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UNITED KINGDOM

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(Sections 60 (*continued*) to 77) Text 2-001

WIPO 1990

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Notifications Concerning Treaties

WIPO Convention

Accession

SINGAPORE

The Government of Singapore deposited, on September 10, 1990, its instrument of accession to the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1967, and amended on October 2, 1979.

Singapore will belong to Class C for the purpose of establishing its contribution towards the budget of the WIPO Conference.

The said Convention, as amended on October 2, 1979, will enter into force, with respect to Singapore, on December 10, 1990.

WIPO Notification No. 149, of September 14, 1990.

WIPO Meetings

Paris Union

Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions

First Part of the Eighth Session
(Geneva, June 11 to 22, 1990)

NOTE*

The Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (hereinafter referred to as "the Committee of Experts") held its eighth session in Geneva from June 11 to 22, 1990.¹

The following States members of the Paris Union were represented at the session: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Cameroon, Canada, China, Cuba, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Ghana, Greece, Hungary, Indonesia, Iraq, Ireland, Israel, Italy, Japan, Kenya, Lebanon, Libya, Madagascar, Malawi, Mexico, Morocco, Netherlands, New Zealand, Nigeria, Norway, Philippines, Poland, Portugal, Republic of Korea, Romania, Soviet Union, Spain, Sweden, Switzerland, Syria, Turkey, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Zaire (55).

The following States members of WIPO were represented by observers: Chile, Ecuador, Guatemala, India, Nicaragua, Panama, Peru, Republic of Yemen, Swaziland, Venezuela (10). Namibia was also represented by an observer. Representatives of six inter-governmental organizations and 30 non-governmental organizations also participated in an observer capacity. The list of participants follows this Note.

The Committee of Experts considered the following 18 questions:

- (i) Establishment of a Union;
- (ii) Definitions;
- (iii) Disclosure and Description, Contents and Order of Description;
- (iv) Claims, Manner of Claiming;
- (v) Unity of Invention, Division of Application;
- (vi) Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant;
- (vii) Priority Claim;
- (viii) Filing Date;
- (ix) Right to a Patent;
- (x) Loss of Rights;
- (xi) Fields of Technology;
- (xii) Conditions of Patentability;
- (xiii) Disclosures Not Affecting Novelty and Inventive Step (Grace Period);
- (xiv) Prior Art Effect of Certain Applications on Novelty;
- (xv) Amendment of Application;
- (xvi) Publication of Application;
- (xvii) Time Limits for Search and Substantive Examination;
- (xviii) Changes in Patents.

The discussions of the eighth session of the Committee of Experts were based on the following documents prepared by the International Bureau of WIPO: "Draft Treaty on the Harmonization of Patent Laws; Draft Regulations under the Draft Treaty (Preamble; Articles 1 to 8; Rules 1 to 6)" (document HL/CE/VIII/2); "Draft Treaty on the Harmonization of Patent Laws; Draft Regulations under the Draft Treaty (Articles 9 to 24; Rule 7)" (document HL/CE/VIII/3) and "Draft Treaty on the Harmonization of Patent Laws; Draft Regulations under the Draft Treaty (Articles 25 to 37; Rule 8)" (document HL/CE/VIII/4), as well as the proposals or comments

* Prepared by the International Bureau.

¹ For Notes on the first, second, third, fourth, the two parts of the fifth, sixth and seventh sessions, see *Industrial Property*, 1985, p. 267; 1986, p. 309; 1987, p. 204; 1988, pp. 179 and 358; 1989, pp. 53 and 269; 1990, p. 140.

by the Delegations of the following countries: Switzerland (document HL/CE/VIII/5, entitled "Draft Articles 7 and 8(1), (2) and (3)"); Austria (document HL/CE/VIII/6, entitled "Draft Article 22"); United States of America (document HL/CE/VIII/7, entitled "Comments Concerning the Question of International Organizations Becoming Party to the Treaty"); Denmark (document HL/CE/VIII/8, entitled "Draft Article 8(3) and Rule 6"); Sweden (document HL/CE/VIII/9, entitled "Draft Articles 2 and 11"); United Kingdom (document HL/CE/VIII/10, entitled "Draft Articles 3(2)(c), 6(1), 8(2)(b), 14, 15, 17(2) and (3), and 23(1)(b) and Draft Rules 4(1)(b), 5, 6(1) and (2)(a), and 7"); Italy (document HL/CE/VIII/11, entitled "Draft Article 19"); Federal Republic of Germany (document HL/CE/VIII/12, entitled "Draft Articles 4 and 23 and Draft Rule 2"); Netherlands (document HL/CE/VIII/13, entitled "Draft Articles 12, 18, 20 and 22"); United States of America (document HL/CE/VIII/14, entitled "Draft Articles 9bis, 12, 13, 15, 18, 19, 21 and 24"); Federal Republic of Germany (document HL/CE/VIII/15, entitled "Draft Article 3 and Rule 1"); France (document HL/CE/VIII/16, entitled "Draft Articles 9, 13 and 21"); Japan (document HL/CE/VIII/17, entitled "Draft Articles 2, 14, 19, 21 and 22"); Canada (document HL/CE/VIII/18, entitled "Draft Article 3(2)(c)"); Switzerland (document HL/CE/VIII/19, entitled "Draft Article 15"); Nigeria (document HL/CE/VIII/20, entitled "Draft Article 20"); United States of America (document HL/CE/VIII/21, entitled "Draft Rule 1"); Algeria, Argentina, Brazil, Cameroon, China, Cuba, Democratic People's Republic of Korea, Egypt, Ghana, Indonesia, Kenya, Libya, Madagascar, Mexico, Morocco, Nigeria, Romania, Syria, Trinidad and Tobago, Tunisia, United Republic of Tanzania, Uruguay, Zaire (document HL/CE/VIII/22, entitled "Draft Preamble, Draft Articles 10, 19, 22, 24 and 33 and Two New Draft Articles"); United States of America (document HL/CE/VIII/23, entitled "Draft Rule 6"); Sweden (document HL/CE/VIII/24, entitled "Draft Article 11(2)(d)"); Israel (document HL/CE/VIII/25, entitled "Draft Article 23(2)").

After hearing general statements from a number of representatives of non-governmental organizations, the Committee of Experts discussed the following questions.

Article 1: Establishment of a Union

Discussions were based on the text of Article 1 as elaborated by the International Bureau. This text read as follows:

"The States, supranational authorities and intergovernmental organizations party to this Treaty (hereinafter called 'the Contracting

Parties') constitute a Union for the purposes of this Treaty."

The portion of the report of the Committee of Experts concerning the discussion of Article 1 reads as follows:

"The Delegation of Nigeria suggested deleting the words 'supranational authorities' in this Article, in order to make it consistent with the definition of 'Office' contained in draft Article 2(iii), which did not refer to 'supranational authorities.'

The Delegation of Ghana, referring to the suggestion by the Delegation of Nigeria, noted that at present there did not seem to exist any supranational authorities in the field of patents, since organizations such as AIPO and the EPO were intergovernmental organizations. It seemed that this matter would need further explanation or clarification.

The Delegation of the United Kingdom indicated that supranational authorities were different from intergovernmental organizations and that the European Communities were an example of a supranational authority which had, or would have, competence in respect of certain aspects of patent law.

It was agreed that the question of whether 'supranational authorities' were to be mentioned in draft Article 1 should be reserved until draft Article 31 had been discussed, since the latter draft Article dealt with the entities that could become party to the Treaty. Otherwise, the draft Article was approved."

Article 2: Definitions

In addition to the text of Article 2 as elaborated by the International Bureau, discussions were based on texts proposed, respectively, by the Delegations of Japan and Sweden:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

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

(i) references to a 'patent' shall be construed as references to a patent for invention;

(ii) references to an 'application' shall be construed as references to an application for a patent;

(iii) 'Office' means the governmental or intergovernmental organization entrusted with the granting of patents by a Contracting Party;

(iv) 'official language' means the language or languages in which the Office concerned publishes patents granted by it;

(v) references to a 'person' shall be construed as references to both a natural person and a legal entity;

(vi) references to an application being 'rejected' shall be construed as including references also to an application that is considered rejected, withdrawn or abandoned;

(vii) 'priority date' means the filing date of the application (whether filed with the same or another Office) whose priority is claimed or, where the priorities of two or more applications are claimed, the filing date of the earliest-filed of those applications; the application whose priority is claimed may be an application for a patent, utility model or another title protecting an invention;

(viii) 'substantive examination' means the examination of an application by an Office to determine whether the invention claimed in the application satisfies the conditions of patentability referred to in Article 11(1);

(ix) 'Union' means the Union referred to in Article I;

(x) 'Assembly' means the Assembly of the Union;

(xi) 'Organization' means the World Intellectual Property Organization;

(xii) 'International Bureau' means the International Bureau of the Organization;

(xiii) 'Director General' means the Director General of the Organization."

[TEXT PROPOSED BY THE DELEGATION OF JAPAN]

"(vii) 'Priority date' means the filing date of the application (—) whose priority (whether based on the Paris Convention for the Protection of Industrial Property or internal priority) is claimed or, where the priorities of two or more applications are claimed, the filing date of the earliest filed of those applications; the application whose priority is claimed may be an application for a patent, utility model [or another title protecting an invention].

(vii)bis Internal priority shall mean that an application shall give rise to a right of priority for a subsequent application filed in the same Contracting Party, only if the subsequent application is filed within a period of 12 months from the filing date of the earlier application, with the same effect as that of a priority claimed under the Paris Convention for the Protection of Industrial Property, when a priority based on the earlier application is claimed in the subsequent application." (Document HL/CE/VIII/17, page 2)

[TEXT PROPOSED BY THE DELEGATION OF SWEDEN]

"(...) 'product' means any kind of physical entity such as an object, article, apparatus, device, machine, substance, compound or composition,

(...) 'process' means any kind of activity comprising one or several steps such as a method or process of manufacture, control or other treatment and shall include any use of a product or process,

(...) references to a 'pending' application shall be construed as references to an application that has not been finally withdrawn, abandoned or rejected, and on which no patent has yet been granted,

(...) an application or a patent shall be deemed to be 'published' when the application or the patent is available to the public." (Document HL/CE/VIII/9, page 2)

The portion of the report of the Committee of Experts concerning the discussion of Article 2 reads as follows:

"In respect of the term 'patent' referred to in item (i), it was pointed out that the reference to 'patent' should be understood to exclude titles of protection which, although called 'patents' in national laws, were not properly patents for invention. In particular, patents for plants, 'petty patents,' patents for utility models, utility certificates, and similar titles of protection should be understood as being excluded from the concept of 'patent' as used in the Draft Treaty.

It was agreed that the notes concerning the term 'patent' should make it clear that this term did not cover those titles of protection which, although called 'patents,' were not properly patents for invention, subject, however, to the understanding that the latter, as well as utility models, can be the basis of priority claims in patent applications.

In respect of the term 'application' referred to in item (ii), the Delegation of the Soviet Union suggested broadening the definition to include applications for other kinds of titles in addition to patents.

The Delegation of Japan indicated that the term 'application' could have different meanings in different Articles. In some Articles of the Draft Treaty an application was understood to include the request and the abstract, whereas in other Articles only the description, drawings and claims were understood to be covered.

Supporting the view of the Delegation of Japan, the Delegation of Egypt suggested replacing the words 'to an application for a patent' with the words 'to all or part of the contents of an application for a patent.'

The Delegation of the United Kingdom did not support the idea of establishing in the Draft Treaty a definition of what constituted an application since such a definition was not necessary and achieving agreement on it would probably take much time.

It was agreed that the Notes should explain what is meant by 'application' and that the question of whether the totality or only part of an application was covered in the relevant Articles would have to be examined and explained in respect of each Article.

As regards the term '*rejected*' referred to in *item (vi)*, the Delegation of the United States of America suggested replacing the definition contained in the Draft Treaty with the phrase used in paragraph 2.07 of the Notes on Article 2, according to which '*rejected*' is an abbreviated expression for '*any action taken, or considered to be taken, by an Office that terminates the pendency of an application.*' It was pointed out that the rejection of an application did not mean that an appeal against a rejection could not be launched.

It was agreed that the definition of the term '*rejected*' should cover the termination of the pendency of an application not only through action by the Office but also through withdrawal or abandonment by the applicant and that, when examining the context in which the term '*rejected*' was used in other provisions of the Draft Treaty, the drafting of the definition should be reviewed.

As regards the definition of '*priority date*' contained in *item (vii)*, the Delegation of Japan proposed inserting a definition of '*internal priority*' in Article 2 following the definition of '*priority date.*' It submitted a proposal to this effect (document HL/CE/VIII/17).

The Delegation of the Netherlands said that the definition of '*priority date*' would require some adjustment to fit the meaning of that term in draft Articles 11 and 12. The reference to the earliest-filed application seemed to be entirely correct only in the context of draft Article 15. The Delegation expressed doubts as to the need for a definition of '*priority*' in the Treaty. The Representative of CIPA stressed that, whatever priority date was meant, the priority accorded should be only in respect of matter disclosed in the elements of the application filed on the filing date.

It was agreed that the definition of '*priority date*' should be reviewed, in particular taking into account the case of multiple priorities in connection with Article 11(2)(b) and (3).

The Delegation of Sweden presented its proposal, contained in document HL/CE/VIII/9, for inserting in Article 2 definitions of the terms '*product,*' '*process,*' '*pending*' and '*published.*' It explained that the terms '*product*' and '*process*' were used, in particular, in draft Article 10 and that a definition would be useful. The term '*pending*' could be used in several provisions of the Draft Treaty replacing the various expressions which otherwise had to be used; thus, the use of the term '*pending*' would simplify the drafting, and, therefore, a definition of that term seemed desirable. The same would apply to the term '*published.*'

The Delegation of the United Kingdom supported the proposal presented by Sweden in

respect of the terms '*product*' and '*process.*' It suggested adding the word '*systems*' to the items listed in the proposed definition of '*product.*'

The Delegation of Switzerland supported the proposal by the Delegation of Sweden.

The Delegation of Ghana asked for clarification in respect of the expression '*composition.*'

The Representative of the European Patent Office suggested adding the words '*of matter*' after the word '*composition*' in order to dispel any doubts as to the meaning of the word '*composition*' as used in the context of that definition.

The Representative of ABA suggested that the definition of the term '*process*' should include the expression '*composition of matter,*' as contained in Section 100(b) of the patent law of the United States of America.

The Delegation of Japan said that the expression '*pending*' could be used in Articles 13 and 15 and that it therefore would be useful to define it.

In respect of the proposed definition of the term '*published,*' the Delegation of the United States of America pointed out that a definition was contained in draft Rule 7 but that the concept might change with future developments of technology.

The Delegation of the Netherlands supported the proposal of the Delegation of Sweden for the term '*published.*' It underlined that the mere reference to paper copies as in draft Rule 7 was too narrow and referred only to the means of achieving publication. The definition proposed by the Delegation of Sweden applied generally, regardless of the technology used in order to make the published matter available to the public.

The Delegation of the United Kingdom shared the view expressed by the Delegation of the Netherlands, underlining that the definition of the term '*published*' should be independent of developments in technology.

The Delegation of Sweden explained that the purpose of its proposal was to include any method which allowed reading of the material which was to be considered as having been published.

It was agreed to reconsider the question of a definition of the terms '*pending*' and '*published*' when examining draft Articles 13 and 15 and draft Rule 7."

Article 3: Disclosure and Description

Rule 1: Contents and Order of Description (ad Article 3(2))

In addition to the text of Article 3 and Rule 1 as elaborated by the International Bureau, discussions

were based on texts proposed by the Delegations of Canada, the Federal Republic of Germany, the United Kingdom and the United States of America. Those texts read as follows:

Article 3

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

“(1) [Disclosure] *The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.*

(2) [Description] (a) *The application shall contain a description.*

(b) *The description shall have the prescribed contents, and such contents shall be presented in the prescribed order.*

(c) *Where the description refers to biological material that cannot be disclosed in the description in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not accessible to the public, the description shall be supplemented by a deposit of such material with a depositary institution.*

(d) *No Contracting Party shall require the description to contain elements that are additional to or different from those provided for in and under this paragraph.”*

[TEXT PROPOSED BY THE DELEGATION OF CANADA]

“(1)

(2)

(b)

(c) *Where the description refers to biological material that cannot be disclosed in the description in such a way as to enable the invention to be carried out by a person skilled in the art without undue experimentation and such material is not readily accessible to the public, the description shall be supplemented by a deposit of such material with a depositary institution.*

(d)

(e)” (Document HL/CE/VIII/18)

[TEXT PROPOSED BY THE DELEGATION OF THE FEDERAL REPUBLIC OF GERMANY]

“(1)

(2)(a) and (b)

(c) *Where the description refers to biological material that cannot be disclosed in the description in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not accessible to the public, the description shall be supplemented by a deposit of such material with a depositary institution. The deposit shall have been made on or before the filing date of the application.*

(d) [to be deleted]

(3) *(Prohibition of other requirements) No Contracting Party shall provide for requirements in respect of the disclosure and the description that are additional to or different from those provided for and*

in under paragraphs (1) and (2).” (Document HL/CE/VIII/15, page 2)

[TEXT PROPOSED BY THE DELEGATION OF THE UNITED KINGDOM]

“The following sentence should be added to paragraph (2)(c):

“[A Contracting Party may require that the] [The] deposit shall have been made on or before the filing date of the application.” (Document HL/CE/VIII/10, page 2)

Rule 1

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

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

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

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

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

(iv) *where a deposit of biological material is required under Article 3(2)(c), indicate the fact that the deposit has been made and identify at least the name and address of the depositary institution, the date of the deposit and the accession number given to the deposit by that institution;*

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

(vi) *set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, priority date of the application;*

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

(2) [Order of Presentation of Contents] *The contents of the description shall be presented in the order in which such contents are listed in paragraph (1), unless, because of the nature of*

the invention, a different order affords a better understanding and a more economical presentation."

[TEXT PROPOSED BY THE DELEGATION OF
THE FEDERAL REPUBLIC OF GERMANY]

"(1)(i), (ii) and (iii)

(iv) where a deposit of biological material is required under Article 3(2)(c), indicate the fact that the deposit has been made and identify (–) the depository institution, state the date of the deposit and the accession number given to the deposit by that institution, and contain *such relevant information as is available to the applicant on the characteristics of the biological material;*

(v)

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

(vii)

(2) (*Order of Presentation of Contents*) The contents of the description shall be presented in the *manner and order* in which such contents are listed in paragraph (1), unless, because of the nature of the invention, a *different manner or a different order* would afford a better understanding or a more economic presentation." (Document HL/CE/VIII/15, page 3)

[TEXT PROPOSED BY THE DELEGATION OF
THE UNITED STATES OF AMERICA]

"The following should be added to paragraph (1):

'Any Contracting Party shall be free to require only items (iii), (iv), (vi) and (vii) for the contents of the description, and in lieu of item (iii) may require a description of the invention, and of the manner of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use it.'

In paragraph (2) change 'shall' to 'should'." (Document HL/CE/VIII/21)

The portion of the report of the Committee of Experts concerning the discussion of Article 3 and Rule 1 reads as follows:

"*Paragraph (1)*. The Delegation of Japan asked for a clarification of the term 'application' as used in draft paragraph (1), stating that the term should be understood as comprising the description, claims and drawings (if any), but not the abstract or the request form.

It was agreed that the explanatory Notes would indicate what the term 'application' meant in this context.

Paragraph (2)(a) and (b). The Delegation of the United States of America, supported by the Delegation of Israel, advocated a provision similar to that contained in draft Article 4(6)(b), which would allow flexibility to Contracting Parties not to require compliance with all the disclosure requirements, for the benefit of the applicant. This

view was supported by the Representatives of AIPLA and of NYPTC.

Several delegations disagreed with the suggestion of the Delegation of the United States of America and stated that one of the main purposes of the patent system was to provide technical information for the public. This aim could best be fulfilled by having a consistent and uniform structure of patent documents achieved through a set of mandatory requirements.

It was agreed that this question should be considered in the context of Rule 1 (see paragraphs 75 and 85, below).

Paragraph (2)(c). The Delegation of the United Kingdom introduced its proposal contained in document HL/CE/VIII/10, which would amend draft Article 3(2)(c) by introducing an alternative, either allowing or obliging a Contracting Party to require that the deposit be made on or before the filing date of the application where the description referred to biological material that could not be disclosed in the description in such a way as to enable the invention to be carried out by a person skilled in the art and such material was not accessible to the public. The Delegation of the United Kingdom stated that it wished to align its proposal with the proposal of the Delegation of the Federal Republic of Germany contained in document HL/CE/VIII/15.

The Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/15. The Delegation stated that any deposit of biological material had to take place on or before the filing date; otherwise there would be a lack of disclosure on that date. The Delegation added that its proposal in respect of draft Article 3(2)(c) had to be read in conjunction with its proposal in respect of draft Rule 1(1)(iv), which required the applicant to give such relevant information as is available to him on the characteristics of the biological material.

The Delegation of Switzerland supported the proposal of the Delegation of the Federal Republic of Germany and drew attention to the term 'biological material' used in paragraph (2)(c) of the draft Article and in the corresponding paragraph of the draft Rule. The term appeared to be too broad because it would include, for example, proteins which are not self-reproducible. The Delegation suggested that the term be replaced by 'biologically reproducible material,' which would encompass living matter, such as microorganisms, plant cells, plasmids and viruses.

The proposal of the Federal Republic of Germany was supported by the Delegations of Norway, Sweden, Italy, the Netherlands, Brazil, the Soviet Union, Hungary, Austria, Australia, Denmark and New Zealand, by the Representative

of the EPO and by the representatives of several non-governmental organizations. The Delegations of Norway, Italy, the Soviet Union, Austria and Australia, the Representative of the EPO and representatives of several non-governmental organizations also supported the suggestion made by the Delegation of Switzerland.

The Representative of the EPO pointed out that, under draft Article 3(2)(c) and the proposed amendments thereto, a deposit would not be required where the material could be disclosed in the description or was available to the public.

The question was raised whether draft Article 8 would need to be amended in view of the proposed amendments to draft Article 3(2)(c). It was agreed that that question could be considered during the discussion of draft Article 8.

The Delegation of Japan stated that it reserved its position on draft Article 3(2)(c) and referred to the present legal situation in its country.

The Delegation of the United States of America opposed the proposal of the Federal Republic of Germany and explained that, according to the patent law of the United States of America, biological material could be deposited later than the filing date and, indeed, at any time before the grant of a patent. Therefore, it could only accept an optional amendment, giving a Contracting Party the freedom to require that the deposit had to be made on or before the filing date of the application.

The Delegation of Canada supported the proposal of the Delegation of the Federal Republic of Germany and suggested, in addition, changing the wording of draft Article 3(2)(c) in order to take due account of those situations where the biological material was so readily accessible that there was no need for a deposit. The Delegation suggested that the words 'carried out by a person skilled in the art and such material is not accessible to the public,' should be replaced by 'carried out by a person skilled in the art without undue experimentation and such material is not readily accessible to the public.' A written proposal to that effect (document HL/CE/VIII/18) was submitted by the Delegation.

In the discussion of the proposal by the Delegation of Canada, several Delegations expressed doubts about the desirability or necessity of including in draft Article 3(2)(c) the expressions 'without undue experimentation' and 'readily accessible.' It was pointed out that the expression 'without undue experimentation' applied to any disclosure while the word 'readily' in the given context led to legal uncertainty and introduced an arbitrary element. One delegation supported the adding of the expression 'without undue experimentation' since that expression frequently occurred in discussions on inventions in the field

of biotechnology, a field in which it was often necessary to perform several experiments in relation to an invention.

On the basis of the Chairman's summary of the discussions, it was agreed that the text of draft Article 3(2)(c) should be maintained, subject to the amendments proposed by the Delegation of the Federal Republic of Germany and the suggestion made by the Delegation of Switzerland. The explanatory Notes should indicate that, as in other fields of technology, a person with ordinary skill in the art might have to perform a certain number of experiments in order to reproduce or carry out the protected invention, but that in the field of biotechnological inventions the number of experiments would often be higher than in other fields. This would adequately accommodate the proposal by the Delegation of Canada.

Paragraph (2)(d). The Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/15, suggesting the replacement of this draft subparagraph by a new paragraph (3). The Delegation explained that the proposal aimed at harmonizing national patent laws by excluding additional requirements not only with respect to the description, but also with respect to the disclosure.

As to substance, no objections were raised in respect of the proposal by the Federal Republic of Germany. However, it was questioned whether the wording of the provision would not, in certain circumstances, be too limitative by not allowing additional requirements with regard, for example, to prior art under Articles 11 and 13, divisional applications, descriptions of amino-acid sequences, filings in machine-readable form and electronic filing.

It was agreed that the explanatory Notes should state that, for example, requirements concerning computer-readable forms were not excluded, and that Contracting Parties were, in general, free to provide for requirements merely concerning the form of the description. Thus, it was concluded that draft paragraph (2)(d) should be replaced by the paragraph (3) as proposed by the Delegation of the Federal Republic of Germany.

Rule 1: Contents and Order of Description

Paragraph (1)(i) and (ii). There were no observations on these provisions.

Paragraph (1)(iii). One delegation pointed out that the technical problem and its solution had to be understood by a person skilled in the art other than the inventor. It was agreed that this should be reflected in the Notes.

Paragraph (1)(iv). The Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/15, which would amend the text of draft Rule 1(1)(iv) by requiring the description to contain 'such relevant information as is available to the applicant on the characteristics of the biological material.' The Delegation stated that the suggested amendment should be understood as a clarification, pointing out that, as regards written information, the applicant had to provide as much information as possible. The purpose was to avoid biological material being merely deposited without the provision of further information.

The Delegation of Norway supported the proposal made by the Delegation of the Federal Republic of Germany.

The Delegation of Switzerland pointed out that, as in the Article, the term 'biologically reproducible material' should replace the term 'biological material.'

The Delegation of the United States of America stated that there was no need for far-reaching additional obligations. It maintained that the proposed amendment would require the provision of otherwise unnecessary relevant information, which was asking too much. The Delegation preferred the existing text of draft Rule 1(1)(iv). Similar views were expressed by the Representatives of ABA and LES.

The Delegation of Japan declared that it reserved its position.

The Representative of the EPO stated that it was in the interest of the applicant to provide as much information as was possible in the written disclosure, as this would be to his advantage where the deposit was found to be defective. The EPO had had good experience in applying such a procedure.

On the basis of the Chairman's summary, it was understood that the International Bureau would draft a provision requiring the text of the description to contain as much information as could be provided in written form that was necessary to satisfy the requirement of a disclosure that was sufficiently clear and complete to enable the invention to be carried out by a person skilled in the art. The deposit would supplement the description.

Paragraph (1)(vi). The Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/15 to delete the last part of the subparagraph, beginning with the words 'however, any Contracting Party may provide.' This proposal was made in order to harmonize national patent laws; therefore, the optional requirement to set forth the best mode for carrying out the invention had to be removed.

The proposal of the Federal Republic of Germany was supported by the Delegations of Finland, Japan, Switzerland, Italy, the Soviet Union, Denmark, Austria, Sweden and Poland and the Representatives of AIPO, JPAA, EPI, CNIPA and CIPA.

The Delegation of the United States of America stated that the proposal of the Delegation of the Federal Republic of Germany, which deviated from a compromise reached after long and difficult discussions, was not acceptable. The Delegation strongly favored maintaining the optional provision as contained in the Draft Treaty. The Delegations of Canada, Australia, Argentina, Mexico, New Zealand, Hungary, Ghana, Madagascar and Brazil and the Representatives of AIPLA, PTIC, ABA, IPO, ALIFAR and NYPTC supported the position taken by the Delegation of the United States of America. The Representative of AIPLA stated that it had become clear, after discussions with interested circles in the United States of America, that there was a necessity to have at least the possibility of requiring the description to set forth the best mode. It would have a negative political impact on the adoption of the Treaty as a whole if this requirement were abandoned. The Representative of ABA added that the best mode requirement was a *quid pro quo* for the granting of exclusive rights under the law of the United States of America and that interested circles in the United States of America had taken a firm position on the matter.

It was agreed that draft paragraph (1)(vi) should remain unchanged.

Rule 1(2). The Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/15 to amend the draft Rule by requiring that, in addition to the order, the *manner* of presentation should be as required in paragraph (1) unless, because of the nature of the invention, a different *manner* or order affords a better understanding and a more economical presentation. The Delegation explained that the proposal was aimed at providing for a more lenient approach for the benefit of the applicant, taking into account those instances where the invention was so simple that a different manner of presentation of the contents of the description would be preferable in order to avoid redundancy and enhance clarity.

The Representative of the EPO added that the proposed text was similar to the wording of the corresponding provision in the Regulations under the EPC, which had not caused any significant problems.

As regards the question of whether some of the requirements set out in Rule 1(1) and, if so,

which should be optional, the Delegation of the United States of America submitted a written proposal contained in document HL/CE/VIII/21. The Delegation stated that the aim of the proposal was to give Contracting Parties the freedom to accept a description that might differ, in some respects, from the requirements set out in paragraph (1) of draft Rule 1, so that applicants would have greater flexibility in the presentation of applications. With respect to draft Rule 1(2), the Delegation stated that the proposed amendment would allow Offices more flexibility in applying the requirements of Rule 1(1), by being able to require less than the items listed therein, and that that would be beneficial to both Offices and applicants. The Delegation indicated, in the course of the discussions, that the words 'may require,' in the third line of its proposed text for inclusion in Rule 1(1), could be replaced by the words 'may accept' so as to make it clear that the Delegation's suggestion with regard to item (iii) of Rule 1(1) was not intended to be mandatory. The Delegation also indicated that the part of Rule 1(2) commencing with the word 'unless' could either be deleted or maintained.

The Delegation of the United Kingdom supported the proposal of the Delegation of the United States of America in principle, subject to the observation that, in view of the provisions of draft Article 3(1), it was not necessary for that proposal to contain an alternative to item (iii) of Rule 1(1).

The Delegation of Israel expressed concern about the possible overlapping between the alternative wording proposed for item (iii), as contained in the proposal of the Delegation of the United States of America, and Rule 1(1)(vi).

The Delegation of Portugal felt that items (i) and (ii) should be mandatory requirements.

The Delegation of the United States of America indicated that, as regards the observation by the Delegation of Israel, item (iii) provided for the general idea and item (vi) for a specific embodiment. In respect of the observation by the Delegation of Portugal, the Delegation pointed out that, under its proposal, Contracting Parties would be free to require compliance with all the requirements in Rule 1(1).

The Representative of the EPO expressed the view that the proposal of the Federal Republic of Germany was preferable to that of the United States of America, since it clearly indicated the correct hierarchical relationship between Article 3 of the Draft Treaty and Rule 1.

The Delegations of Portugal, Japan, the Soviet Union, Spain, Madagascar, Brazil, Ghana, Finland, Bulgaria, the Republic of Korea, Nigeria and Argentina and the Representative of JPA supported the text of Rule 1 as contained in the Draft Regulations.

The Delegation of Denmark expressed its support for the proposal of the Federal Republic of Germany. The Delegation of the Federal Republic of Germany explained that what it had intended to achieve was the possibility of telescoping, where necessary, some of the items in Rule 1(1) and explained further that the word 'manner' could be replaced by 'form.'

The Delegation of Bulgaria and the Representatives of AIPPI, JPAA and UNICE preferred the text of the draft prepared by the International Bureau, subject to the amendments proposed by the Delegation of the Federal Republic of Germany.

The Representatives of AIPLA, ABA and IPO expressed support for the proposal of the Delegation of the United States of America.

On the basis of the Chairman's summary of the discussions, it was agreed that alternative texts should be submitted to the Diplomatic Conference. One would be based on the proposal of the Delegation of the Federal Republic of Germany, using the appropriate wording, and with explanatory Notes, indicating that the different order or form could consist of telescoping some of the items contained in Rule 1(1), which need not be inserted separately, where they are either superfluous or obvious in view of the nature of the invention. The other would be based on the proposal of the United States of America. In that alternative, a second paragraph would indicate that among the items listed in paragraph (1), items (iv), (vi) and (vii) would be mandatory requirements, and the remaining items optional. That alternative would also contain a reference to the standard of disclosure required by Article 3(1) and indicate that item (iii) was directed at ensuring that the standard was complied with. If the description could comply with the required standard otherwise, compliance with item (iii) would not be required."

Article 4: Claims

Rule 2: Manner of Claiming (ad Article 4(5))

In addition to the text of Article 4 and Rule 2 as elaborated by the International Bureau, discussions were based on a text proposed by the Delegation of the Federal Republic of Germany. Those texts read as follows:

Article 4

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Requirement of Claims in the Application] *The application shall contain one or more claims.*

(2) [Contents of Claims] *The claim or claims shall define the matter for which protection is sought.*

(3) [Style of the Claims] *Each claim shall be clear and concise.*

(4) [Relation of Claims with the Description] *Claims shall be supported by the description.*

(5) [Manner of Presentation of the Claims] *Claims shall be presented in the prescribed manner.*

(6) [Prohibition of Other Requirements] (a) *In respect of claims, no application shall be required to satisfy requirements additional to or different from those provided for in paragraphs (1) to (5).*

(b) *A Contracting Party shall be free not to require compliance with all of the requirements prescribed under paragraph (5)."*

[TEXT PROPOSED BY THE DELEGATION OF
THE FEDERAL REPUBLIC OF GERMANY]

"(1) and (2)

(3) [Style of the Claims] *The claims shall be clear and concise.*

(4) to (6)" (Document HL/CE/VIII/12, page 2)

Rule 2

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

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

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

(3) [Form of Claim] *Claims shall be written either*

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

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

(4) [References in the Claims to the Description and Drawings] (a) *No claim shall, except where [Alternative A: absolutely necessary] [Alternative B: appropriate], contain, in respect of the technical features of the invention, references to the description or any drawings, for example, such references as: 'as described in part ... of the description,' or 'as illustrated in figure ... of the drawings.'*

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

(c) *Where the application contains any drawing, any technical feature mentioned in any claim may, if the intelligibility of that claim can thereby be enhanced, include a reference sign to that drawing or to the applicable part of that drawing; such a reference sign shall be placed between square brackets or parentheses.*

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

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

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

[TEXT PROPOSED BY THE DELEGATION OF
THE FEDERAL REPUBLIC OF GERMANY]

"(1) to (3)

(4)(a) [References in the Claims to the Description and Drawings] *No claim shall, except where necessary, contain, in respect of the technical features of the invention, references to the description or any drawings, for example, such references as: 'as described in part ... of the description,' or 'as illustrated in figure ... of the drawings.'*

(b)

(c) *No claim shall contain any reference to a trademark.*

(d) [as subparagraph (c) in the text elaborated by the International Bureau].

