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STANDING COMMITTEE ON THE LAW OF PATENTS

Tenth Session
Geneva, May 10 to 14, 2004

DRAFT REPORT

prepared by the Secretariat

INTRODUCTION

1. The Standing Committee on the Law of Patents (“the Committee” or “the SCP”) held its tenth session in Geneva from May 10 to 14, 2004.
2. The following States members of WIPO and/or the Paris Union were represented at the meeting: Algeria, Argentina, Australia, Austria, Bangladesh, Belgium, Brazil, Bulgaria, Cameroon, Canada, China, Colombia, Costa Rica, Croatia, Czech Republic, Denmark, Dominica, Dominican Republic, Egypt, El Salvador, Ethiopia, Finland, France, Germany, Greece, Hungary, India, Indonesia, Iran (Islamic Republic of), Iraq, Ireland, Italy, Japan, Kazakhstan, Kenya, Latvia, Libyan Arab Jamahiriya, Lithuania, Malaysia, Mali, Malta, Mexico, Morocco, Netherlands, New Zealand, Nicaragua, Nigeria, Norway, Panama, Peru, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Slovakia, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Syrian Arab Republic, Turkey, Uganda, Ukraine, United Kingdom, United States of America, Uruguay, Uzbekistan and Yemen (71).
3. Representatives of the World Health Organization (WHO), the World Trade Organization (WTO), the African Intellectual Property Organization (OAPI), the Eurasian Patent Office (EAPO), the European Commission (EC), the European Patent Office (EPO) and the South Centre (SC) took part in the meeting in an observer capacity (7).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Biotechnology Industry Organization (BIO), Brazilian Association of Intellectual Property Agents (ABAPI), Center for International Environmental Law (CIEL), Centre for International Industrial Property Studies (CEIPI), Chartered Institute of Patent Agents (CIPA), Civil Society Coalition (CSC), Committee of National Institutes of Patent Agents (CNIPA), Federal Chamber of Patent Attorneys (FCPA), Genetic Resources Action International (GRAIN), German Association for Industrial Property and Copyright Law (GRUR), 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 Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Federation of Manufacturers Associations (IFPMA), International Intellectual Property Society (IIPS), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Max-Planck-Institute for Intellectual Property, Competition and Tax Law (MPI), Union of European Practitioners in Industrial Property (UNION), the Trade Marks, Patents and Designs Federation (TMPDF) and the World Association for Small and Medium Enterprise (WASME) (26).

5. The list of participants is contained in the Annex to this report.

6. The following documents prepared by the International Bureau had been submitted to the SCP prior to the session: “Draft Agenda” (SCP/10/1), “Draft Substantive Patent Law Treaty” (SCP/10/2 and 4), “Draft Regulations under the Substantive Patent Law Treaty” (SCP/10/3 and 5), “Practice Guidelines under the Substantive Patent Law Treaty” (SCP/10/6) “Accreditation of a Non-Governmental Organization” (SCP/10/7), “Addendum to Accreditation of a Non-Governmental Organization (SCP/10/7 Add.), “Information on Certain Recent Developments in Relation to the draft Substantive Patent Law Treaty” (SCP/10/8) and “Proposal from the United States of America, Japan and the European Patent Office regarding the Substantive Patent Law Treaty” (SCP/10/9).

7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

GENERAL DISCUSSION

Agenda Item 1: Opening of the Session

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

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

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

Agenda Item 3: Adoption of the Draft Agenda

10. Regarding adoption of the revised draft Agenda contained in document SCP/10/1 Rev., the Delegations of Argentina, Brazil, India and the Islamic Republic of Iran expressed their disagreement on the grounds that it included, as item 6, a proposal from the United States of America, Japan and the EPO. Those Delegations noted that the proposal, which had been received in response to the invitation contained in document SCP/10/8, was dated April 22, 2004, and therefore had not been notified to the Director General and all participants one month before the meeting in accordance with Rule 5(4) of the WIPO Rules of Procedure. Accordingly, there had not been sufficient time for all of the implications of the proposal to be considered by the delegations. The Delegation of Argentina also observed that document SCP/10/8 did not specify any timeframe for the members of the SCP to provide comments.

11. The Secretariat stated that item 6 had been included in the revised draft Agenda by the Director General under Rule 5(1) of the Rules of Procedure, not on the request of a delegation under Rule 5(4) of those Rules. The proposal contained in document SCP/10/9 had been received in response to the invitation contained in document SCP/10/8 dated March 17, 2004. In view of its significance and the need to consider its implications, the Director General had decided to include the proposal in a revised draft agenda under Rule 5(1) of the Rules of Procedure. Since there had been indications that other delegations were considering responding to the invitation contained in document SCP/10/8, a revised draft Agenda had not been issued until immediately before the tenth session on May 8, 2004, to allow time for any further responses also to be included. The Secretariat also noted that it was consistent practice within WIPO to issue a revised agenda on the first day of a meeting, for example, in the case of the General Assemblies of Member States.

12. The Chair, noting that four delegations had spoken against the inclusion of item 6 in the revised draft Agenda contained in document SCP/10/1 Rev. and that no delegation had spoken in favor of the inclusion of that item, proposed that the original draft Agenda contained in document SCP/10/1 should be adopted instead.

13. The draft agenda was adopted as proposed in document SCP/10/1.

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

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

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

15. The Delegation of the Russian Federation noted that the reference to “paragraph (1)” in paragraph 53 of document SCP/9/8 Prov.2 should be corrected to “paragraph (2).”

16. The Committee adopted the draft report of its ninth session (document SCP/9/8 Prov.2) as proposed, subject to the correction referred to in paragraph 15, above.

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

17. The Delegation of Japan introduced the proposal by the United States of America, Japan and the EPO contained in document SCP/10/9. The Delegation noted that, although discussions on the substance of the draft Substantive Patent Law Treaty (SPLT) and Regulations were important, it was also necessary to consider how such discussions could be carried out in an effective and efficient way. It was therefore proposed in document SCP/10/9 that priority should be given to the discussion of certain topics as a first “package.” The Delegation recalled that the need for further patent harmonization following the adoption of the Patent Law Treaty (PLT) in 2000 had been clearly recognized. For example, as stated in document SCP/4/2, paragraph 8:

“8. The need for further patent harmonization beyond the PLT arises mainly from the fact that the costs of obtaining broad patent protection on an international level have become extremely high. The objective of further harmonization should therefore be to lower costs. This goal can, however, only be envisaged if a number of basic legal principles underlying the grant of patents are harmonized.”

18. The Delegation observed that harmonization was still needed to reduce the costs of obtaining patent protection, to reduce the workload of offices by making it possible to avoid the duplication of procedures both in offices and between offices and applicants, and to improve the quality of the patent rights granted. The Delegation noted that the quality of patent rights from the perspective of the protection of traditional knowledge had been recently improved under the Patent Cooperation Treaty (PCT) by incorporating periodicals relating to traditional knowledge into the minimum documentation for international search, and there was a similar need to promote the high quality of patent rights within the context of the SPLT as regards traditional knowledge as prior art. However, as also stated in document SCP/10/8, the United States of America, Japan and the EPO had concluded that, judging from the recent discussion in SCP meetings, an expeditious agreement on all provisions of the current draft SPLT could not be expected. In order to promote the discussion of harmonization within the SCP, the United States of America, Japan and the EPO had identified five guiding principles, namely

- “1. Take a pragmatic approach aimed at early and realistic results;
2. Aim towards a feasible package without adherence to a rigid framework;
3. Pursue best practice taking into account current practices;
4. Address users’ interests as much as possible; and
5. Promote the discussion at the SCP.”

19. Although the United States of America, Japan and the EPO would have preferred a more comprehensive treaty, as a compromise solution based on those five guiding principles, they had decided that the most productive and effective way to promote the draft SPLT would be to give priority to a first package of topics on which agreement could most likely be concluded in the near future, namely the prior art-related issues of definition of prior art, grace period, novelty and non-obviousness/inventive step. In the view of the United States of America, Japan and the EPO, these topics were non-controversial, non-political, purely technical, important to examination as to novelty and non-obviousness/inventive step, and would meet the needs of every applicant and every office. Once the first package of items had been agreed, second and third packages of further items could then be discussed. In addition, the United States of America, Japan and the EPO also considered it important to

establish the time frame for adoption of the first package of items. Since discussions on the draft SPLT had started in 2000 and, according to the recent practice, diplomatic conferences were usually held after four or five years of discussion at the committee level, it was proposed that a Diplomatic Conference should be held in 2006. In this way, the United States of America, Japan and the EPO hoped to make meaningful progress on harmonization to expeditiously achieve the goals of cost reduction for applicants, workload reduction for the offices and maintenance of high quality of patent rights.

20. The Representative of the EPO supported the explanation by the Delegation of Japan of the proposal contained in document SCP/10/9, and stressed his Office's strong and continued commitment to the harmonization of the substantive patent law and the work of the SCP. In the EPO's view, focussing on key topics was a pragmatic approach, which had the potential to produce substantive results in the near term future, and was in line with the views of users organizations as to the need to make substantial progress on substantive patent law harmonization, and took advantage of the momentum of the various initiatives that had occurred since the ninth session of the SCP in May 2003. The Representative emphasized his Office's understanding that the future discussions of the topics contained in the proposed first package, including grace period, should be in the context of a "first-to-file" system.

21. The Delegation of the United States of America stated that, as a co-sponsor of the proposal presented in document SCP/10/9, it fully supported the explanation by the Delegation of Japan of the proposal contained in document SCP/10/9 that the SCP should concentrate on a reduced "initial package" consisting solely of prior art-related provisions. In particular, the Delegation shared the views expressed by the Delegation of Japan as regards its concern at the recent lack of progress in the SCP, its desire to move the discussions in a more positive direction, and its belief that the four prior art-related topics listed provided the best opportunity for near-term agreement. The Delegation noted that an agreement on these topics would benefit all WIPO members, by delivering more consistent examination standards throughout the world, improved patent quality, and a reduction of work performed by patent offices. The Delegation also shared the view that the SCP should take up the proposal with a view to convening a Diplomatic Conference on a first package of items in the first half of 2006, since such a timetable would send a positive message to the users of the patent system as to the willingness of SCP members to conclude a meaningful Treaty as soon as possible.

22. The Delegation of Ireland, speaking on behalf of the EC and its 25 Member States, reaffirmed its commitment to the work of the SCP aimed at the development of a draft SPLT. The Delegation noted that elimination or reduction of differences in the substantive patent law and practice in different countries would lower costs for industry, applicants and offices and benefit many countries, including developing countries. The Delegation noted that, in Europe, a great deal of harmonization of law and practice had already been achieved through the European Patent Convention (EPC) and legislation adopted within the European Union. The EC and its Member States supported the efforts of the United States of America, Japan and the EPO, as well as those of other organizations such as AIPPI, AIPLA, CIPA and FICPI, aimed at promoting progress on the draft SPLT at the SCP. The EC and its Member States therefore supported the proposal by the United States of America, Japan and the EPO that the SCP should initially concentrate on the four topics proposed. However, they could accept a grace period only in the context of a harmonized "first-to-file" system and therefore considered it of paramount importance to address the issue of "first-to-invent" versus "first-to-file" in the draft SPLT. The EC and its Member States considered that, once agreement had been reached on the four topics proposed, based upon the "first-to-file"

system, discussions in the SCP could focus on other related issues, such as enabling disclosure requirements, claim drafting and unity of invention.

23. The Representative of AIPPI stated that his Association represented both applicants and third parties from many different countries, all of whom were in agreement that harmonization was very important for the economy of all countries, and who were therefore concerned at the lack of progress that had been made in the discussions on the harmonization of substantive patent law. As reported in document SCP/10/8, the AIPPI Executive Committee had passed a resolution proposing that work on substantive patent law harmonization should continue, but discussion of the issues concerned should be divided and, as a first step, work should concentrate on those items on which agreement could more easily be reached, particularly those relating to the prosecution of applications. The AIPPI therefore supported the proposal contained in document SCP/10/9 to select a first package of issues on which agreement could be reached. The Representative noted that that Offices were required to handle more cases as a result of an increase in the number of applications over the last year, partly as a result of the globalization of the economy and the increase manufacture of goods and provision of services in developing countries, and that harmonization which facilitated work-sharing between offices would benefit both applicants and third parties. The Representative also reported that his Association had organized a seminar in January 2004 to which the SCP delegations had been invited to hear the views of the users and that the conclusions of the seminar, as well as certain seminar papers, had been sent to those delegations.

24. The Delegation of China stated that it wished to make four points. First, in view of the existing divergences, it agreed, in principle, to the proposal of the United States of America, Japan and the EPO as contained in document SCP/10/9 to focus discussions on a selected package of provisions in order to achieve near-term agreement and results. Second, as regards the fourth guiding principle contained in that document, namely that harmonization should “address users’ interests as much as possible,” in order to achieve a proper balance between the interests of patent applicants and the general public, the term “user” should be interpreted as covering not only patent applicants and patentees, but also the general public. In this regard, the Delegation noted that a recent report by the Federal Trade Commission of the United States of America published in October 2003 had identified patent applicants, rather than the general public, as the customers of the United States Patent and Trademark Office and had viewed that Office’s mission as granting patents to those customers. In the Delegation’s view, this approach was too narrow, since it was also necessary to take account of the objective under Article 7 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) that the protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology. Third, the Delegation noted that many countries and international organizations had in recent years expressed a strong desire to effectively protect genetic resources, traditional knowledge and folklore. In its view, such protection would benefit not only developing countries, but also developed countries, and it expressed the hope that WIPO would take active and productive measures to create the legal framework for such protection as soon as possible. The Delegation therefore supported the inclusion in the draft SPLT of provisions relating to the protection of genetic resources, traditional knowledge and folklore and considered that the SCP was one of the appropriate fora to discuss these matters. Fourth, the Delegation requested that the International Bureau publish SCP documents on its website as early as possible before meetings in order to give Member States sufficient time to consider them.

25. The Delegation of Australia recalled its long standing position that significant inefficiencies in the global patent system, which affected offices and users, both in the sense of applicants and the public at large, stemmed from the inability of offices to recognize each other's work because of differences in their substantive law. There were many difficult issues that needed to be resolved in order to get full and deep harmonization of substantive patent law and it was clear that agreement on all of those issues would be difficult to achieve in the short term. Accordingly, the Delegation was supportive of any proposals to limit the scope of the draft SPLT if that would facilitate progress on achieving harmonization of substantive patent law.

26. The Delegation of Egypt stated that it had examined documents SCP/10/8 and 9 with keen interest and wished to make the following four points. First, as regards the guiding principles set out in document SCP/10/9, the Delegation agreed that it was necessary to attach prime importance to the users of the patent system. However, in deciding who were the users, it was necessary to take account of the interest of society at large and especially the interest of representatives of civil society and, as had already been mentioned by the Delegation of China, the need to promote development policies in accordance with Article 7 of the TRIPS Agreement. Second, although the Delegation appreciated the submission of the proposal of the United States of America, Japan and the EPO, it could not accept any preconditions for discussions or selective approach based on topics which only certain Member States considered appropriate. In the Delegation's view, the provisions in the draft SPLT were interdependent, and it was not possible to divide them. Thus, it was not possible to harmonize the conditions for novelty and inventive step without taking account of certain general exceptions as grounds for the refusal of an application, in particular provisions for the protection of genetic resources and traditional knowledge and other exceptions under Article 2 of the draft SPLT. Third, account had to be taken of the fact that different countries had different standards of novelty and inventive step. For example, Egypt applied absolute standards, but there were other countries that had lower standards for those criteria and it was necessary to harmonize these standards, taking into account that several recent reports had invoked the need for such absolute standards. Fourth, although the Delegation agreed that it was necessary to make progress, it was premature at this stage to decide to hold a Diplomatic Conference in 2006, since the rate of progress of discussions could not be anticipated.

