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STANDING COMMITTEE ON THE LAW OF PATENTS

Seventh Session
Geneva, May 6 to 10, 2002

DRAFT REPORT

prepared by the Secretariat

INTRODUCTION

1. The Standing Committee on the Law of Patents (“the Committee” or “the SCP”) held its seventh session in Geneva from May 6 to 10, 2002.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Angola, Argentina, Armenia, Australia, Austria, Bangladesh, Belarus, Belgium, Bolivia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Croatia, Cuba, Czech Republic, Denmark, Dominican Republic, Egypt, El Salvador, Estonia, Ethiopia, Finland, France, Germany, Greece, Guatemala, Guinea, Hungary, India, Indonesia, Ireland, Japan, Jordan, Kenya, Lao People’s Democratic Republic, Latvia, Lithuania, Luxembourg, Madagascar, Malaysia, Mexico, Morocco, Nepal, Netherlands, New Zealand, Nigeria, Norway, Pakistan, Peru, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Slovakia, Slovenia, Spain, Sudan, Sri Lanka, Sweden, Switzerland, Thailand, The former Yugoslav Republic of Macedonia, Togo, Trinidad and Tobago, Tunisia, United Kingdom, United States of America, Uzbekistan, Viet Nam, Yugoslavia and Zimbabwe (77).
3. Representatives of the Eurasian Patent Office (EAPO), the European Commission (EC), the European Patent Office (EPO) and the World Trade Organization (WTO) took part in the meeting in an observer capacity (4).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Bar Association (ABA), American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Biotechnology Industry Organization (BIO), Centre for International Industrial Property Studies (CEIPI), Chartered Institute of Patent Agents (CIPA), Committee of National Institutes of Patent Agents (CNIPA), Confederation of Indian Industry (CII), Exchange and Cooperation Centre for Latin America (ECCLA), Federal Chamber of Patent Attorneys (FCPA), German Association for Industrial Property and Copyright Law (GRUR), Institute of Professional Representatives before the European Patent Office (EPI), Intellectual Property Institute of Canada (IPIC), Intellectual Property Owners Association (IPO), International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Intellectual Property Society (IIPS), Japan Patent Attorneys Association (JPAA), Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law (MPI), Pacific Intellectual Property Association (PIPA), Patent Documentation Group (PDG) and Union of European Practitioners in Industrial Property (UEPIP) (22).

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

6. Discussions were based on the following documents prepared by the International Bureau: "Revised Draft Agenda" (SCP/7/1 Rev.), "Accreditation of an Intergovernmental Organization (SCP/7/2), "Draft Substantive Patent Law Treaty" (SCP/7/3), "Draft Regulations and Practice Guidelines under the Substantive Patent Law Treaty" (SCP/7/4), "Notes" (SCP/7/5), and "Requirements Concerning the Relationship of the Claims to the Disclosure" (SCP/7/6).

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. Mr. Francis Gurry, Assistant Director General, opened the session, and welcomed the delegates, on behalf of the Director General. The session was chaired by Mr. Dave Herald (Australia). Mr. Philippe Baechtold (WIPO) acted as Secretary to the Committee.

Agenda Item 2: Adoption of the Agenda

9. The revised draft agenda (document SCP/7/1 Rev.) was adopted as proposed.

Agenda Item 3: Accreditation of an Intergovernmental Organization

10. The Committee approved the accreditation of the South Center as an ad hoc observer (document SCP/7/2).

Agenda Item 4: Adoption of the Draft Report of the sixth session

11. The International Bureau indicated that document SCP/6/9 Prov.2 took into account the comments received earlier from members of the Committee on document SCP/6/9 Prov., and further suggested the deletion of the text between square brackets in paragraph 144, seventh line, and in paragraph 173, third and fourth lines; that suggestion was accepted by the Committee.

12. The International Bureau took note of a request by the Delegation of France to make the French version of the report available earlier in the future in order to allow timely review of the document.

13. Regarding paragraph 178 of document SCP/6/9 Prov.2, the Delegation of the Dominican Republic stated that it had not made a proposal to add computer programs, business methods and rules for playing games. It also requested modifications in the text of paragraph 204 in order to better reflect the Delegation's intervention. The Delegation of the United States of America requested the International Bureau to check the requested corrections against the tapes.

14. The Committee adopted the draft report of its sixth session, subject to the changes referred to in paragraphs 11 and 13, above, the final report being contained in document SCP/6/9.

Agenda Item 5: Draft Substantive Patent Law Treaty and Draft Regulations under the Substantive Patent Law Treaty

15. The Chair requested the Committee to focus on the conceptual aspects of the issues and on the effect of the changes from the previous drafts rather than on questions of drafting. Comments and suggestions on detailed matters of drafting were noted by the International Bureau to be taken into account in the preparation of revised drafts.

Draft Article 1: Abbreviated Expressions

Items (i) to (vii)

16. No comment was made on these items.

Item (viii)

17. The International Bureau explained that the text was based on a proposal made by the Delegation of Canada at the previous session and that new item (ix) had been added to cover divisional, continuation-in-part and continuation applications.

18. The Delegation of Germany questioned the words in parenthesis “(‘priority date’),” which gave the impression of a definition.

19. The Delegation of Australia supported the definition of “claim date” and expressed preference for the second bracketed text. The Delegation of the United States of America also expressed support for the inclusion of a definition of “claim date” but reserved its position as to allowing several claim dates for one claim.

20. The Representative of MPI was of the opinion that the present provision raised more confusion than clarification and that the Paris Convention and the Patent Cooperation Treaty (PCT) contained sufficient provisions on priority matters. The Delegation of Denmark, supporting the Representative of MPI, stated that the practice of many offices corresponded to the situations envisaged by the definition of “claim date.” The Delegation of Sweden saw no need for a new definition. The Delegation of Chile found the expression “claim date” confusing. The Delegation of Germany queried whether the definition of “filing date” should be maintained. The Chair noted that the concept of “claim date” had been discussed at length during the previous session. It appeared that, in practice, many Offices used the concept of “claim date.” As regards priority under the Paris Convention, the Chair stated that the SPLT did not regulate what was in the Paris Convention, and that the term “priority date” was defined under the PCT in connection with formalities, while the term “claim date” in the draft SPLT related to substantive issues.

21. The Representative of the EPO suggested replacing the words “in accordance with the applicable law” in the third line by “in accordance with the Paris Convention.” The Delegation of the United Kingdom, supporting the Delegation of Germany in preferring to keep the expression “the applicable law,” felt that it would not be appropriate to refer to the Paris Convention, which did not cover internal priorities.

Item (ix)

22. The Delegation of Australia, supported by the Delegation of the United States of America, pointed out that the present wording did not accommodate divisional applications, which were derived from divisional applications and which claimed more than one priority, in cases where the same subject matter was not contained in the whole chain of divisional applications.

23. Summarizing the discussion on items (viii) and (ix), the Chair recognized some support for item (viii), whereas a number of delegations expressed reservations or did not see the need for it. A proposal to replace “the applicable law” by “the Paris Convention” was not supported. Item (ix) required further improvement as regards claim dates of divisional applications.

Items (x) to (xix)

24. No comment was made on these items.

Draft Rule 1: Abbreviated Expressions

25. The International Bureau noted that, in light of the amendment made to draft Article 11(4), the substance of draft Rule 1(1)(c)(i) should be moved to draft Article 1. No substantive discussion was held on this Rule.

Draft Article 2: General Principles

26. The Delegation of Germany, supported by the Delegation of Kenya which stated that this provision did not reflect general principles, suggested that a provision similar to Article 2(1) of the Patent Law Treaty (PLT) be included. The Delegation of the United States

of America supported the suggestion of the Delegation of Germany to the extent that formality requirements were concerned.

27. The Delegation of Brazil, supported by the Delegations of Chile, Colombia, the Dominican Republic, Egypt and Peru, proposed to include a new paragraph (3) which read as follows:

“(3) Nothing in this Treaty or Regulations shall limit the freedom of Contracting Parties to protect public health, nutrition and the environment or to take any action it deems necessary to promote the public interest in sectors of vital importance to its socio-economic, scientific and technological development.”

28. The Delegation of the Dominican Republic, on behalf of the Delegations of Chile, Colombia, Cuba, Ecuador, Honduras, Nicaragua, Peru, Venezuela and its own country, proposed that the phrase “or to comply with international obligations, including those relating to the protection of genetic resources, biological diversities, traditional knowledge and the environment” be inserted at the end of paragraph (2) and that the title of that paragraph be amended to read “Exceptions.” The Delegation also proposed the inclusion of some text in the explanatory notes to paragraph (2). This joint proposal was supported by the Delegations of Brazil, Egypt and Morocco. Noting that the matter would not be resolved during this session, the Delegation of the Dominican Republic suggested that these proposals be included in the draft Treaty within square brackets for further consideration.

29. The Delegations of Germany, Ireland, Japan and the United States of America and the Representative of BIO strongly opposed the aforementioned two proposals for the following reasons: the objective of the SPLT was to establish best practices and to deeply harmonize the substantive requirements; issues concerning the interpretation of other international treaties should not be resolved by the SPLT; matters regarding the WTO Doha Ministerial Declaration related to the use of patent rights after grant, not to the patentability of claimed inventions or the validity of patents; the proposed issues were extraneous to patent law. The Delegation of the United States of America and the Representative of BIO stated that the WIPO’s Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore was the appropriate body to discuss the proposed issues.

30. In response to a question raised by the Delegation of Sudan concerning the meaning of the words “any action” in paragraph (2), the International Bureau explained that a similar provision was found in PLT Article 4, and that, in general, the terms should be construed in the context of the treaty in which they were used.

31. The Chair summarized the discussion on draft Article 2 as follows: A proposal to amend paragraph (2) was made jointly by nine delegations, and was supported by some other delegations. One delegation, supported by several other delegations, proposed the inclusion of a new paragraph (3). One delegation suggested that these proposals be included in the draft Treaty, within square brackets, for further discussion. Several delegations, however, did not support these proposals, and questioned their relevance for the SPLT. Other issues, for example, the inclusion of a provision similar to PLT Article 2(1), were raised in conjunction with paragraph (1). In relation to paragraph (2), one delegation had asked for clarification on the words “any action.”

Draft Article 3: Applications and Patents to Which the Treaty Applies

32. Following the suggestion of the Delegation of Ireland that transitional provisions be included, the International Bureau explained that this issue would be addressed in the final and administrative provisions. The Delegation of Sweden mentioned that the expression “filed with or for” in paragraph (1)(i) needed further clarification, as discussed in relation to draft Article 8(2).

33. The Chair summarized the discussion on draft Article 3 by noting that it was generally accepted, and that the draft should be reviewed taking into account the comments made.

Draft Rule 3: Exceptions Under Article 3(2)

34. The Representative of CEIPI noted that the legal effect of the words in square brackets “except for Article 8(2)” was to provide an “exception to an exception.” He noted that, if this exception were retained, an earlier international application would have a “prior art effect” in all designated offices, irrespective of whether or not that international application entered the national phase before the designated Office concerned. Speaking in a personal capacity, he expressed the view that the exception should be retained in order to give proper effect to PCT Article 11(3), which provided that an international application should have the effect of a regular national application in each designated State as of the international filing date, even though he was aware that some PCT Contracting States had taken the view that PCT Articles 27(5) and/or 64(4) permitted the exclusion of such “prior art effect” where the earlier international application did not enter the national phase in the Contracting State concerned.

