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STANDING COMMITTEE ON THE LAW OF PATENTS

Ninth Session

Geneva, May 12 to 16, 2003

DRAFT REPORT

prepared by the Secretariat

INTRODUCTION

1. The Standing Committee on the Law of Patents (“the Committee” or “the SCP”) held its ninth session in Geneva from May 12 to 16, 2003.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Argentina, Australia, Austria, Barbados, Belarus, Belgium, Bolivia, Brazil, Bulgaria, Burundi, Cameroon, Canada, Colombia, Costa Rica, Croatia, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Finland, France, Germany, Greece, Holy See, Hungary, India, Indonesia, Ireland, Japan, Kazakhstan, Latvia, Lebanon, Libyan Arab Jamahiraya, Lithuania, Malta, Mexico, Morocco, Netherlands, New Zealand, Nicaragua, Nigeria, Norway, Oman, Pakistan, Panama, Peru, Philippines, Poland, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Sao Tome and Principe, Senegal, Serbia and Montenegro, Slovakia, Slovenia, Spain, Sudan, Sri Lanka, Sweden, Switzerland, Thailand, the former Yugoslav Republic of Macedonia, Tunisia, Turkey, Ukraine, United Kingdom, United Republic of Tanzania, United States of America, Uruguay and Zambia (76).
3. Representatives of the World Trade Organization (WTO), the African Intellectual Property Organization (OAPI), the Eurasian Patent Office (EAPO), the European Commission (EC), the European Patent Office (EPO) and the South Centre (SC) took part in the meeting in an observer capacity (6).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Associated Chambers of Commerce and Industry of India (ASSOCHAM), Brazilian Association of Industrial Property (ABPI), Centre for International Industrial Property Studies (CEIPI), Chartered Institute of Patent Agents (CIPA), Committee of National Institutes of Patent Agents (CNIPA), Federal Chamber of Patent Attorneys (FCPA), Friends World Committee for Consultation (FWCC), Genetic Resources Action International (GRAIN), German Association for Industrial Property and Copyright Law (GRUR), Indian Drug Manufacturers' Association (IDMA), Institute of Professional Representatives before the European Patent Office (EPI), 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 Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Max-Planck-Institute for Intellectual Property, Competition and Tax Law (MPI), Union of European Practitioners in Industrial Property (UEPIP) and the Trade Marks, Patents and Designs Federation (TMPDF) (22).
5. The list of participants is contained in the Annex to this report.
6. The following documents prepared by the International Bureau had been submitted to the SCP prior to the session: "Draft Agenda" (SCP/9/1), "Draft Substantive Patent Law Treaty" (SCP/9/2), "Draft Regulations under the Substantive Patent Law Treaty" (SCP/9/3), "Practice Guidelines under the Substantive Patent Law Treaty" (SCP/9/4) "Industrial Applicability' and 'Utility' Requirements: Commonalties and Differences" (document SCP/9/5) and "Status of the Practice Guidelines under the draft Substantive Patent Law Treaty: Options for Discussion" (document SCP/9/6).
7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

GENERAL DISCUSSION

Agenda Item 1: Opening of the Session

8. The session was opened, on behalf of the Director General, by Mr. Francis Gurry, Assistant Director General, who welcomed the participants. Mr. Philippe Baechtold (WIPO) acted as Secretary.
9. Mr. Gurry noted that the Committee would be considering the fifth draft of the draft Substantive Patent Law Treaty (SPLT) and the draft Regulations under the SPLT, and invited the Committee to consider how further progress could best be made.

Agenda Item 2: Adoption of the Draft Agenda

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

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

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

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

12. The SCP agreed that provisions, the texts of which appeared to be acceptable, would be considered provisionally accepted and placed in a frame in the next draft, subject to the clear understanding that such provisions could be revisited at any time, on request of any delegation, and to the inclusion in accepted texts, where appropriate, of alternatives in square brackets reserved for further consideration. In response to questions by the Delegations of Brazil and the Dominican Republic, the International Bureau confirmed that any delegation would be entitled to re-open discussion on any provision on which agreement had previously been reached and that nothing was finally agreed until everything was finally agreed.

13. On the suggestion by the Delegation of Germany, supported by the Delegation of the United States of America which announced that its Office was undertaking a study on its restriction practice and unity of invention, it was agreed that the Working Group would not meet during the ninth session of the SCP.

Status of the Practice Guidelines Under the Draft Substantive Patent Law Treaty

14. The International Bureau noted that, as explained in document SCP/9/6, it would be necessary to define the status of the Practice Guidelines in the final clauses of the Treaty. They could be given whatever status the Committee decided was appropriate. For example, the Committee could decide that the Practice Guidelines should have a legally binding effect, even though there could be no sanction for non-compliance. Alternatively, it could decide that the Practice Guidelines should not have a legally binding effect and rely on the good faith of the Contracting Parties to apply them.

15. The Delegation of the United States of America, supported by the Delegation of Japan, stated that, in order to promote consistency of standards and work-sharing, it was in favor of giving the Practice Guidelines some form of binding effect, for example, by the adoption of an Agreed Statement to that effect by the Diplomatic Conference.

16. The Delegation of Argentina said that, in its view, the Practice Guidelines should not be legally binding but used for guidance only; any provisions that were intended to be legally binding should be included in the Treaty or Regulations. In response to a question by the Delegation, the International Bureau explained that a precedent for guidelines which had a binding effect on Offices existed under the Patent Cooperation Treaty (PCT), namely the PCT International Search and Preliminary Examination Guidelines which international authorities were obliged to apply under the agreements established under PCT Articles 16(3)(b) and 32(2).

17. The Delegation of Brazil stated that it was opposed to providing in the Treaty or Regulations for the Practice Guidelines to have a legally binding effect. It also opposed any form of adoption of the Practice Guidelines which would constitute a “soft law” approach.

18. The Delegation of Germany stated that it favored a “middle road approach” under which the Practice Guidelines would be observed by Offices but would not have a legally binding effect and could not be used by applicants or third parties as a basis to challenge a decision of an Office.

19. The Delegation of the Netherlands, supported by the Delegations of Finland, the Republic of Korea and Switzerland, expressed the view that the Practice Guidelines should not have a legally binding effect but should be considered as instructions to Offices as to how to proceed. The Delegation also noted that Contracting Parties should commit themselves to applying the Practice Guidelines. The Delegation of the Russian Federation stated that the Practice Guidelines should not be legally binding, but that Offices should apply them in their methodology.

20. The Delegation of Canada referred to the possibility that an Office or court of a Contracting Party might decide that a particular Practice Guideline was not consistent with the Treaty or Regulations. It was therefore also of the view that the Practice Guidelines should not be legally binding, and that any provision which was intended to have a legally binding effect should be included in the Treaty or the Regulations. This view was supported by the Delegations of Finland and Turkey. The Delegation of Ireland also referred to the need for courts to be free to interpret the Treaty and Regulations.

21. The Representative of the EPO, supported by the Delegation of Sri Lanka, stated that the Practice Guidelines should not be legally binding, since it might be necessary to depart from them in exceptional cases.

22. The Delegation of India stated that, although it was of the opinion that the Practice Guidelines should not be legally binding, it wished to reserve its position on their precise status since this matter would need to be revisited at a later stage.

23. The Delegations of Colombia, Egypt, France, Morocco, Spain and Sri Lanka and the Representative of IDMA also stated that the Practice Guidelines should not have a legally binding effect.

24. The Delegation of France raised the question of whether the Practice Guidelines should be published with the Treaty or Regulations or in a separate publication. The Delegation of Sri Lanka expressed concern that publishing them in the same document as the Treaty and Regulations could imply that they had a legally binding effect. However, the Delegation of Canada commented that it would be more convenient to include them in the same publication together with a clear statement that they did not have a legally binding effect, as had been done in the case of the Explanatory Notes on the Patent Law Treaty (PLT).

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

Draft Article 1: Abbreviated Expressions

Item (ii)

26. The Delegation of the United States of America explained that, under its legislation, applications for plant patents and design patents, which might not be considered strictly as applications for titles protecting an invention, could serve as a basis for priority. It suggested that an explanation stating that this was permitted be included in the Practice Guidelines and that the second part of item (ii), defining the meaning of the term “application” where it referred to an application which served as a basis for claiming priority, be deleted and its contents transferred to relevant provisions relating to the issue of applications on which a right of priority was based. The Delegation of Germany also referred to the need to provide for priority claims based on design applications. However, the Delegations of Argentina and Japan opposed that suggested latter change, since they considered that it would introduce a lack of clarity and stated that reference should only be made to priorities provided for in Article 4 of the Paris Convention.

27. The International Bureau explained that the second part of item (ii) had been included in draft Article 1 to ensure that Contracting Parties would not be prevented from permitting applications for any title protecting an invention, such as utility models, serving as a basis for priority according to the applicable law.

Items (vi) and (ix)

28. The Delegation of Canada stated that the wording of this item did not adequately cover the situation in which one alternative of the claimed invention claimed multiple priorities and another alternative of that claimed invention claimed no priority. The Delegation suggested that the item be amended to read as follows:

“(vi) “claimed invention” means the subject matter of a claim for which protection is sought; where a claim defines its subject matter in the alternative, each alternative shall be considered to be a separate claimed invention.”

29. The Delegation of Argentina stated that the term “alternative” was not necessarily appropriate. It suggested that item (vi) should be amended to read as follows:

“(vi) “claimed invention” means the subject matter of a claim for which protection is sought; where multiple priorities or partial priority are claimed in accordance with the applicable law, each element of the claim should be considered separately for the purposes of the priority date of the claimed invention.”

30. The Representative of the EPO also expressed concern that the wording of item (vi) did not cover all situations in which multiple priorities and/or partial priority were claimed for the subject matter of a claim.

