

**DRAFT SPLT DOCUMENTS SCP/7/3 & SCP/7/4**

**UNICE comments**

Before submitting its comments on the Documents SCP/7/3 and SCP/7/4, UNICE would like to register the following remark.

As repeatedly pointed out by UNICE in its previous submissions to WIPO, the new SPLT is not a treaty standing alone but a third treaty in the row formed by the PCT, the PLT and this new SPLT.

In that context, European industry considers that the SPLT, in conjunction with the PLT (the implementation of which is required by Article 17 SPLT) should establish a comprehensive international framework of substantive and quasi substantive aspects of patent law, rather than just "cherry picking" certain issues. Internationally, patent law should not be such that significant substantive areas vary according to different national predilections. Matters which appear to be missing in this treaty include publication of the application and scope of rights. Consistency between treaties can be achieved by incorporating appropriate parts of other treaties in the same field, such as the PCT, by reference.

UNICE would like to invite the Standing Committee on the Law of Patents to consider the proposals contained in this document.

**1. SCP/7/3 : DRAFT SPLT ARTICLES**

**INTRODUCTION**

Regarding Paragraph 3, UNICE would like to stress the fact that this specification should not be interpreted as to allow for further inclusion of substantive elements of a first-to-invent system into the SPLT for the reasons expressed here below concerning Article 9.

**ARTICLE 1(VIII,IX) SPLT:**

In UNICE's view, this article is acceptable as it stands.

**ARTICLE 3(1)(I) SPLT**

The current provision covers both EPC and PCT applications. Applications for e.g. NL that are filed as European patent applications or as Euro-PCT applications should only be covered by the SPLT should the EPO join the SPLT. Moreover, EPC applications may be filed with the Office of an EPC Contracting State. Patents have already been defined so as to include patents of addition.

UNICE would like to suggest replacing this with: "*to applications for patents when these applications are subject to the law of a Contracting Party*".

**ARTICLE 3(1)(II) SPLT**

In UNICE's view, this provision is not in line with the definition of "*international application*" and, therefore, believes that its wording should only refer "*international applications*". Moreover, in line with

Article 3(1)(b)(ii) PLT and Rule 3 SPLT, the temporal scope should be limited. Also, Article 27(1,5) PCT should be respected.

UNICE would like to suggest replacing this with: "*subject to Article 27 of the Patent Cooperation Treaty, to international applications from the date on which processing or examination of the international application may start under Article 23 or 40 of that Treaty.*"

### **ARTICLE 5(3) SPLT**

This provision provides legal significance to the abstract in the situation under Article 7(3), i.e. for the evaluation of whether an amendment goes beyond the previously disclosed subject matter. This seems to **differ from the European Patent system; in particular Article 85 EPC<sup>1</sup> and Guideline CII-2<sup>2</sup>**

Against this background, UNICE believes that this provision should be discussed further on an individual basis in order to assess whether this is a desirable change. In the meantime, UNICE would like also to stress that, since abstracts fulfil functions other than serving the purpose of information, the word "*merely*" does not seem appropriate.

### **ARTICLE 6 SPLT**

In UNICE's view, this article seems redundant with respect to Article 5(2) SPLT.

If Rule 13 PCT is no longer regarded as the best solution, it should therefore be amended, but there should be no other WIPO treaty that defines unity of invention. In view of Article 27(1,5)<sup>3</sup> PCT and Article 23 PLT, problems arise for both PCT national phase applications and direct national applications should the SPLT have its own definition of unity of invention different from that of Rule 13 PCT.

Therefore, UNICE would like to suggest that the wording of Article 6 should have direct reference to the PCT relevant provisions.

### **ARTICLE 7(3)(A) SPLT**

UNICE would like to suggest deleting "*or included in the missing part of the description or the missing drawing, in accordance with the Patent Law Treaty*" as supplementing an application with missing parts results in a shift of the filing date (see Article 5(6) PLT).