(5)" (Document HL/CE/VIII/12, page 3)

The portion of the report of the Committee of Experts concerning the discussion of Article 4 and Rule 2 reads as follows:

"No observations were made concerning paragraphs (1) and (2).

Concerning *paragraph (3)*, the Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/12 and explained that the proposal had to be understood in such a way that not only each individual claim but also the claims taken together had to be both clear and concise.

The proposal by the Delegation of the Federal Republic of Germany was supported by the Delegations of Sweden, the Netherlands and the United Kingdom. The last Delegation stated that it supported, in general, the proposal in order to avoid undue repetition of claims containing features which were already mentioned in other claims. In this context, the Delegation questioned whether the wording of the provision could be improved by replacing the word 'concise' by 'distinctive' in the draft Article, while an additional provision on the requirement of conciseness could appear in the supplementing Rules.

The Delegation of the United States opposed the suggested amendment and indicated that the present wording was a compromise reached following long and intensive discussions within the Committee of Experts in the previous sessions. One representative added that the proposed amendment could be used as a tool to limit the number of the claims as a whole; at least this was feared by patent practitioners in the United States of America.

The majority of the delegations which intervened on this matter expressed themselves in favor of leaving draft Article 4(3) unchanged.

It was concluded that Article 4, paragraph (3), should remain unchanged.

No observations were made on *paragraphs (4) to (6)* of Article 4.

Rule 2: Manner of Claiming

Paragraphs (1) and (2) were accepted without comments.

The Committee of Experts also, in general, agreed on draft *paragraph (3)*. Following a suggestion made by the Delegation of Switzerland, however, it was agreed that the word 'concisely' should be deleted in draft Rule 2(3)(i) as being redundant.

With respect to *paragraph (4)(a)*, the Delegation of the Federal Republic of Germany introduced its proposal contained in document HL/CE/VIII/12 to replace both Alternatives provided for in subparagraph (a).

The proposal of the Federal Republic of Germany was supported by the Delegations of Switzerland and the Netherlands.

The Delegation of the United States of America expressed itself in favor of Alternative B of draft paragraph (4)(a), allowing references to the description or drawings where 'appropriate.' It noted that one could imagine many cases in which a reference to the description or drawings could not be regarded as 'absolutely necessary' or 'necessary,' but in which such a reference would nevertheless facilitate the understanding of the claim and would be helpful in avoiding repetition. Alternative B of the present draft Regulation was also supported by the Delegations of Australia, Argentina, New Zealand, Israel, Ghana, Mexico and Egypt.

The Delegation of the United Kingdom stated that it was also in favor of Alternative B, but that it preferred subparagraph (a) as a whole to be deleted.

The Delegations of the Republic of Korea, Canada, the Soviet Union, Poland, Austria, Sweden, Switzerland, the Netherlands and Hungary supported Alternative A, while the Delegation of Japan reserved its position.

It was pointed out that the terms 'necessary' and 'appropriate' could only be interpreted within a given context; therefore, the question arose if the reference was necessary for what purpose and appropriate for which case. To reach a compromise solution, it was suggested that the two requirements could be combined in such a way that it would be allowed to refer to the drawings where it was necessary for the understanding of the claim, or where such reference would definitely enhance the clarity and conciseness of the claim.

It was agreed that the provision should be redrafted on the basis of the suggested compromise solution.

The Delegation of the Federal Republic of Germany introduced its proposal as contained in document HL/CE/VIII/12 to insert a *new subparagraph (c)* and indicated that the reference to trademarks in the context of a claim was forbidden in the patent laws of many countries.

The proposal by the Federal Republic of Germany was supported by the Delegation of Hungary but opposed by the Delegations of Canada, the United States of America and Japan. The Delegations of Canada and the United States of America explained that a reference to a trademark might be necessary, at least under exceptional circumstances. The possibility to refer in a claim to a trademark should, therefore, not be excluded in all cases.

It was pointed out that reference to a trademark was in most cases not necessary and could

be regarded as a sign that the wording of the claim lacked clarity. On the basis of this point of view, it was agreed that the question of a possible reference in a claim to a trademark should be dealt with in the explanatory Notes.

As regards *paragraph (5)*, the Delegation of the United States of America, supported by the Delegation of the Republic of Korea, recalled its opposition to accepting a multiple dependent claim which depended on another multiple dependent claim or multiple dependent claims referring in the cumulative to the claims on which they depend and suggested that this should be an optional provision left to the national laws of the Contracting Parties.

The Delegations of the Federal Republic of Germany, Japan, Switzerland and Australia supported the provision as contained in draft Rule 2(5). The Delegation of Canada explained that its law did not presently allow multiple dependent claims to depend on other multiple dependent claims, but that it was considering allowing such a possibility in the future.

The Delegation of Japan requested that the explanatory Notes give an example of a multiple dependent claim referring in the cumulative to the claims on which it depends.

It was agreed that consideration should be given to the inclusion of appropriate explanations in the Notes.”

Article 5: Unity of Invention

Rule 3: Details Concerning the Requirement of Unity of Invention (ad Article 5)

Rule 4: Division of Application (ad Article 5)

In addition to the text of Article 5 and Rules 3 and 4 as elaborated by the International Bureau, discussions were based on a text concerning Rule 4 proposed by the Delegation of the United Kingdom. Those texts read as follows:

Article 5

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

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

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

shall not be a ground for the invalidation or revocation of the patent.”

Rule 3

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

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

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

Rule 4

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

“(1) [Right of Applicant to Divide Application] (a) *Where the Office finds that the requirement of unity of invention is not complied with, the applicant shall have the right to file one or more divisional applications during a period of at least two months following the communication to him of that finding.*

(b) *The applicant shall also have the right to file, on his own initiative, one or more divisional applications at any time up to at least the time when the application from which a divisional application is derived is in order for grant or, where applicable under Article [],¹ for publication for the purposes of opposition.*

(2) [Priority Documents] *Priority documents and any required translations thereof that are submitted to the Office in respect of the application from which one or more divisional applications are derived shall be considered as having been submitted also in respect of the latter.*

¹ It is intended that reference should be made here to the provision in the Treaty that envisages a transitional period during which a system of pre-grant opposition may be maintained by a Contracting Party. That provision, as well as all other transitional provisions permitting a temporary deviation from rules to be established by the Treaty, will be contained in the final provisions (see document HL/CE/VIII/4).”

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

"The following should be added to the text of Rule 4(1)(b), as proposed by the International Bureau:

"However, a Contracting Party whose legislation provides that all requirements for the grant of a patent must be complied with by the end of a prescribed period may exclude that right from the final six months of the prescribed period." (Document HL/CE/VIII/10, page 3)

The portion of the report of the Committee of Experts concerning the discussion of Article 5 and Rules 3 and 4 reads as follows:

"The provision in its present form was, in general, found to be acceptable.

Referring to *paragraph (2)*, the Delegation of the Netherlands raised the question as to what would be the legal consequences if an application, in the framework of a registration system, did not comply with the requirement of unity of invention and a search report had been established only for one invention claimed in the application and considered to satisfy the requirement. It might be necessary to raise, under such conditions, the question of unity of invention also in proceedings for the invalidation of the patent registered for all inventions claimed in the original application.

It was pointed out that the problem could be settled by the competent court by requesting an additional search for those inventions claimed in the patent for which no search report had been established so far.

Rule 3: Details Concerning the Requirement of Unity of Invention

With respect to *paragraph (1)*, the Delegation of the United States of America proposed to insert, in the first sentence, the word 'only' after the word 'fulfilled' in order to indicate that the requirement of unity of invention would be fulfilled only where the test set forth in this paragraph was satisfied; this test should be the sole and exclusive test for defining unity of invention.

The proposal by the United States of America was supported by the Delegation of Japan and the Representative of the EPO. Upon a question raised by one representative, the Delegation of the United States of America further stated that the detailed Notes referring to this draft Rule, including those relating to the combinations of different claims, the reference to processes specially adapted for the manufacture of a product, to intermediate and final products as well as to the so-called 'Markush practice,' remained valid and did not have to be changed.

It was agreed that draft Rule 3 should be amended as proposed by the Delegation of the

United States of America and that paragraph (2) should remain without any change and that Notes R3.06 to R3.25 would continue to apply and would appear in the Basic Proposal.

Rule 4: Division of Application

With respect to *paragraph (1)(b)*, the Delegation of the United Kingdom introduced its proposal as contained in document HL/CE/VIII/10 and explained that it had no objection to a generous period for the filing of divisional applications for the benefit of applicants. However, its national law contained an overall time limit of four-and-a-half years for the compliance with all requirements for the grant of a patent that made it necessary to allow Contracting Parties to exclude the right of filing divisional applications for the final six months of the prescribed period.

The Delegation of the United States of America expressed its support for the proposal as far as it corresponded to the idea of a relatively quick examination and grant of a patent. It preferred, however, to combine subparagraphs (a) and (b) of this Rule, because an applicant should have the same right to file a divisional application whether he files it on his own initiative or as a result of a ruling of lack of unity of invention by the Office. Therefore, it suggested deleting draft paragraph (1)(a) as a whole and deleting the words 'on his own initiative' in draft paragraph (1)(b). As a result, the beginning of the new paragraph (1) would read 'the applicant shall have the right to file one or more divisional applications' and would then continue with the further contents of the former draft paragraph (1)(b) as amended by the proposal of the Delegation of the United Kingdom.

In conjunction with this proposal, the Representative of the EPO indicated that previously the situation under the EPC had been the same as proposed in draft Rule 4(1). There had been the same distinction between the two situations, but it had turned out that different standards for dividing an application had caused many problems, not only for applicants, but also for the Office itself, since it was not always clear whether an applicant had an additional right to divide spontaneously after the time limit for a division following an Office finding had expired. Therefore, the Regulations under the EPC now contained a simple provision setting as a standard the right of the applicant to file a divisional application up to the time when the application was in order for a grant. Under these circumstances, the EPO had sympathy for the suggestion put forward by the Delegation of the United States of America.

The suggestion of the Delegation of the United States of America was also supported by the

Delegations of Japan and Israel. The Representative of CIPA, CNIPA and EPI stated that his organizations also had been in favor of the said suggestion; however, having heard the arguments put forward by the Delegation of the Netherlands in respect of Article 5, he now preferred retaining subparagraphs (a) and (b) of draft Rule 4(1).

The Delegation of the Netherlands and the Representative of LES expressed their support for the proposal made by the Delegation of the United Kingdom. The Representative of LES questioned whether Contracting Parties should not be totally free concerning a time limit in the cases covered by subparagraph (a). In this context, it was explained that the time limit contained in subparagraph (a) should be understood as a minimum safeguard for the applicant. The Delegation of Canada suggested extending the minimum period referred to in subparagraph (a) from two months to six months.

The Delegation of France pointed out that it was preferable to establish the principle contained in Rule 4(1)(b) and then to refer to national law for its implementation.

The question was discussed how to proceed in cases where the Office had notified the applicant that the requirement of unity of invention was not complied with and where the applicant had made no use of the possibility of filing a divisional application under subparagraph (a) but, nevertheless, later filed a different divisional application under subparagraph (b).

Following the summary of the Chairman, it was agreed that the problems which could occur in conjunction with the finding of an Office that the requirement of unity of invention was not complied with should be further reviewed in the context of Article 14. In addition, it was agreed that a new provision should be prepared along the lines of the proposal put forward by the Delegation of the United Kingdom and the suggestion made by the Delegation of the United States of America.

In response to the statements of some delegations and representatives seeking clarification concerning the last sentence of Note R4.01 on Rule 4—stating that the original application, after the division, had lesser scope than it had before the division—it was agreed that this sentence be deleted.”

Article 6: Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant

Rule 5: Manner of Identification and Mention of Inventor (ad Article 6)

In addition to the text of Article 6 and Rule 5 as elaborated by the International Bureau, discussions

were based on texts of Article 6 and Rule 5 proposed by the Delegation of the United Kingdom. Those texts read as follows:

Article 6

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

“(1) [Identification of the Inventor in the Application] *The application shall, as prescribed, identify the inventor or, where there are several inventors, all of them, failing which it shall be rejected.*

(2) [Mention of the Inventor in Publications of the Office] *Any publication of the Office, containing an application or a patent granted thereon, shall mention the inventor or inventors as such, provided that any Contracting Party may allow any inventor to request, in a declaration signed by him and filed with the Office, that such publications should not mention him as inventor, in which case the Office shall proceed accordingly.*

(3) [Indication, in the Application, of the Applicant's Entitlement] *Any Contracting Party may require that the applicant indicate the legal grounds of his entitlement to file the application.*

(4) [Prohibition of Other Requirements] *No requirements in respect of the identification or mention of the inventor or in respect of the indication of the applicant's entitlement that are additional to or different from those set forth in the preceding paragraphs shall be allowed.”*

[TEXT PROPOSED BY THE DELEGATION OF THE UNITED KINGDOM]

“Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant

(1) [Identification of the Inventor in the Application] *The application shall, as prescribed, identify the inventor, or, where there are several inventors, all of them. If no identification of an inventor is given, the application may be rejected.*

(2) to (4)” (Document HL/CE/VIII/10, page 4)

Rule 5

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

“(1) [Manner of Identification and Mention] (a) *The identification of the inventor referred to in Article 6(1) shall consist of the indication of the inventor's name and address.*

(b) *The mention of the inventor referred to in Article 6(2) shall consist of the indication of the inventor's name, provided that a Contracting Party may also require the indication of the inventor's address.*

(c) Where there are several co-inventors, the requirements of subparagraphs (a) and (b) shall apply in respect of each of them.

(2) [Correction] (a) If the application and the documents accompanying it do not comply with the requirements provided for under Article 6(1) and, where applicable, Article 6(3), the Office shall invite the applicant to comply with the said requirements within a reasonable time limit.

(b) The application may not be rejected for failure to comply with the said requirements where such an invitation has not been extended to the applicant."

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

"(1) [Manner of Identification and Mention]

(a)

(b) The mention of the inventor referred to in Article 6(2) shall consist at least of the indication of the inventor's name.

(c) [to be deleted]

(2) [Procedure in Case of Non-Compliance with Requirements]

(a) and (b)" (Document HL/CE/VIII/10, page 5)

The portion of the report of the Committee of Experts concerning the discussion of Article 6 and Rule 5 reads as follows:

"Paragraph (1). The Delegation of the United Kingdom, introducing its proposal in document HL/CE/VIII/10, stated that the sanction provided for in draft paragraph (1), namely, rejection of the application if the inventor was not identified, was seen as being too harsh a penalty if it was a mandatory provision. It considered it appropriate that the Office should have the option of rejecting an application in cases where an applicant had been given an opportunity to identify the inventor and the said identification was not supplied. In particular, in the case where there were several inventors, it seemed unwarranted to reject an application where the applicant failed to identify one of them.

The Delegation of Canada expressed the view that the naming of the inventor was essential to searching. For this purpose, it was important for names of inventors to appear in all applications.

The Delegation of Denmark supported the text of the draft Article and expressed the view that the right to be identified was a basic right of an inventor.

The Delegation of the Netherlands, supporting the proposal of the United Kingdom, stated that the sanction provided in the draft Article was too harsh. It noted that, in the case of an application identifying a plurality of inventors, Offices were not in a position to check the accuracy of the identification.

The Delegation of the United States of America expressed sympathy for the proposal by the United Kingdom on the basis that the sanction provided in the draft Article for initial failure to identify the inventor was too harsh. It considered that the existing provisions in the Draft Treaty should be supplemented by a provision that would allow the identification of the inventor to be corrected at any time without effect on the resulting patent. A liberal ability to correct should, however, not detract from the requirement to identify the inventor.

The Delegation of Spain supported the proposal by the United Kingdom, stating that, before rejection of an application, the applicant should have the opportunity to rectify the identification of inventors.

The Delegations of New Zealand, Ireland, Australia, Switzerland and France and the Representative of LES supported the proposal by the United Kingdom.

The Representative of AIPLA expressed the view that the proposal of the Delegation of the United Kingdom could be considered as moving away from harmonization and, from the point of view of an organization representing users of the patent system, undesirable, since it was important for the purposes of searching that the inventor be named.

The Delegation of Japan expressed its preference for a mandatory provision, as in the text of draft Article 6(1), and indicated agreement with the Delegation of the United States of America that there should be a provision for correcting the identification of the inventor.

The Delegation of Sweden supported the provision providing for rejecting applications that did not identify the inventor, but suggested that the Office be required to issue an invitation to correct the deficiency.

The Delegation of the United Kingdom, revising its proposal in document HL/CE/VIII/10, suggested that the provision of a penalty be omitted from draft paragraph (1).

The Delegation of Egypt expressed its support for the revised proposal of the United Kingdom. Further, it stated that, if the inventor was employed by an industrial establishment as a salaried inventor, he should receive fair compensation for his invention.

The Delegations of Hungary, Italy, the Republic of Korea, Madagascar, Belgium and the Soviet Union supported draft Article 6(1). The Delegation of the Republic of Korea stated that the requirements of searching patent documents were a motivating factor in requiring the identification of the inventor. The Delegation of Madagascar considered the inalienable rights of the inventor to be such a motivating factor.

The Delegation of Norway, for the reasons given by the Delegations of Sweden and Denmark, supported draft Article 6(1) and indicated that, based on the last intervention of the Delegation of the United Kingdom on paragraph (1), it could also support the revised position taken by that Delegation.

The Delegations of Japan, Poland, New Zealand and Israel indicated their support for the revised proposal of the Delegation of the United Kingdom. The Delegation of Israel stated that failure to comply with the requirement to identify the inventor inevitably introduced the possibility of a rejection of the application. Moreover, national laws should provide for rectification of the failure to identify the inventor before and after grant of the patent.

The Representative of AIPO considered that rejection of the application was too strict a penalty and that an error in naming the inventors should be correctable.

The Delegation of Argentina indicated that, in Argentina, mention of the inventor was not mandatory, but that its law would be amended to be consistent with draft Article 6.

The Delegation of the Netherlands stated that, in modern industry, a team of individuals frequently worked on the development of an invention, so that it was often difficult to name them at the time of making the patent application. Accordingly, there must be a provision to correct the identification of the inventor. Furthermore, the sanction of rejecting the application would be counterproductive, since it would remove all possibility of remuneration or recognition for the inventor.

It was pointed out that the proposal of the United Kingdom could be interpreted as not requiring a sanction to be imposed for failure to identify the inventor.

The Delegation of the Federal Republic of Germany stressed the importance of a provision for correction of the identification of the inventor.

The Representative of ATRIP also emphasized the necessity of a provision allowing the identification of the inventor to be corrected. He referred to experience in the United States of America where an excessively formal approach had at one stage been applied with the result that patents had been held to be invalid.

The Representative of NYPTC observed that, in addition to moral and search reasons given for the requirement of naming the inventor, there were legal reasons. Specifically, various Articles, such as Articles 12 and 13, assumed that the inventor had been identified so that it was essential that the inventor be identified.

On the basis of the summary of the discussions of the Chairman, it was agreed that paragraph (1)

should provide for the obligation to identify the inventor, that the identification could be furnished after the filing date, that an invitation should be issued in case of non-compliance and that an application should be rejected, on the basis of the requirement of identification of the inventor, only when *no* inventor was identified in the application. It was also agreed that mistakes or omissions in the original designation of inventors could always be corrected.

Paragraph (2). The Delegation of the United States of America asked whether the requirement in paragraph (2) to mention the inventor in Office publications was mandatory or optional.

The Chairman expressed the opinion that the first part of the paragraph was mandatory, while the second part was optional.

The Representative of NYPTC stated that third parties should have access to the name of the inventor in order to be able to determine the legal status of an application, citing the mention of the 'inventor' in Articles 12 and 13, for example. He wondered how this might be possible if the inventor asked not to be mentioned in publications. It was pointed out that, once a patent had been granted, the file was open for inspection.

It was agreed that paragraph (2) should not be amended.

Paragraph (3). The Delegation of Romania proposed that the phrase 'entitlement to file the application' should rather read 'entitlement to a patent.' This proposal was supported by the Representative of LES.

The Delegation of Japan observed that Article 9 was entitled 'Right to a Patent' and stated that there did not appear to be much difference between a right to a patent and an entitlement to apply for a patent.

The Chairman indicated that the end of paragraph (3) should be redrafted to change 'entitlement to file the application' to 'entitlement to a patent.'

The Delegation of Japan considered that there was an inconsistency between the second sentence of Note 6.05 and draft Article 6(3) and (4). Specifically, draft paragraph (3) provided that 'any Contracting Party may require that the applicant indicate the legal grounds of his entitlement to file the application,' while paragraph (4) prohibited requirements additional to or different from these. Note 6.05, second sentence, provided that such an additional requirement 'would be the requirement for an applicant who is not the inventor to produce evidence of the agreement of the inventor to the filing of the application.' It was suggested that this sentence be deleted to ensure that an Office has sufficient discretion to inquire into the legal entitlement to a patent.

The Delegation of the United States of America agreed with the position of the Delegation of Japan, stating that a State should be allowed to require the filing of an assignment document as an indication of an applicant's legal grounds of entitlement to file an application within the meaning of paragraph (3).

The Representative of CNIPA, CIPA and EPI disagreed with the proposal of deleting the second sentence of Note 6.05 on the basis that the requirement of filing an assignment document was extremely onerous in many countries where patent protection was sought.

The Delegation of Denmark stated that it understood that it was not within the terms of draft paragraph (3) to ask for an assignment as evidence of the entitlement to file an application.

It was pointed out that it seemed desirable only to oblige an applicant to make a statement as to his right to file an application without requiring the filing of an assignment or any other documentary evidence in each country. An 'indication' was all that was required under draft Article 6(3), and a Contracting Party could not ask for more.

It was generally agreed that the second sentence of Note 6.05 should be deleted.

It was agreed that draft paragraph (3) should remain unchanged.

No observations were made on draft paragraph (4).

Rule 5: Manner of Identification and Mention of Inventor

Paragraph (1)(a). The Delegation of the Netherlands requested clarification of the word 'address' in the case where there was a plurality of inventors. It was common for a number of inventors to choose a common address and, therefore, the term 'address' should be interpreted to include such a chosen address.

It was agreed that the explanatory Notes to the Rule would be amended to reflect this kind of situation.

Paragraph (1)(a), (b) and (c). The Delegation of the United Kingdom introduced its proposal in document HL/CE/VIII/10 and indicated that the proposal with respect to Rule 5 was linked to Article 6. Article 6 required the listing of several inventors, where appropriate, and the inclusion of the phrase 'at least' in paragraph (1)(b) was to address this situation. The Delegation proposed the deletion of draft paragraph (1)(c) as being redundant.

On the basis of the summary of the discussions by the Chairman it was agreed that draft Rule 5(1)(a) would remain unchanged, draft Rule 5(1)(b) would be amended as suggested by the

Delegation of the United Kingdom and draft Rule 5(1)(c) would be deleted.

Paragraph (2). The Delegation of the United Kingdom introduced its proposal in document HL/CE/VIII/10 with respect to paragraph (2), stating that it consisted of a change in the title to make the title more closely correspond to the content of the paragraph.

It was agreed that the title of paragraph (2) would be changed along the lines of the proposal of the Delegation of the United Kingdom."

Article 7: Priority Claim

In addition to the text of Article 7 as elaborated by the International Bureau, discussions were based on a text proposed by the Delegation of Switzerland. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"[(1) [Delayed Submission of Separate Declaration of the Priority Claim]] *Where the application ('the subsequent application') could have claimed the priority of an earlier application but, when filed, did not contain such priority claim, the applicant shall have the right to claim such priority in a separate declaration submitted to the Office within a period which shall be at least two months from the filing date of the subsequent application and not more than four months from the date on which the 12-month priority period provided for in the Paris Convention for the Protection of Industrial Property expired.*

"[(2) [Delayed Filing of Application Containing a Priority Claim]] *Where the application ('the subsequent application') claiming the priority of an earlier application is filed after the date on which the 12-month priority period provided for in the Paris Convention for the Protection of Industrial Property expired but before the expiration of a period of two months from that date, the Office shall restore the right of priority upon an express request submitted to the Office before the expiration of the said two-month period, if the request states and the Office finds that, in spite of due care, the subsequent application could not have been filed within the said 12-month priority period. The request for restoration shall state the grounds on which it is based, and the Office may require the production of corresponding evidence. The request may be subjected to the payment of a fee to the Office.]"*

[TEXT PROPOSED BY THE DELEGATION OF SWITZERLAND]

"(1) [Delayed Submission of the Priority Claim] *Where the application ('the subsequent application')*

could have claimed the priority of an earlier application but, when filed, did not contain such priority claim, the applicant shall have the right to claim such priority in a separate declaration submitted to the Office within a period which shall be at least two months from the filing date of the subsequent application and not more than four months from the date on which the priority period under the Paris Convention for the Protection of Industrial Property or provided by the Contracting Party for claiming internal priority expired. The declaration claiming such priority may be subjected to the payment of a fee to the Office.

(2) [*Delayed Filing of Application Containing a Priority Claim*] Where the application ('the subsequent application') claiming the priority of an earlier application is filed after the date on which the priority period under the Paris Convention for the Protection of Industrial Property or provided by the Contracting Party for claiming internal priority expired but before the expiration of a period of two months from that date, the Office shall restore the right to claim priority upon an express request submitted to the Office before the expiration of the said two-month period, if the request states and the Office finds that, in spite of all due care required by the circumstances having been taken, the subsequent application was not filed within the said priority period. The request for restoration shall state the grounds on which it is based, and the Office may require the production of corresponding evidence. The request may be subjected to the payment of a fee to the Office." (Document HL/CE/VIII/5, page 2)

The portion of the report of the Committee of Experts concerning the discussion of Article 7 reads as follows:

"*Paragraph (1)*. The Delegation of Switzerland presented its proposal contained in document HL/CE/VIII/5, indicating that it contained two features which differed from the Draft Treaty, namely, the reference to internal priority, which could be the subject of the provisions of paragraph (1) along with the Paris Convention priority, and the introduction of provision for a fee, similar to that provided for in draft paragraph (2). In addition, it proposed a modification of the title of draft paragraph (1), which was purely of a drafting nature.

It was pointed out that the Draft Treaty did not oblige the Contracting Parties to provide for internal priority in their national laws.

The Delegation of Switzerland clarified that the provision for internal priority in paragraphs (1) and (2) of Article 7 was applicable only in the Contracting Parties which provided for such priority.

The Delegations of Egypt and Nigeria expressed themselves in favor of the draft Article.

The Delegations of Austria, Belgium, Canada, Denmark, Finland, France, the Federal Republic of Germany, Hungary, Ireland, Italy, Japan, the Netherlands, the Soviet Union, the Republic of Korea and the United Kingdom, as well as the Representatives of AIPPI, FICPI and UePIP

expressed their general support for the proposal of the Delegation of Switzerland.

Several delegations stressed that the fee provision in paragraph (1) should in no case be of a mandatory nature and that, if it was decided to maintain that provision, it should serve as an option for the Contracting Parties aimed primarily at discouraging applicants from using routinely an opportunity to claim belatedly priority.

A number of delegations proposed to further consider the time limits set forth in paragraph (1) by making them longer, a suggestion which was opposed by certain other delegations.

On the basis of the summary of the discussions by the Chairman, it was agreed that paragraph (1) should cover the case of internal priority and that an optional provision for a fee was acceptable.

Paragraph (2). The Delegation of Switzerland presented its proposal contained in document HL/CE/VIII/5, indicating the two features that differed from draft Article 7(2), namely, the introduction of internal priority, which could be the subject of the provisions of paragraph (2) along with the Paris Convention priority, and the elaboration of the notion of 'due care' which could justify the delayed filing of the application claiming priority.

The Delegations of Australia, Austria, Brazil, Bulgaria, Canada, the Federal Republic of Germany, Italy and the Soviet Union, as well as the Representatives of AIPO, FICPI and NYPTC, supported the proposal of the Delegation of Switzerland. The Delegation of Israel stated that the proposed provision was justified on substance, but that its compatibility with the Paris Convention should be examined.

The Delegation of the United States of America expressed the view that the requirement of 'due care' contained in the Draft Treaty and further developed in the proposal by Switzerland was unnecessary and that the requirement of a high fee would suffice to discourage possible abuses by applicants.

The Delegations of Belgium, Denmark, France, the Netherlands, Poland, the Republic of Korea, Spain and Sweden expressed themselves against the inclusion in the Draft Treaty of a provision dealing with restoration of the priority after the expiry of the 12-month period provided for in the Paris Convention.

The Delegations of Argentina, France, the Netherlands and the Republic of Korea expressed the view that any provision for restoration of the priority was not in conformity with the Paris Convention. In particular, it was indicated that an applicant from a country party to both the Paris Convention and the Treaty would have disadvantages when filing an application in a country

party only to the Paris Convention and not to the Treaty. The Delegation of Argentina pointed out that amending a provision of the Paris Convention in this way could be incompatible with Article 30(2) of the Vienna Convention on the Law of Treaties.

The Delegation of Japan reserved its position on paragraph (2). It also pointed out that the title of paragraph (2) was inconsistent with Note 7.05, which allowed any applicant to invoke both paragraphs.

The Chairman summarized the discussions stating that, as in previous meetings of the Committee of Experts, opinions were divided in respect of the necessity and desirability of the provisions contained in paragraph (2). The majority of delegations which were in favor of the principle of restoration supported the proposal of the Delegation of Switzerland; it could therefore be presented for consideration by the Diplomatic Conference."

Article 8: Filing Date

Rule 6: Details Concerning the Filing Date

In addition to the text of Article 8 and Rule 6 as elaborated by the International Bureau, discussions were based on texts presented by the Delegations of Denmark, Switzerland, the United Kingdom and the United States of America. Those texts read as follows:

Article 8

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Absolute Requirements] (a) The filing date of the application shall be the date of receipt by the Office of documents that contain at least the following elements:

(i) an express or implicit indication that the granting of a patent is sought;

(ii) indications allowing to establish the identity of the applicant;

(iii) a part which, on the face of it, appears to be a description of an invention.

(b) The indications referred to in subparagraph (a)(i) and (ii) shall be in the official language.

(c) Any Contracting Party may, if the part referred to in subparagraph (a)(iii) is in a language other than the official language, require that a translation thereof in the official language be received by its Office within the prescribed time limit. If the translation is so received, the said part shall be considered as if it had been

received on the date on which it was received in the non-official language.

(2) [Permitted Additional Requirements] (a) A Contracting Party may provide that the filing date may be withheld if any of the following requirements is not satisfied within the prescribed time limit:

(i) the application contains a part which, on the face of it, appears to be a claim or claims;

(ii) if the application refers to drawings, it contains such drawings;

(iii) the required fee is paid.

Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with, without enlarging the scope of the disclosure, later than the date of receipt by the Office of the elements referred to in paragraph (1)(a), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.

(b) A Contracting Party may continue to apply any of the requirements referred to in subparagraph (a) only if it applied such requirement at the time of becoming party to this Treaty.

(c) Any Contracting Party may, if the part referred to in subparagraph (a)(i) and any text matter contained in the drawings referred to in subparagraph (a)(ii) are in a language other than the official language, require that a translation thereof in the official language be received by its Office within the prescribed time limit. If the translation is so received, the said part and the said text matter shall be considered as if they had been received on the date on which they were received in the non-official language.

(3) [Replacing Description, Claims and Drawings by Reference to Another Application] (a) Notwithstanding paragraphs (1) and (2), a reference in the application to another previously filed application for the same invention by the same applicant or his predecessor in title may, for the purposes of the filing date of the application, replace any of the following elements:

(i) the part which, on the face of it, appears to be a description of an invention,

(ii) the part which, on the face of it, appears to be a claim or claims,

(iii) any drawings,

provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office within the prescribed time limit. If the said parts and drawings, and, where required, the certified copy, are so received, the application shall be considered as if it had contained the said parts and drawings rather than a mere reference to the other applica-

tion, provided that the said parts and drawings have the same content as the description, claim or claims and drawings in the other application.

(b) Any Contracting Party may require that the parts and the text matter contained in any drawings be furnished in the official language.

(4) [Prohibition of Other Requirements] (a) The filing date may not be subjected to the fulfillment of any requirement that is additional to or different from those set forth in the preceding paragraphs.

(b) Notwithstanding subparagraph (a), a Contracting Party may, for the purposes of any treaty providing for the grant of regional patents, require that an application for a regional patent contain the designation of at least one State party to that treaty."

