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DRAFT REGULATIONS AND PRACTICE GUIDELINES
UNDER THE DRAFT SUBSTANTIVE PATENT LAW TREATY

prepared by the International Bureau

INTRODUCTION

The present document contains draft Regulations and draft Practice Guidelines under the draft Substantive Patent Law Treaty (SPLT), which is contained in document SCP/5/2 Prov.

Unlike in the draft SPLT, the draft Regulations and draft Practice Guidelines contained in the present document are based on existing texts only. No alternatives are suggested at this stage, since their future wording will depend on the choice of the SCP with respect to the drafting style of the draft SPLT (see also the explanations given in the introduction part of document SCP/5/2 Prov.).

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DRAFT REGULATIONS

Rule 1

Abbreviated Expressions

[Reserved]

Rule 2

Details Concerning the Right to a Patent Under Article 2

Parts of Art. 9(1) PLT/DC/69

Any Contracting Party shall be free to determine the circumstances under which and the extent to which the right to the patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention.

Rule 3

Contents and Order of Description Under Article 5

Rule 2, 1991 Draft

(1) [*Contents of Description*] The description shall, after stating the title of the invention,

(i) specify the [technical] field or fields to which the invention relates;

(ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such background art;

(iii) describe the invention, as claimed, in such terms that the [technical] problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

(iv) where a deposit of biologically reproducible material is required under Rule 9, indicate the fact that the deposit has been made and identify at least the name and address of the depositary institution, the date of the deposit and the accession number given to the deposit by that institution, as well as describe, to the extent possible, the nature and the characteristics of such material, relevant to the requirement of disclosure of the invention;

(v) briefly describe the figures in the drawings, if any;

[Rule 3(1), continued]

(vi) set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any;

(vii) indicate explicitly, when it is not otherwise clear from the application or nature of the invention, the way or ways in which the invention satisfies the requirement of being useful or industrially applicable.

(2) [*Manner and Order of Presentation of Contents*] (a) The contents of the description shall be presented in the manner and order specified in paragraph (1), unless, because of the nature of the invention, a different manner or a different order would afford a better understanding or a more economical presentation.

Rule 2(2),
PLT/DC/69

(b) Any Contracting Party may accept a description which does not contain the matters specified in paragraph (1)(i), (ii) and (v), or which contains, in lieu of the matter specified in paragraph (1)(iii), a description of the invention in any terms that satisfy the requirement of a disclosure of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(3) [*Requirements Under the Patent Cooperation Treaty*] Any Contracting Party shall apply the formal requirements concerning the disclosure of special technical features, for example, computer program listings or nucleotide or amino acid sequences, which are applicable under the Patent Cooperation Treaty, if any.

Rule 2(3)
1991 Draft,
as amended
by
PLT/DC/69

Rule 4

Details Concerning Claims Under Article 6

Rule 3, 1991 Draft

(1) [*Consecutive Numbering*] Where the application contains several claims, they shall be numbered consecutively in [whole] numerals.

(2) [*Method of Definition of Invention*] The definition of the matter for which protection is sought shall be in terms of the [technical] features of the invention.

(3) [*Elements of Claims*] Each claim shall consist of one or more elements.

(4) [*Form of Claim*] Claims shall be written, at the option of the applicant, either

(i) in two parts, the first part consisting of a statement indicating those technical features of the invention which are necessary in connection with the definition of the claimed subject matter and which, in combination, appear to be part of the prior art, the second part (“the characterizing portion”), introduced by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or other words to the same effect, consisting of a statement indicating those technical features which, in combination with the features stated in the first part, define the matter for which protection is sought; or

(ii) in a single statement containing a recitation of a combination of several elements or steps, or a single element or step, which defines the matter for which protection is sought.

(5) [*References in the Claims to the Description and Drawings*] (a) No claim may contain, in respect of the [technical] features of the invention, a reference to the description or any drawings, for example, such references as: “as described in part ... of the description,” or “as illustrated in figure ... of the drawings,”.

