

**RECORDS
OF THE DIPLOMATIC CONFERENCE
FOR THE CONCLUSION OF A TREATY SUPPLEMENTING
THE PARIS CONVENTION
AS FAR AS PATENTS ARE CONCERNED**

**Volume I:
First Part of the Diplomatic Conference
The Hague, 1991**



**WORLD INTELLECTUAL PROPERTY ORGANIZATION
(WIPO)**

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EDITOR'S NOTE

The first part of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned took place in The Hague from June 3 to 21, 1991, at facilities made available by the Government of the Netherlands. The present publication contains the Records of the first part of the Conference. The Records consist of the parts described below, as well as indexes.

Draft Treaty

This part of the Records (pages 11 to 53) reproduces the text of the draft Treaty (called "the Basic Proposal") as presented to the first part of the Diplomatic Conference.

Conference Documents

This part (pages 55 to 175) contains two series of documents distributed before and during the first part of the Diplomatic Conference: "PLT/DC" (69 documents) and "PLT/DC/INF" (4 documents).

Summary Minutes

This part (pages 177 to 521) contains the summary minutes of the sessions of the Plenary of the Diplomatic Conference (pages 179 to 227), Main Committee I (pages 228 to 490) and Main Committee II (pages 491 to 521) that took place at the first part of the Diplomatic Conference.

Participants

This part lists the individuals who represented member delegations (pages 525 to 547), special delegations (page 547), observer delegations (page 548), intergovernmental organizations other than the World Intellectual Property Organization (page 549), international non-governmental organizations (pages 550 to 553) and the World Intellectual Property Organization (pages 553 and 554). (The report of the Credentials Committee appears on pages 163 to 167.) This part also lists the officers of the Diplomatic Conference and the officers and members of the Committees of the Diplomatic Conference (pages 555 to 557).

Indexes

The Records contain six different indexes (pages 559 to 629).

The first index (pages 561 to 567) lists by number each Article of the Treaty and Rule of the Regulations under the Treaty, and indicates, under each of them, the pages where the text of the Article or Rule appears in these Records, the pages where the written proposals for amendments to the Article or Rule are reproduced and, finally, the serial numbers of those paragraphs of the summary minutes which reflect the discussion on the Article or Rule.

The second index (pages 569 to 581) is an alphabetical list of the States having the status of "member delegation" showing, under the name of each such State, where to find the names of the members of its delegation, as well as the written proposals for amendments submitted and the interventions made on behalf of that State.

The third index (page 583) is an alphabetical list of the intergovernmental organizations having the status of "special delegation" showing, under the name of each such organization, where to find the names of the members of its delegation, as well as the interventions made on behalf of that organization.

The fourth index (page 583) is an alphabetical list of the States having the status of "observer delegation" showing, under the name of each such State, where to find the name of the observers representing it, as well as the interventions made on its behalf.

The fifth index (pages 585 to 588) is an alphabetical list of intergovernmental organizations and of non-governmental organizations showing, under the name of each organization, where to find the names of the observers representing it, as well as the interventions made on its behalf.

The sixth index (pages 589 to 629) is an alphabetical list of the individual participants indicating, under the name of each individual, the State or organization which he represented, as well as the place in these Records where his name appears, together with that of the State or organization represented by him as an officer of the Conference or as an officer or a member of a Committee, or as a speaker in the Plenary, Main Committee I or Main Committee II.

Geneva, November 1991

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Draft of the Treaty
as Presented to the Diplomatic Conference

DRAFT
TREATY SUPPLEMENTING THE PARIS CONVENTION FOR THE PROTECTION
OF INDUSTRIAL PROPERTY AS FAR AS PATENTS ARE CONCERNED
(PATENT LAW TREATY)

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The Contracting Parties,

Alternative A

DESIRING to strengthen international cooperation in respect of the protection of inventions,

CONSIDERING that such protection is facilitated by a harmonization of patent law,

RECOGNIZING the need to take into consideration the public policy objectives underlying national patent law,

TAKING INTO ACCOUNT development, technological and public interest objectives of the Contracting Parties,

HAVE CONCLUDED the present Treaty, which constitutes a special agreement within the meaning of Article 19 of the Paris Convention for the Protection of Industrial Property.

Alternative B

Note: Same text as Alternative A, without the third and fourth paragraphs.

Article 1

Establishment of a Union

The States and intergovernmental organizations party to this Treaty (hereinafter called "the Contracting Parties") constitute a Union for the purposes of this Treaty.

Article 2

Definitions

For the purposes of this Treaty, unless expressly stated otherwise:

(i) references to an "application" or "application for a patent" shall be construed as references to an application for a patent for invention;

(ii) "priority date" means the filing date of the application for a patent, utility model or other title protecting an invention which has been filed with another or, where the Contracting Party so provides, the same Office and the priority of which is claimed; where the priorities of two or more such applications are claimed, the priority date,

(a) for the purposes of computing time limits, shall be the filing date of the earliest-filed of those applications,

(b) for any other purpose, shall be, for each element of the invention, the filing date of the earliest-filed of those applications which contains that element;

(iii) "prescribed" means prescribed in the Regulations under this Treaty that are referred to in Article 29;

(iv) references to a "patent" shall be construed as references to a patent for invention;

(v) "Office" means the governmental or intergovernmental agency entrusted with the granting of patents by a Contracting Party;

(vi) references to a "person" shall be construed as references to both a natural person and a legal entity;

(vii) "Director General" means the Director General of the World Intellectual Property Organization;

(viii) "published" means made accessible to the public;

(ix) "substantive examination" means the examination of an application by an Office to determine whether the invention claimed in the application satisfies the conditions of patentability referred to in Article 11(2) and (3);

(x) references to an "instrument of ratification" shall be construed as including references to instruments of acceptance and approval;

(xi) "Assembly" means the Assembly of the Union;

(xii) "Union" means the Union referred to in Article 1;

(xiii) "Organization" means the World Intellectual Property Organization;

(xiv) "Regulations" means the Regulations under this Treaty that are referred to in Article 29.

Article 3

Disclosure and Description

(1) [Disclosure] (a) The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(b) Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. Any Contracting Party may require that the deposit be made on or before the filing date or, where priority is claimed, the priority date of the application.

(2) [Description] (a) The application shall contain a description.

(h) The description shall have the prescribed contents, and such contents shall be presented in the prescribed order.

(3) [Prohibition of Other Requirements] In respect of the disclosure or the description, no requirement additional to or different from those provided for in this Article and in the relevant provisions of the Regulations may be imposed.

Article 4

Claims

(1) [Requirement of Claims in the Application] The application shall contain one or more claims.

(2) [Contents of the Claims] The claims shall define the matter for which protection is sought.

(3) [Style of the Claims] Each claim shall be clear and concise.

(4) [Relation of the Claims with the Description] The claims shall be supported by the description.

(5) [Manner of Presentation of the Claims] (a) The claims shall be presented in the prescribed manner.

(b) A Contracting Party shall be free not to require compliance with all of the requirements prescribed under subparagraph (a).

(6) [Prohibition of Other Requirements] In respect of the claims, no requirement additional to or different from those provided for in paragraphs (1) to (4) and (5)(a) may be imposed.

Article 5

Unity of Invention

(1) [Requirement of Unity of Invention] The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

(2) [Validity of Patent Not Affected by Lack of Unity of Invention]

The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

Article 6

Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant

(1) [Identification of the Inventor in the Application] (a) The application shall, as prescribed, identify the inventor or, where there are several inventors, all of them.

(b) No patent may be granted on an application that does not identify an inventor.

(2) [Mention of the Inventor in Publications of the Office] Any publication of the Office, containing the application or the patent granted thereon, shall mention the inventor or inventors as such, provided that any inventor may request, in a declaration signed by him and filed with the Office, that such publications should not mention him as inventor, in which case the Office shall proceed accordingly.

(3) [Indication of the Applicant's Entitlement] Any Contracting Party may require that the applicant indicate the legal grounds of his entitlement to file the application.

(4) [Prohibition of Other Requirements] In respect of the identification or mention of the inventor or in respect of the indication of the applicant's entitlement, no requirement additional to or different from those provided for in the preceding paragraphs may be imposed.

Article 7

Delayed Claiming of Priority

(1) [Delayed Submission of Priority Claim] Where the application ("the subsequent application") could have claimed the priority of an earlier application but, when filed, did not contain such priority claim, the applicant shall have the right to claim such priority in a separate declaration submitted to the Office within a period to be fixed by the Contracting Party which shall be at least two months from the filing date of the subsequent application and not more than four months from the date on which a period of 12 months from the filing date of the earlier application expired.

[(2) Delayed Filing of the Subsequent Application] Where the application ("the subsequent application") which claims or could have claimed the priority of an earlier application is filed after the date on which a period of 12 months from the filing date of the earlier application expired but before the expiration of a period of two months from the date on which that 12-month period expired, the Office shall restore the right of priority upon an express request submitted to the Office before the expiration of the said two-month period, if the request states and the Office finds that, in spite of all due care required by the circumstances, the subsequent application could not have been filed within the said 12-month period. The request for restoration shall state the grounds on which it is based, and the Office may require the production of corresponding evidence.]

Article 8

Filing Date

(1) Absolute Requirements] The filing date of the application shall be the date of receipt by the Office of at least the following elements:

(i) an express or implicit indication that the granting of a patent is sought;

(ii) indications allowing the identity of the applicant to be established;

(iii) a part which, on the face of it, appears to be a description of an invention.

(2) Permitted Additional Requirements] (a) A Contracting Party may provide that the filing date may be refused if either of the following requirements is not satisfied within the prescribed time limit:

(i) the application contains a part which, on the face of it, appears to be a claim or claims;

(ii) the required fee is paid.

Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with later than the date of receipt by the Office of the elements referred to in paragraph (1), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.

(b) A Contracting Party may apply a requirement referred to in subparagraph (a) only if

(i) it applied such requirement at the time of becoming party to this Treaty, or

(ii) it has, after having become party to this Treaty, to apply such requirement in order to comply with an obligation under a treaty concluded before the date of entry into force of this Treaty.

(3) [Drawings] If the application refers to drawings but such drawings are not received by the Office at the date of receipt of the elements referred to in paragraph (1), at the option of the applicant either any reference to the drawings shall be deemed to be deleted or the filing date of the application shall be the date on which the drawings are received by the Office.

(4) [Replacing Description, Claims and Drawings by Reference to Another Application] Notwithstanding paragraphs (1), (2) and (3),

Alternative A: each Contracting Party shall

Alternative B: any Contracting Party may

provide that a reference in the application to another previously filed application for the same invention by the same applicant or his predecessor in title may, for the purposes of the filing date of the application, replace any of the following elements:

- (i) the part which, on the face of it, appears to be a description of an invention,
- (ii) the part which, on the face of it, appears to be a claim or claims, or
- (iii) any drawings,

provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office within the prescribed time limit. If the said parts and drawings, and, where required, the certified copy, are received by the Office within the said time limit, the filing date of the application shall, provided that the other requirements concerning the filing date are fulfilled, be the date on which the application containing the reference to the previously filed application was received by the Office.

(5) [Language] (a) Any Contracting Party may require that the indications referred to in paragraph (1)(i) and (ii) be in the official language.

(b) Any Contracting Party may, if any of the parts referred to in paragraph (1)(iii) and paragraph (2)(a)(i) or any text matter contained in any drawings is in a language other than the official language, require that a translation thereof in the official language be received by its Office within the prescribed time limit. If the translation is so received, the filing date of the application shall be the date of receipt by the Office of the elements referred to in paragraph (1) in the language in which they were first received.

(c) Any Contracting Party may require that the parts referred to in paragraph (4)(i) and (ii) and any text matter contained in drawings referred to in paragraph (4)(iii) be furnished in the official language within the time limit referred to in paragraph (4).

(d) For the purposes of this paragraph, "official language" means the official language of the Office or, if there are several such languages, any of them.

(6) [Prohibition of Other Requirements] (a) In respect of the filing date, no requirement additional to or different from those provided for in the preceding paragraphs may be imposed.

(b) Notwithstanding subparagraph (a), a Contracting Party may, for the purposes of any treaty providing for the grant of regional patents, require that an application for a regional patent contain the designation of at least one State party to that treaty.

Article 9

Right to a Patent

(1) [Right of Inventor] The right to a patent shall belong to the inventor. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention.

(2) [Right Where Several Inventors Independently Made the Same Invention] Where two or more inventors independently have made the same invention, the right to a patent for that invention shall belong,

(i) where only one application is filed in respect of that invention, to the applicant, as long as the application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected, or

(ii) where two or more applications are filed in respect of that invention, to the applicant whose application has the earliest filing date or, where priority is claimed, the earliest priority date, as long as the said application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected.

Article 10

Fields of Technology

Alternative A

(1) Patent protection shall be available for inventions in all fields of technology which are new, which involve an inventive step and which are industrially applicable, except for:

(i) inventions whose use would be contrary to public order, law or morality or injurious to public health;

(ii) plant or animal varieties or essentially biological processes for the production of plants or animals;

(iii) discoveries and materials or substances already existing in nature;

(iv) methods of medical treatment for humans or animals;

(v) nuclear and fissionable material.

(2) Contracting States may, on grounds of public interest, national security, public health, nutrition, national development and social security, exclude from patent protection, either in respect of products or processes for the manufacture of those products, certain fields of technology, by national law.

(3) Contracting States shall notify the Director General of such exclusions by a written declaration. Any such declaration may be withdrawn at any time totally or partially by notification addressed to the Director General.

Alternative B

Patent protection shall be available for inventions, whether they concern products or processes, in all fields of technology.

Article 11

Conditions of Patentability

(1) [Patentability] In order to be patentable, an invention shall be novel, shall involve an inventive step (shall be non-obvious) and shall be, at the option of the Contracting Party, either useful or industrially applicable.

(2) [Novelty] (a) An invention shall be considered novel if it does not form part of the prior art. For the determination of novelty, items of prior art may only be taken into account individually.

(b) The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world.

[(c) Notwithstanding subparagraph (b), any Contracting Party shall be free to exclude from the prior art matter made available to the public, by oral communication, by display or through use, in a place or space which is not under its sovereignty or, in the case of an intergovernmental organization, under the sovereignty of one of its member States.]

(3) [Inventive Step (Non-Obviousness)] An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in paragraph (2), it would not have been obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date of the application claiming the invention.

Article 12

Disclosures Not Affecting Patentability (Grace Period)

(1) [Circumstances of Disclosure Not Affecting Patentability] Disclosure of information which otherwise would affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed, during the 12 months preceding the filing date or, where priority is claimed, the priority date of the application,

(i) by the inventor,

(ii) by an Office and the information was contained
(a) in another application filed by the inventor and should not have been disclosed by the Office, or
(b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information direct or indirectly from the inventor,

or

(iii) by a third party which obtained the information direct or indirectly from the inventor.

(2) ["Inventor"] For the purposes of paragraph (1), "inventor" also means any person who, at the filing date of the application, had the right to the patent.

(3) [No Time Limit for Invoking Grace Period] The effects of paragraph (1) may be invoked at any time.

(4) [Evidence] Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving, or of making the conclusion likely, that the conditions of that paragraph are fulfilled.

Article 13

Prior Art Effect of Certain Applications

(1) [Principle of "Whole Contents"] (a) Subject to subparagraph (b), the whole contents of an application ("the former application") as filed in,

or with effect for, a Contracting Party shall, for the purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party, be considered as prior art from the filing date of the former application on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent. Any Contracting Party may consider the whole contents of the former application to be prior art also for the purpose of determining whether the invention satisfies the requirement of inventive step (non-obviousness).

(b) Where the former application referred to in subparagraph (a) claims the priority of an earlier application for a patent, utility model or other title protecting an invention, matter that is contained in both the former application and such earlier application shall be considered as prior art in accordance with subparagraph (a) from the priority date of the former application.

(c) For the purposes of subparagraph (a), the "whole contents" of an application consists of the description and any drawings, as well as the claims, but not the abstract.

(2) [Applications No Longer Pending] Where the former application referred to in paragraph (1)(a) has been published in spite of the fact that, before the date of its publication, it was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected, it shall not be considered as prior art for the purposes of paragraph (1)(a).

(3) [International Applications Under the PCT] As regards international applications filed under the Patent Cooperation Treaty, any Contracting Party may provide that paragraph (1) shall apply only if the acts referred to in Article 22 or, where applicable, Article 39(1) of that Treaty have been performed.

(4) [Self-Collision] [(a)] Paragraph (1) shall not apply when the applicant of, or the inventor identified in, the former application, and the applicant of, or the inventor identified in, the application under examination, is one and the same person.

[(b) Any Contracting Party that considers the whole contents of the former application to be prior art only for the purpose of determining the novelty of the invention shall be free not to apply subparagraph (a).]

Article 14

Amendment or Correction of Application

(1) [Amendments or Corrections Following Office Findings] Wherever the Office finds that the application does not comply with any requirements applicable to it, it shall give the applicant at least one opportunity to amend or correct the application or to comply with the said requirements. Such an opportunity need not be given before the application has a filing date.

(2) [Amendments or Corrections on Applicant's Initiative] The applicant shall have the right, on his own initiative, to amend or correct the application or to comply with a requirement applicable to the application up to the time when the application is in order for grant; however, any Contracting Party which provides for substantive examination may provide that the applicant shall have the right to amend or correct, on his own initiative, the description, the claims and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

(3) [Limitation of Amendments or Corrections] No amendment or correction of the application may go beyond what has been disclosed in the application as filed.

Article 15 Publication of Application

(1) [Requirement to Publish the Application] (a) Subject to paragraphs (2) to (4), the Office shall publish the application as soon as possible after the expiration of 18 months from the filing date or, where priority is claimed, the priority date.

(b) Notwithstanding subparagraph (a), any Contracting Party that, at the time of depositing its instrument of ratification of, or accession to, this Treaty, does not provide for the publication of applications as provided in subparagraph (a) may notify the Director General at the said time that it reserves the right to publish applications as soon as possible after the expiration of 24 months, rather than 18 months, from the filing date or, where priority is claimed, the priority date.

(2) [Earlier Publication at Applicant's Request] If, before the expiration of the time limit referred to in paragraph (1), the applicant requests that the application be published, the Office shall, without delay after the receipt of the request, publish the application.

(3) [National Security] Any Contracting Party shall be free not to publish an application for reasons of national security.

(4) [Circumstances in Which Publication May Not Take Place] (a) No application may be published if it is withdrawn or abandoned or is considered withdrawn or abandoned

(i) earlier than two months before the expiration of the time limit applicable under paragraph (1) or,

(ii) where the Office completes the technical preparations for publication later than two months before the expiration of the time limit applicable under paragraph (1), prior to the completion of such preparations.

(b) No application may be published if it has been rejected.

Article 16

Time Limits for Search and Substantive Examination

(1) [Time Limits for Search] (a) If a Contracting Party provides for substantive examination, its Office shall publish, at the same time as the application is published under Article 15, a report, established by or on behalf of that Office, citing any documents that reflect the prior art relevant to the invention claimed in the application (hereinafter referred to as "the search report").

(b) Notwithstanding subparagraph (a), where Article 15(2) applies, the search report need not be published at the same time as the application, provided that it shall be published as soon as possible, but not later than the expiration of the time limit applicable under Article 15(1).

(c) If, notwithstanding subparagraphs (a) and (b), for any exceptional reason, the search report cannot be published as provided for in those subparagraphs, it shall be published as soon as possible and in no case later than six months after the expiration of the time limit applicable under Article 15(1).

(2) [Time Limits for Substantive Examination] (a) If a Contracting Party provides for substantive examination, its Office shall start the substantive examination of the application not later than three years from the filing date of the application.

(b) Notwithstanding subparagraph (a), a Contracting Party shall be free to provide that no substantive examination shall be carried out and the application shall be considered withdrawn or abandoned, or shall be rejected, if a request is not made, within three years from the filing date of the application, to its Office by the applicant or any third party that substantive examination should start. Where such a request is made, the Office shall start the substantive examination promptly after receipt of the request.

(c) The Office shall, wherever possible, reach a final decision on the application not later than two years after the start of substantive examination.

Article 17

Changes in Patents

(1) [Limitation of Extent of Protection] The owner of a patent shall have the right to request the competent Office to make changes in the patent in order to limit the extent of the protection conferred by it.

(2) [Obvious Mistakes and Clerical Errors] The owner of a patent shall have the right to request the competent Office to make changes in the patent in order to correct obvious mistakes or to correct clerical errors.

(3) [Additional Changes That May Be Allowed] Each Contracting Party may provide that the owner of a patent shall have the right to request the competent Office to make changes in the patent in order to correct mistakes or errors, other than those referred to in paragraph (2), made in good faith, provided that, where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two years from the grant of the patent and the change shall not affect the rights of any third party which has relied on the patent as published.

(4) [Changes Affecting the Disclosure] No change in the patent shall be permitted under paragraphs (1) or (3) where the change would result in the disclosure contained in the patent going beyond the disclosure contained in the application as filed.

(5) [Decision in Respect of the Request and Publication of the Changes] If, and to the extent to which, the competent Office changes the patent according to paragraphs (1), (2) or (3), it shall publish the changes.

Article 18

Administrative Revocation

(1) [Administrative Revocation] (a) Where a patent was granted after substantive examination, any person shall have the right to request the competent Office to revoke the patent, in whole or in part, at least on the ground that, because of one or several documents available to the public, the conditions of novelty or inventive step are not satisfied.

(b) The request for revocation may be presented during a period to be fixed by the Contracting Party which shall commence from the announcement in the official gazette of the grant of the patent and shall not be less than six months.

(c) No request for revocation may be based on grounds of non-compliance with formal or procedural requirements.

(d) No decision may be made by the Office departing from the request unless the person having made the request has had at least one opportunity to present his arguments on the grounds on which the Office intends to depart from the request.

(e) The Office may not revoke the patent, in whole or in part, at the request of a third party, unless the owner of the patent has had at least one opportunity to present his arguments on the grounds on which the Office intends to revoke the patent.

(2) [Prohibition of Pre-grant Opposition] (a) No Contracting Party may allow any party to oppose, before its Office, the grant of patents ("pre-grant opposition").

(b) Notwithstanding subparagraph (a), any Contracting Party which, at the time of becoming party to this Treaty, provides for the possibility of pre-grant opposition may, for a period not exceeding the expiration of the tenth calendar year after the year in which this Treaty was adopted, continue to do so and, for the same period, it shall not be obliged to apply paragraph (1).

(c) Any Contracting Party that wishes to avail itself of the faculty provided for in subparagraph (b) shall address a corresponding notification to the Director General. As long as the notification has effect, any reference in this Treaty or in the Regulations to the time when the application is in order for grant shall be replaced, with respect to that Contracting Party, by a reference to the time when the application is in order for publication for the purposes of pre-grant opposition.

Article 19
Rights Conferred by the Patent

Alternative A

Note: No article on the rights conferred by the patent.

Alternative B

(1) [Products] Where the subject matter of the patent concerns a product, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

(i) the making of the product,

(ii) the offering or the putting on the market of the product, the using of the product, or the importing or stocking of the product for such offering or putting on the market or for such use.

(2) [Processes] Where the subject matter of the patent concerns a process, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

(i) the using of the process,

(ii) in respect of any product directly resulting from the use of the process, any of the acts referred to in paragraph (1)(ii), even where a patent cannot be obtained for the said product.

(3) [Exceptions to Paragraphs (1) and (2)] (a) Notwithstanding paragraphs (1) and (2), any Contracting Party may provide that the owner of a patent has no right to prevent third parties from performing, without his authorization, the acts referred to in paragraphs (1) and (2) in the following circumstances:

(i) where the act concerns a product which has been put on the market by the owner of the patent, or with his express consent, insofar as such act is performed after that product has been so put on the market in the

territory of that Contracting Party or, where the Contracting Party is a member of a group of States constituting a regional market, in the territory of one of the member States of such group;

(ii) where the act is done privately and on a non-commercial scale or for a non-commercial purpose, provided that it does not significantly prejudice the economic interests of the owner of the patent;

(iii) where the act consists of making or using exclusively for the purpose of experiments that relate to the subject matter of the patented invention [or for the purpose of seeking regulatory approval for marketing];

(iv) where the act consists of the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(h) The provisions of paragraphs (1) and (2) shall not be interpreted as affecting the freedom that Contracting Parties have under the Paris Convention for the Protection of Industrial Property to allow, under certain circumstances, the performance of acts without the authorization of the owner of the patent.

(4) [Contributory Infringement] (a) Subject to subparagraph (b), a patent shall also confer on its owner [at least] the right to prevent a third party from supplying or offering to supply a person, other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for carrying out the invention, when the third party knows, or it is obvious in the circumstances, that those means are suitable and intended for carrying out that invention. This provision shall not apply when the means are staple commercial products and the circumstances of the supply of such products do not constitute inducement to infringe the patent.

(b) Persons performing the acts referred to in paragraph (3)(a)(ii), (iii) and (iv) shall not be considered to be parties entitled to exploit the invention within the meaning of subparagraph (a).

Alternative C

(1) [Products] Where the subject matter of the patent concerns a product, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

(i) the making of the product,

(ii) the offering for sale of the product, and the using of the product.

(2) [Processes] Where the subject matter of the patent concerns a process, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, the using of the process.

(3) [Exceptions to Paragraphs (1) and (2)] (a) Notwithstanding paragraphs (1) and (2), any Contracting State shall be free to provide that the owner of a patent has no right to prevent third parties from performing,

without his authorization, the acts referred to in paragraphs (1) and (2) in the following circumstances:

(i) where the act concerns the offer for sale or the use of a product which has been offered for sale by the owner of the patent, or with his express consent, insofar as such an act is performed after the product has been so offered for sale in the territory of that Contracting State;

(ii) where the act is done privately and on a non-commercial scale;

(iii) where the act consists of making or using for exclusively experimental, academic or scientific research purposes;

(iv) where the act consists of the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(b) The provisions of paragraphs (1) and (2) shall not be interpreted as affecting the freedom that Contracting States have under the Paris Convention for the Protection of Industrial Property, to allow, under certain circumstances, the performance of acts without the authorization of the owner of the patent.

(c) Persons performing the acts referred to in paragraph (3)(a)(ii), (iii) and (iv) shall not be considered to be parties entitled to exploit the invention within the meaning of subparagraph (a).

Article 20

Prior User

(1) [Right of Prior User]

Alternative A

Any Contracting Party may provide that, notwithstanding Article 19,

Alternative B

Notwithstanding Article 19,

a patent shall have no effect against any person (hereinafter referred to as "the prior user") who, in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using the invention or was making effective and serious preparations for such use; any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

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

Article 21

Extent of Protection and Interpretation of Claims

(1) [Determination of the Extent of Protection] (a) The extent of protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings.

(b) For the purposes of subparagraph (a), the claims shall be so interpreted as to combine fair protection for the owner of the patent with a reasonable degree of certainty for third parties. In particular, the claims shall not be interpreted as being confined to their strict literal wording. Neither shall the claims be considered as mere guidelines allowing that the protection conferred by the patent extends to what, from a consideration of the description and drawings by a person skilled in the art, the owner has contemplated, but has not claimed.

(2) [Equivalents] (a) Notwithstanding paragraph (1)(b), a claim shall be considered to cover not only all the elements as expressed in the claim but also equivalents.

(b) An element ("the equivalent element") shall generally be considered as being equivalent to an element as expressed in a claim if, at the time of any alleged infringement, either of the following conditions is fulfilled in regard to the invention as claimed:

(i) the equivalent element performs substantially the same function in substantially the same way and produces substantially the same result as the element as expressed in the claim, or

(ii) it is obvious to a person skilled in the art that the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element.

(c) Any Contracting Party shall be free to determine whether an element is equivalent to an element as expressed in a claim by reference to only the condition referred to in subparagraph (b)(i) or to only the condition referred to in subparagraph (b)(ii), provided that, at the time of depositing its instrument of ratification or accession to this Treaty, it so notifies the Director General.

(3) [Prior Statements] In determining the extent of protection, due account shall be taken of any statement limiting the scope of the claims made by the applicant or the owner of the patent during procedures concerning the grant or the validity of the patent.

(4) [Examples] If the patent contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims shall not be interpreted as limited to those examples; in particular, the mere fact that a product or process includes additional features not found in the examples disclosed in the patent, lacks features found in such examples or does not achieve every objective or possess every advantage cited or inherent in such examples shall not remove the product or process from the extent of protection conferred by the claims.

(5) [Abstract] The abstract of a patent shall not be taken into account for the purpose of determining the protection conferred by the patent.

Article 22

Term of Patents

Alternative A

Note: No article on the term of patents.

Alternative B

(1) [Minimum Duration of Protection] The term of a patent shall be at least 20 years.

(2) [Starting Date of Term] (a) The starting date of the term of a patent shall be the filing date of the application on which the patent is granted, whether or not the application claims the priority of another application.

(b) Notwithstanding subparagraph (a), where an application ("the subsequent application") invokes one or more earlier applications without claiming the priority of any of those earlier applications, the starting date of the term of the patent granted on the subsequent application shall be the filing date of the earliest-filed application invoked in the subsequent application.

Article 23

Enforcement of Rights

(1) [Enforcement Based on Patents] The owner of the patent shall have at least the right

(i) to obtain an injunction to restrain the performance or the likely performance, by any person without his authorization, of any of the acts referred to in Article 19(1), (2) and (4);

(ii) to obtain damages, adequate under the circumstances, from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4), where the said person was or should have been aware of the patent.

(2) [Enforcement Based on Published Applications] (a) The applicant shall at least have the right to obtain reasonable compensation from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4) in relation to any invention, claimed in the published application, as if a patent had been granted for that invention, provided that the said person, at the time of the performance of the act, had

(i) actual knowledge that the invention that he was using was the subject matter of a published application, or

(ii) received written notice that the invention that he was using was the subject matter of a published application, such application being identified in the said notice by its serial number.

(b) Any Contracting Party may provide that, with respect to the compensation referred to in subparagraph (a), an action may not be initiated or a decision may not be made until after the grant of a patent on the published application, provided that, if an action may be initiated only after the grant of the patent, the owner of the patent shall have reasonable time to initiate such action.

(c) For the purposes of subparagraphs (a) and (b), the extent of the protection shall be determined by the claims as appearing in the published application. However, if the claims are amended after the initial publication of the application, the extent of the protection shall be determined by the amended claims in respect of the period following their publication. Furthermore, if the claims of the patent as granted or as changed after its grant have a narrower scope than the claims in the application, the extent of the protection shall be determined by the claims with the narrower scope.

Article 24

Reversal of Burden of Proof

Alternative A

Note: No article on the reversal of the burden of proof.

Alternative B

(1) [Conditions for the Reversal of the Burden of Proof] (a) For the purposes of proceedings, other than criminal proceedings, in respect of the violation of the rights of the owner of the patent referred to in Article 19(2), where the subject matter of the patent is a process for obtaining a product, the burden of establishing that a product was not made by the process shall be on the alleged infringer if either of the following conditions is fulfilled:

(i) the product is new, or

(ii) a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

(b) Any Contracting Party shall be free to provide that the burden of proof indicated in subparagraph (a) shall be on the alleged infringer only if the condition referred to in subparagraph (a)(i) is fulfilled or only if the condition referred to in subparagraph (a)(ii) is fulfilled, provided that, at the time of depositing its instrument of ratification of or accession to this Treaty, it so notifies the Director General.

(2) [Manufacturing and Business Secrets] In requiring the production of evidence, the authority before which the proceedings referred to in paragraph (1) take place shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

Article 25

Obligations of the Right Holder

Alternative A

Note: No article on obligations of the right holder.

Alternative B

(1) The owner of a patent shall have at least the following obligations in addition to any other provided for in this Treaty:

(i) to disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art; the description shall set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, priority date of the application;

(ii) to provide such information and supporting documents in his possession as is requested by the competent Office concerning corresponding foreign applications and grants;

(iii) to work the patented invention in the territory of the Contracting State for which it is granted within the time limits as provided by national law;

(iv) to pay, or cause to be paid, such fees as prescribed by national law in relation to the application and the maintenance of the patent granted on it;

(v) in respect of license contracts and contracts assigning patents, to refrain from engaging in abusive, restrictive or anticompetitive practices adversely affecting the transfer of technology.

(2) The applicant or holder of a patent shall comply with any other obligations established in the national law of the State in which the patent was granted in connection with the acquisition and the exercise of the rights conferred by the patent and with the exploitation of the patented invention.

Article 26Remedial Measures Under National LegislationAlternative A

Note: No article on remedial measures under national legislation.

Alternative B

(1) Any Contracting State is free to provide appropriate measures to ensure compliance with the obligations referred to in the Article entitled "Obligations of the Right Holder," and for measures to remedy non-compliance with such obligations, including the grant of non-voluntary licenses and the revocation or forfeiture of the patent.

(2) A non-voluntary license under paragraph (1) shall be refused if the owner of the patent proves, to the satisfaction of the national authorities competent to grant non-voluntary licenses, that there are circumstances which justify the non-working or insufficient working of the patented invention.

(3) Any Contracting State is free to provide, at any time, on grounds of public interest, national security, nutrition, health, or the development of other vital sectors of national economy, for the grant of non-voluntary licenses or for the exploitation of the patented invention by the government of that country or by third persons authorized by it.

Article 27Assembly

(1) [Composition] (a) The Union shall have an Assembly consisting of the Contracting Parties.

(b) Each Contracting Party shall be represented by one delegate, who may be assisted by alternate delegates, advisors and experts.

(c) The Union shall not bear the expenses of the participation of any delegation in any session of the Assembly.

(2) [Tasks] (a) The Assembly shall:

(i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Treaty;

(ii) modify, where it considers it desirable, any time limit provided for in Articles 3 to 26 of this Treaty and make any consequential amendments necessitated by any such modification; the adoption of any such modification shall require unanimous consent;

(iii) adopt, where it considers it desirable, guidelines for the implementation of provisions of this Treaty or the Regulations under this Treaty;

(iv) exercise such rights and perform such tasks as are specifically conferred upon it or assigned to it under this Treaty;

(v) give directions to the Director General concerning the preparations for any conference referred to in Article 31 or Article 32 and decide the convocation of any such conference;

(vi) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;

(vii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;

(viii) determine which States and intergovernmental organizations, other than Contracting Parties, and which non-governmental organizations shall be admitted to its meetings as observers;

(ix) take any other appropriate action designed to further the objectives of the Union and perform such other functions as are appropriate under this Treaty.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) [Representation] A delegate may represent one Contracting Party only.

(4) [Voting] (a) Subject to subparagraph (e), each Contracting Party that is a State shall have one vote and shall vote only in its own name.

(b) Any intergovernmental organization referred to in Article 33(1)(ii) that is a Contracting Party may exercise the right to vote of its member States that are Contracting Parties, [whether] present [or absent] at the time of voting. The intergovernmental organization may not, in a given vote, exercise the right to vote if any of its member States participates in the vote or expressly abstains.

(c) Provided that all its member States that are Contracting Parties have notified the Director General that their right to vote may be exercised by it, any intergovernmental organization referred to in Article 33(1)(iii) that is a Contracting Party may so exercise the right to vote of its member States that are Contracting Parties, [whether] present [or absent] at the time of voting. The intergovernmental organization may not, in a given vote, exercise the right to vote of any of its member States if any of them participates in the vote or expressly abstains.

(d) The right to vote of a State that is a Contracting Party may not, in a given vote, be exercised by more than one intergovernmental organization.

(e) No Contracting Party shall have the right to vote on questions concerning matters in respect of which it has made a declaration under Article 35.

(5) [Quorum] (a) One-half of the Contracting Parties that have the right to vote shall constitute a quorum, provided that, for the purposes of determining whether there is a quorum in respect of any question concerning any matter on which a declaration under Article 35 has been made, any Contracting Party not having the right to vote on that question shall not be counted.

(b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence.

(6) [Majorities] (a) Subject to paragraphs (2)(a)(ii) and (9)(b) of this Article and to Articles 29(2) and (3) and 30(4), the decisions of the Assembly shall require a majority of the votes cast.

(b) Abstentions shall not be considered as votes.

(7) [Sessions] (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, either at the request of one-fourth of the Contracting Parties or on the Director General's own initiative.

(8) [Rules of Procedure] The Assembly shall adopt its own rules of procedure.

(9) [Guidelines] (a) In the case of conflict between the guidelines referred to in paragraph (2)(a)(iii) and the provisions of this Treaty or the Regulations under this Treaty, the latter shall prevail.

(b) The adoption by the Assembly of the said guidelines shall require three-fourths of the votes cast.

Article 28

International Bureau

(1) [Tasks] The International Bureau of the Organization shall:

(i) perform the administrative tasks concerning the Union, as well as any tasks specifically assigned to it by the Assembly;

(ii) provide the secretariat of the conferences referred to in Articles 31 and 32, of the Assembly, of the committees and working groups

established by the Assembly, and of any other meeting convened by the Director General under the aegis of the Union.

(2) [Director General] The Director General shall be the chief executive of the Union and shall represent the Union.

(3) [Meetings Other than Sessions of the Assembly] The Director General shall convene any committee and working group established by the Assembly and all other meetings dealing with matters of concern to the Union.

(4) [Role of the International Bureau in the Assembly and Other Meetings] (a) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meetings convened by the Director General under the aegis of the Union.

(b) The Director General or a staff member designated by him shall be ex officio secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).

(5) [Conferences] (a) The Director General shall, in accordance with the directions of the Assembly, make the preparations for any conference referred to in Article 31 or Article 32.

(b) The Director General may consult with intergovernmental and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and staff members designated by him shall take part, without the right to vote, in the discussions at any conference referred to in subparagraph (a).

(d) The Director General or a staff member designated by him shall be ex officio secretary of any conference referred to in subparagraph (a).

Article 29

Regulations

(1) [Content] The Regulations annexed to this Treaty provide rules concerning

(i) matters which this Treaty expressly provides are to be "prescribed";

(ii) any details useful in the implementation of the provisions of this Treaty;

(iii) any administrative requirements, matters or procedures.

(2) [Amending the Regulations] (a) The Assembly may amend the Regulations and shall determine the conditions for the entry into force of each amendment.

(b) Subject to the provisions of paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.

(3) [Requirement of Unanimity] (a) The Regulations may specify rules which may be amended only by unanimous consent.

(b) Exclusion, for the future, of any rules designated as requiring unanimous consent for amendment from such requirement shall require unanimous consent.

(c) Inclusion, for the future, of the requirement of unanimous consent for the amendment of any rule shall require unanimous consent.

(4) [Conflict Between the Treaty and the Regulations] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 30

Settlement of Disputes

(1) [Consultations] (a) Where any dispute arises concerning the interpretation or implementation of this Treaty, a Contracting Party may bring the matter to the attention of another Contracting Party and request the latter to enter into consultations with it.

(b) The Contracting Party so requested shall provide, within the prescribed time limit, an adequate opportunity for the requested consultations.

(c) The Contracting Parties engaged in consultations shall attempt to reach, within a reasonable period of time, a mutually satisfactory solution of the dispute.

(2) [Other Means of Settlement] If a mutually satisfactory solution is not reached within a reasonable period of time through the consultations referred to in paragraph (1), the parties to the dispute may agree to resort to other means designed to lead to an amicable settlement of their dispute, such as good offices, conciliation, mediation and arbitration.

(3) [Panel] (a) The Assembly shall adopt rules for the establishment of a body of experts, any candidate having to be presented by a Contracting Party. It shall adopt rules concerning the manner of selecting the members of each panel, each panel having three members, none of which shall, unless the parties to the dispute agree otherwise, be from either party to the dispute. The Assembly shall also adopt rules for the conduct of the panel proceedings, including provisions to safeguard the confidentiality of the proceedings and of any material designated as confidential by any participant in the proceedings. Each panel shall give full opportunity to the parties to the dispute and any other interested Contracting Parties to present to it their views.

(b) If the dispute is not satisfactorily settled through the consultations referred to in paragraph (1), or if the means referred to in paragraph (2) are not resorted to, or do not lead to an amicable settlement within a reasonable period of time, the Director General, at the written request of either of the parties to the dispute, shall appoint members of a panel to examine the matter.

(c) The terms of reference of the panel shall be agreed upon by the parties to the dispute. However, if such agreement is not achieved within the prescribed time limit, the Director General shall set the terms of reference of the panel after having consulted the parties to the dispute and the members of the panel.

(d) If both parties to the dispute so request, the panel shall stop its proceedings.

(e) Unless the parties to the dispute reach an agreement between themselves prior to the panel's concluding its proceedings, the panel shall promptly prepare the draft of a written report containing a statement of the facts of the case and containing recommendations for the resolution of the dispute and provide it to the parties to the dispute for their review. The parties to the dispute shall have a reasonable period of time, the length of which shall be fixed by the panel, to submit any comments on the report to the panel, unless they agree to a longer time in their attempts to reach a mutually satisfactory resolution to their dispute.

(f) The panel shall take into account the comments and shall promptly transmit its final report to the Assembly, which report shall be accompanied by the written comments, if any, of the parties to the dispute.

(4) [Recommendation by the Assembly] The Assembly shall give the report of the panel prompt consideration. The Assembly shall make recommendations to the parties to the dispute, based upon its interpretation of this Treaty and the report of the panel. Any recommendation by the Assembly shall require consensus among the members of the Assembly other than the parties to the dispute.

Article 31

Revision of the Treaty

This Treaty may be revised by a conference of the Contracting Parties.

Article 32

Protocols

For the purposes of further developing the harmonization of patent law, protocols may be adopted by a conference of the Contracting Parties, provided that the provisions of any such protocol shall not contravene the provisions

of this Treaty. Only Contracting Parties may become party to any such protocol.

Article 33

Becoming Party to the Treaty

(1) [Eligibility] The following may become party to this Treaty:

(i) any State which is a party to the Paris Convention for the Protection of Industrial Property and in respect of which patents may be obtained either through the State's own Office or through the Office of another Contracting Party;

(ii) any intergovernmental organization which is competent in matters governed by this Treaty and which has established, on such matters, norms that are binding on all its member States, provided that all those States are party to the Paris Convention for the Protection of Industrial Property;

(iii) any intergovernmental organization which maintains an Office granting patents with effect in more than one State, provided that all of its member States are party to the Paris Convention for the Protection of Industrial Property.

(2) [Signature; Deposit of Instrument] To become party to this Treaty, the State or the intergovernmental organization shall:

(i) sign this Treaty and deposit an instrument of ratification, or

(ii) deposit an instrument of accession.

(3) [Condition as to Effect of Instrument] (a) Any instrument of ratification or accession (hereinafter referred to as "instrument") may be accompanied by a declaration making it a condition to its being considered as deposited that the instrument of one State or one intergovernmental organization, or the instruments of two States, or the instruments of one State and one intergovernmental organization, specified by name and eligible to become party to this Treaty according to paragraph (1)(i) or (iii), is or are also deposited. The instrument containing such a declaration shall be considered to have been deposited on the day on which the condition indicated in the declaration is fulfilled. However, when the deposit of an instrument specified in the declaration is, itself, accompanied by a declaration of the said kind, that instrument shall be considered as deposited on the day on which the condition specified in the latter declaration is fulfilled.

(b) Any declaration made under paragraph (a) may be withdrawn, in its entirety or in part, at any time. Any such withdrawal shall become effective on the date on which the notification of withdrawal is received by the Director General.

Article 34

Entry Into Force of the Treaty

(1) [Entry Into Force] This Treaty shall enter into force three months after eight States or intergovernmental organizations have deposited their instruments of ratification or accession (hereinafter referred to as "instrument").

(2) [Entities Not Covered by the Entry Into Force] Any State or intergovernmental organization not covered by paragraph (1) shall become bound by this Treaty three months after the date on which it has deposited its instrument, unless a later date has been indicated in the instrument. In the latter case, the said State or intergovernmental organization shall become bound by this Treaty on the date thus indicated.

Article 35

Reservations

Alternative A

Note: No article on reservations.

Alternative B

(1) [Possibility of Making Reservations] (a) Any instrument of ratification of, or accession to, this Treaty that is deposited not later than the end of the eighth calendar year after the year in which this Treaty has been adopted may be accompanied by a declaration making reservations to this Treaty as provided for in paragraphs (2) to (5).

(b) No reservations to this Treaty other than the reservations allowed under paragraphs (2) to (5) are permitted.

(2) [Fields of Technology] (a) Any State or intergovernmental organization may declare that, notwithstanding the provisions of Article 10, patents will not be granted by the competent Office in the fields of technology specified in its declaration, provided that such a declaration may only specify those fields of technology which, at the time of making the declaration, are fields for which that State or intergovernmental organization provides for the exclusion of the grant of patents.

(b) Any declaration made under subparagraph (a) by a developing country or by an intergovernmental organization all the members of which are developing countries shall lose its effect at the end of the fifteenth calendar year after the year in which this Treaty has been adopted. Any declaration made under subparagraph (a) by any other State or intergovernmental organization shall lose its effect at the end of the tenth calendar year after the year in which this Treaty has been adopted.

(3) [Certain Rights Conferred by Process Patents] (a) Any State which is a developing country or any intergovernmental organization all the members of which are developing countries and which, at the time of making the declaration, does not provide for the right referred to in Article 19(2)(ii) may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted.

(4) [Term of Patent] (a) Any State or intergovernmental organization which, at the time of making the declaration, provides that the protection conferred by a patent shall end before the expiration of the 20-year period referred to in Article 22(1) may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) by a developing country or by an intergovernmental organization all the members of which are developing countries shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted. Any declaration made under subparagraph (a) by any other State or intergovernmental organization shall lose its effect at the end of the tenth calendar year after the year in which the Treaty has been adopted.

(5) [Reversal of Burden of Proof] (a) Any State which is a developing country or any intergovernmental organization all the members of which are developing countries and which, at the time of making the declaration, does not provide for the reversal of the burden of proof referred to in Article 24 may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted.

Article 36

Special Notifications

(1) [States] (a) Any State in respect of which patents may be obtained only through the Office of another Contracting Party shall notify this fact and shall identify such Contracting Party.

(b) Any change in the fact notified by a State under subparagraph (a) shall be promptly notified by such State.

(2) [Intergovernmental Organizations Referred to in Article 33(1)(ii)] (a) Any intergovernmental organization referred to in Article 33(1)(ii) shall notify the list of its member States and, if its norms deal with only some of the matters covered by Articles 3 to 26, shall notify this fact and shall, among the provisions of the said Articles, identify those provisions with which its norms deal. The other provisions of the said Articles shall not bind the intergovernmental organization.

(b) If the norms of the intergovernmental organization referred to in subparagraph (a) later deal with any matter covered by Articles 3 to 26 concerning which the intergovernmental organization has not made a notification under subparagraph (a), the intergovernmental organization shall be bound by the corresponding provisions of this Treaty and shall promptly notify the relevant changes in its norms.

(3) [Intergovernmental Organizations Referred to in Article 33(1)(iii)]

(a) Any intergovernmental organization referred to in Article 33(1)(iii) shall notify the list of its member States and, if its norms do not deal with any of the matters covered by Articles 19 to 26, shall notify this fact and shall, among the provisions of the said Articles, identify those provisions with which its norms do not deal. The latter provisions shall not bind the intergovernmental organization.

(b) If the norms of the intergovernmental organization referred to in subparagraph (a) later deal with any matter concerning which the intergovernmental organization has made a notification under subparagraph (a), the intergovernmental organization shall be bound by the corresponding provisions of this Treaty and shall promptly notify the relevant changes in its norms.

(4) [Time of Notification] (a) Any notification under paragraphs (1)(a), (2)(a) or (3)(a) shall accompany the instrument of ratification or accession.

(b) Any change under paragraphs (1)(b), (2)(h) or (3)(b) shall be notified promptly in a declaration deposited with the Director General.

Article 37

Denunciation of the Treaty

(1) [Notification] Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) [Effective Date] Denunciation shall take effect one year from the date on which the Director General has received the notification. It shall not affect the application of this Treaty to any application pending or any patent in force in respect of the denouncing Contracting Party at the time of the expiration of the said one-year period.

Article 38

Languages of the Treaty; Signature

(1) [Original Texts; Official Texts] (a) This Treaty shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) [Time Limit for Signature] This Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 39

Depositary

The Director General shall be the depositary of this Treaty.

DRAFT REGULATIONS
UNDER THE TREATY SUPPLEMENTING THE PARIS CONVENTION FOR THE
PROTECTION OF INDUSTRIAL PROPERTY AS FAR AS PATENTS ARE CONCERNED
(PATENT LAW TREATY)

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- Rule 1: Definitions (ad Article 2)
- Rule 2: Contents and Order of Description (ad Article 3(2))
- Rule 3: Manner of Claiming (ad Article 4(5))
- Rule 4: Details Concerning the Requirement of
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- Rule 6: Manner of Identification and Mention of
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- Rule 7: Details Concerning the Filing Date Requirements
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- Rule 12: Requirement of Unanimity for Amending
Certain Rules (ad Article 29(3))
- Rule 13: Settlement of Disputes (ad Article 30)

Rule 1

Definitions
(ad Article 2)

(1) ["Treaty"; "Article"] (a) In these Regulations, the word "Treaty" means the Treaty Supplementing the Paris Convention for the Protection of Industrial Property as far as Patents Are Concerned (Patent Law Treaty).

(b) In these Regulations, the word "Article" refers to the specified Article of the Treaty.

(2) [Expressions Defined in the Treaty] The expressions defined in Article 2 for the purposes of the Treaty shall have the same meaning for the purposes of these Regulations.

(3) [Means of Publication] For the purposes of Article 2(viii), an application, a search report, a patent or any change in a patent shall be deemed to be "made accessible to the public" if any person so wishing, against payment or free of charge, can

(i) obtain from the Office paper copies of the application, the search report, the patent or the document reflecting the change,

(ii) inspect, at the Office, the application, the search report, the patent or the document reflecting the change and, on request, obtain from the Office paper copies thereof, or

(iii) take cognizance, by means of electronic communication, of the application, the search report, the patent or the change and make, if he so wishes, paper copies thereof.

Rule 2

Contents and Order of Description
(ad Article 3(2))

(1) [Contents of Description] The description shall, after stating the title of the invention,

(i) specify the technical field or fields to which the invention relates;

(ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such background art;

(iii) describe the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

(iv) where a deposit of biologically reproducible material is required under Article 3(1)(b), indicate the fact that the deposit has been made and identify at least the name and address of the depositary institution, the date of the deposit and the accession number given to the deposit by that institution, as well as describe, to the extent possible, the nature and the characteristics of such material, relevant to the requirement of disclosure of the invention;

(v) briefly describe the figures in the drawings, if any;

(vi) set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, priority date of the application;

(vii) indicate explicitly, when it is not otherwise obvious from the description or nature of the invention, the way or ways in which the invention satisfies the requirement of being useful or industrially applicable.

Alternative A

(2) [Manner and Order of Presentation of Contents] (a) The contents of the description shall be presented in the order specified in paragraph (1), unless, because of the nature of the invention, a different order would afford a better understanding or a more economical presentation.

(h) Any Contracting Party may accept a description which does not contain the matters specified in paragraph (1)(i), (ii) and (v), or which contains, in lieu of the matter specified in paragraph (1)(iii), a description of the invention in any terms that satisfy the requirement of a disclosure of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(3) [Nucleotides and Amino Acid Sequences] Any Contracting Party may, where the application contains disclosure of a nucleotide or amino acid sequence, provide for special requirements concerning the place, mode and format of such disclosure.

Alternative B

(2) [Manner and Order of Presentation of Contents] The contents of the description shall be presented in the manner and order specified in paragraph (1), unless, because of the nature of the invention, a different manner or a different order would afford a better understanding or a more economical presentation.

Rule 3

Manner of Claiming
(ad Article 4(5))

- (1) [Consecutive Numbering] Where the application contains several claims, they shall be numbered consecutively in arabic numerals.
- (2) [Method of Definition of Invention] The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.
- (3) [Form of Claim] Claims shall be written either
- (i) in two parts, the first part consisting of a statement indicating those technical features of the invention which are necessary in connection with the definition of the claimed subject matter and which, in combination, appear to be part of the prior art, the second part ("the characterizing portion"), introduced by the words "characterized in that," "characterized by," "wherein the improvement comprises," or other words to the same effect, consisting of a statement indicating those technical features which, in combination with the features stated in the first part, define the matter for which protection is sought; or
 - (ii) in a single statement containing a recitation of a combination of several elements or steps, or a single element or step, which defines the matter for which protection is sought.
- (4) [References in the Claims to the Description and Drawings] (a) No claim may contain, in respect of the technical features of the invention, a reference to the description or any drawings, for example, such references as: "as described in part ... of the description," or "as illustrated in figure ... of the drawings," unless such a reference is necessary for the understanding of the claim or enhances the clarity or the conciseness of the claim.
- (h) No claim may contain any drawing or graph. Any claim may contain tables and chemical or mathematical formulas.
- (c) Where the application contains a drawing, the mention of any technical feature in a claim may, if the intelligibility of that claim can thereby be enhanced, include a reference sign to that drawing or to the applicable part of that drawing; such a reference sign shall be placed between square brackets or parentheses; it shall not be construed as limiting the claim.
- (5) [Dependent and Multiple Dependent Claims] (a) Any claim which includes all the features of another claim of the same category or several other claims of the same category (hereinafter referred to as "dependent claim" and "multiple dependent claim," respectively) shall, preferably in the beginning, refer to the other claim or the other claims, as the case may be, by indicating the number of the other claim or the numbers of the other claims and shall then state those features claimed that are additional to the features claimed in the other claim or the other claims.

(b) A dependent claim may depend on another dependent claim or on a multiple dependent claim. A multiple dependent claim may depend on a dependent claim or another multiple dependent claim. Multiple dependent claims may refer in the alternative or in the cumulative to the claims on which they depend.

(c) All dependent claims referring back to the same claim, and all multiple dependent claims referring back to the same claims, shall be grouped together in the most practical way possible.

Rule 4

Details Concerning the Requirement of Unity of Invention (ad Article 5(1))

(1) [Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled] Where a group of inventions is claimed, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of those inventions, considered as a whole, makes over the prior art.

(2) [Determination of Unity of Invention Not Affected by Manner of Claiming] The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Rule 5

Divisional Applications (ad Article 5(1))

(1) [Time Limit] (a) The applicant may file one or more divisional applications at any time up to at least the time when the initial application is in order for grant.

(b) Notwithstanding subparagraph (a), any Contracting Party which establishes a time limit for compliance by the applicant with all requirements for the grant of a patent may provide that no divisional application may be filed during the six months preceding the expiration of that time limit.

(2) [Priority Documents] Priority documents and any translations thereof that are submitted to the Office in respect of the initial application shall be considered as having been submitted also in respect of the divisional application or applications.

Rule 6

Manner of Identification and Mention of Inventor (ad Article 6)

(1) [Manner of Identification and Mention] (a) The identification of the inventor referred to in Article 6(1)(a) shall consist of the indication of the inventor's name and address.

(b) The mention of the inventor referred to in Article 6(2) shall consist of at least the indication of the inventor's name.

(2) [Procedure in Case of Non-Compliance with Requirements] (a) If the application and the documents accompanying it do not comply with the requirements provided for under Article 6(1)(a) and, where applicable, Article 6(3), the Office shall invite the applicant to comply with the said requirements within a reasonable time limit.

(b) The application may not be rejected for failure to comply with the said requirements where such an invitation has not been extended to the applicant.

(3) [Corrections] The applicant may correct, at any time, the identification of the inventor given in accordance with Article 6(1)(a). Any Contracting Party may require the consent of any previously designated inventor before accepting such a correction.

Rule 7

Details Concerning the Filing Date Requirements (ad Article 8)

(1) [Time Limits] (a) The time limit referred to in Article 8(2)(a) shall be at least two months from the date on which the elements referred to in Article 8(1) have been received by the Office.

(b) The time limit referred to in Article 8(4) shall be at least two months from the date on which the application containing the reference to the previously filed application has been received by the Office.

(c) The time limit referred to in Article 8(5)(b) shall be at least two months from the date on which the item requiring translation has been received by the Office.

(2) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with any of the requirements of Article 8(1) or the applicable requirements, if any, of Article 8(2)(a), Article 8(4) or Article 8(5)(b) that the application must satisfy either on receipt or within a prescribed time limit thereafter, the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which time limit shall be at

least one month from the date of the invitation or, where the non-compliance relates to a matter for which a time limit for compliance is established by paragraph (1), the time limit referred to in paragraph (1), whichever expires later. Compliance with the invitation may be subject to the payment of a special fee. Failure to send an invitation shall not alter the said requirements.

(3) [Filing Date in Case of Correction] If, within the time limit fixed in the invitation, the applicant complies with the invitation referred to in paragraph (2) and pays the required special fee, if any, the filing date shall be the date on which the elements referred to in Article 8(1) have been received by the Office. Otherwise, the application shall be treated as if it had not been filed.

(4) [Date of Receipt] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document by a branch or sub-office of an Office, by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, or by an official postal service, shall be deemed to constitute receipt of the document by the Office concerned.

(5) [Correction of Translations] Any translation of the parts of the application, or of the text matter, referred to in Article 8(5)(b) and (c) may be corrected at any time up to the time when the application is in order for grant in order to conform to the wording of those parts or that text matter furnished in a language other than the official language.

Rule 8

Announcement in the Gazette of the Publication of an Application (ad Article 15(1))

The publication of an application shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the applicant,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) if available, the symbols of the International Patent Classification.

Rule 9

Announcement in the Gazette of the
Publication of a Change in a Patent
(ad Article 17(5))

The publication of a change in a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the serial number of the patent,
- (iii) the date of the change,
- (iv) the nature of the change.

Rule 10

Announcement in the Gazette of the
Grant of a Patent
(ad Article 18(1)(b))

The grant of a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) the serial number of the patent,
- (vi) if available, the symbols of the International Patent Classification.

Rule 11

Absence of Quorum in the Assembly
(ad Article 27)

In the case provided for in Article 27(5)(b), the International Bureau shall communicate the decisions of the Assembly (other than those concerning the Assembly's own procedure) to the Contracting Parties having the right to

vote which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of that period, the number of Contracting Parties having thus expressed their vote or abstentions attains the number of Contracting Parties which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

Rule 12

Requirement of Unanimity for Amending Certain Rules
(ad Article 29(3))

Amendment of Rule 2(1)(vi) or Rule 3(3) of these Regulations shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.

Rule 13

Settlement of Disputes
(ad Article 30)

(1) [Time Limit for Consultations] The time limit referred to in Article 30(1)(b) shall be two months from the date of the request to enter into consultations.

(2) [Time Limit for Reaching Agreement on the Terms of Reference of the Panel] The time limit referred to in Article 30(3)(c) shall be three months from the date on which the Director General appointed the members of the panel.

[End]

CONFERENCE DOCUMENTS

CONFERENCE DOCUMENTS "PLT/DC" AND "PLT/DC/INF" SERIES

Document Number	Source	Subject
PLT/DC/1	The Preparatory Meeting for the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned	Draft Agenda of the Diplomatic Conference
PLT/DC/2	The Preparatory Meeting for the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned	Draft Rules of Procedure
PLT/DC/3	The Director General of WIPO	The "Basic Proposal" for the Treaty and the Regulations
PLT/DC/4	The Director General of WIPO	Notes on the Basic Proposal for the Treaty and Regulations
PLT/DC/5	The International Bureau	History of the Preparations of the Patent Law Treaty
PLT/DC/5 Corr.	The International Bureau	Corrigendum to document PLT/DC/5
PLT/DC/6	The United States of America	Draft Articles 9, 11 and 13
PLT/DC/7	The Delegation of Norway	Draft Article 15(4)
PLT/DC/8	The Delegation of Norway	Draft Article 16
PLT/DC/9	The Delegation of Switzerland	Draft Article 20
PLT/DC/10 Rev.	The Delegation of Ireland	Draft Article 8 and Rule 7
PLT/DC/11	The Delegation of Sweden	Draft Article 13(1)(a)
PLT/DC/12	The Delegation of The Netherlands	Draft Article 1

Document Number	Source	Subject
PLT/DC/13	The Delegation of The Netherlands	Draft Article 2(ii)(h)
PLT/DC/14	The Delegation of The Netherlands	Draft Article 19(3)
PLT/DC/15	The Delegation of The Netherlands	Draft Article 23(1)(ii)
PLT/DC/16	The Delegation of The Netherlands	Draft Rule 7(4)
PLT/DC/17	The Delegation of Japan	Draft Article 6
PLT/DC/18	The Delegation of Japan	Draft Article 8
PLT/DC/19	The Delegation of Japan	Draft Article 13(1)
PLT/DC/20	The Delegation of Japan	Draft Article 15(1)
PLT/DC/21	The Delegation of Japan	Draft Article 16
PLT/DC/22	The Delegation of Japan	Draft Article 17
PLT/DC/23	The Delegation of Japan	Draft Article 19
PLT/DC/24 Rev.	The Delegation of Japan	Draft Article 21
PLT/DC/25	The Delegation of Japan	Draft Article 22
PLT/DC/26	The Delegation of Japan	Draft Article 24
PLT/DC/27	The Delegation of Japan	Draft Rule 2
PLT/DC/28	The Delegation of Japan	Draft Rule 3
PLT/DC/29	The Delegation of Israel	Draft Article 2(ix)
PLT/DC/30	The Delegation of Israel	Draft Article 3(2)(b)
PLT/DC/31	The Delegation of Israel	Draft Article 4(3)
PLT/DC/32	The Delegation of Israel	Draft Article 5
PLT/DC/33	The Delegation of the United Kingdom	Draft Article 4(3)
PLT/DC/34	The Delegation of the United Kingdom	Draft Rule 3(2)

Document Number	Source	Subject
PLT/DC/35	The Delegation of the United Kingdom	Draft Article 9(1)
PLT/DC/36	The Delegation of Germany	Draft Article 16
PLT/DC/37	The Delegation of Germany	Draft Article 19
PLT/DC/38	The Delegation of Germany	Draft Article 24
PLT/DC/39	The Delegation of Germany	Draft Rule 2
PLT/DC/40 Rev.	The Delegation of the United States of America	Draft Article <u>9bis</u>
PLT/DC/41	The Delegation of the United States of America	Draft Article 11
PLT/DC/42	The Delegation of Israel	Draft Article 7
PLT/DC/43	The Delegation of Israel	Draft Article 9
PLT/DC/44	The Delegation of Lebanon	Preamble
PLT/DC/45	The Delegation of Lebanon	Draft Article 3(1)(a)
PLT/DC/46	The Delegation of Lebanon	Draft Article 7
PLT/DC/47	The Delegation of Lebanon	Draft Article 8
PLT/DC/48	The Delegation of Lebanon	Draft Article 9
PLT/DC/49	The Delegation of Lebanon	Draft Article 10
PLT/DC/50	The Delegation of the United States of America	Draft Article 11(2)
PLT/DC/51	The Delegation of the United States of America	Draft Article 13
PLT/DC/52	The Delegation of the United States of America	Draft Article 15(4)
PLT/DC/53	The Delegation of the United States of America	Draft Article 16(2)
PLT/DC/54	The Delegation of the United States of America	Draft Article 17(1)
PLT/DC/55	The Plenary of the Diplomatic Conference	Rules of Procedure (as adopted on June 3, 1991, and amended on June 6, 1991)

Document Number	Source	Subject
PLT/DC/56	The Delegation of Switzerland	Draft Article 8 and Rule 7
PLT/DC/57	The Delegation of the United Kingdom	Draft Rule 2(2)
PLT/DC/58	The Delegation of Germany	Draft Article 3(1)
PLT/DC/59	The Delegation of the United States of America	Draft Article 18(1)
PLT/DC/60	The Delegation of the United States of America	Draft Article 20(1)
PLT/DC/61	The Delegation of the United States of America	Draft Article 21(3)
PLT/DC/62	The Delegation of the United States of America	Draft Article 23
PLT/DC/63	The Delegation of France	Draft Article 21
PLT/DC/64	The Delegation of Canada	Draft Article 21(2)
PLT/DC/65	The Delegation of Israel	Draft Article 14
PLT/DC/66	The Secretariat of the Conference	First Report of the Credentials Committee
PLT/DC/67	The Delegation of Germany	Draft Article 23(2)
PLT/DC/68	The Delegation of Bangladesh	Draft Article 23(1)
PLT/DC/INF/1	The Secretariat of the Conference	List of Participants in the First Part of the Diplomatic Conference
PLT/DC/INF/2	The Secretariat of the Conference	Officers and Committees
PLT/DC/INF/3	The International Bureau	List of Proposals for Amendment of Provisions of the Basic Proposal, Published Before and During the First Part of the Diplomatic Conference
PLT/DC/INF/4	The Secretariat of the Conference	List of Documents Issued Before and During the First Part of the Diplomatic Conference

[End]

PLT/DC/1

November 26, 1990 (Original: English)

Source: THE PREPARATORY MEETING FOR THE DIPLOMATIC CONFERENCE FOR THE
CONCLUSION OF A TREATY SUPPLEMENTING THE PARIS CONVENTION AS FAR AS
PATENTS ARE CONCERNED

Draft Agenda of the Diplomatic Conference

1. Opening of the Conference by the Director General of WIPO
2. Consideration and adoption of the Rules of Procedure
3. Election of the President of the Conference
4. Election of the Vice-Presidents of the Conference
5. Consideration and adoption of the agenda
6. Election of the members of the Credentials Committee
7. Election of the members of the Drafting Committee
8. Consideration of the first report of the Credentials Committee
9. Opening declarations by Delegations
10. Consideration of the texts proposed by the Main Committees
11. Consideration of the second report of the Credentials Committee
12. Adoption of the Treaty and the Regulations
13. Adoption of any recommendation, resolution, agreed statement or final act
14. Closing declarations by Delegations
15. Closing of the Conference by the President*

* Immediately after the closing of the Conference, the Final Act, if any, and the Treaty will be open for signature.

[End]

PLT/DC/2

November 26, 1990 (Original: English)

Source: THE PREPARATORY MEETING FOR THE DIPLOMATIC CONFERENCE FOR THE
CONCLUSION OF A TREATY SUPPLEMENTING THE PARIS CONVENTION AS FAR AS
PATENTS ARE CONCERNED

Draft Rules of Procedure*

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* These draft Rules of Procedure will apply as provisional Rules of Procedure until the Diplomatic Conference adopts its Rules of Procedure under the relevant item of the agenda. According to Rule 34(1), such adoption requires a majority of two-thirds.

[PLT/DC/2, continued]

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[PLT/DC/2, continued]

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CHAPTER I: OBJECTIVE, COMPETENCE, COMPOSITION, SECRETARIAT

Rule 1: Objective and Competence

(1) The objective of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned (hereinafter referred to as "the Conference") is to negotiate and adopt, on the basis of the drafts contained in document PLT/DC/3, a treaty supplementing the Paris Convention for the Protection of Industrial Property as far as patents are concerned and regulations under that treaty (hereinafter referred to as "the Treaty" and "the Regulations," respectively).

(2) The Conference, meeting in Plenary, shall be competent to:

(i) adopt these Rules of Procedure (hereinafter referred to as "these Rules") and to make any amendments thereto;

(ii) adopt the agenda of the Conference;

(iii) decide on credentials, full powers, letters or other documents presented in accordance with Rules 6, 7 and 8 of these Rules;

(iv) adopt the Treaty and the Regulations;

(v) adopt any recommendation or resolution whose subject matter is germane to the Treaty;

(vi) adopt any agreed statements to be included in the Records of the Conference;

(vii) adopt any final act of the Conference;

(viii) deal with all other matters referred to it by these Rules or appearing on its agenda.

Rule 2: Composition

(1) The Conference shall consist of:

(i) delegations of the States members of the International (Paris) Union for the Protection of Industrial Property (hereinafter referred to as "the Paris Union"),

[PLT/DC/2, continued]

(ii) delegations of the States members of the World Intellectual Property Organization (WIPO) other than those referred to in item (i),

(iii) delegations of the European Patent Organisation and the Organisation africaine de la propriété intellectuelle and

(iv) representatives of other intergovernmental and of non-governmental organizations invited to the Conference.

(2) Hereinafter, delegations referred to in paragraph (1)(i) are called "Member Delegations," delegations referred to in paragraph (1)(ii) are called "Observer Delegations," delegations referred to in paragraph (1)(iii) are called "Special Delegations," and representatives referred to in paragraph (1)(iv) are called "representatives of Observer Organizations." The term "Delegations," as hereinafter used, shall, unless otherwise expressly indicated, include Member Delegations, Observer Delegations and Special Delegations; it shall not include the representatives of Observer Organizations.

(3) The Conference may invite to one or more of its meetings any person whose technical advice it may consider useful for its work.

Rule 3: Secretariat

(1) The Conference shall have a Secretariat provided by the International Bureau of WIPO (hereinafter referred to as "the International Bureau").

(2) The Director General of WIPO and any official of the International Bureau designated by the Director General of WIPO may participate in the discussions of the Conference, meeting in Plenary, as well as in any committee or working group thereof and may make oral or written statements, observations or suggestions to the Conference, meeting in Plenary, and any committee or working group thereof concerning any question under consideration.

(3) The Director General of WIPO shall, from among the staff of the International Bureau, designate the Secretary of the Conference and a Secretary for each committee and for each working group.

(4) The Secretary of the Conference shall direct the staff required by the Conference.

(5) The Secretariat shall provide for the receiving, translation, reproduction and distribution of the required documents; the interpretation of oral interventions; and the performance of all other secretarial work required for the Conference.

(6) The Director General of WIPO shall be responsible for the custody and preservation in the archives of WIPO of all documents of the Conference. The International Bureau shall distribute the final documents of the Conference after the Conference.

[PLT/DC/2, continued]

CHAPTER II: REPRESENTATION

Rule 4: Composition of Delegations

Each Delegation shall consist of one or more delegates and may include alternate delegates and advisors. Each Delegation shall have a Head of Delegation and may have an Alternate or Deputy Head of Delegation.

Rule 5: Representatives of Observer Organizations

An Observer Organization may be represented by one or more representatives.

Rule 6: Credentials and Full Powers

(1) Each Delegation shall present credentials.

(2) Full powers shall be required for signing the Treaty. Such powers may be included in the credentials.

Rule 7: Letters of Appointment

The representatives of Observer Organizations shall present a letter or other document appointing them.

Rule 8: Presentation of Credentials, etc.

The credentials and full powers referred to in Rule 6 and the letters or other documents referred to in Rule 7 shall be presented to the Secretary of the Conference, if possible not later than twenty-four hours after the opening of the Conference.

Rule 9: Examination of Credentials, etc.

(1) The Credentials Committee referred to in Rule 11 shall examine the credentials, full powers, letters or other documents referred to in Rules 6 and 7, respectively, and shall report to the Conference, meeting in Plenary.

(2) The final decision on the said credentials, full powers, letters or other documents shall be within the competence of the Conference, meeting in Plenary. Such decision shall be made as soon as possible and in any case before the adoption of the Treaty.

Rule 10: Provisional Participation

Pending a decision upon their credentials, letters or other documents of appointment, Delegations and representatives of Observer Organizations shall be entitled to participate provisionally in the deliberations of the Conference as provided in these Rules.

[PLT/DC/2, continued]

CHAPTER III: COMMITTEES AND WORKING GROUPS

Rule 11: Credentials Committee

- (1) The Conference shall have a Credentials Committee.
- (2) The Credentials Committee shall consist of eleven members elected by the Conference, meeting in Plenary, from among the States whose delegations are Member Delegations.

Rule 12: Main Committees and Working Groups

(1) The Conference shall have two Main Committees. Each Main Committee shall consist of all the Member Delegations. The Main Committees shall be responsible for proposing for adoption by the Conference, meeting in Plenary, the provisions of the Treaty and the Regulations and any recommendation, resolution or agreed statement referred to in Rule 1(2)(v) and (vi), as follows:

(i) Main Committee I, in respect of the provisions other than those referred to in item (ii), below, as contained in the basic proposal referred to in Rule 29(1);

(ii) Main Committee II, in respect of the preamble and the substantive provisions entitled "Fields of Technology," "Rights Conferred by the Patent," "Term of Patent," "Reversal of Burden of Proof," "Obligations of the Right Holder," "Remedial Measures under National Legislation," as well as the administrative provisions and the final clauses, as contained in the basic proposal referred to in Rule 29(1).

(2) Each Main Committee may establish working groups. In establishing a working group, the Main Committee concerned shall define its tasks. The number of the members of any working group shall be decided by the Main Committee establishing it; the members of each working group shall be elected by the Main Committee establishing it from among the Member Delegations.

Rule 13: Drafting Committee

- (1) The Conference shall have a Drafting Committee.
- (2) The Drafting Committee shall consist of ten members elected by the Conference, meeting in Plenary, from among the Member Delegations, as well as, ex officio, the Chairmen of the two Main Committees.
- (3) The Drafting Committee shall prepare drafts and give advice on drafting as requested by the Main Committees. The Drafting Committee shall not alter the substance of texts submitted to it, but shall coordinate and review the drafting of all texts approved by the Main Committees, and shall submit the texts so reviewed for final approval to the Main Committees.

[PLT/DC/2, continued]

Rule 14: Steering Committee

(1) The Steering Committee of the Conference shall consist of the President of the Conference, the Chairman of the Credentials Committee, the Chairmen of the two Main Committees and the Chairman of the Drafting Committee. Its meetings shall be chaired by the President of the Conference and, in his absence, by the Chairmen of the two Main Committees by turns.

(2) The Steering Committee shall meet from time to time to review the progress of the Conference and to make decisions for furthering such progress, including, in particular, decisions on the coordinating of the meetings of the Plenary, the committees and the working groups.

(3) The Steering Committee shall propose for adoption by the Conference, meeting in Plenary, the text of any final act of the Conference.

CHAPTER IV: OFFICERS

Rule 15: Officers

(1) The Conference, meeting in Plenary and presided over by the Director General of WIPO, shall elect its President, and, presided over by its President, shall elect ten Vice-Presidents.

(2) The Credentials Committee, the Main Committees and the Drafting Committee shall each have a Chairman and two Vice-Chairmen.

(3) Each of the bodies mentioned in paragraphs (1) and (2) shall elect its officers from among the delegates of States whose Delegations are its members. The officers of any working group shall be elected by the Main Committee establishing it from among the delegates of States whose Delegations are its members.

(4) Precedence among the Vice-Presidents or Vice-Chairmen of a given body shall depend on the place occupied by the name of the State of each of them in the list of Member Delegations established in the French alphabetical order, beginning with the name of the State drawn by lot by the President of the Conference.

Rule 16: Acting President or Acting Chairman

(1) If the President of the Conference or any Chairman is absent from any meeting of the body (the Conference, meeting in Plenary, the committee or working group) to be chaired by him, such meeting shall be presided over, as Acting President or Acting Chairman, by that Vice-President or Vice-Chairman of that body who, among the Vice-Presidents or Vice-Chairmen present, has precedence over the others.

(2) If all the officers of a body are absent from any meeting of that body (Conference, meeting in Plenary, committee or working group), an Acting President or Acting Chairman, as the case may be, shall be elected by that body.

[PLT/DC/2, continued]

Rule 17: Replacement of President or Chairman

If, for the rest of the duration of the Conference, the President or any Chairman is unable to perform his functions, a new President or Chairman shall be elected.

Rule 18: Vote by Presiding Officer

(1) No President or Chairman, whether elected as such or Acting (hereinafter referred to as "the Presiding Officer"), shall vote. Another member of his Delegation may vote in the name of his Delegation.

(2) Where the Presiding Officer is the only member of his Delegation, he may vote, but only after all other Delegations have voted.

CHAPTER V: CONDUCT OF BUSINESS

Rule 19: Quorum

(1) A quorum shall be required in the Conference, meeting in Plenary, and shall be constituted by one-half of the Member Delegations participating in the Conference.

(2) A quorum shall be required in the meetings of any committee or any working group and shall be constituted by one-half of the members of that committee or working group.

Rule 20: General Powers of the Presiding Officer

(1) In addition to exercising the powers conferred upon him elsewhere by these Rules, the Presiding Officer shall declare the opening and closing of the meetings, direct the discussions, accord the right to speak, put questions to the vote, and announce decisions. He shall rule on points of order and, subject to these Rules, shall have complete control of the proceedings at any meeting and over the maintenance of order thereat.

(2) The Presiding Officer may propose to the meeting the limiting of time to be allowed to speakers, the limitation of the number of times each Delegation may speak on any question, the closure of the list of speakers, or the closure of the debate. He may also propose the suspension or the adjournment of the meeting, or the adjournment of the debate on the question under discussion. Such proposals of the Presiding Officer shall be considered as adopted unless immediately rejected.

Rule 21: Speeches

(1) No person may speak without having previously obtained the permission of the Presiding Officer. Subject to Rules 22 and 23, the Presiding Officer shall call upon speakers in the order in which they signify their desire to speak.

[PLT/DC/2, continued]

(2) The Presiding Officer may call a speaker to order if his remarks are not relevant to the subject under discussion.

Rule 22: Precedence

(1) Member Delegations asking for the floor shall generally be accorded precedence over Observer Delegations asking for the floor, and either shall generally be accorded precedence over representatives of Observer Organizations.

(2) The Chairman of a committee or working group may be accorded precedence during discussions relating to the work of his committee or working group.

(3) The Director General of WIPO or his representative may be accorded precedence for making statements, observations or suggestions.

Rule 23: Points of Order

(1) During the discussion of any matter, any Member Delegation may rise to a point of order, and the point of order shall be immediately decided by the Presiding Officer in accordance with these Rules. Any Member Delegation may appeal against the ruling of the Presiding Officer. The appeal shall be immediately put to the vote, and the Presiding Officer's ruling shall stand unless the appeal is approved.

(2) A Member Delegation which under paragraph (1) rises to a point of order may not speak on the substance of the matter under discussion.