[TEXT PROPOSED BY THE DELEGATION
OF DENMARK]

"(3) Any Contracting Party may provide that a reference in the application to another previously filed application for the same invention by the same applicant or his predecessor in title may, for the purpose of the filing date of the application, replace any of the following elements:

(a) the part, which, on the face of it, appears to be a description of an invention,

(b) the part, which, on the face of it, appears to be a claim or claims,

(c) any drawings,

provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office within the prescribed time limit. If the said parts and drawings, and the certified copy are received within the prescribed time limit, the filing date of the application shall be the date on which the reference to the previously filed application was received by the Office." (Document HL/CE/VIII/8, page 2)

[TEXT PROPOSED BY THE DELEGATION
OF SWITZERLAND]

"(1)(a) and (b)

(c) Any Contracting Party may, if the part referred to in subparagraph (a)(iii) is in a language other than the official language, require that a translation thereof in the official language be received by its Office within the prescribed time limit. If the translation is so received the filing date of the application shall be the date of receipt by the Office of the elements referred to in paragraph (1)(a).

(2) [Permitted Additional Requirements] (a) A Contracting Party may provide that the filing date may be withheld if any of the following requirements are not satisfied within the prescribed time limit:

(i) the application contains a part which, on the face of it, appears to be a claim or claims;

(ii) the required fee is paid.

Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with later than the date of receipt by the

Office of the elements referred to in paragraph (1)(a), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.

(b) Where the part referred to in subparagraph (a)(i) or any drawings containing text matter are received by the Office at the same time as the elements referred to in paragraph (1)(a) and if the said part or any text matter in the drawings are in a language other than the official language, paragraph (1)(c) shall apply *mutatis mutandis*. Any Contracting Party may provide that the said part shall be in the official language if it is received by the Office later than the elements referred to in paragraph (1)(a).

(c) as (b)

(3) [Drawings] Any Contracting Party may provide that if the application refers to drawings, but does not contain such drawings at the time of filing the application, at the option of the applicant either any reference to the drawings shall be deemed to be deleted or the filing date of the application shall be redated to the date on which the drawings are received by the Office." (Document HL/CE/VIII/5, page 3)

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

"(2)(b) A Contracting Party which does not apply one or more of the requirements referred to in subparagraph (a) before becoming a party to this Treaty may only introduce them into its legislation thereafter in order to align with some treaty to which it is or becomes party." (Document HL/CE/VIII/10, page 6)

Rule 6

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Time Limits] (a) The time limit referred to in Article 8(1)(c) and (2)(c) shall be at least two months from the date on which the item requiring translation has been received by the Office.

(b) The time limit referred to in Article 8(2)(a) shall be at least two months from the date on which the elements referred to in Article 8(1)(a) have been received by the Office.

(c) The time limit referred to in Article 8(3)(a) shall be at least two months from the date on which the application containing the reference has been received by the Office.

(2) [Procedure in Case of Non-Compliance with Requirements] (a) If the application does not, at the time of its receipt by the Office or, where applicable, at the expiration of the time limit referred to in paragraph (1)(a) or (b), comply with any of the requirements of Article 3(1) or the applicable requirements, if any, of Article 8(2), the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which shall be at least one month from the date of the invitation. Compliance with the invitation may be subject to

the payment of a special fee. Failure of sending an invitation shall not alter the said requirements.

[(a-bis) Notwithstanding subparagraph (a), where the application does not comply with any of the requirements of Article 8(1)(c) and (2)(c), any Contracting Party shall be free not to extend an invitation to the applicant to comply with the applicable requirement.]

(b) No invitation shall be sent if the application does not contain indications making it possible for the Office to identify, or communicate with, the applicant.

(3) [Filing Date in Case of Correction] (a) If the applicant complies with the invitation referred to in paragraph (2)(a) and pays the required special fee, if any, within the time limit fixed in the invitation, the filing date shall, subject to subparagraph (b), be the date on which the elements referred to in Article 8(1)(a) have been received by the Office. Otherwise, the application shall be treated as if it had not been filed.

(b) If the invitation relates to the claims (Article 8(2)(a)(i)) or to drawings (Article 8(2)(a)(ii)) and the scope of the disclosure is enlarged as a result of compliance with the invitation, the filing date shall be the date on which the claims or drawings, as the case may be, were received by the Office.

(4) [Date of Receipt] Each Contracting Party shall be free to treat the date of receipt of any document by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, or by an official postal service, as the date of receipt by the Office.

(5) [Correction of Translations] Any translation furnished in accordance with Article 8(1)(c) or (2)(c) may be corrected at any time prior to the grant of a patent in order to conform to the wording of the application as filed in the original language."

[TEXT PROPOSED BY THE DELEGATION
OF DENMARK

"(1) (Time Limits) (a) The time limit referred to in Article 8(1)(c) shall be at least one month from the date on which the item requiring translation has been received by the Office.

(b) The time limit referred to in Article 8(2)(a) shall be at least one month from the date on which the elements referred to in Article 8(1)(a) have been received by the Office.

(c) The time limit referred to in Article 8(3)(a) shall be at least one month from the date on which the application containing the reference has been received by the Office.

(2) (Procedure in Case of Non-Compliance with Requirements) If the application does not, at the time of its receipt by the Office or, where applicable, at the expiration of the time limit referred to in paragraph

(1)(a) or (b), comply with any of the requirements of Article 8(1) or the applicable requirements, if any, of Article 8(2), the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which shall be at least one month from the date of the invitation. Compliance with the invitation may be subject to the payment of a special fee. (-)

(a bis) deleted.

(b) deleted.

(3) (Filing Date in Case of Correction) (a) If the applicant complies with the invitation referred to in paragraph (2) and pays the required special fee, if any, within the time limit fixed in the invitation, the filing date shall be the date on which the elements referred to in Article 8(1)(a) have been received by the Office. Otherwise, the application shall be treated as if it had not been filed.

(b) deleted.

(4) Each Contracting Party shall be free to determine the conditions under which an application or any other document is deemed to have been received by the Office.

(5) (Correction of Translations) Any translation furnished in accordance with Article 8(1)(c) may be corrected at any time prior to the grant of a patent in order to conform to the wording of the application as filed in the original language." (Document HL/CE/VIII/8, pages 3 and 4)

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

"The time limits referred to in Rule 6(1) should be 'at least one month.'

The following should be added at the end of the first sentence in Rule 6(2)(a):

'unless it has issued such an invitation before the expiry of the time limit referred to in paragraph (1)(a) or (b), in which case the time limit fixed in the invitation should not expire before that time limit.'" (Document HL/CE/VIII/10, page 7)

[TEXT PROPOSED BY THE DELEGATION OF
THE UNITED STATES OF AMERICA]

"(2) [Procedure in Case of Non-Compliance with Requirements] (a) If the application does not, at the time of its receipt by the Office comply with any of the requirements of Article 8(1) or the applicable requirements, if any, of Article 8(2) or Article 8(3), the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which time limit shall be at least one month from the date of the invitation or shall be the time limit referred to in paragraph (1), whichever is later. Compliance with the invitation may be subject to the payment of a special fee. Failure of sending an invitation shall not alter the said requirements.

[(a-bis)] Deleted

(b) If the application does not contain indications making it possible for the Office to identify, or communicate with, the applicant, the time limit in paragraph (1) shall apply." (Document HL/CE/VIII/23)

The portion of the report of the Committee of Experts concerning the discussions of Article 8 and Rule 6 reads as follows:

“Paragraph (1)(a) and (b). The Delegations of Denmark and Norway suggested that, for filing date purposes, Contracting Parties be free to accept the indications referred to in draft paragraph (1)(a)(i) (that the grant of a patent is sought) and (ii) (identifying the applicant) in a language other than the official language (i.e., that draft paragraph (1)(b) be made optional for Contracting Parties).

The Delegations of Italy, the Netherlands, Romania and the United Kingdom suggested that, for filing date purposes, the part referred to in draft paragraph (1)(a)(iii) (a description) should be in the official language (i.e., that item (iii) of draft paragraph (1)(a) be covered by draft paragraph (1)(b) and that draft paragraph (1)(c) be deleted).

The Delegation of Spain expressed its desire that, for filing date purposes, the indications referred to in draft paragraph (1)(a)(i) and (ii) and the part referred to in draft paragraph (2)(a)(i) (the claims) be both mandatory and in the official language.

The Delegation of Egypt suggested that the wording of draft paragraph (1)(a)(iii) be revised so as to delete the words, ‘a part which, on the face of it, appears to be...’

The Delegation of Switzerland suggested that the term ‘the official language’ in draft paragraph (1)(b) be changed to ‘a recognized language.’

The Delegation of Japan raised a question in connection with Note 8.03 on draft Article 8, which states that the word ‘documents’ in draft paragraph (1)(a) should be interpreted as including ‘not only paper but also electronically transmitted data.’ It asked whether the requirements of draft Article 8 should also apply to electronically transmitted applications, since, by their very nature, such applications may have to be subject to additional requirements for filing date purposes. The Delegation explained that the Japanese Diet had recently adopted a law allowing electronically transmitted applications and that such applications would be subject to additional formal requirements, such as technical standards regarding the input and output of information and the use of an identification code for the applicant which would permit entry into the system.

The Delegation of the United States of America stated that it was important that draft Article 8 should be applicable also to electronically transmitted applications and that the adoption of an electronic application system should not become a way of avoiding the obligations undertaken under Article 8. For example, the possibility of filing in a foreign language for filing date purposes should apply even to electronically transmitted applications and should not

be excluded by the application of technical standards relating to electronic transmission.

The Delegation of the Federal Republic of Germany stated similar concerns to those expressed by the Delegation of the United States of America.

It was pointed out that the introduction of electronically transmitted applications should not become a means of avoiding the application of the requirements of Article 8. It was further pointed out that draft Article 8 dealt with substantive requirements for the purposes of establishing a filing date, that is, what a Contracting Party must or, in some cases, could require an application to contain in order for its Office to establish a filing date, and it did not deal with formal requirements such as the use of a form, size of text matter and drawings, margins or other technical requirements such as those mentioned by the Delegation of Japan. As regards the use of an identification code for the applicant, a Contracting Party requiring that the identity of the applicant be established by indicating a number would comply with the requirement of draft paragraph (1)(a)(ii).

It was agreed that, in order to reach a further compromise between those Offices which, for filing date purposes, are willing to accept all the required elements in a foreign language and those Offices which desire that all the required elements be filed in the official language, draft paragraph (1)(b) should be made optional so that any Contracting Party would be free, but not obliged, to require that the indications referred to in draft paragraph (1)(a)(i) and (ii) be in the official language. Moreover, it was agreed that the explanatory Notes should make it clear that the Treaty should apply in the same way to paper filing and electronic filing and that a Contracting Party could require that the identity of the applicant be established by indicating a number.

Paragraph (1)(c). The Delegation of Switzerland introduced its proposal (contained in document HL/CE/VIII/5) and explained that the proposal differed from draft paragraph (1)(c) in the sense that it did not use the form of a fiction for saying that the translation had been received by the Office on the same date as the non-official language description. The approach of the draft paragraph might raise problems if the translation went beyond the original non-official language disclosure, a question which should not, and could not, be dealt with at the stage of establishing the filing date but only much later during the substantive examination of the application. Therefore, the proposal by Switzerland suggested that the last sentence of draft paragraph (1)(c) should read in the same manner as the two final

lines of draft paragraph (2)(a); this wording would avoid problems in cases where a translation did not correspond to the description in a foreign language.

The Delegation of Australia suggested that the text of draft paragraph (1)(c) should be changed to refer to a 'verified' translation.

The Delegation of the Federal Republic of Germany expressed its support for draft paragraph (1)(c).

The Delegation of Japan objected to the principle itself established in draft paragraph (1)(c). It considered that an Office could not responsibly perform such an important administrative act as establishing a filing date on the basis of non-official language documents which it could not understand and on the basis of which it might have to issue priority date certificates to be used for claiming a priority. In its opinion, draft paragraph (1)(c) could create confusion in the patent system and could do a disservice to third parties. The translation had to be checked at some point, and, if this was not done by the Office, the burden would fall on third parties.

The Delegation of the United States of America supported the principle in draft paragraph (1)(c) and could accept either the text of the Draft Treaty or the proposal by Switzerland. It considered that this provision was in the interest of applicants. Allowing non-official language filings, with a time period for submitting translations and corrections, was not unusual and had not proven difficult for its Office.

The Delegation of Egypt was opposed to the principle in draft paragraph (1)(c). It also suggested that the term 'official language' be defined somewhere in the Draft Treaty.

The Delegation of the Netherlands supported the position taken by the Delegation of Japan, objecting to the principle in draft paragraph (1)(c). Although the later submitted translation could not go beyond the original disclosure, this would be difficult to verify for the Office, for third parties and for the courts. This problem was more severe if draft paragraph (1)(c) was read in conjunction with the ample time periods prescribed in draft Rule 6, which allowed corrections practically up to the conclusion of the patent granting procedure.

The Delegation of Canada indicated that, although it had been instructed to support the text of draft paragraph (1)(c), it needed to understand better the proposal by Switzerland before taking a final position on this question. It supported the principle in draft paragraph (1)(c).

The Delegation of Israel expressed its support for the principle in draft paragraph (1)(c). It did not see a serious problem with the possibility of an incorrect translation being filed. This was a

question for courts to decide if and when the patent was ever challenged. A very similar situation already presented itself when a foreign priority was claimed and the priority documents were in a non-official language, and, until now, it had posed no major problem. When the priority of an earlier application was claimed, Offices usually did not compare the earlier and the later applications; it was a question which only arose if the grant of the patent was challenged.

The Delegation of Belgium expressed some doubts about the practical aspects of draft paragraph (1)(c) and wished to further confer with interested circles in its country before taking a position with respect to this provision.

The Delegation of France expressed its support for the principle in draft paragraph (1)(c) but its preference for the proposal by Switzerland. It was of the opinion that furnishing a translation could present serious practical problems for applicants, and it saw no reason to ask them to make unreasonable efforts in this regard. Its Office presumed that translations were correct and would do the same for filing date purposes as it already did with priority documents.

The Delegation of Italy disagreed with the principle in draft paragraph (1)(c). It considered that the description should also be submitted in the official language. However, if draft paragraph (1)(c) were retained, it preferred the text proposed by Switzerland.

The Delegation of the United Kingdom stated that it shared the concerns expressed by the Delegation of the Netherlands regarding the principle in draft paragraph (1)(c) and would therefore also prefer to see the element indicated in draft paragraph (1)(a)(iii) (the description) covered by draft paragraph (1)(b). It thought that draft paragraph (1)(c) would pose problems both for third parties who would have to verify the translation and for the Office which relied on the translation and therefore would want to work with an authenticated text. It was also concerned with the reliability of the validity of granted patents under such a flexible system.

The Delegation of Romania agreed with the statement made by the Delegation of the United Kingdom and wished to see the element referred to in draft paragraph (1)(a)(iii) (the description) covered by draft paragraph (1)(b).

The Delegation of the United States of America, in reply to the concerns raised by several delegations, stated that it did not view the possibility of incorrect or improper translations as a major practical problem either for Offices or for third parties. As mentioned by other delegations, Offices already accepted foreign language documents for priority purposes, and translations were accepted under the PCT. Third parties did not

check all translations but only those related to applications which might be significant to them, and, in that case, they checked the entire file to the last detail anyway.

In response, the Delegation of Japan explained that the question of translations for priority document purposes was different from the question of translations for filing date purposes and therefore merited different treatment. When the priority of an earlier foreign application was claimed, the Office checked the identity of the earlier and the later applications only in those rare cases where conflicting prior art was found to have been disclosed between the priority date and the filing date. The foreign language documents needed to be verified only in those rare cases when a question as to possible conflicting prior art arose. However, foreign language applications for filing date purposes would have to be dealt with frequently and would therefore present a systematic problem.

The Delegation of the Federal Republic of Germany recalled that it was in the interest of applicants to furnish as correct a translation as possible. Therefore, it did not share the concerns expressed by the Delegation of Japan. The experience in its country was that translations were seldom incorrect because the consequences of an error could be very serious and possibly even lead to the invalidation of the patent. Translations were already used under the PCT and for claiming priority, and, in the vast majority of cases, they proved to be correct and reliable.

The Representative of the EPO explained that the EPO constantly received foreign language documents, with translations being filed later. The system worked well, and there was no reason why it could not work at the national level. The EPO therefore supported the principle in draft subparagraph (c), but preferred the text contained in the proposal by Switzerland. Since discrepancies between the original foreign language documents and the translation were unavoidable, the provision should be worded in such a way as to leave no room for a possible misunderstanding that the translation might be considered the original document. The accuracy of the translation could not be checked at the time the filing date was established, and therefore the question should be left for a later stage.

All of the Representatives of the non-governmental organizations who spoke (ABA, AIPLA, AIPPI, APAA, EPI, JPAA, PTIC), expressed their support for the principle in draft subparagraph (c), with a majority expressing a preference for the text contained in the proposal by Switzerland. They considered that the flexibility which the provision would allow was in the interest of and of major concern to applicants, be they large

enterprises or individual inventors, as the submission of translations, especially when seeking patent protection in several countries, posed a heavy burden on applicants and patent attorneys. The Representative of AIPLA added that, since the users of the patent system in the United States of America would ultimately determine if the Draft Treaty was acceptable to that country, every attempt should be made to make the Draft Treaty as user-friendly as possible.

It was generally agreed that the principle of draft subparagraph (c) would be maintained but in the form presented in the proposal by Switzerland and that the question of verifying the translation of the description should be explained in the Notes.

Paragraph (2). The Delegation of Switzerland introduced its proposal (contained in document HL/CE/VIII/5) by explaining that the proposal differed from the corresponding text in the Draft Treaty in two important respects. *First*, as regards the last sentence of draft paragraph (2)(a), the words 'without enlarging the scope of the disclosure' should be deleted as it was considered that the question of the scope of the disclosure should not be confused with the task of establishing a filing date. For filing date purposes, it was sufficient for the Office to determine that the claims had been filed. Only later, during the substantive examination, could the Office confirm that any later filed claims did not go beyond the scope of the original disclosure. *Second*, as regards the drawings, it was proposed to align the Draft Treaty with the PCT. Accordingly, draft paragraph (2)(a)(ii) should be deleted and drawings should be dealt with separately, as proposed, under a new draft paragraph (3) which would provide that, instead of allowing a time for the later filing of drawings and keeping as the filing date the date on which the Office had received the elements required under draft paragraph (1), any Contracting Party could provide that, at the applicant's option, either any reference to later filed drawings would be deemed to be deleted, or the filing date would be the date on which the Office received the later filed drawings.

The Delegation of Japan recalled that at past sessions of the Committee of Experts it had proposed that claims should constitute absolute requirements for filing date purposes (i.e., that they should be included in draft paragraph (1)), but, in a spirit of compromise, it had agreed to keep claims as a permitted additional requirement under draft paragraph (2). On the other hand, the Delegation had always advanced that drawings should not constitute a requirement for establishing a filing date, but only a requirement for maintaining an application. Now the Delegation

was of the opinion that the same treatment should apply to claims, i.e., that failure to file claims should be a ground for refusing an application but not for refusing a filing date. The Delegation understood that, as worded, draft paragraph (2) would permit a Contracting Party to adopt such a system and, for that reason, supported the principle in draft paragraph (2). This understanding was shared by the International Bureau.

The Delegation of Spain stated that it desired to see claims as an absolute requirement and therefore that they should be included in draft paragraph (1). As regards the proposal by Switzerland, it agreed with the deletion of the words 'without enlarging ... the disclosures' but disagreed with the proposed new draft paragraph (3), which would make drawings essential for filing date purposes, when these should be merely auxiliary.

The Delegation of the United Kingdom supported the proposal by Switzerland in both respects. It also recalled that it had always insisted that the payment of fees constitute an absolute requirement under draft paragraph (1) but, in a spirit of compromise, was ready to accept the principle in draft paragraph (2) that the payment of fees constitute merely a permitted additional requirement. It nonetheless reserved its position as regards the prescribed period for complying with draft paragraph (2), provided for in the corresponding draft Rule 6.

The Delegation of the Netherlands indicated that it was of the opinion that the claims should constitute an absolute requirement under draft paragraph (1), and that, if, contrary to that opinion, claims were to constitute only a permitted additional requirement under draft paragraph (2), it did not support the proposal by Switzerland, but preferred the text of the Draft Treaty. Even if the words 'without enlarging ... the disclosure' would not require the Office to examine whether later filed claims had enlarged the scope of the original disclosure, they would act as a warning and discourage applicants from so enlarging the original disclosure. As regards the payment of fees, it preferred that this element also constitute an absolute requirement under draft paragraph (1), but, in a spirit of compromise, was willing to accept it as a permitted additional requirement under draft paragraph (2). As regards the question of drawings, it supported the proposal by Switzerland.

The Delegation of Ireland indicated that it was ready to compromise on the question of fees and to accept draft paragraph (2)(a)(iii).

In response to an inquiry by the Delegation of Nigeria, it was clarified that the last word in draft paragraph (2), 'elements,' meant those elements referred to in draft paragraph (1)(a).

The Delegation of Argentina stated that it supported the text of draft paragraph (2) as regards the drawings, but agreed with the proposal by Switzerland that the words 'without enlarging ... the disclosure' should be deleted from draft paragraph (2).

The Delegation of Israel disagreed with the proposal by Switzerland as regards drawings. If late drawings did not enlarge the scope of the original disclosure, it did not see why the original filing date should not be maintained. As was the case with claims, the decision on whether drawings went beyond the original disclosure should be delayed until a later stage of the procedure, and therefore later filed drawings should be allowed for filing date purposes.

The Representative of the EPO supported the proposal by Switzerland, as it considered that the question of whether or not later filed claims or drawings enlarged the scope of the original disclosure could be examined only at a later stage and not for filing date purposes.

The Representative of NYPTC expressed its support for the text contained in draft paragraph (2) and, in particular, was of the opinion that the same requirements regarding translations under draft paragraph (1) should apply to claims and drawings under draft paragraph (2).

The Representatives of AIPPI and UPEPI supported the proposal by Switzerland.

On the basis of the summary of the Chairman it was agreed that the proposal by Switzerland, as regards the deletion of the words 'without enlarging ... the disclosure' and as regards drawings, was supported by the majority of delegations, subject to what would result from the discussions of draft Article 14 (Amendment of Application).

The Delegation of Switzerland then introduced the last part of its proposal (in document HL/CE/VIII/5) to amend draft paragraph (2), explaining that the proposal basically consisted, *first*, of making the provision in draft paragraph (1)(c) applicable to draft paragraph (2) through a cross-reference in paragraph (2)(b) of the proposal, *second*, of shifting draft paragraph (2)(b) to become paragraph (2)(c) and, *third*, of deleting draft paragraph (2)(c). One reason for the proposal was to avoid the successive accumulation of time limits for submitting translations, as each Contracting Party may require the filing of late elements in an official language.

The Delegations of Canada and the United States of America and the Representative of the EPO supported the proposal by Switzerland. The Representative of the EPO called attention to the fact that a successive accumulation of time limits could create difficulties in respect of the 18-month publication deadline which many Offices such as the EPO had to meet.

The Delegation of Japan stated that it could not support the proposal by Switzerland because of its general position concerning foreign language filings, already expressed earlier.

The Delegation of the United Kingdom introduced the proposal by the United Kingdom (contained in document HL/CE/VIII/10) to replace the text of draft paragraph (2)(b) (paragraph (2)(c) in the proposal by Switzerland). It explained that the proposal by the United Kingdom was intended to take into account the possibility of future regional efforts towards harmonization of national laws and was meant not to discourage countries which might be contemplating such efforts from adhering, for that reason, to the Treaty.

It was pointed out that the proposal by the United Kingdom should nevertheless be redrafted so as not to allow for a loophole whereby a Contracting Party could avoid its obligations under draft Article 8 merely by concluding and adhering to a treaty with, for example, only one other country.

It was concluded that the proposal by Switzerland should be taken into account for the next version of the Draft Treaty, subject to possible changes of a drafting nature in order to align its wording with the other provisions of the Draft Treaty and on the understanding that draft paragraph (2)(b) (now draft paragraph (2)(c)) would be redrafted along the lines of the proposal by the United Kingdom but expressly indicating that only an *existing* Treaty is meant to be covered by that provision.

Paragraph (3) (which will henceforth be paragraph (4), in view of the conclusions reported on in the preceding paragraph). The Delegation of Denmark introduced its proposal (contained in document HL/CE/VIII/8) by explaining that the proposal basically covered the matter covered in draft paragraph (3) (now draft paragraph (4)), except that it made the provision allowing for filing by reference to another previously filed application optional for Contracting Parties. Furthermore, the term, 'where required,' in the last sentence of draft paragraph (3) (now draft paragraph (4)), did not appear in the proposal. The Delegation recalled that the Nordic countries had first proposed the provision contained in draft paragraph (3) (now draft paragraph (4)), as this practice had long existed in those countries and was expected to become even more useful in the future. However, the proposal was being submitted as a compromise in order to obtain as broad an acceptance as possible for the Draft Treaty.

The Delegations of Australia, Canada, Finland, France, Ghana, Israel and the United States of

America expressed their support for the mandatory provision contained in draft paragraph (3) (now draft paragraph (4)). The Delegation of Ghana pointed out that, if the provision were made optional, it would be tantamount to deleting it, with the result that there would be no harmonization on this point.

The Delegations of Austria, the Federal Republic of Germany, Italy, Japan, the Netherlands, the Republic of Korea, Romania, Spain, the Soviet Union, Sweden and Switzerland expressed their support for the optional provision contained in the proposal by Denmark. The Delegation of the Federal Republic of Germany recalled that one of the basic principles of patent law was that there be a complete disclosure of the invention, and it did not consider a reference to another application a complete and sufficient disclosure. The Delegation of the Republic of Korea was of a similar opinion. The Delegation of Japan stated that a reference in the application to another previously filed application might raise a problem of filing in a foreign language, and that it was not considered necessary to refer to another application filed with the same Office.

The Delegation of Norway stated that it could support either draft paragraph (3) (now draft paragraph (4)) or the proposal by Denmark.

The Representatives of AIPO, ABA, AIPLA, AIPPI, ATRIP, CIPA, CNIPA, EPI, IPO, NYPTC, PTIC and UEPIP expressed their support for the mandatory provision in draft paragraph (3) (now draft paragraph (4)).

The Representative of AIPLA explained that the optional provision contained in the proposal by Denmark would be pointless. The mandatory provision in draft paragraph (3) (now draft paragraph (4)) was 'user-friendly' and therefore should be in the Draft Treaty and should be mandatory. If foreign language documents were to be allowed, it was not clear why references to another application could not be allowed as well. This provision had been shown to be of major interest to private circles, and now they would wonder why it should be made optional.

The Representative of NYPTC recalled that the main purpose of the patent system was to grant patents to inventors. Therefore, the Draft Treaty should facilitate the patent granting procedure primarily for inventors and not for the Offices. Draft paragraph (3) (now draft paragraph (4)) was one of the provisions that would make life easier for applicants. If it were made optional, it would be tantamount to taking it out of the Treaty. As far as interested circles in the United States of America were concerned, adherence to the Treaty would require major changes in the patent law of that country. This was one change that was of interest to them, in particular to users. Any practi-

tioner knew why filing by reference was useful, especially in international practice. For these reasons, he hoped that those supporting the proposal by Denmark would reconsider their position in the interest of users and offer them some advantages in the Draft Treaty by agreeing to a mandatory provision.

The Representative of ATRIP agreed that draft paragraph (3) (now draft paragraph (4)) was looked upon favorably by users in the United States of America. He doubted that, without this mandatory provision, there would be much support for the Draft Treaty from the private sector in that country.

The Representative of FICPI expressed his support for draft paragraph (3) (now draft paragraph (4)) but could also accept the proposal by Denmark.

The Representative of JPA expressed its support for the optional provision in the proposal by Denmark.

The Representative of LES stated that, although he agreed with the principle in draft paragraph (3) (now draft paragraph (4)), he had some doubts about how such a system of disclosure by reference would work in practice.

It was agreed that draft paragraph (3) (now paragraph (4)) and the proposal by Denmark should be presented to the Diplomatic Conference in the form of alternatives.

Paragraph (4) (henceforth (5)). It was noted that, since no delegation or organization expressed disagreement with this provision, draft paragraph (4) (henceforth paragraph (5)) was accepted.

Rule 6: Details Concerning the Filing Date

Paragraphs (1) and (2). (a) The Delegation of the United States of America introduced its proposal to amend this provision (contained in document HL/CE/VIII/23). It explained that, under the proposal, it was understood that draft paragraph (1) would remain as it appeared in document HL/CE/VIII/2, with a two-month time limit for submitting the elements referred to therein. The proposal was intended to modify draft paragraph (2) so that, in the case of non-compliance with the requirements of draft Article 8(1), (2) or (3), the Office would have promptly to invite the applicant to comply with such requirements within the time limit fixed in the invitation, which time limit would be at least one month from the invitation date or the time limit referred to in draft paragraph (1), *whichever was later*. The proposal thus tried to respond to the concern that the text of draft Rule 6(1) and (2) might result in an accumulation of time limits which, if added to the time required for carrying out the necessary administrative tasks of sending

out invitations and checking compliance therewith, would be too onerous and would interfere with the smooth working of the patent granting procedure. Under the proposal, the procedure in most cases would involve a prompt invitation and a maximum two-month time period for compliance. This would be beneficial for both applicants and Offices, as it would maximize legal security for applicants and minimize the filing date procedure time for the Offices.

(b) Furthermore, the Delegation stated that the proposal by the United States of America made draft Rule 6(2) applicable to draft Article 8(3). As regards draft Rule 6(2)(b), it seemed more appropriate and clearer to provide, as did the proposal, that the time limit in draft Rule 6(1) applied if it was not possible for the Office to identify or communicate with the applicant, rather than to provide, as did draft Rule 6 that, in such a case, no invitation should be sent, which, since the task was impossible to perform, was self-evident.

(c) In reply to an inquiry, the Delegation of the United States of America explained that, under its proposal, if there were several deficiencies, there would be only one invitation and only one time limit.

The Delegations of Norway and Switzerland expressed their support for the proposal by the Delegation of the United States of America, except as to the last sentence of paragraph (2)(a), which, in their opinion, should be deleted.

The Delegation of the United Kingdom was ready to withdraw its proposal regarding draft Rule 6 (contained in document HL/CE/VIII/10) and to support the proposal by the United States of America, subject to certain modifications. The Delegation was reluctant to allow for more than one month for complying with Article 8 requirements but was ready to go along with the proposal by the United States of America to provide for a one-month time limit for complying with an invitation. In fact, it was of the opinion that draft Rule 6 could be even further simplified by omitting paragraph (2) altogether or by omitting the phrase '... shall be the time limit referred to in paragraph (1), whichever is later,' as it appears in the proposal by the United States of America.

The Delegations of the Federal Republic of Germany, Finland, Madagascar, Sweden and the Soviet Union expressed their support for the proposal by the Delegation of the United States of America.

The Delegation of Denmark also supported the proposal by the Delegation of the United States of America and withdrew the proposal by Denmark regarding draft paragraphs (1) and (2) (contained in document HL/CE/VIII/8). Nevertheless, it asked whether the time limits in the proposal

by the United States of America were intended to apply to the entire paragraph (1) of draft Article 8, that is, to draft subparagraphs (a), (b) and (c) of that paragraph. It also inquired why the Delegation of the United States of America preferred a two-month as opposed to a one-month time limit.

In reply to the last inquiry, the Delegation of the United States of America explained that it considered two months a reasonable time to comply with Article 8 requirements if one took into account that many Offices had to process a large number of patent applications filed from abroad.

The Delegation of Japan stated that it was not clear why draft paragraph (2) should apply to subparagraphs (a) and (b) of draft Article 8(1) and what the phrase 'if any' in paragraph (2) of the proposal by the Delegation of the United States of America meant.

The Delegation of the United States of America explained that it would not object to its proposal being more specific and indicated that paragraph (2) was meant to cover the time limits for complying with the requirements of draft Article 8(1)(c), (2)(c) and (3)(a).

The Representative of the EPO welcomed the proposal by the Delegation of the United States of America as it alleviated to a great extent its concern about the successive accumulation of time limits under draft Rule 6. However, the Representative shared the opinion of the Delegation of the United Kingdom that the proposal by the United States of America could be even further simplified by doing away with a threefold time limit approach and merely providing for a one-month time limit for complying with Article 8 requirements. He considered the proposal by the United States of America too far-reaching in obliging Offices to send out invitations, as the EPO was concerned about promptly preparing the basis for the examination as to form and for the 18-month publication.

The Representatives of AIPPI, CIPA, CNIPA and EPI supported the proposal by the United States of America and disagreed with the position taken by the Delegation of the United Kingdom and the Representative of the EPO in this regard.

It was agreed that draft Rule 6(1) would remain unchanged, but that the next version of draft Rule 6(2) should be based on the proposal by the Delegation of the United States of America, subject to some drafting revisions specifying those provisions in draft Article 8 to which the Rule was meant to apply.

Paragraph (3). It was agreed that this paragraph had to be redrafted, taking into account the conclusions on paragraphs (1) and (2).

Paragraph (4). The Delegation of Denmark introduced its proposal (contained in document HL/CE/VIII/8). It explained that, although the Delegation would prefer that an agreement be reached on a precise definition of when an application or any other document should be deemed to have been received by an Office, experience had shown that it was difficult to reach agreement on that point, and, in light of the different practices and rules existing in various countries in that regard, it may be wiser to leave the Contracting Parties free to determine the conditions under which an application or any other document should be deemed to have been received by the Office.

