

WIPO



SCP/6/9

ORIGINAL: English

DATE: May 6, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

STANDING COMMITTEE ON THE LAW OF PATENTS

Sixth Session

Geneva, November 5 to 9, 2001

REPORT

adopted by the Standing Committee

INTRODUCTION

1. The Standing Committee on the Law of Patents (hereinafter referred to as “the Standing Committee” or “the SCP”) held its sixth session in Geneva from November 5 to 9, 2001.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Albania, Argentina, Australia, Austria, Bangladesh, Barbados, Belgium, Belize, Benin, Brazil, Bulgaria, Cambodia, Cameroon, Canada, China, Costa Rica, Croatia, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, Estonia, Finland, France, Germany, Ghana, Greece, Guatemala, Honduras, Hungary, India, Indonesia, Iraq, Ireland, Italy, Japan, Jordan, Kazakhstan, Kenya, Latvia, Lesotho, Lithuania, Malaysia, Mexico, Morocco, Mozambique, Netherlands, New Zealand, Nigeria, Norway, Oman, Peru, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Seychelles, Slovakia, South Africa, Spain, Sudan, Sweden, Switzerland, Thailand, The former Yugoslav Republic of Macedonia, Tunisia, Turkey, Ukraine, United Kingdom, United States of America, Venezuela, Viet Nam and Yugoslavia (76).
3. Representatives of the World Trade Organization (WTO), the African Regional Industrial Property Organization (ARIPO), the Eurasian Patent Office (EAPO), the European Patent Organisation (EPO) and the European Commission (EC) took part in the meeting in an observer capacity (5).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Bar Association (ABA), American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Biotechnology Industry Organization (BIO), Chartered Institute of Patent Agents (CIPA), Committee of National Institutes of Patent Agents (CNIPA), Institute of Professional Representatives before the European Patent Office (EPI), Intellectual Property Institute of Canada (IPIC), Intellectual Property Owners Association (IPO), International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Intellectual Property Society (IIPS), Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law (MPI), Trade Marks, Patents and Designs Federation (TMPDF), Union of European Practitioners in Industrial Property (UEPIP) and Union of Industrial and Employers' Confederations of Europe (UNICE) (16).
5. The list of participants is contained in the Annex of this report.
6. Discussions were based on the following documents prepared by the International Bureau of WIPO: "Revised Agenda" (SCP/6/1 Rev.), "Draft Substantive Patent Law Treaty" (SCP/6/2), "Draft Regulations and Practice Guidelines under the Draft Substantive Patent Law Treaty" (SCP/6/3), "Notes" (SCP/6/4), "Study on the Interface between the SPLT, the PLT and the PCT" (SCP/6/5), "United States Proposal for a Working Group on Multiple Invention Disclosures and Complex Applications" (SCP/6/6) and "Amendment of the Draft Agenda (SCP/6/1)" (SCP/6/7).
7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

GENERAL DISCUSSION

Agenda Item 1: Opening of the Session

8. Mr. Shozo Uemura, Deputy Director General, opened the session, and welcomed the participants on behalf of the Director General. Mr. Philippe Baechtold (WIPO) acted as Secretary to the Standing Committee.

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

9. The Standing Committee unanimously elected, for one year, Mr. Dave Herald (Australia) as Chair, and Mr. Volodimir Zharov (Ukraine) and Mr. Chaho Jung (Republic of Korea) as Vice-Chairs.

Agenda Item 3: Adoption of the Revised Agenda

10. The revised draft Agenda (document SCP/6/1 Rev.) was adopted as proposed.

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

11. The International Bureau indicated that document SCP/5/6 Prov. 2 included the comments received earlier from members of the SCP. Since several delegations had commented that the report was difficult to read because it did not name the different delegations, the International Bureau stated that, in future reports, names of delegations would be mentioned more often.

12. Regarding paragraph 168 of document SCP/5/6 Prov. 2, the Delegation of the Dominican Republic requested a verbatim reflection of its intervention. The Representative of UNICE, with regard to paragraph 34, requested that the text quoted by the International Bureau from the Records of the Diplomatic Conference on the Patent Cooperation Treaty concerning the requirements relating to form or contents be cited in full in the report.

13. The draft report was adopted, with the modifications requested by the Delegation of the Dominican Republic and the Representative of UNICE.

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

14. The International Bureau explained that the structure of the draft Treaty and Regulations had slightly changed in order to group matters which belonged together and that the subdivision into parts had been removed. It also indicated that the Practice Guidelines, now drafted in treaty style, would have to be redrafted in a more explicit style similar to that of the PCT Administrative Instructions at a later stage.

General discussion

15. In response to an invitation by the Chair to inform the SCP about recent developments in the United States of America on questions such as, for example, the first-to-file issue, the Delegation of the United States of America explained that, as reported at the fifth session of the SCP, 45 responses received to a notice published by the United States Patent and Trademark Office (USPTO) had shown a deep division among the interested circles of the United States of America on many issues, including the first-to-file issue. Because of this division that continued despite further efforts made by the Delegation, as well as in view of lack of political leadership in the USPTO, the Delegation stated that, at this stage, it was not able to express a definitive position on this issue. The Delegation, however, reaffirmed its support to move forward to determine best practices for all substantive aspects of patent law, which would ultimately provide deep harmonization for the benefit of users worldwide. In addition, the Delegation informed the SCP that the confirmation hearing of their future Director might take place on November 7, 2001.

16. The Delegation of Japan noted that, although the current draft Substantive Patent Law Treaty (SPLT), which aimed at a deep harmonization of substantive elements of patent law, provided great advantages for users at the international level, future discussions should not be limited to the existing scope of the draft SPLT, and that the SCP should include other issues which would reduce both costs and risks for applicants. Welcoming the ongoing efforts being made by the Delegation of the United States of America, the Delegation stated that the first-to-file principle should govern the SPLT and hoped that the United States of America would be able to accept that principle in the future.

Draft Article 1: Abbreviated Expressions

Item (iv)

17. The Delegation of Japan pointed out an inconsistency between draft Article 1(iv), where the term “subject matter” was used and draft Article 11(1), where the term “matter” was used. The International Bureau suggested the addition of the word “subject” before the word “matter” in draft Article 11(1).

Item (v)

18. In response to the question of the Delegation of the Republic of Korea asking whether the “person who is applying for the patent” was the same as “the person who is filing or prosecuting the application,” the Chair indicated that Article 1(viii) of the Patent Law Treaty (PLT) contained the same definition and that it may be, but not always, the same person.

Item (vi)

19. In response to the question of the Delegation of Canada on how the “filing date” in draft Article 1(vi) would apply to PCT international applications and whether a reference to PCT Article 11 should be included, the International Bureau indicated that, except for Article 8(2), the draft SPLT did not intend to cover PCT applications until they enter the national phase, but that it would clarify this point in the Notes.

20. The Chair welcomed the proposal made by the Delegation of Germany, which was supported by the Delegation of the United States of America, to keep the reference to the applicable law of the Contracting Party, which would include the PLT, but to delete the last part of the sentence “in accordance with [Article 5 of] the Patent Law Treaty” and said that the International Bureau should further review the draft provisions, as well as the necessity of this definition.

Item (vii)

21. The Delegations of Bangladesh, France, India, Ireland, Morocco, the Netherlands, Romania, Russian Federation, Spain, Sudan, Sweden, Switzerland, Ukraine, the United Kingdom and the United States of America, and the Representatives of the EAPO and the EPO stated that it was premature to introduce the notion of “time of filing,” and were in favor of the deletion of this provision. Some of these delegations, however, admitted that the problem of receiving two applications containing the same invention on the same date should be given attention.

22. The Delegation of Japan, supported by the Delegations of Argentina and the Republic of Korea was in favor of the retention of this item, since the issue was important in the context of prior art and different time zones. The Delegation noted that electronic filing would facilitate identifying the time of filing. As regards the alternative words in square brackets, the Delegations of Japan and the Republic of Korea preferred the first alternative and the Delegation of Argentina preferred the second alternative.

23. The Delegation of Germany reserved its position since this issue would also be discussed in conjunction with draft Articles 7(3) and 8(2) of the SPLT. The Delegation

wondered whether, if the term “time of filing” was included in the SPLT, national Offices would be obliged to record the time of filing in hours and minutes.

24. The Delegation of Canada shared the concerns of other delegations, but hesitated to simply delete this provision. The situation would be different for countries with different time zones and it was difficult to foresee what would be needed in the future, in particular in an enhanced electronic environment. The Delegation proposed not to simply delete the concept, but rather to keep a general reference for future elaboration in the Regulations.

25. The Representatives of AIPPI, CIPA and FICPI were in favor of the deletion of this item. The Representative of AIPPI was also concerned about the conformity of this provision with Article 4C(2) of the Paris Convention. The Representative of UNICE was opposed to the provision and suggested a standard date based on the time in Geneva where the International Bureau was located.

26. The Chair summarized the discussion as follows: few delegations expressed support for this provision and the majority of delegations that spoke wished to delete it. There was also concern about deleting the provision entirely without a possibility of future discussion. He invited the International Bureau to prepare a new draft which would leave enough flexibility for the future.

Item (viii)

27. In order to enhance consistency with draft Article 1(ix), the Delegation of the United States of America, supported by the Delegation of Canada, proposed to insert after the phrase “whose priority is claimed,” the phrase “and whose priority the claim is entitled to.” The SCP agreed to this proposal, subject to the proposal of the Delegation of Australia to replace the word “claim” by “application.” The Delegation of Canada proposed to delete the last part of the sentence, “in accordance with the Paris Convention.”

Item (ix)

28. The Delegation of France, supported by the Delegations of Belgium, Germany, Morocco, Norway and Sweden, and the Representative of AIPPI, reserved its position, because the terms “claim date” and “limitation” were new expressions which required further clarification.

29. The Delegations of Australia, China, Japan, the United Kingdom and the United States of America welcomed the inclusion in the draft SPLT of the concept “claim date.” The Delegation of the Republic of Korea, while supporting the concept of “claim date,” noted that other expressions such as “effective date” (EPO Examination Guidelines), “relevant date” (PCT Rule 64) and “critical date” were used in some systems. It preferred the term “effective date” because it was self-explanatory. The Chair observed that PCT Rule 64 refers to the “relevant date” but that that term was not associated with any particular claim.

30. The Delegation of the United States of America suggested to replace the term “limitation” by “embodiment,” but opposed the term “feature” which was suggested by the Delegation of Germany. The Delegation of the United Kingdom proposed to delete the word “limitation” and keep the word “alternative.” The Delegation of the Russian Federation proposed to have a clear definition of the terms “limitation,” “feature” and “embodiment” in draft Article 1. The Delegation of Japan shared the view of the Delegation of the United

States of America regarding the term “feature,” but expressed some difficulty with the term “embodiment.”

31. As regards the two alternative texts presented within square brackets, the Delegations of Australia, Canada, Japan, the Netherlands, the Russian Federation and the United Kingdom expressed preference for the second bracketed text, which was more applicant friendly. The Delegation of China preferred the first bracketed phrase which was simpler. The Delegation of the United States of America reserved its position with regard to the two alternative texts in square brackets.

32. Concerning the term “entitled to,” the Delegation of Australia noted that this concept which was different in each law, should be elaborated in the Practice Guidelines. The Delegation of Japan further proposed to replace “containing” by “disclosing” and replace “the claim is entitled to” by “valid.” The Chair suggested that the International Bureau review the wording taking into account the concerns of some delegations regarding the term “entitled to.”

33. The Representative of the EPO asked whether there would be any problem with the definition “the ‘claim date’ for a claim means the filing date of the application containing the claim” in the case of amended claims and whether, if “claim date” was introduced, the claim date had to be assessed and its validity always checked during examination. The Representative also queried whether, in the case of multiple priority dates, the Office would have to publish the patent as granted with indication of the claim dates. As far as the term “limitation” was concerned, the Representative supported the terms “feature” or “embodiment,” but also expressed interest in the proposal by the Delegation of Canada. With regard to the bracketed text, if necessary at all, the Representative preferred the second alternative.

