraph (1)*. A suggestion to redraft this paragraph in the positive sense, along the lines of the redraft of Article 2(1)(a) proposed by the International Bureau, was opposed by two delegations. The Delegation of the United States of America reserved its position with respect to the scope of the form or contents of an application, referring to Note 5.05 in respect of unity of invention. This paragraph was adopted as proposed.

146. *Paragraph (2)(a)*. One delegation, supported by another delegation and one intergovernmental organization, suggested that the term “format” be used instead of the term “Form,” to accommodate electronic filing. Another delegation proposed that paragraphs (2) to (4) be transferred to the Regulations in order to facilitate future amendments.

147. As regards the contents of the request of an international application under the PCT, the International Bureau observed that it envisaged the incorporation, into the request part, of certain national requirements allowed under PCT Article 27, for example, a declaration alleging inventorship.

148. A suggestion by the International Bureau that the words “or in a format” be added after the words “a request Form” was accepted, and this provision was adopted with the modification.

149. *Paragraph (2)(b)*. One delegation expressed the position that the format, rather than the layout, of the form was important in order to capture the relevant information, and suggested coordination with the SCIT regarding formatting of documentation **and use of document type definitions (DTDs)**. The International Bureau explained that Model International Form N° 1 in document SCP/1/5 had been revised to a format which would facilitate computer processing, and which largely corresponded to the PCT EASY printed form. It noted that, as a global Treaty, the Forms should work equally well for Contracting Parties which accepted electronic filing and those which accepted paper filing. It was agreed that the Standing Committee would further discuss the Model International Forms at the next meeting, and this provision was referred to the International Bureau for further study.

United States of America

150. *Paragraph (3)*. Concerning item (iii) of this paragraph, the Delegation of the United States of America, supported by the Delegation of Japan and one non-governmental organization, pointed out that a requirement requiring unanimous consent for a Contracting Party to adopt 100% electronic filing was not forward-looking. On the other hand, the Delegations of the Russian Federation, Brazil and Argentina expressed reservations, preferring that draft Rule 3(1), which obliged a Contracting Party to accept the filing of applications in paper form, should be transferred to the draft Treaty.

151. One non-governmental organization expressed concern that, in accordance with draft Article 4(1), an application filed on paper would not be able to receive a filing date if it was filed in an Office which did not accept the filing of applications on paper. The Delegation of the United States of America noted that it **disagreed. It stated that a filing date should be granted, and the applicant be required to resubmit the application in electronic form. It would revisit this provision in connection with the filing date requirement under draft Article 4(1). This subparagraph was ~~adopted as proposed, subject to the reservations expressed reserved for further discussion.~~**

United States of America

Int'l Bureau

152. *Paragraphs (4) to (10)*. Discussion of these paragraphs was deferred.

Draft Article 13: Extension of a Time Limit Fixed by the Office

153. *Paragraph (1)*. Following some discussion, during which the Chair suggested that Note 13.01 should make it clear that paragraph (1) imposed a minimum standard and that any Contracting Party could be more lenient, this paragraph was adopted as proposed.

154. *Paragraph (2)(a)*. One delegation observed that a Contracting Party should not be required to extend time limits for submission of translations to the effect that a translation could be submitted after an application was due to be published. The Delegation of the United Kingdom stated that it reserved its position on this provision pending the results of its

study as to whether there were any other maximum time limits under its law which it would wish to be included in the exception under paragraph (2)(a). Subject to this reservation, this provision was adopted as proposed.

155. *Paragraph (2)(b), new item.* A proposal by the Delegation of the United States of America that a further item (iii) should be added to paragraph (2)(b) to provide for an exception to the extension of a time limit as of right in the case of expedited or specialized procedures, appeals, interferences and oppositions was supported by one other delegation. A proposal that the new item should use the language of Article 15(2)(i) was not supported. The representative of one non-governmental organization noted that, where an applicant requested an extension of a time limit in an expedited procedure before the European Patent Office, the expedited procedure was withdrawn. Following further discussion, during which the Delegation of the United States of America indicated that it could agree to the exceptions listed in paragraph (2)(b), **including an accommodation of, e.g., expedited and specialized procedures**, being included in the Regulations, it was agreed that the proposal should be referred to the International Bureau for further study.

United
States of
America

156. *Paragraphs (3) and (4).* It was noted that paragraph (4) should refer to Article 5(5) and not Article 5(3). One delegation suggested that these provisions be moved to the Regulations. Apart from this, consideration of these paragraphs was deferred.

157. *Paragraph (5).* A proposal by one delegation that a first extension of a time limit should not be subject to a fee was supported by four other delegations and the representatives of three non-governmental organizations, but opposed by eight delegations. This paragraph was reserved for further discussion.

158. *Paragraph (6).* In response to a question by one delegation, the International Bureau explained that this provision would not amount to an additional extension of a time limit, since the grant of an extension under paragraph (1) would be automatic if the formalities are complied with. The opportunity to make observations would merely allow the requesting party to assert that those formalities, for example the payment of the fee, had in fact been complied with in a timely manner. Following this explanation, this paragraph was adopted as proposed.

Draft Rule 13: Details Concerning Extension of a Time Limit Fixed by the Office Under Article 13

159. *Paragraph (1).* This paragraph was adopted as proposed.

160. *Paragraph (2).* Consideration of this item was deferred.

Draft Article 14: Further Processing or Revival of Application

161. A suggestion to combine Articles 14 and 15 was supported by one delegation, and opposed by five delegations and the representative of one non-governmental organization.

162. *Paragraph (1)(a).* A proposal by the Delegation of the United States of America that the term “revive” in paragraph (1)(a)(ii) should be replaced by “reinstate,” with consequential amendments elsewhere in Article 14, was adopted. Another delegation observed that it may

be preferable to avoid the use of terms such as “further processing,” which were not generally understood in States which did not currently provide for the remedies under paragraph (1).

