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STUDY ON THE INTERFACE BETWEEN THE SPLT, THE PLT AND THE PCT

prepared by the International Bureau

INTRODUCTION

1. The current discussions on the draft Substantive Patent Law Treaty (SPLT), which are intended to harmonize substantive principles of patent law, build upon the foundation of the recent Patent Law Treaty (PLT) adopted on June 1, 2000,¹ which harmonized many aspects of national and regional procedural patent practice and law. The process of international harmonization must also take into account the significant level of acceptance of provisions relating to patent applications under the Patent Cooperation Treaty (PCT). The goal of the harmonization process should be, and indeed is, to establish a uniform set of standards that would be applicable both to national and regional laws and practice, and to the international framework under the PCT.

2. The present study is based on a request of the member States of the Standing Committee on the Law of Patents (SCP), at its fifth session, held in Geneva from May 14 to 19, 2001. The Draft Report for that session (document SCP/5/6 Prov.) states:

“34. The International Bureau explained the negotiating history of the PCT as well as the PLT, and said that the dividing line between formality requirements and substantive requirements was not always clear. Further, it stressed the *importance of establishing a seamless interface between the SPLT and the PLT*. . . .

...

¹ The text of the Patent Law Treaty is contained in document PT/DC/47.

“36. Following a suggestion made by the Chair, it was agreed that the *International Bureau would conduct a study with respect to the interface between the draft SPLT and the PLT.*” [emphases added]

3. The present study reviews the history of the interface between the PLT and the PCT, highlights the questions involved in the interface between the PLT and the SPLT, and provides suggestions for a seamless interface between the SPLT, PLT and PCT.

THE PLT – PCT INTERFACE

4. During the discussions in the SCP leading up to the adoption of the PLT, the question of a legally effective and practical interface between the PLT and the PCT was examined in detail.

5. The idea of a link between the PLT and the PCT was first suggested by the Delegation of the United States of America in November 1996, at the third session of the Committee of Experts on the Patent Law Treaty (see the Report, document PLT/CE/III/6, paragraph 12). The Committee of Experts accepted the suggestion (document PLT/CE/III/6, paragraph 77). In incorporating this approach in the documents for later meetings, the International Bureau pointed out that the earlier drafts of the PLT, which included an express list of maximum elements that could be required by a Contracting Party in an application, would in fact establish a different international standard than the standard existing under the PCT. Since the establishment of two different international standards within WIPO for the form or contents of patent applications made no rational sense, and since the PCT standard already existed, the most logical path was to incorporate, to the extent possible, existing PCT standards into the PLT.

6. The desired result was accomplished through a provision which became Article 6 of the PLT. Paragraphs (1) and (2) of that Article, and Rule 3(2), state:

“[Article 6](1) [*Form or Contents of Application*] Except where otherwise provided for by this Treaty, no Contracting Party shall require compliance with any requirement relating to the *form or contents* of an application different from or additional to:

(i) the requirements relating to *form or contents* which are provided for in respect of international applications under the Patent Cooperation Treaty;

(ii) the requirements relating to *form or contents* compliance with which, under the Patent Cooperation Treaty, may be required by the Office of, or acting for, any State party to that Treaty once the processing or examination of an international application, as referred to in Article 23 or 40 of the said Treaty, has started;

(iii) any further requirements prescribed in the Regulations.

[Article 6](2) [*Request Form*] (a) A Contracting Party may require that the *contents* of an application which correspond to the contents of the request of an international application under the Patent Cooperation Treaty be presented on a request Form prescribed by that Contracting Party. A Contracting Party may also require that any

further contents allowed under paragraph (1)(ii) or prescribed in the Regulations pursuant to paragraph (1)(iii) be contained in that request Form.

(b) Notwithstanding subparagraph (a), and subject to Article 8(1), a Contracting Party shall accept the *presentation* of the contents referred to in subparagraph (a) on a request Form provided for in the Regulations.

...