The Delegations of Italy, the United Kingdom, the Netherlands, Canada, Japan, Nigeria, the Federal Republic of Germany, Portugal, France, Finland, Israel and Australia expressed their support for the proposal by Denmark. The Delegation of Italy indicated that, if the proposal by Denmark were not adopted, the first sentence of draft Article 8(1)(a) would have to be amended in order to take into account those countries where branch offices were authorized to receive patent applications on behalf of the national Office. Furthermore, it wished to see a reference to this particular situation in Note R6.12 on draft paragraph (4). The Delegation of the United States of America was of the opinion that the drafting contained in Note R6.12 on draft paragraph (4) would provide a better basis for the provision than the drafting in draft paragraph (4) itself. The Delegation of Portugal suggested that the wording, 'in particular with a view to setting the date of receipt,' be added at the end of paragraph (4).

The Representative of AIPO did not support the proposal by Denmark, as it considered that it would result in indescribable anarchy in the dating of applications, which frequently became an important issue in patent litigation.

It was agreed that the proposal by Denmark to amend draft paragraph (4) should be taken into account for the next version of that draft paragraph, subject to eventual drafting changes to clarify that the provision was intended for purposes of fixing the date of receipt by the Office and subject to further clarifications in Note R6.12 on draft paragraph (4).

Paragraph (5). The Delegation of Denmark introduced its proposal (contained in document HL/CE/VIII/8), explaining that the only difference between the texts in the proposal and that contained in draft paragraph (5) in document HL/CE/VIII/2 was that paragraph (5) in the proposal had deleted the cross-reference to draft Article 8(2)(c).

The Delegation of Norway was of the opinion that the time limits in draft Rule 6 and in draft Article 14 should be harmonized and stated that it preferred the time limits provided for in draft Article 14.

The Delegation of the United States of America expressed its desire that draft paragraph (5) cover not only matter referred to in draft Article 8(1)(c) but also matter referred to in draft Article 8(2) and (3).

The Delegation of the Netherlands stated that, even if its Delegation would be able to overcome its opposition to the principle of accepting foreign language filings, it was opposed to the proposal by the Delegation of Denmark because it might encourage applicants to file bad or inaccurate translations, or at least not discourage them from doing so.

The Delegation of the United States of America was of the opinion that applicants tried to file as good a translation as possible, but, if a translation contained a critical error, applicants should be allowed to correct it.

The Delegation of Switzerland expressed its support for draft paragraph (5), as formulated in the proposal by Denmark, since it considered that errors could happen to anyone and that there was no reason why applicants should be penalized therefor.

The Delegation of Japan expressed its strong objections to draft paragraph (5). It considered that the one-year Paris Convention priority allowed sufficient time for applicants to prepare a proper and correct translation. Draft paragraph (5) would only leave the door open for applicants to file any kind of translation to the detriment of third parties.

The Delegation of the Federal Republic of Germany was of the opinion that, if foreign language filings were accepted, correction of translation errors should also be permitted. It therefore supported the position taken by the Delegation of the United States of America, but also shared the opinion expressed by the Delegation of Norway.

The Delegation of Canada expressed its support for the proposal by Denmark, as it considered the provision contained therein necessary for applicants for whom a slight translation error could cause serious problems.

The Delegation of Portugal stated that, although it sympathized with the position of the Delegation of Japan, it considered that, since errors were always possible and human, applicants should be allowed to correct translation errors up to the time of grant. This would result eventually in as good and accurate translations as possible. However, it did not understand why the correction of translation errors in respect of draw-

ings should not be allowed as well. It therefore supported the position expressed by the Delegation of the United States of America.

The Delegation of Denmark explained that the proposal by Denmark was meant to discourage the use of text next to drawings, which could pose serious practical problems for an Office.

The Delegations of Cameroon and Lebanon and the Representative of AIPO expressed their support for draft paragraph (5).

The Delegations of Argentina, Australia, Finland and the Soviet Union and the Representative of the EPO also expressed their support for draft paragraph (5) but with the revision suggested by the Delegation of the United States of America (i.e., adding a reference to draft Article 8(2) and (3)). The Representative of the EPO added that he did not see how the correction of translation errors posed a significant burden on patent examiners; in the EPO's experience, translations were not corrected frequently.

The Delegation of the United Kingdom recalled its objections to allowing foreign language filings. However, it conceded that, if foreign language filings were to be allowed, then some provision allowing for the correction of translation errors had to be included and the possibility of correcting translation errors should, in principle, be possible at any time. However, the system would need to provide for safeguards in view of the rights which may arise as a result of early publication. It was also of the opinion that 'any time prior to the grant of a patent' should not mean that corrections would be allowed up to the last minute.

The Delegation of Italy recalled that it did not agree with the principle of accepting foreign language filings. However, if this principle were to be accepted in the Draft Treaty, the Delegation would be favorable to draft paragraph (5) in document HL/CE/VIII/2, with the revision suggested by the Delegation of the United States of America (i.e., adding the reference to draft Article 8(2) and (3)).

The Representatives of ABA, AIPLA, AIPPI, APAA and JPAA expressed their support for draft paragraph (5) with the revision suggested by the Delegation of the United States of America (i.e., adding the reference to draft Article 8(2) and (3)). The Representative of ABA pointed out that Offices should not presume that applicants would, in bad faith, submit inaccurate translations. The Representative of AIPLA noted that applicants usually depended on someone else for a translation; if it contained an error, it was not their fault. An accurate translation was as much in the interest of the applicant as it was in the interest of the Office, and, if the translation contained an error, having it corrected was also in the interest

of the applicant and the Office. The Representative of JPAA requested, nonetheless, that prior users' rights should be taken into account in the context of draft Article 15 (Publication of Applications).

It was concluded that the principle contained in draft paragraph (5) should be maintained, that translation errors should be correctable and that such a provision should cover all cases referred to in draft Article 8(1), (2) and (3). The question of prior users' rights and the question of amending an application remained reserved until the discussion of the respective draft Articles dealing with those questions."

Article 9: Right to a Patent

In addition to the text of Article 9 as elaborated by the International Bureau, discussions were based on a text proposed by the Delegation of France. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Right of Inventor] *The right to a patent shall belong to the inventor. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong to the employer of the inventor or to a person who commissioned the work of the inventor which resulted in the invention.*

(2) [Right Where Several Inventors] *Where two or more inventors independently have made the same invention, the right to a patent for that invention shall [, irrespective of the dates on which the invention was made by each of the inventors,] belong,*

(i) *where only one application is filed in respect of that invention, to the applicant, as long as the application is not withdrawn, abandoned or rejected, or,*

(ii) *where two or more applications are filed in respect of that invention, to the applicant whose application has the earliest filing date or, where priority is claimed, the earliest priority date, as long as the said application is not withdrawn, abandoned or rejected."*

[TEXT PROPOSED BY THE DELEGATION OF FRANCE]

"(1) [Right of Inventor] The right to a patent shall belong to the inventor or his successor in title. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong to the employer of the inventor or to a person who commissioned the work of the inventor which resulted in the invention.

(2) [Right Where Several Inventors] Where two or more inventors independently have made the same invention, the right to a patent for that invention shall, irrespective of the dates on which the invention was made by each of the inventors, and subject to the conditions and limits specified in Article 13, belong,

- (i) where only one application is filed in respect of that invention, to the applicant, or,
- (ii) where two or more applications are filed in respect of that invention, to the applicant whose application has the earliest filing date or, where priority is claimed, the earliest priority date." (Document HL/CE/VIII/16, page 2)

The portion of the report of the Committee of Experts concerning the discussion of Article 9 reads as follows:

"The Delegation of France introduced its proposal (contained in document HL/CE/VIII/16), stating that it was necessary to amend *paragraph (1)* to explicitly provide that the right to a patent shall belong to the inventor or to his successor in title. With respect to *paragraph (2)*, the Delegation stated that the proposal introduced no change in substance, but was meant to cover a proposal made at the seventh session of the Committee of Experts. Specifically, it proposed that the provisions of Article 9 be subject to Article 13 of the Draft Treaty. The Delegation indicated that, if the proposed amendment to paragraph (2) of Article 9 was not accepted, then reference could be made in the Notes to the connection between the rule that the right to a patent belongs to the first of several independent inventors to file and the provisions of Article 13.

Paragraph (1). The Delegations of the Netherlands, Italy, Australia, Spain, Mexico, the United Kingdom, the Soviet Union and Hungary indicated their support for the proposal by France.

The Delegation of the United States of America indicated that the second sentence of paragraph (1) might convey the impression that Contracting Parties were not free to determine other situations in which the right to a patent might belong to one other than the inventor. Accordingly, it was suggested that the phrase 'at least' be inserted following the word 'shall' in the second line of paragraph (1). Thus, other situations that arose could be addressed by Contracting Parties.

The Delegation of Nigeria did not, in principle, see any difference between draft Article 9(1) and the proposal of the Delegation of France. The Delegation thought it unnecessary to include reference to the successor in title because it was obvious.

It was pointed out that the result of the amendment proposed by the Delegation of the United States of America would be the same under the

draft Article 9(1) and the Article as amended in the proposal by France.

The Delegations of the Netherlands and the United Kingdom supported the proposal by France.

As regards the second sentence of paragraph (1), the Delegation of Japan recommended transferring this sentence to the Notes to avoid the problems expressed by the Delegation of the United States of America.

The Delegation of Switzerland indicated that, under the laws of Switzerland, the employer acquired the right to a patent at the outset. This case was not covered by the first sentence; therefore the second sentence of paragraph (1) should be maintained. The Delegations of the Netherlands and the United Kingdom agreed with the position taken by the Delegation of Switzerland.

On the basis of the summary of the discussions by the Chairman, it was agreed that the first sentence of draft paragraph (1) should be amended as suggested by the Delegation of France or that appropriate explanations should be given in the Notes.

It was further agreed that the second sentence of draft paragraph (1) should be maintained provided that there was an explanation in the Notes indicating that the second sentence should not be considered to be exhaustive of Contracting Parties' rights to provide for situations in which the right to a patent might vest in someone other (for example, the estate of a bankrupt) than the inventor.

Paragraph (2). The Delegation of the United States of America stated that for the United States of America to adopt the first-to-file system involved a fundamental change, as had been understood from the beginning. The Delegation indicated that there was no consensus in the United States of America that this change should be made. To its knowledge, none of the interested circles had taken a position in favor of that change, and there were powerful, vocal elements which actively opposed it. The Delegation stated that the Administration in the United States of America remained willing to propose such a change if it was able to show clearly that the total harmonization package would be of benefit to the industry and inventors in the United States of America. The Delegation asked that it be borne in mind that the United States of America would need understanding and concessions on other points or else the Administration would feel unable to convince the Senate of the United States of America to ratify the Treaty and the Congress to enact implementing legislation. The Delegation indicated that it would have opposition in the United States of America from

inventors' groups, from industry and from universities so that the harmonization treaty could fail to be ratified even if the Administration recommended it. The Delegation underlined that it was not unwilling to go forward with this provision, as it stood, but that it was not a foregone conclusion that the Treaty could be ratified in the United States of America unless it contained also clear and significant benefits to its people.

The Delegation of the Netherlands indicated a preference for the draft Article, stating that the reference to Article 13 in the proposal by the Delegation of France had nothing to do with the principles contained in Article 9. However, the Delegation felt that, with respect to draft paragraph (2)(i) and (ii), the qualifier, 'as long as the application is not withdrawn, abandoned or rejected' could be deleted.

The Delegation of Switzerland indicated that it considered it to be necessary for the concluding words of draft paragraph (2)(ii) to be maintained because there were countries that made a distinction between abandoned and withdrawn applications, an abandoned application still having an effect on later-filed applications.

The Delegation of Nigeria recommended that the concept of 'innocence' be added to draft paragraph (2)(ii). An example was given of an invention derived from another and a patent being applied for, although the derivation was not innocent. As presently worded, draft paragraph (2)(ii) was not seen as precluding such an application.

The Delegation of Japan questioned the desirability of having the qualifier 'withdrawn, abandoned or rejected' in draft paragraph (2)(i) and (ii). In this connection, the term 'pending' could be used, provided that it was properly defined.

The Delegation of the United Kingdom and the Representatives of UNICE and FICPI indicated a preference to have a cross-reference to Article 13 in Article 9. While it was preferred that such a cross-reference be in the Article, it was considered acceptable to include it in the Note to Article 9.

On the basis of the summary of the discussions by the Chairman, it was concluded that the text of draft paragraph (2) should be maintained but that the words within brackets would be deleted as being superfluous and the Notes would contain appropriate explanations. In particular, the last part of draft paragraph (2)(i) and (ii) reading 'as long as the said application is not withdrawn, abandoned or rejected' was considered necessary. As regards a cross-reference to Article 13, appropriate explanation should be given in the Notes."

Article 9bis: Loss of Rights

The text of Article 9bis was proposed by the Delegation of the United States of America. This text read as follows:

[TEXT PROPOSED BY THE DELEGATION OF
THE UNITED STATES OF AMERICA]

“(1) Any Contracting Party shall be free to provide that the right to a patent shall be lost by the applicant where:

(i) the invention was placed on sale or secretly used by the applicant more than 12 months preceding the filing date or, where priority is claimed, the priority date of the application, even if the invention was not, by virtue of being so placed on sale or secretly used, made available to the public; or

(ii) an application for an industrial property title was filed by applicant outside the Contracting Party in violation of the national security provisions of the Contracting Party.

(2) Notwithstanding Article 11 and paragraph (1) of this Article, any Contracting Party shall be free to provide that the right to a patent shall not be lost to the applicant where the use of the claimed invention by the applicant more than 12 months preceding the filing date or, where priority is claimed, the priority date of the application, was experimental.” (Document HL/CE/VIII/14, page 2)

The portion of the report of the Committee of Experts concerning the discussion of Article 9bis reads as follows:

“(a) The Delegation of the United States of America introduced its proposal (contained in document HL/CE/VIII/14) for a new Article 9bis and stated that the proposal was intended to allow the United States of America freedom to continue existing practice in that country. While the substance of the proposal was put forward in Article 9bis, its exact location in the Draft Treaty was not seen as essential.

(b) Paragraph (1)(i) of the proposed Article dealt with the situation where an applicant placed an invention on sale or secretly used it more than 12 months prior to the filing or priority date, even if such use or sale did not result in the invention being disclosed to the public. The purpose of the provision was to provide that the applicant should not get a commercial advantage without sharing the technology with the public. Paragraph (1)(ii) dealt with the situation where a patent application was filed abroad in violation of security laws of the Contracting Party, such as might be the case where those laws required nationals first to submit an application to the national Office before filing abroad.

(c) The Delegation of the United States of America indicated that *paragraph (2)* provided for an exception to the loss of rights where an

applicant used the invention experimentally. An example of such experimentation was work to improve and perfect the invention. Even if such use occurred more than 12 months before the filing or priority date, and even if it was public, such use would not constitute a bar to seeking patent protection.

The Delegation of the Federal Republic of Germany asked whether the term ‘secret use’ applied only to such use in the territory of the United States of America, or also to use outside its territory.

The Delegation of the United States of America responded that secret use would apply to such use abroad, as well as to use in the United States of America, since it was considered inequitable to allow an inventor to use an invention for a number of years and then seek patent protection.

The Delegation of the Netherlands gave an example of a Dutch inventor developing an invention in the area of agricultural machinery which took time to develop and could only be tested in the summer months. The question arose whether, if such a use was secret and effected in the Netherlands, the Dutch inventor would be denied patent protection in the United States of America.

The Delegation of the United States of America indicated that if what the Dutch inventor was doing was for experimental purposes, within the meaning of paragraph (2) of the proposed Article 9bis, there would be no bar to patent protection. If, however, the use was for commercial purposes, there would be a bar to patent protection.

The Delegation of the United Kingdom stated that placing an item on sale would seem to make it available automatically to the public and that it was difficult to know how a secret use could be for commercial purposes (and not for experimental purposes). With respect to experimental use, the Delegation asked whether field tests by pharmaceutical manufacturers conducted before applying for patent protection would be considered as constituting experimental use.

The Delegation of the United States of America indicated that one could exploit an invention secretly for commercial purposes by, for example, producing products and then allowing their use under a secrecy agreement. In such a case, the inventor would obtain the advantage of commercializing the invention, without having to disclose it to the public. The provisions of Article 9bis had the purpose of encouraging disclosure in such cases. As to pharmaceutical inventions, the Delegation stated that Article 9bis would apply to such inventions but that, in a first-to-file system, if one waited to complete the preparations necessary to perfect the invention, there was a danger

that competitors could file patent applications, or that there would be a leak of information that would destroy the competitive position of the inventor.

The Delegation of Denmark asked whether it was necessary to expand the grace period provisions of Article 12 in this manner.

The Delegation of the United States of America indicated that the proposed Article 9*bis* would have the effect that the grace period would be enlarged in certain respects but, in other respects, it would be narrowed.

The Delegation of Portugal inquired again about paragraph (1)(ii) and gave an example of a Contracting Party, such as Portugal, which had no provision in its laws preventing the filing of patent applications because of national security provisions. If a national of another State, such as the United States of America, were to file a patent application in Portugal in violation of the national security provisions of the United States of America, the question arose as to the status of patent rights in Portugal and in the United States of America.

The Delegation of the United States of America responded that the status of patent rights in Portugal would be determined under Portuguese law. In the United States of America, however, the patent could be invalidated.

The Delegation of Japan reserved its final position on Article 9*bis* but saw the provisions of paragraph (1)(i) as being applicable to a first-to-invent system, rather than a first-to-file system. In a first-to-invent system, the right to the patent was not endangered by subsequent intervening acts, even if other applications were subsequently filed. The provisions in paragraph (1)(i) were seen as being, perhaps, necessary to prohibit abuse in such a system. In a first-to-file system, it was felt that a person engaging in acts such as use or sale was at risk of losing rights as a consequence of someone else's filing for patent protection first. Accordingly, there was no possibility of abuse. Such provision was seen as working against filing, as a person would be disinclined to file, choosing trade secret protection instead. The Delegation indicated that, in a certain country which had recently changed from a first-to-invent system to a first-to-file system, the requirement for a loss of rights provision had disappeared.

The Delegation of the Netherlands asked what the status of an invention that had been used under a requirement of secrecy, imposed by the government, would be after the lifting of a defense security qualification.

The Delegation of the United States of America stated that the provisions of paragraph (1)(i) did have application in a first-to-file system. Further, the experimental use contemplated in

paragraph (2) could include use as a trade secret for an extended period of time. However, at some time, experimental use would end and commercial use would begin, and each case was to be judged on its own facts. Regarding the question raised by the Delegation of the Netherlands on paragraph (2), it stated that, in respect of a patentable invention classified for military security reasons, there were provisions in the law of the United States of America for the filing of such a classified patent application. Moreover, it was indicated that use by a country for military purposes could be considered to be more for defense purposes than commercial purposes, and that it would only be when the security restrictions were lifted that commercial use would arise.

The Delegation of Canada inquired about the worldwide nature of the 'placed on sale' provisions giving the example of a small inventor who developed an invention and was granted protection in one country. If a picture was taken of the invention which did not disclose all its elements, and circulars containing the pictures were sent to another country, the question would arise whether the invention should be considered as having been 'placed on sale' in the second country.

The Delegation of the United States of America stated that its proposal was based on the fundamental fairness of preventing an applicant from obtaining a commercial advantage from his invention, without having filed for patent protection and disclosed the invention. In response to the example given by the Delegation of Canada, it was suggested that courts be left to deal with each situation as it arises.

The Delegation of Sweden inquired as to why the proposal of the United States of America was necessary, given the existing provisions in the Draft Treaty.

The Delegation of the United States of America stated that prior art was defined in draft Article 11 as anything that 'has been made available to the public anywhere in the world.' In a situation where an invention was secretly used it was not made available to the public and was not, therefore, prior art within the meaning of Article 11.

The Delegation of Ghana saw no problem with Article 9*bis* as proposed by the United States of America, with the exception of paragraph (1)(ii). It did not seem clear whether the provisions of paragraph (1)(ii) applied to nationals of the Contracting Party in question only or to foreigners as well.

The Delegation of India indicated that the provision in paragraph (2) providing for a period longer than 12 months was not consistent with its national law, nor was it considered necessary in light of the grace period.

The Delegation of Argentina indicated that similar provisions currently existed in the law of Argentina but that a prior declaration was needed that the inventor had the right to perform work or experiments in the process of developing the invention.

The Delegation of Denmark stressed that the patent system was not to be used to punish inventors but that the protection of third parties must be considered as well. It was stated that a third party would determine the state of the art, find out what parts of that prior art were protected and act accordingly. The question was raised whether, if parts of the prior art not yet patented were used experimentally, there would not be uncertainty as to what a third party would be entitled to do.

The Delegation of the United States of America indicated that in a first-to-file system the inventor could proceed with a patent application. A second point was that, even without the provisions of proposed Article 9*bis*, one did not know for at least 18 months what applications were pending in national patent offices.

The Delegation of Switzerland commented that it had been agreed that no new proposals were to be submitted and it was not timely to open in the last session of the Committee discussion on new points. It felt that the proposed new Article 9*bis* was not consistent with nor conducive to harmonization, but would result in a treaty that maintained the *status quo*. Paragraph (1)(ii) seemed to be a sanction that was not appropriate as a provision in the Treaty. The Delegation wondered whether Article 4*quater* of the Paris Convention for the Protection of Industrial Property did not prohibit such provisions.

The Delegation of Sweden indicated that it did not support the proposal by the United States of America and that it shared the view of the Delegation of Switzerland that there should be a closed list of proposals and that no new proposals should be taken up.

The Delegation of the United States of America stated, regarding paragraph (1)(ii), that a number of countries had the same problem as its country and that such a provision seemed necessary. Regarding paragraph (1)(i), the result of it would be to encourage inventors to obtain patents. Such a provision was seen as addressing some of the criticisms of the term of patent protection as it prevented the possibility of using an invention for long periods of time before filing, then disclosing it and still being able to file a patent application within the grace period. The proposed provision should be considered on its merits, with a view to putting it forward to the Diplomatic Conference.

The Delegation of Portugal indicated that it had no objections to considering paragraph (1)(i) in the Diplomatic Conference. With respect to

paragraph (1)(ii), reservations were expressed to placing it in the Treaty because it seemed that this matter could be left to national penal law.

The Delegation of Ghana felt that proposed Article 9*bis* was not new subject matter but, rather, a proposal similar to others that had been submitted.

The Delegation of India felt that the proposal by the United States of America would benefit the Treaty but indicated that the proposal, in general, needed some adjustment, in particular to certain time limits it contained.

The Delegations of Austria, Canada and Australia reserved their positions on the proposed Article.

The Representative of AIPO expressed concern with the provisions regarding secret sale and use and experimental use and indicated that African inventors did not benefit from the same provisions as inventors in other countries. The proposal might amount to protectionism based on intellectual property and might not be compatible with Article 2 of the Paris Convention for the Protection of Industrial Property.

The Representative of FICPI stated that he agreed with the Delegation of Japan that, under the first-to-file system, provisions such as those in the proposal were not necessary. The type of misuse contemplated by paragraph (1)(i) only occurred rarely.

The Representative of AIPPI raised the possibility of problems associated with trade secret protection and the implications of the proposal by the United States of America with respect to trade secret protection.

The Delegation of the United States of America stated that the proposed Article would not prevent an inventor from using know-how or trade secret protection for as long as he wished. The United States of America was a strong supporter of that form of intellectual property protection. If, however, an inventor chose such a form of protection and commercially exploited the invention, after the expiration of 12 months, patent protection should no longer be available.

The Representative of MPI questioned whether the provision was necessary in a first-to-file system.

The Representative of NYPTC supported paragraph (1)(i) and stated that, in a first-to-file system, he did not see its inclusion as being a major problem.

The Representative of CIPA recalled that the United Kingdom had had a similar provision to that in paragraph (1)(i) until 1978, and at that time the provision was removed in order to permit the United Kingdom to harmonize its patent laws with those of the other Member States of the European Patent Organisation.

The Representative of ABA felt that more consideration must be given in the harmonization process to the requirements of the United States of America.

The Representative of PTIC stated that there had not been much time to study the proposal. As to paragraph (1)(ii), it was felt that such a provision was not needed in the Treaty. Moreover, one should consider what would happen if a Canadian inventor shared inventorship with a national of the United States of America. If both countries had provisions consistent with paragraph (2), it would be difficult for each of them to comply with his nation's provisions at the same time.

The Chairman stated that the proposed Article 9bis was a new topic which had come forward only during the current session and that the diversity of opinions expressed did not allow a definite conclusion to be drawn. However, there had been sufficient interest expressed in the proposal to allow its provisions to be maintained for further discussion. One should consider whether the provisions in paragraphs (1)(ii) and (2) should, if maintained, have an optional or a mandatory nature. Moreover, the question arose as to whether a transitional provision might not be an acceptable way of dealing with the provisions."

Article 10: Fields of Technology

In addition to the text of Article 10 as elaborated by the International Bureau, discussions were based on a text proposed by the Delegations of Algeria, Argentina, Brazil, Cameroon, China, Cuba, Democratic People's Republic of Korea, Egypt, Ghana, Indonesia, Kenya, Libya, Madagascar, Mexico, Morocco, Nigeria, Romania, Syria, Trinidad and Tobago, Tunisia, United Republic of Tanzania, Uruguay and Zaire. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"Alternative A:

*Patent protection shall be available for inventions, whether they concern products or processes, in all fields of technology.*¹

Alternative B:

[No Article 10]

[TEXT PROPOSED BY THE DELEGATIONS OF ALGERIA, ARGENTINA, BRAZIL, CAMEROON, CHINA, CUBA, DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA, EGYPT, GHANA, INDONESIA, KENYA, LIBYA, MADAGASCAR, MEXICO, MOROCCO, NIGERIA, ROMANIA, SYRIA, TRINIDAD AND TOBAGO, TUNISIA, UNITED REPUBLIC OF TANZANIA, URUGUAY AND ZAIRE]

"Alternative A

This Article should read as follows:

'Fields of Technology

(1) Patent protection shall be available for inventions in all fields of technology which are new, which involve an inventive step and which are industrially applicable, except for:

(i) inventions whose use would be contrary to public order, law or morality or injurious to public health;

(ii) plant or animal varieties or essentially biological processes for the production of plants or animals;

(iii) discoveries and materials or substances already existing in nature;

(iv) methods of medical treatment for humans or animals;

(v) nuclear and fissionable material.

(2) Contracting States may, on grounds of public interest, national security, public health, nutrition, national development and social security, exclude from patent protection, either in respect of products or processes for the manufacture of those products, certain fields of technology, by national law.

(3) Contracting States shall notify the Director General of such exclusions by a written declaration. Any such declaration may be withdrawn at any time totally or partially by notification addressed to the Director General.'

Alternative B

Deletion of Article 10 as proposed in Alternative B of WIPO text in document HL/CM/1." (Document HL/CE/VIII/22, page 3)

The portion of the report of the Committee of Experts concerning the discussion of Article 10 reads as follows:

"The Delegation of Mexico, which assumed the chairmanship of the Consultative Meeting of Developing Countries on the Harmonization of Patent Laws, held in Geneva from June 5 to 8, 1990, and attended by 44 developing countries, introduced the conclusions adopted by that Meeting and drew the attention of the Committee of Experts to the fact that the Consultative Meeting had decided to present the proposals contained in document HL/CM/II/2 and reproduced in document HL/CE/VIII/22 for inclusion in the Basic Proposal for the Diplomatic Conference to be held in 1991. The Delegation explained that the proposed new Alternative A of Article 10 would allow Contracting Parties to exclude inventions in certain designated fields from patentability. The proposed Alternative A

¹ The final provisions (see document HL/CE/VIII/4) will contain a provision permitting, under certain conditions, a reservation to be made in respect of this norm."

was intended to replace Alternative A of Article 10 in the Draft Treaty. Alternative B of Article 10 in document HL/CE/VIII/22 was identical with Alternative B in the Draft Treaty.

The Delegation of the United States of America stated that Alternative A of proposed Article 10 in document HL/CE/VIII/22 would not be acceptable. The Delegation expressed concern, in particular, with respect to paragraph (2) of that Alternative, which would give no legal certainty to inventors and would discourage enterprises from making investments in countries which enacted exclusions based on that paragraph. In any case, the paragraph was contrary to a present trend in patent laws of all countries to expand the coverage of patent protection. The Delegation hoped that the proposal was only a starting point for negotiations, since the United States of America regretted that proposals of this sort might have the effect that governments would prefer other fora such as GATT. In view of different levels of development the interests of countries tended to differ. However, no country would be obliged to join the Treaty.

The Delegation of Portugal said that it could envisage negotiations on a list of exclusions such as the one contained in paragraph (1) of the proposed Alternative A for Article 10 contained in document HL/CE/VIII/22. It would, however, be very difficult to accept a text along the lines of paragraph (2) of that proposal since virtually any exclusion could be inserted in a law under the notion of 'public interest.'

The Delegation of the United Kingdom said there should be an Article 10 in the Treaty dealing with fields of technology and that, in principle, patents should be available in all fields of technology. It could be admitted that there were matters which did not constitute inventions; mentioning them in the Notes to Article 10 would suffice. Moreover, inventions the exploitation or publication of which would be contrary to public order or morality, as well as plant and animal varieties and essentially biological processes for the production of plants or animals, could reasonably be excluded from patent protection. The same could apply to methods for the treatment of the human body. With respect to the proposed Alternative A for Article 10 contained in document HL/CE/VIII/22, the Delegation believed that items (i) and (ii) of paragraph (1) should be optional, and that paragraph (2) should not be accepted because it would allow arbitrary exclusions from patent protection. The Delegation noted that the patent system benefited all countries, both developed and developing, and that, if technological fields were excluded arbitrarily, incentives for research work would be suppressed. That would be detrimental to all countries.

The views of the Delegation of the United Kingdom were generally shared by the Delegations of Australia, the Federal Republic of Germany, New Zealand, Canada, the Netherlands, France and Denmark.

The Delegation of Switzerland supported the views expressed by the United States of America and expressed its preference for strong patent protection since it served better the development of technology. Although certain exclusions from patent protection were still a matter to be discussed, in particular as regards plant and animal varieties, Alternative A of Article 10 as contained in the Draft Treaty should be submitted to the Diplomatic Conference.

The Delegations of Indonesia, Argentina, Chile, India, Cuba, the Democratic People's Republic of Korea, China, Brazil, Venezuela, Nigeria, Mexico, Cameroon, Swaziland, Lebanon, Libya and Peru, and the Representative of ALIFAR supported Alternative A of Article 10 as proposed in document HL/CE/VIII/22. Reference was made to document HL/CM/INF/1 Rev., which showed that a number of countries excluded certain subject matter from patent protection for the purposes of their economic or technological development policies, or for other reasons of prevailing public interest. Paragraph (2) of Alternative A in document HL/CE/VIII/22 should not be seen as an open-ended provision allowing the establishment of arbitrary exclusions for patent protection, but rather as a restatement of the freedom that countries should have to define certain specific areas in which, for their own particular reasons or interests, patent protection would not be available. All countries had the right to legislate in accordance with the imperatives of national security and public interest. The possibility of making a temporary reservation in respect of that liberty was not a satisfactory option. As had been said, developing countries had reached different levels of development and had different needs and interests. No harmonization would seem possible unless the lowest common denominator was taken into account in these negotiations. Alternative A of Article 10 as contained in the Draft Treaty was unacceptable because it did not allow countries to exercise any degree of flexibility in the light of their own national development strategies and their economic development requirements. Although some countries had recently deleted from their laws exclusions from patentability, harmonization of patent laws could not be expected to solve development issues. Development had to be accomplished step by step, and in this respect a fixed time limit in the Treaty would be unworkable. The proposed new Alternative A should therefore be included in the Draft Treaty and

given serious consideration by all delegations. Otherwise, Alternative B, to the effect that the Treaty should not have a provision on this matter, could turn out to be the only feasible choice. The Delegation of India stated that the alleged uncertainty, which other delegations claimed would be caused by the text of paragraph (2) of the proposed alternative for Article 10 as contained in document HL/CE/VIII/22, would not exist because paragraph (3) of proposed Article 10 would require countries which established exclusions from patentability under said paragraph (2) to notify this fact to the Director General of WIPO in writing, and through his intermediary all Contracting Parties would know what exclusions were applicable.

The Delegation of Ghana said that most States maintained, in their present national legislation on patents, exclusions from patent protection of inventions in certain fields of technology on the grounds of national security, amongst others, and as such it was unrealistic not to take note of such exclusions in Article 10 of the Draft Treaty. It therefore expressed the view that the exclusions contained in Article 10 of document HL/CE/VIII/22 were in the right direction.

The Delegations of Japan, Austria, Ireland, Belgium and Bulgaria said that the proposal for a new Alternative A of Article 10 contained in document HL/CE/VIII/22 was a proposal that required further study in their countries, as well as consideration of the outcome of discussions in other fora. They, therefore, reserved their positions on the said proposal.

The Delegations of Norway and Romania said that, in view of the situation existing presently in patent laws in the world, Alternative B should also be considered, namely omitting any article dealing with fields of technology in the Treaty.

The Delegation of the Republic of Korea expressed preference for a text along the lines of Alternative A of the Draft Treaty, with the addition of some of the exclusions listed in paragraph (1) of proposed Alternative A contained in document HL/CE/VIII/22. It referred, in particular, to the exclusions listed in items (i), (ii) and (iv) of paragraph (1) of that proposed Alternative.

The Delegation of the Soviet Union proposed maintaining Alternative A as it appeared in the Draft Treaty, but considered that the exclusions listed in paragraph (1) of the proposed Alternative A of document HL/CE/VIII/22 could be kept as an optional provision.