Would WIPO still desire to maintain this provision, the provision should then be completed along the following lines:

"(3) [Limitation of Amendments or Corrections] (a) An amendment or correction ~~of the description, the claims, the abstract and any drawings~~ shall be permitted, provided ~~that~~ the amendment or correction would not result in the disclosure ~~of the invention contained~~ in the amended or corrected application going beyond the disclosure ~~of the invention contained~~ in the ~~application description, the claims, any drawing and, where prepared by the applicant, the abstract at the time of~~ on the filing date, or included in the missing part of the description or the missing drawing, in accordance with the Patent Law Treaty , **after these have become part of the re-dated.**"

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<sup>1</sup> Article 85 EPC: "*The abstract shall merely serve for use as technical information; it may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 54, paragraph 3.*"

<sup>2</sup> Part C, Chapter II, 2. Abstract (Guideline for Examination in the EPO): "[...] *The examiner should therefore not seek any amendment of the abstract. He should, however, note that the abstract has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter.*"

<sup>3</sup> Article 27(5) PCT clarifies that conditions of patentability may include requirements as to form and contents, and that Article 27(1) PCT applies to such conditions of patentability. In line with this, the 1970 PCT Notes as to Article 27(1,5) PCT clarify that the form or contents related PCT provisions are those of Article 3-8 PCT and Rules 3-13 PCT, and that the conditions of patentability that are left to the national law are those governing patent-eligible subject matter, novelty, non-obviousness and industrial applicability. Since requirements as to "contents" are substantive by nature, the fact that Article 27(1) PCT does not just refer to "form" but explicitly mentions "contents" as well must be preserved as a basis.

#### **ARTICLE 7(3)(B) SPLT**

UNICE strongly believes that the alternative "anyone" should not be adopted or, at least, to be replaced by the expression "a person skilled in the art".

#### **ARTICLE 9(1-3) SPLT**

UNICE maintains its opposition to the introduction of a grace period, considering that the whole concept of a grace period has important drawbacks since its lack of legal certainty would be primarily prejudicial to small and medium sized enterprises in terms of higher risks and costs<sup>4</sup>.

**European industry strongly believes that the question of grace period is a very technical issue whose underlying arguments need to be very carefully assessed on a separate basis, putting it in perspective with the existing US system of first-to-invent.**

**UNICE is and remains firmly opposed to any form of grace period exceeding Article 55 European Patent Convention.**

The addition of paragraph 4 does not take away the fundamental concerns that a grace period is incompatible with legal certainty. Certainly, it is clearly undesirable to have a grace period that is twice as long as the current US grace period, four times as long as the current EP, CN, JP and KR grace periods, without having to confess the disclosure upon filing, as is the case in many modern grace period provisions, and without a publication of the fact that the grace period has been invoked in the 18-months' publication.

Finally, UNICE would like to stress that **paragraph 3 of Alternative A is unacceptable.**

#### **ARTICLE 9(4) SPLT**

As to the new paragraph 4, UNICE believes that this provision is inconsistent for the following reasons:

- Prior use should give a free right to continue that prior use. This should not only apply to prior use between the disclosure date and the claim date; it should apply to all prior use before the claim date.
- The proposed good faith limitation only causes various questions as to what constitutes "**good faith**", and may undermine the very concept of free continued use of what has been used prior to the claim date. It should suffice that the prior user did not derive his knowledge of the invention from confidential information from the inventor.

Therefore, UNICE would like to suggest that the references to "*good faith*" should be excluded. Third parties should be fully entitled to use non-confidential information, in the public domain, on which no patent has yet been sought, without having to show "*good faith*".

- In view of the remuneration comments in the Notes, the Article should make clear that prior use may be continued for free, which is only fair because of the fact that the prior use precedes the claim date. This compensates for the fact that in the SPLT system, a first inventor who is later to file, does not get the patent.
- The right to continue a use of the invention that preceded the claim date should not be confused with a free license to use anything that is in the patent. The continued use rights should be limited to what has been prior used and obvious modifications thereto.

In view of the above comments, UNICE would like to suggest that paragraph 4 should be reworded as follows:

**"(4) A third person party who, before the claim date, without having derived his knowledge of the invention from confidential information from the inventor, in good faith had, between the date on which**

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<sup>4</sup> UNICE's previous comments submitted to WIPO on 19 April 2001 concerning SCP/5/2: "Re: Grace period. UNICE respectfully submits that for reasons of legal certainty it is strongly opposed to grace periods. UNICE refers to the attached expert opinion submitted by Mr. Jan E.M. Galama on request of the European Patent Organisation. UNICE draws furthermore attention to the fact that a full year grace period prior to the priority date is twice as long as the current US loss-of-rights deadline that is one year prior to the filing date, and 4 times as long as the current "grace periods" in CN, EP, JP, KR that are 6 months prior to the filing date. There is no protection for third parties who started using the invention prior to the priority date. The opportunity to invoke the grace period at any time without any obligation for the applicant to refer in its application at the filing date to its own disclosure prior to the priority date is far too generous for the applicant and completely ignores third party interests. UNICE thus requests that Article 10 be deleted from the proposal."

