

QUESTION 89

Harmonization of certain provisions of the legal systems for protecting inventions

Yearbook 1989/II, pages 324 - 329
Executive Committee of Amsterdam, June 4 - 10, 1989

Q89

Question Q89

Harmonisation of certain provisions of the legal systems for protecting inventions

Guidelines by AIPPI

Article 106: Publication of applications

AIPPI considers that the proposal of WIPO fits into the frame-work of other harmonisation provisions connected with the first-to-file system.

1. AIPPI supports the text of paragraph 1 (a). It should, however, be understood that the requirement of publication is also fulfilled if the application is laid open for public inspection.
2. AIPPI is aware of the fact that there might be different interpretations with respect to the effects of withdrawal or abandonment. It should therefore be understood that the publication should not occur if there is no intent by the applicant to pursue the application. With respect to a rejection, no publication should occur if the application is finally rejected without the possibility of an appeal.
3. There should be a clear statement in the treaty of the point in time up to which he can withdraw his application without it being published; this period for withdrawal should be as long as possible. The rules should state that this period should not be shorter than 17 months after filing or after the priority date.
4. AIPPI is of the opinion that the concept of „national security“ in (c) should be narrowly interpreted.

5. AIPPI supports the text of (d) with the understanding that this provision only regulates the publication of the application after 18 months and nothing is said about the form of publication of the granted patent.

6. The text of paragraph (2) is supported. AIPPI especially welcomes sentence 2 of the provision which has the effect that through an earlier publication the applicant can also create a stronger prior art effect for inventive step.

7. If a patent is granted prior to the expiration of 18 months - paragraph 1 b - it should be understood that the original application should be laid open for public inspection.

8. In case of an internal priority or a continuation-in-part filed in time for publication at the expiration of 18 months the completed, modified application should be so published and the file should be made available for public inspection, in order that third parties have access to the original application.

In the case of a continuation in part filed after the expiration of 18 months or so shortly before that it can no longer be taken into consideration, publication of the CIP should occur as soon as possible.

9. AIPPI is of the opinion that the Treaty should also rule on the question of publication of divisional applications.

10. With respect to rule 106 AIPPI is of the opinion that information obtainable from the industrial property office should be possible by any technical means, but for the convenience of small- and medium-sized companies at least also on paper.

Article 108: Post grant opposition

AIPPI favours the introduction of a form of third party participation in the granting process. With respect to the proposed wording of WIPO it takes the following position.

1. It should be understood that the introduction of an opposition can only be requested for countries with a substantive examination system.

2. In the interest of a speedy granting procedure, AIPPI favours a post-grant opposition.

3. AIPPI regards the introduction of a time limit for an opposition as desirable.

4. With respect to the grounds of opposition it should be understood that at least the following grounds should be expressly mentioned:

- that an invention is not patentable in the light of printed publications;
- that the invention was not sufficiently disclosed for a person skilled in the art;
- that the application was extended beyond the content of the originally filed documents.

5. The text of paragraph 1 (b) that third parties shall be given the opportunity to present their arguments is supported by AIPPI.

6. AIPPI is aware of the fact that the mandatory introduction of an opposition or revocation procedure before the patent office may pose problems even in some examining countries and it therefore agrees to offer as an alternative the introduction of a re-examination which could be used by the applicant or third parties at any time during the life of the patent. The grounds of such a re-examination should at least be that the invention is not patentable in the light of printed publications.

7. AIPPI strongly supports the prohibition of a pre-grant opposition but is also in favour of a transitory period for abolition in countries which presently have a pre-grant opposition.

8. AIPPI supports the text of paragraph (3), namely that invalidation or cancellation procedures before the courts or quasi judicial - authorities can be available in addition to third party procedures before the Patent Office.

9. AIPPI furthermore considers that the introduction merely of a re-examination system without full third party involvement is not sufficient and each country therefore should provide third party intervention and review possibility by courts or quasi - judicial authorities.

Article 107: Time limits for search and substantive examination

AIPPI supports the principle that patents should be granted in a short term. This enables the applicant to exercise his rights and the public to obtain security about the scope of protection. Among the means to enable this goal AIPPI supports the following:

1. On filing, the applicant should request the search and pay the search fees. The payment of the search fees may in some countries discourage the filing of patent applications which are not intended to be seriously pursued.

