I – Introduction

The 9th session of the SCP was opened by Francis GURRY, Assistant Director General of WIPO; Philip THOMAS (WIPO), in charge of PCT attended the meeting which was chaired by David HERALD (Australia), Philippe BAECHTOLD (WIPO) acting as Secretary of this meeting.

The documents on which were based the discussions were prepared in advance by the International Bureau and were available on the WIPO website (http://www.wipo.int/scp); such documents were referenced SCP/9/1 (Agenda), SCP/9/2 (Draft SPLT), SCP/9/3 (Draft regulations), SCP/9/4 (Draft guidelines), SCP/9/5 (Industrial Applicability/Utility), SCP/9/6 (Status of the Guidelines).

Besides the discussions on documents referenced SCP/9/2, SCP/9/3, SCP/9/4, two issues were debated:

- status of the Guidelines (as compared with the legal status of the SPLT and that of its Regulations). The point was to know whether the Guidelines have or should have any legal effect, binding the parties of the SPLT;

  Although initially in favour of a binding effect, the US delegation, seconded by the Japanese delegation, did not stick to that position, accepting a flexibility on this issue. A large majority of delegations (European countries, EPO, Canada, Brazil or Russian Federation among others) being against any binding effect, it was decided by the SCP that the Guidelines should have no legal binding effects on the SPLT parties; the precise status of the Guidelines will be dealt with later on.

- necessity of maintaining a session for the Working Group created during the 6th session (November 2001), in charge of debating on claims and unity of invention; after a short discussion it was decided not to have a meeting for the Working Group during that SCP session, bearing in mind that it appeared more and more clearly that this question was more, if not only, relevant with the patent offices, involving fiscal (financial) issues for them. Furthermore this
decision took into consideration the information given by the US delegation, according to which the unity of invention, among other issues, should be dealt with in a Strategic Plan which has been initiated in the USA (an intermediate report should be available in Fall 2003, and a final one in Spring 2004).

II Adoptions

The Draft Agenda (SCP/9/1) and the Draft Report on the 8th session (SCP/8/9/Prov.2) were adopted without any modification.

III Debate on the Draft SPLT, Draft Regulations and Draft Guidelines

Article 1 – Abbreviated expressions

Discussions took place on Articles 1.ii (application), vi (claimed invention), ix (priority date of a claimed invention) and x; as a result of those discussions it was decided:

- to redraft Article 1.ii: which application are precisely covered by this Article? This Article should be consistent with the Paris Convention.

- to redraft Articles 1.vi and ix in order i) to envisage all situations and ii) to avoid any ambiguity; the question of the validity of a claimed priority was also discussed and two proposals were presented by delegations (one from Canada and Argentina concerning Article 1.vi, one from EPO concerning Article 1.ix).

- to redraft Article 1.x: the US delegation was concerned about the proposed text (chain of applications) and proposed an amended text.

Article 2 – General principles and Exceptions

Not debated.

Article 3 – Applications and Patents to which the Treaty applies

Article 3.1

There was a general consensus on the proposed text.

Article 3.2 and Rule 3

The text is not final and a future version should precise some terms; there were also some concerns about “exceptions” which were dealt with in the Regulations (instead of being mentioned in the Draft Treaty itself).

Article 4 – Right to a patent

There was finally a consensus on Articles 4.1 and 4.2, subject to a limited number of modifications: Article 4.1 shall deal with the right to a patent (not to the patent), with
a similar wording in Article 4.2 line 3 and by deleting in said Article, line 4, “by the inventor”.

A consensus was also reached in deleting Article 4.3, leaving national laws to deal with this issue of an invention made jointly by several inventors.

There was no debate on Article 4.5 (issue concerning first to file/first to invent systems).

**Article 5 – Application**

Such Article was lengthy debated with very controversial discussions; this article is likely to appear as a blocking point.

This article comprises three paragraphs:

(1) – Parts of Application
(2) – Requirements concerning parts of Application
(3) – Abstract

Concerning Article 5.1, a list of five items was envisaged, namely a request, a description, one or more claims, one or more drawings, an abstract.

