

CHAIR'S TEXT

For discussion at the Fifth Group I / B+ Experts Meeting

Tokyo, Japan, November 20-21, 2006

*Based on the decisions in the WG1 Chair's Proposal,
document B+/PL/3/2*

06 November 2006

Introduction

1. It was agreed at the Group B+ meeting on 24 September 2006 that the UK would prepare a formulation of the WG1 Chair's Proposal, set out in document B+/PL/3/2, in Treaty language, and that the Chair would incorporate comments of the drafting group and circulate a text for discussion at the Tokyo meeting. The present document contains the Chair's Text, based on the exemplary work done by the UK delegation and comments received from the drafting group.

2. The present document retains the numbering of articles and rules used in the Group B+ draft, document B+/EM/4/0-2, and the SPLT, WIPO document SCP/10/4 (clean text). The sources of provisions are identified in the notes accompanying each article and rule. Text which had been boxed in the Group B+ draft has been left unchanged and boxed in this document.

3. References in this document to the Chair's Proposal are references to document B+/PL/3/2; references to the Group B+ draft are references to document B+/EM/4/0-2; and references to the SPLT are references to WIPO document SCP/10/4.

4. For ease of reference, the rules appear immediately after the articles that they support.

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Article 4

Right to a Patent for a Claimed Invention

(1) [*Principle*] The right to a patent for a claimed invention shall belong to:

(i) the inventor; or

(ii) the successor in title of the inventor.

(2) [*Employee's Inventions and Commissioned Inventions*] Notwithstanding paragraph (1), any Contracting Party shall be free to determine the circumstances under which and the extent to which the right to a patent shall belong to the employer of the inventor or to the person who commissioned the work which resulted in the invention.

(3) [*Inventions Made Independently by More Than One Inventor*] If an invention is made independently by more than one inventor, and separate applications claiming the invention are filed in or for the Office of a Contracting Party by those inventors or by persons authorized by them under the applicable law of the Contracting Party, the patent for that claimed invention, if any, will be granted on the application which has the earliest filing or priority date for the claimed invention and which is published with a claim for the invention.

Notes to Article 4

1. The Chair's Proposal calls for a provision on adoption of the "first inventor to file" principle. Based on comments of the drafting group, the Chair proposes to present that principle in the context of an article on entitlement to a patent in general.
2. The text for this article is based on SPLT Article 4. The title of the Article has been amended to refer to the right to a "patent for a claimed invention," since a patent may contain more than one invention owned by different inventors or groups of inventors.
3. Paragraph (1)(a) is taken from SPLT Article 4(1), but is amended to refer to a patent for a claimed invention. Paragraph (2)(a) is taken verbatim from SCP/10/4.
4. Paragraph (3) was reserved in the SPLT. The provision presented here is new text, taking into account suggestions and comments by members of the drafting group. Since filing dates and priority dates are attributes of applications, the text relies on the relative filing dates of the applications rather than inventors or other persons. This has the advantage of avoiding reference to entitlement to the patent, which might conflict with or complicate the provisions on entitlement in paragraphs (1) and (2).
5. By referring to the earliest filing or priority date "for the claimed invention," the text takes into account that an application may have different priority dates for different claims, for example in the case of partial priority. This also allows for the case where the second-filed application may contain additional claimed inventions that could be patentable even if the first-filed application issues.
6. The text makes clear that the first inventor to file principle only applies to two or more applications for the same invention which are filed in or for the Office of a single Contracting Party, and not to applications filed in different offices.
7. In some cases where the first-filed application does not survive to publication (e.g., if it is withdrawn or abandoned), the second filed application may be entitled to issue as a patent. The text thus provides that the patent, if any, shall issue on the application which is (i) published with a claim for the invention *and* (ii) has the earliest filing or priority date for the claimed invention. In cases where the first-filed application is published and subsequently withdrawn, abandoned or rejected, that application will serve as prior art for later-filed applications, preventing them issuing as patents for the claimed invention. This point highlights the comment of one delegation that the first inventor to file principle is linked to the provision on prior art effect of published applications, and in fact may already be covered by that latter provision.

Notes to Article 4, continued

8. While it is not technically necessary to state that the applications were filed by the inventor or a person authorized by the inventor (this must always be the case), for political purposes it appears advantageous to do so.

Sources:

Article 4(1) and (2): SPLT, Article 4(1) and (2), slightly modified.