31. The Delegation of the United States of America reserved its position on the possibility of multiple priority dates for alternatives contained in the same claim.

32. In response to a query by the Delegation of the Russian Federation, the International Bureau explained that the term “contains” had been changed to “discloses” in item (ix) as

agreed by the Committee at its eight session. However, this change did not imply an enabling requirement for the purposes of a priority claim. The Delegation of Argentina suggested that “contains” was more appropriate than “discloses,” since no disclosure occurred where the earlier application was abandoned before publication.

33. The Representative of the EPO, supported by the Delegation of Germany, expressed the view that the definition of “priority date of a claimed invention” in item (ix) should not involve the question of the validity of the priority claim which, in its opinion, was a matter that should be dealt with elsewhere. In this connection, it noted that it was not necessary to determine the validity of a priority claim if all of the prior art relevant to the patentability of the claimed invention was published before the claimed priority date. It suggested that the item be amended to read as follows:

“(ix) “priority date of a claimed invention” in an application means, subject to item (x):

(a) where a priority is claimed, the filing date of the earliest application whose priority is claimed;

(b) where no priority is claimed, the filing date of the application.”

34. The Delegation of the United States of America expressed its concern with the suggestion by the Representative of the EPO since, in its view, it was necessary to take account of both the substantive and the procedural aspects of a priority claim.

35. The Delegation of Australia stated that it shared the concern expressed by the Delegation of the United States of America. It also noted that it was necessary to establish the level of disclosure required in the earlier application for a priority claim to be valid. As regards the terminology used, it had no preference as regards the use of “contains” or “discloses.”

36. The Delegation of Canada stated that, although it agreed that it was necessary to distinguish what could be considered as the procedural and substantive aspects of a priority claim, it shared the concerns expressed by the Delegations of Australia and the United States of America. It noted that the existing text did not require the validity of a priority date to be determined in all cases. The Delegation therefore favored the retention of the expression “in accordance with the applicable law,” and the reference to “the filing date of the application concerned.” It also favored the term “discloses” to “contains,” but was of the opinion that the matter of the level of disclosure required in an earlier application should be left to the applicable national law.

37. The International Bureau commented that item (vi), second part, and item (ix) together covered three topics, namely, alternatives in claimed inventions, the priority date of claimed inventions and partial priority. It noted that it might be preferable to cover these topics in three separate provisions.

38. The Delegation of the Netherlands stated that substantive provisions should not be included in the definitions. It therefore supported the amended text suggested by the Representative of the EPO. It also supported consideration of whether it would be more appropriate to have three separate provisions as suggested by the International Bureau.

39. The Delegation of Egypt suggested that a priority claim should only be based on an invention which was industrially applicable.

Item (x)

40. The Delegation of the United States of America expressed concern about this paragraph which would mean that, where there was a chain of applications, the priority date of the last application would necessarily be the filing date of the first parent application in the chain. This would prevent the applicant from preserving the filing date of a later parent application in the chain. It suggested that the item be amended to read as follows:

“(x) The “priority date of a claimed invention” in any divisional, continuation, or continuation-in-part shall be the earliest priority date that is both (1) preserved for the claimed invention in the parent and (2) validly claimed by the applicant, according to the applicable law.”

41. The Chair summarized the debate as follows:

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

Items (vi) and (ix): The discussions mainly focused on three issues: (i) alternatives in a claim; (ii) validity of priority claims; and (iii) multiple priorities and partial priority. The Delegations of Canada and Argentina made drafting proposals with respect to item (vi) and the Representative of the EPO submitted a drafting proposal concerning item (ix).

Item (x): The Delegation of the United States of America submitted a drafting proposal regarding the possibility for an applicant to specify any parent applications for the purpose of determining the priority date of a claimed invention.

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

42. In response to a question by the Delegation of Argentina, the Chair confirmed that, under paragraph (1)(iii), the Treaty and Regulations would not apply to an international application until it had entered the national phase before the Office of the Contracting Party concerned.

43. The Delegations of Germany and the United States of America noted that the provision would need to be taken into account, and might need to be reviewed, when considering the prior art effect of earlier applications under draft Article 8(2).

44. The Delegation of Germany, supported by the Delegations of India and Ireland, suggested that the exceptions referred to in paragraph (2) should be prescribed in the Treaty itself rather than in the Regulations. The Chair noted that this could mean that further exceptions, for example, in respect of a new form of second-tier protection, would only be included by revision of the Treaty at a Diplomatic Conference. He suggested that it would be preferable to provide for the exceptions in the Regulations and, if necessary, to provide that unanimity should be required for amendment of the Rule concerned. The Delegation of

Ireland also expressed its concern about the applicability of the SPLT to applications for patents of addition, since these patents often claim improvements, which did not always meet the requirement of inventive step.

45. A suggestion by the International Bureau that the the words “a Contracting Party” be replaced by “that Contracting Party” in item (iv) was agreed.

46. The Chair summarized the debate as follows: the Committee provisionally accepted draft Article 3(1) as proposed by the International Bureau with the replacement of the words “a Contracting Party” in item (iv) by the words “that Contracting Party.” As regards draft Article 3(2), several delegations raised concerns as to exceptions being dealt with in the Regulations.

Draft Rule 3: Exceptions Under Article 3(2)

47. In response to requests by the Delegations of Egypt and Mexico, the Delegation of the United States of America explained that an application for re-issue referred to in item (ii) was filed where a patentee sought to amend a granted patent by renouncing that patent and applying for it to be re-issued in its amended form. In the light of this explanation, the Delegation of Mexico suggested that the term in the Spanish text should be “*solicitudes de reexpedición*.”

48. The Delegation of Ireland explained that Irish law provided for the second-tier protection in the form of short-term patents and stated that it wished such second-tier protection to be added to the exceptions under draft Rule 3.

49. The Delegation of Sri Lanka commented that the terms “applications for re-issue” and “second-tier protection” were not widely used or understood and suggested that they be defined. The Chair suggested that it might be sufficient to explain the terms in the Practice Guidelines.

50. The Chair summarized the debate as follows: there was some debate about the inclusion of “second tier protection” and about the meaning of the term “reissue patent.”

Draft Article 4: Right to [a][the] Patent

Title; Paragraph (1)

51. The Delegation of the United States of America stated that clarification should be provided, either in the Regulations or the Practice Guidelines, regarding improper derivation or theft of an invention.

52. The SCP agreed the suggestion of the Chair that the title of draft Rule 4 and the text of paragraph (1) should refer to the right to “a patent.” The Representative of GRUR noted that this was consistent with the terminology used in the first sentence of Article 60(1) of the European Patent Convention (EPC).

Paragraph (2)

53. After some discussion, it was agreed on the suggestion of the Delegation of the Russian Federation that the words “of the inventor” should be deleted after “the work” in the last line

of paragraph (1) in order to take account of the situation in which the invention is made by the employee of a company which is commissioned to do the work.

54. In consequence of the agreement under paragraph (1), it was agreed that the words “the patent” should be replaced by “a patent” in line 3.

Paragraph (3)

55. The Delegation of Germany, supported by the Delegations of Canada, Denmark, Finland, Greece, India, the Russian Federation and the United States of America, suggested that the rights to an invention made jointly by several inventors should be left to national law. It was agreed that paragraph (3) should be deleted and that the Practice Guidelines would explain that matters concerning the entitlement to a right to a patent by joint inventors would be left to national law.

56. The Chair summarized the debate as follows:

Article 4(1): The Committee provisionally accepted the text as proposed by the International Bureau with the deletion of the word “[the]” and the deletion of the square brackets surrounding the word “a.” The same changes were also made in the title of draft Article 4.

Article 4(2): The Committee provisionally accepted the text as proposed by the International Bureau with the deletion of the words “of the inventor” in the last line, and the replacement of the words “the patent” by “a patent” in the third line.

Article 4(3): The SCP agreed that this provision should be deleted. The Practice Guidelines would clarify that matters concerning the entitlement to the right by joint inventors were left to the national laws.

Draft Article 5: Application

Paragraph (1)(iv)

57. The Chair noted that the draft text contained two alternative texts presented in square brackets concerning the situation in which one or more drawings were contained as part of an application, namely “where they are necessary for the understanding of the claimed invention” and “where they are referred to in the description or claims.”

58. The Delegation of Germany stated that it supported the second alternative, since it should be left to the applicant to decide whether or not to file drawings, and that the determination of whether or not an application contained an enabling disclosure was a separate matter dealt with under draft Article 10.

59. The Delegation of Argentina also supported the second alternative, noting that the determination of whether or not drawings were required necessitated an examination as to substance. The Delegation of Canada, noting that the addition of drawings to satisfy the requirement of enabling disclosure under draft Article 10 would generally introduce new matter, also supported the second alternative. The Delegations of Finland, France, Greece, Ireland, Morocco, the Netherlands, Peru, Romania, the Russian Federation, Spain and Sweden, and the Representative of the EPO also supported the second alternative.

60. The Delegation of the United States of America, supported by the Delegation of the Republic of Korea, stated that, although it agreed that the requirement under paragraph (1)(iv) was different from that under draft Article 10, it favored the first alternative for consistency of those provisions and of the corresponding Practice Guidelines. The Delegation of New Zealand also favored the first alternative in order to permit Offices to require drawings. The Representative of AIPLA, supported by the Representative of IPO, favored the first alternative since it was concerned that, under the second alternative, an application could be refused if drawings referred to in the description were not filed as part of the application.

61. The Delegation of India, supported by the Delegation of Senegal and the Representative of IDMA, stated that it was necessary to cover the situations under both alternatives and suggested that both alternatives should be retained linked by the word “or.”

62. The Delegation of the Republic of Moldova and the Representative of the EAPO stated that they could support either the first alternative or the suggestion by the Delegation of India.