34. In response to the Representative of the EPO, the Chair observed that, in Australian law, there was no “claim date,” but that its practice in fact used the concept. The fact that amendments to the claims were made did not remove the entitlement to priority. In his view, there was no obligation for the Offices to publish the claim date. The Delegation of Canada supported the observation made by the Chair that the claim need not be in the application as filed and said that in Canada, as in Australia, the claim date was only assessed on an “as needed” basis. The International Bureau confirmed that it was not the intention to oblige any Office to look at the validity of the claim during the procedure before the Office.

35. The Delegation of Belgium asked whether the wording was in conformity with Article 4H of the Paris Convention which referred to “certain elements of the invention for which priority is claimed.”

36. The Representative of the EPO, supported by the Delegation of Japan and the Representatives of EPI and FICPI, proposed to replace “claim” in the second line by “subject matter claimed,” which may also accommodate the issue raised by the Delegation of Belgium. The Representative also proposed, if it was not necessary to assess the validity of claim, to delete the phrase “and whose priority the claim is entitled to.”

37. The Representative of the EAPO observed that Article 5 of the PLT did not require the filing of claims to fulfill the filing date requirements. The Representative shared the concern raised by the Delegation of Belgium regarding Article 4H of the Paris Convention.

38. After some discussion, the Delegation of Canada proposed the following wording:

“(ix) the “claim date” for a claim in an application means the filing date of the application or, where priority is claimed in accordance with the applicable law, the filing date of the earliest application whose priority is claimed and which discloses the subject matter defined by the claim; where a claim defines its subject matter in the alternative, [the claim date for the claim in respect of each alternative shall be the claim date to which that alternative is entitled] [each alternative shall be considered to be a separate claim];”

39. The Delegations of China, the United Kingdom and the United States of America and the Representative of the EPO reserved their position on the second part of the provision. The Delegation of the United Kingdom said that, where a priority document partially disclosed the subject matter defined by the claim, there could be more than one claim date for one claim. The Delegation of the United States of America, supported by the Delegation of the United Kingdom and the Representative of the EPO, stated that the priority document should have a full disclosure. The Chair suggested to include the words “in such manner as to meet the requirements of Article 10” at the end of the first part of the provision.

40. The Chair summarized the discussion as follows: A number of delegations expressed reservations, some questioned whether there was a need for this definition, for others, it was an important issue. The discussion showed that different practices existed. The International Bureau was mandated to prepare a new draft for the next meeting based on the proposal by the Delegation of Canada keeping the two alternatives and covering also the post-grant situation.

Item (x)

41. The Delegation of Germany expressed the opinion that this item might better be left to case law and that, rather than to have a definition which might not be sufficient, a more detailed explanation should be included in the Practice Guidelines. After some discussion, during which the question of the need for this provision was also raised, the SCP agreed to keep this item, but to move it to draft Rule 1, since the term “general knowledge of a person skilled in the art” was used in the Regulations only.

Items (xii), (xiii) and (xiv)

42. In relation to the wording “revised, amended and modified” in these items, the Delegation of Japan suggested that a provision similar to Article 16 of the PLT be needed in the SPLT.

Draft Rule 1: Abbreviated Expressions

43. The International Bureau pointed out a change to be made in the title of the Rule which should read “Abbreviated Expressions in the Regulations.”

44. The Representative of the EAPO reserved his position. He expressed the wish to defer the discussion of draft Rule 1 until draft Article 10 had been discussed and thought it would be useful to refer to the Budapest Treaty in draft Article 10 itself rather than in the Rule.

Draft Rule 2: Person Skilled in the Art Under Articles 1(x), 7(3)(c), 10(1), 11(3)(b) and 12(3), and Rules 5(2)(b), 8(2)(b), 10(1) and (2)(iii), 11(1), 12(1) and (3)(a), 14(1)(ii) and (2) and 15

45. The Delegation of Japan, supported by the Delegation of Germany, questioned whether the concept of “person skilled in the art” should be the same or a different one in all provisions concerned. The Delegation of the United States of America, referring to the Note to draft Rule 2, proposed to replace the expression “ordinary practitioner” by “hypothetical person of ordinary skill in the art,” the term “relevant date” by “claim date” and “Article 8(1)” by “Article 8.” It also proposed to include relevant factors to determine a person skilled in the art, such as the educational level of active workers in the field, the educational level of the inventor, the type of problems encountered in the art, the prior art solutions to those problems, the rapidness with which innovations are made in that field and the sophistication of the technology. The Delegation of Germany agreed that the six factors mentioned by the Delegation of the United States of America were important, but noted that they would rather be relevant in the context of defining the concept of inventive step.

46. The Delegation of Japan, supported by the Representative of UNICE, supported the proposal by the Delegation of the United States of America to replace the term “relevant date” by “claim date,” but opposed to replace the words “Article 8(1)” by “Article 8.” The Delegation further noted that, if the definition of the “person skilled in the art” in draft Rule 2 was applicable to draft Rule 14(1), a reference to draft Article 8(2) was needed.

47. The Delegation of Australia supported the concept of “person skilled in the art,” but doubted that such a person would understand all prior art. In response to the Delegation of Sudan, the Chair noted that a diploma was not necessarily a requirement for a person skilled in the art, but that, in some technological fields, high qualification was necessary.

48. The Representative of TMPDF was in favor of deleting the word “ordinary” before the word “practitioner” and stated that the ordinary common sense of those not skilled in the art should not be disregarded.

Draft Guideline Under Rule 2

49. The International Bureau suggested to delete the word “specialists” in the first line of paragraph (2) and to replace the word “specialists” in the second line of that paragraph by the word “persons.”

50. The Delegation of the United States of America expressed its preference for a wording along the lines of “deemed to have the knowledge of” to be inserted after “may be” in paragraph (2).

51. The Delegation of China expressed doubt as to the necessity to extend the definition of a person skilled in the art to a team. In this context, the Delegation of Cameroon recalled that, in view of draft Article 1(xi), the person skilled in the art could encompass a plurality of persons. The Representative of AIPPI, while supporting the concept of a team as an important one in certain technologies, reserved its position until the text would be further elaborated.

52. The Chair summarized the discussion on draft Rule 2 and the draft Guideline under Rule 2 as follows: The question of the use of “relevant date” versus “claim date” would have

to be further examined. There was wide support for these provisions, which should apply to all contexts and environments, but further discussion was necessary with regard to terms such as “team” and “ordinary practitioner,” as well as concerning the six factors proposed by the Delegation of the United States of America.

Draft Article 2: General Principle

53. Referring to the explanation given in Note 2.01 of document SCP/6/4, the Delegation of the Republic of Korea stated that equivalents, which were provided under draft Article 14 in document SCP/5/2, should be included in the draft SPLT, since they also related to the pre-grant phase of patent applications. The Delegation of Canada stated that it was premature to exclude all infringement issues from the scope of the SPLT in view of the objective of harmonization, which was to provide a framework allowing one application to be prepared and accepted by the Offices of all Contracting Parties. Therefore, in its view, it was not sufficient to deal with the issue concerning claim interpretation in the pre-grant phase only, since in particular, applications would have to be drafted differently, depending on whether a particular country applied the doctrine of equivalents or not. Stressing the importance of international harmonization on the drafting of claims as well as claim interpretation, the Delegation of the United States of America, supported by the Delegation of the United Kingdom, noted that, even if harmonization on the drafting of claims were achieved, a different interpretation of claims might defeat the objective of the SPLT. The Delegation of Germany, supported by the Delegation of France, underlined the importance of patents after grant, and pointed out that some provisions under the current draft, for example draft Rule 12(2)(b) and the use of the term “limitation,” were also applicable in the context of infringement. The Chair proposed that the words “other than on claim interpretation” be added at the end of draft Article 2.

54. Supporting current draft Article 2 as proposed, the Delegation of Japan stated that infringement issues went beyond the objective of the SPLT, which was to provide the same examination results for the same applications. Although the Delegation was afraid of a delay in the conclusion of the SPLT due to the inclusion of infringement issues, it did not object to explore any links between elements which were applicable throughout examination, grant and infringement procedures.

55. In response to the suggestion made by the Delegation of the United States of America to delete the word “substantive,” the International Bureau said that the term was intended to clarify that the SPLT dealt with substantive but not with formality requirements.

56. Further, the Delegation of the United States of America suggested the inclusion of a provision concerning national security which could be modeled after Article 4 of the PLT. In addition, the Delegation stated that the SPLT should not interfere with other types of laws, such as antitrust and unfair competition laws, or rules relating to fraud.

57. The Chair concluded that the International Bureau would redraft the provision taking into account the comments received, in particular, the applicability of the SPLT to claim interpretation under infringement procedures.

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

58. The Delegation of the Republic of Korea, supported by the Delegations of Canada and the United States of America, stated that, since divisional applications should be covered by

the expression “applications for patents for invention and for patents of addition,” as under the PLT, item (ii) of paragraph (1) was not necessary. The Delegations of the Republic of Korea and the United States of America said that a clarification in the Notes in this respect would be satisfactory.

59. The Delegation of Canada, supported by the Delegation of the United States of America, suggested the inclusion of an express reference to international applications under the PCT rather than to cover international applications under item (i) in paragraph (1), since Article 11(3) of the PCT did not clearly refer to “applications ... which are filed with or for the Office.” The Delegation suggested to take into account the wording of Article 3 of the PLT.

60. The Delegation of the United States of America observed that the Notes should explicitly state the applicability of the SPLT to continuation and continuation-in-part applications, as it was the case in the Explanatory Notes 3.04 on the PLT.

61. Concerning paragraph (2), the Delegation of the Republic of Korea objected to the inclusion of the bracketed language “[and patents].”

Draft Rule 3: Exceptions Under Article 3(2)

62. In response to a proposal made by the Delegation of the Republic of Korea to incorporate item (i) into draft Article 2(2), which was supported by the Representative of UNICE, the International Bureau explained that this item had been included in the Regulations in order to provide some flexibility in view of the PCT Reform currently under consideration.

63. Regarding the statement of the Delegation of the Republic of Korea that this item was not needed, the Delegation of the United States of America observed that draft Rule 3(ii) was in fact needed to exclude re-issue and re-examination proceedings from the scope of the Treaty. It also stated that a clarification was necessary with respect to the applicability of the SPLT to plant patents and design patents. The Representative of UNICE, supported by the Representative of the EPO, requested a clarification of the term “plant patent” since, in certain countries, plants that met the patentability requirements could be protected by patents.

64. The Chair summarized the discussions on draft Article 3 and draft Rule 3 as follows: the SCP supported a broad coverage of the SPLT, including divisional applications, continuation, and continuation-in-part applications. The International Bureau should look into the question of the inclusion of international applications under the PCT, taking into account the relevant language of Article 3 of the PLT, as well as the location of the provision.

Draft Article 4: Right to a Patent

65. As regards item (iii), the Delegation of Canada, supported by the Delegations of Germany and the United States of America, proposed that, since the third party and the inventor were not necessarily in a contractual relationship, the relationship of these parties be reviewed and elaborated in the Regulations. While supporting item (iii), the Delegation of the Republic of Korea, supported by the Delegation of Sudan, suggested that the words “any third party” be replaced by “a person” and noted that the words “under another legal title” lacked clarity. Further, the Delegation of Australia, supported by the Delegation of Sudan, suggested that, where persons listed in items (i) to (iii) were legally incapacitated or deceased persons,

or minors, the representatives of those persons be covered by this Article. The Delegation of the United Kingdom, supported by the Delegations of Canada, Romania and Sudan, pointed out that item (ii) should not only refer to the inventor in item (i) but also to the third party in item (iii).

66. In view of the difficulty of international harmonization on this subject, the Delegation of the Russian Federation proposed that the provision be deleted and that, where a person was accorded the right to a patent under the law of one country, other countries should recognize the right of that person under their applicable law.