Article 4(3): New text

Article 8

Prior Art

(1) [*Definition*] The prior art with respect to a claimed invention shall consist of all information which has been made available to the public anywhere in the world in any form [, as prescribed in the Regulations,] before the priority date of the claimed invention.

(2) [*Prior Art Effect of Certain Applications*] (a) The following subject matter in another application (“the other application”) shall also form part of the prior art with respect to a claimed invention, provided that the other application or the patent granted thereon is made available to the public subsequently by the Office [, as prescribed in the Regulations]:

(i) if the filing date of the other application is prior to the priority date of the claimed invention, the whole contents of the other application;

(ii) if the other application has a filing date that is the same as, or later than, the priority date of the claimed invention, but claims, in accordance with the applicable law, the priority of a previous application having a filing date that is earlier than the priority date of the claimed invention, subject matter that is contained in both the other application and that previous application.

[Article 8(2), continued]

(b) For the purpose of this provision, “the other application” means an application filed with or for the Office of the Contracting Party or a regional or international application designating the said Contracting Party.

(3) *[Publication of Applications]* (a) Any application still pending shall be published promptly after the expiry of a period of 18 months from its filing date or, if priority is claimed, from its priority date.

(b) An applicant may request the early publication of an application at any time prior to the expiry of the period mentioned above [, as prescribed in the Regulations].

(4) *[Secret Commercial Use and On Sale Status]* No Contracting Party shall deny a patent on the grounds that the invention was secretly used in a commercial manner or placed on sale, except to the extent that the prior art might include information made available to the public by virtue of the invention being secretly used or placed on sale, subject to Article 9.

(5) *[Experimental Use]* Subject to Article 9, no Contracting Party shall exempt from the prior art information made available to the public as the result of experimental use.

Notes to Article 8

1. The Chair's Proposal calls for provisions stating that:

- (i) published applications have prior art effect as of the priority date (i.e., elimination of the Hilmer doctrine);
- (ii) PCT applications shall form part of the secret prior art from the filing/priority date upon designation;
- (iii) Contracting Parties shall not refuse a patent on the grounds of secret commercial prior use, except to the extent that such use resulted in information entering the prior art; and
- (iv) Contracting Parties shall not exempt experimental use from the prior art, outside of the grace period.

Concerning items (iii) and (iv), the text in the Chair's Proposal refers to "no provision on" these items. This was intended to mean that Contracting Parties would not be permitted to adopt provisions on these items in their relevant laws.

2. The Chair's Proposal also states that Article 8(2), Article 12(3) and Rule 9(3) shall be considered together. Rule 15(2) is also relevant.

3. The boxed text of paragraphs (1) and (2)(a) from the Group B+ draft have been included, to provide context for the remaining provisions. The last line of paragraph (1) in the Group B+ draft included alternative language. The term "claimed invention" has been chosen over the term "claimed subject matter," to conform with the use of "claimed invention" the first line of that paragraph. Some delegations in the drafting group pointed out that the International Bureau might not be covered by the term "Office" in the chapeau of paragraph (2)(a), as an office which publishes applications; it appears that the term "Office" may not have an antecedent in that provision, and therefore that it may not be sufficiently well defined.

4. Paragraph (2)(a)(ii) in the boxed text ensures that published applications have prior art effect as of their priority date and therefore eliminates the Hilmer doctrine.

5. Paragraph (2)(b) provides that international applications under the PCT will have prior art effect from their filing or priority date in Contracting Parties that are designated in the international application, whether or not the applicant enters the national phase in that Contracting Party.

6. Paragraph (3) requires publication of applications. This provision is retained in the present draft even though it was not mentioned in the Chair's Proposal, as it is considered to be integral to the concept of prior art effect of published applications.

Notes to Article 8, continued

7. Paragraph (4) prohibits denial of the grant of a patent on the grounds of certain actions by the inventor or successor in title of the inventor involving the invention, except to the extent that such actions lead to information being made available to the public and thus becoming part of the prior art, in accordance with the Chair's Proposal.

8. Paragraph (5) is moved here from the article on the grace period in the Group B+ draft, Article 9(4), based on comments from the drafting group that it relates to the definition of prior art rather than the grace period. It is reworded as a prohibition to exempting experimental use from the prior art. Although not strictly necessary, this paragraph is made subject to Article 9 to emphasize that the grace period still applies.