The Delegation of Hungary stated that, while document HL/CE/VIII/22 contained an interesting proposal, it was in favor of Article 10, Alternative A, of the Draft Treaty. In any case, no exclusion from patent protection should be mandatory.

The Representatives of LES, UNICE, NYPTC, CEPIC, CIPA, CNIPA, EPI, PTIC, APAA, AIPLA, AIPPI and FICPI favored Alternative A as contained in the Draft Treaty. They questioned the need for any exclusions from patent protection, in particular since legal and technological developments had rendered certain exclusions obsolete, and because discriminatory exclusions in certain fields of technology, for example, the chemical and biological fields, would entail less research and investment in the countries having the exclusions, and a consequential reduction in the flow of technology to those countries.

It was agreed that the Basic Proposal will contain two texts for Article 10, each of which will be placed in square brackets and without an identifying letter (such as 'A' or 'B'). One of the texts will be the text of Alternative A in document HL/CE/VIII/22, and the other text will be the text of Alternative A in document HL/CE/VIII/3. Thus, both texts will have exactly the same status in the Basic Proposal."

Article 11: Conditions of Patentability

In addition to the text of Article 11 as elaborated by the International Bureau, discussions were based on a text proposed by the Delegation of Sweden. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Patentability] An invention shall be patentable if it is novel, involves an inventive step (is non-obvious) and is useful or industrially applicable.

(2) [Novelty] (a) An invention shall be considered novel if it does not form part of the prior art.

(b) The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world.

[(c) Notwithstanding subparagraph (b), any Contracting Party shall be free to exclude from the prior art matter made available, by oral disclosure, by use or by display at an exhibition, in a place or space which is not under its sovereignty or, in the case of a supranational authority or of an intergovernmental organization, under the sovereignty of one of its constituent or member States.]

(3) [Inventive Step (Non-Obviousness)] An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in paragraph (2), it would

not have been obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date of the application claiming the invention.”

[TEXT PROPOSED BY THE DELEGATION OF SWEDEN]

“(1) [Patentability] An invention shall be patentable if it is novel and involves an inventive step (is non-obvious) and is, at the option of any Contracting Party, either useful or industrially applicable.

(2) [Novelty] (a) An invention shall be considered novel if it is not disclosed in a single item forming part of the prior art.

(b) The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public. (–)

(c) (Document HL/CE/VIII/9, page 3)

(d) Any Contracting Party shall be free to provide that a product comprised in the state of the art shall be considered novel in respect of its use in a method for the treatment of the human or animal body by surgery or therapy or in a diagnostic method practiced on the human or animal body, provided that its use for any such method is not comprised in the state of the art.” (Document HL/CE/VIII/24)

(3) [Inventive Step (Non-Obviousness)] An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in paragraph (2), it would not have been obvious to a person skilled in the pertinent art [before the filing date or, where priority is claimed, the priority date of the application].” (Document HL/CE/VIII/9, page 3)

The portion of the report of the Committee of Experts concerning the discussion of Article 11 reads as follows:

“Paragraph (1). The Delegation of Sweden presented its proposal (contained in document HL/CE/VIII/9), indicating that the main purpose of the proposal was to make it clear that the choice of the requirement of usefulness or industrial applicability was left to the option of the Contracting Parties in their national laws and not to the applicants.

The Delegations of Australia, Austria, Belgium, Bulgaria, Canada, Denmark, Finland, the Federal Republic of Germany, Ireland, Italy, the Netherlands, Norway, Poland, the Soviet Union, Switzerland and the United Kingdom expressed their support for the proposal of the Delegation of Sweden.

The Delegation of Ghana expressed itself in favor of the draft paragraph.

The Delegations of Argentina and Japan indicated that, both in respect of the Draft Treaty and in the proposal of the Delegation of Sweden, they wished to leave only one criterion—industrial applicability—and to delete the notion of usefulness.

The Delegation of Lebanon proposed to amend paragraph (1) by adding the words ‘for public’ after ‘useful’ and by changing the words ‘or industrially applicable’ by ‘and commercially applicable.’

The Delegation of Portugal stated its general preference for the draft paragraph and indicated that the proposal of the Delegation of Sweden required further consideration.

On the basis of a summary of the discussions by the Chairman it was generally agreed that this paragraph should be redrafted along the lines of the proposal by Sweden.

Paragraph (2). The Delegation of Sweden presented its proposal (contained in document HL/CE/VIII/9), indicating that draft paragraph (2)(a) should refer to a ‘single item forming part of the prior art’ in order to exclude the possibility that the novelty of an invention could be denied on the basis of a mosaic of various elements, and that the words ‘anywhere in the world’ at the end of draft paragraph (2)(b) should be deleted because they did not clearly include activities in outer space.

As regards draft paragraph (2)(a), the Delegations of India, Madagascar, Romania and the Representative of AIPO expressed themselves in favor of the draft since it used generally accepted terminology.

The Delegations of Canada, France, the Federal Republic of Germany, Hungary, Israel, Japan, the Netherlands, Portugal, the Soviet Union, Spain, Switzerland, the United Kingdom and the United States of America, as well as the Representatives of AIPPI and EPO expressed their generally positive attitude towards the proposal of the Delegation of Sweden.

It was suggested that, when using the term ‘disclosed,’ common knowledge, which was in the public domain and which therefore should be taken into account by the examiner, should be understood to be covered by that term.

It was also suggested that the proper equivalents should be used in other languages for the term ‘item,’ appearing in the proposal by Sweden. The term was understood to cover, for example, a document, a machine, an exhibition and an oral description. Thus, consideration should be given to using, instead of the term ‘item,’ such expressions as ‘article,’ ‘solution,’ ‘document,’ or ‘event.’

A number of delegations proposed to explain in the Notes the meaning of the terms ‘disclosed’ and ‘item’ with possible examples, while other delegations were against any explanations since they could lead to a dilution of the criterion of novelty.

On the basis of a summary by the Chairman, it was agreed that the proposal by Sweden should be taken into account and that two alternatives could be presented in respect of drafting, the first alternative expressly prohibiting the possibility of 'mosaicking,' and the second alternative using the term 'item' or another equivalent term and giving appropriate explanations in the Notes on that term. Moreover, it should be made clear in the Notes that 'disclosing an invention' means telling a person skilled in the art something which he does not yet know.

In the discussions of draft *paragraph (2)(b)*, objections were raised against the deletion of the words 'anywhere in the world' at the end as suggested in the proposal of Sweden (document HL/CE/VIII/9). The Delegation of Sweden agreed to withdraw its proposal in that respect.

The Delegation of the Netherlands stated that draft *paragraph (2)(b)* should speak of the 'priority which exists' rather than which is 'claimed,' in order to exclude priority claims that were not valid.

It was agreed that draft *paragraph (2)(b)* should remain unchanged and that the Notes should clarify that only validly claimed priorities should be taken into account.

In the course of discussions on draft *paragraph (2)(c)*, the Delegations of Australia, Japan, Nigeria, the Republic of Korea and the United States of America, as well as the Representative of ABA, proposed to keep draft *paragraph (2)(c)* in the Draft Treaty, the Delegations of Australia, Nigeria and the United States of America underlining that the square brackets should be removed in the next draft.

The Delegations of Canada, the Netherlands and the United Kingdom suggested deleting draft *paragraph (2)(c)*.

The Delegation of the United States of America drew attention to Note 11.05, which it considered to be wider in meaning than draft *paragraph (2)(c)*.

It was agreed that draft *paragraph (2)(c)* should be kept in the Draft Treaty in square brackets and that Note 11.05 should be reviewed.

In the course of discussions of draft *paragraph (2)(a)*, a question was raised by the Delegation of Sweden in respect of the interpretation of the novelty requirement where a known product was used for a new medical indication, a case regulated in Article 54(5) of the European Patent Convention ('EPC'). The Delegation of Sweden submitted a proposal for a new *paragraph (2)(d)* (document HL/CE/VIII/24) and indicated that the proposal was of an optional nature and was based on the respective provisions of the EPC.

It was explained that under the EPC a general rule applied that, if a product was already known

it could not obtain patent protection even in the case of a new use. Such a new use could only be claimed for the purposes of obtaining a process patent. However, the EPC provided for an exception to that rule, namely, where a known product was intended for a new medical use; in that case, the product could be considered as novel and granted patent protection.

The Delegations of Austria, the Federal Republic of Germany, Italy, Switzerland, Denmark and the Netherlands and the Representatives of EPO and LES supported the inclusion in the Draft Treaty of a provision as proposed by the Delegation of Sweden. It was stated that medical treatment should comprise pharmaceutical use and that the exception to novelty applied only to first medical use.

The Delegation of the United States of America indicated that it preferred to see the provision of Article 52(4) of the EPC changed. Protection should be available beyond first medical use.

The Delegation of Japan expressed doubt over the necessity to introduce into the Draft Treaty a provision to deal with a specific issue existing under the European Patent Convention. The Delegation expressed concern that the introduction of such a provision might be construed as eliminating other possibilities on the basis of *argumentum a contrario*. The Delegation of the Federal Republic of Germany opposed such an *a contrario* conclusion and referred to the jurisprudence in its country allowing patents also for a second medical use.

The Representative of AIPLA associated himself with the positions taken by the Delegations of Japan and the United States of America.

The Delegation of India opposed the inclusion in the Draft Treaty of a new subparagraph (2)(d), stating that pharmaceutical products *per se* and their use were not patentable under its national law.

The Chairman concluded that the consideration of the proposed subparagraph (2)(d) should be postponed until it became clear whether Article 10 of the Draft Treaty would provide for a possibility of excluding pharmaceutical products from patent protection.

Paragraph (3). The Delegation of Sweden presented its proposal (contained in document HL/CE/VIII/9).

The Delegations of Japan and the United States of America, as well as the Representatives of ABA, AIPLA and the Max Planck Institute supported the proposal of the Delegation of Sweden in respect of introducing the adjective 'pertinent' before 'prior art' since the person dealing with an invention should be skilled not in

the (general) art but in the art to which the invention pertained.

The Delegations of Canada, France, Nigeria, Norway, Portugal and Swaziland, as well as the Representatives of AIPPI, UNICE and UEPIP expressed themselves in favor of the draft and against the use of the term 'pertinent,' since the phrase 'a person skilled in the art' had been generally adopted and had a clear meaning since an invention could comprise a composition of elements from a neighboring area of technology that was not 'pertinent' but still should be patent-defeating.

There was no support for the proposal by Sweden to replace the word 'at [the filing date]' by 'before [the filing date].'

It was agreed that draft paragraph (3) should remain unchanged and that the Notes could be reviewed as regards the explanation of the phrase 'a person skilled in the art.' As for the date at which the invention should not be obvious in order to be patentable, it was agreed that neither the filing date nor the priority date should be expressed in terms of hours. The Delegation of Japan reserved its position on this matter."

Article 12: Disclosure Not Affecting Novelty and Inventive Step (Grace Period)

In addition to the text of Article 12 as elaborated by the International Bureau, discussions were based on texts proposed by the Delegations of the Netherlands and the United States of America. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Circumstances of Disclosure Not Affecting Patentability] *Disclosure of information which otherwise would affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed, during the 12 months preceding the filing date or, where priority is claimed, the priority date of the application,*

- (i) *by the inventor,*
- (ii) *by an Office*
- (a) *and the information was contained in another application filed by the inventor and should not have been disclosed by the Office, or*
- (b) *and the information was contained in an application filed without the knowledge or consent of the inventor by a third party which obtained the information direct or indirectly from the inventor, [provided that the applicant who invokes the grace period shall have the burden of proof in*

respect of the fact that the information was obtained direct or indirectly from the inventor.]

or

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

(2) ['Inventor'] *For the purposes of paragraph (1), 'inventor' shall also mean any person who, at the filing date, had the right to a patent in respect of the application."*

[TEXT PROPOSED BY THE DELEGATION OF THE NETHERLANDS]

"(1)[but text in square brackets under (b) to be deleted.]

(2)

(3) [Burden of Proof] *The applicant or the owner of the patent shall have the burden of proof in respect of the conditions referred to in paragraph (1)."* (Document HL/CE/VIII/13, page 2)

[TEXT PROPOSED BY THE DELEGATION OF THE UNITED STATES OF AMERICA]

"(1)

(2)

(3) *The applicant or the owner of the patent shall have the right to claim at any time the benefit of the grace period for the disclosures set forth in paragraph (1)."* (Document HL/CE/VIII/14, page 3)

The portion of the report of the Committee of Experts concerning the discussion of Article 12 reads as follows:

"The Delegation of the Netherlands introduced its proposal (document HL/CE/VIII/13) to amend this Article, recalling that it remained difficult for interested circles in that country to accept the principle of a grace period and that the Delegation, therefore, had to reserve its position on the draft Article as a whole. Whether or not it could eventually accept the principle of a grace period would depend on whether a final well-balanced treaty package could be negotiated. Its proposal was being submitted in an attempt to facilitate interested circles' acceptance of draft Article 12. The proposal asked for the introduction of a new paragraph (3) providing that the applicant or the owner of the patent would have the burden of proof in respect of whether the conditions for invoking the grace period under draft paragraph (1) had been met. Contrary to draft Article 12 which contained in square brackets a burden of proof provision which would be applicable only to applicants invoking the grace period with respect to disclosures specified in draft paragraph (1)(ii)(b) (i.e., disclosures by an Office when the information was contained in an application filed,

without the knowledge or consent of the inventor, by a third party which had obtained the information direct or indirectly from the inventor), paragraph (3), as proposed by the Delegation of the Netherlands, would make the burden of proof provision applicable to an applicant as well as to a patent owner invoking the grace period with respect to any disclosure under draft paragraph (1) (i.e., a disclosure by the inventor, by an Office or by a third party which had obtained the information direct or indirectly from the inventor).

The Delegation of the United States of America introduced its proposal (document HL/CE/VIII/14), for amending the draft Article, explaining that the proposal would also introduce a new paragraph (3) providing that the applicant or the patent owner should have the right to claim *at any time* the benefit of the grace period. It seemed that some countries required that the grace period be invoked at the time of filing a patent application. However, in many cases, applicants may not be aware at the time of filing their application that disclosures for which the grace period could be invoked had been made. The proposal would ensure that the applicant or patent owner could claim the benefit of the grace period at any time during the patent granting procedure or even after the grant of the patent, for example, during invalidation proceedings.

The Committee of Experts first considered the proposal by the Netherlands.

The Delegation of the United Kingdom expressed its support for the proposal by the Netherlands. It said that interested circles in the United Kingdom also found it difficult to accept the principle of a grace period. However, this principle might be accepted if a well-balanced treaty package could be negotiated, especially as regards harmonizing the first-to-file system. The Delegation was concerned that the grace period not go beyond protecting inventors from having their own disclosures, or disclosures of information obtained direct or indirectly from them, destroy the patentability of their invention. It therefore agreed that, if an applicant or patent owner wished to claim the benefits of the grace period, he should have the burden of proving that the conditions of draft paragraph (1) had been met. This should mean that the applicant or patent owner must at least establish a *prima facie* case that he had met those conditions. In addition, the Delegation was of the opinion that effective protection must be provided for prior users in the context of the grace period.

The Delegation of Norway did not agree that draft Article 12 should contain any burden of proof provision, be it in the form that it appeared in the proposal by the Netherlands or be it in the form that it appeared in square brackets in draft

paragraph (1)(ii)(b). Furthermore, the Delegation recalled that, although it did not favor the principle itself of a grace period, it was prepared to accept it as part of a well-balanced treaty package.

The Delegation of the United States of America did not object to the proposal by the Netherlands as a conceptual matter, but it was concerned that the proposed text, in its present wording, might be applied too strictly and allow Offices to require a heavier burden of proof than would be desirable or fair to impose on an applicant or patent owner. Therefore, it sympathized with the opinion expressed by the Delegation of Norway that a burden of proof provision should not appear in draft Article 12. However, in a spirit of compromise, it was willing to accept a burden of proof provision, provided that the wording was changed, for example, to the effect that the applicant or patent owner would have the burden of coming forward with evidence in respect of the conditions referred to in draft paragraph (1). Furthermore, the Delegation disagreed with the position taken by the Delegation of the United Kingdom that there be a provision protecting prior users' rights in the context of the grace period.

The Delegation of the United Kingdom agreed with the Delegation of the United States of America that the burden of proof should not be too severe and that it would be sufficient if the applicant or patent owner came forward with *prima facie* evidence.

The Delegation of the Netherlands explained that the intention behind the proposal was not to impose on the applicant or patent owner a burden of conclusive proof but only a burden of going forward with evidence. It suggested that this could be explained in the Notes on draft Article 12.

The Delegation of Japan expressed its support for the proposal by the Netherlands but agreed with the Delegation of the United States of America that there should not be a provision protecting prior users' rights in the context of the grace period. It added that it preferred a grace period of six months.

The Delegation of the Federal Republic of Germany recalled that it had always favored the principle of a grace period. It stated that it could accept a burden of proof provision, as contained in the proposal by the Netherlands or reworded in the manner suggested by the Delegation of the United States of America. As regards prior users' rights, it was of the opinion that these should not be dealt with in the context of the grace period.

The Delegation of Sweden recalled that, although it was opposed to the principle of a

grace period, it was ready to accept it if it formed part of a well-balanced treaty package. It expressed its support for the proposal by the Netherlands.

The Delegation of the Soviet Union said that it could support a burden of proof provision but would prefer a text along the lines suggested by the Delegation of the United States of America. It was also of the opinion that prior users' rights should be protected in the context of the grace period.

The Delegation of Switzerland expressed its support for the proposal by the Netherlands and agreed with the position of the Delegation of the United Kingdom that the Draft Treaty should ensure effective protection of prior users' rights in the context of the grace period.

The Delegation of Israel expressed its support for the principle of a grace period and agreed with a one-year period. It also expressed its support for the proposal by the Netherlands, as it considered it only fair that the burden of proof fall on the person who claimed the benefits of the grace period.

The Delegation of Canada expressed its support for the principle of a grace period of 12 months and its support for the proposal by the Netherlands.

The Delegation of Italy expressed its support for the proposal by the Netherlands and agreed with the Delegation of the United Kingdom that the burden of proof provision should be understood as imposing only a burden of coming forward with *prima facie* evidence. It also agreed that prior users' rights should be protected in the context of the grace period.

The Delegation of Australia expressed its objection to including a burden of proof provision in the Treaty, as it considered that such a question should be left to national law.

The Delegation of Denmark stated that it was ready to accept the principle of a grace period but only if the first-to-file provision were also harmonized in the Draft Treaty. If it were to accept a grace period, it would prefer that it contain a burden of proof provision, either as it appeared in draft paragraph (1)(ii)(b), or as it appeared in the proposal by the Netherlands.

The Delegation of Belgium stated that it was ready to accept the principle of a grace period as part of an overall well-balanced treaty package, in particular on the condition that the first-to-file system was also harmonized in the Draft Treaty and that prior users' rights would be ensured in the context of the grace period.

The Delegation of Romania agreed with the principle of a grace period but only of six months. However, it was opposed to a burden of proof provision.

The Delegation of Ireland stated that it was ready to accept a 12-month grace period as part of an overall well-balanced treaty package which would also provide for effective protection of prior users' rights in the context of the grace period. It could support the proposal by the Netherlands on the burden of proof.

The Delegation of France recalled that it was not favorable to the principle of a grace period, but, in a desire to achieve harmonization, it was ready to accept it as part of a well-balanced treaty package which would harmonize in particular the first-to-file system. As regards the burden of proof provision, it could accept either the proposal by the Netherlands or the wording suggested by the United States of America in this regard. It also joined the Delegation of the United Kingdom in the opinion that prior users' rights should be protected in the context of the grace period.

The Delegation of India expressed its support for the principle of a grace period but could not agree that it should include a burden of proof provision, as it considered that this question should be left to national law.

The Delegations of Argentina, Austria, Poland, the Republic of Korea and Spain expressed their support for the principle of a grace period, but of six months, and their support for the proposal by the Delegation of the Netherlands.

The Delegation of Lebanon was opposed to the principle of a grace period and to a burden of proof provision, a question which he considered should be left to national law.

The Representative of AIPO expressed his support for the principle of a grace period.

The Representative of the EPO expressed his support for the proposal by the Netherlands and his agreement with the position taken by the Delegation of the United Kingdom, especially as regards the relationship between the grace period and prior users' rights. He was of the opinion that prior users' rights should be expressly safeguarded within the context of the grace period and that disclosures by the inventor should not give rise to a kind of priority right which would in effect create a first-to-publish system.

The Representative of AIPLA explained that it was understood that the grace period was meant to constitute a *quid pro quo* for the first-to-file system. However, it was not enough for the Draft Treaty to provide for a grace period; it would have to provide for a meaningful one. A watered-down grace period would not be seen in the United States of America as a *quid pro quo* for the first-to-file system. Protecting prior users' rights in the context of the grace period would be seen as a watering down of the grace period. As regards a burden of proof provision, such a provi-

sion should be softened, along the lines suggested by the Delegation of the United States of America, by clearly providing for a burden of coming forward with evidence. In fact, when a third party appropriated information, the burden of proof should be on him to show how he acquired such information.

The Representative of PTIC expressed his concern about possible abuses with respect to the grace period.

The Representative of UNICE recalled that his organization was opposed to the grace period because of the uncertainty and possible abuses to which it might give rise. However, it was ready to accept the principle as part of an overall well-balanced treaty package. He was concerned that third-party rights be adequately protected in the context of the grace period and suggested that it be expressly provided in draft paragraph (1)(ii)(b) that the information was obtained 'illegally' by the third party.

The Representative of CIPA, CNIPA and EPI recalled that the majority of the members of those organizations were opposed to the principle of a grace period but were willing to accept it as part of an overall well-balanced treaty package. He expressed concern that the word 'during' would not be interpreted as 'not earlier than' unless the latter expression were used. He expressed his support for the proposal by the Netherlands and agreed with the Delegation of the United Kingdom about the need to protect prior users' rights in the context of the grace period.

The Representative of ABA expressed his concern about a prior users' rights provision watering down the effects of draft Article 12 to the point that there would be no effective grace period under the Draft Treaty. He recalled that, although the United States of America would be willing to consider a well-balanced treaty package, the package so far offered by many countries was an empty one. Although the ABA had adopted recommendations to give consideration to a well-balanced harmonization treaty package, it had also adopted resolutions not to accept any prior users' rights provision under any international harmonization treaty. Therefore, it could not consider a prior users' rights provision as part of any treaty package.

The Representative of AIPPI expressed his support for the proposal by the Netherlands but was opposed to any provision on prior users' rights in the context of the grace period.

The Representative of ATRIP suggested that a provision be included to bar secret commercial use after a specific period of time.

The Representative of FICPI stated that his organization had always supported the grace period. Anyone who had ever had experience with

the grace period did not want to give it up. As regards a burden of proof provision, he supported the text which appeared in draft paragraph (1)(ii)(b) but could accept the proposal by the Netherlands provided that it was understood as imposing only a burden of coming forward with evidence. In its opinion, the issue of the grace period arose very seldom in practice, and, when it did, the third party usually proved to be the abuser.

The Representative of JPA expressed his support for the proposal by the Netherlands, in the spirit of harmonization.

The Representative of LES explained that he had been persuaded by the Representative of AIPLA that the grace period formed part of a well-balanced treaty package and that including a prior users' rights provision would water down the grace period.

The Representative of CEFIC expressed his support for the grace period and for the proposal by the Netherlands.

The Representative of NYPTC stated that his organization very much favored the 12-month grace period. He pointed out that the current text of draft Article 12 would already require such a change in the law of the United States of America that, even without the changes just proposed, it could be considered as a sufficient *quid pro quo* without even taking the first-to-file system into consideration.

The Chairman concluded that a great majority, if not all, of the delegations were willing to accept the principle of a grace period, at least as part of an overall well-balanced treaty package. He noted that this was the first attempt at harmonizing a grace period rule at the international level and thus provide for a certain degree of security in this respect internationally. As regards the question of the length of the grace period (i.e., six months or 12 months), the majority was in favor of 12 months. Furthermore, although a minority of delegations had expressed opposition to the proposal by the Netherlands, a great majority had expressed support for the proposal, but with many preferring the drafting suggested by the Delegation of the United States of America to make it clear that the purpose of such a provision was to impose on the person claiming the benefits of the grace period merely a burden of coming forward with *prima facie* evidence. As regards the question of prior users' rights, the relevant issues would be considered during the discussion of draft Article 20 (Prior User).

The Committee of Experts considered next the proposal by the United States of America.

The Delegation of Japan stated that how and when the applicant or patent owner could claim the benefit of the grace period should be left to

national law. In its opinion, the applicant should clearly indicate at the time of filing his application that he wished to claim the benefits of the grace period. Such a requirement was conducive to examination efficiency and was in the interest of third parties. It therefore reserved its position with respect to the proposal by the United States of America but was willing to review the question.

The Delegation of Norway stated that, if there was to be a grace period, it should not be burdened by bureaucratic procedures and therefore supported the proposal by the United States of America.

The Delegation of the Federal Republic of Germany, in response to the statement made by the Delegation of Japan, noted that, although it may be possible, in the case of written disclosures, to claim the benefit of the grace period at the time of filing the patent application, it was almost impossible to claim the benefit of the grace period at that stage with respect to oral disclosures because these were seldom known to the applicant at that time. It, therefore, supported the proposal by the United States of America.

The Delegation of France did not object to the proposal by the United States of America and noted that, as a compromise, it could be made clear that the right to claim at any time the benefit of the grace period should be available at least if and when a given disclosure was challenged.

The Delegation of Romania was of the opinion that the grace period was generally invoked only if a third party or the Office challenged any given disclosure and, therefore, supported the proposal by the United States of America.

The Delegation of Spain favored a grace period and considered it logical that, if a grace period existed, it should be possible to claim its benefits at any time and therefore supported the proposal by the United States of America.

The Delegations of Cameroon, Denmark and Italy stated that, if a grace period were provided for, they were in favor of the proposal by the United States of America.

The Delegations of the following States also expressed their support for the proposal by the United States of America: Australia, Bulgaria, Canada, Ghana, Ireland, New Zealand, Portugal, Republic of Korea, Switzerland.

The Delegation of Japan suggested that, if a majority supported the proposal by the United States of America, perhaps a compromise could be reached by providing that, in the interest of third parties, the grace period could be claimed within a specific time after the filing date of the application.

The said suggestion did not inspire any response.

The Delegation of the United Kingdom stated that it could not at this time support the proposal by the United States of America, as it needed more time to study this question. There was concern in the United Kingdom that the grace period could be invoked at any time. Third parties should know at some specific stage of the patent-granting procedure if the grace period was being invoked.

The Representative of the EPO expressed support for the proposal by the United States of America, as it considered the grace period meaningless without such a provision.

The Representatives of AIPPI, APAA, CNIPA, CIPA, EPI, FICPI and JPAA expressed support for the proposal by the United States of America.

The Chairman concluded that the proposal by the United States of America was supported by a great majority of delegations and by all of the organizations which spoke. He added that the Notes on draft Article 12 should make it clear that 'at any time' meant that the benefits of the grace period could be claimed at any stage of the patent-granting procedure or thereafter, for example, during invalidation proceedings."

Article 13: Prior Art Effect of Certain Applications on Novelty

In addition to the text of Article 13 as elaborated by the International Bureau, discussions were based on texts proposed by the Delegations of France and the United States of America. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Principle of 'Whole Contents'] (a) Subject to subparagraph (b), the whole contents of an application ('the former application') as filed in, or with effect for, a Contracting Party shall, for the sole purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party (and not for determining whether that invention involves an inventive step), be considered as prior art from the filing date of the former application to the extent that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent.

(b) Where the former application referred to in subparagraph (a) claims the priority of an earlier application, matter that is contained in both the former application and the earlier application shall be considered as prior art in accordance with subparagraph (a) from the priority date of the former application.

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

(2) [Withdrawn Applications] Notwithstanding paragraph (1), no former application that has been published despite having been withdrawn prior to its publication shall be considered as prior art.

(3) [International Applications Under the PCT] As regards international applications filed under the Patent Cooperation Treaty, any Contracting Party may prescribe that paragraph (1) shall apply only if the acts referred to in Article 22 or, where applicable, Article 39(1) of that Treaty have been performed.

(4) [Self-Collision or Internal Priority] (a) Subject to subparagraph (b), a Contracting Party shall not apply paragraph (1) when the applicant of, or the inventor identified in, the former application, and the applicant of, or the inventor identified in, the application under examination, is one and the same person.

(b) A Contracting Party shall not be bound by subparagraph (a) if it provides for internal priority. Internal priority shall mean that any person who has duly filed an application in, or with effect for, a Contracting Party shall enjoy a right of priority for a subsequent application filed in, or with effect for, the same Contracting Party to the extent that the subsequent application claims the same invention, if that application is filed within a period of 12 months from the filing date of the earlier application, and if neither internal priority nor priority under the Paris Convention for the Protection of Industrial Property has been claimed for the earlier application. The effect of an internal priority validly claimed shall be the same as that of a priority claimed under the said Convention.

(c) Not more than one patent shall be granted on two or more applications to the extent that they claim one and the same invention."

[TEXT PROPOSED BY THE DELEGATION
OF FRANCE]

"(1) (Principle of 'Whole Contents') (a) Subject to subparagraph (b), the whole contents of an application ('the former application') as filed in, or with effect for, a Contracting Party shall, for the sole purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party (and not for determining whether that invention involves an inventive step), be considered prior art from the filing date of the former application, on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent.

(b) and (c)

(2) (Applications No Longer Pending) A prior application that has been published in spite of the fact that it was no longer pending on the date of its publication shall not be considered prior art for the purposes of paragraph (1).

(3)

(4) (Self-Collision or Internal Priority) (a)

(b) A Contracting Party shall not be bound to apply the provisions of subparagraph (a) where it provides for internal priority, under which an application filed in due form in, or with effect in, its territory gives rise to a right of priority for a subsequent application filed in, or with effect in, the same territory, under the same conditions and with the same effects as if the prior application had been filed in another country party to the Paris Convention for the Protection of Industrial Property.

(c)" (Document HL/CE/VIII/16, page 3)

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED STATES OF AMERICA]

"(1) (Principle of 'Whole Contents') (a) Subject to subparagraph (b), the whole contents of an application ('the former application') as filed in, or with effect for, a Contracting Party shall, for the purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party, be considered as prior art from the filing date of the former application to the extent that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent. Any Contracting Party may apply the foregoing whole contents of the former application also for determining whether the invention satisfies the requirement of inventive step (non-obviousness)." (Document HL/CE/VIII/14, page 4)

The portion of the report of the Committee of Experts concerning the discussions of Article 13 reads as follows:

"Paragraph (1)(a). The Delegation of the United States of America introduced its proposal to amend draft paragraph (1)(a) (contained in document HL/CE/VIII/14), explaining that the proposal addressed itself to the question of whether the principle of 'whole contents' of the prior art effect of certain applications should be applied only for the purpose of determining novelty or also for the purpose of determining inventive step (i.e., non-obviousness). The proposed amendment would permit, but not oblige, any Contracting Party to extend the prior art effect of as yet unpublished applications that were later published to the determination of inventive step as well as novelty. This would enable Contracting Parties to avoid granting several patents for inventions that did not differ from each other in a non-obvious way. Because the prior art effect of certain applications would have to be considered, under draft Article 13, from the priority date and not the filing date, this provision would already involve a major change

of the law of the United States of America. It was recalled that the United States Patent and Trademark Office had set the goal of an 18-month pendency for applications. This meant that the search would have to be carried out about six months after the filing in the United States of America, at a time when some foreign priority applications might not yet be on the files. In such cases, it would be necessary to determine how to overcome the difficulty caused by conducting the search on the basis of incomplete files. Since the objective remained to grant valid patents and to avoid double patenting for the same or for similar inventions, all the proposal was intended to accomplish was to permit the United States of America and any other Contracting Party to apply the whole contents of senior applications against junior applications for purposes of determining both novelty and inventive step.

The Delegation of Japan expressed its objection to the proposal by the United States of America. It did not agree that the whole contents principle should be applied for purposes of determining inventive step, since the inventor was not aware of the senior application at the time of filing his application, and, therefore, it was opposed to the proposal even in the form of an option.

The Delegation of Hungary expressed its support for the proposal by the United States of America. It understood that this application of the whole contents approach already existed under the PCT.

The Delegation of the Netherlands was strongly opposed to the proposal by the United States of America inasmuch as it would result in having two groups of countries, one group which would apply the whole contents principle only for purposes of determining novelty and another group which would apply the whole contents principle also for purposes of determining inventive step. Even if an optional provision meant that each Contracting Party was free to apply or not to apply the proposed amendment, applicants who were not nationals of the United States of America but who filed in that country would nonetheless be subject to the law of that country and, therefore, to the application of the whole contents principle for purposes of determining both novelty and inventive step.

The Delegation of Switzerland shared the concerns expressed by the Delegation of the Netherlands to the extent that Swiss nationals filing in the United States of America would be affected by that country's application of the whole contents principle for purposes of determining both novelty and inventive step and, therefore, was opposed to the proposal by the United States of America. In its opinion, it was not fair

for applicants to be subject to this additional criterion of applying the whole contents principle also for purposes of determining inventive step which, as opposed to novelty, involved a much more subjective evaluation and therefore could lead to legal insecurity. It preferred the text of draft paragraph (1).

The Delegation of the United Kingdom was also opposed to the proposal by the United States of America, but stated that it would confer with interested circles in its country regarding this question. It explained that the whole contents principle was a logical consequence of a first-to-file system in order to avoid double patenting. Nonetheless, it resulted in a kind of 'rough justice,' because the junior applicant, in fact, had not been aware of the contents of the senior application which could nonetheless be used under the whole contents principle to destroy the patentability of the invention claimed in his junior application. Applying the whole contents principle for purposes of determining not only novelty but also inventive step would dispense even 'rougher' justice, and, if the United States of America were to apply the principle in that manner, it would mean that it would be more difficult for foreigners to obtain patents in that country.