63. The Delegation of Sudan suggested that the order of paragraph (1)(iv) and (v) should be reversed.

64. The Delegation of Argentina suggested that the item relating to drawings should be separated from the items listing other parts of the application, for example, by the use of the term “and/or.”

65. The Delegation of Egypt stated that the matter of whether drawings were required was a technical question.

66. The Chair observed that it was necessary to resolve the matter of whether drawings should be filed at the option of the applicant or whether the Office should have the power to require the applicant to file drawings.

67. The International Bureau observed that it did not appear necessary to include in paragraph (1) substantive requirements in respect of parts of the application, including drawings, listed in that paragraph, since these should be covered elsewhere, for example, in draft Article 10. It would then be possible to include the reference to drawings as a “may” provision. In addition, it was necessary to take account both of the consequences for non-compliance, namely rejection of the application, with requirements under each item, and of the fact that later-filed drawings would almost invariably introduce new matter.

68. The Delegation of India expressed concern that paragraph (1), which provided the technical parts of an application, would prevent a Contracting Party from imposing valid information requirements, such as a declaration concerning the source and geographical origin of genetic resources, compliance with other national laws including those relating to the access to biological material, such as compliance with prior informed consent requirements, details of corresponding foreign filings, the deposit of microorganisms and declaration of inventorship. The Delegation suggested that a new paragraph (1)(b) be added providing for “Any other requirement in accordance with national law.” In its view, such a provision was necessary in order to take account of the concerns of all countries and to promote a large membership of the SPLT. It also noted that paragraph (2)(b) already permitted Contracting Parties to provide for requirements which were different from those under the PLT and PCT where these were more favorable from the viewpoint of applicants and patentees.

69. The Delegation of Brazil stated that, like the Delegation of India, it did not support the restriction under paragraph (2) on the right of Contracting Parties to impose further requirements under national law. In particular, the need for flexibility to provide for requirements in the public interest should not be abandoned and there should be a balance between the needs and concerns of different countries. The Delegation also recalled that provisions on the protection of genetic resources and traditional knowledge had not been included in the PLT because they were considered to be of a substantive nature and stated that it was therefore appropriate to include such provisions in the SPLT. In its view, the retention of paragraph (2) could prejudice this matter. The Delegation therefore suggested that paragraph (2) be deleted, although it could accept the addition of a new paragraph (1)(b) as suggested by the Delegation of India.

70. The Delegation of the Dominican Republic also stated that paragraph (2) imposed unjustifiable limits on other requirements that a Contracting Party might wish to establish in its national law. It therefore supported the suggestions of the Delegations of Brazil and India.

71. The Delegation of the Dominican Republic also noted that no provision corresponding to paragraph (2) was contained in the draft SPLT considered by the SCP at its fifth session (document SCP/5/2) or referred to in the report of that session (document SCP/5/6) and requested clarification as to its origin in document SCP/9/2. The International Bureau explained that the paragraph had been introduced following consideration by the SCP at its sixth session of the “Study on the Interface Between the SPLT, the PLT and the PCT” prepared by the International Bureau (document SCP/6/5) and mirrored the approach adopted in Article 6(1) of the PLT in respect of the requirements relating to form or contents of an application.

72. The Delegation of the Dominican Republic, supported by the Delegation of Argentina, further raised the question of whether, under paragraph (2), Contracting Parties to the SPLT would be obliged to change their national laws to take account of amendments to the PLT and the PCT, and Regulations under those Treaties, even though they were not party to them. The Chair explained that, as described in document SCP/6/5, this would need to be dealt with in the final clauses of the draft Treaty. The International Bureau also noted that, since there were now 120 Member States of the PCT, it was important that the PCT provided a basis for the provisions under the SPLT and that there was convergence between the SPLT, the PLT and the PCT. The effect of changes to the PLT and PCT could be dealt with in the final clauses as had been done under PLT Article 16.

73. The Delegation of the United States of America stated that it opposed the changes suggested by the Delegations of Brazil and India that would permit a Contracting Party to establish in its national law any requirements that it wished. To do so would undermine harmonization under the SPLT and the Delegation questioned the value of a Treaty that contained either of such changes. It also considered such changes as a backward step from the agreement that had been reached at the sixth session of the SCP following consideration of the study contained in document SCP/6/5.

74. The Delegation of Switzerland commented that an important aim of the SPLT was to harmonize national laws while preserving coherence with the PLT and the PCT in order to build on the achievements that had already been made at the international level. It stated that the suggestion of the Delegation of Brazil was contrary to this aim. In its view, it would be preferable to deal with the matters of the source and geographical origin of genetic resources

and traditional knowledge in the context of the PCT and recalled that, in this connection, it had submitted a proposal for consideration by the Working Group on Reform of the PCT at its fourth session, to be held from May 19 to 23, 2003 (document PCT/R/WG/4/13).

75. The Delegation of Canada stated that it also could not support the suggestions of the Delegations of Brazil and India for the reasons stated by the Delegations of Switzerland and the United States of America. In its view, PLT Article 6(1) provided a good precedent for the provisions of paragraph (2).

76. The Delegation of Japan also stated that it supported the views expressed by the Delegations of Switzerland and the United States of America.

77. The Delegation of Thailand stated that it supported the views expressed by the Delegations of Brazil, the Dominican Republic and India.

78. The Delegation of Argentina noted that, while paragraph (2)(a) prevented a Contracting Party from imposing further requirements, paragraph (1) did not appear to prevent a Contracting Party from requiring parts of an application additional to those listed in items (i) to (iv), for example, a tax code number, information on the geographical origin of biological material or guardian for a person below the age of majority. This view was supported by the Delegation of India which suggested that ambiguity be avoided by deleting paragraph (2) and clarifying the chapeau of paragraph (1) to make it clear that extra parts could be required.

79. The Chair agreed that it was not clear whether paragraph (1) prevented a Contracting Party from requiring one or more parts additional to those listed. However, it was questionable as to whether some of the items mentioned should be considered as separate parts of the application or as sub-parts of items already listed. For example, references to the deposit of microorganisms were generally considered as part of the description, as under PCT Rule 13*bis*.

80. The Delegation of Mexico stated that it was in favor of a treaty that would harmonize national laws and therefore supported retention of paragraph (2). The Delegation still attached importance to providing in the draft Treaty for the protection of genetic resources and traditional knowledge but, in its view, such protection would not be prevented by retaining paragraph (2).

81. The Delegation of Peru stated that it supported the deletion of paragraph (2) for the reasons put forward by the Delegation of the Dominican Republic.

82. The Delegation of France stated that it was in favor of retaining paragraph (2) for the reasons already stated by other delegations

83. The Delegation of the United Kingdom, supported by the Delegation of Germany, stated that, for the reasons given by the Delegation of the United States of America, it was necessary to retain paragraph (2) in order to achieve harmonization. In addition, paragraph (2) was necessary to define the precise relationship of the SPLT with the PCT and the PLT. It was also necessary to take account of provisions that were “otherwise provided for by this Treaty and the Regulations.”

84. The Delegation of Indonesia expressed support for the suggestion by the Delegation of India.

85. The Delegation of New Zealand stated that it had some sympathy with the inclusion in the SPLT of provisions on the protection of genetic resources and traditional knowledge. However, this should be dealt with in specific provisions and not by way of the inclusion of a general exception under paragraph (1) or the deletion of paragraph (2).

86. The Delegation of Morocco stated that it supported the retention of paragraph (2) in the interests of harmonization.

87. The Delegations of Ecuador, Egypt and Sudan noted the views that had been expressed regarding the need for harmonization, but agreed with the suggestions made by the Delegations of Brazil and India and the views expressed by the Delegation of the Dominican Republic in order to provide protection for inventions involving microorganisms and genetic resources.

88. The Delegation of Norway stated that paragraph (2) should be retained but that this should not prevent the inclusion of requirements in respect of the source and geographical origin of genetic resources.

89. The Delegation of Spain supported the retention of paragraph (2), noting that this would not preempt the discussions concerning the protection of genetic resources.

90. The Delegation of Ireland, supported by the Delegations of Belgium, Denmark, Finland and the Netherlands, stated that it supported the retention of paragraph (2) for the reasons given by the Delegations of Germany and the United Kingdom. It was of the view that, for the reasons given by the Delegation of Denmark, speaking on behalf of the European Community and its Member States, at the eighth session of the Committee, at this stage, the SCP was not the right forum to deal with the protection of genetic resources, biodiversity and traditional knowledge.

91. The Delegation of Greece, speaking on its own behalf, stated that paragraph (2) should be retained for the sake of harmonization and legal certainty. Speaking on behalf of the European Community and its Member States, and supported by the Delegation of Romania, the Delegation of Greece stated that the SCP was not the right forum to discuss the protection of genetic resources, biodiversity and traditional knowledge and that the outcome of the discussions in other fora, such as the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) should be awaited.

92. The Delegation of Colombia stated that it did not support paragraph (2) since it could conflict with the obligations of its country as part of the Andean community.

93. The Delegation of Pakistan stated that it supported the deletion of paragraph (2) as suggested by the Delegation of Brazil.

94. The Delegation of Sri Lanka also expressed support for the views expressed by the Delegations of Brazil, the Dominican Republic and India. In its view, those concerns should be accommodated, for example, in the form of a new subparagraph, to allow a Contracting Party to require that an application contained parts other than those listed in paragraph (1). In addition, the Delegation noted that paragraph (2) provided for exceptions in the Treaty; it therefore reserved its position on that paragraph pending the outcome of the discussions on draft Articles 2 and 13 which it regarded as very important.