(b) No claim may contain any drawing or graph. Any claim may contain tables and chemical or mathematical formulas.

(c) Where the application contains a drawing, the mention of any [technical] feature in a claim may, if the intelligibility of that claim can thereby be enhanced, include a reference sign to that drawing or to the applicable part of that drawing; such a reference sign shall be placed between square brackets or parentheses; it shall not be construed as limiting the claim.

(6) [*Dependent and Multiple Dependent Claims*] (a) Any claim which includes all the features of another claim of the same category or several other claims of the same category (hereinafter referred to as “dependent claim” and “multiple dependent claim,” respectively) shall, preferably in the beginning, refer to the other claim or the other claims, as the case may be, by indicating the number of the other claim or the numbers of the other claims and shall then state those features claimed that are additional to the features claimed in the other claim or the other claims.

[Rule 4(6), continued]

(b) A dependent claim may depend on another dependent claim or on a multiple dependent claim. A multiple dependent claim may depend on a dependent claim or another multiple dependent claim. Multiple dependent claims may refer in the alternative or in the cumulative to the claims on which they depend.

(c) All dependent claims referring back to the same claim, and all multiple dependent claims referring back to the same claims, shall be grouped together in the most practical way possible.

Rule 5

Details Concerning the Requirement of Unity of Invention Under Article 7

Rule 4, 1991 Draft

(1) [*Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled*] Where a group of inventions is claimed, the requirement of unity of invention shall be fulfilled only when there is a [technical] relationship among those inventions involving one or more of the same or corresponding special [technical] features. The expression “special [technical] features” shall mean those [technical] features that define a contribution which each of those inventions, considered as a whole, makes over the prior art.

(2) [*Determination of Unity of Invention Not Affected by Manner of Claiming*] The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Rule 6

Availability to the Public Under Article 8

Inspired by Art. 11(2)(c), 1991 Draft

(1) [*Form of Availability to the Public*] Prior art may be made available to the public in written form, by oral communication, by display, through use or in any other form.

(2) [*Accessibility to the Public*] Prior art shall be deemed to have been available to the public, if it has actually been accessed by one or more members of the public, or if there was a reasonable possibility that it could have been accessed by one or more members of the public.

(3) [*Evidence of Non-Documentary Disclosures*]

[*Reserved*]

Rule 7

Prior Art Effect of Certain Applications Under Article 9

Art. 13,
1991 Draft

(1) [*Principle of “Whole Contents”*] (a) Subject to subparagraph (b), the whole contents of a former application shall, for the purpose of determining the novelty of an invention claimed in another application, be considered as prior art from the filing date or, where priority is claimed, the priority date of the former application on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent.

(b) Where the former application referred to in subparagraph (a) claims the priority of an earlier application for a patent, utility model or other title protecting an invention, matter that is contained in both the former application and such earlier application shall be considered as prior art in accordance with subparagraph (a) from the priority date of the former application.

(c) For the purposes of subparagraph (a), the “whole contents” of an application consists of the description and any drawings, as well as the claims, but not the abstract.

(d) Any Contracting Party shall consider an application for a utility model as prior art in accordance with paragraph (a).

Inspired by
Art. 13(1)(d)
as proposed in
PLT/DC/69

(2) [*Applications No Longer Pending*] Where the former application referred to in paragraph (1)(a) has been published in spite of the fact that, before the date of its publication, it was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected, it shall not be considered as prior art for the purposes of paragraph (1)(a).

[Rule 7, continued]

(3) [*Self-Collision*] Paragraph (1) shall not apply when the applicant of, or the inventor identified in, the former application, and the applicant of, or the inventor identified in, the application under examination, is one and the same person, provided that only one patent may be validly granted by the same Office for the same invention.