The Republic of Korea expressed support for draft paragraph (1) as it appeared in the Draft Treaty for the reasons already stated by the Delegation of Japan.

The Delegations of Lebanon, Portugal and Romania expressed their support for the proposal of the United States of America.

The Delegation of Ghana explained that draft paragraph (1) in the Draft Treaty and the proposal by the United States of America represented two different philosophical approaches. Furthermore, if it were optional for Contracting Parties to apply the whole contents principle for the determination of inventive step, this would mean that there would be no harmonization regarding that question. Therefore, it wished to further study the issue raised by the proposal.

The Delegation of the Soviet Union expressed its support for draft paragraph (1) as contained in the Draft Treaty.

The Delegation of Nigeria shared the same concerns expressed by the Delegation of Ghana.

The Delegation of Norway supported the statements already made by the Delegations of the Netherlands, Switzerland and the Soviet Union in opposition to the proposal by the United States of America. It explained that for many years the whole contents principle had been applied in Norway for the purposes of determining both novelty and inventive step, but it had been abolished because applicants, not least of all American applicants, had complained about the practice.

The Delegation of India explained that, under the law of that country, only the claims (not the whole contents) of the earlier application were considered in the novelty examination, but, after acceptance of the application, for opposition purposes, the whole contents of the earlier application were considered both for determining novelty and inventive step.

The Delegation of Canada explained that it wished to reserve its position with respect to draft paragraph (1) and the proposal of the United States of America in order to be able to study this question further.

The Delegation of Denmark shared the views expressed by the Delegation of Norway, as it had had the same experience as that country and, for the same reasons, preferred the text of draft paragraph (1) as contained in the Draft Treaty.

The Delegation of Poland could not accept the proposal of the United States of America. Draft Article 13 represented a new concept in that country. Although it was willing to consider such a provision, it preferred the text of draft paragraph (1) as it appeared in the Draft Treaty.

The Representative of AIPO found both the text of draft paragraph (1), as it appeared in the Draft Treaty, and the proposal of the United States of America confusing and needed time to further study this question.

The Representative of AIPLA recalled that the novelty requirement was applied differently in different countries. In his opinion, if the Draft Treaty did not define novelty in the sense of establishing a standard of the extent to which one invention needed to be different from the prior art in order to be novel, there would not be any harmonization on this question. In light of the uncertainty in this regard, it would be preferable that the United States of America be able to continue applying the whole contents principle for the determination both of novelty and inventive step.

The Representatives of AIPPI, CIPA, CNIPA, EPI, JPA, JPAA, PTIC, UNICE and UEPIP disagreed with the proposal by the United States of America and expressed their support for draft paragraph (1).

The Representative of ABA expressed support for the proposal by the United States of America and wondered how harmonization could be achieved if the Draft Treaty were merely to reflect the European Patent Convention.

The Delegation of the United States of America asked the Committee of Experts to further reflect on the proposal and asked that it be submitted to the Diplomatic Conference for consideration. It noted that the concern for the junior applicant who might not be aware of the senior unpublished application at the time of

filing his junior application applied equally with respect to non-obviousness as it did to novelty. This concern had to be balanced against the much more important concern of avoiding multiple patenting of the same invention. Furthermore, the Delegation raised the possibility that, given the strict novelty standard applied in the United States of America, applying the whole contents principle for purposes of both novelty and inventive step may have the same practical result in that country as applying a broader novelty standard and the whole contents approach only for purposes of determining novelty in other countries. The objective should be to avoid knowingly granting multiple patents for obvious variants of the same invention.

The Chairman concluded that, since delegations seemed divided about the proposal by the United States of America and, among those opposed to the proposal, some might accept it in the spirit of compromise, and since some delegations and organizations wished to further study the question, the proposal should be submitted to the Diplomatic Conference.

Paragraphs (1), (2) and (3). The Delegation of France introduced its proposal (contained in document HL/CE/VIII/16) to amend the said provisions. It explained that the proposal consisted primarily of drafting changes. As regards draft paragraph (1)(a), it was proposed to change the expression 'to the extent' to the expression 'on condition,' and otherwise to leave subparagraphs (b) and (c) as they appeared in document HL/CE/VIII/3. As regards draft paragraph (2), it was proposed to speak of applications 'no longer pending' rather than of 'withdrawn' applications. No proposal of amendment was made with respect to draft paragraph (3).

The Delegation of the United Kingdom agreed with the text of draft paragraph (1)(a), as it considered the term 'to the extent' appropriate insofar as the whole contents principle applied only and to the extent that subject matter in the former application was the same as filed and as subsequently published.

The Delegation of the Netherlands agreed with the text in the proposal by the Delegation of France, pointing out that, if a patent was granted and published before the 18-month publication requirement, the contents of the patent could often be narrower than the contents of the application as filed which might have been published if the patent had been granted after the 18-month publication period.

In this regard, the Chairman noted that, if a patent was granted and published before the 18-month publication period, the entire file had to be made available to the public and it was the

contents of that file that would constitute prior art for purposes of the whole contents principle.

The Delegation of Japan expressed support for the proposal by the Delegation of France.

The Delegation of the United States of America inquired whether reference to the 'former application' in draft paragraph (1)(b) was meant to include a former application for a utility model.

The Representative of AIPLA raised a similar question, as he noted that draft Article 2 (Definitions) provided that references to an 'application' are to be construed as references to an 'application for a patent.'

The Chairman stated that, in light of draft Article 2(vii) which, in accordance with the Paris Convention for the Protection of Industrial Property, provided that priority could be claimed on the basis of an application for a patent, utility model or another title protecting an invention, 'former application' for the purposes of draft Article 13(1)(b) must be understood to include a former application for a utility model.

The Delegation of Japan asked the International Bureau to review the text so that the proposed term 'applications no longer pending' would be used appropriately and correctly wherever applicable, in particular that it would encompass also applications deemed to be withdrawn.

The Delegation of France agreed that the term 'applications no longer pending' was meant to include withdrawn applications, applications deemed to be withdrawn or abandoned, etc.

The Chairman concluded that draft paragraph (1) should be submitted to the Diplomatic Conference in the form of the proposal by France, with the understanding that the proposal by the United States of America regarding draft paragraph (1)(a), already discussed and contained in document HL/CE/VIII/14, would be incorporated as agreed. Draft paragraphs (1)(b) and (c) would remain unchanged. As regards draft paragraph (2), the proposal by France to amend this provision would be submitted to the Diplomatic Conference. Draft paragraph (3) would remain unchanged.

Paragraph (4)(a) and (b). The Delegation of France introduced the proposal by France to amend this provision (contained in document HL/CE/VIII/16), explaining that the proposal consisted primarily of drafting changes of a formal nature. Under the proposal, draft paragraph (4)(a) would remain unchanged and the wording of draft paragraph (4)(b) would be shortened by providing that an internal priority could be claimed under the same conditions and with the same effects as a Paris Convention priority.

The Delegation of the United States of America was opposed to draft paragraph (4)(b),

which would allow a Contracting Party not to provide for an anti-self-collision provision if it provided for internal priority. It did not see why adopting an internal priority provision should exclude any Contracting State from the obligation to provide for an anti-self-collision provision. In its opinion, an internal priority provision was not a substitute solution for dealing with self-collision problems. An internal priority would be effective only during a 12-month period, whereas self-collision could occur during the 18-month publication period. Moreover, by its nature, internal priority was primarily, if not exclusively, used by domestic applicants. Therefore, draft paragraph (4)(a) should be mandatory (i.e., an anti-self-collision provision should be mandatory for all Contracting Parties) and draft paragraph (4)(b) (be it in the form of the draft Article or in the form of the text in the proposal by France) should be deleted.

The Delegation of Japan agreed with the position taken by the Delegation of the United States of America. It was also of the opinion that, even with an internal priority provision, self-collision would not necessarily be avoided. Therefore, it supported the deletion of draft paragraph (4)(b) and the making of draft paragraph (4)(a) mandatory.

The Delegation of the Federal Republic of Germany was opposed to an anti-self-collision provision. It had been willing, in the spirit of compromise, to accept such a provision in an optional form as it appeared in draft paragraph (4)(a) but could not agree to making that provision mandatory. As regards draft paragraph (4)(b), it supported the text in the proposal by France.

The Delegation of Canada shared the concerns expressed by the Delegation of the United States of America: It did not find draft paragraph (4)(b) acceptable and preferred to see a mandatory anti-self-collision provision.

The Delegation of the Netherlands opposed the deletion of draft paragraph (4)(b) regarding internal priority, for the reasons expressed by the Delegation of the Federal Republic of Germany.

The Delegations of Belgium, Italy and Switzerland expressed their support for draft paragraph (4)(b) but with the wording contained in the proposal by France.

In response to an inquiry by the Delegation of Australia about how draft paragraph (4) would be applied in the case of several co-applicants, the Delegation of Japan replied that, for purposes of an anti-self-collision provision, there had to be complete identity of inventorship between the two applications.

The Delegation of the United Kingdom was of the opinion that an anti-self-collision provision was only necessary when the whole contents prin-

ciple was applied for purposes of determining not only novelty but also inventive step. Therefore, it saw no justification for all Contracting Parties having to adopt an anti-self-collision provision and was of the opinion that an internal priority provision was sufficient to avoid double patenting. Furthermore, it did not see how an internal priority discriminated against foreigners, as the latter could always benefit from the 12-month Paris Convention priority period. If an anti-self-collision provision were retained in draft paragraph (4), then it was necessary that it be optional, on the condition that, if the Contracting Party did not apply such a provision, it would provide for internal priority. As regards the wording of the internal priority provision in draft paragraph (4)(b), the Delegation supported the proposal by France.

The Delegation of Lebanon was of the opinion that the entire draft paragraph (4) should be deleted and replaced by a provision stating that these questions were to be left to the national law of each Contracting Party.

The Representative of AIPLA explained that an internal priority seemed to be available only for nationals and that, without an anti-self-collision provision, internal priority would discriminate against foreigners.

The Representative of UNICE was opposed both to draft paragraph (4)(a) on self-collision and draft paragraph (4)(b) on internal priority.

The Representative of PTIC stated that his organization could live with draft paragraph (4)(b) on internal priority but wanted draft paragraph (4)(a) on self-collision to be mandatory.

The Representatives of CIPA, CNIPA and EPI stated that, although they were not opposed to draft paragraph (4)(b) on internal priority and that they could even accept it as a mandatory provision, they considered that draft paragraph (4)(a) on self-collision should be mandatory.

The Representative of AIPPI expressed his support for the flexible approach contained in draft paragraph (4)(a) and (b).

The Representatives of APAA, JPA, JPAA and MPI were of the opinion that draft paragraph (4)(b) on internal priority should be deleted and that draft paragraph (4)(a) on self-collision should be mandatory.

The Chairman stated that two alternative solutions had been advanced. One was to maintain draft paragraph (4)(a) and (b), possibly in the form of the proposal of the Delegation of France. The other was to delete draft paragraph (4)(b) on internal priority and to make draft paragraph (4)(a) on self-collision mandatory. However, in the light of the discussion and the various opinions expressed, especially that by the Delegation of the United Kingdom, the Chairman wondered

whether another compromise solution could not be envisaged to the effect that draft paragraph (4)(a) on self-collision would be mandatory for those Contracting States which would apply the whole contents principle for purposes of determining both novelty and inventive step (in accordance with the proposal by the United States of America regarding paragraph (1) of draft Article 13) and would be optional for those Contracting Parties which would apply the whole contents approach only for determining novelty. As regards the question of internal priority, this question could be taken out of draft Article 13 and could be dealt with independently elsewhere in the Draft Treaty.

The Delegation of Switzerland expressed its support for this last solution suggested by the Chairman, in other words, to make draft paragraph (4)(a) on self-collision mandatory only for those Contracting States which would apply the whole contents principle for purposes of determining both inventive step and novelty and either to delete draft paragraph (4)(b) on internal priority or to deal with this question separately under another provision in the Draft Treaty.

The Delegation in the United Kingdom also expressed support for the second solution suggested by the Chairman. It noted that under the European Patent Convention system, which applied the whole contents principle only for purposes of determining novelty, an anti-self-collision provision had not proved to be necessary.

The Delegation of France also agreed with the second suggestion by the Chairman to make draft paragraph (4)(a) mandatory only for those Contracting States that would apply the whole contents principle for purposes of determining both novelty and inventive step. It noted that, if the United States of America was concerned that a first-to-file system might encourage premature filings, then an anti-self-collision provision would encourage premature filings even more.

The Delegation of the United States of America stated that it had not been convinced that internal priority was an answer to the self-collision problem. An anti-self-collision provision and an internal priority provision addressed separate problems and should be dealt with independently. Therefore, it could not accept that draft paragraph (4)(a) not be mandatory (that is, the words 'subject to subparagraph (b)' should be deleted).

The Delegation of Japan also disagreed with the solution suggested by the Chairman. It was of the opinion that draft paragraph (4)(a) on self-collision should be mandatory in all cases and for all Contracting Parties.

The Delegation of Canada was also of the opinion that draft paragraph (4)(a) on self-collision

sion should be mandatory and did not agree with the second suggestion of the Chairman, but needed more time to reflect on this problem.

The Delegation of the Netherlands supported the second solution suggested by the Chairman. As regards draft paragraph (4)(b) on internal priority, it could agree to its retention in draft paragraph (4), although it would not be opposed to its deletion because it did usually apply to nationals of a given country.

The Delegation of Norway expressed support for the second solution suggested by the Chairman.

The Delegation of the Federal Republic of Germany said that it could accept draft paragraph (4)(a) and (b) or the second solution suggested by the Chairman.

The Representative of LES explained, by giving a practical example, that an anti-self-collision provision was necessary and that, in his opinion, it should be mandatory. As regards draft paragraph (4)(b) on internal priority, it could be deleted or it could be dealt with independently in its own right.

The Representatives of AIPLA and MPI considered that an anti-self-collision provision should be mandatory in all cases and for all Contracting Parties as internal priority did not address itself completely and entirely to the self-collision problem.

The Representative of UNICE was concerned about making draft paragraph (4)(a) on self-collision mandatory.

The Representative of AIPPI recalled that its organization had always been of the opinion that an anti-self-collision provision should be mandatory in all cases and for all Contracting Parties and that it had always taken a position against double patenting. The organization had also always favored internal priority. It therefore agreed that draft paragraph (4)(a) on self-collision should be mandatory, that draft paragraph (4)(c) should be retained and that the question of internal priority should be dealt with but elsewhere in the Draft Treaty.

The Representative of the EPO explained that it did not agree that draft paragraph (4)(a) on self-collision should be mandatory. It had been the EPO's experience that the whole contents principle, as applied by the EPO, had always avoided self-collision problems.

The Representative of PTIC was of the opinion that draft paragraph (4)(a) on self-collision should be mandatory for the reasons expressed by the Delegation of Japan.

The Chairman concluded that certain support had been expressed for the second solution he had suggested (see paragraph 489, above), although a few delegations needed to reflect further on the

question and some opposed it. It was agreed that the solution should be examined by the International Bureau. Consideration could be given to making draft paragraph (4)(a) on self-collision mandatory for those Contracting Parties which would apply the whole contents principle for determining both novelty and inventive step and to introducing a new draft paragraph (4)(b) making an anti-self-collision provision optional for those Contracting Parties which applied the whole contents principle only for determining novelty. The internal priority provision could be taken out of draft Article 13, and it could be considered later whether to include it elsewhere in the Draft Treaty.

The Delegation of Japan introduced its proposal (contained in document HL/CE/VIII/17) to incorporate a reference to internal priority in item (vii) of draft Article 2 (Definitions) and a definition of internal priority in a new item (viibis) in draft Article 2.

After some discussion, and in the light of the agreement by the Committee of Experts that any internal priority provision would be dealt with outside of draft Article 13, it was agreed that the question of whether and how internal priority should be defined would be considered in and with respect to those specific provisions, if any, which would deal with or be applicable to internal priority.

Paragraph (4)(c). The Delegations of the Netherlands and Switzerland were of the opinion that the word 'patent' should be changed to the term 'valid patent.'

The Representative of EPI noted that draft paragraph (4)(c) did not address the question of independent inventors who claimed the same invention in two separate applications but with the same filing or priority date.

The Delegation of Japan considered that the question raised by the Representative of EPI should be left to national law.

It was pointed out that this question could be dealt with in a Note on draft Article 13.

The Delegation of the United Kingdom wondered what 'one and the same invention' meant for purposes of draft paragraph (4)(c) and whether such a provision was at all needed.

The Representative of PTIC was of the opinion that a double patenting provision was needed in connection with an anti-self-collision provision.

The Representative of the EPO was of the opinion that a double patenting provision was not needed when the whole contents principle was applied for purposes of determining novelty, as in such a case it was impossible to grant two patents for the same invention.

The Delegations of Japan and the United States of America noted that double patenting provisions existed in their national laws.

The Delegation of Switzerland explained that a double patenting provision was not necessary under the European Patent Convention. Because it did not contain an anti-self-collision provision, it was not possible to grant two patents for the same invention. However, if an anti-self-collision provision were adopted under the Draft Treaty, then a double patenting provision would be needed, provided that such a provision would only cover identical subject matter claimed in the two applications and not obvious modifications.

The Chairman concluded that consideration should be given to dealing with the question of double patenting in the Notes on draft Article 13. With such an explanation in the Notes and in light of draft paragraphs (4)(a) and (b), it might be considered that a double patenting provision was not necessary in draft Article 13."

Article 14: Amendment of Application

In addition to the text of Article 14 as elaborated by the International Bureau, discussions were based on texts proposed by the Delegations of Japan and the United Kingdom. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Amendments Following Office Findings] Where the Office finds that the application does not comply with the requirements of Article 3(2) or Article 4, the applicant shall be given an opportunity to amend the application.

(2) [Amendments on Applicant's Initiative] The applicant shall have the right to amend, on his own initiative, the description, the drawings, if any, or the claims up to the time when the application is in order for grant or, where applicable under Article [],¹ for publication for the purposes of opposition.

(3) [Limitation of Amendments] No amendment of the application shall go beyond what has been disclosed in the application as filed.

¹ It is intended that reference should be made here to the provision in the Treaty that allows Contracting Parties to make temporary reservations, under certain conditions, to the prohibition of pre-grant opposition contained in Article 18(2) (see document HL/CE/VIII/4)."

[TEXT PROPOSED BY THE DELEGATION OF JAPAN]

"(1) [Amendments Following Office Findings] Where the Office finds that the application does not

comply with the substantive requirements provided for in the Treaty, the applicant shall be given at least one opportunity to amend the application.

(2) [Amendments on Applicant's Initiative] (a) If a Contracting Party requires substantive examination, the applicant shall have at least one opportunity to amend, on his own initiative, the description, the drawings, if any, or the claims up to the time when the substantive examination of the application has started, except during the term that the Contracting Party provides as unreasonable term for amendments.

(b) If a Contracting Party does not require substantive examination, the applicant shall have at least one opportunity to amend, on his own initiative, the description, the drawings, if any, or the claims up to the time when the application is in order for grant.

(3)" (Document HL/CE/VIII/17, page 3)

[TEXT PROPOSED BY THE DELEGATION OF THE UNITED KINGDOM]

"(1) [Deficiencies of the Application] Where the Office finds that an application to which a filing date has been given does not comply with the requirements of the Treaty, the applicant shall be given at least one opportunity to remedy the deficiencies identified and to amend the application.

(2) [Amendment on Applicant's Initiative] (a) If a Contracting Party requires substantive examination of the application, the applicant shall have the right to amend, on his own initiative, the description, the claims and any drawings at least up to the time allowed for the reply to the first substantive communication from the Office.

(b) If a Contracting Party does not require substantive examination of the application, the applicant shall have the right to amend, on his own initiative, the description, the claims and any drawings up to the time when the application is in order for grant.

(3) [Limitation of Amendments] No amendment of the application shall go beyond what has been disclosed in the application as filed." (Document HL/CE/VIII/10, page 8)

The portion of the report of the Committee of Experts concerning the discussion of Article 14 reads as follows:

"The Delegation of the United Kingdom introduced its proposal (document HL/CE/VIII/10), explaining that, although it agreed on the need for such an Article and, in general, on the approach taken by the International Bureau, it felt that draft Article 14 should be slightly amended in some respects. As regards draft paragraph (1), the possibility for an applicant to remedy deficiencies should be generalized so that it be applicable to all the provisions of the Treaty, except in respect of deficiencies related to the filing date requirements. As regards paragraph (2), dealing with amendments on the applicant's initiative, it considered that the text of the International Bureau could be accepted in the case of non-examining Offices where amendments could take place until the patent application was in order for

grant. In contrast, where Offices carried out substantive examination, requests for amendment should not come too late, for instance, after the examination process was finished. In such cases, accordingly, paragraph (2)(a) of the proposal of the United Kingdom proposed that amendments could be made at least up to the time allowed for the reply to the first substantive communication from the Office.

The Delegation of Japan introduced its proposal (document HL/CE/VIII/17), explaining that, as regards draft paragraph (1), it could endorse most of the explanations given by the Delegation of the United Kingdom. The only difference in its proposal was that the possibility of amendments following Office findings was limited to substantive requirements provided for in the Treaty. Although the Delegation was not, in principle, opposed to the possibility of amendments in respect of formal requirements, the Treaty did not contain all the possible formality requirements. If those latter requirements were to be taken into account, it would be preferable to have two concepts, namely, amendments of applications in respect of substantive requirements and corrections of applications in respect of formality requirements. In respect of draft paragraph (2)(a) as proposed by it, the Delegation withdrew the last two lines reading 'except during the term that the Contracting Party provides as unreasonable term for amendments.' This proposal had been made in a similar spirit as the United Kingdom proposal and contained the same distinction between non-examining Offices and examining Offices. The only difference in this latter case concerned the time limit during which the applicant could submit amendments, this time limit being in its proposal the beginning of the substantive examination. It had difficulties with the time limit proposed by the Delegation of the United Kingdom, because it would not be efficient from the point of view of an examining Office, since, if an amendment came to the attention of an examiner after he had issued a first Office action, he would have to issue a new action, this being time-consuming.

Paragraph (1). The Delegation of the United Kingdom said that it had intended to state a general principle and that it was open to the proposal made by the Delegation of Japan if the concept of 'substantive requirements provided for in the Treaty' was considered sufficiently clear.

It was pointed out that the amendments proposed by the Delegations of Japan and the United Kingdom were more advantageous to users than draft paragraph (1). However, the question arose whether the term 'substantive' should be used, which was not easy to define. Therefore,

the text proposed by the Delegation of the United Kingdom appeared to be preferable.

The Delegation of Canada felt that draft paragraph (1) was probably more advantageous to users. The Delegation added that it had difficulties with the notion of substantive requirements as proposed by the Delegation of Japan. It agreed with the notion of 'at least one opportunity' and had no objections against the beginning of the proposal of the United Kingdom. However, it was wondering why there was a reference to the requirements of the Treaty in this latter proposal.

The Delegation of Japan stated that it could accept the proposal of the Delegation of the United Kingdom. However, it proposed that the verb 'to correct' be added after the verb 'to amend.' It stated that it would withdraw its proposal if a majority of delegations supported the proposal of the Delegation of the United Kingdom.

The Delegations of Australia, Austria, the Federal Republic of Germany, Finland, France, Hungary, Ireland, Israel, Madagascar, the Netherlands, New Zealand, Norway, the Republic of Korea, the Soviet Union, Switzerland and the United States of America expressed their support for the proposal put forward by the Delegation of the United Kingdom. The Delegation of Switzerland said that it preferred the notion of 'requirements of the Treaty' to the notion of 'substantive requirements,' since certain conditions which could be considered semi-formal could, in the future, be included in the Treaty.

The Delegation of the United States of America expressed interest in examining further the suggestion made by the Delegation of Canada that the right to amend should not be limited to the requirements of the Treaty. It proposed that draft paragraph (1) also mention the requirements of national laws which may go further than those provided in the Treaty. The Delegation also wished it to be clear that draft paragraph (1) would not require an Office to accord a further opportunity to amend where a subsequent application dealing with the same or similar subject matter was filed. Thus, for example, a second opportunity would not be necessary when an applicant, after having had full opportunity to amend his application, was not satisfied with the decision of the Office and filed a continuation application merely to discuss further the issues. The Delegation considered that this question could be dealt with in the Notes to the Treaty. The Delegation of Norway supported the suggestion made by the Delegation of the United States of America.

The Delegations of Argentina and India expressed their support for draft paragraph (1).

The Representative of AIPLA questioned whether the proposal of the Delegation of the

United Kingdom excluded provisions in national laws which were not covered in the Treaty.

The Delegation of the United Kingdom stated that draft paragraph (1) was limited to specific Articles of the Treaty, while its proposal extended to the requirements of the Treaty. If needed, a new proposal should be studied which would extend paragraph (1) to matters outside the Treaty.

The Representative of the EPO, while expressing his support for the proposal of the Delegation of the United Kingdom, noted that the text implied that the meaning of an invitation by an Office was understood in the same way by all. He wondered whether this could not be made clear in the Notes.

The Representative of AIPO said that he favored the proposal made by the Delegation of the United Kingdom, although he felt that it should be mentioned that the invitation to amend the application should be complied with by the applicant within a certain time limit; if this condition was not fulfilled, the application should be rejected.

It was pointed out that it might be preferable to use the title of draft paragraph (1) with the text proposed by the United Kingdom. The beginning of the proposal by the United Kingdom could be amended so that it could read 'Where the Office finds that an application to which a filing date has been given does not comply with the requirements *applicable to it*,...' It was considered that this suggestion could solve some of the concerns which had been expressed.

The Delegation of Canada supported the suggestions made in the preceding paragraph.

The Chairman noted that there was agreement with the suggestions reported on in paragraph 531, above. With respect to draft paragraph (1), he concluded that the proposal made by the Delegation of Japan had been withdrawn, and that the majority of delegations which had expressed themselves favored the proposal by the United Kingdom. Therefore, this latter proposal should provide the basis of the text of paragraph (1) to be submitted to the Diplomatic Conference, subject to modifications resulting from the suggestions reported on in paragraph 531, above. The Notes should, in particular, also deal with the question of national law requirements.

Paragraph (2). Reference was made to the proposal by the United Kingdom (contained in document HL/CE/VIII/10) and the proposal of Japan (contained in document HL/CE/VIII/17).

The Delegation of Switzerland considered that the possibility for amendment should not be too strictly limited, since the needs of applicants had to be taken into account. Therefore, the Delegation

could accept draft paragraph (2). However, since there could be problems for countries with a substantive examination system, it could also accept, as a second best solution, the text proposed by the Delegation of the United Kingdom. As regards the proposal of the Delegation of Japan, it considered that that proposal was too restrictive since the latter provided for the obligation to make the amendment of the application before the substantive examination had started.

The Delegations of Austria, the Federal Republic of Germany and Finland and the Representative of AIPPI agreed with the statement made by the Delegation of Switzerland.

The Delegation of Belgium said that it had difficulties in accepting paragraph (2), since, in a non-examining Office, amendments could not be checked and this constituted a risk for applicants and gave no security to third parties.

The Delegation of the Republic of Korea stated that it supported the text proposed by the Delegation of Japan.

The Delegations of Australia, Canada, Denmark, India, Israel, the Netherlands, New Zealand, Norway, Romania, the Soviet Union, Sweden and the United States of America expressed their support for the text proposed by the Delegation of the United Kingdom. The Delegation of Israel stated that an applicant who wanted to delete claims should still be able to do so after the time limit fixed in paragraph (2)(a) of the proposal of the Delegation of the United Kingdom. The Delegations of Norway and the Netherlands said that the abandonment of claims was always possible as long as the patent was in force.

The Delegation of the United States of America stated that, as in respect of paragraph (1), the Notes accompanying this paragraph should make it clear that an Office was not required to accord a second opportunity to amend where a subsequent application was filed with respect to the same subject matter as a previous application for which an opportunity to amend had been given (for example, a continuation application filed after an opportunity had already been given to amend the same subject matter in the patent application).

In response to clarifications asked by the Delegation of Japan, the Delegation of the United States of America said that it did not wish to allow an applicant to prolong the procedure after the issues had been fully examined by the Office.

The Delegation of Japan stated that it had difficulties with the approach taken in the proposal of the Delegation of the United Kingdom. It considered that, if an applicant amended the whole subject matter after the first

examination had commenced, the Office would have to carry out a new examination, which would cause delay in the prosecution of the application. The Delegation reserved its position on this matter.

The Representative of ABA said that neither the proposal made by the Delegation of Japan nor the one made by the Delegation of the United Kingdom was advantageous to users; he therefore expressed his preference for the draft Article including the prohibition of extending the disclosure as provided in paragraph (3).

The Representative of AIPLA stated that users were mainly interested in amending the claims in many countries because one Office may reflect a new art, and he wondered whether the proposal of the Delegation of the United Kingdom would enable and facilitate this possibility.

The Delegation of the United Kingdom stated that the concerns of the Representative of AIPLA were dealt with in draft Article 17. The possibility of making amendments was different from the question of a possible limitation of the extent of protection.

The Representative of NYPTC said that the applicant should be able to amend the claims if new prior art was cited in a second substantive communication from the Office, since otherwise he would be forced to file an appeal.

The Representatives of APAA and LES expressed their preference for the text proposed by the International Bureau, since it gave more freedom from the user's standpoint.

The Delegation of the United Kingdom stated that the opportunities for amendments were more important in examining Offices, although problems could arise when the examination was in an advanced stage. Where a second substantive communication came from the Office, paragraph (1) was applicable. The Delegation concluded by stating that its proposal was flexible and had the advantage of setting a clear time frame.

It was pointed out that, if the proposal of the Delegation of the United Kingdom was adopted, paragraphs (1) and (2) should be inverted.

In concluding the discussions on paragraph (2), the Chairman said that the proposal of the Delegation of Japan had not found sufficient support. The draft Article, which gave the largest freedom to applicants, had only been supported by a few delegations. An intermediate approach could be found in the proposal by the Delegation of the United Kingdom which had been supported by a number of delegations. This latter proposal constituted a minimum, and national laws could provide for more freedom than the freedom resulting from the draft Article. In respect of the question relating to a possible second substantive communication by an Office, paragraph (1) was appli-

cable and not paragraph (2), since it was an amendment following Office findings. In the Notes, it could be indicated that the abandonment of a claim was always possible. Paragraphs (1) and (2) could be inverted.

Paragraph (3). The Representative of EPI pointed out that this paragraph might be considered as preventing examining Offices from requiring the insertion of references to prior art, particularly prior art covered by Article 13. The Representative of CIPA suggested that nothing should inhibit or discourage the addition of information as to background or prior art.

It was agreed that this draft paragraph should remain unchanged."

Article 15: Publication of Application

Rule 7: Meaning of Publication

In addition to the text of Article 15 and Rule 7 as elaborated by the International Bureau, discussions were based on texts proposed by the Delegations of Switzerland, the United Kingdom and the United States of America. Those texts read as follows:

Article 15

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

(1) [Requirement to Publish the Application] Subject to paragraphs (2) to (4), the Office shall, without delay after the expiration of 18 months from the filing date or, where priority is claimed, from the priority date, publish the application unless it has been withdrawn, abandoned or rejected.

(2) [Earlier Publication at Applicant's Request] If, before the expiration of the time limit referred to in paragraph (1), the applicant requests that his application be published, the Office shall, without delay after the receipt of the request, publish the application.

(3) [Circumstances in Which Publication Is Not Required] Any Contracting Party shall be free

(i) not to publish an application for reasons of national security;

(ii) not to publish an application if, by the time the application should be published according to paragraphs (1) or (2), a patent granted on the application has been published; or

(iii) to omit from the publication any words or drawings that are contrary to morality or public order or that are disparaging with respect to persons, provided that the fact that words or

drawings have been omitted is referred to in the publication and that a copy of the omitted words or drawings may be obtained from the Office of the Contracting Party on request."

[TEXT PROPOSED BY THE DELEGATION
OF SWITZERLAND]

"(1)

(2)

(3)

(4) [*Circumstances in Which no Publication Shall Take Place*] No application shall be published if it is withdrawn or abandoned, is considered withdrawn or abandoned, or is rejected, before:

- (i) the expiration of 16 months from the filing date or, where priority is claimed, the priority date of the application, or
- (ii) the industrial property office completes the technical preparations for publication, where such preparations are completed after the expiration of the said period of 16 months.

[In view of this addition, the reference to paragraphs (2) to (4) in paragraph (1) should be left unchanged.] (Document HL/CE/VIII/19)

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

"(1) [*Requirement to Publish the Application*] Subject to paragraphs (2) to (4), the Office shall, [as soon as possible after the expiration of 18 months] [not later than 24 months] from the filing date or, where priority is claimed, from the priority date, publish as filed every application which has not been finally withdrawn, abandoned or refused including, in case of amendment of claims, at least the last amended claims filed before the termination of the technical preparations for publication.

(2) No change, except that the words 'without delay' should be changed to 'as soon as possible'.

(3) [*National Security*] Any Contracting Party shall be free not to publish an application for reasons of national security." (Document HL/CE/VIII/10, page 9)

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED STATES OF AMERICA]

"(1)

(2) [*Earlier Publication at Applicant's Request*] If, before the expiration of the time limit referred to in paragraphs (1) or (4), the applicant requests that his application be published, the Office shall, without delay after the receipt of the request, publish the application.