Rule 24: Limit on Speeches

In any meeting, it may be decided to limit the time to be allowed to each speaker and the number of times each Delegation or representative of an Observer Organization may speak on any question. When the debate is limited and a Delegation or a representative of an Observer Organization has used up its allotted time, the Presiding Officer shall call it to order without delay.

Rule 25: Closing of List of Speakers

(1) During the discussion of any given question, the Presiding Officer may announce the list of participants who have signified their wish to speak and decide to close the list as to that question. The Presiding Officer may nevertheless accord the right of reply to any speaker if a speech, delivered after he has decided to close the list of speakers, makes it desirable.

(2) Any decision made by the Presiding Officer under paragraph (1) may be the subject of an appeal according to the provisions of Rule 23.

[PLT/DC/2, continued]

Rule 26: Adjournment or Closure of Debate

Any Member Delegation may at any time move the adjournment or closure of the debate on the question under discussion, whether or not any other participant has signified his wish to speak. In addition to the proposer of the motion to adjourn or close the debate, permission to speak on that motion shall be accorded to one Member Delegation supporting and two Member Delegations opposing it, after which the motion shall immediately be put to the vote. The Presiding Officer may limit the time allowed to speakers under this Rule.

Rule 27: Suspension or Adjournment of the Meeting

During the discussion of any matter, any Member Delegation may move the suspension or the adjournment of the meeting. Such motions shall not be debated, but shall immediately be put to the vote.

Rule 28: Order of Procedural Motions; Content of Interventions on Such Motions

(1) Subject to Rule 23, the following motions shall have precedence in the following order over all other proposals or motions before the meeting:

- (i) to suspend the meeting,
- (ii) to adjourn the meeting,
- (iii) to adjourn the debate on the question under discussion,
- (iv) to close the debate on the question under discussion.

(2) Any Member Delegation which has been given the floor on a procedural motion may only speak on that motion and may not speak on the substance of the matter under discussion.

Rule 29: Basic Proposal and Proposals for Amendment

(1)(a) Document PLT/DC/3 shall constitute the basis of the discussions in the Conference, and the text of the draft Treaty and Regulations contained in that document shall constitute the "basic proposal."

(b) Where, for any given Article, there are two or three alternatives in the basic proposal, consisting of either two or three texts, or one or two texts and an alternative that there should be no such Article, the alternatives shall be designated with the letters A, B and, where applicable, C, and shall have equal status. Discussions shall take place simultaneously on the alternatives and, if voting is necessary and there is no consensus on which alternative should be put to the vote first, each Member Delegation shall be invited to indicate its preference among the two or three alternatives. The alternative supported by more Member Delegations than the other alternative or, where there are three alternatives, any of the other alternatives, shall be put to the vote first.

[PLT/DC/2, continued]

(c) Wherever the basic proposal contains words within square brackets, only the text that is not within square brackets shall be regarded as part of the basic proposal, whereas words within square brackets shall be treated as a proposal for amendment if presented as provided in paragraph (2).

(2) Any Member Delegation may propose amendments to the basic proposal.

(3) Proposals for amendment shall, as a rule, be submitted in writing and handed to the Secretary of the competent body (the Conference, meeting in Plenary, the committee or working group). The Secretariat shall distribute copies to the Delegations and the representatives of Observer Organizations represented in the body concerned. As a general rule, a proposal for amendment shall be considered and discussed or put to the vote in any meeting only if copies of it have been distributed at least three hours before it is called up for consideration. The Presiding Officer may, however, permit the consideration and discussion of a proposal for amendment even though copies have not been distributed or have been distributed less than three hours before it is called up for consideration.

Rule 30: Decisions on Competence

(1) If any Member Delegation moves that a proposal, duly seconded, should not be considered by the Conference because it is outside the competence of the Conference, such a motion shall be decided by the Conference, meeting in Plenary, and shall be put to the vote before the proposal is called up for discussion.

(2) If the motion referred to in paragraph (1) is made in a body other than the Conference, meeting in Plenary, it shall be referred for decision to the Conference, meeting in Plenary.

Rule 31: Withdrawal of Procedural Motions and Proposals for Amendment

Any procedural motion and any proposal for amendment may be withdrawn by the Member Delegation which has made it, at any time before voting on it has commenced, provided that no amendment to that motion or proposal has been proposed by another Member Delegation. Any motion or proposal which has thus been withdrawn may be reintroduced by any other Member Delegation.

Rule 32: Reconsideration of Matters Decided

When any matter has been decided by a body (the Conference, meeting in Plenary, a committee or working group), it may not be reconsidered by that body, unless so decided by the majority applicable under Rule 34(1)(iv). In addition to the proposer of the motion to reconsider, permission to speak on that motion shall be accorded only to one Member Delegation seconding and two Member Delegations opposing the motion, after which the motion shall immediately be put to the vote.

[PLT/DC/2, continued]

CHAPTER VI: VOTING

Rule 33: Right to Vote

Each Member Delegation shall have the right to vote. A Member Delegation shall have one vote, shall represent only itself and shall vote only in its name.

Rule 34: Required Majorities

(1) All decisions of all bodies (the Conference, meeting in Plenary, the committees and working groups) shall be made as far as possible by consensus. If it is not possible to attain consensus, the following decisions shall require a majority of two-thirds of the Member Delegations present and voting:

- (i) adoption by the Conference, meeting in Plenary, of these Rules,
- (ii) adoption by the Conference, meeting in Plenary, of any amendments to these Rules,
- (iii) adoption by any of the bodies of any proposal for amendment to the basic proposal,
- (iv) decision by any of the bodies to reconsider, under Rule 32, a matter decided,
- (v) adoption by the Conference, meeting in Plenary, of the Treaty and the Regulations,

whereas all other decisions of all bodies shall require a simple majority of the Member Delegations present and voting.

(2) In determining whether the required majority has been attained, only affirmative and negative votes shall be counted, and express abstentions, non-voting or absence during the vote shall not be counted.

Rule 35: Requirement of Seconding; Method of Voting

(1) Any proposal for amendment made by a Member Delegation shall be put to a vote only if it is seconded by at least one other Member Delegation.

(2) Voting on any question shall be by show of hands unless any Member Delegation, supported by at least one other Member Delegation, requests a roll-call, in which case it shall be by roll-call. The roll shall be called in the French alphabetical order of the names of the States, beginning with the State whose name is drawn by lot by the Presiding Officer.

Rule 36: Conduct During Voting

(1) After the Presiding Officer has announced the beginning of voting, the voting shall not be interrupted except on a point of order concerning the actual conduct of the voting.

[PLT/DC/2, continued]

(2) The Presiding Officer may permit any Member Delegation to explain its vote or abstention either before or after the voting.

Rule 37: Division of Proposals

Any Member Delegation may move that parts of the basic proposal or of any proposal for amendment be voted upon separately. If objection is made to the request for division, the motion for division shall be put to a vote. In addition to the proposer of the motion for division, permission to speak on that motion shall be given only to one Member Delegation in favor and two Member Delegations against. If the motion for division is carried, all parts separately approved shall again be put to the vote, together, as a whole. If all operative parts of the basic proposal or of a proposal for amendment have been rejected, the basic proposal or the proposal for amendment shall be considered to have been rejected as a whole.

Rule 38: Voting on Proposals for Amendment

Any proposal for amendment shall be voted upon before voting upon the text to which it relates. Proposals for amendment relating to the same text shall be put to a vote in the order in which their substance is removed from the said text, the furthest removed being put to a vote first and the least removed being put to a vote last. If, however, the adoption of any proposal for amendment necessarily implies the rejection of any other proposal for amendment or of the original text, such other proposal or the original text shall not be put to the vote. If one or more proposals for amendment relating to the same text are adopted, the text as amended shall be put to a vote. Any proposal to add to, or delete from, a text shall be considered a proposal for amendment.

Rule 39: Voting on Proposals on the Same Question

Subject to Rule 38, where two or more proposals relate to the same question, the body (the Conference, meeting in Plenary, the committee or working group) concerned shall, unless it decides otherwise, vote on the proposals in the order in which they have been submitted.

Rule 40: Equally Divided Votes

(1) If a vote is equally divided on matters that require adoption by simple majority other than elections of officers, the proposal shall be regarded as rejected.

(2) If a vote is equally divided on a proposal for electing a given person as an officer, the vote shall be repeated if the nomination is maintained until either that nomination is adopted or rejected or another person is elected for the position in question.

[PLT/DC/2, continued]

CHAPTER VII: LANGUAGES AND MINUTES

Rule 41: Languages of Oral Interventions

(1) Subject to paragraph (2), oral interventions made in the meetings of any body (the Conference, meeting in Plenary, the committee or working group) shall be in Arabic, English, French, Russian or Spanish, and interpretation shall be provided by the Secretariat into the other four languages, provided that, for practical reasons, a Main Committee may limit the languages of interpretation in any meeting of a working group established by it.

(2) Any committee or working group may, if none of its members objects, decide to waive interpretation or to limit it to fewer languages than those referred to in paragraph (1).

Rule 42: Summary Minutes

(1) Provisional summary minutes of the Plenary meetings of the Conference and of the meetings of the Main Committees shall be drawn up by the International Bureau and shall be made available as soon as possible after the closing of the Conference to all speakers, who shall, within two months after the making available of such minutes, inform the International Bureau of any suggestions for changes in the minutes of their own interventions.

(2) The final summary minutes shall be published in due course by the International Bureau.

Rule 43: Languages of Documents and Summary Minutes

(1) Any written proposal shall be presented to the Secretariat in Arabic, English, French, Russian or Spanish. Such proposal shall be distributed by the Secretariat in Arabic, English, French, Russian and Spanish.

(2) Reports of the committees and working groups shall be distributed in Arabic, English, French, Russian and Spanish. Information documents of the Secretariat shall be distributed in English and French.

(3)(a) Provisional summary minutes shall be drawn up in the language used by the speaker if the speaker has used English or French; if the speaker has used another language, his intervention shall be rendered in English or French as may be decided by the International Bureau.

(b) The final summary minutes shall be made available in English and French.

(c) The text of the Treaty and of the Regulations and of any recommendation or resolution, agreed statement or final act adopted by the Conference shall be made available in the languages in which it is adopted.

[PLT/DC/2, continued]

CHAPTER VIII: OPEN AND CLOSED MEETINGS

Rule 44: Meetings of the Conference and of the Main Committees

The Plenary meetings of the Conference and the meetings of the Main Committees shall be open to the public unless the Conference, meeting in Plenary, or the Main Committee concerned, as the case may be, decides otherwise.

Rule 45: Meetings of Other Committees and of Working Groups

The meetings of any committee other than the Main Committees and the meetings of any working group shall be open only to the members of the committee or working group concerned and the Secretariat.

CHAPTER IX: SPECIAL DELEGATIONS

Rule 46: Special Delegations

Special Delegations shall have the same status as Member Delegations, except that Special Delegations shall not have the right

- (i) to vote,
- (ii) to make proposals and to second proposals, or
- (iii) to have their delegates elected as officers.

CHAPTER X: OBSERVERS

Rule 47: Observers

(1) Observer Delegations may attend, and make oral statements in, the Plenary meetings of the Conference and the meetings of the Main Committees.

(2) Representatives of Observer Organizations may attend the Plenary meetings of the Conference and the meetings of the Main Committees. Upon the invitation of the Presiding Officer, they may make, in those meetings, oral statements on questions within the scope of their activities.

(3) Written statements submitted by Observer Delegations or by representatives of Observer Organizations on subjects for which they have a special competence and which are related to the work of the Conference shall be distributed by the Secretariat to the participants in the quantities and in the languages in which such statements are made available.

[PLT/DC/2, continued]

CHAPTER XI: AMENDMENTS TO THE RULES OF PROCEDURE

Rule 48: Amendments to the Rules of Procedure

With the exception of the present Rule, these Rules may be amended.

CHAPTER XII: FINAL ACT

Rule 49: Final Act

If a final act is adopted, it shall be open for signature by any Delegation.

[End]

PLT/DC/3

December 21, 1990 (Original: English)

Source: THE DIRECTOR GENERAL OF WIPO

The "Basic Proposal" for the Treaty and the Regulations

Editor's Note: Document PLT/DC/3 contains the text of the Basic Proposal. It is reproduced on pages 11 to 53 of these Records.

[End]

PLT/DC/4

December 21, 1990 (Original: English)

Source: THE DIRECTOR GENERAL OF WIPO

Notes on the Basic Proposal for the Treaty and Regulations

[PLT/DC/4, continued]

I. GENERAL EXPLANATIONS ON THE NOTES

0.01 This document contains notes on the Draft Treaty Supplementing the Paris Convention as far as Patents are Concerned (Patent Law Treaty) and the Draft Regulations under that Treaty contained in document PLT/DC/3 (hereinafter referred to as the "Draft Treaty" and the "Draft Regulations," respectively).

0.02 Notes have been prepared only with respect to those provisions of the Draft Treaty and the Draft Regulations which seem to require comments.

0.03 The Draft Treaty and the Draft Regulations contain, in respect of 12 provisions, alternatives: in respect of 11 provisions, they are designated with two letters, namely, "A" and "B" (Preamble; Articles 8(4), 10, 19, 20(1), 22, 24, 25, 26 and 35; Rule 2(2)), and in respect of one provision (Article 19) with three letters, namely, "A," "B," and "C." Draft Rule 29(1)(b) of the Draft Rules of Procedure of the Diplomatic Conference contains the following provision dealing with such alternatives:

"Where, for any given Article, there are two or three alternatives in the basic proposal, consisting of either two or three texts, or one or two texts and an alternative that there should be no such Article, the alternatives shall be designated with the letters A, B and, where applicable, C, and shall have equal status. Discussions shall take place simultaneously on the alternatives and, if voting is necessary and there is no consensus on which alternative should be put to the vote first, each Member Delegation shall be invited to indicate its preference among the two or three alternatives. The alternative supported by more Member Delegations than the other alternative or, where there are three alternatives, any of the other alternatives, shall be put to the vote first."

0.04 The Draft Treaty contains, in respect of six provisions, text which appears in square brackets, namely, in Articles 7(2), 11(2)(c), 13(4)(b), 19(3)(a)(iii) (Alternative B), 27(4)(b) and (c)). Draft Rule 29(1)(c) of the Draft Rules of Procedure of the Diplomatic Conference contains the following provision concerning such texts:

"Wherever the basic proposal contains words within square brackets, only the text that is not within square brackets shall be regarded as part of the basic proposal, whereas words within square brackets shall be treated as a proposal for amendment if presented as provided in paragraph (2)."

II. NOTES ON THE DRAFT TREATY

Note on the Preamble

P.01 Article 19 of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the "Paris Convention") reads as follows:

[PLT/DC/4, continued]

"It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention."

Note on Article 1
(Establishment of a Union)

1.01 There are two kinds of unions established by special agreements under the Paris Convention: those which entail financial obligations for the members and those without such obligations. The union to be established by the present Treaty would be of the latter kind.

Note on Article 2
(Definitions)

2.01 It is to be noted that the terms "official language" and "inventor" are not included in Article 2 because each is used for the purposes of one provision of the Treaty only, namely, Articles 8(5) and 12(1), respectively. The terms are defined in Articles 8(5)(d) and 12(2), respectively.

2.02 The terms defined in Article 2 are listed in the order of their first appearance in the Treaty (starting with Article 3).

2.03 Item (i) does not attempt to define the constituent elements of an application. Usually, an application would be considered to comprise a request (for the grant of a patent), a description, one or more claims, one or more drawings (where required) and an abstract (see, for example, Article 3(2) of the Patent Cooperation Treaty (PCT)). In the present Treaty, however, this matter is not regulated so that, subject to the requirements of this Treaty (such as, for example, the requirements to accord a filing date when the conditions of Article 8 are satisfied or to comply with the stipulations of Article 3 and Rule 2 concerning the description), each Contracting Party would be free to decide what elements constitute an application.

2.04 The terms "application" and "application for a patent" are used in Articles 2(ii) and (ix); 3(1) and (2)(a); 4(1); 5; 6(1), (2) and (3); 7; 8; 9(2); 11(2)(b) and (3); 12(1) and (2); 13; 14; 15; 16(1)(a) and (b) and (2); 17(4); 18(2)(c); 20(1); 22(2) (Alternative B); 23(2); 25(1)(i), (ii) and (iv) (Alternative B); 37(2). They also appear in Rules 1(3); 2(1)(vi) and (3); 3(1) and (4)(c); 5(1) and (2); 6(2); 7(1)(b), (2), (3) and (5); 8; 10.

2.05 Item (ii): The term "priority date" is used in Articles 3(1)(b); 9(2)(ii); 11(2)(b) and (3); 12(1); 13(1)(b); 15(1); 20(1); 25(1)(i); as well as in Rule 2(1)(vi).

2.06 Item (iii): The term "prescribed" is used in Articles 3(2)(h); 4(5); 6(1); 8(2), (4) and (5)(b); 29(1)(i); 30(1)(b) and (3)(c); as well as in Rule 7(2).

2.07 Item (iv): The term "patent" is used in the Treaty to refer only to patents for inventions and to exclude other titles of industrial property that

[PLT/DC/4, continued]

are sometimes referred to in national laws as "patents," such as patents for designs, patents for utility models, petty patents and plant patents.

2.08 The term "patent" is used in the Preamble, Articles 2(i), (ii), (iv) and (v); 5(2); 6(1)(b) and (2); 8(1)(i) and 8(6)(b); 9; 10(1) and (2) (Alternative A) and 10 (Alternative B); 12(2); 13(1)(a) and (b) and (3); 17; 18(1)(a), (b) and (e) and (2); 19 (Alternatives A and B); 20(1) (Alternatives A and B); 21(1), (3), (4) and (5); 22 (Alternatives A and B); 23; 24(1) (Alternative B); 25(1) and (2) (Alternative B); 26 (Alternative B); 33(1)(i) and (iii); 35(2) and (4)(a); 36(1)(a); 37(2); as well as in Rules 1(1)(a) and (3); 5(1)(b); 7(4); 8; 9; 10.

2.09 Item (v): The term "Office" is used in Articles 2(ii) and (ix); 6(2); 7; 8(1), (2), (3), (4) and (5); 12(1)(ii); 14(1) and (2); 15(1)(a), (2) and (4); 16(1)(a), and (2); 17(1), (2), (3) and (5); 18(1)(a), (d) and (e) and (2); 25(1)(ii); 33(1)(i) and (iii); 35(2) (Alternative B); 36(1); as well as in Rules 1(3)(i) and (ii); 5(2); 6(2); 7(1) to (4); 8(iv); 10(iv).

2.10 Item (vi): The term "person" is used in Articles 9(1); 12(2); 18(1)(a) and (d); 19(4) (Alternative B) and 19(3)(c) (Alternative C); 20(1); 23(1) and (2)(a); 26(3) (Alternative B); as well as in Rule 1(3).

2.11 Item (vii): The term "Director General" is used in Articles 10(3) (Alternative A); 15(1)(b); 18(2)(c); 21(2)(c); 24(1)(b) (Alternative B); 27(2)(a)(v) and (vi), (4)(c) and (7); 28(1)(ii), and (2) to (5); 30(3)(b) and (c); 33(3)(b); 36(4)(b); 37; 38(1)(b); 39; as well as in Rule 13(2).

2.12 Item (viii): The term "published" is used in Articles 13(1)(a) and (2); 15(2) and (4); 16(1); 17(3); 23(2). The definition is to be read in conjunction with Rule 1(3), which indicates the means which must be considered as making an application, search report, a patent or a change in a patent accessible to the public and, therefore, as rendering the application, search report, patent or change "published."

2.13 Item (ix): The term "substantive examination" is used in Articles 14(2); 16(1)(a) and (2); 18(1)(a).

2.14 Item (x): The term "instrument of ratification" is used in Articles 15(1)(b); 21(2)(c); 24(1)(b) (Alternative B); 33(2)(i) and 3(a); 35(1)(a) (Alternative B); 36(4)(a).

2.15 Item (xi): The term "Assembly" is used in Articles 27; 28(1), (3) to (5); 29(2); 30(3)(a) and (f) and (4); 38(1)(b); as well as in Rules 11; 12.

2.16 Item (xii): The term "Union" is used in Articles 1; 2(xi); 27(1)(a) and (c), (2)(a)(i), (vi), (vii) and (ix) and (b); 28(1)(i) and (ii) and (2) to (4).

2.17 Item (xiii): The term "Organization" is used in Articles 27(2)(b) and (7)(a); 28(1); 38(2).

2.18 Item (xiv): The term "Regulations" is used in Articles 3(3); 18(2)(c); 27(2)(a)(iii) and (9)(a); 29; as well as in Rules 1(1) and (2); 12.

[PLT/DC/4, continued]

2.19 It is to be noted that Rule 1(3) contains the definition of the term "accessible to the public."

Note on Article 3
(Disclosure and Description)

3.01 Paragraph (2): It is to be noted that Rule 2 contains further details concerning the contents and the order of the description.

3.02 Paragraph (3): It is understood that the prohibition of additional or different requirements does not prevent a Contracting Party from requiring compliance with certain formal requirements, such as, in the case of paper filings, the use of a special form and the dimensions of text matter and drawings or, in the case of electronic filings, technical standards regarding the input and output of data.

3.03 It is to be noted that Rule 2(3) allows Contracting Parties to provide for special requirements in respect of the disclosure of nucleotides or amino acid sequences.

Note on Article 4
(Claims)

4.01 Paragraph (3): The number of claims per se cannot be the subject of an objection on the basis of the requirement of conciseness. The requirement of clarity would provide a basis for disallowing any claim that merely paraphrased another claim, since it would not be clear how such a claim differed from the earlier claim.

4.02 Since a trademark does not define a product, a reference in a claim to a trademark would be considered to impair the clarity of the claim and should, save in the exceptional case where such a reference may be unavoidable, be eliminated.

4.03 Paragraph (5): It is to be noted that Rule 3 contains further details concerning the manner of claiming.

4.04 Paragraph (6): As to the scope of the prohibition, see note 3.02, above.

Note on Article 5
(Unity of Invention)

5.01 Paragraph (1): It is to be noted that Rules 4 and 5 contain further details concerning the requirement of unity of invention.

5.02 Paragraph (2): The essential purpose of the requirement of unity of invention is to facilitate the administration and the search of applications. Accordingly, paragraph (2) provides that, while paragraph (1) requires that applications must conform to the requirement of unity of invention, if a patent happens to be granted on an application that does not comply with that requirement, the failure to comply with the requirement of unity of invention

[PLT/DC/4, continued]

cannot be a ground for the invalidation or revocation of the patent. In other words, and as already stated, since the purpose of the requirement of unity of invention is to facilitate the administration and the search of applications, failure to comply with the requirement can and needs only be redressed at the application stage. At that stage, the sanction for non-compliance is the refusal of the grant of a patent unless the application is restricted through the elimination of certain claimed subject matter. The subject matter so eliminated may then be included in one or more "divisional" applications.

5.03 An objection of lack of unity should only be made when lack of unity seriously disturbs the procedure and, if made, it should be made as soon as possible, that is, normally at the latest at the stage of the first examination based on the prior art. At a later stage of procedure, it should not be raised unless as a consequence of amendment of claims or for other clearly justified reasons.

5.04 Occasionally, in cases of lack of unity of invention, particularly if noted only after assessment of the prior art, the examiner will be able to make a complete search and examination for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. It is understood that, in those cases, the search and examination for the additional invention(s) should be completed in respect of the whole application, and no objection of lack of unity of invention should be raised.

Note on Article 6

(Identification and Mention of Inventor;
Declaration Concerning the Entitlement of the Applicant)

6.01 Paragraphs (1) to (3): It is to be noted that Rule 6 contains further details concerning the manner of the identification and mention of the inventor.

6.02 Paragraph (2) extends the right of the inventor, established by Article 4~~ter~~ of the Paris Convention, to be mentioned in the patent to any publication of the Office containing the application. Article 4~~ter~~ of the Paris Convention reads as follows: "The inventor shall have the right to be mentioned as such in the patent."

6.03 As regards the meaning of "publication," see Article 2(vii) and Rule 1(3).

6.04 Paragraph (3) allows a Contracting Party to require the indication--as opposed to the production of evidence--of the legal grounds of the applicant's entitlement. Such legal grounds might be, for example, assignment, employment or inheritance. Proof of the correctness of the indicated grounds of entitlement could not be required by the Office ex officio.

6.05 Paragraph (4): This paragraph does not affect such general, formal requirements as a requirement to furnish a transliteration of the inventor's name.

[PLT/DC/4, continued]

Note on Article 7
(Belated Claiming of Priority)

7.01 Paragraph (1) addresses the situation in which an application which could claim the priority of an earlier application does not, when filed, contain such a claim. The paragraph allows the claiming of priority in a separate declaration filed later than the application. This is permissible since the Paris Convention does not require that the priority claim ("the declaration" containing the priority claim, according to the terminology of Article 4D(1) of that Convention) be contained in the subsequent application itself.

7.02 Paragraph (2): It is to be noted that, if paragraph (2) is adopted, paragraphs (1) and (2) would not be mutually exclusive. Any applicant could invoke both paragraphs, as implied by the words "claims or could have claimed" in the opening of paragraph (2).

7.03 It is understood that an Office could require the payment of a special fee in either of the situations contemplated in paragraphs (1) and (2).

Note on Article 8
(Filing Date)

8.01 It is to be noted that certain details concerning the matter of filing date are provided for in Rule 7.

8.02 Paragraph (1) applies regardless of the medium (whether paper, electronic impulses or otherwise) in which the elements specified in it are or may be submitted to the Office. The manner of compliance may, however, take into account the particular medium required or allowed by an Office. For example, a Contracting Party whose Office requires or allows electronic filings may require that, in the case of such filings, the applicant identify himself by reference to an identification code which permits entry into the Office system. Such a requirement would be considered to comply with item (ii) of paragraph (1).

8.03 Paragraph (2)(a): The time limit is fixed in Rule 7(1)(a).

8.04 Paragraph (3) accords with Article 14(2) of the Patent Cooperation Treaty (PCT).

8.05 Paragraph (4): The time limit is fixed in Rule 7(1)(b).

8.06 Paragraph (5)(b): The time limit is fixed in Rule 7(1)(c).

Note on Article 9
(Right to a Patent)

9.01 Paragraph (1): It is understood that the ordinary rules in each Contracting Party applicable to the sale, transfer, devolution or other transmission of property rights, as well as rules on bankruptcy, apply to the right to a patent and are not affected by paragraph (1). Thus, if, in a given case, the inventor (or the employer or the person having commissioned the work

[PLT/DC/4, continued]

of the inventor) has sold his right to a patent for a particular invention, the right to the patent would belong to the successor-in-title of the inventor (or of the employer or of the said person).

9.02 Paragraph (2): The result produced by paragraph (2) (namely, that where there are several inventors who have independently made the same invention, the right to a patent belongs to the one who was the first to file an application) applies regardless of when each of the inventors made the invention.

9.03 The prior art effect of an application in relation to a later application results from Articles 11 (Conditions of Patentability) and 13 (Prior Art Effect of Certain Applications).

9.04 The relationship of two applications filed by the same person with the same Office in respect of the same invention is regulated by the provision on self-collision in Article 13(4).

Note on Article 10
(Fields of Technology)

10.01 The Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (hereinafter referred to as the "Committee of Experts") decided at its June 1990 meeting that this Article should contain two alternatives. Alternative A reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

Note on Article 11
(Conditions of Patentability)

11.01 Paragraph (2)(a): The second sentence means that a "mosaic" approach to assessing novelty, whereby a plurality of items in the prior art are combined to defeat the novelty of an invention, cannot be used.

11.02 Paragraph (2)(b): It goes without saying that, in this subparagraph, as in all articles of the Draft Treaty, the term "priority date" means a priority date that is valid.

11.03 Paragraph (2)(c): It is left to general principles of international law to determine what areas of space, land, the sea and the sea-bed fall within and outside the sovereignty of each State.

Note on Article 12
(Disclosures Not Affecting Patentability (Grace Period))

12.01 Paragraph (1): The disclosure may have been made by any means and in any form: in writing, orally or in some other form (such as display at an exhibition or information via an electronic data base).

12.02 Paragraph (2): Persons, other than the inventor, who may have the right to a patent are, for example, the inventor's successor-in-title, his employer, the person commissioning the work that resulted in the invention, or a trustee in bankruptcy.

[PLT/DC/4, continued]

12.03 Paragraph (3): The phrase "at any time" means that the effects of paragraph (1) can be claimed at any stage of the patent-granting procedure or thereafter, for example, during invalidation proceedings.

Note on Article 13
(Prior Art Effect of Certain Applications)

13.01 Paragraph (1)(a): Since the term "application" only means an application for a patent (see Article 2(i)), applications for other titles protecting inventions (for example, utility models) do not have the prior art effect provided for in Article 13. However, where an application for a patent invokes the priority of an earlier application for a utility model, or other title protecting an invention, the prior art effect of the said application for a patent commences (for matter in both the application and the earlier application for a utility model, or other title protecting an invention, which has been invoked) from the priority date (see paragraph(1)(b)).

Note on Article 14
(Amendment or Correction of Application)

14.01 Paragraph (1): The "requirements" referred to in this paragraph may result from the Treaty, the applicable national or regional law or both the Treaty and such law.

14.02 The last sentence of paragraph (1) is intended to make it clear that the opportunity to amend or correct that must be provided under this paragraph arises independently of, and need only be given after, any opportunity to amend or correct, required under Article 8 and its corresponding rule (Rule 7(2)), in respect of elements submitted to obtain a filing date.

14.03 Paragraph (2): Abandoning a claim falls under the notion of amendment of an application.

Note on Article 15
(Publication of Application)

15.01 Paragraph (1): It is to be noted that Rule 8 requires that the publication of the application be announced by the competent Office in its official gazette. That Rule reads as follows:

"The publication of an application shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the applicant,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,

[PLT/DC/4, continued]

(v) if available, the symbols of the International Patent Classification."

15.02 The said paragraph does not deal with the determination of the commencement of the 18-month or 24-month time limit in the case of divisional applications, continuation applications, or continuation-in-part applications. Such a determination is left to applicable national or regional law.

15.03 Paragraph (1)(a): As to the term "publish," see Article 2(viii) and Rule 1(3). In particular, it may be noted that there is no obligation for the Office to distribute pamphlets containing the application, since publication may be effected by allowing inspection of the application and providing paper copies of it on request (Rule 1(3)(ii)) or through an electronic communication which also permits a paper copy to be made (Rule 1(3)(iii)).

15.04 The term "as soon as possible" would permit any unavoidable delays caused as a result of strikes, natural disasters or other cases of vis major, but not delays resulting merely from understaffing or inappropriate management arrangements.

15.05 Paragraph (1)(b): Naturally, the reservation referred to in this subparagraph may be withdrawn at any time.

Note on Article 16

(Time Limits for Search and Substantive Examination)

16.01 Paragraph (1): As to the term "publish," see Article 2(viii) and Rule 1(3).

Note on Article 17

(Changes in Patents)

17.01 Paragraph (2): While the Treaty does not define "obvious mistakes" or "clerical errors," they are understood to encompass defects in translations.

17.02 Paragraph (3): The last two words ("as published") cover each successive text of any patent that has been the subject of changes.

17.03 Paragraph (5): As to the term "publish," see Article 2(viii) and Rule 1(3).

17.04 It is to be noted that Rule 9 requires that the publication of a change of a patent be announced by the competent Office in its official gazette. That Rule reads as follows:

"The publication of a change in a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the serial number of the patent,
- (iii) the date of the change,
- (iv) the nature of the change."

[PLT/DC/4, continued]

Note on Article 18
(Administrative Revocation)

18.01 Paragraph (1)(a): The term "document" means any permanent record of information such as, for example, information recorded on paper or information stored in an electronic form.

18.02 Paragraph (1)(h): It is to be noted that Rule 10 requires that the grant of a patent be announced by the competent Office in its official gazette. That rule reads as follows:

"The grant of a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) the serial number of the patent,
- (vi) if available, the symbols of the International Patent Classification."

18.03 Paragraph (1)(d): The words "departing from the request" signify that an opportunity to present arguments must be accorded on the terms indicated in this provision wherever the decision of the Office does not exactly correspond to the decision requested. Thus, if it is requested that claims A and B be revoked, a proposed decision to revoke only claim B or to revoke claims A, B and C would constitute a "departing from the request" and would require that an opportunity be given to the person making the request to present arguments on the grounds on which the Office intends to depart from the request.

Note on Article 19
(Rights Conferred by the Patent)

19.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain three alternatives. Alternative C reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

19.02 Paragraph (3)(a)(iii): The words in square brackets ("or for the purpose of seeking regulatory approval for marketing") cover, in particular, acts performed towards the end of a patent term in order to obtain approval of the competent authority for the marketing, following the expiration of the patent term, of a product protected by the patent.

[PLT/DC/4, continued]

Note on Article 20
(Prior User)

20.01 Paragraph (1): The definition of "good faith" is left to applicable national or regional law. In particular, it would be for that law to determine whether a prior use based on information obtained from a non-prejudicial disclosure made during the grace period (that is, a disclosure that does not affect patentability), as opposed to independent invention, constituted a use in good faith.

20.02 The term "territory" is to be interpreted in its broadest sense to cover any and all places and areas where the patent has effect.

Note on Article 21
(Extent of Protection and Interpretation of Claims)

21.01 Paragraph (2)(b): The phrase "at the time of any alleged infringement" may be regarded as meaning at any time during the occurrence of the alleged infringement or only at the start of the alleged infringement.

Note on Article 22
(Term of Patents)

22.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

22.02 Alternative B, paragraph (2)(a): Where priority is claimed under the Paris Convention, Article 4bis(5) of that Convention applies. Article 4bis(5) reads as follows: "Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority." The present provision treats applications claiming internal priority in the same manner.

22.03 Alternative B, paragraph (2)(b): This provision covers the term of patents granted on divisional applications, continuation applications and applications for continuation in part. In the case of patents of addition, the term would run from the filing date of the parent application.

Note on Article 23
(Enforcement of Rights)

23.01 Paragraphs (1) and (2) are presently drafted by reference to Article 19, which sets out the rights conferred by a patent. If Alternative A of Article 19 were adopted, which would leave the rights conferred by the patent to be determined by each Contracting Party, the present Article would have to be re-drafted to refer to those acts recognized by the concerned Contracting Party as constituting an infringement of the rights of the owner of the patent.

[PLT/DC/4, continued]

23.02 It is understood that national or regional procedural requirements relating to litigation are not affected by this Article.

23.03 Since paragraphs (1) and (2) establish minimum rights (see the words "at least" in the opening clause of each paragraph), any Contracting Party could provide for an exclusive or other licensee to have the right to enforce patent rights or rights arising from published applications.

23.04 Paragraph (2): Where a Contracting Party provides for more measures than those required by paragraph (2) (by, for example, making available injunctions or damages in respect of rights conferred by published applications), it may naturally continue such additional measures. Such measures as are continued must, because of the principle of national treatment, be available to eligible nationals and residents of other States party to the Paris Convention.

23.05 Paragraph (2)(a): As regards the meaning of "published," see Article 2(viii) and Rule 1(3).

23.06 Paragraph (2)(b): Contracting Parties are free to provide other mechanisms to enhance the enforcement of rights based upon published applications such as, for example, accelerated processing of the application.

23.07 A provision ensuring that the statute of limitations could not commence to run until after the grant of a patent where legal proceedings may not be initiated before the grant of the patent would satisfy the requirement of the proviso that the owner of the patent be accorded a "reasonable" time to initiate such proceedings.

23.08 Paragraph (2)(c): It is understood that the phrase "claims of the patent" refers to the claims appearing in the granted patent on the date of any decision by the court to award compensation.

Note on Article 24
(Reversal of Burden of Proof)

24.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

Note on Article 25
(Obligations of the Right Holder)

25.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative B reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/31, para 336).

[PLT/DC/4, continued]

Note on Article 26
(Remedial Measures Under National Legislation)

26.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative B reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

Note on Article 27
(Assembly)

27.01 Paragraph (1): Subparagraph (c) does not preclude the Assembly from requesting financial assistance for the expenses of the participation of all or some delegations from sources outside the Union.

27.02 Paragraph (4)(b) and (c): The words in square brackets ("whether ... or absent") in these subparagraphs are based on a proposal made by the member States of the Organisation africaine de la propriété intellectuelle (OAPI). OAPI has 14 member States.

27.03 Paragraph (4)(e): This subparagraph will have to be omitted if Alternative A (rather than Alternative B) of Article 35 is adopted, that is, if there will be no Article 35.

Note on Article 28
(International Bureau)

Note on Article 29
(Regulations)

Note on Article 30
(Settlement of Disputes)

Note on Article 31
(Revision of the Treaty)

Note on Article 32
(Protocols)

[PLT/DC/4, continued]

Note on Article 33
(Becoming Party to the Treaty)

33.01 Paragraph (1)(ii): The words "that affect the national laws of the States constituting the said organization," which qualified the term "norms" in the proposal made in the last session of the Committee of Experts on which the present provision is based (see document HL/CE/VIII/30), have been omitted. They would seem to be superfluous since any norm in the field of the treaty that is binding on the member States of an intergovernmental organization necessarily affects the national law of those member States.

Note on Article 34
(Effective Date of Ratifications and Accessions)

Note on Article 35
(Reservations)

35.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VII/22).

35.02 Alternative A: In relation to the legal effect of the absence of a provision on reservations in a treaty, see Article 19 of the Vienna Convention on the Law of Treaties, which reads as follows:

"A State may, when signing, ratifying, accepting, approving or acceding to a treaty, formulate a reservation unless:

- (a) the reservation is prohibited by the treaty;
- (b) the treaty provides that only specified reservations, which do not include the reservation in question, may be made; or
- (c) in cases not falling under sub-paragraphs (a) and (b), the reservation is incompatible with the object and purpose of the treaty." (Emphasis added)

It would follow from paragraph (c) that the most likely interpretation of the absence of a provision on reservations in this Treaty would be that reservations on any of the substantive provisions would not be permitted at all because the object and purpose of the Treaty is to establish harmonization, within the limits stated in the Treaty, and all the substantive provisions serve that object and purpose.

35.03 Alternative B, paragraph (2): This paragraph is applicable whether Alternative A or Alternative B of Article 10 is adopted.

35.04 Alternative B, paragraph (3): This paragraph is applicable only if Alternative B of Article 19 is adopted.

35.05 Alternative B, paragraph (4): This paragraph is applicable only if Alternative B of Article 22 is adopted.

[PLT/DC/4, continued]

35.06 Alternative B, paragraph (5): This paragraph is applicable only if Alternative B of Article 24 is adopted.

Note on Article 36
(Special Notifications)

Note on Article 37
(Denunciation of the Treaty)

Note on Article 38
(Languages of the Treaty; Signature)

Note on Article 39
(Depositary)

III. NOTES ON THE DRAFT REGULATIONS

Note on Rule 1
(Definitions (ad Article 2))

R1.01 Paragraph (3): Article 2(viii) defines "published" as meaning "made accessible to the public."

Note on Rule 2
(Contents and Order of Description (ad Article 3(2)))

R2.01 Paragraph (1)(ii): The expression "background art" is used in the corresponding provision of the Regulations under the Patent Cooperation Treaty (PCT) (Rule 5.1(a)(ii)).

R2.02 Paragraph (1)(iv): Article 3(1)(b) reads as follows:

"Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. Any Contracting Party may require that the deposit shall be made on or before the filing date or, where priority is claimed, the priority date of the application."

[PLT/DC/4, continued]

R2.03 Paragraph (1)(vi): As regards amendments of this provision, see Rule 12 which provides that amendment "of Rule 2(1)(vi) ... shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment."

Note on Rule 3
(Manner of Claiming (ad Article 4(5)))

R3.01 Paragraph (1) corresponds to Rule 6.1(b) of the Patent Cooperation Treaty (PCT).

R3.02 Paragraph (2) corresponds to Rule 6.2(a) of the Patent Cooperation Treaty (PCT).

R3.03 Paragraph (3): As regards amendments of this provision, see Rule 12 which provides that amendment "of Rule 3(3) ... shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment."

R3.04 Paragraph (5)(c) corresponds to Rule 6.4(c) of the Patent Cooperation Treaty (PCT).

Note on Rule 4
(Details Concerning the Requirement of
Unity of Invention (ad Article 5(1)))

R4.01 Paragraph (1) contains the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an application. According to that method, unity of invention will exist only when there is a technical relationship among the inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" is defined in paragraph (1) as meaning those technical features that define a contribution that each of the inventions, considered as a whole, makes over the prior art.

R4.02 Independent and Dependent Claims. Unity of invention has to be considered in the first place only in relation to the independent claims in an application and not the dependent claims. In the context of Rule 4, "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed--for example, product, process, use or apparatus or means, etc.).

R4.03 If the independent claims are patentable and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim is patentable. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim is patentable and the combination claim includes all the features of the subcombination.

[PLT/DC/4, continued]

R4.04 If, however, an independent claim is not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) should be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

R4.05 It is intended that the method contained in paragraph (1) for determining whether unity of invention exists should be able to be applied without it being necessary to search the prior art. Where the Office does search the prior art, an initial determination of unity of invention, based on the assumption that the claims are not invalidated by the prior art, might be reconsidered on the basis of the results of the search of the prior art. Where the Office does not search the prior art, unity of invention would be determined on the assumption that the claims are not invalidated by the prior art, unless it is obvious to the person making the determination that the claims are invalidated by the prior art.

R4.06 Illustrations of Particular Areas. There are three particular areas of practice where the application of the method for determining unity of invention contained in paragraph (1) of Rule 4 may be illustrated:

(i) combinations of different categories of claims; (ii) so-called "Markush practice"; and (iii) the case of intermediate and final products. Principles for the interpretation of the method contained in paragraph (1) in the context of each of those areas are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of paragraph (1) of Rule 4. Contracting Parties that wish to adopt, in their patent legislation, more detailed provisions on unity of invention than those contained in Article 5 and Rules 4 and 5 could include the substance of the principles of interpretation set out below.

R4.07 In order to secure the greatest possible harmonization of practice, Article 27(2)(a)(iii) empowers the Assembly to adopt guidelines for the implementation of provisions of the Treaty and the Regulations. Under that procedure, the Assembly could adopt, and revise where necessary, the principles of interpretation on the three areas of special concern referred to in the preceding paragraph and set out below. Alternatively, those principles of interpretation could be adopted in the form of an agreed text or statement by the Diplomatic Conference when the Treaty is adopted. The latter method, however, is less flexible, since the text could probably not be later modified in the light of experience in the way that guidelines could be modified by the Assembly.

R4.08 Combinations of Different Categories of Claims. The method for determining unity of invention contained in paragraph (1) of Rule 4 should be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

[PLT/DC/4, continued]

- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
- (iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

R4.09 As indicated in the last part of paragraph R4.08, above, a process should be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process. They are also not intended to imply that the same kind of process of manufacture could not also be used for the manufacture of other products.

R4.10 As also indicated in the last part of paragraph R4.08 above, an apparatus or means should be considered to be "specifically designed for carrying out" a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. On the other hand, the words "specifically designed" should not imply that the apparatus or means could not be used for carrying out another process, or that the process could not be carried out using an alternative apparatus or means.

R4.11 "Markush Practice." The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Article 5 and Rule 4. In that special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in paragraph (1) of Rule 4 should be considered to be met when the alternatives are of a similar nature.

R4.12 When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where the following criteria are fulfilled:

- (a) all alternatives have a common property or activity, and
- (b)(i) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or
- (ii) in cases where the common structure cannot be the unifying criterion, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

[PLT/DC/4, continued]

R4.13 In (b)(i), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

R4.14 In (b)(ii), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

R4.15 The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

R4.16 When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel, unity should be reconsidered by the examiner. Reconsideration should not necessarily imply that an objection of lack of unity must be raised.

R4.17 Intermediate and Final Products. The situation involving intermediate and final products is also governed by Article 5 and Rule 4.

R4.18 The term "intermediate" is intended to mean intermediate or starting products. Such products have the ability to be used to produce patentable final products through a physical or chemical change in which the intermediate loses its identity.

R4.19 Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(a) the intermediate and final products have the same essential structural element, i.e.,

(i) the basic chemical structures of the intermediate and the final products are the same, or

(ii) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(b) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

R4.20 Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known--for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to

[PLT/DC/4, continued]

satisfy unity in such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

R4.21 It should be possible to accept in a single application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

R4.22 The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new.

R4.23 If the same application claims different intermediates for different structural parts of the final product, unity should not be regarded as being present between the intermediates.

R4.24 If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

R4.25 As long as unity of invention can be recognized applying the above guidelines, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not affect the decision on unity of invention.

R4.26 Paragraph (2) requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

R4.27 Paragraph (2) is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 4(1)) remains the same regardless of the form of claim used.

R4.28 Paragraph (2) does not prevent an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Office.

Note on Rule 5
(Divisional Applications (ad Article 5(1)))

R5.01 The right to file divisional applications is established in Article 4G of the Paris Convention, which reads as follows:

"(1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

[PLT/DC/4, continued]

"(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the [Paris] Union shall have the right to determine the conditions under which such division shall be authorized."

Note on Rule 6
(Manner of Identification and Mention of Inventor
(ad Article 6))

R6.01 Paragraph (1): The inventor may decide or require that instead of his home address the application should contain an address for service chosen by him.

Note on Rule 7
(Details Concerning the Filing Date Requirements
(ad Article 8))

Note on Rule 8
(Announcement in the Gazette of the Publication of an Application
(ad Article 15(1)))

Note on Rule 9
(Announcement in the Gazette of the Publication of a Change in a Patent
(ad Article 17(5)))

Note on Rule 10
(Announcement in the Gazette of the Grant of a Patent
(ad Article 18(1)(b)))

R10.01 The data required in items (i) and (ii) are already required to be published by Article 12 of the Paris Convention which, in its material part, reads as follows:

"(1) Each country of the [Paris] Union undertakes to establish a special industrial property service and a central office for communication to the public of patents ...

"(2) This service shall publish an official periodical journal. It shall publish regularly:

(a) the names of the proprietors of patents granted, with a brief designation of the inventions patented; ..."

[PLT/DC/4, continued]

Note on Rule 11

(Absence of Quorum in the Assembly (ad Article 27))

R11.01 Article 27(5)(b) reads as follows:

"In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence."

Note on Rule 12

(Requirement of Unanimity for Amending Certain Rules
(ad Article 29(3))

R12.01 The two Rules identified (Rule 2(1)(vi), concerning the mode of carrying out the invention that must be disclosed, and Rule 3(3), concerning the form of claims) contain provisions of fundamental importance. Therefore, those Rules may not be amended without unanimity.

Note on Rule 13

(Settlement of Disputes (ad Article 30))

R13.01 Paragraph (1): Article 30(1)(b) provides that a Contracting Party that is requested to enter into consultations with another Contracting Party "shall provide within the prescribed time limit an adequate opportunity for the requested consultations."

R13.02 Paragraph (2): Article 30(3)(c) provides that the parties to the dispute shall agree upon the terms of reference of the panel but that "if such agreement is not achieved within the prescribed time limit, the Director General shall set the terms of reference of the panel after having consulted the parties to the dispute and the members of the panel."

[End]

PLT/DC/5

December 21, 1990 (Original: English)

Source: THE INTERNATIONAL BUREAU

History of the Preparations of the Patent Law Treaty

1. The present document is a brief summary of the history of the proposed "Patent Law Treaty," that is, the Treaty whose draft is contained in WIPO document PLT/DC/3 (the "Basic Proposal"), a document bearing the same date as the present document.

{PLT/DC/5, continued}

2. The history of the proposed Treaty started with a proposal, made in June 1983 by the Director General of the World Intellectual Property Organization (WIPO) to the Governing Bodies of WIPO (and, in particular, the Assembly of the Paris Union), for a study on the legal effects of public disclosure of an invention by its inventor prior to filing an application (see WIPO document AB/XIV/2, Annex A, item PRG.03(4)). The proposal was adopted and the question was considered in May 1984 by the WIPO "Committee of Experts on the Grace Period for Public Disclosure of an Invention Before Filing an Application." The "grace period," as it is popularly called, has the effect that certain disclosures, made during a specified period prior to the filing or priority date of an application, do not affect the patentability of the invention claimed in the application. Provisions in the present draft are found in Article 12.

3. It was soon realized that one could not deal with the question of a grace period alone, since it necessarily involved other issues that would have to be agreed upon at the same time as agreeing on the grace period. In particular, such issues are the identification of the inventor (since the grace period is a period primarily covering publication of the invention by the inventor) and the requirements of a filing date of the application (since the grace period has to be counted back from that date). These issues were considered for the first time in the second meeting of the Committee, held in July 1985, and are addressed in Articles 6 and 8, respectively, of the present draft.

4. In recognition of this expanded scope of its task, the name of the Committee was changed to "Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions." That name was retained throughout the preparatory work for the proposed Patent Law Treaty, which ended in November 1990. The Committee continued to meet during the six years between 1984 and 1991: once in 1985, once in 1986 and twice in each of the subsequent four years (1987 to 1990). In other words, there have been a total of 11 preparatory meetings. At each of those meetings, except those held in 1988 and the second meeting held in 1989, the scope of the proposed Patent Law Treaty grew as the Committee considered additional substantive subject matter for inclusion in it.

5. Through this gradual process of growth of its scope, the proposed Patent Law Treaty came to address many important issues in the field of patents upon which there is great divergence in treatment among national and regional laws, but for which harmonization is desired. It is intended that the Treaty achieve a legally more secure patent system, a system which is easier to apply by patent offices and easier to use by inventors, industry and their professional representatives.

6. Among those issues addressed by the Committee, and in addition to those three already mentioned in paragraphs 1 and 2, above, the following deserve special mention (in the order of the Articles of the proposed draft):

(i) What should be the requirements of disclosure, particularly in the case of applications referring to biologically reproducible material? (Article 3(1)(b))

(ii) How should "unity of invention" be defined and what should be the legal consequences if the requirements of unity of invention are not fulfilled? (Article 5 and Rule 4)

[PLT/DC/5, continued]

(iii) What should be the requirements of identifying and mentioning (in publications) the inventor and of indicating the applicant's entitlement (if he is not the inventor) to file an application? (Article 6)

(iv) Should it be possible to claim priority belatedly and, if so, under what conditions? (Article 7)

(v) Should it be allowed that an application incorporate the contents of another application by a mere reference to the other application? Could applications be filed in an Office in a language other than the official language of that Office? (Article 8)

(vi) Should the "first-to-file" principle prevail over the "first-to-invent" principle? (Article 9)

(vii) Should a Contracting Party have the possibility of excluding from patenting inventions belonging to certain fields of technology and, if so, what should be the permitted cases of exclusion? Alternatively, should the Treaty be silent on this issue? (Article 10)

(viii) Should applications be published and, if so, how many months after their filing? (Article 15)

(ix) Should time limits be fixed for the search and the substantive examination of applications? (Article 16)

(x) Should pre-grant oppositions be prohibited and the possibility of the administrative revocation of patents be institutionalized? (Article 18)

(xi) Should the Treaty deal with the question of the rights of the patent owner and, if so, what should be the minimum list of those rights? (Article 19)

(xii) Should the Treaty--particularly in view of the "first-to-file" principle--prescribe the minimum rights of a "prior user" of an invention for which a patent has been granted? (Article 20)

(xiii) What should be the principles governing the interpretation of the claims, particularly as far as "equivalents" are concerned? (Article 21)

(xiv) Should the Treaty set a minimum term of patents and, if so, should that term be 20 years, calculated from the filing date of the application? (Article 22)

(xv) What remedies (including injunctions and damages) should be available when the patent is infringed, including the case when the prohibited activity takes place before the grant of the patent? (Article 23)

(xvi) Should the Treaty deal with the question of the reversal of the burden of proof in the case of the infringement of certain process patents? (Article 24)

(xvii) Should the Treaty deal with the obligations of the patentee and, if so, in what way and with what remedial measures if an obligation is disregarded? (Articles 25 and 26)

[PLT/DC/5, continued]

7. As to the chronology in which these and other issues took the form of draft articles, the following information may be of interest:

(i) At its third meeting (March 1986), the Committee considered a total of six new issues, namely, what is covered in the present draft by Article 4 (various aspects of claims in a patent application), Article 5 (the requirement of unity of invention), Article 13 (the prior art effect of earlier-filed applications that would otherwise not be considered prior art because they had not yet been published at the time a later application is filed), Article 14 (the amendment or correction of applications), Article 19 (the rights conferred by a patent), and Article 24 (the question of the reversal of burden of proof in the case of products obtained through a patented process).

(ii) At its fourth meeting (March 1987), the Committee took up four new issues, namely, what is covered in the present draft by Article 3 (the requirements of disclosure), Article 9 (the right to a patent, in particular, when an invention is made and applied for by two applicants, requiring a choice between the "first-to-file" and "first-to-invent" principles), Article 21 (the extent of protection and interpretation of claims) and Article 22 (the term of patents).

(iii) At its fifth meeting (November 1987), the Committee considered four issues for the first time. The first of them concerned the delayed submission of a priority claim and the delayed filing of an application which claims or could have claimed the priority of an earlier application. This issue is dealt with in Article 7 of the present draft. The other three issues are covered in the present draft by Article 10 (in what fields, if any, of technology could a Contracting Party exclude the availability of patent protection), Article 20 (the principle of prior use, whereby a person who was using an invention before the filing date or priority date of an application in respect of that invention, may continue such use) and Article 23 (enforcement of rights, whether based upon a patent or a published application).

(iv) At its eighth meeting (April 1989), the Committee considered five new issues, namely, what is covered in the present draft by Article 11 (the conditions to be satisfied for an invention to be considered patentable), Article 15 (the obligation to publish applications), Article 16 (time limits for search and substantive examination), Article 17 (the right of an owner of a patent to request an Office to make changes in his patent) and Article 18 (administrative--that is, by the Office--revocation of a patent, in whole or in part, at the request of any person).

(v) At its eleventh, and final, meeting (October/November 1990), the Committee considered two new provisions, which constitute, in the present draft, Article 25 (enumeration of certain obligations of the owner of a patent) and Article 26 (remedial measures for non-compliance with the obligations referred to in Article 25).

8. Thus, along with an article establishing a new Union (Article 1) and an article containing 14 definitions (Article 2), the present draft includes 26 substantive articles. Twelve of them are accompanied by draft Rules, which form part of the present draft.

[PLT/DC/5, continued]

9. The present draft also contains 13 articles dealing with administrative and other miscellaneous matters, as well as the final clauses. They are: Articles 27 (the Assembly of the Union, including the question of voting), 28 (the International Bureau), 29 (reference to the Regulations to be adopted together with the Treaty), 30 (settlement of disputes among Contracting Parties), 31 (possibility of revising the Treaty), 32 (possibility of concluding protocols to supplement the Treaty), 33 (becoming party to the Treaty by States and by certain intergovernmental organizations), 34 (effective date of ratifications and accessions), 35 (reservations to certain provisions of the Treaty), 36 (special notifications, particularly by intergovernmental organizations party to the Treaty), 37 (denunciation of the Treaty), 38 (languages and signature of the Treaty) and 39 (depository functions). With the exception of the subject matter of Articles 32 and 36, the drafts of Articles 27 to 39 were first considered at the ninth (November 1989) meeting of the Committee. Drafts of Articles 32 and 36 were first considered by the Committee at its eleventh (October/November 1990) meeting.

10. The 13 articles referred to in the preceding paragraph are similar to those in other treaties administered by WIPO, with the exception of Articles 30, 32 and 33. Article 30, proposed to the Committee by the International Bureau, contains detailed provisions on the settlement of disputes. Article 33 addresses the question of who may become party to the treaty: as proposed to the Committee by the International Bureau, this article would allow not only States, but also certain intergovernmental organizations, such as the European Communities, the European Patent Organisation and the Organisation africaine de la propriété intellectuelle, to become party to the Treaty. Article 32, also based upon a proposal by the International Bureau, is inspired by the evolutionary nature of the process of harmonization manifested by the history of the preparations of the Treaty. It envisages the possibility of the Contracting Parties adopting one or more protocols to the Patent Law Treaty.

11. As the scope of discussion expanded, so too did the size of the Committee. From the first meeting in 1984 to the last meeting in 1990, the participation of member States of the Paris Union increased from 11 to 54. Similar increases were realized for observer States (from two in 1987 to 11 in 1990), intergovernmental organizations (from one in 1984 to six in 1990), and non-governmental organizations (from eight in 1984 to 30 in 1990). A table showing the attendance of all participants in the meetings of the Committee is provided in the Annex to this document.

12. In all meetings of the Committee, the International Bureau acted as secretariat.

13. Moreover, the International Bureau conducted surveys of relevant national and regional law and prepared studies on issues considered by the Committee. Indeed, with the exception of the Articles 14 (Amendment and Correction of Application), 25 (Obligations of the Right Holder), and 26 (Remedial Measures Under National Legislation), the International Bureau prepared studies on the subject matter of each of the substantive articles in the present draft. Those studies are as indicated below in respect of the article of the present draft to which they relate, the reference numbers of the latest WIPO document on each topic being shown in parenthesis: Article 3, "Requirements in Respect of Manner of Description of Invention in Patent Applications" (HL/CE/III/3);

[PLT/DC/5, continued]

Article 4, "Requirements in Respect of the Manner of Claiming in Patent Applications" (HL/CE/III/2 Supp. 1); Article 5, "Requirements in Respect of Unity of Invention in Patent Applications" (HL/CE/III/2 Supp. 2); Article 6, "Requirements in Respect of the Naming of the Inventor and in Respect of Evidence to be Furnished Concerning the Entitlement of the Applicant" (HL/CE/II/2); Article 7, "Restoration of the Right to Claim Priority" (HL/CE/IV/INF/3); Article 8, "Requirements for Granting a Filing Date to an Application for a Title of Protection for an Invention; Arguments in Favor of a Uniform Solution; Draft Treaty Provisions" (HL/CE/III/3); and Article 9 "The Right to a Patent Where Several Inventors Have Made the Same Invention Independently" (HL/CE/III/4).

14. The Committee also considered the following studies in respect of Article 10, "Exclusions from Patent Protection" (HL/CE/IV/INF/1); Articles 11, 15, 16, 17 and 18, "Information on Provisions Concerning Publication of Application; Time Limits for Search; Time Limits for Substantive Examination; Opposition and Administrative Revocation and Cancellation of Patents; Changes in Granted Patents; Patentable Inventions" (HL/CE/VII/INF/1); Article 12, "Grace Period for Public Disclosure of an Invention before Filing an Application; Existing Legislative Provisions; Arguments For and Against a Grace Period; Desirability of Uniform Solution" (HL/CE/I/2); Article 13, "Prior Art Effect of Previously Filed But Yet Unpublished Applications" (HL/CE/III/2 Supp. 3); Articles 19 and 24, "Extension of Patent Protection of a Process to the Products Obtained by that Process; Proof of Infringement of a Process Patent" (HL/CE/II/5); Articles 20, 22 and 23, "Duration of Patents; Maintenance Fees; Provisional Protection of Applicant; Prior Users' Rights" (HL/CE/IV/INF/2) and "Interpretation of Patent Claims" (HL/CE/III/5).

15. The most important task of the Secretariat, however, consisted in preparing, for each meeting, beginning with the third meeting (March 1986), the draft texts of the Treaty and the Regulations to be discussed in the meeting, always accompanied by explanatory notes. The volume of those texts and notes is considerable: an average of over 80 pages for each meeting, with the total of almost 900 pages for the 11 meetings.

16. Towards the end of each meeting, the Secretariat prepared a draft report, summarizing the discussions and any conclusions reached on specific points. The average number of paragraphs in each of the 11 reports is nearly 300, so that the total number of paragraphs of the 11 reports amounts to over 3,000.

17. It should be noted that the discussions in each meeting were among three main groups of participants: the representatives of governments and intergovernmental organizations, the representatives of non-governmental organizations, and the Secretariat which explained and, if the trend of the discussion so required, modified its draft proposals. The participation of the representatives of non-governmental organizations reflected the views of the users of the patent system since such representatives were mainly patent lawyers or agents, both corporate counsel and independent practitioners.

18. The evolution of the draft treaty was not only reflected by the documents of the Secretariat distributed to each government and interested organization but also by the publication, in the monthly issues of the WIPO periodical Industrial Property, of a Note on each of the meetings of the Committee. (For Notes on the first through the tenth meetings see Industrial Property,

[PLT/DC/5, continued]

1984, p. 313; 1985, p. 267; 1986, p. 309; 1987; p. 204; 1988, pp. 179 and 358; 1989, pp. 53 and 269; 1990, pp. 140 and 297. The Note for the eleventh meeting, held in October/November 1990, will be published in the January 1990 issue of Industrial Property.) Thus, not only the invitees to the meetings but also the general public were kept informed of the development of the proposed Patent Law Treaty.

19. In consequence of a decision taken by the Assembly of the Paris Union in September 1989 (see WIPO document, P/A/XIV/4, paragraphs 37 and 38), a "Consultative Meeting of Developing Countries on the Harmonization of Patent Laws" was held in June 1990. In preparation for that meeting, the International Bureau prepared three documents: "Provisions of Special Interest to Developing Countries in the Draft Treaty on the Harmonization of Patent Laws" (HL/CM/1); "Exclusions from Patent Protection" (HL/CM/INF/1 Rev.); and "Duration of Patents" (HL/CM/INF/2).

20. At the time of the writing of these notes (December 1990), it is not yet known whether the Uruguay Round of the GATT (General Agreement on Tariffs and Trade) negotiations will result in the adoption of norms in the field of intellectual property. But what is reflected by the latest document (November 1990) of GATT in this area, at least some countries proposed that such norms cover the following questions also covered by the proposed treaty: exclusions from patent protection, rights of the owner of the patent, term of the patent, enforcement of patent rights and reversal of the burden of proof in the case of certain process patents, obligations of the right holder and remedial measures under national legislation. These are dealt with in the present draft of WIPO in Articles 10, 19, 22, 23, 24, 25 and 26, respectively. The subject matter covered by the remaining 18 substantive articles of the present draft does not seem to be covered, or is covered only marginally, by the GATT draft.

[Annex follows]

[PLT/DC/5, continued]

AnnexParticipants in Meetings of Committees of Experts
Relating to the Patent Law TreatyI. STATES MEMBERS OF THE COMMITTEE

(STATES PARTY TO THE PARIS CONVENTION)

State	Meeting										
	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Algeria				X		X		X	X	X	X
Argentina				X	X	X	X	X	X	X	
Australia				X	X	X	X	X	X	X	X
Austria			X	X	X				X	X	X
Bangladesh (party to the Paris Convention as from March 1991)								X	X		
Barbados		X									
Belgium		X	X	X	X	X	X	X	X	X	X
Brazil	X		X	X	X	X	X	X	X	X	X
Bulgaria				X	X	X	X	X	X	X	
Cameroon		X	X				X	X		X	X
Canada			X	X	X	X	X	X	X	X	X
China		X	X	X				X	X	X	X
Côte d'Ivoire				X				X			X

[PLT/DC/5, continued]

State	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Cuba				X		X				X	
Czechoslovakia							X	X	X	X	X
Democratic People's Republic of Korea				X					X	X	X
Denmark	X	X	X	X	X	X	X	X	X	X	X
Egypt		X			X		X	X	X	X	
Finland		X	X	X	X	X	X	X	X	X	X
France	X	X	X	X	X	X	X	X	X	X	X
German Democratic Republic (until October 2, 1990)							X	X	X	X	
Germany, Federal Republic of	X	X	X	X	X	X	X	X	X	X	X
Ghana						X	X	X	X	X	X
Greece				X		X	X		X	X	
Guinea											X
Hungary		X	X	X	X	X	X	X	X	X	X
Iceland			X								
Indonesia			X					X	X	X	X

[PLT/DC/5, continued]

State	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Iraq									X	X	
Iran (Islamic Rep.)											X
Ireland				X	X	X	X	X	X	X	X
Israel				X		X		X	X	X	X
Italy	X		X	X	X	X	X	X	X	X	X
Japan	X	X	X	X	X	X	X	X	X	X	X
Kenya									X	X	X
Lebanon										X	
Lesotho (party to the Paris Convention as from Sept. 1989)					X						
Libya									X	X	X
Madagascar		X	X	X	X	X		X	X	X	X
Malawi		X								X	
Mexico				X	X	X	X	X	X	X	X
Morocco				X					X	X	
Netherlands		X	X	X	X	X	X	X	X	X	X
New Zealand						X		X	X	X	X
Nigeria			X					X	X	X	X

[PLT/DC/5, continued]

State	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Uruguay		X		X	X	X	X		X	X	
Viet Nam											X
Yugoslavia				X		X					
Zaire						X				X	
Zambia								X			
United Republic of Tanzania									X	X	
Total	11	22	30	39	31	36	35	45	49	55	46

[PLT/DC/5, continued]

II. OBSERVER STATES

(STATES NOT PARTY TO THE PARIS CONVENTION)

State	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Angola									X		
Chile								X	X	X	X
Colombia				X				X			
Ecuador								X	X	X	
El Salvador						X		X	X		
Guatemala										X	
Honduras					X			X			
India								X	X	X	X
Namibia										X	
Nicaragua										X	
Pakistan					X						
Panama					X	X	X	X	X	X	
Paraguay								X			
Peru						X				X	X
Yatar					X						

[PLT/DC/5, continued]

State	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Swaziland										X	X
Venezuela				X	X					X	
Yemen									X	X	
Total				2	5	3	1	8	7	11	4

[PLT/DC/5, continued]

III. INTERGOVERNMENTAL ORGANIZATIONS

Organization	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
United Nations (UN)										X	X
General Agreement on Tariffs and Trade (GATT)							X	X	X	X	X
<u>Organisation africaine de la propriété intellectuelle</u> (OAPI)										X	X
Commission of the European Communities (CEC)		X		X		X	X	X	X	X	X
European Patent Office (EPO)	X	X	X	X	X	X	X	X	X	X	X
Latin American Economic System (SELA)								X			
Organization of African Unity (OAU)										X	
Total	1	2	1	2	1	2	3	4	3	6	5

[PLT/DC/5, continued]

IV. NON-GOVERNMENTAL ORGANIZATIONS

Organization	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
American Bar Association (ABA)				X	X	X	X	X	X	X	X
American Intellectual Property Law Association (AIPLA)		X	X	X	X	X	X	X	X	X	X
International Association for the Protection of Industrial Property (AIPPI)	X	X	X	X	X	X	X	X	X	X	X
Latin American Association of Pharmaceutical Industries (ALIFAR)						X	X	X	X	X	X
Asociación Mexicana para la Protección de la Propiedad Industrial (AMPPI)											X
Asian Patent Attorneys Association (APAA)	X	X	X	X	X	X	X	X	X	X	X
Arab Society for the Protection of Industrial Property (ASPIP)			X	X	X		X	X			

PLT/DC/5, continued]

Organization	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Deutsche Vereinigung für Gewerblichen Rechtsschutz und Urheberrecht e.V. (DVGR)		X	X	X	X					X	
European Federation of Pharmaceutical Industries' Associations (EPPIA)					X	X			X	X	X
Inst. of Professional Representatives before the European Patent Office (EPI)				X	X	X	X	X	X	X	X
Federal Chamber of Patent Agents (FCPA)						X	X	X	X	X	X
European Federation of Agents of Industry in Industrial Property (FEMIP)		X	X	X	X	X		X	X		
International Federation of Industrial Property Attorneys (FICPI)	X	X	X	X	X	X	X	X	X	X	X
International Confederation of Free Trade Unions (ICFTU)			X	X					X		

[PLT/DC/5, continued]

Organization	May 1984	July 1985	May 1986	Mar 1987	Nov 1987	June 1988	Dec 1988	Apr 1989	Nov 1989	June 1990	Nov 1990
Union of Industrial and Employers' Confederations of Europe (UNICE)	X	X	X	X	X	X	X	X	X	X	X
Total	8	18	21	26	30	29	25	29	30	30	26

[End]

PLT/DC/5 Corr.

January 21, 1991 (Original: English)

Source: THE INTERNATIONAL BUREAU OF WIPO

Corrigendum to Document PLT/DC/5 (English Version)

1. On page 6, paragraph (13), the document identified after "Article 8" should be: "Requirements in Respect of the Granting of a Filing Date to a Patent Application" (HL/CE/II/2 Supp. 1).
2. In the Annex, page 10, the title of the first organization identified ("ATRIP") should be corrected by substituting the word "Intellectual" for "Industrial."
3. In the Annex, page 11, an "X" should be inserted in the row corresponding to the organization "Federal Chamber of Patent Agents" under the heading "Nov. 87," and the reference to the said organization on page 13 of the Annex should be deleted.

[End]

PLT/DC/6

March 1, 1991 (Original: English)

Source: THE UNITED STATES OF AMERICA

Draft Articles 9, 11 and 13

The present document reproduces proposals by the United States of America for draft Articles 9, 11 and 13, together with the letter transmitting those proposals.

Letter of February 22, 1991, from the Assistant Secretary and Commissioner
of Patents and Trademarks of the United States of America
to the Director General of WIPO

Enclosed is a proposal of the United States amending Articles 9, 11 and 13 of the proposed Treaty Supplementing the Paris Convention as far as Patents Are Concerned as found in WIPO document PLT/DC/3.

[PLT/DC/6, continued]

A number of factors have prompted the United States to offer a proposal to add an option in Article 9, and accompanying changes to Articles 11 and 13, which would allow a country to award patents to the first-to-invent. One factor is the lack of sufficiently crystallized support by the private sector in the United States for the basic changes to U.S. law that would be required by the first-to-file concept in Article 9. A second factor is the failure to conclude the GATT Uruguay Round of discussions on schedule. The clarification of a number of issues addressed in the TRIPS agreement would have facilitated consensus-forming on a package which included the concept of first-to-file. Finally, while the issue of first-to-file may be taken up by a recently-formed Advisory Commission on Patent Law Reform, the results of the Commission's deliberations will obviously not be available by the time of the Diplomatic Conference in The Hague.

In view of these considerations, it is believed essential to the United States to at least have the option to retain a first-to-invent system to maximize its prospects for being able to adhere to any resulting harmonization treaty. We are, of course, aware that certain aspects of the U.S. system for awarding patents to the first to invent have been criticized, in particular, the provision of U.S. law that precludes U.S. and foreign inventors from relying on acts outside the United States to prove dates of invention. We can assure you that the United States is willing to develop with others, in discussions of the proposed option, treaty language to address such criticisms in a mutually satisfactory manner.

Please circulate this letter and the proposal as a document of the Diplomatic Conference.

Article 9
Right to a Patent

(1) [Right of Inventor] The right to a patent shall belong to the inventor. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention.

(2) [Right Where Several Inventors Independently Made the Same Invention] Where two or more inventors independently have made the same invention, the right to a patent for that invention shall belong,

(i) where only one application is filed in respect of that invention, to the applicant, as long as the application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected, or

(ii) where two or more applications are filed in respect of that invention, at the option of the Contracting Party, either (a) to the applicant whose application was made by or on behalf of the earliest inventor who has not abandoned, suppressed or concealed the invention, or (b) to the applicant whose application has the earliest filing date or, where priority is claimed, the earliest priority date, as long as the said application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected.

[PLT/DC/6, continued]

COMMENT: The proposal, in which new language is underlined, provides an option whereby any Contracting Party may have a system to award patents to the first inventor or a system to award patents to the first to file an application. In the past, criticism has been leveled against some aspects of the United States's system of awarding patents to the first to invent, in particular, the provision of U.S. law that precludes U.S. and foreign inventors from relying on acts outside the United States to prove dates of invention. The United States is willing to develop with others, in discussions of the above proposed option, treaty language to address such criticisms in a mutually satisfactory manner.

Article 11
Conditions of Patentability

(1) [Patentability] In order to be patentable, an invention shall be novel, shall involve an inventive step (shall be non-obvious) and shall be, at the option of the Contracting Party, either useful or industrially applicable.

(2) [Novelty] (a) An invention shall be considered novel if it does not form part of the prior art. For the determination of novelty, items of prior art may only be taken into account individually.

(b) The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world.

(c) Any Contracting Party that awards patents to the first-to-invent shall be free to also consider as prior art an invention which was made before the invention claimed in an application and which was not abandoned, suppressed or concealed.

~~(d)~~ (d) Notwithstanding subparagraph (b), any Contracting Party shall be free to exclude from the prior art matter made available to the public, by oral communication, by display or through use, in a place or space which is not under its sovereignty or, in the case of an intergovernmental organization, under the sovereignty of one of its member States.]

(e) Notwithstanding subparagraph (b), any Contracting Party that awards patents to the first-to-invent shall be free to exclude from the prior art everything made available to the public after the invention was made, provided it was not made available to the public more than one year before the filing or priority date of an application claiming that invention.

(3) [Inventive Step (Non-Obviousness)] An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in paragraph (2), it would not have been obvious to a person skilled in the art, either at the time the invention was made if a Contracting Party awards patents to the first to invent or at the filing date or, where priority is claimed, the priority date of the application claiming the invention if a Contracting Party awards patents to the first to file.

[PLT/DC/6, continued]

COMMENT: The proposal, in which the new language is underlined and deleted language is lined through, adds a new paragraph (c), a new paragraph (e) and new language to paragraph (3). The amendment adding new paragraph (c) provides that a Contracting Party awarding patents to the first-to-invent may consider as prior art a showing that the invention was made by another before the invention claimed in the application was made by the applicant. Former paragraph (c) is redesignated as paragraph (d). The amendment adding paragraph (e) provides that a Contracting Party awarding patents to the first-to-invent may exclude from prior art, as defined in subparagraph (b), everything made available to the public after the invention was made, provided it was not made available to the public more than one year prior to the filing date, or if priority is claimed the priority date, of the application claiming that invention. The amendment to paragraph (3) provides that in evaluating the non-obviousness of an application if a Contracting Party awards patents to the first-to-invent, it may make the evaluation as of the time the invention was made rather than at the filing date, or the priority date if one is claimed.

Article 13
Prior Art Effect of Certain Applications

(1) [Principle of "Whole Contents"] (a) Subject to subparagraphs (h) and (c), the whole contents of an application ("the former application") as filed in, or with effect for, a Contracting Party shall, for the purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party be considered as prior art from the filing date of the former application on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent. Any Contracting Party may consider the whole contents of the former application to be prior art also for the purpose of determining whether the invention satisfies the requirement of inventive step (non-obviousness).

(b) Where the former application referred to in subparagraph (a) claims the priority of an earlier application for a patent, utility model or other title protecting an invention, matter that is contained in both the former application and such earlier application shall be considered as prior art in accordance with subparagraph (a) from the priority date of the former application.

(c) Any Contracting Party that awards patents to the first to invent may consider that the former application shall not be considered as prior art against an invention claimed in another application where that invention is made prior to the filing date of the former application, or where the former application claims the priority of an earlier application, prior to the priority date of the former application.

~~(d)~~ (d) For the purposes of subparagraph (a), the "whole contents" of an application consists of the description and any drawings, as well as the claims, but not the abstract.

[PLT/DC/6, continued]

COMMENT: The proposal, in which new language is underlined and deleted language is lined through, provides that a Contracting Party opting to award patents to the first to invent may consider certain former applications as not constituting prior art. For example, the Contracting Party could provide that a former application having a filing date earlier than the filing date of a later application will not be considered to be prior art as to the invention claimed in the later application, if that invention was made prior to the filing date of the former application. However, the proposal would not change the basic rule in paragraph (1)(h) that the former application would be considered as prior art from its priority date if such a date is claimed.

PLT/DC/7

June 3, 1991 (Original: English)

Source: THE DELEGATION OF NORWAY

Draft Article 15(4)

Article 15(4) should be amended to read as follows:

"(4) [Circumstances in Which Publication May Not Take Place]
No application may be published if it has been finally rejected, withdrawn or abandoned or considered withdrawn or abandoned

- (i) [No change]
- (ii) [No change]
- (b) [Deleted]"

[End]

PLT/DC/8

June 3, 1991 (Original: English)

Source: THE DELEGATION OF NORWAY

Draft Article 16

Article 16 should be amended to read as follows:

"(1) [Time Limit for Search]

Alternative X:

(a) - (c) - No change

(d) Notwithstanding subparagraphs (a) - (c), any Contracting Party member of The Patent Cooperation Treaty (PCT) and/or an intergovernmental organisation referred to in Article 33(1)(ii) or (iii) shall be entitled to declare itself not to be bound by the provisions of subparagraphs (a) - (c), provided that it so notifies the Director General at the time of becoming member to the Treaty, the PCT, or the said intergovernmental organisation.

Alternative Y:

Paragraph 1 to be deleted.

(2) [Time Limit for Substantive Examination]

(a) and (b) - No change

(c) The Office shall, wherever possible, reach a final decision on the application not later than five years after the filing date of the application."

[End]

PLT/DC/9

June 3, 1991 (Original: English)

Source: THE DELEGATION OF SWITZERLAND

Draft Article 20

Article 20 should be amended to read as follows:

"(1) (Right of Prior User) Notwithstanding Article 19, a patent shall have no effect against any person (hereinafter referred to as "the prior

[PLT/DC/9, continued]

user") who, in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using the invention or was making effective and serious preparations for such use; any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations. The mere fact that prior use is based on information disclosed within the meaning of Article 12 shall not prejudice good faith.

(2) as in PLT/DC/3."