95. The Representatives of AIPPI, FICPI, GRUR, IIPS and IPO opposed the deletion of paragraph (2) which they considered essential for the harmonization of patent laws and therefore of paramount importance to users. The Representative of GRUR also noted that Member States, and potential Member States of the European Community, had already agreed to measures in respect of medicines, public health and biodiversity in the Directive of the European Parliament and of the Council on the legal protection of biotechnological inventions. However, the Representative of IDMA expressed the view that paragraph (2) was not acceptable.

96. The Delegations of Argentina, Brazil and the Dominican Republic suggested that paragraph (2) be presented in square brackets.

Paragraph (3)

97. The Chair noted that this provision was linked to draft Article 7(5). The Delegation of the Republic of Korea, supported by the Delegations of France, Germany, Ireland, Japan, the Netherlands, Spain and Sweden, and the Representative of the EPO, proposed deleting the words “[Subject to Article 7(5)].”

98. The Delegation of the United States of America, supported by the Delegations of Australia, Canada, Peru, the Russian Federation, Sudan and the United Kingdom, and the Representative of EPI, was in favor of retaining the words “Subject to Article 7(5),” since otherwise, an applicant might lose his right by the mere fact that he described his whole invention under the title “abstract.” The Delegation further suggested that, since the text of draft Article 7(5) as proposed would not solve the above problem in non-examining Offices and during post-grant procedures, the abstract prepared by the applicant be recognized as a part of the description. The Delegation of Canada stated that it needed to further consider the suggestion made by the Delegation of the United States of America. The Representative of EPI did not support this suggestion.

99. The Delegation of Argentina explained that, since only the abstract, but not the entire application, was published after seven months from the filing date according to its national law, the quality of the abstract was an important issue. Therefore, the Delegation suggested including the sentence “The abstract shall, however, describe the claimed invention in such a way as to allow third parties to understand the subject matter thereof, including references to familiar generic names, where chemical compounds or related processes are claimed.” The Delegation of Sudan stated that a reference to draft Article 7(4) should also be made in order to take into account the abstract prepared by the Office.

100. The Delegation of Spain noted that the words “ Subject to Article 7(5)” were not surrounded by square brackets in the Spanish text.

101. The Chair summarized the debate as follows: as regards paragraph (1), two main issues were addressed. The first concerned the exhaustive or non-exhaustive nature of the list under paragraph (1). The second related to whether additional elements not listed in paragraph (1) should be expressly addressed or whether such additional elements were already incorporated within the current list. Concerning paragraph (2), many delegations stated that this provision was an essential part of having a harmonizing treaty. There was strong support, however, for the deletion of draft Article 5(2). Some delegations emphasized the importance of the phrase “except where otherwise provided for by this Treaty and the Regulations,” and noted that

these important issues should be explicitly addressed in the text. In order to find a solution that would ensure that, on the one hand, the specific issues of concern would be addressed and, on the other hand, the harmonizing effect of draft Article 5(2) would be safeguarded, delegations who thought the list of elements in draft Article 5(1) should be expanded were invited to submit proposals consistent with the continuing presence of draft Article 5(2) to the SCP electronic forum for discussion at the next session. The Chair concluded that, in view of the divergent views expressed in paragraph (3), it was agreed that the words “[Subject to Article 7(5)]” would remain in the text for further discussion.

Draft Rule 2: Person Skilled in the Art Under Articles 7(3)(b), 10(1), 11(4)(a) and 12(3), and Rules 7(2), 4(1)(vii), 10(iii), 12(1)(a) and (2), 13(5)(ii), 14(1)(a) and (2) and 15(2), (3) and (4)

102. The Delegation of Argentina, supported by the Delegations of Brazil and India, suggested that the definition of “a person skilled in the art” contained in draft Rule 2 should be transferred to the Treaty. The International Bureau explained that the previous definitions of “a person skilled in the art” and “general knowledge of a person skilled in the art” in the draft Treaty and Regulations had been combined to avoid a circularity. However, the International Bureau had no view on whether the proposed replacement definition should be in the Treaty or the Regulations. The Delegations of Canada, Germany, Ireland, the Netherlands, the Russian Federation, Sweden, the United States of America and the Representatives of the EAPO and the EPO, stated that they could accept the definition in either the Treaty or the Regulations. The Delegation of the Republic of Moldova expressed a preference for the definition remaining in the Regulations.

103. The Delegation of Argentina, supported by the Delegation of India, suggested that the use of the terms “general knowledge” and “ordinary skill” could result in a level of inventive step that was too low. In response to requests by the Delegation of Brazil for clarification of the draft definition and its relevance to the promotion of innovation, the Chair explained that the proposed terminology was already used in many national laws in order to determine what a person skilled in the art concerned would understand by a prior art disclosure. The definition took account of the fact that the precise knowledge and skill possessed by a hypothetical “person skilled in the art” depended on the art in question and could, in some cases, involve the knowledge of more than one person.

104. The Delegation of Spain stated that it supported the existing definition in the English and French text but the term “*conocimientos generales y básicos*” in the Spanish text implied a lower level of knowledge and skill than the English term “general knowledge and ordinary skill.”

105. The Delegations of Canada, Germany, Ireland, the Netherlands, the Republic of Moldova, the Russian Federation, Sweden and the United States of America and the Representatives of EAPO and the EPO all supported the definition as proposed in draft Rule (2). The Delegation of the United States of America stated that it opposed increasing the level of skill or knowledge attributed to a hypothetical person skilled in the art since it would have negative impact on innovation.

106. The Delegation of Sri Lanka commented that the term “person skilled in the art” was well understood in patent law and suggested that there was therefore no need to define it.

107. The Delegation of India stated that the definition of the term “person skilled in the art” should be left to national laws.

108. The Chair suggested that the delegations who had concerns should submit alternative drafting proposals to the SCP electronic forum for discussion at the next session of the Committee.

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

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

Paragraph (1)(i)

110. The Delegation of the United States of America stated that, although it did not support the inclusion of the term “technical” in paragraph (1)(i), it agreed to the term being retained in square brackets pending discussion of draft Article 12(1). The Delegations of Australia, Argentina, Morocco, Romania and the United Kingdom and the Representative of the EPO also agreed to the term being retained in square brackets. The Delegations of Ireland and the Netherlands supported the text of draft Rule 4 as proposed by the International Bureau. The Delegation of the Russian Federation stated that it would prefer the term to be deleted for the reasons contained in the Comment on paragraph (1)(i). The Delegation of France stated that it was in favor of deleting the term and, instead, reference should be made in paragraph (1)(iii) to a “technical problem.” The International Bureau noted that if the words “in all fields of technology” were retained in draft Article 12(1), it might not be necessary to retain the term “technical” in paragraph (1)(i).

Paragraph (1)(ii)

111. The Delegations of Argentina and Mexico, and the Representative of the EAPO, supported the retention of the term “preferably.”

Paragraph (1)(iii)

112. The Representative of the EPO, supported by the Delegation of Romania, suggested that the word “preferably” should be deleted in paragraph (1)(iii), or at least placed in square brackets. This suggestion was opposed by the Delegations of Australia, Canada, the United Kingdom and the United States of America, and the Representative of the EAPO. The Chair observed that, since it was not intended that an application should be rejected because the claims were not in a “problem/solution” form, the word “preferably” appeared appropriate.

113. The Delegation of France suggested that the term “technical” be added before the words “problem” and “solution” in paragraph (1)(iii). The Delegations of Argentina and Romania also suggested that the term “technical” be added before the word “problem” in that paragraph. The Delegation of Romania suggested that, as an alternative, the following extra

sentence be added to the end of the paragraph: “A Contracting Party may require that such problem and its solution be of a technical character.”

Paragraph (1)(iv)

114. The Delegation of India, supported by the Delegation of Brazil and the Representative of IDMA, suggested that paragraph (1)(iv) be amended to provide for a Contracting Party to require an indication of the source and geographical origin of the deposited biologically reproducible material. This suggestion was opposed by the Delegation of the United States of America which stated that such a provision would not enhance access and benefit sharing with respect to genetic resources or traditional knowledge and that appropriation of such resources or knowledge should be dealt with by a regulatory mechanism and not under patent law. The Delegation of the Russian Federation opposed the suggestion on the grounds that the indication of source and geographical origin of the deposited biological reproducible material was not relevant to paragraph (1)(iv) which was directed to the disclosure of the invention by reference to a deposit. The suggestion by the Delegation of India was also opposed by the Delegations of Canada, France, Ireland, Japan, the Netherlands and the United Kingdom.

115. The Delegation of Canada stated that, in its view, it was not appropriate for an application to be refused under draft Article 13 because the address of the depository institution or the date of the deposit was not indicated as required under paragraph (1)(iv).

116. The Chair suggested that this issue might be better dealt with by way of a further subparagraph within draft Rule 4(1) and that interested delegations should submit proposals for such a new provision to the SCP electronic forum prior to the next session of the Committee.

Paragraph (1)(vi)

117. The Delegation of the United States of America noted that if, as it had suggested, the best mode of carrying out the invention known to the applicant at the filing date of the application were included as a requirement under draft Article 10, the wording of paragraph (1)(vi) would need to be amended to reflect this. The Delegations of Brazil and India stated that they also supported the inclusion of a requirement as to “best mode.” The Delegation of Argentina stated that it supported the inclusion of such a requirement as an option for Contracting Parties. However, the inclusion of such a requirement was opposed by the Delegations of Canada, Germany, France, Ireland, Japan, the Netherlands, Romania, the Russian Federation and the United Kingdom, and the Representatives of the EAPO and the EPO. In response to criticisms that it would be unclear as to what criteria should be applied in determining what constituted “the best mode,” the Delegation of India suggested that “the best mode” should be “the best mode as far as known to the applicant.” The Delegations of Mexico and the United States of America indicated that they could support a requirement for “best mode” in such terms.

Paragraph (2)

118. The Delegation of Canada queried whether draft Rule 4 should provide for further requirements in respect of the description, in particular information concerning the applicant’s corresponding foreign applications and grants as provided for under Article 29(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).

