

DRAFT SUBSTANTIVE PATENT LAW TREATY

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SUBSTANTIVE PATENT LAW TREATY

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Article 1

Abbreviated Expressions

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

- (i) “filing date” means the date of filing or, where priority is claimed, the priority date, unless stated otherwise;

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

PART I: APPLICATION

SECTION ...: RIGHT TO A PATENT

Article 2

Right to a Patent

Inspired by Art. 9, 1991 Draft, as amended by PT/DC/69

The right to a patent shall belong to the inventor or his successor in title, as prescribed in
the Regulations.

SECTION ...: SUBSTANTIVE CONTENTS OF APPLICATION

Article 3

Adequate Disclosure in Application as a Whole

Inspired by
Art. 3(1)(a),
1991 Draft

(1) [*Requirements In Respect of Disclosure*] The disclosure of the invention in the application as a whole shall be adequate, if, as of the date of filing of the application, it sets forth the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art, as prescribed in the Regulations.

(2) [*Prohibition of Other Requirements*] In respect of the disclosure, no requirement additional to or different from those provided for in paragraph (1) may be imposed.

Art. 3(3),
1991 Draft

Article 4

Description

(1) [*Contents and Order of Description*] The description part of the application shall have the contents, and be presented in the order, prescribed in the Regulations.

Art. 3(2)(b),
1991 Draft

(2) [*Prohibition of Other Requirements*] In respect of the description, no requirement additional to or different from those provided for in paragraph (1) may be imposed.

Art. 3(3),
1991 Draft

SECTION ...: CLAIMS

Article 5

Requirements Concerning Claims

Art. 4, 1991 Draft

(1) [*Contents of the Claims*] The claims shall define the matter for which protection is sought, as prescribed in the Regulations.

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

Art. 4(3), PT/DC/69

(3) [*Relation of the Claims with the Description*] The claims shall be supported by the description and the drawings, as prescribed in the Regulations.

(4) [*Manner of Presentation of the Claims*] The claims shall be presented as prescribed in the Regulations.

(5) [*Prohibition of Other Requirements*] In respect of the claims, no requirement additional to or different from those provided for in paragraphs (1) to (4) may be imposed.

Article 6

Unity of Invention

Art. 5, 1991 Draft

(1) [*Requirement of Unity of Invention*] The application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"), as prescribed in the Regulations.

(2) [*Validity of Patent Not Affected by Lack of Unity of Invention*] The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

SECTION ...: AMENDMENT OF APPLICATION

Article 7

Amendment or Correction of Application

Art. 14, 1991 Draft

(1) [*Amendments or Corrections Following Office Findings*] Wherever the Office finds that the application does not comply with any requirements applicable to it, it shall give the applicant at least one opportunity to amend or correct the application or to comply with the said requirements.

(2) [*Amendments or Corrections on Applicant's Initiative*] The applicant shall have the right, on his own initiative, to amend or correct the application or to comply with a requirement applicable to the application up to the time when the application is in order for grant; however, any Contracting Party which provides for substantive examination may provide that the applicant shall have the right to amend or correct, on his own initiative, the description, the claims and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

(3) [*Limitation of Amendments or Corrections*] (a) No amendment or correction, other than the correction of an obvious mistake or of a clerical error within the meaning of subparagraph (b), shall be permitted where the amendment or correction would result in the disclosure of the invention contained in the amended or corrected application going beyond the disclosure of the invention contained in the application as filed.

Art. 14(3), 1991 Draft, as amended by PT/DC/69

(b) For the purposes of subparagraph (a), a mistake shall be considered obvious, and an error shall be considered clerical, where what is corrected is obviously wrong, and the correction is obvious, to a person skilled in the art.

[SECTION ...: LENGTH OF APPLICATION

Article 8

Lengthy Applications

A Contracting Party may prescribe special requirements in respect of lengthy applications, as prescribed in the Practice Guidelines.]

PART II: PRIOR ART

Article 9

Definition of Prior Art

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

(1) [*Principle*] The prior art shall consist of everything which, before the filing date of the claim, has been made available to the public anywhere in the world, as prescribed in the Regulations.

[Alternative A]

[Alternative B]

(2) [*Former Applications*] An application filed before, but published after, the filing date of the application under consideration shall form part of the prior art, as prescribed in the Regulations.

No provision on former applications.