Notes:

1. The Swiss proposal gives preference to the mandatory nature of the prior users' rights (Alternative B in the Basic Proposal), since such rights are linked with the first-to-file system. As a matter of justice, e.g. a person who made an invention and is using it or is making preparations for such use should not be barred from continuing such use or such preparations just because a third person, who made the invention independently and possibly later than the other inventor, manages to be the first to file an application for that invention.
2. Switzerland proposes to add a second sentence to par. (1). The sentence aims at clarifying that prior use should not be prejudiced by the fact that it is based on information disclosed by the inventor during the grace period. The grace period should only be a safety net designed to save imprudent inventors from loss of novelty. In no case should it provide for a quasi-priority right. This, however, would be the case if grace period disclosures would, per se, exclude any right of prior use. On the other hand, the fact that prior use is based on a grace period disclosure should not lead per se and inevitably to the conclusion that the prior user is in good faith, since additional elements of a particular case might very well lead to the opposite conclusion. An example would be if an inventor shows his application before filing to a third party with that party committing itself not to disclose it further. If the third party, despite its commitment, discloses the invention to the public and then bases its prior use on that disclosure, a court would hardly find that party to be in good faith. However, the situation might be different for other parties who know nothing of the breach of confidentiality and base their prior use on the disclosure made by the third party. Thus, the proposed additional sentence is designed to prevent the courts to be hounded, in one way or the other, by the mere fact that a grace period disclosure has taken place and to allow findings taking into consideration the other elements of a particular case.

[PLT/DC/9, continued]

Accordingly, the second sentence of Note 20.01 on the Basic Proposal should read as follows: "However, the second sentence makes it clear that the mere fact that prior use is based on information obtained from a non-prejudicial disclosure made during the grace period (that is, a disclosure that does not affect patentability) shall not prejudice good faith of the prior user."

[End]

PLT/DC/10 Rev.

June 5, 1991 (Original: English)

Source: THE DELEGATION OF IRELAND

Draft Article 8 and Rule 7

Article 8 should be amended to read as follows:

"(1) [No change]

(2) [Permitted Additional Requirements] (a) A Contracting Party may provide that the filing date may be refused if either of the following requirements is not satisfied ~~within the prescribed time limit:~~

(i) the application contains a part which, on the face of it, appears to be a claim or claims;

(ii) the required fee is paid.

~~Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with later than the date of receipt by the Office of the elements referred to in paragraph (1), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.~~

(b) [No change]

(3) [No change]

(4) [Replacing Description, Claims and Drawings by Reference to Another Application] Notwithstanding paragraphs (1), (2) and (3),

Alternative A: each Contracting Party shall

Alternative B: any Contracting Party may

provide that a reference in the application to another previously filed

[PLT/DC/10 Rev., continued]

application for the same invention by the same applicant or his predecessor in title may, for the purposes of the filing date of the application, replace any of the following elements:

- (i) the part which, on the face of it, appears to be a description of an invention,
- (ii) the part which, on the face of it, appears to be a claim or claims, or
- (iii) any drawings,

provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office ~~within the prescribed time limit. If the said parts and drawings, and, where required, the certified copy, are received by the Office within the said time limit, the filing date of the application shall, provided that the other requirements concerning the filing date are fulfilled, be the date on which the application containing the reference to the previously filed application was received by the Office.~~

(5) [Language] (a) Any Contracting Party may require that the indications referred to in paragraph (1)(i) and (ii), the parts referred to in paragraph (1)(iii) and paragraph (2)(a)(i) and any text matter contained in any drawings be in the official language.

(b) Any Contracting Party may require that the parts referred to in paragraph (4)(i) and (ii) and any text matter contained in drawings referred to in paragraph (4)(iii) be furnished in the official language ~~within the time limit referred to in paragraph (4).~~

(c) [Text same as subparagraph (d) of the basic proposal]

(6) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with the requirements of paragraph (1) or any applicable requirements of paragraphs (2)(a) or (4), the Office shall promptly invite the applicant to comply with such requirements within the prescribed time limit. If the applicant complies with the invitation, the filing date shall be the date on which the applicant so complied. Otherwise, the application shall be treated as if it had not been filed.

~~(6)~~ (7) [Title and text same as Paragraph (6) of the Basic Proposal]"

Rule 7 should be amended to read as follows:

"(1) [Deleted]

~~(2)~~ (1) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with any of the requirements of Article 8(1), or the applicable requirements, if any, of Article 8(2)(a), Article 8(4) or Article 8(5)(b), that the application must satisfy either on receipt or within the time limit applicable under

[PLT/DC/10 Rev., continued]

~~paragraph (1)~~, the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which time limit shall be at least one month from the date of the invitation ~~or, where the non-compliance relates to a matter for which a time limit for compliance is established by paragraph (1), the time limit referred to in paragraph (1), whichever expires later.~~ Compliance with the invitation may be subject to the payment of a special fee. Failure to send an invitation shall not alter the said requirements.

(3) [Deleted]

~~(4)~~ (2) [Title and text same as Paragraph (4) of the Basic Proposal]

~~(5)~~ (3) [Correction of Translations] Any translation of the parts of the application, or of the text matter, referred to in Article 8(5)(b) and (c) may be corrected at any time up to at least the time when the application is in order for grant in order to conform to the wording of those parts or that text matter furnished in a language other than the official language."

Explanatory Notes

1. Article 8, new paragraph (6)

The procedural provisions of new paragraph (6) have been transferred from Rule 7(3) because it is felt that the legal consequences affecting the existence of the application should be embodied in the Treaty.

2. Rule 7

Rule 7 has been redrafted to reflect the need for a more simplified one-stage procedure with a single prescribed time limit.

[End]

PLT/DC/11

June 3, 1991 (Original: English)

Source: THE DELEGATION OF SWEDEN

Draft Article 13(1)(a)

Article 13(1)(a) should be amended to read as follows:

"(a) Subject to subparagraph (b), the whole contents of an application ("the former application") as filed in, or with effect for, a Contracting Party shall, for the purpose of determining the novelty of an invention

[PLT/DC/11, continued]

claimed in another application filed in, or with effect for, that Contracting Party, be considered as prior art from the filing date of the former application on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent."

Explanatory Note

The proposal consists in deleting the last sentence of the subparagraph.

[End]

PLT/DC/12

June 3, 1991 (Original: English)

Source: THE DELEGATION OF THE NETHERLANDS

Draft Article 1

Article 1 should be amended by adding the following new paragraph:

"The States party to this Treaty shall provide for the protection of inventions by patents in accordance with the provisions of this Treaty."

Explanatory Note

Insertion of this paragraph should explicitly specify the Contracting States' obligation to grant (either through its national office or through a regional office or both) patents in accordance with the provisions of the Treaty and would imply their freedom to also afford different protection to other types of patents, such as petty patents, without being bound by the provisions of the Treaty.

[End]

PLT/DC/13

June 3, 1991 (Original: English)

Source: THE DELEGATION OF THE NETHERLANDS

Draft Article 2(ii)(b)

Article 2(ii)(b) should be amended to read as follows:

"(b) for any other purpose, shall be, for each element of the invention, the filing date of the earliest-filed of those applications which contains that element and provided that the priority has been validly claimed."

[End]

PLT/DC/14

June 3, 1991 (Original: English)

Source: THE DELEGATION OF THE NETHERLANDS

Draft Article 19(3)

Article 19(3) (Alternatives B and C) should be amended by adding the following new subparagraph (v):

"(v) where the act concerns a product which has been put on the market by a prior user."

[End]

PLT/DC/15

June 3, 1991 (Original: English)

Source: THE DELEGATION OF THE NETHERLANDS

Draft Article 23(1)(ii)

Article 23(1)(ii) should be amended to read as follows:

"(ii) to obtain damages, adequate under the circumstances, from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4), where the said person is liable under national law."

[End]

PLT/DC/16

June 3, 1991 (Original: English)

Source: THE DELEGATION OF THE NETHERLANDS

Draft Rule 7(4)

Rule 7(4) should be amended to read as follows:

"(4) [Date of Receipt] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document by an associated Office, a branch or sub-office of an Office, by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, or by an official postal service, shall be deemed to constitute receipt of the document by the Office concerned."

[End]

PLT/DC/17.

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 6

Article 6 should be amended to read as follows:

"(1) [No change]

(2) [Mention of the Inventor in Publications of the Office] Any publication of the Office, containing the application or the patent granted thereon, shall mention the inventor or inventors as such, provided that any Contracting Party may allow any inventor to request, in a declaration signed by him and filed with the Office, that such publications should not mention him as inventor, in which case the Office shall proceed accordingly.

(3) [No change]

(4) [Prohibition of Other Requirements] In respect of the identification or mention of the inventor or in respect of the indication of the applicant's entitlement at the time of the filing date, no requirement additional to or different from those provided for in the preceding paragraphs may be imposed."

[End]

PLT/DC/18

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 8

Article 8(3) should be amended to read as follows:

"(3) [Drawings] If the application refers to drawings but such drawings are not received by the Office at the date of receipt of the elements referred to in paragraph (1), at the option of the applicant either any reference to the drawings shall be deemed to be deleted or the filing date of the application shall be the date on which the drawings are received by the Office. Any Contracting Party may require that the option be made within a period of sixteen months after the filing date or, where priority is claimed, the priority date."

[End]

PLT/DC/19

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 13(1)

Article 13(1) should be amended by adding the following new subparagraph (d):

"(d) Any Contracting Party shall be free to decide whether an application for a utility model shall be considered as prior art in accordance with subparagraph (a)."

[End]

PLT/DC/20

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 15(1)

Article 15(1) should be amended to read as follows:

"(1) [Requirement to Publish the Application]

Alternative X:

(a) [No Change]

(b) Notwithstanding subparagraph (a), any Contracting Party that, at the time of depositing its instrument of ratification of, or accession to, this Treaty, does not provide for the publication of applications as provided in subparagraph (a) may reserve the right, for a period not exceeding the expiration of the X-th calendar year after the year in which this Treaty has been adopted, to publish applications as soon as possible after the expiration of 24 months, rather than 18 months, from the filing date or, where priority is claimed, the priority date. Any Contracting Party that wishes to avail itself of the faculty provided for in this subparagraph shall address a corresponding notification to the Director General.

(c) In the case of divisional applications, continuation applications, continuation-in-part applications or other applications of such nature as to contain all or part of the contents of one or more earlier

[PLT/DC/20, continued]

applications filed by the same applicant, the time limit referred to in subparagraphs (a) and (b) shall be counted from the filing date of the earliest-filed application or, where priority is claimed in the earliest-filed application, from the priority date.

Alternative Y:

(1)(a) Subject to paragraphs (2) to (4), the Office shall publish the application as soon as possible after the expiration of 18 months from the filing date or, where the application is entitled, for the purpose of Article 11(2) and (3), to the benefit of the filing date of one or more earlier applications including, where priority is claimed, applications on which to base priority thereof, the filing date of the earliest-filed application.

(h) Notwithstanding subparagraph (a), any Contracting Party that, at the time of depositing its instrument of ratification of, or accession to, this Treaty, does not provide for the publication of applications as provided in subparagraph (a) may reserve the right, for a period not exceeding the expiration of the X-th calendar year after the year in which this Treaty has been adopted, to publish applications as soon as possible after the expiration of 24 months, rather than 18 months, from the starting date provided for in subparagraph (a). Any Contracting Party that wishes to avail itself of the faculty provided for in this subparagraph shall address a corresponding notification to the Director General."

[End]

PLT/DC/21

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 16

Article 16 should be deleted.

[End]

PLT/DC/22

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 17

Article 17(4) should be amended to read as follows:

"(4) [Changes Affecting the Disclosure] No change in the patent shall be permitted under paragraph (1), (2) or (3) where the change would result in the disclosure contained in the patent going beyond the disclosure contained in the application as filed."

[End]

PLT/DC/23

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 19

Alternative B, Article 19(3)(a)(ii) should be amended to read as follows:

"(3)(a)(ii) Where the act is done privately and on a non-commercial scale or for a non-commercial purpose (-)."

[End]

PLT/DC/24 Rev.

June 18, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 21

Article 21(2) should be amended to read as follows:

"(2) [Equivalents] (a) For the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements which, at the date of the alleged infringement, are equivalent to the elements as expressed in the claims.

(b) An element (-) shall (-) be considered as being equivalent to an element as expressed in a claim if (-) either of the following conditions is fulfilled in regard to the invention as claimed:

(i) it performs (-) the same function in (-) the same way and produces (-) the same result as the element as expressed in the claim, or

(ii) it is obvious to a person skilled in the art that it can achieve the same result as that achieved by means of the element as expressed in the claim (-)."

[End]

PLT/DC/25

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 22

Article 22 should be amended to read as follows:

"The term of a patent shall be at least 20 years and at most 25 years. However, any Contracting Party may provide for an extension of the patent term, where and to the extent that the patented invention is deterred from exploitation by the administrative regulatory approval procedure and provided that the overall patent term does not exceed 30 years."

[End]

PLT/DC/26

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Article 24

Article 24 should be amended to read as follows:

"(1) [Conditions for the Reversal of Burden of Proof] (-) For the purposes of proceedings, other than criminal proceedings, in respect of the violation of the rights of the owner of the patent referred to in Article 19(2), where the subject matter of the patent is a process for obtaining a product, the burden of establishing that a product was not made by the process shall be on the alleged infringer at least if the product is new.

(2) [Manufacturing and Business Secrets] In the adduction of proof to the contrary, the legitimate interests of the defendant in not disclosing his manufacturing and business secrets shall be taken into account."

[End]

PLT/DC/27

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Rule 2

Rule 2 should be amended to read as follows:

- "(1) [No change]
(2) [No change]
(3) [Deleted]."

[End]

PLT/DC/28

June 3, 1991 (Original: English)

Source: THE DELEGATION OF JAPAN

Draft Rule 3

Rule 3(4) should be amended to read as follows:

"(4) [References in the Claims to the Description and Drawings] (a) No claim may contain, in respect of the technical features of the invention, a reference to the description or any drawings, for example, such references as: "as described in part...of the description," or "as illustrated in figure...of the drawings," unless such a reference is necessary for defining the subject matter or appropriate for enhancing the clarity or the conciseness of the claim."

[End]

PLT/DC/29

June 4, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 2(ix)

Article 2(ix) should be amended to read as follows:

"(ix) "substantive examination" means the examination of an application by an Office to determine whether the invention claimed in the application satisfies at least the conditions of patentability referred to in Article 11(2) and (3);"

Explanatory Note

The subject matter of Article 11(2) and (3), referred to in Article 2(ix), concerns novelty and inventive step (non-obviousness) respectively. One should take into account, however, that certain countries, in their domestic legislation, may wish, in addition, to provide for examination of patent applications by reference, also, to other matters such as inherent patentability or whether a specific invention lies contrary to public order. The addition of the words "at least" provides for this possibility.

[End]

PLT/DC/30

June 4, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 3(2)(b)

Article 3(2)(b) should be amended to read as follows:

"3(2)(b) The description shall have the prescribed contents."

Explanatory Note

As anticipated in Alternatives A and B to Draft Rule 2 certain circumstances may render it necessary or preferable to change the order of the prescribed contents. It is considered, therefore, that any provision concerning such order of presentation, and exceptions thereto, would best be left to the Rules rather than be set out as a mandatory matter in Article 3(2)(b).

[End]

PLT/DC/31

June 4, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 4(3)

Article 4(3) should be amended to read as follows:

"(3) [Style of the Claims] Each claim shall be clear and as concise as possible having regard to the nature of the invention."

Explanatory Note

The meaning of the term "concise", in the context of Draft Article 4(3), is relative to the circumstances of any given situation and must depend, to a large extent, on the character of the invention concerned. The foregoing Proposal takes these criteria into account.

[End]

PLT/DC/32

June 4, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 5

Article 5 should be amended to read as follows:

"(1) [No change]

(2) [No change]

(3) [Divisional Application] The applicant may file one or more divisional applications within such time and upon such conditions as are prescribed."

Explanatory Note

It is felt that the principal issue concerning divisional applications is not a procedural but a substantive one. The basic principle should be set out, therefore, in Article 5 leaving Rule 5 to deal with the appropriate procedural details.

[End]

PLT/DC/33

June 4, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED KINGDOM

Draft Article 4(3)

Article 4(3) should be amended to read as follows:

"(3) [Style of the Claims] The claims shall be clear and concise."

[End]

PLT/DC/34

June 4, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED KINGDOM

Draft Rule 3(2)

Rule 3(2) should be amended to read as follows:

"(2) [Method of Definition of Invention] The definition of the matter for which protection is sought shall be in terms of the technical features of the invention. The technical features may be expressed in structural, functional or mathematical terms."

[End]

PLT/DC/35

June 4, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED KINGDOM

Draft Article 9(1)

Article 9(1) should be amended to read as follows:

"(1) [Right of Inventor] The right to a patent shall belong to the inventor or his successor in title. Any Contracting Party shall be free to determine the circumstances under which the right to a patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention."

[End]

PLT/DC/36

June 5, 1991 (Original: English)

Source: THE DELEGATION OF GERMANY

Draft Article 16

1. Article 16(1) should be deleted.
2. Article 16(2) should be deleted.

[End]

PLT/DC/37

June 5, 1991 (Original: English)

Source: THE DELEGATION OF GERMANY

Draft Article 19

Article 19(2) should be amended to read as follows:

"(2) [Processes] Where the subject matter of the patent concerns a process, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

- (i) the using of the process,
- (ii) in respect of any product directly obtained by the process, any of the acts referred to in paragraph (1)(ii), even where a patent cannot be obtained for the said product."

[End]

PLT/DC/38

June 5, 1991 (Original: English)

Source: THE DELEGATION OF GERMANY

Draft Article 24

Article 24 should be amended to read as follows:

"If the subject matter of a patent is a process for obtaining a new product, the same product when produced by any other party shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process.

In the adduction of proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and business secrets shall be taken into account."

[End]

PLT/DC/39

June 5, 1991 (Original: English)

Source: THE DELEGATION OF GERMANY

Draft Rule 2

Rule 2(1)(vi) should be amended to read as follows:

"(vi) set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any;"

[End]

PLT/DC/40 Rev.

June 10, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 9bis

The treaty should provide for certain situations related to a loss of right. The following proposal deals with a number of situations not presently addressed in the treaty:

"Article 9bis
Loss of Right

(1) Any Contracting Party shall be free to provide that the right to a patent shall be lost by the applicant where:

(i) the invention was placed on sale or secretly used by the inventor, successor-in-title or applicant more than 12 months preceding the filing date or, where priority is claimed, the priority date of the application, even if the invention was not, by virtue of being so placed on sale or secretly used, made available to the public; or

(ii) an application for an industrial property title was filed by the applicant outside the Contracting Party in violation of the national security provisions of the Contracting Party.

(2) Notwithstanding Article 11 and paragraph (1) of this Article, any Contracting Party shall be free to provide that the right to a patent shall not be lost to the applicant where the use of the claimed invention by the applicant more than 12 months preceding the filing date or, where priority is claimed, the priority date of the application, was experimental."

[End]

PLT/DC/41

June 6, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 11

The United States of America has consistently urged that the brackets on Article 11(2)(c), designated as Article 11(2)(d) in the proposal of the United States in document PLT/DC/6, should be deleted. Consistent with this

[PLT/DC/41, continued]

position, the following amendment (new language underlined) should be made to the proposal of the United States found in document PLT/DC/6 for a new Article 11(2)(c):

"(2)(c) Any Contracting Party that awards patents to the first to invent shall be free to also consider as prior art an invention which was made in a place or space under its sovereignty and before the invention claimed in an application and which was not abandoned, suppressed or concealed."

[End]

PLT/DC/42

June 6, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 7

Article 7 should be amended to read as follows:

"(1) [No change]

(2) [Delayed Filing of the Subsequent Application] Where the application ("the subsequent application") which claims or could have claimed the priority of an earlier application is filed after the date on which a period of 12 months from the filing date of the earlier application expired but before the expiration of ~~two months from the date on which that 12-month period expired~~ such period as shall be determined by the Contracting Party the Office shall restore the right of priority upon an express request submitted to the Office, ~~before the expiration of the said two-month period~~, if the request states and the Office finds that, in spite of all due care required by the circumstances, the subsequent application could not have been filed within the said 12-month period. The request for restoration shall state the grounds on which it is based, and the Office may require the production of corresponding evidence."

Explanatory Note

It is felt that the two month period set out in this Draft Article is arbitrary and, in any event, constitutes a very short period. The main point is that the specific and respective requirements of Contracting Parties may vary to the extent that the foregoing period of two months, or any other period which may be fixed in Draft Article 7, may not suit all of them. The Proposal, in leaving the determination of the period to the Contracting Party, reflects the variation in the individual needs of the Contracting Parties and endeavours to resolve that issue.

[End]

PLT/DC/43

June 6, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 9

Article 9 should be amended to read as follows:

"(1) [Right of Inventor] The right to a patent shall belong to the inventor, his assignees or successors in title. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong, whether jointly with the inventor or individually, to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention, or to any other person.

(2) [No change]

(3) [Right of Third Party] Where it is proved to the satisfaction of the Office that a person, other than the one who has filed the application for a patent or the patentee, is the true and lawful owner of the invention in respect of which such application has been filed or such patent has been granted, the Office, in addition to any other relief, shall grant the patent or transfer the patent rights, as the case may be, to the person who proves that he, and not the applicant or the patentee, is the owner of such invention."

[End]

PLT/DC/44

June 7, 1991 (Original: Arabic)

Source: THE DELEGATION OF LEBANON

Preamble

The Preamble should be amended to read as follows:

"The Contracting Parties,

Alternative A

DESIRING to strengthen international cooperation and solidarity in respect of the protection of inventions,

[PLT/DC/44, continued]

CONSIDERING that such protection is facilitated by a harmonization of patent law,

RECOGNIZING the need to take into consideration the public policy, development, technological and public interest objectives of the Contracting Parties,

HAVE CONCLUDED the present Treaty, which constitutes a special agreement within the meaning of Article 19 of the Paris Convention for the Protection of Industrial Property."

Explanatory Note

The word "solidarity" has been added in the first recital in Alternative A. After amendment, the third and fourth recitals would constitute but a single recital.

[End]

PLT/DC/45

June 7, 1991 (Original: Arabic)

Source: THE DELEGATION OF LEBANON

Draft Article 3(1)(a)

Article 3(1)(a) should be amended to read as follows:

(1) [Disclosure] (a) The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by (*) any person who is skilled and knowledgeable in the subject. The application shall disclose the best mode of carrying out the invention. The disclosure shall contain an abstract of the subject matter of the invention, shall indicate any other filing made by the applicant in any country whatsoever and shall state whether he has obtained a patent on the basis of such application."

(*) The term "a person skilled in the art" has been deleted.

[End]

PLT/DC/46

June 7, 1991 (Original: Arabic)

Source: THE DELEGATION OF LEBANON

Draft Article 7

Article 7 should be amended to read as follows:

"Belated Claiming of Priority

Where the application ("the subsequent application") could have claimed the priority of an earlier application but, when filed, did not contain such priority claim, the applicant shall have the right to claim such priority in a separate declaration submitted to the Office within a period to be fixed by the Contracting Party, that is to say the same period as that given to the owner of the invention to claim the priority of the filing date."

N.B. (1) The wording is deleted as from "which shall be at least..."

(2) Paragraph (2) has been deleted, following amendment of paragraph (1).

[End]

PLT/DC/47

June 7, 1991 (Original: Arabic)

Source: THE DELEGATION OF LEBANON

Draft Article 8

1. An item (iv) should be added to paragraph (1) with the following wording:

"(iv) a part which, on the face of it, appears to be a claim or claims."

N.B. Item (iv) is one of the additional requirements permitted by item (i) of paragraph (2).

2. Subparagraph (a)(i) of paragraph (2) should be deleted.

[PLT/DC/47, continued]

3. Subparagraph (b) of paragraph (2) should be amended to read as follows:

"(b) A Contracting Party may not impose one of the permitted additional requirements if it concludes and ratifies a treaty prior to the entry into force of this Treaty."

4. With respect to paragraph (4), we propose adoption of Alternative A.

5. A paragraph (6) should be added with the following wording:

"A Contracting Party shall be entitled to fix a specific time limit for payment of the fees. If the applicant does not comply with such time limit, his application shall be cancelled. However, if the fees are received within the prescribed periods, or periods of grace fixed by the Contracting Party, the filing date of the application shall be the date of receipt by the Office of the elements referred to in paragraph (1) of this Article."

6. The present paragraph (6) would become (7).

[End]

PLT/DC/48

June 7, 1991 (Original: Arabic)

Source: THE DELEGATION OF LEBANON

Draft Article 9

Paragraph (1) should be amended to read as follows:

"The right to a patent shall belong to the inventor."

N.B. The remaining wording should be deleted. The right, as a legal principle, belongs to the inventor. This right can in no event be granted to the employer of the inventor or the person who commissioned the work of the inventor which resulted in the invention. However, the employer or the person who commissioned the work may conclude with the inventor an agreement under which the latter licenses or authorizes working of his invention for a period which the parties decide of common accord.

[End]

PLT/DC/49

June 7, 1991 (Original: Arabic)

Source: THE DELEGATION OF LEBANON

Draft Article 10

1. We propose the adoption of Alternative A, after amendment as follows:

"(1) Patent protection shall be available for inventions (products, industrial processes, specific industrial results, new application of a known industrial process) in all fields of technology which are new, which are of an inventive nature and which are industrially applicable, except for (...)."

2. Item (i) in paragraph (1) should be deleted.

3. Paragraph (2) should be amended to read as follows:

"The Contracting Parties may prohibit the grant of a patent for reasons of public order, law, morality, national security, public health, nutrition, national development or social security."

N.B. The term "public interest" has been deleted here since it is too general and may give rise to differences between the Contracting Parties when interpreted with respect to patents.

[End]

PLT/DC/50

June 10, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 11(2)

At the end of Article 11(2)(c) of the basic proposal in document PLT/DC/3, the following sentence should be added:

"Further, any Contracting Party shall be free to exclude from the prior art matter which is not identified and organized in a manner that makes the matter accessible to the public."

[End]

PLT/DC/51

June 10, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 13

Article 13 should be amended by adding the following new paragraph:

"(5) Not more than one patent shall be granted on two or more applications by the same applicant or inventor to the extent that they claim identical subject matter."

[End]

PLT/DC/52

June 10, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 15(4)

Article 15(4) should be amended as follows:

"(4) [Circumstances in Which Publication May Not Take Place] ~~(a) No application may be published if it is withdrawn or abandoned or is considered withdrawn or abandoned~~ not pending or is considered not pending

(i) earlier than two months before the expiration of the time limit applicable under paragraph (1) or,

(ii) to the extent that a Contracting Party can effect withdrawal prior to publication, where the Office completes the technical preparations for publication later than two months before the expiration of the time limit applicable under paragraph (1), prior to the completion of such preparations.

~~(b) No application may be published if it has been rejected."~~

[End]

PLT/DC/53

June 10, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 16(2)

Article 16(2)(c) should be amended to read:

"(2)(c) The Office shall, wherever possible, reach ~~→~~ final decisions on ~~the~~ applications not later than two years after the start of substantive examination and shall, in any event, reach final decisions on applications in no longer than an average of two years."

[End]

PLT/DC/54

June 10, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 17(1)

The following sentence should be added to Article 17(1):

"A Contracting Party shall be free to provide that changes made must be to correct errors made in good faith."

Comment: Paragraph (1) of the Article should be amended to make it clear that a Contracting Party shall be free to provide that changes limiting patent protection will only be made to correct errors made in good faith.

[End]

PLT/DC/55

June 11, 1991 (Original: English)

Source: THE PLENARY OF THE DIPLOMATIC CONFERENCE

Rules of Procedure

Editor's Note: The Rules of Procedure adopted by the Diplomatic Conference are those set forth in document PLT/DC/2 (See pages 62 to 77 of these Records) with the following changes:

1. Rule 14(1), in the fourth line, after "Committee" the following was added: "and four Member Delegations elected by the Conference, meeting in Plenary."
2. Rule 15(1), it was decided that twelve, rather than ten, Vice-Presidents would be elected by the Conference.

[End]

PLT/DC/56

June 11, 1991 (Original: English/French)

Source: THE DELEGATION OF SWITZERLAND

Draft Article 8 and Rule 7

Article 8 should be amended to read as follows:

"(1) [No change]

(2) [Permitted Additional Requirements] (a) A Contracting Party may provide that the filing date may be refused if either of the following requirements is not satisfied ~~within the prescribed time limit:~~

(i) the application contains a part which, on the face of it, appears to be a claim or claims;

(ii) the required fee is paid.

[PLT/DC/56, continued]

~~Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with later than the date of receipt by the Office of the elements referred to in paragraph (1), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.~~

(b) [No change]

(3) [No change]

(4) [Replacing Description, Claims and Drawings by Reference to Another Application] Notwithstanding paragraphs (1), (2) and (3),

Alternative A: each Contracting Party shall

Alternative B: any Contracting Party may

provide that a reference in the application to another previously filed application for the same invention by the same applicant or his predecessor in title may, for the purposes of the filing date of the application, replace any of the following elements:

(i) the part which, on the face of it, appears to be a description of an invention,

(ii) the part which, on the face of it, appears to be a claim or claims, or

(iii) any drawings,

~~provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office within the prescribed time limit. If the said parts and drawings, and, where required, the certified copy, are received by the Office within the said time limit, the filing date of the application shall, provided that the other requirements concerning the filing date are fulfilled, be the date on which the application containing the reference to the previously filed application was received by the Office.~~

(5) [Language] (a) [No change]

(b) Any Contracting Party may, if any of the parts referred to in paragraph (1)(iii) and paragraph (2)(a)(i) or any text matter contained in any drawings is in a language other than the official language, require that a translation thereof in the official language be received by its Office ~~within the prescribed time limit. If the translation is so received, the filing date of the application shall be the date of receipt by the Office of the elements referred to in paragraph (1) in the language in which they were first received.~~

(c) Any Contracting Party may require that the parts referred to in paragraph (4)(i) and (ii) and any text matter contained in drawings referred to in paragraph (4)(iii) be furnished in the official language ~~within the time limit referred to in paragraph (4).~~

(d) [No change]

[PLT/DC/56, continued]

(6) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with the requirements of paragraph (1) or any applicable requirements of paragraphs (2)(a), (4) or (5)(b), the Office shall promptly invite the applicant to comply with such requirements as prescribed. If the applicant complies with the invitation, the filing date shall be the date on which the elements referred to in paragraph (1) have been received by the Office or, in the case referred to in paragraph (4), the date on which the application containing the reference to the previously filed application was received by the Office. Otherwise, the application shall be treated as if it had not been filed.

~~(6)~~ (7) [Title and text same as paragraph (6) of the Basic Proposal]"

Rule 7 should be amended to read as follows:

"(1) [Deleted]

~~(2)~~ (1) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with any of the requirements of Article 8(1), ~~or the applicable requirements, if any, of Article 8(2)(a), Article 8(4) or Article 8(5)(b) that the application must satisfy either on receipt or within the time limit applicable under paragraph (1),~~ the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which time limit shall be at least one month from the date of the invitation ~~or, where the non-compliance relates to a matter for which a time limit for compliance is established by paragraph (1), the time limit referred to in paragraph (1), whichever expires later.~~ Compliance with the invitation may be subject to the payment of a special fee. Failure to send an invitation shall not alter the said requirements.

(3) [Deleted]

~~(4)~~ (2) [Title and text same as paragraph (4) of the Basic Proposal]

~~(5)~~ (3) [Correction of Translations] Any translation of the parts of the application, or of the text matter, referred to in Article 8(5)(b) and (c) may be corrected at any time up to at least the time when the application is in order for grant in order to conform to the wording of those parts or that text matter furnished in a language other than the official language."

Explanatory Notes

1. Article 8, new paragraph (6)

The procedural provisions of new paragraph (6) have been transferred from Rule 7(3) because it is felt that the legal consequences affecting the existence of the application should be embodied in the Treaty.

2. Rule 7

Rule 7 has been redrafted to reflect the need for a more simplified one-stage procedure with a single prescribed time limit.

[End]

PLT/DC/57

June 11, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED KINGDOM

Draft Rule 2(2)

Rule 2(2) should be amended to read as follows:

"(2) [Manner and Order of Presentation of Contents] (a) The contents of the description shall be presented in the manner and order specified in paragraph (1), unless, because of the nature of the invention, a different manner or a different order would afford a better understanding or a more economical presentation.

(b) Any Contracting Party may accept a description which does not contain the matters specified in paragraph (1)(i), (ii) and (v), or which contains, in lieu of the matter specified in paragraph (1)(iii), a description of the invention in any terms that satisfy the requirement of a disclosure of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art."

[End]

PLT/DC/58

June 11, 1991 (Original: English)

Source: THE DELEGATION OF GERMANY

Draft Article 3(1)

Article 3(1)(b) should be amended to read as follows:

"(b) Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. The deposit shall be made on or before the filing date. However, any Contracting Party may provide that the deposit may also be made after the filing date."

[PLT/DC/58, continued]

Note: It is understood that when an application referring to biologically reproducible material claims the priority of an earlier application and when the deposit has been made on or before the filing date, but after the priority date, the effect would be that the priority would not have been validly claimed, rather than that the requirement of disclosure under subparagraph (b) would not be fulfilled. This would however be different if a country would choose the option under the last sentence.

[End]

PLT/DC/59

June 12, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 18(1)

1. In Article 18(1)(b), the phrase "announcement in the official gazette of the grant of the patent" should be changed to "publication of the patent."
2. Delete Article 18(1)(d) and (e) and substitute the following new paragraph (d):

"(1)(d) Any party requesting revocation shall have at least one opportunity to present full arguments to the Office relating to the permissible grounds for revocation. The owner of the patent shall have at least one opportunity to amend the claims and otherwise respond to all arguments and grounds made for revocation before a decision is made in respect of the request for revocation. The decision of the Office may only be based on grounds or evidence on which the owner of the patent has had an opportunity to present its comments."

[End]

PLT/DC/60

June 12, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 20(1)

Article 20(1) [Right of Prior User] Alternative A should be amended to read as follows:

"Any Contracting Party may provide that, notwithstanding Article 19, a patent shall have no effect against any person (hereinafter referred to as "the prior user") who, in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using ~~the~~ his invention or was making effective and serious preparations for such use; any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations."

[End]

PLT/DC/61

June 12, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 21(3)

The following sentence should be added to Article 21(3):

"Changes made in the claims in response to the citation of prior art shall be taken into account when determining the extent of protection."

[End]

PLT/DC/62

June 12, 1991 (Original: English)

Source: THE DELEGATION OF THE UNITED STATES OF AMERICA

Draft Article 23

Article 23 should be amended to read as follows:

"(1) [Enforcement Based on Patents] (a) The owner of the patent shall have at least the right

(i) to obtain an injunction to restrain the performance or the likely performance, by any person without his authorization, of any of the acts referred to in Article 19(1), (2) and (4);

(ii) to obtain damages, adequate under the circumstances, from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4), ~~where the said person was or should have been aware of the patent.~~ A Contracting Party shall be free to require notice of the patent as a condition to obtaining damages.

(b) Each Contracting Party shall have the freedom to determine the liability for products directly resulting from the use of a patented process where the products are in possession or transit prior to becoming aware of the patent.

(c) Notwithstanding subparagraph (a)(i), whenever an invention is used or manufactured by or for a Contracting Party for public, non-commercial purposes, any Contracting Party may provide that the owner shall only have the right to obtain damages in accordance with subparagraph (a)(ii).

(2)(a) [unchanged]

(b) [unchanged]

(c) For the purposes of subparagraphs (a) and (b), the extent of the protection shall be determined by the claims as appearing in the published application. However, if the claims are amended after the initial publication of the application, the extent of the protection shall be determined by the amended claims in respect of the period following their publication. ~~Furthermore, if the claims of the patent as granted or as changed after its grant have a narrower scope than the claims in the application, the extent of the protection shall be determined by the claims with the narrower scope.~~ The extent of protection conferred by the claims appearing in the published application or by subsequently published amended claims shall be determined by the claims appearing in the patent granted on that application, at least to the extent that claims of substantially the same scope appeared in the application as published or in the application as subsequently published."

[End]

PLT/DC/63

June 12, 1991 (Original: French)

Source: THE DELEGATION OF FRANCE

Draft Article 21

Article 21 should be amended to read as follows:

"(1)(a) [Unchanged]

(b) [Unchanged]

(2) [Equivalents] For the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements which, at the date of the alleged infringement, are equivalent to the elements expressed in the claims.

(3) [Prior Statements] In determining the extent of protection, any Contracting Party may provide that due account shall be taken of any statement unequivocally limiting the scope of the claims made by the applicant or the owner of the patent during procedures concerning the grant or the validity of the patent.

(4) [Unchanged]

(5) [Unchanged]"

[End]

PLT/DC/64

June 13, 1991 (Original: English)

Source: THE DELEGATION OF CANADA

Draft Article 21(2)

Article 21(2)(b) should be amended to read as follows:

"(b) An element ("the equivalent element") shall generally be considered as being equivalent to an element as expressed in a claim if, at the time of any alleged infringement, the following conditions are fulfilled in regard to the invention as claimed:

[PLT/DC/64, continued]

(i) the equivalent element performs substantially the same function in substantially the same way and produces substantially the same result as the element as expressed in the claim, and

(ii) it is obvious to a person skilled in the art that the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element."

[End]

PLT/DC/65

June 14, 1991 (Original: English)

Source: THE DELEGATION OF ISRAEL

Draft Article 14

Article 14 should be amended by adding the following new paragraph:

"(4) Notwithstanding the provisions of the preceding paragraph (3) a Contracting Party may allow an amendment or a correction of the application to be made which goes beyond what has been disclosed in the application as filed provided that the effective filing date of the application in respect of the subject matter of the amendment will be the date of submission of the amendment to the Office."

Explanatory Note

The amendment is necessary in order to give Contracting Parties the option (which is already exercised by some of them) to allow amendments which broaden the scope of the original disclosure provided that the allowance of such an amendment may result in the partial or entire post-dating of the application.

[End]

PLT/DC/66

June 20, 1991 (Original: English)

Source: THE SECRETARIAT OF THE CONFERENCE

First Report of the Credentials Committee

1. The Credentials Committee (hereinafter referred to as "the Committee"), established on June 3, 1991, by the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents are Concerned (hereinafter referred to as "the Conference"), met on June 6, 1991, and on June 19, 1991.

2. The delegations of the following States members of the Committee attended the meetings: Brazil, Congo, Egypt, Finland, Germany, Ireland, Malaysia, New Zealand, Poland, Portugal and Sri Lanka (11).

3. At its first meeting, on June 6, 1991, the Committee unanimously elected Mr. Salah Kamel (Egypt) as Chairman and Mr. Affonso Arinos de Mello-Franco (Brazil) and Mr. Alfons Schäfers (Germany) as Vice-Chairmen.

4. In accordance with Rule 9(1) of the Rules of Procedure adopted by the Conference on June 3, 1991 (hereinafter referred to as "the Rules of Procedure"), the Committee examined, at its second meeting, on June 19, 1991, the credentials, full powers, letters or other documents of appointment presented for the purposes of Rules 6 and 7 by delegations of States members of the International (Paris) Union for the Protection of Industrial Property (hereinafter referred to as "the Paris Union"), participating in the Conference in accordance with Rule 2(1)(i) of the Rules of Procedure (hereinafter referred to as "Member Delegations"), by delegations of States members of the World Intellectual Property Organization (WIPO) other than those members of the Paris Union, participating in the Conference in accordance with Rule 2(1)(ii) of the Rules of Procedure (hereinafter referred to as "Observer Delegations"), and by the delegations of the European Patent Organisation and the Organisation africaine de la propriété intellectuelle, participating in the Conference in accordance with Rule 2(1)(iii) of the Rules of Procedure (hereinafter referred to as "Special Delegations"), as well as by the representatives of intergovernmental and non-governmental organizations, participating in the Conference in accordance with Rule 2(1)(iv) of the Rules of Procedure (hereinafter referred to as "representatives of Observer Organizations").

5. On the basis of the information provided by the Secretariat as to the practice prevailing in other diplomatic conferences and in particular in diplomatic conferences convened by the World Intellectual Property Organization (WIPO), the Committee decided to recommend to the Conference, meeting in Plenary, that the following criteria should be applied by the Committee in its examination of, and should govern the decision of the Conference on, the credentials, full powers, letters or other documents presented for the purposes of Rules 6 and 7 of the Rules of Procedure:

- (i) as far as any State is concerned, its delegation's credentials and full powers should be accepted if they were signed by that State's Head of State, Head of Government or Minister for Foreign Affairs;

[PLT/DC/66, continued]

credentials, but not full powers, should be accepted if they were contained in a note verbale or letter of that State's Permanent Representative in Geneva or its Ambassador to the Government of the Netherlands, or in a note verbale of that State's Ministry for Foreign Affairs or its Permanent Mission in Geneva or its Embassy in The Hague, and should not otherwise be accepted, in particular, a communication emanating from a Minister other than the Minister for Foreign Affairs, or from an official other than the Permanent Representative or Chargé d'affaires a.i. of a Permanent Mission in Geneva or the Ambassador to the Government of the Netherlands, should not be treated as credentials;

(ii) as far as any Organization is concerned, its representative's letter or other document of appointment should be accepted if it is signed by the Head (Director General, Secretary General or President) or Deputy Head or official responsible for external affairs of the Organization;

(iii) facsimile and telex communications should be accepted if, as to their source, the requirements stated in points (i) and (ii) were fulfilled.

6. Pending a final decision by the Conference, meeting in Plenary, on the said criteria, the Committee decided to apply those criteria to the documents received by it.

7. Accordingly, the Committee found in order

(a) as far as Member Delegations are concerned,

(i) the credentials and full powers (that is, credentials for participating in the Conference and full powers to sign a treaty supplementing the Paris Convention for the Protection of Industrial Property as far as patents are concerned) of the delegations of the following 33 States:

Benin	Indonesia	Romania
Brazil	Italy	Rwanda
Burkina Faso	Lebanon	Senegal
Chad	Libya	Soviet Union
China	Malawi	Spain
Côte d'Ivoire	Mali	Switzerland
Denmark	Mongolia	United Republic
Egypt	New Zealand	of Tanzania
Ghana	Niger	Yugoslavia
Greece	Philippines	Zambia
Guinea	Poland	Zimbabwe
Guinea-Bissau		

[PLT/DC/66, continued]

(ii) the credentials (without full powers) of the delegations of the following 47 States:

Algeria	Gabon	Republic of Korea
Argentina	Germany	Sri Lanka
Australia	Hungary	Sudan
Austria	Iran (Islamic Republic of)	Swaziland
Bangladesh	Ireland	Sweden
Belgium	Japan	Syria
Bulgaria	Jordan	Togo
Burundi	Kenya	Trinidad and Tobago
Canada	Malaysia	Tunisia
Chile	Malta	Turkey
Cuba	Mauritania	Uganda
Czechoslovakia	Mexico	United Kingdom
Democratic People's Republic of Korea	Monaco	United States of America
Dominican Republic	Netherlands	Uruguay
Finland	Norway	Viet Nam
France	Portugal	

(h) as far as Observer Delegations are concerned, the credentials of the delegations of the following 3 States:

Peru
Thailand
Venezuela

(c) as far as the Special Delegations are concerned, the credentials of the Delegation of the European Patent Organisation and the Delegation of the Organisation africaine de la propriété intellectuelle.

(d) as far as the representatives of Observer Organizations are concerned, the letters or documents of appointment of representatives of the following Observer Organizations (listed in the alphabetical order of the name of the organization according to its name in French if it exists or, if it does not exist, according to its name in another language):

- (i) intergovernmental organizations: General Agreement on Tariffs and Trade (GATT); European Communities; Latin-American Economic System (SELA) (3);
- (ii) non-governmental organizations: American Bar Association (ABA); American Intellectual Property Law Association (AIPLA); Asociación Mexicana para la Protección de la Propiedad Industrial (AMPPI); Associação Brasileira da Propriedade Industrial (ABPI); Asian Patent Attorneys Association (APAA); Inter-American Association of Industrial Property (ASIPI); International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP); International Association for the Protection of Industrial Property (AIPPI); Latin American Association of Pharmaceutical Industries (ALIFAR); Association of Patent Attorneys, Netherlands (APA); Bundesverband der Deutschen Industrie e.V., Germany (BDI); Center for Advanced Study and Research on Intellectual Property,

[PLT/DC/66, continued]

United States of America (CASRIP); Center for International Industrial Property Studies (CEIPI); Chartered Institute of Patent Agents, United Kingdom (CIPA); Chemical Manufacturers Association, United States of America (CMA); Committee of National Institutes of Patent Agents (CNIPA); Committee for Industrial Property Studies, Netherlands (CIPS); Compagnie nationale des conseils en brevets d'inventions (CNCBI), France; European Council of Chemical Manufacturers' Federations (CEFIC); Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht (DVGR); Federal Chamber of Patent Agents (Patentanwaltskammer (PAK)), Germany (FCPA); European Federation of Pharmaceutical Industries' Associations (EFPIA); International Federation of Inventors' Associations (IFIA); International Federation of Industrial Property Attorneys (FICPI); International Group of National Associations of Manufacturers of Agrochemical Products (GIFAP); Patent and Trademark Institute of Canada (PTIC); Institute of Professional Representatives before the European Patent Office (EPI); Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law (MPI); Intellectual Property Owners, Inc., United States of America (IPO); Japan Patent Association (JPA); Japan Patent Attorneys Association (JPAA); Licensing Executives Society International (LES); International League on Competition Law (LIDC); The New York Patent, Trademark and Copyright Law Association, Inc. (NYPTC); Pacific Industrial Property Association (PIPA); Union of Industrial and Employers' Confederations of Europe (UNICE); Union of European Practitioners in Industrial Property (UEPIP) (37).

8. The Committee noted that, in accordance with established practices, a designation of representation implied, in principle, in the absence of any express reservation, the right of signature, and that it should be left to each delegation to interpret the scope of its credentials.

9. The Committee recommends to the Conference, meeting in Plenary, to accept the credentials and full powers of the delegations mentioned in paragraph 7(a), above, the credentials of the delegations mentioned in paragraph 7(b) and (c), above, and the letters or documents of appointment of the representatives of the organizations mentioned in paragraph 7(d), above.

10. The Committee recalled that the Conference, meeting in Plenary, when adopting Rule 8 of the Rules of Procedure, made the interpretation that credentials, full powers and letters or other documents of appointment presented for the first part of the Conference would be considered valid for the second part of the Conference unless they were superseded by new credentials, full powers or letters or other documents of appointment presented for the second part of the Conference.

11. The Committee expressed the wish that the Secretariat should bring Rules 6 ("Credentials and Full Powers"), 7 ("Letters of Appointment") and 10 ("Provisional Participation") of the Rules of Procedure to the attention of Member Delegations or Observer Delegations not having presented credentials or full powers and of the representatives of Observer Organizations not having presented letters or other documents of appointment.

[PLT/DC/66, continued]

12. The Committee noted that those Delegations and Observer Organizations that had not presented to the Conference at its first part their credentials or full powers or letters or other documents of appointment or wished to make changes in the composition of their delegations or representatives could do so at the second part of the Conference.

13. The Committee decided that a report on its meeting should be prepared by the Secretariat and issued as its report, to be presented by the Chairman of the Committee to the Conference, meeting in Plenary.

14. The Committee authorized its Chairman to examine any further communications concerning Member Delegations, Observer Delegations, Special Delegations or Observer Organizations which might be received by the Secretariat after the close of its second meeting and to report thereon to the Conference, meeting in Plenary, unless the Chairman deemed it necessary to convene the Committee to examine and report on those communications.

[End]

PLT/DC/67.

June 19, 1991 (Original: English)

Source: THE DELEGATION OF GERMANY

Draft Article 23(2)

Article 23(2) should be amended to read as follows:

"(2) [Enforcement Based on Published Applications] (a) The applicant shall have at least the right to obtain reasonable compensation from any person who, without his authorization, performed, in the period between the publication of the application and the grant of the patent thereon, any of the acts referred to in Article 19(1), (2) and (4) in relation to the invention as claimed in the published application, at least in the case where the said person was aware of the application.

(b) Any Contracting Party may provide that a decision to award any measures under subparagraph (a) may not be made until after the grant of a patent on the published application.

(c) For the purposes of subparagraphs (a) and (b), the extent of the protection shall be determined by the claims as appearing in the published application. However, if the claims of the patent as granted or as changed after its grant have a narrower scope than the claims as appearing in the published application, the extent of the protection shall be determined by the claims with the narrower scope."

[End]

PLT/DC/68

June 20, 1991 (Original: English)

Source: THE DELEGATION OF BANGLADESH

Draft Article 23(1)

The following item should be added to Article 23(1):

"(iii) Contracting States shall provide that a patent-holder shall not be entitled to any damage, in respect of any infringement of the patent, from any defendant who proves that at the date of the infringement he or she was not aware, nor had the reasonable means to be aware, of the existence of the patent."

PLT/DC/INF/1

June 21, 1991 (Original: English/French)

Source: THE SECRETARIAT OF THE CONFERENCE

Liste des participants de la première partie de la conférence diplomatique
List of Participants in the First Part of the Diplomatic Conference

Editor's Note: This document contains the list of participants. It is not reproduced here, but may be found at pages 525 to 554 of these Records.

[End]

PLT/DC/INF/2

June 11, 1991 (Original: English/French)

Source: THE SECRETARIAT OF THE CONFERENCE

Bureaux, Commissions et Comités
Officers and Committees

Editor's Note: This document contains a list of officers and members of the Main Committee, the Credentials Committee, the Drafting Committee and the Steering Committee. For the full list of officers of the Conference, see pages 555 to 557 of these Records.

[End]

PLT/DC/INF/3

June 21, 1991 (Original: English/French)

Source: THE INTERNATIONAL BUREAU

List of Proposals for Amendment of Provisions of the Basic Proposal Published Before and During the First Part of the Diplomatic Conference

Preamble:

- Lebanon (PLT/DC/44)

[PLT/DC/INF/3, continued]

Article 1 (Establishment of a Union):

- Netherlands (PLT/DC/12)

Article 2 (Definitions):

- Netherlands (PLT/DC/13)
- Israel (PLT/DC/29)

Article 3 (Disclosure and Description):

Paragraph (1) (Disclosure):

- Lebanon (PLT/DC/45)
- Germany (PLT/DC/58)

Paragraph (2) (Description):

- Israel (PLT/DC/30)

Article 4 (Claims):

Paragraph (3) (Style of the Claims):

- Israel (PLT/DC/31)
- United Kingdom (PLT/DC/33)

Article 5 (Unity of Invention):

- Israel (PLT/DC/32)

Article 6 (Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant):

Paragraph (2) (Mention of the Inventor in Publications of the Office):

- Japan (PLT/DC/17)

Paragraph (4) (Prohibition of Other Requirements):

- Japan (PLT/DC/17)

Article 7 (Related Claiming of Priority):

- Lebanon (PLT/DC/46)

[PLT/DC/INF/3, continued]

Paragraph (2) (Delayed Filing of the Subsequent Application):

- Israel (PLT/DC/42)

Article 8 (Filing Date):

- Ireland (PLT/DC/10 Rev.)
- Lebanon (PLT/DC/47)
- Switzerland (PLT/DC/56)

Paragraph (3) (Drawings):

- Japan (PLT/DC/18)

Article 9 (Right to a Patent):

Paragraph (1) (Right of Inventor):

- United Kingdom (PLT/DC/35)
- Israel (PLT/DC/43)
- Lebanon (PLT/DC/48)

Paragraph (2) (Right Where Several Inventors Independently Made the Same Invention):

- United States of America (PLT/DC/6)

Paragraph (3) (Right of Third Party):

- Israel (PLT/DC/43)

Article 9bis (Loss of Right):

- United States of America (PLT/DC/40 Rev.)

Article 10 (Fields of Technology):

- Lebanon (PLT/DC/49)

Article 11 (Conditions of Patentability):

Paragraph (2) (Novelty):

- United States of America (PLT/DC/6, 41 and 50)

[PLT/DC/INF/3, continued]

Paragraph (3) (Inventive Step (Non-Obviousness)):

- United States of America (PLT/DC/6)

Article 13 (Prior Art Effect of Certain Applications):

- United States of America (PLT/DC/51)

Paragraph (1) (Principle of "Whole Contents"):

- United States of America (PLT/DC/6)
- Sweden (PLT/DC/11)
- Japan (PLT/DC/19)

Article 14 (Amendment or Correction of Application):

- Israel (PLT/DC/65)

Article 15 (Publication of Application):

Paragraph (1) (Requirement to Publish the Application):

- Japan (PLT/DC/20)

Paragraph (4) (Circumstances in Which Publication May Not Take Place):

- Norway (PLT/DC/7)
- United States of America (PLT/DC/52)

Article 16 (Time Limits for Search and Substantive Examination):

- Japan (PLT/DC/21)

Paragraph (1) (Time Limits for Search):

- Norway (PLT/DC/8)
- Germany (PLT/DC/36)

Paragraph (2) (Time Limits for Substantive Examination):

- Norway (PLT/DC/8)
- Germany (PLT/DC/36)
- United States of America (PLT/DC/53)

[PLT/DC/INF/3, continued]

Article 17 (Changes in Patents):

Paragraph (1) (Limitation of Extent of Protection):

- United States of America (PLT/DC/54)

Paragraph (4) (Changes Affecting the Disclosure):

- Japan (PLT/DC/22)

Article 18 (Administrative Revocation):

Paragraph (1) (Administrative Revocation):

- United States of America (PLT/DC/59)

Article 19 (Rights Conferred by the Patent):

Paragraph (2) (Processes):

- Germany (PLT/DC/37)

Paragraph (3) (Exceptions to Paragraphs (1) and (2)):

- Netherlands (PLT/DC/14)
- Japan (PLT/DC/23)

Article 20 (Prior User):

Paragraph (1) (Right of Prior User):

- Switzerland (PLT/DC/9)
- United States of America (PLT/DC/60)

Article 21 (Extent of Protection and Interpretation of Claims):

- France (PLT/DC/63)

Paragraph (2) (Equivalentents):

- Japan (PLT/DC/24 Rev.)
- Canada (PLT/DC/64)

Paragraph (3) (Prior Statement):

- United States of America (PLT/DC/61)

[PLT/DC/INF/3, continued]

Article 22 (Term of Patents):

- Japan (PLT/DC/25)

Article 23 (Enforcement of Rights):

- United States of America (PLT/DC/62)

Paragraph (1) (Enforcement Based on Patents):

- Netherlands (PLT/DC/15)
- Bangladesh (PLT/DC/68)

Paragraph (2) (Enforcement Based on Published Applications):

- Germany (PLT/DC/67)

Article 24 (Reversal of Burden of Proof):

- Japan (PLT/DC/26)
- Germany (PLT/DC/38)

Rule 2 (Contents and Order of Description (ad Article 3(2)):

Paragraph (1) (Contents of Description):

- Germany (PLT/DC/39)

Paragraph (2) (Manner and Order of Presentation of Contents):

- United Kingdom (PLT/DC/57)

Paragraph (3) (Nucleotides and Amino Acid Sequences):

- Japan (PLT/DC/27)

Rule 3 (Manner of Claiming (ad Article 4(5)):

Paragraph (2) (Method of Definition of Invention):

- United Kingdom (PLT/DC/34)

Paragraph (4) (References in the Claims to the Description and Drawings):

- Japan (PLT/DC/28)

[PLT/DC/INF/3, continued]

Rule 7 (Details Concerning the Filing Date Requirements (ad Article 8)):

- Ireland (PLT/DC/10 Rev.)
- Switzerland (PLT/DC/56)

Paragraph (4) (Date of Receipt):

- Netherlands (PLT/DC/16)

[End]

PLT/DC/INF/4

June 21, 1991 (Original: English/French)

Source: THE SECRETARIAT OF THE CONFERENCE

List of Documents Issued Before and During the First Part of the Diplomatic Conference

Editor's Note: This document contains the full list of documents of the Diplomatic Conference. It is not reproduced here, but may be found at pages 57 to 60 of these Records.

[End]

SUMMARY MINUTES

PLENARY OF THE DIPLOMATIC CONFERENCE

President: Mr. M. Engels (Netherlands)

Secretary: Mr. L. Baeumer (WIPO)

<p><u>First Meeting</u> <u>Monday, June 3, 1991</u> <u>Morning</u></p>

Opening of the Conference

1.1 Mr. BOGSCH (Director General of WIPO) opened the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents are Concerned and welcomed the participants.

1.2 He stated that the Conference was taking place at The Hague at the invitation of the Government of the Netherlands. It was an honor to have Her Excellency Mrs. Y.M.C.T. van Rooy, Minister for Foreign Trade (Economic Affairs) of the Netherlands present at the Opening Ceremony, as well as Mr. A.J.E. Havermans, Burgomaster of The Hague. Mr. Bogsch expressed his gratitude to the Minister for the excellence of the arrangements that had been made. He stated that the Conference was taking place in a centre which was outstanding from both the practical and aesthetic points of view. He then invited Her Excellency Mrs. Y.M.C.T. van Rooy, Minister for Foreign Trade (Economic Affairs) to address the Plenary.

2.1 Mrs. Y.M.T.C. VAN ROOY (Netherlands), on behalf of the Government of the Netherlands, thanked the Director General, Mr. Bogsch, for the opportunity to express some words of welcome at the start of the Diplomatic Conference.

2.2 She stated that it was a great pleasure to welcome the participants who had come from every part of the world to discuss the harmonization of patent law. The Government of the Netherlands considered the work of WIPO to be extremely important for the development of a legislative system of intellectual property, which promoted world prosperity and contributed to the distribution of that prosperity among the different peoples of the world. Patent law played an important role in this context as it related to those products of the intellect that together made up technological progress. The delegates carried the primary responsibility of ensuring that, in an age of rapid technological advances, patent law kept pace with technological changes and remained capable of producing fair and effective results in changing circumstances.

2.3 The Minister stated that further harmonization of patent law was not only a worthwhile objective but also a necessity. The process of harmonization involved far more than the creation of a strong system which satisfied the aesthetic needs of a small number of specialists. By the very nature of the issue, only a system in which the main points corresponded on a worldwide scale could work effectively. The Minister stated that the question of whether an invention was eligible for patent protection should be answered on the basis of the criterion of novelty which had no limits. In addition, international trade was growing to the extent that differences between national or regional patent systems would increasingly act as barriers.

2.4 The Minister noted that the last diplomatic conference held concerning intellectual property at The Hague was in 1960, when the Hague Agreement Concerning the International Deposit of Industrial Designs had been concluded. She believed that there was only one participant present at that Diplomatic Conference who was also present today, namely, Mr. Arpad Bogisch, who had been present in 1960 as a Delegate of the United States of America and who was now participating as Director General of WIPO. Mr. Bogisch's presence represented a continuity in a personal capacity over a period of 31 years. In a much broader sense, his presence represented a continuity in the field of intellectual property in a professional capacity and the Government of the Netherlands was proud to have Mr. Bogisch at the present Conference.

2.5 The Minister stated that it could not be denied that the background to the present Diplomatic Conference had been a difficult one. Technical preparations had taken place over many years and the venue of The Hague and the dates for the Diplomatic Conference had been established in September 1990. Some weeks ago, however, altered circumstances had led to the decision to hold the Conference in two parts and to shorten the first part of the Conference by one week. As the host country, the Netherlands regretted that the decision had to be taken. As a member State of the Paris Union, however, the Netherlands understood the reasons for that decision. She noted the change in structure might also affect the nature of the talks during the first part of the Conference since there was no longer any deadline for reaching agreement. The absence of a deadline might be an advantage, since there would be less pressure. However, it was important that the Conference should not succumb to the tendency to relax, since it was extremely important that patent law should keep pace with technological change. Moreover, the results of the first part would be important for deciding when the second part would take place.

2.6 The Minister concluded by wishing the participants wisdom and success in the Conference as well as an enjoyable time. She recalled that the sea was always close at hand to cool down the atmosphere if the temperature of the discussions rose too much.

3. Mr. BOGICH (Director General of WIPO) thanked the Minister for Foreign Trade (Economic Affairs) for her inspiring speech.

4.1 Mr. HAVERMANS (Burgomaster of The Hague) welcomed the participants to the city of The Hague. He stated that the city was honored to have been chosen as the venue for the Diplomatic Conference. He regarded that choice as a most sensible one, in view of the fact that the city had had, for centuries, a very rich diplomatic tradition and had been, for decades, home to institutions practising the harmonization of patent law.

4.2 He stated that The Hague was a step on a road which had begun in 1883 with the conclusion for the Paris Convention for the Protection of Industrial Property. More than a century after that Convention had been concluded, an attempt was now being made to achieve harmonization. That was not an easy task since it involved bringing into line the legislation of more than 100 countries. The Conference had been preceded by six years of difficult preparatory negotiations.

4.3 The Burgomaster stated that The Hague was very much familiar with the process of making decisions. He referred to the discussions that were taking place on the location of the European Trademark Office, in which discussions he had participated personally for six years. He stated that the decision on the location was a political one. Only two or three cities were left in the running and The Hague was one of them. Legislation on the European Trademark was still awaited, and depended on decisions concerning the languages to be used and the seat of the Office. He stated that languages would pose no problem in The Hague which had a polyglot tradition and had amongst its facilities all the international schools that could be desired. The city had also an internationally oriented approach, and was home to business institutions, international corporations and international institutions, including the European Patent Office and the Benelux Trademarks Office, both of which had decided to build new buildings near the center of the city.

4.4 The Burgomaster drew attention to the social program which had been organized for the participants in the Diplomatic Conference, stating that it provided an opportunity for the participants to become familiar with both the city and the country, as well as their cultural, architectural, business and political traditions. He hoped that, at the end of their visit, the participants would consider The Hague to be a fine city in which to live and work. He wished the Conference every success and stated that the participants were always welcome at any time again at The Hague.

5. Mr. BOGSCH (Director General of WIPO) stated that he was sure that all the delegates would agree that the choice of The Hague was a particularly happy one. He thanked the Minister for Foreign Trade (Economic Affairs) for having come, together with the Burgomaster of The Hague, to open the Diplomatic Conference. He then suspended the meeting.

[Suspension]

6.1 Mr. BOGSCH (Director General of WIPO) resumed the meeting and referred to the draft Agenda contained in document PLT/DC/1. He stated that the draft Agenda had been established by the Preparatory Meeting, which had met in June 1991. The draft Agenda would serve as a guide until the meeting reached the question of the adoption of the Agenda, which was presently item number 5 on the draft Agenda.

6.2 The Director General stated that the draft Agenda together with the Draft Rules of Procedure contained in document PLT/DC/2 had to be read in conjunction with the decision of the Paris Union Assembly taken at its extraordinary session held on April 29 and 30, 1991. In particular, it was to be recalled that the present meeting constituted the first part of the Diplomatic Conference and that this first part would discuss the provisions of

the Basic Proposal. It was understood when that decision had been made by the Assembly of the Paris Union that a final decision on all Articles would only be taken at the second part of the Diplomatic Conference. The reference of a final decision on all provisions to the second part of the Diplomatic Conference was to be emphasized since most delegations considered the draft Treaty as a package.

Consideration and Adoption of the Rules of Procedure

6.3 The Director General then asked the meeting to turn to a consideration of the Draft Rules of Procedure contained in document PLT/DC/2. By way of introduction, he stated that, although certain situations envisaged in the draft Rules were likely to become operative only rarely, if at all, during the first part of the Diplomatic Conference, it was nevertheless necessary to adopt draft Rules for the Diplomatic Conference as a whole. He stated that, for example, it might be expected that the Drafting Committee would meet rarely, if at all, during the first part of the Diplomatic Conference.

6.4 The Director General asked whether, before considering the draft Rules of Procedure one by one, any delegation wished to make any observations on the draft Rules as a whole. There being no such observations, he invited the meeting to consider each draft Rule.

6.5 He then turned to Rules 1 to 7 which, in the absence of discussion, he declared to be adopted.

6.6 He then took up Rule 8 (Presentation of Credentials, etc.).

7. Mr. TROMBETTA (Argentina) asked whether, since the Diplomatic Conference was to be held in two parts, new credentials would need to be presented for the second part of the Diplomatic Conference.

8.1 Mr. BOGSCH (Director General of WIPO) stated that credentials presented for the first part of the Diplomatic Conference would be considered valid for the second part of the Diplomatic Conference unless they were superseded by new credentials presented for the second part. With this interpretation, and in the absence of further discussion, he declared Rule 8 adopted.

8.2 He then turned to Rules 9 to 11 which, in the absence of discussion, he declared to be adopted.

8.3 The Director General then took up Rule 12 (Main Committees and Working Groups).

9. Mr. TROMBETTA (Argentina) proposed the deletion of the word "substantive" in line 1 of paragraph (1)(ii) on the basis that the provisions in question were identified by their titles so that it was unnecessary to qualify their nature.

10.1 Mr. BOGSCH (Director General of WIPO) explained that the word "substantive" had been inserted in order to distinguish the provisions so qualified from the administrative provisions and final clauses referred to in the second last line of paragraph (1)(ii).

10.2 He asked whether there was a seconder for the proposal of the Delegation of Argentina. There being no such seconder, he declared Rule 12 to be adopted as proposed in document PLT/DC/2.

10.3 He then took up Rules 13 to 16 which, in the absence of any discussion, he declared to be adopted.

10.4 He then moved to Rule 17 (Replacement of President or Chairman), which he emphasized might assume particular importance in a diplomatic conference held in two parts, since the election of a new President or of a Chairman for the second part would become necessary should the President or any Chairman elected during the first part not be available for the second part. If they continued to be available, of course, the President and Chairmen would be the same for the second part of the Conference as those elected for the first part. In the absence of any further discussion, he declared Rule 17 to be adopted.

10.5 He then moved to Rules 18 to 41 which, in the absence of discussion, he declared to be adopted.

10.6 Turning to Rule 42, the Director General stated that, in view of the two parts of the Conference, it was important that the summary minutes during the first part be available as soon as possible. He indicated that provisional summary minutes of the Plenary meetings of the Conference and of the meetings of the Main Committees during the first part would be prepared in English during the course of the first part of the Conference. These provisional summary minutes would then be submitted for approval to each delegation concerned. There being no other discussion, he declared Rule 42 adopted.

10.7 He then took up Rules 43 to 49 and, in the absence of any discussion, he declared Rules 43 to 49 adopted.

10.8 The Director General declared the totality of the Rules of Procedure to be adopted.

Election of the President of the Conference

10.9 The Director General then turned to item 3 on the draft Agenda contained in document PLT/DC/1, namely, the election of the President of the Conference. He invited nominations for the office of President from the floor.

11. Mr. MANBECK (United States of America) proposed Mr. Max Engels, President of the Netherlands Patent Office, as President of the Conference. He stated that he was certain that the Conference could achieve the maximum of success under the skillful guidance of Mr. Engels.

12. Mr. SCHAEFERS (Germany) seconded the proposal of the Delegation of the United States of America to elect Mr. Engels as President of the Conference.

13. Mr. TROMBETTA (Argentina) expressed the pleasure that his Delegation had in seconding the proposal of the United States of America.

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14. Mr. COMBALDIEU (France) supported the proposal by the Delegation of the United States of America.
 15. Mr. SIAHAAN (Indonesia) expressed the support of his Delegation for the proposal of the United States of America.
 16. Mr. GAO (China) supported the proposal of the Delegation of the United States of America to elect Mr. Engels as President of the Conference.
 17. Mr. TIGBO (Cameroon) stated that his Delegation supported the proposal by the Delegation of the United States of America.
 18. Mr. ENÄRJÄRVI (Finland) supported the proposal to elect Mr. Engels as President of the Conference.
 19. Mr. UEMURA (Japan) joined in supporting the proposal of the Delegation of the United States of America.
 20. Mr. JAYASINGHE (Sri Lanka) expressed the pleasure his Delegation had in supporting the proposal of the Delegation of the United States of America.
 21. Mr. HATOUM (Lebanon) supported the proposal to elect Mr. Engels as President of the Conference.
 22. Mr. KIM (Republic of Korea) supported the proposal of the Delegation of the United States of America.
 23. Mr. de MELLO-FRANCO (Brazil) supported the proposal of the Delegation of the United States of America.
 24. Mr. GARIEPY (Canada) joined in supporting the proposal to elect Mr. Engels as President of the Conference.
 25. Mr. KHUMALO (Swaziland) supported the proposal of the Delegation of the United States of America.
 26. Mr. GROSSENBACHER (Switzerland) expressed his Delegation's pleasure in supporting the proposal by the Delegation of the United States of America.
 27. Mr. HIEN (Burkina Faso) supported the proposal made by the Delegation of the United States of America.
 28. Mr. HACHEME (Benin) supported the proposal made by the Delegation of the United States of America.
 29. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for the election of Mr. Engels as President of the Conference.
 30. Mr. WIERZBICKI (New Zealand) warmly welcomed the proposal of the Delegation of the United States of America.
 31. Mr. JILANI (Tunisia) supported the proposal to elect Mr. Engels as President of the Conference.

32. Ms. KRUDO SANES (Uruguay) supported the proposal of the Delegation of the United States of America.
33. Mr. BOHTE (Yugoslavia) expressed the pleasure his Delegation had in adding its voice to the proposal to elect Mr. Engels as President of the Conference.
34. Mr. BULGAR (Romania) expressed his Delegation's support for the proposal by the Delegation of the United States of America.
35. Mr. ABU BAKAR (Malaysia) supported the proposal to elect Mr. Engels as President of the Conference.
36. Mr. UNAN (Turkey) supported the proposal of the Delegation of the United States of America.
37. Mr. NTAHOMVUKIYE (Burundi) stated that his Delegation had no objection to the proposal made by the Delegation of the United States of America.
38. Mr. BOGSCH (Director General of WIPO) expressed his pleasure that such a great number of delegations had supported the proposal of the Delegation of the United States of America to elect Mr. Engels as President of the Conference. He declared Mr. Engels to be elected by acclamation as President. He then congratulated Mr. Engels and asked him to take the chair designated for the President.
- 39.1 The PRESIDENT thanked the Director General, Mr. Bogsch, and expressed his thanks to all of the delegations for the confidence which they had manifested in him in electing him as President. He welcomed all the observers present, stating that he expected that they would bring to the deliberations a wealth of experience.
- 39.2 He stated that it was of great importance that all delegations should cooperate during the three weeks of the first part of the Conference in order to maximize the results to be obtained. He emphasized that the interests at stake were of essential importance to the use of patents and to industrial property offices throughout the world. While the adoption of the Basic Proposal was not feasible at this stage, he hoped that the three weeks of the first part could be used in order to clarify the mutual positions of the various delegations in order to facilitate the second part of the Conference and to ensure that that second part would take place in the not too distant future. He then adjourned the meeting.

[Suspension]

Election of the Vice-Presidents of the Conference

- 40.1 The PRESIDENT resumed the meeting and turned to a consideration of item 4 (Election of the Vice-Presidents of the Conference) on the draft Agenda contained in document PLT/DC/1. He indicated that this item, together with items 6 (Election of the members of the Credentials Committee) and 7 (Election of the members of the Drafting Committee) often, as experience showed, required lengthy deliberations. He suggested that consideration be given to

the adoption of an informal procedure whereby an informal meeting would be convened between three ad hoc representatives from the developing countries, three ad hoc representatives from the industrialized countries, a representative of China and a representative of the Soviet Union. The aim of the informal meeting would be to prepare an informal agreement on the way in which to proceed on items 4, 6 and 7 of the draft Agenda.

40.2 There being no objections to the informal procedure proposed by the President, the President adjourned the meeting so that the informal group could convene.

[Suspension]

41. The PRESIDENT resumed the meeting and reported that the informal consultations of the ad hoc representatives of the developing countries, industrialized countries, China and the Soviet Union had indicated an interest in pursuing the informal discussions on the election of officers for the Conference. He emphasized that these informal discussions were not intended to replace the decision of the Plenary, but merely to speed up the process of taking that decision. He invited Mr. Ledakis (WIPO) to give indications on the availability of meeting rooms for meetings of the various groups.

42. Mr. LEDAKIS (WIPO) gave indications of meeting rooms in the conference center.

43. Mr. MOTA MAIA (Portugal) congratulated the President on his election and on the excellence of the arrangements made by the Government of the host country. He announced the time and room for the meeting of the Group B countries.

44. Mr. TROMBETTA (Argentina) extended his congratulations to the President on his election and thanked the Government of the Netherlands for its invitation for the holding of the Diplomatic Conference. He gave indications on the meeting of the Group of Latin American countries.

45. Mr. KAMEL (Egypt) also congratulated the President on his election and gave indications concerning the meeting which would be attended by Arab countries.

46. Mr. SAPALO (Philippines) also congratulated the President on his election and gave indications concerning the meeting of Asian countries.

47. Mr. IDDI (United Republic of Tanzania) congratulated the President on his election and gave indications concerning the meeting of African countries.

48. The PRESIDENT adjourned the meeting.

Second Meeting
Wednesday, June 5, 1991
Morning

Opening Declarations

49.1 The PRESIDENT opened the second meeting of the plenary of the Diplomatic Conference. He expressed regret that, after the smooth and fruitful start to the Conference on the first morning, little progress had since been achieved in that no consensus had been reached on items 4 (Election of the Vice-Presidents of the Conference), 6 (Election of the members of the Credentials Committee) and 7 (Election of the members of the Drafting Committee) contained in document PLT/DC/1. He proposed that, while endeavors continued to find a consensus, the Conference agree to a change in the order of items foreseen on the draft agenda so that the opening declarations envisaged as item 9 could commence immediately. The Conference could then revert to the discussion of items 4, 6 and 7 of the draft Agenda later.

49.2 There being no objections to the procedure proposed by the President, the President invited delegations to make their opening declarations.

50. Practically all delegations and representatives of organizations which took the floor expressed their warm congratulations to Mr. Max Engels, the Head of the Delegation of the Netherlands, on his unanimous election as President of the Diplomatic Conference and the confidence that, thanks to his competence and experience, he would lead the Conference to a successful result. They also expressed their warm thanks to the Government of the Netherlands and to the authorities of the City of The Hague for their warm welcome and kind hospitality, as well as for the exceptionally efficient and agreeable conference services and facilities. In addition, they congratulated Dr. Bogsch, the Director General of WIPO, and the staff of the International Bureau of WIPO for the excellence of the preparatory documents and of the conference services.

51. Mr. ENÄJÄRVI (Finland) stated that Finland regarded the attempts for worldwide harmonization of patent laws and patent practice in principle as positive. Lately, difficulties seemed to have arisen concerning some crucial issues under preparation, among which the first-to-file principle and the grace period could be mentioned. The Finnish Delegation hoped that, during the meeting, new light would be shed on matters still unsolved and that it would be possible to map the points of unanimity and the points that possibly needed to be discussed further. He emphasized that, under the circumstances, the division of the Diplomatic Conference into two parts was a clearly realistic alternative because there did not seem to be a chance of reaching a satisfactory outcome at that stage. He hoped, however, that problematic items would be discussed openly in the meeting and, if possible, positive alternatives and solutions found. He stated that a good agreement was naturally one that benefitted every party involved. He hoped that the meeting would find a basis on which to build the planned harmonization, if not immediately, at least in the long run, and even gradually, if necessary.

52.1 Mr. SCHAEFERS (Germany) recalled that the draft Treaty under consideration focused on three basic objectives. First, harmonized conditions on formalities and substantive patent law, which would facilitate the filing of patent applications in other countries, for the benefit of inventors, and more practically speaking of their agents, but equally of the public which wished to acquire new foreign technology. Secondly, for the smooth operation of patent systems, discrepancies in the substantive conditions for the granting and administration of patents should be avoided. Thirdly, the fair protection that the inventor deserved should be defined in terms of a high level of protection, taking account of the legitimate interests of society and competitors.

52.2 Above all, the future Treaty should provide for really harmonized solutions that were meaningful, transparent, and well-balanced, rather than to combine various national peculiarities. It would be necessary for all to say good-bye even to long-standing traditions. In that context, his Delegation attached particular importance to a universal system based on a first-to-file approach and the period of grace for early disclosures by the inventor. He also indicated that not all the Articles in the draft Treaty could, as they stood, find the support of the German Delegation. The Delegation would avail itself of the opportunity to express its concerns relating to the Articles on exclusions from patentability and time limits for search and examination at a later stage.

52.3 He stated that it was necessary to follow the decision made by the Assembly of the Paris Union, meeting in Extraordinary Session, in April 1991, that the present meeting would be only the first part of the Diplomatic Conference, with no final decisions nor with the adoption of the draft Treaty. In view of the prevailing circumstances, his Delegation considered that to be a prudent and reasonable solution. However, the German Delegation firmly believed that it was necessary, for the sake of a successful completion of the work, to evaluate in the first part of the Conference the possible elements which would form an overall solution, with due account of work done in other fora, even if the time for final compromise packages may not yet have come. It was however its wish to contribute, in a constructive way, to negotiations which would pave the way for the successful adoption of the Treaty in the second part of the Diplomatic Conference.

53.1 Mr. MOTA MAIA (Portugal) pointed out that Portugal, as a founder country of the Paris Convention, was well aware of the importance of the work undertaken by WIPO with a view to concluding a treaty supplementing the Paris Convention as far as patents were concerned. The growing internationalization of trade in goods and the increase in technology transfer at a worldwide level clearly demonstrated the opportuneness of adopting such a treaty.

53.2 He stated that the aim to conclude a treaty also presumed an effort to harmonize the various national patent laws. Within the European framework, due to the influence of the European Patent Convention, it could be claimed that the harmonization of the laws of the European States was almost completed. Nevertheless, a number of basic differences of principle remained between the European laws and those of other States. Those differences called for an in-depth examination of certain aspects of various national laws with regard to the proposals contained in the draft Treaty in order to arrive at appropriate solutions that would enable all States to accept the desired harmonization.

53.3 To conclude, he reaffirmed the attachment of the Portuguese Delegation to the efforts undertaken by WIPO to harmonize patent laws and its view that WIPO was the United Nations Agency within which States could succeed in establishing such harmonization. He pointed out that his Office was in the course of reviewing the Industrial Property Code and that the new draft already took into consideration the relevant provisions contained in the Basic Proposal.