67. The Delegation of the United States of America noted that the obligation on Contracting Parties should be more clearly stated in this Article, and proposed the following language: "The applicant or patentee shall have the right to a patent." The Delegation of Canada was concerned, however, about the adverse effect of such a provision, for example in the form of a contest during a court procedure. The Delegation of the United States of America explained that draft Article 4, which was referred to in draft Article 13, should be drafted as a positive requirement as it was the case for draft Article 12.

68. The Representative of EPI suggested that the words "who is" be replaced by the words "who, at the time the invention was made, was."

Draft Rule 4: Details Concerning the Right to a Patent Under Article 4

69. The Delegations of Canada, Germany, Japan and the United States of America supported paragraph (1)(a) as proposed. The Delegation of the Russian Federation observed that the provision went beyond employee's inventions since it included the case where an invention was made under an agreement between a commissioner and an inventor, and proposed the deletion of the words "of the inventor."

70. The Representative of the EPO, supported by the Delegations of Canada, Egypt and the Russian Federation, proposed that, if the intention of item (iii) in draft Article 4 was to cover employee's inventions, the text of draft Rule 4(1)(a) be moved to draft Article 4.

71. Concerning paragraph (1)(b), the Representative of the EPO, supported by the Delegation of France, proposed that, where the State in which the employee performs his main activity could not be determined, the law of the State in which the employer has his place of business be applied. The Delegation of Romania considered this provision useful to clarify certain legal uncertainty. The Delegations of Germany, Japan and the United States of America, however, were not in favor of including provisions relating to the questions of applicable law in the SPLT. The Delegation of Canada stated that this provision should be kept in the draft Treaty within square brackets.

72. The Delegations of Japan and the United States of America supported the inclusion of paragraph (2). The Delegation of the United States of America was of the view that this provision should provide for joint inventors to have undivided interests to fully enforce the right to a patent. The Delegation of Romania said that, where an invention was made jointly by several inventors, each of them had the status of inventor and the right should be owned jointly. The Delegation of Egypt observed that, where an invention was made jointly, the right to the patent should be divided equally unless the joint inventors agreed otherwise. The Representative of EPI noted that, in practice, there were problems where an invention made jointly by several inventors involved nationals of more than one country. The Delegation of

Germany, however, stated that it was premature to include a provision concerning the right to an invention made jointly by several inventors. The Delegation of Cameroon said that a provision concerning the right to an invention made independently by several inventors should be included.

73. The Chair summarized the discussions on draft Article 4 and draft Rule 4 by suggesting that the International Bureau review the provisions taking into account the interventions made, in particular, the contractual relationship under draft Article 4(iii), the relationship between draft Article 4(i), (ii) and (iii), the proposal by the Delegation of the United States of America concerning positive construction of draft Article 4, the relationship between draft Article 4(iii) and draft Rule 4(1)(a), the diverging views concerning draft Rule 4(1)(b) and the general support on draft Rule 4(2).

Draft Article 5: Application

Paragraph (1)

74. The Delegation of Japan noted that item (ii) was silent concerning the language requirements of a “description,” while PLT Article 5 provided that “a part which on the face of it appeared to be a description” could be in any language for the purposes of obtaining a filing date, and PLT Article 6(3) provided that a translation of any part of the application that was not in a language accepted by the Office could be required later. The Chair explained that the SPLT was dealing with substantive requirements only, and that, in view of the filing date requirements under the PLT, the assumption was that the Office already was in possession of a description which was in a language accepted by the Office.

75. As regards item (iv), the Delegation of the United States of America proposed that the words “where required” be replaced by the words “where necessary to understand the invention,” which appeared in Note 5.01 in document SCP/6/4 and were similar to the wording used in PCT Article 7(1). In response to a question raised by the Delegation of Canada, the Chair suggested that the International Bureau should include an explanation in the Notes that drawings under item (iv) included photographs and other forms of presentation using new technologies.

Paragraph (2) and Interface Between the SPLT, the PLT and the PCT

76. The International Bureau introduced the study on the interface between the SPLT, the PLT and the PCT contained in document SCP/6/5 and stressed the importance of providing a seamless interface between these treaties in order to establish a uniform set of standards that would be applicable both to national and regional laws and practices, and to the international framework under the PCT. The International Bureau recommended the following mechanism: the requirements concerning form or contents of an application and requirements for the contents and presentation of the request part of the application are governed by Article 6 of the PLT, incorporating by reference the relevant requirements of the PCT, with some modifications. The formality requirements strongly linked to substance concerning the contents and presentation of claims, description, drawings and abstract would be governed by draft Article 5(2) of the SPLT, incorporating by reference the relevant provisions of the PCT, with some modifications. Finally, the substantive requirements would be governed by express provisions in the SPLT.

77. In response to a question raised by the Delegation of the United States of America, which supported the interface mechanism as proposed, the International Bureau explained that the second sentence of paragraph 25(i) of document SCP/6/5 intended to provide the possibility of including, in the SPLT, any requirements which departed from the PCT requirements and which were not included in the PLT, if the SCP were to decide on such requirements.

78. In response to an observation made by the Representative of UNICE, the International Bureau said that Article 6 of the PCT, for example, could be viewed as a substantive requirement, although the Records of the Diplomatic Conference on the PCT indicated that that Article provided requirements relating to form or contents. During the development of the PLT, vain efforts had been made to make a clear distinction between “form or contents” and “substance” and between “form” and “contents.” The proposed preamble of draft Article 5(2) of the SPLT covered “any requirement” relating to a request, claims, description, drawings and abstract, and no distinction needed to be made in that context between formality requirements and substantive requirements.

79. The Chair concluded that the SCP agreed on the direction provided in document SCP/6/5.

80. As regards paragraph (2) of draft Article 5, the Delegation of New Zealand did not disagree with the incorporation by reference to the PCT requirements, but preferred the explicit reference in the SPLT to the relevant Articles and Rules under the PCT. The Delegation of the Republic of Korea supported this paragraph as proposed. In response to a question raised by the Delegation of Japan, the International Bureau explained that the word “this Treaty” in the preamble was intended to cover the provision under the SPLT, the Regulations under the SPLT and the Practice Guidelines that laid down substantive requirements, while item (ii) was intended to provide the legal basis for including requirements in the Regulations relating to the request, description, claims, drawings or abstracts which may deviate from those under the PCT.

81. The Chair summarized the discussion by noting that there was general agreement on the mechanism regarding the interface among the SPLT, the PLT and the PCT as set forth in document SCP/6/5 and draft Article 5(2).

Paragraph (3)

82. The Delegation of the United States of America stated that an abstract submitted by the applicant should be considered as a part of the description. The Chair queried whether any consideration should be given to abstracts established by applicants and abstracts established by an Office, for example, abstracts contained in international applications under the PCT established by the International Searching Authority. The International Bureau suggested that, where an abstract was drawn up by the applicant, the applicant be given the right to incorporate the disclosure made in the abstract as of the filing date into the description, and that the PCT could be modified accordingly if the Contracting States agreed. This suggestion was supported by the Delegations of Argentina and the United States of America and the Representative of FICPI. The Representative of FICPI noted that, though an abstract should be regarded as a part of the disclosure, it should not be considered in the context of infringement procedures.

83. However, the Delegations of Germany and the Republic of Korea and the Representative of the EPO supported the concept laid down in this paragraph as proposed. The Representative of IPIC observed that the purpose of an abstract was to provide technical information about the claimed invention and that the abstract was not a place to set up the invention. Therefore, if the abstract was used for the purpose of interpretation, it would cause a radical change for users.

84. As regards the words “for any other purpose,” the Delegation of the Republic of Korea said that these words were too restrictive, since an abstract might serve, for example, an educational purpose. Further, in response to an observation made by the Delegation of Brazil, the Representative of AIPPI noted that, once an abstract was published in a manner accessible to the public, it formed part of the prior art under draft Article 8(1).

85. The Chair concluded the discussion concerning paragraph (3) by suggesting that the International Bureau should review the provisions under the entire Treaty and the Regulations that concerned the disclosure and the status of an abstract, and prepare alternative provisions for the next draft.

Draft Rule 5: Contents and Order of Description Under Article 5

Draft Rule 6: Details Concerning Claims Under Article 5

86. The Chair suggested that, since the contents of draft Rules 5 and 6 overlapped with the PCT reform process, they might be better addressed by the Working Group on PCT Reform or be referred to the PCT body in general. The International Bureau noted that the PCT Regulations could be revised in the future so that the mechanism provided under draft Article 5(2) would work better.

87. The Delegations of Japan, New Zealand, the Republic of Korea and the United States of America, however, were of the view that draft Rules 5 and 6 should be discussed under the SCP for the following reasons: the Working Group on PCT Reform had its specific mandate; it would be difficult to proceed under the PCT since some of the provisions envisaged under draft Rules 5 and 6 involved modifications of the PCT articles; draft Rules 5 and 6 related to substantive requirements under the SPLT; the SPLT aimed at the harmonization of national laws, while the PCT only regulated the international phase.

88. The International Bureau observed that, since the PCT was already operational, once the PCT Regulations were amended, they had an immediate binding effect on all Contracting States. The Delegation of the United States of America stated, however, that, since the mandate of the Working Group on PCT Reform was not limited to changes of the PCT Regulations, once the SCP would have identified substantive deviations from the PCT requirements, the Working Group should not put aside the possibility of PCT Treaty changes in the future. In response to a question raised by the Delegation of Argentina, the International Bureau explained that both the SCP and the PCT bodies generally operated on a consensus basis, and that non-member States of the PCT could participate in the PCT meetings as observer States. Recalling the discussions during the PLT negotiation, the Chair observed that the SPLT, which incorporated PLT and PCT provisions, would need a provision similar to Article 16 of the PLT regulating the mechanism to incorporate future amendments and modifications of the PCT.

89. After some discussion, the Chair concluded that in view of time constraints, the SCP would not discuss draft Rules 5 and 6 during this session. In order to facilitate the preparation

of the next draft, however, the International Bureau would send an invitation to the members and observers of the SCP to identify any requirements which needed to be contained in draft Rules 5 and 6, and to submit comments to the International Bureau in this regard, which would be posted on the SCP Electronic Forum. The starting point of the discussion would be the requirements under the PCT as regards claims, description, drawings and abstract of an application. Certain provisions under draft Rules 5 and 6 contained in document SCP/6/3, which are different from corresponding PCT provisions, should also be taken into account.

Draft Article 6: Unity of Invention

Draft Rule 7: Details Concerning the Requirement of Unity of Invention Under Article 6

90. The International Bureau explained that the text of draft Rule 7(1) corresponded to the PCT wording with a purely editorial change and that the word “technical,” which had been deleted by mistake, should be kept within brackets.

91. In response to a question raised by the Delegation of Australia on whether draft Article 5(2)(i) incorporated by reference PCT Rule 13, the International Bureau noted that the SCP should decide whether the mere incorporation of the PCT provisions on this issue was satisfactory or not. The Representative of the EPO proposed to replace “The claims in the application” by “The application” and noted that the principle of unity of invention should be discussed in conjunction with many other provisions. The Representative of UNICE stated that PCT Rule 13 should be applicable in view of PLT Article 23.

92. The Chair concluded that the discussion on the inclusion of PCT Rule 13 by cross-reference be considered in conjunction with draft Article 5(2).

Draft Article 7: Amendment or Correction of Application

Paragraph (1)

93. The International Bureau noted that the drafting should be reviewed taking into account some overlap with draft Article 15(1).

94. The Delegation of the United States of America asked to include a clarification regarding final rejections of certain continuation applications in the Notes. The Delegation of Japan said that the same should also apply to divisional applications. The Representative of the EPO, while welcoming the comment by the International Bureau as regards Note 14.B in document PLT/DC/69, said that the exclusion of certain divisional or continuation applications should be non-mandatory.