163. As regards the time limits to which Article 14 should apply, the Delegation of Switzerland proposed that paragraph (1)(a) should apply to any situation “where the applicant or owner fails to comply with a time limit,” first by removing the words “fixed by the Office,” and, second, by broadening the scope of Article 14 to cover all time limits in respect of applications and patents. The deletion of the words “fixed by the Office” was supported by the Chair, who suggested that an exception could instead be added under paragraph (2), by one other delegation and by the representatives of one intergovernmental organization and three non-governmental organizations. Retention of the words “fixed by the Office” without square brackets was supported by seven delegations. The broadening of paragraph (1)(a)(ii) to include all time limits in respect of applications and patents was supported by six delegations and the representatives of one intergovernmental organization and three non-governmental organizations, but opposed in part by the Delegation of Japan which stated that paragraph (1)(a) should be restricted to time limits in respect of applications.

164. A proposal by one delegation to delete the requirement in paragraph (1)(a) that the communication be signed was not supported by any other delegation.

165. *Paragraph (1)(b)*. The Delegation of the United States of America supported retention of this provision, which would be necessary, in particular, in a case where a time limit is missed because, for example, the communication from the Office had been lost in the mail. The delay in such a case might be long enough to warrant requiring a declaration that the missing of the time limit was unintentional. On the other hand, the Delegation stated that, if Rule 14(1) were to be limited to a very short period, for example no more than two months, there may not be a need for such a declaration. Another delegation suggested that it may be important to be able to require a statement where the failure to comply with a time limit was unintentional or the result of a mistake. However, the Delegation of Germany proposed that further processing under Article 14 should be subject only to the payment of a fee, and that any procedure which required a statement should be governed by Article 15. A further delegation questioned whether a statement was appropriate where the application had been considered abandoned upon the request of the applicant. The representative of one non-governmental organization suggested that a statement should only be required in the case of time limits not fixed by the Office, and that paragraph (1)(b) should be deleted if paragraph (1)(a) did not apply to such time limits. It was agreed that this paragraph would be referred to the International Bureau for further study

166. *Paragraph (2)*. A proposal by one delegation that paragraph (2)(b) be deleted was not supported by any other delegation. It was agreed that this paragraph would be referred to the International Bureau for further study.

167. *Paragraphs (3) to (5)*. Consideration of these paragraphs was deferred.

168. *Paragraph (6)*. In response to a question by one delegation, the International Bureau explained that it was intended that what constituted a “failure by the Office” should be a matter for national law. Further consideration of this paragraph was deferred.

169. *Paragraphs (7) and (8)*. Consideration of these paragraphs was deferred.

170. *Paragraph (9)*. In response to a comment by one delegation, the Chair observed that intervening rights would appear to constitute an exception to rights conferred within the terms of Article 30 of the TRIPS Agreement.

171. A proposal by one delegation that paragraph (9) should be deleted on the grounds that it related to substantive rights rather than formal matters was supported by two other delegations. In addition, three other delegations stated that, although they could accept the retention of at least subparagraph (a), they were not opposed to the deletion of the paragraph, thereby leaving the matter of intervening rights to be decided by national law. Two delegations were in favor of retaining subparagraph (a), and the representative of one non-governmental organization suggested that paragraph (9) struck the right balance. The Delegation of Switzerland commented that, although its national law provided for intervening rights where further processing had been allowed, no such case had ever arisen. Following a question by one delegation as to whether the users were in favor of harmonization in this matter, the representative of one non-governmental organization stated that minor mistakes resulting in non-compliance with time limits should not create intervening rights. Two delegations were in favor of retaining subparagraph (b) if subparagraph (a) were deleted, but 11 delegations and the representative of one non-governmental organization were in favor of its deletion.

172. One delegation observed that it followed from the use of the term “may” in line 1 that subparagraph (a) was discretionary, and that it would therefore permit a Contracting Party to adopt other forms of intervening rights. Another delegation stated that once an announcement that an application was withdrawn or abandoned had been published, the application should not be revived. In response to questions, the International Bureau confirmed that it was the intention that what constituted publication of the withdrawal or abandonment, and what constituted “effective and serious preparation,” would be matters for national law.

173. A proposal by one delegation for deletion of the words “and that fact had been made known to the public” was supported by the representative of one non-governmental organization but opposed by another delegation, which wished to retain the words without square brackets, and another non-governmental organization. A proposal by one delegation that the expression “the application shall not be invoked against” in subparagraph (a) should be replaced by “nothing in the application shall prejudicially affect” was not supported by any other delegation. However, one delegation suggested that the last four lines of subparagraph (a) should be revised to separate the issue of the act of invoking from the issue of the definition of the period in question.

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174. Following a suggestion by the representative of one non-governmental organization that the proposed period of three months after expiration of the time limit was too long, one delegation suggested that this period be deleted. However, two other delegations and the representative of another non-governmental organization supported its retention, it being observed that no intervening rights would then arise if the applicant acted promptly.

175. A proposal by the Delegation of Switzerland that the word “allowed” in the last line of subparagraph (a) should be changed to “requested” was not favored by the representative of one non-governmental organization. An alternative proposal by the Chair to base the expiration of the period concerned on the date on which the filing of the request for further

processing or revival was made known to the public was supported by the representatives of two non-governmental organizations. However, two delegations and the representative of another non-governmental organization were in favor of basing the expiration on the date on which the fact that further processing or revival had been allowed was made known to the public. A proposal by one delegation that an intervening right should not be transferable, except with the agreement of the user, was supported by one other delegation.

176. It was agreed that paragraph (9) would be referred to the International Bureau for further study.

Draft Rule 14: Details Concerning Further Processing or Revival of Application under Article 14

177. *Paragraph (1)*. One delegation stated that it preferred that the time limit concerned be calculated as previously proposed in document PLT/CE/V/2, rather than from a date of notification, in order to avoid the distinction between Articles 14 and 15 being lost. Another delegation commented that it was not clear what time limit would apply if no notification occurred. It was agreed that this paragraph should be referred to the International Bureau for further study.

178. *Paragraph (2)*. Consideration of this paragraph was deferred.