54.1 Mr. GROSSENBACHER (Switzerland) stated that Switzerland had always shown great interest in the harmonization of patent law on a worldwide scale, which was to lead to the conclusion of a corresponding treaty. That was borne out by the fact that Switzerland, in the person of Mr. Comte, had occupied the Chair of the Committee of Experts that had prepared the ground for the present Conference over a long number of years. His country's interest in harmonization derived in part from a wish to establish a well-developed patent system at worldwide level. Switzerland viewed that condition as indispensable to technical progress. Secondly, his country's interest was based on a concern to ease the task of users of the patent system, particularly users at international level, by giving them, wherever possible, rules that were uniform throughout the world.

54.2 As far as the Basic Proposal for the envisaged Treaty was concerned, he emphasized that it frequently conformed, particularly with regard to the items of an essentially technical content, with his Delegation's concepts of harmonization; it therefore appeared acceptable to his Delegation to a large extent. Furthermore, he noted with satisfaction that it took into account relations between the developing countries and the industrialized countries by providing for the possibility of reservations that were limited in time, thus achieving a proper balance whilst taking into account the needs and interests of the various countries.

54.3 His Delegation could but regret the difficulties that had recently arisen and which had finally led to the Conference being divided into two parts. He referred firstly to the matter of the system to be adopted for allocating the right to a patent. The apparent agreement in favor of the first-to-file system, in force in practically all countries, had been called into question by a recent proposal to give the possibility of maintaining the first-to-invent system. The Delegation of Switzerland deplored that development. It held that a harmonization treaty that was not even able to regulate the fundamental matter of the right to the patent in a homogeneous manner would hardly warrant that name. That issue, just as the period of grace, was one of the pillars of the envisaged Treaty. They were not the only elements in the package but were amongst the most important. In both cases, Switzerland firmly and jointly supported the solutions put forward in the Basic Proposal.

54.4 The second problem concerned those provisions in the Basic Proposal that were referred to as "political" in that they were the subject of some divergence of views between the developing countries and the industrialized countries. He referred to the matter of the fields of technology for which patents were available (Article 10 of the Basic Proposal), the rights conferred by the patent (Article 19), the term of patents (Article 22), the reversal of the burden of proof (Article 24) and the obligations of the right holder and the remedial measures (Articles 25 and 26). The fact was that, if one took a look at those proposals and, above all, at the remaining

alternatives, very large divergences could be ascertained between the points of view of the industrialized countries and the developing countries. Those divergences were so large that his Delegation had considerable doubts as to the possibility of reconciling the differing points of view. He was convinced that, as things stood, it was impossible to reach viable solutions in those fields. The same applied to the first-to-file issue. Nevertheless, the situation, was not frozen. Dialogue was continuing on several fronts. However, it would indeed seem that, for the moment, it was more of an internal awareness within the countries or groups of countries that was emerging and that would still take a certain amount of time.

54.5 In that context, it was necessary to make a remark on the date of the second part of the Conference. At the Extraordinary Session of the Paris Union Assembly, at the close of April 1991, a wish had been expressed that the second part should take place towards mid-1992, in approximately one year. It was basically the interest of Switzerland that a rapid conclusion of the Treaty be envisaged. However, he noted that the setting of the date for the second part would also have to take into account the difficulties that remained, that was to say the problem created by the proposal of the United States with regard to the first-to-invent system, and also the divergencies in the North-South dialogue. For as long as those problems had not been overcome, or at least considerably reduced, his Delegation would have serious doubts as to the opportuneness and chances for success of a second part of the Conference. He felt that a degree of flexibility had to be maintained with regard to the date for that second part, which would have to take place at the best time as a function of the two elements he had mentioned. That in no way meant an indefinite postponement since, in both cases, the signs did not preclude a degree of optimism; on the contrary, he thought it was possible to look forward in the very near future to an evolution in opinions and an awareness with relation to current positions enabling all parties to make their share of concessions towards a compromise on the disputed matters of negotiation as a whole. He hoped that the Conference would take the opportunity during the coming weeks to prepare the ground for those political decisions that would have to be taken subsequently, by reaching agreement on the technical items in the draft.

55.1 Mr. HIEN (Burkino Faso) welcomed the initiative undertaken by the Director General of WIPO in 1983 to draft an instrument that would harmonize laws and would protect inventions. He made a point of referring to WIPO on account of the fact that Burkino Faso had not so far had occasion, since the start of the preparatory work on the draft Treaty and Regulations, to personally take part in the discussions. That was in no way a lack of interest in the endeavor to reach agreement. Struck by the worldwide phenomenon of economic crisis, added to its state of poverty, and for a whole number of other reasons, Burkino Faso, as most developing countries, participated only sporadically in international meetings despite the fact that they were often of great interest for its economy.

55.2 He expressed the wish to harmonize the laws that protect inventions, but also to harmonize interests, however small they might be, to enable the developing countries to look forward to a degree of technological progress. He wished to elaborate a treaty on patent law, but also to think of the Paris Convention revision that had been going on for some years already and that which had been at a standstill for some time. Burkina Faso felt moreover that the most important aspect of patents was that of working within the countries

in which they had been applied for and not that of the link between the future agreement and certain discussions held within other international institutions, such as GATT, although those did have their importance of course, but to a lesser extent. He would also wish the content of the future agreement to take that into account since industrial property law as a whole, particularly patent law, was the law of the creation of goods, the law of technology, that is to say the law of national and international economy.

56. Mr. CASADO CERVIÑO (Spain) recalled that his country had a well-known interest in the harmonization of patent laws and that it supported the activities undertaken by WIPO in this respect. Spain also supported the decision taken by the Assembly of the Paris Union, at its last extraordinary meeting, to split the Diplomatic Conference in two parts. Notwithstanding the difficulties and complexities of the negotiation leading to the conclusion of a patent law harmonization treaty, he expressed his confidence in a successful outcome. In that connection, he underlined the importance of compromise in order to conciliate outstanding differences. He joined other delegations that had expressed their willingness to participate actively and constructively in the Diplomatic Conference.

57.1 Mr. UEMATSU (Japan) emphasized the importance and urgency of achieving international harmonization of patent laws. He stated that, along with economic globalization and the rapid progress of technological innovation, trade in products and technology to be protected by intellectual property rights was growing in the global market, and intellectual property systems supporting them were becoming increasingly important. It was for that reason that it had become essential to achieve international harmonization of patent laws in terms of standards and enforcement, including the procedure of obtaining a patent. However, various differences in patent systems currently coexisted in the world, some of which stemmed from differences in philosophies. This was true not only with aspects of procedure but also with aspects of the level of protection.

57.2 He stated that harmonization for the smooth international transaction of products and technology had to be such that it would eliminate those differences and thereby establish standardized global patent systems. To achieve that end, it was necessary to accomplish a patent law treaty which would harmonize the patent systems of countries and cover the widest possible range of aspects, in particular, the first-to-file system, an appropriate patent term and early publication. In other words, the adoption of a "grand package" had to be aimed at.

57.3 He further stated that, although he reserved the right of his Delegation to make detailed comments on the proposals, before coming to specific items for discussion he wished to take the opportunity to make brief observations on some of the items which he found to be very important, that is, with regard to the question of first-to-file versus first-to-invent systems and the appropriate patent term. He considered that harmonized international rules should be simple and clear, as well as easy to implement. The first-to-file system met those criteria, whereas the first-to-invent system did not because it placed excessive burdens on the applicants and parties concerned. His Delegation was therefore of the firm view that the mandatory adoption of the first-to-file system was in conformity with the spirit of harmonization. With regard to the term of patents, he stated that what had to be borne in mind, in his view, was the need to ensure an effective

and appropriate level of protection. Accordingly, he was of the belief that the term of patents should be within a reasonable range because periods that were either too long or too short caused problems. He drew attention to the fact that his Delegation had made a proposal on this matter.

57.4 He expressed regret that the Treaty would not be adopted at the first part of the Diplomatic Conference, because the times urged the achievement of that goal as soon as possible and in as extensive a form as possible. He referred to the decision by the extraordinary session of the Assembly of the Paris Union as indicating that various obstacles still remained in the way of harmonization of patent systems. He stated that it was imperative to establish, by overcoming those obstacles, the foundation for the industrial property system for the 21st century. In order to achieve this, he found it necessary to make the utmost effort to take a long-sighted view of a desirable course for the development of the world economy, industry and technology. He felt nevertheless that, in the course of discussions in the past and in on-going negotiations, there seemed, and there still now seemed to be a move to try to minimize the revision of domestic laws. The harmonization of patent systems had to be achieved from the viewpoint of what system was most desirable in order to meet the challenges imposed by economic globalization.

57.5 He stated that, in the Diplomatic Conference, the Delegation of Japan wished to make proposals which it believed contributed to the realization of ideal harmonization, and ultimately, to the success of the Conference. He indicated that the Government of Japan had recently called on the Industrial Property Council to initiate comprehensive and extensive reviews of the Japanese Patent Law and practices, including measures to reduce the patent examination period. He stated that the reviews would certainly take into account the discussions at this and future diplomatic conferences.

57.6 He added that the success of efforts to harmonize patent systems would greatly affect the ongoing and future promotion of technology transfer and the balanced expansion of world economy. He stated that, although this task would not be completed at the first part of the Diplomatic Conference, the utmost effort had to be made to ensure success at the second part of the Diplomatic Conference. In order to achieve this, he considered it necessary to have active and candid exchanges of views, in particular on important matters, while recognizing the importance of making international rules and of the derived benefits. He stated that his Delegation was determined and prepared to make a maximum effort to cooperate with the other Delegations at the Diplomatic Conference.

58.1 Mr. ROMERO (Chile) expressed his satisfaction in participating in the Diplomatic Conference and representing a country that had just acceded to the Paris Convention for the Protection of Industrial Property. He added that Chile attached great importance to the adoption of a treaty on patent law harmonization and that it was ready to work constructively in the forthcoming negotiations with a view to improve certain of the provisions contained in the basic proposal.

58.2 He stated that, in accordance with the free market economic system implemented in his country, Chile had decided to establish high level of protection for intellectual property, in general, and industrial property, in particular. A strong patent system was considered as an important element in fostering foreign investment and in facilitating access to new technologies by local users, in order to promote the modernization of the productive system of the country.

58.3 He informed the Conference that his country, in addition to the accession to the Paris Convention, had recently enacted a new law on industrial property, which included modern concepts on industrial property laws, and was currently working on the setting up of an autonomous institute of industrial property, which would be entrusted with important tasks in the field of registration and technology diffusion. WIPO was actively cooperating with his Government in that endeavour.

58.4 He stated in conclusion that the interest of Chile in intellectual property developments including, of course, patents, was obvious. For that reason, his Delegation had decided to cooperate with other Delegations with a view to successfully finalizing the Diplomatic Conference.

59.1 Mr. SIAHAAN (Indonesia) expressed pleasure that the Diplomatic Conference could at last be convened, surviving an attempt to postpone it. The Diplomatic Conference was being held with the objective of negotiating and adopting a Treaty Supplementing the Paris Convention as Far as Patents are Concerned, and regulations under that treaty. The projected treaty was intended to address many important issues in the field of patents upon which there was great divergence in treatment among national and regional laws and for which harmonization was desired. Indonesia had always attached great importance to the work to harmonize patent laws and the leading role of WIPO in intellectual property matters. Indonesia thus had a keen interest in seeing a successful outcome of the Diplomatic Conference.

59.2 He stated that it was worth noting that the developing countries, including Indonesia, proposed alternatives on some draft Articles during the last meeting of the Committee of Experts. The alternatives put forward by the developing countries were especially related to the fields of technology to which patents should apply, the nature of rights conferred by patents, the term of patents, the reversal of burden of proof and reservations. He stated that, in addition to those alternatives, the developing countries also presented two new draft articles laying down the obligations of right holders and also the remedial measures that could be provided under national legislation to secure that the right holders comply with their obligations. In his view it was time for those concerns of the developing countries to be taken into account in the efforts to solve key substantive issues.

59.3 He stated that WIPO was widely recognized as the appropriate framework for the harmonization of patent law through the development of international treaties. WIPO was the organization which was competent to initiate and maintain the momentum for that process. For that reason, it was only fair to wish that the process underway under the jurisdiction of WIPO should be solved within the jurisdiction of WIPO, which was the competent international organization in respect to all intellectual property issues, and should not be dependent on what might or might not happen in other fora. In that regard, he saw no valid reason to link the Diplomatic Conference with the uncompleted negotiations on patent law in another forum. That unnecessary linking would only result in creating a new problem, that is, that the final decisions on all draft articles would have to be deferred to the second part of this Diplomatic Conference, the dates of which were still unknown, thus diminishing the significance of the first part of the Conference. Consequently, apart from discussing all matters relating to the draft Treaty, it was seen as important that in the first part of the Conference at least dates for the second part of the Conference should be recommended for consideration by the meeting of the Paris Union later that year.

59.4 He emphasized that intellectual property rights were important for Indonesia, especially during the process of national development towards industrialisation. In implementing one aspect of national development, namely, economic development, technology had a very important role to play in the improvement and advancement of industry. In that context, he felt it was necessary to create not only a more favorable climate and greater incentives for activities regarding technological discoveries, but also the means for providing legal protection for the results of those activities, including patent protection in the form of law. For that reason, he stated, Indonesia was willing to harmonize its relationship with other countries in order to strengthen intellectual property rights. He announced in that regard that Indonesia would bring its Patent Law into force on 1 August 1991.

60. The PRESIDENT stated that the question of the dates for the second part of the Diplomatic Conference had been discussed during the extraordinary session of the Assembly of the Paris Union in April 1991, when it had been decided that there should be an opportunity at the next session of the Assembly of the Paris Union in September 1991 to express views and preferences on desirable dates for the second part.

61. Mr. SUGDEN (United Kingdom) confirmed that the United Kingdom attached very considerable importance to reaching agreement on the Treaty. He pointed out that the Treaty was the first which aimed to harmonize substantive and procedural patent law. In this regard, he saw the Treaty as providing great benefits to patent applicants, to third parties who might be affected by the patent rights of others and to all those who used patents whether for information or otherwise. He felt that the treaty would also provide benefits to national authorities by establishing a clear and uniform international framework for regulating the grant of patents. He confirmed his administration's attachment to the first-to-file principle and its desire to avoid heavy involvement in sensitive political issues. He observed that some excellent proposals had been presented and looked forward with confidence to the eventual success of the Conference at the end of its second part.

62. Mr. ABU BAKAR (Malaysia) noted that, in respect of intellectual property, Malaysia was very much in a transitory period. Legislation on patents had been enacted in 1983. Subsequently, it had been amended in 1986 and, at the same time, the Patent Regulations 1986 were introduced. He stated that his Delegation's stand on the proposed Patent Law Treaty was mixed. There were issues on which it needed to seek further clarification. While he did not wish at that stage to enumerate the issues, he stated that his Delegation's mandate was to discuss those important issues with other Union members. He expressed the hope that the results of the Conference would be meaningful for all.

63. Mr. ELHUNI (Libya) stated that his country placed great importance on intellectual property. A law existed on the protection of patents and it was being supplemented so that protection would be extended also to other titles of intellectual property. He recalled that his country was also a member of the Convention Establishing the World Intellectual Property Organization, the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works. He hoped that the Conference would produce tangible progress so that equity and justice would be achieved for all involved. Since his country was in the process of elaborating a new patent law and reflecting on the new steps being taken

internationally, his Delegation was particularly interested in the results that the Diplomatic Conference would achieve. He hoped that all differences and obstacles would be eliminated so that a real cooperation would result.

64.1 Mr. MANBECK (United States of America) stated that, as was known to many of those present, the draft patent law harmonization treaty, which had been well-guided in its development by the Director General of WIPO and his staff, did not enjoy a consensus of approval in the United States at that time, especially with regard to adoption a first-to-file system. However, a number of events had recently taken place which should help the consensus forming process. Those events included, first, the convening of the first meeting of a commission in the United States to study various aspects of the patent laws; secondly, the recent approval by the United States Congress of an expedited Congressional approval process for agreements reached by United States negotiators continuing the Uruguay Round of trade talks including those involving patents; and, finally, a more vigorous debate regarding the merits of various aspects of the treaty in a number of industry groups and in a number of Bar groups. While the picture was not yet clear in the United States regarding certain provisions of the draft Treaty, that should not in any way deter the Conference from advancing harmonization insofar as possible, since such an advance would move all toward the eventual conclusion of a beneficial patent law harmonization treaty. He certainly hoped that its provisions would be such that the United States, one of the world leaders in invention and innovation, could be a party to the Treaty.

64.2 He added that his Delegation would not attack at that time the procedures used by certain other countries which were unfair or unfortunate, for example, the inability to correct translations, pre-issue oppositions, excessive delays in the granting of patents, and the severely limited interpretation of patents, but he trusted that those procedures would be discussed fully as the Conference proceeded.

65. The PRESIDENT adjourned the meeting.

Third Meeting
Wednesday, June 5, 1991
Afternoon

66.1 Mr. SZEMZŐ (Hungary) recalled that his Delegation had come to The Hague to take an active part in the elaboration of the Treaty Supplementing the Paris Convention as far as Patents are Concerned. The Delegation knew that the question of postponing the Conference has been raised as a consequence of what he hoped was the temporary failure of the Uruguay Round of GATT. It was pleased with the decision to hold the Conference at the time established

earlier, although with a shorter duration and split into two parts. It was delighted that the Conference had started in The Hague.

66.2 He stated that Hungary was interested in concluding a patent law treaty, because uniform legal norms would, on the one hand, ensure the adequate protection of Hungarian inventions abroad and, on the other hand, promote foreign capital investment in and the transfer of technology to his country. His Delegation considered that the provisions of the basic proposal concerning patentable fields of technology, the extension of the protection in respect of a process to the product directly resulting from the use of that process, the establishment of a minimum duration of a patent of 20 years, the reversal of the burden of the proof and the prohibition of pre-grant opposition did not contradict its long-term interests. The majority of those provisions formed an integral part of Hungary's present patent law.

67.1 Mr. KENT (Argentina) stated that, as the world become increasingly interdependent, it was necessary to provide nationals as well as foreign nationals with adequate legal instruments to facilitate and promote international relations. The significant political events that had recently taken place had shown that national boundaries did not isolate a nation from the rest of the world. In addition, many states had decided to initiate integration processes and to agree upon new forms of legal, economic and even political cooperation.

67.2 Intellectual property was affected by the abovementioned events and it was to be expected that multilateral treaties to be concluded in that field would reflect those developments. WIPO, the United Nations specialized agency responsible for the promotion of creativity and technology transfer, had been sensitive to the new trends and had promoted the protection of intellectual property. He added that his country was aware of the importance and influence of WIPO and that it was convinced that it was possible to enhance international cooperation with a view to furthering the use of industrial property as an instrument of acquisition of technology and promotion of scientific and technological information. He was of the view that it was possible to conciliate those instruments with those purposes.

67.3 He emphasized that patent law harmonization was a difficult and complex endeavour that required time and effort in order to conciliate differences. The presence of a great number of delegations was a clear indication that a multilateral framework, particularly within WIPO, was perceived as the adequate approach which could lead to the conclusion of an agreement that would promote the use of patents as a useful instrument of national and regional development. He stated that, in any case, certain issues concerning intellectual property should be reserved to each country, even though the dynamic interaction of economic factors would lead to the treatment of those issues on a similar basis throughout the world.

67.4 He noted that the harmonization of patent laws would, in respect of a number of issues, facilitate the work of both offices and applicants. However, there were certain other issues that required further consideration and elaboration. Moreover, the implications of certain issues under discussion would not affect all the participants in the negotiations in the same way and would not be perceived by them in the same way. In such circumstances, and as decided by the Assembly of the Paris Union, it was necessary to split the Diplomatic Conference into two parts. The first part,

he added, could be and should be devoted to examine those issues where consensus was already possible. Finally, he reiterated that the Argentine delegation was prepared to participate constructively in the work of the Diplomatic Conference.

68.1 Mr. GAO (China) stated that his Delegation had always held the opinion that the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents are Concerned, the Patent Law Treaty, was of great importance to the harmonization and development of the international patent system. His Delegation was sincerely willing to work and cooperate with delegations of all countries in order to contribute to the Conference.

68.2 He recalled that the Chinese patent system was born in the process of China's reform and opening to the outside world and was further developing in that process. He stated that China had received much help and great support both in China and abroad. With the direct leadership and concern of his Government, his country had made tremendous efforts to implement its patent law and the great development which attracted the attention of the world had been achieved in the past six years. He emphasized that in the outline of the Eighth Five-Year Plan and the Ten-Year Plan, which had begun that year, the Chinese intellectual property system had to be further strengthened and perfected. He said that China had been taking an active attitude to intellectual property protection and noted that, as was known to all, this was an established policy in China's reform and opening to the outside world. He went on to say that it was nonetheless clear that there was much to be done in China in the field of patents in order to further improve its intellectual property system. There was a certain difference between the level of patent protection in China and that of the majority of developed countries. Consequently, the Chinese Patent Law should be further perfected and developed so as to better fit the development of the international intellectual property system. China had already begun to work on the revision of the Patent Law and to adopt an active attitude towards the international harmonization of patents. He noted, however, that, since it would take time for China to raise its level of protection to that of the industrialized countries it lay great emphasis on the activities of WIPO to harmonize patent laws.

68.3 He stated that his Delegation would earnestly join the discussions, voice its opinions, cooperate with all delegations for the success of this Conference, benefit from the experiences and thus promote the development of the Chinese patent system, as well as the international patent system. At the same time, in the promotion of harmonization, different levels of development had to be taken into account in order to meet the interests of most countries. He added that friendly cooperation and compromise were good traditions which had long existed in WIPO. His Delegation sincerely hoped that the Conference, although it was only the first part of the Diplomatic Conference, would offer a full opportunity for all delegations to exchange views on every aspect of harmonization of patents and that it would achieve complete success under the guidance of such spirit.

69. Mr. HATOUM (Lebanon) expressed the assurance of his Delegation that the final results of the Conference would increase the level of technical development throughout the world. He further stated that with normal life now re-established in Lebanon, international efforts were resuming in all fields and that Lebanon would now resume its place in the world.

70. Mr. KHUMALO (Swaziland) stated that his Delegation viewed the Conference as an important attempt to achieve global harmony in the field of patent protection and patent law. His Delegation was present in order to contribute effectively and constructively to the deliberations. Specific comments on draft Articles, particularly draft Articles 10, 19, 22, 23 and 24, would be advanced when the issues came up for discussion during the first and second parts. He emphasized that his Delegation was desirous of seeing a treaty at the end that would be relevant to the situation prevailing in developing countries like Swaziland. His Delegation hoped that the efforts would not be in vain, but stated that judgement could only be given at the end of the whole exercise. He concluded that his Delegation was hopeful of a good outcome and, on that note, was happy to take part in these discussions.

71.1 Mr. SMITH (Australia) applauded the work of the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions. He stated that, to a certain extent, international harmonization had started more than one hundred years ago with the Paris Convention for the Protection of Industrial Property. Whilst stressing the independence of national patent systems and the territorial limitations of protective rights granted under those national systems, it nevertheless contained some basic norms, including the principle of national treatment and the recognition of priority rights. Those basic norms have been continuously extended in the past years during the various revision processes. In more recent years, with the globalization of corporate activities and the greater sophistication of invention and innovation, the role of technology as a factor in industrial and economic development had assumed a sharper focus. This had emphasized the importance of the industrial property system and, at the same time, had accentuated the need to harmonize certain features currently found in patent laws and to formulate provisions for a dispute-settlement system.

71.2 He stated that Australia, whilst noting the increasing importance of intellectual property matters in the international arena, acknowledged WIPO's important role in providing the impetus for the harmonization of patent law, which would ultimately lead to a stronger industrial property system with attendant advantages for both inventors and international trade. Harmonization would assist those inventors who wished to obtain patent protection in foreign countries. At present, there were widely differing requirements, procedures and time limits which could make patenting in foreign countries a complex, time-consuming and costly process. Harmonization of the requirements for the grant of a patent would significantly reduce those difficulties, thereby making the patent system more useful internationally. Equally, if the rights conferred by a patent could be harmonized, patent owners and industry would be advantaged by the more certain operation of national patent systems.

71.3 He stated that Australia realised that harmonizing patent law would necessarily address a number of significant issues, the result of which would require changes in the national law and/or practice in those countries seeking to become party to any treaty that might result from the Conference. The provisions of the final Treaty would therefore need to result in significant benefits to countries and to patent applicants and owners who were faced with the complexities of different patent systems in different countries. Countries were only likely to join the Treaty if they considered that the benefits that would arise from the Treaty were sufficient to justify the changes that would be necessary in their national law and practice. Clearly,

the more numerous and detailed the provisions in the final Treaty, the greater the harmonization that would be achieved. The scope of the final Treaty must not, however, go too far, because the more detailed that the Treaty became the more difficult it would be to obtain the complete support of those countries eligible to join the Treaty. Consequently, it was imperative that the final Treaty achieve the fine balance between going too far and not going far enough. While Australia appreciated the advantages of harmonization, harmonization should not be pursued for its own sake. The Conference should only consider a treaty that would offer significant benefits to countries and to users of the patent system. The mere fact, however, that the patent laws of various countries dealt with a particular topic in different ways was not, in itself, enough to warrant bringing those laws into conformity. Harmonization initiatives had to be aimed at achieving some wider benefits, beyond the mere fact of conformity. Therefore, the aim of patent law harmonization on any particular issue had to deal with those problems that had been identified as resulting from disconformity between different national laws and legal systems.

71.4 So far as the first part of the Diplomatic Conference was concerned, he stated that Australia's clear preference was for discussion to focus not on all issues, but rather on issues such as the right to a patent or first-to-file (Article 9) and the grace period (Article 12), as well as those other substantive issues where discussions had focussed on political, economic or developmental considerations and on which no agreement had yet been reached. Australia hoped that such a discussion would enable a determination to be made as to whether or not there was any common ground upon which compromise proposals might be based for consideration at the second part of the Diplomatic Conference. In that regard, the second part of the Conference should not, in the view of his Delegation, take place until it was much clearer that grounds for compromise proposals did in fact exist.

72.1 Mr. COMBALDIEU (France) observed that patents were the greatest invention and the only one to be protected for a term of more than 20 years. He emphasized that they were an indispensable instrument of regulation for competition which, without them, would be savage. Indeed, patents, by justifiably protecting the inventor, gave him an advantage over his competitors. However, the rules of the game had to be the same for all and everywhere.

72.2 That was why he stressed that the practical and philosophical basis of harmonization was to suppress those systems and practices felt to be discriminatory. Referring to the example of allocation of the right to a patent, he stated that those countries having such systems or such procedures would have to make an effort to join the great majority.

72.3 He emphasized the chance provided by the possibility of working within the framework of WIPO, a multilateral framework, thus avoiding recourse to the bilateral negotiations that could on occasion, in that field, give an unfair advantage to certain countries. He stated that France wished to participate fully in the Conference and was ready to do its best to ensure that the Conference reached a constructive outcome.

73. Mr. WIERZBICKI (New Zealand) stated that his Delegation had hoped that the present session of the Diplomatic Conference could have concluded a treaty, but acknowledged that that was no longer possible. He said

New Zealand believed that there were benefits in attempting to harmonize the major principles of patent law, for example, the first-to-file principle, emphasizing that this was particularly timely for New Zealand, which was at present reviewing its patent law. His Delegation would therefore take a positive approach to the discussion of those issues during the Conference. He added that the New Zealand Delegation hoped that, at the conclusion of this part of the conference, it would be possible to record real and substantive progress.

74.1 Ms. FUCHS (Mexico) stated that the Government of her country had a special interest in the conclusion of a treaty on the harmonization of patent laws. Referring to the statement of the Minister for Foreign Trade, she joined her in warning that the first part of the Diplomatic Conference should not succumb to the tendency to relax. The interest of her Government was the result of the process of modernization and liberalization of the Mexican economy and of the need to develop a multilateral system on the matter that would preclude unilateral approaches. Moreover, the Government was of the view that intellectual property played an important role as an instrument for economic development and as a means of promoting the transfer of technology to her country. The modernization of legislation on industrial property was one of the priorities of the Government since it was considered to be an important condition for the improvement of productivity and competitiveness of Mexican enterprises. Currently, the Mexican Congress was considering new draft legislation in the field of patents and marks.

74.2 She further stated that Mexico considered it necessary to improve the transparency of the international system of intellectual property protection. The position of her Delegation was based on the following principles: first, intellectual property rights should be adequately protected but without distorting the operation of the market; secondly, each State was entitled to adopt rules for the protection of intellectual property that were consistent with the national legal system and with its national independence and sovereignty; thirdly, protection was enhanced when it was entrusted to specialized and autonomous agencies, at the international level, WIPO being the competent agency within the United Nations system to deal with intellectual property matters; fourthly, an intellectual property régime should balance the responsibilities and rights of each of the participating States.

74.3 In conclusion, she stated that the success of the Diplomatic Conference would depend on the capacity of member States to conciliate their interests.

75. Mr. GARIEPY (Canada) stated that Canada had participated in almost all expert meetings that had led to the Diplomatic Conference, and it was very much in support of the completion of a treaty which would be beneficial and acceptable to as many countries as possible. He also stated that a key element which had to be included in the treaty was the first-to-file principle. In that regard, Canada had been encouraged by the declaration made that morning by the Delegation of the United States of America to the effect that a major review of patent legislation was being undertaken in that country. He observed that Canada had adopted, in 1989, new legislation which changed its system from first-to-invent to first-to-file and that the new system had been widely accepted without adverse effects on the users of the system or on the Patent Office. He added that it was the intent of the Delegation of Canada during the first part of the Diplomatic Conference, as well as during the second part, to work in a constructive fashion for the successful completion of the Treaty.

76. Mr. KNITTEL (Austria) stated that the basic proposal dealt with topics that were very important for the industry of his country. That significance was the reason why the Austrian Delegation was prepared to agree with certain provisions proposed during the meetings of the Committee of Experts, although those provisions required essential changes in the Austrian Patent Law. Nevertheless, the former Austrian consent was to be seen in the context of the idea of a well-balanced treaty. His Delegation hoped therefore that the first part of the Conference would smooth the way for a treaty which met that requirement.

77. Mr. BULGAR (Romania) expressed the interest and attention devoted by Romania to industrial property in general, as also to the success of the Diplomatic Conference. The proof of that attention was the fact that his country already had a draft law on patents that was compatible with the draft Treaty and that was currently tabled before the Romanian Parliament. He added that his Delegation considered WIPO to be the sole forum in which harmonization of patent laws could and should be achieved and it welcomed the fact that the Diplomatic Conference had not been postponed.

78. Mr. JAYASINGHE (Sri Lanka) stated that Sri Lanka had always attached very great importance to the effective legal protection of industrial property having granted its first patent in the year 1886, and that, in recognition of the rapid changes that were taking place in the contemporary world it was prepared to be in readiness to meet the demand of the times. He stated that the Delegation of Sri Lanka looked with hope towards the satisfactory conclusion of the proposed treaty on patent law. He further stated that, in the process of harmonization of patent law one should not lose sight of the fact that different levels of development existed among the various countries, particularly the developing countries of the region from which he came. He therefore commended that this factor of unevenness of development be duly considered during the deliberations of this Conference in order to produce a truly meaningful treaty.

79. Mr. NYILIMBILIMA (Rwanda) stated that his country had attached great attention for some time already to industrial property as an effective instrument for economic development in general and industrial development in particular. The harmonization of patent provisions, under discussion here, occurred at a highly significant juncture for his country since it was characterized by revision of Rwandese legislation on industrial property with a view to the effective transfer of technology on reasonable conditions and promotion of the local spirit of creativity and innovation. The outcome of the Conference would therefore constitute an important element in finalizing the revision of Rwandese legislation by taking into account the international system. It was with that prospect in view that the Rwandese Delegation assured WIPO of its positive collaboration to ensure the success of the present Conference.

80. Mr. KHRIESAT (Jordan) expressed the view that the positions taken during the Conference should not be tactical ones, based on old prejudices but, rather, should be based upon a true dialogue that would meet the expectations of all countries, developing and developed alike. He hoped that the Treaty would be clear in its objectives and that its text would not be linked to the interests of only some countries. In particular, he hoped that the text of the Treaty would not be a harmful one to certain countries, imposed upon them, as in the GATT. He stated that the second part of the

Conference could be purely formal if items could be agreed to in the first part. He felt, therefore, that all aspects of the draft Treaty should be looked at in detail.

81. Mr. JAKL (Czechoslovakia) announced that the Czech and Slovak Federal Republic had adopted a new patent law from the January 1, 1991, fully harmonized with the laws of the member States of the European Communities and expressed great interest for further harmonization on the basis of the proposed Patent Law Treaty. He considered the basic proposal to be a good basis for discussion and expressed the hope that it would be possible to achieve harmonization of patent laws on a world-wide basis during the first part of the Conference.

82.1 Mr. UNAN (Turkey) stated that when the Assembly of the Paris Union adopted its decision of April 30, 1991, it was understood that the final decisions on all Articles would be taken in the second part of the Diplomatic Conference. Nevertheless, he saw the present meeting as an attempt to reconcile conflicting positions and possibly to conclude the most important part of the work. However, the existence of a large number of alternatives on important Articles demonstrated that the work before the meeting was not easy. He believed that the required ingredients did exist for a successful outcome.

82.2 He stated that the Turkish Government was in the final stages of developing new domestic legislation for the protection of patents, and that throughout the process of developing such legislation Turkey had benefitted greatly from the meetings of the Committee of Experts hosted by WIPO and from various WIPO documents in this field. Therefore, his country was looking forward to the successful conclusion of the Treaty at the end of the Diplomatic Conference, not only for the attainment of the global harmonization of patent laws, but also for its national purposes.

82.3 He also stated that the Turkish Government gave considerable importance to promoting multilateralism in the field of intellectual property and to an approach that met the needs of both developed and developing countries. He underlined that Turkey was in favor of a harmonization of patent laws which was in the interest of the users of the system and of the economic development of all countries. The Delegation of Turkey also believed that the Conference should not be connected with GATT's Uruguay Round since that Round depended on the outcome of a number of issues, including matters that had no relationship with patent laws. He stressed, however, that by saying this, Turkey did not deny that a close link existed between intellectual property and trade, but in his opinion the first step in the field of patents was to put in place a widely accepted international legal instrument supplementing the Paris Convention. He also stressed that WIPO was the only appropriate forum in which the harmonization of patent law should take place, notably through the development of international treaties, and that, as the competent organization, WIPO had initiated and maintained the momentum in the process of the harmonization of patent law so that this opportunity should not be allowed to pass without being seized. He hoped that a spirit of compromise would prevail during the Conference for the attainment of a successful conclusion.

83.1 Mr. OPHIR (Israel) stated that it was clear that, more than ever before, the harmonization of patent laws was of supreme importance. The vital necessity of promoting international cooperation in the protection of

inventions and inventors' rights, and the ever-increasing importance of providing the means for accessibility to and dissemination of technology, rendered it a matter of some urgency to conclude the Patent Law Treaty at the earliest opportunity; a treaty which would provide a vital basis for substantive matters of economic and industrial benefit to all countries and their inventors. His Delegation viewed very favorably the moves which were being taken, and those already taken, in that direction.

83.2 He stated that, on numerous matters set out in the basic proposal, it should not prove an insurmountable task to reach a consensus. There were, however, some very basic issues which would require discussion and resolution, not the least of which were the first-to-file and first-to-invent principles and the grace period. He was certain that in the spirit of goodwill, compromise and constructive thought, those aspects could be brought to an eventual satisfactory and acceptable resolution.

83.3 He reported that Israel was engaged in examining and revising its 1967 patent legislation. The proposed harmonization provisions were, therefore, of considerable interest and significance in the formulation of new provisions in Israel's domestic law. He added that whilst the broad principles embodied in the basic proposal were acceptable, he looked forward to joining the forthcoming discussions on specific issues, pointing out that there were some matters on which his Delegation held certain views and other matters regarding which it had already submitted, and had yet to submit, specific proposals. He wished every success to all the delegations in their deliberations towards the speedy and successful conclusion of all outstanding issues.

84.1 Mr. MBUYU (Zaire) wished to thank the Director General of WIPO for all his efforts to enable the Industrial Property Service of Zaire to be restructured and modernized by the acquisition of suitable equipment and the provision of experts for a long stay in Zaire to enable it to meet the ever more complex demands of today's world. Although Zaire was participating for the first time in that type of Diplomatic Conference, he was sure that the meeting would enjoy a successful outcome in view of the obvious advantages that each country would obtain from the harmonization of patent laws.

84.2 Zaire, whilst supporting the success of the Conference, was asking that such harmonization should enable the developing countries to exploit the protected technologies. If such were not to be the case, the protection of inventions without the possibility of working them could, in the end, be felt as a brake. It was for that reason that the Delegation of Zaire invited the developed countries to assist them in emerging from underdevelopment. The Delegation of Zaire would adhere to any proposal for harmonization that would lead the Conference on towards success.

85.1 Mr. TIGBO (Cameroon) stated that the decision to divide the Conference into two parts would certainly make it possible to deal with the draft Treaty in more depth in the interest of all the parties concerned. Moreover, he was aware of the differing interests reflected in the various draft Articles proposed by the different parties. His Delegation nevertheless remained convinced that, with a little effort and clarification, the Conference would achieve a compromise to satisfy everyone. It therefore felt it would be better to go forward slowly but surely towards the common aim of a treaty supplementing the Paris Convention as far as patents were concerned.

85.2 He stated that harmonization of patent legislation was a constant concern of his country, which was a founder member of the African Intellectual Property Organization (OAPI) whose treaty had ensured a certain degree of harmonization at its subregional African level. His Delegation considered that a well-designed patent system was an important element that could assist its country in the fight for development. Thus, his Delegation welcomed the action taken by WIPO which had enabled it to take part in the present meetings and it intended to make a contribution throughout the discussions towards the success of the work which, it was convinced, would take place in an atmosphere of equity and serenity.

86.1 Mr. FORTINI (Italy) was certain that strong protection for patents lay in the interest of all the countries. He added that industrial property protection was one of the keys to development and to economic success.

86.2 He expressed the concern of his Delegation for safeguarding the multilateral system, which was a system working in the interests of all. He pointed out that a bilateral system constituted a face-to-face between an economic power and a weaker partner. Nevertheless, the multilateral system had to be used in a reasonable manner, not only against economic pressure but also against numerical pressure. He concluded by wishing the Conference maximum success in the most equitable direction possible.

87. Mr. ABDALLA (Sudan) stated that the Conference was of great importance in light of the fact that inventions were becoming more numerous and that harmonization of legislation in the area of patents would, therefore, benefit everyone. He was convinced that the Conference was the most important one that WIPO had organized and emphasised that the work that had taken place to date in the Committee of Experts leading up to the Conference should be taken fully into account. He stated that all of the delegates were fully aware of their responsibility to draw up a treaty that would benefit mankind as a whole.

88. Mr. TOURE (Côte d'Ivoire) said that the aims pursued by the present Conference were of particular importance to his country. His Delegation therefore hoped that a spirit of solidarity and equity would prevail since they were indispensable if the interests of all concerned were to be truly taken into account during the debate. He assured the Conference of his Delegation's will to make its contribution to the search for solutions that were acceptable to all and he wished every success to the discussions.

89. Mr. KUNKUTA (Zambia) stated that Zambia had faith in the value of industrial property and was convinced that harmonized provisions would facilitate the transfer of technology and the work of patent offices and inventors and their agents. His delegation was convinced that the proposals contained in document PLT/DC/3 were well balanced and would constitute a good basis for the negotiations. He stated, in conclusion, that his Delegation was committed to the principle of the first-to-file.

90.1 Mr. IDDI (United Republic of Tanzania) stated that his Delegation attached great importance to the Conference and the issues being discussed and supported the integrity of WIPO to administer those issues. He felt that the Conference was timely and important in view of what was happening in respect of patents and in other fora. He believed that the highly technologically and scientifically developed countries and the developing countries had to sit together and come to agreement on how to supplement the Paris Convention.

90.2 He stated that Tanzania had recently revised its law to increase the level of patent protection while at the same time taking into account the public and national interests of his country. He expressed the opinion that patents should accord the maximum protection while imposing an obligation on the owner of the patent to work the patented invention in order to improve the welfare of the country. He hoped that industrialized countries would take those considerations into account.

91.1 Mr. JILANI (Tunisia) recalled that Tunisia was a founder member of the Paris Union and was greatly interested in the Diplomatic Conference. His Delegation regretted that the Conference had been split into parts and that the second part would not be concluded for some time.

91.2 He stated that harmonization was an important and useful process, provided that it took into account the differing levels of technological development of all countries and achieved, on that basis, a just balance with respect to the main elements of the proposed Treaty. In particular, the length of the patent term should be reasonable and the State should have the right to exempt certain technical fields from protection, as well as strike a balance between the rights and the obligations of the inventor. He noted that his country had prepared a new law for the protection of patents which would make it possible to meet the necessary conditions foreseen for the proposed Treaty.

91.3 He also expressed the conviction of his Delegation that WIPO was the sole body that had jurisdiction over patent matters and that there was no need to await the outcome of discussions in other fora in order to deliberate on the proposed Treaty.

92. Mr. BOUCOUVALAS (Greece) attributed great importance to the Draft Patent Law Treaty, since he believed that it would fill a gap that had been sensed by broader and broader circles of interested parties all over the world. He considered that the harmonization of patent law should establish a clear, simple and easily manageable international framework that would enhance the role of the patent system in its contribution to the development of technology and industry and, thus, promote economic development through the encouragement of research and development expenditures, investment and technology transfer. He assured the Conference that his Delegation would cooperate constructively during the deliberations and hoped that the outcome of the Conference would be as fruitful as possible.

93.1 Mr. BRAENDLI (European Patent Organisation) stated that his organization (EPO) had always considered harmonization of patent law on an international scale, meeting both the needs of the users of the patent system and those of the Offices administering that system, to be most important. It had therefore done all it could to encourage the efforts undertaken by WIPO as from the beginning of work in 1984. In that respect, it was interesting to note that the same needs for harmonization of patent law had emerged 30 years ago at a European level as those now to be observed at worldwide level: that was to say the need to simplify the grant procedure and to strengthen the protection afforded to inventions which, as one should not forget, served as a driving force to technical innovation, which, for its part, constituted the key factor in economic and social progress. The EPO's European Patent Convention was drawn up in 1973, in response to those needs. It represented the outcome of substantial harmonization. It was, at the same time, a source

of patent law harmonization, which was far from being completed and which was not limited to the Contracting States alone or to those that wished to become Contracting States. In view of the similarity of the problems and of the interests involved, the international harmonization of patent law conducted by WIPO, which had led to the Basic Proposal submitted to the Conference, had been justifiably inspired, in some respects, by the uniformity already achieved in Europe. Although the EPO approved that alignment--a partial alignment of course since the Basic Proposal also contained numerous elements from other sources--between the harmonization treaty and a system that had proved its worth, it did not exclude such harmonization also leading in some respects to an evolution of current European Law.

93.2 What were the reasons that led to such importance being attached to the international harmonization of patent law? The EPO wished to reply to that question by setting out the major objectives pursued:

- harmonization of patent law had to lead to a strengthening of protection for patents;
- harmonization had to bring with it simplification and improvement in the grant procedure and in promotion of patents to serve the needs of applicants and holders of patents;
- harmonization had to achieve uniformity in the criteria serving as a basis for assessing the patentability of inventions to ensure that applications be examined and patents granted in compliance with the same criteria.

93.3 The definition of prior art applied worldwide was central to those criteria. Any departure from such a definition, whether as a result of options reserved to a single country or to a limited number of countries, had to be deemed a barrier to international cooperation. The achievement of those objectives was of particular importance since it opened up new possibilities for cooperation between Offices, including that under the PCT procedure, and would make it possible in the long term to simplify the work of Offices--for the benefit of their customers--and would probably constitute one of the remedies for the generalized excess workload.

93.4 For those reasons, and in view of the efforts already undertaken, the EPO felt that the conclusion, at the appropriate time, of a harmonization treaty reflecting those objectives was in the interests of everyone. The EPO was convinced that the first part of the Conference would prepare the ground for the forthcoming conclusion of the Treaty. In any event, the EPO would cooperate wherever possible to enable that aim to be achieved as rapidly as possible.

94.1 Mr. KIM (Democratic People's Republic of Korea) stated that the adoption of the Patent Law Treaty would contribute to the acceleration of the economic development of each Contracting Party and to further expanding and strengthening international cooperation in relation to inventions and patents. He observed that, while there were some differences in relation to the draft Treaty, the basic composition of it was nearly completed.

94.2 He considered that the differences between the developing countries and the developed countries in the field of patents were further deepening and the developing countries were experiencing difficulties as a consequence. He considered it to be evident that the Treaty should fully reflect the demands

and interests of the developing countries. He stated that, therefore, a compromise on major items seriously discussed on several occasions at the meetings of the Committee of Experts and at the Consultative Meeting of Developing Countries should be made without infringing upon the interests of any party. He stated that the contents of the joint document presented by the developing countries in June 1990 should be reflected in the Treaty when adopted. He hoped that a treaty fully reflecting the demands and interests of the developing countries would be adopted in the long run.

95. Mr. SAPALO (Philippines) recalled that, as early as 1947, the Philippines had enacted a patent law that protected processes and products and that, in 1965, it had acceded to the Paris Convention. While indicating that his country was one of two in the world that still adhered to the first-to-invent principle, he stated that there was pending legislation in the Philippines to adopt the first-to-file principle. He further indicated that, in line with the objective to harmonize patent laws, his country would be willing to consider other proposals to change its laws. He stressed, consistent with the views of other developing countries, a willingness to compromise on issues relating to patent law within WIPO, rather than in other fora. He stated that the harmonization of patent laws presented challenges but that his Delegation could be counted on to work hard towards a successful conclusion of the Conference.

96.1 Mr. DURANDISSE (Haiti) stated that his Delegation attached great importance to the work of WIPO towards the harmonization of the laws protecting inventions in differing countries. That work was certainly not easy. That was witnessed to by the difficulties encountered at the beginning of the Conference in reaching an agreement from both the political and the purely technical points of view.

96.2 The development of international trade and the rapid evolution of technology made industrial property an important instrument in a country's economic policy. He noted that all the developing countries that had taken the floor had expressed their will to amend their laws, taking into account the basic principle of the Treaty. His Delegation therefore attached most particular importance to the outcome of the Conference and hoped that compromises could be found to ensure a positive outcome to its work. He assured the Conference of its collaboration in that task and would speak at the appropriate time to explain its point of view on the Treaty.

97. Mr. EFON (African Intellectual Property Organization) expressed the pleasure of his organization, as an intergovernmental organization comprising 14 member States, in taking the floor. As for the substantive issues that were to be dealt with, OAPI's position was that expressed by the Delegations of its member States, which was, after almost 30 years of existence, that OAPI would not be satisfied with the simple protection of patents and other industrial property titles, but intended to commit itself increasingly to their exploitation. OAPI would contribute, in agreement with its member States, in setting up a legal framework enabling those objectives to be achieved in the proper interests of inventors, applicants and the economy of the member States in compliance with the Bangui Agreement that had established the African Intellectual Property Organization. OAPI concluded its remarks with that hope and wished every success to the meeting.

98.1 Ms. LACHOWICZ (Poland) stated that Poland had always attached great importance to the work on the harmonization of certain provisions of patent laws. Presently her country was in the course of changing its Law on Inventive Activity so as to modernize and adjust the Polish patent system to European industrial property protection standards. Therefore her Delegation felt that the final outcome of the Conference would have great influence on the final outcome of her country's legislative works.

98.2 Her Delegation was conscious that there were still many fundamental, outstanding and very difficult problems which had to be considered and solved during the first part of the Conference, and it believed that all those problems would be considered and solved in a spirit of compromise. She wished to stress that Poland was in favor of the harmonization process and was interested in reaching an agreement which could satisfy all countries taking part in the meeting.

98.3 Her Delegation found the basic proposal to be a very good basis for the discussions but was also ready and open to discuss other proposals submitted by other delegations, having in mind that the Treaty, which it was expected would be worked out successfully during the Conference, should serve the strengthening and further development not only of national patent systems, but also of European and world patent systems.

99.1 Mr. OUSEAKOV (Soviet Union) stated that he understood that the Conference had been convened to complete work that had been begun seven years before and, in terms of its importance, could only be compared to the Stockholm Conference of 1967 at which the World Intellectual Property Organization itself was established. He observed that during the course of the preparatory work that had led up to the Conference, a number of questions had been put forward by the participants. He pointed out, however, that no matter how the Conference ended, the result of the work of the Committee of Experts was not academic since the studies undertaken and recommended solutions to the problems raised were, in themselves, a considerable contribution to the theory and practice of intellectual property law.

99.2 He stated that the reform of the intellectual property system in the Soviet Union had been sped up as a consequence of the recommendations made by the Committee of Experts. In this regard, he announced that on May 31, 1991, the Soviet Parliament had adopted a law on inventions that was fundamentally distinct from the previous one. In particular, the new law rejected restrictions on patents for inventions, established a 20-year period of protection, restricted the possibility of demanding a non-voluntary license, established a 12-month grace period, and established an institute of patent officials, Board of appeals within the State Patent Office and a Patent Court. He stated that the introduction of the new law had not been an easy matter for the Soviet Union.

99.3 He stated that he had every hope that other interested countries would make every effort to see to it that the Conference removed differences in patent systems. In this regard he pointed to the positive experience in the establishment, through joint efforts, of a universal instrument in the field of patent classification. He saw a successful conclusion to the Conference as providing the participants with an opportunity for long-term cooperation in countries with diverse legal systems.

100. Mr. NTAHOMVUKIYE (Burundi) stated that his country was closely following the work of the Conference, that was considered of capital importance. He observed that several problems remained to be solved and cited the issues of reversal of the burden of proof, the first-to-file principle and the differences that existed between the developing countries and the industrialized countries. He pointed out that his country's patent law dated from 1964 and that it would be necessary to revise it; the work of the Conference was of special interest for that reason.

101. Mrs. DE CUYPERE (Belgium) said that her country attached constant importance to the harmonization work carried out under the aegis of WIPO. That was proved by its consistent presence at the various preparatory meetings. As for the substantive provisions of the Treaty, her Delegation hoped that the work of the Conference would lead to high levels of protection for innovations and the adoption of a universally accepted provision laying down the first-to-file system. As the representative of Canada had previously observed, an encouraging sign in that direction could be perceived in the United States of America. She wished the Conference every success in achieving the abolition of national particularities thereby contributing to fullest possible harmonization at worldwide level, particularly in the interest of inventors and of the actual users of the patent system.

102. Mr. MILANDOU (Congo) said that his country attached capital importance to the issues linked with industrial property. As a result, the efforts undertaken in that field by his country had begun to bear fruit with the assistance of the World Intellectual Property Organization (WIPO) and the European Patent Office (EPO). He asked those two institutions to accept, on the present occasion, the expression of his deep gratitude. As for the Conference, he stated that Congo was going to unite its efforts with those of the other countries to endeavor to achieve an equitable solution beyond the specific features of each country.

103. Mr. KAINAMURA (Uganda) announced that, during the previous week, his country's legislature had passed a new patent law which had been drafted with the assistance of WIPO. He stated that the results of the Conference were anticipated in the new law and that it was hoped that those anticipations would be proved to be correct.

104. Mr. SOUMANA (Niger) expressed his gratitude to WIPO for all the efforts that it was undertaking in order to train officials of Niger in the field of intellectual property and to promote industrial property in his country. He stated that harmonization of patent laws would doubtlessly promote an improvement in the patent system in all its aspects and, in particular, for the transfer of technology. That was why he stressed the fact that his country attached capital importance to the outcome of the Conference and hoped that it would be possible to adopt equitable conclusions. The Delegation of Niger wished every success for the Conference.

105. Mr. DEMBEREL (Mongolia) stated that his Delegation was conscious that the main goal of the Conference was to sum up many years of work covering provisions on many aspects of patent law and practice and to add another major step in the international framework for the protection of industrial property. He hoped that, in that process, the goals of all countries could be met, as well as the interests of all countries, especially the developing countries. He indicated that the basic proposal could serve as a very

fruitful basis for the work of the Conference and for reaching mutually acceptable conclusions relating to all issues, including such basic issues as the question of the attribution of the right to a patent and the grace period.

106. Mr. HACHEME (Benin) stated that his country attached a large degree of importance to WIPO, that had unceasingly used its praiseworthy endeavors for the benefit, in particular, of countries such as Benin to help them to improve all that concerned industrial property. The harmonization of patent laws was the objective to be reached. Certainly, difficulties remained to be overcome, but cooperation between all concerned during the Conference was sure to establish conditions that could help in convening the second phase that was to be decisive in the prospect of concluding a treaty supplementing the Paris Convention as far as patents were concerned. His country was going to work with an open mind in order to overcome any difficulties.

107. Mr. MANZOLILLO DE MORAES (Brazil) stated that Brazil was intensely aware of the need for a productive and harmonious search for a patent system that offered greater legal security at an international level to all concerned parties. He announced that there was a new draft law on patents under scrutiny at the Brazilian National Congress and stated that the Brazilian Government was strongly interested in obtaining a modern legislation on that matter. That indicated significant progress as far as the strengthening and modernization of the patents system was concerned. He offered assurances that, in spite of the fact that Brazil was not fully in agreement with all the provisions contained in the basic proposal, his Delegation would do everything to avoid obstacles to the successful conclusion of a multilateral agreement on the matter under discussion.

108. Mr. MLETWA (Zimbabwe) stated that his Delegation had certain reservations concerning the draft Treaty, similar to those already expressed by some of the developing countries, which would be advanced when the discussion on it progressed. He expressed the view that Contracting Parties to the Treaty could realize substantial benefits from its provisions only on attainment of a certain level of scientific and technical development and he hoped that this matter would become a subject of discussion and consideration by the Conference.

109.1 Mrs. PURI (India) stated that her Delegation attached considerable importance to and supported the norm-setting role of WIPO which had the primary mandate, competence, expertise and experience in the field of international intellectual property and was the only United Nations Agency with a jurisdiction in that field. She reaffirmed the belief of her Delegation that WIPO and its work had its own life and existence and that it should therefore be dealt with as such.

109.2 Concerning the process of harmonization, she wished to stress certain principles which she considered should be respected. First, her Delegation believed that harmonization should involve a meeting of minds and an accommodation of diverse interests and not the setting aside of the interests of some countries. Secondly, the extent to which due account was taken of the different level of development of each country constituted an extremely important principle. Some expression had been given to that principle in the basic proposal by way of alternatives and in the special consideration accorded to developing countries in respect of the transitional adoption of various proposed measures. It was crucial, however, that the results of

harmonization should respect the capacity of developing countries to implement those results. Thirdly, harmonization had a role to play in determining the access that developing countries would have to technology and the terms on which such technology would be diffused and used. It was therefore important that the impact of harmonization should be a positive rather than a negative one.

109.3 She observed that the draft Treaty was comprehensive in scope. It was necessary to ensure that the procedures which it involved should not, however, present problems for national administrations to implement and should be in keeping with the capacities of those national administrations. Similarly, the procedures ought to facilitate the use of the industrial property system by the user. She also wished to agree with those Delegations which had stated that harmonization was not an end in itself and that there should be some larger objective served by the process of harmonization which could be established taking into account the interests of all concerned.

109.4 Concerning the substantive issues dealt with in Articles 10, 19, 22, 24, 25 and 26 of the basic proposal, she affirmed the belief of her Delegation that the public interest must be at the center of norm-setting in those areas. Her Delegation was ready to cooperate in engaging in a meaningful dialogue in resolving the resolvable at this first part of the Diplomatic Conference.

110. Mr. KAMEL (Egypt) expressed his general agreement with the provisions of the basic proposal and indicated that he would have specific comments when particular provisions came up for consideration. He indicated a desire that meetings during the Conference not be scheduled at the same time to allow small delegations to participate fully in the Conference.

111. The PRESIDENT stated that the scheduling of meetings would be discussed and decided in the Steering Committee.

112. Mrs. DIAWARA (Mali) explained that it was the first Diplomatic Conference held under the aegis of WIPO at which her country had been present. Her country attached great importance to the work to be done by the Conference.

113.1 Mrs. JESSEL (Commission of the European Community (CEC)) stated that the Commission of the European Communities wished to make two observations. The first concerned the importance of the Treaty to be dealt with by the Conference. It was not vain to compare its importance to that assumed by the Paris Convention, in its time, that was to say at the close of the last century. The founder countries of that Convention, who were much less numerous than today, permitted the development of industrial property at an international level and, in so doing, ensured the survival of the industrial property system whose essential vocation had been to go beyond the national framework.

113.2 Today, on the verge of the 21st century, two elements of increasing importance had emerged. That was to say, the rapid development of technology and the considerable increase in international trade. It was obvious in those circumstances that all users of the patent system (that was to say both the holders of patents and the others throughout the world that used the information contained therein) had a need, as part of the efficient

development of trade, for certain essential provisions of patent law to be harmonized. Those were, amongst others, the system for allocating the right to a patent and the obvious interest in adoption throughout the world of the first-to-file system today already used by a very broad majority.

113.3 Due to its specific weight in international economic relations, the European Community naturally attached quite special importance to adequate protection at international level. The Commission of the European Communities could therefore but welcome the relevant harmonization work undertaken by WIPO. The Commission intended to be attentive to the interests of the European Communities, and those had already been made known, particularly in the negotiations taking place at GATT. Those negotiations and the WIPO negotiations were not in competition, but should supplement each other. That prospect meant that a good chance could be perceived of developments favorable to the final conclusion of the Diplomatic Conference.

113.4 The Commission of the European Communities hoped that the first part of the Diplomatic Conference would be able to define guidelines that were sufficiently clear to enable true compromises to be achieved which were not simply a photograph of national particularities.

114. Mr. SALAZAR (SELA) recalled that the Latin American Economic System (SELA) assembled 26 Latin American and Caribbean countries, and that it was a forum for consultations and cooperation in the region. SELA had a great interest in intellectual property as evidenced by a number of activities undertaken by his Organization in that field. He expressed his gratitude for the cooperation received from WIPO and mentioned, in that connection, the Latin American Forum on Intellectual Property. Discussions on patent law harmonization and on the Diplomatic Conference were held in the last meeting of that Forum. While each member State of SELA would express its own view in the Diplomatic Conference, he stated that at that meeting of the Latin American Forum WIPO was considered to be the competent agency to promote and develop the protection of intellectual property internationally. He stated, in conclusion, that he was prepared to participate constructively in the Diplomatic Conference with a view to its successful conclusion.

115. Mr. PETERSEN (CIPA, CNIPA and EPI) stated that the three Organizations he represented included patent practitioners in Europe which had inventors and applicants as clients and without whom there would be no patent system. He supported a balanced package in the Treaty, but he had detailed criticisms on some parts. He considered that the appearance of document PLT/DC/6 was a catastrophe that had destroyed the delicate balance of the package which included the grace period. He stated that, until that balance was restored, he could not support all that was proposed but that there were parts which provided practical improvement on which he hoped to see progress. Those parts included the provisions concerned with the preparation of documents and the mechanics of filing, amongst which he mentioned particularly draft Article 7, both paragraphs of which he wished to see retained.

116.1 Mr. SCHEMITT-NILSON (FICPI) stated that FICPI had actively and whole-heartedly participated from the beginning in all efforts of WIPO in preparing the draft Patent Law Treaty which developed and supplemented the Paris Convention and provided for improved, simplified and more reliable conditions for patent offices, applicants and patent attorneys around the world. His support was based on three main goals to be achieved by the Treaty.

116.2 The first goal he saw for the Treaty was the introduction of an international grace period. The second was the establishment of a patent system which was balanced on a worldwide level. He stated that such a balanced patent system should not favour domestic applicants as compared to foreign applicants, which violated at least the spirit of the Paris Convention. Moreover, the necessity for applicants to take into account very fundamental differences among the patent systems of various countries should be avoided. One of those very fundamental differences was the contrast between the first-to-invent system and the first-to-file system. He believed that the first-to-invent system was detrimental to the interests of the inventors since they had to be prepared to carry out complicated and expensive interference proceedings and since they had to take into account the first-to-file system in any event, in view of potential filings later on in countries following the first-to-file principle. Thus, he still hoped that the original "package deal" proposal would be accepted, at least after some transitional period of time for those countries which have to take the step from a first-to-invent system to a first-to-file system.

116.3 The third goal he saw for the Treaty was to harmonize several concrete provisions to develop the patent system as a whole. At this stage, he wanted to stress two aspects he believed to be of particular importance. Firstly, he pointed to the provision regarding the restoration of the Paris Convention priority term. He stated that a need to restore such priority term occurred very seldom, but if it occurred, the applicant was faced with the prospect of a total loss of his application. Secondly, he pointed to the necessity to safeguard the applicants' interests during the period between publication of the application and the grant of the patent. In this regard, he stated that the applicant provided the public the information about the invention upon its publication. He therefore wanted to provide the applicant, in return, with the maximum remedies against imitation and counterfeiting prior to the grant of the patent.

117.1 Ms. LEVIS (ALIFAR) stated that a number of Latin American countries had initiated a process of liberalization of their economies that constituted a significant challenge for local industry. It was expected that, under those new policies of freedom and competition, the region would attain progress and development. However, those policies were not consistent with the intellectual property systems advocated by some countries, which could lead to the establishment of monopolies and which would entail a heavy economic and social cost for the Latin American region.

117.2 She stated that ALIFAR was convinced that a regime of intellectual property protection should be based on a balance of rights and obligations of the holders of intellectual property rights and should be consistent with the development goals of different countries. She added that each government, in consultation with the interested national parties, was entitled to decide national development strategies. The foregoing did not imply that intellectual property rights should not be respected.

118.1 Mr. BETON (UNICE, CEFIC and EPPIA) expressed dismay with the direction that the negotiations had taken and concluded that there was little will to arrive at a good workable patent system. In those circumstances he did not wish to see disruption in the existing major patent systems, but preferred to stick with what existed rather than to adopt a series of bad compromises ending up with attenuated protection, unacceptable legal uncertainty and an inability to put matters right for many decades.

118.2 He stated that the major requirements for a good patent system were made clear in the Basic Framework of GATT Provisions on Intellectual Property of June 1988, submitted by the European, Japanese and United States business communities. The main elements of that were the following: (1) liberal criteria for patentability (novelty, non-obviousness and industrial applicability or utility) without discrimination as to technical field, where an invention was made or with respect to the exercise of the rights conferred and their enforcement; (2) adequate and effective protection of inventions and enforcement of patent rights involving the right to exclude others from the manufacture, use or sale of the patented invention and, in the case of a patented process, similar protection for the product. Those rights included any form of handling of patented products in the course of trade and required non-discriminatory and equitable civil procedures and remedies for their enforcement; (3) a patent term of at least 20 years; (4) no revocation for non-working, no confiscatory government use or compulsory licensing provisions and no international exhaustion which worked to the detriment of poor countries, as well as industry; (5) acceptance that the purpose of a patent is to stimulate invention and innovation by protecting its holder from competition by direct exercise of the invention or by copying or imitation.

118.3 He stated that the rest was mechanics, but that the mechanics were important, since there had to be a proper balance between the needs of those who sought protection and the legitimate needs of competitors to be able to find out with reasonable certainty what patent rights they had to respect. He felt that, at the last meeting of the Committee of Experts, the Committee seemed to be heading towards a balanced package based on first-to-file, liberal patentability, a grace period, dealing with conflicting applications on the basis of the whole contents approach with respect to novelty (except that United States of America wanted it with obviousness), early publication, processing applications within reasonable time limits and especially making an early publication of the search report, no pre-grant opposition, reasonable provisions on the rights conferred, prior use, a fair extent of protection coupled with reasonable legal certainty, a patent term of at least 20 years, reasonable provisions on enforcement, and reversal of the burden of proof where a process patent holder had a legitimate need to bring out into the open what an infringer tried to hide behind closed doors. The balanced package had been put in doubt by the withdrawal by the United States of America of its proposal to adopt the first-to-file system, while continuing to ask for the other parts of the package. He expressed sympathy with the position in which the United States Administration found itself. Many of its interested circles had strongly opposed first-to-file and it seemed unlikely that Congress would approve it. He felt, however, that there was a real danger that a bad package leading to bad patent systems would be the result. He pointed out that an ill-considered treaty would at best polarise the world with respect to patents and at worst would lead to unacceptable provisions of patent law that would take many decades of argument and further conferences to put right.

118.4 He stated that the first-to-invent option proposed by the United States had the unfortunate effect that the relative merits of the first-to-file and first-to-invent systems might not be debated fully in the Conference. He welcomed the promise of the United States of America to remove the discrimination against non-residents of that country, but feared that the removal of those discriminatory aspects would result in greatly increased costs and legal uncertainty when there were priority contests. He stated that, in particular, European industry was sorry that this appeared to be at

the cost of greatly increased incidence of expensive proceedings to determine the date of an invention made outside the United States of America with respect both to counts of interferences and the citable art.

118.5 He further stated that the basic requirements to get a patent were (i) invent and (ii) file. Pure justice suggested priority based on first-to-invent but practicability dictated that it should be based on first-to-file. He felt it was an illusion to think one could get pure justice through the first-to-invent system, since the first inventor could lose his rights by not complying with the other requirements of the patent system, especially if he filed after expiry of the grace period or abandoned, suppressed or concealed the invention. He saw the existing law in the United States of America as a compromise which was troublesome to industry outside that country. It sought to give perfect justice to residents of the United States of America while avoiding difficulties concerning proof of date of invention abroad. He felt that that made applicants from outside the United States of America second-class citizens in not obtaining the first-to-invent system, nor even a grace period, but only first-to-file without a grace period. On the other hand, if the discriminations referred to were eliminated the costs and legal uncertainties would go up sharply for anyone.

118.6 He concluded that a first-to-invent system for the United States of America was not practicable and that that country ought to adopt a first-to-file system for their own people as well as foreigners. For that reason, amongst others, industry outside the United States of America was unwilling to see concessions made in the direction of the package in the basic proposal until that country implemented its part of the bargain.

119. Mr. LANGTON (PTIC) indicated that the Patent and Trademark Institute of Canada (PTIC) is a professional association of practitioners in the intellectual property field. He stated that, in general, the PTIC supports the basic proposal for the Treaty and Regulations. He observed that Canada had recently amended its patent law to change from a first-to-invent to a first-to-file system and had adopted absolute novelty, but with a one year grace period for disclosures by or derived from the inventor. He stated that, while there were potential difficulties and inequities with both the first-to-file principle and the grace period, he believed that Canada's new law represented a balanced approach. He hoped that the experience gained in the introduction of the new law would provide a useful background for the delegates in the discussions during both parts of the Conference.

120. Mr. GOLDRIAN (BDI and DVGR) stated that the Organizations that he represented had always welcomed and supported the harmonization process. They had been surprised and dissatisfied by the last-minute proposal made to enable the retention of the first-to-invent system and his Organization deplored that development. The members of his Organizations had had a long-standing positive experience with the first-to-file system and with the grace period and viewed them very favorably. Moreover, the first-to-file system constituted the only financially affordable means of achieving legal certainty. He appealed to all Delegations to use their best efforts to bring into existence a well-balanced package within a shortest possible time limit.

121. Mr. BRUNET (NYPTC) expressed the hope that the official delegations would not consider the participation of observer organizations in the Conference as an intrusion but would, rather, see their participation as

bringing to the Conference the benefit of their experience. He invited questions and formal and informal discussion with delegations and, in this regard, stated that while his current position on the issues to be discussed was based on instructions from his Organization, his Organization did have a demonstrated willingness to modify its positions.

122. Mr. de PASSEMAR (CEIPI) stated that, as far as legal culture was concerned, WIPO constituted the sole organization capable of undertaking a project as complex as that of the harmonization of patent legislation. He observed that CEIPI was directly concerned by the project since it was responsible for the legal training of Frenchmen, Europeans and, in cooperation with WIPO, trainees from the developing countries. It was therefore keenly interested in an outcome to the Conference that would be directed towards equity and justice and the deletion from national laws of those particularities that served no other purpose than to hinder the effective use of the patent system.

123. Mr. TAKAMI (AIPPI) stated that AIPPI, whose membership was above 7,000 world-wide, had intensively studied the matters dealt with in the draft Treaty at an international level. He recalled that his Organization had always actively participated in the meetings of WIPO. He stated that the patent system was very important for international transfer of technology and the key factor for economic development, not only for developed countries, but also for developing countries. Progress and development of new technology in recent years had recently accelerated so that, for users of the patent system, harmonization was essential. In particular, he felt that simplification of the patent system and the establishment of uniform criteria were important and saw that harmonization would result in strengthened protection for inventors. He hoped that deliberations of the Conference would result in a fruitful conclusion.

Fourth Meeting
Thursday, June 6, 1991
Morning

Election of the Vice-Presidents of the Conference
Election of the Members of the Credentials Committee
Election of the Members of the Drafting Committee

124.1 The PRESIDENT opened the meeting and stated that he was now ready to report on the informal discussions concerning elections. The discussions had lasted more than two days. All were sorry that the delegations and the observers had had to wait for such a long time. But now there were results, and the President wished to put them to the Conference for adoption.

124.2 As far as the Vice-Presidents of the Conference were concerned, it was proposed that they be 12, rather than 10, and it was proposed that they be:

the representatives of 5 Group 77 countries, namely,
Cameroon
Chile
Lebanon
Philippines, and
the United Republic of Tanzania,

the representatives of 4 Group B countries, namely,
Australia
Germany
Japan, and
Portugal,

as well as the representatives of three other countries, namely, China, Hungary and the Soviet Union.

124.3 As far as Main Committee I was concerned--of which, it was recalled, all member Delegations were members--, it was proposed that

the Chairman be Mr. Comte from Switzerland and
the two Vice-Chairmen be from Swaziland and Uruguay.

The names of the two Vice-Chairmen would be furnished to the Secretariat by the interested two delegations.

124.4 As far as Main Committee II was concerned--of which, it was recalled, all member Delegations were members--, it was proposed that

the Chairman be Mr. Trombetta from Argentina and
the two Vice-Chairmen be from Czechoslovakia and Sweden.

The names of the two Vice-Chairmen would be furnished to the Secretariat by the interested two delegations.

124.5 As far as the Credentials Committee was concerned, it was proposed that

the Chairman be Mr. Kamel from Egypt,
the two Vice-Chairmen be from Brazil and Germany,
and the other eight members be from
Congo
Finland
Ireland
Malaysia
New Zealand
Poland
Portugal and
Sri Lanka.

The names of the two Vice-Chairmen would be furnished to the Secretariat by the interested delegations.

124.6 As far as the Drafting Committee was concerned, it was proposed that the Chairman be Mr. Kirk from the United States of America the two Vice-Chairmen be from Algeria and Spain and the other seven elected members be from

- Canada
- China
- France
- Jordan
- Mexico
- Soviet Union and
- United Kingdom.

The names of the two Vice-Chairmen would be furnished to the Secretariat by the interested delegations.

It was recalled that the Chairman of the Main Committee I (Mr. Comte) and the Chairman of Main Committee II (Mr. Trombetta) would be ex officio members of the Drafting Committee.

124.7 As far as the Steering Committee was concerned, it was proposed that it consist not only of its 5 ex officio members, but also of 4 elected members.

The 5 ex officio members were the President of the Conference (Mr. Engels, the Netherlands), and the Chairmen of the four Committees, namely, Main Committee I (Mr. Comte, Switzerland), Main Committee II (Mr. Trombetta, Argentina), Credentials Committee (Mr. Kamel, Egypt) and Drafting Committee (Mr. Kirk, United States of America).

As far as the 4 elected members of the Steering Committee were concerned, it was proposed that they be from China, Indonesia, Poland and the Soviet Union. The names of the representatives of those four members would be furnished to the Secretariat by the interested delegations.

Thus, the Steering Committee would consist of 9 persons, three coming from the Group of 77, three coming from Group B and three coming from neither of those Groups.

124.8 The President stated that if those proposals had the approval of the Conference, two provisions of the Rules of Procedure would have to be modified, namely, Rule 14, paragraph (1), concerning the Steering Committee and Rule 15, paragraph (1), as far as the number of the Vice-Presidents of the Conference was concerned.

As far as Rule 14, paragraph (1), was concerned, it was proposed that the following words be added to the first sentence "and four Member Delegations elected by the Conference, meeting in Plenary."

As far as Rule 15, paragraph (1), was concerned, it was proposed that the words "ten Vice-Presidents" be changed to "12 Vice-Presidents."

124.9 Finally, it was to be noted that since the four Committees must elect, themselves, their officers, if the proposals of the President in respect of those officers were adopted, they should be considered as adopted not by the Plenary but by the four Committees, as if the four Committees were sitting separately under the ad hoc chairmanship of the President.

124.10 The President stated that the proposals were known to most of the delegations since most had participated in the informal consultations or the various group meetings. They formed a well-balanced package, and he proposed that the Conference adopt them, without a vote, by consensus, in their totality.

124.11 The President then asked whether there were any objections to the proposals. There being no objections, he declared the proposals to be adopted by consensus.

125. Mr. KESOWO (Indonesia), speaking on behalf of the Group of Developing Countries, while stating that he was thankful that the organizational aspects of the conference had been finalized, expressed disappointment that the Conference had been delayed on procedural matters, especially in relation to the composition of the Steering Committee. He wished it to be made clear that the delay had not been caused by the Group of Developing Countries. On the contrary, the solution just agreed upon by the Plenary had been approved by the Group of Developing Countries two days' earlier, only to be rejected by others and then, after a continuation of negotiations, returned to again. He indicated that throughout the negotiations the Group of Developing Countries had shown a flexibility resulting from its desire to deal with substantive, rather than procedural, issues in the Conference. He wished to assure the Conference that the Group of Developing Countries would always be willing to exhibit the same flexibility to attain a compromise package and he hoped that other parties would do the same.

Consideration and Adoption of the Agenda

126. The PRESIDENT moved to the discussion of item 5 of the draft agenda contained in document PLT/DC/1 (Consideration and adoption of the agenda) and asked if there were any comments thereon.

127. Mr. SUGDEN (United Kingdom), observing that the draft agenda had been prepared before the decision to divide the Conference in two parts, requested clarification as to which of the items on the draft agenda would be dealt with in the first part of the Conference and which would be dealt with in the second part.

128. Mr. BOGSCH (Director General of WIPO) stated that it was likely that, for the remainder of the first part of the Conference, discussions would take place primarily in Main Committees I and II, and would involve a consideration of the basic proposal. The exact order in which such consideration would take place would be decided upon by the Steering Committee. He recalled that the decision of the Assembly of the Paris Union taken in April, 1991, was that final decisions on all articles would be made only in the second part of the Conference, so that there could be no question of the Treaty being adopted in the first part.

129. There being no further discussion, the PRESIDENT declared the agenda contained in document PLT/DC/1 to be adopted.

Opening Declarations (continued from paragraph 123)

130.1 Mr. KIM (Republic of Korea) stated that there was an urgent need to harmonize patent laws in order to provide for a balanced international protection system for inventions. Harmonization of patent laws would contribute to global economic development by encouraging creative and inventive activities, and, thus, to the prosperity of mankind. He observed that, nevertheless, there were still many different views and opinions regarding the appropriate level of patent protection which had become obstacles to achieving agreement on some of the major issues of the Patent Law Treaty.

130.2 He stated that the Government of the Republic of Korea had revised its industrial property laws in recent years in order to keep pace with changing international trends in that field. It had also participated actively in the Committee of Experts on the harmonization of patent laws with the hope that the Treaty would be quickly adopted. He was of the opinion that such a treaty would go a long way to facilitate an overall streamlining of the application process, more efficient protection of inventions and effective patent administration worldwide.

130.3 He expressed support for most of the draft Articles contained in the draft Patent Law Treaty concerning application procedures and requirements, even though some of them departed from those of the Korean Patent Law. He did not believe, however, that it was desirable to permit the co-existence of the first-to-file and first-to-invent principles. His Delegation was in favor of the first-to-file system for the timely publication of inventions and the legal stability of patent rights. In addition, it believed that patent rights should be granted expeditiously. He found, however, that the proposed provisions relating to the publication of the search report and time limit for examination were too onerous since their implementation depended on the circumstances of each country's patent office. With regard to patentability, he thought that inventions contrary to public order or morality should be excluded and that it was premature to discuss the question of animal varieties at the conference.

130.4 He was confident that the harmonization of patent laws would contribute to the development of each country's industrial property system and the world economy. He stated that, in order for the Treaty to succeed, every participant should be willing and ready to make concessions. He expressed the hope that the Conference would serve as an opportunity to achieve the goal of harmonization by reflecting the various views and positions of all the distinguished delegates and participants.

131.1 Mr. VILLIERA (Malawi) stated that Malawi attached great importance to the protection of industrial property. In that connection, he recalled that discussions were underway with the International Bureau on how his country could strengthen its industrial property system. His country was mindful of the fact that industrial property could be a tool for national development. Harmonization of patent laws would ensure uniform protection of inventions in all States bound by the Patent Law Treaty. This was obviously to the advantage of both applicants who seek protection for their inventions and to industrial property offices. In that vein, he urged the Conference to consider and discuss the basic proposal as contained in document PLT/DC/3 with an open mind.

131.2 He recalled that this was the first part of the Diplomatic Conference at which no final decision could be taken regarding the provisions of the Treaty. However, it was Malawi's hope that the Conference would be a stepping stone towards the harmonization of patent laws and that the divergent views held by delegations would be reconciled and an amicable solution arrived at.

132. Mr. ZAVAREIE (Iran) stated that his Delegation would participate in discussions and would express its views in respect of specific Articles in the Main Committees at the appropriate time.