2. After having received the search report the applicant should have the possibility of a reasonable period of time to request examination. The time limit considered as reasonable by AIPPI is two years after the publication of the search report.

3. Third parties should have the possibility, especially if the time period is longer than two years, to request examination at any time upon payment of the examination fees.

4. Since the fixing of time limits for requesting examination does not necessarily ensure that the examination will soon be accomplished, AIPPI in addition supports the enactment of strong provisional protection for the published application.

Article 110: Changes in granted patents

AIPPI supports the introduction of a possibility of amending granted patents. With respect to the proposed text of WIPO AIPPI makes the following observations:

1. The provision of article 110 (1) (i) is acceptable, namely that claims can be limited.
2. AIPPI is of the opinion that the clarification of ambiguities should be left to the courts, since an ex-parte proceeding is not appropriate for such a purpose.
3. AIPPI is in favour of a provision that clerical errors can be corrected, provided that in accordance with the Treaty proposal of WIPO the scope of the claims is not enlarged.
4. AIPPI is of the opinion that article 110 paragraph 1 should be regarded as a minimum requirement, so that countries can provide also, during a limited period of time, for an enlargement of claims even beyond the correction of these errors, if intervening rights are protected.
5. AIPPI is of the opinion that rule 110 should be deleted and thus paragraph (2) be modified accordingly (deletion of the reference to the regulations).

Article 200: Patentable inventions

1. AIPPI is of the opinion that a general definition of inventions as proposed in paragraph 1 should be deleted.
2. AIPPI supports the definition of patentability in (2) with the following modifications:
 - a) the definition of inventive step in the bracket should be deleted („is non obvious"), since paragraph 4 still contains such a definition.
 - b) it should be stated that the requirement of industrial applicability has the same or a very similar meaning as utility to that after „industrially applicable“ „or useful“ should be added.
 - c) in the definition of industrial applicability (5) „in the technological sense“ should be deleted, and after „in any kind of industry“, „or technology“ should be added.
 - d) Furthermore, the notes should clarify that „industry“ must be interpreted in the broadest sense which includes agriculture as well as e.g. medical treatment.
3. AIPPI is in favour of defining the concept of novelty. It prefers however a wording as was proposed in Geneva „if it does not form part of the prior art“, since the word „anticipated“ might lead to confusion.
4. In paragraph 3 (b) the bracket „or any other“ should be deleted so that the prior art defined would only comprise written or other graphic publications and would exclude oral disclosures as well as prior public use. The introduction of the absolute novelty concept should be made optional for the countries.

5. In paragraph 4, the definition of inventive step, is supported by AIPPI.

Article 105: A unity of invention

AIPPI is of the opinion that the trilateral proposal should be made on the basis of the discussion.

1. AIPPI is in favour of articles 1, 3 and 4 of the proposal.

2. AIPPI is also in favour of the introduction of a new requirement expressed in paragraph 2 to the effect that linked inventions must have a technical interrelationship, such interrelationship being expressed in the claims in terms of the same or corresponding technical features with the following qualifications:

a) the special technical features mean those that appear to define the contribution which each invention as a whole makes over the prior art.

b) the new definition should be transferred to the rules where it may be more readily modified with the benefit of experience and limited in its applicability to groups of claims falling within the same categories of invention.

3. AIPPI notes that the first paragraph of Note (d) to the Articles is in agreement with PCT rule 13.2 and recommends that this portion of the Note be transferred to the rule to define the single general inventive concept for different categories of inventions.

4. With respect to the rules as set forth in document HL/CE/V/5, paragraphs 1, 3 and 4 are endorsed by AIPPI without change.

5. With respect to paragraph 2 of the rules AIPPI is of the opinion that a definite date should be announced to the applicant so that he can determine whether he wants to file a divisional application. The reference to **!Textmarke nicht definiert, PRE** should therefore be deleted and an advance notice similar to the EPC „ready for grant“ be provided for.

6. Where lack of unity exists, the applicant should, whenever possible, be given the

opportunity to make the selection or pay a second search fee. AIPPI is, however, aware of the fact that such a possibility will be difficult for countries with a fast search where an automatic selection may become necessary.

Article 109: Restoration of the right to claim priority

1. AIPPI favours the introduction of this principle into the international treaty. However, AIPPI questions whether the two alternatives A and B as proposed by WIPO, which would result in an extension in fact of the priority right, are compatible with the Paris Convention.

