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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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STANDING COMMITTEE ON THE LAW OF PATENTS

Tenth Session
Geneva, May 10 to 14, 2004

DRAFT SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The tenth session of the Standing Committee on the Law of Patents (SCP) was opened, on behalf of the Director General, by Mr. Francis Gurry, Deputy Director General, who welcomed the participants. Mr. Philippe Baechtold (WIPO) acted as Secretary.

Agenda Item 2: Election of a Chair and Two Vice-Chairs

2. The SCP unanimously elected, for one year, Mr. Alan Troicuk (Canada) as Chair and Mr. Yin Xintian (China) and Mr. Heetae Kim (Republic of Korea) as Vice-Chairs.

Agenda Item 3: Adoption of the Draft Agenda

3. The SCP adopted the draft agenda as proposed in document SCP/10/1.

Agenda Item 4: Accreditation of Intergovernmental and/or Non-Governmental Organizations

4. The SCP approved the accreditation of the Civil Society Coalition (CSC), the Center for International Environmental Law (CIEL) and the European Generic medicines Association (EGA) as *ad hoc* observers (documents SCP/10/7 and 7 Add.).

Agenda Item 5: Adoption of the Draft Report of the Ninth Session

5. The draft report of the ninth session (document SCP/9/8 Prov.2) was adopted with the modification that the reference in paragraph 53 to paragraph (1) should be replaced by a reference to paragraph (2).

Agenda Item 6: Draft Substantive Patent Law Treaty and Draft Regulations Under the Substantive Patent Law Treaty

6. The SCP discussed draft provisions on substantive patent law harmonization, based on the Draft Substantive Patent Law Treaty (SPLT) (documents SCP/10/2 and 4) and Draft Regulations under the Substantive Patent Law Treaty (documents SCP/10/3 and 5), referring, where appropriate, to the Draft Practice Guidelines under the Substantive Patent Law Treaty (document SCP/10/6).

7. The SCP discussed whether priority should be given to a first “package” of provisions and, if so, which topics should be included in those provisions. Many delegations expressed support for the proposal by the United States of America, Japan and the European Patent Office regarding the Substantive Patent Law Treaty that, rather than attempting to resolve the entire text of the current draft at once, the Committee should focus its attention on an initial package of prior art-related issues and, once agreement had been reached on those issues, discussions could then focus on other related issues. However, a number of other delegations opposed this proposal, emphasizing the need to consider all of the provisions contained in the current draft as a whole, having regard to the interrelationship of those provisions and the importance that they attached to other issues, in particular, the disclosure of the origin of genetic resources and traditional knowledge and the exceptions relating to the protection of genetic resources, biological diversities, traditional knowledge and the environment and public interest provided for in draft Article 2. However, some delegations considered that the SCP should not consider matters relating to the disclosure and protection of genetic resources and traditional knowledge, at least until the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) had completed its consideration of the issues involved. The Chair concluded that, in view of the variety of opinions that had been expressed, the SCP was unlikely to reach consensus either on whether priority should be given to a first “package” of provisions or on whether the Committee should discuss the whole of the draft Treaty and Regulations. The SCP agreed to discuss, during the remainder of this session, the draft Articles, together with the corresponding draft Rules and draft Practice Guidelines, starting with draft Articles 8 to 16 and continuing with draft Articles 1 to 7*bis*.

8. A brief summary of the discussions on the draft Articles and Rules follows:

Matters Relating to Article 8

Article 8(1) and Article 13(2)

9. Some delegations supported a proposal concerning the inclusion as part of the prior art under draft Article 8(1) of prior secret commercial use and offer for commercial sale, without the disclosure of the invention, by the applicant or the patentee. A large majority of delegations opposed this proposal but a number of those delegations expressed their support

for draft Article 13(2). The Chair concluded that draft Article 8(1) could be provisionally accepted and that draft Article 13(2) would remain within square brackets for further consideration. The International Bureau would further revise draft Article 13(2) taking into account a number of points raised by delegations. As regards the prior art effect of admissions by the applicant in the application, a number of delegations stated that such admissions should not constitute prior art.

Rule 8(1)

10. The text of this provision was provisionally accepted. No comments were made with regard to this provision.

Rule 8(2)(a)

11. The SCP provisionally accepted the text with the deletion of the second sentence. The Chair concluded that the International Bureau would further elaborate the notion of “reasonable possibility” in the Practice Guidelines.

Rule 8(2)(b)

12. In the light of the divergent views concerning the definition of the term “public,” the International Bureau was requested to further review the draft provision in conjunction with the expression “reasonable possibility to access” in draft Rule 8(2)(a).

Rule 8(3)

13. One delegation suggested clarifying that the applicant had to submit the evidence. It was agreed to retain the provision for further discussion.