35. The Delegation of the United States of America also expressed support for the retention of the words in square brackets in the interests of best practice and to maximize harmonization with a view to facilitating future mutual recognition and work-sharing. However, the Delegations of Brazil, China, France, Republic of Korea and the Russian Federation and the Representatives of the EPO and FICPI expressed the view that the words “except for Article 8(2)” should be deleted so that the prior art effect would only apply to earlier international applications that entered the national phase in the Contracting State concerned.

36. The Chair noted that item (ii) would be reserved for further discussion.

37. The Chair summarized the discussion on draft Rule 3 as follows: Although a majority of delegations favored a deletion of the words “except for Article 8(2),” in view of the importance of the issue, the words concerned should be retained in square brackets for the purpose of future discussion and review, together with draft Article 3.

Draft Article 4: Right to a Patent

38. The Delegation of the United States of America stated that, in view of draft Article 13, which provided that non-compliance with the requirements under draft Article 4 was a ground for refusal of an application, paragraph (1) should be revised to include improper derivation or theft of an invention.

39. Further, the Delegation of the United States of America, supported by the Delegations of Germany, Japan, the Netherlands and Norway, suggested the deletion of paragraph (2)(b),

since it constituted an issue of choice of law. Noting the difficulty of achieving harmonization on matters relating to the right to a patent, the Delegation of the Russian Federation stated that draft Article 4 should be deleted in its entirety or formulated differently so that, where a person was accorded the right to a patent under the law of the country in which the invention was created, other countries would have to recognize the right of that person to a patent under their applicable laws. The Delegation of China also noted that harmonization on this subject would be very difficult. In response to a question raised by the Delegation of Japan, the Chair explained that the “right to a patent” was applicable to both the pre-grant and post-grant stages.

40. The Delegation of Spain pointed out that, in paragraph (3) of the Spanish text, the translation of the words “right to a patent” should be reviewed. As regards paragraph (3), the Delegation of Mexico stated that the provision should clearly indicate that each of the inventors had to agree on the right to a patent among themselves.

41. The Chair summarized the discussion on draft Article 4 by stating that, while there was general support for this provision in principle, a majority of delegations expressed the wish to delete paragraph (2)(b), since it did not relate to substantive patent law. Two delegations, however, proposed to delete draft Article 4 in its entirety and one delegation proposed to include specific wording on improper derivation in paragraph (1).

Draft Article 5: Application

42. The Representative of the EPO, supported by the Delegation of France, proposed that item (iv) of paragraph (1) be replaced by the phrase “any drawings referred to in the description or claims.” However, the Delegation of the United States of America, supported by the Delegation of Chile and the Representatives of ABA and AIPLA, was in favor of the text as proposed by the International Bureau, since an indication or non-indication of a reference to the drawings in the description was not relevant to the question of whether these drawings were necessary for the understanding of the claimed invention. The Chair noted that paragraph (1) could address the issues by stating what should be achieved by each part of an application.

43. The Delegation of Germany stated that it could not accept the words “and the Regulations” in paragraph (2), which would allow the Treaty to be overridden by the Regulations. As regards paragraph (3), the Representative of the EPO, supported by the Delegations of France and Spain, stated that the abstract should serve the purpose of information only.

44. The Chair summarized the discussion on draft Article 5 as follows: There was general support for this provision. Some delegations suggested drafting changes in paragraph (1)(iv) concerning drawings. Regarding paragraph (3), a majority of delegations expressed the view that the abstract should serve the purpose of information only.

Draft Rule 4: Further Requirements Concerning Contents and Order of Description Under Article 5(2)

45. The Representative of the EPO stated that the word “technical” should be retained in paragraph (1)(i) and (iii). The Delegation of the United Kingdom expressed general concern about the detailed mandatory requirements contained in this Rule, since what the description needed to achieve was to clearly state what the invention intended to accomplish. In the view

of the Delegation, the draft Rule imposed an unnecessary burden on applicants and should contain maximum requirements only.

46. The Representative of the EPO pointed out that the proposed deletion of the word “preferably” in item (ii) of paragraph (1) would mean that the situation where an applicant did not cite a background art document would constitute a ground for invalidation of the application or revocation of the patent under draft Articles 13 and 14, since draft Article 5 was expressly referred to in those provisions. The Delegation of the United States of America noted that matters concerning fraud were explained in Note 2.01 and suggested maintaining the term “preferably.” In this context, the Delegation referred to its separate document citation system which required applicants to disclose prior art documents. The Delegation of Japan supported the deletion of the term “preferably,” since it would facilitate examination, but opposed the fact that non-compliance with item (ii) should be a ground for revocation of the patent.

47. Concerning item (iii) of paragraph (1) in relation to paragraph (2), the Delegation of the United States of America queried whether there was an obligation under this Rule to describe the invention using a problem-solution approach. In response to the explanation of the International Bureau that Offices were allowed to request applicants to describe the invention as set forth in paragraph (1)(iii), but were free to accept, or should accept in certain cases, a different presentation of the invention in light of paragraph (2), the same delegation stated that paragraph (2) should be the general rule, and that paragraph (1)(iii) should be the exception. This position was supported by the Representatives of ABA, AIPLA and BIO, who also stated that, although a majority of applications would contain elements of the problem and the solution, the problem-solution approach was not an appropriate way of presenting the invention in certain cases, and that an approach as broad and inclusive as possible should be adopted, rather than forcing the applicant to use such an approach. The Delegation of France, supported by the Representative of the EPO, stated that, in the interest of clarity and of legal certainty for third parties, the problem-solution approach should be maintained as the general rule. The Delegation of the Russian Federation, supported by the Representative of the EAPO, suggested that paragraph (1)(iii) should reflect that this was the preferable way of describing the invention. The International Bureau pointed out that the objective was to make life easier for applicants, but that, if there was no standard accepted by all Offices, there was no harmonization for applicants. The Delegation of Germany proposed that paragraph (2) be the general rule and that paragraph (1)(iii) be a preferable solution. The Delegation of Ireland suggested adding the words “unless, because of the nature of the claimed invention, a different manner would afford a better understanding of the claimed invention” at the end of paragraph (1)(iii). The Representative of CIPA said that this Rule was too mandatory on issues that were not actually important and that the Regulations should include the mandatory parts, while the practice guidelines should contain the practices that should be preferably followed.

48. The Chair summarized the discussion as follows: In addition to some drafting suggestions, the discussion showed the need to establish provisions which provided a balance between adequate flexibility for users to draft the description on the one hand and adequate support for the efficiency of offices on the other. In light of the divergent views expressed, the challenge lay in how to reconcile these positions. In addition, the question whether the provisions under this Rule should constitute grounds for invalidation or revocation of a patent or not needed to be carefully reviewed.

Draft Rule 5: Further Requirements Concerning Claims Under Article 5(2)

49. In response to a suggestion by the Delegation of the United States of America that paragraph (1) be deleted because of its formal nature, the International Bureau explained that the provision had been included because it deviated from PCT Rule 6.1(b).

50. The Representative of the EPO, supported by the Delegations of the Russian Federation and the United States of America, proposed the deletion of the term “technical” in paragraphs (2) and (3)(i). This proposal was opposed by the Delegation of Colombia, which wished, if possible, to maintain this term. The Delegation of France proposed to delete the second part of paragraph (2), since there was no need to differentiate between the terms “features” and “limitations.” The Delegation of the United States of America supported the wording of paragraph (2) as proposed, but suggested that the explanation contained in Note R5.03 on the terms “features” and “limitations” could be used to establish some kind of definition provision on those terms. The Delegation of the Russian Federation, although preferring the terms “elements or steps,” supported the approach put forward by the Delegation of the United States of America. The Delegation of Germany supported the Delegation of France as to the wording of paragraph (2), and reiterated the reservation it had made at the previous session of the Committee.

51. The Delegation of Japan sought clarification as to why a reference to drawings in the claims was allowed under paragraph (4)(c), while paragraph (4)(b) prohibited the inclusion of drawings as such in the claims. The Delegation of Australia expressed the view that drawings should not be excluded from the claims as provided in paragraph (4)(b). The Delegation of the United States of America stated that drawings should not be permitted in the claims. In its view, there was a difference between drawings and graphs, since the latter constituted only a pictorial representation of a table, while drawings could be too broad to define the boundaries of the claim. On paragraph (4)(c), the Delegation of Ireland queried whether the term “limitation” was correct in this context, and the Delegation of Germany requested that an explicit link be made between this subparagraph and draft Rule 12(3). Following a question from the Delegation of the United States of America on the proposed deletion of subparagraph (d), the International Bureau explained that the matters dealt with in that subparagraph were considered to be incorporated from the PCT via draft Article 5(2).

52. The Chair summarized the discussion as follows: The Committee agreed that the word “technical” in paragraphs (2) and (3)(i) should be deleted. Concerning the terms “features” and “limitations,” the International Bureau should review the use of these terms in view of the explanation given in Note R5.03. A proposal to allow drawings to be included in the claims had received little support.

*Draft Article 6: Unity of Invention**Draft Rule 6: Details Concerning the Requirements of Unity of Invention Under Article 6*

53. No discussion was held on these provisions, noting that their substance was under consideration by the Working Group on Multiple Invention Disclosures and Complex Applications (see paragraphs 209 and 210, below).

Draft Article 7: Observations, Amendments or Corrections of Application

Draft Rule 7: Time Limit Under Article 7

Draft Article 7(1) and (2) and draft Rule 7

54. The Delegation of Australia, supported by the Delegation of the United States of America and the Representatives of AIPLA, AIPPI and PIPA, proposed that draft Article 7, with appropriate modifications, be extended to also cover amendments and corrections of patents, while ensuring, for example, that the scope of the patent claims could not be broadened. The Delegations of China, Germany and the Russian Federation were not in favor of the extension of draft Article 7 to post-grant corrections and amendments because of the different nature of patent applications and patents. The Delegation of Chile and the Representative of the EAPO stated that they would support the inclusion of provisions concerning amendments and corrections of patents only if they were limited to clear mistakes. The Delegation of Brazil said that, once a patent was granted, the claims should not be able to be extended. The Delegation of China was of the view that a mistake made by the Office should be correctable even after the grant of the patent. The Delegation of Switzerland reserved its position on the matter.

55. The Delegation of the United States of America supported the inclusion of paragraph (1)(b), which merely controlled, under the liberal continuation practice, the continuation of applications without any appropriate amendment in response to a notification of the Office. The Delegation of Australia, supported by the Delegation of Germany, suggested that the words “same requirement” be replaced by the words “same area of defect.” The Representative of CIPA and EPI, supported by the Delegation of the Russian Federation and the Representatives of AIPPI and BIO, was of the opinion that reference to divisional applications should be deleted from paragraph (1)(b), while the Delegation of the United States of America suggested that these concerns be accommodated in the Notes. The Delegation of Japan reserved its position on paragraph (1)(b).