95. The Representative of the EPO highlighted the difference between mere “corrections,” which related to the correction of formalities and “amendments,” and stated that corrections such as, corrections in the name of the applicant should not be dealt with in draft Article 7. The Representative proposed to delete the words “and to make amendments...in the Regulations,” from draft Article 15(1), which, in her view, regulated the right to be heard.

96. Summarizing paragraph (1), the Chair stated that the proposal to include a reference to continuation and divisional applications in the Notes and the suggestion made by the Representative of the EPO would be considered by the International Bureau for the next draft.

Paragraph (2)

97. The Delegation of China stated that the current regulations in China provided for the possibility of amendments only before the acceptance of the first substantive communication by the Office and that they did not prevent the applicant from correcting or amending on his own initiative, but that this was possible only up to the first communication by the Office.

98. The Delegation of the United States of America suggested that a further definition of “the time when the application is in order for grant” be included in the Regulations or the Practice Guidelines. The Representative of the EAPO observed that, before his Office, the applicant could amend the application without going beyond the original disclosure until the time of the decision. The Chair mentioned that in Australian practice there was time for further amendments during the pre-grant opposition period. He also noted that the problem would be different for examining and non-examining Offices and suggested further elaboration in the Notes.

99. The Delegation of Canada noted some inconsistency in the use of the term “application” in draft Article 7. The Delegation assumed that the term would cover the application as defined in draft Article 5(2), which would, for example, include the request. In the second part of draft Article 7(2), however, the application was limited to description, claims and drawings. The only limitation in draft Article 7(3) related to adding new subject matter, but if the request was included in what could be corrected, this could include priority claims, which could raise a need for some limitation in draft Article 7(3).

100. The International Bureau agreed with the Delegation of Canada that there was an inconsistency. It explained that it had not been the intention to include the request in paragraph (3) and therefore the wording should be reviewed.

101. In response to the Delegation of Argentina, asking whether Contracting States were obliged to provide substantive examination, the Chair noted that the second part of paragraph (2) was an alternative, not an obligation.

102. The Representative of the EPO, supported by the Delegations of Egypt, Ireland, the Netherlands, New Zealand, Sudan and Switzerland, and the Representatives of AIPPI and UNICE, felt that a distinction had to be made between amendments and corrections of clerical and obvious mistakes, which should be allowed at any time. The Delegation of Japan was of the opinion that paragraphs (1) and (2) were less relevant for the SPLT than paragraph (3), and was reluctant to accept corrections in the description, claims or drawings at any time, since substantive modifications could be disguised as corrections. If it was a correction of a trivial nature, the Delegation did not see the need for the correction. The Delegation of the United States of America stated that corrections that changed issues during prosecution should not be allowed. The Delegation of Germany supported this provision in its present form, which appeared in the 1991 Draft. It observed that a distinction between corrections and amendments was not needed because this issue was covered by paragraph (3).

103. With regard to amendments that result in substantive changes, the Delegations of Ireland, the Netherlands, Sudan and Switzerland expressed the wish to limit the number of such amendments. The Delegations of Argentina and Egypt stated that, before their Offices, substantive amendments were allowed up to publication. The Representative of ARIPO explained that, in its practice, the deadline for amendments was the time when the decision on the grant of the patent was made by the designated State concerned. The Delegation of

New Zealand said that, in its country, corrections were allowed at any stage during the entire life of the patent, not only at the pre-grant stage. It suggested that the International Bureau prepare a survey of the practices of the Offices around the world. While understanding the heavy workload of major Offices, the Representative of IPIC pointed out that a solution to these problems should not affect the quality of their work and requested a more liberal approach as regards the second part of this paragraph.

104. In response to the Delegation of China, which stated that it was difficult to distinguish between corrections and amendments and that this was a matter for the examiner to decide on, the Chair observed that some clerical errors, for example, in the name of the applicant, would not be obvious to an examiner, but correction should nevertheless be allowed.

105. The Delegation of Argentina suggested a correction in the Spanish text. It noted that it was important for small inventors to be able to make amendments to the claims before substantive examination so that if, for example, the application contained subject matter A and B and only subject matter B was claimed, the applicant had a possibility to claim subject matter A by making an amendment. It was therefore important that the disclosure in the abstract could be included in other parts of the application by way of amendments.

106. Summarizing paragraph (2), the Chair noted that two issues of substance had been discussed, namely the meaning of the wording “the time when the application is in order for grant” and the proposal to distinguish between corrections and amendments which found wide support, although a number of delegations expressed a contrary view. The International Bureau was requested to further explore this issue for the next draft.

Paragraph (3)

107. The Delegation of Canada stated that a reference to the “application” in this paragraph was problematic in view of the definition of the term “application” in draft Article 5(1), which included the request. In response, the International Bureau explained that, in accordance with draft Article 10(2), in the context of the disclosure in the application, only the description, claims and drawings should be taken into account.

108. The Delegation of Germany expressed preference for the text of draft Article 14(3) in the 1991 Draft, which it found clearer. In response to that Delegation which made a reference to Rule 18 of the PLT, the Delegation of Canada said that that Rule was applicable to the correction to the extent that it was correctable by the Office under the applicable law of each Contracting Party.

109. The Delegation of Japan, supported by the Delegations of Canada, China and the United States of America, proposed to delete the words “of the invention contained” in subparagraph (a) because new matter should be determined based on the complete disclosure and the current text was not in conformity with PCT Articles 28(2) and 34(2)(b). The Delegation was of the view that the term “disclosure” offered sufficient flexibility in order to allow the addition of prior art.

110. The International Bureau noted that, in subparagraphs (a) and (c), the words “at the time of filing” should be enclosed in square brackets, and the bracketed words “[on the filing date]” should be inserted at the end of each sentence. The Delegation of the United States of America, supported by the Delegations of Australia and Morocco, and the Representatives of

the EPO and of UNICE, was in favor of using the term “on the filing date.” The Delegation of Canada preferred the wording “on the filing date,” but pointed out that this would not cover missing parts under PLT Article 5(6)(b). It therefore proposed to add the words “or included in the missing parts added in accordance with Article 5(6) of the PLT” at the end of the paragraph.

111. The Delegation of the United States of America, supported by the Representative of the EPO, proposed to replace in subparagraph (b) “Notwithstanding subparagraph (a)” by “In particular.” The Delegation also proposed to add, in the third line of subparagraph (c), after the word “correction,” the words “that is the only one that” which would be similar to the practice under Rule 91 of the PCT. The Representative of the EPO supported the proposal by the Chair to align the wording of subparagraph (c) to that of PCT Rule 91.1 and not to limit it to a “person skilled in the art,” but also to include the words “a member of the public.” The Delegation of Canada requested clarification on whether any documents other than the application could be used to determine the obviousness of clear mistakes.

112. The Delegation of China felt that it was not necessary to include subparagraphs (b) and (c) in the SPLT because the problem of corrections of the translation should be found in the PCT rather than in the SPLT.

113. The Delegation of New Zealand believed that the notion of “disclosure” should be extended to the information contained in the priority document. The Delegation of Argentina suggested a correction in the Spanish text.

114. The Chair summarized the discussion on paragraph (3) as follows: there was a clear support for the deletion of the words “the invention contained in,” subject to a revision of the Spanish translation. It was felt important that all provisions concerning amendments should be consistent and some delegations suggested the deletion of subparagraphs (b) and (c), while the majority wished to keep those provisions. There was a preference to use a wording similar to that of PCT Rule 91.1 and the question was raised which documents might be used to check whether an error is obvious, namely only the application or also other documents.

Draft Article 8: Prior Art

Paragraph (1)

115. The International Bureau drew the attention of the Committee to document SCP/6/INF/2, which contained a brief summary of the results of the questionnaire concerning the definition of prior art. The Delegation of Japan, supported by the Delegation of the Republic of Korea, requested clarification of the expression “all information.”

116. The Delegation of Romania proposed to add words at the end of the sentence in the sense of “provided that the date of making it available to the public be identifiable.” The Delegation of Ukraine, referring to draft Article 1(iv) and Note 1.02, proposed to replace “the subject matter of a particular claim” by “the claimed invention.”

117. The Delegation of the United States of America stated that the definition was not complete and should include admissions by the applicant. It was in favor of discussing the concept of loss of rights in this Committee. The Representative of the EPO agreed with the Delegation of the United States of America that if a formula was used secretly, it was not part of the prior art according to draft Article 8(1). It was, however, not in favor of introducing the

concept of loss of rights in the Treaty because of the subjective nature of such a standard. The Representative understood the necessity of such a provision under a first-to-invent system, while a first-to-file system sufficiently motivated the applicants to disclose the invention as soon as possible. The Representative of UNICE agreed with the Representative of the EPO and was not in favor of the concept of loss of rights. The Delegation of the United States of America added that there was no link between the first-to-invent system and the concept of loss of right. Instead, this concept was directed directly toward the fundamental *quid pro quo* of the patent system: early disclosure in exchange for patent protection, and is therefore equally applicable in a first-to-file system.

118. The Chair stated that, in Australian practice, prior secret use by the applicant would invalidate the patent even under the first-to-file principle. The Representative of the EPO noted that although in the old British system, prior secret use had been a reason for invalidation, it was not the case any longer since prior user's rights were introduced in order to be in line with the current European system. The Delegation of Australia stated that Australia also had prior user's rights but that the fact that a document was cited in an application did not necessarily mean that it was prior art. The Delegation of Germany opposed the inclusion of the concepts of loss of rights and secret use in this provision. The Delegations of Australia and the United Kingdom and the Representative of UNICE were in favor of the deletion of the words "[time of filing on the]." The Delegations of Germany and Sweden were of the view that the critical time for the determination of prior art was the filing date.

119. The Chair summarized the discussion as follows: there was no express support for keeping the expression "time of filing," some delegations wanted to include the concept of prior use and loss of rights, but fairly strong opposition was voiced by other delegations who felt that this was not appropriate or that this issue had to be discussed elsewhere. The International Bureau was asked to check whether the phrase "as prescribed in the Regulations" was appropriate, and to further elaborate the draft.

Paragraph (2)

120. The International Bureau explained that, pursuant to Article 11(3) of the PCT and, as provided for in draft Article 3(1) and draft Rule 3(1), any international application under the PCT filed with or for the Office of a Contracting Party would be part of the prior art under this paragraph, and that the results of the Working Group on Reform of the PCT regarding the designation system might influence the drafting of this paragraph.

121. In response to the Representative of FICPI who could not see any justification for any prior art effect of a PCT international application before it had entered the national phase, the International Bureau observed that, according to Article 11(3) of the PCT, a PCT international application had the effect of a national application in all designated States as of the international filing date, and that the only State which made a reservation under PCT Article 64(4)(a) was the United States of America.

122. The Delegation of Canada was of the opinion that PCT Article 27(5) provided sufficient flexibility for Contracting States in respect of the prior art effect of competing PCT international applications, and reserved its position on draft Article 8(2).

123. The Delegation of Australia, supported by the Delegation of Canada and the Representative of UNICE, expressed concern about the current wording of the provision

regarding the term “priority date” since the application could contain new subject matter which would not be entitled to priority. The Representative of UNICE proposed to replace the words “where applicable” by “to the extent that priority is claimed in accordance with the applicable national law.”

124. The Delegation of Canada stated that the “claim date” was relevant for the novelty of a particular claim which would not be novel if the subject matter was disclosed in an application filed before, or in an application filed later which was based on a priority application which disclosed the subject matter.

125. The Delegation of Cameroon pointed out that the French version did not correctly reflect the English text.

126. The Chair summarized the discussion on paragraph (2) by stating that the International Bureau should further review the provision taking into account the comments received.