The Delegation of Germany noted that the reference in paragraph 39 of the Practice Guidelines to “additional contents, which are not provided under paragraph (1),” was not clearly consistent with draft Rule 4 in this respect.

119. The Delegation of Argentina suggested that the word “shall” should be changed to “may.”

120. The Chair concluded that draft Rule 4, except paragraph (1)(iv), could be considered provisionally accepted, subject to the following:

Paragraph (1)(i)

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

Paragraph (1)(ii)

The term “preferably” should be maintained.

Paragraph (1)(iii)

The term “preferably” should be maintained.

Paragraph (1)(iv)

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

Paragraph (1)(vi)

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

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

Paragraph (1)

121. The Delegation of Canada suggested that the provision be amended so as to ensure that the number of claims would start with “1” and that a Contracting Party could require applicants to use a particular kind of numerals, such as Arabic numerals.

Paragraph (2)

122. The Delegation of Argentina proposed that the words “at the option of the applicant” be deleted and that a new paragraph “A Contracting Party may require that the claims shall be written in the form of item (i) or item (ii) or both.” be included, so that the question as to

whether the claims be drafted in two parts or in a single part would be left to the option of a Contracting Party. The Delegations of Australia, Canada, Colombia, Ireland, the Republic of Moldova and the United States of America and the Representatives of AIPPI, EPI and FICPI supported the text as proposed.

123. The Delegation of Ireland noted that dependent claims were, in general, not drafted in a two-part form. Further, the Representative of FICPI stated that, if the option was left to the Offices, an applicant filing an international application under the PCT would face serious difficulties to comply with different requirements set by the Offices in the national phase. In response, the Delegation of India observed that, since the form of the claims should be determined by the question as to which form would result in the claims being clearer and providing useful information to the public, the issue should be determined by the Office, and not by the applicants.

124. The Delegation of Argentina, supported by the Delegations of Colombia and Mexico, proposed replacing the word “feature” with the words “[technical] feature” throughout paragraph (2). The Delegation of Canada pointed out that the issue of the technical character of inventions was a separate matter. The Delegation of the Republic of Moldova supported the text as proposed. The SCP accepted the suggestion by the Chair to address the issue relating to the term “technical” in the Treaty and the Regulations in connection with the discussion of draft Article 12(1), following which consequential changes might be considered throughout the Treaty and the Regulations.

125. The Delegation of Argentina queried the appropriateness of the word “improvement” in item (i), since the claims should define the “invention.”

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

Paragraph (3)

127. A proposal by the Delegation of Argentina to delete the words “, except where absolutely necessary,” did not receive support. The SCP provisionally accepted the text as proposed.

Paragraph (4)

128. The Delegation of Canada, supported by the Delegations of Romania and the Russian Federation, proposed that the following new subparagraph be included: “A dependent claim may only refer to a preceding claim or claims.” In response to the comment by the Delegation of the United States of America as to whether the point raised by the Delegation of Canada could be solved through renumbering of claims by the Office, the Delegation of the Russian Federation stated that its Office was not allowed to modify the claims *ex officio*. The Delegation of Argentina indicated that renumbering of claims should fall under the responsibility of the applicant.

129. The Delegation of the United States of America opposed the possibility of multiple dependent claims depending on multiple dependent claims, since such a possibility would confuse examiners and third parties when determining the scope of the claims. The Delegation of the Russian Federation stated that allowing multiple dependent claims depending on multiple dependent claims caused no major difficulty to its Office, and noted that the opposition to such multiple dependent claims ran counter to the trend, which was to simplify applications and to provide less voluminous applications. The Delegation indicated that the inclusion of examples in this respect in the Practice Guidelines might be helpful.

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

Draft Article 6: Unity of Invention

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

131. The Delegation of the United States of America noted that its Office will prepare a study regarding its restriction practice within the next 18 months, and suggested that the discussion on unity of invention be postponed. No further discussion was held on these provisions.

Draft Article 7: Observations, Amendments or Corrections of Application

Paragraph (1)

132. The Representatives of AIPLA and EPI opposed the inclusion of subparagraph (b) according to which applicants would not be given a further opportunity to make amendments or corrections under certain circumstances. The Delegation of Argentina stated that, where the applicant of the parent application was not the same as the applicant of a divisional, continuation or continuation-in-part application because of, for example, an assignment of rights, subparagraph (b) should not apply. The Chair observed that, at least under a common law jurisdiction, the assignee took over any rights and obligations of the assignor, and that providing a different treatment for the assignees might lead to an abuse of the system.

133. On a query by the Representative of AIPLA concerning the link between the expressions “same error or defect” and “any requirement under draft Article 13(1),” the International Bureau responded that it would review the text.

134. The Chair summarized the debate as follows: the discussion focussed on subparagraph (b). While no delegation of a State raised objections to the inclusion of this provision, some non-governmental organizations expressed concern about the fact that applicants would not be given another opportunity to make amendments or corrections. A further question was raised as to whether this provision should apply to the applicant in respect of the divisional, continuation or continuation-in-part application who was not the same as the applicant in respect of the parent application. One delegation further inquired about the link between the expressions “error or defect” and “requirement under draft

Article 13(1).” The Chair concluded that subparagraph (a) could be provisionally accepted, while subparagraph (b) required further thought in respect of the above-mentioned issues.

Draft Rule 7: Details Concerning Observations, Amendments or Corrections of Application Under Article 7(1)

Paragraph (1)

135. The Delegations of Australia, Egypt, the Russian Federation and Sudan and the Representatives of AIPPI and OAPI supported a minimum time limit of three months on the following grounds: since the PLT provided minimum time limits of two months for formality matters, this provision, which related to substantive requirements, should provided minimum time limit of three months; communications needed to be sent to remote countries; certain Offices calculated the time limit from the time of sending a notification.

136. The Delegation of Japan, supported by the Delegations of Austria, France and the Republic of Moldova and the Representative of the EPO, was in favor of a minimum time limit of two months because of the following: the current Japanese practice of a two-month time limit did not cause any problems; while the longer time limit may be beneficial for applicants, a longer period for processing the application would burden third parties; and a minimum time limit of two months would also accommodate those Offices which applied a longer time limit. The Delegation of Mexico stated that it preferred a minimum of two months, but suggested another possibility, i.e., a time limit of not less than two months that could be extended by another two months. The Chair reminded the SCP that not only national applicants but also applicants from abroad would be affected by this provision.

137. In response to a proposal by the Delegation of Peru to include a time limit not exceeding three months, the Chair observed that many Offices would probably have difficulty in setting a maximum time limit and that the objective of this provision was to provide a reasonable opportunity for an applicant to respond.

138. The Delegation of Argentina stated that the time limit should run from the time of receipt of the notification. The Delegation of Austria indicated that the time limit should be considered to be complied with if the applicant sent the communication before the expiration of the time limit.

139. In response to a query by the Delegation of New Zealand as to whether this provision applied only to the initial rejection or also to the subsequent correspondence to the applicant, the Chair explained that, in his view, it only covered the first one.

140. After some discussions, the SCP provisionally accepted the text as proposed, with both two and three months within square brackets.

Paragraph (2)

141. The Delegation of Germany, supported by the Delegations of Spain and the United Kingdom, proposed deletion of the word “abstract,” since it only served for information purposes. The Delegation of the United Kingdom wondered whether an applicant should have the right to amend the abstract, since, normally, the Office had the power to amend the abstract *ex officio*. The Delegation, as well as the Delegation of Argentina, pointed out that it was not desirable to allow amendments and corrections of the abstract at least up to the time

when the application was in order for grant, since the abstract should be published with other parts of the application earlier than at that point. The Delegations of the Republic of Moldova, the Russian Federation and the United States of America were in favor of retaining the word “abstract.” Following a suggestion by the Delegation of the Russian Federation, the Chair proposed including the words “Subject to Article 7(4)” at the beginning of this paragraph.

142. The Delegation of Canada, supported by the Delegations of Colombia and the United States of America, proposed that the words “to amend and correct” be replaced by the words “to make amendments and corrections” for clarity, and that the distinction between the expressions “amendments” and “corrections,” which was explained in paragraph 54 of the Practice Guidelines, be included in the Regulations. The Delegation of the Russian Federation observed that the expression “amendments” encompassed “corrections.” The Delegation of the United Kingdom observed that those terms reflected already well known concepts. Explaining the distinguished usage of the terms “correction,” “rectification” and “amendment” under the PCT, the International Bureau noted that the concepts behind the terminology, rather than the terminology as such, were important.

143. The Delegation of Spain noted that the word “abstract” was not referred to in the Spanish text.

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

Paragraph (3)

145. The Chair suggested the insertin of the phrase “subject to Article 7(5),” at the beginning of the paragraph within square brackets.

146. In response to the proposal by the Delegation of India to replace the word “may” by “shall,” the International Bureau clarified that it found no problem to do so, since the obligatory character of this provision was not affected by such a change.

147. The Delegation of the United States of America, supported by the Delegations of Japan, the Russian Federation and Sri Lanka, stated that corrections of clear mistakes should also be governed by the rule prohibiting new matter as it was the case in respect of other corrections and amendments. The Delegation of Canada proposed deleting the words “, other than the correction of a clear mistake as prescribed in the Regulations,”. The International Bureau clarified that, for example, if a person skilled in the art could clearly understand from the context that the word “acid” in the description was meant to be “alkali,” correcting the word “acid” to the word “alkali” did not change the understanding, and thus did not constitute adding new matter.