27. The Delegation of the Russian Federation recalled that it had always supported harmonization under the auspices of WIPO. It therefore valued the results of the work which had already been achieved on the harmonization of substantive patent law in general terms and not just from the point of view of what might ultimately emerge in the form of a Treaty or other form of agreement. In the Delegation's view, the work of the SCP in seeking to improve patent legislation at national and international levels had a value in itself, and it was therefore worthwhile discussing the harmonization of substantive patent law in the broadest possible terms. In addition, many of the issues, such as the disclosure of the invention and novelty/inventive step, were interrelated so that restricting discussions to particular topics as a first package might lead to difficulties. For example, such restriction might necessitate radical redrafting, since Articles retained in the first package would then have to be considered without reference to Articles that had been omitted. The Delegation therefore did not support restricting discussions to a first package of topics nor to deciding precisely when the draft SPLT should be concluded. However, taking into account the proposals in documents SCP10/8 and 9, it considered that it would be useful to establish priorities for the discussion of the provisions contained in the current draft SPLT. This would allow to decide whether a package for a treaty could be determined or whether the discussions on the draft SPLT as a whole needed to continue.

28. The Delegation of India noted that it had come prepared to discuss all the issues that had been discussed at earlier sessions. The Delegation observed that it had been stated that the four topics included in the first package proposed in document SCP/10/9 had been chosen because they were considered to be particularly important from the users' point of view. However, it was necessary in this context to consider what was meant by the term "users." In the Delegation's view, the term was not restricted to applicants and third parties, but additionally included the public at large which also had an interest in the grant of patents. The Delegation therefore supported the view expressed by the Delegations of China and Egypt that the term "users" should be given a wide meaning and should, in particular, take into account the provisions of Article 7 of the TRIPS Agreement where the term "user" was used in the context of "users of technical knowledge" as distinct from "producers of technical knowledge" and thus excluded applicants, which are producers of technical knowledge. Although it was sometimes stated that the interest of the public at large was addressed by offices, that was not always the case as evidenced by the fact that, in many countries, separate independent entities, for example, the Federal Trade Commission in the United States of America, had been set up to explicitly address the interest of the public at large in the patent system. In view of this, the Delegation could not support restricting discussion to a limited set of topics which had been identified exclusively from the perspective of "users" in the limited sense of the term. Although the Delegation agreed that the topics concerned were important, it considered that other issues were also important from the point of view of developing countries. In particular, as had been stated by several delegations in the Working Group on Reform of the PCT at its sixth session, the protection of genetic resources, traditional knowledge and folklore was an important part of the work of the SCP. In addition, the promotion and transfer of technology were also important issues that should be addressed in the framework of the draft SPLT. The Delegation was therefore of the view that the proposal that the SCP should consider a limited set of topics with a view to concluding an "SPLT 1," followed by an "SPLT 2" and "SPLT 3" was not in the interest of all countries. For example, once a first package of topics had been adopted as "SPLT 1," there was no guarantee that other topics, in particular the protection of genetic resources and traditional knowledge, would be taken up under an "SPLT 2." Accordingly, although the SCP needed to address the four topics listed by the United States of America, Japan and the EPO, that should not be done with the exclusion of other issues, which were important to other delegations. Nevertheless, the Delegation might consider a more limited SPLT concluded in a single phase, as it understood had been suggested by the Delegation of Australia, provided that it included topics of particular interest to developing countries, in particular concerning disclosure and other issues connected with genetic resources, traditional knowledge and folklore.

29. The Delegation of Brazil noted that, in addition to its administrative aspects, it was also necessary to consider development aspects of the SPLT, since industrial property was not just a matter of private law. For example, in Brazil, industrial property was a policy instrument for industrialization and development, and therefore had to be considered in the light of the national interest. Although the interests of applicants were important in the context of the national economy, the interests of the public, including the development interests of the State, also needed to be taken into account. In addition, it had to be remembered that it was States, not users, who were members of WIPO, signatories to treaties and responsible for compliance with treaties. Accordingly, signing an international treaty was essentially a matter of public, rather than private, interest. It was also necessary to take into account the social impact of intellectual property rights. The Delegation therefore supported the opinions expressed by the Delegations of China, Egypt and India as to the need to give a wide meaning to the term

“users” and to provide for the protection of traditional knowledge, genetic resources and folklore. The Delegation also noted that it wished to consider the promotion of public health and protection of the environment in accordance with the objectives and principles set out in Articles 7 and 8 of the TRIPS Agreement, in accordance with the provision of the Vienna Convention on the Law of Treaties that any treaty shall be interpreted in light of its objectives and principles. Accordingly, the Delegation did not support the proposal to restrict discussions in the SCP to the proposed first package of topics, since this would not take account of the wider public interest, but, instead, wished to discuss all matters contained in document SCP/10/2.

30. The Delegation of the Dominican Republic stated that it favored discussing the harmonization of substantive patent law under the draft SPLT in a comprehensive context, taking into account other discussions within WIPO and elsewhere, including development policy and the Patent Agenda. The Delegation was therefore of the view that it would be contrary to those objectives to limit the topics to be discussed or to exclude certain topics. Harmonization should be for the benefit of all users and beneficiaries of the patent system and it would not be logical just to focus on certain provisions, since no account could then be taken of those deleted provisions or of discussions on interrelated and interdependent issues in other committees, both within WIPO and in other organizations. For example, it was not possible to discuss novelty and inventive step without considering other conditions of patentability. The Delegation was therefore of the view that the draft SPLT should be negotiated as a whole and should not be limited to particular topics of particular interest to certain delegations, leaving out topics of interest to other delegations. If the course of discussions were to be changed in the SCP, this would have to be done in other areas as well, e.g., in discussion on the WIPO Patent Agenda.

31. The Delegation of Algeria opposed the proposal to limit discussions to the proposed first package of topics, since it did not take account of the interests of all concerned in the intellectual property system, including those relating to the protection of genetic resources and traditional knowledge. Although, the Delegation wished to discuss the four topics listed in the proposal by the United States of America, Japan and the EPO, it did not wish to limit discussions to those topics. Instead, it wished to discuss a comprehensive SPLT, which took account of the general interest of all stakeholders, including the promotion of development and public health.

32. The Delegation of Argentina stated that, although it agreed that no significant progress had yet been made in the discussions on the harmonization of substantive patent law, in its view, this was because discussions on many of the subjects of interest to developing countries had been successively postponed. The Delegation also commented that there had not been a broad consensus to start the discussions on a draft SPLT, since many developing countries did not see their interest in negotiating a treaty, especially as certain issues of particular interest to them were not included. In the Delegation’s view, the objective of the SPLT should not just be in meeting the needs of the applicants, in particular by reducing the cost of obtaining a patent, but should also address the need of the patent system to promote the development of technology. The Delegation therefore fully supported the opinions that had already been expressed as regards the need to take account of Articles 7 and 8 of the TRIPS Agreement. The Delegation also noted that the delegations which proposed to restrict the SPLT to four topics had originally proposed a comprehensive Treaty. Although the Delegation agreed that the four topics concerned were core issues, in its view, many other topics were also core issues, since the SCP was a substantive treaty and not just a procedural one. Also, in its opinion, in view of the interrelationship between many provisions, it would be difficult to

discuss just the four topics proposed without reference to other provisions contained in the draft SPLT. It therefore favored continuing to discuss a comprehensive SPLT which both balanced the rights and obligations of the applicants and patent owners and took account of the interests of consumers and society at large.

33. The Delegation of the Islamic Republic of Iran stated that it welcomed any initiative to progress discussions on the draft SPLT which took account of all concerns of Member States. It noted that the conclusion of treaties as such did not have a negative aspect, provided that their contents took account of the interests of all parties to it. Also, all parts of a treaty should have a procedural and substantive consistency and the parties should comply with all of its provisions as a whole. In the case of the draft SPLT, even procedural matters were relevant to the public. The Delegation noted that the proposal by the United States of America, Japan and the EPO to restrict discussions to four topics and to fix a date for a Diplomatic Conference was a pragmatic one aimed at getting a result. However, whether it was realistic or not depended on the reaction of other delegations. In particular, it was necessary for delegations to agree on the subject matter that should be included in the Treaty taking account of the views of all States. Alternative approaches which might be considered would be other ways of saving time within the SCP and to arrange seminars between SCP sessions with a view to bringing the opinions closer together.

34. The Delegation of Switzerland stated that it supported the proposal by the United States of America, Japan and the EPO to focus on a first package of topics as a priority. It also supported the statements of the EPO and the Delegation of Ireland speaking on behalf of the EC and its Member States that the proposal was closely linked to a “first-to-file” system which should be considered at the same time as the four topics concerned. The Delegation noted that an agreement on those four topics would help to bring the workload problems of offices under control and improve the quality of granted patents, thus benefiting both developed and developing countries. In its view, discussions on those topics should not prejudice parallel discussions in other fora on genetic resources and traditional knowledge, including discussions in the Working Group on Reform of the PCT on a proposal by the Delegation of Switzerland that enabled the Contracting States of the PCT to require applicants to declare the source of genetic resources and traditional knowledge in international patent applications. The Delegation considered that it would be a great misfortune if the opportunity to complete a first limited substantive patent law treaty was not seized in WIPO but were to be realized instead outside the Organization.

35. The Delegation of Romania noted the recent developments reported in document SCP/10/9. In its view, the SCP was faced with two basic alternatives. The first alternative was to continue to work on a broad, ambitious harmonization with no foreseeable timeframe for concluding the draft SPLT, particularly as it had become apparent that several matters were extremely controversial and politically sensitive. The second alternative was to discuss a reduced package of topics with a view to streamlining the work on harmonization and obtaining good results within a reasonable period. The Delegation therefore supported the proposal by the United States of America, Japan and the EPO contained in document SCP/10/9 to restrict discussions to a reduced package of topics as a pragmatic approach.

36. The Representative of the EAPO expressed full support for the proposal by the United States of America, Japan and the EPO in document SCP/10/9 to conclude a separate treaty on a reduced package of topics. He noted that a similar approach had led to the adoption of the PLT in 2000 after the failure to adopt a more comprehensive harmonization treaty in 1991. In

the view of his Office, other topics, including provisions on genetic resources, traditional knowledge and folklore, should not be added to the proposed package but could, instead, be included in a separate treaty.

37. The Representative of FICPI explained that he represented an international federation of intellectual property attorneys in almost 80 countries, including many developing countries, who, as practitioners, acted not only for applicants, but also for third parties affected by the grant and exploitation of IP rights. He recalled that FICPI had consistently supported broad international harmonization of IP laws, including substantive patent laws, in view of the potential benefit to all users and, in its submission on the WIPO Patent Agenda, FICPI had considered the implications of the patent system from the point of view of applicants, the parties and the general public in all countries. FICPI had considered the lack of progress towards agreement on a comprehensive SPLT at the most recent sessions of the SCP and, as a purely pragmatic step, had concluded that the SCP should confine its attention to those issues that were central to the examination of patent applications relative to the state of the art, namely first-to-file, an international grace period, a clear definition of the state of the art that was compatible with the first-to-file system and the grace period, and double patenting. Although, it appreciated that other issues were also important to users, in its view, the SCP should focus on certain important issues on which consensus could be achieved in the near term and which would lead to practical benefits.

38. The Representative of the CSC referred to the need to address concerns that intellectual property should not be used to impede the development of the Internet or free software and whether the WIPO Patent Agenda was consistent with other United Nations agency mandates. In view of the opinions expressed by the Delegations of Brazil, China, Egypt, India and others, and the Representative stated that the work on harmonization should recognize that there was a broader social agenda. The Representative suggested that, first, WIPO should collect information on patent validity disputes and share information between Member States to improve patent quality. Second, a global framework should be established for addressing problems relating to standards, for example, in respect of Internet technology which were protected by patents. Third, procedures for requesting compulsory licenses for medicines should be standardized. Fourth, a procedure should be introduced for waiving license fees in cases of so-called social patents where the purpose of the license is primary to benefit the public, for example, to promote access to medicines.

39. The Delegation of the United States of America stated that it did not agree with the view expressed by a number of delegations that the proposal by the United States of America, Japan and the EPO did not take into account the interests of the general public. In its opinion, agreement on the four topics concerned would result in great benefits to all WIPO members, since it would lead to more consistent examination standards throughout the world, improved patent quality and a reduction of work performed by offices, which were goals shared by not only users, but also by patent offices and the general public at large.

40. The Delegation of South Africa, supporting the views expressed by the Delegations of Algeria, Brazil and India, stated that the SCP should continue to discuss the harmonization of substantive patent law within the framework of the draft SPLT in its current form, including the issue of disclosure of sources of traditional knowledge and genetic resources which was relevant to validity. If, nevertheless, it were agreed to have an expedited program, that program should also include the issue of traditional knowledge and genetic resources.

41. The Delegation of Japan, responding to the views that had been expressed by other delegations, stated that, first, it still strongly believed that, in order to give a positive message to all stakeholders, a reasonable timeframe for adopting a treaty was needed. However, it agreed that the actual date of a Diplomatic Conference would clearly depend on the progress of the discussions. Second, the Delegation accepted that all the elements of the patent system were closely interrelated, but was of the view that the topics concerning prior art could be elaborated to take into account the need for consistency with other provisions in the current draft SPLT. Third, since it would be time-consuming to continue discussions on all the draft SPLT provisions as a single undertaking, the Delegation still preferred an expeditious approach based on a limited first package of topics which, in its view, were the most important for every stakeholder. The Delegation also explained that the proposal by the United States of America, Japan and the EPO was, in its view, not to exclude certain issues, but rather to give priority to certain issues.

42. The Delegation of Ireland, speaking on behalf of the EC and its Member States, reiterated its support for the proposal by the United States of America, Japan and the EPO to limit discussions on the draft SPLT to the four topics mentioned. The EC and its Member States continued to recognize the importance which many countries, especially developing countries, attached to issues relating to the protection of genetic resources, biological diversity, traditional knowledge, the environment, public health and nutrition. However, they considered that the draft SPLT was not the appropriate context in which to address issues such as the protection of genetic resources and traditional knowledge. They also noted that the draft SPLT as currently proposed would not prevent a country from taking the necessary steps for the protection of the subject matter concerned, and were of the opinion that an international agreement on the definition of prior art could assist discussions within the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC). The Delegation recalled that the EC and its Member States had stated their willingness to engage in a positive manner in reaching agreement in discussions on genetic resources and traditional knowledge within WIPO, the TRIPS Council and the Convention on Biological Diversity (CBD) and urged all countries to make coordinated efforts in the IGC with a view to achieving tangible and positive results. However, it was also necessary to be aware of the difficulties of reaching international consensus on proposals to include in the draft SPLT any provisions which were not directly linked to substantive patent law.

43. The Representative of JPAA expressed its support for substantive harmonization within a “first-to-file” system and, in particular, for the views expressed by the Delegation of Japan. In the opinion of his Association, the provision of consistent examination standards throughout the world was very important and, to achieve this, priority should be given to the four topics proposed. In addition, in view of its importance in reducing the burden on applicants and costs, and in balancing the interests of applicants and offices, the JPAA was in favor of discussing the issue of information disclosure statement in the future.

44. The Delegation of Morocco stated that it wished to discuss all of the provisions contained in the draft SPLT and Regulations rather than restrict consideration to certain topics as had been proposed. Nevertheless, certain topics might be discussed as a matter of priority provided that it was not done in an exhaustive or restrictive manner. The Delegation urged all SCP members to show a spirit of compromise for harmonization under the draft SPLT and to reach a consensus, especially on controversial matters, which struck a balance between all the interests involved.