133. Mr. NGOUA-MEYO (Gabon) stated that his country had been happy to make its modest contribution to the various stages that had preceded the convening of such a large international forum. As a developing country, Gabon had always attached great importance to industrial property and to WIPO's activities in that field. In addition to the technical issues that were to be discussed in detail during the Conference, a matter of special interest for the developing countries such as Gabon was whether there was a real chance of such countries obtaining benefit in future from the conclusion of the Treaty. The Delegation of Gabon asked itself that question with anxiety but without pessimism and with the certainty that the reply would depend on the way in which the States participating in the Conference would achieve a compromise taking into consideration the legitimate interests of all groups of States.

134. Mr. WARR (Malta) stated that the work undertaken pursuant to the harmonization of patent laws would be instrumental to Malta when amending its own patent law.

135. Mr. NOSOLINY (Guinea Bissau) stated that Guinea Bissau was amongst the last countries to become party to the Paris Convention and that his Government attached great importance to industrial property. He therefore hoped for equitable harmonization in order to satisfy the developing countries in general and Africa in particular.

136.1 There being no further discussion on this item, the PRESIDENT declared the consideration of opening declarations by Delegations (item 9 of the draft agenda) closed.

136.2 He expressed gratitude for the praise expressed by delegations for the hospitality extended by the Government of the Netherlands and the city of The Hague. He warmly concurred in the congratulations that had been extended to Dr. Bogsch, the Director General of WIPO, and the International Bureau of WIPO for their efforts in the preparation of the Conference.

136.2 He then suspended the meeting in order to enable the Steering Committee to meet to decide on the organization of the work of the Conference thenceforth.

[Suspension]

137.1 The PRESIDENT reconvened the meeting and reported that the Steering Committee had met and had reached complete agreement on how to proceed. It was the intention of the Steering Committee in principle that the two Main Committees should not meet at the same time. It was also the intention and wish of the Steering Committee that the basic proposal be considered in the sequence of the provisions presented therein.

137.2 He then adjourned the Plenary in order that Main Committee II might convene to discuss the first provision contained in the basic proposal, namely, the Preamble.

Fifth Meeting
Friday, June 21 1991
Morning

138.1 The PRESIDENT opened the fifth meeting of the Plenary of the Diplomatic Conference.

Report of the Credentials Committee

138.2 He noted that the next item on the Agenda for the Conference was the report of the Credentials Committee. He invited the Chairman of the Credentials Committee, Mr. Kamel of Egypt, to present the report.

139.1 Mr. KAMEL (Chairman of the Credentials Committee) stated that he had the privilege and the honor to present to the Conference the report of the Credentials Committee which had met, under his Chairmanship, on June 19, 1991. He wished to briefly summarize the main points of the report, which was contained in document PLT/DC/66, and supplement the report with additional information relating to the credentials, full powers or letters or other documents of appointment received since the Credentials Committee last met.

139.2 The Credentials Committee consisted of 11 States: Brazil, Congo, Egypt, Finland, Germany, Ireland, Malaysia, New Zealand, Poland, Portugal and Sri Lanka.

139.3 The Credentials Committee had examined the documents presented as credentials, full powers or letters of appointment by the Governments of the States and by the Observer Organizations invited to the Conference.

139.4 The criteria which the Credentials Committee had applied in its examination of the credentials, full powers, letters or other documents of appointment presented for the purposes of Rules 6 and 7 of the Rules of Procedure were set forth in paragraph 5 of the report. The Committee recommended to the Conference, meeting in Plenary, that those criteria should govern the decision of the Conference on this matter.

139.5 The delegations in respect of which the Committee had found that credentials and full powers, or credentials alone, existed in the name of their delegates announced as participants in the Conference were listed in paragraph 7(a), (b) and (c) of the report.

139.6 The Organizations in respect of which the Committee had found that letters or other documents of appointment existed in the name of their representatives announced as participants in the Conference were listed in paragraph 7(d) of the report.

139.7 The Credentials Committee recommended to the Conference the acceptance of the credentials, full powers and letters or other documents of appointment of the Delegations and Observer Organizations listed in paragraph 7.

139.8 He noted that since the meeting on June 19, 1991, of the Credentials Committee, the Secretariat had received two documents: one setting forth the full powers of the Delegation of Luxembourg; the other setting forth the credentials of the Delegation of Nigeria. He proposed that the name of Luxembourg be added to the list of Delegations appearing in paragraph 7(a)(i) of the report and that the name of Nigeria be added to the list of Delegations appearing in paragraph 7(a)(ii) of the report.

139.9 He drew the attention of the Delegations and representatives of Observer Organizations to paragraphs 10, 11 and 12 of the report which concerned the presentation of credentials, full powers or letter of appointment in respect of the second part of the Conference.

139.10 Finally, he expressed his appreciation and that of the members of the Credentials Committee for the excellent preparations made by the Secretariat which had facilitated greatly the tasks of the Credentials Committee.

140. The PRESIDENT thanked the the Chairman of the Credentials Committee for having presented the report.

141. Mr. LEDAKIS (WIPO) informed the meeting that, since the distribution of the report of the Credentials Committee, the Secretariat had received a copy of the credentials of the Delegation of Israel. As soon as the original of those credentials was received, the appropriate correction would be made to paragraph 7 of the report of the Credentials Committee.*

142.1 There being no other observations, the PRESIDENT declared the report of the Credentials Committee to be adopted.

Closing Declarations

142.2 He then opened the floor for closing declarations.

143.1 Mr. MOTA MAIA (Portugal), speaking on behalf of the Group B countries, stated that the States member of Group B were very pleased to address their sincere thanks to the Government of the Netherlands for having organized the first session of the Diplomatic Conference in the most pleasant city of The Hague. All the members of the delegations of the Group B countries wished to express their gratitude to the Government of the Netherlands, to the Netherlands Patent Office and to the Municipal Authorities of The Hague for the remarkable welcome they had enjoyed during the three weeks of work.

* The original was received by the Secretariat on June 27, 1991.

143.2 The delegates of the States member of Group B were also grateful to the Government of the Netherlands, to the Burgomaster of The Hague, to the Benelux Trademark and Designs Offices, to WIPO, to the European Patent Office, to the Netherlands Association for Industrial Property and the Netherlands Association of Patent Attorneys and to all of those who, in one way or another, had contributed to the organization and the success of the excellent program of social events that had considerably helped in strengthening friendly ties between the delegates.

143.3 The delegations of Group B wished also to warmly thank and congratulate WIPO, in the person of its Director General, Dr. Arpad Bogsch, the Secretariat and all the other staff of the Organization for the remarkable work that had been done and the inestimable intellectual and material support they had given to the delegations with the greatest consideration and efficiency.

143.4 The States member of Group B wished to express their gratitude to the President of the Conference, Mr. Max Engels, and to the Chairmen of the Committees, namely, Mr. Jean-Louis Comte and Mr. Antonio Trombetta, for the remarkable competence with which they had chaired their respective Committees. The States member of Group B also wished to pay a tribute to all the participants in the Conference, not only their colleagues from the other member delegations, but also the representatives of the special delegations and the intergovernmental and non-governmental observer delegations for their constructive contributions throughout the discussions.

143.5 Finally, the delegations of the States member of Group B also addressed their thanks to the interpreters for their excellent work that had enabled the participants to understand one another.

143.6 In that context, and in his capacity as Spokesman for Group B, he wished to stress that the excellent atmosphere in which their discussions had taken place had done much to help in obtaining results that might be considered encouraging for the continuation of their work. The exchanges had led to a better comprehension of the problems and of the points of view that each might have. It would certainly be a subject for reflection and would enable all to approach the second session of the Conference with proposals to achieve the worldwide harmonization that all sought. The Group B States were convinced that harmonization would assist in promoting the technical progress that was an indispensable factor in improving living conditions throughout the world.

144. Mr. KESOWO (Indonesia), speaking on behalf of the Group of Developing Countries, expressed his gratitude to the Government of the Kingdom of the Netherlands for the warm hospitality which it had extended to all of the participants and for the excellence of the arrangements which it had provided as the host of the first part of the Diplomatic Conference. The Government of the Netherlands and the Netherlands Patent Office had succeeded in creating an atmosphere which was conducive not only to constructive discussion but also to the establishment of friendly relations amongst the various delegations.

144.2 He extended his thanks also to WIPO and to the Director General, Dr. Arpad Bogsch, for his support and advice throughout the first part of the Conference. He also thanked the Secretariat for their constructive assistance during the Conference.

144.3 He extended his congratulations and expressed his gratitude to the President of the Conference, Mr. Max Engels, as well as to the Chairmen of the Main Committees, Messrs Jean-Louis Comte and Antonio Trombetta, for the fine way in which they had conducted the proceedings of the Plenary, Main Committee I and Main Committee II, respectively.

144.4. He thanked the interpreters for their patience and their fine work in enabling the delegations to understand each other. He also thanked the clerical and technical staff of the Conference who had facilitated the work of the Conference.

144.5 He wished finally to thank the delegations for their constructive contributions to the discussions which had vindicated the holding of the first part of the Conference by producing results which would serve as the basis for the eventual establishment of a treaty achieving worldwide harmonization of patent laws.

145.1 Mr. OUSHAKOV (Soviet Union) stated that he wished to express the gratitude of his Delegation once again to the Government of the Kingdom of the Netherlands for having hosted in an outstanding way, and for the excellent organization of, the Conference, as well as for the possibility that had been provided to the participants to get to know the wonderful country of the Netherlands and its achievements. In that regard, he stated that the participants would all long remember the wonderful final reception that had been given on the preceding evening.

145.2 He expressed the gratitude of his Delegation to the President of the Conference, Mr. Max Engels, and to the Chairmen of the Main Committees, Messrs Jean-Louis Comte and Antonio Trombetta, for the warm and efficient way in which they had presided over their respective meetings. He expressed gratitude also to the participants for their constructive contributions to the discussions.

145.3 He stated that, as usual, the Director General, Dr. Arpad Bogsch and the Secretariat had worked at its customary high level. He also thanked the interpreters for their fine work.

145.4 He was conscious that the participants were now saying goodbye to The Hague, but certainly not to hopes of concluding successfully the work that had begun at The Hague. He wished all happiness and success.

146.1 Mr. QIAO (China) stated that his Delegation wished to join others in expressing their hearty thanks to the Government of the Netherlands and to the Netherlands Patent Office for the hospitality that had been offered to the participants during the 21 days of the Conference, which had impressed the participants so deeply that they would never forget it.

146.2 He expressed the gratitude of his Delegation to the Director General, Dr. Arpad Bogsch, and to the Secretariat for their very hard and diligent work.

146.3 He also thanked the interpreters and the other staff members who had enabled the delegates to understand each other. He also extended his thanks to all delegations for their hard and constructive work.

146.4 It was the sincere wish of his Delegation that the second part of the Conference would bring success in the light of the spirit of compromise that had been shown at the present part of the Conference. His Delegation would look forward to meeting the other delegations again to finally achieve the goal of the Patent Law Treaty.

147.1 The PRESIDENT noted that the first part of the Conference had reached item 15 on the Agenda, namely, the closing of the first part of the Conference.

147.2 He stated that, in the first place, he wished to concur with the remarks of the other delegations who had spoken and who had underlined the remarkably active participation of so many delegations during the three weeks of the first part of the Conference. The full and active participation of the delegations in an open and neutral atmosphere had determined the character of the three weeks. Without that participation, the result would not have been the same.

147.3 He stated that he wished to highlight those few among the participants who had, on account of a specific task, contributed specially to the outcome. In the first place, he mentioned the Chairmen of the Main Committees for the wonderful job which they had done. He was pleased that both Main Committees had been able to complete their programs as envisaged. The aim of the three weeks had been to try to discuss all of the Articles and in the Rules and that aim had been achieved. He reiterated his thanks to Messrs Jean-Louis Comte and Antonio Trombetta.

147.4 He stated that he had enjoyed particularly the cooperation which had existed in the Steering Committee. The meetings of that Committee had been short, efficient and fruitful and had produced a clear atmosphere of cooperation. He expressed his gratitude to his colleagues on the Steering Committee.

147.5 He observed that the Spokesmen of the Groups had performed an often hidden performance. The way in which they had acted had been respectable and a major part of the achievements of the first part of the Conference was to be credited to their efforts. He thanked them warmly.

147.6 He stated that it went without saying that all had deep respect for and gratitude to the Director General, Mr. Arpad Bogsch, not only for the preparation of the documentation of the Conference, but also for his active and intense participation in and assistance to the Plenary, the Main Committees, the delegations, the Steering Committee and all participants. The Director General's influence had brought about interesting results for which all were grateful.

147.7 He also expressed his gratitude to the Secretariat for the preparation of documents and the provision of advice at all hours of the day.

147.8 He expressed his gratitude to the interpreters, without whose assistance no outcome or result would have been feasible, for the wonderful job which they had done. He mentioned that there were many others, including clerical and technical staff of WIPO and of the Congresgebouw who both during and before the Conference had performed an excellent job to meet all the detailed requirements that had been made of them.

147.9 He remarked that the way in which the International Bureau of WIPO had assisted the Government of the Netherlands in the preparation of the holding of the Conference had been extremely efficient and he expressed his gratitude to the International Bureau and, in particular, to Mr. Ledakis in that regard.

147.10 He mentioned two persons in particular whose role had been especially significant. The first was Mrs. Groot, who had assumed charge of the preparations of the Conference. He expressed his deep gratitude for all of the work that she had accomplished during the preceding one and a half years, during which time she had become both colleague and a friend. The second was Mr. Nicaise of the Ministry of Economic Affairs who had monitored and supervised the activities of the Organizing Committee and who had played a very active role in preparing the Conference and making the necessary decisions.

147.11 He noted that the results of the first part of the Conference would be for others to evaluate. However, he personally thought that the relatively modest objectives of the first part of the Conference had been fully met. At least, the first part had served as a guarantee that many items had been clarified so that between that time and the holding of the second part of the Conference fruitful discussion could continue.

147.12 With the hope that the second part of the Conference would lead to the conclusion of a Treaty that was satisfactory to all, he closed the first part of the Conference.

MAIN COMMITTEE I OF THE DIPLOMATIC CONFERENCE

Chairman: Mr. J.-L. Comte (Switzerland)

Secretary: Mr. F. Curchod (WIPO)

First Meeting
Thursday, June 6, 1991
Afternoon

1. Mr. BOGSCH (Director General of WIPO) declared open the first meeting of Main Committee I and, referring to the election of the Chairman and Vice-Chairmen reported in paragraph 124 of the summary minutes of the Plenary, above, invited the Chairman, Mr. Comte (Switzerland), to take the chair.

2.1 The CHAIRMAN warmly thanked the Delegations for having entrusted to him the task of chairing Main Committee I. He was convinced that the kind cooperation of the Delegations would ease his task.

2.2 He invited the Conference to discuss the first batch of provisions that had been entrusted to Main Committee I, those contained in Articles 1 to 9. He suggested that the Committee should begin with the most difficult issue, that raised in Article 9, which demanded a choice to be made between the first-to-file and the first-to-invent principles. Two proposals had been submitted with respect to Article 9, the proposal by the Delegation of the United States of America contained in document PLT/DC/6 and the proposal by the Delegation of the United Kingdom contained in document PLT/DC/35. He proposed that discussions should begin with the proposal by the United States of America in document PLT/DC/6 and should be limited to the question of principle between the two systems, first-to-file and first-to-invent.

3. Practically all of the delegations and representatives of observer organizations that took the floor congratulated the Chairman on his election as Chairman of Main Committee I. They referred, in particular, to his wise and clear chairmanship of the meetings of the Committee of Experts preceding the Diplomatic Conference and expressed their confidence in his capacity to preside over the consideration of what would be often difficult and technical questions.

4.1 Mr. MANBECK (United States of America) stated that the United States of America had come to the Conference with a strong desire to participate in the resulting Treaty. It did not, however, wish to negotiate a treaty which the Senate of its Congress would refuse to ratify, as had occurred in the case of the Trademark Registration Treaty. It also wished to avoid a situation like

that which occurred in respect of the Treaty on Intellectual Property in Respect of Integrated Circuits, which had been concluded in Washington in 1989 and where some had felt that the United States of America did not express its concerns and difficulties early and strongly enough.

4.2 In view of those circumstances, the Delegation of the United States of America had evaluated whether it would be possible for the Government to recommend accession to a treaty along the lines of the basic proposal contained in document PLT/DC/3. Its conclusion had been that there was not a consensus in the United States to join such a treaty. The United States was being asked to make many changes in its law, including, for example, the introduction of the mandatory publication of applications, a change in the date that foreign-originated U.S. patents are considered effective as prior art, measuring the term of a patent from filing rather than grant, and, most significantly, the adoption of the first-to-file system. While all of the changes mentioned would meet with opposition, views on the question of the adoption of the first-to-file principle were so divided that the Delegation of the United States of America could not provide an assurance that a Treaty requiring the adoption of that principle would be ratified. Accordingly, the Delegation had suggested an amendment to the basic proposal that would permit an option to retain the first-to-invent system and would thus allow the participation of the United States of America in the resulting Treaty, regardless of the outcome in the United States of the debate concerning the retention of the first-to-invent system or the adoption of the first-to-file system.

4.3 Mr. Manbeck stated that he was aware of the criticisms directed against the first-to-invent system in the United States of America, specifically the inability to rely on acts occurring outside the territory of the United States of America in proving a date of invention. His Delegation was willing to work with others to develop treaty language that could meet such criticism.

4.4 He emphasized that he was not necessarily saying that the United States would keep the first-to-invent system and nor that it would adopt the first-to-file system. In fact, the outcome of the debate on that question was uncertain in the United States of America. The question had been taken up in the advisory commission that had been appointed and it could be said that debate on the matter was now heightened. Perhaps more debate should have taken place earlier, but the fact was that the real debate was occurring now.

4.5 He stated that the Conference would help in the process of consensus-forming in the United States of America but that, in order to assure a reasonable level of certainty of participation of the United States in the resulting Treaty, it was highly desirable, if not essential, that the first-to-invent option be available. He noted that one observer organization had described the proposal of the United States to retain its first-to-invent system as a "catastrophe." He considered, however, that the real catastrophe would be a treaty on harmonization in which the United States of America could not participate because of private sector and congressional disapproval.

5.1 Mr. SCHAEFERS (Germany) stated that Germany attached great importance to the maintenance or adoption by all of the first-to-file principle. He fully agreed with the Delegation of the United States of America that it would be a catastrophe if the United States were to remain outside the treaty on harmonization. United States was one of the biggest producers and consumers

of patented inventions. United States industry was very active on a worldwide basis and it was a basic policy of the United States of America that the protection of intellectual property should be promoted internationally. The basic principles underlying the United States policy internationally were affirmed in the Omnibus Trade Act 1988 of the United States. Under that legislation, the Government of the United States kept a watch list concerning compliance by other countries of proper standards of protection and enforcement of intellectual property. Germany, was, for example, to be found on that watch list because of an alleged lack of sufficiency of protection of computer software. He stated that, if Germany or the European Communities maintained a similar procedure, it would be likely that the United States would be found on the list because of an insufficiency of protection extended to foreigners in respect of the first-to-invent system.

5.2 He stated that the difficulties concerning the first-to-invent system, such as, for example, the principle contained in section 104 of the United States patent legislation whereby acts occurring outside the territory of the United States could not be relied on to prove a date of invention, had been discussed in detail previously. During those discussions, the representative of the United States of America had stated that the first-to-invent system and the requirement of the disclosure of the best mode of making an invention could be given up as part of a package deal. Now, however, the United States had reached a position where it was no longer possible to make the same statement.

5.3 He stated that both German industry and European industry felt adversely affected by the first-to-invent system. The United States had made a step in the right direction in indicating its willingness to adopt changes in relation to section 104 of its patent legislation, but such a step remained insufficient because it would still leave a lot of uncertainties and a lot of very cumbersome procedures in the practice of the first-to-invent system. The time was not, therefore, ripe to accept the United States proposal contained in document PLT/DC/6. The Delegation of Germany would follow with great interest further developments of the United States' position but, for the moment, was unable to accept that position.

6. Mr. GROSSENBACHER (Switzerland) stated that Article 9 of the Basic Proposal constituted, for his Delegation, one of the main pillars of the future treaty. That had been mentioned by his Delegation in its opening declaration. It had also stated its regret for the fact that the proposal by the United States of America, as far as the first-to-file principle was concerned, called into question the harmonization of the patent laws along the lines of the system already adopted in practically all countries. It readily accepted the fact that, from a philosophical point of view, the first-to-invent system could represent the most equitable solution. However, from a practical point of view, which also included that of legal certainty, it raised very serious problems for applicants, particularly for the small and medium enterprises and for foreign applicants. It was a complex and costly system. It was obvious that the complexity and rules of a procedure affected primarily the foreign applicants who were not familiar with it, particularly since it constituted a system that was practically unique in the world. It was therefore not sufficient, as suggested by the comment in the American proposal, to attenuate it by deleting certain discriminatory rules such as those in Article 104. That was why harmonization would have to be achieved, ineluctably, on that issue, on the basis of the first-to-file principle. His

Delegation was aware of the fact that it would require a significant amendment to the legislation of at least one big country. It nevertheless hoped that the realization which appeared to be emerging in the United States of America would soon make it possible for the step to be taken and thereby avoid endangering the fragile balance constituted by the Basic Proposal, to which his Delegation fully adhered.

7. Mr. BRUNET (NYPTC) expressed the support of his Organization for the proposal of the United States of America in document PLT/DC/6. He remarked that the first-to-invent system had been used in the United States of America for nearly 200 years. During that period, the greatest inventions known to mankind had come from the United States of America. Furthermore, the benefits flowing from those inventions had been enjoyed by all countries. Many persons in the United States of America were now concerned that the adoption of the first-to-file system would endanger the continuation of those accomplishments. The matter was, however, being studied closely and it was not impossible that the first-to-file system would be adopted in the future. He recommended, however, that it would be desirable to avoid ultimatum approaches in seeking to persuade the United States to change to that system.

8.1 Mr. SUGDEN (United Kingdom) stated that the first reaction of his Delegation to the proposition of the United States of America in document PLT/DC/6 was considerable disappointment. The work on harmonization had been conducted in the Committee of Experts over a number of years and had involved regular consultations on the part of his Delegation with the interested circles in his country to discuss the progress of that work. Those interested circles had indicated that certain features of the proposed Treaty posed difficulties, such as the grace period, the manner of interpretation of claims and the required method of disclosure of inventions. However, the interested circles and his Delegation were willing to treat those difficulties with understanding on the basis that the proposed Treaty would contain a well-balanced package which included a mandatory adoption of the first-to-file principle. Now, his Delegation had learnt that the previous discussions and progress had all been for nothing since the United States of America wished to retain the first-to-invent system.

8.2 He stated that the supposed advantages of the first-to-invent system had been outlined to the Conference, but those advantages only operated to the benefit of those persons who were operating within the United States of America. Furthermore, those corporations of the United States of America who operated overseas were required to work on the basis of the first-to-file system. In addition, the first-to-invent system was a very complex one in practice, involving such cumbersome procedures as the maintenance of laboratory workbooks. He therefore urged the Conference to seek to achieve harmonization on the basis of the first-to-file principle, without which it would be extremely difficult to achieve a worthwhile treaty. It was true that a treaty without the participation of the United States of America would not be worthwhile, but it was equally true that a treaty without the participation of many other States would also not be worthwhile.

9. Mr. MOTA MAIA (Portugal) wished to make comments of a general nature on the matter of principle. His Delegation wished to conclude a treaty at worldwide level and it would be regrettable if any of the countries were unable to accede. The choice between the first-to-invent system and the first-to-file system raised a problem that the United States of America would

have to solve itself. He pointed out that every country would be obliged to make compromises if the conference were to lead to a practical result. He quoted the example of his country, a small country with a weak industry, that would nevertheless be obliged to make an effort to adopt several provisions to which Portuguese industry was opposed. His Government was currently preparing a draft law for that purpose.

10.1 Mr. BESPALOV (Soviet Union) stated that the one principal issue on which the success of the Conference depended was the question of the attribution of the right to a patent. Logic might dictate that that question should be resolved so that the right was accorded to the first inventor. However, the basis of the patent system required that protection be given only where there was a voluntary disclosure made by the inventor. Thus the encouragement of an early disclosure through a filing by the attribution of the right to a patent to the first to file was of fundamental importance.

10.2 He stated that he was aware that the first-to-file system could produce a result in which a patent was awarded to someone other than the first inventor. He cited the example of the Russian inventor, Popov, who he stated had invented and demonstrated in practice the radio receiver before Marconi to whom a patent was given for the invention in the United Kingdom, where, at that stage, the principle of local novelty was applied and Russian prior art was not taken into account.

10.3 He also drew attention to the practical disadvantages of the first-to-invent system and the fact that the first-to-invent system did not apply in the United States of America to foreigners. He wished, however, every success to the United States of America in its deliberations on whether to consider changing to the first-to-file system.

11.1 Mr. COMBALDIEU (France) said that the Committee was touching on the essential part of its work. He pointed out that the Committee of Experts had worked for a long time and that, obviously, certain problems remained. However, the advent of the proposal contained in document PLT/DC/6 was a great disappointment, both for France and the other European countries, particularly since the United States of America was claiming other provisions that the European countries were willing, despite some hesitation, to accept.

11.2 He well understood that changes were more difficult to accomplish in countries with a long tradition. He understood it all the more for the fact that industry in France did not wish to accept the grace period and could only do so if the United States of America adopted the first-to-file system. He also mentioned that the concept of equivalents was involved as was the date to be taken into account for assessing the equivalents. Since the United States of America was currently studying the respective advantages of the first-to-file system and the first-to-invent system, he suggested that it also study the counterparts offered for adoption of the first-to-file system. He emphasized that, if the United States of America wished to obtain a treaty that gave it overall satisfaction, it was necessary that it also conduct its studies on an overall basis. He pointed out the importance of a treaty to which all countries could accede and made a friendly appeal to his American friends to favorably reconsider adopting the first-to-file system.

12.1 Mr. UEMURA (Japan) stated that his Delegation had made its position clear in its opening declaration. Nevertheless, he wished to re-affirm that

Japan categorically opposed the proposal of the United States of America contained in document PLT/DC/6. It was clear that a mandatory requirement of the adoption of the first-to-file system met the spirit of harmonization in that it would constitute an international rule which was simple, economical and easy to implement.

12.2 He stated that there were numerous problems with the first-to-invent system, such as, for example, the complicated interference procedures that were involved and that caused substantial burden in terms of cost, time and labor and posed particular problems for small and medium enterprises. The involvement of research scientists and laboratories in the maintenance of records concerning the date of invention, as well as in interference procedures, also could be considered to have the effect of hampering research and development and innovation. There was, in addition, a lack of certainty and transparency with regard to the right granted to the genuine right holder under the first-to-invent system, which, in turn, could constitute a hindrance to the licensing and diffusion of patented technology. There were still other problems which he would not describe at that stage.

12.3 He emphasized that Japan could subscribe to the Treaty only on the basis that it included the mandatory principle of first-to-file. The maintenance of the first-to-invent system would spoil the very significant goal that had been aimed at since the start of the harmonization exercise. He noted that Government of Japan had the intention of coping in a very positive light with some of the proposals which it had previously opposed, but it would only do so if there was a grand package which included the mandatory principle of first-to-file, an appropriate term of protection and early publication. His Delegation was pleased to hear during the opening declarations that different efforts were being made in the United States of America to formulate a consensus in favor of the first-to-file principle and he hoped that that consensus would materialize.

13. Mr. NEERVOORT (Netherlands) recalled, in respect of draft Article 9 that in the Netherlands the interested circles had been strongly opposed to grace period provisions and, because of that, had difficulty in accepting an article in the draft Treaty containing such provisions. Upon hearing in the Committee of Experts that the United States of America would be willing to accept the first-to-file principle, however, the possibility of establishing a package including the first-to-file principle and the grace period emerged. Given that situation, he stated that his Delegation was disappointed to receive the proposed amendment from the United States of America. While he was grateful for the offer of the Delegation of the United States of America to remedy certain difficulties experienced by foreigners filing applications in their country, he doubted this would restore the equilibrium that had been upset. He hoped the United States of America would change its opinion and would accept the system of the first-to-file in the near future.

14. Mr. GARIEPY (Canada) stated that his Delegation believed that the first-to-file principle was so important for harmonization that it had to be included in the Treaty. He recognized that it would be extremely unfortunate if the United States of America could not ratify the resulting Treaty, but the present proposal of the United States of America was not acceptable. He therefore hoped that the United States of America would be able to agree to a treaty which did not include the right to retain the first-to-invent system, since there were considerable problems with the first-to-invent system as it existed in the United States of America.

15. Mr. KAMEL (Egypt) stated that his Delegation supported the first-to-file principle on the basis that it was clear and unambiguous.
16. Mr. HIEN (Burkina Faso) wondered whether the developing countries were not being marginalized in the discussion on the choice between the first-to-file principle and the first-to-invent principle since those countries were consumers of foreign inventions. Nevertheless, his country considered it more judicious to adopt the first-to-file principle.
17. Mr. SAPALO (Philippines) stated that his country presently used the first-to-invent system. In the spirit of harmonization, however, the Patent Office had initiated moves to adopt the first-to-file principle and a proposal to that effect was pending in draft legislation before its Congress. He wished to express understanding of the situation in the United States of America, since, during public hearings of the proposal for change in the Philippines, there had been strong resistance from some groups, especially inventors groups, to the change to the first-to-file system.
18. Mr. ALLELA (Kenya) stated that his Delegation placed great importance on transparency. In that respect, it was clear that the first-to-file system was preferable, since it was easier to verify the date of filing than the date of invention. He pointed out that the developing countries were consumers of the products of technology, rather than of technology, and that he considered that the first-to-file system would provide the best incentive for developing the capabilities of inventors and scientists in his own country.
19. Mr. WIERZBICKI (New Zealand) stated that his Delegation considered the first-to-file principle to be fundamental. It was unfortunate that the United States of America was unable to accept it, particularly as that country had appeared willing to do so previously as part of a package. He emphasized that the notion of a package deal was particularly important for his country and that, in order to achieve such a package, all countries would have to compromise. He said his own country was in the process of reviewing its law and a number of changes would be required if New Zealand was to bring its law into conformity with the basic proposal. Changes under consideration included the introduction of the publication of applications, the grace period, a twenty-year term and the reversal of the burden of proof. He said New Zealand recognized the practical difficulties confronting the Delegation of the United States of America, but he hoped that those could be overcome.
20. Mr. VON ARNOLD (Sweden) stated that the first-to-file principle was a main feature of a balanced package. His Delegation was very discouraged that the United States of America had withdrawn its formal willingness to accept the first-to-file principle. In fact, the disappointment of his Delegation had been so great that it had made efforts to postpone the Diplomatic Conference, since it considered it to be meaningless to discuss the Treaty before the United States of America clarified its own position domestically. He hoped that the United States of America would take account of the strong arguments that were being presented against their retention of the first-to-invent system.
21. Mr. OPHIR (Israel) emphasized that harmonization was the key concept before the Conference. In the package on harmonization that was being prepared, the first-to-file principle could be considered to constitute a basic pillar and he would therefore urge the United States of America to adopt

that principle. That, however, represented only one side of the coin. The other side of the coin was realism in the face of the difficulty of the United States of America in ratifying a treaty requiring the adoption of the first-to-file system. The word "catastrophic" had been used to describe a treaty without the participation of the United States of America. He would prefer to describe such a situation as disastrous. He hoped that by the second part of the Conference the position of the United States of America would have crystallized. If such were not the case, he proposed that consideration be given to allowing a reservation to the adoption of the first-to-file system which would be limited in time and which might enable the United States of America to join the Treaty with Article 9 in an unamended form.

22. Ms. BACH (Denmark) stated that her Delegation attached great importance to the maintenance of the first-to-file principle on a mandatory basis as part of a well-balanced package containing compromises on the part of all the participants. Her Delegation could not support the proposal by the United States of America to retain the first-to-invent system. It noted with pleasure that efforts were being made to develop a consensus in favor of first-to-file within the United States of America.

23. Mr. KNITTEL (Austria) stated that his Delegation shared the view of the previous speaker. He emphasized that Austrian industry considered that it was necessary for the first-to-file principle to be mandatory.

24. Mr. TOURE (Côte d'Ivoire), after mentioning a delicate situation that had occurred in his country when the rights in a utility model, developed by a group of local craftsmen, had been granted to foreigners who had submitted an application for its protection observed that the first-to-invent system was not without its advantages. However, he clearly stated that his Delegation opted for the first-to-file system which seemed more practical at present.

25. Mr. MBUYU (Zaire) did not see why his country should relinquish a system such as that of first-to-file, which was simple and effective, for something which was more expensive and more complicated.

26. Mr. KHUMALO (Swaziland) expressed the clear preference of his Delegation for the first-to-file principle since the first-to-invent system could be very cumbersome and expensive. He wished the voice of his Delegation to be added to the preponderant view that had been expressed.

27. Mr. BAKER (Australia) expressed the disappointment of his Delegation at the proposal of the United States of America contained in document PLT/DC/6. His Delegation regarded the Treaty as a series of compromises, one of which was the adoption by the United States of America of the first-to-file system. However, in view of the importance of the problem for the Conference, his Delegation wondered whether it might not be desirable to provide for some way out of a stalemate. That way out might be to allow the United States of America to maintain the first-to-invent system for a limited transitional period, on condition that it deleted section 104 of its patent law and the effect of the Hilmer doctrine.

28. Mr. KIM (Republic of Korea) expressed the strong view of his Delegation that the first-to-file principle was an integral part of the harmonization exercise. He expressed the hope that the United States of America would come

around to adopting the first-to-file principle, without which harmonization would be meaningless.

29. Mr. CASADO CERVIÑO (Spain) stated that it was obvious that the proposed Treaty could only be considered from the point of view of a balance. A balance implied that all countries must make compromises. He understood the difficulties involved in making major changes, mentioning the difficulty that his own Delegation had in adopting the grace period. He stated that the suggestion of a transitional period that was limited in time during which the United States of America could retain the first-to-invent system might be a good one, provided that such a limited transitional period was extended to all those legal points that were complex and difficult for countries to adopt, including, obviously, the grace period.

30. Mr. VÉKÁS (Hungary) stated that he could imagine the difficulties that the United States of America would face in changing to the first-to-file system. Nevertheless, that system had proved its advantages in the vast majority of countries of the world. In order to achieve a higher level of harmonization, the option to retain the first-to-invent system should not be permitted. He hoped that the position of the Delegation of the United States of America would change.

31. Mrs. JESSEL (Commission of the European Communities (CEC)) held that it was no longer the right time to assess the respective merits of the first-to-file and first-to-invent systems, but to choose that system which best suited the great majority of countries. In that respect, it was obvious that the first-to-file principle practically enjoyed unanimity amongst the Delegations. She added that to accept the amendment to the Basic Proposal permitting the United States of America to maintain the first-to-invent system during a limited transitional period, would be a disservice to the American Administration thus deprived of almost unanimous international pressure.

32. Mr. GAO (China) recalled that the first-to-file principle was used in China and that his Delegation favored the text set out in the basic proposal. He hoped that the United States of America would seriously consider the opinions expressed during the Conference and would find itself in a position to change from the first-to-invent system to the first-to-file system.

33. Mr. HATOUM (Lebanon) expressed the disappointment of his Delegation with the proposal of the United States of America in document PLT/DC/6. His Delegation hoped that the United States of America would re-consider its position as a change in that position would do much to lead to a successful conclusion of the Conference.

34. Mr. JAKL (Czechoslovakia) underlined the importance that his Delegation attached to the mandatory requirement of the adoption of the first-to-file principle.

35. Mr. HENNESSEY (ABA) recalled that the Patent, Trademark and Copyright Section of the American Bar Association (ABA) constituted the largest body of practitioners in the field of intellectual property in the United States of America and, perhaps, in the world. Its membership numbered nearly 10,000. He stated that it favored consideration of the amendment of the patent legislation of the United States of America to provide that, except in cases of derivation, the right to a patent should belong to the first-to-file,

provided that such adoption of the first-to-file system constituted part of a broader package which was well-balanced. He thus believed that the eventual position of the United States of America would very much depend on the outcome of the Conference and the various questions before it.

36. Mr. GOLDRIAN (BDI and DVGR) referred to the observations made by the representative of the NYPTC, who had sought to establish a link between the first-to-invent system and the number of important inventions that had originated in the United States of America. He recalled that the vast majority of inventions that had originated in the United States of America had been made by employees of large corporations in the United States of America which, by virtue of the fact that they did business internationally, were forced to follow the first-to-file principle that was used in all markets outside the United States of America. As far as small and medium sized enterprises are concerned, they should be informed that the first-to-file system, avoiding the consequences of the first-to-invent system interference procedures, can save them expenses. He hoped that the United States of America would change its position and agree to the adoption of the first-to-file system.

37. Mr. BETON (UNICE) stated that his Organization was interested in seeing progress achieved and a balanced package established. It regarded the proposal of the United States of America in document PLT/DC/6 as unfortunate because it prejudiced the establishment of a balanced package, was conducive to legal uncertainty and involved excessive and unnecessary expense. He considered that there were two ways out of the difficulty created by the proposal of the United States of America. One way would be to suspend the whole package on harmonization by way of transitional provisions until such time that the United States of America could adopt the first-to-file system. The other would be to place the whole package of provisions into the negotiations on trade-related aspects of intellectual property (TRIPS) in the Uruguay Round of GATT so that the Congress of the United States of America would have no option but to adopt it as part of the expedited approval procedure.

38. Mr. PETERSEN (CIPA, CNIPA and EPI) stated that the Organizations which he represented were aware of the willingness on the part of the United States of America to overcome the discriminatory practices which constituted a part of the first-to-invent system, but regarded such steps as insufficient to balance the advantages to the U.S. inventor of a grace period elsewhere.

39. Mr. SCHMITT-NILSON (FICPI) stated that his Organization was aware of the difficulties that a mandatory requirement of the adoption of the first-to-file system might produce in the United States Congress. He therefore considered that the compromise suggested whereby the United States of America would be permitted to retain the first-to-invent system for a limited period of time should be favorably considered.

40. Ms. LACHOWICZ (Poland) expressed the opposition of her Delegation to the proposal of the United States of America in document PLT/DC/6. Her Delegation was conscious of the difficulties that a change from the first-to-invent system, which had been practised for nearly 200 years in the United States of America, would involve. She stated that, in a spirit of compromise, her Delegation would entertain favorably the idea of a transitional period during which the United States of America could adopt the first-to-file principle.

41. Mr. ZAVAREIE (Iran) expressed the firm support of his Delegation for the mandatory requirement of the first-to-file system.

42. Mr. TAKAMI (AIPPI) stated that his Organization considered the first-to-file principle to be a fundamental element of the proposed Treaty. He considered that the adoption of that principle as part of a grand package was the only means of achieving the goal of harmonization of patent laws throughout the world.

43. Mr. YAMAGUCHI (JPAA) underlined the importance of adoption of the first-to-file principle as less costly and most effective means for obtaining a patent.

44. Mr. de PASSEMAR (CEIPI) said that it had to be acknowledged that, although the first-to-invent system was just and equitable from a philosophical point of view, it was nevertheless discriminatory at international level in practice. Moreover, if it was wished to achieve harmonization, there was no other option but to insist on the universal adoption of the first-to-file principle.

45. Mr. OLD (APAA) stated that his Organization had been reluctant to express itself on the question since one of the countries from which its members were drawn, namely, the Philippines, had the first-to-invent system. However, during the Conference the Delegation of the Philippines had indicated that a new proposal was before its Congress to change to the first-to-file system. He also made reference to the observations made by a number of delegations that foreigners were not able to operate in the United States of America on the basis of the first-to-invent system. He recommended that the first-to-file principle be included as an essential part of the harmonization treaty.

46.1 Mr. MANBECK (United States of America) stated that his Delegation had listened with great interest to the comments that had been made. He stated that the first-to-invent system had been a way of life in the United States of America for a long time and that much of the inventive community, such as universities and small enterprises, liked and wanted to keep it.

46.2 He had listened to the criticism that the first-to-invent system posed difficulties for foreigners. However, he did not consider that the difficulties could be unbearable since over 45 per cent of the patent applications received in the United States of America came from overseas.

46.3 He also wished to correct the statements that had been made that the United States had stated that it would adopt the first-to-file system. Rather, the representatives of the United States of America had expressed a willingness to recommend a change to the first-to-file system in the context of a well-balanced package. Such representatives did not and could not have, however, the power to commit the United States to a change which required, amongst other things, Congressional approval.

46.4 He also wished to comment on the statement that the United States had indicated that it would be prepared to move away from the requirement of the disclosure of the best mode of making an invention. He wished to make it clear that, since November 1987, the United States of America had consistently underlined the need to keep the best mode requirement for itself.

46.5 Concerning the observations that had been made on the grace period, he wished to point out that the grace period was of benefit to all nations and that withholding it from the Treaty would consequently involve damage to all those countries which did not presently have a grace period.

46.6 He also wished to clarify some confusion that he considered seemed to have been created concerning the effect of the proposal of the United States of America in document PLT/DC/6. He wished it to be clear that the United States of America did not want to impose the first-to-invent system on any other country but, rather, wished to retain an option to maintain that system itself.

46.7 He expressed the appreciation of his Delegation for the suggestion which had been made that the first-to-file system might be introduced in the United States of America after a transitional period that was limited in time. Such a suggestion had not yet been considered in the United States of America, but would now be considered.

46.8 He expressed the gratitude of his Delegation for the opportunity given to it to make its position known and to comment on the observations that had been made by the other delegations that had spoken.

47.1 The CHAIRMAN closed the discussion on the matter of principle. He thanked all the delegations that had congratulated him on his election.

47.2 He observed that a very large number of delegations, constituting a very large majority of Main Committee I, had clearly backed the advantages offered by the first-to-file system. Furthermore, that same majority had pointed to the drawbacks of the first-to-invent system, quoting in particular its cost and lengthy procedure, together with the hazards of the system for those who have trust in it and file applications abroad in countries where there is no period of grace.

47.3 He also observed that the great majority of delegations that had spoken attached capital importance to that issue and considered the compulsory first-to-file principle to be the keystone of the Treaty. The adoption of that system constituted the essential element if concessions were to be obtained such as the grace period and other items.

47.4 He mentioned that the great majority of delegations had also appealed to the United States of America and the Philippines in an attempt to achieve the necessary consensus for adopting the first-to-file principle. It was pointed out, in that respect, that harmonization of patent laws was not a stocktaking of all national laws, but rather the search for a common denominator that was as simple and as clear as possible.

47.5 Finally, he mentioned the idea, raised by a number of delegations, of transitional measures that would enable the first-to-invent system to be maintained for a limited period of time.

47.6 He adjourned the discussions.

Second Meeting
Friday, June 7, 1991
Morning

47.7 The CHAIRMAN opened the second meeting of Main Committee I and thanked President Braendli of the European Patent Office for the reception sponsored by that Organisation on the previous evening.

47.8 He recalled also the excellent reception that had been offered by Her Excellency Madam van Rooy on behalf of the Government of the Netherlands to the participants on June 3, and the very interesting and enjoyable sight-seeing tour of The Hague on June 4. He extended the thanks of participants to the organizers.

47.9 He indicated that draft Articles 1 to 9 would next be discussed in Main Committee I, after which discussions would resume in Main Committee II.

47.10 He stated that, based upon the experience gained in the discussions of the Committee of Experts, it would not be possible to discuss all of the Articles, Rules and proposed amendments in depth during the time available to Main Committee I. It appeared wise, therefore, to select the most difficult of the provisions for initial discussion and he proposed, therefore, to commence with the discussion of Articles 3 and 4.

Article 3: Disclosure and Description

48. The CHAIRMAN opened discussion on Article 3, indicating that there were three proposals for amendment of that Article, and the corresponding Rule 2, namely, the proposal of the Delegation of Israel (PLT/DC/30), that of the Delegation of Germany (PLT/DC/39) and one from the Delegation of Japan (PLT/DC/27). He then gave the floor to the Delegation of Israel to introduce its proposal.

49. Mr. OPHIR (Israel) indicated that the proposal of his Delegation was to delete the second part of Article 3(2)(b) which read "and such contents shall be presented in the prescribed order." He stated that, as anticipated in Alternatives A and B of draft Rule 2, certain circumstances might render it necessary or preferable to change the order of the prescribed contents of the description. Therefore, provisions relating to the order in which the contents of the description were presented would best be dealt with in the rules, rather than in draft Article 3

50. Mr. BOGSCH (Director General of WIPO) indicated that the flexibility desired by the Delegation of Israel was already contained in the Article and the Rule thereunder.

51. The CHAIRMAN, observing that there was no support for the proposal by the Delegation of Israel, closed discussion on it.

52. Mr. KIRK (United States of America) proposed deleting the portion of Article 3(3) which, in respect of the disclosure or the description, provided that no additional or different requirements from those provided for in the relevant provisions of the Regulations could be imposed. His Delegation considered that provision to be redundant in view of paragraph 2(b), which provided that the "description shall have the prescribed contents, and such contents shall be presented in the prescribed order."
53. Mr. UEMURA (Japan) indicated that his Delegation had no strong objection to the proposal of the Delegation of the United States of America. He stated that the proposal might have some relationship with the proposal of his Delegation (PLT/DC/27) to delete paragraph (3) of draft Rule 2.
54. The CHAIRMAN, observing that there were no objections, indicated that the proposal of the Delegation of the United States of America to delete the phrase "and in the relevant provisions of the Regulations" from draft Article 3(3) was generally supported.
55. Mr. SCHAEFERS (Germany) expressed the concern of his Delegation in respect of the last sentence of paragraph (1)(b) which read that "[a]ny Contracting Party may require that the deposit be made on or before the filing date or, where priority is claimed, the priority date of the application." He indicated the preference of his Delegation for a mandatory provision whereby each Contracting Party would have to require that the deposit be made on or before the indicated date.
56. Mr. COMBALDIEU (France) supported the proposal made by the Delegation of Germany.
57. Mr. MESSERLI (Switzerland) supported an obligatory provision in relation to the date of deposit. His Delegation considered the deposit to be part of the disclosure and, according to the general principle, the disclosure should be made at the date of the application.
58. Mr. SUGDEN (United Kingdom) supported the view that a deposit should be required to be made on or before the filing date of an application. He proposed, however, that the second part of the sentence, which established that a deposit be made before the priority date, where priority was claimed, be deleted.
- 59.1 Mr. KIRK (United States of America) opposed the establishment of a mandatory requirement that a deposit be made on or before the filing date of an application.
- 59.2 He stated that the question of when a deposit should be made was a matter for national law to decide, including in the case of applications originating in another country. He recalled that the question under consideration was related to a question contained in a circular letter which had been sent to the States party to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. He considered that a mandatory rule in this regard should not be adopted without a great deal of further study.
60. Mr. NEERVOORT (Netherlands) supported the proposal by the Delegation of Germany to make it obligatory that a deposit be made on or before the filing or priority date.

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61. Mr. MOTA MAIA (Portugal) preferred to maintain the possibility of choice presented in the basic proposal.
62. Mr. OPHIR (Israel) preferred that the provision not be mandatory and supported the position taken by the Delegation of the United States of America.
63. Mr. GARIEPY (Canada) expressed the preference of his Delegation for draft Article 3(1)(b) as it appeared in the basic proposal. He considered that making the provision mandatory might lead to problems in cases where there was doubt as to whether the subject matter disclosed in an application needed to be supported by a deposit.
64. Mr. BOGSCH (Director General of WIPO) stated that, when drafting Article 3(1)(b) of the basic proposal, there had been some hesitation, as the differences of view on the matter were well known. He indicated that the way in which the provision was drafted in the basic proposal would not prevent any Contracting Party from making it a mandatory provision in their national laws if they so chose. He wondered whether a country's desire to be more lenient in that regard would cause harm to countries desiring to have a mandatory requirement that deposits be made on or before the filing date.
65. Mr. HATOUM (Lebanon) indicated a preference for draft Article 3(1)(b) as it appeared in the basic proposal.
66. Mr. SMITH (Australia) agreed with the Delegation of the United Kingdom that the reference to priority date in the last sentence of draft Article 3(1)(b) should be deleted.
67. Mr. ROMERO (Chile) agreed with the Delegation of the United States of America that there should be no mandatory requirement that the deposit be made on or before the filing date.
68. Mr. SCHAEFERS (Germany) suggested that the provisions in the last sentence in Article 3(1)(b) be reversed so that the principle that a deposit be made on or before the filing date be stated first, followed by a provision enabling a Contracting Party to allow a deposit at a later stage.
69. Mr. SCHATZ (EPO) stated that the deposit was part and parcel of the description and had to be made, therefore, on or before the filing date. He considered that applicants filing in countries having a more liberal system might face uncertainty upon filing in a country that required a deposit to be made on or before the filing date.
70. Mr. SUGDEN (United Kingdom) observed that a deposit of biological material was made in situations where a written description was insufficient. He indicated, therefore, that, for the same reasons that it was not possible to add to a written disclosure following the filing date, it should be mandatory that a deposit be made on or before the filing date. He stated that the reference to the priority date in the last sentence of Article 3(1)(b) was another matter; it concerned the disclosure needed at the priority date in order for claims to be able to rely upon that date; it was not related to establishing a mandatory deposit for purposes of supporting the disclosure at the filing date.

71. Mr. BOGSCH (Director General of WIPO) agreed with the Delegation of the United Kingdom that the date of deposit was not related to the priority right and suggested the proposal of that Delegation be followed.

72. The CHAIRMAN concluded that the proposal to establish a mandatory requirement that a deposit be made on or before the filing date did not enjoy majority support. He then invited observations by the Committee on the proposal by the Delegation of Germany to redraft the last sentence of Article 3(1)(b) so as to state the general principle first that deposits be made on or before the filing date, followed by the optional provision that Contracting Parties might allow deposits to be made at a later date.

73. Mr. KIRK (United States of America) stated that the drafting proposal by the Delegation of Germany was acceptable to his Delegation as long as it was made clear that each Contracting Party would be allowed to follow the optional approach.

74. M. MOTA MAIA (Portugal) agreed in principle with the proposal of the Delegation of Germany, but wished to see a written text prior to forming a definitive opinion.

75. Mr. OPHIR (Israel) stated his willingness to accept, in principle, the proposal of the Delegation of Germany, subject to the clarification indicated by the United States of America.

76. The CHAIRMAN stated that there appeared to be agreement, in principle, with the proposal by the Delegation of Germany and asked that Delegation to prepare a written proposal.

77. Mr. UEMURA (Japan) indicated that his Delegation was awaiting instructions from his government on the item under discussion and reserved the right to make its position clear at a later time.

78. The CHAIRMAN indicated that the Delegation of Japan would have such an opportunity and turned to the proposal made by the Director General of WIPO.

79. Mr. COMBALDIEU (France) asked whether the British proposal nevertheless permitted a Contracting State to require that the deposit with an institution be made at the priority date of the application. He observed that such was the present European system and he wished to be sure that it would still be possible to require that condition.

80. Mr. BOGSCH (Director General of WIPO) interpreted the meaning of the United Kingdom proposal as permitting each country not to afford priority if it deemed the identity of the material not to have been proved at the time that priority had to be proved. The reply to the question put by the Delegation of France therefore seemed to be that the application for priority could be cancelled if it was not proved that the same thing was involved.

81. Mr. HATOUM (Lebanon) proposed, in reference to Article 3(1), that a requirement be added that the invention be easily carried out and that, if there is another related application, that reference be made to it if it covered the same invention.

82.1 The CHAIRMAN indicated that a proposal in that regard had just been received from the Delegation of Lebanon and that the matter would be taken up after the proposal had been distributed.

Rule 2: Contents and Order of Description (ad Article 3(2))

82.2 The Chairman then turned to a consideration of Rule 2 and indicated that there were two proposals in relation thereto, one by the Delegation of Japan contained in document PLT/DC/27 and the other by the Delegation of Germany contained in document PLT/DC/39.

83.1 Mr. SCHAEFERS (Germany) introduced the proposal of his Delegation contained in document PLT/DC/39 stating that it was directed at deleting the facultative provision in Rule 2(1)(vi) which would allow Contracting Parties to require that the description set forth the "best mode."

83.2 He indicated that the proposal being submitted by his Delegation (PLT/DC/39) had been submitted at the eighth meeting of the Committee of Experts and its re-submission reflected the European position in the dialogue with the United States of America. In particular, it was intended as a signal that the question of the "best mode" was an essential element of the package sought in the Treaty.

83.3 He recalled that an information document concerning the manner of description submitted by the International Bureau of WIPO in March of 1987 had recommended abolishing the "best mode" requirement. He further recalled that the Delegation of the United States of America had, in March of 1987, stated its willingness to change its national law to drop the "best mode" requirement but that later it had indicated difficulties in convincing interested circles to drop the requirement.

83.4 He indicated that the "best mode" requirement was not found in the European Patent Convention and that interested circles in Europe and the United States of America were happy with that situation. He further indicated that the "best mode" requirement did not figure in the national laws of the member States of the European Patent Organization, noting in particular that the law of the United Kingdom had been changed in 1977 in that regard. He considered that maintaining the "best mode" requirement in the form of an option was a major deviation from general trends.

83.5 He further stated that the "best mode" requirement was not related to the basic requirements of patentability. He observed that the facultative provision in Rule 2(1)(vi) would allow a Contracting Party to call for "the best mode for carrying out the invention known to the inventor at the time of filing." He further observed that the patent law of the United States of America called for the "best mode" contemplated by the inventor. He stated that this was a subjective element--what was in the mind of the inventor at the date of filing--and would be difficult to prove.

83.6 He also stated that the requirement was not related to the enablement requirement but, rather, was related to the common-law principle that the applicant must deal honestly with the patent office. In that regard he felt that the real significance for the "best mode" requirement was not in patent grant proceedings, but in infringement litigation. He stated that an analysis

of court decisions relating to the "best mode" requirement revealed that it was used by accused infringers to harass and tease patent owners.

83.7 He considered that the "best mode" requirement in the United States of America caused imbalance and difficulties for foreigners filing in that country and that the 45,000 foreign applications filed in the United States Patent and Trademark Office were not attracted by that requirement and, even, would constitute a higher number if it were eliminated.

84. The CHAIRMAN stated that there appeared to be some linkage between the "best mode" requirement and the first-to-invent principle. In particular, an inventor could continue to work to achieve the best mode prior to the filing date in a first-to-invent country. In a first-to-file system the application would have to be filed quickly and further results achieved by the inventor could not be introduced into the application after the filing date.

85. Mr. SUGDEN (United Kingdom) supported the proposal made by the Delegation of Germany. He recalled that the patent law in the United Kingdom had been changed in 1977 to delete a requirement similar to the "best mode" requirement and stated, with respect to that provision in the law up to 1977, that there had been little litigation in the United Kingdom, although such appeared not to be the case in the United States of America. He considered that the "best mode" requirement could lead to costly and time-consuming litigation, which was to be avoided in a modern and efficient patent system.

86. Mr. GARIEPY (Canada) supported the inclusion of the facultative provision in draft Rule 2(1)(vi) to allow Contracting States to require the "best mode." He stated that disclosure of the invention by the inventor was made in return for the inventor being given certain rewards. He referred to court cases involving patents that did not disclose a mode that would allow the invention to work and stated that the wording of the proposal of the Delegation of Germany would allow the disclosure of a mode that would not work. Referring to the jurisprudence in Canada, he indicated that the "best mode" requirement had not created any problems.

87. Mr. SMITH (Australia) supported the position of the Delegation of Canada and inquired as to how the proposal by the Delegation of Germany would prevent a country from requiring the "best mode" requirement.

88. Mr. SCHAEFERS (Germany) replied that, since Article 3(3) provided that "no requirement additional to or different from those provided for ... in the relevant provision of the Regulations may be imposed," no Contracting Party would be able to impose the "best mode" requirement if the proposal of his Delegation were adopted.

89. Mr. MANZOLILLO DE MORAES (Brazil) requested that more thought be given to retaining the option for Contracting Parties to require the "best mode" since it was considered important to his country as a developing nation. He saw the "best mode" requirement as being of particular importance in light of the exception to infringement contained in draft Article 19(3)(iii) for acts performed for research or experimental purposes. That exception was essential to the patent system's purpose of furthering the development of science and technology and would be easier to take advantage of if the "best mode" were required. He stated that Brazil had introduced the "best mode" requirement in July, 1986, in its regulations in response to pressure that had been exerted to introduce such a requirement.

90. Mr. GUERRINI (France) felt it quite logical that in return for the monopoly afforded by the public authorities there could well be an obligation on the inventor to let the community know the most effective way of carrying out the invention. However, it was a fact that in practice that principle nurtured litigation and introduced a factor of legal uncertainty. The imperative need for clarity and legal certainty meant that his Delegation supported the position of the Delegation of Germany.

91. Mr. UEMURA (Japan) supported the proposal made by the Delegation of Germany, even if the "best mode" requirement were merely an optional provision since an applicant in a country not having the "best mode" requirement would nevertheless have to take it into consideration for his domestic application if he planned to file his application in a country having such a requirement and wished to claim priority on the domestic application.

92. Mr. KIRK (United States of America) agreed with the positions taken by the Delegations of Canada, Australia and Brazil. He saw no link between the "best mode" requirement and the first-to-file versus first-to-invent question. He felt it appropriate that, in exchange for the inventor obtaining a patent right, he should not conceal his best thoughts, at the time the application is filed, about how his invention might be utilized or practiced. He did not see the "best mode" requirement as being relevant to enablement, since an inventor could provide an enabling disclosure while hiding his best mode.

93. Mr. MESSERLI (Switzerland) said that the Delegation of Switzerland supported the proposal made by the Delegation of Germany for the reasons that had been presented by that Delegation. His Delegation held that the requirement to set out the best mode could be abusively exploited by third parties, particularly infringers, in court proceedings. It further believed that the requirement to set forth the best mode could turn into a true pitfall for applicants in those cases where, on the date of application or priority, they knew such a mode but were not certain, for some reason or other, whether it was the best one. If it subsequently proved indeed to be the best mode, they ran the risk of losing all their rights and that result did not seem to be what was wanted.

94. Mr. WIERZBICKI (New Zealand) supported the views of the Delegation of Canada and stated that the facultative provision in respect of the "best mode" requirement should be retained. He indicated that the requirement existed in the patent laws of his country and that there had not been any problems with it. He recognized that the proposal by the Delegation of Germany reflected a specific problem that European countries had with the United States of America, but did not believe that that specific problem should lead to the change proposed to Rule 2(1)(vi).

95. Mr. SEGURA (Argentina) was of the view that draft Rule 2(1)(vi) in the basic proposal was correct, for the reasons given by the Delegations of the United States of America and Canada. He stated that if the inventor did not disclose the "best mode" he would, to a certain extent, prevent third parties from carrying out the invention in the best mode.

96. Mr. NYILIMBILIMA (Rwanda) said that his Delegation went along with those of Canada, Brazil, the United States of America and Argentina. He considered that if a country afforded an exclusive right to an inventor, the

latter had to permit access to the protected invention. His Delegation therefore held that the description as proposed by the International Bureau should be maintained.

97. Mr. MOTA MAIA (Portugal) observed that the text of the basic proposal seemed to address at least three characteristics. Firstly, the principle of the best mode for carrying out the invention was optional and, therefore, States were not obliged to adopt it. Secondly, that principle did not mean that the following day, or the week after, the inventor would not find another, even better possibility. Thirdly, the dates referred to were either the filing dates or the priority dates. Furthermore, it seemed after the explanations given by the Chairman that different treatment was necessary with respect to the first inventor and for the first applicant since the first inventor would have more time to ascertain prior to filing what was exactly the best mode of carrying out the invention. That was why the Delegation of Portugal was not able to give its final views and wished to reserve its position until a later date.

98. Mr. GAO (China) supported the positions taken by the Delegations of the United States of America and Canada and indicated his preference for the text in the basic proposal. He stated that the "best mode" requirement was useful and necessary.

99. Mr. KAMEL (Egypt) expressed the preference of his Delegation for the text in the basic proposal.

100. Mr. KESOWO (Indonesia) indicated his preference for the text in the basic proposal allowing a Contracting Party to require the "best mode."

101. Mrs. DE CUYPERE (Belgium) strongly supported the proposal by Germany for all the reasons that had been advanced by that Delegation, particularly because the proposal solved the problems that arose on the basis of a European application where a priority filing had been made in a country that required disclosure of the best mode on the filing date.

102. Mr. CASADO CERVIÑO (Spain) stated that his Delegation had no final position on the issue under discussion, but that it had sympathy for the basic proposal in which the "best mode" requirement would be an optional provision and was, in principle, in favor of it. He indicated that the legislation in his country had no precedent for the "best mode" requirement but that he could see the logic behind requiring the applicant to set forth the best mode he was aware of as of the filing date of the application.

103. Mr. SAPALO (Philippines) supported keeping the text of Rule 2(1)(vi) as in the basic proposal. He stated that the legislation in his country included the "best mode" requirement and that it had caused no difficulties with the enforcement of patents. He indicated that, in his country, reference was made to the "best mode" requirement to convince society as to the effectiveness of patents as a tool for industrial development.

104. Mr. JILANI (Tunisia) expressed his support for the text in the basic proposal stating that, when the inventor was accorded patent rights he should have the obligation to indicate the best possible mode for carrying out the invention. He considered this to be of particular importance for developing countries.

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105. Ms. BACH (Denmark) supported the proposal by the Delegation of Germany.
106. Mr. LOSSIUS (Norway) supported the proposal by the Delegation of Germany.
107. Mr. KORCHAGUIN (Soviet Union) shared, in principle, the view of the Delegation of Germany, seeing no particular need to indicate the best mode since the principal requirement was one of enablement. He expressed understanding for those countries that had the "best mode" requirement and agreed that Rule 2(1)(vi) of the basic proposal, since it was a facultative provision, was a good compromise.
108. Mr. ELHUNI (Libya) indicated that the legislation of his country included the "best mode" requirement and stated that the text of the basic proposal should continue to allow Contracting Parties to require it.
109. Mr. KNITTEL (Austria) supported the proposal of the Delegation of Germany.
110. Mr. VON ARNOLD (Sweden) supported the proposal of the Delegation of Germany. He said that the optional provision in draft Rule 2(1)(vi) would mean that the "best mode" requirement would have to be complied with by applicants in countries not having a "best mode" requirement if such applicants desired to later file in a country having a "best mode" requirement.
111. Mr. HIEN (Burkina Faso) stated that his Delegation was altogether in favor of maintaining the idea of disclosing, in the best manner possible, the execution of the invention. He emphasized the importance of such a requirement for the developing countries, particularly in the transfer of technology context. Furthermore, setting out the best mode of carrying out the invention could be beneficial to all those parties that would then gain knowledge of that best mode of carrying out the invention. He also observed that the idea of disclosing the invention was also to be found in the OAPI system of law that governed the industrial property law of Burkina Faso.
112. Mr. KIM (Republic of Korea) stated that the text set forth in the basic proposal should be retained.
113. Mr. O'FARRELL (Ireland) supported the proposal of the Delegation of Germany, especially considering the difficulties for an inventor to comply with the "best mode" requirement in his country which followed the first-to-file system.
114. Mr. MANTERE (Finland) supported the proposal of the Delegation of Germany.
115. Mr. KIM (Democratic People's Republic of Korea) expressed his support for the text found in the basic proposal.
116. Mr. BOUCOUVALAS (Greece) supported the proposal of the Delegation of Germany.
117. Ms. KRUDO SANES (Uruguay) supported the text in the basic proposal.
118. Mr. ABU BAKAR (Malaysia) supported the text in the basic proposal.

119. Mr. KHRIESAT (Jordan) supported the text in the basic proposal stating that it was clear, flexible and represented a good compromise.
120. Mr. ABDALLA (Sudan) supported the text found in the basic proposal.
121. Mr. LY (Senegal) supported those who had spoken in favor of the proposal by the International Bureau, particularly since he did not understand the amendment that had been put forward by the Delegation of Germany, to the extent that the basic proposal contained only an option and not an obligation.
122. Mr. VU HUY TAN (Viet Nam) said that his Delegation supported the text as contained in the basic proposal.
123. Mr. MTEWEAUNGA (United Republic of Tanzania) supported the text contained in the basic proposal.
124. Mrs. PURI (India) supported the retention of the "best mode" requirement as a facultative provision. She saw such a provision as being useful for developing countries and noted that, for that reason, such a provision had been included in Alternative B of draft Article 25 of the basic proposal, which had its origin in a proposal by a group of developing countries to the Committee of Experts.
125. The CHAIRMAN indicated that the proposal of the Delegation of Germany did not seem to have majority support, so that the text found in the basic proposal should be retained.
126. Mr. SCHAEFERS (Germany) proposed an amendment to draft Rule 2(1)(vi) to preserve or safeguard the priority right by adding that "the priority right shall not be affected where the application whose priority is claimed does not set forth such best mode."
127. Mrs. MOLINOS (Venezuela) expressed her support for the basic proposal.
128. Mrs. JESSEL (Commission of the European Communities) stated that the "best mode" requirement was difficult to apply in practice and that its optional nature was misleading since those intending to file in countries having such a requirement would have to follow that requirement in filing in their home countries, whether such a requirement existed there or not. She supported the proposal by the Delegation of Germany in document PLT/DC/39.
129. Mr. JAYASINGHE (Sri Lanka) expressed his support for the text contained in the basic proposal.
- 130.1 Mr. PETERSEN (CIPA, CNIPA), referring to the observation made by the Delegation of Canada that a disclosure might be of a mode that does not work, stated that such a mode would not be a mode for carrying out the invention and thus would render the application liable to refusal or revocation.
- 130.2 He stated that the position of the inventor seemed to have been overlooked. He presented a hypothetical situation wherein, taking into consideration the "grace period" provision of Article 12 and the restrictions of Article 14(3) in respect of amending an application, an inventor made an invention and published a mode for carrying it out, a mode which was at that

stage the best mode. During the subsequent 12 months of the "grace period" the inventor developed other modes for carrying out the invention and, at the end of the 12-month period, filed an application. He considered that, if the inventor had any intention of filing an application in a Contracting State requiring the best mode, he should include all the modes he had invented, any of which could be the best. If, during the ensuing 12 months of the priority period the inventor carried on with the invention, more modes could emerge. He stated that, when filing foreign applications, he would wish to use a common text including all of the modes, in case one of them turned out to be the best. The size of an application under those circumstances would be appalling, especially considering the translation costs.

131.1 Mr. BETON (UNICE) supported the proposal by the Delegation of Germany. He indicated that the "best mode" requirement did not just apply to countries having such a requirement, since it had to be taken into account by anyone intending to file an application in such a country. He saw the "best mode" requirement as presenting few positive features and as operating mainly to cause legal uncertainty for all parties. In particular, he stated that the requirement included a subjective element that would require extensive taking of evidence to prove, at a high cost. Moreover, he indicated that his experience with cases in the United States of America was that the "best mode" requirement was just a way of harassing other parties in an infringement case or interference proceedings. He understood that the "best mode" requirement as practised in the United States of America did not cover just deliberate concealment, but mistakes and accidents as well.

131.2 He stated that UNICE preferred that the option for the "best mode" provision in Rule 2(1)(vi) be deleted. He further stated that, if retained, it should not apply to applications claiming priority and should only apply to cases of flagrant concealment.

132. Mrs. LEVIS (ALIFAR) indicated her agreement with the text in the basic proposal. In particular, she felt that it responded to the premise that patent documents should be rigorous documents that promoted the dissemination of technology.

133. The CHAIRMAN suspended the meeting.

[Suspension]

134. The CHAIRMAN opened the meeting and noted that the discussion on the best mode in Rule 2(1)(vi) had been completed.

135.1 Mr. BRUNET (ABA) reported that in September, 1989, at a special meeting of the Patent, Trademark and Copyright Section of the ABA, a resolution had been passed that the Section favored, in principle, that any treaty relating to international harmonization of provision for the protection of inventions contain an Article providing (1) that any Contracting State party to that treaty shall require a description that discloses the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art to which it pertains, and (2) that any country may require that the best mode of carrying out the invention be set forth in said description.

135.2 He further reported that another committee of the Section had passed a resolution in 1988 that it favored, in principle, the position that the patent law of the United States of America did not and should not require patent application disclosures to include mechanical tolerances of any particular specimen or model embodying the invention beyond that sufficient to enable a person of ordinary skill in the art to which the invention pertains to make and use the invention utilizing the engineering of those of such ordinary skill. The Section indicated its belief that the opinion of the United States Court of Appeals for the Federal Circuit in Christensen v. Colt Industries was essentially correct as far as it concerned the disclosure requirements of 35 USC 112.

135.3 He considered that the "best mode" requirements of the patent law of the United States of America should not lead to unwarranted attacks on a patent.

136. The CHAIRMAN then turned to Rule 2(2) and asked the International Bureau of WIPO to introduce its provisions.

137.1 Mr. BAEUMER (WIPO) stated that Alternative A of Rule 2(2) was more flexible than Alternative B. He stated that the text of Alternative A was the same as Alternative B except that the words "in manner" and "different manner" did not appear in Alternative A.

137.2 He indicated that subparagraph (b) of Alternative A would allow certain elements not to be included in a description, in particular those appearing in subparagraphs (i), (ii), and (v) of paragraph (1). He further indicated that subparagraph (b) of Alternative A provided flexibility in respect of the requirement of paragraph (1)(iii) in saying that the description of the invention might be "in any terms that satisfy the requirement of a disclosure of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art."

138. Mr. KIRK (United States of America) supported Alternative A, stating that it was a user-friendly provision that, if adopted, would not affect the practices in other offices that did not desire to take advantage of its flexibility.

139. Mr. SCHAEFFERS (Germany) stated his preference for Alternative B. He stated that the Alternative was based upon European experience and practice wherein clear-cut guidelines were followed as to the manner and order of description. Moreover, he saw no difference in the flexibility accorded under Alternative A or B. Indeed, he saw Alternative B as being more flexible in view of its reference to both the manner and order of the description, coupled with the proviso that the manner and order might be varied if, because of the nature of the invention, a different manner or a different order would afford a better understanding or a more economical presentation.

140. Mr. BULGAR (Romania) stated his preference for Alternative A, considering it to be more flexible.

141. Mr. KAMEL (Egypt) preferred Alternative A stating that it offered flexibility for Contracting Parties and users of patent systems.

142. Mr. UEMURA (Japan) considered Alternative A to be too flexible, especially from the viewpoint of enhancing the utility of patent specifications as technical literature. He therefore supported Alternative B.

143.1 Mr. SUGDEN (United Kingdom) supported Alternative B because it referred to both order and manner of description. He was of the view that the end part of the alternative, whereby under some conditions a different manner or order would be permitted, provided sufficient flexibility.

143.2 He expressed sympathy for those who suggested Rule 2(2) would require a slavish following of the manner and order of description which may not be necessary. He accordingly proposed attaching subparagraph (b) of Alternative A to Alternative B. This proposal would mean that an applicant who followed the first paragraph of Alternative B would be in compliance with the requirements of all Contracting Parties. It would, however, be open for certain countries not to require such a full and prescriptive way of disclosing the invention for their own purposes.

143.3 He stated that the proposal was similar to the approach in other Articles or Rules of the draft Treaty which set out what applicants must do in order to be in compliance with the requirements of all Contracting Parties, but allowed some latitude for individual countries to adopt less stringent requirements.

144. Mr. ROMERO (Chile) stated his preference for Alternative A as offering a more flexible approach.

145. Mr. KORCHAGUIN (Soviet Union) stated that, in principle, Alternatives A and B were equivalent. He saw Alternative B as giving more flexibility and indicated his preference for it. He stated that he was prepared to study the proposal made by the Delegation of the United Kingdom.

146. Mr. GAO (China) stated that flexibility should be given to applicants but that Alternative A was too flexible. He preferred Alternative B as requiring more formality in written applications and being, therefore, easier to follow in practice.

147. Mr. JAKL (Czechoslovakia) stated that Alternative A was too flexible and indicated his preference for Alternative B.

148. Mr. KNITTEL (Austria) stated his preference for Alternative B as it was important for harmonization that the contents be in the order and manner as in paragraph (1).

149. Mr. SEGURA (Argentina) said that the two alternatives were similar but that, with a view to harmonization, Alternative B was preferred.

150. Mr. SMITH (Australia) inquired as to the meaning of the word "manner" as used in the context of Rule 2(2).

151. Mr. BAEUMER (WIPO) indicated that the word "manner" had the same meaning in paragraphs (1) and (2).

152. Mr. SMITH (Australia) then wondered whether its use in paragraph (2) was redundant.

153. Mr. SCHAEFERS (Germany) stated that the operative element in Alternative B of Rule 2(2) was the portion following the word "unless" which provided a certain flexibility in the manner and order of presentation of the description from that called for in paragraph (1).

154. Mr. NEERVOORT (Netherlands) stated that Alternative B included the word "manner" because the part of Alternative B following the word "unless" gave possible exceptions to the "manner" of presentation of the description established in paragraph (1). He did not support the proposal of the Delegation of the United Kingdom for the amendment of Alternative B, considering that Alternative B, as it was, better served the goal of harmonization.

155. Mr. KESOWO (Indonesia) sought clarification of whether the proviso of Alternative B following the word "unless" included the elements of subparagraph (b) of Alternative A.

156. Mr. BAEUMER (WIPO) stated that the proviso of Alternative B referred to the totality of paragraph (1) allowing, therefore, not only a deviation in the order of the description, but also a deviation in the manner of presentation of all of the elements of paragraph (1). Under Alternative B one could not omit any of the elements, only present them in a different order or manner.

157. Mr. KESOWO (Indonesia) stated his understanding that the proviso of Alternative B included the elements contained in subparagraph (b) of Alternative A. He accordingly did not see much conflict between the two alternatives.

158. The CHAIRMAN observed that Alternative B was derived directly from the Patent Cooperation Treaty (PCT) and that Alternative A was more specific.

159. Mr. SMITH (Australia) expressed his support for the proposal of the Delegation of the United Kingdom to place subparagraph (b) of Alternative A into Alternative B.

160. Mr. MESSERLI (Switzerland) indicated his preference for Alternative B, stating that it was important to have the term "manner" in the text. He did not support the proposal of the Delegation of the United Kingdom stating that, if one took advantage of all of the exceptions found in subparagraph (b) of Alternative A, one would only be obliged to "disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art" and that this requirement was already contained in draft Article 3(1) of the basic proposal.

161. Mr. WIERZBICKI (New Zealand) supported the proposal made by the Delegation of the United Kingdom to add subparagraph (b) of Alternative A to Alternative B.

162. Mrs. DE CUYPERE (Belgium) stated her preference for Alternative B as giving more flexibility to applicants for the drafting of applications since it dealt with both the manner and order of presenting the contents.

163. Mr. OPHIR (Israel) felt that Alternative A was too flexible and preferred Alternative B. He supported the proposal of the Delegation of the United Kingdom of adding subparagraph (b) to Alternative B.

164. Mr. COMBALDIEU (France) said that his Delegation preferred Alternative B in the basic proposal.
165. Mr. O'FARRELL (Ireland) stated his preference for Alternative B.
166. The CHAIRMAN adjourned the meeting.

Third Meeting
Friday, June 7, 1991
Afternoon

167.1 The CHAIRMAN opened the third meeting of Main Committee I and offered the provisional conclusion with respect to Rule 2(2) that there were few in favor of Alternative A and that it should not, therefore, be maintained. There was a clear majority for Alternative B. He stated that the proposal by the Delegation of the United Kingdom to add subparagraph (b) for Alternative A to Alternative B had been supported, in principle, by a number of delegations. He asked that Delegation to submit that proposal in writing so that, if time permitted, discussion on Alternative B could be continued after the proposal was distributed.

167.2 The CHAIRMAN then turned to a discussion of Article 4: Claims.

Article 4: Claims

167.3 The CHAIRMAN stated that there were two proposals submitted in respect of Article 4, one by the Delegation of Israel, contained in document PLT/DC/31, and the other one by the Delegation of the United Kingdom, contained in document PLT/DC/33. Since both proposals concerned paragraph (3) and were of similar nature, he suggested that they be considered simultaneously.

168. Mr. OPHIR (Israel) explained that the purpose of his Delegations's proposal was to clarify the meaning of the expression "concise" since it was necessary to relate claims to the specific context and circumstances of a given invention. The proposed amendment would be added to give more flexibility to the drafter of a claim.

169. Mr. SUGDEN (United Kingdom) stated that his Delegation's proposal did not address the same issues as the proposal of the Delegation of Israel. His Delegation's proposal related not only to each claim, but to the totality of claims. The experience of his national Office showed that there were applications that contained a significant number of claims, all independent and each clearly and concisely drafted; however, and because of different language used in each claim, it was sometimes not clear at all whether or not those were claims to exactly the same contents and whether or not such a

significant number of claims was actually necessary. The purpose of his Delegation's proposal was to address those issues by enabling a review of the claims as a whole. His Delegation's proposal was, of course, he added, not intended to permit national offices to arbitrarily restrict the number of claims, but only to strike out redundancies and repetitions.

170. The CHAIRMAN agreed that both proposals had different purposes and, consequently, suggested that they be discussed separately. He invited the Committee to consider the proposal of the Delegation of Israel and asked whether any delegation supported that proposal. Since no formal support was expressed, the Chairman regretted that the proposal could not be pursued. However, he noted that the idea behind the proposal was already implicit in paragraph (4).

171. Mr. UEMURA (Japan) stated that his Delegation agreed with the interpretation of the Chairman.

172. The CHAIRMAN asked whether any delegation supported the proposal of the Delegation of the United Kingdom.

173. Mr. SCHAEFERS (Germany) supported the proposal of the United Kingdom.

174. Mr. NEERVOORT (Netherlands) also supported the proposal of the United Kingdom for the reasons expressed by that Delegation.

175. Mr. BOGSCH (Director General of WIPO) suggested to combine the text proposed by the International Bureau with the text proposed by the United Kingdom. He suggested the following text: "The claims, both individually and in their totality, should be clear and concise." With the suggested text it would be clear that it was not only necessary that the claims, taken as a whole, were clear and concise, but also each of them.