[Rule 3](2) [*Request Form Under Article 6(2)(b)*] A Contracting Party shall accept the *presentation* of the contents referred to in Article 6(2)(a):

(i) on a request Form, if that request Form corresponds to the Patent Cooperation Treaty request Form with any modifications under Rule 20(2);

(ii) on a Patent Cooperation Treaty request Form, if that request Form is accompanied by an indication to the effect that the applicant wishes the application to be treated as a national or regional application, in which case the request Form shall be deemed to incorporate the modifications referred to in item (i);

(iii) on a Patent Cooperation Treaty request Form which contains an indication to the effect that the applicant wishes the application to be treated as a national or regional application, if such a request Form is available under the Patent Cooperation Treaty.” [emphases added]

7. These provisions, while they provide for a single application which may be filed in national and regional offices and under the PCT, do not expressly specify the standards concerning form or contents, or contents and presentation, under the PCT. This is in part because those standards are not defined in the context of the PCT itself, and in part because the PCT may further evolve over time.

8. In particular, the provisions do not define the distinction between provisions of the PCT that refer to form or contents, provisions that refer to contents and presentation, and provisions which refer to substantive law. Although a note from the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty (see Note 6.02 in Annex I, hereto) seems to shed some light on what that distinction might be, in practice different Contracting States have differing views on this issue, and the question has been avoided in the context of the PCT. Thus, it was deemed inappropriate for the PLT to strictly define a matter under the PCT which has intentionally been left ambiguous in the context of the PCT itself.

9. The solution in the PLT was to refer to the requirements of the PCT which relate to form or contents and to presentation of the contents of the request part (see PLT Article 6(1) and (2), and Rule 3(2), quoted above). The result is that the PLT requires Offices of PLT Contracting Parties to apply the provisions of the PCT which relate to form or contents, and to contents and presentation of the request part. However, the PLT does not require those Offices to apply the provisions of the PCT which relate to the contents and presentation of other parts of the application, or those that relate to substantive law (see also PLT Article 2(2)). Since different Contracting States of the PCT define the dividing lines between these provisions differently, it is likely that different Contracting Parties of the PLT will differ in their application of Article 6(1) of the PLT itself. (See the Explanatory Notes to Article 6 of the PLT, which were prepared by the International Bureau for explanatory purposes only, reproduced in Annex I.)

10. On the other hand, the SCP deemed it appropriate for a number of provisions of the PLT to differ from the PCT, in particular, where the time was deemed ripe to adopt more user-friendly provisions than those contained in the PCT.

11. Two approaches were taken to modify PCT provisions in the context of the PLT. The first approach was to modify the Regulations of the PCT itself, and to incorporate the modified PCT regulations into the PLT. For this purpose, a special session of the PCT Assembly was convened from March 13 to 17, 2000, in Geneva, to adopt amendments to the PCT Regulations (see the Report, document PLT/A/28/5). In taking this approach, the SCP was aware that, if the PCT Assembly did not modify the PCT Regulations prior to the Diplomatic Conference for the Adoption of the PLT, express provisions would have to be adopted into the PLT itself.

12. The second approach was used in cases where the modifications to the PCT would have had to be made in the Articles which could only be amended by a Diplomatic Conference. The approach consisted of incorporating express provisions into the PLT, and making any incorporation of PCT provisions into the PLT subject to those express PLT provisions. For example, the filing date provisions of the PCT are contained in Article 11, and could not be modified except through a Diplomatic Conference. However, the SCP considered the time ripe to make filing date provisions more user friendly. The solution was to adopt Article 5 of the PLT, which contained more user-friendly provisions concerning the filing date than the PCT, and to make Article 6(1) of the PLT subject to Article 5, with the words, "Except where otherwise provided for in this Treaty....". Relevant parts of the Explanatory Notes to Article 5 of the PLT, which were prepared by the International Bureau for explanatory purposes only, are reproduced in Annex II.