45. The Chair noted that there was a large majority, taking into account the fact that the Delegation of Ireland had spoken on behalf of the 25 EC Member States, in favor of the proposal that the SCP should focus its attention on a more limited package, at least as a priority list of issues. The Chair also noted that a number of delegations had emphasized the importance of including provisions on genetic resources and traditional knowledge and invited views on how that issue should be addressed by the SCP.
46. The Delegation of Brazil suggested that the best way of dealing with the issue of genetic resources and traditional knowledge was to continue to discuss them in the context of the draft SPLT, pursuant to document SCP/10/2, in particular under draft Article 2 which referred explicitly to those matters. In this context, the Delegation recalled that the issue of a limited package of issues was not part of the agenda as adopted.
47. The Delegation of India noted the desirability of the SCP continuing to proceed on the basis of consensus, rather than on a headcount with the EC Member States counting as 25 votes. Indeed, this latter approach may prove divisive, in that it may lead to developing countries speaking through one single coordinator, as the EC Member States did.
48. The Representative of AIPPI reiterated its support for focussing on a first package of measures, in particular to improve the quality of patents, which would be beneficial to all, including developing countries.
49. The Delegation of Mexico stated that it recognized the importance of the harmonization of substantive patent law which should lead to benefits for the applicants, Offices and authorities and assist in meeting the development targets of all States. In its view, the discussions should take account of the interests of all involved, and not just those of a few countries, particularly as the issues contained in the draft SPLT were those which delegations had already defined as priorities. The Delegation therefore favored studying all of the proposals contained in the draft SPLT, although it was possible that such study might identify certain subjects that could enjoy consensus as priority subjects for inclusion in a first package.
50. The Representative of CSC referred to the need to concentrate on improving the quality of patents and avoiding abuses of the patent system.
51. In view of the discussion, the Chair proposed that in this session, the SCP should first discuss issues relating to prior art, followed by other issues such as the disclosure of origin in the context of genetic resources and traditional knowledge.
52. The Delegations of Brazil and India indicated that they could agree with the proposal of the Chair. The Delegation of Argentina reiterated its view that, for the reasons stated by the Delegation of Brazil, it was in favor of discussing all matters contained in the draft SPLT. Accordingly, it was only prepared to discuss prior art topics first if it received express guarantees that to do so would not prejudice a decision on including those topics in a first package and that other draft SPLT provisions, including those on genetic resources, would not be excluded.
53. The Delegation of the United States of America stated that, while it maintained its view that a reduced package would be the best approach for the SCP, it did not envisage that proposal as precluding or delaying discussion or progress in WIPO on matters relating to traditional knowledge and genetic resources, including patent disclosure requirements. Thus, the United States of America would continue to participate in the IGC which had a clear

mandate to address those matters in a comprehensive manner and which the Delegation therefore considered to be the appropriate forum in WIPO for such discussions. It noted that broad issues arose with respect to appropriate access and benefit sharing systems and, in its view, that this was one of the main reasons why the IGC had been set up in the first place. It also believed that the IGC's work was currently being done in an effective manner. The Delegation confirmed that it was of the view that discussions within WIPO on genetic resources and traditional knowledge should be restricted to the IGC.

54. The Delegation of Algeria stated that it could agree to discuss the four topics addressed in the proposal by the United States of America, Japan and the EPO as a priority, provided that this would not exclude discussion of other topics, in particular genetic resources and traditional knowledge, which would not be in the interest of many SCP Member States. For the same reason, it did not support the suggestion that had been made that there should be two SPLT treaties.

55. The Delegation of Egypt stated that, in its opinion, consideration of the issues of traditional knowledge and genetic resources should not be restricted to the IGC. Nothing in the mandate of the IGC indicated that it was the sole forum to discuss genetic resources, traditional knowledge and folklore, but the renewed mandate of the IGC adopted by the Assemblies in 2003 explicitly stated that the work of the IGC was without prejudice to work in other fora. The Delegation also noted that other topics which delegations had indicated that they wished to discuss were not limited to genetic resources and traditional knowledge, but additionally included such matters as public health, transfer of technology and exceptions to patentability under Article 2 of the draft SPLT, which were not within the mandate of the IGC. The Delegation reiterated that it wished to discuss all of the issues in the draft Treaty and not limit discussion to a package of issues which were of particular interest to certain delegations.

56. The Delegation of India explained that its earlier agreement to a proposal by the Chair to discuss prior art matters first had been on the assumption that other topics, including genetic resources, would also be discussed afterwards. In its view, the SCP was considering only a single issue, namely the question of substantive patent law harmonization. As far as that Delegation was concerned, nothing in the draft SPLT was agreed till everything was agreed, and that acquiescence should not be construed as acceptance but, if anything, it should be construed as non-acceptance and subject to final consideration when the entire package was considered.

57. The Delegation of Brazil stated that it fully supported the statement by the Delegation of India. It recalled that, in discussions at the sixth session of the Working Group on Reform of the PCT on a proposal by the Delegation of Switzerland providing for the disclosure of the origin of genetic resources and traditional knowledge, the Delegation of Brazil had contended that the discussion of genetic resources could not be limited to the IGC but, because of its special features and characteristics, also needed to be discussed in that Working Group and in the SCP. The Delegation expressed its concern that discussions on genetic resources and traditional knowledge in the SCP and the Working Group on Reform of the PCT had continued to focus on whether or not those particular fora were appropriate, rather than on matters of substance.

58. The Delegation of the Islamic Republic of Iran observed that agreeing on the subject of a treaty was a recognized principle in international law, and that giving priority to a particular part of a treaty might create a precedent in WIPO. The Delegation reiterated the need for

delegations to agree on the subject matter and content of the draft SPLT taking account of all different views.

59. The Delegation of the Dominican Republic expressed concern that the discussions seemed to be reverting to decisions that the SCP had already taken at an earlier session concerning the inclusion in the draft Treaty of proposals made by a group of developing countries. In this connection, the Delegation noted that the report of the ninth session (document SCP/9/8) stated “that provisions, the text of which appears acceptable, would be considered as provisionally accepted and placed in a frame in the next draft, subject to the clear understanding that such provisions could be revisited at any time, on the request of any delegation, and to the inclusion in accepted texts, where appropriate, of alternatives in square brackets reserved for further consideration.” The Delegation noted that delegations were able to re-open discussions on any provisions that had been agreed provisionally and that, accordingly, there was no final agreement until there was a consensus on all provisions.

60. The Delegation of China stated that it did not agree with the view that genetic resources and traditional knowledge should not be discussed in the draft SPLT. The Delegation noted that the Convention on Biological Diversity set out three principles. First, a State enjoyed sovereign rights over its genetic resources. Second, the use of such genetic resources of a country was subject to prior consent of the State concerned. Third, there should be an equitable share of benefits arising from the use of such resources. The Delegation stated that the second principle, namely the requirement for the prior consent of the State, was closely related to the patent system and was the basis of the third principle, since only when a country knew who had used its natural resources could it get some equitable share of the benefit. It noted that the Delegation of Switzerland had made a proposal to the Working Group on Reform of the PCT at its sixth session that the origin of traditional knowledge or genetic resources should be disclosed in patent applications. The Delegation was of the opinion that failure to comply with that requirement should be grounds for refusal or invalidation and thus provide a guarantee mechanism in relation to genetic resources and traditional knowledge. It therefore considered that the inclusion of provisions on genetic resources in the draft SPLT was both relevant and appropriate, in particular, since the PLT did not deal with substantive issues and did not provide for sanctions.

61. The Delegation of Kenya supported the statement made by Egypt on the issue of genetic resources and traditional knowledge. In addition, the Delegation noted that the Secretariat of the Convention on Biological Diversity had written to WIPO, not to the IGC itself, concerning the disclosure of origin of genetic resources and traditional knowledge. It also noted that, once the IGC had completed its work, the matter would in any case need to be discussed in other fora. The Delegation was also of the opinion that it had not been agreed that the issue of genetic resources and traditional knowledge would be discussed only in the IGC to the exclusion of discussions in other fora, either within WIPO or in other bodies, such as the CBD or the TRIPS Council. The Delegation therefore supported discussions in both the SCP and the Working Group on Reform of the PCT.

62. The Delegation of Indonesia stated that, in its opinion, the SCP and the PCT were appropriate fora for discussions on genetic resources and traditional knowledge as far as they related to patent applications.

63. The Delegation of Ireland stated that the EC and its Member States had had no opportunity to consider the proposal of the Chair as to the order of the work of the session, and was thus not in a position to comment on it.

64. The Chair concluded that the SCP had been unable to reach consensus either on the proposal for a limited package or on whether the SCP should discuss genetic resources and traditional knowledge. Although the Rules of Procedure provided for the SCP to vote on those issues, in his view, this could have a negative effect on the spirit of cooperation that was needed for the SCP to be able to go forward with constructive discussions. He therefore proposed that the SCP should note his conclusion that no consensus had been reached on those two issues and that a decision on how the SCP should proceed would need to be taken by the Assemblies at their next session.¹

65. As to the subsequent work of the session, the Chair proposed that discussions should commence on documents SCP/10/2 to 6. Noting the interventions that had already been made and that, in the past, the SCP had not always started its discussions with draft Article 1, the Chair suggested that discussions should start with draft Articles 8, 9, 12(2) and 12(3) and the related Rules, followed by draft Article 1 *et seq.* The Delegations of Australia, France, Germany, Ireland, the Russian Federation and the United Kingdom supported the proposal made by the Chair.

66. In response to a question by the Delegation of Egypt as to precisely what the Assemblies would be asked to decide, the Chair stated that, in his view, it would be very difficult, if not impossible, for the SCP to agree on a detailed statement to be referred to the Assemblies. In any case, any Member State would be free to make its own proposal to the Assemblies as to what should be discussed at future sessions of the SCP. Accordingly, in his view, the appropriate course would be to refer the general matter of future work program of the SCP to the Assemblies.¹

67. After some discussion, in which the Delegation of India, supported by the Delegations of Algeria, Argentina, Brazil and Egypt, suggested that work should commence from where discussions at the ninth session had concluded, namely at draft Article 11, it was agreed, in a spirit of compromise and after the Chair had recalled that discussions on draft Articles 8 to 10 at the ninth session had been restricted due to a shortage of time, that discussions should commence with draft Article 8, followed first by draft Articles 9 to 16 and then by draft Article 1 *et seq.*

68. The Delegation of the United States of America stated that it wished to record that it did not support the current direction of the SCP. However, in the light of the acknowledgement and conclusions of the Chair that there was no consensus on how to proceed and that the Assemblies must consider the issue, the Delegation was nevertheless prepared to offer comments in a constructive spirit solely to advance substantive matters on certain points in the draft documents.

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

¹ See also the discussion on future work reported in paragraphs 228 to 280, below.

Draft Article 8: Prior Art

Paragraph (1)

70. The Delegation of Argentina, supported by the Delegation of Brazil, proposed the inclusion in draft Article 8(1) of the following text: “Prior art also includes the prior secret commercial use or offer for sale without disclosure of the invention by the applicant or patentee.”

71. The Delegation of the United States of America, supported by the Representative of IIPS, stated that it supported the inclusion in draft Article 8 of the provision which included prior secret commercial use and offer for sale as part of the prior art, in order to prevent an inventor from extending his exclusive rights by not disclosing his invention. However, in its view, such prior use or offer for sale should be on-going and have occurred more than one year prior to the filing date of the application.

72. The Delegations of Australia and the United Kingdom stated that they could accept a provision on secret prior use in either draft Article 8 or 13, but noted the need to consider the implications of considering such use as prior art under draft Article 8, particularly in respect of inventive step. The Delegation of the United Kingdom further observed that such a provision should not be mandatory.

73. The Delegations of Algeria, Austria, Belgium, Canada, China, Colombia, Denmark, Finland, France, Germany, Ireland, Japan, Kenya, Malaysia, Morocco, the Netherlands, Norway, Portugal, the Republic of Korea, Romania, the Russian Federation, Spain, Sweden and Ukraine, and the Representatives of the EAPO, the EPO, OAPI, JIPA and CEIPI, opposed the inclusion of secret prior commercial use and offer for sale as prior art under draft Article 8. The Delegation of the Russian Federation, supported by several other delegations, contended that such a provision would be difficult to apply in practice, intrude into the right of an inventor to decide how best to exploit his invention by punishing him if he decided to use it secretly before applying for a patent, and impede the transfer of technology. Some delegations referred to the problems of legal uncertainty, the difficulty of establishing prior secret commercial use in the course of substantive examination, the fact that cases of such use were very rare, the risk of discouraging inventors from subsequently disclosing their invention in a patent application once prior secret commercial use had occurred, and the need for an objective definition of prior art.

74. A suggestion by the Delegation of the United States of America that the definition of prior art should include admissions of prior art by the applicant contained in the application on its filing date, was opposed by the Delegations of Australia, Canada and Germany on the grounds that such admissions should be considered as rebuttable presumptions of prior art. It was also opposed for the same reason by the Representative of the EPO, who suggested that the matter be dealt with in the draft Practice Guidelines.

75. The Delegation of Argentina stated that it wished to reserve its position on paragraph (1).

76. The Chair summarized the discussions under paragraph (1) as follows: some delegations had supported a proposal concerning the inclusion as part of the prior art under draft Article 8(1) of prior secret commercial use and offer for commercial sale, without the disclosure of the invention, by the applicant or the patentee, but a large majority of

delegations had opposed that proposal. As regards the prior art effect of admissions by the applicant in the application, a number of delegations stated that such admissions should constitute a rebuttable presumption of prior art. Subject to the reservation of the Delegation of Argentina, the SCP provisionally accepted paragraph (1).

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

Paragraph (1)

77. There was no discussion on paragraph (1) which the SCP had previously provisionally accepted as proposed.

Paragraph (2)(a)

78. The Delegation of the Russian Federation reiterated its proposal, previously expressed on several occasions, to replace the word “reasonable” by the term “legitimate.” This proposal was opposed by the Delegation of the United States of America which wished to retain the words “reasonable possibility.” The Delegation of New Zealand stated that, in its opinion, the word “reasonable” introduced uncertainty and should be deleted. A number of delegations, however, supported the retention of the word “reasonable.”

79. The Representative of the EPO, supported by the Delegations of Australia, Canada, Germany, India, Ireland, Japan and the United States of America, and the Representative of EPI, suggested that the second sentence should be deleted and the expression “reasonable possibility” be further elaborated in the draft Practice Guidelines. The Delegation of the United Kingdom stated that, although it did not oppose such elaboration in the draft Practice Guidelines, the discussions highlighted the difficulty of defining the term “reasonable possibility.” The Delegation of Brazil stated that, although it wished to reserve its position on this matter, it was not convinced of the need for the second sentence.

80. The Chair summarized the discussion as follows: the SCP provisionally accepted paragraph (2)(a) with the deletion of the second sentence. However, the International Bureau should further elaborate the notion of “reasonable possibility” in the draft Practice Guidelines.

Paragraph (2)(b)

81. The Delegation of India stated that it was not clear whether the term “public” could be construed as meaning just one person, so that paragraph (2) could be considered to apply where, for example, information had been placed on the Internet for a very short time, for example one day, and had been accessed by one person. The International Bureau noted that paragraph (2)(b) had to be read in conjunction with the requirement under paragraph (2)(a) that there was a reasonable possibility that the information could be accessed by the “public.” The Delegation of Australia agreed that the “public” could be just one person, but noted that there would be an evidential burden in establishing that the information concerned had indeed been made available to the public in the example given by the Delegation of India. The Delegation of Australia also referred to paragraph 91 of the draft Practice Guidelines, that the possible access to the information by the public had to be legitimate, so that a situation where information on private premises could reasonably be accessed by a person unlawfully breaking into those premises would not be included. The Delegation of China also agreed that clarification was needed: for example, it was not clear whether a neighbor’s child who was shown the invention by the applicant would be considered as the “public” for the

purposes of paragraph (2). The Delegation of Germany stated that it could accept paragraph (2)(b) as proposed in view of the difficulty of drafting a more precise definition of the term “public.” The Representative of FICPI explained that his Federation had discussed the matter and had concluded that the “reasonable possibility of access by the public” only occurred where the disclosure of the information was not confidential, the person disclosing the information lost control over the information, and the person to whom the disclosure was made understood it and was able to take away that understanding. In addition, a disclosure which was an evident abuse of the applicant’s rights should be excluded from the prior art.