Draft Article 15: Restoration of Rights

179. *Paragraph (1)*. It was agreed that this paragraph would be referred to the International Bureau for further study, in conjunction with Article 14(1).

180. *Paragraph (2)*. A proposal by one delegation to delete this paragraph was supported by one other delegation and the representatives of one intergovernmental organization and three non-governmental organizations. The proposal was opposed by two delegations, which wished to retain items (i) to (v) as proposed. The Delegations of China, the United Kingdom, Sweden, Japan, Greece, France, Canada and Kenya reserved their positions on this paragraph. One other delegation suggested that it would be inconsistent to permit exceptions under Article 13 but not Article 15. Concerning the individual items proposed in paragraph (2), the following comments were made.

181. *Item (i)*. Two delegations were in favor of retaining this item.

182. *Item (ii)*. The deletion of this item was proposed by one delegation, but opposed by another delegation. Following a comment by a further delegation that the reference to the period of grace was unclear, the International Bureau stated that it would review the wording.

183. *Items (iii) and (iv)*. One delegation was in favor of retaining these items.

184. *Item (v)*. The deletion of this item was proposed by one delegation. In answer to a question by another delegation, the Delegation of Belgium, while reserving its position on the retention of this item, explained that the purpose of the item, which it had proposed, had been to ensure consistency with the European Patent Convention.

185. It was agreed that this paragraph would be referred to the International Bureau for further study.

186. *Paragraphs (3) to (8)*. Consideration of these paragraphs was deferred.

187. *Paragraph (9)*. It was agreed to refer this paragraph to the International Bureau for further study, in conjunction with Article 14(9).

Draft Rule 15: Details Concerning Restoration of Rights Under Article 15

188. *Paragraph (1)*. One delegation noted that, unlike under Rule 14, the time limit under Rule 15 would apply even if no notification took place and questioned whether this difference was justified. It was agreed that this paragraph would be referred to the International Bureau for further study.

189. *Paragraph (2)*. Consideration of this paragraph was deferred.

Draft Article 16: Addition and Restoration of Priority Claim

190. The Delegation of Switzerland expressed its support for Article 16.

191. *Paragraph (1)*. After some discussion, a proposal by one delegation that the words “signed by the applicant” be deleted was withdrawn by that delegation. Following an explanation by the Chair that, under Article 7(1)(b), a signature by a representative would have the effect of a signature by the applicant, the representative of one intergovernmental organization noted that the signature of the applicant himself may not be acceptable where mandatory representation was required under Article 7(2), and it was agreed that this latter matter should be reconsidered in the context of Article 7.

192. A proposal by one delegation that paragraph (1) be made optional by replacing “shall” by “may” in line 1 was not supported by any other delegation. The Chair noted that the proposal would have the effect of negating the provision, which was based on amendments to the Regulations under the PCT which would take effect from July 1, 1998.

193. In response to a suggestion by a delegation that paragraph (1) be broadened to include corrections of priority claims, as was the case under PCT Rule 26*bis*.1, the Chair observed that corrections were covered by other provisions in the draft Treaty, as explained in Notes 5.23 and 12.02. This paragraph was adopted as proposed.

194. *Paragraph (2)*. The Delegations of the United Kingdom and Argentina reserved their positions on paragraph (2). The Delegations of Spain and China stated that they could accept the paragraph if it were made discretionary by amending “shall” to “may” in line 4; otherwise, those Delegations reserved their positions. In response to a comment by the Delegation of Egypt that the paragraph was incompatible with the Paris Convention, the Chair explained that this matter had been discussed extensively by the Committee of Experts and that there was general agreement that there was no inconsistency. The representatives of two non-governmental organizations stated that this paragraph was very important to users.

195. Following a proposal by one delegation, supported by four other delegations and the representatives of one intergovernmental organization and two non-governmental organizations, it was agreed that the period from the expiration of the priority date should be prescribed in the Regulations as not less than two months, and that subparagraph (b) should be deleted. Consequently, ~~in the chapeau of subparagraph (a), the words “two months of the date on which the priority period expired”~~²² would be amended so that to “the time limit would be prescribed in the Regulations.”

196. In response to a question by one delegation, the International Bureau confirmed that the effect of restoration of the priority right was that protection under the right of priority would extend back to the priority date. There was no support for the suggestion of one intergovernmental organization that the references to technical preparations should be deleted from subparagraph (a)(i).

197. In response to a concern expressed by the Delegation of Brazil regarding the restoration of a priority right which would prejudice another application for the same invention which had been filed in the meantime, it was suggested by the Chair that this might be considered in the context of intervening rights under paragraph (9). Paragraph (2) was adopted with the modifications proposed, subject to the reservations noted above.

198. *Paragraph (3)*. Following some discussion, it was agreed that the term “a reasonable time limit” in line 4 of paragraph (3)(a) should be replaced by “that time limit,” so that the time limit for filing a request under this paragraph would be fixed and would be the same as that for furnishing the copy of the earlier application.

199. Following a proposal by two delegations, it was agreed that the time limit referred to in subparagraph (b)(ii) should be fixed and prescribed in the Regulations as not less than one month, so that subparagraph (b)(ii) would read:

“(ii) the copy of the earlier application referred to in subparagraph (a) be furnished to the Office within the time limit prescribed in the Regulations.”

200. It was also agreed that in subparagraph (a)(i) the term “states” should be amended to “indicates,” and that in subparagraph (b)(i) the term “statement” should be amended to “request” and the reference to “subparagraph (a)(i)” should be amended to “subparagraph (a).” One delegation noted that the amendment of the term “states” to “indicates” would not involve a change in the Spanish text. This paragraph was adopted with those modifications.

201. *Paragraphs (4) to (8)*. Consideration of these paragraphs was deferred.

202. *Paragraph (9)*. Further to its intervention on paragraph (2), the Delegation of Brazil proposed the addition of a new paragraph (9)(b) to the effect that Member States may reject the restoration of a priority right if such restoration could lead to the loss or reduction of the rights of any other applicant who has filed a patent application for, or with effect for, that Member State. Following some discussion, during which two delegations expressed support for the proposal and a further delegation expressed concern that this involved a matter of substance, it was agreed that paragraph (9) would be referred to the International Bureau for further study.