Article 8(2)(a)

14. A majority of delegations expressed the view that the prior art effect of earlier applications should apply to novelty only, while a minority of delegations proposed that such prior art effect should apply to both novelty and inventive step. Several delegations and non-governmental organizations referred to the further exploration of the concept of “enlarged novelty” as applied in some jurisdictions. The SCP agreed to a proposal by the Chair that the International Bureau would prepare a study on the subject, focussing initially on draft Article 8(2)(a), but also considering the implications of extending such a concept to novelty in general. Two delegations proposed the introduction of a provision on the publication of applications after 18 months. The Delegation of the United States of America noted that draft Article 8(2)(a)(ii) was in conflict with the “Hilmer doctrine” that applied in that country.

Article 8(2)(b)

15. One delegation suggested that this provision should be revised to ensure that it would apply to Euro-PCT applications. As regards the alternatives on the effect of international applications in the context of draft Article 8(2) presented in the draft, opinions of delegations were split between alternatives A and B. Some delegations noted that there was a link with the issue of “enlarged novelty.” The SCP agreed that both alternatives should remain in the next draft.

Rule 9(1)

16. One delegation noted some inconsistency between this provision and paragraph 101 of the draft Practice Guidelines.

Rule 9(2)

17. Following a proposal by one delegation, the SCP provisionally accepted the following text:

“(2) [*Applications No Longer Pending*] Where the other application has been made available to the public in accordance with draft Article 8(2) in spite of the fact that it should not have been made available to the public under the applicable law, it shall not be considered as prior art for the purposes of draft Article 8(2).”

Rule 9(3)

18. In view of the differences in opinion which had consistently been expressed on this provision, the SCP agreed not to revisit it at this stage and to maintain it within square brackets.

Matters Relating to Article 9

General observations

19. All the delegations which spoke supported the introduction of a provision on a grace period in the SPLT, except for one delegation which reserved its position. However, opinions were split among delegations as to whether the duration of the grace period should be six or twelve months, on whether the provision on third party rights should be regulated in the SPLT as a mandatory requirement, and on whether the grace period needed to be expressly invoked by the applicant, and if so, in which form. Different views were expressed regarding the bracketed text in paragraph (1)(ii)(a). The Chair concluded that the parts of the text within square brackets and the alternatives in draft Article 9 should be retained. There was no support for a proposal to exclude experimental use from the prior art.

Article 9(1)

20. It was agreed that the International Bureau would review the text of the provision as well as the title of the Article.

Article 9(2)

21. Some delegations and representatives expressed their positions as to the circumstances under which a declaration invoking the grace period could be required. One delegation noted that the duration of the grace period could be expressed to differ depending on the circumstances of the disclosure.

Article 9(3)

22. One delegation questioned the applicability of this provision to cases relating to multiple or partial assignments.

Article 9(4)

23. Following a suggestion by one delegation, the Chair concluded that the current draft, including the two alternatives, should be retained for future discussions.

Matters Relating to Article 10

Article 10(1)

24. Some delegations questioned the use of the expression “make and use,” and the International Bureau was requested to study the matter and to explore possible alternative wording, such as “carried out.” Some delegations proposed that the expression “a person skilled in the art” in the first sentence should be expressly stated to be a person in the country of grant, in order to take account of the different levels of technological capability in different countries and to have a comprehensive disclosure in all countries. In view of the divergent opinions among delegations on this proposal, the SCP agreed to include the words “in the country of grant” in square brackets at the end of the first sentence. One delegation suggested insertion of the words “over the whole of its claimed range” after the words “made and used” in the second sentence. While the objective of the latter suggestion was generally agreed, the SCP agreed that the International Bureau should examine how to best accommodate it in the text.

Article 10(2)

25. On the proposal of one delegation, the SCP agreed that the words “under the applicable law” be retained, followed by the insertion of the words “in accordance with draft Article 7.” One delegation proposed to delete the term “claims.” There was a debate on whether the provision should expressly refer to the fact that deletions should not be taken into account for the purposes of disclosure or whether the expression “as amended and corrected” covered deletions. The International Bureau was requested to examine whether the issue would be best dealt with in the draft Treaty, draft Regulations or draft Practice Guidelines.

Rule 10

26. Opinions were split on whether this provision should be moved to the draft Practice Guidelines. The SCP agreed that the expression “make or use” should be re-examined by the International Bureau.

Matters Relating to Article 11

Article 11(1)

27. One delegation suggested that this provision should be reviewed to ensure that it would adequately cover claims in granted patents as well as pending applications. The SCP agreed to refer this matter to the International Bureau for further study. In response to comments made by two delegations relating to the term “technical,” the Chair noted that the SCP had

agreed, at an earlier meeting, to discuss all the aspects relating to the terms “technical” and “fields of technology” in conjunction with draft Article 12(1).

Article 11(2)

28. The SCP provisionally accepted this provision.

Article 11(3) and Rule 12(2)

29. Opinions were split on whether the bracketed term “claims” in draft Article 11(3) and draft Rule 12(2) should be retained. Several delegations pointed out that these provisions addressed two separate issues. The first issue, considered as a substantive matter, derived from the principle that the applicant should only claim what he had recognized and described on the filing date. For that purpose, the disclosure in the claims should be taken into account. The second issue concerned formal consistency between the disclosure in the claims and the disclosure in the description. With respect to the first issue, one delegation suggested that the bracketed term “claims” be replaced by “other claims.”