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

Paragraph (2)

127. The Delegations of Canada, Japan and the United States of America agreed on the inclusion of the term “reasonable,” whereas the Delegation of Argentina, supported by the Delegation of Spain, requested a further elaborated definition of that term and the Delegation of the United States of America suggested adding some reference to catalogues or indexes. The Delegation of the Russian Federation, supported by the Representative of the EAPO, expressed preference for the term “legal” instead of “reasonable.” The Delegation of Germany opposed the term “legal” and proposed to further explain the term “reasonable” in the Notes.

128. The Delegation of New Zealand stated that some prior art, like well-known laboratory techniques, could not be catalogued and was also in favor of including some explanations in the Notes. The Delegation of Canada proposed that the issue be explored further and explanations be included in the Practice Guidelines rather than in the Notes. This proposal was supported by the Delegation of the United States of America, for which it was important that the term “reasonable” be defined in the SPLT.

129. The Representative of the EPO, supported by the Delegations of Austria and Cambodia, proposed to delete the reference to the person skilled in the art in subparagraph (b) and to replace the expression “not bound by any restrictions” by “not bound to any secrecy.” The Delegations of China and Germany expressed concern about draft Rule 8(2)(b) and requested further clarification. The Delegation of the United States of America suggested that the phrase “not bound by any restrictions” be replaced by “free to disclose” in order to more clearly set forth what is intended.

130. The Chair summarized the discussion as follows: the discussion focused on the word “reasonable” and its deletion, elaboration or change to “legal.” There was some support for the proposal to include explanations in the Practice Guidelines and there was agreement that the wording of paragraph (2)(b) should be revised.

Paragraph (3)

131. The International Bureau suggested to replace the expression “timing and contents” by “date and contents.”

132. The Representative of the EPO, supported by the Representative of AIPPI, stated that the requirement of evidence should not be limited to non-documentary disclosures, but to any disclosure which was doubtful. The Representative also reserved her position as to the expression “corroborative evidence.” The Representative proposed to delete the words “in non-written form” and pointed out that *ex-parte* and *inter partes* proceedings may require a different treatment. The Delegation of the United States of America stated that corroboration should be required for all non-written disclosure and suggested changing the term “may” to “shall” in the language of Rule 8(3).

133. Summarizing the discussion on paragraph (3), the Chair proposed to replace the word “timing” by “date.” In the next draft, the provision should not be limited to non-documentary disclosures, a difference should be made between *ex-parte* and *inter partes* proceedings and the issue of corroborative evidence should be addressed.

Paragraph (4)

134. The Delegation of Canada, supported by the Representative of the EPO, proposed to include a more generic definition. The Delegation of Argentina wondered how an Office would determine the timing at which the information had been made available. The Chair stated that the International Bureau would prepare a new draft with a more generic formulation.

Guideline Under Rule 8

135. The International Bureau suggested to delete the reference to paragraph (3), since the whole of draft Rule 8 was concerned. The Representative of the EPO noted that, if draft Rule 8 was redrafted as discussed, there might be no need for this Guideline anymore.

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

Paragraph (1)

136. Concerning subparagraph (a), the Delegation of the United States of America, supported by the Representative of AIPLA, proposed that the provision be applicable to both novelty and inventive step/non-obviousness. Regarding the Hilmer Doctrine, the Delegation noted that consultations were currently being held on this matter.

137. The Delegations of Australia, Brazil, Canada, Germany and the Russian Federation and the Representative of UNICE did not support the extension of the provision to inventive step/non-obviousness. The Delegation of Canada said that, while recognizing the concern of the Delegation of the United States of America whose patent system needed a provision that allowed the Office to refuse a claimed invention which was not patentable and distinct, the need did not exist in other systems. The Delegation of Germany said that the applicability of the provision to novelty only should be provided in the Treaty.

138. As regards subparagraph (b), the Delegation of the United States of America proposed to include abstracts created by the applicant in the whole contents of the application.

139. In response to the Delegation of Germany regarding draft Rule 9(1)(c) as to why utility models had been included and whether countries would be obliged to consider utility models as prior art, the International Bureau explained that the wording came from the 1991 Draft but that, in view of full harmonization, the provision had been drafted as a mandatory provision. The Delegation of Spain, which provides conversion of patent applications from/to utility model applications, and the Representative of UNICE supported the inclusion of utility models in this provision.

Paragraph (2)

140. The Representative of the EPO reserved her position on draft Rule 9(2) regarding the inclusion of the priority document for determining novelty. The reference made to the earlier application in line 4 of Rule 9(2) should be deleted, so that only matter contained in the former application itself should be considered to be prior art under this provision. The Delegation of China stated that it had some difficulty with draft Rule 9(2) where the former application contained a combination of the new subject matter and the subject matter that was contained in the earlier application.

Paragraph (3)

141. The Delegation of Germany supported this provision as proposed. The Delegation of Austria wondered whether draft Rule 9 was the right place for this provision since the prior art effect of published applications was dealt with under draft Article 8(1). The Delegation of Brazil felt uncomfortable with this provision because applications were published shortly after filing in Brazil.

142. The Delegation of the Russian Federation requested clarification of the term “rejected.” The Delegation of Canada understood this term as “finally rejected” and stated that an application which was still pending in any form at the publication date should be prior art. The Chair noted that the term “rejected” should be considered in a broad sense, including refusal, and that this provision might need further consideration in view of the situations where a rejected or refused application could be revived in accordance with, for example, an extension of time limits which was provided in the PLT. The Representative of the EPO proposed the term “no longer pending.” The Delegation of the Russian Federation stated that, if the law of a Contracting Party prevented publication of the former application, that should not be considered prior art. The Delegation of Brazil was in favor of a general provision as proposed by the Delegation of the Russian Federation and the Representative of the EPO. Further, the Delegation of the United Kingdom stated that if the provision was maintained, it should cover all cases which ceased to be pending.

Paragraph (4)

143. The Delegation of the United States of America supported the provision in view of user-friendliness, and suggested that the title read “Anti-Self-Collision.”

144. The Delegation of Japan, supported by the Delegation of Canada, proposed to reintroduce the term “inventor.” The Delegation of Japan also asked what would happen if two applications claiming the same invention were filed on the same day. This could be the

case for divisional applications filed by the same applicant or two applications from different applicants. The Chair explained that, under Australian practice, in case of different applicants, both would get a patent, but if the same applicant filed them, he would only get one patent.

145. The Delegation of the United Kingdom, supported by the Delegation of Spain, was of the view that this provision provided limited benefit to applicants. The Delegation asked clarification for the expression “one and the same person” and whether this would include subsidiary companies and successors in title, and pointed out difficulty of determining “the same claimed invention.” The Representative of the EPO, supported by the Representative of UNICE, stated that if an applicant’s first application was not yet published at the time of the filing of his second application, the applicant could always withdraw that first application prior to its publication in order to avoid a conflict with his second application. The Representative of UNICE proposed the deletion of the provision because of possible abuse, for example, an applicant could sell his application to avoid the novelty problem.

146. The Delegation of the Russian Federation wondered whether the reference should be to paragraphs (1) and (2) instead of to paragraphs (1) to (3).

147. The Chair summarized the discussion on draft Rule 9 as follows: with regard to paragraph (1), the inclusion of inventive step/non-obviousness, of the abstract in the “whole contents” and of utility models were discussed. Paragraph (2) should be redrafted in a more clear way. As to paragraph (3), the International Bureau should review the concept of “rejected, abandoned, withdrawn.” Concerning paragraph (4), the SCP expressed divergent views and the proposal to include the term “inventor” was made.

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

148. The Delegation of the United States of America proposed the deletion of the square brackets surrounding this Article, since there was no link between this Article and other issues in view of the fact that many of the countries which had a first-to-file system had introduced some form of grace period. Stressing the importance of international harmonization on this issue, the Delegation of Japan stated that, in general, the current draft was acceptable. The Delegation of the United Kingdom explained that, in its country, large businesses and the patent profession were against a grace period, while small businesses and researchers were in favor of it. The Delegation observed that this divergence was based on different needs, and called for alternative models for further consideration. The Delegation of France stated that, though the issue of grace period was political, it would not oppose a discussion by the SCP. Detailed consultations in its country revealed an awareness of the grace period as well as concerns by industry. The Delegation noted that, if it were included, the grace period should have certain characteristics so that it would not affect the rights of third parties. Therefore, it should be an immunity type, but not a priority type, grace period. The Delegation was also of the view that the grace period could be envisaged only within the framework of a first-to-file system. According to the Delegation, a declaration concerning the date and the circumstances of the disclosure should be submitted to the Office. The Delegation of Canada expressed its support to include provisions concerning a grace period which should be applicable to both novelty and inventive step. The Delegation of Germany stressed the importance of a grace period for small and medium enterprises which generated 50% of its national turnover. The Delegation explained that the grace period provisions under the Utility Model Law of its country had not created any legal uncertainty, as applicants still filed their applications as

soon as possible. Even without a grace period, legal uncertainty existed due to, for example, the publication of applications after 18 months. Although supporting the inclusion of grace period provisions in the SPLT, the Delegation of Austria noted that the grace period was linked to the first-to-file issue.

149. While supporting the introduction of a grace period, the Delegation of China suggested that a provision safeguarding the interests of third parties be included in order to strike a balance between the applicant and other parties. Recalling the discussion during the negotiation of the PLT, the Chair noted that the issue of intervening rights should be clarified by a provision or by the Notes.

150. The Delegations of Finland and Sweden considered that the grace period was linked to the first-to-file issue and suggested keeping the provision within square brackets. The Delegation of Switzerland was not opposed to the grace period, but reserved its position in view of the open questions related to such a grace period. The Delegation sought further clarification with respect to the scope of applicable “publication,” prior user’s rights and several publications on the same subject matter by different parties. The Delegation of the Netherlands stated that considerable opposition to a grace period existed in its country. Although the Delegation did not oppose the inclusion of the provision in the SPLT, its position would depend on the global outcome of the SPLT. The Delegation further stressed the importance of efforts for harmonization toward a first-to-file system. The Delegation of Belgium reserved its position and supported the intervention made by the Delegation of the Netherlands.

151. The Representative of the EC informed the SCP that, under the Directive 98/44 of the European Council and the European Parliament on the legal protection of biotechnological inventions, a report was planned to be sent to the European Parliament and the Council of the European Community on the implications for basic genetic engineering research of failure to publish, or late publication of, documents on subjects which could be patentable. The Representative explained that a questionnaire had been sent to the interested circles, and confirmed that any future development would be brought to the attention of the SCP. The Delegation of Ireland stated that, since the national patent system of its country was tied closely to the European framework, the Delegation could not articulate its position before clarification on that issue was achieved in the European context. The Delegation of Spain shared the concern raised by the Delegation of France and supported the position of the Delegation of Ireland.

152. The Representative of UNICE stated that European industry opposed the grace period because of legal uncertainty. The Representative of CIPA, EPI and TMPDF opposed the inclusion of grace period provisions because of the risk of litigation, legal uncertainty and the risk of having a non-harmonized standard for the grace period around the world. He considered that it was necessary to educate applicants not to publish before the filing date. If the grace period provisions were included, the Representative expressed the view that the grace period should be invoked only before the publication of an application and that prior user’s rights should be taken into account. The Representative of FICPI stressed the need of the grace period for small and medium enterprises as well as for university researchers as an adjustment of the absolute novelty standard by referring to the necessity of publishing, using and practicing their own inventions before filing a patent application. The Representative of ABA supported the position expressed by the Delegation of the United States of America that the grace period was not linked to the first-to-file principle. He stated that, though the grace period was particularly important for small and medium enterprises, in his country, large

corporations also supported a grace period. The Representatives of AIPPI and AIPLA were also in favor of introducing grace period provisions in the SPLT. The Representative of IIPS expressed concerns about prior user's rights and wondered whether the provision was applicable to the cases where an applicant had received the knowledge about the invention from the inventor. Supporting the interventions made by the Delegation of Germany and the Representative of FICPI, the Representative of the MPI said that not only university researchers who wished to publish their results at an early stage, but also industries, had an interest in a grace period due to the growing interaction between research institutes, universities and industry. The Representative of IPIC, supporting the Representatives of FICPI and ABA, said that a grace period provided great benefits under a first-to-file system, as was demonstrated by the Delegation of Canada. The Representative of BIO stated that the inclusion of grace period provisions was a prerequisite for his support to the SPLT.