148. The Delegation of the United States of America requested clarification concerning the expression “going beyond the disclosure,” as it did not agree with paragraph 61 of the Practice Guidelines in relation to adding a new reference to an item of prior art in the description. The Delegation was of the view that the added reference to the item of prior art

could be used as a basis for the disclosure, provided that such an addition complied with the general rule of prohibiting the inclusion of new matter. The Chair suggested taking into account the recent discussions of the Meeting of International Authorities under the PCT.

149. The Delegation of the Russian Federation, supported by the Delegations of the Republic of Moldova and Sri Lanka, stated that the rule prohibiting the inclusion of new matter should also apply to corrections and amendments of the abstract. The International Bureau noted that, on the one hand, since the role of the abstract was to serve information purposes only, it could be treated differently from other parts of the application. On the other hand, in light of ensuring a high quality of the abstract, it could be argued that that rule, which was applicable to other parts of the application, should also apply to the abstract. The Delegation of Canada supported the deletion of the word “abstract,” since the abstract had no legal status. The Representative of the EPO reserved its position on this matter.

150. In response to a query by the Delegation of India regarding the meaning of the phrase “included, in accordance with the Patent Law Treaty... or a missing drawing”, noting that the phrase related to a missing part of the description or a missing drawing under Article 5(6)(b) of the PLT, the International Bureau stated that it would review and attempt to clarify the wording of the provision.

151. The Delegation of Mexico noted a discrepancy between the English text and the Spanish text with respect to the English word “included.”

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

Paragraph (4)

153. The Chair noted that this provision was inherently linked to draft Article 7(2). The Delegation of the United States of America generally agreed with the concept of this paragraph, but expressed its reservation on the text as proposed, subject to the meaning of the phrase “the Office is responsible for the preparation of the final contents of the published abstract.” The Delegation of Australia queried whether the term “Office” covered International Search Authorities (ISA) under the PCT. The International Bureau agreed to reviewing the question as to whether an applicant should be allowed to amend the abstract in the national phase, where the abstract was prepared by the ISA.

154. The Delegation of Argentina stated that the expression “the published abstract” should be replaced by the expression “the abstract to be published.”

Paragraph (5)

155. The Delegation of Germany, supported by the Delegation of Japan, stated that, if the disclosure in the abstract on the filing date could form the basis for amendments and

corrections of an application, for example, an amendment of the claims, the disclosure in the abstract would be indirectly used for the purpose of interpreting the claims. The Representative of the EPO stated that the status and function of the abstract should be limited to providing technical information only.

156. The Delegation of Canada, supported by the Delegations of the Republic of Moldova, the Russian Federation, Sri Lanka, Sweden, the United Kingdom and the United States of America, supported the general concept of this provision with the word “shall.” The Delegation noted that the same effect could be achieved by way of inserting the words “and the abstract” before the words “on the filing date” in draft Article 7(3). The Delegation of the Russian Federation was of the view that this provision did not contradict the principle that the abstract should serve for information purposes only. The Delegation also noted that the use of the term “disclosure” might create confusion in the context of this paragraph, which addressed the contents of the abstract. The Delegation of the United Kingdom considered that the disclosure in the abstract on the filing date could be taken into account for amendments and corrections, but should not be taken into account in any other respect, such as for the purpose of interpreting the claims.

157. In response to queries by some delegations, the International Bureau, supported by the Delegations of Sri Lanka and the Russian Federation, proposed deleting the words “, where the applicant is responsible for the preparation of the abstract,” and adding the words “where the abstract was submitted by the applicant” after the words “disclosure in the abstract.” Further, in response to the Chair, the International Bureau suggested replacing the words “shall be allowed taking account of the disclosure” with the words “shall take into account the disclosure.”

158. The Delegation of the United States of America reiterated that the abstract should not only form the basis for amendments and corrections, but also be part of the disclosure. The Chair noted that that matter should be dealt with in draft Article 5(3).

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

Draft Article 7bis: Amendments or Corrections of Patents

160. The Delegation of Canada questioned the value of this provision in the Treaty. The Delegations of Argentina, Colombia, India, Ireland and Peru and the Representative of IDMA suggested deleting this provision for the following reasons: the post-grant nature of the provision; lack of legal clarity; and the possibility of abuse. The Representative of GRUR noted that some issues covering post-grant procedures were also found in other parts of the Treaty. The Delegation of Brazil and the Representative of OAPI reserved their position.

161. The Delegations of France, Germany, the Russian Federation and the United States of America and the Representatives of EPI and GRUR supported the inclusion of this provision, which would provide a limitation procedure in all Contracting Parties. The Delegation of the Republic of Moldova stated that more details should be included in the Regulations. Noting

that the provision might be useful in principle, the Delegation of the Netherlands, however, expressed concern about the applicability of this provision to a non-examining Office. The Representative of GRUR noted that the limitation procedure might also be ordered by a court and suggested reviewing the definition of “Office” in draft Article 1 to make it compatible with draft Article 7*bis*. The International Bureau agreed to review the matter in connection with the definition of the term “Office” in draft Article 1(i) and paragraph 67 of the Practice Guidelines. The International Bureau further noted that, when redrafting paragraphs (2) and (3), it would ensure compliance of its wording with draft Article 7(3).

162. The Chair summarized the discussion as follows: although a number of delegations expressed the opinion that this Article should be deleted, a number of other delegations considered that it would have the effect of providing a post-grant limitation procedure in all Contracting Parties. The International Bureau noted that paragraphs (2) and (3) should be brought into line with draft Article 7(3) when redrafting these provisions.

Draft Article 8: Prior Art

Paragraph (1)

163. The Delegation of the United States of America, supported by the Delegations of Argentina and Australia, and by the Representative of IDMA and IIPS, reiterated their support to the inclusion of a provision to provide for loss of patent rights where the applicant or patentee had made secret prior commercial use of an invention or previously offered a product for sale without disclosing the invention. The Delegations of Brazil and Sri Lanka reserved their position while acknowledging some merits in the arguments put forward by the Delegation of the United States of America.

164. The Delegation of Canada, supported by the Delegations of Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Japan, the Netherlands, New Zealand, Norway, the Republic of Korea, the Russian Federation and Sweden, and the Representative of the EPO, opposed the inclusion of such a provision in the SPLT.

165. The Representative of GRUR, although being in favor of the current wording, felt that the arguments put forward by the Delegation of the United States of America should be given consideration and suggested the inclusion of an optional clause which would provide for a ground for refusal. The Representative of CEIPI, supported by the Delegation of Germany, suggested that the problem be solved in the context of draft Article 13 instead of draft Article 8.

166. Given the fundamental split between the delegations, the International Bureau suggested that a new paragraph covering the issue of secret prior art be added in square brackets giving further consideration as to whether the issue should be dealt with as a matter of prior art or in the context of the grounds for refusal. This proposal received support from the Delegation of Canada.

167. The Representative of IPO suggested the inclusion in the draft SPLT of an objective and a global definition of prior art.

168. The Chair summarized the discussions on paragraph (1) as follows: a number of delegations supported the inclusion of a loss of rights provision in the context of secret commercial use. A majority of delegations, however, opposed this proposal. One delegation

suggested dealing with the issue on an optional basis in the framework of draft Article 13. The Chair concluded that the provision could be provisionally accepted, subject to the inclusion, in the next draft of the Treaty, of new draft text within square brackets addressing the issue of secret commercial use, in the context either of draft Article 8 or of draft Articles 13 and 14.

Paragraph (2)(a) and (b)

169. The Delegation of France, supported by the Representative of the EPO, suggested combining subparagraphs (a) and (b) for more clarity. In relation to the reference to publication of earlier application, the Delegation suggested that, after 18 months from the priority date, the application be published or the file be made accessible to the public. The Representative of the EPO, supported by the Delegation of Ireland, proposed the inclusion of a provision according to which publication of the application be made as soon as possible after 18 months. Rather than including such a provision in draft Article 8(2), the Delegation of Canada, supported by the Delegation of the United Kingdom, suggested including a separate provision on publication.

170. The Delegation of the United States of America, however, stated that prior art effect and publication were two distinct issues and that it could not agree to a new provision concerning mandatory publication which did not relate to the objective of the SPLT. The Chair reminded the SCP that, at an earlier session of the SCP, it was agreed that the issue of early publication of applications should be postponed. In response to the Representative of EAPO who sought clarification concerning the meaning of the term “publication,” the International Bureau explained that that term had to be understood as “made available to the public” in this context and that this might have to be made clear in the context of this provision.

171. The Delegation of the Russian Federation requested clarification of the term “earlier application,” since in certain cases, the “earlier application” could be filed “later” than the application under consideration. In this connection, the Delegation of Canada proposed replacing, in the first line of both subparagraphs (a) and (b), “an earlier application” by “another application (hereinafter referred to as the co-pending application)” and by “the co-pending application” in the rest of the paragraph. The Delegation of the United Kingdom was hesitant to accept the term “co-pending,” since an earlier application did not have to be pending to have prior art effect.

172. The Delegation of the United States of America maintained its position that the prior art effect of earlier applications should apply to both the determination of novelty and non-obviousness, and observed that some of the issues related to the definition of novelty. The Delegation of Canada and the Representative of the EPO did not support such a prior art effect being applied to the determination of inventive step. However, the Delegation of Canada agreed with the concern regarding the definition of the term “novelty.”

173. In response to the Delegation of Argentina, which wondered whether it should not be clarified that Offices carrying out substantive examination should not start examination before the earlier application had been published, the Chair noted that, in examining Offices, an objection could only arise after the earlier application had been published.

174. The Chair summarized the discussions on draft Article 8(2) as follows: some delegations proposed combining subparagraphs (a) and (b), while some other delegations wished to maintain the present structure to clearly express the concepts involved. One

delegation expressed the view that the prior art effect of earlier applications should apply to both novelty and inventive step. There was some discussion on the possible introduction of a provision on the publication of applications after 18 months, either in the framework of this provision or as a separate provision in the draft Treaty. This concept was supported by some delegations and opposed by some others. It was concluded that the International Bureau would reflect upon the need for such a provision. It was further decided that the International Bureau would reconsider the use of the term “earlier applications,” since this expression as used in the draft text also covered applications the filing date of which was later than the filing date of the application under consideration.