2. In case these provisions are compatible with the provision of Art. 4 of the Paris Convention:

a) AIPPI, for practical reasons, favours the alternative A which constitutes a fast and simple procedure to correct errors and deficiencies of priority applications. Another reason for favouring alternative A can be seen in the fact that the definition „due care“ may be interpreted very differently from country to country; some countries might even set an unreasonably high standard of care in order to bar priority applications from abroad.

b) AIPPI would also be ready to accept alternative B. It notes, however, that such procedure in which factual and legal arguments must be put forward in order to prove that the error was committed in spite of due care, can be lengthy and expensive. This may lead to a situation where publication within 18 months will no longer be possible. Nevertheless AIPPI also favours that another month be given to the applicant in order to substantiate its claim for restoration.

3. AIPPI also favours the introduction of the possibility of restoration not only for cases where the application was filed late but also where the priority claim was erroneously omitted, although the application was filed in the priority period.

Article 301: Principle of first to file

AIPPI is of the opinion that the text of article 60 EPC should be taken as the treaty text. This article would therefore read as follows:

1. The right to a patent shall belong to the inventor or his successor in title.
2. If two or more persons have made an invention independently of each other, the right to the patent shall belong to the person whose patent application has the earliest date of filing; however, this provision shall apply only if this first publication has been published under article 106 or in the form of a granted patent.

Such a text would not only institute the principle of first to file but at the same time state that this principle should only apply where the invention was made by two independent inventors. The provision that only prior applications which are published later constitute a bar follows from the fact that non-published applications do not belong to the prior art.

Article 304: Extent of Protection

AIPPI supports the text of article 304 as proposed by WIPO.
With respect to rule 304 AIPPI has the following observations:

1. AIPPI also supports the wording of rule 304 paragraphs (1) to (3).
2. With respect to paragraph (4) AIPPI is of the opinion that the second part of the sentence („or for a combination of less than all the said elements“) should be deleted. Such a rule would unnecessarily prevent the courts from finding an infringement where the infringer omits only one feature from a claim of a great number of features but nevertheless achieves the inventive result, even if at a lesser degree („less advantageous solution“). It would also exclude cases where the patentee has erroneously mentioned an element or a feature which later is found to be unnecessary for the completion of the invention („overclaiming“).

As a general proposal AIPPI would therefore prefer to adopt the new draft of paragraph (4) proposed by WIPO:

„A claim for a combination shall not provide independent protection for the individual parts of the combination.“

3. Reference should be made to article 302 (3) in the form of „notwithstanding Art. 302 (3)“
4. AIPPI is of the opinion that paragraph (5) should be deleted.
5. AIPPI supports the wording of articles (6) and (7) of the WIPO draft.

Article 306: Maintenance fees

AIPPI supports the intended harmonization of the method of payment of maintenance fees.

With respect to the text proposed by WIPO AIPPI has the following proposals.

1. In order to maintain flexibility, AIPPI confirms its view that payment periods longer than one year should be allowed.
2. AIPPI is of the opinion that the payment of annuities or maintenance fees should only start after the grant of the patent. Such a rule, which exists in some countries, takes into account that the applicant, through automatic publication after 18 months, has already given valuable information to the public.

Furthermore, if maintenance fees are paid after grant there is a considerable incentive upon the Patent Office to speed up examination. The starting of payments after grant also reflects the value the patentee has received by the grant.

The argument that the applicant can already enforce his rights by way of provisional protection does not justify the payment of maintenance fees, since provisional protection only follows from early publication which opens the possibility for competitors to use the invention.

3. AIPPI supports the calculation of the due date as from the first day of the following months in paragraph (3) (i).
4. AIPPI proposes to give examples in the notes as to the meaning of „due date“.

Article 307: Provisional Protection

AIPPI supports the introduction of an improved provisional protection. Such protection is necessary as a compensation for early publication.

However, in view of its importance, AIPPI has resolved to put the question on the Agenda of its activities at its next Executive Committee Meeting to be held in Barcelona in September/October 1990 (Q 98).

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Question Q89

Harmonization of certain provisions of the legal systems for protecting inventions

Guidelines of AIPPI for representation before WIPO

Yearbook 1991/I, pages 280 - 286

Q89

Executive Committee of Barcelona, September 30 - October 5, 1990

Articles contained in the draft Treaty (VIII/2-3-4)

Article 3 - Description and Disclosure

AIPPI has studied the proposals of the US Delegation (VIII/21) and the Delegation of the FRG (VIII/15). These proposals are intended to facilitate the drafting of descriptions in cases of less complicated inventions.