153. Concerning the two alternative texts, the Delegation of France supported Alternative A, while the Delegations of Canada, Morocco, Sudan and the United States of America supported Alternative B.

154. The Delegations of Germany and Ireland suggested that the International Bureau distribute the two studies on the grace period commissioned by the EPO Administrative Council in 2000.

155. With respect to paragraph (1), the Delegation of the United States of America, supported by the Delegation of Kenya, proposed that the words "anywhere in the world in any form" be added after the words "the information was made available to the public," as appeared in draft Article 8(1). The Delegations of Kenya and the Russian Federation were of the view that a 12-month grace period was too long. The Delegation of Morocco suggested a six-month grace period.

156. As regards item (ii) of paragraph (1), the Delegation of the United States of America, supported by the Delegations of Canada and the Russian Federation, suggested the deletion of the words "and should not have been made available to the public by the Office." However, the Delegation of Japan opposed this proposal on the grounds that it would introduce a broad exception to the first-to-file principle.

157. Further, the Delegation of the United States of America proposed that experimental use be also excluded from the prior art. The Delegation of Japan, while supporting the proposal made by the United States of America, wondered if current item (i) already covered that situation.

158. In response to the observation made by the Delegation of Argentina concerning paragraph (3), the Chair noted that this provision would be necessary to prevent third parties from raising the effect of a publication made by the applicant before the filing date during invalidation proceedings.

159. The Chair summarized the debate by stating that there was a wide support to include some form of grace period into the SPLT. Some delegations reserved their positions without, however, expressing opposition to the inclusion of any text. As regards the link to the first-to-file system, while noting that square brackets surrounding a text were significant when presented in a basic proposal for a Diplomatic Conference, at this point, the Chair suggested the deletion of the footnote and the square brackets surrounding draft Article 9, and added that the SCP could, if necessary, revisit this issue once the full range of issues under the SPLT had

been further elaborated. The SCP agreed with the suggestion by the Chair and mandated the International Bureau to redraft the provisions taking into account the comments received.

Draft Article 10: Enabling Disclosure

Paragraph (1)

160. The Delegations of Japan and the United States of America supported the inclusion of the concept of “undue experimentation.” In response to a question raised by the Delegation of Japan, the Chair explained that the words “made and used” in draft Article 10(1) meant that the disclosure should be such that the invention could be made and used by a person skilled in the art, while the words “make or use” were used in draft Rule 10(2)(vi) in the context of a factor to be considered for the purpose of assessing whether the experimentation required was undue or not. The Delegation of the United States of America requested the International Bureau to review the drafting style of current paragraph (1) using two sentences.

Paragraph (2)

161. The Chair noted that the points raised with respect to the abstract under draft Article 5(3) were also applicable to this provision.

Draft Rule 10: Sufficiency of Disclosure Under Article 10

Paragraph (1)

162. The Delegation of the Republic of Korea noted that the substance of this paragraph was already contained in draft Article 10(1) and pointed out a redundancy between paragraph (1) and items (iii) and (vi) of paragraph (2). The Delegation of Japan expressed its view that there was a redundancy between paragraph (1) and items (iii) and (iv) of paragraph (2). The Delegation of the United States of America suggested that further methodology for the determination of “general knowledge of a person skilled in the art” and the standards for substantive evidence when making such a determination be provided in the Practice Guidelines.

Paragraph (2)

163. The International Bureau confirmed that the list of factors under paragraph (2) was of a non-exhaustive nature. The Delegation of the Russian Federation, supported by the Delegation of Argentina, which found the term “undue experimentation” unclear, expressed the view that the details concerning “undue experimentation” should be contained in the Practice Guidelines. In response to questions raised by the Delegations of Japan and the United States of America, the International Bureau explained that the terms “the nature of the claimed invention” in item (ii) could mean, for example, subject matter of the claimed invention, and “references” in item (v) could be references to prior art provided in the application. The Chair added that the location of this paragraph, either in the Regulations or in the Practice Guidelines, should be further reviewed.

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

164. The Representative of the EAPO suggested that paragraph (1) be moved to draft Article 10.

165. Concerning the second sentence of paragraph (1), the Delegation of the Republic of Korea noted that, if a Contracting Party was allowed to require the deposit of biologically reproducible material on the filing date of a patent application, in order to obtain a certificate of the deposit on the filing date, in practice, the deposit should be made before the filing date. The Chair noted that the issue of deposit certificates was not addressed in draft Rule 11. The Delegation of Canada observed that the deposit did not simply supplement the disclosure as indicated in draft Rule 11(1), but that the deposit should be considered a part of the disclosure to the extent that the disclosure requirements could not be otherwise complied with.

166. The Delegation of the Russian Federation, supported by the Delegation of Argentina, proposed that the deposit referred to in the second sentence of paragraph (1) be made on the claim date, since, where a priority was claimed, the subject matter of the application claiming the priority, which included the disclosure of the claimed invention through the deposit, should be disclosed in the earlier application on the priority date. The International Bureau, supported by the Delegations of Canada and France and the Representative of AIPPI, however, explained the need for the term “filing date” as proposed, since the priority document did not necessarily disclose the claimed invention in an enabling manner, and since the issues of disclosure and of claiming priority were two different matters.

167. The Delegation of the United States of America wished to retain the second sentence of paragraph (1) as proposed. Since, in its view, a full disclosure of the invention should be set forth in the application, with the exception that a person skilled in the art needed access to the deposited material to make and use the invention, the Delegation considered the deposit as a mere ministerial function that could be performed after the filing date, although the applicant should corroborate that the deposited material and the material identified in the patent application were identical, that the deposit was properly made and that all access restrictions would be irrevocably removed for the duration of the patent. The Representatives of AIPLA, BIO and IIPS supported the Delegation of the United States of America in view of the administrative flexibility that was given to the applicants. The Representatives of the EPO and IPIC, however, were in favor of deleting this sentence. The Delegation of Romania pointed out that the words “the deposit has been made” in draft Rule 5(1)(iv) suggested that the deposit had already been made when the description was prepared. The Delegations of France and Germany and the Representative of the EPO raised a concern about the consistency of this sentence with draft Article 7(3). The Delegations of France and Germany and the Representatives of the EC and AIPPI reserved their position concerning the second sentence of paragraph (1). The Delegation of the Russian Federation stated that the disclosure of the claimed invention should not depend on the field of technology, and opposed the deletion of the second sentence of paragraph (1). In connection with the observation made by the Representative of IPIC, wondering if an analogous treatment to the later filing of a missing page under the PLT was applicable to the later deposit of biological material where an applicant simply forgot the deposit, the Delegation of the Russian Federation noted that, though the same approach as the PLT could be taken as far as a missing part of the description was concerned, the later deposit of biological material could not be treated in the same manner and should be considered as addition of new matter.

168. In response to a question posed by the Delegation of New Zealand, the International Bureau explained that the SPLT did not regulate possible subsequent procedures where the sufficiency of disclosure was not complied with, such as, for example, the possibility of according a new filing date or filing a new application.

169. The Chair summarized the discussions concerning draft Article 10(1) and draft Rule 11 by noting that most of the discussion related to draft Rule 11(1), and in particular, to the timing of the deposit, the significance of the deposit with respect to the substantive versus the formality nature of the disclosure, the analogous treatment of the late submission of a missing part of the description and the later deposit, and the effect of a deposit which was outside the scope of the Budapest Treaty.

Draft Article 11: Claims

Paragraph (1)

170. The Delegation of the United States of America, supported by the Representative of AIPLA, proposed that the words “for which protection is sought” be replaced with the words “which the applicant regards as his invention” which appeared in Note 11.01 of document SCP/6/4. The Delegation of Canada, however, was in favor of keeping the concept of the claims as defining the matter for which protection was sought, although it did not oppose the proposal by the Delegation of the United States of America. The Delegation of Japan expressed interest in the proposal made by the Delegation of the United States of America. The Delegation of Australia supported this provision as proposed in document SCP/6/2. The Representative of UNICE was of the view that this paragraph was already covered by the PCT.

Paragraph (2)

171. As regards the “totality” of the claims, the Delegation of the United States of America said that further clarification as regards the number of claims was needed and that the substance of Note 11.03 in document SCP/6/4 could be included in the Treaty or the Regulations. The Delegation of Japan noted that the clarity and conciseness of claims related to the workload of Offices. The Representative of the EPO reserved its position as regards the words “both individually and in their totality.” The Representative of AIPLA opposed these words and said that the determination of what constituted a sufficient number of claims should be left to the applicant.

Paragraph (3)

172. The Delegation of China underlined the importance of harmonization on the issue covered by this paragraph. The Delegation of the Russian Federation supported subparagraph (a) as proposed. The Delegation of the United States of America stated that subparagraph (a) was covered by draft Article 10(1). The Delegation of Canada was of the view that subparagraph (a) was not needed in view of draft Article 10(1), although the Delegation did not oppose repeating the point. Noting that, according to draft Article 14, the requirement under subparagraph (a) was not a ground for invalidation, the Delegation of Japan explained that, in order to refuse a claim which was unreasonably broad, some countries invoked the support requirement as prescribed in subparagraph (a), while others invoked the enabling requirement as prescribed in draft Article 10(1), and requested clarification on these two requirements. The Chair noted that, in Australia, non-compliance

with the support requirement could be a ground for invalidating a patent. The Representative of the EPO wondered if, in addition to drawings, sequence listings and other documents should also be taken into account.

173. As regards subparagraph (b), the Delegations of Cameroon, Canada and the Russian Federation, supported by the Representatives of CIPA and IPIC, said that an additional condition beyond enabling disclosure should not be required. The Representative of UNICE requested the deletion of subparagraph (b), which was an additional requirement not contained in the PCT. The Delegation of China sought clarification as regards the relationship of claims, the disclosure of the application and the disclosure contained in the description. Supporting the subparagraph as proposed, the Delegation of the United States of America explained that the provision would prevent an applicant from obtaining a right to the claimed invention which was not actually invented as of the filing date. The provision was particularly important in the field of biotechnology or chemistry, which were of unpredictable technical nature. For example, where a product could be made as an end result using a known technique, i.e., satisfying the enabling disclosure requirement, if no one knew what the product was as of the filing date, the product could not be regarded as truly invented by the inventor as of the filing date. Although the concept laid down under this subparagraph was unfamiliar to the Delegation of Japan, it shared the concerns raised by the Delegation of the United States of America, particularly in respect of the area of biotechnology. The Representative of FICPI supported subparagraph (b) as proposed with the understanding that the provision addressed the substantive aspect of the disclosure of the invention as claimed. Stressing the importance of the disclosure requirement, the Representative requested harmonization of the rules and practices with respect to overly broad claims, and indicated that lack of support by the disclosure should be a ground for the revocation of a patent.

174. The Representative of the EPO suggested that the International Bureau should undertake a comparative analysis on the relationship of the claims to the disclosure, which might demonstrate that Europe, Japan and the United States of America have substantially similar practices which probably often lead to the same result despite the differences in the terminology used under their respective laws. In this context, the Delegation of the United States of America referred to the studies conducted by the trilateral offices.

175. The Chair summarized the discussions concerning draft Article 11(1) to (3) as follows: The International Bureau should further review the provision taking into account the comments made, in particular, the reference to the words “individually and in their totality” in paragraph (2) and the relationship with the corresponding provisions under the PCT. Concerning paragraph (3), noting the divergent views expressed by the SCP and referring to the suggestion made by the Representative of the EPO, the Chair suggested to first explore the practices of each Office in order to understand the underlying concepts and, in a second step, to establish the terminology properly reflecting those practices.