(3)(i)

(ii) not to publish an application if, by the time the application should be published according to paragraphs (1), (2) or (4), a patent granted on the application has been published; or

(iii)

(4) [*Alternative Time Limit for Publication*] Notwithstanding paragraph (1), any Contracting Party shall be free to publish the application, without delay, after the expiration of 24 months from the filing date

or, where priority is claimed, from the priority date." (Document HL/CE/VIII/14, page 5)

Rule 7

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"For the purposes of the Treaty and these Regulations, an application or a patent shall be deemed to be published if paper copies thereof are put at the disposal of any person wishing to obtain them."

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

"At the time of publication the Office shall mention in an official gazette the fact that the application has been published or the patent granted and shall put at least paper copies thereof at the disposal of any person wishing to obtain them.

Note 15.04: the last sentence of this note should be deleted." (Document HL/CE/VIII/10, page 10)

The portion of the report of the Committee of Experts concerning the discussion of Article 15 and Rule 7 reads as follows:

"Three proposals were submitted in respect of Article 15, a proposal from the United Kingdom (contained in document HL/CE/VIII/10), a proposal from the Delegation of the United States of America (contained in document HL/CE/VIII/14) and a proposal from the Delegation of Switzerland (contained in document HL/CE/VIII/19).

Paragraph (1). The Delegation of the United Kingdom introduced its proposal (contained in document HL/CE/VIII/10), indicating that its proposal included four points with respect to paragraph (1).

(a) First, publication of an application should take place 'as soon as possible' after the expiration of 18 months of the filing or priority dates. The Delegation saw the proposal as being similar to draft Article 15(1), but the requirement of publication 'without delay' was seen as being unrealistic in all cases. The United Kingdom Patent Office attempted to publish applications within 18 months of filing or priority dates but circumstances arose at times that made it impossible to do so in all cases. This was seen as being the case, in particular, where, as in accordance with the Draft Treaty, provisions were made for late filing of elements needed to acquire a filing date. In such cases, it was seen as being impossible to expect an Office to conduct searches and finalize an application for publication within an invariable 18-month time period. As an alternative, the time limit of 'not later than 24 months' was suggested.

(b) The Delegation of the United Kingdom indicated that a second aspect of its proposed amendment to paragraph (1) was to provide that the publication be of the 'as filed' materials. The Delegation felt that publishing the 'as filed' materials would be of benefit to third parties in allowing them to see the contents of such materials.

(c) The Delegation of the United Kingdom stated that a third aspect of its proposed amendment was the substitution of the word 'refused' for 'rejected.' The Delegation felt that it was desirable to provide that it was a final situation that was referred to. The Delegation directed attention to Note 15.04 and, in particular, to the last sentence which indicated that an application should be published notwithstanding the fact that it is subject to an appeal, and recommended that this sentence be deleted from the Notes.

(d) The Delegation of the United Kingdom raised a fourth point with respect to its proposed amendment, directing attention to the addition of the phrase 'including, in case of amendment of claims, at least the amended claims filed before the termination of the technical preparations for publication.' The Delegation indicated that it often happens that applicants filed new claims before publication and that it was important that such claims be published since they govern rights after grant.

Several questions were asked concerning the proposal of the Delegation of the United Kingdom. First, it was asked whether the phrase 'as soon as possible' meant that, in certain cases, years could lapse, for example, when proceedings were pending an appeal. Further, it was asked whether the provision of the 24-month time limit in the proposal was an upper limit and whether it could be combined with the 18-month period to read 'as soon as possible after the expiration of 18 months but not later than 24 months.' It was felt that, in the absence of such an upper limit, the significance of the provision would be lost. In addition, it was asked whether the 'as filed' materials would include, for example, all clerical errors, materials in other languages and numerical references to other applications. As to the inclusion of 'at least the last-amended claims' in the publication of the application, it was asked whether this would include both the claims as amended and the claims as originally filed.

The Delegation of the United Kingdom suggested that a 24-month time limit should apply in all circumstances except where the application was subject to an appeal. Further, the Delegation indicated that publication of an application 'as filed' did mean that it would include all clerical errors, numerical references to files and materials in foreign languages. Moreover, it was stated that

the last-amended claims would be published. The Delegation felt that the expense of publication of material provided to an Office after the filing date should be borne by the applicant.

The Chairman pointed out that three main points had been raised with respect to paragraph (1). First, the choice of a qualifying phrase to the time period for publication, such as 'as soon as possible' or 'without delay,' was linked to the choice of 18 or 24 months for such a period. Second, paragraph (1) raised the issue as to the status of an application upon publication, namely, whether publication applied to every application which had not been refused, rejected or withdrawn. Third, whether the Treaty should provide a definition of the contents of an application to be published or whether such contents should be specified in a rule. In this regard, it was noted that the Delegation of the United Kingdom had proposed publication of any amendments or changes entered in an application after the filing date because such amendments may influence subsequent rights, such as provisional protection under draft Article 23, and may affect the prior-art effect of the published application.

The Delegation of Ghana supported the text of draft Article 15.

The Delegation of Lebanon proposed that the time period in paragraph (1) be six months to one year, counted from the filing date, and not from the priority date.

The Delegation of the United States of America presented its proposal (contained in document HL/CE/VIII/14) by indicating that there was significant opposition in the United States of America to providing for a mandatory publication of patent applications. The Delegation further indicated that, at present, in the United States of America, a majority of patent applications were disposed of within 18 months. Accordingly, most of the disclosures contained in patent applications in the United States of America were available to the public within the 18-month time period without publication of applications. The Delegation stated that there was a long tradition of applicants for patents in the United States of America being able to keep technology as trade secrets if no patent protection was available. The Delegation stated that one proposal that had been put forward in the United States of America was to adopt publication of patent applications but allow an applicant to have publication deferred until the prosecution was completed. The Delegation asked whether this was the intent of the 24-month time limit suggested by the Delegation of the United Kingdom. The Delegation also indicated that another approach had been considered by it, providing for publication of those applications for which an applicant intended to file an application

in a country which provided for publication of the application, or for which the applicant had previously filed applications in such countries, as well as of applications which did not include a request that the applications be kept in confidence but, rather, requested accelerated examination.

The Delegation of Hungary indicated that it had sympathy with the proposal made by the Delegation of the United Kingdom but said that there was a desire to identify a precise date of the publication of an application, in particular if the applicant wished to withdraw his application in a timely manner.

The Delegation of the Federal Republic of Germany observed that, although circumstances might arise where an Office could not fulfill its legal obligations, Contracting Parties were bound by the time limit for publication, and excuses such as 'an overload of work' were insufficient.

The Delegation of Japan agreed with the Delegation of the Federal Republic of Germany that derogation from the time limit of publication should be confined to narrowly defined circumstances. It was indicated that the suggested deletion of the last sentence of Note 15.04 gave rise to concern because any such deviation from publication of the application would create great uncertainty among third parties.

The Delegation of Portugal preferred draft Article 15 and expressed the view that the proposal of the Delegation of the United Kingdom raised problems of interpretation if an Office had to publish every application 'as filed,' in particular if an application had been filed in a foreign language. Further, it was felt that the phrase qualifying the time limit by adding 'as soon as possible' would allow applications to be published without an effective time limit.

The Delegation of the Netherlands supported the proposal by the Delegation of the United Kingdom, indicating that the qualifying phrase 'as soon as possible' was in the legislation of the Netherlands and that no problems had been experienced with it. It was indicated that the word 'publication' was interpreted as meaning laying open for public inspection and that the materials to be laid open were those that provided the maximum scope of disclosure. This included any deficiencies in the original filed materials, along with their corrections, and a foreign-language version, if appropriate. The Delegation stated that, in the Netherlands, foreign-language applications were published and printed only upon translation into Dutch.

The Delegation of France supported the principle of early publication of patent applications. As to the time period for publication, it accepted the idea to allow flexibility to countries that have an 18-month period. As to the content of what

was to be published, it agreed that the elements as filed, as well as amendments, should be made available to the public. The Delegation agreed with the suggestion of the United Kingdom.

The Delegation of Israel accepted the proposal by the United Kingdom but had some difficulty with requiring the publication of 'as filed' materials. In particular, when such materials had been filed in a non-official language, their publication might not serve any public interest if the public did not understand the non-official language. The Delegation indicated that an application that is laid open for public inspection should include the application in other languages, if filed.

The Delegations of Canada, Nigeria, Australia and India supported draft Article 15.

The Delegation of Norway expressed sympathy for the remarks made by the Delegation of the Netherlands. The Delegation indicated that files laid open for inspection by the Norwegian Patent Office included materials filed in the original language and translations. Further, it indicated preference for the 18-month term for publication of applications.

The Delegation of Belgium supported the proposal by the Delegation of the United Kingdom.

The Representative of the EPO supported the proposal by the Delegation of the United Kingdom and indicated that it was important to have a clear 18-month time period with limited flexibility. The EPO usually delayed publication of an application for up to four weeks in order to ensure that the search report was published with the application. If the time limit was given a range of 18 to 24 months, this would present great uncertainty to third parties since there would be doubts as to whether one could have confidence that all pertinent applications had been published. The Representative expressed a preference for publication in an official language, even where the originally filed materials were in a non-official language, and laying open the materials 'as filed' for inspection by third parties.

The Delegation of Italy supported the proposal by the Delegation of the United Kingdom, with the exception of the qualifier 'as soon as possible' for the time period for publication.

The Delegation of Spain accepted the proposal by the Delegation of the United Kingdom and expressed itself in favor of an 18-month period as being an appropriate balance between the rights of the applicant and interests of third parties.

The Delegation of Denmark preferred draft Article 15 to the proposal by the Delegation of the United Kingdom. It was indicated that in its country the concept of publication, like that expressed by the Delegation of the Netherlands, was understood as opening the files to public

inspection. In cases where the 'as filed' materials were in a foreign language, the translation into Danish was published. Furthermore, it would be desirable to re-introduce into draft Article 15 the provision of a time limit for last withdrawal of application to avoid publication, as contained in the previous version of the Draft Treaty (draft Article 106(1)(b) in document HL/CE/VII/3 of July 1989).

The Chairman indicated that, with respect to the interpretation of 'publication,' there was no obligation in the Draft Treaty to print anything and that a published application meant an application that is made available to the public. In this regard, the Chairman noted that draft Rule 7 provided that, if paper copies were available, they were put at the disposal of any person wishing to obtain them, which implied allowing making photocopies. The Chairman stated that the minimum contents of a publication were those sufficient to establish a basis for provisional protection and that it was advisable to put such a requirement in a rule.

The Delegation of the United States of America indicated, although there was little support in the United States of America for mandatory publication of the applications and a great deal of resistance, since there appeared to be strong opinions in the Committee in favor of early publication, it wished to propose the alternative formulation that a Contracting Party be free to publish an application after 24 months from the filing or priority date. The Delegation emphasized, however, that the willingness to go forward with the proposal did not imply acceptance of the concept of publication of the application among interested circles in the United States of America. The Delegation thought that, in the United States of America, the vast majority of cases would be decided within 18 months but for some cases this was not possible and mandatory publication would amount to a fundamental change in the patent practice of the United States of America. It was indicated that, if 24-month early publication of patent applications was provided for in United States' patent law, translations of 'as filed' materials would be published where those materials were not in the English language.

The Delegation of Japan wondered whether it was intended that applications on which no final decision had been taken, such as those that were on appeal, need be published at 18 months.

The Delegation of the Federal Republic of Germany expressed concern that flexibility with respect to the publication date would disadvantage third parties who watched publications issued by an Office, because such third parties could not be sure as to their rights at a fixed point in time. The Delegation thought that a fixed term for the publi-

cation date was also important to provide a certain date by which any desired withdrawal of an application must be accomplished.

It was pointed out that a compromise solution could be the following: 'Any Contracting Party which, when it becomes party to the Treaty, does not provide, in its national law, for the publication of applications after 18 months, could, by a declaration notified to the Director General, reserve the right to publish applications without delay after 24 months.' It was underlined that, for those numerous countries which already have 18-month publication, it was not desirable to change the system by allowing them to go to 24 months.

The Representative of AIPO indicated that draft Article 15 was acceptable but that it should, however, be made more flexible by providing for publication of applications 24 months after the filing date.

The Delegation of the United Kingdom indicated a willingness to consider the solution referred to in paragraph 579, above. The Delegation indicated that, in the United Kingdom, the application was published together with the search report. Accordingly, there might be delays of up to several weeks after the 18-month period before such simultaneous publication could take place. This simultaneous publication of the application and the search report was seen as being important to both applicants and to third parties. The Delegation further indicated that there should be reference in the rule to the minimum contents that must be published by being laid open to public inspection. In particular, it had been found that an application as filed should be accompanied by the translation so as to determine the accuracy of the translation and that this should be specified in the rule. The Delegation added that the word 'finally' in its proposed amendment to paragraph (1) should be deleted.

The Representative of ABA indicated that his organization did not support draft Article 15, but had consistently opposed the concept of early publication and supported the safeguarding of the rights of inventors who did not want the invention disclosed unless they were assured of obtaining patent protection. The Representative expressed willingness to consider the proposal referred to in paragraph 579, above.

The Representative of AIPLA endorsed the concept of early publication provided that accelerated proceedings for persons who desire to protect trade secrets were made available by Offices. The Representative stated that, assuming that the United States Patent and Trademark Office could undertake to complete examination within 24 months, his organization could support the proposal of the United States of America. The Representative saw the option of requiring early

publication as providing certain major advantages such as establishing provisional rights and clearly establishing prior art effect of published applications. Therefore, applicants had an interest in early publication to secure these advantages.

The Representative of IPO indicated that there was no consensus within his organization for the concept of publication of applications. The Representative indicated that inventors in the United States of America relied on the the United States Patent and Trademark Office to keep their inventions secret until the issuance of a patent. The Representative indicated that 60,000 applications per year were filed only in the United States of America, without corresponding applications being filed abroad. The applicants filing those applications would be most affected by the adoption, in the United States of America, of a system of compulsory publication of applications.

The Representative of NYPTC indicated that his organization could support publication provided that damages were provided for infringement after publication. If publication occurred after search and an opportunity to withdraw the application was given, and, in the event that the withdrawn application was published anyway by an Office, the applicant would have an opportunity to refile the application.

The Representative of ATRIP emphasized the delicate balance between the protection of trade secrets, on the one hand, and patents, on the other, in the United States of America. The Representative stated that it was important to have the disclosure of inventions through patents and, therefore, to encourage patents to be filed but, to protect trade secrets, one must have the opportunity or the right to withdraw patent applications.

The Representative of FICPI supported the proposal to extend publication from 18 to 24 months and to provide for a flexible compromise as referred to in paragraph 579, above. The Representative stressed that the applicant must have the possibility to withdraw the application before publication.

The Delegation of New Zealand stated that the proposal by the Delegation of the United States of America was of particular interest to New Zealand since New Zealand did not presently provide for early publication.

The Delegation of India indicated that the proposal to allow publication after 24 months was not acceptable because, in their country, publication occurred after a period of examination which could go beyond the 24-month period. The Delegation indicated that, if a system of deferred examination was adopted in India, the proposal would be re-examined.

The Delegation of Switzerland suggested that countries that currently have early publication

should be allowed to publish applications after 24 months. It was indicated that the ideal procedure was that, after the search report was sent to the applicant, he should have two months to decide whether to withdraw the application or to proceed to examination. It was felt that such a procedure was not possible under an 18-month system but that it should be possible under a 24-month system. The Delegation of the Federal Republic of Germany stated that its initial reaction to the solution referred to in paragraph 579, above, was positive, but that that solution deserved further study.

(a) The Delegation of Japan reserved its position on the question of time limits, but indicated a willingness to consider the solution referred to in paragraph 579, above, as being a good basis for a compromise. The Delegation indicated, however, a preference for an 18-month period for the publication of applications.

(b) The Delegation of Japan also expressed concern about Note 15.03 according to which the 'calculation of the 18-month time limit in the case of divisional applications ... [is] left to each Contracting Party to decide.' In the interest of third parties, publication should take place as early as possible; therefore, the starting date should be the filing date of the original or parent application.

The Delegation of the United States of America indicated that such a calculation should be left to the discretion of each Contracting Party.

It was pointed out that the last sentence of Note 15.03 could say that 'the time limit applies possibly to divisional rather than parent applications.'

The Delegation of the United Kingdom indicated that the said note also referred to applications claiming multiple priorities and asked whether the filing date of such applications would be the filing date of the earliest application.

It was pointed out that there was not a difficult problem where a parent application was withdrawn and not published; the divisional application then would have the date of priority of the parent application.

The Representative of JPA indicated that, in the case of derived applications, the publication date should be calculated from the original filing date of the parent application since they enjoy privileges associated with that original filing date.

On the basis of a summary of the discussions by the Chairman, it was agreed that a clear definition of the contents of an application to be published was desired. It was agreed that the drafting of such a definition could be left to the International Bureau. As to the manner in which publication takes place, subject to the conclusions concerning Rule 7, it was agreed that there was

no requirement to print a document in order to accomplish publication, and that it was sufficient to place a document at the disposal of the public and to provide paper copies to those who required them. The question of when publication was to take place was open. One possibility was to provide for a time limit of 18 months with the possibility of extending it to 24 months. Another possibility was to maintain 18 months as the basic rule and to provide a facility, for Contracting Parties that have not yet established the publication of patent applications, to publish applications at the end of 24 months. It was also agreed that the International Bureau of WIPO would undertake a study on the determination of filing dates in the case of divisional applications, applications for continuation-in-part and applications claiming multiple priorities.

Paragraph (2). The Delegation of the United Kingdom introduced its proposal (contained in document HL/CE/VIII/10) by indicating that, as in the case of *ex officio* publication, publication at the applicant's request should be effected 'as soon as possible' and not 'without delay.' The Delegation indicated that, as stated with respect to the corresponding proposal with respect to paragraph (1), the language 'without delay' may be interpreted too strictly so as not to allow Offices sufficient time for the technical preparations necessary to publish an application. In addition, with respect to practice in the United Kingdom, a search report was issued simultaneously with publication and the preparation of the search report would necessarily delay the publication of the application in cases where a request for early publication was made soon after filing. The Delegation indicated that the intention in introducing the proposal was not to allow a delay any longer than was necessary to provide the applicant time to consider his position upon receipt of the search report.

The Delegation of Portugal indicated that there was no reason to change the language as contained in draft Article 15(2) because the phrase 'without delay' allowed for a certain flexibility which would cover the situations envisaged by the Delegation of the United Kingdom.

The Delegation of Cameroon indicated a preference for the phrase 'without delay' but could accept it being replaced with the phrase 'within the shortest time possible.'

It was pointed out that such a phrase would, in effect, be the same as the proposal by the Delegation of the United Kingdom. Such a phrase would imply that an Office could wait until a term of years had passed, claiming, for example, budgetary problems that prevented publication.

The Delegation of Japan supported draft Article 15(2). Further, the Delegation supported

the intervention by the Delegation of Portugal and indicated that one should be flexible in setting a time limit in order to accommodate delays for technical preparations and for cases in which the completion of the formality examination takes a substantial amount of time.

The Delegation of the Netherlands indicated that the phrase 'as soon as possible' was provided for in its national legislation and that the phrase was interpreted in the sense of 'without delay,' as had been discussed by the Committee. The Delegation agreed that, if the applicant requested earlier publication, he should not be obliged to await for a search report but that publication of the application should be accomplished promptly.

The Delegation of Canada indicated its support for the phrase 'without delay,' but could also accept the phrase 'as soon as possible.' The Delegation of Denmark supported the position taken by the Delegation of Canada.

The Delegation of Ghana recalled discussions on this issue that had occurred during the seventh session of the Committee of Experts and expressed its preference for the word 'promptly' over the word 'without delay' or 'as soon as possible.' The Delegation also expressed itself in favor of Article 15 providing for publication after 18 months, but not later than 24 months.

The Delegation of the United Kingdom stated that it could accept the phrase 'without delay' but that it requested clarification in the Notes on Article 15 that the Treaty did not require publication of an application on the day following the request by an applicant, but that a few days must be given to allow completion of the technical requirements necessary for publication in the gazette.

The Delegation of Italy indicated its support for draft Article 15(2).

The Chairman observed that it was easier to choose an appropriate qualifying phrase than to determine the proper interpretation of such a phrase. He concluded that draft Article 15(2) would remain unchanged and that the necessary explanations concerning its interpretation should be given in the Notes.

Paragraph (3). The Delegation of the United Kingdom introduced its proposal (contained in document HL/CE/VIII/10) by indicating that it called for the retention of subparagraph (i) of paragraph (3), with the deletion of subparagraphs (ii) and (iii). With respect to subparagraph (ii), the Delegation indicated that from discussions in the Committee it was clear that publication did not require printing. It was felt, therefore, that the application should be published, that is, laid open for inspection, even where the patent is granted before the time limit for publication of the appli-

caution. With respect to subparagraph (iii), the Delegation objected to the second half of that subparagraph because, if an application contained words that disparaged someone, the provision of a copy of those words would constitute a repetition of the libel by the Office.

The Delegation of the Netherlands welcomed the proposal by the Delegation of the United Kingdom but recommended that the word 'national' be deleted from the phrase 'national security.'

The Delegation of Norway supported the proposal by the Delegation of the United Kingdom and the suggestion by the Delegation of the Netherlands.

It was pointed out that the suggested deletion of the word 'national' from the phrase 'national security' would make the provision too broad since any kind of security could be understood to be included.

The Delegation of the United States of America stated, with respect to the suggestion by the Delegation of the Netherlands, that it had some hesitation in deleting the word 'national' from the phrase 'national security' because the phrase had a well-understood meaning in international agreements and the adoption simply of the word 'security' could lead to possible abuse. With respect to the proposal by the Delegation of the United Kingdom to delete subparagraphs (ii) and (iii), the Delegation doubted the necessity for such a deletion. As to subparagraph (ii), if the patent is granted, the file is open to the public, and the application, as filed, can be inspected. As to the deletion of subparagraph (iii), the position of the Delegation was dependent on the final meaning of 'publication.'

It was pointed out that the proposal by the Delegation of the United Kingdom assumed that patents were published and that publication meant 'laying open to public inspection.' However, so far there was no provision in the Treaty that provided that the whole file of an application was to be laid open to public inspection upon issuance of a patent.

The Delegation of Israel indicated that inspection of a file was important for the purposes of litigation, in particular in determining the validity of the patent. The Delegation felt that there should be such a provision in the Treaty.

The Representative of the EPO supported the deletion of subparagraph (ii) to avoid double publication. The Representative stated that, if the patent had been issued, one needed to provide for inspection of the file. If a definition of publication was provided, then the provision of subparagraph (ii) could be deleted.

On the basis of a summary of the discussions by the Chairman it was agreed that the substance

of subparagraph (i) would be kept as it appeared in draft Article 15(3)(i). With respect to subparagraph (ii), the question arose whether this provision was not superfluous since, if a patent was granted and published by the date for publication of the application, the initial text of the application would be available in the file. It was agreed that draft Article 15(3)(ii) should probably be deleted and that draft Article 15(3)(iii) could be deleted, subject to appropriate explanations in the Notes.

New Paragraph (4). The Delegation of Switzerland introduced its proposal for a new paragraph (4) (contained in document HL/CE/VIII/19) by indicating that, in the previous draft of the Treaty, in Article 106(1)(b) (contained in document HL/CE/VII/3), it was explicitly provided that no application should be published if it was withdrawn or abandoned within a specific time period. This was felt important to enable an applicant to know the date by which he must withdraw his application in order to prevent its novelty from being destroyed by publication.

The Delegation of Denmark supported the proposal by the Delegation of Switzerland.

The Delegation of Norway supported the proposal by the Delegation of Switzerland and, further, asked if it could be placed in a Note that such a provision applied, *mutatis mutandis*, to withdrawal of a priority claim.

The Delegation of the United States of America requested that the period of 16 months be adjusted for those countries that accept the facility of publishing applications at 24 months. With that modification, it could support paragraph (4)(i). With respect to paragraph (4)(ii), however, the Delegation indicated some hesitation as it was not quite certain of the meaning of 'completes the technical preparations for publication.'

The Delegation of Switzerland indicated that the provision was to allow withdrawal of an application and stop its publication at the latest time that the publication could be stopped without undue effort by the Office.

The Chairman observed that subparagraph (i) of the Swiss proposal guaranteed a certain date for applicants to stop publication of an application through withdrawal, but that, under the terms of subparagraph (ii), an Office would be allowed to go beyond those minimum requirements if it could still stop the technical preparations for publication.

The Delegation of the United States of America indicated that, with that clarification, it would have no difficulty accepting subparagraph (ii).

The Delegation of Japan could not accept the proposal by the Delegation of Switzerland as the

time periods were too short and suggested a period of 15 months, stating that after that time it was too late to stop the technical preparations for publication.

The Delegation of the United Kingdom agreed in principle with the proposal by the Delegation of Switzerland, but suggested that it was unwise to have the time limit of 16 months specified in the Article and suggested that it be placed in the Rule. Secondly, the Delegation indicated that an applicant's request for early publication should be understood as rendering inapplicable the 16-month period for withdrawal.

The Representative of the EPO agreed, in principle, with the proposal by the Delegation of Switzerland and indicated that the EPO had a system of technical preparations for publication which allowed the stopping of publication of an application 10 weeks before the 18-month publication date. The Delegation agreed with the Delegation of the United Kingdom that the details concerning the time period should be placed in the Draft Regulations.

The Delegation of Portugal agreed in principle with the proposal by the Delegation of Switzerland and recommended a reorganization of Article 15 to place paragraph (4), proposed by Switzerland, before the existing paragraph (3).

The Representative of AIPLA indicated that the idea of having a fixed period for withdrawal of an application was attractive to users. It was suggested that, in contemplating the 18 or 24-month period for early publication, the provisions in paragraph (4) could be adjusted by providing that they apply two months prior to the prescribed date of publication.

The Representatives of AIPPI, BDI, JPAA and UNICE supported the proposal by the Delegation of Switzerland.

The Representative of FICPI supported the proposal by the Delegation of Switzerland emphasizing that legal security was important to applicants. It was further stated that the harmonization of such a time period, rather than the length of the time period itself, was paramount.

The Representative of ATRIP indicated that it was important to have a definition of withdrawn, abandoned or rejected for the application of this Article.

The Representative of ABA indicated that the 16-month period was a minimum and that any shorter period would reduce the value of withdrawing an application.

The Representative of NYPTC supported the proposal by the Delegation of Switzerland as it was important to fix the time, on an international basis, for the withdrawal of applications. It was also emphasized that in the case of an inadvertent publication by an Office, an applicant should

be given an opportunity to reinstate the application.

The Delegations of France, Sweden, Australia, the Soviet Union, Argentina, Canada, Italy and the Netherlands supported the proposal by Switzerland.

The Chairman concluded that, in principle, the proposal by the Delegation of Switzerland had been accepted. The proposal would not apply when early publication was effected before the 18-month time limit at the applicant's request. In respect of countries that would apply the extended time limit of 24 months, the 16 months provided for in the Swiss proposal had to be replaced by 22 months. It should be examined whether the time period should be in a Rule rather than in the Article.

Rule 7: Meaning of Publication

The Delegation of the United Kingdom introduced its proposal (contained in document HL/CE/VIII/10) by indicating that, with respect to putting paper copies at the disposal of persons requesting them, it was in agreement with the provision in draft Rule 7. The Delegation indicated, further, that its proposal required providing 'mention' in an official gazette of the fact that the application had been published or the patent granted. This provision was provided to give interested parties information as to the fact that an application had been published. The Delegation's proposal was related to the means of publication rather than the meaning of publication. As to the latter, the Delegation indicated its support for the Swedish proposal, relating to the definition of 'published' in Article 2, which stated that 'published' means that 'the application or the patent is available to the public.' This was seen as not being limited to printing paper copies, although however publication was accomplished, the person desiring copies in paper should be able to obtain them.

It was pointed out that the word 'print' was not used in relation to a definition of 'published.' If mention or notice was to be made of an application being published or a patent granted, it would have to be determined what information should be contained in that notice. This could be fixed, for example, in the Administrative Instructions and should include the serial number of the application, the name of the applicant, the name of the inventor, the title of the invention, the classification symbol, the date of filing, the date of priority and the date of publication.

The Delegation of the United Kingdom indicated that the contents of the publication in the gazette should be sufficient so that adequate searching could be accomplished.

The Delegation of the Netherlands supported the proposal of the Delegation of the United Kingdom and agreed that it was important to determine, if notice of a publication was to be made in the gazette, what that notice should include. The requirement of providing 'paper copies' should be placed in the rules so that it could be changed at a later date as technology evolves.

The Delegation of the Federal Republic of Germany supported the proposal made by the Delegation of the United Kingdom, especially with respect to notice in an official gazette of the publication of an application or a patent. It was emphasized that notice in an official gazette had to give access to the fact that publication has taken place. The normal way of assessing a competitor's position was not just to order a particular class of applications or patents but was normally done by reading the gazette. Such a gazette publication should include the drawings and the abstract.

The Delegation of Canada supported draft Rule 7 as being more flexible and less restrictive than the proposal by the United Kingdom. The Delegation was opposed to providing a list of items to be mentioned in the official gazette.

The Delegation of Portugal felt that the proposal by the United Kingdom was implicit in draft Rule 7 and thought it desirable to consider the minimum elements to be mentioned in the gazette, such as the title of the application or patent, the names of inventors, and the number of the patent or application.

The Delegations of Hungary and the Soviet Union supported the proposal by the United Kingdom and indicated that the contents of the gazette should be left to national legislation.

The Delegation of Japan supported the proposal by the United Kingdom and felt that the requirement as what is to be published in the official gazette should be as flexible as possible. Examples of such requirements could be given in the Notes. The term 'paper copies' was too restrictive, and the Treaty and the Regulations should not preclude the issuance of CD-ROMS in the future. If a person wanted paper copies from the CD-ROMS, such copies could be made.

The Delegations of the United States of America and Denmark expressed sympathy for the proposal by the United Kingdom and indicated that the mere mention of the fact of the publication in a gazette without additional information was not helpful; publication of the international classification of a particular application or patent would be a minimum requirement.

The Delegation of India supported the proposal by the United Kingdom because the official gazette publication would amount to constructive

notice of the existence of an application or a patent.

The Delegation of Belgium supported the proposal by the United Kingdom and indicated that its Office made paper copies available to those who wanted them.

The Representative of the EPO supported the proposal by the Delegation of the United Kingdom and indicated that the indication of details of the manner of the publication in the official gazette was desirable but that it was not appropriate to overload either the Treaty or the Regulations with such provisions. Perhaps the Assembly established under the Treaty could provide guidelines with respect to this matter.

The Representative of AIPO indicated that the definition of 'publication' in draft Rule 7 was consistent with the relevant legislation pertaining to his organization. Neither the form nor the elements of publication in the gazette should be restricted in the Regulations.

The Delegation of Switzerland supported the proposal by the Delegation of the United Kingdom and agreed with the suggestion of the Representative of the EPO.

It was pointed out that the proposal by the Delegation of the United Kingdom presupposed that the proposal by the Delegation of Sweden, relating to the definition of publication in Article 2, had been adopted.

The Representatives of NYPTC, ATRIP and ABA indicated the desirability of publication of sufficient information concerning the patent or application to allow creation of an index to facilitate searching.

The Representative of AIPPI supported the proposal by the Delegation of the United Kingdom.

On the basis of the summary of the discussions by the Chairman, it was agreed that publication should be defined as making available to the public, that draft Rule 7 should provide that publication required that at least paper copies be made available on request, and that there should be a notice of the publication in a gazette. Consideration should be given to whether the minimum contents of such a notice should be specified in the explanatory Notes, in a rule or in future Administrative Instructions to be drawn up by the Assembly."

Article 16: Time Limits for Search and Substantive Examination

The discussions were based on the text of Article 16 as elaborated by the International Bureau. This text read as follows:

"(1) [Time Limits for Search] (a) If a Contracting Party requires substantive examina-

tion, its Office shall publish, together with the publication of the application under Article 15, a report, established by or on behalf of that Office, citing any documents that reflect the prior art relevant to the invention claimed in the application (hereinafter referred to as 'the search report').

(b) Notwithstanding subparagraph (a), where Article 15(2) applies, the publication of the search report need not accompany the publication of the application, provided that the publication of the search report shall be effected as soon as possible, but not later than the expiration of 18 months from the filing date or, where priority is claimed, the priority date of the application.

(c) If, notwithstanding subparagraphs (a) and (b), for any exceptional reason, the publication of the search report cannot be effected as provided for in those subparagraphs, the search report shall be published as soon as possible and in no case later than the expiration of 24 months from the filing date or, where priority is claimed, the priority date of the application.

(2) [Time Limits for Substantive Examination]

(a) If a Contracting Party requires substantive examination, its Office shall start the substantive examination of the application not later than three years from the filing date of the application.

(b) Notwithstanding subparagraph (a), a Contracting Party may provide that no substantive examination shall be carried out and the application shall be rejected if a request is not made, within three years from the filing date of the application, to its Office by the applicant or any third party that substantive examination should start. Where such a request is made, the Office shall start the substantive examination promptly after receipt of the request.

(c) The Office shall, wherever possible, reach a final decision on the application not later than two years after the start of substantive examination."

The portion of the report of the Committee of Experts concerning the discussion of Article 16 reads as follows:

"The Delegation of Israel indicated that it had a problem with the publication of an application with the search report, as it did not provide for a split between search and examination and it felt that there was no possibility for the search report to be available within the time periods prescribed in Article 16. It suggested, therefore, the possibility of making a reservation with respect to Article 16 by Contracting Parties that did not prepare a separate search report.