Some delegations (India, Brazil, Dominican Republic among others) vigorously requested that such a list should not be deemed as exhaustive and that besides those “technical” requirements, the application should include other information, such as the origin/source of the genetic resources; some delegations (E.U. countries, Canada, USA, Japan…) strongly opposed such inclusion, arguing that the SPLT was not the appropriate forum to discuss those issues. On that occasion the Brazilian delegation reminded that during the PLT discussions, a similar reference was requested but, at that time, was refused, based on the proviso that such reference should be more appropriately discussed at the SPLT meeting...

Similarly, there was a clear opposition between those delegations (India, Brazil, Dominican Republic among others) in favour of deleting Article 5.2 and those in favour of retaining such Article aimed to harmonize national laws by preventing them adopting different provisions (E.U. countries, Canada, USA, Japan…); according to those latter delegations, in the absence of such article, the national laws would have the possibility to impose specific (national) obligations to the applicant: this would be in contradiction with the present attempt of harmonization.

As a result, it was decided to put Article 5.2 between square brackets for the forthcoming discussions; India shall prepare a new wording of this article in cooperation with Brazil.

Coming back to Article 5.1, there was no consensus either on a more technical issue, namely that of the drawings.

One problem is to know whether drawings are presented by the applicant, or requested by the patent office; another problem is to envisage the sanction in case of
no presentation of such drawings. Still another problem is to determine whether drawings are necessary only in case they permit a better understanding of the invention.

Concerning Article 5.3, there was a clear opposition among the delegations as to whether to retain, with or without square brackets, “subject to Article 7.5”; this different opinion is related to the status which is given to the abstract, such status itself depending upon who is at the origin of the abstract (the applicant or the patent office).

Referring now to the corresponding Rules of the Draft Regulations, the situation is the following one:

* Rule 2 (Person skilled in the art)
  Two distinct problems have not been solved:
  - the location of the definition of a person skilled in the art: would it be in the Treaty (suggestion from Argentina, Brazil, India...) ? A number of delegations including Canada, the USA, European countries, the Russian Federation... have no preference.
  - the content of the definition: some delegations (Argentina, India...) are of the opinion that the present definition should lead to a too low level for the inventive step, but the US delegation pointed out that an increase on this level should have a negative impact on innovation and a majority of delegations was in favour of retaining the present wording; those delegations which are not satisfied with the present definition will have to propose another one.

* Rule 4 (Further requirements/description)
  The debate was dedicated to three issues:
  - the best mode: although the USA, Brazil, India, Mexico were in favour of providing the best mode, the majority of the delegations was against.
  - the information on the origin of a genetic resource: same debate as for Article 5.1.
  - the word “technical” (related to the field to be specified) shall remain within square brackets, and the word “preferably” (concerning the citation by the applicant of the documents reflecting the prior art) shall be maintained.

* Rule 5 (Further requirements/claims)
  Two questions arose during the discussion:
  - presentation of a claim in one part or in two parts; a majority of delegations was in favour of leaving the decision up to the applicant, while few delegations (mainly Argentina) preferred to have the offices deciding upon said presentation;
  - features of a claim qualified as “technical”; the Chair confirmed that this issue will be discussed later on, since this “technical” aspect could be discussed in several parts of the Treaty (such as in Article 12.1 for instance).
The issue of a dependent claim referring only to preceding claim(s) was also debated, and the renumbering of claims was preferred to be under the responsibility of the applicant (although some delegations were in favour of leaving this duty to the office); eventually, the issue of multiple dependent claims depending on multiple dependent claims was again put forward.

**Article 6 – Unity of invention**

Due to the information provided by the US delegation (Strategic Plan – see above), this article was not debated.

**Article 7 – Observations, amendments or corrections of application**

**Article 7.1**

There was no major discussion concerning Article 7.1.a), but Article 7.1.b) has to be redrafted, such article dealing with divisional, continuation or continuation-in-part application containing the same error or mistake as in the parent application; the relationship with Article 13.1 (refusal of an application) has also to be clarified. The related Rule 7.1 was also discussed but no consensus was reached and both solutions (time limit of 2 months/time limit of 3 months) for amending or correcting are retained.

**Article 7.2**

A clarification is still needed as regards the wording (amendments/corrections); furthermore there was a debate as to whether the abstract is covered by this provision (until the status of the abstract is not clarified, there will be such discussions). A reference to Article 7.4 has been accepted.

**Article 7.3**

In order to avoid any confusion, it was decided to delete “other than the correction of a clear mistake as prescribed in the Regulations”; same remark as above concerning the abstract. A reference to Article 7.5 has been decided; the International Bureau has also to redraft the issue related to missing parts of description or drawings.