82. The Chair summarized the discussion as follows: in the light of the divergent views concerning the definition of the term “public,” the International Bureau should further review paragraph (2)(b) in conjunction with the expression “reasonable possibility to access” in paragraph (2)(a).

Paragraph (3)

83. The Chair noted that, at the SCP’s ninth session, there had been divergent views as to whether the information should be presumed to have been made available on the first or the last day of the month. In order to avoid a restatement of those views, the Chair suggested that only delegations that had changed their view should intervene on that particular matter.

84. The Delegation of Argentina proposed that the paragraph should be restricted to evidence submitted by the applicant, for example, by amending the final words to read “unless the applicant submits evidence that proves otherwise.” With reference to that proposal, the Chair recalled that, at the ninth session of the SCP, a number of delegations had expressed concern that an applicant might not have the possibility of submitting evidence where the information was published by a third party. The Representative of EPI commented that the paragraph did not adequately cover the case of journals which were published weekly.

85. The Chair concluded that the SCP should note the proposal by the Delegation of Argentina and that the provision would be retained for further discussion.

Draft Article 8(2)(a)

86. The Delegation of the Russian Federation suggested that the wording “other application or the patent thereon is made available to the public” in the introductory words should be replaced by “published application.” Following an explanation by the Chair that, in some jurisdictions, only the granted patent, and not the pending application, was published, the Delegation commented that the above wording did not appear clear.

87. The Delegation of the Russian Federation also queried the meaning of the words “is made available to the public subsequently by the Office” in the introductory words. Following an explanation by the Chair that “the other application” was not citable until it, or the patent granted thereon, had been made available to the public, the Delegation suggested that the need for the word “subsequently” should be examined.

88. The Delegation of the United States of America proposed that the prior art effect of certain applications should not be restricted to novelty, but should apply also to inventive step in order to prevent the granting of multiple patents for inventions which were not patentably distinct. This proposal was supported by the Delegations of Argentina, Brazil, Egypt and India, and by the Representatives of AIPLA, BIO and IPO. However, it was opposed by the

Delegations of Australia, Austria, Canada, Germany, Ireland, Japan, the Netherlands, the Republic of Korea, Sweden and the United Kingdom, and by the Representatives of the EPO, the EAPO, CIPA, EPI, GRUR and the Max-Planck-Institute.

89. The Delegation of Germany, supported by the Delegations of Canada, the Netherlands and the United Kingdom, and the Representatives of the EPO, EPI and CIPA, suggested that, instead of extending the prior art effect to inventive step, a concept of “enlarged novelty” could be considered as a compromise. In response to a request for clarification by the Delegation of the Russian Federation, the Chair explained that a concept of “enlarged novelty” could include inherent disclosures and equivalents in addition to a strictly “photographic” concept of novelty. The Delegation of Canada expressed the view that the “enlarged novelty” concept could be derived from draft Rule 14(2) which included inherent disclosures in the prior art. Following some discussion on whether a concept of “enlarged novelty” would apply generally or only in respect of prior art effect of other (earlier) applications, the SCP agreed to a proposal by the Chair that the International Bureau should prepare a study on the subject, focussing initially on paragraph (2)(a), but also considering the implications of extending such a concept to novelty in general.

90. The Delegation of France, supported by the Representative of the EPO, suggested that, rather than extending the prior art effect to inventive step, it would be preferable to provide for applications to be systematically published, or otherwise made available to the public, as soon as possible after 18 months from the priority date. The Delegation of the United States of America stated that such a provision would complicate SPLT discussions and was not necessary for harmonization.

91. The Delegation of the United States of America noted that item (ii) was not consistent with the “*Hilmer* doctrine” under its law, although it acknowledged that the doctrine was controversial and under review. The Delegation of Japan commented that the *Hilmer* doctrine discriminated against applications published in a language other than English. The Delegation of Ireland stated that, in its opinion, the *Hilmer* doctrine violated the provisions under both the Paris Convention for the Protection of Industrial Property and the TRIPS Agreement, and therefore had no place in the draft SPLT.

92. The Representative of CSC suggested that, in order to improve patent quality, patent owners should be obliged to notify WIPO of any prior art cited after the grant of a patent.

93. The Chair summarized the discussions on paragraph (2)(a) as follows: a majority of delegations expressed the view that the prior art effect of earlier applications should apply to novelty only, while a minority of delegations proposed that such prior art effect should apply to both novelty and inventive step. Several delegations and non-governmental organizations referred to the further exploration of the concept of “enlarged novelty” as applied in some jurisdictions. The SCP had agreed to a proposal by the Chair that the International Bureau should prepare a study on the subject, focussing initially on paragraph (2)(a), but also considering the implications of extending such a concept to novelty in general. One delegation, supported by one representative of an IGO, proposed the introduction of a provision on the publication of applications after 18 months. The Delegation of the United States of America noted that item (ii) was in conflict with the *Hilmer* doctrine that applied in that country.

Draft Article 8(2)(b)

94. The International Bureau explained that, under Alternative A contained in the draft paragraph, earlier international applications under the PCT would have a prior art effect only where they entered into the national phase of the Contracting Party concerned; under Alternative B, earlier international applications would have a prior art effect for all designated States, whether or not they entered into the national phase of the Contracting Party concerned. For greater clarity, it proposed that the text of Alternative B(i) be amended to read as follows:

“[Alternative B]

(i) where the Contracting Party is a State, an application referred to in Article 3(1)(i) and an international application which designates the said Contracting Party or, if that Contracting Party is a member of a regional patent organization, a regional application filed with or for the Office of that regional patent organization through which patent protection in the said Contracting Party is sought.”

95. The Delegation of Australia expressed a preference for Alternative B since the prior art effect of an international application would then be the same in all countries, thus facilitating work-sharing between Offices. The Representative of CEIPI stated that it supported Alternative B for the reasons set out in paragraph 179 of the Report of the ninth session of the SCP (document SCP/9/8); in particular, the Representative was of the opinion that Alternative A was not compatible with the PCT which provided that any international application shall be equivalent to a regular national filing; in addition, since the period for entry into the national phase under the PCT was 30 months, under Alternative A, there would be a long period of uncertainty as to whether or not an international application had a prior art effect in the Contracting State concerned. The Delegation of the United States of America stated that it supported Alternative B, since it would harmonize the prior art effect, restrict the prior art effect of an international application to a consideration of its contents rather than its status in a Contracting Party, and reduce uncertainty; it was also more consistent with draft Article 11(3). Alternative B was also supported by the Delegations of Brazil, India and the Islamic Republic of Iran.

96. The Delegations of Germany, the Republic of Korea, the Russian Federation and Spain, and the Representative of the EAPO supported Alternative A, since the purpose of paragraph (2)(b) was to prevent double patenting. The Delegation of the Republic of Korea also noted that the PCT Regulations now provided for the automatic designation of all Contracting States but, in many cases, it would be difficult for a designated Office to establish the contents of international applications which did not enter its national phase, since they were not translated into the language of that Office.

97. The Representative of the EPO stated that, although it favored Alternative A, it might be able to support Alternative B depending on the outcome of the study on the concept of “enlarged novelty” under paragraph (2)(a). The Representative of CIPA stated that his Institute favored Alternative B for the reasons given by the Delegation of Australia; however, it also could accept Alternative A, even though in some cases, the period for entry into the national phase could be longer than 30 months, thus increasing the period of uncertainty even further.

98. In response to a suggestion by the Delegation of Germany that the draft Practice Guidelines should clarify that the prior art effect would only apply where the patent

application was “valid,” for example in the sense that it had not been deemed withdrawn, the Chair noted that draft Rule 9(2) was also relevant in that respect.

99. The Delegation of Germany expressed concern that paragraph (2)(b) did not adequately cover Euro-PCT applications. In addition, the Delegation of the Russian Federation stated that, under Alternative A, where a Contracting Party was a member of a regional patent organization, it was not logical or symmetrical to apply the prior art effect of regional applications in the Contracting Party under item (i), while the prior art effect of national applications were not recognized in the regional patent organization under item (ii).

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

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

Paragraph (1)

101. The Delegation of the United States of America expressed concern that the penultimate sentence of paragraph 101 of the draft Practice Guidelines was not consistent with draft Rule 9(1)(b). The Delegation further suggested the deletion of the last sentence of that same paragraph of the draft Practice Guidelines as regards applications for plant and design patents which, under its law, could be converted into applications for utility patents. Following an explanation by the International Bureau that the intention of the draft Practice Guideline in the penultimate sentence of paragraph 101 of the draft Practice Guidelines was that, where a State provided for double protection of the same invention by two different titles of invention, that State was not obliged to cite an application for one title against an application to protect the same invention by a different title, and confirmation by the International Bureau that the last sentence of paragraph 101 of the draft Practice Guidelines could be deleted, the Delegation stated that it would consider the matter further.

102. The Chair summarized the discussions on paragraph (1) as follows: one delegation noted some inconsistency between this provision and paragraph 101 of the draft Practice Guidelines.

Paragraph (2)

103. The Chair noted that the draft text contained two alternatives defining the status of “the other application.” The Delegations of Australia, the Republic of Korea and the Russian Federation supported the first alternative, namely “was no longer pending and should not have been made available to the public.” However, the Delegations of Argentina and Canada supported the second alternative, namely “had been withdrawn.” The Delegation of the United States of America, supported by the Delegations of Canada and Japan, and the Representative of the EPO, proposed that paragraph (2) be amended to read as follows:

“(2) [*Applications No Longer Pending*] Where the other application has been made available to the public in accordance with Article 8(2) in spite of the fact that it should

not have been made available to the public under the applicable law, it shall not be considered as prior art for the purposes of Article 8(2).”

104. The Delegation of Canada, however, expressed the view that the reference to the applicable law was against the spirit of harmonization.

105. The Chair summarized the discussions on paragraph (2) as follows: following a proposal by one delegation, the SCP provisionally accepted the text of paragraph (2) as set out above.

Paragraph (3)

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

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

107. The Delegation of the Republic of Korea stated that it supported a grace period. It proposed that the title of draft Article 9 should be amended to: “Items of Prior Art Not Affecting Patentability” in order to introduce into that title the concept of prior art referred to in paragraph (1). With reference to paragraph (1), the Delegation favored a six-month period in the interest of legal certainty. With reference to paragraph (1)(ii), the Delegation was of the view that the grace period should apply only where the application was published by mistake. With reference to paragraph (2), it supported the inclusion of a provision allowing the Contracting Party to require the applicant to submit a declaration invoking the grace period, as proposed under Alternative B. With reference to paragraph (4), the Delegation supported the inclusion of a provision on third party rights in the draft SPLT.

108. The Delegation of Ireland, speaking on behalf of the EC and its Member States, expressed support for a grace period which was in the context of a globally harmonized patent system based upon the “first-to-file” principle and provided a safety net for the applicant. With reference to paragraph (1), the Delegation favored a grace period of six months preceding the priority date of the claimed invention. With reference to paragraph (2), the Delegation noted that a declaration invoking the grace period would help third parties by informing them that a disclosure made during the preceding six months originated from the applicant and should therefore not be regarded as prior art. With reference to paragraph (4), the Delegation supported the provision of prior user rights.

109. The Delegation of Australia stated that it supported a grace period which provided a safety net for unintentional and ill-advised disclosures of the invention by the applicant, but not as a part of a strategy for filing applications. With reference to paragraph (1)(ii), the Delegation was of the opinion that an applicant should obtain the benefit of the grace period in respect of a publication by another Office where that publication should not have taken place, but not where it had occurred normally. With reference to paragraph (2), although the Delegation appreciated that requiring applicants to invoke the grace period would provide certainty for third parties, there was also a need to provide for situations where the applicant was unaware of an unintended or unauthorized disclosure on the filing date. Accordingly, in its view, a declaration should only be required where the applicant was aware of the disclosure. With reference to paragraph (4), the Delegation supported the provision for intervening rights to protect third parties.

110. The Delegation of Japan stated, with reference to paragraph (1), that the grace period should be six months, since a longer period would be a disincentive to the applicant to file an application as soon as possible after a disclosure and also create uncertainty for third parties. The Delegation was also of the opinion that the grace period should be a safety net and that, accordingly, with reference to paragraph (1)(ii), it should apply where publication by an Office should not have taken place. With reference to paragraph (2), the Delegation was of the opinion that it should be mandatory for applicants to submit a declaration invoking the grace period. With reference to paragraph (4), it supported the inclusion of third party rights, but was of the view that consideration of the details of such rights should be deferred until after the details of the grace period itself had been settled.

111. The Delegation of the United States of America stated, with reference to paragraph (1), that it favored a grace period of 12 months, since it would be less confusing for both applicants and third parties and a shorter period might not be sufficient for applicants in all cases. The Delegation said that paragraph (1)(ii) was too restricted and suggested its deletion so that the grace period would apply to any disclosure by, or derived from, the inventor. If paragraph (1)(ii)(a) was retained, the words in square brackets should be deleted to prevent any application from being anticipated by an earlier application of the same applicant published during the grace period. The Delegation also suggested that experimental use of the invention should not affect patentability, even if such use had commenced more than 12 months preceding the priority date. With reference to paragraph (2), the Delegation stated that it did not support a requirement that the applicant should invoke the grace period by submitting a declaration, since it would reduce its effectiveness, especially for small and medium-size enterprises. With reference to paragraph (3), the Delegation expressed concern that the definition of “inventor” did not adequately cover situations in which there had been a multiple or partial assignment of the invention before the filing date. With reference to paragraph (4), the Delegation did not support the inclusion of a provision on third party rights which, it considered, should be left to national law as in the case of other infringement issues.

112. The Delegation of China stated that a grace period should be considered in the context of a “first-to-file” system. With reference to paragraph (1), it favored a six-month period in order to protect the interest of the public by ensuring that the applicant would have to file an application soon after the disclosure, and also to avoid the “first-to-file” system being turned into a “first-to-publish” or “first-to-invent” system. It suggested that a short grace period could also avoid the need for third party rights under paragraph (4). However, in the interest of harmonization, the Delegation could accept a longer grace period under paragraph (1), in which case Contracting Parties might be permitted to provide for third party rights under paragraph (4). With reference to paragraph (2), the Delegation stated that it was in favor of requiring the applicant to submit a declaration invoking the grace period, consistent with its current practice in respect of disclosures at exhibitions and academic conferences. That would also avoid problems that might arise where, for example, the grace period was invoked in post-grant proceedings in a foreign country.

113. The Delegation of India stated that it accepted that there were good reasons speaking in favor of a grace period. With reference to paragraph (1), it was of the view that the period should be limited to six months in order to avoid complications that might arise from a longer period. In response to a comment by the Delegation that the grace period should additionally apply to situations in which the invention was exhibited at a governmental exhibition or published in a paper to a learned society, the Chair expressed the opinion that those situations were already covered by the existing text. With reference to paragraph (2), the Delegation

was in favor of requiring the applicant to submit a declaration invoking the grace period. With reference to paragraph (4), the Delegation was in favor of providing for third party rights as proposed under Alternative A. In reply to a concern expressed by the Delegation that paragraph (4), Alternative A, did not cover the situation in which the third party had become aware of the invention before the priority date of the application and had started to use it between the priority date and the publication date of that application, the Chair suggested that this was regulated by Article 4B of the Paris Convention.

114. The Delegation of the Islamic Republic of Iran stated that it had not yet evaluated the usefulness of a grace period and therefore reserved its position on paragraphs (1) to (3). However, if a grace period were introduced, it should be in the context of a “first-to-file” system. With reference to paragraph (4), the Delegation considered the inclusion of third party rights under Alternative A to be preferable to leaving it to the applicable law.

115. With reference to paragraph (1), the Delegation of Morocco stated that it favored a 12 month grace period. Although, at present, its national law provided for a grace period of six months, it was proposed to increase it to 12 months to encourage university professors to file applications.