THE SPLT - PLT INTERFACE

13. The PLT is expressly directed toward harmonization of procedures, and not to harmonization of substantive law. This is stated clearly in Article 2(2) of the PLT:

“ (2) [*No Regulation of Substantive Patent Law*] Nothing in this Treaty or the Regulations is intended to be construed as prescribing anything that would limit the freedom of a Contracting Party to prescribe such requirements of the applicable substantive law relating to patents as it desires.”

14. In contrast, the States members of the SCP have made clear their intention that the SPLT be directed toward substantive law (see Report of the fourth session of the SCP, document SCP/4/6, paragraph 47 and 49, and in general).

15. In order to arrive at a completely and consistently harmonized system, the PLT and the SPLT should interface seamlessly, that is, in such a way that (i) they do not conflict or contradict; (ii) they cover the full range of patent practice, and do not leave legal or procedural gaps; (iii) they interlock in a legally sound and practical way, and are capable of implementation without confusion; and (iv) they achieve full harmonization, that is, they are, in combination, implemented uniformly by all Contracting Parties. Toward this goal, the

SPLT expressly requires that all SPLT Contracting Parties implement the provisions of the PLT.²

THE SPLT - PLT - PCT INTERFACE

16. The complexity of the SPLT-PLT-PCT interface is amply illustrated by the following paragraph from the Draft Report of the fifth session of the SCP (document SCP/5/6 Prov.):

“33. The representative of one non-governmental organization stated that the substance of draft Article 5 and draft Rule 3 was already contained in the PLT, since PCT Rule 5 was incorporated in the PLT by reference. If the substance of draft Article 5 and draft Rule 3 was considered to be of a substantive nature, the SPLT should simply refer to PCT Rule 5. One delegation considered it necessary to have a common understanding in the Committee concerning what were substantive and what were formal requirements regulated under the PLT. The Delegation was of the opinion that a proper reference to the PLT was appropriate as regards the requirements of formal nature under draft Rule 3, and that the requirements of a substantive nature should be in the subsequent provisions relating to substance. It stated that draft Rule 3 should not give the basis for the rejection of an application. The representative of one non-governmental organization was of the opinion that the SPLT should answer questions that had not been answered by the PLT or the PCT. The representative of another non-governmental organization said that, since draft Article 5 related to the style of drafting patent applications, that draft article included formal matters. One delegation, while noting that the PLT did not provide substantive requirements, and PCT Article 27(5) allowed Contracting Parties to provide any substantive conditions of patentability, the simpler way would be to refer to the PCT provisions, and to add additional requirements such as the prohibition of the best mode requirement. One delegation stated that PCT Rule 5 was not incorporated by reference in the PLT, since the technical character of the invention, etc. were substantive requirements. Two delegations were of the opinion that draft Rule 3 should cover elements of the description, and any substantive requirements should be covered by other provisions.”

17. Some clarification of a possible way forward was provided by the International Bureau (document SCP/5/6 Prov.):

“51. The International Bureau observed that, *while the PLT established a mechanism where a single application would be validly accepted by all Contracting Parties for the purposes of filing an application, the draft SPLT aimed at allowing a single application to be prepared for the purposes of substantive examination in all offices.* However, the discussion revealed that there was a *third category* of requirements that fell between these two, which related to *formal aspects that were strongly linked to substance.* For example, a certain structure of claims or the contents of the description might not be compatible with the requirements concerning the structure and contents during

² While it may be more effective to require that each Contracting Party join the PLT, it has been the practice of WIPO of late not to condition membership in one treaty upon membership in another treaty. Thus, the PLT itself requires only that Contracting Parties implement the provisions of the Paris Convention relating to patents, and not that they be party to that Convention. However, the possibility may be considered that, in the future, the PLT and SPLT, and perhaps even the PCT, be combined into a single instrument.

examination, although they would be accepted to meet the requirements for a complete application. Against this backdrop, in view of the possible link with the PCT, *the International Bureau suggested that the draft SPLT also regulate minimum requirements concerning the third category of requirements so that there would be uniformity in the results of examination by all Contracting Parties.*" [emphasis added]

18. In particular, it is important to note that a number of provisions regarding the "formal aspects of applications that are strongly linked to substance" are already contained in the PCT, and are binding on Contracting States (that is, Contracting States must accept international applications drafted in conformity with these requirements, and cannot require amendment of the applications to conform to different or additional requirements). On the other hand, provisions of the PCT relating to the definition of prior art and substantive conditions of patentability are expressly not binding on Contracting States for the purposes of examining claims and granting patents.³ In fact, the latter provisions are not harmonized among the various Offices, such lack of harmonization being the *raison d'être* of the SPLT.