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

176. The International Bureau noted that the words “at the time of filing” which appeared in paragraphs (1) and (3) should be placed within square brackets, that the bracketed words “[on the filing date]” should also appear as an alternative, and that the discussion under draft Article 8(1) should be reflected in the context of this draft Rule.

Paragraph (1)

177. The Delegation of the United States of America, supported by the Representative of CIPA, pointed out that draft Rule 12(1) went beyond what was covered by draft Article 11(4), and stated that an abstract, a dictionary or an affidavit might also be taken into account under certain circumstances for the establishment of the term “general knowledge.”

Paragraph (3)

178. Concerning subparagraph (b), the Delegation of the United States of America proposed to add the words “unless the applicant agrees that the claimed invention is so limited” at the end of sentence. The Delegation of China suggested that the words “shall not remove” be replaced by the words “may not necessarily remove.” The Delegation of Germany, supported by the Representative of CIPA, expressed deep concern about the vague language of subparagraph (b), which might be interpreted as a basis for introducing “file wrapper estoppel” that could be abused by an alleged infringer and be disadvantageous to applicants. The Delegation was of the view that this issue should be dealt with on a case by case basis.

Paragraph (4)

179. The Delegation of the United States of America reserved its position concerning means-plus-function claims under subparagraph (a), and indicated that this subparagraph should also be applicable to claims defining “steps.” As regards subparagraph (c), the same Delegation said that the words “substance or composition” should be replaced by the word “product.”

180. The Delegation of the Russian Federation said that this paragraph was not extensive enough, and that it could be moved to the Treaty. Further, the Representative of UNICE proposed the inclusion, in draft Rule 12, of a new paragraph stating that references to the description or drawings in the claims should not limit the interpretation of claims.

181. The Chair concluded the discussion concerning draft Article 11(4) and draft Rule 12 by stating that the International Bureau would revise the provision taking into account the comments made, in particular, the relationship between draft Article 11(4) and draft Rule 12(1) and the possibility of including a general provision as regards evidence. The Chair also noted that the discussion concerning file wrapper estoppel would be further explored at future meetings.

Draft Article 12: Conditions of Patentability, Paragraph (1)

Draft Rule 13: Exceptions to Patentable Subject Matter Under Article 12(1)

182. The International Bureau explained that, although the terms “industrial applicability” and “utility” had disappeared from the text, the essence of these requirements was subsumed under draft Article 12(1) and draft Rule 13(1) concerning patentable subject matter, as well as other requirements, such as the enabling disclosure requirement. While the Delegations of Australia and Canada supported the general approach of the provisions as proposed, most of the delegations did not support merging the concept of industrial applicability/utility with other requirements. The discussion focused on the following issues: (i) the scope of patentable subject matter and exceptions; (ii) whether to retain the term “industrial applicability” and “utility.”

183. As regards the first issue concerning the scope of patentable subject matter and exceptions, the Delegations of Australia, Canada and the United States of America supported a broad provision in paragraph (1). The Delegations of Australia and Canada were of the view that, since the SCP was not likely to agree on all patentable subject matter issues, they were open to a range of exception provisions. The Delegation of Canada encouraged further discussion by the SCP on the underlying principles relating to these issues, so that the provisions set forth would not result in different interpretations and practices at the national level. This view was supported by the Representative of IPIC.

184. One of the main issues debated was whether, to be patentable subject matter, the invention should have a technical character or not. The Delegations of Belgium, speaking on behalf of the European Community and its Member States, Argentina, China, the Dominican Republic, Morocco, Norway, the Republic of Korea, Romania and Switzerland and the Representatives of the EPO, UNICE and UPEPI considered that an invention should have a technical character. The Delegation of Belgium, speaking on behalf of the European Community and its Member States, objected to the words “in any field of activity” in draft Article 12(1) and proposed to use the wording of Article 27.1 of the TRIPS Agreement. The Delegation of Japan suggested two possibilities: the first, which was supported by the Delegation of Switzerland, was to provide a positive definition of patentable subject matter, i.e., a definition of the term “invention,” and the second was to include, in draft Article 12(1), a statement that patentable subject matter must have a technical nature and must use laws of nature. Alternatively, the Delegation proposed to add two items, namely inventions not using laws of nature (which might allow to exclude business methods and software *as such*) and inventions not of a technical nature (which might exclude mere skills), in the non-exhaustive list of exceptions under draft Rule 13(1).

185. The Delegation of the United States of America was of the view that requiring a technical character was unnecessarily limiting the innovations in new fields of endeavor, such as information technology and biotechnology, and that the term “in all fields of technology” which appeared in Article 27.1 of the TRIPS Agreement was not mandating any requirement relating to technical character. The Delegation added that the standard for patentability should be that an invention need only provide for a practical application having a useful, concrete and tangible result. This view was supported by the Representatives of AIPLA, BIO and IIPS.

186. The second highly debated issue were the exceptions to patentable subject matter. The Delegation of Brazil, supported by the Delegation of Argentina, proposed to incorporate Article 27.2 and 27.3 of the TRIPS Agreement, and to include a general provision allowing exceptions to patentability which would be necessary for the protection of public health and environment. The Delegations of Guatemala and the Russian Federation and the Representative of the EAPO also referred to the provisions in the TRIPS Agreement. In view of the different character of the TRIPS Agreement on the one hand, which provides for minimum requirements under the WTO, and the SPLT on the other, which aims at establishing best practices at the international level, the Delegation of the United States of America, supported by the Representative of BIO, opposed the inclusion of the exceptions contained in Article 27.2 and 27.3 of the TRIPS Agreement at this stage, in particular with respect to plants and animals.

187. In response to a question raised by the Chair, the Delegations of Canada, Ireland, Mexico and Switzerland and the Representatives of the EPO and BIO, which intervened spoke in favor of a non-exhaustive list of exceptions. The Delegation of Belgium, speaking

on behalf of the European Community and its Member States, and supported by the Representative of the EPO, stated that the exceptions in draft Rule 13 should be in the Treaty itself. The Delegation of Australia said that the exceptions could be in the Regulations. In this context, the Chair noted that the Committee should bear in mind possible future technical developments and the possibility of establishing a differentiated voting mechanism to amend the Regulations.

188. As regards the exceptions under draft Rule 13(1), the Delegation of the Dominican Republic, supported by the Delegation of Argentina, observed that this list seemed to be exhaustive and asked whether Contracting Parties would be obliged to accept computer programs, business methods and rules for playing games as patentable subject matter. The Delegation of the Russian Federation suggested to include the information or software. In response to an observation made by the Delegation of Romania, the International Bureau explained that inventions such as perpetual motion machines or an invention unattainable in practice would not be patentable subject matter, since they would fall under the exception of draft Rule 13(1)(ii). The Delegation of Sudan proposed a new paragraph in draft Article 12 as follows: “Nothing in this Treaty shall limit the right of a Contracting Party to preclude from patentability such matters which it deems fit.”

189. With respect to the second issue regarding industrial application and utility, the Delegations of Belgium, speaking on behalf of the European Community and its Member States, Argentina, Brazil, the Dominican Republic, Guatemala, Japan, Mexico, Norway, Romania, the Russian Federation and Switzerland, and the Representative of the EPO wished to keep the concept of industrial application as a separate requirement. One of the major reasons illustrated by these delegations was that the existing international and regional agreements, for example, Directive 98/44 of the European Council and the European Parliament on the legal protection of biotechnological inventions and Article 27.1 of the TRIPS Agreement, contained the requirement of industrial application. The Delegation of Belgium, speaking on behalf of the European Community and its Member States, said that reducing the requirements at this stage was not politically opportune, and endangered the balance of the TRIPS Agreement. In response to a concern raised by some delegations, the International Bureau explained that, even in the absence of the term “industrial application” in the SPLT, a Contracting Party may apply the requirement of industrial application, provided that such requirement met the conditions set forth in the SPLT. The Delegations of Japan and Romania said that the overlap between the requirement of industrial application and other requirements could be further examined.

190. The Delegation of the United States of America considered that the utility requirement was covered under paragraph (1) by the word “made and used,” and opposed the inclusion of industrial application which was self-limiting and discouraged innovations in emerging fields.

191. The Delegation of the United States of America also suggested that the title of paragraph (1) be replaced by “Patent Eligible Subject Matter.”

192. The Chair concluded the discussion of draft Article 12(1) and draft Rule 13 as follows: a majority of the SCP supported the retention of industrial application as a distinct requirement. There was a clear divergence in the Committee as regards the technical character of the invention and the list of exceptions, both in terms of the structure of the provisions as well as their substance. The International Bureau received the mandate to further review the provisions in view of the comments made.

Paragraph (2)

193. There was general agreement on this provision. The Delegation of New Zealand proposed to replace the word “as” by the term “in a manner.”

Paragraph (3)

194. The Delegation of Germany stated that the provision was too close to the text of Alternative B as presented in draft Article 18 of document SCP/5/2, and that the term “differences and similarities” should be moved to the Regulations. In addition, the Delegation reiterated its concerns with respect to the term “claim date” and also suggested to use the term “inventive step” only and to delete the term “non-obviousness.” The Delegation of the United Kingdom also voiced concerns with the term “differences and similarities,” since it could hide the fact that the invention as a whole had to be non-obvious. The Delegation of the United States of America, supported by the Delegation of Japan with respect to the first two items, expressed the wish to (1) keep the term “differences and similarities” in the Treaty itself, (2) to replace the word “it” by “the claimed invention as a whole” and (3) to keep the term “non-obviousness” at this stage. The Chair suggested to introduce the words “as a whole” after the words “claimed invention,” in order to meet the concerns raised, in particular, by the Delegation of the United Kingdom.

195. The Chair summarized the discussion as follows: the International Bureau would revisit the provision, taking into account, in particular, the issue of the non-obvious character of the invention as a whole and the proposal of the Delegation of Canada made in the framework of draft Article 1(ix), second sentence, as regards the term “claim date.”

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

196. The Delegation of Argentina proposed to delete paragraph (1)(ii), since, for the purpose of novelty, a prior document had to exactly mirror the claimed invention, but did not need to be enabling. The Delegation of the United States of America, supported by the Delegations of Japan, Egypt and Romania, and the Representative of the EPO, opposed that proposal, since, in its view, a document, to be novelty-destroying, must be enabling for a person skilled in the art. The Representative of CIPA pointed out that the whole of the claimed invention must be enabling.

197. The Delegation of Japan addressed the issue of the relevant time for making available to the public the secondary items of prior art under draft Rule 14(2), and advocated that these items must have been made available to the public before the primary item of prior art, except for item (iv), which could be made available to the public after the claim date. The Delegation of Australia pointed out that the reference to a person skilled in the art was not needed in respect of item (ii) of paragraph (2). In the same paragraph, the Representative of CIPA questioned the appropriateness of item (iv), since what had not been made available to a person skilled in the art could not be part of the prior art. In response to that intervention, the Representative of the EPO proposed to insert the word “explicitly” before the word “disclosed” in item (iv), and, as a consequential change, also in paragraph (3) of the draft Guideline under Rule 14. The Chair indicated that items (i), (iii) and (iv) of draft Rule 14(2) were of an evidentiary nature rather than items of prior art in themselves. Supporting the Chair, the Representative of IPIC stated that item (ii), which might include the incorporation by reference of other applications, went beyond draft Article 12(2), and that the dividing line

between item (ii) and the prohibition of taking into account multiple items of prior art under draft Article 12(2) might be difficult to draw.

Draft Guideline Under Rule 14: Methodology for Assessment of Novelty

198. As regards paragraph (2), the Representative of EPI proposed to include, possibly in the Notes, the widely recognized practice of allowing disclaimers to overcome novelty objections.