176. Mr. TOURE (Côte d'Ivoire) supported the proposal of the Director General.

177. Mr. GARIEPY (Canada) supported the text as proposed in the basic proposal.

178. Mr. SMITH (Australia) supported the text proposed by the Director General.

179.1 Mr. KIRK (United States of America) drew the attention of the Committee to paragraph 4.01 of document PLT/DC/4 containing the note on Article 4 where it was stated that the number of claims per se could not be the subject of an objection on the basis of the requirement of conciseness, and that the requirement of clarity could provide a basis for disallowing any claim that merely paraphrased another claim, since it would not be clear how such a claim differed from the earlier claim. He stated the concern of his Delegation in respect of the last part of that note. He recalled that at the Committee of Experts an understanding was reached along the basis of what was stated now in paragraph (3) of Article 4, and he was of the view that such understanding should be reflected in the text of the Note.

179.2 His Delegation was concerned with the note, as well as with the proposal of the United Kingdom and the part of the Director General's

suggestion referring to the totality of the claim, because they might be interpreted as allowing an Office to arbitrarily restrict the number of claims simply because it felt that the public might not be able to clearly understand the idea of what was being protected. For that reason, his Delegation was opposed to the proposals under consideration.

180. Mrs. DIVOY (France) said that her Delegation did not share the concern of the Delegation of the United States of America and expressed its support for the suggestion made by the Director General.

181. Mr. MILLS (Ghana) stated the support of his Delegation for the proposal of the Director General, since it covered all eventualities.

182. Mr. SUGDEN (United Kingdom) thanked the Director General for his proposal and stated that his Delegation might accept it in the text. As far as the statement of the United States of America was concerned, he stated that the proposal of his Delegation was not intended to allow the imposition of restrictions on the number of claims that an applicant might make. As concerned the note on Article 4 where it was stated that the requirement of clarity would provide a basis for disallowing any claim that merely paraphrased another claim, he was of the view that such a notion was not reflected in the text of paragraph (4) of Article 4 as proposed by the International Bureau. In order to incorporate in that paragraph such a notion, he suggested amending paragraph (4). He suggested the following provisional wording for possible consideration: "Each claim shall be clear and concise and distinct in contents from other claims."

183. Mr. KHRIESAT (Jordan) expressed the support of his Delegation for the suggestion of the Director General.

184. Mr. KAMEL (Egypt) expressed the total support of his Delegation for the proposal of the Director General stating that it contained all the considerations that were important for his country.

185. Mr. KIRK (United States of America), referring to the preliminary suggestion of the United Kingdom, stated that his Delegation was interested in it since that proposal treated the problem indicated by him in his previous statement. In any case, it would be necessary for his Delegation to study further the proposal of the United Kingdom.

186. Mr. MESSERLI (Switzerland) said that his Delegation supported the proposal by the Director General since it was important that not only each claim, but also the claims all together be clear and concise.

187. Mr. ELHUNI (Libya) expressed the full support of his Delegation for the proposal of the Director General.

188. Mr. BOGSCH (Director General of WIPO), in response to the statement by the Delegation of the United States, stated that arbitrary decisions were never permitted.

189. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the proposal of the Director General since it fulfilled all the expectations of his country.

190. Mr. SCHAEFERS (Germany) expressed the support of his Delegation for the proposal of the Director General. As far as the second proposal of the United Kingdom was concerned, he expressed the doubts of his Delegation as to the advisability of including at that stage a reference to distinctiveness. He was of the view that it was more appropriate to follow the proposal of the Director General.

191. Mr. KORCHAGUIN (Soviet Union) stated the support of his Delegation for the proposal of the Director General.

192. Mr. KNITTEL (Austria) supported the proposal of the Director General since, in his view, the claims as a whole should be as clear as each of the claims.

193. Mr. BOUCOUVALAS (Greece) expressed the support of his Delegation for the proposal of the Director General for the reasons already indicated by the preceding speakers.

194. Mr. UEMURA (Japan) stated that the key element concerning the style of the claims was clarity. In the view of his Delegation, paragraph (3) might be drafted in reference to that element only; in fact, he added, a claim which was not concise would not be clear. However, he said that his Delegation would go along with the text of paragraph (3) as envisaged in the basic proposal and that it could give further consideration to the proposal of the Director General, as well as to the idea advanced by the Delegation of the United Kingdom. He sought clarification as to the meaning of the last sentence of the note on paragraph (3) contained in paragraph 4.01 of document PLT/DC/4.

195. Mr. BOGSCH (Director General of WIPO), in response to the question raised by the Delegation of Japan, stated that "paraphrase a claim" meant simply the repetition of the contents of that claim with different wording.

196. Mrs. DE CUYPERE (Belgium) expressed the support of her Delegation for the idea behind the proposal of the Delegation of the United Kingdom that the criteria of conciseness and clarity should be applied to the claims considered as a whole. She further gave her support to the suggestion made by the Director General.

197. Mr. KOLLE (EPO) supported the initial proposal of the United Kingdom, as clarified by the Director General. He considered it to be very important that individual, as well as the complete set of claims, be clear and concise. There could be no question of arbitrary refusal of claims because of their number. He underlined the importance of clarity of the claims in order to facilitate access to patent information by the public. Clarity was also considered to be an important condition in order to establish what was protected by a patent and what was its scope.

198. The CHAIRMAN noted that there was wide support for the proposal of the Director General.

199. Mr. HACHEME (Benin) supported the proposal of the Director General.

200. Mr. ROMERO (Chile) stated that the text of the basic proposal was acceptable to his Delegation, as well as the amendment suggested by the Director General.

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201. Mr. OPHIR (Israel) supported the proposal of the Director General.
202. Mr. HIEN (Burkina Faso) expressed his support for the proposal of the Director General.
203. Mr. SEGURA (Argentina) supported the proposal of the United Kingdom as supplemented by the Director General.
204. Ms. LILJEGREN (Norway) supported the proposal of the Director General.
205. Mr. KHUMALO (Swaziland) supported the proposal of the Director General.
206. Ms. LACHOWICZ (Poland) supported the proposal of the Director General for the reasons expressed by the preceding speakers.
207. Mr. UEMURA (Japan) requested clarification as to whether any claim that paraphrased another claim had to be rejected. As far as the second proposal of the Delegation of the United Kingdom was concerned, he stated that it introduced an additional standard, namely, distinctiveness. In his view, the term "distinct" did not have a very clear meaning, particularly given its use in the context of the unity of invention. Nevertheless, his Delegation was prepared to give further consideration to that proposal.
208. The CHAIRMAN indicated that he had not seen sufficient support for that proposal of the United Kingdom.
209. Mr. BOGSCH (Director General of WIPO), in response to the question raised by Japan, stated that in cases where a claim was merely a paraphrased version of another claim, he could foresee that the Office would try to persuade the applicant to choose between the two claims, and, if necessary, the Office would have to reject one of those claims. That would not do any harm since a paraphrased claim would, by definition, have exactly the same contents as the first claim.
210. The CHAIRMAN observed that he shared the view of the Director General.
211. Mr. BULGAR (Romania) supported the proposal of the Director General.
212. Ms. BACH (Denmark) supported the proposal of the Director General.
213. The CHAIRMAN concluded that, since there was broad support of the Director General's proposal, it should be considered as the basis for further discussions on paragraph (3) of Article 4.
214. Mr. BRUNET (NYPTC) stated that his Organization had some difficulties with the proposals of the United Kingdom and of the Director General. He recalled that, since drafting claims was extremely difficult, it was necessary to use different language in different claims. Those claims with a different language might--at a given point in time--seem redundant, but--at a later stage--such differences in language might turn out to be critical. If the applicant was restricted in the number of claims, he might end up cancelling precisely the claim that could be decisive to show infringement or to support a defense against prior art.

215. Mr. BOGSCH (Director General of WIPO) clarified once more that his suggestion did not restrict per se the number of claims that an application might contain.

216. Mr. KIRK (United States of America) stated that, because of the complexities involved in the drafting of applications, it was often the case that a patent claim paraphrased another. One of those two claims might, subsequently, be held invalid and if the applicant was forced to choose prematurely between the two, he might make the wrong decision. Nevertheless, in view of the statement of the Director General that his proposal did not entail any limitation in the number of claims that an application might have and therefore that there would be no ability on the part of an Office to require an applicant to reduce the number of claims because they were not in their totality concise, his Delegation did not have problems with the proposal of the Director General.

217. Mr. BOGSCH (Director General of WIPO) clarified, in response to the preceding speaker, that, in accordance with his suggestion, the mere fact that an application had a high number of claims was not sufficient reason to refuse; however, if there was a lack of clarity, as a result of such a high number of claims, or of conciseness, then there was a reason to refuse. For the sake of certainty, he suggested striking out from paragraph 4.01 of document PLT/DC/4 the example concerning paraphrased claims.

218.1 The CHAIRMAN stated that in the case where a claim paraphrasing another claim meant that the latter was identical in content to the former, a choice between one or the other did not affect the scope of protection. He stated again that the oral proposal by the Director General had received a very large support from delegations and it should be considered as the basis for further discussions of paragraph (3) of Article 4.

218.2 Since there was no further discussion on Article 4, he stated that that Article, as envisaged in the basic proposal with the amendment suggested by the Director General, should be considered as the basis for further discussions in the Committee.

Rule 2: Contents and Order of Description (ad Article 3(2)) (continued)

218.3 The CHAIRMAN then turned to the proposal of the Delegation of Japan contained in document PLT/DC/27 which called for the deletion of paragraph (3) of Rule 2. He gave the floor to the Delegation of Japan to explain its proposal.

219.1 Mr. UEMURA (Japan) stated that the provisions contained in paragraph (3) were too detailed and should be placed in the notes. He further stated that paragraph (3) might give rise to an argument a contrario that in future one might not impose any different or additional requirements in respect of the description.

219.2 He indicated that his Delegation's proposal was related to the earlier discussion in relation to deleting part of Article 3(3), specifically the proposed deletion of the words "no requirement additional to or different from those provided for in ... the relevant provision of the Regulations may be imposed." He stated that if that provision was deleted with the understanding

that a Contracting Party may derogate from the general requirements prescribed in Rule 2, then the proposal of his Delegation might not be necessary.

219.3 He stated that the proposed deletion of Rule 2(3) intended also to facilitate the establishment, in the future, of specific requirements for the description in certain fields such as computer science, and not just biotechnology.

220. Mr. BOGSCH (Director General of WIPO) agreed with the assessment of the Delegation of Japan that, a contrario, any other departure from the Rule would not be permitted. He raised the question whether the permitted departure could be deleted in view of the fact that in many countries the requirements contemplated by Rule 2(3) already exist. He indicated that the provisions of Rule 2(3) had been placed in a Rule, rather than in an Article, so that they could be changed as necessitated by technological developments.

221. Mr. KIRK (United States of America) agreed with the Delegation of Japan with respect to the underlying concept, but was troubled by the narrowness of draft Rule 2(3). He preferred retaining draft Rule 2(3) but broadening it to address computer program listings and electronic filings. He desired to have clear authority in the Rule to continue the special requirements which existed in the practice of the United States of America. He suggested making the Rule open-ended to preclude having to modify the Rule in future each time practice necessitated a change.

222. The CHAIRMAN reminded the meeting that, in discussion of the Committee of Experts, it was understood that Rule 2 would contain provisions relating to the content of the description. It was never intended that draft Rule 2 would include the physical form of presentation or include details such as found in the Patent Cooperation Treaty (PCT).

223. Mr. SCHAEFERS (Germany) agreed that draft Rule 2 should not deal with physical requirements and supported the proposal of the Delegation of Japan to delete draft Rule 2(3).

224. The CHAIRMAN drew attention to and emphasized that, where necessary, the rules could be amended by the Assembly.

225. Mr. SUGDEN (United Kingdom) stated that his first reaction was to support draft Rule 2(3), seeing it as being a different requirement from paper size or electronic filings. However, special situations, such as that addressed in draft Rule 2(3) could be dealt with in the notes. He pointed out that the rules under the European Patent Convention required measurements to be expressed in metric units, seeing it as a special requirement which would not infringe Article 3, paragraph (3).

226. Mr. UEMURA (Japan) referred to Note 3.02 in document PLT/DC/4 as setting forth a clear statement that the prohibition on additional or different requirements does not prevent a Contracting Party from requiring compliance with certain formal requirements, such as electronic filings. In the view of that Note, he did not see the necessity for draft Rule 2(3).

227. The CHAIRMAN stated that draft Rule 2(3) seemed superfluous in light of the discussions and that consideration could be given to deleting it and, if necessary, clarifying the situation in the notes, as well as stating in the

records of the Conference that the meeting had noted the distinction that had to be made between the form or presentation of the application and the contents. The possibility of amending the rule by the Assembly was also to be noted. He stated that draft Rule 2(3) could, in the absence of any objection, be deleted.

228. Mr. KIRK (United States of America) urged that, if it were the direction of the meeting to delete draft Rule 2(3), its contents be placed in the notes. He stated that his concern was prompted by draft Article 3(3), which stated that "no requirement additional to or different from those provided for in this Article and in the relevant provision of the Regulations may be imposed." He wished the note to be clear that provisions such as were provided for in draft Rule 2(3) could be called for by national offices.

229. Mr. BOGSCH (Director General of WIPO) stated that if there was a prevailing view that what was now in draft Rule 2(3) was formal requirement, like size of paper to be used in an application, then there would be no problem with its deletion. He stated that, however, anything other than a formal requirement could not be introduced into national law as it was clearly stated in the Treaty that no additional requirements were permitted.

230. The CHAIRMAN stated that the meeting was of a view that draft Rule 2(3) might be considered as a requirement of form to be left up to national law and that this should be so stated in the notes.

Rule 3: Manner of Claiming (ad Article 4(5))

231. The CHAIRMAN invited the Committee to discuss Rule 3 (Manner of Claiming (ad Article 4(5))). Two proposals were submitted, namely, a proposal by the Delegation of Japan concerning paragraph 4 and reproduced in document PLT/DC/28, and a proposal by the Delegation of the United Kingdom concerning paragraph (2) on the method of definition of invention and reproduced in document PLT/DC/34.

232. Mr. SUGDEN (United Kingdom) explained that the purpose of his Delegation's proposal was to clarify the expression "technical features," in particular to indicate that that expression was rather wide. To that effect, it was proposed to add a sentence stating that technical features might be expressed in structural, functional or mathematical terms: structural terms would define the tangible expression of the invention; functional terms might concern, for example, the way in which the invention worked or the way in which different parts interrelate to each other; mathematical terms would be relevant in the description of inventions in certain fields such as radio communications or the incorporation of computer programs into systems.

233. Mr. SCHAEFERS (Germany) stated that his Delegation seconded the proposal of the United Kingdom. He recalled that the idea behind the proposal of the United Kingdom was already incorporated in the notes submitted by the International Bureau to the eighth session of the Committee of Experts. Interested circles, in his country, had indicated that they supported a provision such as that proposed by the United Kingdom.

234. Mr. KIRK (United States of America) expressed the support of his Delegation for the clarification submitted by the United Kingdom. He

suggested adding the expression "inter alia" after the words "the technical features may be expressed" so as to make it clear that technical features might be expressed in a manner other than those indicated in the proposal by the United Kingdom.

235. Mr. SUGDEN (United Kingdom) expressed his support, in principle, for the suggestion of the United States of America; however, his Delegation would have to consider the matter further.

236. Mr. BOGSCH (Director General of WIPO) proposed that instead of the words "inter alia," the words "in particular" be used.

237. Mr. GARIEPY (Canada) expressed the support of his Delegation for the proposal. However, he considered it to be somehow limited and, for that reason, he agreed with the amendment proposed by the United States of America.

238. Mr. UEMURA (Japan) stated that his Delegation did not oppose the proposal of the United Kingdom. However, it had some concern regarding the insertion of examples as to how the technical features might be expressed, since it might be interpreted as a recommendation concerning the terms in which to express those features. There were cases where those terms were appropriate; however, his Delegation did not share the view that the Treaty should recommend those terms. In his view, it would be advisable to incorporate the proposal of the United Kingdom in the notes.

239. Mr. MESSERLI (Switzerland) expressed the support of his Delegation for the proposal of the United Kingdom as amended by the United States of America.

240. Mr. NEERVOORT (Netherlands) stated the support of his Delegation for the proposal of the United Kingdom as amended by the United States of America.

241. Mr. SMITH (Australia) expressed his support for the proposal of the United Kingdom as amended by the United States of America.

242.1 The CHAIRMAN stated that there was strong support for the proposal of the United Kingdom, as amended by the United States of America and by the Director General. He took note of the reservations of Japan.

242.2 He then invited the Committee to consider paragraph (4) of Rule 3 and invited the Delegation of Japan to introduce its proposal contained in document PLT/DC/28.

243.1 Mr. UEMURA (Japan) expressed that there were cases where references in the claims to the description and drawings were necessary to define or express the subject matter of the claim rather than for understanding that claim or enhancing its clarity or conciseness. For example, diagrams representing the state of an alloy were not necessary to understand the claim but to express the subject matter. In order to bring those cases within the scope of the last sentence of paragraph (4), his Delegation proposed the addition of the expression "the subject matter."

243.2 In accordance with the text of paragraph (4) references in the claim to the description or drawings were permitted if such a reference enhanced the clarity or the conciseness of the claim. In the view of his Delegation, that formulation might give rise to abuse. In order to prevent that, his

Delegation's proposal would empower offices with enough discretion to determine whether or not a particular reference to a description or drawing was appropriate.

244. The CHAIRMAN stated that, since no delegation supported the proposal of the Delegation of Japan, he regretted not being in a position to open discussion on that proposal and ask the Committee whether there were other comments on Rule 3.

245. Mr. KIRK (United States of America) expressed his concern about draft Rule 3(5)(b). He stated that it would require Contracting Parties to allow multiple dependent claims to depend from other multiple dependent claims and to allow multiple dependent claims to refer in the cumulative to the claims on which they depend. He was concerned that such a provision would lead to a great deal of confusion with respect to the understanding by the public as to exactly what the claim covered. He therefore believed that draft Rule 3(5)(b) should be amended to permit a Contracting Party to refuse multiple dependent claims which depend on other multiple dependent claims and to refuse multiple dependent claims in the cumulative.

246. The CHAIRMAN stated that, in European practice, claims are directed not to the public, but rather to one skilled in the art.

247. Mr. BOGSCH (Director General of WIPO) stated that the question of allowing multiple dependent claims in the cumulative was a theoretical, rather than a practical, one and could safely be deleted.

248. Mr. UEMURA (Japan) stated that he could accept draft Rule 3(5)(b) on the understanding that when such multiple dependent claims in the cumulative lacked clearness or conciseness, they would not be accepted by an office.

249. Mr. BOGSCH (Director General of WIPO) suggested that an intermediate solution would be, as the Delegation of Japan proposed, to insert the words "subject to the requirement of clarity and conciseness" if the possibility of filing multiple dependent claims in the alternative was to be maintained. He requested private circles to provide an example of such claims.

250. Mr. SCHAEFERS (Germany) did not share the concerns expressed by the Delegation of the United States of America. If it was really a case where multiple dependent claims refer to another multiple dependent claim and the clearness of that claim was seriously, or at all, affected by such reference, then the general principle would prevail and the claim could be rejected. He did not support the addition suggested by the Director General. He then asked Mr. Bardehle of his delegation to present a technical example for such a multiple dependent claim.

251. Mr. BARDEHLE (Germany) gave the example of a patent covering a screw, the main claim of which characterized the screw as having one part. The second claim was directed to a screw according to claim one in which the one part was pointed. The third claim was directed to a screw according to claim one or two wherein the one point was hardened. He indicated that the fourth claim was problematic because there existed one multiple dependent claim which was claim three depending on claims one or two. He indicated that the fourth claim could be worded as follows: "a screw according to one of the preceding claims (including claim three) which included threads having a very small

angle. If the multiple dependency were not permitted, he indicated that he would have to say in claim four: "screw according to claim one with threads having a very small angle"; followed by claim five: "screw according to claim two, with threads having a very small angle"; followed by a further claim six: "screw according to claim three, with threads having a very small angle." He considered such a claiming scheme to be superfluous and even expensive because in some Patent Offices one had to pay claims fees from the tenth claim. He indicated that if it were permissible to have multiple dependent claims it would simplify the drafting and understanding of the claims.

252. The CHAIRMAN stated that the requirement that claims be clear and concise appeared in Article 4(3) which automatically prevailed over that which appeared in draft Rule 3.

253. Mr. PETERSEN (EPI) followed up the example given by Mr. Bardehle with a fifth claim which concerned the screw with the hardened point and the very small angle and included another novel feature. He stated that the additional feature could be as claimed in claims three or four, but because claim four was dependent on one, two or three, then it was not sufficient because it does not include the features of claim three when it was dependent upon claim one or two. He therefore stated that he would have to add three or four as dependent upon claim three. He indicated that this is what he had in mind in using the phrase "in the cumulative."

254. Mr. BOGSCH (Director General of WIPO) stated that neither of the interventions responded to his question since what he asked for was an example where what was referred to was a set of multiple claims in the cumulative.

255. Mr. JENNY (Switzerland) stated that, under the European Patent Convention, it was quite frequent that claims having multiple dependencies and multiple dependent claims dependent on other multiple dependent claims were drafted, and he was a little bit surprised that such examples could not have been found. He stated that in chemical practice, especially in the practice of claiming chemical processes, such claims were very frequent. He stated that in countries where this multiple claiming was restricted, one would have to repeat the same claim with different dependencies several times and it was clear that a great number of claims would be necessary.

256. Mr. BOGSCH (Director General of WIPO) asked whether the statement also included the word cumulative.

257. Mr. JENNY (Switzerland) referred to what the delegate of the EPI has said and admitted that, in most cases, claims were in the alternative and not cumulative.

258. The CHAIRMAN said that it would be useful to try to find a few practical examples for the International Bureau, which would be delighted to have them.

Article 5: Unity of Invention

259. The CHAIRMAN invited the Committee to discuss Article 5.1 in respect of which there was one proposal submitted by the Delegation of Israel and reproduced in document PLT/DC/32.

260. Mr. OPHIR (Israel) stated that his Delegation proposed to add a new paragraph indicating that the applicant might file one or more divisional applications within such time and upon such conditions as were prescribed. In the view of his Delegation, the principal issue concerning divisional applications was not procedural but substantive; for that reason his Delegation proposed to add a new paragraph to Article 5, leaving to Rule 5 the procedural details.

261. The CHAIRMAN recalled that the principle concerning divisional applications was set out in the Paris Convention and, therefore, the provisions in this matter contained in Rule 5 were of a procedural nature.

262. Mr. CURCHOD (WIPO) drew the attention of the Committee to paragraph R5.01 of document PLT/DC/4 where the relevant provision of the Paris Convention, namely, Article 4G, was quoted.

263. The CHAIRMAN stated that, since there was no support for the proposal of the Delegation of Israel and since there were no additional comments on Article 5, the Article could be retained as formulated in the basic proposal. He then invited the Committee to discuss Rules 4 and 5.

Rule 4: Details Concerning the Requirement of Unity of Invention
(ad Article 5(1))

264. Mr. SEGURA (Argentina) drew the attention of the International Bureau to a mistake in the Spanish text of Rule 4(1), in document PLT/DC/3, as to the place where the word "solo" was located.

Rule 5: Divisional Applications (ad Article 5(1))

265. The CHAIRMAN invited the Committee to discuss Rule 5.

266. Mr. UEMURA (Japan) requested clarification as to the meaning of the expression "in order for grant" in paragraph (1).

267. Mr. CURCHOD (WIPO) stated that "in order for grant" meant the time when the application was ready for the grant of the patent by the patent office.

268. The CHAIRMAN stated that, in other words, it was the time when the Office, on the basis of the evidence before it, was of the opinion that the patent could be granted.

269. Mr. PETERSEN (EPI) expressed the concern of his Organization in respect of the word "initial" in paragraph (1)(a). He envisaged a situation where, in order to attack infringers, an early grant was desired. To that effect the applicant might proceed forthwith with a simple claim to get a patent quickly in the expectation of subsequently dividing the rest of the matter so as to protect other inventions disclosed. He asked for confirmation as to whether it was possible to continue to divide because that division may itself contain more than one invention. In his view it was draconian to prevent divisionals being divided themselves.

270. The CHAIRMAN stated that, in his opinion, the expression "initial application" was tantamount to what was known as the "mother application," even if the latter is a divisional application.

271. Mr. SCHMITT-NILSON (FICPI) stated that paragraph (2) of Rule 5 did not contain an explicit reference to the priority claim which might be covered by the Paris Convention. For the sake of clarity, he considered that it would be advisable to mention the priority claim.

272. Mr. CURCHOD (WIPO), in response to the preceding statement, drew the attention of the Committee to paragraph R5.01 of document PLT/DC/4, which contained a note on Rule 5 stating that the right to file divisional applications was established in Article 4G of the Paris Convention. That Article stated that divisional applications would keep the date of the initial application and the benefit of the right of priority, if any.

273. Mr. NEERVOORT (Netherlands) requested clarification of the meaning of the expression "time limits" in paragraph 1.

274. Mr. SCHAEFERS (Germany) recalled that, at the eighth session of the Committee of Experts, the Delegation of the United Kingdom had indicated that there were, in his country, time limits within which the applicant should comply with certain requirements.

275. Mr. HARDEN (United Kingdom) confirmed that, according to the applicable rule in his country, the final application had to be in order for grant within four and a half years.

276.1 The CHAIRMAN stated that the discussion on Rule 5 showed no need for modification. He then invited the Committee to consider Article 6.

Article 6: Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant

276.2 A proposal in respect of Article 6, contained in document PLT/DC/17, was submitted by the Delegation of Japan.

277. Mr. UEMURA (Japan) noted that the proposal of his Delegation was based on the draft of the same Article submitted by the International Bureau to the eighth session of the Committee of Experts. He stated that at that session there was general agreement to make it optional for Contracting Parties to determine whether the inventor should not be mentioned in the publications of the Office, if the inventor so requested. In his view paragraph (2) of Article 5 was not consistent with that general agreement. The purpose of his Delegation's proposal was to bring that paragraph into line with the general agreement. He added furthermore that there were several situations where it was important and even necessary to know the name of the inventor and that it was not clear to him why it might be necessary to keep the inventor's name secret.

278. The CHAIRMAN recalled that, in accordance with paragraph (1) of Article 6, it was obligatory to identify the inventor in the application, whereas in accordance with paragraph (2), the name of the inventor should be mentioned in the publications of the Office, unless the inventor requested

otherwise. The proposal of Japan would make the right of the inventor contingent on the national legislation.

279. Mr. KIRK (United States of America) stated the support of his Delegation for the reasons behind the proposal of the Delegation of Japan. However, his Delegation would prefer to make the identification of the inventor obligatory in the publications of the Office. To that effect, he suggested deleting the proviso in the second part of paragraph (2).

280. Mr. GARIEPY (Canada) supported the proposal of the Delegation of the United States of America.

281. Mr. SZEMZÓ (Hungary) stated that his Delegation did not support the proposal of the Japanese Delegation. He stated that, as far as he could recall, in accordance with the Paris Convention, the inventor had the right to request that his name would not be mentioned in the publications of the Office.

282. The CHAIRMAN recalled that, in accordance with Article 4 of the Paris Convention, the inventor had the right to be mentioned, as such, in the patent.

283. Mr. SCHAEFERS (Germany) stated that his Delegation was in favor of maintaining the freedom of the inventor to decide whether his name should be published or not. In his country such freedom had a constitutional basis related to the right of privacy. He supported the text of the basic proposal.

284. Mr. LOSSIUS (Norway) supported the proposal of the Delegation of the United States of America.

285. Mr. MESSERLI (Switzerland) expressed the support of his Delegation for the text of the basic proposal for the reasons mentioned by the Delegation of Germany. He was opposed to the proposal of the Delegations of Japan and of the United States of America. In Switzerland, the right to be mentioned was a right and, as such, could be waived, otherwise the right would become an obligation.

286. Mr. NEERVOORT (Netherlands) opposed the proposals of the Delegations of Japan and the United States of America for the reasons mentioned by the Delegation of Switzerland.

287. Mr. MOTA MAIA (Portugal) expressed the opposition of his Delegation to the proposals of the Delegations of Japan and the United States of America for the reasons referred to by the Delegation of Switzerland.

288. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the basic proposal, since the right of the inventor should be respected.

289. Mr. KAMEL (Egypt) expressed the support of his Delegation for the basic proposal. The inventor had the right to be mentioned. He was not under an obligation in his respect, he considered this to be a matter related to a fundamental human right.

290. Mr. BOUCOUVALAS (Greece) stated that the right of the inventor should be respected. Therefore, he supported the text envisaged in the basic proposal.

291. Mr. OPHIR (Israel) supported the basic proposal for the reasons mentioned by the Delegation of Germany. In order to enhance the right of the inventor not to be mentioned, he suggested deleting from paragraph (4) the word "request" and replacing it by the word "require."

292. Mr. KNITTEL (Austria) expressed the support of his Delegation for the text envisaged in the basic proposal because the inventor had the right to be mentioned and was not under an obligation in this respect.

293. Mr. JAKL (Czechoslovakia) expressed his support for the text contained in the basic proposal: the freedom of the inventor should be respected.

294. Mr. HARDEN (United Kingdom) stated that, in accordance with Article 9, the right to a patent belonged to the inventor. As such, it was only natural that the name of the inventor be mentioned in the publication of the Office; all the more so, since the inventor might assign the patent. He understood, however, that an inventor might have legitimate reasons to require that his name should not be mentioned in the publications. As a compromise, he suggested that in cases where the name was not revealed in the publication, a procedure should be defined according to which interested parties might have access to the name of the inventor.

295. Mr. KORCHAGUIN (Soviet Union) supported the text envisaged in the basic proposal for the reasons put forward by the Delegation of Germany.

296. Mrs. BESAROVIC (Yugoslavia) stated that it was a right to be mentioned and not an obligation; for that reason, she supported the text of the basic proposal. She expressed concern for cases where pressure might be exercised on the inventor in order to obtain from him a request that his name should not be mentioned.

297. Mr. BRAENDLI (EPO) stated that there was a right to be mentioned and under no circumstances should there be an obligation. He added that the proposal of the United States of America was logical within the framework of principle of first-to-invent.

298. Mr. ROMERO (Chile) supported the text of the basic proposal since the freedom of the inventor should be protected. He mentioned that that freedom was protected by the domestic legislation of his country.

299. Ms. LACHOWICZ (Poland) supported the text as envisaged in the basic proposal.

300. Mr. MILLS (Ghana) supported the text of paragraph (2) as envisaged in the basic proposal.

301. Mr. BULGAR (Romania) supported the text of paragraph (2) as envisaged in the basic proposal.

302. Mr. ABU BAKAR (Malaysia) expressed the support of his Delegation for the text of paragraph (2) in the basic proposal because it clearly stated that it was the inventor who had a right to be mentioned and that he was not under the obligation to be mentioned.

303. Mr. SCHAEFERS (Germany) stated that the question under discussion had a connotation with human rights since it affected a question of protection for personal privacy. As far as the suggestion of the Delegation of the United Kingdom was concerned, he stated that to the extent an interested person had access to the application, he or she could find the name of the inventor in the files.

304. Mr. BOGSCH (Director General of WIPO) asked whether the right not to be mentioned applied also to the patentee.

305. Mr. ELHUNI (Libya) expressed the support of his Delegation for the text of paragraph (2) in the basic proposal since the freedom of the inventor not to be mentioned should be protected.

306. Mr. SCHAEFERS (Germany), in response to the Director General, stated that the applicant and the patentee, by definition, agreed to the publication of their names.

307. Mr. KESOWO (Indonesia) stated that in a first stage, namely, at the application, the name of the inventor should be mentioned, whereas at a second stage, namely, publication by the Office, the mentioning of the name of the inventor should be optional. The two cases in his view should be separated.

308. Mr. SAPALO (Philippines) stated that, in the context of the first-to-invent system, it was understandable that the name of the inventor should be mentioned in the publication. For that reason he supported the proposal of the Delegation of Japan.

309. Mr. VON ARNOLD (Sweden) declared that his Delegation would have no problems to accept the proposal of the Delegation of the United States of America, but in view of constitutional problems of some countries, Sweden supported the proposal of the Delegation of Japan.

310. Mr. UEMURA (Japan) recalled that Article 4~~ter~~ of the Paris Convention concerning the identification of the inventor used the term "patent," not publication of patent. He, therefore, expressed a reservation on the interpretation that the right not to be mentioned arose from that article. As a question of clarification, he asked whether, in those countries where privacy was protected, it would be possible to consult the application in order to ascertain the name of the inventor.

311. The CHAIRMAN, in response to the question formulated by the preceding speaker, stated that there were countries where it was possible to consult the application and countries where it was not possible to do that. Such a matter was decided by the national law of each country. It is not envisaged that those kind of matters should be the subject of harmonization.

312. Mrs. PURI (India) supported the text of paragraph (2) as it was in the basic proposal. In respect of paragraphs (4) and (6) of Article 6 she indicated that her Delegation did not favor having any prohibitions about imposing requirements other than those that were stated in those provisions.

313. Mr. BRUNET (NYPTC) stated that his Organization proposed that the publication should also mention the name of the inventor. That publication was important for search purposes. He added that the scope of human rights was different in different countries.

314. The CHAIRMAN stated that there was a clear majority in favor of the text of paragraph (2) of Article 6 as proposed in the basic proposal. Therefore, that text should be the basis for further discussions of that Article.

315. Mr. ROMERO (Chile) announced a meeting of the Latin American Group.

316. Mr. IDDI (United Republic of Tanzania) announced a meeting of the African Group.

317. Mr. SAPALO (Philippines) announced a meeting of the Asian Group.

318. The CHAIRMAN then adjourned the meeting.

Fourth Meeting
Monday, June 10, 1991
Morning

319.1 The CHAIRMAN opened the meeting and warmly thanked the organizers of the outings that had been provided over the weekend. The delegations joined in those thanks by acclamation.

Article 6(4): Prohibition of Other Requirements

319.2 He proposed that paragraph (4) of Article 6 (Prohibition of Other Requirements) be examined. He pointed out that there was only one proposal for amendment, that of the Delegation of Japan, contained in document PLT/DC/17. He gave the floor to the Delegation of Japan for it to present its proposal.

320.1 Mr. UEMURA (Japan) introduced the proposal of his Delegation contained in document PLT/DC/17. He stated that the purpose of the amendment, which consisted of the addition of the words "at the time of the filing date" in line 3 of paragraph (4), was to qualify the prohibition contained in paragraph (4) so that it was clear that the prohibition only applied to requirements that could be imposed at the time of filing.

320.2 He pointed out that, in many cases, such as where a transfer or an assignment of an application occurred after the filing date, it would be necessary, in the interest of legal certainty, to require evidence of the legal entitlement of the new applicant. In other words, it would be necessary in such cases to require more than a mere indication of the applicants' entitlement. He asked whether the amendment which his Delegation sought in that respect was truly in the nature of an amendment or merely a clarification of the intent of the provision as it already appeared in the basic proposal.

321. Mr. KIRK (United States of America) stated that his Delegation had exactly the same concerns as the Delegation of Japan. There were situations where the presentation of proof of entitlement to make an application would be necessary but might otherwise be barred on a strict interpretation of the prohibition contained in paragraph (4). His Delegation agreed that a Contracting Party should not be permitted to require more than a mere indication of the applicant's entitlement at the time of filing, but considered nevertheless that Contracting Parties ought to be permitted to require a proof or other showing of entitlement in respect of certain situations occurring after the filing date.

322. Mr. BOGSCH (Director General of WIPO) sought clarification from the Delegation of Japan whether, under its proposal contained in document PLT/DC/17, a Contracting Party could request any manner of document from an applicant in order to prove the applicant's entitlement 24 hours after the filing date, or whether the possibility of asking for evidence of entitlement was to be confined to certain specific cases.

323. Mr. UEMURA (Japan) stated that his Delegation had no intention of asking for evidence of entitlement from the original applicant. Such evidence of entitlement would only be requested in such cases as where there was a change from the original applicant to another applicant.

324. Mr. BOGSCH (Director General of WIPO) stated that, in view of the clarification given by the Delegation of Japan, the objective sought by that Delegation could perhaps best be dealt with by leaving the text of paragraph (4) of Article 6 in the form contained in the basic proposal and by adding a new provision to Rule 6 which would make it clear that the prohibition in paragraph (4) of Article 6 did not apply in respect of a transfer or other change in the identity of the applicant.

325. Mr. KIRK (United States of America) stated that he agreed that a Contracting Party should not be permitted to require evidence of entitlement in the circumstances envisaged in the question of the Director General, namely, within 24 hours of the filing date. However, his Delegation would not like to see the grounds on which evidence of entitlement could be requested after the filing date too narrowly defined. His Delegation imagined that there could be other reasons for requesting evidence of entitlement which might result, for example, from an apparent insufficiency of authorization on the part of the inventor. His Delegation considered that the corresponding Rule should, however, require that Contracting Parties allow a minimum period of time for applicants to respond to any Office action requesting evidence of entitlement.

326. Mr. BOGSCH (Director General of WIPO) indicated that the example given by the Delegation of the United States of America meant that the Office could ask for further proof of entitlement in the event that it did not believe any statement concerning entitlement contained in the application. He proposed that both the example of the Delegation of Japan and that of the Delegation of the United States of America could be dealt with in the Rule by clarifying that the provisions contained in paragraph (4) did not apply if the Office considered it to be necessary to have proof of the veracity of statements made in the application or if there was a change in the identity of the applicant. In each case, the Office would be required to issue an invitation to the applicant requesting the furnishing of the evidence of entitlement. He also

indicated that a draft provision to that effect for inclusion in Rule 6 could be prepared by the Secretariat if the meeting so desired.

327. The CHAIRMAN proposed to the delegations that they should accept, finally, that there should be no amendment to Article 6(4) and that a double rule be added to enable an Office to require additional information and proof from the applicant where it needed to check the legal basis of the applicant's rights or where there was a change in the identity of the applicant.

328. Mr. UEMURA (Japan) asked whether, if the text of Article 6(4) remained as presented in the basic proposal and a new provision was included in Rule 6 in the terms explained by the Director General and repeated by the Chairman, the possibility of requesting evidence of entitlement from an applicant in the terms envisaged in the new provision in the Rule would be considered to constitute a derogation from Article 6(4) or to be merely a clarification of the extent of that provision.

329. Mr. BOGSCH (Director General of WIPO) stated that he considered the proposed new provision in the Rule to be mainly a clarification since one could already read the provision in Article 6(4) as allowing requests for evidence of entitlement in the circumstances envisaged in that proposed new provision.

330. Mr. SCHAEFERS (Germany) stated that his Delegation favored the text of the basic proposal for Article 6(4). His Delegation was concerned that the elements indicated by the Delegations of Japan and the United States of America deviated from the basic principle of Article 6, which was to limit the burden of formalities placed on the applicant. The purpose of Article 6 was to establish the identity of the applicant, as well as the identity of the inventor. The question of proof of the entitlement of the applicant was peculiar to the situation in the United States of America, where applications had to be filed by the inventor.

331. Mr. CASADO CERVIÑO (Spain) asked whether the provision contained in Article 6(1)(b) was consistent with the provision contained in Rule 6(2)(b).

332.1 The CHAIRMAN first asked whether there were further comments to be made on Article 6(4). Since no delegation asked for the floor, he noted the conclusion that he had already sketched out.

332.2 He moved on to the question put by the Delegation of Spain and recalled that the Committee of Experts had concluded that an application should only be rejected in those cases where no mention of the inventor was filed.

333. Mr. BOGSCH (Director General of WIPO) pointed out that the Spanish text of Article 6(1)(b) was not correct. The word "una patente o una solicitud" should be replaced by the words "una patente sobre la base de una solicitud." He indicated that the necessary correction would be made to the Spanish text.

Rule 6: Manner of Identification and Mention of Inventor (ad Article 6)

334. Mr. KIRK (United States of America) asked if the possibility accorded by Rule 6(3) to the applicant to correct the identification of the inventor applied not only "at any time" during the application procedure, but also

"at any time" after the grant of a patent. If such possibility of correction existed, his Delegation suggested that a clarification to that effect could be added to the notes.

335. Mr. BOGSCH (Director General of WIPO) stated that, in substance, it would appear that those corrections should be allowed at any stage before or after the grant of a patent. He indicated that consideration should be given to the place where it would be most appropriate to set out the corresponding clarification.

336. Mr. MESSERLI (Switzerland) supported the suggestion made by the Delegation of the United States of America according to which the possibility of correcting the identification of the inventor should exist not only prior to grant of the patent, but also afterwards. As to the appropriate place for such a provision, he preferred it to be set out in paragraph (3) of Rule 6 dealing with identification of the inventor.

337.1 Mr. HATOUM (Lebanon) stated that consideration should be given to amending paragraph (1)(b) of Rule 6 so as to require that the address of the inventor be included in addition to the inventor's name.

337.2 In relation to the possibility of correcting the identification of the inventor contained in Rule 6(3), his Delegation considered that such a correction should only be allowed if the previously identified inventor accepted the correction.

338. The CHAIRMAN asked whether there had not been a misunderstanding in relation to the first question raised by the Delegation of Lebanon. He pointed out that subparagraph (1)(a) of Rule 6 referred only to identification of the inventor, consisting of his name and address, whereas subparagraph (b) dealt only with the mention of the inventor in publications made by the Office and in which it was not indispensable to give the address of the inventor since the latter could change. He asked whether the Delegation of Lebanon was satisfied with that explanation.

339. Mr. HATOUM (Lebanon) indicated that he was entirely satisfied with the explanation given by the Chairman.

340. The CHAIRMAN gave the floor to the Director General and asked him whether he could reply to the second question raised by the Delegation of Lebanon.

341. Mr. BOGSCH (Director General of WIPO) stated that, if he understood correctly the concerns of the Delegation of Lebanon, those concerns seemed to be already met in the text of Rule 6(3) in the basic proposal, since that text allowed any Contracting Party to require the consent of any previously identified inventor before accepting a correction.

342. Mr. HATOUM (Lebanon) stated that his Delegation considered that each Contracting Party should be under an obligation, rather than merely have the possibility, to obtain the consent of any previously identified inventor whenever a request was made to change the identity of the inventor.

343. Mr. UEMURA (Japan) stated that it might be opportune for him to raise certain different concerns that he had with the second sentence of Rule 6(3).

He wondered whether there was a clear relationship between the provision contained in Article 6(4) and that contained in Rule 6(3). In particular, he wondered whether, in view of the prohibition contained in Article 6(4), it would be possible for a Contracting Party to impose any other requirement in relation to corrections of the identification of the inventor than that allowed under the second sentence of Rule 6(3). His Delegation considered that a Contracting Party should be free to impose requirements additional to that of the consent of any previously identified inventor where corrections were requested in respect of the identification of the inventor.

344. Mr. BOGSCH (Director General of WIPO) stated that there was no conflict between Article 6(4) and Rule 6(3), since Rule 6(3) dealt only with corrections of the identification of the inventor.

345.1 Mr. SUGDEN (United Kingdom) stated that his Delegation considered that the second sentence of Rule 6(3) went too far. It would be unreasonable if someone that had been wrongly identified as an inventor could withhold his or her consent to a correction in that identification and thus prevent the application from going forward.

345.2 His Delegation also supported the proposal of the Delegation of the United States of America that the first sentence of Rule 6(3) should be amended to make it explicit that the identification of the inventor could be corrected at any stage before or after the grant of a patent. Such clarification was explicitly required since the present text referred only to the applicant and did not include the owner of the patent.

346. Mr. ROMERO (Chile) expressed the support of his Delegation for the proposal that the first sentence of Rule 6(3) should be amended so as to make it clear that corrections could be made to the identification of the inventor even after the patent had been granted. The absence of such a possibility of correction would lead to confusion.

347.1 Mr. SCHAEFERS (Germany) stated that the first sentence of Rule 6(3) adequately reflected the result of the last discussion of that provision in the Committee of Experts, where it had been agreed that the identification of the inventor should be able to be corrected at any stage.

347.2 The second sentence of Rule 6(3) reflected the actual situation in certain national laws which required the consent of any previously named inventor before a correction could be made to the identification of the inventor. Both the national law of his country and the European Patent Convention required such consent and not merely consultation with the previously identified inventor.

348. Mr. SHACHTER (Israel) expressed the agreement of his Delegation of the reservation voiced by the Delegation of the United Kingdom that the second sentence of Rule 6(3) might allow Contracting Parties to impose a requirement that was too rigid. His Delegation considered that, in the event of any requested change in the identification of the inventor, the applicant should be under an obligation to inform any previously identified inventors and, if such previously named inventors agreed, to correct the identification.

349. Mr. BOGSCH (Director General of WIPO) pointed out that the second sentence of Rule 6(3) in the basic proposal would not seem to satisfy the

concerns of the Delegation of United Kingdom since, under it, any Contracting Party could or could not require consent of a previously identified inventor.

350. Mr. GARIEPY (Canada) suggested that Article 17(2) might be an appropriate place in which to clarify that the identification of the inventor could be corrected after the grant of a patent if the present wording of Rule 6(3) were not sufficiently clear to indicate that a correction could be made at that stage.

351. Mr. BAKER (Australia) expressed the support of his Delegation for Rule 6(3) as it appeared in the basic proposal.

352.1 Mr. BRUNET (ABA) expressed the wish of his Organization that the words "or patentee" be added after the words "the applicant" in the first sentence of Rule 6(3). He considered that such an amendment would be preferable to a new provision in Article 17 as the present text of Article 17 was more general and did not clearly refer to the identification of the inventor.

352.2 He also expressed support for the inclusion of a note on Rule 6(3) which would make it clear that neither the prohibition contained in Article 6(4) nor the provision contained in Rule 6(3) would preclude a Contracting Party from requiring the showing of evidence or proof in relation to an inventor where there was a change requested in the identification of the inventor.

353. Mr. KOLLE (EPO) expressed the agreement of his Organization with the statement made by the Delegation of Germany concerning the second sentence of Rule 6(3). In his view, the consent of previously identified inventors to a change in the identification of the inventors was required for reasons of expedience. If no consent was given, action could be brought in a court in order to obtain an appropriate ruling.

354. Mr. KIRK (United States of America) stated that a provision requiring that the consent of previously identified inventors be obtained was unnecessary and inefficient. He expressed the agreement of his Delegation with the views expressed by the Representative of ABA that the second sentence of Rule 6(3) should not be interpreted so as to preclude Contracting Parties from imposing other requirements in relation to corrections in the identification of the inventor. He considered that either the explanatory notes or the text of the Rule itself should make it clear that a Contracting Party could impose an additional requirement that proof be furnished in respect of a change in identity of the inventor.

355. Mr. SUGDEN (United Kingdom) stated that his Delegation considered the second sentence of Rule 6(3), which allowed Contracting Parties to require the consent of the previously identified inventor, could impose a very onerous burden on applicants. If the previously identified inventor refused his consent, there was nothing in Rule 6(3) to indicate how the application could go forward. For that reason, his Delegation preferred that the liberty given to Contracting Parties in Rule 6(3) be limited to inviting the previously identified inventor to consent to a change in the identification of the inventor. Each Contracting Party could then decide on the appropriate measures to take in the event that a consent were refused by a previously identified inventor.

356. Mr. BOGSCH (Director General of WIPO) stated that he was not sure that the solution suggested by the Delegation of the United Kingdom would satisfy each country. He suggested that Contracting Parties be allowed to require the consent of previously named inventors or, where such consent was refused, appropriate evidence of the veracity of the proposed correction in the identity of the inventor.

357.1 Mr. UEMURA (Japan) indicated that his Delegation was satisfied with the explanation that had been given earlier by the Director General to the effect that there was no conflict between the provisions contained in Article 6(4) and Rule 6(3).

357.2 He stated that his Delegation was concerned, however, that the second sentence of Rule 6(3) might give rise to an argument a contrario that no other requirement than the consent of the previously identified inventor, such as a clarification sought by the Office, could be required.

358.1 Mr. SCHAEFERS (Germany) indicated that the second sentence of Rule 6(3) represented, in his view, the maximum requirement that could be allowed. Any other requirement of a less onerous nature would be permitted.

358.2 Concerning the observations made by the Delegation of the United Kingdom, he wished to point out that the court procedure in cases of a refused consent in Germany was simple and straightforward. In the event, for example, that the previously identified inventor did not respond to a legal action claiming to give his consent to a correction, the court simply held in favor of the plaintiff claiming the correction.

359. Mr. BOGSCH (Director General of WIPO) asked whether the Delegation of Germany would be satisfied with the suggestion that he had made that, if the consent of previously identified inventors was not attainable, another form of evidence could be allowed.

360. Mr. SCHAEFERS (Germany) indicated that the first reaction of his Delegation, given on the basis of a reservation until such time as a written text would be available, was inclination to accept the suggestion made by the Director General.

361. Mr. SHACHTER (Israel) noted that the second sentence of Rule 6(3) indicated the maximum that could be required by a Contracting Party and expressed his preference for a provision which would establish the minimum required of each Contracting Party. That minimum was, in his view, an obligation to inform the previously named inventor of any proposed change in the identification of the inventor.

362.1 The CHAIRMAN concluded, in respect of the first sentence of Rule 6(3), that the discussions had shown a large majority for extending the faculty of correcting the identification of the inventor during the period following the grant of a patent. That extension could be set out either in the paragraph itself or elsewhere. To include it in paragraph (3) would seem the simplest approach.

362.2 As for the second sentence of paragraph (3), he observed that the suggestion that the consent of any previously identified inventor should be compulsory had not received majority support. The options given in the second

sentence did not prevent any Contracting Party from laying down itself the requirement of consent.

362.3 He observed that the proposal made by the Director General should satisfy all delegations, but that it had still to be drafted. The same applied to the note suggested by the United States of America.

363. Mr. BOGSCH (Director General of WIPO) asked the Delegation of Japan whether it could provide an example of a requirement that a Contracting Party might wish to impose in relation to a change in the identification of the inventor which would not be permitted in the text of the basic proposal of Rule 6(3).

364. Mr. UEMURA (Japan) stated that a declaration on the part of the newly identified or any additionally identified inventor was the example which his Delegation had in mind.

365. Mr. BOGSCH (Director General of WIPO) asked whether such a declaration would be required in Japan from the originally named inventor.

366. Mr. UEMURA (Japan) replied in the negative to the question posed by the Director General.

367. Mr. KIRK (United States of America) indicated that the practice in the United States was similar to that in Japan. In his country, a newly identified inventor would be asked to submit an oath or declaration that he or she was the genuine inventor. Such a requirement was also imposed in respect of the originally named inventor. To the extent that his Delegation would wish to continue the practice in respect of inventors named following a change in the identification of the inventors, his Delegation was in agreement with the Delegation of Japan.

368. Mr. BOGSCH (Director General of WIPO) indicated that the example given by the Delegation of Japan raised a new requirement which, if generally accepted, would require a change in Rule 6.

369. The CHAIRMAN proposed that the wording of the second sentence of paragraph (3) be supplemented to make it clear that any Contracting Party could require not only the consent of any previously identified inventor, but also a declaration by the newly identified inventor.

370. Mr. GARIEPY (Canada) asked whether the present wording of Rule 6(3) would extend to covering situations in which the identity of an inventor were fraudulently placed on an application.

371. Mr. BOGSCH (Director General of WIPO) expressed the view that forgery or fraud was not covered generally in the draft Treaty and that a Contracting Party could, in any such circumstances, take the action it judged appropriate.

372. Mr. WALLIN (IFIA) expressed the agreement of his Organization with the proposal made by the Delegation of Israel that there should be an obligation to inform any previously identified inventor of a proposed change. He suggested that the second sentence of Rule 6(3) should commence so as to read "Each Contracting Party shall inform any previously identified inventor and may require ..."

373. Mr. MESSERLI (Switzerland) supported the proposal by the Delegation of Israel. He thought that, before the name of the inventor was deleted, he should at least have the right to know what was happening.
374. Mr. VON ARNOLD (Sweden) expressed the agreement of his Delegation with the position of the Delegation of Switzerland.
375. The CHAIRMAN noted the general view that the second sentence should be supplemented to ensure that any previously identified inventor was at least informed of a change. Furthermore, it would have to be specified that any Contracting Party could require furnishing of any other means of proof.
376. Mr. KIRK (United States of America) stated that his Delegation could agree with the proposal made by the Delegation of Israel which was supported by the Delegation of Switzerland that there should be an obligation to inform any previously identified inventors in the event of a change, provided that it was made clear that that obligation extended only to making best efforts to inform any such previously identified inventors.
377. Mrs. BESAROVIC (Yugoslavia) supported the idea expressed by the Chairman.
378. Mr. UEMURA (Japan) stated that he had difficulty in imagining how an Office could be obliged to communicate with previously identified inventors. It was usually the applicant that requested a correction in the identification of an inventor, so that it would seem appropriate that the obligation to inform the previously identified inventor be placed on the applicant.
379. The CHAIRMAN observed that the declaration of the inventor should contain the address of the inventors and, consequently, the Office could correspond with any previously identified inventor without going through the applicant.
380. Mr. SHACHTER (Israel) expressed the agreement of his Delegation with the view expressed by the Delegation of the United States of America that an obligation on the Contracting Party to inform previously identified inventors of a change should be limited to an obligation to use best efforts so to inform.
381. Mr. GUERRINI (France) felt that it was open to question whether an Office should have an obligation to inform any previously identified inventor. He preferred the obligation to continue to be incumbent on the applicant and not to be imposed on the national Office.
382. Mr. BOGSCH (Director General of WIPO) stated that he did not see that there was any real necessity to require that previously identified inventors be informed, since their consent might in any case be required by a Contracting Party under Rule 6(3) as drafted in the basic proposal. He added that it was also unusual to provide in an international treaty for an obligation to be placed on a national Office to correspond with persons in another country.
383. Mr. SCHAEFERS (Germany) considered that it was appropriate not to enter into too many details in Rule 6(3), citing the example of a situation in which a previously identified inventor had subsequently died before a change was requested.

384. Mr. TALUKDAR (Bangladesh) expressed the agreement of his Delegation with the observations just previously made by the Director General.

385. Mr. NEERVOORT (Netherlands) sought clarification as to whether the word "applicant" in Rule 6(3) meant that there was no obligation to provide for a correction at the request of an inventor. He cited the example of an employer who had wrongly named the inventors and wondered whether the real inventors in such circumstances would be entitled to request a correction.

386.1 The CHAIRMAN pointed out that the question put by the Delegation of the Netherlands had already been raised in the Committee of Experts where certain delegations had explained that it was not the Office that was competent in such a situation, but the courts.

386.2 He concluded that the task of drafting a new text for Rule 6(3) should be entrusted to the Secretariat, which would judge the best moment to present it. The new text should state that a correction to the identification of the inventor could be made after grant of the patent. That text should also cover the suggestion made by the Director General on the matter dealt with in the second sentence of the paragraph. Additionally, the note asked for by the Delegation of the United States of America remained to be drafted by the Secretariat. He suspended the meeting.

[Suspension]

Article 7: Belated Claiming of Priority

387.1 The CHAIRMAN invited delegations to resume discussions on Article 7. He noted that paragraph (1) of Article 7 dealt with a case which was different from that under paragraph (2). He proposed that the two cases be dealt with separately and that discussion should be limited to the first paragraph.

387.2 He explained that the first paragraph dealt with the case in which an application, for which the applicant wished to enjoy a priority, was received within the 12-month time limit laid down by the Paris Convention, but did not contain, for whatever reason, the claim to priority. In such case, the circumstances under which a Contracting Party could authorize belated claiming of priority had to be determined.

387.3 He announced that there was only one proposal for amendment of Article 7(1), that of the Delegation of Lebanon, contained in document PLT/DC/46. He gave the floor to the Delegation of Lebanon.

388. Mr. HATOUM (Lebanon) introduced the proposal of his Delegation contained in document PLT/DC/46. He explained that his proposal amounted to amending paragraph (1) of Article 7 so that an applicant would be permitted to file a priority claim only within the 12-month priority period. The proposal also envisaged deleting paragraph (2) of Article 7 in its entirety.

389. Mr. GUERRINI (France) said that he had not altogether understood the aim of the proposal by the Delegation of Lebanon. He wondered whether the proposal was that the claim could be filed only during the one year priority period.

390. Mr. HATOUM (Lebanon) replied to the question raised by the Delegation of France in the affirmative and stated that the proposal of his Delegation was in accordance with the Paris Convention.

391. The CHAIRMAN asked whether any other delegation supported the proposal by the Delegation of Lebanon. Since no request to take the floor was forthcoming he declared that the proposal could not be pursued. He asked whether there were other comments to be made on paragraph (1).

392.1 Mr. SUGDEN (United Kingdom) stated that he understood the proposal of the Delegation of Lebanon to allow any applicant who has filed an application within the priority year to submit the priority claim at any time during the remainder of that year. His Delegation considered, however, that the proposal constituted an approach to the claiming of priority which was too rigid.

392.2 He stated that the period of four months after the end of the priority year permitted as a maximum under the text of Article 7(1) in the basic proposal might be considered to be too long, especially if publication of the application takes place 18 months after the priority date. His Delegation accepted in principle the belated claiming of priority, but would wish to see the period during which the priority claim could be submitted reduced to two months after the end of the priority year.

393. The CHAIRMAN pointed out that the proposal contained in PLT/DC/46 was no longer under discussion, unless a delegation wished to support it. As for the comments made by the Delegation of the United Kingdom, he pointed out that any Contracting Party so wishing could limit the period for claiming a priority to two months. The effect of the position supported by the Delegation of the United Kingdom would be to remove the possibility for other States to afford the more generous four-month time limit.

394. Mr. KIRK (United States of America) stated that his Delegation wondered whether there was any need to have an upper limit of not more than four months from the end of the priority period in which the priority claim could be submitted. Paragraph (1) of Article 7 set a minimum period of two months from the filing date and, if any Contracting Party so wished, it could limit the right to submit the priority claim to the two-month period following the end of the priority year. There would, however, be some Contracting Parties that were planning to publish applications at 24 months rather than at 18 months, and such Contracting Parties might wish to accept the submission of the priority claim much later than four months after the end of the priority year. His Delegation therefore suggested that the maximum limit of four months after the priority year be deleted and that it be left to Contracting Parties to determine whether they wished to be more generous in their treatment of delayed priority claims.

395. Mr. KHRIESAT (Jordan) stated that his Delegation favored the deletion of the maximum time limit, since that maximum limit should depend on various considerations, such as the date of publication of applications. An approach whereby only the minimum period during which the priority claim must be received was stated would be more flexible.

396. Mr. KIRK (United States of America) again stated that his Delegation questioned the need for an upper time limit. He also stated that, if the time limit were limited merely to the Convention priority period of 12 months, it

might be necessary to clarify that divisional applications, continuing applications and continuations in part were to be treated differently.

397. Mrs. ØSTERBORG (Denmark) stated that her Delegation supported the text of paragraph (1) of Article 7 in the basic proposal. Her country presently allowed the priority claim to be submitted within the three months following the 12-month priority period. Her Delegation would be against diluting the effect of harmonization by not fixing a maximum time limit. Such a maximum limit was important so the said parties could obtain legal certainty, especially where, as in most European countries, the right of the prior user was recognized.

398. Mrs. BESAROVIC (Yugoslavia) supported the wording of Article 7(1) as given in the basic proposal.

399. Mr. UEMURA (Japan) stated that his Delegation supported the text of paragraph (1) of Article 7 in the basic proposal. His Delegation considered that internal priority applications should be treated separately from the continuation or continuation-in-part applications mentioned by the Delegation of the United States of America. He suggested that the latter class of applications be discussed further when the meeting discussed Article 2.

400.1 Mr. SCHAEFERS (Germany) stated that all Delegations seemed to agree with the minimum period of two months. The maximum period of four months had been set by reference to publication of the application after 18 months. Now that the possibility existed that the 18-month limit for publication might be extended to 24 months, his Delegation considered that it made sense to delete the upper limit of four months in paragraph (1) of Article 7.

400.2 His Delegation did not consider that it was necessary to deal with the question of divisional applications and continuations-in-part in the present context. He considered that divisional applications would have accorded to them the priority date claimed by the parent application and were outside the scope of the provision being discussed at that stage.

401. Mr. QIAO (China) said that his Delegation could agree to the text of paragraph (1) of Article 7 in the basic proposal provided that the four-month maximum period was shortened to three months.

402. Mr. MOTA MAIA (Portugal) pointed out that his Delegation had opposed that provision in the discussions in the Committee of Experts since it held the 12-month priority period to be sufficient to settle everything, including priority claims. However, since exceptional cases were possible, his Delegation was now ready to accept the basic proposal.

403. Mr. KIRK (United States of America) stated that, if it were agreed generally that Article 7 did not deal with the question of continuation-in-part applications, his Delegation would be more comfortable with the notion that other Contracting Parties wished the law of the United States to preclude the nationals of those other Contracting Parties from having more than four months after the end of the priority period within which to submit a priority claim.

404. Mr. UEMURA (Japan) stated that his Delegation found it difficult to reach a conclusion on the question of whether a maximum time limit should be

included. However, his Delegation wished to point out that it was not necessarily in agreement with the approach suggested by the Delegation of Germany concerning divisional applications and continuations-in-part. While the Delegation of Germany had suggested that if the parent application claimed priority, the divisional application or the continuation or continuation-in-part was automatically considered to have claimed a priority, his Delegation was not convinced that this was so. His Delegation considered that the divisional application, the continuation or continuation-in-part had an independent status from the parent application so that a separate priority claim would be required in respect of them.

405. Mr. GUERRINI (France) acknowledged that a maximum period of four months was logical in view of the 18-month time limit for publication. Even if the publication time limit was extended to 24 months, his Delegation would tend to hold a single time limit to be appropriate in order to achieve uniformity and for reasons of legal certainty. Furthermore, suppression of the maximum period went too far in accommodating the wish to preserve national particularities that ran counter to the wish for harmonization. His Delegation supported the wording in the basic proposal.

406. Mr. SUGDEN (United Kingdom) stated that, on reflection, his Delegation was sympathetic to the proposal made by the Delegation of the United States of America to delete the maximum time limit and to leave the fixing of that maximum time limit to each Contracting Party. Clearly, of course, what each Contracting Party allowed as a maximum had to be compatible with its obligation to publish applications and Contracting Parties could be reminded of that in a note.

407. Mr. CASADO CERVIÑO (Spain) stated that his Delegation considered that the period during which a priority claim might be submitted should be limited to two months after the end of the priority year and not extended further in order to allow Offices to discharge their obligations of searching and examining applications.

408. Mr. BAKER (Australia) stated that his Delegation considered that a maximum limit should not be specified. If such a limit were specified, it should be consistent with the publication requirement in Rule 8.

409. Mr. SHACHTER (Israel) stated that his Delegation supported the deletion of a maximum limit, stating that it was to be understood that any time limit fixed by a Contracting Party had to be compatible with the other treaty obligations of that Contracting Party.

410. Mr. TALUKDAR (Bangladesh) wondered whether the subsequent application and the priority claim should not be submitted together.

411. Mr. OLD (APAA) stated that his Organization agreed that a minimum time limit should be fixed, but that the maximum limit should be left to each Contracting Party. The disadvantage of the text in the basic proposal appeared to his Organization to be that it required countries with a more lenient approach to adopt a more rigid approach.

412.1 The CHAIRMAN noted that a whole number of delegations had supported the basic proposal.

412.2 He proposed that the issue of divisional applications and of applications known in English as "continuations" or "continuations-in-part" be dealt with during the discussions on Article 2.

412.3 He noted that the issue of the maximum time limit had engendered lengthy discussions. Nevertheless, the minimum time limit of two months was not in question. Delegations were agreed. There was disagreement, on the other hand, on the maximum four month time limit. Some delegations did not wish to have such a maximum time limit, others wanted a maximum time limit that was shorter than four months and others again wished to support the basic proposal, whilst mentioning the 18-month time limit for publication. In that respect, he pointed out that the 18-month publication period was not the only link involved. There was also the problem of producing the search report that had also to be available at the time the application was published according to the provisions in the basic proposal. There was equally the problem of the security of third parties who did their own searching.

413. Mr. SEGURA (Argentina) stated that his Delegation considered that an upper limit of three months from the end of the priority period was quite sufficient.

<p><u>Fifth Meeting</u> <u>Monday, June 10, 1991</u> <u>Afternoon</u></p>

414. The CHAIRMAN opened the fifth meeting of Main Committee I and invited discussion on draft Article 7(2). He observed that the draft Article was contained in square brackets and, consistent with Rule 29(1)(c) of the Rules of Procedure, it had to be proposed as an amendment to the basic proposal. He also observed that the Delegation of Israel had presented a proposal for the amendment of Article 7(2) contained in document PLT/DC/42. He suggested proceeding in a two-step approach, firstly to see if the text in square brackets contained in Article 7(2) would be proposed as an amendment by a member delegation and supported by another member delegation and, secondly, to consider the proposal of the Delegation of Israel.

415. Mr. KIRK (United States of America) supported the text contained in square brackets in draft Article 7(2) and proposed removing the square brackets.

416. Mr. SCHAEFERS (Germany) supported the text contained in square brackets in draft Article 7(2) and seconded the proposal of the Delegation of the United States of America.

417. The CHAIRMAN indicated that, since two member delegations had supported the text contained in draft Article 7(2), the proposal could be discussed and adopted by Main Committee I. He then requested the Delegation of Israel to introduce its proposal.

418.1 Mr. SHACHTER (Israel) introduced the proposal of his Delegation contained in document PLT/DC/42. He stated that the provisions contained in draft Article 7(2) were designed to meet emergency situations. Under the Paris Convention, an application claiming priority was to be filed within 12 months of the priority date but, if an emergency situation arose such that an applicant was prevented from meeting the 12-month deadline, there should be an opportunity to re-establish the right to priority.

418.2 He stated that the two-month delayed filing period provided for in the basic proposal did not make sense, as an emergency must be considered in the circumstances that gave rise to it. In particular, he stated that if the general principle was accepted that emergency situations prevented one from filing an application claiming priority within 12 months and the applicant took all measures to comply but was not able to do so, it should be left to national law to determine the length of the delayed filing period. He stated that provisions for a delayed filing period existed in many countries.

418.3 He stated that proof might be adduced, such as through affidavits, that an applicant tried to file his application on or before the end of the priority period, but was unable to do so. If such proof later turned out to be fraudulent, the patent so obtained would be invalidated or rendered unenforceable.

418.4 He proposed a variation to the exact text of the proposal of his Delegation contained in document PLT/DC/42 by providing that the period for the delayed filing of the subsequent application be "at least two months" of the expiration of the 12-month priority period.

419. Mr. MESSERLI (Switzerland) supported the proposal of the Delegation of Israel. He stated that the provision that the period be at least two months gave a certain flexibility to treat this case as other cases of "restitutio in integrum." He emphasised that it was not the right of priority being restored but the right to claim priority.

420. The CHAIRMAN indicated that, since two delegations had supported the proposal by the Delegation of Israel, it and the proposal in draft Article 7(2) were opened to discussion.

421. Mr. SMITH (Australia) supported the proposal by the Delegation of Israel to establish the delayed filing period as "at least" two months.

422.1 Mr. GUERRINI (France) said that his Delegation could not support the basic text nor could it support the amendment proposed by the Delegation of Israel. For his Delegation it was a matter of principle that had to be settled immediately. It was important that the meeting take a stance on the question whether priority could subsist beyond 12 months. He observed that the period of extension remained unspecified in the proposal by the Delegation of Israel that had received support and which opened vast prospects of flexibility.

422.2 He considered that there were two major categories of time limit. There were firstly the time limits given to individuals to enable them to exercise rights, whereby consideration was given to their possible incapacity to act. Those were time limits that were essentially given in the exclusive interests of the person enjoying them and it was at that moment that the formulation "against the person who had not been able to act validly, prescription did not run" came into operation and thus the time limit could be prolonged. There were further types of time limits, on the other hand, which were laid down by law in an imperative manner on account of a number of requirements that did not solely take into account the person enjoying the limit, but also concerned the whole of the community. In such cases, it was clear that the applicant's rights could be in competition with the rights of others. It was therefore necessary to arbitrate between the situation of such other persons and the situation of the applicant. The Paris Convention, in its wisdom, had set a 12-month period; it had not set a time limit that could be extended, but a predetermined period. On questions of principle, one should not open the way to situations that ought to be avoided.

422.3 He quoted the example already given in the Committee of Experts. That was the case of a German applicant who wished to file a patent application in France. It assumed that France was party to both the Paris Convention, giving a 12-month time limit, and the Harmonization Treaty that provided for what was presently being done, that was to say the possibility of extending the priority period. It then assumed that Germany, for its part, had not ratified or acceded to the Treaty and that relations between Germany and France were therefore governed exclusively by the Paris Convention. The German applicant could find himself faced with an extended priority, could find himself faced with a filing made in France by a Frenchman, which was later than his, but which claimed a 14 or 18-month priority under the Treaty on which the meeting was working. The German applicant would be justified in claiming that, as a national of a State bound in its relations with France by the Paris Convention only, he knew only the time limit laid down by the Paris Convention.

422.4 He considered that, essentially, it had to be acknowledged that arbitration between two interests was involved, those of the applicant and those of third parties, who should be capable of knowing the scope of rights they may have with regard to the patentee. The Paris Convention had fixed a reasonable period.

423.1 Mr. SUGDEN (United Kingdom) stated that his Delegation agreed with the position of the Delegation of the United States of America that the square brackets should be removed and the provisions in draft Article 7(2) should be contained in the draft Treaty. He saw it as a reasonable proposal whereby applicants who, due to force majeure, were not able to file their applications within 12 months of the priority date, were able to save them.

423.2 He stated that, in the penultimate sentence of Article 7(2), the phrase "the subsequent application could not have been filed within the said 12-month period" introduced a requirement in addition to the one that the applicant had exercised "all due care." Accordingly, he proposed that the phrase be substituted by the words "the subsequent application was not filed within the said 12-month period."

423.3 With respect to the proposal by the Delegation of Israel, he stated that he had sympathy for the position of the Delegation of France that there must be certainty for third parties; in particular, they should know if priority would be claimed at the publication of the application. Therefore, he supported the two-month delayed filing period as found in the text of draft Article 7(2) in the basic proposal.

424. Mr. POPPLEWELL (New Zealand) stated that his Delegation was in substantial agreement with the Delegation of the United Kingdom and supported the removal of the square brackets so as to retain the text of draft Article 7(2) in the basic proposal. He agreed with the amendment suggested by the Delegation of the United Kingdom to the penultimate sentence of draft Article 7(2). He stated that the basic principle was important in that there were certain circumstances that were outside the control of the applicant or agent. His Delegation favored the principle put forward by the Delegation of Israel that more flexibility in terms of the length of the delayed filing period was desirable.

425.1 Mr. SCHAEFERS (Germany) supported the text in the basic proposal and moved its inclusion in the draft Treaty. He recalled that the topic under discussion was one put forward by FICPI in the fourth meeting of the Committee of Experts to address problems of patent agents when they filed priority applications late under circumstances beyond their control. He was, therefore, in favor of the principle of the restoration of the priority right, even if the law of Germany and the European Patent Convention expressly excluded the possibility.

425.2 As for the length of the period, he stated that the period provided for in the basic proposal of two months was too short a time to accommodate certain situations, but that, if it were made longer, provisions would have to be made for intervening rights. He indicated that his Delegation was inclined to accept the proposal of the Delegation of Israel.

426. Mr. GARIEPY (Canada) supported the removal of the square brackets to draft Article 7(2) so as to include it in the draft Treaty. As to the length of the delayed filing period, he felt that two months was sufficient.

427. Mr. BOGSCH (Director General of WIPO) inquired of those States that had supported an open-ended length for the delayed filing period if they perceived any conflict between such a provision and the requirement to publish patent applications at 18 months after the filing or priority date.

428. Mr. MESSERLI (Switzerland) felt that the situations in which the delayed filing of a priority application would be exercised would be few. As to the relationship between such provisions and the requirement for early publication, his Delegation considered that there should be a balance between the interests of third parties and those of an applicant which, despite the exercise of all due care, was not able to meet the deadline of 12 months and that the balance should be in favor of the applicant.

429. Mr. BOGSCH (Director General of WIPO) emphasised that the rights of third parties should be protected and stated that the filing of an application claiming priority after, for example, a five-year delay would be counter to their rights. He stated that, if the situations in which the facility would be availed of were so rare, then keeping the period as in the basic proposal would not harm the overwhelming majority of applicants.

430. Mr. NEERVOORT (Netherlands) stated that in the Committee of Experts his Delegation had opposed draft Article 7(2) as not being in accord with the Paris Convention. In this regard, his Delegation fully supported the position taken by the Delegation of France.

431.1 Mr. GUERRINI (France) said that, to his mind, the discussion had gone aground on the question of whether the time limit was too short or too long. Two months, that was sufficient. Should one envisage four months? Should one envisage cases of force majeure? Or even other situations also? That was not the issue. His Delegation had looked at the problem in terms of principles, as had just been referred to by the Delegation of the Netherlands. The question was whether such a provision would comply with the Paris Convention, whereas the example that had been given previously suggested the opposite, that was to say the situation of the German wishing to file an application in France (France being bound by the two Treaties (Paris Convention and the Hague Treaty)) and Germany being bound solely by the Paris Convention. Since the Paris Convention laid down the principle of national treatment, the German in France was placed in the same situation as a Frenchman and the German could therefore be faced with a filing subsequent to his own made by a Frenchman under a 14, 15, or 18-month priority, depending on the decision taken.

431.2 He observed, nevertheless, that Article 2 of the Paris Convention reserved the possibility of special rights, that was to say the provisions in the Paris Convention that foreign Convention nationals could invoke in other Convention countries. Consequently, the German in the example that had been quoted would be entitled, as a special right, to invoke that 12-month time limit that was more favorable to him in that it improved his situation in his relationship with the French applicant. The German applicant would be entitled to reject opposition by the Frenchman's patent.

431.3 He emphasized that his wish was for proper awareness of the absolutely fundamental nature of the objection that his Delegation was making to that provision. It did not intend to discuss soporifically, as was the present case, the conditions for extending the Convention priority. His Delegation intended to stay with the question of principle.

432. Mrs. SANDBERG (Sweden) stated that her Delegation did not support the provision as provided for in draft Article 7(2) because the uncertain situation it creates for the third party, but also for not being in accordance with the Paris Convention.

433. Mr. UEMURA (Japan) indicated that his Delegation was awaiting further instructions from his government on the issue under discussion. He stated, however, that the provisions of draft Article 7(2) might be incompatible with Article 4A(1) of the Paris Convention and he sided, therefore, with those delegations that had expressed difficulties in accepting such a proposal.

434. Mr. SHACHTER (Israel) agreed with the Delegation of France that there was a principle at stake. He stated that, if one accepted, however, that the provisions in draft Article 7(2) were consistent with the Paris Convention, then the two-month delayed filing period was not a realistic proposal. He noted that the Director General and the Delegation of Canada had expressed some misgivings about an open-ended time limit. He stated that in practice in many countries the period never extended beyond three to four months, and not more than six.

435. Mr. JILANI (Tunisia) agreed with the position taken by the Delegation of France and stated that there was no need for the provisions found in draft Article 7(2). His Delegation felt that the 12 month period provided for in the Paris Convention was enough, especially in light of the rapid means of communication currently available.

436. Mr. ESCUDERO CÁCERES (Chile) stated that his Delegation agreed with the positions taken by the Delegations of France, the Netherlands and Tunisia. In the view of his Delegation, the provisions of draft Article 7(2) were not compatible with the Paris Convention.

437. Mr. PARK (Republic of Korea) supported the position taken by the Delegation of France.

438.1 Mr. KIRK (United States of America) indicated that his Delegation had not had the opportunity to discuss the proposal by the Delegation of Israel with interested circles in its country. He stated, however, that the proposal was attractive in providing some flexibility but presented problems, such as the possibility of providing for intervening rights if the delayed filing period was too long. He therefore favored the two-month period as provided for in the text of draft Article 7(2) in the basic proposal.

438.2 He agreed with the proposal by the Delegation of the United Kingdom with respect to the penultimate sentence of draft Article 7(2) to replace "could not have been filed" with "was not filed."

438.3 He stated that the applicant should have the possibility of re-establishing the right to priority following a delay after the priority period upon the payment of a fee, the amount of which would be high enough to reflect the extraordinary nature of the provision. He stated that possibility of re-establishing the right to priority upon the payment of a fee would avoid the problem of the requirement that the "all due care" standard be interpreted too rigidly by Offices.

439. Mr. ORTEGA LECHUGA (Spain) stated that the proposal in draft Article 7(2) might be incompatible with the Paris Convention.

440. Mr. KAMEL (Egypt) supported the positions taken by the Delegations of France and Tunisia and stated that the provisions in draft Article 7(2) were not needed as the provisions of the Paris Convention were sufficient.

441. Mr. HATOUM (Lebanon) concurred with the position taken by the Delegation of France. He stated that his Delegation found the provisions of the Paris Convention sufficient and that there was no need for an extension of the priority period.

442.1 Mr. KOLLE (EPO) stated that his Delegation was in sympathy with the provisions contained in draft Article 7(2). He stated that the situations in draft Article 7(1) and (2) were not totally different, the end result being to allow the applicant to claim priority even if the priority year had expired. He pointed out that the modern trend in patent law was to allow an applicant an opportunity to remedy missed time limits, if resulting from circumstances beyond his control or in spite of all due care observed by him. Also, when there was general interruption in the delivery of mail, all time limits were extended including the priority period. He observed that some national laws provide for the restoration of the right to claim priority and that the countries having such laws obviously did not consider them to be contrary to the Paris Convention.