56. In response to the Representative of the EPO, who queried whether the office of a Contracting Party was allowed to provide additional opportunities to make amendments by way of informal notification (e.g., telephone calls by examiners), the Chair noted that paragraph (1)(a) might need to be more explicitly user-friendly by providing extra opportunities.

57. The Delegation of Singapore, whose Office did not have in-house substantive examiners and recognized search reports and examination reports prepared by other Offices, raised a concern about the second part of paragraph (2) which set out requirements for a Contracting Party that provided for substantive examination. The Delegation of Switzerland also raised a concern about the applicability of that part to its Office, as it did not conduct a full examination of an application, but examined whether amendments included new matter or not, and suggested the deletion of any reference to substantive examination in paragraph (2).

58. Referring to Note 7.04, the Delegation of the United States of America, supported by the Delegation of New Zealand, stated that the timing “when the application is in order for grant” in paragraph (2) should not be tied to the timing of the publication, but should rather be linked to the notice of allowance. In response to the Delegation of Germany, the Chair noted that a Contracting Party would be free to provide longer time limits than those prescribed in paragraph (2) and that the provision should be redrafted in order to explicitly refer to such a possibility. The Delegation of Canada proposed that paragraph (2) be subject to the

Regulations which would provide the types of amendments and the scope of amendments allowed. The Delegation of Sudan supported the text of paragraph (2) as proposed in document SCP/7/3.

59. The Delegation of the United States of America stated that draft Article 7 should not cover provisional applications of the kind provided for under its national law. The Chair noted that Australian law also provided for provisional applications and that the requirements for such applications were considerably curtailed compared with those applicable to standard patent applications.

60. The Chair summarized the discussion on draft Article 7(1) and (2) and draft Rule 7 as follows: Although there was general acceptance that paragraph (1)(b) should stay in some form, the drafting of that paragraph needed to be reviewed in terms of its applicability to divisional applications and in respect of the words “same requirement.” Concerning paragraph (2), a number of delegations expressed the need to clarify the words “in order for grant” and “substantive examination.” Although the proposal made by one delegation to extend draft Article 7 to the post-grant stage did not receive wide support, the International Bureau was requested to explore the feasibility of including provisions relating to the correction of patents in at least some cases.

Draft Article 7(3)

61. The Delegation of Germany, supported by the Delegations of China, Ireland and Morocco, and the Representatives of the EPO and EPI, opposed the inclusion of an abstract as a source of disclosure under draft Article 7(3)(a), even if it was prepared by the applicant, since the consequence of such inclusion, for example, would extend the concept of “whole contents” under draft Rule 9(1)(b) to the abstract, could have adverse effects and would change the way in which abstracts were drafted in the future. The Delegation of France did not support the inclusion of abstracts in paragraph (3)(a) as it might worsen the quality of the abstracts. The Delegation of Japan expressed reluctance to include abstracts in view of the burden for examiners to check abstracts and because of legal uncertainty for third parties. The Delegation of the United States of America, supported by the Representative of ABA, welcomed the inclusion of the abstract as a source of disclosure, and explained that the courts in its country used the abstracts to interpret claims, although the main purpose of the abstracts was to provide information. It further suggested that abstracts be viewed as a part of the description of the application during the pre-grant examination and post-grant validity procedures.

62. The Delegation of the Russian Federation wondered whether the phrase “where prepared by the applicant” in paragraph (3)(a) was superfluous, since the applicant was responsible for the preparation of the application, including the abstract. The Delegation further sought clarification concerning the meaning of the words “going beyond the disclosure” and the applicability of this paragraph to corrections and amendments of the request. The Delegation of China suggested that the reference to the missing part of the description or the missing drawing be deleted from paragraph (3)(a).

63. Concerning the alternative terms within square brackets in paragraph (3)(b), the Delegations of Sweden and the United States of America expressed preference for the word “anyone.” The Delegation of the United States of America explained that it wished to limit the term “clear mistake” to mistakes of a clerical nature. That Delegation, supported by the Representative of the EPO, further stated that subparagraph (b) should clarify that only one

possibility for correction of a clear mistake had to be provided as in the case of PCT Rule 91.1(b). The International Bureau noted that PCT Rule 91.1(b), according to which a rectification could only be made where “anyone” would “immediately” realize that nothing else could have been intended than what was offered as rectification, was very difficult to apply. The Delegations of Australia, Brazil, Colombia, Japan, the United Kingdom and the Representative of the EPO were in favor of the alternative “a person skilled in the art.” The Delegation of Chile suggested the words “any person normally familiar with the subject matter.” The Representative of AIPPI said that this provision should not apply in cases where only the applicant found the correction to be obvious.

64. The Delegation of Canada proposed that the substance of paragraph (3)(b) be moved to the Regulations and that the reference to the missing part of the description and missing drawing in subparagraph (a) be included in subparagraph (b). The Delegation of the United Kingdom wondered why the word “amendment” was included in paragraph (3)(b).

65. The Chair summarized the discussion on draft Article 7(3) by noting that the possibility of amendments or corrections on the basis of the abstract prepared by the applicant on the filing date had received little support. As regards subparagraph (b), many delegations expressed their preference for the words “a person skilled in the art” over the word “anyone.”

Draft Rule 2: Person Skilled in the Art Under Articles 7(3)(b), 10(1), 11(3)(b) and (4)(a) and 12(3), and Rules 1(c)(i), 4(1)(vii), 10(iii), 12(5), 14(1)(ii), (2)(a) and (b) and 15(2), (3) and (4)

66. The International Bureau suggested deletion of the phrase “to have access to and to understand all prior art under draft Article 8, and.” The Representative of CEIPI suggested mentioning first general knowledge and then ordinary skills.

67. The Chair noted that there was general agreement on this Rule and that it was ready for adoption with the changes proposed by the International Bureau and the Representative of CEIPI.

Draft Guidelines Under Rule 2

68. The Delegation of Japan, supported by the Delegation of the United States of America, proposed to delete in Guideline G1.02, line 6, the word “average.” The Delegation of the United States of America, supported by the Representative of the EPO, proposed replacing the word “required” by the word “deemed” in the last sentence of Guideline G1.01. It also requested the deletion of the phrase “referred to in Rule 2” in Guideline G1.03, since that draft Rule did not contain any reference to a team of persons. In addition, the Representative of the EPO wished to add, at the end of the third sentence in Guideline G1.02, the phrase “in which case the specialized person in that field is the appropriate person skilled in the art.”

69. The Chair summarized the discussion on these draft Guidelines by noting that there was fundamental agreement, subject to some drafting changes.

Draft Article 8: Prior Art

Paragraph (1)

70. The Delegation of the United States of America, supported by the Representative of IIPS, generally supported the definition in draft Article 8(1) but wished to include admissions by the applicant and the concept of “loss of rights” in the definition of prior art. In its view, a patent should not be granted to an invention which had been protected as a trade secret for a long period. The Representative of the EPO, supported by the Delegations of France, Germany and Japan, was not in favor of the inclusion of a loss of rights provision, which was not necessary in a first-to-file system. The Delegation of Australia observed that its country had such a provision in its law under a first-to-file system.

71. The Delegation of Denmark wished the word “relevant” to be deleted. The Delegation of Germany suggested deletion of the phrase “as prescribed in the Regulations,” since the phrase “in the world in any form” seemed to be sufficient.

72. The Chair summarized the discussions on draft Article 8(1) as follows: Some drafting issues were raised and the debate focussed on the question of secret prior use and whether it should be part of the prior art. Although two delegations and the representative of one non-governmental organization were in favor of including a provision on loss of rights, the majority of delegations were against such inclusion.

Paragraph (2)

73. The International Bureau proposed a revised paragraph (2) which read as follows:

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

(b) If the filing date of an application (“earlier application”) filed in, or with effect for, a Contracting Party is the same as, or later than, the claim date of a particular claim contained in another application filed in, or with effect for, the same Contracting Party, but the earlier application claims the priority of a previous application having a filing date that is earlier than the claim date of the claim, subject matter that is contained in both that earlier application and the previous application shall form part of the prior art for the purpose of determining the novelty of the claimed invention, provided that the earlier application or the patent granted thereon is published subsequently by the competent authority, as prescribed in the Regulations.”

74. The Delegation of the United States of America, supported by the Representative of AIPLA, was of the opinion that the prior art effect of earlier applications should apply when assessing both novelty and non-obviousness, since more than one patentee might hold patents

which were not distinct. It also noted that paragraph (2)(b) was inconsistent with the current law of the United States of America, which, however, was under further consideration.

75. In response to the Delegation of the United States of America, which queried whether the words “filed in” also referred to an international application which was filed under the PCT with the receiving Office of a country but did not designate that country, the International Bureau drew attention to the words “with effect for” and to draft Rule 3 which made a specific reference to draft Article 8(2). The Representative of CEIPI noted that, if a PCT application was filed with the United States Patent and Trademark Office as a receiving Office, but did not designate the United States of America, it was “filed in” but had no “effect for” the United States of America, and he suggested changing the wording in order to make a clear distinction between national applications on the one hand and regional and international applications on the other. The Delegation of the United States of America stated that the terms “filed in” and “with effect for” should be further clarified. The Representative of the EPO, supported by the Representative of FICPI, suggested that, since the purpose of this paragraph was to prevent cases of double patenting, the reference to draft Article 8(2) in draft Rule 3 be deleted, so that only PCT applications that had entered the national phase would be covered.

76. The Delegation of Australia wondered whether information contained in the application as filed but removed before publication of the application, which should not have a prior art effect, had been covered. The International Bureau suggested replacing the words “provided that” by “to the extent that.”

77. The Delegation of Chile noted that some clarification in the Spanish text, vis-a-vis the English text was required.

78. The Chair summarized the discussion on draft Article 8(2) by stating that the revised text of the provision, as submitted by the International Bureau, found agreement in principle. The following specific issues were raised: The first one concerned the phrase “filed in or with effect for” in relation to international applications under the PCT, and, in particular, to an international application which was filed in a country that was not designated. The second issue concerned the proposal by one delegation to expand the scope of the provision to include inventive step. The Chairman recalled that the issue had been discussed at some length at the previous session of the Committee, and that a strong majority had expressed the wish to limit the provision to novelty.

Draft Rule 8: Availability to the Public Under Article 8(1)

79. Regarding paragraph (1), the Delegation of the United States of America proposed to add reference to communications in electronic form.

80. The Delegation of Germany, supported by the Delegations of Chile, Japan and the United States of America, was in favor of maintaining the word “reasonable” in paragraph (2)(a) and saw some parallel with the term “undue,” both terms meaning that one should not have to apply excessive efforts. The Delegation of New Zealand, however, expressed concern about the lack of definition of the term “reasonable.” The Representative of the EPO, supported by the Delegation of Ireland, proposed the deletion of the word “reasonable” in order to avoid legal uncertainty. The Delegation of the United Kingdom noted that the test of determining what constituted a “reasonable possibility” was not simple.