AIPPI is of the opinion that it should support any proposal which has the effect of simplification and flexibility so that both proposals are welcome, with the exception of the best mode requirement contained in the US proposal.

Article 10 - Fields of Technology

AIPPI has examined the proposal of the developing countries² which contains in its Alternative A an enumeration of subject matter which is regarded by the developing countries as unpatentable. However, the list in Paragraph (1)(i) does not only contain fields of technology which AIPPI considers should not be excluded from patent protection. It also includes other possible obstacles to patent protection which do not fall under the concept of "fields of technology", such as illegality or immorality and the exclusion of mere discoveries.

Most seriously, Paragraph (2) is drafted so broadly that it would give a country the possibility of excluding any kind of subject matter.

AIPPI therefore firmly rejects the proposal and continues strongly to support Alternative A of the WIPO proposal.

Article 11 - Conditions of Patentability

1. AIPPI recognizes that in a number of countries the concept of worldwide absolute novelty has been introduced which means that also prior public use abroad destroys novelty.

² All references to the developing countries are made with respect to those countries that are indicated on document HL/CE/VIII/22 of WIPO

However, in view of the difficulties of proof in such cases, countries should have the option of excluding such acts as prior art if they have occurred abroad. AIPPI therefore is in favor of Article 11(2)(c) as an option and recommends the deletion of the brackets from that provision.

2. AIPPI has examined the Swedish proposal in Document VIII/9 which has the purpose expressly of excluding the possibility of using a combination of references ("mosaicing") for the determination of novelty. Although this is the usual approach in most patent systems, AIPPI favors inclusion of this provision in the Treaty in order to avoid any uncertainty.

Article 13 - Prior Art Effect of Certain Applications on Novelty

1. The Committee does not support the US proposal to apply the whole contents approach also for the examination of inventive step, even if this would only be an option for the contracting parties. Such a provision if introduced by one or several countries would lead to disharmony.

AIPPI is of the opinion that for the determination of inventive step the documents to be considered must have been accessible to the public.

2. AIPPI favors the introduction of an anti-self collision clause in Article 13(4)(a) as a mandatory provision. In the interest of harmonization, a foreign applicant should not be faced with a provision in another country which could be a ground for invalidation of his patent.

AIPPI is of the opinion that the internal priority is not a substitute for the anti-self collision clause, because of the fact that it does not cover the full term until the publication of the application. However, some sort of provision for an internal priority should be maintained in the Treaty because it prevents third parties from obtaining rights in the priority interval.

Article 15 - Publication of Application

AIPPI has examined the Swiss proposal (VIII/19) which would enable applicants to withdraw pending applications up to a predetermined point in time before they are published. AIPPI strongly supports inclusion of such a provision in the Treaty.

AIPPI also supports the UK proposal in Rule 7 which obliges countries which do not publish applications but only lay them open for public inspection to publish pertinent information in an official gazette.

AIPPI furthermore has sympathy with the US proposal which would extend the existing 18 month time limit for publication to 24 months. It recognizes that in countries where examination can be accomplished within such time period only one document instead of two needs to be published. This not only reduces cost but also the ever increasing number of search documents. It also allows applicants to withdraw applications when it

can be seen that a satisfactory patent cannot be obtained and therefore could allow countries which have problems in introducing automatic publication into their laws to ratify the Treaty.

Article 16 - Time Limits

AIPPI confirms the view taken by AIPPI in Amsterdam that maximum time limits for search and examination should be laid down in the Treaty. Only if patents are granted within a reasonable period of time has the inventor a chance to receive a due reward for his contribution.

AIPPI can therefore support the WIPO proposal. AIPPI repeats, however, the proposal made in Amsterdam that the time period for accomplishing the substantive examination should be counted from the completion of the search report in countries where the examination and search are conducted separately.

AIPPI, having taken note of the fact that separate search reports are required by national offices e.g. in European countries which are members of the EPC all being established by the EPO, strongly suggests improved international cooperation among Patent Offices and mutual recognition of search reports based on the same documentary prior art. As long as Patent Offices continue to duplicate each other's work.

Article 19 - Rights conferred by the Patent

AIPPI considers the inclusion of an article defining the minimum rights conferred by a patent to be an important question of harmonization.