116. The Delegation of the Russian Federation stated that it supported the concept of a grace period in a broad sense. It did not support limiting it to situations in which the disclosure was unintentional, since an inventor who was not sure how best to exploit his invention might decide to apply for a patent after having disclosed it to another person. With reference to paragraph (1), the Delegation favored a six-month period. However, it suggested that it could accept a 12-month period where the disclosure had been made available to the public without the knowledge or approval of the applicant. With reference to paragraph (2), it did not support requiring the applicant to invoke the grace period by submitting a declaration on the filing date, although it could accept such a provision where, on the filing date, the applicant was aware that the invention had been made available to the public. In other cases, the applicant should be required to submit a declaration soon after learning of the disclosure. With reference to paragraph (4), the Delegation stated that it was in favor of a more general provision which covered prior use by third parties independently of the invention and was harmonized with Article 4B of the Paris Convention.

117. The Delegation of Canada stated that it strongly supported a grace period and agreed with the Delegation of Australia that it should be a safety net. With reference to paragraph (1), the Delegation favored a 12-month period. With reference to paragraph (1)(ii), the Delegation suggested that it be clarified that the term “item of prior art” in the introductory words of the item referred to prior art defined in draft Article 8. In addition, if the term “application” in draft Article 9(1)(ii)(a) included “another application” referred to in draft Rule 9(1), as was presumably intended, it must also include applications which were no longer pending referred to in draft Rule 9(2), even though that interpretation appeared inconsistent with the reference in square brackets to prior art in the application being made available to the public. With reference to paragraph (2), it was against requiring the applicant to submit a declaration invoking the grace period, since, in its opinion, such a requirement would be unworkable and thus diminish the usefulness of the grace period.

118. The Delegation of Kenya stated that it favored a 12-month grace period, since experience under its national law had shown that a six-month period was insufficient.

119. The Delegation of Mexico stated that it supported a grace period which it considered to be important. With reference to paragraph (1), the Delegation favored a 12-month period. With reference to paragraph (2), it supported requiring the applicant to invoke the grace period when filing the application.

120. The Delegation of Argentina stated that it supported a grace period. With reference to paragraph (1), the Delegation favored a 12-month period. With reference to paragraph (4), it agreed with the Delegation of the Russian Federation that prior users should have the right to continued use.

121. The Delegation of New Zealand stated that it agreed with the Delegation of Australia that the grace period should be a safety net. With reference to paragraph (1), the Delegation favored a 12-month period. With reference to paragraph (2), it was against requiring the applicant to submit a declaration invoking the grace period.

122. The Delegation of Ukraine stated that it favored a 12-month grace period, since it considered a six-month period to be insufficient.

123. The Representative of the EAPO stated that it supported a grace period. With reference to paragraph (1), the Representative stated that, although the EAPO currently provided a grace period of six months, it could consider a longer period. Also, the Representative was against applying different grace period conditions to different forms of disclosures, for example, in respect of experimental use. With reference to paragraphs (3) and (4), the Representative of the EAPO supported the view expressed by the Delegation of the Russian Federation with reference to paragraph (4).

124. The Delegation of Indonesia stated, with reference to paragraph (1), that it favored a six-month period since, in its opinion, a 12-month period would create a too long period of uncertainty.

125. The Representative of the EPO expressed its support for the common position of the EC and its Member States as stated by the Delegation of Ireland. In particular, the EPO supported a grace period which provided a safety net for applicants. With reference to paragraph (1), the Representative suggested that, in order to make such a safety net workable in the interests of both applicants and third parties, the grace period should be six months and in the context of a “first-to-file” system. In addition, it should apply only in exceptional cases to avoid encouraging inventors from publishing their inventions before applying for a patent. As a drafting matter, the Representative also suggested amending the wording in the introductory words of paragraph (1) to read: “in so far as that item was included in the prior art under Article 8.” With reference to paragraph (1)(ii), the Representative supported the inclusion of the words “and should not have been made available to the public by the Office” presented in square brackets. With reference to paragraph (2), the EPO was of the opinion that, in the interest of transparency for the public, the applicant should be required to submit a declaration invoking the grace period even though, in some cases, it might be difficult for the applicant to know if his invention had been made available to the public, for example, where it had been tested in public. With reference to paragraph (4), the EPO was of the view that invoking the grace period should not affect the prior user rights of third parties, but that this should be dealt with only in the context of the draft Practice Guidelines.

126. The Representative of OAPI supported a grace period and noted that its regional law already provided for such a period where an invention had been made public at an official

exhibition or there was an abuse of the applicant's rights. With reference to paragraph (1), the Representative supported a 12-month period. With reference to paragraph (2), the Representative was in favor of allowing a Contracting Party to require the applicant to submit a declaration invoking the grace period under Alternative B.

127. The Delegation of Malaysia stated that it supported a 12-month grace period.

128. The Representative of CEIPI supported the view expressed by the Delegation of Australia that the grace period should be a safety net and not be used as part of a filing strategy. The Representative suggested that the wording of the title should be changed to "Elements not Affecting Prior Art"; it opposed changing the title to read "Grace Period" in view of the risk of confusion with the term "period of grace" in Article 5*bis*(1) of the Paris Convention in respect of the payment of fees for the maintenance of industrial property rights. With reference to paragraph (1), the Representative favored a 12-month period for the reasons given by the Delegation of Kenya. As a drafting matter, the Representative also suggested changing the words "that item was included in the prior art" in the introductory words of paragraph (1) to "that item became part of the prior art." With reference to paragraph (1)(ii), the Representative supported retaining the words "and should not have been made available to the public by the Office" in square brackets. With reference to paragraph (2), the Representative opposed requiring the applicant to invoke the grace period by submitting a declaration, since it would create difficulties for inexperienced applicants, particularly where the invention had been made available to the public without the consent of the applicant. With reference to paragraph (4), the Representative supported the proposal in Alternative B that third party rights should remain a matter for the applicable law.

129. The Representative of FICPI supported a grace period of 12 months in line with that already applied by most offices. With reference to paragraph (2), the Representative opposed a requirement that the applicant should be required to invoke the grace period by submitting a declaration. With reference to paragraph (4), the Representative supported a provision for third party rights and observed that such rights would deter the use of the grace period as part of a filing strategy.

130. The Representative of ABAPI supported a grace period of 12 months. With reference to paragraph (2), the Representative opposed requiring the applicant to invoke the grace period by submitting a declaration, since applicants might not know the precise date or extent of the disclosure and inexperienced applicants might not be aware of the requirement.

131. The Delegation of Romania supported a grace period. The Delegation suggested that the title should be changed to "Grace Period," possibly followed by the words "Information Not Affecting Patentability" in brackets. With reference to paragraph (1), the Delegation stated that it had initially favored a 12-month period but, for the reasons given by the Representative of the EPO, now favored a six-month period. With reference to paragraph (1)(ii), the Delegation shared the concerns expressed by the Delegation of the United States of America concerning disclosure by an Office and could support deletion of that item. With reference to paragraph (2), the Delegation supported allowing a Contracting Party to require the applicant to invoke the grace period by submitting a declaration, as proposed under Alternative B. With reference to paragraph (4), the Delegation considered that third party rights should be dealt with in the draft Practice Guidelines rather than in the Treaty.

132. The Representative of GRUR stated that his organization supported a grace period as a safety net. With reference to paragraph (1), it favored a six-month period but was not opposed to 12 months. With reference to paragraph (2), his organization was of the view that the applicant should be able to invoke the grace period at any time. With reference to paragraph (4), it was opposed to providing for third party rights as proposed in Alternative A, but would support the inclusion of a broader provision on prior user rights as proposed in the 1991 draft Treaty Supplementing the Paris Convention as far as Patents are Concerned.

133. The Representative of AIPPI stated that, although his Association supported a grace period as a safety net, it had not completed its studies on the issue which would be discussed at its June 2004 congress. The Representative noted that the provisions needed to take account of the interests of all applicants and not, for example, just inexperienced applicants, but also academics.

134. The Delegation of Norway supported a grace period within the context of a “first-to-file” system. With reference to paragraph (1), it favored a 12-month period but had no position on other provisions.

135. The Delegation of South Africa stated that, although its national law did not provide for a grace period, it could support a grace period as a safety net. With reference to paragraph (1), it had no strong views on the length of the grace period.

136. The Representative of IPO stated that his organization supported a grace period as a safety net. With reference to paragraph (1), it favored a 12-month period in view of the needs of universities and small inventors. With reference to paragraph (2), the Representative opposed requiring the applicant to invoke the grace period by submitting a declaration, since such a requirement was not user-friendly and applicants might not know that their invention had been disclosed. With reference to paragraph (4), the Representative considered that third party rights were a matter for national law.

137. The Representative of JPAA stated that his organization supported a grace period as a safety net. Although Japanese law provided for a six-month period which was widely used, his Association would favor a 12-month period.

138. The Representative of the Max-Planck-Institute stated that his organization supported a grace period in the context of a “first-to-file” system. With reference to paragraph (1), it favored a period of not more than six months. With reference to paragraph (2), his organization was of the view that the applicant should be required to invoke the grace period by submitting a declaration, even though it appreciated that such a requirement could cause difficulties. With reference to paragraph (4), it supported the inclusion of a broader provision on prior user rights, as suggested by the Representative of GRUR.

139. The Representative of BIO stated that his organization supported a grace period. With reference to paragraph (1), it favored a 12-month period to give applicants sufficient time to consider their foreign filing strategy after the invention had been made public. With reference to paragraph (2), the Representative opposed requiring the applicant to invoke the grace period by submitting a declaration for the reasons given by other representatives of users.

140. The Representative of CIPA, with reference to paragraph (2), stated that, although it supported a requirement that the applicant should invoke the grace period by making a declaration, the applicant should be permitted to make that declaration at any time before the

grant of the patent. Supporting the Representative of CIPA, the Representative of CEIPI stated that the declaration should be submitted up to the grant of the patent under the situations described in paragraph (1)(i) and (1)(ii)(a).

141. The Delegation of Germany suggested, as a drafting matter, that paragraph (4), Alternative A, should refer to “before the priority date of the claimed invention.”

142. The Chair summarized the discussions on draft Article 9 as follows: as regards the general observations that had been made, all the delegations which spoke supported the introduction of a provision on a grace period in the draft SPLT, except for one delegation which reserved its position. However, many delegations considered a grace period only acceptable in the framework of a harmonization including the first-to-file system. Furthermore, opinions were split among delegations as to whether the duration of the grace period should be six or twelve months, on whether the provision on third party rights should be regulated in the draft SPLT as a mandatory requirement, and on whether the grace period needed to be expressly invoked by the applicant, and if so, in which form. Different views were expressed regarding the bracketed text in paragraph (1)(ii)(a). The Chair concluded that the parts of the text within square brackets and the alternatives in draft Article 9 should be retained. There was no support for a proposal to exclude experimental use from the prior art. It was agreed that the International Bureau would review the text of paragraph (1) as well as the title of the draft Article. As regards paragraph (2), some delegations and representatives expressed their positions as to the circumstances under which a declaration invoking the grace period could be required. One delegation noted that the duration of the grace period could differ depending on the circumstances of the disclosure. As regards paragraph (3), one delegation questioned the applicability of this provision to cases relating to multiple or partial assignments. As regards paragraph (4), following a suggestion by one delegation, the Chair concluded that the current draft, including the two alternatives, should be retained for future discussions.

Draft Article 10: Enabling Disclosure

Paragraph (1)

143. The Representative of the EPO queried whether the term “carried out” in the first sentence meant the same as the terms “made and used” in the second sentence and “make or use” in draft Rule 10(vi). It expressed its preference for the use of the same terminology throughout the whole text. In response to an observation by the Delegation of the Russian Federation that the purpose of the enabling disclosure was to enable a person skilled in the art to manufacture the invention and to use it, the Chair expressed the opinion that these actions were both covered by the term “carried out.” The Delegation of the United States of America observed that, if the term “carried out” were used, there was a need for a common understanding as to what it meant. The Delegations of Canada and Germany also supported the use of the same terminology throughout the Treaty and Regulations.

144. The Delegation of India proposed that, in order to take account of the different levels of development in different countries, the words “in that country” be added after the words “person skilled in the art.” It stated that, unless the invention could be understood and carried out in the country concerned, there was no socio-economic basis for granting a patent. In order to take account of the different technological capabilities of different countries, the Delegation of Brazil similarly proposed that the words “in the country of grant” be added after

the words “person skilled in the art.” These proposals were supported by the Delegations of Argentina, Egypt and the Islamic Republic of Iran.

145. In response to an observation by the Chair that the term “person skilled in the art” was defined in draft Rule 2 for the purpose of a number of provisions, including paragraph (1), the Delegations of Argentina and Egypt expressed the opinion that a more restricted definition of the term was required for the purposes of that paragraph.

146. The proposals of the Delegations of Brazil and India were opposed by the Delegations of Australia, Canada, Denmark, Germany, Japan, Morocco, the Russian Federation, South Africa and the United States of America, and the Representative of the EPO, on the grounds that they would result in different standards of enabling disclosure in different countries and were thus inconsistent with the objective of harmonization. However, the Delegations of Argentina, Brazil and Egypt observed that, if an application contained a comprehensive enabling disclosure which satisfied the requirements of all countries, it would not be necessary to have different disclosures for different countries. The Representative of WASME observed that, since examiners in different offices had a different level of technological expertise, in some cases, they would come to different conclusions on the adequacy of the enabling disclosure, even under the originally proposed text. The Representative suggested the addition of the words “in the circumstances of the case” to the originally proposed text as a compromise.

147. The proposals of the Delegations of Brazil and India were also opposed by the Delegation of Ireland on the grounds that applying different standards in different countries would hinder work-sharing between offices. A further contention by the Delegation of Ireland that the proposals were contrary to the provisions of Articles 27 and 29 of the TRIPS Agreement was not accepted by the Delegations of Argentina, Brazil and Egypt which submitted that they were fully consistent with those provisions.

148. The Delegation of Australia noted that “a person skilled in the art” was a hypothetical concept and that the same standard applied throughout a country even though the levels of technical expertise might be different in different areas. It further noted that, if the concept of a person skilled in the art linked to the level of development of the country concerned were applied to the determination of obviousness under draft Article 12(4), a claimed invention could be considered to involve an inventive step in a “low” technology country but not in a “high” technology country. The Representative of the EPO also noted the need to consider the impact of the proposals on the assessment of novelty and inventive step.

149. In response to a comment by the Delegation of Germany that PCT Article 5 referred to “a person skilled in the art” without reference to a country, the Delegation of Egypt noted that the PCT was expressly restricted to the form and contents of international applications and did not prescribe substantive conditions of patentability.

150. In response to a proposal by the Delegation of Brazil that the words “over the whole of its claimed range” be added after the words “made and used” in the second sentence, the Chair stated that, in his view, this was already covered by the reference to “the entire scope of the claim” in draft Rule 12(2). The Delegation of the United States of America stated that, although it agreed with the Delegation of Brazil that the disclosure must enable the invention to be made and used over its whole range, it also considered that this was already covered by draft Article 11(3) and draft Rule 12(2). The Representative of the EPO stated that it also

agreed that disclosure must be enabling over the entire scope of the claims, but considered it to be a matter for the Regulations.

151. The Chair summarized the discussions on paragraph (1) as follows: some delegations questioned the use of the expression “made and used,” and the International Bureau was requested to study the matter and to explore possible alternative wording, such as “carried out.” Some delegations proposed that the expression “a person skilled in the art” in the first sentence should be expressly stated to be a person in the country of grant, in order to take account of the different levels of technological capability in different countries and to have a comprehensive disclosure in all countries. In view of the divergent opinions among delegations on this proposal, the SCP agreed to include the words “in the country of grant” in square brackets at the end of the first sentence. One delegation suggested insertion of the words “over the whole of its claimed range” after the words “made and used” in the second sentence. While the objective of the latter suggestion was generally agreed, the SCP agreed that the International Bureau should examine how to best accommodate it in the text.