The Delegation of the Russian Federation expressed preference for the word “legitimate” instead of the word “reasonable” or for the use of both terms.

81. Concerning paragraph (2)(b), the Delegation of China pointed out that, in China, information disclosed by the inventor to a friend would not be considered as information having been made available to the public. The Delegation of the United States of America, noting that “any person” could be a single person, but that some amount of circulation of the information should be required for it to become part of the prior art, sought further clarification of the expressions “any person” and “made available to the public.” The Representative of the EPO agreed with the general concept of this subparagraph, but preferred a wording reflecting that no obligation to maintain secrecy should be imposed, to the present phrase “free to disclose.”

82. Summarizing the discussion, the Chair noted that a number of delegations wished to delete the word “reasonable,” but that the majority of delegations who spoke were in favor of keeping the present wording. One delegation suggested replacing “reasonable” by “legitimate.” There was a drafting suggestion to include reference to electronic communications in paragraph (1), and reference was also made to Guideline G2.06.

Draft Guidelines Under Rule 8

83. The Delegation of the United States of America suggested to replace the word “possible” by the expression “reasonably possible” in line 3 of Guideline G2.06, and to replace the expression “a member of the public” by “the public” in Guidelines G2.03 to G2.06 for reasons of consistency between the Rules and Guidelines. The Representative of the EPO proposed to delete the words “In other words” in the last sentence of Guideline G2.04, and queried whether, in the second last line of Guideline G2.04, reverse engineering without undue burden was intended to be covered.

Draft Rule 9: Prior Art Effect of Earlier Applications Under Article 8(2)

Paragraph (1)

84. Following the changes introduced by the International Bureau on draft Article 8(2), the International Bureau suggested that paragraph (1)(a) and (b) be combined into a single paragraph as follows:

“(a) The whole contents of an earlier application referred to in Article 8(2) shall consist of the description, claims and drawings and, where it was prepared by the applicant, the abstract, on the filing date.”

85. The Delegation of Japan opposed the provision in paragraph (1)(b) for a “prior art effect” based on the abstract, whether or not it was prepared by the applicant. The Delegation of Germany also opposed this provision, observing that to provide for such a “prior art effect” of an abstract would add a significant legal consequence flowing from the preparation of the abstract. In addition, it would be necessary to decide to what extent an abstract had been “prepared by the applicant” in a case where the abstract had been partly amended by the Office. The Representative of EPI, supported by the Representative of AIPPI, suggested that the words “where it was prepared by the applicant” should be replaced by “filed with the application.”

86. The International Bureau suggested that the proviso in paragraph (1)(c) should be amended to read: “provided that the applicable law allows for one of those titles to be validly granted with effect for a Contracting Party for the same claimed invention.”

87. The Delegation of the United States of America stated that it should be clarified in the Notes that the term “any other title protecting an invention” used in paragraph (1)(c) should not be interpreted to include plant patents and design patents provided for under its national law. The Representative of EPI suggested that this paragraph should not oblige national laws to prevent an applicant from obtaining double protection for an invention in the form of a patent and a utility model.

88. The Chair summarized the discussions on paragraph (1) as follows: There was general support for this paragraph with the amendment suggested by the International Bureau. In view of the concerns expressed concerning the “prior art effect” of an abstract, the reference to the abstract in paragraph (1)(a) as amended should be placed in square brackets and the matter explained in the Notes. In addition, the term “any other title of the invention” in paragraph (1)(c) should be explained in the Notes.

Paragraph (2)

89. No comment was made on this paragraph.

Paragraph (3)

90. The Delegation of the United States of America sought clarification as to the operation of paragraph (3) in cases where the earlier application had been erroneously published despite the fact that it had already been withdrawn. The Delegation of Canada agreed and suggested that, if this provision were retained, the words “with no rights outstanding” should be added after the words “no longer pending.”

Paragraph (4)

91. The International Bureau explained that the words “or the invention identified in” had been re-introduced to cover the situation in which the inventor was the same but the applicant was different, for example, because the inventor had changed his employer. The Representative of the EPO noted that a proposal to include the concept of anti-self-collision in the corresponding provision of the European Patent Convention had been rejected and suggested that the paragraph should be included in square brackets. The Delegation of the United States of America suggested that, in order to prevent “double patenting,” the paragraph be retained but revised to cover inventions that were not patently distinct. The Delegation of Japan supported this suggestion and noted that it was unclear whether the words “the inventor identified in the earlier application” were meant to refer to the true inventor. The Representative of EPI opposed the inclusion of any anti-self-collision clause along the lines of paragraph (4).

92. The Chairman summarized the discussions on paragraph (4) as follows: There were divergent views on this paragraph; in particular, one representative had suggested that it be presented in square brackets, while two delegations had expressed support for it subject to further amendment and clarification.

*Draft Article 9: Information Not Affecting Patentability (Grace Period) [Alternative A]
Grace Period [Alternative B]*

General discussion

93. Although differences as to the modalities were expressed, the principle of including a provision on the grace period found wide support, in particular from the Delegations of Austria, Brazil, Canada, Chile, China, France, Germany, Ireland, Romania and the United States of America and the Representatives of ABA, AIPPI, BIO, FICPI and IIPS.

94. The Delegations of Belgium, Finland, Ireland and Spain stated that they were not yet in a position to express an official position, due to ongoing discussions internally and/or within the European Union. Several delegations and the representative of one non-governmental organization expressed preference for Alternative A, while the representative of another non-governmental organization was in favor of Alternative B. The Delegations of Romania and Sweden expressed a preference for a period of six rather than twelve months. The Delegation of Sweden stated that a grace period could only be envisaged if the first-to-file system was also included in the SPLT. The Delegations of France, Germany and Sweden were in favor of a grace period which was limited in scope, insofar as it should only constitute a safety net for applicants.

95. The Delegation of the United Kingdom pointed out that, while it was not in a position to take any clear position at this stage, it was important to determine the objective of a grace period, for example, whether it should be a safety net for applicants, in which case a short grace period might be sufficient, or whether it should be broader, for example, providing the possibility for applicants to develop an invention in public. The delegation suggested that the question was an issue both for Offices and for non-governmental organizations.

Discussion on specific parts of draft Article 9

96. The Delegation of the United States of America, supported by the Delegation of Germany, suggested deletion of the words “and should not have been made available to the public by the Office,” in paragraph (1)(ii)(a).

97. Concerning paragraph (3), the Delegation of China raised an issue related to the following situation: if, some time after the grant of the patent, a third party alleged invalidity, submitting evidence from a publication by the patentee in another country, the patentee could then allege that the publication abroad was derived directly or indirectly from him/her. In this case, it would be very difficult for third parties to provide counter-evidence and for the court to make a judgement. According to the Delegation, a solution could be to consider placing an obligation on the applicant to record his/her disclosures to the public. The Representative of AIPPI opposed the inclusion of paragraph (3) on the ground that it would create legal uncertainty.

98. The inclusion of a provision on third parties' rights, along the lines of proposed paragraph (4), was supported, in principle, by the Delegations of Australia, Austria, Canada, China, Finland, France, Germany, Romania and Sweden and the Representative of FICPI, some of whom stressed the importance of striking a balance between the rights of applicants and those of third parties. The Delegations of Chile and the United States of America and the Representatives of ABA, BIO and IIPS opposed the inclusion of such a provision on the grounds that this matter related to infringement issues. The Delegation of Australia proposed

the deletion of the words “for the purpose of his business.” The Delegation of Canada questioned the meaning of the term “use” in the last line of the paragraph, while the Delegation of Sweden proposed replacing this term by the expression “start to use.” The Delegation of Romania proposed the inclusion of the words “to continue the” before the word “use” whereby such use may be continued for the same purpose and in the same volume as provided under the Paris Convention. The Delegation of France stated that it would submit alternative wording for paragraph (4) for consideration at the next session of the Committee.

99. The Delegation of the United States of America proposed the inclusion of an additional paragraph which would allow for public experimental use, even if it had taken place before the grace period. The Representative of the EPO opposed this proposal, noting that it would constitute a significant departure from the principle governing prior art under draft Article 8.

100. The Chair summarized the discussion as follows: There had been little discussion on the preference for either Alternative A or B, but Alternative A seemed to receive more support. While a number of delegations indicated that the domestic debate as to the desirability of providing for a grace period was still going on in their countries, no strong suggestion was expressed that no grace period at all should be included. Many delegations indicated that the inclusion of a provision on third parties’ rights was critical, while a few delegations were opposed to such a provision since it related to infringement. There seemed to be a feeling that the grace period should be limited in scope and constitute a safety net for applicants only, although one delegation wished to extend the scope to include public experimental use. As far as duration was concerned, some delegations favored a period of six months while others preferred twelve months.

Draft Article 10: Enabling Disclosures

101. In response to the Representative of AIPPI, the International Bureau explained that it had been the understanding that the PCT would be adjusted accordingly in the future if the Committee found that the provisions under the SPLT should be expressed differently from those under the PCT. The International Bureau further explained that draft Article 10(1) of the SPLT derived from Article 5 of the PCT, whereas the second part of draft Article 10(1) corresponded to the PCT Regulations with the difference that the SPLT referred to the “claimed invention” and the PCT to the “invention.” Moreover, in draft Article 10(1) of the SPLT, the requirement applied to the application, whereas in Article 5 of the PCT the requirement applied to the description. Although revision of the Articles of the PCT would require a Diplomatic Conference, the PCT Regulations could be amended by the PCT Assembly.

102. The Delegation of Germany expressed support for the present wording of draft Article 10. The Delegation of Colombia expressed acceptance of the general contents of the Article, but requested further elaboration on the term “undue experimentation.” In response to a query by the Chair whether the second part of paragraph (1) should be moved to the Regulations, the Representatives of CEIPI and the EAPO supported such reallocation. The Representative of CEIPI was also in favor of moving paragraph (2) to the Regulations and noted that amendments of certain Rules could be subject to unanimity or a qualified majority. The Delegation of the United States of America wished to retain the term “undue experimentation” in the Article, but would not object to further clarification of the term. The Delegation also stated that the provisions of the SPLT should not be constrained by the PCT, and reminded the Committee that the objective of the SPLT was to establish best practice.

103. The Delegation of Spain expressed preference, in the Spanish text, for the expression “experimentación excesiva” instead of “experimentación indebida” which would correspond more closely to the French text. As to the title of the Article, it suggested the expression “suficiencia de la divulgación” as in draft Rule 10. The Representative of the EPI proposed to replace the words “the invention” by the words “the whole of the invention” in the second last line of paragraph (1).

104. The Chair summarized the discussion as follows: There was broad agreement on the principles of this Article and some express support for those provisions over the PCT. What should go in the Article and in the Rules was rather a drafting issue, which would need to be decided at a later point in time. Some comments were made on the use, and necessity for clarification of, the expression “undue experimentation.”

Draft Rule 10: Sufficiency of Disclosure Under Article 10

105. In response to the Representative of MPI, who expressed concern as to the use of the expression “make or use” in item (vi), the International Bureau explained that this was a linguistic question which would be taken into consideration when redrafting the provision.