19. Thus, in order to achieve a seamless interface between the SPLT and the PCT (and therefore the PLT), provisions of the SPLT which correspond to provisions of the PCT which are binding on PCT Contracting States should be the same in both treaties, to achieve the goal of one uniform standard for applications worldwide. However, since provisions of the PCT concerning substantive requirements are not binding on Offices and do not achieve harmonization, they should be reexamined and expressly harmonized in the SPLT.

20. Following these thoughts, the following approach could be considered for the SPLT-PLT-PCT interface:

(a) formality requirements directed toward a *single application which would be accepted by all Offices for the purposes of filing a complete application are subject to regulation by the PLT*, through incorporation-by-reference of PCT provisions, plus additional express requirements. However, there may be some further provisions that need to be added to complete this aspect of harmonization;

(b) requirements directed toward a *single application which would be accepted by all Offices for the purposes of search, examination and grant would be subject to regulation by the SPLT*, as follows:

(i) *Formal aspects linked to substance.* Formal requirements that are strongly linked to substance, that is, requirements which are not examined for the purposes of determining if a complete application has been filed, but which could affect the scope of a search or result in rejection of the claims during substantive examination (for example, structure of claims or the contents and presentation of the description), should be subject to regulation by the SPLT through incorporation-by-reference of existing or modified PCT provisions, plus any necessary express requirements or deletions.

(ii) *Substantive aspects.* The substantive (non-formal) requirements (for example, definition of prior art and the substantive conditions of patentability) under which the claims are evaluated for patentability should be solely subject to regulation by express provisions of the SPLT.

³ See especially PCT Articles 27(5) and 33(5).

21. In addition, it seems that the aspects referred to in paragraph 20(b)(i) may not require full harmonization. Rather, it would seem more appropriate (and perhaps more practical) to analogize these requirements to those of the PLT in which a maximum list of requirements is imposed. Under the PLT scheme, if an applicant submits an application which conforms to the PLT, the Office of a Contracting Party must accept that application, and cannot impose any additional requirements that are not contained in the PLT. This provides the assurance that an applicant can prepare one single application that would be acceptable (after translation) as a complete application in every Office that is bound by the PLT. However, Offices would not be prevented from accepting applications which conform to other requirements.

22. Likewise, the SPLT could include a maximum list of formal requirements strongly linked to substance concerning the various parts of the application for the purposes of search, examination and grant, under paragraph 20(b)(i). This would provide the assurance that an applicant can prepare one single application that would be acceptable, from the point of view of the above-mentioned requirements linked to substance concerning description, drawings, claims and abstract, for the purposes of substantive examination, in every Office that is bound by the SPLT, even though such Offices would not be prevented from accepting applications which conform to other requirements.

23. In other words, an applicant could draft a single application, containing an “international-style” description and “international-style” claims, and could not be required to make changes to the application, other than translation and substantive amendments, through grant.

24. In contrast, in order to accomplish the further goals of mutual recognition of search and examination results, the aspects referred to in paragraph 20(b)(ii) would require full harmonization, that is, an exact standard rather than a maximum requirement. Full harmonization of the standards used for search and examination of claims would mean, theoretically, that each Office, examining the same application from the same inventor, would reach the same result concerning patentability.