Sources:

Article 8(1) – Group B+ text for Article 8(1)

Article 8(2)(a) – Group B+ text for Article 8(2)(a)

Article 8(2)(b) – Group B+ text for Article 8(2)(b), Alternative B

Article 8(3) – Group B+ text, page 12, modified

Article 8(4) – Group B+ text for Article 9(4), modified

Rule 8

*Availability to the Public
Under Article 8(1)*

(1) [*Form of availability to the Public*] Information made available to the public in any form, such as in written form, in electronic form, by oral communication, by display or through use, shall qualify as prior art under Article 8(1).

(2) [*Accessibility to the Public*] (a) Information should be deemed to be made available to the public if there is a reasonable possibility that it could be accessed by the public.

(b) For the purposes of Article 8 and this Rule, the term “public” means any person who is not bound by an explicit or implicit obligation of confidentiality to maintain the information secret.

(3) [*Determination of the date of availability to the Public*] Where information allows the determination of only the month or the year, but not the specific date, of availability to the public the information shall be presumed to have been made available to the public on the last day of that month or that year respectively, unless any evidence proves otherwise.

Notes to Rule 8

1. Rule 8, while not covered by the Chair’s Proposal, is included because it is already adopted text, and provides necessary context to Article 8.

Sources

Rule 8: Group B+ boxed text for Rule 8

Rule 9

*Prior Art Effect of Certain Applications
Under Article 8(2)*

(1) [*Principle of “Whole Contents”*] (a) The subject matter of the other application referred to in Article 8(2) shall consist of the description, claims and drawings as of its filing date.

(b) The other application referred to in subparagraph (a) may be an application for the grant of a patent or an application for a utility model or any other title protecting an invention under the applicable law, provided that the applicable law allows for only one of those titles to be validly granted with effect for a Contracting Party for the same claimed invention.

(2) [*Applications Erroneously Published*] Where the other application has been made available to the public although it should not have been made available to the public under the applicable law, it shall not be considered as prior art for the purposes of Article 8(2).

(3) [*Anti-Self-Collision*] (a) Article 8(2) and paragraph (1) of this rule shall not apply when the applicant in respect of, or the inventor identified in, the other application and the applicant in respect of, or the inventor identified in, the application under examination, are, at the filing date of the application under examination, one and the same person, provided that only one patent may be

[Rule 9(3)(a), continued]

validly granted with effect for a Contracting Party on two or more applications by the same applicant or inventor to the extent they claim identical subject matter.

(b) A Contracting Party may provide that not more than one patent shall be granted on two or more applications by the same applicant or inventor to the extent they claim matter that is obvious in view of the claims in the other application, unless the applicant or inventor files a disclaimer with a provision such that any second patent granted shall be enforceable only for and during such period that the patent is commonly owned with the aforesaid one patent or the application granted thereon.

Notes to Rule 9

1. The Chair's Proposal calls for providing:

- (i) that the abstract shall not form part of the "whole contents";
- (ii) that the content of the secret prior art shall be defined as the content of the application at the filing date;
- (iii) for anti-self-collision, including common ownership and limitation of term.

The Chair's Proposal also states that Article 8(2), Article 12(3) and Rule 9(3) shall be considered together. Rule 15(2) is also relevant.

2. Paragraph (1)(a) excludes the abstract in accordance with the Chair's Proposal, and adopts the alternative in Rule 9(1)(a) of the Group B+ draft referring to the filing date. Minor drafting changes have been made to conform the language to that of Article 8(2) (viz., using the terms "subject matter" and "the other application").

Notes to Rule 9, continued

3. Alternative B from the Group B+ draft has been selected for the anti-self-collision provision in paragraph (3), since it includes provisions corresponding to common ownership and limitation of term as set out in the Chair's proposal.

Sources:

Rule 9(1)(a) – Group B+ text for Rule 9(1)(a), modified

Rule 9(1)(b) – Group B+ boxed text for Rule 9(1)(b)

Rule 9(2) – Group B+ boxed text for Rule 9(2)

Rule 9(3) – Group B+ text for Rule 9(3), Alternative B

Article 9

*Prior Art Not Affecting Patentability (Grace Period);
Right of Prior User*

(1) [*General Principle for Article 8(1) Prior Art*] Information which forms part of the prior art with respect to a claimed invention in accordance with Article 8(1) shall not affect the patentability of that claimed invention, in so far as that information was made available to the public on a date during the 12 months preceding the priority date of the claimed invention

(i) by the inventor;

(ii) by an Office and the information was disclosed:

(a) in another application filed by the inventor and should not have been made available to the public by the Office under the applicable law; or

(b) in an application filed without the consent of the inventor by a third party who obtained the information directly or indirectly from the inventor;

or

(iii) by a third party who obtained the information directly or indirectly from the inventor.