30. With respect to draft Article 11(3), suggestions to replace the words “the claimed invention” by the words “the claims” or “the scope of the claims” were made. One delegation queried the appropriateness of the word “and.” Concerning draft Rule 12(2), one delegation proposed that the second part of that paragraph be replaced, for the purpose of clarity, by “thereby ensuring that the claim does not comprise subject matter which the applicant had not recognized and described on the filing date.” The International Bureau was requested to review these provisions taking into account the various views raised.

Rule 11(1)

31. The SCP provisionally accepted this provision with the modification that the words “to describe the claimed invention in compliance with” should be replaced by the words “to fulfil the requirement of.”

Rule 11(2)

32. One delegation expressed the view that Alternative B, subparagraph (b)(i), was duplicative of draft Rule 11(1)(ii). The delegation further considered that Alternative B, subparagraph (b)(ii) should be tied to the publication of the application. One representative expressed concerns about Alternative B, subparagraph (b)(ii), which, in his view, could result in the addition of new matter. The International Bureau was requested to further examine those issues.

Rule 11(3)

33. The SCP provisionally accepted this provision.

Article 11(4) and Rule 13(5)

34. There was no support for a proposal by a delegation suggesting the inclusion of the abstract among the elements which can be used for interpreting the claims. In view of the different views regarding the inclusion of draft Article 11(4)(b) and draft Rule 13(5) in the SPLT, it was agreed that the SCP would revisit those provisions after reviewing the study

concerning enlarged novelty to be prepared by the International Bureau. The International Bureau was requested to review the text taking into account the various comments made.

Rule 12(1)

35. A proposal to move this provision to the draft Practice Guidelines was not supported. The International Bureau was requested to further clarify the terms “clear” and “concise,” taking into account both the comments made by delegations and the PCT International Search and Preliminary Examination Guidelines.

Rule 13(1)(a)

36. The SCP provisionally accepted this provision.

Rule 13(1)(b)

37. In view of the concerns raised by some delegations as to the open-ended nature of this provision, the International Bureau was requested to further examine it.

Rule 13(2)

38. As regards subparagraph (a), an alternative text proposed by one delegation was not supported by other delegations. One delegation reserved its position on this provision. Some delegations expressed concern about the reference to the term “application,” which would include the abstract.

Rule 13(3)

39. The SCP provisionally accepted this provision.

Rule 13(4)

40. There was no consensus on this provision. Concerning subparagraph (a), some delegations expressed the opinion that it should be optional, while other delegations favored retaining the requested character of the provision. The International Bureau was requested to include two options in square brackets into the next draft. On subparagraph (b), some delegations expressed their satisfaction with the provision as proposed, while some others suggested that it was too broad and should be limited to situations where it was not possible to define a product by its composition or structure. Some delegations further suggested limiting this provision to products obtained by the specified process. Some delegations supported a proposal to amend subparagraph (c) to cover any product suitable for the specified use, but this was opposed by some other delegations.

Rule 13(6)

41. One delegation supported the alternative “may” and another delegation questioned whether the word “due” was needed.

Matters Relating to Article 12

Article 12(1) and (5)

42. The SCP noted the footnotes relating to these provisions, which stated that the SCP had agreed at its eighth session to postpone the discussions on them, and agreed to proceed to a discussion at the present session.

43. No agreement was reached on the question whether the words “in all fields of technology” in square brackets in paragraph (1)(a) should be retained or deleted. One delegation proposed to include an additional item relating to inventions which are contrary to public order or morality into paragraph (1)(b), concerning subject matter not considered eligible for patent protection. A number of delegations, while supporting inclusion of a provision concerning public order or morality, preferred its inclusion in paragraph (5), which dealt with exceptions to patentability. On paragraph (5), a number of delegations expressed the opinion that the exceptions under this provision should, in view of their importance, be contained in the Treaty itself, rather than in the Regulations. No agreement was reached on whether to include the exceptions contained in TRIPS Article 27.2 and 3 in the draft SPLT. Following the suggestion of one delegation, the International Bureau was requested to establish a table of correspondence between the provisions of the draft SPLT and the relevant provisions of the TRIPS Agreement.

Agenda Item 7: Future Work

44. Following a discussion of suggested approaches as to what matters the SCP should consider at its next sessions, part of which is outlined in paragraph 7 above, the Chair stated his conclusion that there was no agreement in the Committee regarding its future work plan, noting that the report would reproduce all the interventions that were made in respect of this agenda item, including comments made by two delegations in respect of the Chair’s conclusion.

45. Following the request of one delegation for dates for the next SCP, the International Bureau informed the SCP that the weeks of November 22 and 29, 2004, had provisionally been reserved for the PCT Reform Working Group and the SCP.

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

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