SUMMARY OF POSSIBLE INTERFACE PRINCIPLES

25. Thus, the International Bureau would recommend that the SPLT be drafted in the following way, to achieve a seamless interface with the PLT and the PCT:

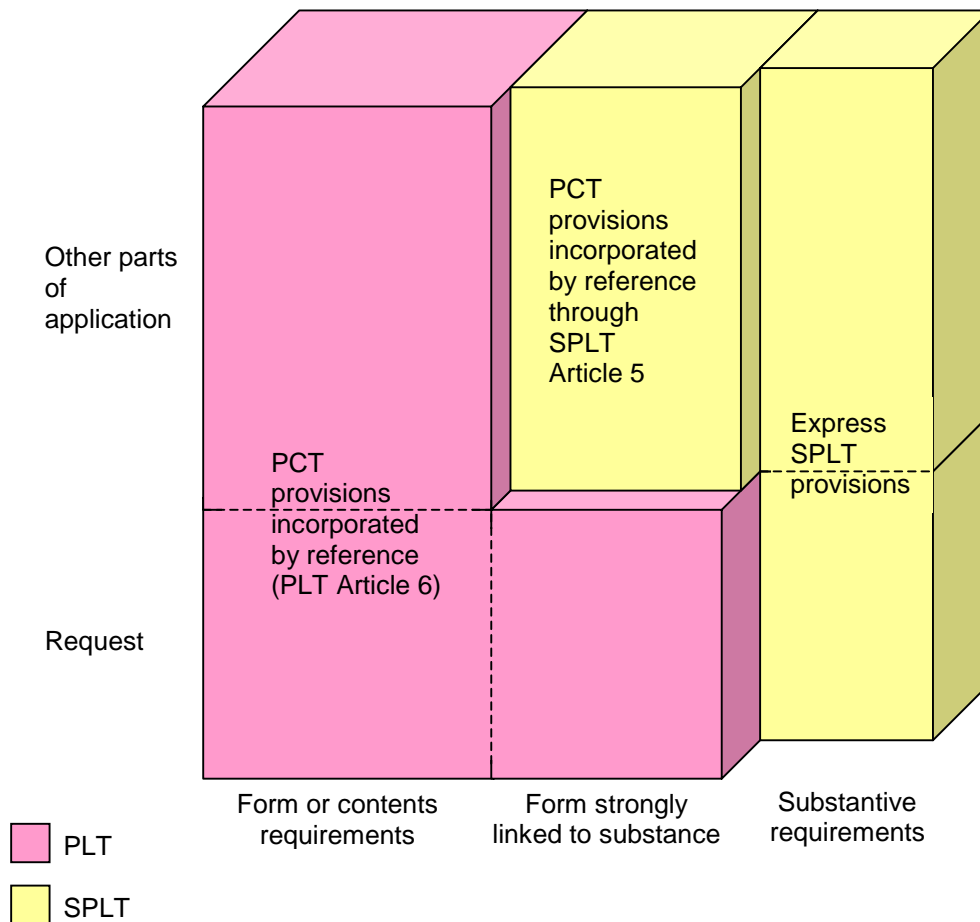
(i) formality requirements for filing a complete application (PLT Article 6(1)), and requirements for the contents and presentation of the request part of the application (PLT Article 6(2)) are governed by the PLT, incorporating by reference the relevant requirements of the PCT, with some modifications. If necessary, those modifications could be included in the SPLT. Offices must accept applications which conform to these requirements as complete applications in accordance with draft Article 16 of the SPLT as presented in document SCP/6/2, but would be free to accept other applications as well;

(ii) formality requirements strongly linked to substance concerning, for example, the contents and presentation of the other parts of the application (namely, description, claims, drawings and abstract), for the purposes of search, examination and grant, are governed by the SPLT, incorporating by reference the relevant requirements of the PCT, with some modifications. Offices must accept applications which conform to these requirements for the

purposes of search, examination and grant, but would be free to accept other applications as well;

(iii) requirements concerning the substantive examination of claims (namely, definition of prior art, disclosure of the claimed invention, patentable subject matter, novelty, inventive step/non-obviousness and, if included, industrial applicability/utility) are governed by express provisions in the SPLT. Offices may not examine claims using any different requirements.⁴