442.2 He stated that such restoration might occur two, three or four months following the end of the priority period, but that what was decisive was that the interests of third parties be protected. In that regard he noted that third parties had no legitimate interest in being protected when the original application was filed late, provided they were apprised of the priority date either in the application as published or in a published warning of a late claim to priority. Thus, he felt that the delayed filing period should be kept short.

443. Mr. BOGSCH (Director General of WIPO) stated that moderation was good counsel in drafting international treaties. He observed that the test of "in spite of all due care required by the circumstances" might be considered as going far enough. It was not the more limited test of "circumstances beyond control." He indicated that draft Article 7(2) was a suitable compromise and that allowing a delayed filing period of five years or providing for delayed filing on the mere payment of a fee did not seem to be consistent with the spirit of the Paris Convention.

444. Mr. KORCHAGUIN (Soviet Union) agreed that the square brackets should be removed from around draft Article 7(2) and that the period of two months provided for in that draft Article was sufficient.

445. Mr. MANZOLILLO DE MORAES (Brazil) expressed his opposition to the inclusion of draft Article 7(2) and supported the position of the Delegation of France.

446. Mr. SEGURA (Argentina) stated that the provisions of Article 7(2) were not consistent with the Paris Convention and, therefore, opposed their inclusion.

447. Mr. ENÇ (Turkey) shared the point of view of the Delegation of France that draft Article 7(2) should not be included in the draft Treaty as it would create uncertainty for third parties.

448. Mr. HIEN (Burkina Faso) supported the position taken by the Delegation of France that draft Article 7(2) should be deleted. He stated that if the draft Article were to remain, it would only further complicate patent grant procedures in his country.

449. Mr. SCHAEFERS (Germany) stated that he was not convinced by the arguments put forward by the Delegation of France. He indicated that he found a study that had been prepared by the Max-Planck-Institute persuasive in that regard. He stated that time limits were not absolute, citing the European Patent Convention and practice in some countries whereby time limits might be prolonged, such as in the case of the interruption of postal service. He urged, therefore, that the proposal contained in draft Article 7(2) be accepted.

450. Mr. KNITTEL (Austria) supported draft Article 7(2) as such since it was seen as being helpful to applicants in difficult situations. He indicated that his Delegation accepted the delayed filing period of two months, but was willing to accept a longer period. He saw the provision of the draft Article as being in conformity with the Paris Convention. He indicated that the patent law of Austria dealt with the matter under discussion in a similar way and that no problems had been experienced.

451. Mr. LY (Senegal) agreed with the position taken by the Delegation of France that draft Article 7(2) should be deleted. He stated that draft Article 7(2) was contrary to the relevant provisions of the Paris Convention, according to a normal method of interpretation as known in international law.

452. Ms. KRUDO SANES (Uruguay) stated that her Delegation agreed with the position taken by the Delegations of France and Senegal that draft Article 7(2) should be deleted.

453. Mr. SUGDEN (United Kingdom) stated that his Delegation shared the sentiment of the Delegation of Germany. He stated that his Delegation felt that the Paris Convention did not prevent limits being extended where such limits were missed as a result of force majeure. He was concerned with protecting the rights of third parties, in particular the right to find out about the application and the priority claim. He indicated, therefore, that the delayed filing period should be compatible with the publication of applications after 18 months from the priority date.

454. Mr. KESOWO (Indonesia) indicated the preference of his Delegation that draft Article 7(2) not be included in the Treaty. He stated that the draft Article presented some difficult technical issues that should be dealt with in the context of discussions on the revision of the Paris Convention.

455.1 Mr. GUERRINI (France) said that he would like to reply to what had been said by the Federal Republic of Germany. He stated that decrees were taken in France in order indeed to achieve prolongation of time limits in the event of interruption of postal services, but those decrees did not concern the priority rights. Indeed, the law under which such decrees were taken provided for interruption of time limits "with regard to the National Institute of Industrial Property." It was certain, that the Convention priority time limit was not a time limit effective with regard to the National Institute of Industrial Property. What was concerned, were the time limits laid down for the application examination procedures.

455.2 He recalled that reference had also been made to an academic study conducted by the Max Planck Institute. The specialists had become accustomed to the admirable work done by the Max Planck Institute, which he acknowledged. However, he admitted that he had not been satisfied. The 25-page study had not replied to the sole question put to its authors.

455.3 He approved the altogether pertinent comment made by the Delegation of Senegal.

455.4 He observed that various delegations seemed to him to be maintaining a form of confusion when agreeing that the provision could be contrary to the Paris Convention and that, therefore, it was necessary to consider only very strict exceptions as, for instance, a case of force majeure that could make it impossible for the parties to act. He stated that if the time limit laid down by the Paris Convention was indeed as he had attempted to demonstrate, that was to say a predetermined time limit, such a time limit could be subject to no interruption of any kind, including force majeure. He concluded by saying that a decision would have to be taken in the light of that situation. Either it was in compliance with the Paris Convention and one had complete freedom, or it was acknowledged that it was not in compliance with the Paris Convention and, in that case, if it appeared advisable to extend the time limit, the debate had to be referred to the Paris Convention revision.

456. Mr. SCHAEFERS (Germany) clarified that it was the 12 month time limit provided for in the Paris Convention that was subject to restoration, in the same manner that all time limits are subject to restoration. He indicated that such restoration should only be allowed in situations of force majeure.

457. Mrs. DE CUYPERE (Belgium) stated that her Delegation was also one of the delegations opposed to the very principle of a claim to priority of an application filed beyond the 12-month time limit fixed by the Paris Convention. She fully adhered to the arguments presented by France and supported the deletion of the paragraph.

458. Mr. TOURE (Côte d'Ivoire) supported the position taken by the Delegation of France, in particular that any provisions adopted in the draft Treaty should be consistent with the Paris Convention.

459. Mr. MILLS (Ghana) stated that his Delegation was opposed to the inclusion of draft Article 7(2) in the Treaty.

460. Mrs. BESAROVIC (Yugoslavia) stated that her Delegation supported the deletion of draft Article 7(2) for the reasons given by the Delegation of France.

461. Mr. VEKAS (Hungary) stated that his Delegation shared the views of the Delegation of the European Patent Organization and that draft Article 7(2) should be included in the Treaty.

462. Mr. ABU BAKAR (Malaysia) indicated that his Delegation had reservations in respect of draft Article 7(2). In particular, if it was contrary to the Paris Convention, it should be deleted.

463. Mr. O'FARRELL (Ireland) supported the position of the Delegation of France that draft Article 7(2) should not be included in the Treaty.

464. Mr. SAPALO (Philippines) agreed with the point made by the Delegation of the European Patent Organization that there was slight difference between draft Article 7(1) and (2) as the end result was the same in that an applicant would be allowed 14 months within which to claim priority. The only difference was the requirement of "due care" in paragraph (2). He stated that

there was no need to be dogmatic about time periods; such periods need not be adhered to in the case of force majeure.

465. Mr. ELHUNI (Libya) supported the position taken by the Delegation of France in respect of the deletion of draft Article 7(2).

466. Mr. KAINAMURA (Uganda) had misgivings in respect of the inclusion of draft Article 7(2) because it gave discretion to national offices to decide on an international issue. That would result in differing decisions on a country-to-country basis which would defeat the purposes of harmonization.

467. Mr. ABATZIS (Greece) stated that his Delegation agreed with the position taken by the Delegation of France.

468. Mr. MBUYU (Zaire) stated that his Delegation supported the position of the Delegation of France and asked for the deletion of draft Article 7(2) to follow the spirit of the Paris Convention.

469. Mr. TALUKDAR (Bangladesh) invited the delegations to take a position on two criteria; first, the compatibility of the provisions of draft Article 7(2) with the Paris Convention and, secondly, whether the provisions created an added burden.

470. Mr. WARR (Malta) supported the inclusion of draft Article 7(2).

471. Mr. VU HUY TAN (Viet Nam) urged the deletion of draft Article 7(2) for the reasons that had been well explained by other delegations that preceded his.

472. Mr. HADJ-SADDOK (Algeria) urged the deletion of draft Article 7(2).

473. Mr. NYILIMBILIMA (Rwanda) urged the deletion of draft Article 7(2) for the reasons given by the Delegation of France.

474. Mr. SOUMANA (Niger) supported the views expressed by the Delegations of France and Senegal.

475. Mr. GAO (China) indicated that his Delegation did not want draft Article 7(2) included in the Treaty.

476. Mr. LOSSIUS (Norway) indicated that his Delegation was in favor of draft Article 7(2) as it stood in the basic proposal.

477. Mr. KUNKUTA (Zambia) supported the position taken by the Delegation of France in favor of the deletion of draft Article 7(2).

478. The CHAIRMAN indicated that neither the proposal contained in square brackets in draft Article 7(2) in the basic proposal nor the proposal by the Delegation of Israel (PLT/DC/42) had attracted sufficient support.

479. Mr. BRUNET (NYPTC) recommended that consideration be given to accepting draft Article 7(2). He indicated that the "all due care" standard in the draft Article related to external problems, such as mail strikes, that prevented the filing of an application within the priority period. He stated, however, that some problems were internal to the office of an attorney and

that, in those instances, if the filing date was missed the delayed filing of a priority application should be allowed upon the payment of a fee. He did not see that the public would be harmed and considered that, if the fee were large enough, delayed filing of priority applications would not be a regular occurrence.

480. Mr. HIJMANS (APA) stated that draft Article 7(2) created an unacceptable level of uncertainty for third parties and should be deleted. He stated that the Conference had no power to adopt a provision such as found in draft Article 7(2) as it was in contradiction with the Paris Convention.

481. Mr. PETERSEN (CIPA and CNIPA) supported draft Article 7(2) as a compassionate and merciful provision. He stated that the provision added to the protection provided by the Paris Convention. Further, he stated that, with respect to the protection of the rights of third parties, since publication of the application does not occur until 18 months, or perhaps 24 months, after the priority date, third parties were not aware until then of a claim to priority. He felt, therefore, that there was no problem with late claiming.

482. Mr. HATOUM (Lebanon) urged the deletion of draft Article 7(2).

483. Mr. PARKES (UPEPI) supported draft Article 7(2) as it appeared in the basic proposal. He stated that general circumstances, such as an interruption on postal service, might necessitate an extension. Some offices deal with such a situation by creating the legal fiction that the office was closed during the emergency situation. He stated that draft Article 7(2) was addressed to special circumstances that made it impossible to file an application within the 12 month priority period.

484.1 Mr. EVERITT (FICPI) stated that his Organization had supported the proposal contained in draft Article 7(2) for ten years. He stated that its essence was that the applicant should have priority right restored in exceptional circumstances where the intention to file was frustrated through no fault of his own.

484.2 He observed that no delegation had alleged that the provision was not moral, the objections raised having been limited to the compatibility of the provision with the Paris Convention. He alluded to the study done by the Max-Planck-Institute, in particular, which concluded that the Paris Convention was silent on the issue of the restoration of the right to claim priority. In that regard, he noted that there was a difference between the extension of the priority period and the restoration of the right to claim priority. He indicated the draft Article 7(2) was of the latter type--the restoration of the right to claim priority.

484.3 His Organization considered the provisions of draft Article 7(2) to be of advantage to patent offices in allowing them to prevent a deserving applicant from losing his right to a patent. In that regard, he referred to problems that might arise if the computer system crashed in an office that accepted filings electronically.

484.4 He observed that the Paris Convention itself provided some flexibility since applications for which the priority period expires on a day when the office was closed were considered to be filed when next the Office opened.

485. Mr. PAGENBERG (MPI) stated that his Organization supported draft Article 7(2). He emphasized that the provision under discussion provided for the re-instatement of the right to claim priority, not the extension of the priority period. He alluded to the study that had been prepared by his Organization in that regard that found the Paris Convention to be silent on the matter and indicated that there was no contrary in-depth study.

486. Mr. OLD (APAA) indicated that his Organization was in favor of draft Article 7(2). He stated that two countries within the region of his Organization had provisions for the re-instatement of the right to claim priority and that they had experienced no problems with the protection of the rights of third parties.

487. The CHAIRMAN concluded that there had been insufficient support to maintain either the proposal of draft Article 7(2) or the proposal of the Delegation of Israel (PLT/DC/42) and that, therefore, only draft paragraph (1) of Article 7 would be retained as the basis for further discussion. He emphasized that the conclusions reached in the Committee would not affect national legislation, in particular national legislation that included provisions similar to those found in draft Article 7(2). The Chairman then suspended the meeting.

[Suspension]

Article 8: Filing Date

488.1 The CHAIRMAN opened discussion on draft Article 8 (Filing Date) and noted that there were three proposals in relation thereto, one from the Delegation of Lebanon (PLT/DC/47), one from the Delegation of Ireland (PLT/DC/10 Rev.) and one from the Delegation of Japan (PLT/DC/18). He stated that draft Article 8 was the result of long and detailed discussions within the Committee of Experts which had finally resulted in provisions that seemed to represent an acceptable balance. He cautioned, therefore, against the introduction of proposals that might upset that balance.

488.2 He then turned to a discussion of the proposal of the Delegation of Lebanon (PLT/DC/47) and invited that Delegation to take the floor.

489. Mr. HATOUM (Lebanon) requested a postponement of discussion of the proposal being presented by his Delegation so as to afford an opportunity to the Group of Developing Countries to meet and consider it.

490. Mr. KESOWO (Indonesia), speaking in the name of the Group of Developing Countries, stated that it was his understanding that the request by the Delegation of Lebanon to postpone discussions in relation to draft Article 8 related only to the proposal of that Delegation concerning draft Article 8.

491. Mr. KAMEL (Egypt) concurred with the Delegation of Indonesia in its understanding of the request of the Delegation of Lebanon.

492. The CHAIRMAN concluded that discussion of the proposal of the Delegation of Lebanon (PLT/DC/47) would be set aside and that the proposal of the Delegation of Ireland (PLT/DC/10 Rev.) would be taken up. He invited the Delegation of Ireland to take the floor.

493. Mr. O'FARRELL (Ireland) introduced the proposal of his Delegation indicating that it was motivated by a desire to have a less complicated one-step procedure for time limits. His Delegation thus preferred a single time limit. He stated that the provisions contained in new paragraph (6) had originally been contained in Rule 7 and that they had been transferred to the Article as it was the opinion of his Delegation that the legal consequences affecting an application should be dealt with in an Article and not a Rule. He characterized new paragraph (6) as requiring claims and a fee to be filed with an application so as to establish a filing date.

494. The CHAIRMAN indicated that the proposed amendments to Rule 7 would be set aside, to be discussed when the discussion on Article 8 had been completed. He requested clarification from the Delegation of Ireland as to the consequences of not complying with the requirements in draft Article 8 as they proposed to amend it.

495. Mr. O'FARRELL (Ireland) indicated that the proposed new paragraph (6) would require the filing of all of the elements called for in draft paragraph (1), draft paragraph 2(a)(i)--relating to claims--and draft paragraph 2(a)(ii)--relating to the fee. In such instances, the Office would invite compliance within a time limit and, if the applicant complied, the filing date would be taken as the date of compliance with the invitation.

496. Mr. BOGSCH (Director General of WIPO) indicated that the proposal by the Delegation of Ireland would, in effect, mean there was no difference between the requirements in draft paragraphs (1) and (2), a result which would upset one of the great achievements embodied in draft Article 8.

497.1 Mr. MESSERLI (Switzerland) stated that his Delegation could accept the explanatory notes found in the proposal by the Delegation of Ireland. In particular, it could support the ideas of transferring the sanctions for non-compliance of the provision in Article 8 from Rule 7 to the Article and of simplifying the system of time limits from a two-stage approach to a one-stage approach.

497.2 He indicated, however, that his delegation could not accept the other points raised by the proposal. He noted that draft Article 8 represented a compromise reached after a number of years of discussion and that this compromise should not be jeopardized. In particular, he expressed a preference for the approach taken in the basic proposal that the filing date should be the date on which the requirements of paragraph (1) were fulfilled, not the time the applicant complied with the invitation to provide claims or the fee.

497.3 Further, he stated that his Delegation did not agree with the proposal of the Delegation of Ireland in respect of draft paragraph (5) which would require the description and claims to be filed in an official language at the filing date.

497.4 He indicated that the position of his Delegation was exactly as contained in the original proposal submitted by the Delegation of Ireland before it had been revised (PLT/DC/10).

498. Mr. CURCHOD (WIPO) indicated that, with respect to placing the provisions in relation to non-compliance with requirements in draft Rule 7

rather than in draft Article 8, it was decided, on the basis of experience gained in the Committee of Experts, that a flexible approach was desired. Thus, as experience was been gained with the Treaty it would be possible to amend the provision without having to resort to a diplomatic conference.

499. Mr. NEERVOORT (Netherlands) indicated his support for the proposal by the Delegation of Switzerland to take up the original proposal of the Delegation of Ireland. While he indicated that he understood the clarification given by Mr. Curcbod, he indicated that it was not consistent with the approach taken in legislation in the Netherlands wherein the consequences of non-compliance with a law were set out in the law rather than in the regulations.

499.2 He welcomed the attempt by the Delegation of Ireland to simplify the provisions of Article 8. He observed that the proposal of that Delegation allowed Contracting Parties to file a claim or claims in order to establish a filing date and noted that such a provision existed in the patent law of the Netherlands.

499.3 As to the question whether certain elements of an application would have to be filed in an official language of an Office, he indicated that his Delegation was flexible and could accept either the basic proposal or the proposal of the Delegation of Ireland in that regard.

500. The CHAIRMAN noted that there had been no clear-cut support for the proposal by the Delegation of Ireland.

501. Mr. GUERRINI (France) said that his Delegation supported the approach of introducing a sanction for failure to comply with the time limits under the Treaty.

502. Mr. SCHAEFERS (Germany) indicated that while his Delegation hesitated to support including procedural provisions from the regulations into draft Article 8, his Delegation supported the principle of a one-step time limit as discussed in note number 2 in PLT/DC/10 Rev. He suggested that debate not be continued on the basis of PLT/DC/10 Rev.

503. Mr. MANZOLILLO DE MORAES (Brazil) stated that his Delegation had some apprehension in establishing a filing date on the basis of applications filed in a non-official language. He indicated that that issue was being discussed in the Brazilian Congress and that there was not complete belief in Brazil in the possibility of adopting such a principle. He stated that his Delegation believed that it would be a great burden to accept applications filed in a non-official language as identifying non-compliance with requirements in a language not fully understood would demand a greater effort by the Office. He saw the proposal by the Delegation of Ireland as being very positive for its greater flexibility.

504.1 Mr. ORTEGA LECHUGA (Spain) considered the proposal by the Delegation of Ireland as positive in transferring the provisions concerning the effect of non-compliance with the provisions of the draft Article 8 from the rules to the draft Article.

504.2 He requested clarification from the Delegation of Ireland as to whether the date of filing accorded to an application filed in a non-official language

would be the date of receipt of the elements in the non-official language or the date of receipt of the translations.

505. Mr. O'FARRELL (Ireland) stated that the proposal submitted by his Delegation would require that the parts of an application be in an official language, if not, the date on which the translations were provided to the Office would determine the filing date of the application. He stated that the issuance of an invitation by an Office to provide translations would require post-dating of the filing date.

506. The CHAIRMAN observed that the proposal by the Delegation of Ireland was a version considered by the Committee of Experts four or five years before wherein all of the claims, description and fees had to be filed to obtain a filing date, and all in the official language.

507. Mr. BOGSCH (Director General of WIPO) wondered whether draft Article 8 in the form proposed by the Delegation of Ireland would be worth having in the Treaty, as it did not tend towards harmonization.

508.1 Mr. SUGDEN (United Kingdom) indicated that his Delegation was not in favor of the proposal by the Delegation of Ireland. He recalled that his Delegation had, in the discussions in the Committee of Experts, originally called for filing of an application in an official language, along with a fee, in order to be accorded a filing date. After long and difficult discussions at home, there came an acceptance of the need to harmonize the requirements for a filing date and accept, in principle, the provisions now included in the basic proposal.

508.2 He felt that the basic proposal was overly complicated, however, and called for a simplified approach. In that regard he indicated he would be willing to accept the proposal of the Delegation of Switzerland, taking over the original proposal of the Delegation of Ireland contained in document PLT/DC/10.

509. Mr. LOSSIUS (Norway) indicated that he was convinced that the basic proposal should be retained, but stated a preference for a more simplified procedure.

510. Mr. UEMURA (Japan) stated that his Delegation had difficulty in accepting the general idea in the basic proposal, indicating that, for example, the claim was an absolute requirement in his country. However, in light of the strong need to harmonize, he indicated that his Delegation could accept it. He expressed a desire to base discussions on either the basic proposal or on the original proposal of the Delegation of Ireland (PLT/DC/10).

511. Mr. BOGSCH (Director General of WIPO) stated that, in the proposal of the Delegation of Switzerland (the original proposal of the Delegation of Ireland contained in document PLT/DC/10 and now contained, as the proposal of the Delegation of Switzerland, in document PLT/DC/56), there was no possibility of filing in a foreign language to obtain a filing date. He inquired as to whether that was an intended result.

512. Mr. MESSERLI (Switzerland) indicated that his understanding of the original proposal of the Delegation of Ireland (PLT/DC/10) was that paragraph (5) allowed a Contracting Party to require that the description,

claims or text matter in a drawing be in an official language. If a Contracting Party made such a choice and if the application as filed did not include such elements in the official language, the applicant would be invited to provide translations. If he complied with that invitation, the filing date would be the date on which the elements referred to in paragraph (1) were received.

513. Mr. SCHAEFERS (Germany) proposed considering the proposal of the Delegation of Switzerland in document PLT/DC/56 and, if no agreement could be reached, returning to the basic proposal. He indicated that the proposal had certain merits, in particular, in moving the provisions relating to the consequence of non-compliance with draft Article 8 from the Rule to the Article.

514. Mr. KIRK (United States of America) supported the basic proposal and agreed with the position taken by the Delegation of Norway. He stated that the matter should be examined carefully before the excellent work of the Committee of Experts was abandoned.

515. The CHAIRMAN observed that there was no support for the proposal of the Delegation of Ireland contained in document PLT/DC/10 Rev. He indicated that there had been some support for the basic proposal and for the proposal of the Delegation of Switzerland (document PLT/DC/56). He indicated that the proposal of the Delegation of Switzerland would be distributed and discussed along with the proposal of the Delegation of Lebanon (PLT/DC/47). He then adjourned the meeting.

<p><u>Sixth Meeting</u> <u>Tuesday, June 11, 1991</u> <u>Morning</u></p>

Article 8: Filing Date (continued)

516.1 The CHAIRMAN opened the meeting and warmly thanked the Delegation of the Netherlands and all those who had helped in organizing the outing to the flower market in Rijnsburg.

516.2 He announced that the President of the Conference was convening the Steering Committee at 2.30 p.m. in his office.

516.3 He then summarized the work accomplished so far by Main Committee I. He first noted that discussions on Articles 1 and 2 had been postponed since definitions could not be examined before the content of the substantive provisions was known. He commented that the discussions on Articles 3 to 7 had left two issues in suspense, that was to say the proposal by the Delegation of Lebanon on Article 3, contained in document PLT/DC/45, and the proposal by the Delegation of Germany, also on Article 3, contained in

document PLT/DC/58. Likewise, the discussions on the corresponding Rules, that was to say Rules 2 to 6, had terminated with a decision to deal later with the proposal by the Delegation of the United Kingdom on Rule 2, contained in document PLT/DC/57.

516.4 He further noted that discussions on Article 8 had begun the preceding day and that the proposals by the Delegation of Lebanon, contained in document PLT/DC/47, of the Delegation of Switzerland, contained in document PLT/DC/56, and of the Delegation of Japan, contained in document PLT/DC/18, on that Article, were still under discussion.

516.5 He invited the Delegation of Lebanon to explain its proposal in document PLT/DC/47.

517. Mr. HATOUM (Lebanon) introduced the proposal of his Delegation contained in document PLT/DC/47. He explained that the main effect of the amendment would be to make the filing of the claim or claims an essential element for obtaining a filing date under paragraph (1) of Article 8, which would have to be required by each Contracting Party before according a filing date. He then explained the various other features of the proposal of his Delegation.

518. The CHAIRMAN asked whether there was a Delegation that supported the proposal by the Delegation of Lebanon.

519. Mr. KESOWO (Indonesia) stated that his Delegation supported the proposal of the Delegation of Lebanon in document PLT/DC/47. The support related, in particular, to the proposed modification to paragraph (1) of Article 8 whereby the filing of a claim or claims would be a mandatory requirement before a filing date could be given. His Delegation would make comments on the other features of the proposal of the Delegation of Lebanon later in the debate.

Article 8(1): [Absolute Requirements]

520. The CHAIRMAN proposed that discussion be limited to paragraph (1) of Article 8.

521. Mr. KAMEL (Egypt) expressed the support of his Delegation for the proposal of the Delegation of Lebanon. He added that, in respect of paragraph 1(iii) of the text of Article 8 in the basic proposal, his Delegation would also prefer that the words "part which, on the face of it, appears to be a description of an invention" be replaced by a reference to the "total description."

522. The CHAIRMAN pointed out that the wording of subparagraph (1)(iii) of the basic proposal was taken word for word from the Patent Cooperation Treaty (PCT). He added that the formulation took into account the fact that the examination carried out by an Office on receipt of the application was a formal examination and not a substantive one.

523. Mr. KHRIESAT (Jordan) expressed the support of his Delegation for the proposal of the Delegation of Lebanon.

524. Mr. SEGURA (Argentina) stated that his Delegation supported the proposal of the Delegation of Lebanon and agreed with the Delegation of Indonesia that the claims were an essential requirement before according a filing date.

525. Mr. ROMERO (Chile) supported the proposal of the Delegation of Lebanon, stating that the filing of a claim or claims should be a mandatory requirement before a filing date is granted.

526. Mr. GARIEPY (Canada) recalled that the requirements for a filing date had been discussed many times in the Committee of Experts. He pointed out that it was important that the claims were contained in an application when the application was examined, but that the claims were not significant for establishing a filing date. Rather, what was important in the establishment of a filing date was a disclosure and the claims were not essential in that regard. In order to establish a patent system which was user-friendly, it was important not to insist on requiring all Contracting Parties to withhold the filing date until the claims were lodged.

527. Mr. SAPALO (Philippines) expressed the support of his Delegation for the proposal made by the Delegation of Lebanon, emphasizing the importance of claims for the establishment of a filing date.

528.1 Mr. SUGDEN (United Kingdom) stated that his Delegation opposed the proposal made by the Delegation of Lebanon. He pointed out that his country had operated a system for many years in which claims had not been required for the establishment of a filing date and that there had been no difficulties whatsoever in the operation of that system. In particular, it had proven to be of the utmost importance in assisting small inventors and enterprises that were not very familiar with the patent system and who required a filing date to be established at this early stage.

528.2 He said that there were two safeguards that needed to be established where the claims were not required to be submitted in order to obtain a filing date. The first was the right of third parties to know the definition of an invention for which protection was sought. That could only be known, however, when the application was published, that is, 18 months after the filing or priority date, and the claims only needed therefore to have been submitted in time for such publication. The second safeguard was that claims submitted after the filing date should not extend the disclosure made to obtain a filing date. Both of those safeguards were foreseen in the provisions of the draft Treaty and, with them, his Delegation could see no reason why the submission of claims should be considered an essential element for obtaining a filing date.

529. Mr. SHACHTER (Israel) said that he wished to add the voice of his Delegation to the case so eloquently expressed by the Delegation of the United Kingdom. It seemed to his Delegation that the requirement that claims be submitted before a filing date was accorded would prejudice the interests of the very persons that developing countries would wish to protect. It must be left open for small inventors to act without professional advice because it was often important for such inventors to have a disclosure on file as soon as possible in order to avoid damaging their interests through an unprotected disclosure.

530. Mr. LOSSIUS (Norway) expressed the agreement of his Delegation with the Delegations of the United Kingdom and of Israel. He considered that the proposal of the Delegation of Lebanon would place an unnecessary extra burden on inventors.

531. Mr. MILLS (Ghana) expressed the support of his Delegation for the proposal of the Delegation of Lebanon.

532. Mr. MBUYU (Zaire) explained that his country did not carry out substantive examination of patent applications and, consequently, it was most important to have claims with the application in order to obtain all the necessary information on the invention. His Delegation supported the proposal by the Delegation of the Netherlands.

533. Mr. BOGSCH (Director General of WIPO) stated that, before discussion progressed any further, he wished to make certain clarifications concerning the basic proposal. The basic proposal did not prevent any country from requiring that claims be submitted before a filing date was accorded. It might therefore be considered that it was a matter of indifference to those countries that might wish to require the lodging of claims for a filing date that other countries would be satisfied with less onerous requirements. The issue was thus whether those countries which required claims before a filing date was given, which would have the right to maintain that requirement, also wanted to prevent others from not doing so.

534. Mr. SCHAEFERS (Germany) stated that the remarks he was going to make had been in part preempted by the statement of the Director General, with which his Delegation agreed entirely. He also stated that his Delegation would not like to see called into question a substantial element of the basic proposal that had been developed over many years in the Committee of Experts. Furthermore, it did not make any sense to require claims for establishing a filing date. It seemed to be a concern of the developing countries to require claims because they saw their own situation as predominantly that of receivers of patent applications. Their concern was, however, already accommodated in paragraph (2) of draft Article 8, which allowed countries to require claims for the filing date. In addition, if inventors and enterprises in their own countries were to seek protection, they would be disadvantaged because the drafting of claims was a very burdensome and difficult task.

535. Mr. KIRK (United States of America) expressed the support of his Delegation for the basic proposal. He emphasized that his Delegation was very much opposed to a requirement of claims for a filing date that would be mandatory for all countries to apply. If the ultimate conclusion was that some countries should be allowed to require claims as one of the elements for a filing date, his Delegation would urge very strongly that it not be a mandatory requirement.

536. Mr. UEMURA (Japan) stated that his Delegation had some sympathy with the proposal of the Delegation of Lebanon, since claims were presently required in Japan for establishing a filing date. However, as a result of the long discussions that had occurred in the Committee of Experts, his Delegation had reviewed its position and had reached the conclusion that claims should not be an absolute requirement for obtaining a filing date. His Delegation had been convinced by the argument that it was in the interests of small inventors and enterprises that were not familiar with the patent system not to require claims for a filing date.

537. Mr. MESSERLI (Switzerland) stated that his Delegation was opposed to the proposal by the Delegation of Lebanon for the reasons already advanced by other delegations, particularly that of the United Kingdom. He pointed out that discussion only concerned the filing date. It was obvious that claims were required for examination and for the grant of a patent, but those requirements could in no case comprise the need to submit the claims when filing the application.

538. Mrs. DIVOY (France) expressed the support of her Delegation for the basic proposal, which represented the most flexible solution and enabled any country to require claims on filing of the application and at the same time leaving other countries the possibility of not requiring them. She also pointed out that a more or less formal claim would suffice to satisfy the requirement of claims since the claims could be amended and, therefore, such a requirement would have no point.

539. Mr. TALUKDAR (Bangladesh) expressed the support of his Delegation for the proposal of the Delegation of Lebanon. He stated that the requirement of claims for a filing date was an important means of discouraging crowding in the Office through the filing of applications that had not been sufficiently thought out. The requirement was, thus, a means of ensuring the seriousness of applications.

540. Mrs. ØSTERBORG (Denmark) expressed the support of her Delegation for the basic proposal. She considered that paragraphs (1) and (2) of the text of Article 8 in the basic proposal left sufficient flexibility to accommodate the interests of all parties. She also referred to the experience of almost 100 years of the Office of her country. Eighty-six per cent of the applications received by that Office came from abroad. Those applications emanating from abroad always claimed the priority of an earlier foreign application and, in consequence, contained claims without a specific requirement to that effect for granting a filing date in the national legislation. The remaining 14% of applications were filed by nationals and domestic enterprises. Of those, one half of them, representing 7% of all applications, were filed by nationals using professional assistance. In those cases also, the applications contained claims. The remaining category, consisting of 7% of all applications, comprised applications filed by individuals or enterprises who were certainly to be considered as serious, but who did not have professional assistance. Their applications were the ones which sometimes were filed without claims and whose applicants constituted precisely the sort of person that her Delegation considered ought to be protected from the unduly onerous burden that would be imposed if the proposal of the Delegation of Lebanon were adopted.

541.1 Mr. BOGSCH (Director General of WIPO) recalled that of course it was the case that every country in the world only granted a patent on an application which contained claims. The basic proposal did not affect that requirement. Indeed, it reaffirmed it in Article 4(1). The meeting was not, however, in the process of discussing the conditions that an application must satisfy before a patent was granted, but was discussing the conditions that had to be satisfied before a filing date was established. Those conditions for a filing date were in themselves of great significance because, in a first-to-file system, the filing date determined the priority of an application.

541.2 He emphasized that, if a country were concerned to ensure that the absence of a requirement of claims for a filing date would lead to crowding of the Office, it could, under paragraph (2) of Article 8 in the basic proposal, choose to require claims for the filing date.

542. Mr. BAKER (Australia) expressed the agreement of his Delegation with the basic proposal for the reasons that had been outlined by the Delegations of the United Kingdom and Germany, as well as by the Director General.

543. Mr. SALIM (Syria) expressed the support of his Delegation for the proposal of the Delegation of Lebanon, stating that a requirement of claims for the filing date was a fair one.

544. Mr. KNITTEL (Austria) stated that his Delegation supported the text of the basic proposal, which was more flexible than the proposal put forward by the Delegation of Lebanon and which was in the interests of small companies and applicants that were not familiar with the patent system.

545. Mr. WIERZBICKI (New Zealand) stated that his Delegation was strongly in favor of the text of the basic proposal, particularly for the reasons that had been given by the Delegation of Denmark. A requirement to make the presence of claims mandatory for a filing date disadvantaged small local inventors compared to large foreign applicants.

546. Mr. ALLELA (Kenya) stated that he had listened carefully to the debate and that his Delegation was convinced that the text of the basic proposal would ensure that more benefits would accrue to local inventors. His Delegation supported the basic proposal as being a flexible solution.

547. Mr. SCHATZ (EPO) pointed out that the meeting was not discussing the need to have claims in the application or not, that issue was in fact covered by draft Article 4(1). He had difficulty understanding why certain countries were opposed to other countries not requiring claims by the filing date and wondered whether there was not a misunderstanding as to the effect of the basic proposal.

548. Mr. JILANI (Tunisia) stated that his Delegation was still convinced that claims were a necessary element for a filing date and the vital one for all concerned.

549. Mr. AGOUH (Central African Republic) said that his Delegation supported unreservedly the proposal by the Delegation of Lebanon, which appeared clear and simple.

550. Mr. ENÇ (Turkey) said that his Delegation approved the wording of the basic proposal for the reasons given by the Director General.

551. Mr. WARR (Malta) stated that his Delegation supported the text of the basic proposal for the reasons outlined by the Director General.

552. Mrs. DE CUYPERE (Belgium) supported the basic proposal which offered the most flexible solution because it would permit national legislation making the filing of claims a condition for maintaining the filing date.

553. Mr. BULGAR (Romania) said that his Delegation supported the basic proposal on the grounds given by the Director General.

554. Mr. MANTERE (Finland) expressed the support of his Delegation for the text of the basic proposal.

555. Mr. QIAO (China) stated that his Delegation supported the text of the basic proposal.

556. Mr. JAKL (Czechoslovakia) stated that his Delegation agreed entirely with the Director General that claims were an essential requirement for the grant of a patent but that, for the filing date, only the disclosure was necessary.

557. Ms. LACHOWICZ (Poland) expressed the support of her Delegation of the text in the basic proposal.

558. Mr. IONNANTUONO (Italy) said that his Delegation approved the basic proposal, the text of which gave sufficient flexibility to satisfy all types of enterprises, particularly the small ones.

559. Mrs. PURI (India) stated that her Delegation had been satisfied with the basic proposal but that, after listening to the discussions, believed that it was useful to have the claims as a requirement of paragraph (1). Her Delegation believed that the harmonization of procedures should aim at simplicity and should make the patent system easier for users, but it should not impose onerous duties on the Patent Office. In that respect, her Delegation agreed with the Delegation of Bangladesh that the requirement of claims for a filing date would reduce the number of applications filed without serious intent. It had been argued that at best this could be an optional provision but in the interest of harmonization and so that inventors in any country are not put at a disadvantage vis-a-vis inventors in countries where there are no such requirements.

560. Mr. IVÁNYI (Hungary) expressed the support of his Delegation for the text of the basic proposal.

561. Mr. HADJ-SADOK (Algeria) stated that the text of the proposal satisfied his Delegation. It would seem to him that the proposal by the Delegation of Lebanon would penalise the small and medium sized enterprises in the developing countries. He observed that 90% of applications for patents in his country came from outside and that the applicants concerned were perfectly aware of all requirements under the patent law.

562. Mr. ABDALLA (Sudan) stated that, after following the discussions, his Delegation was convinced that the proposal of the Delegation of Lebanon constituted an improvement over the text of the basic proposal.

563. Mr. KIM (Republic of Korea) expressed the support of his Delegation for the text of the basic proposal for the reasons given by the Director General.

564. Mr. MOTA MAIA (Portugal) supported the text of the basic proposal.

565. Mr. CHISUM (AIPLA) stated that his Organization wished to express its support for the basic proposal. He pointed that a mandatory requirement of claims for a filing date could be satisfied in a formal manner by, for example, a claim which merely claimed the invention described in the disclosure. The requirement would thus merely constitute a trap for small inventors who did not have great familiarity with the patent system.

566. Mr. PETERSON (CIPA, CNIPA and EPI) stated that the Organizations that he represented were in favour of the text of the basic proposal. A mandatory requirement of claims for a filing date would have the effect of discouraging local inventors from filing, particularly in developing countries. He considered the proposal of the Delegation of Lebanon to be less flexible, less user-friendly and less welcome than the text of the basic proposal.

567. Mr. PAGENBERG (AIPPI and MPI) expressed the support of the Organizations that he represented for the text of the basic proposal. He pointed out that foreign applicants usually claimed priority and, in consequence, filed applications with claims, so that those who would be disadvantaged by a mandatory requirement of claims for a filing date would be the local inventors, especially the small inventors who acted without legal advice.

568. Mr. HIJMANS (APA) stated that his Organization was in favor of the text of the basic proposal which was not only user-friendly, but also an essential part of a balanced package that certain interests in the United States of America were seeking in return for the adoption of the first-to-file system.

569. Mr. TALUKDAR (Bangladesh) said that he wished to point out, for the purpose of clarification, that his previous statement should not be construed as being against the interests of small inventors, whether those were located in developing countries or in industrialized countries. Rather, his support for the requirement of claims for a filing date was to be seen as operating in favor of serious applicants.

570. Mr. ORANGE (FICPI) stated that his Organization represented practitioners who frequently acted on behalf of small businesses. In the experience of his Organization, there were many situations in which there was a need to obtain a filing date urgently. Any person who was represented by a professional would be able to meet the requirement of claims. However, persons not so represented would be penalized by a requirement of claims for a filing date.

571.1 The CHAIRMAN noted that views were very divided. He noted also that there was very broad support for the text of the basic proposal, which was the text that had emerged from the discussions in the Committee of Experts, that had gone on for a number of years.

571.2 He suggested that the period between the two parts of the Diplomatic Conference should be put to use to reexamine the positions of the Delegations.

571.3 He observed that the wording of the basic proposal would permit any country so wishing to require claims on filing of the application and he wondered whether that text should not be reexamined in order to understand more clearly that such action was permitted.

571.4 He expressed his personal view, based on forty years of experience, that what was important was not to have the claims quickly, but to have claims that were the result of ripe reflection.

Article 8(3): [Drawings]

572. The CHAIRMAN then invited Delegations to examine paragraph (3) of Article 8 on how to treat drawings. He announced that there was a proposal for amendment by the Delegation of Japan, contained in document PLT/DC/18. He gave the floor to the Delegation of Japan for it to present its proposal.

573. Mr. UEMURA (Japan) stated that paragraph (3) did not specify any time limit within which the applicant should make the choice provided therein. That silence was a cause of concern to his Delegation because it would give rise to legal insecurity. That is, if the filing date was not to be chosen definitely before the publication of the application, then the filing date might be shifted to a different date in such a manner that the application would lose its novelty owing to its own publication. It was undesirable, and could be even dangerous to the applicant himself, to allow him to choose the filing date after the publication. In order to meet those concerns, his Delegation proposed to supplement paragraph (3) with an additional sentence providing that any Contracting Party could require that the option be exercised within a period of sixteen months after the filing date or, where priority was claimed, the priority date.

574. The CHAIRMAN recalled the content of paragraph (3) of Article 8 and underlined that it did not provide for a time limit. In his view such a silence meant that the national legislation of each Contracting Party could fix the time limit within which the option should be exercised.

575. Mr. SHACHTER (Israel) supported the proposal by the Delegation of Japan. In doing so, he underlined the importance of establishing a time limit within which the choice would have to be made.

576. Mr. SUGDEN (United Kingdom) expressed the sympathy of his Delegation for the proposal of the Delegation of Japan. However, he stated that the provision in the basic proposal was more satisfactory since it referred the question to the national legislation of each Contracting Party. In addition, a period of sixteen months, as proposed by the Delegation of Japan, was considered too long.

577. Mr. BOGSCH (Director General of WIPO) suggested that the idea contained in the proposal of the Delegation of Japan could be reflected in a rule which would state that the Office concerned would have to invite the applicant to send the drawings within a reasonable period of time, which period would be defined by the Office.

578. Mr. UEMURA (Japan) stated that the suggestion by the Director General may impose a burden on Offices since it would require them to send invitations.

579. Mr. BOGSCH (Director General of WIPO), in response to the statement of the preceding speaker, stated that such a burden would be a light one since most of the applicants would realize that their drawings had not been sent and they would proceed to send such drawings on their own initiative.

580. Mr. GARIEPY (Canada) expressed the sympathy of his Delegation with the purpose of the proposal of the Delegation of Japan. However, his Delegation preferred the text of the basic proposal since it referred the matter to the national legislation of each Contracting Party.

581. Mr. SCHATZ (EPO) expressed the support of his Delegation for the suggestion of the Director General to refer the matter to Rule 7. In accordance with that Rule the Office had to invite the applicant to comply with certain requirements and he saw no reason why that obligation could not be broadened to include the situation raised by the Delegation of Japan.
582. Mr. BOGSCH (Director General of WIPO) stated that in the light of the debate he had reached the conclusion that it was necessary to provide for a time limit in the rules and that this matter should not be left to the national legislation of the Contracting Parties.
583. Mr. SUGDEN (United Kingdom) supported the suggestion of the Director General which was fully consistent with the practice of the Office of his country where invitations were sent in this kind of situation.
584. Mr. SCHAEFERS (Germany) expressed the support of his Delegation for the suggestion of the Director General.
585. The CHAIRMAN concluded that the suggestion of the Director General had received broad support and asked the International Bureau to draft a provision to be included in Rule 7 along the lines of that suggestion. He then invited the Committee to consider the proposal by the Delegation of Lebanon set forth in paragraph (3) of document PLT/DC/47.
586. Mr. HATOUM (Lebanon) stated that his Delegation proposed that subparagraph (b) of paragraph (2) be amended so as to provide that a Contracting Party might not impose one of the permitted additional requirements if it concluded and ratified a Treaty prior to the entry into force of the Treaty.
587. Mr. BOGSCH (Director General of WIPO) suggested considering the proposal by the Delegation of Lebanon after the text of paragraph (1) was known.
588. Mr. HATOUM (Lebanon) accepted the suggestion of the Director General.
589. The CHAIRMAN announced a meeting of the Steering Committee and adjourned the meeting.

Seventh Meeting
Tuesday, June 11, 1991
Afternoon

Article 8: Filing Date (continued)

590. The CHAIRMAN, opened the meeting and announced, on behalf of the President of the Conference, that, in accordance with the discussion that had taken place in the Steering Committee, the Regional Groups would meet. He

then invited Main Committee I to resume its consideration of Article 8 and in particular the proposal of the Delegation of Switzerland contained in document PLT/DC/56.

591.1 Mr. MESSERLI (Switzerland) explained that the proposal by his Delegation had two main aims, that was to say to regulate--within the Article itself and not in the Rule--the implications for the application and for its filing date in either the event of the applicant complying with the conditions or in the event that he did not do so. That transfer from the Rule to the Article had been effected by adding a new paragraph (6) to the Article. The reason for that transfer was that a matter of such importance warranted regulation at Treaty level. The proposal by his Delegation in no way changed the substance of the basic proposal. He emphasised that, where the applicant did not comply with the conditions within the prescribed time limit, he did not know what other consequence could be envisaged apart from the consequence that had been set out--that was to say that the application would be treated as if it had not been filed.

591.2 The second aim was to simplify the system of time limits prescribed in the basic proposal, particularly with respect to the additional requirements in paragraph (2), the reference in paragraph (4) and translation into an official language in paragraph (5). In those cases, Article 8 envisaged a two-step system of time limits: there was a first time limit of at least two months then, if that time limit was not complied with, a second limit that would be triggered by an invitation. He held that system to be too complicated.

591.3 He explained that the corrections and deletions in the text were numerous and served exclusively to achieve those two aims without in any way changing the substance of the basic proposal. Consequently, the compromise achieved after several years of discussion was not affected by the proposal made by his Delegation. He then gave some examples for applying the proposal by his Delegation:

- an application filed without description: the Office would invite, without delay, the applicant to furnish a description within a period of at least one month. If the applicant complied, the filing date would be that of receipt of the description or of handing to the official postal services.

- an application filed without claims in a State in which the filing date depended on the submission of the claims: the Office would invite, without delay, the applicant to furnish the claims within a period of at least one month. If the applicant complied, the filing date would be that of the application filed without the claims.

- an application with a reference to the description contained in another application filed abroad (priority application): the Office would invite, without delay, the applicant to furnish that description within a period of one month at least, where necessary in the official language, and to furnish a copy of the earlier application. If the applicant complied, the filing date would be that of submission of the application containing the reference.

- a final example: an application containing a description in a foreign (non-official) language. Where the State concerned required a

translation, the Office would invite, without delay, the applicant to furnish the translation within a period of one month at least. If the applicant complied, the filing date would be that of receipt of the application containing the description in the foreign language.

592. The CHAIRMAN invited the Committee to concentrate its attention on the two elements of the Swiss proposal, namely, the transfer of the text of the provision contained in Rule 7(3) to the text of Article 6 as a new paragraph (6), and the unification of the system of time limits provided for in Article 6. He added that later the Committee could consider the whole text of Article 8 embodied in the basic proposal.

593. Mr. SUGDEN (United Kingdom) confirmed the support of his Delegation for the proposal of the Delegation of Switzerland. He underlined the importance of establishing a simplified time limit system.

594. Mr. ORTEGA LECHUGA (Spain) stated that both the basic proposal and the proposal of the Delegation of Switzerland provided for options for the Contracting Parties, but once that option was exercised by a Contracting Party, its consequences were specified in mandatory terms. He wondered whether it would be possible to draft the consequences of the decision to exercise an option in facultative terms rather than mandatory. He mentioned, for instance, the requirement of translation to official languages and asked whether it would be possible to leave to the Contracting Parties the faculty of defining the filing date of the application.

595. The CHAIRMAN, in response to the preceding speaker, stated that the options established in Article 8 were referred to national legislation. Once those options were decided on, each Contracting Party was under the obligation to apply them on the conditions and within the time limit established in the Treaty.

596. Mr. ORTEGA LECHUGA (Spain) stated that, if a translation was required by a Contracting Party, in exercising the option established in paragraph (5), it would be only natural to allow that Contracting Party to determine the filing date of the application. If the requirement of the translation was optional he saw no reason not to allow that Contracting Party to establish the date of the filing of the application. He added that it was necessary for an Office to understand the application so as to consider it properly.

597. The CHAIRMAN stated that, since the concern of the Delegation of Spain concerned both the basic proposal and the proposal of Switzerland, it could be considered at a later stage. He invited the Committee to continue the consideration of the proposal of the Delegation of Switzerland.

598. Mr. SALIM (Syria) expressed the support of his Delegation for the proposal of the Delegation of Switzerland. He requested clarification concerning the starting point of the specified period to provide the translations referred to in paragraph (5)(b) or to fulfil the requirements provided for in paragraphs (1) and (2). He asked whether there was a time limit within which the Office had to send the invitation referred to in paragraph (6) of the proposal of the Delegation of Switzerland.

599. Mr. MESSERLI (Switzerland), in response to the preceding statement, stated that the time limit to provide the translation was at least one month

from the date of the invitation. The Office had to send the invitation promptly. There was no time limit specified in the text of the proposal of his Delegation since that period would depend on the circumstances. In any case the Office could not wait too long and furthermore it should send the invitation as soon as the Office concerned was aware of the existence of a case of non-compliance with the requirements.

600. Mr. BOGSCH (Director General of WIPO) asked what would happen, under the proposal of the Delegation of Switzerland, if the Office did not send the invitation, in particular, whether there would be sanctions in such case.

601. Mr. MESSERLI (Switzerland) stated that the proposal of his Delegation did not envisage sanctions.

602. Mr. BOGSCH (Director General of WIPO) suggested deleting the word "promptly" from paragraph (6) of the proposal of the Delegation of Switzerland. An omission could be discovered by an examiner and of course that would normally take place some time after the filing of the application.

603. Mr. SCHAEFERS (Germany) supported the simplified and unified time limit system proposed by the Delegation of Switzerland. It was simpler than the approach set forth in the basic proposal. He also supported the transfer of Rule 7(3) to the text of Article 8 in the form of the new paragraph (6).

604. Mr. KIRK (United States of America) stated that his Delegation could provisionally accept the proposal of the Delegation of Switzerland in respect of time limits as well as in respect of the transfer of paragraph (3) of Rule 7. However, he stated that his Delegation had some hesitations on the time limit applicable to the translation provided for in paragraph (5)(b), simply because the translation might take more than one month, particularly in respect of certain languages. He suggested a time limit of two months.

605. Mr. SCHATZ (EPO), expressed the full support of his Delegation for the proposal of the Delegation of Switzerland which was clear, simple and easy to understand.

606. Mr. UEMURA (Japan) stated that his Delegation could support the general approach in the basic proposal. Although in his view the proposal by the Delegation of Switzerland was an improvement of the basic proposal, he expressed the concern of his Delegation in respect of the requirement of translation to official languages.

607. Mr. BESPALOV (Soviet Union) expressed the support of his Delegation for the proposal of the Delegation of Switzerland.

608. Mr. TALUKDAR (Bangladesh) stated that in his view Article 8 specified the filing date but prescribed submission of requirements by instalment and asked what was gained by that kind of prescription. With respect to cases of applications by reference, he requested clarification as to the difficulties, if any, for the applicant to furnish certified copies of the referred application. He then asked why it was not possible to request the applicant to furnish, as part of the application, a translation of it into the official language in cases where that application was in a different language.

609. The CHAIRMAN, in responding to the preceding speaker, recalled that discussions at the Committee of Experts had shown that it was often the case that a certain time was necessary to obtain a certified copy of the application.

610. Mr. BOGSCH (Director General of WIPO), in response to the statement of the Delegation of Bangladesh, recalled that, as a matter of practice, applicants were under time constraint.

611.1 The CHAIRMAN concluded that there was broad support for the proposal of the Delegation of Switzerland and that it should be considered as the basis for further discussion on the relevant paragraphs of Article 8.

611.2 He then invited the Committee to consider paragraphs 5 and 6 of the proposal by the Delegation of Lebanon, reproduced in document PLT/DC/47. He added that the proposals of the Delegation of Lebanon and Switzerland were to a certain extent parallel and that he saw no inconsistency in the legal consequences of both proposals.

612. Mr. MESSERLI (Switzerland) confirmed that the consequences of the proposal by the Delegation of Lebanon were consistent with those of the proposal of his Delegation.

613. Mr. HATOUM (Lebanon) recalled that in respect of paragraph (4) of Article 8 his Delegation's proposal envisaged Alternative A. The proposal of his Delegation also envisaged the insertion of a new paragraph (6) according to which Contracting Parties would be entitled to fix a specific time limit for the payment of fees. If the applicant did not comply with such a time limit his application would be cancelled. However, if the fees were received within the prescribed periods, or periods of grace fixed by the Contracting Party, the filing date of the application would be the date of receipt by the Office of the elements referred to in paragraph (1) of Article 8.

614. The CHAIRMAN invited the Committee to discuss the proposal of the Delegation of Lebanon.

615. Since no delegation wished to take the floor, he invited the Committee to consider the rest of Article 8 as envisaged in the basic proposal. In respect of paragraphs (1) and (2) of Article 8, he recalled that the Committee had already had a detailed discussion on them.

616. Mr. JILANI (Tunisia) stated that, in keeping with the practice of diplomatic conferences, it might be advisable for the sponsors of the proposals contained in document PLT/DC/47 and document PLT/DC/56 to hold consultations among themselves with a view to reaching a compromise text.

Article 8 (3): [Drawings]

617.1 The CHAIRMAN stated that in his view Main Committee I should proceed to examine the basic proposal. He then invited the Committee to make any further observations on paragraph (3). He recalled that discussions on this matter had already taken place on that paragraph in connection with the proposal of the Delegation of Japan. There being no observations, he declared that paragraph (3) of the basic proposal would serve as the basis for further discussion.

Article 8(4): [Replacing Description, Claims and Drawings by Reference to Another Application]

617.2 He then invited the Committee to examine paragraph (4) of Article 8.

618. Mr. KIRK (United States of America) stated that his Delegation supported Alternative A in respect of paragraph (4).

619. Mr. SCHAEFERS (Germany) expressed the support of his Delegation for Alternative B.

620. Mr. SALIM (Syria) expressed the support of his Delegation for Alternative A and suggested that the Delegations of Lebanon and Switzerland should consult each other in order to consider the proposal containing paragraph (5) of document PLT/DC/47.

621. Mr. TALUKDAR (Bangladesh) expressed the support of his Delegation for Alternative B which kept the necessary flexibility. He also suggested that in the last sentence of paragraph (4) the words "was received by the Office" should be changed for "are furnished to the Office."

622. The CHAIRMAN reminded the preceding speaker of the existence of a provision, in Rule 7, concerning the date of the reception by the Office of documents which are due under Article 8.

623. Mr. GARIEPY (Canada) stated the support of his Delegation for Alternative A.

624. Ms. BESAROVIC (Yugoslavia) expressed the support of her Delegation for Alternative B. She mentioned that the internal legislation of her country did not provide for what was required by Alternative A.

625. Mr. SMITH (Australia) expressed the support of his Delegation for Alternative A.

626. Mr. KNITTEL (Austria) expressed the support of his Delegation for Alternative B. In his view, there was no need for a mandatory rule.

627. Mr. JILANI (Tunisia) expressed the support of his Delegation for Alternative A, which he considered to be in harmony with paragraph (2) of Article 8.

628. Mr. BESPALOV (Soviet Union) expressed the support of his Delegation for Alternative B.

629. Mr. JAKL (Czechoslovakia) expressed the support of his Delegation for Alternative B.

630. Ms. LACHOWICZ (Poland) expressed the support of her Delegation for Alternative B because it envisaged an optional system.

631. Mr. KHUMALO (Swaziland) expressed the support of his Delegation for Alternative B since it was more flexible.

632. Mr. BOGSCH (Director General of WIPO) drew the attention of the Committee to the fact that the alternatives under discussion could be examined not only from the viewpoint of the interest of the offices but also of the interest of the applicants.

633. Mr. ABDALLA (Sudan) expressed the support of his Delegation for Alternative B since it was more flexible.

634. Mr. MBUYU (Zaire) expressed the support of his Delegation for Alternative B.

635. Mr. UEMURA (Japan) expressed the preference of his Delegation for Alternative B. He was, nonetheless, aware that the system of application by reference was not of much significance to applicants because the applicant can easily file an application with a copy of specification or the drawings to be cited instead of filing an application by referring to the previously filed application and it was much simpler than the applicant asking the office to issue a certified copy and submitting the same to other offices. That requirement imposed a burden on both Offices and third parties since they would have to examine such a certified copy for its identity with the application as filed. It was for those reasons that his Delegation preferred the optional system envisaged in Alternative B.

636. Mr. SEGURA (Argentina) expressed the support of his Delegation for Alternative B. He added that the national legislation of his country was not consistent with Alternative A.

637. Mr. BULGAR (Romania) expressed the support of his Delegation for Alternative B.

638. Mr. VAN DER EIJK (Netherlands) expressed the support of his Delegation for Alternative B.

639. Mr. HADJ-SADOK (Algeria) expressed the support of his Delegation for Alternative B.

640. Mr. GAO (China) expressed the support of his Delegation for Alternative B.

641. Mr. O'FARRELL (Ireland) expressed the support of his Delegation for Alternative B.

642. Mr. SHACHTER (Israel) stated that, in his view, Alternative A presupposed that the subsequently filed application was identical to the originally filed application. That presumption was not the case in many instances and, therefore, Alternative A would not really arise. For that reason his Delegation supported Alternative B.

643. Mr. HIEN (Burkina Faso) expressed the support of his country for Alternative B since it was more flexible.

644. Mr. MESSERLI (Switzerland) expressed the support of his Delegation for Alternative A.

645. Mr. KIM (Republic of Korea) expressed the support of his Delegation for Alternative B since it provided Contracting Parties with more flexibility.

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646. Mr. KAINAMURA (Uganda) expressed the support of his Delegation for Alternative B because he considered that that matter should be left to the national legislation of each Contracting Party.
647. Mr. VON ARNOLD (Sweden) expressed the support of his Delegation for Alternative A in the interest of harmonization.
648. Mr. KAMEL (Egypt) expressed the support of his Delegation for Alternative B because of its flexible nature.
649. Mrs. DE CUYPERE (Belgium) stated that her Delegation supported Alternative B for its flexibility.
650. Mr. ELHUNI (Libya) expressed the support of his Delegation for Alternative B since it was more flexible.
651. Mr. ABU BAKAR (Malaysia) stated the preference of his Delegation for Alternative B which could provide the necessary flexibility to Contracting Parties.
652. Mrs. ØSTERBORG (Denmark) stated the preference of her Delegation for Alternative A.
653. Mr. TIGBO (Cameroon) expressed the support of his Delegation for Alternative B because it was to the benefit of both offices and inventors.
654. Mr. BOBROVSZKY (Hungary) expressed the support of his Delegation for Alternative B, since it was more flexible.
655. Mr. ENÇ (Turkey) expressed the support of his Delegation for Alternative B since it was more flexible.
656. Mr. KESOWO (Indonesia) expressed the support of his Delegation for Alternative B.
657. Ms. RODRIGUES MITTELBAACH (Brazil) expressed the support of her Delegation for Alternative B since it was more flexible.
658. Mr. DIENG (Senegal) expressed the support of his Delegation for Alternative B.
659. Mr. LOSSIUS (Norway) expressed the support of his Delegation for Alternative A.
660. Mrs. MSOSA (Malawi) expressed the support of her Delegation for Alternative B.
661. Mr. LICARI (Malta) expressed the support of his Delegation for Alternative B.
662. Mr. KIM (Democratic People's Republic of Korea) expressed the support of his Delegation for Alternative B since it was more flexible.

663. Mr. KIRK (United States of America) noted that many delegations had expressed support for Alternative B. His Delegation was concerned with that preference since it deprived applicants of the guarantee to be able to file by reference. In the view of his Delegation it would be of great benefit for the applicants, as mentioned by the Director General, to provide for a system of filing by reference. He called on the delegations to reflect on that fact with a view to, eventually, reconsidering their position in the second part of the Diplomatic Conference. He expressed the reservation of his Delegation for many of the arguments that were mentioned in support of Alternative B.

664. Mr. NTAHOMVUKIYE (Burundi) expressed the support of his Delegation for Alternative B because of the reasons already stated by delegations that were of the same view. He added that the national legislation of his country was inconsistent with Alternative A.

665. Mr. IDDI (United Republic of Tanzania) expressed the support of his Delegation for Alternative B.

666. Mr. KUNKUTA (Zambia) expressed the support of his Delegation for Alternative A which was more consistent with the spirit of harmonization.

667. Mr. SHACHTER (Israel) requested clarification as to whether, under Alternative A, it would be possible to modify the subsequent application.

668. The CHAIRMAN stated that, in cases where an application was filed by reference to another application, the text of the latter had to be identical to the former application.

669. Mr. KIRK (United States of America) agreed with the interpretation of the Chairman in respect of cases where the applicant wished to benefit from the date of the original application.

670. Mr. SHACHTER (Israel) sought additional clarification as to whether in cases such as the one referred to by the Delegation of the United States of America it would be possible for the applicant to change the text of the application when filing.

671.1 Mr. BOGSCH (Director General of WIPO) observed that the applicant was never obliged to apply by reference. He would have, under Alternative A, the option to do that and he would have--subsequently--the same rights as any other applicant.

671.2 He noted that many delegations had mentioned flexibility as an argument supporting Alternative B. He recalled that the purpose of the Diplomatic Conference was to harmonize patent laws and that flexibility, in the present case, amounted to a negation of harmonization.

672. Mrs. DIVOY (France) said that her Delegation had carefully listened to the arguments in favor of the two Alternatives taking into account the fact that the aims of the Treaty, as pointed out by the Director General, were both to help applicants and to avoid too much flexibility. In view of the explanation given by the Chairman on the identity of applications, the Delegation of France was in favor of Alternative A. She added that that Alternative was not compatible with the current domestic law of her country.

673. Mrs. KRUDO SANES (Uruguay) expressed the support of her Delegation for Alternative B.

674. Mr. KHRIESAT (Jordan) expressed the support of his Delegation for Alternative B since it was more flexible.

675. Mr. SCHATZ (EPO) stated that flexibility was a merit if it was for the benefit of the applicant. However, if it was for the Contracting Parties, it merely indicated a necessity for compromise. Nevertheless, his Organization supported, for the time being, Alternative B.

676. Mr. ALLELA (Kenya) expressed the support of his Delegation for Alternative B.

677. Mrs. PURI (India) expressed the support of her Delegation for Alternative B, since it provided for more flexibility. She also stated that flexibility should be for the benefit of the Contracting Parties as well as of the applicant.

678. Mrs. NUORLAHTI-SOLARMO (Finland) expressed the support of her Delegation for Alternative A.

679. Mr. MILLS (Ghana) expressed the support of his Delegation for Alternative B.

680. Mr. BRUNET (ABA and NYPTC) stated that the Organizations he represented shared the views of the Director General and therefore supported harmonization rather than flexibility and favored Alternative A, since that Alternative took into account the needs of the applicants. He mentioned that the laws of the United States would have to be amended in order to accommodate the text of Alternative A.

681. Mr. SANTARELLI (AIPPI) expressed the disappointment of his Delegation with the result of the discussion. In his view it did not advance harmonization. His Organization favored Alternative A which was for the benefit of applicants.

682. Mr. CHISUM (AIPLA) expressed the support of his Organization for Alternative A for the reasons stated by the Director General. He also stated that Alternative B would promote diversity, rather than harmonization.

683. Mr. PAGENBERG (MPI) stated that his Organization had the same position as AIPPI.

684. Mr. EVERITT (FICPI) stated that, in the interest of practitioners, his Organization supported Alternative A. There was a problem of timing when filing applications in foreign countries. Alternative B did not solve that problem.

685. Mr. BETON (EPPIA) expressed the support of his Organization for Alternative A. He drew the attention of the Committee to the difficulties that could be encountered in obtaining necessary translations of an application in official languages.

686. Mr. PETERSEN (CIPA, CNIPA and EPI) stated that the Organizations he represented supported Alternative A. He added that, by adopting Alternative B, one of the easiest means of filing an application was removed from inventors.
687. Mr. WALLIN (IFIA) regretted that so many countries favored flexibility for the Office rather than for the benefit of the applicant. He mentioned the case of inventors who did not have full legal assistance. For them the possibility of filing by reference would significantly facilitate protection of their inventions. He called upon the delegations to reconsider the matter with a view to changing their positions in the second part of the Conference.
688. Mr. BLAKEMORE (UNICE) expressed the support of his Organization for Alternative A.
689. Mr. PARKES (UEPIP) expressed the support of his Organization for Alternative A, which he considered would advance harmonization. He drew the attention of the Committee to the practical advantages of Alternative A.
690. Mr. SUGDEN (United Kingdom) stated that his Delegation had some sympathy for Alternative A, as well as for the reasons that have been invoked in its favor. He, nevertheless, drew the attention of the Committee to the difficulties that that Alternative might entail for national offices. He suggested that a fee might be imposed for every application by reference to ensure that applicants only used this procedure in an emergency.
691. The CHAIRMAN noted that nothing in the Treaty prohibited imposing fees, including fees for applications by reference.
692. Mr. NYILIMBILIMA (Rwanda) expressed the support of his Delegation for Alternative A, which favored inventors as well as applicants.
693. Mr. SHACHTER (Israel) stated that, since it was clear to him that under Alternative A the applicant had the right to--and was not obliged to--file by reference, his Delegation reversed its position and supported Alternative A.
694. Mr. SCHAEFERS (Germany) stated that in view of the discussion his Delegation would reconsider its position of support for Alternative B.
695. Mr. BOGSCH (Director General of WIPO) recalled that Alternative B provided national Offices with some flexibility whereas Alternative A would benefit national applicants and inventors rather than national offices.
696. Mr. UEMURA (Japan) stated that, in his view, filing by reference did not have significant practical importance. It would be much simpler to send a copy of the application to the countries where protection was sought. Therefore, his Delegation continued to support Alternative B.
- 697.1 The CHAIRMAN stated that, while discussion had shown a strong support for Alternative B, it would be desirable to revert to the matter in the next part of the Diplomatic Conference.

Article 8(5): [Language]

697.2 The discussion on draft Article 8(4) having been completed, he turned to draft Article 8(5), noting that there were no proposals for the amendment of the basic proposal.

698.1 Mr. UEMURA (Japan) stated that his Delegation had difficulties with Article 8(5). He drew attention to the fact that the granting of a filing date brought with it important effects, notably the establishment of the prior-art effect of the application and the establishment of the right to claim priority. As a practical matter, however, the determination and examination of such effects would have to be made by relying on a translation. Acceptance by an Office of an application in a language other than the official language presented difficult problems in that regard.

698.2 He stated that a situation might arise in which the translated version of the application included matter that was not found in the original language version. That might exclude applications filed later by others.

698.3 He observed that there were many languages in the world which third parties would find difficult to check. They would, therefore, be placed at a disadvantage in invalidity or opposition proceedings.

699. The CHAIRMAN recalled that all states represented at the Conference which had also ratified the Patent Cooperation Treaty (PCT) were, more or less, confronted with a similar problem. A PCT application could be filed in a language which was not an official language in all countries. The application would be translated some time, either 20 or 30 months, later. It was the first-filed application, however, upon which the earlier rights were based.

700. Mr. UEMURA (Japan) noted that most, if not all, of the Delegations that had intervened had supported the basic proposal. He emphasized that his Government would give further consideration in a positive light to the provisions of draft Article 8(5) if it was the consensus of the Conference to include its provisions as part of a grand package including the first-to-file principle, an appropriate term of protection and publication at 18 months following the filing or priority date.

701. The CHAIRMAN stated that all participants were aware that paragraph (5) was an integral part of Article 8 and that it was an important part of the harmonization package.

702. Mr. TALUKDAR (Bangladesh) asked what time limit applied in respect of providing a translation.

703. The CHAIRMAN indicated that when the proposal made by the Delegation of Switzerland (PLT/DC/56) had been taken as the basis of discussion, one single time limit of at least one month, reckoned from the date of the invitation, was established. That time limit, therefore, applied with respect to the provision of translations. He indicated that some delegations preferred a longer time limit and stated that the provision, as drafted, would not prevent those delegations from establishing a longer time period (such as two months in the case of translations).

704. Mr. TALUKDAR (Bangladesh) asked whether the time limits that had been deleted from paragraph (5) would be re-instated.

705. Mr. MESSERLI (Switzerland) indicated that the time limits of new paragraph (6) would apply to translations.

706. Mr. BOGSCH (Director General WIPO) expressed sympathy for the difficulties experienced in understanding that the time limit established in draft Article 8(6) applied to all the provisions of draft Article 8. He suggested including a cross-reference to paragraph (6) in the other relevant paragraphs of draft Article 8.

707. Mr. RAFFNSØE (FICPI) stated that, as a practical matter, the time limit of at least one month provided in new paragraph (6) was too short. He stated that, in the case of an application filed in another country, an invitation would be sent to a local agent by the local office. That invitation would then be transmitted to the agent in the country of origin of the applicant, who would then seek instructions from his client and reverse the procedure upon receipt of those instructions. Such a procedure was time-consuming and, therefore, he asked that consideration be given to establishing a longer term in new paragraph (6).

708.1 Mr. SUGDEN (United Kingdom) considered the provisions of new paragraph (6) were addressed to emergency situations, where the applicant was not able to comply with all of the requirements for a complete application on the filing date. He indicated that his Delegation had moved with great difficulty to a situation in which it could accept the establishment of a filing date without a fee having been paid and without having an application filed in the official language.

708.2 He stated that formalities examination, search and publication all must be carried out within 18 months. Providing for an extension for filing all of the elements of an application would extend by six or seven weeks the time required to collect all of the necessary elements. Given those constraints, he stated that his Delegation would be willing to provide an extension of the time within which to file all the elements for an application on condition that applicants also helped by expediting the process as much as they could.

708.3 He indicated that the one month time period in the proposal by the Delegation of Switzerland properly balanced the emergency needs of the applicant and the needs of the Office and considered that this period should be set as a minimum by the rule. Nevertheless, if this period was adopted, he would be willing to discuss providing a longer period with the operational services of his Office and the interested circles in his country.

709. Mrs. PURI (India) referred to the prohibitory clause in new paragraph (7) and indicated that her concerns were the same as expressed in respect of similar clauses found in draft Articles 4 and 6.

710. Mr. PAGENBERG (AIPPI and MPI) supported the position taken by FICPI stating that the time limit of one month might be too short, especially in the case of filing applications in another country. He suggested providing for a general time limit of at least two months and indicated that, if such a general time limit was not adopted, then it should at least be adopted with respect to translations.

Rule 7(4): [Date of Receipt]

711. The CHAIRMAN then turned to a proposal by the Delegation of the Netherlands in respect of Rule 7(4) contained in document PLT/DC/16.

712.1 Mr. VAN DER EIJK (Netherlands) stated that the proposal of his Delegation was to make it clear that a Contracting Party would be free to determine the circumstances in which the receipt of a document by "an associated office" would be deemed to constitute receipt of the document by the Office concerned.

712.2 He stated that the proposal sought to take into consideration the special case of Aruba and the Netherlands Antilles which, while part of the Kingdom of the Netherlands, did not have a branch or sub-office of the Dutch Patent Office. The proposal was to allow the Netherlands to provide that the filing date of a patent application in the Patent Offices of Aruba or the Netherlands Antilles would also be valid for the Dutch Patent Office.

713. The CHAIRMAN, observing that there were no objections, declared that the proposal of the Delegation of the Netherlands in document PLT/DC/16 was accepted as the basis for further discussion. He then turned to the proposal of the Delegation of Switzerland, contained in document PLT/DC/56, in respect of paragraph (5) "[Correction of Translations]" of Rule 7, which the proposal sought to re-number as paragraph (3) of Rule 7.

Rule 7(5): [Correction of Translations]

714. Mr. MESSERLI (Switzerland) stated that the proposal introduced only a minor change which, by adding the words "at least," made the provision a minimum one so as to allow Contracting Parties to be more flexible and allow corrections to translations at a time after the application is in order for grant.

715. Mr. UEMURA (Japan) stated that the comments that his Delegation had made with respect to draft Article 8(5) also applied to proposed new paragraph (3) of Rule 7 in the proposal of the Delegation of Switzerland, as well as to paragraph (5) of Rule 7 in the basic proposal.

716. Mr. SUGDEN (United Kingdom) supported the proposal of the Delegation of Switzerland in respect of proposed new paragraph (3) of draft Rule 7 on the assumption that Contracting Parties that allowed corrections to translations at a late stage, including up to the date of grant, would protect the interests of third parties who relied on the application as published.

717. Mr. KIRK (United States of America) accepted the proposal by the Delegation of Switzerland, noting that the provisions of proposed new paragraph (3) of Rule 7 would not detract from the rights provided for in Article 17. Specifically, he referred to Note 17.01 of document PLT/DC/4 which stated, in respect of correcting "obvious mistakes" or "clerical errors," that "they are understood to encompass defects in translations." He observed that there was therefore no limit to when the corrections to translations could be made. They could be made up to the grant of a patent by virtue of proposed new paragraph (3) of draft Rule 7 and after the grant of a patent by virtue of Article 17.

718.1 The CHAIRMAN concluded that the proposal of the Delegation of Switzerland in respect of proposed new paragraph (3) of draft Rule 7, as contained in document PLT/DC/56, had been accepted as the basis for further discussion.

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Morning

718.2 The CHAIRMAN opened the meeting and declared that discussion on draft Article 8 and draft Rule 7 had been concluded the previous day. He then proposed returning to draft Article 3 and draft Rule 2 to consider several points that had been reserved for discussion.

Article 3: Disclosure and Description

718.3 There being no objections, he turned to a consideration of the proposal by the Delegation of Lebanon in document PLT/DC/45 on draft Article 3(1)(a), the proposal by the Delegation of Germany in document PLT/DC/58 on draft Article 3(1)(b) and the proposal by the Delegation of the United Kingdom in document PLT/DC/57 on draft Rule 2(2).

718.4 He then invited the Delegation of Lebanon to introduce its proposal.

719. Mr. HATOUM (Lebanon) stated that the proposal of his Delegation in document PLT/DC/45 to amend draft Article 3(1)(a) called for the deletion of the words "a person skilled in the art" at the end of that subparagraph and the addition of the following: "any person who is skilled and knowledgeable in the subject. The application shall disclose the best mode of carrying out the invention. The disclosure shall contain an abstract of the subject matter of the invention, shall indicate any other filing made by the applicant in any country whatsoever and shall state whether he has obtained a patent on the basis of such application."

720.1 The CHAIRMAN observed that the proposal of the Delegation of Lebanon called for replacing the term "person skilled in the art" with "person who is skilled and knowledgeable in the subject." He noted that a discussion on the matter dealt with in the second sentence of the proposal, that the "application shall disclose the best mode of carrying out the invention," had already taken place, at great length, and could not be taken up again. He also observed that the last sentence of the proposal dealt with the requirement that the applicant give indications concerning filings in other countries. He noted that that matter was contained in draft Article 25 and was within the competence of Main Committee II and could not, therefore, be considered in Main Committee I.

720.2 He then asked whether there were any delegations that wished to support the proposal of the Delegation of Lebanon. There being none, he concluded that the proposal had not been supported and could no longer be discussed, it being understood that those portions of the proposal concerning the indications concerning filings in other countries would be discussed in Main Committee II.

720.3 He then turned to a discussion of the proposal of the Delegation of Germany in document PLT/DC/58 in respect of draft Article 3(1)(b) and requested that Delegation to introduce it.

721.1 Mr. SCHAEFERS (Germany) indicated that the proposal of his Delegation was directed at replacing the last sentence of draft Article 3(1)(b), which read: "Any Contracting Party may require that the deposit be made on or before the filing date or, where priority is claimed, the priority date of the application." His Delegation felt that that wording might lead to a belief that it contained the general principle governing the time at which deposits were to be made. Accordingly, his Delegation suggested changing the arrangement of the provision so as to start with the general principle, which would be followed by a statement of a freedom to deviate from the general principle. The Delegation proposed, therefore, deleting the last sentence of draft Article 3(1)(b) and substituting the following: "The deposit shall be made on or before the filing date. However, any Contracting Party may provide that the deposit may also be made after the filing date." He stated that this proposal would leave Contracting Parties free to accept deposits before, on or after the filing date of an application.

721.2 He referred to concerns that had been expressed by the Delegation of the United Kingdom in respect of the mention of the priority date in subparagraph (b) and stated that his Delegation felt it was not necessary to mention the priority date, considering that the disclosure in a first patent application did not affect the formal validity of the priority claim made on it in a second application.

722. The CHAIRMAN recalled that the discussions on draft Article 3(1)(b) which had occurred earlier indicated favor for the flexible approach whereby a Contracting Party would be allowed to accept a deposit before, on or after the filing date.

723. Mr. KIRK (United States of America) expressed difficulties with the way in which the proposal of the Delegation of Germany had been drafted, stating that it might be interpreted such that a Contracting Party would require a deposit to be made on or before the filing date and after the filing date. He indicated that his Delegation desired a provision that gave Contracting Parties the freedom to provide that a deposit may be made after filing date, rather than on or before it.

724. The CHAIRMAN stated that the difficulties of the Delegation of the United States of America were more of a drafting nature, but that the intent was clear.

725. Mr. NEERVOORT (Netherlands) stated that his Delegation had sympathy with the proposal made by the Delegation of Germany. He asked whether the proposal would allow Contracting Parties to require additional deposits of microorganisms each time another application, directed to the same invention

and claiming priority based upon the first application, was filed in another country.

726.1 The CHAIRMAN stated that use of the definite article in reference to the deposit made it clear that it was intended that a Contracting Party could not require a second deposit. He concluded that the proposal made by the Delegation of Germany was accepted in principle, subject to improvement of the wording by the Drafting Committee.

Rule 2(2): [Manner and Order of Presentation of Claims] (continued from paragraph 167.1))

726.2 The CHAIRMAN then returned to the discussion to Rule 2 and requested the the Delegation of the United Kingdom to introduce its proposal contained in document PLT/DC/57 in respect of draft Rule 2(2).

727.1 Mr. SUGDEN (United Kingdom) stated that the proposal being made by his Delegation was intended to capture an oral suggestion made during the earlier discussion of draft Rule 2.