Paragraph (2)

152. The International Bureau explained that the words “under the applicable law” after the words “as amended and corrected” had been deleted for consistency with draft Article 7 which regulated the amendment and correction of applications. Following a suggestion by the Delegation of India that the deleted words should be re-instated in order to clarify that the amendments and clarifications concerned were in accordance with the applicable law, the SCP agreed that those words be retained, followed by the insertion of the words “in accordance with Article 7.” The Delegation of the Russian Federation observed that it was necessary to take account of draft Article 7(3) in the interests of harmonization.

153. The Delegations of Japan and the Russian Federation proposed that the word “claims” be deleted since, in their opinion, a claimed invention must be based on the disclosure in the description and drawings. The Chair noted that the same issue arose in connection with the relationship of the claims to the disclosure under draft Article 11(3). The Delegation of Australia commented that, although a claim should have a basis in the description at the grant stage, it was acceptable for the enabling disclosure to be only in the claims at the time of filing, since the description could subsequently be amended to incorporate that disclosure. In the light of the discussions, the Chair concluded that there was no consensus on the deletion of the term “claims” in paragraph (2) and that there was also a need to take into account whether that term was included or not in draft Article 11(3).

154. The Delegation of Brazil, supported by the Delegations of Argentina and India, proposed that the sentence “Information deleted from the application shall not be considered for that purpose” be added to the end of paragraph (2). In response to a comment by the Chair that, in his opinion, the matter was already covered by the words “as amended and corrected” and could be clarified in the draft Practice Guidelines, the Delegations of Brazil and India stated that they wished to include an explicit provision in the draft Article to put the matter beyond doubt. However, the Delegation of the United States of America considered that a clarification in the draft Practice Guidelines was an appropriate approach, since the proposed text could lead to problems of interpretation elsewhere in the Treaty. The Delegation of Germany referred to the need to take into account the possibility that deleted parts of an application could be re-instated before grant. The Representative of the EAPO stated that, instead of adding the proposed sentence which could prevent re-instatement of deleted parts of an application before grant, it would be preferable for the matter to be clarified in the draft

Practice Guidelines. The Delegation of Argentina observed that the objections that had been raised were of a technical nature and could be overcome by making appropriate drafting changes to the proposed new sentence, such as adding the words “where amendments and corrections include information that had been deleted.” The Delegation of Brazil noted that no delegation had suggested that deleted matter should be taken into account and stated that, in its opinion, it would be preferable to deal with the various matters that had been raised in the draft Treaty and Regulations, rather than in the draft Practice Guidelines which did not have a binding effect. The International Bureau observed that, in view of the consistency of the texts throughout the Treaty, an explicit reference to deletions in this provision would require similar references to such deletions in other relevant provisions of the Treaty and Regulations. The Chair suggested that the SCP should note the proposal of the Delegation of Brazil and request the International Bureau to examine whether the issue would be best dealt with in the draft Treaty, draft Regulations or draft Practice Guidelines.

155. The Chair summarized the discussions on paragraph (2) as follows: on the proposal of one delegation, the SCP agreed that the words “under the applicable law” be retained, followed by the insertion of the words “in accordance with Article 7.” One delegation proposed to delete the term “claims.” There was a debate on whether the provision should expressly refer to the fact that deletions should not be taken into account for the purposes of disclosure or whether the expression “as amended and corrected” covered deletions. The International Bureau was requested to examine whether the issue would be best dealt with in the draft Treaty, draft Regulations or draft Practice Guidelines.

Draft Rule 10: Sufficiency of Disclosure Under Article 10

156. A proposal of the Representative of the EPO, supported by the Delegation of the Russian Federation and the Representative of EPI, that the contents of draft Rule 10 should be moved to the draft Practice Guidelines was opposed by the Delegation of the United States of America which considered that factors relating to be considered in assessing enabling disclosure were of sufficient importance to be included in the Regulations.

157. In response to a request by the Delegation of Argentina for clarification of the terms “nature of the invention” in item (ii), and “the amount of direction provided in the application” in item (v), the International Bureau noted that an explanation of those terms was contained in paragraphs 123 and 124, respectively, of the draft Practice Guidelines.

158. The Chair noted that it had been agreed in the discussions on draft Article 10(1) that the use of the term “make or use” in item (vi) should be re-examined by the International Bureau.

159. The Chair summarized the discussions on draft Rule 10 as follows: opinions were split on whether this provision should be moved to the draft Practice Guidelines. The SCP agreed that the expression “make or use” should be re-examined by the International Bureau.

Draft Article 11: Claims

Paragraph (1)

160. In response to comments made by the Representative of EPI and the Delegation of the Russian Federation relating to the term “technical,” the Chair noted that the SCP had agreed, at an earlier meeting, to discuss all the aspects relating to the terms “technical” and “fields of technology” in conjunction with draft Article 12(1).

161. The Delegation of Germany suggested that the wording “for which protection is sought” did not adequately cover claims in granted patents as well as pending applications. In response to a comment by the Chair, the Delegation observed that the wording concerned was appropriate in the context of PCT Article 6, since that provision related only to pending applications. On the suggestion of the Chair, the SCP agreed to refer the matter to the International Bureau for further study.

162. The Chair summarized the discussions on paragraph (1) as follows: one delegation suggested that this provision should be reviewed to ensure that it would adequately cover claims in granted patents as well as pending applications. The SCP agreed to refer this matter to the International Bureau for further study. In response to comments made by two delegations relating to the term “technical,” the Chair noted that the SCP had agreed, at an earlier meeting, to discuss all the aspects relating to the terms “technical” and “fields of technology” in conjunction with draft Article 12(1).

Paragraph (2)

163. The SCP provisionally accepted this provision.

Paragraph (3) and draft Rule 12(2)

164. The Delegation of Argentina, supported by the Delegations of China, Japan, Kenya, Malaysia and the Russian Federation, proposed that the bracketed word “claims” in draft Article 11(3) and draft Rule 12(3) be deleted so that the claims would be supported by the description and the drawings only.

165. Referring to paragraph 136 of the draft Practice Guidelines, the Delegation of Germany, supported by the Delegations of Canada and the United States of America, and the Representative of the EPI, contended that the reference to the claims was necessary. The Delegation of Canada noted that, if the reference to the claims was not included, an application would be refused, or a patent would be revoked, in accordance with draft Articles 13 and 14, on the grounds that the claimed invention was not supported by the description, only because the applicant missed the opportunity to transfer text contained in the claims to the description during the examination procedure. The Chair added that this problem could also be relevant to non-examining Offices.

166. The Representative of the EPO introduced the so-called support requirement provided in the EPC, which was a formal requirement that did not constitute a ground for revocation. The Delegation of China, supported by the Delegations of Germany and the United States of America, however, stated that the requirement laid down in draft Article 11(3) and draft Rule 12(2) was a substantive requirement which should be a ground for revocation. Referring to paragraph 138, first sentence of the draft Practice Guidelines, the Representative of WASME noted that, during examination, if the applicant had under-claimed his invention, he would lose something which was contained in the description only, and if he had over-claimed his invention, he would be required to justify his broad claim. In his view, the words “of the [claims], description and drawings” in draft Article 11(3) were not necessary because of the word “fully.”

167. The Delegation of China observed that the requirements concerning claims involved three aspects to be considered. The first aspect concerned novelty and inventive step, which

related to prior art. The second concerned the relationship between the claims and the disclosure, which was laid down in draft Article 11(3). The third aspect related to the claims themselves, such as the requirement regarding clear and concise claims. In the view of the Delegation, these were all important substantive requirements, which had to be distinguished from the enabling disclosure requirement under draft Article 10. This view was supported by the Delegation of Argentina. The Delegation of China further suggested that the bracketed word “claims” be replaced by the words “other claims” in order to avoid a situation where a claim was supported by that claim itself.

168. The Delegation of Australia stated that there were two separate issues surrounding the support requirement. The first issue, which could be fulfilled by copying the text of the claims to the description, was whether the claims were formally supported by the description. The second issue was whether the applicant recognized the whole scope of the claimed invention on the filing date. The Chair, supported by the Representative of GRUR, proposed that the International Bureau review the draft by separating the substantive issue reflected in draft Rule 12(2) from the issue of formal consistency between the claims and the description.

169. The Delegations of Argentina and the Russian Federation suggested that the words “the claimed invention” in draft Article 11(3) be replaced by the words “the claim.” The Delegation of Australia expressed the view that the term “claimed invention” implied the substantive concept of the claimed invention behind the text of the claims. The International Bureau proposed that draft Article 11(3) read as follows: “The scope of the claims should be supported by the disclosure of the claims, description and drawings[, as prescribed in the Regulations].”

170. The Delegations of Canada and China queried whether the words “and drawings” should be replaced by the words “or drawings.” The Delegation of the United States of America stated that the text should reflect the concept that the entire disclosure was relevant. The Chair noted that, since the choice of the word “and” or “or” was a linguistic matter, the SCP could leave this issue to the International Bureau for further examination.

171. The Delegation of New Zealand, supported by the Representative of EPI, suggested that, as in the case of draft Article 10(2), the words “, as amended and corrected under the applicable law in accordance with Article 7” be inserted after the word “drawings” in draft Article 11(3).

172. The Delegation of Argentina proposed that, in order to clarify the relationship between the claim and the teaching, the second part of draft Rule 12(2) should read as follows: “thereby ensuring that the claim does not comprise subject matter which the applicant had not recognized and described on the filing date.” The Delegation of Australia wondered whether the second part of draft Rule 12(2) was an inevitable consequence of the first part of the sentence or an additional condition to the first part. If the former was the case, the Delegation considered the second part redundant.

173. Summarizing the discussion on draft Article 11(3) and draft Rule 12(2), the Chair stated that the International Bureau would review these provisions taking into account the various views that had been expressed.

Draft Rule 11: Deposit of Biological Material for the Purposes of Articles 10 and 11(3)

Paragraph (1)

174. The Delegation of the Russian Federation suggested that the words “to describe the claimed invention in compliance with” be replaced by the words “to fulfil the requirement of.” The SCP provisionally accepted this provision with the proposed modification.

Paragraph (2)

175. The International Bureau noted that the SCP had agreed, at its eighth session, not to discuss the alternatives at this session. The Chair stated that, in view of the split of opinions in the SCP at past sessions, he would propose to avoid repeating the same debate. The Delegation of Australia expressed the view that Alternative B, subparagraph (b)(i), was duplicative of draft Rule 11(1)(ii). The Delegation further considered that Alternative B should be tied to the publication of the application. The Representative of the EPO, supported Alternative A and expressed concerns about Alternative B, subparagraph (b)(i), which, in his view, could result in the addition of new matter. The International Bureau was requested to further examine these issues.

Paragraph (3)

176. The SCP provisionally accepted this provision.

Draft Rule 12: Details Concerning Claims Under Article 11

Paragraph (1)

177. The Delegation of Japan expressed the view that the definition in subparagraph (a) was useless in the case where a claimed invention was defined by uncommon and unusual parameters, and consequently, proposed that this provision be moved to the draft Practice Guidelines. However, the Delegation of China, supported by the Delegations of the Russian Federation and the United States of America, stated that the provision should stay in the Regulations due to its importance.

178. Concerning claims characterized by uncommon and unusual parameters, the Delegation of Australia suggested that the International Bureau look at the relevant part of the PCT International Search and Preliminary Examination Guidelines. In its view, the problems that arose from uncommon and unusual parameters in the claims related to practical examination in respect of searching prior art rather than to the issue of clear and concise claims.

179. The Delegations of China and the United States of America sought clarification about the applicability of this provision to a single claim, since it referred to the word “claims” in the plural. Noting that draft Article 11(2) referred to both an individual claim and the totality of claims, the Chair requested the International Bureau to further review the draft. The Delegation of the Russian Federation expressed the view that the current draft was not sufficiently clear to allow for an objective implementation of the Regulations.

180. The Chair summarized the discussion by stating that the International Bureau was requested to further clarify the terms “clear” and “concise,” taking into account the comments made by delegations.

Draft Article 11(4) and draft Rule 13(5)

181. The Delegation of Japan stated that it could accept draft Article 11(4) only if the provision was limited to the claim interpretation prior to the grant of a patent. The Delegation of the United Kingdom shared the concern expressed by the Delegation of Japan, and suggested deletion of draft Article 11(4)(b) and draft Rule 13(5) which were, in its view, post-grant issues. The Delegation of Colombia proposed the deletion of the doctrine of equivalents which was regulated in draft Article 11(4)(b) and draft Rule 13(5), since the scope of the claims should be determined by their wording and an invention had to be described in specific terms rather than in general terms.

182. The Delegation of the Russian Federation stated that, although it did not oppose the inclusion of a provision concerning equivalents in the draft SPLT, current draft Article 11(4)(b) did not support the objective of harmonization, in particular, in view of the definition of equivalents contained in draft Rule 13(5).

183. The Delegation of the United States of America, supported by the Delegations of Australia, France, Germany and Ireland, expressed the view that it was useful to retain draft Article 11(4)(b) in view of the direct link between the harmonization of equivalents and the harmonization of claim drafting. The Delegations of Austria and Romania and the Representative of the EPO supported the retention of draft Article 11(4)(b) and draft Rule 13(5). The Representative of the EPO, however, queried whether the doctrine of equivalents belonged to the concept of “interpretation of claims,” which was the title of draft Article 11(4). The Delegation of Austria noted that, although the doctrine of equivalents was applied during infringement procedures, the concept of equivalents was implicitly applied during the search and examination procedure. The Delegation of Australia expressed its difficulty to accept different claim interpretation rules applicable before and after the grant of a patent, and recalled the link between the concept of enlarged novelty and the concept of equivalents. Supporting this view, the Delegation of France suggested that the SCP first review the study concerning enlarged novelty to be prepared by the International Bureau.

184. The Delegation of India suggested that draft Article 11(4)(b) be retained and draft Rule 13(5) be deleted, so that the determination of equivalents would be fully left to national courts. The Delegation of Argentina also proposed the deletion, or a revision, of draft Rule 13(5), since it dealt with infringement issues.

185. As regards the elements to be used for the interpretation of the claims under draft Article 11(4)(b), a proposal by the Delegation of the United States of America suggesting the inclusion of abstracts prepared by the applicant was opposed by the Delegations of Austria, Germany and Ireland.

186. In response to a comment made by the Delegation of China that the observations submitted by the applicant during the examination procedure should also be taken into account for the interpretation of claims under draft Article 11(4)(a), the Chair noted that draft Rule 13(6) dealt with the issue as far as patented claims were concerned.

187. The Delegation of Argentina expressed its concern about the use of the term “the general knowledge of a person skilled in the art” in draft Article 11(4)(a).

188. The Chair summarized the discussion by stating that the SCP would revisit those provisions after reviewing the study concerning enlarged novelty to be prepared by the International Bureau, and that the International Bureau would review the text taking into account the various comments made.

Draft Rule 13: Interpretation of Claims Under Article 11(4)

Paragraph (1)(a)

189. The SCP provisionally accepted this provision.

Paragraph (1)(b)

190. While recognizing the underlying concept, the Delegation of India, supported by the Delegations of Argentina and Brazil, expressed its concern about the open-ended nature of this provision. The Delegation of Australia noted that, similar to the doctrine of equivalents, the question at stake was to what extent the scope of the claims could be extended by their interpretation. The Chair noted the relevance of this provision for the concept of enlarged novelty. The Delegation of the United States of America stated that the doctrine of equivalents and this provision related to two different issues. In its view, the former was applicable in the context of infringement when assessing whether a defendant was infringing a patent, while the latter concerned the interpretation of claims in terms of their validity when assessing novelty and inventive step. The Chair summarized the discussion by stating that the International Bureau should further examine the provision.