106. The Delegation of Chile noted the expressions “experimentación indebida” in the Spanish text and “expérimentation excessive” in the French text and suggested that the same expression be used in both languages. The Delegations of Belgium and France and the Representative of AIPPI were in favor of the term “excessive” in French. The Representative of the EPO suggested looking at court decisions for the terminology to be used.

107. In his summary of the discussion, the Chair noted that this Rule was ready for adoption, subject to the question of the terminology to be used in the French and Spanish texts to translate “undue experimentation.”

Draft Rule 11: Deposit of Biologically Reproducible Material Under Article 10

Paragraph (1)

108. The Delegation of China, supported by the Delegation of Spain and the Representatives of the EC, EPI and EPO, expressed concern about the draft which they felt did not accurately reflect the objectives of the provision. From the present wording, it could be understood that, where an application related to biological material, it did not matter how such material was described in the application, as long as a deposit had been made, and this did not appear to be satisfactory.

Paragraph (2)

109. The International Bureau suggested replacing, in paragraph (2)(b), the phrase “Where the deposit is made in a manner compliant with Article (3)” by the phrase “Where the disclosure of the deposited biologically reproducible material, to the extent to which it is taken into account for the purpose of Article 10(1), is compliant with Article 7(3).”

110. The Delegation of the United States of America expressed concern regarding the first part of the paragraph which it felt did not reflect the idea that, if a Contracting Party accepted a deposit, subject to evidentiary proof, such deposit would be considered to be compliant with draft Article 7(3) and would not constitute additional matter. The Delegation opted for the

term “shall” as it considered the making of a deposit to be a purely administrative matter and stated that paragraph (2) provided the best practice, since it would leave some flexibility and, due to the corroboration requirement, it would not make any difference to the examiner whether the deposit was made before or after the filing date of the application.

111. The Representative of the EPO preferred the term “may” and noted that the priority rules applied by the EPO did not allow deposits made after the filing date to be considered for priority purposes. The Representative explained that European applicants would generally deposit biological material when certain subject matter could not otherwise be disclosed in the description. Therefore, since the deposit was an issue of disclosure, paragraph (2)(b) might be a trap for applicants if the deposit was necessary to make the invention enabling. The Delegations of Australia, Germany, Japan, Spain, Sudan and Sweden and the Representatives of the EC and EPI also preferred the term “may.”

112. The Delegation of the United States of America pointed out that PLT Article 5(7), which provided for filing by reference, opened the way for some flexibility in draft Rule 11(2)(b) and for a transfer from an independent deposit to a dependent deposit.

113. The Delegation of the United Kingdom, sharing the concerns of other delegations regarding the use of “may” or “shall,” noted that, for the benefit of harmonization, the International Bureau should attempt to find a text acceptable to all retaining the word “shall.”

114. The International Bureau noted that it had not been the intention to enable the addition of new matter under draft Rule 11(1), and this was reflected in the phrase “to the extent that this requirement cannot otherwise be complied with.” Draft Rule 11(2) had to be understood as allowing a deposit after the filing date under certain conditions. Even if the invention was disclosed in the description as fully as possible, a deposit might be needed in order to enable the making and using the claimed invention. The revised wording of draft Rule 11(1) was intended to achieve this. One should pay attention not so much to the “disclosure” but rather to the “sufficiency” of that disclosure.

115. The Chair summarized the discussions as follows: The Committee felt that the present wording did not meet the objectives sought and that the provision needed to be redrafted to better express the circumstances in which a deposit was required. Whereas, regarding paragraph (2)(b), one delegation expressed a strong preference for the term “shall,” most delegations which expressed their views were in favor of the term “may.”

Draft Article 11: Claims

Paragraph (1)

116. The Delegation of the Russian Federation expressed the view that the role of paragraphs (1) and (2) was not clear in the context of the Treaty and that the wording of these paragraphs was not appropriate. In particular, it was not clear what obligations these paragraphs placed on Contracting Parties, for example, in respect of grounds for revocation. The Chair noted that the grounds for revocation under draft Articles 13(1)(ii) and 14(1) included non-compliance with the requirements of draft Article 11(2) but not the requirements of draft Article 11(1).

117. The Delegation of the United States of America suggested that the words “subject matter for which protection is sought” be replaced by the words “subject matter which the

applicant regards as his invention,” in line with the wording in Note 11.01. However, the Delegations of Chile, Colombia, France, Germany, Ireland, Morocco and Sudan and the Representatives of the EAPO and EPO supported the terminology as proposed. The Delegation of Chile noted that paragraph (1), as well as paragraph (2), was a mandatory provision.

118. The Chair summarized the discussions on paragraph (1) as follows: The wording of paragraph (1) should be retained as proposed, but the International Bureau should review the wording of Note 11.01 with a view to achieving deeper harmonization.

Paragraph (2)

119. The International Bureau observed that, as stated in the footnote to this paragraph in document SCP/7/3, the text of this draft Article would be affected by the discussions in the Working Group on Multiple Invention Disclosures and Complex Applications (see paragraphs 209 and 210, below).

120. The Delegation of the United States of America, supported by the Delegation of Australia, noted that the Working Group would not be considering the matters of clarity and conciseness of individual claims. It observed that the wording in Note 11.03 was useful in the context of harmonization of best practice and suggested that this wording should be incorporated into paragraph (2) or the Regulations.

121. The Chair summarized the discussions on paragraph (2) as follows: The wording of this paragraph should be retained as proposed, but the International Bureau should elaborate the Regulations on the basis of the explanations contained in the Notes.

Paragraph (3) and draft Rule 11bis

122. Discussion of paragraph (3) was based on the text of draft Article 11(3) and draft Rule 11*bis* that had been suggested by the International Bureau in document SCP/7/6, rather than on draft Article 11(3) as contained in document SCP/7/3.

123. The Representative of the EPO suggested that the word “claims” presented in square brackets be deleted from both draft Article 11(3) and draft Rule 11*bis* since it was not possible for a claim in a granted patent to be self-supporting. If an otherwise allowable claim in the application as filed was not supported by the disclosure of the description and drawings, then the appropriate procedure would be to amend the description to include the disclosure contained in that claim. This view was supported by the Delegations of Germany and Japan. The Delegation of the United States of America, however, stated that the originally filed claims should be able to support the claimed invention, even if the content did not appear in the description.

124. The Delegation of China observed that, if the embodiments of the invention contained in the description omitted a special feature of the invention that was indispensable, the claims would not be supported by the description and drawings. It stated that the definition of “support” contained in the EPO Guidelines appeared preferable to that contained in draft Rule 11*bis*.

125. The Representative of FICPI, supported by the Delegation of the United Kingdom, stated that draft Rule 11*bis* as worded added nothing to the general principle of enabling

disclosure already contained in draft Article 10(1). The Delegation suggested that additional effect be given to the fundamental principle concerning the relationship of the claims to the disclosure in line with the contents of paragraph 40 of document SCP/7/6. He also suggested that account be taken of the protection afforded by claims in respect of equivalents under draft Rule 12(5).

126. The Delegation of Ireland referred to the need to take account of applications in respect of which a deposit of microorganisms had been made.

127. The Delegation of the United States of America suggested that the word “recognized” in draft Rule 11*bis* be replaced by “possessed and adequately described.”

128. The Delegations of Germany and Japan suggested that the International Bureau review the Guidelines and Notes in the light of the changes to draft Article 11(3) and the addition of draft Rule 11*bis*.

129. The Chair summarized the discussions on draft Article 11(3) and draft Rule 11*bis*, as contained in document SCP/7/6, as follows: There was general agreement in principle on these provisions as proposed. There had been no support for the suggestion that the word “recognized” in draft Rule 11*bis* should be replaced by “possessed and adequately described.” However, the International Bureau should review the text of these provisions, in particular with reference to the term “claims” in square brackets and the deposit of microorganisms. The International Bureau should also review the corresponding Guidelines and Notes, taking account of the changes to paragraph (3) and the addition of draft Rule 11*bis*.

Paragraph (4)

130. The International Bureau explained that, although the draft Treaty did not contain provisions on infringement *per se*, it was intended that the provisions of draft paragraph (4) should also apply to the interpretation of claims in infringement proceedings.

131. The Delegation of Japan expressed concern that the provisions of paragraph (4) were too detailed and would unduly inhibit a court in making a decision based on the facts of the case.

132. As regards the use of the terms “primary basis” and “secondary basis” in paragraph (4)(a), the Representative of MPI, supported by the Delegations of Chile and Germany, stated that the objective of the paragraph should address the methodology to be employed in the interpretation of claims and not to establish an order of precedence of one term over the other. The Delegation of Spain suggested that the word “basis” in paragraph (4)(a) should be interpreted as “elemento” in the Spanish text.

133. The Representative of FICPI suggested that the reference to draft Article 7 in paragraph (4)(a) be deleted, since its inclusion appeared to exclude amendments and corrections made after the grant of the patent. The Representative also suggested that the words “as amended and corrected” be amended to read “as amended or corrected” in paragraph (4)(a). The Representative of the EPO, supported by the Representative of GRUR, suggested that the International Bureau review all references to “Article 7” and “Article 7(3)” in the draft Treaty and Regulations to ensure that they were both correct and necessary in each particular context. The Chair noted that the matter might be addressed by including an appropriate definition in draft Article 1.

134. The Delegation of Colombia expressed concern about the provisions for expanding the scope of the claims to equivalents under paragraph (4)(b) and draft Rule 12(5), since that would not be compatible with Andean Resolution 486.

135. The Representative of BIO noted that the provision should capture the principle that due account be taken of prosecution records.

136. The Chair summarized the discussions on paragraph (4) as follows: There was general support for the paragraph in principle, although one Delegation considered that it would unduly inhibit a court in making a decision based on the facts of the case. It was agreed that the International Bureau should review the text of paragraph (4) to ensure that post-grant amendments and corrections were covered, possibly in the context of an added definition in draft Article 1, and to clarify the meaning of the terms “primary basis” and “secondary basis.”

Draft Rule 12: Interpretation of Claims Under Article 11(4)

Paragraph (1)

137. The Delegation of China suggested that paragraph (1)(b) should be deleted on the grounds that it was unnecessary in view of draft Article 11(4)(a).

Paragraph (2)

138. The Delegation of China observed that paragraph (2)(a) might not cover the cases where the claims were expressly limited to the embodiments disclosed in the application.

139. A suggestion by the Representative of FICPI that the words “unless the applicant states” in paragraph (2)(b) should be replaced by “unless the claims expressly state” was opposed by the Delegation of the United States of America on the grounds that paragraph (2)(b) related to statements by the applicant furnished during the prosecution of the application, but not necessarily contained in the application itself.

140. The Chair summarized the discussions on paragraph (2) as follows: There was a common view that the claims should not be interpreted as limited to specific embodiments, and the International Bureau should review the wording of paragraph (2)(b) in this respect. It should also review the wording of paragraph (2)(a) to ensure that it covered claims limited to a specific embodiment.