The basic provisions of Article 19(1) and (2) of the WIPO draft are approved by AIPPI which rejects all the amendments proposed by the developing countries as being both too limiting regarding basic rights and unjustifiably broad in their exceptions.

AIPPI also supports Paragraph (2)bis proposed by the US (VIII/14) whereby patent owners will have the right to prevent third parties from actively inducing the performance of infringing acts when such inducement results in an actual infringement of the patent. This is in accordance with the position of AIPPI taken at the EXCO meeting in Sydney (1988).

AIPPI supports the WIPO text for Article 19(3) with the exception of (3)(ii) and (3)(iii) where - based on the Italian proposal (VIII/11) - the phrase "on a non-commercial scale" in (3)(ii) should be replaced by "for a non-commercial purpose" and in (3)(iii) before the proviso there should be added "relating to the subject matter of the invention".

The US proposal (VIII/14) to add (3)(v) with respect to intervening rights is not accepted but the question should be left to national legislation. It is recommended that a Note on Article 17 of the Treaty should mention this.

The Japanese proposal (VIII/17) also to add a paragraph (3)(v) relating to products existing prior to the filing date needs further clarification and therefore does not, insofar as presently understood, have the support of AIPPI.

Article 19(4)(a) - contributory infringement. AIPPI accepts the WIPO proposal with the

inclusion in paragraph (4)(a) of the phrase - taken from the US proposal - relating to a "material element of the invention" to qualify the word "means" in line 4. The rest of the US proposal (VIII/14) was rejected by AIPPI on the grounds of the concept of contributory infringement being an unlawful act in its own right.

Article 20 - Prior User

Contrary to the WIPO draft, AIPPI continues to consider that this article should be mandatory. However, in view of concerns expressed by some members of AIPPI, the WIPO text could serve as a compromise. In this context AIPPI favours the WIPO text over the Netherlands proposal (VIII/13).

However, in accordance with the Amsterdam resolution on Question 89D (1989), AIPPI does not accept the recognition of prior user rights when knowledge of the invention was obtained from the inventor or his successors.

Article 21 - Extent of the protection and interpretation of claims

The WIPO draft of Article 21 was examined in detail together with the US, French and Japanese proposals (VIII/14-10-17) in the list of the Amsterdam Resolution regarding the previous WIPO draft of Article 304.

Article 21 (1)(a) - The WIPO draft is supported by AIPPI.

Article 21 (1)(b) - AIPPI favoured the US proposal for this paragraph regarding the provision that the scope of claims should not be limited to a literal interpretation, with the proviso that the word "necessarily" be added to the second sentence such that it now reads: "In particular, the claims should not necessarily be interpreted as being confined to their strict, literal wording".

Article 21 (2) - Moreover, the French and Japanese proposals were rejected by AIPPI as a whole regarding this paragraph and its sub-paragraphs, the WIPO draft being favoured in view of the fact that it provides a higher degree of harmonisation. AIPPI recommends, however, that the Notes on the article clarify that the option to determine equivalency either on an "element-by-element" or on a "claim-as-a-whole" basis is left to the national legislations.

Article 21 (2)(b) - AIPPI is strongly of the opinion that the question of equivalency should be considered as of the time of the alleged infringement (WIPO draft), rejecting the Japanese proposal that is silent on this point, this giving freedom to the national laws to determine the question.

Article 21 (3) - AIPPI supports the WIPO draft over the French and US proposals as being simpler and adequate. However, in sympathy with the US proposal, AIPPI recommends that the words "or amendment" should be introduced after "Any representation..."

Article 22 - Term of Patent

AIPPI is in favour of this article in principle and therefore rejected the proposal for its deletion by the developing countries.

AIPPI is also in favour of a term of at least 20 years from the application date.

AIPPI is strongly of the opinion that it should be mandatory that the terms of patents of addition, patents granted with internal priorities and patents granted on divisional, continuation and continuation-in-part applications be counted from the filing date of the earlier or earliest application invoked. This is basically according to the Austrian, Netherlands and Japanese proposals (VIII/6-13-17) except that internal priorities are included in the proposal of AIPPI.

AIPPI furthermore is in sympathy with the Japanese proposal (VIII/17) to extend protection for a reasonable period when working of the invention is postponed by delays caused by government product approval procedures. It is observed, however, that this situation is foreseen in Note 22.04 of the WIPO draft.