Paragraph (2)(c)

175. The International Bureau explained that the text of this paragraph came from previous draft Article 1(v) and that the term “pursuant to” should be replaced by the term “referred to in” throughout subparagraph (c).

176. The Delegation of the United Kingdom preferred Alternative A, but proposed to replace, in item (i), the words “with effect in” by “with or for” for reasons of consistency. The Delegation of Germany supported Alternative A, but considered that the reference to draft Article 3(1)(i) to (iii) did not sufficiently cover all types of applications envisaged. The Delegations of Brazil, the Russian Federation and Spain expressed preference for Alternative A. The Delegation of Japan stated that it was in favor of Alternative A because Alternative B would create legal uncertainty. The Representative of the EPO felt that Alternative A was more user-friendly. The Delegation of the Republic of Korea preferred Alternative A, since translations of earlier PCT international applications would not always be available in the case of Alternative B.

177. The Delegation of the United States of America, which supported Alternative B, stated that the whole of draft Article 8(2) did not conflict with PCT Article 64(4) and that the concept of the Hilmer doctrine was under consideration in its country. The Delegations of Canada and India, and the Representatives of CEIPI, EPI and IPO, spoke also in favor of Alternative B. The Representative of CEIPI, speaking in a personal capacity, further noted that Alternative A was in violation with PCT Article 11(3), unless a Contracting Party had made a reservation under PCT Article 64(4).

178. The Chair summarized the discussion as follows: one delegation suggested that the reference to draft Article 3(1)(i) to (iii) in this provision did not cover all cases envisaged. The Delegation of the United States of America noted that the issue of the Hilmer doctrine was still under consideration in its country. One delegation suggested, for reasons of consistency, replacing, in item (i) of Alternative A, the words “filed with effect in” by the words “filed with or for.” The majority of delegations supported Alternative A, while a smaller number of delegations spoke in favor of Alternative B. The SCP decided to keep both alternatives in the next draft.

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

Paragraph (1)

179. The Delegation of Ireland pointed out that the expression “through use” would also include prior use. The SCP provisionally accepted the provision as proposed.

Paragraph (2)(a)

180. The Delegation of the Russian Federation reiterated its proposal, previously expressed on several occasions, to replace the word “reasonable” by the term “legitimate.” The Delegation of Canada suggested including some of the details regarding the expression “reasonable possibility” contained in paragraph 76 of the Practice Guidelines in the Regulations. The Chair noted that paragraph 77 of the Practice Guidelines could also be relevant. The Representative of EPI proposed putting the words “there is a reasonable possibility that” in square brackets or to delete them.

Paragraph (2)(b)

181. The Delegation of the United States of America suggested replacing the word “obligation” or to clarify that term, for example by inserting the words “express/explicit or implicit” before the word “obligation.” Further, since the term “obligation” implied the existence of legal contracts under its jurisdiction, the Delegation suggested replacing that term with another term or clarifying circumstances that there was a reasonable expectation that the information concerned should be kept secret.

182. The Chair summarized the discussions on paragraph (2)(a) and (b) as follows: based on paragraphs 76 and 77 of the Practice Guidelines, the International Bureau was requested to further elaborate on the expression “reasonable possibility” in the Regulations. The Chair invited delegations to submit written proposals to the electronic forum to assist the International Bureau. The use of the term “obligation” should be reviewed in order to cover circumstances outside strictly contractual relations.

Paragraph (3)

183. The Delegation of Argentina, supported by the Delegations of Brazil, India, Pakistan, Peru, Spain and Sudan, proposed replacing the words “last day” by the words “first day” so that a patent would not be granted to an invention to which a patent should not be granted, because the date of availability to the public was not specified.

184. The Delegation of the United States of America spoke in favor of the current wording since the Patent Office should have the burden to prove that the claimed invention was not patentable. The Delegations of Austria, Canada, Germany, Finland, Japan, Norway, the Republic of Moldova, the Russian Federation, Sweden and the United Kingdom and the Representatives of the EAPO, the EPO and EPI supported the Delegation of the United States of America, as in practice, if the presumption of the date of publication was based on the first date of the month or the year, the applicant, who might be in another country, might not have the possibility to prove the date of actual publication made by a third party. On the other hand, anybody would agree that, at least on the last date of the month or the year, the publication was made available to the public. The International Bureau pointed out the danger of abuse, especially when making information available to the public via the Internet, in case the words “first day” would be introduced. Referring to Article 34.2 of the TRIPS Agreement, the Delegation of India reserved its position on draft Rule 8(3).

185. The Delegation of Canada suggested the inclusion of a general statement to the effect that the Office would resolve any doubt in favor of the applicant when considering an application. This suggestion was supported by the Delegation of the Republic of Moldova,

but the Delegations of Argentina, Brazil and Sri Lanka reserved their position on the suggestion.

186. The Representative of ABPI pointed out that it might be impossible for individual inventors to furnish proof regarding the actual date of availability to the public.

187. The Representative of GRUR mentioned that Article 114 of the EPC, which was also applied by the German Patent Office, provided for an *ex officio* burden of proof by the Office and that the relevant provisions were contained in Article 62 of the TRIPS Agreement rather than in Article 34.

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

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

Paragraph (1)(a) and (b)

189. The SCP provisionally accepted the text as proposed.

Paragraph (2)

190. As regards two alternative phrases placed within square brackets, the Delegations of Germany, the Netherlands and the Republic of Korea expressed support for the first alternative in order to protect third parties. The Delegation of the United Kingdom was in favor of the first alternative but deleting the phrase “and should not have been published under the applicable law” since the expression “no longer pending” seemed to cover all situations. The Representative of the EPO supported the first alternative with the amendments proposed by the Delegation of the United Kingdom, but stated that it would consider the matter further.

191. The Delegations of Argentina, Australia, Canada, India and the Russian Federation spoke in favor of the second alternative because of its clarity. The Delegation of the Russian Federation suggested that, although, in general, an application would not be published if it was withdrawn before publication, the words “and should not have been published under the applicable law” be added in the second alternative text.

192. In response to the suggestion by the International Bureau to include the words “or considered withdrawn” in the second alternative text, the Delegations of Canada and the Netherlands noted that it might introduce uncertainty in the text. The Representative of ABPI preferred the second alternative.

193. The Delegation of the United States of America reserved its position concerning both alternatives. In response to a query by that Delegation, the Chair noted that the words “that Article” in the last line should expressly refer to draft Article 8(2).

194. The Chair summarized the discussion as follows: while the majority of the delegations expressed preference for the second alternative in square brackets, there was some support for the first alternative as well. One delegation proposed retention of the first alternative, but deleting the words “and should not have been published under the applicable law.” Some delegations wished to reflect on a proposal to include, in the second alternative, the words “or considered withdrawn.” The SCP further agreed to refer expressly to draft Article 8(2) in the last line.

Paragraph (3)

195. In response to a query by the Delegation of Argentina, the International Bureau noted that the reference to paragraphs (1) to (3) should be corrected to paragraphs (1) and (2).

196. The Delegations of India, Japan and the Republic of Korea and the Representative of IIPS supported retention of this paragraph. The Delegation of the United States of America, supporting the retention of the anti-self-collision provision, stated that the final wording of this provision would depend on the discussion on the grace period.

197. As regards the link with protection against double patenting, the Delegation of Canada, which was in favor of a provision on anti-self-collision, preferred the alternative language at the end of the sentence which had been struck out, since there was potential for abuse in the present wording. In response, the Delegation of the United States of America expressed its concern about the term “patentably distinct” in connection with its practice of a patent with a limitation disclaimer.

198. The Delegations of Australia, Finland, Germany, Greece, Ireland and Sweden and the Representatives of the EPO and EPI were of the view that this provision was not necessary.

199. The Delegation of Australia was of the opinion that the priority of two applications filed on the same date was an issue to be considered by the SCP.

200. The Chair summarized the discussion on paragraph (3) as follows: the discussion showed a significant division among delegations on whether or not to include this provision in the SPLT. One delegation pointed out that this provision would have to be reconsidered in the context of the grace period provision and one delegation wished to reinsert the deleted text. It was agreed that this provision should be placed within square brackets. The reference to paragraphs (1) to (3) should be corrected to refer to paragraphs (1) and (2).

Draft Article 9: Information Not Affecting Patentability (Grace Period)

201. The Delegation of Greece made the following statement on behalf of the European Community and its Member States:

“The European Community and its Member States consider that the introduction of a uniform grace period at the international level could be beneficial to users of the patent system. For reasons of legal certainty, harmonization should be aimed at within the framework of a first to file system. If introduced, the grace period should be strictly regulated, so as to constitute a safety net for applicants. As far as duration is concerned, a period limited in time should be introduced, so as to minimize legal uncertainty - possibly a period not exceeding six months before the priority date of the claimed

invention. The grace period should not affect priority rights under the Paris Convention. The grace period should cover all disclosures of information prior to the filing of an application that could affect the patentability of an invention. It should be claimed by the applicant, unless the applicant was not aware and could not have been aware of the disclosure. Finally, the Member States of the European Union would like to stress the importance of striking a balance between the rights of applicants and those of third parties. Third party rights should not be affected in any way by the introduction of a grace period.”

202. In response to a request for clarification by the Delegation of Canada, the Delegation of Greece confirmed that the European Community and its Member States considered that the grace period should not exceed six months before the priority date of the claimed invention and should not affect the priority period provided under the Paris Convention, but stated that it was not in a position to provide further details at this stage.