Paragraph (3)

141. No comment was made on this paragraph.

Paragraph (4)

142. In respect of paragraph (4)(a), the Representative of the EPO observed that, where a means was defined by its function, the requirements of draft Article 10 might not be complied with if much experimentation was required to find out what means could be used to carry out the invention. The Delegations of the Republic of Korea and the United States of America requested that the square brackets be deleted from paragraph (4)(a) and the wording between them retained.

143. The International Bureau suggested that paragraph (4)(b) be deleted, since it related to the determination of patentability and not to the interpretation of claims. The Delegation of the Republic of Korea suggested that paragraph (4)(b) be retained without square brackets.

144. With regard to paragraph (4)(c), the Delegation of the United States of America expressed concern that a product made by a process that included a new step was not distinct from the same product not using that step. As regards paragraph (4)(c) and (d), the Delegation of China observed that even for “product-by-process” or “product-by-use” claims, the general principle should be that any restriction in a claim should not be ignored.

145. The International Bureau suggested that the text of paragraph (4)(d) after the words “such use only” be deleted since it related to the determination of patentability and not to the interpretation of claims. The Delegation of Australia suggested that the word “particular” in paragraph (4)(d) be deleted. The Chair and the Representative of MPI, supported by the Delegation of New Zealand and the Representative of the EPO, pointed out that a claim to a new product for a particular use was not the same as a claim to a new use of a known product; in the first case, the product *per se* would be covered, while in the second case, only the new use would be protected. The Delegation of the United States of America expressed concern about such a distinction between a known and a new product. The Representative of FICPI noted the need to take into account claims in respect of a new medical use of a known substance.

146. The Chair summarized the discussions on paragraph (4) as follows: It was agreed that the square brackets in paragraph (4)(a) should be deleted. Also as regards paragraph (4)(a), it had been observed by one representative that, where a means was defined by its function, the requirements of draft Article 10 may not be complied with if much experimentation was required to find out what means could be used to carry out the invention. The retention of paragraph (4)(b) had been supported by only one delegation; it should therefore be deleted. The International Bureau should review the wording of paragraph (4)(d) in the light of the comments that had been made, in particular, in respect of a new use of a known product, such as a new medical use of a known substance.

Paragraph (5)

147. The Delegations of Austria, Chile, China, France, Germany, the United Kingdom and the United States of America and the Representatives of the AIPLA, BIO, EPO, IIPS, IPO and MPI expressed support for this paragraph in principle.

148. The Delegation of the Russian Federation stated that, while it supported the concept of equivalence, it objected to the inclusion of the paragraph since the Treaty did not deal with infringement of patent rights. The Representative of FICPI stated that the criterion of equivalence in the prosecution of the application should be the same as in infringement proceedings. The Delegation of Austria noted that equivalent elements needed to be considered in the processing of the application, not just in infringement proceedings, and that this needed to be reflected in the provision.

149. The Delegation of Brazil stated that it supported the concept of equivalence, but was concerned that the provision as proposed would restrict the ability of a court to make decisions on a case-by-case basis.

150. The Representative of the EPO stated that, although it supported the principle of equivalence as set out in draft Article 11(4)(b), it considered the provisions of paragraph (5) as too narrow, since they appeared to combine two doctrines applied by different jurisdictions. The Delegation of Germany, supported by the Delegation of Austria, suggested that the two tests under this provision should be alternatives and thus that “and” should be replaced by “or.” In its view, the first test required the interpretation of “substantially the same” function, way and result. This was supported by the Delegation of France which suggested the use of “and/or” and also indicated that it preferred the first of the tests proposed. The Chair observed that it would need to be made clear whether a Contracting Party could choose which option it would apply or whether it would be obliged to apply both.

151. As regards the second test, namely, that it should be obvious to a person skilled in the art that substantially the same result could be achieved by the “equivalent element,” the Delegation of China queried whether this meant that the function of the “claimed element” had to be non-obvious. The Representative of GRUR expressed the opinion that the “equivalent element” must not be inventive. The Representative of AIPLA, supported by the Representatives of BIO, IIPS and IPO were of the view that equivalence should not be based on the criterion of non-obviousness.

152. The Delegation of the United Kingdom, supported by the Representatives of CIPA and EPI opposed the notion of determining equivalence at the time of any alleged infringement, since what was considered to be an equivalent element might change with time in the light of subsequent technological changes. However, the Delegations of Germany and the United States of America and the Representatives of GRUR and MPI supported the time of the alleged infringement as the appropriate time for determining equivalence. In support of this, the Delegation of Germany referred to the situation in which a transistor could be regarded as equivalent to an amplifying valve specified in a claim drafted before the transistor was invented. The Delegation of France suggested that it was not clear whether the time at which equivalence should be determined should be the time at which the patent owner made the allegation of infringement or the time at which the decision on infringement was made.

153. The Representative of GRUR supported the principle of equivalence but suggested that the provisions should be included in the Treaty rather than the Regulations in view of the importance of the principle.

154. The Chair summarized the discussion on paragraph (5) as follows: There was wide support for inclusion of this provision, although a small number of delegations questioned the necessity for it in the SPLT. The following issues, in particular, were raised: whether the two elements in the test should be presented as alternatives; the applicability of the alternatives to each Contracting State; and the location of the provision. Concerning the time at which equivalence should be assessed, a large number of delegations had expressed support for using the time of the infringement, while some were in favor of using the filing date.

Paragraph (6)

155. This paragraph was supported by the Delegation of the United States of America on the grounds that any statement referred to was a part of the public record, of which the courts should take due account. The paragraph was also supported by the Delegations of China, Sudan and Sweden and the Representatives of ABA, AIPLA, BIO and IIPS. However, the Delegation of Germany objected to the inclusion of this provision on the grounds that the doctrine of “file wrapper estoppel” could result in an injustice to the patent owner, since an

applicant who made a statement during prosecution in the absence of an alleged infringement might not be able to foresee the consequences of that statement in the context of such alleged infringement. The Delegation noted that the inclusion of a similar provision in the European Patent Convention had been rejected by a Diplomatic Conference in November 2000. The inclusion of paragraph (6) was also opposed by the Delegations of Austria and the United Kingdom and the Representatives of EPI, the EPO and MPI.

156. The Delegation of the Russian Federation stated that, although it could accept the principle, it was of the view that paragraph (6), like paragraph (5), should not be included in the draft SPLT, since the Treaty did not deal with infringement. The International Bureau noted that the majority of delegations at the previous session of the Committee had agreed that this provision should, as an exception, apply to infringement. The Chair, supported by the Representative of FICPI, also advocated the importance of ensuring consistency on the interpretation of claims during prosecution and infringement proceedings.

157. The Representative of FICPI, supported by the Delegation of China and the Representatives of ABA and BIO, suggested that the statement referred to should be given due account only in the jurisdiction in which it was made. In addition, the Representative of ABA suggested that any statement made in respect of an application should apply to other patents in the same family, such as a divisional patent, in that jurisdiction. The Representative of the IIPS suggested that “actions” in addition to “statements” by the applicant should also be taken into account.

158. The Chair summarized the discussions on paragraph (6) as follows: Those delegations that had a similar provision in their national law supported its inclusion whereas those that did not have such a provision opposed its inclusion. He noted that there had been little discussion on whether or not such a provision would be a good or a bad thing. There had been support for the suggestion that a statement should only be given due account in the jurisdiction that it had been made. It had also been suggested that the statement should apply to other patents in the same family, such as divisional applications and continuation-in-part applications.

Draft Article 12: Conditions of Patentability
Draft Rule 13: Exceptions Under Article 15(5)

Draft Article 12(1), (4) and (5) and draft Rule 13

159. The Delegation of Spain, speaking on behalf of the Member States of the European Union, and supported by the Delegations of the Dominican Republic, Egypt, Ireland, Morocco, Norway, Peru and the Republic of Korea and the Representative of the EPO, stated that paragraph (1)(a) should be restricted to subject matter having a technical character and should not include, for example, business methods. Accordingly, the square brackets in paragraph (1)(a) should be deleted and the words “in all fields of technology” should be retained. The Delegations of Brazil, Cuba, Indonesia, Japan, Mexico and the Russian Federation and the Representatives of AIPPI and GRUR also suggested the retention of the text “in all field of technology” and the deletion of the square brackets. The Delegation of the Russian Federation stated that draft Article 12(1) should provide a minimum standard for conditions of patentability.

160. With regard to paragraph (1), the Delegation of the United States of America stated that, in line with comments it had made at past SCP meetings, it strongly supported the provision of broad patent protection for any new and useful invention. It therefore proposed deletion of

the phrase “in all fields of technology.” The Delegation viewed that phrase in the same manner as it was used in Article 27.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”), that is, to broadly refer to all fields of innovation, and that such a phrase could not, and should not, be restricted to inventions having “technical” character. To the extent that other delegations may have a different view of this phrase, the SPLT was not the proper forum to attempt to resolve or discuss any of these differences, since the goal of the SPLT was to determine clearly-defined best practices as to patentability.

161. The Representative of ABA opposed the inclusion of a requirement of “technical” character in paragraph (1)(a), noting that, in the United States of America, business methods and biotechnological inventions had long been patentable, to good effect. He emphasized that, like all inventions, in order to be patentable, a business method must meet the standards of novelty and inventiveness. The Representative of the AIPLA stated its support for the interventions of the Delegation of the United States of America and of the Representative of ABA. In particular, he supported the grant of patents for inventions in any field of activity, including biotechnology, business methods and computer programs. The Representative of IIPS, supporting the views of the Delegation of the United States of America, stated that there should be no requirement for technical content and that the aim should be to broaden the concept of invention to cover all useful arts, including inventions in “precursor activities.” The Representative of FICPI stated that his organization had no position on the requirement for technical character but favored as few exceptions as possible. The Representative of MPI suggested that the words “made and used” in paragraph (1)(a) should be changed to “made or used.”

162. The Delegation of Peru stated that it considered the list contained in paragraph (1)(b) to be illustrative so that Contracting Parties would be free to exclude protection from other subjects. The Delegation of the Dominican Republic expressed a similar view and emphasized the need to make a distinction between matters that are inherently not patentable and inventions that may not be patented as a matter of policy. The Delegation of Ireland suggested that the words “in particular” be added to cover subject matter similar to those areas listed in paragraph (1)(b), and that the words “Notwithstanding paragraph (a),” be deleted. The Delegation of the Republic of Korea suggested that a survey of exceptions provided under existing national laws might assist the preparation of revised proposals.

163. The Delegation of Spain, speaking on behalf of the Member States of the European Union and supported by the Delegations of the Dominican Republic, Ireland, Morocco, Norway and the Republic of Korea and the Representative of the EPO, indicated that the exceptions to patentability that were provided for in Articles 27.2 and 27.3 of the TRIPS Agreement should also be provided for in the Treaty under paragraph (5). The Delegation of Brazil, supported by the Delegations of Egypt and Peru, suggested that the exceptions to patentability permitted under Articles 27.2 and 27.3 of the TRIPS Agreement be included by reference in paragraph (5). The Delegation of Mexico, however, stated that it did not support the inclusion by reference of the TRIPS exceptions into paragraph (5), since this would cause difficulties if Articles 27.2 and 27.3 of the TRIPS Agreement were amended. The Delegations of China and Indonesia stated that the exceptions provided under paragraph (5) should be based on the TRIPS Agreement. In connection with exceptions under paragraph (5), the Delegation of Ireland observed that Member States of the European Union were bound by the Directive of the European Commission on the protection of biotechnological inventions.