**Article 7.4**

A clarification is still needed concerning the situation of an amendment of an abstract prepared by the office in the case of a PCT application, before the national phase is opened.
Article 7.5

There was no consensus on this new article, although a majority of delegations was in favour of its inclusion (case of an abstract prepared by the applicant and amended later on); this article will be reworded.

Article 7 bis – Amendments or Corrections on Patents

A number of delegations were in favour of deleting this article which did not exist in the first SPLT draft, which was asked later on to be included, and which is now contested... This article will be retained for further discussions; some delegations pointed out that the SPLT should be limited to provisions applicable before the grant of a patent, while this article is clearly related to a granted patent.

Article 8 – Prior art

Article 8.1

The issue of loss of rights in the case of secret prior art (commercial use) was put forward by the US delegation, supported by the delegation of Australia; a clear majority of delegations was against this concept, although it could be of interest to have some provision concerning it, but rather in Article 13, in order to be taken into consideration in future sessions.

The related Rule 8 was also discussed, with same comments as in previous session concerning the “reasonable possibility” for the public to have an access to the information; the concept of “confidentiality” has also to be clarified and precised. Eventually, it was debated on the burden of the proof: applicant or office? with a majority of delegations in favour of the office having this burden.

Article 8.2

The US delegation insisted, as in previous session, on the fact that an earlier application should affect also the inventive step (a clear majority of delegations is in favour to limit the effect of such earlier application to the novelty). A clarification is still needed in the wording in order to cover all situations.

Concerning Article 8.2.c), a majority of delegations is in favour of alternative A i.e. that an earlier application under the PCT has prior art effect only when this application enters into the national, or regional phase.

The related Rule 9 was also debated, Rule 9.1 being accepted, on a provisional basis; Rule 9.2 shall be redrafted (applications no longer pending) and Rule 9.3 (anti self collision) led to a debate without final consensus, the delegations being clearly divided as to whether such a provision is appropriate in the SPLT.
Article 9 – Grace period

The Greek delegation, on behalf of the E.U. countries presented a grace period system as a safety net, in the context of the first to file system; the general framework of this grace period system would be the following one: 6 months before the priority date, applicable to any disclosure and claimed by the applicant; the third party rights should not be affected by the introduction of a grace period.

As an answer to this presentation, many delegations expressed their strong wish to have a grace period system in the SPLT (USA, Canada, Brazil, Australia, India among others) but diverged on the conditions: 6 months/12 months ? claim by the applicant ? third party rights ? In this respect it was reminded that AIPPI should present in a near future the analysis of the answers received on its questionnaire; the International Bureau will prepare alternative wordings.

Article 10 – Enabling disclosure

In Article 10.1, the relationship between “invention” and “claimed invention” has to be clarified; concerning Article 10.2, it was reminded by the Chair that, in order to comply with the enabling disclosure requirement, an applicant could not rely on something which was not present in the disclosure on the filing date.

Article 11 – Claims

Not debated.

Article 12 – Conditions of Patentability

Not debated.

Article 13 – Grounds for refusal of a claimed invention

Not debated.

Article 14 – Grounds for invalidation or revocation of a claim or a patent

Not debated.

Article 15 – Review

Not debated.

Article 16 – Evidence

Not debated.
IV – Conclusion – comments

This 9th session clearly evidenced the difficulties in harmonizing the substantive patent law throughout the world; in this respect, it will be very difficult, if not impossible, to reach a consensus if some delegations merely state that any modification is impossible because contrary to their present law!

A further difficulty comes from the concept itself of the discussions; as it was reminded by Francis GURRY: “Until everything is accepted, nothing is accepted”. It means that any delegation, at any time, has a possibility of reopening the debate on a specific provision on which a consensus was previously obtained; the risk is clearly to lengthen the discussions.

Some NGOs (users associations) wondered whether it could be appropriate, or wise, to split the SPLT, by leaving aside those issues for which there is clearly a blocking situation. In such a case, the SPLT should be limited to provisions for which there is already a consensus or, for which, such a consensus could be easily envisaged. Such a limited project would be less ambitious than the present one but could have a chance in leading to an agreement.

The next session is scheduled to take place some time in the first half of 2004; the usual November SCP session is cancelled.