Article 24 - Reversal of Burden of Proof

This article has already been considered by AIPPI as being of extreme importance and therefore the proposal by the developing countries to eliminate the article was rejected by AIPPI.

AIPPI also considered that the wording of Article 24(1) according to the WIPO draft is ambiguous and does not clearly implement the intention of the provision, particularly in the phrase "any identical product... and at least where the product is new...". The US proposal (VIII/14) for Article 24(1) was approved by AIPPI except that the phrase "at least one of" should be deleted with the result that the reversal of the burden of proof would be obligatory in each of the situations in which (i) the product is new and (ii) when the product is not new, there is a substantial likelihood that it was made by the process and the patentee has been unable "through reasonable efforts" to determine the process actually used.

Article 33 - Reservations

AIPPI agrees that an article of this nature should be included in the Treaty due to the necessity for the contracting parties to adjust their national legislations and to avoid outright rejection of the Treaty in many cases.

AIPPI also agrees that the periods for which reservations may remain in force should, in general, be measured from the date of signature of the Treaty and not from the date of ratification by each contracting party.

AIPPI emphasizes, however, the desirability of reducing such periods to a minimum and consequently recommends the following alterations to the otherwise approved WIPO draft:

- Article 33(2) - reservations excluding certain areas of technology from patent protection - 8 years from signature of the treaty or 5 years from ratification, whichever expires first.
- Article 33(3) - reservations maintaining pre-grant oppositions - 10 years from signature of the treaty.
- Article 33(4) - reservations regarding certain rights conferred by process patents - same as for Article 33(2).
- Article 33(5) - reservations regarding Patent Terms - same as for Article 33(2).
- Article 33(6) - reservations regarding the reversal of the burden of proof - same as for Article 33(2).

Proposals for new articles

Article 9^{bis} US Proposal - Loss of Rights - (VIII/14)

AIPPI does not favour the inclusion of this article which was proposed after the date given for introducing new questions and, further, felt it to be counter to the spirit of harmonization. However, all of the provisions except for Article 9^{bis} (1)(i) could be included in national legislations if so desired. Regarding (1)(i), AIPPI feels that the question of sale or secret use more than one year before the filing date being a ground for loss of rights becomes of less importance under a first-to-file system which stimulates prompt filing.

Proposal by developing countries (VIII/22)

A. Obligations of the Right Holder.

It is not clear from the text whether "patents" also comprise "applications" so that certain requirements are already contained in the Treaty or the Regulations thereunder. For example, paragraph (1)(i) - disclosure requirement - already exists in article 3 as a condition for obtaining a patent as opposed to an obligation.

Other obligations in the proposal, e.g. the payment of maintenance fees, are not excluded by the Treaty and are in fact features common to many patent systems.

Obligations such as provisions governing license contracts (contained in paragraph (1)(v)) should not be included in a treaty on Patent Law Harmonization but rather relate to the field of anti-trust or competition Law.

Finally, paragraph (2) is much too broad and is counter-productive to harmonization because it would give the individual countries unlimited discretion as to the further obligations they might impose.

AIPPI is therefore of the opinion that his proposal should not be endorsed.

B. Remedial measures under National Legislation.

This proposed article contains provisions which are under discussion within the framework of the provision of the Paris Convention without so far having being solved. It is not the purpose of the Harmonization Treaty to enact provisions which are contrary to the Paris Convention or would change it.

AIPPI is therefore of the opinion that this proposal should be rejected.

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Question Q89

Harmonization of patent rights

Resolution

Yearbook 1992/II, page 343

Q89

Council of Presidents of Lucerne, September 15 - 19, 1991

The AIPPI

- reaffirms the importance which it attributes to the project of a treaty for the harmonization of patent laws.
- expresses with emphasis the wish that the Diplomatic Conference leads to the signature of the Treaty.