The Delegation of Austria indicated that it was against time limits for search reports or comple-

tion of substantive examination. It felt that it could be faced with unpredictable situations such as heavy application loads, not enough examiners, and would, therefore, be forced to violate Treaty obligations. Since such conditions were beyond the control of the Office, it recommended deleting the provision.

The Delegation of the United States of America indicated that Article 16 was one of the most important Articles in the Treaty, since the objective of time limits for processing applications was to ensure that protection was granted as expeditiously as possible and the remaining provisions in the Treaty might be considered of little effect if no such protection was granted. Furthermore, the commencement of the patent term from the filing date meant that slow and inefficient processing reduced the length of the term of protection available. Without time limits there was a risk that Patent Offices would be submerged in applications, rendering the patent system inoperative and the patent system would be brought into disrespect. The Delegation indicated it was time for the Committee to address this issue and indicated that the difficulty in obtaining examiners or other such reasons were insufficient excuses. The Patent and Trademark Office of the United States of America practiced unitary examination and search, but could accept the provision of simultaneous publication of an application and search report since the search results could be extracted and published in the required time period.

The Delegation of Argentina indicated that it may be necessary to extend the time period for completing the search report to 24 months.

The Delegation of Australia opposed the inclusion of Article 16 in the Treaty, indicating that, while the Article did not require the separation of search and examination, it was likely that such a separation would result for countries, like Australia, that had a deferred examination system. The Delegation raised four points with respect to Article 16. Firstly, there would be problems for Offices because the separation of search and examination would be resource-intensive, resulting in an increasing backlog of applications. Thus, it was possible that Offices could be in breach of the Treaty by being unable to comply with the time limits due to circumstances beyond their control. Secondly, the Delegation acknowledged that an early search report may provide advantages for applicants and third parties, but that it considered that the benefit was not justified by the extra resources required. Thirdly, the Delegation was of the opinion that the deferred examination system offered advantages to both applicants and Offices. Applicants had time to consider whether they wanted to proceed with the applica-

tion after evaluating the economic implications of the invention. Offices did not have to examine applications with which an applicant might decide not to proceed, and the filing fee could thus be kept relatively low. Fourthly, the requirement that all Contracting Parties publish a search report at 18 months was seen by the Delegation as leading to a great deal of duplication. Overlapping searches might be undertaken by many Contracting Parties and no Contracting Party would have the benefit of the search of another Contracting Party, prior to publishing its own search report.

The Delegation of Romania indicated that it was not possible for its Office to publish search reports at the date of publication of the application. The Delegation felt that simultaneous publication would be possible only for large Patent Offices that had special groups that conduct the searching.

The Delegation of Japan opposed the inclusion of Article 16 in the Treaty, citing the report of the seventh session of the Committee of Experts as giving the reasons thereof. The Treaty should not require Contracting Parties to do something that was beyond their control. In particular, the time required to conduct search and examination of patent applications was subject to the number of applications which, in turn, were subject to business trends and changes in business climate.

The Delegations of the Republic of Korea and the Soviet Union recommended the deletion of draft Article 16.

The Delegation of the Federal Republic of Germany stated that it had serious problems with draft Article 16 and that it was not in a position to accept that Article in view of its organizational and financial implications. It added that the existing procedure in the German Patent Office was not consistent with the said draft Article. It was the view of the Delegation that the separation of search and examination imposed obligations on the Contracting Party to have a separate search, even with a deferred examination system. In addition, it would promote the repetition of searches all over the world; this was not seen as being in the interests of applicants. As to the deferred examination system, it was seen as providing a balance of the needs of speedy examination and the needs of applicants, examination taking place only if there was clear interest. Further, such a system decreased the work load on an Office. The effects of rigorous time limits were seen as loss of quality during examination and search because an examiner would have to rush decisions on examination in order to comply with the time limits.

The Delegation of Canada was not opposed to setting time limits *per se*, but was opposed to the

specific limits provided within draft Article 16. It was felt that simultaneous publication of search reports was too demanding and could not be met by many Offices.

The Delegation of India urged the deletion of draft Article 16 because in India search and substantive examination were carried out simultaneously, within specified time limits. Publication of a search report was prohibited under Indian law, more so because of the interest of the applicant.

The Delegation of Brazil indicated that it would be difficult to comply with the time limits as proposed because a search report was not available before a request for examination was made. It was felt that adhering to the requirements of Article 16 would affect the quality of the system, because conducting a quality examination requires time. Moreover, the Delegation indicated that, in Brazil, government policy was to cut back on personnel, not to hire more and that, therefore, there would be no possibility of complying with the requirements of the Article.

The Delegation of the Netherlands called for the deletion of draft Article 16 because the Article was hostile to the system of deferred examination and would require it to abolish this essential element of its patent system. In a patent system with backlogs, such a provision would not solve the problem.

The Delegation of Ghana felt that, without time limits, some Patent Offices would collapse under their backlog, citing conclusions drawn in the seventh session of the Committee of Experts. The Delegation felt that time limits should be in the Treaty.

The Delegation of China indicated its opposition to the inclusion of Article 16 in the Treaty because it felt that, even if the number and the quality of examiners were good, the time required for examination depended on the cooperation between the examiner and the applicants.

The Delegation of Norway indicated that it had great problems with draft Article 16, but that it could manage to comply with the requirements of Article 16 with respect to those applications not claiming Convention priority. Further, it was felt that the problems of duplication of effort could be solved if work was shared between Patent Offices. It was felt that the requirement of publishing a search report 'established by or on behalf of' an Office meant that the published search report of the PCT would fulfill obligations under the Article.

The Delegation of Switzerland indicated that it had no problems with paragraph (1). As to paragraph (2), it agreed in principle that patents should be granted within a reasonable time, which would not be the case if an applicant was not

interested in the grant of a patent, but wanted time to test the invention before bearing the costs of examination. The interests of third parties should be considered, and a system should be established whereby early publication of an application takes place and the applicant and third parties have the right to request examination at any time thereafter.

The Delegation of the United Kingdom indicated that it had sympathy with the aims of the Article and was not happy with systems having extensive deferred examination. It was important to complete search and examination quickly, thereby avoiding uncertainty in the minds of both applicants and third parties as to the scope of protection. The Delegation indicated that it had no problem with paragraph (1) and that it was an excellent idea to provide the applicant with a search report before publication. In deferred examination systems, third parties should have the right to request examination at little or no cost.

The Delegation of Italy supported the proposal by the Delegation of Switzerland with regard to deferred examination that third parties should have the right to request examination.

The Delegation of Spain, in view of problems in recruiting examiners and the increase in applications, indicated a preference for not having time limits for search and examination. Therefore, draft Article 16 should be deleted.

The Delegation of Nigeria felt that the inclusion of Article 16 was not beneficial to developing countries, especially those starting substantive examination systems, and favored deletion of the Article.

The Delegation of Portugal indicated that, if it were difficult to comply with the time limit provisions, it may prove to be a disincentive to countries considering adhering to the Treaty. Two possible solutions were suggested. Firstly, draft Article 16 could be made optional or, secondly, the provisions of draft Article 16 could be transferred to the explanatory Notes to Article 15.

The Delegation of Sweden supported draft Article 16 and had no problem with the time limits.

The Delegation of Denmark indicated its strong support for draft Article 16, stating that it was necessary to reform the patent system to do away with excessive delays. It was seen, in particular, as being advantageous to third parties to know as quickly as possible their status vis-à-vis patent applications. The Delegation did not support the suggestion by the Delegation of Norway that the Article be limited to applications not claiming priority, since in many countries the number of applications filed by foreigners was much higher than applications filed by nationals.

The Delegation of Swaziland indicated that it could not support draft Article 16 because of a lack of resources. It indicated that Swaziland was a member of ARIPO because it could not complete its tasks without assistance with respect to examination of patent applications.

The Delegation of Poland indicated a preference for deleting draft Article 16 because it found it difficult to accept providing for a separate search report since, in its Office, search was an integral part of examination.

The Delegation of Ghana indicated that for those countries which would find it difficult to comply with the provisions of draft Article 16, the services of the PCT or ARIPO could be used to accomplish their obligations to provide a search report.

The Delegation of France expressed sympathy for the position taken by the Delegation of Norway. It was further felt that, when a search report was provided to an applicant, such a report could be provided to other Offices in other countries. As to substantive examination, the Delegation sympathized with the time limit, in principle, but stated that other options should be provided for in cases where an applicant desires a speedy examination or where the applicant wants examination deferred. Furthermore, it was felt that any third party should be allowed to request the start of the examination.

The Representative of AIPLA stressed the importance of having an early clarification of rights to enable both applicants and third parties to determine what they would have the right to do. The specific time periods could be discussed. As to the effect of the Article on the quality of searches and examinations, the Representative stated that the longer the examination was delayed, the greater the possibility that the person who originally wrote the application, and would be in the best position to prosecute it, would no longer be available. In the absence of that person, the quality of the prosecution would necessarily suffer. As to the problems of Offices with meeting staffing requirements and complying with time periods, it was suggested that greater cooperation with other Offices be pursued.

The Representative of BDI, while recognizing the objectives of the Article, was not happy with the way in which it was written. In particular, with respect to draft paragraph (2), it was felt unnecessary to do away with deferred examination and, with respect to draft paragraph (2)(c), the requirement that substantive examination be completed within two years from its start would lower the quality of examination.

The Representative of AIPO indicated that the effect of draft Article 16 with respect to the existing legislation of his organization would have to be considered.

The Representative of ABA emphasized the importance of setting standards in this area, in order to give certainty to both applicants and third parties as to their rights.

The Representative of NYPTC supported the provisions of Article 16 as providing a benefit to both applicants and third parties. The Representative suggested that it be established that an application be searched within 18 months and the search report published, if it was requested by the applicant and the appropriate fee paid. If not, then no search report would be provided and the applicant would not be accorded the benefit of provisional protection for his published application.

The Representative of LES indicated that it was difficult to consider the provisions of Article 16 outside the provisions relating to the term of patent protection because, to the extent that examination was delayed, the period of protection was reduced.

The Delegation of IPO emphasized the need for a reasonable time for substantive examination to be completed. As to the problem some countries may have in complying with the requirements of draft Article 16, it was stated that excellent searching facilities exist in major countries and that there should be a way of making such facilities available to other countries. It was stated that if applicants desired to establish provisional protection, they could request searches themselves and pay the fees.

The Delegation of the United States of America emphasized the obligation incumbent upon Patent Offices to address the problem of failing to give prompt protection to inventions. It was stated that the Draft Treaty would require fundamental changes to the patent system of the United States of America but that, in the absence of draft Article 16, it would be difficult to obtain sufficient support in the United States of America for acceptance of the Treaty.

The Representative of AIPPI supported draft Article 16 in principle, as well as the desirability of allowing third parties to request examination at any time. The Representative emphasized international cooperation to assist countries in conducting searches by providing information on searches conducted in other Offices.

It was pointed out that international searching authorities under the PCT had undertaken to prepare search reports within the period of time suggested in Article 16 and, on the basis of those precedents, it was felt that Contracting Parties should be able to comply with the provisions of Article 16. As to the arguments that complying with specific time periods would increase costs to an Office, it was stated that appropriate fees had to be charged and that savings would not result from delaying what had to be done. With respect

to the burden of searching, it was stated that applicants could be required, even outside the PCT, to produce the results of searches conducted elsewhere. As to the position that the quality of searching required a longer term than provided in the draft Article it was pointed out that the search was not the end of the procedure for the grant of a patent, but was followed by examination, for which three years were normally provided. It was emphasized in this regard that draft paragraph (2)(c) provided that a final decision should be reached 'wherever possible' within two years of the start of substantive examination. The time period provided under Article 16 for search and examination was altogether five years, that is, as much as one quarter of the minimum life span of the patent under the Draft Treaty. With respect to the sharing of search results, it was stated that national legislation was free to require the sharing of the results of searching in the country of origin. It was indicated that, with respect to practice in the smaller and medium-sized countries, they can have, even outside the PCT, access to results of previously conducted searches for a large percentage of applications in their Offices.

The Delegation of Ghana emphasized that the longer the period of time taken for examination, the shorter the time for the patent to run. With respect to search and examination, it was felt that, since users had to pay for the services, there should be no problem in an Office providing the personnel and facilities to accomplish the job in a timely fashion.

The Representative of the EPO stated that the EPC demonstrated that a system such as mandated in Article 16 works. The Representative stated that prosecution of patent applications within a reasonable period of time is in the interests of applicants and third parties. There were ways and means to speed up the grant, such as using a fee system. Further, cooperation among examining Offices should be encouraged.

The Delegation of Japan indicated that concessions to achieve harmonization had been made by Japan but it was felt that Japan could not accept Article 16, as the Article provided for something that the Delegation could not guarantee could be complied with. It pointed out that the time limit provided for in the PCT was limited to search, and that Article 65 of the PCT offered the safeguard against not being able to keep the time limit.

The Delegation of the United Kingdom supported the principle of early examination and stated that the United Kingdom was one of the few countries that put time limits on examination. The Delegation felt that some countries were content with deferred examination since preliminary rights were established if an infringing

Article fell within the scope of the claims as published. Third parties, however, would be adversely affected. A possible solution would be a system that guaranteed any party, including applicants and third parties, the right to request examination and that such a requested examination be speedily performed.

The Delegation of Canada reiterated that it was not opposed to time limits *per se* but had problems with the specific time limits provided in draft Article 16. The Delegation indicated that it had taken steps to speed up both search and examination by making prior art available as soon as possible, requiring applicants to provide prior art from other countries, automating searching, establishing maintenance fees on applications, providing for speedy action on applications in special cases, and ratifying the PCT.

The Delegation of the Federal Republic of Germany indicated that its problem was with the requirement of a division of search and examination, which did not now exist in their Patent Office. With respect to draft paragraph (2), the Delegation recalled that a third party had a right to request substantive examination at any time and that this should overcome the problems with the deferred examination system. It was also indicated by that Delegation that there would be difficulties convincing the interested circles within its country to accept the provisions of draft Article 16.

It was pointed out that providing third parties with the right to request examination in countries having delayed examination was good, but there was a question whether countries with such a system would be willing to accept a time limit for examinations.

The Delegation of the Federal Republic of Germany indicated that there was a possibility for requesting examination in its system, but that there was no time limit for the examination. Once requested, an examination would be done in the regular course of business.

The Delegation of France indicated that the aim should be to shorten the time limits for search and examination. It was felt, with respect to draft paragraph (2), that the three-year period did not seem short, but that the situation in other Offices must be considered. It was felt that time limits should not run counter to the rights of third parties. The Delegation also stated that there would have to be provisions to allow for the implementation of the provisions contained in Article 16.

The Chairman concluded that some Delegations had indicated that draft Article 16 was an important one and an integral part of the package that comprises the Treaty. Opposition to draft Article 16 was founded on two considerations:

first, there were objections as a whole that Offices did not want to consider time limits, and second, there were objections of a more technical nature, such as the requirement of a division between search and examination. It was agreed that draft Article 16 should be further discussed and that it should be considered whether it was advisable to have transitional provisions to allow States to establish the infrastructure to implement the provision. With respect to draft paragraph (1)(a), a search should be conducted for any given application, either by an Office or on behalf of the Office. There was a need for the search to be conducted in a relatively short period of time. With respect to draft paragraph (2), the Chairman indicated a need to dissipate a misunderstanding with regard to its purported hostility to deferred examination systems. The Chairman stated that paragraph (2) was, itself, a deferred examination system that allowed deferral of examination by three years. One should consider the possibility of providing applicants and third parties with the right to request substantive examination, and it was necessary, when such a request was made, that examination be accomplished promptly."

Article 17: Changes in Patents

In addition to the text of Article 17 as elaborated by the International Bureau, discussions were based on a text proposed by the Delegation of the United Kingdom. Those texts read as follows:

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Limitation of Extent of Protection] *The owner of a patent shall have the right to request the competent Office to make changes in the text or drawings of the patent in order to limit the extent of the protection conferred by the patent.*

(2) [Obvious Mistakes and Clerical Errors] *The owner of a patent shall have the right to request the Office having granted the patent to make changes in the text or drawings of the patent in order to correct obvious mistakes or to correct clerical errors.*

(3) [Limitation in Respect of Changes] *No change in the text or drawings of the patent shall be permitted under paragraphs (1) or (2) where the change would result in the disclosure contained in the patent going beyond the disclosure contained in the application as filed.*

(4) [Decision in Respect of the Request and Publication of the Changes] *If, and to the extent to which, the Office changes the patent according to paragraphs (1) or (2), it shall publish the changes."*

[TEXT PROPOSED BY THE DELEGATION
OF THE UNITED KINGDOM]

- “(1)
 (2) should refer to ‘the competent Office’.
 (3) delete ‘or (2)’ in the second line.
 (4)” (Document HL/CE/VIII/10, page 11)

The portion of the report of the Committee of Experts concerning the discussion of Article 17 reads as follows:

“*Paragraph (1)*. The Delegation of the United States of America proposed to insert the words ‘at least’ after the words ‘drawings of the patent’ in the third line of draft paragraph (1) in order to make it clear that paragraph (1) could not be interpreted as limiting the rights of the Contracting Parties to provide additional opportunities to patent owners to request changes, in particular in respect of broadening the claims of patents within a reasonable period of time (for example, two years), provided that there was no extension of the original disclosure. In such circumstances, it should be required that patent owners act in good faith.

It was noted that draft paragraph (1) was not intended to limit the Contracting Parties in allowing patent owners to make any changes in patents. Therefore, the Notes in the next draft could expressly confirm that understanding and leave the determination of good faith to national laws.

The Delegations of Canada and Finland and the Representatives of AIPLA, AIPPI and NYPTC expressed their general support for the proposal of the Delegation of the United States of America, indicating that changes aimed at broadening the claims should be allowed if they were introduced without deceptive intent and if the rights of third parties were duly preserved. The Delegation of Norway said that it could support the proposal of the United States of America although, in its own legislation, patent owners would probably not be given an opportunity to broaden the claims.

The Delegations of Australia, Belgium, Hungary, the Netherlands, Portugal, the Republic of Korea, Spain and the United Kingdom were not in favor of giving the patent owners an opportunity to broaden the claims of patents since this would create uncertainty in respect of third parties’ rights; therefore, the Delegations were reluctant to support the proposal of the Delegation of the United States of America.

The Delegation of Japan expressed itself against permitting any changes which would broaden the patent claims. It also indicated that a change which did not result in either limiting or

broadening the patent claims, but was needed to eliminate ambiguities, should be permitted.

The Delegations of the Federal Republic of Germany, India and Romania expressed themselves in favor of draft paragraph (1).

The Delegation of France expressed its favorable attitude towards the proposal of the United States of America, provided that third parties’ rights be preserved and that a maximum time limit be provided for.

The Delegation of the Netherlands proposed to use in paragraph (1) a more neutral term such as ‘authority’ instead of ‘Office.’

The Chairman summarized the discussions stating that opinions were divided over the proposal of the United States of America to allow the Contracting Parties more freedom to accept changes in patents upon the request of the patent owners. He noted that it was commonly understood that any changes:

- (i) should be made in good faith and without deceptive intent;
- (ii) should in no case go beyond the original disclosure;
- (iii) should only be allowed where they involved a broadening of the scope of protection, within a reasonable limited time period, for example, two years;
- (iv) should only be allowed if the rights of third parties were duly preserved.

The main controversial question was whether such changes should be allowable only if they limited the extent of the claims, or if they could both limit or broaden the extent of the claims, or for the purpose of correcting mistakes or errors without affecting the scope of the claims. The Chairman noted that the next draft should take into account the changes which were needed to eliminate ambiguities.

Paragraph (2). The Delegation of the United Kingdom presented its proposal contained in document HL/CE/VIII/10, indicating that it was aimed at making clear which Office was competent to deal with correction of obvious mistakes or clerical errors. The Delegation cited as an example the case where the European Patent Office granted a patent and the United Kingdom national Office was supposed to make corrections, resulting in limiting the scope of protection.

The Delegation of Canada suggested that, for the sake of clarity, paragraph (2) should speak of ‘mistakes which are obvious from the reading of the document.’ The proposal was not supported by other delegations.

The Representative of ABA, supported by the Delegation of the United States of America, proposed clarifying in the Notes that translation

errors and ambiguities were covered by the provisions of paragraph (2).

The Delegation of Japan was against the possibility of correcting translation errors.

The Chairman noted that draft paragraph (2), with the addition of the word 'competent' proposed by the Delegation of the United Kingdom, was generally accepted.

Paragraph (3). The Delegation of the United Kingdom presented its proposal contained in document HL/CE/VIII/10, stating that the proposed deletion of the reference to draft paragraph (2) was of a substantive nature. The underlying idea was that the applicant acting in good faith should be entitled to obtain the patent he had intended from the outset.

The Delegations of Australia and the United States of America supported the proposal to delete in draft paragraph (3) the reference to paragraph (2).

The Delegations of the Federal Republic of Germany, Japan and Norway expressed hesitation in respect of the proposal of the Delegation of the United Kingdom and their preference for draft paragraph (3).

The Chairman concluded that the next draft of paragraph (3) should not contain a reference to paragraph (2) and that the Notes should contain appropriate explanations.

Paragraph (4). Draft paragraph (4) was accepted with the addition of the word 'competent' before 'the Office'."

LIST OF PARTICIPANTS**

I. States

Algeria: H. Yahia-Cherif. **Argentina:** R.J. Segura; A.G. Trombetta. **Australia:** G. Baker. **Austria:** E. Jakadofsky; T.M. Baier. **Belgium:** G. de Cuyper. **Brazil:** A.R. de Holanda Cavalcanti; P. Tarrago; M. Pinto Coelho. **Bulgaria:** M. Tosheva; J.K. Kosseva. **Cameroon:** J.-C. Shanda Tonme; J.O. Tigbo. **Canada:** J.H.A. Gariépy; J. Butler; B. Couchman; E.W. Bown. **China:** Ma Lianyan. **Cuba:** B. Maza Llovet. **Czechoslovakia:** M. Hujerova. **Democratic People's Republic of Korea:** C.R. Pak; H.B. Kim; S.R. Kim. **Denmark:** L.D. Østerborg; H.J. Jensen; A. Bach. **Egypt:** M.Y. Saada; N. Gabr; M.F.A. Dounya. **Finland:** V.J. Rainesalo; E. Häkli; E. Nuorlahti-Solarmo. **France:** M. Guerrini; J. Divoy. **German Democratic Republic:** S. Schröter. **Germany (Federal Republic of):** D. Schennen; H. Bardehle. **Ghana:** J.D. Essuman; M.A. Abdullah. **Greece:** A. Cambitsis. **Hungary:** I. Iványi; Gy. Szemző; E. Parragh. **Indonesia:** B. Kesowo; T. Sutrisno; E.D. Husin. **Iraq:** J.A. Hamza. **Ireland:** B. O'Farrell. **Israel:** M. Cohn; I. Shachter; R. Walden. **Italy:** M.G. Fortini; M. Carro Sciamanna.

Japan: S. Uemura; K. Ukai; Y. Muranaga; A. Nagaoka; S. Takakura. **Kenya:** N. Cheluget. **Lebanon:** M.S. Hatoum. **Libya:** S.A. Elhuni; A.A. Alkamoshi. **Madagascar:** J. Velontrasinga; P. Verdoux. **Malawi:** M.H. Chirambo. **Mexico:** J.L. Moya Ortega. **Morocco:** A. Bendaoud. **Netherlands:** W. Neervoort; W. van der Eyk. **New Zealand:** H. Burton; A.F. Wierzbicki. **Nigeria:** E.O. Jegede. **Norway:** K.H. Reinskou; P.T. Lossius. **Philippines:** R.B. Saquilabon; L. Gatan. **Poland:** G. Lachowicz. **Portugal:** J. Mota Maia; R.A. Costa de Morais Serrão; J. Pereira da Cruz; A.Q. Ferreira. **Republic of Korea:** S.-H. Lee; Y.-B. Yu; S.-H. Maeng; J.-K. Kim. **Romania:** V. Erhan; L. Bulgar; V. Pordea. **Soviet Union:** V.M. Ouchakov; A.D. Korchagin; V.N. Shitikov; D.V. Knyazhinsky. **Spain:** M. Hidalgo Llamas; C.E. Velasco; J.M. González de Linares Palou; M. Saenz de Heredia. **Sweden:** R. Halvorsen; B. Sandberg; B. Davidsson. **Switzerland:** J.-L. Comte; P. Messerli; H.-E. Laederach; F.A. Jenny. **Syria:** M.A. Kholandi. **Turkey:** A. Algan. **United Kingdom:** A. Sugden; B.G. Harden; A.C. Waters. **United Republic of Tanzania:** R.B. Mngulwi. **United States of America:** H.F. Manbeck, Jr.; M.K. Kirk; C.E. Van Horn; L. Maassel; L.J. Schroeder; L.E. Boland. **Uruguay:** R. González-Arenas. **Zaire:** M. Mutambula.

II. Observer States

Chile: S. Fernández-Illanes; P. Romero. **Ecuador:** P. Andrade. **Guatemala:** N.R. Olivero. **India:** R.A. Acharya; L. Puri. **Namibia:** B.C. Schutte. **Nicaragua:** M. Moncada-Fonseca. **Panama:** F. de M. Monteverde. **Peru:** J.L. Swabian Chale. **Republic of Yemen:** A.Y. Al Modwahi. **Swaziland:** B. Mkwanzazi; S.H. Zwane. **Venezuela:** L. Molinos; C.R. Pestana Macedo.

III. Intergovernmental Organizations

United Nations (UN): R. Dhanjee. **General Agreement on Tariffs and Trade (GATT):** A. Otten; M.C. Geuze. **African Intellectual Property Organization (AIPO):** I. Salia. **Commission of the European Communities (CEC):** B. Schwab; S. Jessel; L.M.C. Fonseca Ferrão. **European Patent Office (EPO):** G. Kollé; A. Rémond; R. Teschemacher; E. Alfonso v. Laun. **Organization of African Unity (OAU):** M.H. Tunis.

IV. Non-Governmental Organizations

American Bar Association (ABA): G.R. Clark; R.C. Witte; M.N. Meller; W.J. Brunet; S. Helfgott. **American Intellectual Property Law Association (AIPLA):** W.S. Thompson; R.A. Armitage; J.A. De Grandi; T.L. Irving; G.L. Newton; M.J. Pantuliano. **Asian Patent Attorneys Association (APAA):** I. Shamoto; A. Okawa; Y. Inoue. **Centre for International Industrial Property Studies (CEIPI):** B. de Passemar. **Chartered Institute of Patent Agents (CIPA):** R.C. Petersen; J.U. Neukom. **Committee of National Institutes of Patent Agents (CNIPA):** R.C. Petersen; J. Beier. **Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht (DVGR) (Federal Republic of Germany):** H. Goldrian. **European Council of Chemical Manufacturers' Federations (CEFIC):** R. Sieders. **European Federation of Pharmaceutical Industries' Associations (EFPIA):** P. Leardini. **Federal Chamber of Patent Attorneys (FCPA):** J. Beier. **Federation of German Industry (BDI):** H. Goldrian; H.-J. Schulze-Steinen. **Institute of Professional Representatives Before the European Patent Office (EPI):** R.C. Petersen; J.-F. Léger. **Intellectual Property Owners, Inc. (IPO):** D.M. Sell; R.C. Witte; R.S. Smith. **International Association for the Advancement of**

** A list containing the titles and functions of the participants may be obtained from the International Bureau.

Teaching and Research in Intellectual Property (ATRIP): W.T. Fryer III. **International Association for the Protection of Industrial Property (AIPPI):** M. Santarelli. **International Chamber of Commerce (ICC):** R.F. Fawcett. **International Confederation of Professional and Intellectual Workers (CITI):** P.J. Bernd. **International Federation of Industrial Property Attorneys (FICPI):** J. Beier; J.-F. Léger. **International Federation of Pharmaceutical Manufacturers Associations (IFPMA):** H.-J. Schulze-Steinen. **Japan Patent Association (JPA):** M. Takada; S. Suzuki. **Latin American Association of Pharmaceutical Industries (ALIFAR):** M.N. Levis. **Licensing Executives Society (LES):** R.S. Crespi. **Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI):** J. Pagenberg. **New York Patent, Trademark and Copyright Law Association, Inc. (NYPTC):** W.J. Brunet; S. Helfgott; M.N. Meller. **Pacific Industrial Property Association (PIPA):** M. Taniguchi; K. Komura. **Patent and Trademark Institute of Canada (PTIC):** R.E. Mitchell. **Patent Attorneys Association of Japan (JPAA):** I. Shamoto; A. Okawa. **Trade Marks, Patents and Designs Federation (TMPDF):** J.L. Beton. **Union of European Practitioners in Industrial Property (UEPIP):** H.-E. Böhmer. **Union of Industrial and Employers' Confederations of Europe (UNICE):** J.L. Beton; H. Goldrian; H.-J. Schulze-Steinen.

V. Bureau

Chairman: J.-L. Comte (Switzerland). *Vice-Chairmen:* M.A. Abdullah (Ghana); A.D. Korchagin (Soviet Union). *Secretary:* L. Baeumer (WIPO).

VI. International Bureau of WIPO

A. Bogsch (*Director General*); A. Schäfers (*Deputy Director General*); Francis Gurry (*Special Assistant, Office of the Director General*); L. Baeumer (*Director, Industrial Property Division*); A. Ilardi (*Senior Legal Officer, Industrial Property Law Section, Industrial Property Division*); J. Quashie-Idun (*Head, Developing Countries (Industrial Property) Section, Industrial Property Division*); O. Espinosa (*Senior Legal Officer, Industrial Property Law Section*); H. Lom (*Senior Legal Officer, Developing Countries (Industrial Property) Section*); W. Starein (*Senior Program Officer, Developing Countries (Industrial Property) Section*); B. Ibos (*Legal Officer, Industrial Property (Special Projects) Division*); R. Wilder (*Legal Officer, Industrial Property Division*); S. Zotine (*Legal Officer, Industrial Property (Special Projects) Division*).

New Items

CENTRAL AFRICAN REPUBLIC

*Head, National Industrial Property
and Standardization Service*

We have been informed that Mr. Roger Baguene has been appointed Head of the National Industrial Property and Standardization Service.

RWANDA

Directeur de la politique technologique

We have been informed that Mr. Jean-Marie Vianney Nyilimbilima has been appointed *Directeur de la politique technologique*.

Calendar of Meetings

WIPO Meetings

(Not all WIPO meetings are listed. Dates are subject to possible change.)

1990

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|-----------------------------------|--|
| October 29 to November 9 (Geneva) | <p>Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Eighth Session; Second Part)</p> <p>The Committee will continue to examine a draft treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).</p> <p><i>Invitations:</i> States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.</p> |
| November 7 to 9 (Geneva) | <p>Preparatory Meeting for the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned (Second Part)</p> <p>The Meeting will complete the preparation of the organization of the diplomatic conference (June 1991).</p> <p><i>Invitations:</i> States members of the Paris Union, EPO and OAPI.</p> |
| November 26 to 30 (Geneva) | <p>Working Group on the Application of the Madrid Protocol of 1989 (Second Session)</p> <p>The working group will continue to study Regulations for the implementation of the Madrid Protocol of 1989.</p> <p><i>Invitations:</i> States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.</p> |
| December 10 to 14 (Geneva) | <p>PCT Committee for Administrative and Legal Matters (Fourth Session)</p> <p>The Committee will continue the work started during its third session (July 2 to 6 and September 17 to 21, 1990).</p> <p><i>Invitations:</i> States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.</p> |

1991**January 28 to 30 (Geneva)****Information Meeting(s) on the Revision of the Paris Convention**

An information meeting of developing countries members of the Paris Union and China and, if it is so desired, information meetings of any other group of countries members of the Paris Union will take place for an exchange of views on the new proposals which will have been prepared by the Director General of WIPO for amending the articles of the Paris Convention for the Protection of Industrial Property which are under consideration for revision.

Invitations: See the preceding paragraph.

January 31 and February 1 (Geneva)**Assembly of the Paris Union (Fifteenth Session)**

The Assembly will fix the further procedural steps concerning the revision of the Paris Convention and will take cognizance of the aforementioned proposals of the Director General of WIPO. It will also decide the composition of a preparatory meeting which will take place in the first half of 1991.

Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

June 3 to 28 (The Hague)**Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned**

This diplomatic conference will negotiate and adopt a treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).

Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

September 23 to October 2 (Geneva)**Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-Second Series of Meetings)**

All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary sessions every two years in odd-numbered years. In the sessions in 1991, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1990, and consider and adopt the draft program and budget for the 1992-93 biennium.

Invitations: States members of WIPO or the Unions and, as observers, other States members of the United Nations and certain organizations.

**November 18 to December 6
(dates and place to be confirmed)****Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Fifth Session)**

The Diplomatic Conference is to negotiate and adopt a new Act of the Paris Convention.

Invitations: States members of the Paris Union and, without the right to vote, States members of WIPO or the United Nations not members of the Paris Union as well as, as observers, certain organizations.

UPOV Meetings

(Not all UPOV meetings are listed. Dates are subject to possible change.)

1991**March 4 to 19
(dates and place to be confirmed)****Diplomatic Conference for the Revision of the UPOV Convention**

Invitations: Member States of UPOV and, without the right to vote, States members of the United Nations not members of UPOV as well as, as observers, certain organizations.

Other Meetings Concerned with Industrial Property**1991****September 15 to 20 (Lucerne)**

International Association for the Protection of Industrial Property (AIPPI): Council of Presidents

September 30 to October 4 (Harrogate)

International Federation of Industrial Property Attorneys (FICPI): Congress