Paragraph (2)

191. In order to avoid using a negative way of formulating the sentence, the Delegation of Argentina proposed the following text in subparagraph (a): “The claims shall be interpreted as limited to the embodiments expressly disclosed in the application.” This proposal was opposed by the Delegations of Australia, Canada, Germany and the United States of America, and the Representative of the EPO, on the grounds that it would require the applicant to include all possible embodiments in the claims, which would be extremely difficult where the claimed invention applied, for example, to a certain range of temperatures. The Delegation of the United States of America noted that, although the words “only where the claims are expressly limited to such embodiments” could be added at the end of the text proposed by the Delegation of Argentina in order to preserve the meaning of the original provision, the Delegation preferred the text as proposed in document SCP/10/3. The Delegation of Germany expressed concern about the draft proposed by the Delegation of Argentina, which would require an applicant to describe the whole range of sub-claims to be included in the main claim, and expressed its preference for the text contained in document SCP/10/3. The Delegation of Brazil reserved its position on this provision, since it needed more time to consider the proposal made by the Delegation of Argentina.

192. The Delegation of Canada, supported by the Representative of the EPO, proposed that the word “application” in subparagraph (a) be replaced by the word “description,” since the abstract was a part of the “application.” The International Bureau noted that drawings might also contain embodiments. However, in view of the discussion concerning the status of the abstract in other contexts such as the basis for amendments under draft Article 7, the Delegation of the United States of America did not share the views expressed by the Delegation of Canada and the Representative of the EPO.

193. The Chair summarized the discussion as follows: an alternative text proposed by one delegation concerning subparagraph (a) was not supported by other delegations. One delegation reserved its position on this provision. Some delegations expressed concern about the reference to the term “application” which would include the abstract.

Paragraph (3)

194. The SCP provisionally accepted this provision.

Paragraph (4)

195. The Delegation of Argentina, supported by the Delegation of Brazil, proposed that the words “Where a Contracting Party accepts such claim” be inserted at the beginning of subparagraph (a) so that the provision would be optional for each Contracting Party. The Delegation of India proposed inclusion of the words “Subject to the applicable law of the Contracting Party” at the beginning of subparagraph (a) for the same purpose. The Delegations of Australia and the United States of America and the Representative of the EPO, however, supported the text as proposed in document SCP/10/3. The International Bureau was requested to include two options in square brackets into the next draft. The Delegation of the United States of America expressed the view that the use of means (step)-plus-function claims should be left to the discretion of applicants.

196. Concerning subparagraph (b), the Delegation of Australia and the Representative of the EPO expressed support for the provision as proposed. The Delegations of Argentina and China suggested that product-by-process claims should be allowed only where it was not possible to define a product by its composition or structure. The Delegation of China further proposed that, if a product was defined by its manufacturing process in the claim, the scope of the claim be limited to the product obtained by that manufacturing process. The Delegation of the United States of America, however, expressed the view that the use of product-by-process claims should depend on whether the claimed invention could be better characterized by such type of claims.

197. With respect to subparagraph (c), the Representative of the EPO, supported by the Delegation of Australia, proposed that a claim defining a product for a particular use be construed as defining any product suitable for, but not necessarily restricted to, such use. The Delegation of the United States of America, which considered the provision to be very broad, expressed concern about “use claims,” which were not accepted in its country. The Delegation of China supported the text as proposed. In its view, since the applicant decided to limit a claim to a particular use for one reason or another, expanding the scope of the claim to other use was not fair for the general public.

198. The Chair concluded that there was no consensus regarding this provision, and that the International Bureau would further reflect on the points raised by delegations.

Paragraph (6)

199. The Delegation of the Russian Federation supported the alternative “may.” The Chair recalled that the discussions at past meetings had shown divided opinions regarding the alternatives “may” and “shall.” The Delegation of Australia questioned whether the word “due” was needed.

Draft Article 12: Conditions of Patentability

Paragraphs (1) and (5)

200. In response to a question posed by the Delegation of Brazil regarding the meaning of the term “postponed” that appeared, for example, in the footnote to draft Article 12(1) and the term “reserved” that appeared, for example, in draft Rule 16, the International Bureau explained that the term “postponed” referred to a decision by the SCP to postpone discussion on that provision, while the term “reserved” indicated that an issue had been identified, but that no specific text for a provision had been proposed yet.

201. The Delegation of the Islamic Republic of Iran proposed that inventions contrary to public order be included in the list of non-patentable subject matter under paragraph (1)(b), since the final objective of the patent system should consist in meeting social development and welfare, and since that concept was recognized in every society.

202. Following an invitation by the Chair to comment on the re-opening the discussion on draft Article 12(1) and (5), the Delegations of Argentina, Brazil, the Dominican Republic, Egypt, India and Malaysia supported re-opening the discussion on those provisions on the following grounds: the postponement of the discussion as contained in the footnote did not mean indefinite postponement; the interests of all countries may not be adequately reflected if the issues were fragmented and taken up sequentially; the procedural decision could be re-considered upon request by any delegation who wished to resume discussion; it was timely to resume discussions on draft Article 12(1) and (5), since patentable subject matter, novelty and inventive step all related to the conditions of patentability; and the footnotes had lost their “*raison d’être*,” since some delegations had expressed the view that it was not appropriate to discuss the totality of the draft SPLT any longer.

203. The Delegations of Germany and the United States of America did not support re-opening the discussion because of the following reasons: a wide divergence of views which were not easy to reconcile still existed in the SCP; there were other issues on which progress could be made and the rationale behind the adoption of the footnote thus still existed; and, since the SCP had reached no consensus as to how to proceed in the future, the current discussion could be no more than a mere *ad-hoc* exchange of views.

204. The Delegation of Mexico noted that, with regard to draft Article 12(1), no delegation had made any proposal that went beyond the different positions regarding the term “all fields of technology.” The Delegation suggested that the following methodology could apply in respect of those provisions which had been agreed to postpone: (i) the Chair should ask the SCP whether any delegation wished to make a proposal going beyond the different positions or was ready to take a more flexible approach; (ii) if there was any such delegation, the Chair would re-open the discussion; and, (iii) if there was no such delegation, the Chair would conclude that the discussion should be further postponed.

205. After some discussions, the Chair suggested that the SCP proceed to discuss draft Article 12(1) and (5) and draft Rule 16.

206. The Delegation of Australia, supported by the Delegation of Germany, noted that draft Article 12(5) and draft Rule 16 were optional provisions, which were consistent with Article 27.2 of the TRIPS Agreement, while draft Article 12(1)(b) was of a mandatory nature.

The Delegation further noted that the Australian patent law did not provide exceptions to patentability for inventions contrary to public order.

207. The Delegation of Malaysia supported the proposal by the Delegation of the Islamic Republic of Iran, although it understood that the public order exception might fall under draft Article 12(5).

208. The Delegation of Egypt, supporting the proposal by the Islamic Republic of Iran, explained that, according to Article 2 of its Law on the Protection of Intellectual Property Rights, patents should not be granted for: (i) inventions whose exploitation was likely to be contrary to public order or morality, or prejudicial to the environment, human, animal or plant life and health; (ii) discoveries, scientific theories, mathematical methods, programs and schemes; (iii) diagnostic, therapeutic and surgical methods for humans and animals; (iv) plants and animals, regardless of their rarity or peculiarity, and essentially biological processes for the production of plants or animals other than microorganisms, non-biological and microbiological processes for the production of plants and animals; and (v) organs, tissues, live cells, natural biological substances, DNAs and the genome. The Delegation explained that its legislation was fully in line with the TRIPS Agreement. The Delegation expressed the view that, when seeking patent law harmonization, the TRIPS Agreement, which was a minimum standard, should not be the benchmark, but that all national legislation should be taken into account.

209. The Delegation of Mexico stated that, since an exception for inventions contrary to public order should be non-compulsory for States, it should be included in draft Rule 16 under draft Article 12(5).

210. The Delegation of Ireland expressed the view that the subject matter under paragraph (1)(b) had in common that they were either of an abstract nature or had non-technical character. Therefore, those items were not considered as inventions. On the other hand, referring to the EPC and the Directive of the European Parliament and Council on the Legal Protection of Biotechnological Inventions, the Delegation considered that there were certain issues, including inventions contrary to public order and morality, that should, at the option of each State, be excluded from patentability in view of public policies.

211. The Delegation of Greece, supporting the interventions of the Delegations of Australia and Ireland, observed that the subjects listed under paragraph (1)(b) were not considered inventions to be eligible for patent protection, while the items under paragraph (5) were inventions, but were excluded from patent protection.

212. The Delegation of Kenya considered that draft Article 12 dealt with fundamental issues concerning patentability. The Delegation explained that, under its legal regime, non-patentable subject matter included not only inventions contrary to public order and morality, but also those inventions that had negative impacts on environment and health, and that inventions relating to methods of treatment and diagnostic methods were excluded from patent protection.

213. The Delegation of Brazil agreed with the general distinction between draft Article 12(1) and (5), and stated that the proposal by the Islamic Republic of Iran should be included in draft Article 12(5), but not in draft Rule 16 in view of its importance. The Delegation of Brazil further suggested that the words "*inter alia*" be inserted at the end of the introductory words of paragraph (1)(b), although it agreed with the items listed in that paragraph. This

suggestion was opposed by the Delegation of the United States of America, since it would undermine harmonization. The Delegation considered that, although it could accept clearly defined optional exceptions, a mere quotation of Article 27.2 and 3 of the TRIPS Agreement was not acceptable in view of the objective to establish best practices. For example, in its view, patent protection for plants and animals would be of great benefit to the biotechnology industry.

214. The Delegation of Argentina stated that the proposal by the Delegation of Brazil did not contradict the TRIPS Agreement. The Delegation further requested the International Bureau to conduct a study concerning the inter-relationship between the provisions of the draft SPLT and those of the TRIPS Agreement. The International Bureau stated its willingness to establish a table of correspondence between the provisions of the draft SPLT and the relevant provisions of the TRIPS Agreement. The Delegation of the United States of America commented that, in doing so, the International Bureau should not engage in any interpretation of the TRIPS Agreement or influence ongoing discussions concerning that Agreement.

215. The Delegations of Argentina and Brazil sought clarification in respect of the term “mere discoveries” in paragraph (1)(b)(i).

216. The Delegation of Cameroon considered that the public policy issues, which differed in each country, should be addressed in paragraph (5) as an optional provision.

217. The Delegation of Egypt supported the Delegation of Brazil regarding inclusion of the exceptions in the Treaty itself, due to the importance of those exceptions. The Delegation, speaking on behalf of the African Group, stated that, in March 2004, the African Group had made a proposal in the context of the revision of Article 27.3(b) of the TRIPS Agreement in the WTO, which suggested the prohibition of patent protection on life forms. The Delegation observed that that proposal should be taken into consideration in the context of draft Article 12(1)(b).

218. The Delegation of India wondered whether it was necessary to address issues relating to patentable subject matter in the draft SPLT, since they were already regulated in the TRIPS Agreement. In the Delegation’s view, since the SCP was discussing substantive patent law harmonization, it was appropriate for this body to consider any improvement to Article 27.2 and 27.3 of the TRIPS Agreement.

219. The Delegation of Morocco stated that the exceptions for inventions contrary to public order should be included in draft Article 12(5).

220. The Delegation of the Islamic Republic of Iran stated that it could accept the inclusion of its proposal in draft Article 12(5).

221. The Delegation of Algeria supported the inclusion of the proposal by the Delegation of the Islamic Republic of Iran in draft Article 12(1)(b).

222. Concerning the question as to whether the exceptions to patentability should be included in the Treaty or in the Regulations, the Representative of the CEIPI expressed his preference for the Regulations, since, in view of unforeseeable technical developments, a certain flexibility for possible future modifications of such a provision might be preferable. This was not only important in view of future deletions of exceptions, but also in the case of possible additions of exceptions. The Representative added that, as a safeguard measure,

Contracting Parties could require unanimity for the modification of such a provision. The Delegation of Brazil reiterated that the exceptions should be contained in the Treaty in view of their importance, although different ways could be envisaged for future modifications of the Regulations. The Delegation of Brazil further considered that there could be other items that needed to be covered by paragraph (1)(b), and suggested, subject to the clarification of the expression “mere discoveries,” the adoption of items (i) to (iv) in that paragraph as well as the insertion of a new item (v) with the text “reserved.”

Draft Article 13: Grounds for Refusal of a Claimed Invention

Paragraph (2)

223. The Delegations of Colombia, Denmark, Kenya, Norway and Romania, and the Representative of CEIPI, supported the inclusion of secret prior commercial use and offer for sale as grounds for refusal in this provision. In addition, the Delegations of Belgium, Finland, Germany, the Netherlands, Portugal, Spain and the United Kingdom, and the Representative of the EPO, stated that, although they opposed the inclusion of secret prior commercial use and offer for sale as prior art under draft Article 8(1), they could consider, as a compromise, accepting such use and sale as grounds for refusal of a claimed invention. However, paragraph (2) was opposed by the Delegation of the Russian Federation, supported by the Delegation of Ukraine, for the same reasons that it had opposed the inclusion of prior secret commercial use and offer for sale as prior art under draft Article 8(1), although it could consider such use as grounds for revocation of a patent if any country had such a provision in its existing law. Paragraph (2) was also opposed by the Delegation of France which similarly considered that such prior secret use should be a ground for revocation of a patent, rather than for refusal of an application, but also considered that, as such, it would be outside the scope of the draft Treaty. Paragraph (2) was also opposed by the Delegation of the Republic of Korea which observed that there was no risk of double patenting, by the Delegation of Ireland which stated that it did not consider prior secret use to be a matter for patent law, and by the Representative of the EAPO for reasons similar to those it had given for opposing the inclusion of such use as prior art under draft Article 8(1).

224. In reply to a statement by the Delegation of India that a sanction against prior secret commercial use was necessary to prevent an inventor increasing the term of protection for his invention by first using it secretly and then, perhaps many years later, applying for a patent, the Chair noted that such a sanction would be provided under paragraph (2).

225. The Representative of the EPO, supported by the Delegation of India and the Representative of GRUR, observed that the period under paragraph (2) for which the claimed invention in the application was on sale in the Contracting State was linked to the grace period. A suggestion by the Representative of the EPO that the period should be more than one year prior to the “priority date” of the application, rather than prior to the “filing date,” was supported by the Delegations of Australia and the United States of America. The Delegation of India stated that it favored a period of six months rather than 12 months and suggested that both periods should be included in square brackets as alternatives.

226. In response to a proposal by the Delegation of Germany that paragraph (2) should be limited to sale by the applicant, the Delegation of Australia suggested that the sale could also be authorized by the applicant. The Delegation of the United States of America also referred to the need to link the sale to the applicant.

227. The Chair summarized the discussions on paragraph (2) as follows: since a number of delegations had expressed their support for paragraph (2), it should remain within square brackets for further consideration. However, the International Bureau should further revise the paragraph taking into account a number of points raised by delegations.

CONCLUSION OF THE MEETING

Agenda Item 7: Future Work

228. Referring to his conclusion on the first day of the session that the SCP was unable to reach agreement on how to move forward and that the issue should be submitted to the General Assemblies for direction on how to proceed with future work (see paragraphs 64 and 66, above), the Chair invited comments.

229. The Delegation of Brazil expressed the opinion that the SCP had the capacity of conducting and directing its own work and noted that, when the SCP started discussions on the draft SPLT in the year 2000, it took a highly relevant and significant decision without any external influence. The Delegation indicated that, at the fifth session of the SCP, a first draft SPLT had been submitted and that all discussions since had been based on decisions taken by the Committee. The issue at stake was not a minor decision, since the SPLT was a treaty that would create obligations for States. The Delegation therefore was of the opinion that the Committee alone was competent to deal with the future and follow up of its work.

230. The Chair agreed that the Committee had been given a very broad mandate and had the ability in large measure to decide on the future direction of its work, but noted that there had not been agreement as to what that direction should be.