~~the information was made available to the public under paragraph (1) and the claim date, used the invention for the purpose of his business or started effective and serious preparations for such use shall have the right freely to continue that use and obvious modifications thereto the invention for that purpose."~~

#### **ARTICLE 10 AND 11(1-3) SPLT**

As for Article 6 SPLT, UNICE would like to suggest that the wording of Article 10 and 11 (1-3) should have direct reference to the PCT corresponding provisions.

Furthermore, in UNICE's view, Article 11(3)(b) SPLT is in comparison with Article 6 PCT an additional requirement that is clearly forbidden by Article 27(1,5) PCT.

#### **ARTICLE 12(1) SPLT**

UNICE would like to suggest removing the square brackets from "*in all fields of technology*", and deleting the expression "*which can be made and used in any field of activity*" since this phrase is redundant in view of the industrial applicability requirement in paragraph 4.

#### **ARTICLE 12(4) SPLT**

In line with the corresponding TRIPs footnote, UNICE believes that the alternatives should be combined in such a way that they shall read: "It shall be considered industrially applicable (useful) if it can be made or used in any kind of industry and/or if it has a specific, substantial and credible utility."

#### **ARTICLE 12(5) SPLT**

UNICE would like to underline that no exceptions other than those contained in Article 27(2,3) TRIPs Agreement can be permitted. Therefore, Article 12(5) SPLT should simply refer to those TRIPs provisions.

## **2. SCP/7/4: DRAFT SPLT RULES**

### **RULES 4-6 SPLT**

In view of Article 27(1,5) PCT and the PLT, UNICE believes that these Rules should be rather considered as a Guideline, not as a Rule.

### **RULE 9(1)(C) SPLT**

This provision contains an unnecessary and undesired limitation at the end: for prior art effect, it should not matter whether only a patent or a utility model can be granted or that both can be granted. For instance, in DE both can be granted, while still an earlier utility model should be able to anticipate a later patent.

### **RULE 9(4) SPLT**

There is no need for such an anti-self-collision clause as for inventive step, the prior art of Article 8(2) SPLT is not taken into account. Moreover, it is clearly undesired to have some understanding that only one patent may be validly granted with effect for a Contracting Party for the same claimed invention. For example, there is nothing wrong if a parent and a divisional have overlapping scopes.

### **RULE 10 SPLT**

UNICE is of the opinion that this provision should be inserted as a Guideline, not as a Rule.

#### **RULE 12(5) SPLT**

UNICE believes that this provision is incomplete and be more specific about "insubstantial differences" as an alternative to the triple identity test. When being considered, this provision should be regarded together with Rule 12 (6) since, in UNICE's view, these provisions seem incompatible with the new version of the European Patent Convention.

**Against this background, UNICE strongly believes that the proposals for Rule 12(5) and Rule 12(6) are crucial issues which should be discussed further on an individual basis with the interested circles.**

#### **RULE 13 SPLT**

**UNICE is of the strong opinion that such important provision should not be considered under the SPLT Rules but rather under the SPLT Articles.**

#### **RULE 14(2)(C) SPLT**

Even if many publications refer to earlier publications, that alone is insufficient justification for making a combination of publications obvious, let alone for considering the set of publications to form one single item of prior art that could take away novelty. The wording of this provision should be much more precise.

### **3. SCP/7/4: GUIDELINES**

Currently, many offices work with much more elaborate Guidelines, such as the PCT-II Guidelines for preliminary examination, which allow for much more detailed help in how to deal with the various issues of patentability. It thus seems to make much more appropriate to take the whole of the present PCT-II Guidelines, to be reviewed by the PCT Meeting of International Authorities after the text of the SPLT has been finally adopted, than to confine oneself to a few short statements as currently proposed.

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