Draft Rule 16: Details concerning Addition and Restoration of Priority Claim Under Article 16

203. *Paragraph (1)*. Following some discussion, during which the Chair noted that this paragraph prescribed a minimum time limit and that a Contracting Party would be free to provide for a longer time limit subject to whatever conditions it wished, this paragraph was adopted as proposed.

204. *New paragraph (1bis)*. In accordance with the agreement reached on Article 16(2), a proposal by the Chair was adopted that a new paragraph, provisionally numbered (1bis), be added as follows:

“(1bis) [Time Limit Under Article 16(2)] The time limit referred to in Article 16(2) shall be not less than two months from the date on which the priority period expired.”

205. *Paragraph (2)*. This paragraph was adopted with one modification, namely to replace “Rule 5(1)” in the last line with “Rule 5(1)(a).”

206. *New paragraph (2bis)*. In accordance with the agreement reached on Article 16(3)(b)(ii), a proposal by the International Bureau was adopted that a new paragraph, provisionally numbered (2bis), be added as follows:

“(2bis) [Time Limit Under Article 16(3)(b)(ii)] The time limit referred to in Article 16(3)(b)(ii) shall be not less than one month from the date on which the applicant is provided with the copy referred to in that provision by the Office with which the earlier application was filed.”

207. The representative of one non-governmental organization expressed concern that a period of one month might not always be sufficient to furnish copies of earlier applications to certain Offices.

208. *Paragraph (3)*. Consideration of this paragraph was deferred.

Other Provisions

209. Discussion of all other provisions was deferred.

CONCLUSION OF THE MEETING

Agenda Item 9: Future work

210. The Standing Committee discussed its future work and decided the following:

211. The work of the first session of the Standing Committee would continue at an additional meeting, which would take place preferably in November 1998, and be restricted to discussions concerning the draft PLT.

212. The International Bureau would report to the Assemblies of the Member States of WIPO on the progress made at its first meeting, and would notify those Assemblies that the Standing Committee, in undertaking preparations for a diplomatic conference at the preparatory meeting mentioned in Sub-program 09.1 of the WIPO Program and Budget for 1998-99, expected that it would, at one of its meetings in 1999, set dates for a diplomatic conference which could be held as early as 2000.

Agenda Item 10: Summary by the Chair

213. The Chair presented a draft Summary (document SCP/1/6 Prov.), orally proposed some additions to the draft Summary concerning Articles 5 and 16, Rule 16, and the Model International Forms of the draft Patent Law Treaty, and received comments from the participants. The Summary by the Chair (document SCP/1/6) is contained in Annex II of the present document.

Agenda Item 11: Closing of the session

214. The Chair adjourned the first session of the Standing Committee, with the understanding that the session would be reconvened, tentatively, in November 1998.

[Annexes follow]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. ÉTATS MEMBRES/MEMBER STATES

(dans l'ordre alphabétique des noms français des États)
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MALI

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MALTE/MALTA

Godwin WARR, Deputy Controller, Industrial Property Office, Valletta

MAROC/MOROCCO

Nafissa BELCAID (Mme), chef du Service des brevets, Office marocain de la propriété industrielle, Casablanca

Abdellah BEN MELLOUK, premier secrétaire, Mission permanente, Genève

MAURICE/MAURITIUS

Ah Yao LAM, First Secretary, Permanent Mission, Geneva

MEXIQUE/MEXICO

Arturo HERNÁNDEZ-BASAVE, Ministro, Misión Permanente, Ginebra

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PHILIPPINES

Estrellita Beltran ABELARDO (Mrs.), Chief, Hearing Division, Intellectual Property Office, Makati City

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RÉPUBLIQUE DE MOLDOVA/REPUBLIC OF MOLDOVA

Ion DANILIUC, Deputy Director General, State Agency on Industrial Property Protection of the Republic of Moldova, Kishinev

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Viorel PORDEA, chef du Département de l'examen préliminaire, Office d'État pour les inventions et les marques, Bucarest

Valeriu ERHAN, chef du Département de l'examen des inventions et topographies, Office d'État pour les inventions et les marques, Bucarest

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SÉNÉGAL/SENEGAL

Khaly Adama NDOUR, conseiller, Mission permanente, Genève

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SLOVÉNIE/SLOVENIA

Andrej PIANO, Legal Council, Slovenian Intellectual Property Office, Ljubljana

SOUDAN/SUDAN

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SUÈDE/SWEDEN

Laila KIRPPU (Ms.), Legal Adviser, Ministry of Justice, Stockholm

Marie ERIKSSON (Ms.), Head, Legal Division, Patent Department, Swedish Patent and Registration Office, Stockholm

SUISSE/SWITZERLAND

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Olexandr PRYKHODKO, Head, Appeals Department, State Patent Office of Ukraine, Kyiv

Volodymir RADOMSKY, Deputy Head, Legislation and Patent Policy Department, State Patent Office of Ukraine, Kyiv

VENEZUELA

David VIVAS, Misión Permanente, Ginebra

VIET NAM

PHAM Phi Anh, Director, Inventions and Utility Solutions Department, National Office of Industrial Property of Vietnam, Hanoi

II. ORGANISATIONS INTERGOUVERNEMENTALES/
INTERGOVERNMENTAL ORGANIZATIONS

ORGANISATION MONDIALE DU COMMERCE (OMC)/WORLD TRADE
ORGANIZATION (WTO)

Nuno CARVALHO, Counsellor, Intellectual Property and Investment Division, Geneva

COMMUNAUTÉS EUROPÉENNES (CE)/EUROPEAN COMMUNITIES (EC)

Dominique VANDERGHEYNST, administrateur, Bruxelles

OFFICE EUROPÉEN DES BREVETS (OEB)/EUROPEAN PATENT OFFICE (EPO)