Art. 13(1),
1991 Draft

[Article 10¹

Disclosures Not Affecting Patentability (Grace Period)

Art. 12 ,1991 Draft, as amended by PT/DC/69

(1) [*Circumstances of Disclosure Not Affecting Patentability*] Disclosure of information which otherwise would affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed, during, or with effect under Article 9(2) on a date during the 12 months preceding the filing date of the application,

(i) by the inventor,

(ii) by an Office and the information was contained

(a) in another application filed by the inventor and should not have been disclosed by the Office, or

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

or

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

¹ This provision is placed in square brackets, since its inclusion may be dependent on discussions to take place at a later stage.

[Article 10, continued]

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

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

(4) [*Evidence*] Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving, or of making the conclusion likely, that the conditions of that paragraph are fulfilled.]

PART III: EXAMINATION

SECTION ..: PATENTABILITY

Article 11

Patentable Inventions

Inspired by TRIPS Art. 27(1)

Patents shall be available for any invention, provided they are new, involve an inventive step (are non-obvious) and are capable of industrial application (are useful), in accordance with the requirements prescribed in this Treaty.

SECTION ...: NOVELTY

Article 12

Definition of Novelty

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

An invention shall be considered novel if, taking into account individual items of prior art only, it does not form part of the prior art, as prescribed in the Regulations.

SECTION ..: INVENTIVE STEP/NON-OBVIOUSNESS

Article 13

Inventive Step/Non-Obviousness

Art. 11(3), 1991 Draft

An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in Article [...], it would not have been obvious to a person skilled in the art at the filing date of the application claiming the invention, as prescribed in the Regulations.

SECTION ..: INDUSTRIAL APPLICABILITY/UTILITY

Article 14

Industrial Applicability/Utility

Inspired by PCT Art. 33(4) (in part)
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An invention shall be considered industrially applicable (useful) if, according to its nature, it can [be made or used in any kind of industry][accomplish a practical application in the field of art], as prescribed in the Regulations.

SECTION ..: EXAMINATION AND INTERPRETATION OF CLAIMS

Article 15

Examination and Interpretation of Claims

Parts of Art. 21,
1991 Draft.

(1) [*Extent of Protection and Interpretation of Claims*] The scope of protection conferred shall be determined by the claims, which are to be interpreted in the light of the description and drawings, as prescribed in the Regulations.

(2) [*Equivalents*] For the purpose of determining the scope of protection conferred by the application, due account shall be taken of elements which are equivalent to the elements expressed in the claims, as prescribed in the Regulations.

Parts of art. 21(2)
PT/DC/69

SECTION ..: REMEDIES AGAINST REJECTION/REFUSAL OF APPLICATION

Article 16

Observations and Review

Inspired by
Art. 10(2)
PLT

(1) [*Opportunity to Make Observations, Amendments or Corrections in Case of Intended Rejection or Refusal*] An application may not be rejected or refused on the grounds of lack of patentability, either totally or in part, without the applicant being given the opportunity to make observations on the intended rejection or refusal, and to make amendments and corrections where permitted under the applicable law, within a reasonable time limit.

(2) [*Review After Rejection or Refusal*] The rejection or refusal of an application by the examining authority on the grounds of lack of patentability of the invention under Articles [...] shall be subject to judicial review by a judicial or quasi-judicial authority.

Inspired by Art.
62.5 TRIPS

SECTION ...: REGULATIONS AND PRACTICE GUIDELINES

Article 17

Regulations

Inspired by PLT Art. 14

- (1) [*Content*] The Regulations annexed to this Treaty provide rules concerning:
- (i) matters which this Treaty expressly provides are to be “prescribed in the Regulations”;
 - (ii) details useful in the implementation of the provisions of this Treaty;
 - (iii) administrative requirements, matters or procedures.
- (2) [*Amending the Regulations*] Subject to paragraph (3), any amendment of the Regulations shall require [reserved].
- (3) [*Requirement of Special Majorities*] (a) The Regulations may specify provisions of the Regulations which may be amended only by [unanimity][a majority of nine tenths][a majority of four fifths].
- (b) Any amendment of the Regulations resulting in the addition of provisions to, or the deletion of provisions from, the provisions specified in the Regulations pursuant to subparagraph (a) shall require [unanimity][a majority of nine tenths][a majority of four fifths].

(c) In determining whether unanimity is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(4) [*Conflict Between the Treaty and the Regulations*] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 18

Practice Guidelines

Inspired by PLT Art. 14 and PCT Rule 89

(1) [*Content*] The Practice Guidelines annexed to this Treaty and the Regulations provide guidelines concerning:

(i) matters which this Treaty or the Regulations expressly provides are to be “prescribed in the Practice Guidelines”;

(ii) details useful in the implementation of the provisions of this Treaty and the Regulations.

(2) [*Amending the Practice Guidelines*] [*Reserved*]

[End of Document]