203. The Delegations of Norway, the Republic of Moldova, Romania, Slovenia and Turkey, and the Representative of the EPO, stated that they supported the statement made by the Delegation of Greece speaking on behalf of the European Community and its Member States.

204. The Delegation of Switzerland stated that it continued to have doubts on the inclusion of a grace period. However, if there were a consensus in support, it would not oppose the grace period provided that it was limited in both duration and effect. The Delegation could therefore support the statement made by the Delegation of Greece.

205. The Delegation of Argentina stated that it supported a grace period in principle. It also supported a period of 12 months preceding the priority date. It was also of the view that a third party should have the right to continue to use the invention if it had begun such use before the invention had been disclosed and that national law should at least have the option of providing for third party rights.

206. The Delegation of the United States of America confirmed its strong support for the inclusion of a grace period in the draft Treaty. It viewed the statement made by the Delegation of Greece with some concern. In its view, the grace period should be 12 months, since a shorter duration would introduce confusion and be insufficient for applicants to take full advantage of the grace period. The Delegation also opposed any requirement that the applicant should claim the grace period, since this would impose an unnecessary burden on applicants, particularly smaller enterprises. The Delegation also did not support the inclusion of third party rights under paragraph (5) since it regarded the provision of such rights as an infringement matter which should not be regulated by the Treaty. In response to a suggestion by the Chair that, as a compromise taking account of the support for inclusion of a provision on third party rights expressed by delegations at earlier sessions of the Committee, paragraph (5) be made a “may” provision, the Delegation of the United States of America observed that this would have the same effect as deleting the paragraph.

207. The Delegation of the United States of America also stated that it did not support the inclusion, in paragraph (3), of provisions in respect of evidence which it considered would be better left to national law. If paragraph (3) were retained, it should be limited significantly.

208. The Delegation of India stated that it could support a grace period, if it was limited to six months. The Delegation of Sri Lanka also expressed support for a grace period of six months.

209. The Delegation of Brazil stated that it supported a grace period of 12 months as it already existed in its national law. It did not support paragraph (5) as drafted because it provided an exception to the grace period. It would, however, consider the compromise suggested by the Chair.

210. The Delegation of Canada expressed strong support for the inclusion of a grace period. It would have preferred to link the issue of “first to file” with the grace period but, in view of the importance of that period, it was prepared to agree to its inclusion in the Treaty even if there was no agreement on “first to file.” With regard to the statement made by the Delegation of Greece, the Delegation of Canada was opposed to obliging an applicant to claim the grace period, and favored a duration of 12 months preceding the priority date. It considered that the provision on third party rights was an important matter that should be made mandatory; however, it could accept the limitation of paragraph (5) to particular embodiments.

211. The Delegations of Australia, Colombia and Peru expressed support for a grace period of 12 months.

212. The Delegation of Australia also stated that the applicant should not be obliged to claim the grace period.

213. The Representative of ABPI and FICPI stated that the organizations he represented supported a grace period of 12 months and were of the view that there should be no obligation on the applicant to claim it. The Representative of ABPI explained that, under Brazilian law, according to which the Office might require an applicant to file, together with the application, a declaration regarding the disclosure concerned, there was an understanding that such a requirement might remove the benefits of the grace period particularly from individual inventors. The Representative of IPO also supported a grace period of 12 months with no obligation on the applicant to claim it.

214. The Representative of IDMA supported a six month grace period. The Representative of MPI stated that it supported a grace period with no obligation on the applicant to claim it. The Representative of GRUR stated that, while a majority of the members of his organization strongly supported a grace period, a minority opposed it. The Representative of EPI stated that, although his organization opposed a grace period, it would agree to such a period regulated as set out in the statement by the Representative of Greece, in particular, as regards the requirement that the applicant should be required to claim it.

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

on whether the grace period should have to be claimed by the applicant. Doubts were further raised as to the appropriateness of paragraph (3), since it was a provision relating to evidence. The SCP decided that the International Bureau would include alternatives reflecting different options in the next draft.

Draft Article 10: Enabling Disclosures

Paragraph (1)

216. The Delegation of Ireland stated that the use of the term “claimed invention” in lines 1 and 3 of paragraph (1) was inconsistent with the use of the unqualified term “invention” in lines 2 and 4 of that paragraph. Following a suggestion by the Delegation of Germany that this was an essentially theoretical matter but that the wording used in the EPC might provide a solution, the Delegation of Ireland suggested that the unqualified term “invention” be used in all four instances, consistent with the reference to “an invention” in Article 83 of the EPC. The Delegation also suggested that, with this change, draft Article 11(3) would not be required. The Delegation of France noted that the French text of paragraph (1) used the unqualified term “*l’invention*” in all four instances.

217. The Chair and the International Bureau, supported by the Delegation of Canada, suggested that, since an enabling disclosure was required for each claimed invention, the term “claimed invention” be retained in lines 1 and 3 of paragraph (1) and that the term “the invention” be changed to “that invention” or “the claimed invention” in lines 2 and 4 of that paragraph.

218. The Delegation of the United Kingdom stated that it supported the existing relationship between draft Articles 10 and 11. It noted that the definition of “claimed invention” in draft Article 1(vi) implied that each claim related to a separate claimed invention.

219. The Delegation of the Russian Federation noted that, in connection with the issue of “claimed invention” in draft Article 10(1) raised by the Delegation of Ireland, it was also necessary to take account of priority claims based on an earlier application which did not contain an enabling disclosure in respect of a claimed invention.

220. As regards the relationship between draft Articles 10 and 11(3), the Delegation of Canada expressed the view that these Articles encompassed three principles. The first principle was that the application should contain an enabling disclosure as required under draft Article 10, including enablement by the claims as provided under draft Article 10(2). The second principle was that the claims be supported by the description and drawings, as provided under draft Article 11(3) and draft Rule 12(3), non-compliance with which should, in the view of the Delegation, be grounds for refusal of an application, but not grounds for invalidation of a granted patent. The third principle was that the subject matter of the claimed invention should have been recognized by the applicant on the filing date, which, if necessary, could be established later by extraneous evidence.

221. The Delegation of Argentina noted that, since the skill and knowledge in respect of different technologies varied from country to country, the enabling disclosure that was required in an application would also vary from country to country. Accordingly, the Delegation suggested that the term “a person skilled in the art” referred to in paragraph (1) should be a person skilled in the art in the country of grant. The Chair noted that such change would run counter to the objective of harmonization, since the effect could be that the

application would need to contain more information in a less developed country than in a more developed country.

222. The suggestion of the Delegation of Argentina regarding a person skilled in the art was opposed by the Delegations of Canada, Finland, France, Germany, Greece, Ireland, Morocco, Sri Lanka, Sudan, the Russian Federation and the United States of America, and the Representatives of the EPO and ABPI, since this would be inconsistent with the adoption of a worldwide standard for disclosure needed for the international harmonization of patent laws, introduce subjective criteria, and impose an unfair burden on applicants to provide different descriptions for different countries.

223. The Delegation of India stated that it had no position on the suggestion by the Delegation of Argentina in respect of the person skilled in the art. It agreed that the suggestion ran counter to the objective of harmonization, but questioned whether harmonization was, in fact, appropriate while different countries were at different stages of development. The Delegation noted that a patent was a compact between one side who was granted protection for an invention and society on the other which obtained knowledge on how to make and use the invention, and commented that if, in a particular country, there was no person skilled in the art, there was in fact no compact in that country. The Delegations of Brazil and Egypt stated that the suggestion by the Delegation of Argentina raised important issues which required further consideration, and therefore reserved their position on the matter. The Representative of ABPI noted that, if the concept of “a person skilled in the art” were tied to an actual person in a country, rather than a hypothetical person as defined in draft Rule 2, the criteria for assessing enabling disclosure in that country could change if, for example, the only person skilled in the art in that country died.

224. The Delegation of Argentina also suggested that the expression “as of the filing date” in paragraph (1) should be changed to “on the filing date” to avoid the possibility that dates after the filing date were also included.

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

Paragraph (2)

226. The Delegation of Canada noted that the words “on the filing date” were inconsistent with the reference to “as amended and corrected,” since applications were not normally amended or corrected on the filing date. The Delegation accepted the principle that the application should not be amended or corrected in a way that new matter was added to the disclosure contained in the description, claims and drawings on the filing date but, in its view, this was adequately regulated under draft Article 7(3). The Delegation, supported by the Delegation of Morocco, therefore suggested that the words “on the filing date” in paragraph (2) be deleted. In response to a suggestion by the Delegation of Ireland, supported by the Delegation of Germany and the Representative of the EPO, that the words “as amended and corrected under the applicable law” should be deleted instead of the words “on the filing date,” the Delegation of Canada explained that the effect of such a change would be that,

where the description in an application as filed contained enabling disclosure for a claimed invention in the description and drawings, the disclosure would continue to be regarded as sufficient for the purposes of that claimed invention even if the description and drawings containing the enabling disclosure concerned were subsequently deleted by way of amendment.

227. The Delegation of Sri Lanka suggested that the words “under the applicable law” were not required in paragraph (2), since the amendment and correction of applications were regulated in draft Article 7(2).

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

CONCLUSION OF THE MEETING

Agenda Item 5: Future Work

229. 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.

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

Agenda item 6: Summary by the Chair

231. The draft Summary by the Chair (document SCP/9/7 Prov.) was noted with certain amendments which will be included in the final version (document SCP/9/7).

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

Agenda Item 7: Closing of the Session

233. The Chair closed the session.

234. In accordance with the procedure previously adopted by the Committee (see paragraph 232, above), Committee members are 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 tenth session.

[Annex follows]

ANNEXE/ANNEX

I. ÉTATS MEMBRES/MEMBER STATES

(dans l'ordre alphabétique des noms français des États)
(in the alphabetical order of the names in French of the States)

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