Robert CRAMER, Lawyer, Directorate Patent Law, Munich

ORGANISATION DE L'UNITÉ AFRICAINE (OUA)/ORGANIZATION OF AFRICAN UNITY (OAU)

Venant WEGE NZOMWITA, observateur permanent adjoint, Délégation permanente, Genève

Mustapha CHATTI, attaché, Délégation permanente, Genève

ORGANISATION RÉGIONALE AFRICAINE DE LA PROPRIÉTÉ INDUSTRIELLE (ARIPO)/AFRICAN REGIONAL INDUSTRIAL PROPERTY ORGANIZATION (ARIPO)

Mzondi Haviland CHIRAMBO, Director General, Harare

III. ORGANISATIONS NON GOUVERNEMENTALES/
NON-GOVERNMENTAL ORGANIZATIONS

American Intellectual Property Law Association (AIPLA): Michael K. KIRK (Executive Director, Arlington); Michael J. PANTULIANO (Chairman, Harmonization Committee, New York)

Asociación de Agentes Españoles autorizados ante Organizaciones Internacionales de Propiedad Industrial e Intelectual (AGESORPI): Enrique ARMIJO (Member of the Board, Barcelona)

Association asiatique d'experts juridiques en brevets (APAA)/Asian Patent Attorneys Association (APAA): Hideo TANAKA (Member of the Patent Committee, Tokyo)

Association brésilienne de la propriété intellectuelle (ABPI)/Brazilian Association of Intellectual Property (ABPI): Raul HEY (Designated Representative, Rio de Janeiro)

Association brésilienne des agents de propriété industrielle (ABAPI)/Brazilian Association of Industrial Property Agents (ABAPI): Raul HEY (First Vice-President, Rio de Janeiro)

Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI): Michel DE BEAUMONT (Conseil en propriété industrielle, Grenoble)

Chambre de commerce internationale (CCI)/International Chamber of Commerce (ICC): John H. KRAUS (Permanent Representative, Geneva)

Chartered Institute of Patent Agents (CIPA): John David BROWN (Member of Patents Committee, London)

Committee of National Institutes of Patent Agents (CNIPA): John David BROWN (Representative, Munich)

Federal Chamber of Patent Attorneys (FCPA): Gert SCHMITT-NILSON (Member, Committee on Patent and Utility Model Laws, Munich)

Fédération de l'industrie allemande (BDI)/Federation of German Industry (BDI): Hans-Jürgen SCHULZE-STEINEN (Observer, Königstein)

Fédération internationale des associations d'inventeurs (IFIA)/International Federation of Inventors' Associations (IFIA): Farag MOUSSA (President, Geneva)

Fédération internationale des conseils en propriété industrielle (FICPI)/International Federation of Industrial Property Attorneys (FICPI): John ORANGE (President, Toronto); Christopher EVERITT (President of the Study and Work Commission, London); Gert SCHMITT-NILSON (Special Reporter for International Patent Law, Munich)

Institut canadien des brevets et marques (PTIC)/Patent and Trademark Institute of Canada (PTIC): John ORANGE (Member of Council, Toronto)

Institut des mandataires agréés près l'Office européen des brevets (EPI)/Institute of Professional Representatives before the European Patent Office (EPI): Felix A. JENNY (Chairman, Harmonization Committee, Basel); John David BROWN (Secretary, Harmonization Committee, Munich)

Institut Max Planck de droit étranger et international en matière de brevets, de droit d'auteur et de la concurrence (MPI)/Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI): Rainer MOUFANG (Head of Department, Munich)

Japan Intellectual Property Association (JIPA): Shinya MORISADA (Vice-Chairman, Patent Committee, Tokyo)

Japan Patent Attorneys Association (JPAA): Kazuaki TAKAMI (Chairman, International Activities Committee, Tokyo); Sadaaki KAMBARA (Vice-Chairman, International Activities Committee, Tokyo); Kazuya SENDA (Vice-Chairman, Patent Committee, Tokyo); Takaaki KIMURA (Member, International Activity Committee, Tokyo)

Korea Patent Attorneys Association (KPAA): Young KIM (Mrs.) (Director, International Affairs, Seoul)

Licensing Executives Society (LES): Peter HEINRICH (Member of the board of LES Switzerland, Zurich)

Ligue internationale du droit de la concurrence (LIDC)/International League of Competition Law (LIDC): Jean-François LÉGER (membre du Groupe suisse, Genève)

New York Intellectual Property Law Association, Inc. (NYIPLA): Samson HELFGOTT (Member, Committee on Harmonization of Patent Laws, New York)

Pacific Intellectual Property Association (PIPA): Mitsuo TANIGUCHI (Second Governor, Japanese Group, Tokyo)

Trade Marks, Patents and Designs Federation (TMPDF): John David BROWN (Representative, London)

Union des praticiens européens en propriété industrielle (UPEPI)/Union of European Practitioners in Industrial Property (UEPIP): Bo-Göran WALLIN (Delegate, Patent Commission, Malmö)

World Association for Small and Medium Enterprises (WASME): Ahmed-Rifaat KHAFAGUI (Legal Adviser, National Bank for Development, Cairo); NGUYEN TIEN Quan (General Director, The Non-State Economic Development Center of Vietnam (NEDCEN), Viet Nam)

IV. BUREAU/OFFICERS

Président/Chair: Alan TROICUK (Canada)

Vice-présidents/Vice-Chairs: Rimvydas NAUJOKAS (Lituanie/Lithuania)
WEN Xikai (Mrs.) (Chine/China)

Secrétaire/Secretary: Albert TRAMPOSCH (OMPI/WIPO)

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

Division du droit de la propriété industrielle/Industrial Property Law Division:
Albert TRAMPOSCH (directeur/Director); Erika GEIGER (Ms.) (conseillère principale/
Senior Counsellor); Leslie LEWIS (consultant/Consultant); Tomoko MIYAMOTO (Mrs.)
(consultante/Consultant); Drew SCHAEFER (consultant/Consultant)

Bureau du PCT (Traité de coopération en matière de brevets)/Office of the PCT (Patent
Cooperation Treaty): Philip THOMAS (directeur de la Division juridique du PCT/Director,
PCT Legal Division); Claus MATTHES (juriste principal/Senior Legal Officer)

[End of Annex I, Annex II follows]

ANNEX II

WIPO



SCP/1/6
ORIGINAL: English
DATE June 19, 1998

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF PATENTS

First Session
Geneva, June 15 to 19, 1998

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the session

1. The session was opened by Mr. Albert Tramposch, Director, Industrial Property Law Division, who welcomed the participants.