Art. 13(3) as amended by PLT/DC/69
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Rule 8

Disclosure Under Article 11

For the purposes of Article 11,

(i) the claims as submitted upon filing shall be considered as forming part of the disclosure of the invention contained in the application as filed for the purposes of the filing date;

(ii) the general knowledge of a person skilled in the art and the amount of experimentation required shall be taken into consideration.

Rule 9

Deposit of Biologically Reproducible Material Under Article 11

Art. 3(1)(b), 1991 Draft. Last sentence from PLT/DC/69

Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. No Contracting Party may require that the deposit be made before the filing date of the application.

Rule 10

*Person Skilled in the Art Under Articles 11, 18 and 20(3)(b),
and Rules 3(2)(b), 8, 9, 10, 11(1) and [(2)], 13(3) and 14(2)*

A person skilled in the art shall be considered to be an ordinary practitioner reasonably well versed, but without highly specialized skills, in the relevant field of the art, knowing the general knowledge in that field of the art at the relevant date.

Rule 11

Interpretation of Claims Under Article 14

Parts of Art. 21,
1991 Draft, as
amended by
PLT/DC/69

(1) [*Principle*] For the purposes of Article 14(1), the claims shall be so interpreted as to combine fair protection for the applicant with a reasonable degree of certainty for third parties. Consequently, the claims shall not be interpreted as being necessarily confined to their strict literal wording. Neither shall the claims be considered as mere guidelines allowing that the protection conferred by the application extends to what, from a consideration of the description and drawings by a person skilled in the art, the applicant has contemplated, but has not claimed.

[(2) [*Equivalents*] For the purposes of Article 14(2), an element shall generally be considered as being equivalent to an element as expressed in a claim if, at the time of any alleged infringement, it performs substantially the same function in substantially the same way and produces substantially the same result as the element as expressed in the claim, and it is obvious to a person skilled in the art that the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element.

Parts of
Art. 21(2)
PLT/DC/69

(3) [*Prior Statements*] In determining the scope of protection, due account shall be taken of any statement limiting the scope of the claims made by the applicant during procedures concerning the grant or the validity of the patent.]

(4) [*Examples*] If the application contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims shall not be interpreted as limited to those examples; in particular, the mere fact that a product or process includes additional features not found in the examples disclosed in the patent, lacks features found in such examples or does not achieve every objective or possess every advantage cited or inherent in such examples shall not remove the product or process from the scope of protection conferred by the claims.

(5) [*Abstract*] The abstract shall not be taken into account for the purpose of determining the protection conferred by the claims.

Rule 12

Definition of “Industry” Under Article 16

Inspired by Art. 33(4) PCT (in part)
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For the purposes of industrial applicability (utility), “industry” shall be understood in its broadest sense, as in Article 1(3) of the Paris Convention for the Protection of Industrial Property.

Rule 13

Items of Prior Art Under Article 17

(1) [*Enabling Prior Art*]

[*Reserved*]

(2) [*Primary Reference*] For the determination of novelty, items of prior art may only be taken into account individually.

(3) [*Other Items of Prior Art*] Notwithstanding paragraph (2), for the determination of novelty, items of prior art which would have been known to a person skilled in the art, and which

(a) contribute to determining whether the primary reference was enabling;

(b) are incorporated by reference in the primary reference;

(c) explain the meaning of terms used in the primary reference; or

(d) show that a characteristic not disclosed in the primary reference is inherent,

shall be taken into account.

Rule 14

Items of Prior Art Under Article 18

(1) [*Multiple Items of Prior Art*] For the determination of inventive step (non-obviousness), multiple items of prior art may be combined.

(2) [*General Knowledge of the Person Skilled in the Art*] For the determination of inventive step (non-obviousness), the general knowledge of the person skilled in the art shall be taken into account.

DRAFT PRACTICE GUIDELINES

[Guideline [...]]

Lengthy Applications Under Article 4

A Contracting Party may require that an application comprising more than [...] pages in A4 format be filed by electronic means and in electronic form, as prescribed in the Regulations.]

Guideline [...]]

Methodology Under Article 18

[Reserved]

[End of document]