Comments of the Russian Agency for Patents and Trademarks (Rospatent) on Article 5 of the Draft Substantive Patent Law Treaty and Rules 5 and 6 of the Regulations relating thereto[*]

1. In Rule 5 contained in document SCP/6/3, emphasis is placed on the technical nature of the problem which the invention is designed to solve.

Traditionally, the solutions embodied in technical means are examined as inventions. In this sense, the invention (and not the problem to be solved) always relates to one or other technical field. As regards the problem to be solved by the invention, this may relate to any field of activity.

In order to reflect this way of thinking, it is proposed that in Rule 5:
- in paragraph (1)(i) the square brackets be removed from the word "*[technical]*;"
- in paragraph (1)(iii) the word "*[technical]*" be deleted and "*its solution*" be replaced by the words "*its technical solution*."

2. In document SCP/6/3 Rule 6 contains a number of alternatives, which envisage the need to choose between the words "*features*" (with or without the definition "*technical*"), "*limitations*," and "*elements or steps*."

It is proposed that in Rule 6, paragraphs (2), (3), (4)(ii), (5)(a), (5)(c) and (6), the same term should be used in the sense of "*feature*", preferably without the definition "*technical*." The technical requirement, introduced in relation to the invention, may not be conveyed on each feature considered individually. The claims may, in addition to exclusively "technical" features, also contain non-technical features, for example logical conditions, mathematical expressions and so on.

3. In our opinion, the question of whether to include in Rule 6(5)(a) a provision allowing a reference to a drawing, in addition to the verbal formulation of a feature in the invention, with the stipulation "if the feature cannot be expressed otherwise," is worthy of discussion.

4. A number of the provisions in Rule 6 are devoted to the composition of dependent claims. In that regard, the multiple dependency of claims on other claims, which themselves are multiple dependent claims, is permissible. Such an allowance is not consistent with the trend discussed in the SCP toward a hardening of the approach to multiple invention disclosures and complex applications, and at the same time does not comply with the requirements of the Patent Cooperation Treaty (PCT) in force (see Rule 6.4(a) of the Regulations under the PCT).

In this connection, it is appropriate to examine the question of whether to include the phrase "*or another multiple dependent claim*" in Rule 6, paragraph (6)(b).

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[*] Translation from Russian to English was made by the International Bureau.

5. The possibility of a reference in multiple dependent claims to one or more other claims *in the cumulative* is questionable. A reference is permissible only in the alternative. A reference to one or more claims "in the cumulative," from the point of view of formal logic, may signify the multiple repetition of the same features (features which coincide in one or more claims and to which a reference "*in the cumulative*" is made).

6. Furthermore, Rule 6 does not provide for a possibility which would be permissible, i.e. that of referring in *independent* claims to other independent claims, or claims dependent on other independent claims, so as to avoid the full repetition of their content.

For example, if the application relates to two inventions – a method and a device that can be used in this method – the claim relating to the method may refer to the claim pertaining to the device, instead of characterizing the device in full:

"1. Method for…, in which …, and where the device X is used according to Claim 2.
2. Device X, comprising…"

7. As regards the provisions of Article 5(3) of the Draft Substantive Patent Law Treaty contained in document SCP/6/2, relating to the limited purposes of the abstract, those provisions shall comply with PCT Article 3(3) and we fully support them. The probability that an abstract contains additional information not included in the full description, while complying with the rules to be followed by the applicant in drafting the abstract, is virtually zero.

However, the Russian Agency for Patents and Trademarks will not oppose any possible proposals as regards taking into account in individual cases (for example, when correcting or updating the description and, accordingly, the claims), this additional information which may occasionally be contained in the abstract and be missing for whatever reason from the full description or claims.