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

2. The Standing Committee unanimously elected Mr. Alan Troicuk (Canada) as Chair, and Mr. Rimvydas Naujokas (Lithuania) and Mrs. Wen Xikai (China) as Vice-Chairs. Mr. Albert Tramposch (WIPO) acted as Secretary to the Standing Committee.

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Agenda Item 3: Adoption of the Revised Agenda

3. The Revised Agenda was adopted without modification, on the understanding that the Brief Summary by the Chair (Agenda item 10) would be presented to the Standing Committee in writing.

Agenda Item 4: Rules of Procedure

4. The Standing Committee discussed organizational and procedural matters, under Part II of document SCP/1/2.

5. As invited in paragraph 11 of document SCP/1/2, the Standing Committee adopted the special rules of procedure proposed in paragraph 5 of that document, and noted the working arrangements described in paragraphs 6 to 10 of that document with the following understandings:

6. The question of languages (paragraph 7 of document SCP/1/2) would be revisited at a future meeting of the Standing Committee in the light of any decision taken by the Assemblies of the Member States of WIPO on that issue.

7. The summary of the conclusions of the Standing Committee provided by the Chair at the conclusion of each session would be in writing, and presented prior to the end of the session.

8. In the process of circulating the draft report for comment following the sessions of the Standing Committee (paragraph 8 of document SCP/1/2), the International Bureau would, if possible, circulate the first draft within one week of the meeting, and would make arrangements for participants to have the opportunity to comment on proposed changes to the report. Until the Committee decides otherwise, the revised report would be submitted to the Standing Committee at the next meeting for adoption.

9. The question of languages and funding for participation of delegates at any future Working Group of the Standing Committee (paragraph 10 of document SCP/1/2) would follow any procedures decided by the Assemblies of the Member States of WIPO on those issues, and meetings of the Working Group would be scheduled, if possible, on dates adjoining the dates of a meeting of the Standing Committee.

Agenda Item 5: Issues to be considered by the Standing Committee

10. The Standing Committee discussed the issues to be considered by that Committee, under Part III of document SCP/1/2, as follows:

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Patent formalities harmonization (draft Patent Law Treaty)

11. The Standing Committee discussed this issue (paragraphs 14 to 18 of document SCP/1/2) and agreed that this issue should be discussed with highest priority at its first meeting, and that it should be included on the agenda and discussed with highest priority at the next meeting. It was also agreed that the discussions concerning the PLT should be undertaken in close coordination with discussions concerning PCT reform, electronic filing and information technology in other relevant WIPO bodies, including in particular bodies under the Patent Cooperation Treaty (PCT), and the Standing Committee on Information Technology (SCIT), and that a recommendation to that effect should be made to the SCIT and to the Assemblies of the Member States of WIPO.

Central recording of changes in patents and patent applications

12. The Standing Committee discussed this issue (paragraphs 19 to 23 of document SCP/1/2) and requested further information concerning this issue before deciding whether a second Consultative Meeting should be convened, as proposed by the International Bureau in paragraph 23 of document SCP/1/2. The Standing Committee agreed that this issue would be discussed at the next session, and that the question of whether a second Consultative Meeting should be convened and, if so, what its terms of reference, including the participation of Member States, should be, would be revisited at that time.

Disclosure of technical information on the Internet and its impact on patentability

13. The Standing Committee discussed this issue (paragraphs 24 and 25 of document SCP/1/2), and decided that the International Bureau should collect information from the existing literature on this subject for presentation at the next session, and that this issue should be placed on the agenda for discussion at the next session, in particular with respect to whether the issue should be broadened to include related issues such as infringement of patents through use of the Internet. A non-paper on this issue by the Delegation of the United States of America was distributed.

Biotechnological inventions

14. The Standing Committee discussed this issue (paragraphs 26 to 31 of document SCP/1/2) and agreed that the International Bureau would continue the studies referred to in paragraphs 29 and 30 of document SCP/1/2, and that it would bring this issue before the Standing Committee when appropriate. It was also agreed that the studies should be coordinated with any related work of other WIPO bodies, including the SCIT and PCT bodies.

Other possible issues

15. The Standing Committee discussed this issue (paragraph 32 of document SCP/1/2), and agreed to revert to this discussion at the next session. Two issues which were mentioned by the Standing Committee were substantive harmonization issues and enforcement.

Agenda Item 6: Proposal by the Delegation of Sudan presented at the fifth session of the Committee of Experts on the Patent Law Treaty

16. The Standing Committee discussed the Proposal by the Delegation of Sudan presented at the fifth session of the Committee of Experts on the Patent Law Treaty under Part IV of document SCP/1/2.

17. The Standing Committee agreed that this issue would properly be considered by the Assemblies of the Member States of WIPO, but that, prior to referring the issue to those Assemblies, the International Bureau would collect information on the current practices of countries and regional organizations in this area of fee reductions, that it would consult with the World Trade Organization on the TRIPS-consistency of the Proposal, and that it would present that information to the next session.

Agenda Item 7: Establishment of a PLT Electronic Forum

18. The Standing Committee discussed establishment of a PLT Electronic Forum, under Part V of document SCP/1/2, and approved the proposal to establish an Electronic Forum as presented in paragraphs 44 to 50 of that document on the following understanding: (i) that the Forum would be broadened to include all of the work of the Standing Committee, and that therefore it would be referred to as the “SCP Electronic Forum”; (ii) that the Forum would be restricted for the time being to distribution of the draft report and draft working documents and receipt of comments on those documents; (iii) that the International Bureau would establish specific procedures for the Forum in consultation with other relevant committees and information technology experts within WIPO; (iv) that no decisions on substance would be taken; and (v) that documents would be distributed in English, French and Spanish, but that comments could be sent to the International Bureau in any of the six official WIPO languages.