164. The Delegation of the United States of America expressed its opposition to the optional exceptions suggested by the International Bureau for paragraph (5) and the blanket inclusion of the exceptions provided for under Articles 27.2 and 27.3 of the TRIPS Agreement into the SPLT because of the different nature of the SPLT and the TRIPS Agreement. The TRIPS Agreement was a result of a complex negotiation which involved many other global trade issues and trade-offs, not only within intellectual property, including many issues that were beyond the issues concerning patents being discussed by the Committee. A specific example that did not fit within the confines of the SPLT was the exclusion of plants and animals that were currently allowed under Article 27.3(b) of the TRIPS Agreement, although these were important subject matters in developing fields of innovation, such as biotechnology.

165. The Representative of AIPPI suggested that, although the exceptions should be based on Articles 27.2 and 27.3 of the TRIPS Agreement, it was not necessary to include all of the exceptions provided for under those Articles. In his view, if the exceptions were placed in the Regulations, the amendment of the Rule concerned should require unanimity. The Representative of ABA stated that the Treaty should not include all of the exceptions permitted under the TRIPS Agreement nor attempt to re-interpret that Agreement. The Representative of MPI expressed the personal view that exceptions to patentability in the field of biotechnology were not in the interests of European industry and that Contacting Parties should adopt a broader approach than that taken under the TRIPS Agreement. The Representative of GRUR noted the need to take a fresh look at the provisions of Article 27.2 and 27.3 of the TRIPS Agreement in view of their ambiguity.

166. The Representative of BIO, supported by the Representative of AIPLA, agreed that not all exceptions under the TRIPS Agreement should be included in draft Article 12. In particular, the patenting of biotechnological inventions, including transgenic plants and animals, should be permitted. Emphasizing the need to be forward looking and to take a global view, the Representative stated that the Treaty should provide for the patentability of as broad range of subject matter as possible.

167. The Delegation of Spain, speaking on behalf of the Member States of the European Union and supported by the Delegations of the Dominican Republic, Egypt, Ireland, Morocco, Norway, Peru and the Republic of Korea and the Representative of the EPO, welcomed paragraph (4) concerning the requirement for industrial applicability in respect of, in particular, inventions in the field of biotechnology. The Delegations of Cuba and Mexico also expressed their support for the inclusion of paragraph (4).

168. The Delegation of the United States of America also welcomed the reintroduction of the industrial applicability/utility requirement into the Treaty, since utility was an important requirement for the United States of America. The Delegation, however, was of the view that the industrial applicability standards in certain systems might require a claimed invention to have a technical character or technical effect. The Delegation was also concerned that such a provision might also be used to refuse the patenting of inventions that were considered to be private in nature. The Delegation saw no reason to limit patentability in such a manner; the criteria should be that the invention has utility, is novel and involves an inventive step. The Delegation expressed further concern that an “industrial applicability” standard could stifle the development of new areas of innovation, such as software, biotechnology, or other newly developing areas that could not be foreseen now and that might defy definition according to the current understanding of what is meant by “industrial.”

169. As regards the alternative words presented in square brackets in paragraph (4), the Delegations of Brazil and Morocco and the Representative of the AIPPI were in favor of the second alternative, “can be made or used in any kind of industry.” The Delegation of the Russian Federation expressed a preference for the first alternative without the word “commercial.” The Representative of ABA expressed a preference for the third alternative, or the first alternative without the word “commercial.” The Delegation of the United States of America and the Representatives of AIPLA and FICPI supported the third alternative.

170. The Representative of the EPO expressed the view that the requirement for industrial applicability would not have a great effect in practice. The Representative of MPI stated that the requirement for industrial applicability did not constitute a barrier to granting patents for business methods. The Representative of GRUR drew the attention of the Committee to the fact that Article 1(3) of the Paris Convention required that industrial property “shall be considered in the broadest sense and shall apply not only to industry and commerce proper.” The Representative of BIO observed that it was not always possible to determine industrial applicability at the time that ground-breaking inventions were made, as exemplified by invention of the expression of DNA fragments, and that the standard presently applied in the United States of America would be a good standard for the Treaty.

171. The Representative of the EPO observed that, in deciding the conditions of patentability, it was necessary to take account of what was politically possible. She stated that the Treaty should not force a Contracting Party to adopt a stricter standard of patentability than it had at present. She therefore suggested that, as regards patentable subject matter and exceptions, the SPLT should reflect the consensus of the States today, which was the TRIPS Agreement standard, and provide an express provision allowing a Contracting Party to protect a broader range of subject matter. As regards the requirement concerning “technical character,” the Representative suggested that this concept be confined to those provisions in which it was really necessary and that a Contracting Party be allowed not to require the “technical character” of the invention. These suggestions received preliminary support by the Delegation of Sweden.

172. The Delegation of the United States of America stated that it could support neither a “technical” requirement in the SPLT nor the importation of the very minimal standards of protection that were found in the TRIPS Agreement, nor an “industry” or “industrial-based” standard on the issue of industrial applicability or utility. The Delegation expressed the view that the inclusion of a “technical” or “industrial” requirement would result in the standards for protection for inventions throughout the world to slip backwards, eroding the level of protection for inventors and inventions everywhere. The Delegation was of the opinion that the end result of the discussions, if it were based in part on any of those elements, would not be acceptable to the United States of America, and accordingly, the Delegation might well have to reconsider its participation in those discussions.

173. The Chair summarized the discussion on draft Article 12(1) as follows: A large number of delegations strongly requested the retention of the words “in all fields of technology” and made reference to Articles 27.2 and 27.3 of the TRIPS Agreement, in particular, in the context of paragraph (5). One delegation and a number of representatives of non-governmental organizations expressed the strong view that no reference to the words “in all fields of technology” should be made and that this Treaty should not be bound by the wording of the TRIPS Agreement. The views of delegations were also divided concerning the three alternatives placed within square brackets in paragraph (4). The Chair concluded that, in view

of the importance of the issues involved, two alternative provisions would need to be included in the next draft.

Draft Article 12(2)

174. In response to a suggestion by the Delegation of Sweden that the relevant provisions should be contained in the Treaty instead of prescribed in the Regulations as proposed, the Chair noted that the question concerning the allocation of provisions in the Treaty and the Regulations would need to be decided at a later stage.

Draft Article 12(3)

175. The Representative of EPI suggested that the words “as a whole” be removed, and that the words “that invention” be replaced by the words “the whole of the claimed invention.”

176. The Chair summarized the discussion on draft Article 12(3) by noting that there was general agreement on this provision, and that the International Bureau would further review the draft.

Draft Rule 14: Items of Prior Art Under Article 12(2)

Paragraph (1)

177. The Delegation of the United States of America, supported by the Delegation of Switzerland and the Representatives of AIPLA, BIO, CIPA and EPI, suggested that, in order to cover the situation in which the prior art became enabling after its publication date, the date on which the teaching of the primary items should be assessed under paragraph (1)(ii) be the “claim date.” However, the Delegation of France supported the use for this purpose of the date on which the prior art was made available to the public, as proposed in document SCP/7/4.

178. In response to a suggestion by the Representative of BIO that the wording be further clarified by adding “only” before the words “as of the date,” the Chair noted that this change could have an unintended limiting effect.

179. The Delegation of Japan stated that the term “make and use” in paragraph (1)(ii) may not sufficiently cover the case of a product. The Representative of BIO suggested that the term “made available to the public” should be defined. The Chair noted that both these terms were used in various contexts in the Treaty and the Regulations and suggested that the International Bureau ensure consistent use of these terms.

180. The Delegation of Chile noted that under the law of its country, a patent was considered as made available to the public on the date of publication of the abstract.

181. In response to a comment by the Delegation of Ireland that this provision should cover the cases of display at international exhibitions and the unauthorized disclosure of the invention, the Chair noted that it was intended that these situations should be covered under draft Articles 8 and 9. The Representative of GRUR suggested that draft Rule 14 should cover public prior use as well as prior art.

182. The Representative of the EPO queried the effect of the words “relevant to the lack of novelty” that had been inserted in paragraph (1), in particular as to the standard of information that would be required. The Representative of CIPA suggested that the provisions should more clearly cover the situation in which only part of the claim lacked novelty.

183. The Representative of AIPLA queried whether a primary item of prior art, which was not enabling by its own but was enabling when taken with the general knowledge of a person skilled in the art on the claim date, should destroy the novelty. The Chair suggested that, in that case, the prior art should be considered in the context of obviousness rather than novelty. The Delegation of the Russian Federation stated that, in its view, the proposed text of paragraph (1)(ii) was satisfactory.

184. The Chair summarized the discussions on paragraph (1) as follows: There was a difference of opinion as to the date as at which the teaching of the prior art should be assessed. He therefore suggested that both alternatives should be included for further consideration. The International Bureau should also reconsider the text in the light of the drafting changes that had been suggested.

Paragraph (2)

185. The Chair noted that the considerations under paragraph (1) regarding the date on which the teaching of the prior art should be assessed also applied to paragraph (2)(a) and (b). The Delegation of the Russian Federation observed that, if prior art was assessed on the date on which it was made available to the public, complications could arise in the case where, for example, a book was republished, thus resulting in two such dates for the same primary item of prior art with different amount of general knowledge of a person skilled in the art.

186. The Representative of EPI suggested that, in view of the use of the term “explicitly or inherently disclosed” in paragraph (2)(a), paragraph (2)(b) was redundant. This view was agreed with by the Delegation of Germany and the International Bureau, but was opposed by the Delegation of China.

187. In response to a suggestion by the Representative of EPI that paragraph (2)(c) was irrelevant and to a query by the Delegation of Germany as to its intention, the Chair explained that an item of prior art that was not incorporated by explicit reference in the primary item could not be considered to form part of that primary item. In response to a query by the Delegation of China as to whether, in the case of a document made available on the Internet, a hyperlink to another document could be considered as an explicit reference, the International Bureau recalled that the Committee had decided, following a survey, that all Internet issues should be considered at a later stage, after the general principles relating to prior art had been determined.

188. In response to a question by the Delegation of Ireland, the Chair expressed the view that a document which explicitly referred to a primary item of prior art (that is, a “reverse reference”) should not be considered to form part of that primary item.

189. The Chair summarized the discussion on paragraph (2) as follows: It was agreed that the issue concerning the timing of the determination of the disclosure in the item of prior art in subparagraph (a) should be further reviewed and that subparagraph (b) should be deleted. Concerning subparagraph (c), the cross reference issues, including the applicability to hyperlinks on the Internet, should be further explored.

Paragraph (3)

190. The Chair noted that paragraph (3) should be redrafted to align it with revised draft Article 8(2). The Representative of the EPI suggested that this paragraph would not be required if the teaching of the primary item of prior art were to be assessed on the claim date, as had been suggested under paragraph (1).