231. Referring to the statement made by the Delegation of Brazil, the Delegation of India pointed out that referring the issue of future work to the Assemblies might not be appropriate, since the Committee had not been mandated by the Assemblies to submit periodical reports or seek guidance from the Assemblies. The Delegation observed that a proposal had been submitted by three delegations, that there was a lack of consensus on accepting the suggestions regarding the future course of work contained in that proposal, and that, unless there was consensus that the issue needed to be taken to the Assemblies, it wondered on what basis the issue could be taken to the Assemblies.

232. The International Bureau explained that the Program and Budget that was presented for consideration to the Member States in March 1999 mentioned, amongst the activities for the SCP, the consideration of the desirability and feasibility of further harmonizing patent law; that the Assemblies were always competent and exercised review of this Committee's activities in various ways; that it had become a practice for certain committees to refer matters that had not been able to achieve some form of agreement at a committee level to a higher political level like the Assemblies. The International Bureau cited the example of the IGC, which, regarding an invitation that was addressed to WIPO by the Conference of Parties of the Convention on Biological Diversity, had assessed that it would be more appropriate to seek the guidance of the Assemblies with respect to how that invitation should be treated.

233. The International Bureau noted that, as far as the agenda of the Assemblies was concerned, according to Rule 5 of the WIPO General Rules of Procedure, the Director General exercised a measure of discretion with respect to the work program that should be

considered or that he considered as a chief executive officer was appropriate for consideration by the Assemblies. Further, Rule 5(4) of the WIPO General Rules of Procedures stated that any Member State of a body may request the inclusion of a supplementary item on the draft agenda and that such request shall reach the Director General not later than one month before the date of the opening of the session.

234. Sharing the views expressed by the Delegations of Brazil and India, the Delegation of Argentina recalled that the question of discontinuing the mandate referred to in the Program and Budget of 1999 had actually not been raised on the first day of the session. The Delegation asked what the basis was for including a proposal made by three delegations as an item on the agenda of the Assemblies. Since the SCP had not reached a consensus, it would be unlikely that the dissent could be overcome in the Assemblies. In the past there had been many other proposals in other committees on which no agreement had been reached, but which had not been included as an item on the agenda of the Assemblies.

235. The Chair stated that he had reached the conclusion that there was no agreement as to whether to refer the issue of future work to the Assemblies, and asked for comments on that conclusion.

236. The Delegation of India stated that, in spite of the fact that a proposal by three delegations to consider a very limited number of issues had not met with consensus, the draft SPLT remained a legitimate basis for proceeding with the work of the Committee. The Delegation observed that concluding that there was no agreement on how to proceed because a proposal put forward by some delegations had failed to get consensus would open the door to chaos not just in the SCP but in any body of the Organization, and might prevent progress on any activity of WIPO.

237. The Delegation of Egypt expressed full support for the intervention by the Delegation of India and noted that, in the context of WIPO, issues that had been on the agenda of committees for many years continued to be discussed in those committees and were not referred to the Assemblies. The fact that the SCP was addressing difficult and very technical issues, where delegations had been progressively involved, explained the length of the discussions. The Delegation believed therefore that the SCP was the proper forum to address the issue of its future work.

238. The Delegation of the Islamic Republic of Iran fully shared the views expressed by the Delegations of Egypt and India, and believed that the SCP should continue to consider all issues contained in the draft SPLT.

239. The Chair noted that one proposal for future work was to continue to discuss all of the issues which were raised in documents SCP/10/2, 3, 4, 5 and 6, and invited comments on whether there could be agreement to proceeding on that basis.

240. The Delegation of Algeria wondered whether the SCP was really moving towards a viable legal instrument and expressed concern about repeatedly postponing discussion of certain Articles, which might lead to their abandonment although they were of particular importance to developing countries. The Delegation believed that the Committee should continue its work because it had not yet been completed and, given the limited time available, the Assemblies could only give general guidance.

241. The Delegation of Ireland, speaking on behalf of the EC and its Member States, reiterated its proposal that the SCP should initially concentrate on the four topics proposed by the United States of America, Japan and the EPO.

242. The Delegation of the United States of America recognized that, during the discussion on the first day of the session, there had been an impasse, that it was impossible to agree on future work of the SCP, and that there had also been an acknowledgement that these issues should be directed to the Assemblies. The Delegation, although it did not support discussion of the Articles in a sequential order, had been willing in a spirit of cooperation, to make some comments solely on the understanding that this was intended to advance some technical points in those Articles, but commented that it did not agree with that way of proceeding in future. The Delegation stated that it did not believe that the *status quo* was viable any longer for achieving the goals of the Committee and that it saw no consensus on how to proceed, and observed that, in the absence of agreement as to whether to address the Assemblies, the SCP might simply agree that there was no consensus on how to further proceed.

243. The Delegation of the United Kingdom recalled that the discussion on the proposal by the United States of America, Japan and the EPO highlighted the fundamental disagreements between delegations on how the Committee should proceed with its work and program, and that the Assemblies as a competent and higher political body seemed to be the appropriate forum to make the decision on where the future work of the Committee should be heading.

244. The Delegation of Mexico believed that harmonization was still the goal of the Committee and that taking the issue to the Assemblies would mean recognizing that there was no will to pursue substantive harmonization. The Delegation proposed continuing consideration Article by Article, discussing whether each Article should be included in the Treaty or not and, if the conclusion of the meeting is to delete an Article, to delete it. All delegations would be able to express their views on the suitability of each and every Article and a common understanding to define the scope of the Treaty could be reached.

245. The Delegation of Argentina stated its view that there was a lack of consensus on the proposal submitted by three delegations, but not on the work of the SCP.

246. The Delegation of Japan reiterated its view that a reduction of the number of items to be discussed was the most efficient way to proceed. It supported the conclusions made by the Chair on the first day of the session and considered it appropriate to seek the direction of the Assemblies, the most competent organ of WIPO.

247. The Delegation of Switzerland, considering that focussing on an initial package of priority items seemed the best way to make quick progress, supported the conclusion by the Chair on the first day of the session and the proposal that the Assemblies give guidelines to the SCP on how to proceed in the future.

248. The Representative of the EPO supported the interventions of the Delegations of Ireland on behalf of the EC and its Member States, Japan, Switzerland and the United States of America, and stated that, in order to achieve progress on substantive patent law harmonization more rapidly, the Committee should focus on certain items. He therefore supported the conclusion of the Chair drawn on the first day of the session and the proposal that the question of future work be referred to the Assemblies.

249. The Delegation of Germany also believed that it would be best for the SCP to focus on the four topics that had been mentioned and that, since it was clear that there was no consensus on the future work of the SCP, it would be appropriate to refer the question to the Assemblies.

250. The Delegation of Romania supported the statement made by the Delegation of Ireland on behalf of the EC and its Member States on the first day of the meeting and supported the proposal put forward by the EPO.

251. The Delegation of India queried whether those delegations that were in favor of referring the proposal to the Assemblies were indirectly saying that the draft SPLT as it had been discussed since 2001 was now formally abandoned. The two issues that the SCP would have to decide on by way of consensus was whether or not to abandon the draft SPLT and if so, look at what the SCP should be doing if it was to continue its work. The Delegation sought confirmation from those delegations that had supported to refer the matter to the Assemblies that they did not agree to consider the draft SPLT as it was contained in documents SCP/10/2 to 6.

252. The Delegation of Kenya pointed out that, if the issue of future work were referred to the Assemblies, the position of the delegates would not change unless new proposals on how to proceed were made.

253. In response to a query made by the Delegation of India, the Delegation of France pointed out that the very significance of the proposal to restrict the scope was that there was a strong desire to have an SPLT and to continue the discussions within the SCP. The Delegation fully endorsed the conclusions of the Chair put forward on the first day of the session and felt that a consensus within the Committee was not necessary to take a matter to the Assemblies. On the contrary, where a blockage occurred, it was the duty of the Director General to put it on the agenda of the Assemblies.

254. The Delegation of the Dominican Republic stated that it considered the draft SPLT was part of a broader agenda, in the form of the WIPO Patent Agenda and that, if the Assemblies had to take a decision on the future work of the SCP, that should not be done on the basis of limited or specific provisions, but based on the entire draft SPLT. The Delegation further stated that, in the context of the WIPO Patent Agenda, the future work of other committees, like the Working Group on Reform of the PCT, should also be reviewed in order to maintain consistency in the work of the Organization.

255. The Delegation of the Islamic Republic of Iran supported the Delegation of India in that one could not say that there was no consensus on how to proceed, since the proposal was part of the draft SPLT and would be considered.

256. The Delegation of Brazil pointed out that in fact, the SCP had received guidance from the Program and Budget Committee, which at its last meeting had discussed the harmonization of substantive patent law as well as other possible issues that could be dealt with in the SCP, and suggested that, in the next session of the SCP, a discussion could take place on including additional items on the agenda of the SCP. The Delegation further made it clear that, although this might not be the case for all delegations, its country was prepared to continue to engage in discussions on the draft SPLT.

257. The Delegation of Argentina asked whether not accepting to discuss the four items of the proposal from the United States of America, Japan and the EPO meant that the negotiations were stopped.

258. The Delegation of the United States of America stated that it was certainly not the intention of the United States of America to abandon the draft SPLT, but the Delegation recognized that, since there was no consensus on how to further proceed, it seemed logical to take the issue to the Assemblies.

259. Summarizing the discussion, the Chair concluded that there was fundamental disagreement amongst delegations as to how to proceed with future work. A number of delegations had indicated a wish to continue to discuss all of the issues raised in documents SCP/10/2, 3, 4, 5 and 6, but a large number of delegations had indicated that they were not prepared to proceed on that basis. As to the question of referral to the Assemblies, the Chair suggested to leave it to the various delegations to interpret the Rules of Procedure and to apply them in an appropriate manner.

260. The Delegation of South Africa expressed concern with regard to taking the issue to the Assemblies, since this would create a precedent. It suggested that the SCP had the power to address the issue before it was submitted to the Assemblies.

261. The Delegation of India, referring to the Delegation of Ireland speaking on behalf of the EC and its Member States, believed that it was counterproductive to insist on the number of countries that stood behind the position of the EC, since such an approach could be divisive in an organization which valued an objective approach to issues, and that as large as the number of countries might be, they finally represented only a small proportion of the overall membership of WIPO. It recalled that a vast majority of the members of WIPO were developing countries faced with the challenge of having a patent system that was truly responsive to their needs. The Delegation of China, for example, could preface its remarks by saying that it speaks on behalf of 1.3 billion people, or the Delegation of India could preface its remarks that the Delegation speaks for 1.1 or 1.2 billion people. Although everybody knew that, when the presidency of the EC spoke, there was clearly a fairly wide degree of support behind that, the idea should not be a doctrine of deference which commanded the rest of the membership of WIPO to yield to the dictates of what was still a fairly small proportion of the overall membership.

262. Following to a large extent the comments made by the Delegation of India, the Delegation of Brazil observed that the whole discussion related to an item which had been removed from the agenda and that the issue to be discussed was future work. The Delegation recalled that the SCP had not been set up for the discussion of just the draft SPLT, which was merely one item on the agenda of the SCP. It further stated that harmonization could not be achieved through the SPLT only and suggested that perhaps the time had come to discuss other matters, that perhaps the whole draft SPLT should be put into square brackets and its discussion postponed, and that there were other patent issues that could usefully be discussed in the SCP.

263. The Chair noted the proposal by the Delegation of Brazil to put the whole draft SPLT in square brackets, to put it aside for the time being and to discuss other issues, and invited comments on that proposal.

264. The Delegation of the United States of America, supported by the Representative of the EPO, did not support the proposal put forward by the Delegation of Brazil and reiterated its position that, since it seemed unlikely that a consensus could be reached, it was appropriate to seek the guidance of the Assemblies.

265. The Delegation of Argentina suggested that, in view of the fact that there was no consensus on the proposal made by three delegations, the Committee continue to proceed on the work it had been doing so far.

266. In response, the Chair noted that a number of delegations had opposed continuing work on the basis of the work which the Committee had been doing in the past.

267. The Delegation of Algeria stated that the Committee should take into consideration the interest of all members, that harmonization had to take place in the context of globalization, and that the draft Treaty should be considered as a whole without amputating its main sections.

268. The Delegation of Egypt expressed sympathy for the proposal of Brazil, but since that proposal had met opposition from some delegations, it suggested that the Committee look at the draft Treaty as set forth in the various documents available. The Delegation suggested that this should be the conclusion and that the report should reflect the views of the various delegations on future work without drawing any further conclusions.

269. The Chair responded that the draft report would certainly reflect the interventions that had been made on this issue by all parties.

270. The Delegation of the Islamic Republic of Iran expressed support for what had been suggested by the Delegation of Egypt.

271. The Chair noted that the interventions of delegations on the issue of future work would certainly be reflected carefully in the draft report prepared by the International Bureau and stated that the only conclusion he could make was that the Committee was unable to reach any conclusion as to its future work.

272. In response to the Delegation of Egypt, which suggested that only the interventions of the delegations be reflected in the report, without any conclusions of the Chair, the Chair responded that the Chair had the right to express its conclusions, and that those conclusions would be indicated as being the views of the Chair only, but that they needed to be reflected in the report as well.

273. The Delegation of India queried what exactly the Chair, in the name of the SCP, would be planning to refer, if at all there was such an intention, to the Assemblies.

274. In response to the query by the Delegation of India, the Chair stated that, since there was no longer any agreement to refer anything to the Assemblies, he did not have the intention as Chair to refer anything to the Assemblies.

275. The Delegation of Brazil also opposed the inclusion of the Chair's conclusion in the report, since it did not, in the Delegation's view, reflect what actually happened in the debate. The Delegation reiterated that it was in a position to continue to discuss the draft SPLT in future sessions of the SCP. It also noted that some delegations did not seem to be interested

in pursuing those discussions and that it had therefore proposed to consider other possible issues, but that this proposal had been rejected by one delegation. It was the understanding of the Delegation that there were indications of the desire to block the work of the entire SCP. The Delegation therefore believed that the Chair should not conclude that there was no agreement on future work, but that the most factual way to reflect what really happened in the meeting was to reproduce all interventions in the final report and let people draw their own conclusions.

276. The Chair responded that a report should reflect what had happened in the meeting concerned. He concluded that there was no agreement on future work and that his conclusion should be reflected in the report, but that the comments made by the Delegation of Brazil concerning that conclusion should also be reflected in the report.

277. The Delegation of the United States of America, wishing to clarify its position, stated that it did agree with the Chair's conclusion, which was a factual one, and that it would like to proceed with the work on the draft SPLT on certain matters, but that other delegations which rejected that approach wanted to proceed on these matters in different ways and might want to proceed on other matters as well. The Delegation therefore expressed the view that there was no agreement in the Committee.

278. The Delegation of Egypt noted that this was not the first time that there had been disagreement in the Committee and that, in case of disagreement in the past, there had not been any conclusion that there was a lack of consensus or that there was no consensus. The Delegation suggested that the report should reflect that the Chair took note of the interventions on future work since this was the most factual, precise and neutral conclusion that could be drawn from the debate.

279. The Chair concluded that the conclusions which he had reached should be included in the report, but that the comments that had been made by the Delegations of Brazil and Egypt should be included as well.

280. In response to a query by the Delegation of Argentina, the International Bureau informed the SCP that the weeks of November 22 and November 29, 2004, had provisionally been reserved for the next sessions of the Working Group on Reform of the PCT and the SCP.

Agenda Item 8: Summary by the Chair

281. The draft Summary by the Chair (document SCP/10/10 Prov.) was noted with certain amendments which were included in the final version (document SCP/10/10).

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

Agenda Item 9: Closing of the Session

283. The Chair closed the session.

284. In accordance with the procedure previously adopted by the Committee (see paragraph 282, above), Committee members are invited to comment on this draft report, which is being made available on the SCP Electronic Forum. The Committee will be invited to adopt the report at its eleventh session.

[Annex follows]

ANNEXE/ANNEX

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

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(dans l'ordre alphabétique des noms français des États)
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