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Question Q 89

Harmonization of certain provisions of the legal systems for protecting inventions

Resolution

Yearbook 1994/II, pages 391 - 392

Q 89

Executive Committee of Copenhagen, June 12 - 18, 1994

AIPPI

1. is aware of the press release dated January 24, 1994 of the Department of Commerce of the United States of America and of the decision of this country to maintain for the time being the first-to-invent system;
2. is aware of the WIPO Memorandum of May 20, 1994 (DOC P/A/XXII/I) and of the alternatives A, B and C contained therein for the continuation of the Diplomatic Conference;
3. acknowledges removal from the Draft Treaty of Articles 10, 19, 22(1), 24, 25 and 26 by the Paris Union Assembly on September 1992, which seems acceptable since most of these provisions are included in the GATT/TRIPS Agreement;
4. confirms its former Resolutions in particular the Resolution dated September 19, 1991 (Q 89/Yearbook 1992 II, page 343);
5. expresses the wish that the Draft Treaty implementing the Paris Convention as regards patents will not be further eroded;
6. very much regrets that the member states of the Paris Convention have not unanimously accepted to continue the work of the Diplomatic Conference on the basis of WIPO Document PLT/DC/69 prepared for the second part thereof;
7. considers that it is of paramount importance for the users of the patent system represented by AIPPI to find harmonized solutions throughout the world to the problems with which they are faced to obtain a prompt and reliable grant of their patents as well as an efficient protection for their inventions;
8. suggests therefore, resuming the work of the Diplomatic Conference which goes back to June 1991, within the shortest term with a view to maintaining the momentum acquired during almost 10 years in the field of harmonization of patent laws, and reaching the aims set forth by the draft treaty;

9. expresses the wish that the Assembly of the Paris Union which will be held in Geneva September 26 to October 4, 1994 works for a solution which permits the Diplomatic Conference to be resumed during 1995 without reducing, however, the scope of the draft treaty as far as its essential provisions are concerned;
10. suggests in this context:
 - a) inserting in a first Chapter alternative A as contained in the WIPO Document P/A/XXII/I § 14, including provisions ensuring equal treatment for nationals and non-nationals and removal of the Hilmer doctrine;
 - b) inserting the most controversial provisions of the draft treaty such as Article 9(2) (first-to-file), 12 (grace period), 16 (time limits for search and substantive examination) and 20 (prior user) in a separate Chapter which would enter into force at a later date, when the United States of America becomes bound by this separate Chapter;
11. considers on the other hand that the reduction of the harmonization Treaty to alternatives B and C would reduce its basic interest and would constitute an abandonment of the originally established goals and of the considerable amount of work carried out over the past ten years on an international level;
12. considers in any case that a permanent contact should be maintained between the member states of the Paris Union with a view to find a consensus resulting into the signature of the Treaty within a relatively brief term.

(Earlier Resolutions concerning the same question respectively the same subject matter: Q 89 A/1986 VII, 212; Q 89 B/1986 VII, 215; Q 89 C/1988 II, 212; Q 89 D/1989 II, 308; Q 89/1989 II, 324; Q 89/1991 I, 280; Q 89/1992 II, 343.)

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Question Q89

Harmonization of certain provisions of the legal systems for protecting inventions

Resolution

Yearbook 1995/VIII, page 373
36th Congress of Montreal, June 25 - 30, 1995

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AIPPI

1. Has taken note of the results of the Consultative Meeting for the Further Preparation of the Diplomatic Conference for the Conclusion of the Patent Law Treaty, organized by WIPO from 8 to 12 May 1995 in Geneva.
2. Has taken note of the recommendation adopted at the end of that meeting (Document PLT/CM/4, paragraph 67) recommending another approach for promoting harmonization and the study of a new draft treaty aimed at the harmonization, particularly of matters concerning the formalities of national and regional patent applications.
3. Acknowledges the progress being made in the United States on selected harmonization issues, nevertheless deeply regrets the position taken by the United States to avoid considering for the time being resumption of negotiations on the basic proposal contained in WIPO Document PLT/DC/69.
4. Confirms its previous resolutions pertaining to patent harmonization.
5. Reiterates its endorsement of using the basic proposal contained in WIPO Document PLT/DC/69 in the future negotiations.
6. Recognizes the practical importance, for the users of the patent system, of the approach recommended by the Consultative Meeting.
7. Nevertheless feels that such an approach is only an interim solution and that negotiations on the basic proposal should be resumed at an appropriate time.
8. In consequence, recommends that, at this point in time, harmonization efforts should concentrate on formalities and matters of practical importance such as those included in the recommendation of the Consultative Meeting (signatures, changes in names and addresses, change in ownership, correction of mistakes, observations in case of intended refusal, representation, address for service, contents of at least the request part of the application, and use of model international forms), and also further items relating to formalities such as conditions for granting a filing date, unity of invention,

restoration of rights, mention of inventor, translation of priority documents, formalities concerning recordal of licenses and procedural time limits.

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