Agenda Item 8: Draft Patent Law Treaty

19. The Standing Committee discussed the documents concerning the draft Patent Law Treaty and the accompanying Regulations (documents SCP/1/3 to 5).

20. The Committee agreed that a decision would be taken at this session on the text of each provision, as to whether that provision was adopted, adopted with modifications, deleted, reserved for further discussion or referred to the International Bureau for further study, with the understanding that provisions which have been adopted, adopted with modifications or deleted would be closed for further discussions, except at the express request of a Member of the Standing Committee, or to approve consequential modifications made by the International Bureau when redrafting other provisions.

21. Concerning the specific provisions of the draft PLT and Regulations (document SCP/1/3), the Standing Committee agreed as follows:

Draft Article 1

Item (i). Referred to the International Bureau for further study.

Item (ii) to (v). Adopted.

Item (vi). Adopted with modification.

Item (vii). Adopted.

Item (viii). Adopted with modification.

Item (ix). Adopted.

Item (x). Adopted with modification in the Spanish text.

Item (xi). Referred to the International Bureau for further study.

Item (xii). Adopted with modification.

Item (xiii). Adopted.

Item (xiv). Adopted.

Item (xv). Adopted with modification.

Items (xvi) and (xvii). Adopted.

Item (xviii). Reserved for further discussion.

New Item on a definition of inventor. Referred to the International Bureau for further study.

Draft Rule 1. Adopted.

Draft Article 2. Adopted with modifications.

Draft Article 3. Referred to the International Bureau for further study.

Draft Article 4

Paragraph (1)(a). Adopted.

Paragraph (1)(b). Adopted with modification.

Paragraph (2)(a). Adopted.

Paragraph (2)(b). Adopted with modification.

Paragraph (3). Referred to the International Bureau for further study.

Paragraph (4)(a). Adopted.

Paragraph (4)(b). Adopted with modification.

Paragraph (5). Referred to the International Bureau for further study.

Paragraph (6). Referred to the International Bureau for further study.

Paragraph (7). Adopted with modification.

Paragraph (8). Referred to the International Bureau for further study.

Draft Rule 2

Paragraph (1). Referred to the International Bureau for further study.

Paragraph (2). Referred to the International Bureau for further study.

Paragraph (3)(a). Reserved for further discussion.

Paragraph (3)(b) and (c). Deleted.

Paragraph (3)(d). Adopted.

Paragraph (3)(e). Referred to the International Bureau for further study.

Draft Article 5

Paragraph (1). Adopted.

Paragraph (2)(a). Adopted with modification.

Paragraph (2)(b). Referred to the International Bureau for further study.

Paragraph (3). Reserved for further discussion.

Paragraphs (4) to (10). Discussion deferred.

Draft Article 13

Paragraph (1). Adopted.

Paragraph (2)(a). Adopted.

Paragraph (2)(b), items (i) and (ii). Adopted; referred to the International Bureau for further study of new item (iii).

Paragraphs (3) and (4). Discussion deferred.

Paragraph (5). Reserved for further discussion.

Paragraph (6). Adopted.

Draft Rule 13

Paragraph (1). Adopted.

Paragraph (2). Discussion deferred.

Draft Article 14

Paragraphs (1), (2) and (9). Referred to the International Bureau for further study.

Paragraphs (3) to (8). Discussion deferred.

Draft Rule 14

Paragraph (1). Referred to the International Bureau for further study.

Paragraph (2). Discussion deferred.

Draft Article 15

Paragraphs (1), (2) and (9). Referred to the International Bureau for further study.

Paragraphs (3) to (8). Discussion deferred.

Draft Rule 15

Paragraph (1). Referred to the International Bureau for further study.

Paragraph (2). Discussion deferred.

Paragraphs (4) to (8). Discussion deferred.

Draft Article 16

Paragraph (1). Adopted.

Paragraph (2)(a). Adopted with modification.

Paragraph (2)(b). Deleted.

Paragraph (3). Adopted with modification.

Paragraphs (4) to (8). Discussion deferred.

Paragraph (9). Referred to the International Bureau for further study.

Draft Rule 16

Paragraph (1). Adopted.

New Paragraph (1bis). Adopted.

Paragraph (2). Adopted

New Paragraph (2bis). Adopted.

Paragraph (3). Discussion deferred.

22. Concerning the Model International Forms (document SCP/1/5), the Standing Committee agreed that the Forms would be discussed at the next meeting.

Agenda Item 9: Future work

23. The Standing Committee discussed its future work and decided the following:

24. The work of the first session of the Standing Committee would continue at an additional meeting, which would take place preferably in November 1998.

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25. The International Bureau will report to the Assemblies of the Member States of WIPO on the progress made at its first meeting, and will notify those Assemblies that the Standing Committee, in undertaking preparations for a diplomatic conference at the preparatory meeting mentioned in Sub-program 09.1 of the WIPO Program and Budget for 1998-99, expects that it will, at one of its meetings in 1999, set dates for a diplomatic conference which could be held as early as 2000.

Agenda Item 10: Summary by the Chair

26. The Chair presented a draft Summary (document SCP/1/6 Prov.), orally proposed some additions to the draft Summary concerning Articles 5 and 16, Rule 16, and the Model International Forms of the draft Patent Law Treaty, and received comments from the participants.

Agenda Item 11: Closing of the session

27. The Chair adjourned the first session of the Standing Committee, with the understanding that the session would be reconvened, tentatively, in November 1998.