Draft Guidelines Under Rule 14

191. The Delegation of Canada, with which the Chair and the Delegation of the United Kingdom agreed, stated that Guideline G3.03, second sentence, did not deal adequately with the case where a single claim had two claim dates as referred to in draft Article 1(viii). The Delegation of the United States of America, supported by the Delegation of the United Kingdom and the Representative of EPI, suggested that Guideline G3.02 be made more flexible by replacing the words “clearly identified” by “identified with sufficient specificity.”

192. The Delegation of the United Kingdom noted that, in contrast to items (i) and (ii) of Guideline G3.01, item (iii) referred to “assessment” not “determination.” The Delegation also expressed concerns at the possible effect of the reference to “generic disclosure” in Guideline G3.02. It noted that a generic disclosure could cover as few as two alternatives and that it was undesirable that a generic disclosure should have to be supplemented by a list of all the alternatives that it encompassed solely for possible later prior art purposes. The Delegation of Australia and the Chair, supported by the Delegation of New Zealand, expressed the view that a general disclosure could anticipate a specific one for the purposes of determining novelty, unless the specific disclosure had special and unrecognized characteristics, as in the case of a “selection invention.”

193. In response to a query of the Delegation of the Russian Federation as to whether the Practice Guidelines would be binding on Contracting Parties, the International Bureau suggested that the Articles might set out principles, that the Regulations might implement those principles in a more specific manner in a legislative context, and that the Practice Guidelines might set out the practice of the Office implementing those principles in view of “deep harmonization.” However, these matters would need to be considered further in the context of draft final clauses which were not yet included in the draft Treaty. The Representative of the GRUR suggested that the legal character of the Treaty, Regulations and Practice Guidelines should follow the legal nature of the corresponding provisions under the European Patent Convention.

194. The Chair summarized the discussions as follows: The status of the Practice Guidelines should be considered further at a later date. Guideline G3.02 should be reviewed both in the light of the suggestion by the Delegation of the United States of America and to take account of selection patents. Guideline G3.03 should be reviewed in the light of the matters raised, in particular the context of claim date.

Draft Rule 15: Items of Prior Art Under Article 12(3)

195. In response to the Representative of FICPI, who questioned how the term “substituting” applied to a prior art document, the Chair explained that the term “item of prior art” should be considered as a reference to the particular teaching, and not as a reference to a particular physical item, such as a book or a document. The Representative of ABA queried whether

judicial knowledge was taken into account. The Representative of the EPO reserved the EPO's position on this provision. The Delegation of Belgium pointed out that, in the French version, the words "ont incité" in paragraph (4) did not correspond to the corresponding English text.

196. The Chair summarized the discussion on draft Rule 15 by stating that there was broad agreement on the substance of this Rule, although the representative of one intergovernmental organization had expressed a reservation.

Draft Guidelines Under Rule 15

197. The Delegation of the United Kingdom pointed out that, under item (ii) of Guideline G4.01, the determination should be made in respect of the extent of the disclosure and not as regards the scope. The Delegation of the Russian Federation opposed the inclusion of Guideline G4.01, item (iii), while the Delegations of Germany and Ireland supported the inclusion of that item, since a determination of the person skilled in the art was needed in each case, although that process might not be explicit during the examination procedure. As regards item (v) of Guideline G4.01, the discussion revealed that the International Bureau should clarify the meaning of the words "the claimed invention as a whole." The Representative of the EPO reserved the EPO's position since, in her view, it was not clear whether the Guidelines allowed the so-called "problem-solution approach" to be applied.

198. The Delegation of the United States of America agreed to the general concept of these Guidelines. However, it stated that the word "any" in the penultimate line in Guideline G4.03 should be deleted, since not all kinds of evidence should be allowed. The Representative of EPI said that the word "can" in the fifth line in Guideline G4.03 should be replaced by the word "would." The Delegation of Ireland suggested that the clarification concerning an inventive combination of known features be moved from Note R15.04 to the Practice Guidelines.

199. The Chair summarized the discussion on the draft Guidelines under draft Rule 15 by stating that there was broad agreement on the principles of these Guidelines, although a range of drafting issues needed to be clarified.

Draft Article 13: Grounds for Refusal of a Claimed Invention

200. The Delegation of Brazil proposed the inclusion of a new paragraph (2), which would correspond to its proposal made in relation to draft Article 2, as follows: "A Contracting Party may also require compliance with the applicable law on public health, nutrition, ethics in scientific research, environment, access to genetic resources, protection of traditional knowledge and other areas of public interest in sectors of vital importance for their social, economic and technological development." Consequently, the Delegation suggested that the reference to paragraph (1) in current paragraph (2) be replaced by a reference to paragraphs (1) and (2). This proposal was supported by the Delegations of Chile, Colombia, Cuba, Egypt, Kenya, Morocco and Peru. The Delegation of Egypt, supported by some of these delegations, proposed to include the proposal of the Delegation of Brazil in square brackets. The Chair recalled that the contents of the other provisions of the draft SPLT should be identified before an in-depth discussion on draft Article 13 took place.

201. The Delegation of the United States of America, supported by the Delegations of Germany and Japan, opposed the proposal by the Delegation of Brazil. The Representatives

of ABA and BIO also opposed that proposal on the grounds that it was not related to matters concerning the grant of patents and that it was complex and costly for applicants to deal with issues that are unrelated to requirements of patentability.

202. The Delegation of Belgium indicated an inconsistency between the English and the French text of paragraph (1).

203. The Chair summarized the discussion as follows: the discussion on this provision was a logical follow-up of the discussion on draft Article 2. In view of the divergent opinions, the International Bureau would further reflect on those issues.

Draft Article 14: Grounds for Invalidation or Revocation of a Claim or a Patent

204. In response to the suggestion of the Delegation of China, supported by the Representative of FICPI, that non-compliance with draft Article 11(3)(a) should be a ground for invalidation of a patent, the Chair explained that draft Article 11(3)(a) was still under consideration by the Committee on the basis of document SCP/7/6. The Representative of the EPO observed that care would need to be taken to ensure that the final text did not include non-compliance with formalities as a ground for invalidation.

205. The Delegation of Brazil stated that its proposal made under draft Article 13 should also be taken into account in draft Article 14. The Delegation of the United States of America opposed this proposal.

Draft Article 15: Review

206. On the term “quasi-judicial,” the Representative of the EPO explained that this term was used in the TRIPS Agreement. Use of the term was necessary to ensure that the provision would apply to the boards of appeal of the EPO, which were not considered to be judicial authorities *stricto sensu*.

Draft Article 16: Evidence

207. A short discussion on this provision showed the need for some redrafting. The Delegation of Japan stated that paragraph (1)(b) should not bind the courts. The Delegation of the United States of America stated that the expression “invoke a legal consequence” was unclear, and that paragraph (2) as drafted would have consequences in the law of evidence going beyond patent matters. The Delegation of Japan queried whether the term “a party” included examiners or appeal bodies. The Delegation of Chile supported the comments made by the Delegation of the United States of America on paragraph (2) and suggested its deletion.

Draft Article 17: Relationship to PLT

208. The Delegation of Brazil, supported by the Delegations of Argentina and Egypt, suggested placing the whole of draft Article 17 within square brackets. The Delegation of Spain stated that it might not be necessary to have a complete relationship between the SPLT and the PLT, since only parts of the PLT were relevant to the SPLT. After some discussion on the two alternatives contained in square brackets and some explanation by the International Bureau, it was agreed that this provision would be revisited in the context of the final and administrative clauses.

WORKING GROUP ON MULTIPLE INVENTION DISCLOSURES AND COMPLEX APPLICATIONS

209. The first session of the Working Group on Multiple Invention Disclosures and Complex Applications (“the Working Group”) was convened, in accordance with the request made at the Committee’s previous session (see document SCP/6/9, paragraph 208), during the same week as that during which the present session of the Committee took place. All invitees to the Committee’s session were also invited to the Working Group’s session. The proceedings of the Working Group were informal, there being no agenda and no report. The Working Group’s discussions were based on document SCP/WGM/1/1. The Working Group also had regard to the provisions contained in the documents before the Committee, in particular, documents SCP/7/3 and 4.

210. The Chairman reported to the SCP on the work accomplished by the Working Group as follows:

“On the first day, the Working Group spent most of its time discussing the issues of lack of unity. A number of delegations gave details about the approach they adopted. There was some discussion about why unity was raised by an office. There was general agreement that it was essentially a fiscal issue, but there were secondary issues relating to having relevant disclosures readily identified for search purposes, and in efficiency in examination in large offices where examiners specialize in narrow technological fields.

On the second day, the Working Group discussed the following issues:

Linking of claims

On this issue, the main discussion focussed on the dependency of multiple dependent claims on other multiple dependent claims, as well as on the reference of a dependent claim to more than one other claim in the cumulative, which, according to some delegations would impose a heavy burden on examiners. A majority of delegations, however, did not seem to encounter the same problems and referred to the flexibility these practices provided. The discussion also showed that there were fundamental differences in what was the objective of examination in terms of the degree of certainty to achieve.

Number of claims

Several delegations explained their practice of limiting claims, which, in many cases, was done on the basis of the “clear and concise” and the unity of invention requirements. They also spoke in favor of a procedure that would be easy to administer for the offices. User groups spoke against limiting the number of claims, but expressed their willingness to pay additional fees depending on the number of claims, where justified. One delegation made reference to PCT Rule 6.1(a), which states that the number of claims shall be reasonable in consideration of the nature of the invention claimed, and questioned the meaning of the term “reasonable.” Some delegations were interested in obtaining further information concerning the practice of limiting the number of independent claims in an application to one per category.

Future work

Several delegations expressed their satisfaction with, and emphasized the usefulness of, the discussion of the Working Group and advocated a continuation of its work, but suggested that more effective use should be made of the SCP electronic forum, in order to get more concrete results during the sessions. It was agreed that the International Bureau would send a circular to the members and observers of the SCP requesting input on the different practices as well as concrete proposals on whether and how to address the issues under consideration. The International Bureau would further notify the members of the SCP electronic forum when such comments have been received and posted on the electronic forum.”

CONCLUSION OF THE MEETING

Agenda Item 6: Future Work

211. The Committee invited the International Bureau to prepare revised proposals, taking into account the discussion at the present session, for consideration at the next session.

212. The International Bureau informed the Committee that its eighth session had been tentatively scheduled for November 18 to 22, 2002, in Geneva.

Agenda item 7: Brief Summary by the Chair

213. The draft brief Summary by the Chair (document SCP/7/7 Prov.) was adopted with a few amendments, which will be included in the final version (document SCP/7/7).

214. In accordance with the procedure adopted by the Committee at its fourth session (see document SCP/4/6, paragraph 11), the Committee is invited to comment on this draft report, which is being made available on the SCP Electronic Forum. The Committee will be invited to adopt the report at its eighth session.

Agenda Item 8: Closing of the Session

215. The Chair closed the session.

[Annex follows]

ANNEXE/ANNEX

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