26. The result would be a uniform standard for preparing applications for filing, search and examination, whereby purely formal aspects, and formal aspects linked to substance, would be harmonized for national and regional applications (under the PLT and the SPLT) and would be the same as for PCT applications, except where otherwise provided by the SPLT. Substantive requirements for patentability would be harmonized among national and regional offices through express provisions in the SPLT, resulting in theoretically uniform results among the offices. The following graphic shows which type of provisions would be covered by which treaty under the system described:



⁴ The question whether the PCT should be modified to apply the SPLT substantive requirements to international preliminary search and examination would be a matter purely for the PCT Contracting States to decide.

SUGGESTIONS FOR AMENDMENT OF DRAFT SPLT PROVISIONS

27. In order to accomplish the goals set out in item (ii) of paragraph 25, the SPLT would have to be drafted to incorporate by reference the relevant provisions of the PCT which are not already covered by the PLT (without mentioning specific PCT provisions, which would not be possible, see paragraphs 7 and 8 above). In other words, a provision in the SPLT which is analogous to Article 6 of the SPLT would be required.

28. A possible draft Article 5 of the SPLT could read as follows:

“Article x

Contents and Presentation of Application

(1) [Parts of Application] An application shall contain the following parts:

- (i) a request, ~~as provided for in the Patent Law Treaty;~~
- (ii) a description;
- (iii) one or more claims;
- (iv) one or more drawings, where required; and
- (v) an abstract.

(2) [Requirements Concerning Parts of Application] Except where otherwise provided for by this Treaty or the Patent Law Treaty, no Contracting Party shall require compliance with any requirement relating to the request, description, claims, drawings or abstract of an application different from or additional to:

(i) the requirements relating to the request, description, claims, drawings or abstract which are provided for in respect of international applications under the Patent Cooperation Treaty;

(ii) any further requirements prescribed in the Regulations.”

29. This provision would supersede at least Articles 3, 5 and 6 and supporting rules of the previous draft of the SPLT (document SCP/5/2), except for certain differences that might be considered desirable at the present time. Those differences could be accommodated (analogous to the negotiating process of the PLT) either by amending the PCT and incorporating the amended PCT provisions by reference into the SPLT, or by expressly including different requirements in the Articles or Rules of the SPLT and making the incorporation of PCT provisions subject to those express SPLT provisions.

30. Provisions relating to substantive requirements would be included expressly in the SPLT, as has already been done in previous drafts.

[Annexes follow]

Explanatory Notes to Article 6 of the PLT

Notes on Article 6
(Application)

6.01 Paragraph (1). This paragraph applies the requirements relating to the form or contents of international applications under the PCT to national and regional applications.

6.02 The wording of this provision is modeled after that of PCT Article 27(1). It is implicit that the expression “form or contents of an application” is to be construed in the same way as the expression in that Article. The Notes to that Article in the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, at page 35 of the Final Text of the Treaty and Notes, contain the following explanation:

“The words ‘form or contents’ are used merely to emphasize something that could go without saying, namely that requirements of substantive patent law (criteria of patentability, etc.) are not meant.”

6.03 In accordance with the general principle contained in Article 2(2), paragraph (1) is similarly not intended to be construed as prescribing any requirements of substantive law (see Note 2.02). The requirement, allowed under Article 29.2 of the TRIPS Agreement, that an applicant for a patent provide information concerning the applicant’s foreign applications and grants, is not a requirement as to the “form or contents of an application” for the purposes of this provision. Similarly, requirements in respect of duty of disclosure, indications as to whether an application was prepared with the assistance of an invention marketing company and, if so, indications of the name and address of that company and requirements in relation to the disclosure of search results on related applications and patents, are also not requirements as to the “form or contents of an application” for the purposes of this provision. Further, requirements as to the “form or contents of an application” do not include any requirements relating to foreign investments, public concessions or public contracts under national laws and bilateral and multilateral agreements.