[End of Annex II, Annex III follows]

ANNEX III

REVISED TEXT OF PROVISIONS ADOPTED WITH MODIFICATION
BY THE STANDING COMMITTEE AT ITS FIRST SESSION, FIRST PART

Draft Article 1(vi):

(vi) “records of the Office” means the collection of information maintained by the Office, relating to and including the applications filed with, and the patents granted by, that Office or another authority with effect for the Contracting Party concerned, irrespective of the medium in which such information is maintained;

Draft Article 1(viii):

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

Draft Article 1(xii):

(xii) “a language accepted by the Office” means any one language accepted by the Office for the relevant procedure before the Office;

Draft Article 1(xv):

(xv) ~~for the purposes of this Treaty~~, except where the context indicates otherwise, words in the singular include the plural, and *vice versa*, and masculine personal pronouns include the feminine;

Draft Article 2(1)(a):

(1) [*Applications*] (a) The provisions of this Treaty and the Regulations shall apply to national and regional applications for patents for invention which are filed with or for the Office of a Contracting Party, and which are types of applications that can be filed as international applications under the Patent Cooperation Treaty.

Draft Article 2(1)(b):

(b) Subject to the provisions of the Patent Cooperation Treaty, the provisions of this Treaty and the Regulations shall apply to international applications for patents for invention under the Patent Cooperation Treaty:

[(i) and (ii) unchanged]

Draft Article 2(2):

(2) [*Patents*] The provisions of this Treaty and the Regulations shall apply to patents for invention, ~~resulting from the applications referred to in paragraph (1)~~ which have been granted with effect for a Contracting Party.

Draft Article 4(1)(b):

(b) A Contracting Party may ~~provide that~~, for the purposes of the filing date, accept a drawing ~~may replace the part as the element~~ referred to in subparagraph (a)(iii).

Draft Article 4(2)(b):

(b) The part referred to in paragraph (1)(a)(iii) may, for the purposes of the filing date, be in any language. ~~Where the said part is not in a language accepted by the Office, the application shall contain an indication, in a language accepted by the Office, to the effect that the application contains a description.~~

Draft Article 4(4)(b)

(b) A Contracting Party may provide that, where one or more of the ~~missing~~ requirements referred to in subparagraph (a) are not complied with within the time limit prescribed in the Regulations, the application shall be regarded as not having been filed.

Draft Article 4(7)(a):

(7) [*Replacing Description and Drawings by Reference to a Previously Filed Application*] (a) ~~A Contracting Party may provide that~~, Subject to the requirements prescribed in the Regulations, a reference, in a language accepted by the Office, to a previously filed application ~~in respect of the same invention~~ shall, for the purposes of the filing date of the application, replace the description and any drawings.

Draft Article 4(7)(b):

(b) Where the requirements referred to in subparagraph (a) are not complied with, the application ~~shall~~ may be considered as not having been filed.

Draft Article 5(2):

(2) [*Request Form*] (a) A Contracting Party may require that the contents of an application which correspond to the mandatory contents of the request of an international application under the Patent Cooperation Treaty be presented on a request Form or in a format prescribed by that Contracting Party.

Draft Article 16(2):

(2) [*Delayed Filing of the Subsequent Application*] ~~(a)~~ Where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than **the date on which the priority period expired**, but within the time limit prescribed in the Regulations ~~two months of, the date on which the priority period expired~~, the Office shall restore the right of priority, upon a request made in a communication to the Office signed by the applicant, if:

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(i) **the request is made before the expiration of the said ~~two-month period~~ time limit and before any technical preparations for publication of the subsequent application have been completed;**

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[(ii) to (iv) unchanged]

~~[(b) No Contracting Party may allow for the extension of the period of two months referred to in subparagraph (a).]~~

Draft Article 16(3)(a):

(3) [*Failure to Furnish a Copy of Earlier Application*] (a) Where a copy of an earlier application required under Article 5(7)(a) is not furnished to the Office within the time limit referred to in that Article, the Office shall restore the right of priority, upon a request made, in a communication to the Office signed by the applicant, within a ~~reasonable~~ that time limit, if:

(i) the request for restoration states indicates^{*} the Office to which the request for a copy of an earlier application had been made and the date of that request; and

[(ii) unchanged]

* ~~French and~~ English only.

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Draft Article 16(3)(b):

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the ~~statement request~~ referred to in subparagraph (a)(i) be furnished to the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in subparagraph (a) be furnished to the Office within the time limit prescribed in the Regulations ~~a time limit fixed by the Office calculated from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.~~

Draft Rule 2(1) (as applied to draft Article 4(4)(b) only):

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Bureau

(1) [*Time Limits Under Article 4(4)(b) and (5)(a)*] ~~Each of the~~ The time limits referred to in Article 4(4)(b) ~~and (5)(a)~~ shall be:

(i) where a notification has been made under Article 4(3), not less than two ~~one~~ months from the date of the notification;

(ii) where a notification has not been made because indications allowing the applicant to be contacted by the Office have not been furnished, not less than two months from the date on which one or more elements referred to in Article 4(1)(a) were first received by the Office.

Draft Rule 2(3)(b) and (c):

~~(b) The applicant identified in the previously filed application shall be the same as, or the predecessor in title to, the applicant identified in the application containing the reference.~~

~~(c) Where two or more applicants are indicated in either or both the application containing the reference referred to in Article 4(7)(a) and the previously filed application, the requirements of subparagraph (b) shall be considered as complied with if at least one of those applicants is identified as an applicant in both applications.~~

Draft Rule 16(1bis) (new):

(1bis)* [Time Limit under Article 16(2)] The time limit referred to in Article 16(2) shall be not less than two months from the date on which the priority period expired.

Draft Rule 16(2):

(2)* [Time Limit Under Article 16(3)(a)(ii)] The time limit referred to in Article 16(3)(a)(ii) shall be two months before the expiration of the time limit prescribed in Rule 5(1)(a).

Draft Rule 16(2bis) (new):

(2bis)* [Time Limit under Article 16(3)(b)(ii)] The time limit referred to in Article 16(3)(b)(ii) shall be not less than one month from the date on which the applicant is provided with the copy referred to in that provision by the Office with which the earlier application was filed.

[End of Annex III and of document]

* To be renumbered.