199. The Chair summarized the discussion on draft Article 12(2), draft Rule 14 and the draft Guideline under Rule 14 by noting that the requirement of novelty was already fairly well harmonized. With regard to draft Rule 14(1), he stated that a majority of delegations had expressed the wish to retain item (ii). As regards draft Rule 14(2), the following issues would have to be looked into: the nature of items (i), (iii) and (iv); whether item (ii) was already covered by the introductory words of paragraph (2); whether item (ii) was going beyond draft Article 12(2) by allowing a mosaic approach to novelty; and the issue of inherent disclosure in item (iv).

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

200. The Delegations of Canada, Japan and Germany, and the Representatives of the EPO and EPI sought clarification as to the meaning of the term “motivation” in paragraph (1). While the Delegation of Canada and the Representative of the EPO suggested to use a different wording, such as for example terminology utilizing the word “obvious,” the Delegation of Japan proposed to keep the term “motivation,” but to explain it in the Notes. The Representative of IPIC pointed out that the term “motivation,” which was not used in Canada, but in the United States of America, was useful and suggested to develop a new term along the same line acceptable to everybody.

201. The Delegation of Japan stated that more elaboration for assessing inventive step/non-obviousness beyond motivation and general knowledge were required, and that additional factors, such as, for example, the ordinary inventive ability of a person skilled in the art to select appropriate material or to adapt the prior art to a particular technology, or the mere mosaicing of different pieces of prior art, should be elaborated in the Guidelines. The Delegation of the United States of America, while supporting the general thrust of the intervention of the Delegation of Japan, stated that a greater elaboration of non-obviousness was required, but that the factors mentioned by the Delegation of Japan could not be sufficient to conclude obviousness without the necessary motivation or reasoning. The Delegation further proposed to include the enablement requirement with respect to non-obviousness, as was the case regarding novelty in draft Rule 14(1)(ii). The Delegation of China queried whether paragraphs (1) and (2) could be combined into one provision. This proposal was not agreed to by the Representative of the EPO, who pointed out that paragraph (1) was of an optional character, while paragraph (2) was mandatory.

202. The Chair summarized the discussion by stating that the term “motivation” should be re-examined, and either changed or at least further elaborated in the Practice Guidelines, and that there was no support for merging paragraphs (1) and (2).

*Draft Guideline Under Rule 15: Methodology for Assessment of Inventive Step/
Non-Obviousness*

203. With regard to paragraph (1), the Delegation of China, supported by the Delegation of the Republic of Korea, proposed to invert items (i) and (ii). The Delegation further stated that item (iv) was repeating what was already contained in draft Article 12, and stated that paragraph (2) was not an exhaustive list. In relation to paragraph (1), the Representative of IPIC drew the attention of the SCP to the fact that the term “characteristics” in item (ii) was broader than other terms used in other provisions of the draft SPLT. The Delegation of the Republic of Korea, referring to item (v) of paragraph (2), took the view that the commercial success must be derived from the technical features of the claimed invention. The Delegation of the United States of America opposed that statement as far as the technical features were concerned, while supporting the provision in general. The Delegation added that the criteria contained in paragraph (2) should not be a requirement for a *prima facie* finding of obviousness, but should more appropriately be viewed as rebuttal factors.

204. The Chair summarized the discussions as follows: under paragraph (1), the main issues discussed were the appropriateness of the term “characteristics,” the review of the term “motivation,” which, if it was kept, should be contained in the steps for assessment of non-obviousness, the question of the determining factors of the commercial success of the invention and the decision to invert the order of items (i) and (ii). As regards paragraph (2), it was recognized that the provision did not constitute an exhaustive list and the question was raised whether these factors, in an examination environment, were to be established in the first instance by the person raising the objection or whether they were rather answer-type submissions in *ex-parte* procedures.

Draft Article 13: Grounds for Refusal of a Claimed Invention

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

205. The Delegation of the Dominican Republic referred to its statement made at the last session of the SCP (see paragraph 168 of document SCP/5/6) regarding the inclusion of additional grounds for refusal of an application or the invalidation of a patent due to failure to meet requirements laid down by virtue of international obligations imposing the implementation of certain principles, such as the conservation of biodiversity, imposed by the Convention on Biological Diversity, or the protection of traditional knowledge. In that connection, the Delegation repeated the proposal that it had made at the time, on behalf of several delegations, for the insertion of a new paragraph as an exception to paragraph (2) of the then Article 19 on the prohibition of other requirements for the claimed invention to be patentable, which in the revised version of the draft Treaty appeared in Articles 13 and 14. The Delegation further stated that, in its view, the draft SPLT should not affect the freedom of Contracting Parties to introduce provisions concerning administrative and/or criminal sanctions for non-compliance with certain national norms. In other words, the State had to retain its right to impose sanctions, including for ineligibility to obtain a patent, on a person who violated certain domestic provisions, for example those on access to genetic resources. In addition, the Delegation made it clear that the proposal that it had made neither contravened nor constituted a failure to abide by the TRIPS Agreement, as what it proposed was not additional conditions of patentability. TRIPS only specified what the conditions were for an invention to be considered patentable (industrial applicability, novelty, inventive step), not what the legal and formal requirements were for a patent actually to be granted, which were a matter for the domestic law of Members of the WTO. That statement was supported by the Delegations of Peru and Venezuela.

206. The SCP acknowledged that there were a number of issues to be debated in respect of these provisions, but decided, following a proposal by the Chair, not to discuss draft Articles 13 and 14 in depth at this stage, and to revert to those provisions once the contents of the other provisions of the draft SPLT would be better delimited.

Draft Article 15: Observations and Review

Draft Rule 16: Time Limit Under Article 15(1)

207. The Delegation of the United States of America proposed to add the words “or claimed invention” after the word “application” in draft Article 15(2) in order to overcome an inconsistency with the title of draft Article 13. The Representative of the EPO did not agree with that proposal, since only an application, but not a claimed invention could be refused or rejected, and further proposed to delete the words “and to make amendments and corrections where permitted under the applicable law,” in draft Article 15(1).

Draft Article 16: Relationship to PLT

Draft Article 17: Regulations

Draft Article 18: Practice Guidelines

208. The SCP agreed with a proposal by the Chair to set aside the discussion of these provisions, and to concentrate on the substantive provisions at this stage.

Proposal for a Working Group on Multiple Invention Disclosures and Complex Applications

209. The Delegation of the United States of America introduced a proposal for the establishment of a Working Group on multiple invention disclosures and complex applications (document SCP/6/6) under the SCP. The Delegation explained that the standard of unity of invention might be outdated in view of complex applications, in particular in the framework of, but not limited to, applications in the field of new technologies and applications with numerous claims. Offices were facing increasing difficulties in processing these complex applications, which lead to growing workloads. The Delegation identified four objectives to be pursued by such a Working Group: (1) to reduce the burden on examiners in view of the growing workload of Offices; (2) to focus on the prosecution of an application on a single invention; (3) to develop practices for limiting claims easy to understand and applicable consistently in practice; (4) to consider the long-term viability of such practices.

210. The proposal was supported by the Delegations of Australia, Canada, China, Denmark, France, Germany, Japan, Mexico, the Republic of Korea, Spain, Sudan and Venezuela, and the Representative of the EPO. The Delegation of Australia, supported by the Delegation of Canada and the Representative of IPIC, recalled that certain existing practices on unity of invention in fact did lead to an increased workload themselves, and that any measures considered in the framework of harmonization would have to aim at simple provisions meeting the needs of searches and third parties. Further, such measures should adequately relate the fee to the search and examination efforts required. The Delegation of Japan proposed that the agenda of the Working Group should, beyond unity of invention, include issues such as multiple dependent claims, the clarity and conciseness of claims and criteria for the inadequate disclosure of the claimed invention. The Delegation further questioned whether the workload issue was more relevant in the case where one application contained many claims than in the case where many single applications contain one claim. It also advocated that any new criteria should be easy to understand and consistently applicable for

both applicants and Offices. The Delegation of China agreed that the Working Group should achieve easy and simple standards and that there was a need to modify the PCT Regulations in order to achieve this objective. It further proposed that Offices should have the possibility to reasonably limit the number of claims. The Delegation of the Republic of Korea, further to its general support to the establishment of a Working Group, expressed the view that there were other important issues, such as the standard of inventive step or the establishment of criteria to determine whether an invention was the same invention as the invention as filed, which should also be addressed by the Working Group. The Representative of UNICE recalled that the practice of unity of invention was apt to meet most of the concerns raised, and that other measures, such as the limitation of searches or a fee-regulated mechanism, should be investigated with regard to workload problems of Offices. The Delegation of Canada, supported by the Delegation of Australia, suggested that the discussions of the Working Group could be improved through an increased use of electronic means.

211. The Delegation of Denmark, supported by the Delegations of Canada and France, stated that participation in the sessions of the Working Group should be open to all members of the SCP. The Representative of BIO queried whether non-governmental organizations would also be invited to the sessions of the Working Group. The Delegation of France, supported by the Delegation of Spain, requested that full interpretation during the sessions of the Working Group should be provided. The Delegation of Mexico, supported by the Delegation of Venezuela, expressed concerns on the proliferation of Working Groups at WIPO, the attendance of which created problems, in particular, for developing countries. The Delegation advocated that financial assistance should be provided to developing countries for their assistance in sessions of the Working Group.

212. The International Bureau explained that the current budget did not allow for financial assistance and full interpretation with respect to sessions of the Working Group held separately from the four sessions of the SCP planned for the next biennium, but that, if the sessions of the Working Group were held in conjunction with, and during the same week as, the SCP, the issue of financing certain delegations could be covered by the financing for the ordinary session of the SCP. Further, in that case, interpretation could also be provided. In addition, the International Bureau explained that, in view of the flexibility of the Rules of Procedure of the SCP, it was within the competence of the Committee to decide on the admission of non-governmental organizations as observers to the sessions of the Working Group.

213. After some discussion, the SCP agreed that the first session of the Working Group would be held in conjunction with, and during the same week as, the next SCP meeting. In addition, the SCP agreed that all members and observers of the SCP would be admitted to the sessions of the Working Group. The SCP further agreed that the following issues would, in particular, be examined as part of the mandate of the Working Group: (i) unity of invention, (ii) the linking of claims, (iii) the number of claims, (iv) the requirement of “clear and concise” claims, (v) special procedures to treat complex applications, such as mega-applications or large sequence listings. However, that mandate was to be considered as a flexible one, which could be changed over time by the SCP. The SCP also decided that the Working Group would report the results of its discussions and make suggestions to the SCP. The SCP finally agreed that the International Bureau would collect input from the members of the SCP for the first session of the Working Group and publish the contributions received on the SCP electronic forum.

Agenda Item 6: Proposal by the Delegation of the United States of America

214. The Delegation of the United States of America introduced their proposal (document SCP/6/7) by explaining that the terrorist events of September 11, 2001, had created the need for extension of time limits in certain cases, since a number of people had lost control over their applications and patents. In this context, the Delegation requested information from other delegations on existing or planned measures to remedy such cases. Further, the Delegation requested information from other countries on the status of accession to, or ratification of, the PLT. In addition, the Delegation asked whether any country had identified a need for additional relief measures going beyond those already provided in the PLT.

215. After a discussion, during which the Delegations of Australia, China, Germany, Japan, and the United States of America, and the Representative of the EPO described the existing and planned measures in their respective systems, the SCP agreed to a suggestion of the International Bureau to send an invitation to all members of the SCP to submit relevant information, which would be published on the SCP electronic forum.

CONCLUSION OF THE MEETING

Agenda Item 7: Future Work

216. Following a suggestion by the Chair, the SCP agreed that the order of discussions on the draft SPLT at the next session would be structured according to the nature of the provisions.

217. The SCP also agreed that its seventh session would tentatively be held from May 6 to 10, 2002, in Geneva.

Agenda item 8: Brief Summary by the Chair

218. The draft Summary by the Chair (document SCP/6/8 Prov.) was adopted as proposed.

219. The Standing Committee adopted this report on May 6, 2002.

Agenda item 9: Closing of the Session

220. The Chair closed the session.

[Annex follows]

ANNEXE/ANNEX

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

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