[Article 9, continued]

(2) *[General Principle for Article 8(2) Prior Art]* Subject matter in another application which forms part of the prior art with respect to a claimed invention in accordance with Article 8(2) shall not affect the patentability of that claimed invention in so far as the other application was filed without the consent of the inventor by a third party who obtained the subject matter directly or indirectly from the inventor.

(3) *[Right of Prior User]* Any person (hereinafter referred to as “the prior user”) who in good faith for the purposes of the person’s enterprise or business, before the priority date of a claimed invention in a patent and within the territory where the patent produces its effect, was using the claimed invention or was making effective and serious preparations for such use, shall have the right, for the purposes of the person’s enterprise or business, to continue such use or to use the claimed invention for the activities for which such preparations were made.

(4) *[Successor-in-Title of the Prior User]* The right of the prior user may only be transferred or devolve together with the prior user’s enterprise or business, or with that part of the enterprise or business in which the use or the preparations for use have been made.

[Article 9, continued]

[(5) [Exception for Derived Acts] A Contracting Party may provide that paragraph (3) does not apply where the use or the preparations for use arose out of information concerning the claimed invention obtained directly or indirectly from the inventor of the claimed invention in the patent.]

(6) [Use of a Claimed Invention] For the purposes of paragraphs (3) to (5), use of a claimed invention in a patent means the performance of acts that would otherwise constitute an infringement of the patent under the law of the Contracting Party.

(7) [“Inventor”] For the purposes of this Article, “inventor” also means any person who, at or before the priority date of the claimed invention, had the right to the patent.

(8) [Grandfather clause] If, on [date of agreement], paragraphs (3) to (6) are not compatible with the law of a Contracting Party, those paragraphs shall not apply in respect of that Contracting Party for as long as they continue not to be compatible with that law.

Notes to Article 9

1. The Chair's Proposal calls for a provision on the grace period that provides:
 - (i) a 12 month grace period;
 - (ii) that an applicant's previous published applications are covered only if published erroneously by an Office;
 - (iii) a prohibition on requiring a declaration; and
 - (iv) a mandatory scheme for protection of third party rights (right of prior user).
2. The title of the Article has been modified from the title in the Group B+ draft to clarify that the article covers information in the prior art that does not affect patentability, rather than information that does not affect patentability because it does not constitute prior art. A reference to third party rights is also added to the title.
3. Paragraphs (1) and (2) provide the general principle for a 12-month grace period in accordance with the Chair's Proposal. Paragraph (7) re-defines the term "inventor" for the purposes of, *inter alia*, paragraphs (1) and (2).
4. Paragraphs (3) to (6) and (8) contain the provisions for third party rights (right of prior user). After considering the input from delegations and the discussions in the drafting group, the chair believes that the suggested solution envisaged in the Chair's Proposal for third party rights was perhaps too complicated. It was also felt by some that the text presented in the Group B+ draft was similarly complicated. The chair has therefore, on the basis on the input from the drafting group, presented a new text for third party rights which is based, in part, on the Basic Proposal presented to the 1991 Diplomatic Conference, see WIPO document SCP/4/3, Article 20.
5. Paragraphs (3) and (4) require Contracting Parties to provide for third party rights in accordance with the Chairs' Proposal.
6. Paragraph (5) permits a Contracting Party to exclude third party rights in cases where the use or preparations are based on information derived from the inventor (or, taking into account paragraph (7), another person who had the right to the patent). This paragraph is presented in square brackets for discussion.

Notes to Article 9, continued

7. Paragraph (6) is included to provide guidance as to the type of use of a claimed invention that would be covered by third party rights. While some delegations considered that this provision was not strictly required (acts which do not constitute infringement do not require any special exemption from patent rights), other delegations felt that such a provision would be useful for implementing this Article.

