

Comments by Ukraine on Article 5 of the Substantive Patent Law Treaty (SPLT)*

Paragraph (1)(iv)

1. We support the proposal made by the United States of America that the words “where required” should be replaced by the phrase “when...necessary for the understanding of the invention,” similar to the wording used in PCT Article 7(1).

The legislation of Ukraine, including Article 12(5) of the Law of Ukraine on the Protection of the Rights to Inventions and Utility Models, and Rule 3.1 of the Regulations on Drafting and Filing of Applications, states that applications shall include drawings, where they are referred to in the description. In other words, the wording of our legislation provides the applicant with the right to decide whether drawings should be submitted. Support is expressed for the wording of the PCT, which corresponds to applicant’s interests.

2. According to the clarifications provided by the International Bureau, drawings shall also be understood to include photographs and other forms of submission which make use of new technologies.

The SPLT contains a broader interpretation of drawings through the use of other forms of submission, although there is no mention of charts and diagrams which, in the PCT, are regarded as drawings; the PCT does not refer either to photographs or other forms of submission. It is proposed that all these details should be combined in Rule 5 which, in its current wording, does not disclose requirements additional to the PCT or otherwise. This may, however, be envisaged in the Practice Guidelines which are only at the initial development stage.

Paragraph (2)

We consider it appropriate (proposals put forward by New Zealand, supported by the Republic of Korea) to include in the SPLT clear references to articles of the PCT and to the rules contained in the Regulations Under the PCT.

Such a reference would make the task of reading the text of the Treaty more complicated. As is the case with most legislation, a simple observation of the fact that the provisions of a particular document “shall be extended to this Treaty,” as is the case for example in the PCT (which refers to the Paris Convention for the Protection of Industrial Property), is sufficient. It would be more appropriate to refer to specific articles of a particular document in the Regulations and/or the Practice Guidelines.

Paragraph (3)

The Chairman proposed that the International Bureau should revise the provisions of the whole Treaty and the Regulations in relation to the disclosure and status of the abstract, and prepared alternative provisions for the subsequent wording of the Draft SPLT.

* Translation from Russian to English was done by the International Bureau.

In many cases when the abstract is not prepared by the inventor, an Office proposes its own wording. In that regard, consideration is given to the drafting procedure, the maximum number of words and so on, i.e. the abstract is considered to be part of the application. If the abstract constitutes a section of the description, this may give rise to problems linked to the inclusion of amendments in the abstract and in the description as a whole, although the remaining portion may remain unchanged, with the scope of the content of the abstract, its separation from the text of the description for the subsequent submission of abstract-related information (in the PCT, for example, in more than one language), and so on. The abstract should be left as part of the application, as is already the practice throughout the world.

Regulations

Rule 6

(6)(b) A dependent claim may depend on another dependent claim...A multiple dependent claim may depend on a dependent claim or another multiple dependent claim. Multiple dependent claims may refer in the alternative or in the cumulative to the claims on which they depend.

We consider it appropriate to support the rule in question (the PCT envisages only the alternative).

Additional comments on terminology

The term “invention” is used in the SPLT in the broad and generally recognized sense. However, in relation to the filing of an application it would be appropriate to include the term “proposed invention”... (translator’s note: the final few words of the original text are illegible – please verify).