Resolution

Question Q180

Content and relevance of industrial applicability and/or utility as requirements for patentability

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Yearbook 2006/III, page 507 – 508 Q180
Congress Gothenburg, October 8 – 12, 2006

AIPPI

Considering that:

Article 27 TRIPS provides that, subject to certain exceptions, patents shall be available for any invention, whether product or process, in all fields of technology, provided that it is new, involves an inventive step and is capable of industrial application.

According to the footnote relating to Article 27 TRIPS, for the purpose of said article, the term "*capable of industrial application*" may be deemed by a Member State to be synonymous with the term "*useful*".

The Draft SPLT under discussion at the WIPO contains a provision in Article 12(4) which deals with industrial applicability and/or utility as a third criterion of patentability besides novelty and non obviousness.

In its Resolution Q170, which relates to SPLT, the AIPPI reiterated the opinion that it is in the users' interest to adopt a harmonisation treaty on at least some substantive patent aspects at the earliest possible date. Accordingly, it decided to reserve for future discussions, leading to "SPLT2", the most difficult issues among which is Article 12(4) relating to the third criterion for patentability.

With Q180, AIPPI decided to consider more thoroughly the similarities and differences of the two current criteria and to study whether it is possible to find a third harmonized criterion.

The Geneva Resolution of 2004 confirmed the need for a third harmonized criterion, set some guidelines and concluded that further studies should be conducted for the purpose of defining the content of said third harmonized criterion.

The Executive Committee in Berlin in 2005 confirmed the possibility and the advantages of a third harmonized criterion.

According to the replies to the questionnaire circulated before the Gothenburg Congress of 2006, inventions without any use are not patentable, but not always on the same ground.

Noting that:

The third criterion at issue is not intended to address any requirement of technical content, or any patentability exclusions based on morality, public order, ethics or the like which may be defined by each country independently from said criterion.

Further studies should be conducted regarding the definition of patent eligible inventions, including the question of technical content.

Resolves:

1) Both in patent systems applying the utility criterion and in those applying the industrial applicability criterion, an invention without any use should not be patentable.

2) The subject matter of a claim is both useful and industrially applicable if at least one use would be understood by a skilled person in light of the specification at the filing (or priority) date.

3) As a result of sections 1) and 2), the third criterion should be based on use.