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WIPO SUBSTANTIVE PATENT LAW TREATY REFORM

UNICE comments

In the context of the debate on the Substantive Patent Law Treaty reform, UNICE would like to take this opportunity to comment on certain major issues discussed within WIPO's Standing Committee on Patents.

I. SUBSTANTIVE ISSUES

A. PATENTABLE SUBJECT MATTER (ART. 12.1 SPLT)

UNICE is against attempts to impose as the new world standard the norm that "everything under the sun made by man" (including non-technical business methods) should be patentable subject-matter. The EU member states and other non-EU EPC member states argue for a clear restriction to technical inventions only.

UNICE wants to retain the "in any field of technology" and "industrial applicability" requirements, in accordance with the TRIPs standards (Art. 27.1TRIPs).

B. NOVELTY

In line with the EPC (Art. 54), the SPLT recognises the **absolute** novelty requirement, which is of an objective nature. Doctrines such as the "loss of rights" and the "experimental use" doctrine constitute fundamental deviations from the objective absolute novelty requirement, which ensures a high degree of legal certainty.

In this context, UNICE is strongly against any departure from the novelty requirement as reflected in Art. 54 EPC.

C. GRACE PERIOD

UNICE has repeatedly and consistently stressed that the whole concept of a grace period has important drawbacks. The fundamental concern of European industry is 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 reveal 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.

UNICE is and remains firmly opposed to any form of grace period exceeding Article 55 EPC.

D. ABSTRACT

The latest draft SPLT provided that the abstract should not be taken into account to interpret the claims, but formed part of the disclosure for the purpose of amendment rules equivalent to Art. 123(2) EPC.

UNICE believes that such a requirement should not (re-) appear in the SPLT.

E. SELF-COLLISION (ARTICLE 9(1) SPLT)

Article 9(1) SPLT (Rule 9(4)) foresees that non-prepublished applications are not taken into account if the non-prepublished application has the same owner as the application under consideration, provided that only one patent is granted for the same invention. UNICE is firmly opposed to this approach.

Non-prepublished earlier applications are relevant to novelty only. In view thereof, there is no need to protect an applicant against anticipation by his own earlier application since, to the extent that his later application is the same as his earlier application, he has his earlier application and (apart from internal priority) he should be barred from having two applications with different filing dates for the very same invention, and to the extent that his later application differs from his earlier application, there is no need for a self-collision provision.

In US law anti-self-collision is a fixture that leads to "continuations" and "continuations-in-part". These kinds of inefficient practices, giving room for re-filing of subject-matter, cause unwanted delays and legal uncertainty.

UNICE believes that an anti-self-collision provision is undesirable.

F. DEPOSIT OF BIOLOGICAL MATERIAL

UNICE is against mandatory rules allowing the deposit of biological material to be validly made after the filing date of the application. This violates the principle that no new material may be introduced after the filing date and cannot be accepted.

G. PROBLEM/SOLUTION APPROACH

The EPO current practice of the problem/solution approach offers in principle a sound practice for high quality examination and an appropriate level of inventive step. Attempts to impose US or other methods of examination in the SPLT should be strongly resisted.

II. RELATION OF SPLT TO PCT AND PLT

The SPLT draft contains important provisions that overlap with the corresponding PCT provisions. It is alleged that this should be no problem: after all, the PCT provisions date from 1970, and now there is an opportunity to adopt more modern provisions in the SPLT. Thereafter, the PCT will be adapted to the SPLT.

In this context, for matters already dealt with in the PCT:

- The SPLT should simply refer to the PCT as to what is already dealt with in the PCT (as done in draft Art. 5(2) SPLT).
- The SPLT should not repeat in detail anything that is already adequately provided for in the PCT.
- Where there is any real need to improve the PCT, the PCT Rules should be amended, e.g. PCT Rules 5 and 6 concerning disclosure and claims.

III. CONCLUSIONS

UNICE is concerned about those developments in the SPLT, which are influenced by attempts to introduce US patent law rules into the patent systems in use in the rest of the world.

UNICE opposes this trend and expresses its endorsement of the existing EPC and the like patent systems.

UNICE welcomes further worldwide harmonisation of patent law, but not at any cost. As long as there are two basic different patent systems (first-to-file versus first-to-invent), a genuine worldwide harmonisation cannot be achieved. In this regard, UNICE is of the opinion that a derogation of the first-to-file patent system is unacceptable.

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