6.04 Under Article 23(1), a State or intergovernmental organization may declare through a reservation that the provisions of Article 6(1) shall not apply to any requirement relating to unity of invention applicable under the PCT (see Note 23.01).

6.05 Paragraph (1), introductory words. The requirements referred to in these introductory words which are “otherwise provided for by this Treaty” are, in particular, those under Articles 6(2) to (6), 7 and 8 and the Regulations provided for under those Articles, namely Rules 7 to 10.

6.06 Item (i). This item prohibits a Contracting Party from imposing requirements in respect of the form or contents of a national or regional application that are more strict than those applicable to international applications under the PCT, except where otherwise provided for in accordance with the introductory words or item (iii) of this paragraph (see Notes 6.05 and 6.09). As in the case of PCT Article 27(4), a Contracting Party is free, under Article 2(1), to provide for requirements in respect of the form or contents of national and regional applications which, from the viewpoint of applicants, are more favorable than the requirements provided for under the PCT.

6.07 Item (ii). This item permits a Contracting Party to require that a national or regional application comply with any requirements relating to the “form or contents” that any State party to the PCT is allowed to apply in the “national phase” of an international application, in particular, the requirements that are allowed under PCT Rule 51*bis*. It is to be noted that this item is not restricted to the particular “national phase” requirements under the PCT applied by the Contracting Party concerned, but rather applies to any “national phase” requirements allowed under the PCT.

6.08 As regards the effect of revisions, amendments and modifications to the PCT, the Regulations and Administrative Instructions under the PCT, reference is made to Article 16 (see Notes 16.01 to 16.04).

6.09 Item (iii). This item provides authority for the further requirements under Rule 3(1) in respect of divisional applications and of applications by new applicants determined to be entitled to an invention contained in an earlier application (see Note R3.01).

[Annex II follows]

ANNEX II

Explanatory Notes to Article 5 of the PLT

Notes on Article 5
(Filing Date)

5.01 A Contracting Party is obliged to accord a filing date to an application which complies with the requirements applicable under this Article. Furthermore, a Contracting Party is not permitted to revoke the filing date accorded to an application which complies with those requirements. In particular, the filing date of an application may not be revoked for failure to comply with a requirement under Article 6, 7 or 8 within the applicable time limit, even if that application is subsequently refused or considered withdrawn on the grounds of such non-compliance (see also Note 5.02).

5.02 Paragraph (1). This paragraph prescribes the elements of an application to be filed for the purposes of according a filing date. First, the Office needs to be satisfied that the elements that it has received are intended to be an application for a patent. Second, the Office must be provided with indications which identify the applicant and/or allow the applicant to be contacted. In place of such indications, under subparagraph (c), evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office may be accepted by the Office. Third, the Office must have received a disclosure of the invention, either in the form of a part which on the face of it appears to be a description or, where permitted by the Contracting Party under subparagraph (b), a drawing in place of that description. Since the list of elements under paragraph (1) is exhaustive, a Contracting Party is not permitted to require any additional elements for a filing date to be accorded, in particular, that the application contain one or more claims. Where an application as filed does not contain one or more claims which may be required under Article 6(1)(i) (with reference to PCT Article 3(2)), a Contracting Party may require that these be subsequently filed under Article 6(7), within the time limit prescribed in Rule 6(1). However, the failure to file such claims within that time limit will not result in the subsequent loss of the filing date, even if the application is refused or considered withdrawn under Article 6(8)(a). Another example is where, in accordance with Article 6(1) and with reference to PCT Rule 11.9, a Contracting Party requires that an application on paper be typed or printed: the filing date of an application which does not comply with that requirement, in particular a handwritten application, cannot be revoked on that ground. The same considerations apply where an application does not comply with any other requirement under Article 6, 7 or 8, for example, it is not accompanied by a filing fee required under Article 6(4) (see also Notes 6.16 and 6.22 to 6.24).

[End of Annex II and of document]