8. Paragraph (8), included for discussion, provides for a “grandfather clause” in relation to third party rights.

Sources:

Article 9(1) – Group B+ text for Article 9(1)(a), Alternative B

Article 9(2) – Group B+ text for Article 9(1)(b)

Article 9(3) to (4) – Basic Proposal, WIPO document SCP/4/3, Article 20, modified

Article 9(5) – New text

Article 9(6) – Group B+ text for Article 9(3), Alternative A, modified

Article 9(7) – Group B+ text for Article 9(1)(c)

Article 9(8) – New text

Article 12

Conditions for Patentability

(1) [RESERVED]

<p>(2) [<i>Novelty</i>] A claimed invention shall be novel. It shall be considered novel if it does not form part of the prior art as defined in Article 8 [and prescribed in the Regulations].</p>

(3) [*Inventive Step/Non-Obviousness*] A claimed invention shall involve an inventive step. It shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in Article 8, the claimed invention as a whole would not have been obvious to a person skilled in the art at the priority date of the claimed invention [,as prescribed in the Regulations].

Notes to Article 12

1. The Chair's Proposal states that:

- (i) no elements of methodology concerning inventive step/ non-obviousness should be included at the article level; and
- (ii) secret conflicting applications (as defined in Article 8(2)) shall form part of the prior art for the purpose of determining both novelty and inventive step/non-obviousness.

The Chair's Proposal also states that Article 8(2), Article 12(3) and Rule 9(3) shall be considered together. Rule 15(2) is also relevant.

Notes to Article 12, continued

2. Paragraph (2) in boxed text is included for completeness. The reference to Article 8 as a whole indicates that secret prior art as defined in Article 8(2) shall form part of the prior art for the purpose of determining novelty.

3. In paragraph (3) of the present text, the bracketed phrase “[the differences between the claimed invention and]” that appeared in Article 12(3) of the Group B+ draft has been removed, as this would constitute an element of methodology.

4. Also in paragraph (3), the reference to Article 8[1] that appeared in Article 12(3) of the Group B+ draft has been modified to refer to Article 8 as a whole, to indicate that secret prior art as defined in Article 8(2) shall form part of the prior art for the purpose of determining inventive step/non-obviousness. See Rule 15(2) regarding combining items of secret prior art.

Sources:

Article 12(2) – Group B+ draft, Article 12(2)

Article 12(3) – Group B+ draft, Article 12(3), modified

Rule 14

*Items of Prior Art
Under Article 12*

(1) [*Content of the Items of Prior Art*] (a) The content of any item of prior art shall be determined by what was explicitly or inherently disclosed to a person skilled in the art at the priority date of the claimed invention.

(b) An item of prior art incorporated by explicit reference in another item of prior art shall be considered to form part of the latter item of prior art.

Notes to Rule 14

1. Rule 14, while not covered by the Chair's Proposal, is included because it is already adopted text, and provides necessary context to Article 12.

Sources:

Rule 14: Group B+ draft, boxed text for Rule 14

Rule 14bis

*Assessment of Novelty
Under Article 12(1)*

(1) [*Item of Prior Art*] An item shall qualify as an item of prior art only if it enables a person skilled in the art at the priority date of the claimed invention to carry out the claimed invention.

(2) [*Combining Items of Prior Art*] In the determination of lack of novelty, any relevant item of prior art may only be taken into account individually and may not be combined with other items of prior art.

Notes to Rule 14bis

1. Rule 14*bis*, while not covered by the Chair's Proposal, is included because it is already adopted text, and provides necessary context to Article 12.

Sources:

Rule 14*bis*: Group B+ draft, boxed text for Rule 14*bis*

Rule 15

*Assessment of Inventive Step/Non-Obviousness
Under Article 12(2)*

(1) [*Items of Prior Art*] The prior art referred to in Article 12(2) may consist of a single item of prior art or of multiple items of prior art.

(2) [*Combining Items of Prior Art*] A Contracting Party is free to determine the extent to which an application which constitutes an item of prior art by virtue of Article 8(2) may be combined with other items of prior art for the purpose of assessing inventive step/non-obviousness.

(3) [*General Knowledge of the Person Skilled in the Art*] For the determination of inventive step (non-obviousness), the general knowledge of the person skilled in the art at the priority date of the claimed invention shall be taken into account.

Notes to Rule 15

1. The Chair's Proposal states that, in determining inventive step/non-obviousness, each Contracting Party will be free to determine the extent to which a single item of secret prior art may be combined with other items of secret or public prior art. New Paragraph (2) is intended to give Contracting Parties that freedom, in accordance with the Chair's proposal.

2. No methodology for assessing inventive step/non-obviousness is set out in this Rule. That is left to the Practice Guidelines.

Source:

Rule 15(1) – Group B+ draft, boxed text for Rule 15(1)

Rule 15(2) – new text

Rule 15(3) – Group B+ draft, boxed text for Rule 15(2)

[End of document]