727.2 With respect to draft Rule 2(2), he reiterated the preference of his Delegation for Alternative B as it referred to both the manner and order of the contents of the description. He stated that his Delegation's proposal consisted in adding paragraph (b) of Alternative A to Alternative B so as to allow a Contracting Party to accept something less than the requirements set out in draft Rule 2(1), provided that the necessary requirements of draft Article 3 were complied with. In that regard, he stated that if an applicant complied with draft Rule 2(1) he would know he was safe, but that a Contracting Party might nevertheless accept less.

Article 3: Disclosure and Description (continued from paragraph 726)

728. Mr. GUERRINI (France) asked whether he could return to what had been previously said on Article 3(a) to the effect that a Contracting Party could provide the possibility of deposit of microorganism being made also after the filing date of the application. He held that a filing date existed when the invention had been adequately described. Leaving aside the matter of priority, if one considered a deposit in a country that had availed itself of the faculty referred to, one could conceive of a filing date with insufficient description since, by definition, the deposit of the microorganism would have been deferred. He wondered whether it should not be said in such case that the filing date was not the date of filing of the application, but the date of the deposit of the microorganism.

729.1 The CHAIRMAN recalled that no Office conducts a technical examination on the filing date to determine if the application meets the requirements of sufficiency of disclosure. When the substantive examination takes place and the disclosure is not sufficient, then the patent is not granted. In the case of the deposit of microorganisms, there could be a formal check to see if there had been a deposit, but such a check did not involve a technical examination to see if the disclosure requirements are met by such a deposit.

Rule 2: Contents and Order of Description (ad Article 3(2))

729.2 He then returned to draft Rule 2(2) and, there being no other statements, noted that, based upon the earlier discussions, the proposal by the Delegation of the United Kingdom in document PLT/DC/57 was adopted as the basis for further discussion.

730. Mr. SCHAEFERS (Germany) recalled that his Delegation had raised certain other problems in respect of draft Rule 2. In particular, he stated that the Convention priority should not be affected by the failure to disclose the best mode. He indicated, as a tentative proposal, that the requirement to disclose the best mode be included as an option in Rule 2(1)(vi). He indicated that his Delegation had reconsidered its proposal and had come to the conclusion that the clarification envisaged by his proposal need not go into the text of the Treaty. However, he wished to record that, in the view of his Delegation, the priority right based on the first application should not be affected where the said first application, in conformity with the applicable law, did not set out the best mode known to the applicant, if he complied with an applicable best mode requirement for the second application in accordance with the provision as contained in the basic proposal.

731. The CHAIRMAN indicated that the statement made by the Delegation of Germany would be entered into the records of the Conference.

732. Mr. KIRK (United States of America) noted that the statement made by the Delegation of Germany represented the statement of an individual delegation for the records and did not constitute a statement adopted by the Main Committee I.

Article 9: Right to a Patent (continued from paragraph 46)

733.1 The CHAIRMAN then asked the meeting to resume the discussion of draft Article 9 ("Right to a Patent") and recalled that there had been protracted discussions in respect of draft Article 9(2) and the proposal submitted by the United States of America in document PLT/DC/6. The discussion was now closed for the first part of the Conference on draft Article 9(2) and the question of principle whether any option to retain the first-to-invent system should be permitted.

733.2 With respect to draft Article 9(1), he noted that there were three proposals, one by the Delegation of the United Kingdom in document PLT/DC/35, one by the Delegation of Israel in document PLT/DC/43 and one by the Delegation of Lebanon in document PLT/DC/48.

734. Mr. BOGSCH (Director General of WIPO) drew attention to Note 9.01 in document PLT/DC/4, which read:

"It is understood that the ordinary rules in each Contracting Party applicable to the sale, transfer, devolution or other transmission of property rights, as well as rules on bankruptcy, apply to the right to a patent and are not affected by paragraph (1). Thus, if, in a given case, the inventor (or the employer or the person having commissioned the work of the inventor) has sold his right to a patent for a particular invention, the right to the patent would belong to the successor-in-title of the inventor (or of the employer or of the said person)."

735. The CHAIRMAN remarked that discussions in the Committee of Experts indicated very little possibility of further harmonization on the allocation of rights as between the inventor and the employer of the inventor or the person who commissioned the work of the inventor which resulted in the invention. He then invited the delegations concerned to introduce their proposals on Article 9(1).

736.1 Mr. SUGDEN (United Kingdom) introduced the proposal of his Delegation in document PLT/DC/35 on draft Article 9(1), stating that it called for the addition of the underlined words to the first sentence as follows: "The right to a patent shall belong to the inventor or his successor in title."

736.2 He indicated that his Delegation had borne in mind the Note pointed out by the Director General when drafting the proposed amendment. He stated that the draft paragraph, as it appeared in the basic proposal, made it clear that, while the patentee was alive, he might enter into contracts to dispose of his right to the patent, such as through an assignment, and there was no need to provide for a successor in title. He stated, however, that other situations may arise, such as the death of the inventor or bankruptcy, where the property is disposed of by operation of law and it is no longer within the control of the inventor to dispose of the right to the patent. His Delegation wanted the Article itself to be explicit, rather than the Notes, concerning such situations.

736.3 He stated that the proposed amendment was essential because of the second sentence of draft paragraph (1). Specifically, the first sentence mandated that the right to a patent should belong to the inventor and the second sentence provided instances where that was not the case. Since the second sentence provided two specific instances, there was doubt about the possibility of other such instances. He stated that the proposal of his Delegation was intended to obviate such doubt.

737.1 Mr. SHACHTER (Israel) introduced the proposal of his Delegation in respect of draft paragraph 9(1) in document PLT/DC/43 and withdrew the portion of the proposal directed to the first sentence in favor of the proposal by the Delegation of the United Kingdom contained in document PLT/DC/35.

737.2 He stated that the proposed amendment to the second sentence of draft paragraph (1) was occasioned by the fact that a Contracting Party might be restricted to two possibilities: the first where the invention belonged to the inventor and the second where it belongs to the employer. He stated that other situations might arise in which the right to a patent might be held jointly between the parties and such a situation should not be excluded.

738. Mr. HATOUM (Lebanon) introduced the proposal of his Delegation on Article 9(1) contained in document PLT/DC/48. He stated that the proposal was intended to delete the second sentence of that draft paragraph. He stated that the right to a patent should belong to the inventor and in no circumstances should it belong to the employer or the party commissioning the work. He drew a distinction between the right to a patent and the right to work a patent, stating that the former right should always vest in the inventor, while the latter might vest in another person, such as an employer or one who commissioned the work which resulted in the invention.

739. The CHAIRMAN observed that the proposal which deviated most from the basic proposal was that made by the Delegation of Lebanon and suggested, therefore, that it be taken up first.

740. Mr. SAPALO (Philippines) agreed in principle with the proposal of the Delegation of Lebanon. He drew an analogy between moral rights in the context of copyright law and the recognition of the inventor.

741. Mr. BOGSCH (Director General of WIPO) stated that if, in the laws of the world, the only way to transfer a patent to a third person was by contract, then there would be no problem because the one receiving rights from the inventor would be a contracting partner with the inventor. He stated that, however, in a large number of national laws, if an employed inventor, working within the scope of his contractual obligations, makes an invention, the right to the invention does not vest in the inventor, but vests in the employer.

742. Mr. ZAVAREIE (Iran) supported the proposal of the Delegation of Lebanon. He stated that according to the national law of his country, the right to an invention is a personal right that belongs to an inventor, not to an employer. He stated that that right could be transferred after the grant of a patent.

743. The CHAIRMAN clarified that the text of the basic proposal was not inconsistent with such legislation and that it was up to the Contracting Parties to decide in which case and to what extent the right belonged to the inventor.

744. Mr. BOGSCH (Director General of WIPO) asked whether there were some countries in which the right originally belonged to the employer.

745. Mr. KAMEL (Egypt) supported the text of the basic proposal which, he observed, granted the right to a patent to the inventor, but left it up to Contracting Parties to decide in what circumstances the right to the patent would belong to someone else. He stated that in his country there was no problem in carrying out those provisions because under his national law the right to a patent belonged to the inventor unless, by contract, the inventor and his employer decided otherwise.

746. Mr. MESSERLI (Switzerland) stated, in response to the question raised by the Director General, that the legislation of his country provided that inventions made by employees vest in employers. He indicated that it was the desire of his Delegation to keep such provisions and his Delegation, therefore, opposed the proposal by the Delegation of Lebanon.

747. Mr. SUGDEN (United Kingdom) opposed the proposal by the Delegation of Lebanon because his Delegation desired to retain the second sentence of Article 9(1). He stated that, if an inventor was working for an organization which had employed him to invent, provided him with expensive facilities and the inventor was carrying out the job for which he was paid, then it was reasonable to allow the employer to own the invention. He stated that, while it was normal to establish such an arrangement by contract, it should not be mandatory.

748. Mr. SCHENNEN (Germany) indicated that his Delegation opposed the proposal by the Delegation of Lebanon. He stated that the second sentence of draft Article 9(1) was necessary because in his country the allocation of rights between an employed inventor and the employer was determined by law, not by contract. He stated that it was the understanding of his Delegation that the legal provisions governing the relationship between an employer and an employee were not going to be harmonized in the draft Treaty.

749.1 Mr. ALLELA (Kenya) opposed the proposal by the Delegation of Lebanon because the necessary incentives for investment in research, either private or governmental, would arise only if the employer or the person who commissioned the work that resulted in the invention had ownership of the right to a patent.

749.2 He observed that the proposal of the Delegation of the United Kingdom in document PLT/DC/35 was consistent with the basic proposal.

750. Mrs. BESAROVIC (Yugoslavia) stated that her Delegation supported the basic proposal, while respecting the principle that the inventor had the right to a patent.

751. Mr. HATOUM (Lebanon) emphasized that his proposal was to clarify the distinction between the right to a patent and the right to work a patent. In that regard he proposed adding another paragraph to draft Article 9 that the "right to work a patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention."

752. Mr. BOGSCH (Director General of WIPO) asked the Delegation of Lebanon what, based upon its last intervention, remained with the inventor.

753. Mr. HATOUM (Lebanon) replied that the inventor would have a certain affirmative right to the invention. In particular, the inventor would retain the right to be connected with the patent in that his name would be stated clearly in the patent documents. He saw this as preserving the reputation of the inventor.

754. Mr. BOGSCH (Director General of WIPO) pointed out that draft Article 6(2) provided that "[a]ny publication of the Office, containing the application or the patent granted thereon, shall mention the inventor or inventors as such ..." He saw that provision as protecting the reputation of the inventor and documenting his contribution to science.

755. Mr. MILLS (Ghana) supported the basic proposal, stating that the concepts embodied in draft Article 9(1) were very familiar in his country.

756. Mr. NYILIMBILIMA (Rwanda) supported the basic proposal because it was reasonable that the right to the patent should vest in the employer if he provided the financial means whereby the inventor achieved the invention.

757. Mrs. ØSTERBORG (Denmark) strongly supported the text of draft Article 9(1) in the basic proposal and opposed the proposal by the Delegation of Lebanon. She indicated that her Delegation also supported the proposal by the Delegation of the United Kingdom.

758. Ms. RODRIGUES MITTELBACH (Brazil) supported the text of draft Article 9(1) as it appeared in the basic proposal, stating that the law in her country contained a special article on the rights of employees.

759. Mr. NEERVOORT (Netherlands) stated that the law of his country had a legal provision for employer rights to employee inventions which accorded the right to the invention to the employer, not just the right to work. He indicated that the employer was free to decide whether or not to file for patent protection.

760. Mr. MOTA MAIA (Portugal) supported the text of draft Article 9(1) as it appeared in the basic proposal. He stated that there appeared to have been some confusion between the title of draft Article 9 ("Right to a Patent"), the title of draft paragraph (1) ("Right of Inventor") and other rights, including the right of the inventor to be named, as stated in draft Article 6.

761. Mr. KORCHAGUIN (Soviet Union) supported the basic proposal and stated that the amendment proposed by the Delegation of the United Kingdom would further improve the text.

762. Mr. JAKL (Czechoslovakia) supported the basic proposal, together with the proposal of the Delegation of the United Kingdom. He stated that, if an invention was made as part of a task in an employment relationship that the right to the patent should belong to the employer.

763. Mr. UEMURA (Japan) stated that his Delegation opposed the proposal by the Delegation of Lebanon as it might be interpreted as according the right to a patent to the inventor and no one else.

764. Mr. QIAO (China) supported the basic proposal stating that in his national law there were legal provisions concerning employee inventions. He saw a link between the provisions of the basic proposal and the proposal of the Delegation of the United Kingdom.

765. Ms. LACHOWICZ (Poland) opposed the proposal of the Delegation of Lebanon. She considered that paragraph (1) of the basic proposal was in conformity with the law and practice of her country. She stated that her Delegation was in favor of the basic proposal and the proposal by the Delegation of the United Kingdom.

766. Mr. VU HUY TAN (Viet Nam) supported draft Article 9(1) in the basic proposal and saw that the proposal of the Delegation of the United Kingdom could be merged with it.

767. Mr. BOGSCH (Director General of WIPO) suggested to the Delegation of Lebanon that the records of the Conference clearly state that the provisions of Article 6 were not affected by the second sentence of draft Article 9(1).

768. Mr. HATOUM (Lebanon) supported the suggestion made by the Director General.

769.1 The CHAIRMAN assured the Delegation of Lebanon that the records of the Conference would state that the second sentence of draft Article 9(1) did not go against draft Article 6 in respect of the mention of the inventor in publications of the office.

769.2 He observed that the basic proposal enjoyed substantial support and that there was, therefore, no need to continue discussion. He further observed that the proposal of the Delegation of the United Kingdom had been supported and that it too was, in the absence of any opposition, accepted as the basis for further discussion.

769.3 He then adjourned the meeting of the Committee.

Ninth Meeting
Wednesday, June 12, 1991
Afternoon

Article 9(1): [Right of Inventor] (continued)

770. The CHAIRMAN reconvened the meeting of the Committee for the resumption of consideration of draft Article 9(1). He turned to a discussion of the proposal of the Delegation of Israel in document PLT/DC/43.

Article 3: Disclosure and Description

771. Mr. GUERRINI (France) said that he wished to return again to the discussion on Article 8 to ask whether it would be possible to consider the debate not to have been closed on the matter of the filing date of the application where a microorganism was deposited after filing of the written elements of the application. He believed that the Committee had been in agreement that, in such case, the priority would not apply. He felt that a step in the reasoning had been omitted, that of the reasoning of private international law which was to ask first which law would apply for judging the regularity of the priority deposit, for instance in the United States of America. Considering that the application was deemed to be in order in the United States on the day of filing of the application and that the deposit of the microorganism made subsequently did not affect that date, he did not see what could be a possible basis for refusing, in that hypothesis, to take into consideration the priority in the event of a subsequent filing in Europe. There was a problem of conflict of laws, of application of foreign laws, that should not be omitted in the reasoning. On the other hand, even if one reasoned differently, there would nevertheless be drawbacks that would lead to considering that either the late deposit was not necessary to complete the description and in that hypothesis the provision was pointless or, on the contrary, and that of course was what was being held, the belated deposit would constitute the necessary completion of the description in such cases, the patent could be invalidated on the grounds that new matter had been introduced during examination of the application. That would be altogether unsatisfactory and at such moment it would be necessary to consider perhaps a solution of the type chosen for Article 8(3) of the basic proposal in which the filing date was deferred to the time the drawing was submitted.

772.1 The CHAIRMAN indicated that the concerns raised by the Delegation of France occurred related to discussion on draft Article 3(1)(b), rather than draft Article 8. He stated, therefore, that discussion on draft Article 3(1)(b) could be opened, but not on draft Article 8.

772.2 He moved to the matter of priority and stated his willingness to attempt to give a reply. He held that, when speaking of valid or recognized priority, two things had to be properly distinguished. The conditions that a priority had to satisfy in order to be formally valid had to be distinguished. The application whose priority was claimed had to have been filed in a member State of the Paris Union and the application claiming that priority had to have been filed within 12 months. The first filing, whose priority was claimed, had indeed to be an initial filing and to be recognized as such in the State concerned under the applicable law, which, in the case envisaged, was the law of the United States of America. Those were more in the nature of formal conditions that had to be satisfied if the priority claim was to be recognized.

772.3 Apart from that, there was a further question that arose either during examination or possibly later in the event of legal proceedings, which was the matter of the scope of priority. What was covered by priority and what was not? That was a notion that was altogether in conformity with the Paris Convention since the latter recognized multiple priorities and partial priorities. The scope of priority was therefore not always 100% of what was contained in the second filing. In that respect, that was to say the scope of priority to be recognized in the country in which that priority was claimed, he thought that the domestic law of the State concerned had to be applied and one had to ask whether, under that law, the initial documents of the filing whose priority was claimed contained a sufficient disclosure of the invention. It would therefore seem altogether possible to arrive at the conclusion that the first deposit was valid under the law of the United States and that, consequently, priority was formally valid but that, because the microorganism was not deposited on the filing date of the first application despite the fact that it was necessary for the disclosure to be sufficient, it constituted a priority whose scope was restricted.

773. Mr. GUERRINI (France) said that he would indeed like to go along with the Chairman, but doubted whether he could. He felt that the distinction made by the Chairman meant that the judgment of what ought to be maintained in the basic application as a result of the priority was referred back to the law of the State of the second application. However, the applicant could claim that, in respect of the facts mentioned in the basic application and which had been supplemented by subsequent deposit of a microorganism, the whole of the matter had to be maintained for priority since that would otherwise amount to indirect application of his domestic law. As to the effects of what was comprised in the disclosure, the situation was a little different from that of the conventional hypothesis of partial priority. It was necessary to reflect further on those matters.

774. The CHAIRMAN recommended the adoption of the suggestion of the Delegation of France to reflect on the issues that had been raised and perhaps to come back to them in the second part of the Conference.

Article 9: Right to a Patent (continued from paragraph 769.3)

775. Mr. UEMURA (Japan) requested clarification of the conclusions reached in respect of the proposal of the Delegation of Lebanon (PLT/DC/48). He stated the understanding of his Delegation that draft Article 5(2) referred to the mention of the inventor in publications of the Office, but not to the right of the inventor to be so named. He referred to the provision of Article 4~~ter~~ of the Paris Convention which provided that the "inventor shall have the right to be mentioned as such in the patent." He indicated that his Delegation had difficulties with the interpretation of "patent" in Article 4~~ter~~ of the Paris Convention in light of draft Article 6 of the basic proposal. He stated, therefore, that the minutes of the meeting should reflect that draft Article 9(1) should have no influence on draft Article 6(2).

776. Mr. BOGSCH (Director General of WIPO) stated that the records would show that the understanding reached was that nothing in draft Article 9(1) should be interpreted as derogating in any way from the provisions of draft Article 6.

777. Mr. UEMURA (Japan) indicated that his Delegation was satisfied with the statement of the Director General.

778. The CHAIRMAN then returned to a discussion of the proposal of the Delegation of Israel in document PLT/DC/43.

779. Mr. SHACHTER (Israel) recalled that his Delegation's proposal in relation to the first sentence of draft Article 9(1) had been withdrawn. With respect to the second sentence of paragraph (1), the proposal was intended to cover the situation where the right to the patent was owned by both the inventor and the employer, perhaps jointly. For the sake of simplicity, he suggested that his original proposal in respect of the second sentence of paragraph (1) also be withdrawn and be replaced by the addition of the phrase "and the extent to which" after "Any Contracting Party shall be free to determine the circumstances under which ..."

780. Mr. IANNANTUONO (Italy) supported the oral proposal made by the Delegation of Israel, stating that it fully corresponded with the patent law of his country.

781. Mr. SUGDEN (United Kingdom) stated that his Delegation had no difficulty with the proposal of the Delegation of Israel. He stated that it added clarity and a certain flexibility to the provisions of draft Article 9(1).

782. The CHAIRMAN noted that two Member Delegations had supported the text proposed by the Delegation of Israel. He asked whether any delegations opposed the proposal. There being no such delegations, he concluded that any further discussion on draft Article 9(1) would be based upon the text contained in the Proposal of the Delegation of the United Kingdom in document PLT/DC/35, with the addition of the phrase "and the extent to which" in the place indicated by the Delegation of Israel.

783. Mr. SHACHTER (Israel) indicated that the situation envisaged in proposed paragraph (3) of the proposal in document PLT/DC/43 was the misappropriation of an invention by a third party who subsequently filed for

patent protection. The proposed new paragraph would require Contracting Parties to provide for recourse by the true owner of the rights so as to have them transferred to him.

784. Mr. UEMURA (Japan) requested clarification as to the status of the phrase of "or to any other person" which appeared in the last sentence of draft Article 9(1) of the proposal of the Delegation of Israel in document PLT/DC/43.

785. The CHAIRMAN responded that that portion of the proposal of the Delegation of Israel had not been adopted and requested the Secretariat to read out draft Article 9(1) as it had been adopted for further discussion.

786. Mr. CURCHOD (WIPO) read out draft Article 9(1) as it had been adopted, which included the proposal of the Delegation of the United Kingdom in document PLT/DC/35 and the oral proposal of the Delegation of Israel, as follows:

"The right to a patent shall belong to the inventor or his successor in title. 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 of the inventor which resulted in the invention."

In French, the text was the following:

"Le droit au brevet appartient à l'inventeur ou à son ayant cause. Toute Partie contractante est libre de déterminer les cas dans lesquels et la mesure dans laquelle le droit au brevet appartient à l'employeur de l'inventeur ou à la personne qui a commandé à l'inventeur les travaux ayant abouti à l'invention."

787. Mr. UEMURA (Japan) indicated that his Delegation was fully satisfied with the clarification provided by the Secretariat.

788. Mr. BOGSCH (Director General of WIPO) commented, in respect of the proposal by the Delegation of Israel to add a new paragraph (3), that there was nothing in the draft Treaty that would prevent a Contracting Party from introducing such provisions. Moreover, he indicated that the proposal added new matter to the draft Treaty. He further observed that some terms in the proposal were unclear, such as the term "owner of the invention."

789. Mr. SCHAEFERS (Germany) stated that his Delegation opposed the proposal by the Delegation of Israel, noting that it introduced new matter to the draft Treaty that would require further study. He further stated that the situation was already dealt with under the national law of Germany and under the European Patent Convention.

790. Mr. SUGDEN (United Kingdom) stated that the legislation in his country was more flexible than that contemplated in the proposal of the Delegation of Israel. He stated that a great deal of work would be required before the matter could be dealt with in the draft Treaty, including study on how patent offices would deal with the matter, the rights of third parties, and particular drafting problems. Further, he stated that nothing in the draft

Treaty would prevent a Contracting Party from safeguarding the rights of third parties, including in the situations envisaged by the proposed new paragraph (3).

791. Mr. SMITH (Australia) expressed sympathy with the proposal of the Delegation of Israel stating that such provisions existed in the laws of his country. He saw the proposed text as providing sufficient flexibility to allow its provisions to be implemented by offices or by courts. While indicating that the wording of the proposal could be improved, particularly to refer to the true and lawful inventor, rather than owner, he supported its general thrust.

792. Mr. SHACHTER (Israel) apologized for the late submission of his Delegation's proposal, but emphasized its importance. He stressed that its provisions did not impose an obligation on the Office to decide to whom the rights belong but merely to act on the basis of a decision, e.g. by the court so as to have the rights transferred. As to the wording of the proposal, he indicated that the matter might be taken up in the second part of the Conference.

793.1 Mr. SCHATZ (EPO) indicated that his Delegation was opposed to the proposal of the Delegation of Israel. He stated that the principle was established in draft paragraph (1) that the right to a patent belonged to the inventor and he did not see it as necessary to establish provisions in the draft Treaty as contemplated by proposed new paragraph (3).

793.2 He stated that, under the European Patent Convention, the competence on litigation of the right to a patent belonged to the national courts of the Contracting States. Only after a decision had been taken by the national courts in that regard would the European Patent Office proceed to a transfer in accordance with Article 60 of the European Patent Convention. He did not see that such a complicated problem as envisaged by the proposed new paragraph (3) could be dealt with by the Conference.

794. Mr. KIRK (United States of America) indicated that his Delegation followed the position taken by the Delegation of the United Kingdom and was, on balance, not prepared to accept the proposal of the Delegation of Israel. He stated that the way it was drafted implied that some action would have to be taken by the office.

795. Mr. ROMERO (Chile) expressed sympathy for the proposal by the Delegation of Israel and considered that it should, with certain drafting changes, be included in the draft Treaty.

796.1 Mr. NEERVOORT (Netherlands) stated that his Delegation was in sympathy with the essence of the proposal that the person with the better entitlement should realize his rights. He stated that it would, however, be difficult to achieve harmonization on the issue and that the draft Treaty left the resolution of such issues to the Contracting Parties.

796.2 As to the text of the proposal, he suggested that the issues dealt with in proposed paragraph (3) were not issues for an Office to decide. Moreover, he felt that the inquiry should be as to who was the true and lawful owner, rather than the true and lawful inventor.

797. Mr. SALIM (Syria) expressed sympathy for the positions taken by the Delegations of the United Kingdom and Germany, stating that consideration of the proposal of the Delegation of Israel would delay the work of the Conference.

798. Mr. ORTEGA LECHUGA (Spain) stated that his Delegation opposed the proposal by the Delegation of Israel in document PLT/DC/43 for the reasons outlined by the Delegation of EPO. His Delegation considered that the proposal was not necessary since the possibility existed of taking court action to establish lawful ownership of a patent of invention. His Delegation also had difficulty with the sub-title of paragraph (3) in the proposal of the Delegation of Israel, since the paragraph did not seem to concern third parties but, rather, concerned the true and lawful owner.

799. Mr. GARIEPY (Canada) stated that his Delegation had considerable sympathy for the proposal of the Delegation of Israel. His country did not have such a provision in its national law and it might be desirable to include such a provision. However, since there was nothing in the draft Treaty which would preclude the inclusion of such a provision in the national law at any time and since the subject matter dealt with in paragraph (3) of the proposal was new and had not been considered in the Committee of Experts, his Delegation opposed the proposal.

800. Mr. ENÇ (Turkey) observed that the procedure contained in the proposal by the Delegation of Israel was only possible in his country by judicial means. It seemed to him that such a provision was not necessary and that it had been put forward too late to be examined in the Conference.

801. Mr. HADJ-SADOK (Algeria) explained that the problem raised by the proposal of the Delegation of Israel was dealt with as litigation in the national law of his country. In view of the fact that the proposal required the problem to be dealt with by the Office, his Delegation was opposed to it.

802. Ms. BACH (Denmark) stated that her Delegation opposed the proposal of the Delegation of Israel.

803. Mr. KESOWO (Indonesia) stated that the patent law of his country contained provision for the substitution of the true and lawful owner of a patented invention, but that such action was only possible through judicial proceedings. If the proposal of the Delegation of Israel in document PLT/DC/43 were accepted, therefore, his Delegation would wish that the proposal be extended also to permit judicial proceedings in the alternative to administrative proceedings.

804. Mr. HATOUM (Lebanon) opposed the proposal of the Delegation of Israel.

805. Mr. KHERIESAT (Jordan) stated that paragraph (3) of the proposal of the Delegation of Israel was against the national legislation of his country and that he, therefore, opposed it.

806. Mr. NTAHOMVUKIYE (Burundi) explained that the true and lawful owner of the invention was required to assert his right before the courts in his country. He stated that his Delegation was not willing to support the proposal by the Delegation of Israel.

807.1 The CHAIRMAN concluded that it was not possible to accept the proposal by the Delegation of Israel for a new paragraph (3) in Article 9. He noted that the draft Treaty contained no provision preventing the applicable law from setting out an administrative or judicial procedure for asserting the rights of the true and lawful owner. He further noted that the problem raised by the proposal made by the Delegation of Israel was new and complex since the relevant provisions in national laws were quite divergent. It would therefore have been necessary to discuss it in the Committee of Experts for the proposal to have been subject to discussion.

807.2 He moved on to Article 9bis, which was not in the basic proposal, but was the subject of a proposal prepared by the Delegation of the United States of America and contained in document PLT/DC/40 Rev. He asked the Delegation of the United States of America to present its proposal.

Article 9bis: Loss of Right

808.1 Mr. KIRK (United States of America) introduced the proposal of his Delegation contained in document PLT/DC/40 Rev. He stated that a similar proposal had been introduced by his Delegation in the Committee of Experts and that some discussion had taken place on it. The proposal now before the meeting would allow any Contracting Party to make special provision with respect to the loss or retention of the right to a patent in certain situations.

808.2 The first situation dealt with the case of a patent owner or inventor who benefitted from the commercial exploitation of his invention secretly for a period of time and then moved to obtain a patent only when the invention became known. In such a case, the inventor would enjoy both the rights derived from secrecy and the exclusive right conferred by a patent, unless otherwise prevented from so doing by a legislative provision. In the view of his Delegation, the patent system should be designed so as to encourage inventors to come forward and disclose technology. Thus, if a secret sale or a secret commercial use took place more than 12 months earlier than the filing or priority date, the inventor or his successor in title should be considered to have chosen trade secrecy rather than the patent system and should be prevented from obtaining a patent. However, the draft Treaty did not seem to envisage any loss of right to a patent in such circumstances, since the sale or commercial use would have been secret, and the invention would not therefore form part of the prior art, as defined in Article 11. Paragraph (1)(i) of Article 9bis, as proposed by his Delegation in document PLT/DC/40 Rev., was directed at clarifying that Contracting Parties could provide for the loss of the right to a patent in such circumstances.

808.3 The second situation dealt with in the proposal of his Delegation concerned a filing in a foreign country made by an applicant in breach of national security regulations. The national legislation of his country required domestic applicants to file first in the national Office for national security purposes, unless the applicant had the consent of the national Office to file overseas first. Paragraph (1)(ii) of Article 9bis, as proposed in document PLT/DC/40 Rev., would allow Contracting Parties to provide for the loss of the right to a patent where the application was made by the applicant outside the Contracting Party in violation of the national security provisions of the Contracting Party.

808.4 The third situation concerned experimental use. His Delegation believed that applicants and inventors should be encouraged to perfect inventions and believed that there should be no loss of rights if an applicant used a claimed invention more than 12 months preceding the filing or priority date, even if such use involved the disclosure of the invention provided that the use was experimental. Paragraph (2) of Article 9bis as contained in document PLT/DC/40 Rev. sought to allow Contracting Parties the freedom to provide for such experimental use without the loss of rights that might otherwise be entailed as a result of the definition of the prior art contained in Article 11.

808.5 He emphasized, in conclusion, that the proposal of his Delegation was that each Contracting Party should have the freedom to provide for the loss of rights in the two situations dealt with in paragraph (1) of Article 9bis and for the retention of rights in the situation dealt with in paragraph (2) of Article 9bis. It did not wish to make those provisions mandatory for all Contracting Parties.

809. The CHAIRMAN asked the Delegation of the United States of America whether, in the event of an applicant in the United States of America losing his rights on the grounds of breach of national security regulations, the proposal by the Delegation of the United States of America meant that he would also lose his rights to file abroad.

810. Mr. KIRK (United States of America) replied to the question of the Chairman in the negative. He stated that the proposal of his Delegation addressed only the domestic consequences of action within any particular Contracting Party.

811.1 Mr. SCHAEFERS (Germany) stated that he wished to make clear the opposition of his Delegation to the proposal of the Delegation of the United States of America from the start. He pointed out that, in the Committee of Experts, it had been apparent that the Delegation of the United States of America had had difficulties in locating systematically the appropriate place in the draft Treaty where the provisions contained in its proposal ought to be placed.

811.2 He pointed out that the proposal of the Delegation of the United States of America concerned matters which were peculiar to the law of the United States of America and which appeared to his own Delegation to constitute additional grounds for the refusal or invalidation of the patent. Thus, for example, the loss of right because of a breach of national security provisions should be considered to constitute a ground for refusal or invalidation of the patent.

811.3 He pointed out that the draft Treaty did not contain a complete list of the grounds for refusal or invalidation of a patent. It was also clear that Article 11 did not require the grant of a patent where the conditions of patentability with which it dealt were satisfied. Rather, those conditions were prerequisites to the grant of a valid patent.

811.4 His Delegation therefore considered that the United States of America was free to continue to provide in its law for the situations envisaged in Article 9bis of its proposal and that it was not necessary that a freedom to continue so to provide should be expressly contained in the draft Treaty.

812. Mr. BOGSCH (Director General of WIPO) stated that he agreed with the conclusion of the Delegation of Germany. The proposal of the United States of America in document PLT/DC/40 Rev. created the impression that the draft Treaty contained an exhaustive list of the grounds of refusal or invalidation of a patent. Such a list was not, however, contained in the draft Treaty and would be extremely difficult to construct.

813. The CHAIRMAN asked the Delegation of the United States of America to explain which provisions in the draft Treaty prevented it from maintaining provisions such as those dealt with in the proposal made by that Delegation.

814.1 Mr. KIRK (United States of America) stated that his Delegation had put forward the proposal in document PLT/DC/40 Rev. on the understanding that Article 11 listed the qualifications that had to be satisfied by an invention in order for a patent to be granted and that, once those qualifications were satisfied, a patent had to be granted.

814.2 He stated that his Delegation would certainly be pleased to accept a clarification in the notes or the records of the Conference that the provisions contained in Article 9^{bis} of his proposal could be continued in its national law. He was obligated to point out, however, that a large question remained as to what other grounds of refusal of a patent each Contracting Party could provide for in its law.

815. Mr. BOGSCH (Director General of WIPO) stated that he did not read Article 11 as requiring that a patent had to be granted where the conditions of Article 11 were satisfied. Article 11 provided that the conditions of patentability it contained had to be complied with for an invention to be patentable, which was a different matter. There were many cases, such as antitrust violations or fraud, where the right to a patent could be lost and which were not specifically dealt with in the draft Treaty. He considered that the correct approach would be to note that the interpretation of Article 11 would allow the United States of America to retain the provisions dealt with in document PLT/DC/40 Rev.

816. The CHAIRMAN noted that the discussions appeared to point to general agreement on the view expressed by the Delegation of Germany, that was to say that nothing in the draft Treaty prevented the matter of loss of the right to a patent being dealt with in national laws in the way set out in the proposal by the Delegation of the United States of America. He asked delegations whether a statement to that effect could be entered in the minutes of the Conference and in the notes to the draft Treaty.

817. Mr. UEMURA (Japan) stated that, while his Delegation fully agreed with the interpretation that had been given, he foresaw difficulties in including such a specific interpretation in the records of the Diplomatic Conference since it might be interpreted as a sort of recommendation for the type of provisions national law should contain. He therefore considered that the matter should not be dealt with explicitly as a rule of interpretation.

818. Mr. CHISUM (AIPLA) stated that his Organization considered the present discussion to raise a complicated subject. He was a little perplexed at the explanation given that a Contracting Party could introduce new grounds for the refusal of a patent since, in the United States of America, for example, one of the grounds of refusal was that the invention for which a patent is claimed

was first invented by someone else. Therefore, he wondered whether such a ground could be retained even if the first-to-file system were required to be adopted.

819. Mr. SUGDEN (United Kingdom) stated that he considered that it would be acceptable for a note of interpretation to be made which covered primarily paragraph (1) of Article 9**bis** of the proposal of the Delegation of the United States of America. However, his Delegation would be concerned if any such note should extend to the subject matter dealt with in paragraph (2) of that proposal, since it was not convinced that public experimental use should not be considered as a novelty-defeating event. His Delegation was reluctant to consider that public experimental use should be a free option for Contracting Parties to allow.

820. Mr. RAFFNSØE (FICPI) stated that his Organization considered that the subject matter dealt with in the proposal of the Delegation of the United States of America more logically belonged to Article 11.

821. Mr. SEGURA (Argentina) stated that his Delegation did not agree that public experimental use should be permitted beyond the 12-month grace period.

822. Mr. SMITH (Australia) stated that his Delegation wished to have a clarification of the nature of the note which would appear in the records of the Diplomatic Conference. His Delegation had the same concerns as the Delegation of the United Kingdom concerning paragraph (2) of the proposal of the Delegation of the United States of America.

823. Mr. BLAKEMORE (UNICE) stated that, in Europe, there was no concept of secret prior art and his Organization was in favor of maintaining that position. His Organization had difficulty in understanding why the proposal of the Delegation of the United States of America should not be considered as being an extension of the novelty-defeating grounds. Article 11(2) of the basic proposal seemed to give an exhaustive definition of novelty and the proposal of the Delegation of the United States of America was not consistent with that definition.

824. Mrs. ØSTERBORG (Denmark) stated that her Delegation had the same concerns as those expressed by the representative of UNICE.

825. Mr. AGOUH (Central African Republic) asked whether the proposal made by the Delegation of the United States of America (Article 9**his**) was compatible with Article 2 of the Paris Convention.

826.1 The CHAIRMAN noted general agreement on the fact that nothing in the provisions of the draft Treaty prevented a Contracting Party from providing for loss of the right to the patent under the circumstances described in paragraph (1) of Article 9**bis** of the proposal made by the Delegation of the United States of America, contained in document PLT/DC/40 Rev. He requested that the minutes of the Conference should reflect that agreement and that a corresponding note be inserted in the notes to the draft Treaty.

826.2 He further noted that the matter dealt with in paragraph (2) of the proposal by the Delegation of the United States of America was linked to Articles 11 and 12 of the draft Treaty, which remained to be discussed. He reserved a conclusion on paragraph (2) until the meeting had had the opportunity of taking a stance on Articles 11 and 12.

827. Mr. SANTARELLI (AIPPI) said that his organization even had difficulty in accepting the interpretation of the draft Treaty that permitted a Contracting State to include in its legislation the provision covered by paragraph (1)(i) of the proposal by the Delegation of the United States of America contained in document PLT/DC/40 Rev. He also asked if the Delegation of the United States of America could explain whether the doctrine of secret sale also applied to acts performed outside the territory of the United States.

828. Mr. KIRK (United States of America) stated that the Representative of AIPPI was correct in considering that the proposal of the United States of America treated both United States nationals and foreign nationals in the same manner.

829. The CHAIRMAN suspended the meeting.

[Suspension]

830.1 The CHAIRMAN resumed the meeting and pointed out that discussions on Articles 9 and 9bis had been completed, subject to reservation on certain points.

830.2 He announced that he had contacted the Chairman of Main Committee II and that, once discussions in Main Committee II could usefully begin, the meeting of Main Committee I would be interrupted.

Article 11: Conditions of Patentability

830.3 He invited the delegations to begin their discussions on Article 11 (Conditions of Patentability). He announced that there were three proposals on Article 11, presented by the Delegation of the United States of America and contained in documents PLT/DC/6, PLT/DC/41 and PLT/DC/50. He reminded the meeting that document PLT/DC/6 also covered the proposal of the Delegation of the United States on the fundamental issue of possible maintenance of first-to-invent system. That issue has been discussed in depth and he suggested that the meeting should not go into detail again. He asked the Delegation of the United States of America to say which items the meeting could usefully discuss apart from the fundamental issue of the first-to-invent system.

831. Mr. KIRK (United States of America) stated that the proposals of his Delegation contained in documents PLT/DC/6 and PLT/DC/41 on Article 11 related to the proposal of his Delegation to have the option to retain the first-to-invent system. His Delegation was at the disposal of the meeting to give any further explanation on those proposals. They constituted proposals that his Delegation retained and wished to see as part of the resulting Treaty.

832. The CHAIRMAN thanked the Delegation of the United States of America for the flexibility it had shown. He suggested that the meeting should not go into detail on the proposals on Article 11 contained in documents PLT/DC/6, and PLT/DC/41 and invited the Delegation of the United States of America to present its proposal in document PLT/DC/50.

833.1 Mr. KIRK (United States of America) stated that the proposal of his Delegation contained in document PLT/DC/50 was not related to his Delegation's proposal to have the option to retain the first-to-invent system. His Delegation would wish to make the proposal irrespective of the outcome of discussions concerning the first-to-file principle and the first-to-invent principle.

833.2 He recalled that Article 11(2)(b) of the basic proposal provided that the prior art consisted of everything which, before the filing or priority date, had been made available to the public anywhere in the world. His Delegation was concerned that that formulation would include a document made available to the public by, for example, being placed on a library shelf without having been indexed or in some other way made retrievable. His Delegation therefore wished to propose that such information should not be considered to constitute part of the prior art unless it was identified and organized in a manner that made it accessible to the public. The inclusion in the prior art of the sort of unidentified and unorganized information that his Delegation sought to exclude would be conducive to legal uncertainty since it would only be by a matter of chance that it could be discovered by someone.

833.3 He stated that his Delegation was not asking in its proposal that other Contracting Parties should be required to exclude such information from the prior art. It wished simply to have the freedom to exclude such information itself.

834.1 The CHAIRMAN noted that subparagraph (2)(c) of the basic proposal was in square brackets and that, under the Rules of Procedure of the Conference, it had to be considered as a proposal for amendment that had first to be discussed. He proposed that the meeting should then decide on the proposal by the Delegation of the United States of America.

834.2 He further noted that subparagraph (2)(c) of the proposal by the Delegation of the United States of America gave the possibility of excluding certain elements of prior art. He started from the hypothesis that the proposal by the Delegation of the United States of America was in support of the proposal for amendment which consisted in including subparagraph (2)(c) in the draft Treaty. He asked whether other delegations wished to support inclusion of subparagraph (2)(c) in the draft Treaty.

835. Mr. JILANI (Tunisia) stated that the text contained in paragraph (2)(c) was an important provision for developing countries that his Delegation would wish to see retained in the draft Treaty. He drew attention to the difficulties that many developing countries had in maintaining the necessary skilled personnel to conduct substantive examination on the basis of the criterion of universal novelty. It was, in the view of his Delegation, therefore better to exclude certain matters from the prior art and, on that basis, he supported the inclusion of paragraph (2)(c) in the draft Treaty.

836. The CHAIRMAN explained, to avoid any misunderstanding, that subparagraph (2)(c) enabled a Contracting Party to exclude from prior art certain elements made available to the public, either by oral communication or presentation or utilisation, but not by means of a written document.

837. Mr. KHRIESAT (Jordan) expressed the support of his Delegation for the position of the Delegation of Tunisia.

838.1 Mr. SUGDEN (United Kingdom) stated that his Delegation was opposed to the inclusion of paragraph (2)(c) in Article 11 of the draft Treaty and was also opposed to the proposal made by the Delegation of the United States of America in document PLT/DC/50.

838.2 He affirmed that his Delegation attached great importance to the mandatory adoption of the criterion of absolute novelty. His Delegation wished to exclude the possibility that an application could be made by an applicant on the basis of information picked up orally or at an exhibition in another country. It believed that patent protection should only be made available for inventions that were truly novel.

838.3 Concerning the proposal of the Delegation of the United States of America, his Delegation had difficulty in understanding how, if a matter was cited against a patent or a claimed invention, it could be said that that matter was not retrievable. The fact of it having been retrieved would seem to indicate otherwise.

839.1 Mr. KIRK (United States of America) stated that his Delegation supported the text of paragraph (2)(c) and, thus, the removal of the square brackets surrounding that provision. His Delegation did not believe that the Treaty should require Contracting Parties to consider as prior art oral communications made anywhere in the world. He did not believe that the validity of a patent should be subjected to events that were so uncertain and difficult to prove.

839.2 He pointed out that, while his Delegation had suggested in document PLT/DC/50 that a new sentence be added to paragraph (2)(c), the only connection between the proposal in that document and the text of paragraph (2)(c) was that both provisions concerned an optional deviation permitted to Contracting Parties from the definition of the prior art given in paragraph (2)(b). The proposal of his Delegation in document PLT/DC/50, however, was not dependent on the inclusion of the text in paragraph (2)(c) in the draft Treaty. It stood alone.

840. Ms. RODRIGUES-MITTELBACH (Brazil) stated that her Delegation opposed the inclusion of the text of paragraph (2)(c) in the draft Treaty. Her Delegation strongly supported the notion of absolute novelty.

841. Mr. WIERZBICKI (New Zealand) stated that his Delegation supported the inclusion of the text in paragraph (2)(c) in the draft Treaty, particularly for the reasons that had been given by the Delegation of the United States of America. His country presently practised the concept of local novelty and was considering moving to the notion of absolute novelty. The option provided in paragraph (2)(c) could constitute a good intermediary step.

842. Mr. NEERVOORT (Netherlands) said that his Delegation was opposed to paragraph (2)(c) since inclusion of such an exception seemed to run counter to the aim of harmonization.

843.1 Mr. SCHAEFERS (Germany) stated that his Delegation supported the concept of absolute novelty as set out in paragraph (2)(b), without the inclusion of any permitted deviation through the option contained in paragraph (2)(c). His country had moved to the notion of absolute novelty some 15 years ago and he considered that notion to be consistent with current technological developments which were bringing greater integration to the

world. He did not consider that what happened in other countries concerning public use or oral disclosures should be left out of consideration in the assessment of the novelty of an invention for the purpose of patentability.

843.2 Concerning the proposal of the Delegation of the United States contained in document PLT/DC/50, he stated that he did not consider the question raised by that proposal to deal with the issue of local novelty as envisaged in paragraph (2)(c). Rather, it constituted a qualification of the meaning of the expression "made available to the public" in paragraph (2)(b). He understood that the proposal of the Delegation of the United States of America was based on case law in the United States and he considered that it would be sufficient to cope with the question raised in the proposal if there was an agreed statement in the records of the Diplomatic Conference that the proposal merely constituted a permitted interpretation or clarification of the meaning of the notion of "made available to the public."

844. Mr. PARK (Republic of Korea) stated that his Delegation favored the inclusion of paragraph (2)(c) in the draft Treaty, principally because the disclosures thereby excluded from the prior art were very difficult to prove.

845. Mr. ELHUNI (Libya) stated that his Delegation supported the proposal of the United States of America contained in document PLT/DC/50, since the exclusion of the information mentioned in that proposal would facilitate the examination of applications.

846. Mr. GARIEPY (Canada) stated that his Delegation favored the deletion of paragraph (2)(c) and the mandatory adoption of the concept of absolute novelty.

847. Mr. VON ARNOLD (Sweden) stated that his Delegation opposed, in the interest of harmonization, both the inclusion of paragraph (2)(c) in the draft Treaty and the proposition of the United States of America.

848. Mr. KAMEL (Egypt) stated that his Delegation favored the inclusion of paragraph (2)(c) in the draft Treaty as this would be consistent with the current practice in his country.

849. Mr. KORCHAGUIN (Soviet Union) stated that his Delegation favored the mandatory adoption of a concept of absolute novelty and was, therefore, against the inclusion of paragraph (2)(c) in the draft Treaty. However, his Delegation agreed with the Delegation of the United States of America that material that could not be identified should not constitute part of the prior art and, on that basis, it supported the proposal contained in document PLT/DC/50.

850. Mr. ENÇ (Turkey) said that his Delegation supported the concept of absolute novelty and that, consequently, it favored deletion of subparagraph (2)(c). He added that his Delegation also opposed the proposal made by the Delegation of the United States.

851. Mrs. ØSTERBORG (Denmark) expressed the preference of her Delegation for the deletion of paragraph (2)(c). Concerning the proposal of the Delegation of the United States of America contained in document PLT/DC/50, her Delegation agreed that it would be appropriate to include a note in the records of the Conference which could deal with the subject the proposal intends to solve.

852.1 Mr. UEMURA (Japan) stated that his Delegation preferred, at that time, the removal of the square brackets around paragraph (2)(c) and thus the inclusion of that paragraph in the draft Treaty. However, his Delegation wished to reserve its position until the general view of the conference became known.

852.2 Concerning the proposal of the Delegation of the United States of America in document PLT/DC/50, his Delegation agreed with the Delegation of Germany that the proposal concerned a matter of qualification or interpretation of the concept of public availability. His Delegation did not object to the view that the information described in that proposal was not to be regarded as part of the prior art because it had not been made publicly available. That view ought, however, to be expressed in the records of the Diplomatic Conference rather than in the Treaty itself.

853. Mr. SAPALO (Philippines) stated that his Delegation was in favor of the inclusion of paragraph (2)(c) in the draft Treaty, and that it supported the proposal of the Delegation of the United States of America contained in document PLT/DC/50.

854. Mr. QIAO (China) expressed the support of his Delegation for the inclusion of paragraph (2)(c) in the draft Treaty.

855. Mr. BOGSCH (Director General of WIPO) stated that the drafting of the proposal of the Delegation of the United States of America in document PLT/DC/50 did not seem to indicate that the information with which it dealt could be excluded from the prior art only if it was not available in an identifiable and organized manner anywhere in the world.

856. Mr. KIRK (United States of America) stated that his Delegation was ready to accept a re-drafting of its proposal. His Delegation also agreed that the essence of the proposal could be included in the records of the Diplomatic Conference and the notes to the draft Treaty rather than in the Treaty itself.

857. The CHAIRMAN observed that discussions had addressed two different things that he proposed to separate. There was firstly the proposal for amendment of the basic proposal, consisting in the addition of subparagraph (2)(c), which would make it possible to exclude certain facts from the prior art. Secondly, there was the proposal by the Delegation of the United States of America contained in document PLT/DC/50. That second proposal involved interpretation of the notion of availability to the public. He suggested that the Delegations should make use of the interruption of work to reflect on whether the second question would best be dealt with in the form of a note or by means of an amendment to the basic proposal. He adjourned the meeting.

Tenth Meeting
Thursday, June 13, 1991
Morning

858. The CHAIRMAN opened the meeting and thanked the Burgomaster of The Hague for the musical event that had been sponsored by the City of The Hague and to which all the participants in the Diplomatic Conference had been invited on the preceding day.

859. Mr. HATOUM (Lebanon) stated that his Delegation was the first among the delegations of developing countries that had submitted written proposals. He observed that the majority of the proposals had been submitted by the delegations of industrialized countries. He stated furthermore that the whole world should realize that Lebanon had the strength, despite the crisis it had gone through, to participate actively in negotiations concerning international cooperation, in particular those concerning intellectual property. He observed that some of the proposals of Lebanon had obtained support from developing countries. He called upon delegations of industrialized countries to take into account all proposals coming from all regions of the world. He was of the view that developing countries would promptly develop and so they would eventually be negotiating with industrialized countries on an equal footing.

Article 11: Conditions of Patentability (continued from paragraph 857)

860. The CHAIRMAN invited the Committee to resume the discussion on Article 11. He recalled that the Committee had been considering the proposal by the Delegation of the United States of America which appeared in document PLT/DC/50. He also recalled that paragraph (1)(c) of Article 11 was within square brackets and, since it had received support from some delegations during the previous meeting, it should be discussed by the Main Committee.

861. Mr. MESSERLI (Switzerland) stated that his Delegation was opposed to the inclusion of paragraph (1)(c) as well as to the proposal by the United States.

862. Mr. BAKER (Australia) expressed the support of his Delegation for the inclusion of subparagraph (c). He drew the attention of the Committee to difficulties in producing evidence of acts that occurred in foreign countries.

863. Mr. SEGURA (Argentina) stated that his Delegation was opposed to subparagraph (c) since foreign disclosures could not be ignored.

864. Mr. KUNKUTA (Zambia) expressed the opposition of his Delegation to subparagraph (c), since it was not consistent with the spirit of harmonization.

865. Mr. PAAERMAA (Finland) stated that his Delegation opposed subparagraph (c), since it favored the principle of universal novelty. As far as the proposal of the Delegation of the United States of America was concerned, his Delegation was of the view that the problem raised by that Delegation should be dealt with in the explanatory notes.
866. Ms. LILJEGREN (Norway) stated that her Delegation supported the principle of universal novelty, therefore it was opposed to subparagraph (c).
867. Mr. IANNANTUONO (Italy) stated that his Delegation was opposed to subparagraph (c) since it favored the principle of universal novelty which was already incorporated in the national legislation of his country. He expressed the doubts of his Delegation in respect of the proposal of the Delegation of the United States of America.
868. Mr. SHACHTER (Israel) stated that his Delegation opposed subparagraph (c) because it could be a step back in the development of industrial property law. Regarding the proposal of the Delegation of the United States of America, he stated that a clarification in the notes would be enough to meet the concerns of that Delegation.
869. Mr. TALUKDAR (Bangladesh) stated that his Delegation opposed subparagraph (c) because he could foresee cases where it could lead to injustices. In addition, it would be against the principle of universal novelty which was supported by his Delegation.
870. Mr. ALLELA (Kenya) stated that his Delegation opposed subparagraph (c) since it had many implications and it was a negation of the principle of absolute novelty which was essential for harmonization.
871. Mr. MILLS (Ghana) stated that his Delegation did not favor the inclusion of subparagraph (c) for the reasons already expressed by the delegations that shared the same preference.
872. Mrs. DE CUYPERE (Belgium) said that her Delegation was opposed to subparagraph (c) and that it was also opposed to the proposal made by the United States of America.
873. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the proposal of the United States of America because it did not contradict the principle of universal novelty.
874. Mr. O'FARRELL (Ireland) stated that his Delegation opposed subparagraph (c) and was of the view that subparagraph (2)(b) covered the situation foreseen in the proposal of the Delegation of the United States of America.
875. Mr. DIENG (Senegal) stated that his Delegation opposed inclusion of subparagraph (c). He stated that that subparagraph was in opposition to what was stated in the Bangui Agreement. His country, as a member State of OAPI, was a party to the Bangui Agreement.
876. Mr. SALIM (Syria) stated that his Delegation shared the view of those Delegations that opposed the proposal of the Delegation of the United States of America. He supported the inclusion of subparagraph (c).

877. Mr. KAINAMURA (Uganda) stated that his Delegation opposed inclusion of subparagraph (c).
878. Mr. MBYUYU (Zaire) stated that his Delegation endorsed the principle of absolute novelty and that therefore it was opposed to the inclusion of subparagraph (c).
879. Mr. UEMURA (Japan) stated that, in the view of his Delegation, the proposal by the Delegation of the United States of America was really a matter of interpretation of paragraph (2)(b), particularly of the notion of public availability. As far as subparagraph (c) was concerned, he stated that it should be included in the text of Article 11 since, as was well known, the obtaining of evidence abroad was a very complex process; he wondered whether under subparagraph (c) it would be possible for a Contracting Party not to deal with the facts referred to in that provision during the examination but at a later stage, namely, after the grant.
880. The CHAIRMAN reassured the Delegation of Japan that disclosures, other than by written documents, had been shown by experience to play only an extremely limited role in the examination procedure before Offices simply because such facts were not recorded in the documentation used for searching in all but very exceptional cases. Consequently, where such facts were used as grounds for invalidity of the patent or for non-patentability, they were usually to be found in either opposition proceedings or nullity proceedings before the courts. It was generally the person invoking the fact detrimental to novelty that had to furnish the proof. Paragraph (c) was therefore not intended to facilitate the work of Offices. It was intended more generally for those States that wished to have the subparagraph (c) to facilitate all kinds of proceedings, not necessarily those before Offices only.
881. Mr. BOGSCH (Director General of WIPO) recalled that, in accordance with the Treaty, Contracting Parties were not under an obligation to conduct substantive examination.
882. Mrs. MSOSA (Malawi) stated that her Delegation approved the inclusion of subparagraph (c) for the reasons already explained by the Delegations that shared the same position.
883. Mr. KHUMALO (Swaziland) stated that, since his Delegation supported the principle of absolute novelty, it was opposed to the inclusion of subparagraph (c).
884. Mrs. KRUDO SANES (Uruguay) stated that her Delegation was opposed to the inclusion of subparagraph (c), because of the reason given in favor of universal novelty.
885. Mr. MARTIN BURGOS (Spain) expressed the support of his Delegation for the principle of universal novelty.
886. The CHAIRMAN stated that a significant number of delegations were opposed to the inclusion of subparagraph (c) in paragraph 2 of Article 11. Consequently, the proposal did not enjoy the necessary majority to be considered as a basis for further discussion.
887. Mr. HIEN (Burkina Faso) stated that his Delegation opposed subparagraph (c).

888. Mr. BRUNET (ABA) stated that his Organization favored the inclusion of subparagraph (c) because it gave more reliability to a patent and would allow attorneys to give better advice to their clients.

889. Mr. BETON (UNICE) stated that, in the view of his Organization, the principle of absolute novelty was associated with the principle of first to file and that UNICE favored both principles. For that reason UNICE was against the inclusion of subparagraph (c). As far as the proposal of the Delegation of the United States of America was concerned, he stated that it would give rise to uncertainties and inconsistencies because the definition of what was identified and organized in a manner that made the matter accessible to the public would be different for different Contracting Parties and different between university theses and the contents of patents.

890. Mr. SANTARELLI (AIPPI and CNCBI), as Representative of AIPPI, stated the support of that Organization for subparagraph (c) because of the difficulties in obtaining evidence abroad. Speaking in his capacity as Representative of CNCBI, he stated that that Organization was attached to the principle of universal novelty and thus was opposed to the inclusion of subparagraph (c).

891. Mr. CHISUM (AIPLA) drew the attention of the Committee to the "duty of candor" that was applicable to every applicant under the practice of the United States of America. Any applicant was thus under the obligation to disclose any oral communication of an invention, made anywhere in the world, that he might know. Consequently, the Office would have that information before it at the time of examining the pertinent application.

892. Mr. HOSOE (JPA) stated that his Organization supported the inclusion of subparagraph (c) because it considered that the process of obtaining evidence abroad was too complex and difficult. In addition, he drew attention to the problem that arose out of the fact that the witnesses of the facts referred to in subparagraph (c) were not always subject to the jurisdiction of the Contracting Party where the application was filed.

893. Mr. GOLDRIAN (BDI) stated the support of his Organization for the principle of absolute novelty.

894. The CHAIRMAN pointed out that there was a significant number of delegations that were opposed to the inclusion of subparagraph (c) in paragraph (2) of Article 11. Consequently, it did not have the necessary support to be considered as a basis for further discussions.

895. The CHAIRMAN, as far as the proposal of the Delegation of the United States of America was concerned, noted that while a number of delegations had supported it, several others had stated their opposition. Before finalizing the discussion on the proposal, he invited the Delegation of the United States of America to clarify when a matter was not identified or organized in a manner that made it accessible to the public.

896. Mr. KIRK (United States of America) stated that it was not the aim of the proposal of his Delegation to exclude any matter contained in documents that were not "well arranged" as was suggested by one speaker. As an example of a matter that was not identified and organized in a manner that made it accessible to the public, he indicated the case of a thesis, prepared for a

college, which was not indexed and was not actually available to the public since the latter could not reasonably know where it was. The search for such a thesis would require monumental work. In order to achieve legal security, the proposal of the United States of America would permit Contracting Parties to exclude such kind of matters from the prior art.

897. Mr. BOGSCH (Director General of WIPO) wondered whether a compromise could not consist of inserting the words "and effectively accessible" in the last part of subparagraph (b) which then would read as follows "has been made available and effectively accessible to the public anywhere in the world."

898. The CHAIRMAN stated that, seemingly, there were two possible approaches to meet the concern expressed by the Delegation of the United States of America, namely, the one suggested by the Director General and one consisting in the inclusion in the explanatory notes or in the summary minutes of an agreed statement.

899. Mr. SCHAEFERS (Germany) stated that his Delegation had sympathy for the concern of the Delegation of the United States of America and that it understood that there was no formula to provide mathematical security. He drew the attention of the Committee to the fact that, while the proposal of the United States of America was placed in the context of local novelty, the suggestion of the Director General concerned the definition of universal novelty. That was a cause of hesitation for his Delegation that was very much attached to the general concept of availability contained in paragraph (2). For that reason he preferred that the concern of the Delegation of the United States of America be addressed in a common statement of interpretation.

900. Mr. BOGSCH (Director General of WIPO) stated that his suggestion was fully consistent with the principle of universal novelty.

901. Mr. WALLIN (IFIA) stated that he saw certain contradictions in the proposal by the Delegation of the United States of America because use could never be identified or organized in a manner that made the matter accessible to the public. His Organization was opposed to the proposal by the Delegation of the United States of America.

902. Mr. ORANGE (PTIC) stated that his Organization opposed the proposal by the Delegation of the United States of America. He wondered whether that proposal was consistent with the jurisprudence of the courts of the United States of America.

903. Mr. SANTARELLI (AIPPI) stated that his Organization considered that the proposal of the United States of America, as well as the proposal of the Director General, would introduce complexities and difficulties which were not necessary. In his view the interpretation of the term "available" should be left to the courts.

904. Mr. JENNY (Switzerland) sought, from the Delegation of the United States of America, clarification as to the meaning of the terms "accessible" and "available."

905. Mr. KIRK (United States of America), in response to the previous speaker, stated that "available" meant that something existed whereas "accessible" meant that it could be found.

906. Mr. SHACHTER (Israel) stated that, whatever was the result of the discussion on this matter, it was clear that the terms "available" and "accessible" would have to be interpreted by the courts. As far as the suggestion by the Director General was concerned, he suggested that it should be re-phrased so that the formula suggested by the Director General could be understood as part of the notion of availability and not as establishing an additional criteria, namely, accessibility. He suggested that the last sentence of paragraph (2) be reworded to read "has been made available in that it is accessible to the public anywhere in the world."

907. Mr. SUGDEN (United Kingdom) stated that his Delegation opposed the proposal of the United States of America, as well as an explanatory note drafted along those lines. Absolute novelty meant that the patent could not be given to a second inventor. He recalled that experience showed that opposition proceedings were generally based on information contained in patents; the main risk to applicants and patentees was from documents which would be regarded as accessible. As far as the suggestion of the Director General was concerned, his Delegation was not of the view that a new criterion--accessibility--should be added to the existing one--availability. In his view, it was for the courts to interpret the scope and meaning of the notion of availability.

908. Mr. UEMURA (Japan) stated that his Delegation did not support the suggestion of the Director General, since it would create uncertainties.

909. Mr. KOLLE (EPO) stated that the term "available to the public" was well known in very many national legal systems and that it had not given rise to any major difficulty. His Delegation was opposed to any further definition of that term because, in fact, its actual meaning would depend very much on the actual circumstances of a given case. He underlined that the reference to public should be understood as a reference to a person skilled in the art. He stated that the proposal of the Delegation of the United States of America would give the right to Contracting Parties to exclude certain matters from the prior art. His Delegation was of the view that the notion "prior art" should be the same all over the world.

910. Mr. ORTEGA LECHUGA (Spain) stated that the discussion showed that the definition of what was accessible to the public was a matter of interpretation where courts should play an important role. He stated that there was a difference between what was accessible to the public and what was made accessible to the public. In the latter case there was an action facilitating the accessibility of the public.

911. The CHAIRMAN noted that there was no support for the proposal of the Delegation of the United States of America and only some support for the suggestion of the Director General.

912. Mr. SCHAEFERS (Germany) stated that in Article 2, paragraph (viii), and in Rule 1, paragraph (3), there were references to what was accessible to the public, in both cases in the context of publications. It was clear to him that in the basic proposal there was a fine distinction between what was understood by accessible to the public in the context of patent documentation, on the one hand, and in the context of the definition of novelty in paragraph (2), on the other hand. In the latter case, it was clear that the notion had a broader scope. He stated that the suggestion of the Director

General, whereby the notion of accessibility would be added, could be considered as to restrict the meaning of the term availability in the context of the definition of novelty.

913. Mr. IANNANTUONO (Italy) stated that the proposal by the Delegation of the United States of America was far removed from the principle of absolute novelty which was supported by his Delegation. He, therefore, expressed the opposition of his Delegation to that proposal.

914. Mr. BAKER (Australia) stated that his Delegation opposed the proposal of the Delegation of the United States of America for the reasons already expressed by the Delegations of the United Kingdom, Japan and others. He also said that many countries have a long tradition of using any item of published information irrespective of how it is published. This system has worked well and we should not be in a hurry to throw this out and adopt the proposal of the Delegation of the United States of America in PLT/DC/50.

915. Mrs. NUORLATHI-SOLARMO (Finland) stated that her Delegation opposed the proposal of the Delegation of the United States of America for the reasons mentioned by the Delegation of the United Kingdom. The definition of what was to be meant by available to the public should be left to the jurisprudence of national courts.

916. Mr. NEERVOORT (Netherlands) stated that his Delegation was of the view that the proposal by the Delegation of the United States of America, as well as the suggestion of the Director General, would affect the notion of novelty. For that reason he expressed the support of his Delegation for the text contained in the basic proposal.

917.1 The CHAIRMAN stated that the discussion had shown that the proposal by the Delegation of the United States of America, contained in document PLT/DC/50, had not received the necessary support. He also mentioned that the discussion had shown a significant support for the principle of universal novelty.

917.2 He then turned to paragraph (3) of Article 11. He recalled that there was a proposal by the Delegation of the United States of America, reproduced in document PLT/DC/6.

918.1 Mr. KIRK (United States of America) stated that his Delegation did not request a discussion of its proposal concerning paragraph (3), because that proposal had to be examined in the light of the results of the discussion on Article 9.

918.2 As far as paragraph (2)(a) of the basic proposal was concerned, his Delegation was of the view that its second sentence should be deleted. That sentence stated that, for the determination of novelty, items of prior art may only be taken into account individually. He stated that the discussions on the notion of novelty in the Committee of Experts revealed that there was no agreement as to whether the definition of novelty should be strict or somewhat loose or flexible.

919. The CHAIRMAN drew the attention of the Committee to paragraph 11.01 of document PLT/DC/4 which contained a note on paragraph (2)(a) of Article 11. That note stated that the second sentence of paragraph (2)(a) meant that a

"mosaic" approach to assessing novelty could not be used. According to a "mosaic" approach, a plurality of items in the prior art could be combined to defeat the novelty of an invention.

920. Mr. KIRK (United States of America) stated that his Delegation was aware of the note referred to by the Chairman. However, it drew the attention of the Committee to the fact that that note did not address the question of common knowledge, particularly whether and to what extent an examiner should take common knowledge into account in determining novelty.

921. The CHAIRMAN asked whether any delegation supported the oral proposal of the Delegation of the United States of America. Since no delegation supported that proposal, he asked whether there were any other comments on Article 11.

922. Mr. BAKER (Australia) stated that in his country the mosaic approach was not used except in rare cases where the application contained cross-references. He then asked whether that case was covered by paragraph (2).

923. The CHAIRMAN, in response to the preceding speaker, stated that it would be possible to take into account, by a reference, what was contained in one item of prior art.

924. Mr. SUGDEN (United Kingdom) stated that his Delegation was in agreement with the prohibition of the mosaic approach. However, he was of the view that the second sentence of paragraph (2)(a) could be improved or, alternatively, the note in paragraph 11.01 of document PLT/DC/4 could be expanded so as to make clear that common knowledge should be taken into account. As concerns paragraph 2(h) of Article 11, he drew the attention of the Committee to the fact that in order to claim priority there would have to be a valid claim as was stated in paragraph 11.02 of document PLT/DC/4. He suggested that the Drafting Committee take that into account when examining paragraph (2)(b).

925. Mr. UEMURA (Japan) expressed the sympathy of his Delegation for the proposal of the United States: common knowledge should be taken into account in the determination of novelty.

926. The CHAIRMAN drew the attention of the Main Committee to the discussion that took place in the Committee of Experts where it was understood that the claims, as well as the prior art, were to be examined by persons skilled in the art.

927. Mr. JAYASINGHE (Sri Lanka) stated that, in accordance with Article 11, in order to be patentable, an invention should be novel, should involve an inventive step and should be either useful or industrially applicable. He noted that the notion of novelty was defined in paragraph (2) and inventive step in paragraph (3) of Article 11, whereas no definition was provided for in respect of the term "useful" and "industrially applicable." He wondered whether such a definition could be included.

928. The CHAIRMAN recalled that the Committee of Experts had considered the matter raised by the Delegation of Sri Lanka but could not arrive at any definition of the terms in question.

929. Mr. JAYASINGHE (Sri Lanka) suggested that the term "industrially applicable" could be defined by reference to an invention that could be made or used in any kind of industry.

930. The CHAIRMAN noted that that was the definition contained in Article 33(4) of the PCT, but he wondered whether it would be possible to define the term "useful."

931. Mr. HIEN (Burkina Faso) requested clarification as to the meaning of the term "conditions" in the heading of Article 11.

932. The CHAIRMAN, in response to the preceding speaker, stated that Article 11 referred to the conditions, other than formal, necessary for the granting of a patent.

Article 12: Disclosures Not Affecting Patentability (Grace Period)

933. The CHAIRMAN then invited the Committee to consider Article 12. He recalled that the grace period was at the origin of the work of the Committee of Experts. In respect of Article 12 there was no proposal for amendment.

934. Mrs. ØSTERBORG (Denmark) speaking on behalf of the Delegations of Belgium, Finland, France, Norway, Sweden and its own, stated that, during the Committee of Expert meetings, all those Delegations had expressed their opposition to inclusion of a novelty grace period in the Treaty and added that they continued to be opposed to such a provision. However, she noted, if the Treaty was to provide for the mandatory application of the first-to-file principle, those Delegations would be prepared to consider a novelty grace period combined with a mandatory Article on prior user's rights.

935. Mr. NEERVOORT (Netherlands) recalled that there was a package deal where the provision concerning the grace period was linked to the first-to-file principle.

936. Mr. JENNY (Switzerland) stated that the grace period should be included as part of a well-balanced package deal.

937. Mr. ORTEGA LECHUGA (Spain) stated the support of his Delegation to the statement of the preceding speaker. Article 12 should be part of an overall agreement including other Articles.

938. Mr. SEGURA (Argentina) drew the attention of the Committee to the need to discuss paragraph (1) of Article 12 in connection with the proposal of the Delegation of the United States of America concerning Article 9^{bis}, paragraph (2).

939. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for an overall package deal which would include a mandatory reference to the first-to-file principle, on the one hand, and to the grace period, on the other.

940. Mr. UEMURA (Japan) recalled that his Delegation had some difficulties with the grace period. Article 12 could only be kept in the context of a grand package which would include agreement on other Articles such as 9, 10 and 22.

941. Mr. SCHAEFERS (Germany) stated that his Delegation attached great importance to the grace period. He expressed his satisfaction that, subject to the condition of agreement on a package made by some delegations, a consensus was emerging on Article 12.
942. Mr. ABATZIS (Greece) stated that his Delegation agreed with the position set forth by the Delegation of Denmark.
943. Mr. GARIEPY (Canada) expressed the support of his Delegation for Article 12 and the package deal.
944. Mr. KIRK (United States of America) expressed the support of his Delegation for Article 12 on its own merits; it was beneficial for inventors to have a grace period.
945. Mr. WALLIN (IFIA) expressed the support of his Organization for Article 12 with or without a package deal. He added that, in the view of his Organization, paragraph (3) was essential.
946. Mr. BAKER (Australia) suggested deleting paragraph (4) of Article 12 in order to leave that matter, particularly the determination of the burden of proof, to the national legislation of each Contracting Party. In as far as paragraph (3) was concerned he expressed the support of his Delegation to that paragraph but suggested supplementing it with a provision according to which applicants would have to inform the relevant Office of any disclosure that they may know.
947. Mr. PARK (Republic of Korea) expressed that his delegation could not accept the text of Article 12. However, he noted that the grace period could be dealt with in the context of a package deal.
948. Mr. HATOUM (Lebanon) expressed the support of his Delegation for Article 12.
949. Mr. BETON (UNICE) expressed the support of his Organization for Article 12, but only in the context of a package deal. He suggested deleting the terms "directly or indirectly" from paragraph (1)(ii) and supported the last suggestion of the Delegation of Australia.
950. Mr. PARKES (UEPIP) suggested a drafting amendment to paragraph (2) so that it read as follows: "for the purposes of paragraph (1), 'inventor' also means any person who, at or before the filing date of the application, had the right to the patent."
951. Mr. NEUKOM (CIPA) suggested that the term "during" in paragraph (1) be deleted and replaced by the term "not earlier than." He stated that a drafting change was necessary in order to provide for cases that could take place after the 12-month period. He had in mind possible disclosures under paragraph (1)(ii).
952. Mr. SALIM (Syria) stated that, in accordance with paragraph (4) of Article 12, the party invoking the effects of paragraph (1) would have the burden of proof, or of making the conclusion likely, that the conditions of that paragraph were fulfilled. He requested clarification as to the meaning of the word "likely." He expressed the support of his Delegation for the Article 12.

953. Mr. BOGSCH (Director General of WIPO), in response to the previous speaker, stated that "likely" meant "probable."
954. Mr. SANTARELLI (CNIPA) stated that the majority of the members of his Organization were in favor of the first-to-file principle and that there were different views on Article 12.
955. Mr. SUGDEN (United Kingdom) supported the suggestion made by the representatives of UPEPI and CIPA concerning the drafting of Article 12.
956. The CHAIRMAN noted the suggestions concerning the drafting of Article 12. He then concluded that few delegations expressed their support for Article 12 in the absolute. However, a very large number of delegations stated that they could accept that Article in the context of an overall package, particularly including the mandatory adoption of the first-to-file principle.
957. Mr. UEMURA (Japan) stated that his Delegation had difficulties with the time limits specified in paragraph (1) of Article 12 and suggested reducing it to six months.
958. Mr. SEGURA (Argentina) requested clarification of the effect of paragraph (2) of Article 9**bis** on the grace period. He wondered whether it would entail an extension of the grace period.
959. Mr. KIRK (United States of America) stated that his Delegation had proposed paragraph (2) of Article 9**bis** in order to cover the situation, for instance, where an inventor wished to ensure that an invention worked properly and was required to experiment and, therefore, disclose it. In the view of his Delegation, it would be appropriate to allow Contracting Parties to provide that the right to a patent should not be lost in cases where experimental use was necessary.
960. Mr. SEGURA (Argentina) drew attention to paragraph (1)(i) of Article 9**bis** and expressed the view that the time limit provided therein was too long.
961. Mr. KIRK (United States of America) stated that paragraph (1) of Article 9**bis** had been discussed in a previous meeting of the Committee and it concerned the loss of right whereas paragraph (2) of Article 9**bis**, which he believed to be the matter under discussion, concerned experimental use.
962. Mr. BRUNET (NYPTC) stated that experimental use may be necessary for a period longer than 12 months.
963. Mr. SUGDEN (United Kingdom) was not favorable to the exception for public experimental use. However, he stated that the matter needed further discussion.
964. The CHAIRMAN adjourned the meeting.

Eleventh Meeting
Thursday, June 13, 1991
Afternoon

Article 13: Prior Art Effect of Certain Applications

965.1 The CHAIRMAN opened the meeting and indicated that draft Article 13 would be taken up next. He stated that there were four proposals with respect to the draft Article: two from the Delegation of the United States of America, contained in documents PLT/DC/6 and 51, one from the Delegation of Sweden, contained in document PLT/DC/11 and one from the Delegation of Japan, contained in document PLT/DC/19.

965.2 He indicated that the proposal of the Delegation of the United States of America, contained in document PLT/DC/6, was part of the details related to the proposal of that Delegation to have the option to retain the first-to-invent system. He noted that, since there had been an ample discussion on the principle of including in the draft Treaty an option to retain the first-to-invent system, there were no objections to temporarily setting aside the proposal in document PLT/DC/6.

965.3 He then turned to the proposal of the Delegation of Sweden, contained in document PLT/DC/11, relating to draft paragraph (1).

966. Ms. SANDBERG (Sweden) stated that the proposal of her Delegation was to delete the last sentence of paragraph (1)(a) in the text of Article 13 of the basic proposal. She stated that the proposal had been made because her Delegation was opposed to considering the whole contents of a former application to be prior art for the purpose of determining whether an invention satisfied the requirements of both novelty and inventive step (non-obviousness), instead of only for the purpose of determining the novelty of the invention. She stated that the goal of harmonization would be defeated by the the inclusion of optional provisions, such as the one found in the last sentence of subparagraph (a). She indicated that, if that optional provision were retained, it should be as a reservation.

967. The CHAIRMAN recalled that the problem being addressed was whether an application having an earlier filing date or priority date should be applied against a later-filed application for the purpose of determining the novelty of the invention claimed in the later-filed application, for determining whether it involved an inventive step (was non-obvious) or both. The proposal of the Delegation of Sweden was to limit the use of the former application to determining the novelty of the invention claimed in the later-filed application.

968. Mr. MESSERLI (Switzerland) stated that his Delegation supported the proposal of the Delegation of Sweden.

969. Mr. PARK (Republic of Korea) stated that his Delegation supported the proposal of the Delegation of Sweden.

970. Mr. NEERVOORT (Netherlands) stated that his Delegation supported the proposal of the Delegation of Sweden.

971. Mr. OUSHAKOV (Soviet Union) stated that his Delegation supported the proposal of the Delegation of Sweden.

972.1 Mr. KIRK (United States of America) stated that the second sentence of paragraph (1)(a) should be retained, expressing the view that it was the only way to achieve true harmony in respect of the application of the principles of draft paragraph (1) as a whole.

972.2 He stated that the Conference was not ready to come to grips with the concept of novelty and that it was reasonably clear that there would not be common results in the application of the provision of draft paragraph (1)(a) due to different approaches to novelty. In some cases, a strict interpretation of novelty would be applied and patents would be issued having minor differences over the prior art. In other cases the differences would be greater to establish patentability, such as when the concept of "common knowledge" is applied in the context of determining the novelty of an invention.

972.3 He indicated that, to achieve true harmonization, an earlier application must be considered as prior art from its filing date for the purpose of determining both novelty and obviousness. Such an approach would avoid patents being granted on inventions having only obvious differences over inventions claimed in earlier-filed patent applications.

973. Mr. IVÁNYI (Hungary) indicated that his Delegation supported the proposal of the Delegation of Sweden.

974. Ms. LACHOWICZ (Poland) stated that her Delegation supported the proposal of the Delegation of Sweden.

975.1 Mr. SCHENNEN (Germany) stated that his Delegation supported the proposal of the Delegation of Sweden.

975.2 He considered that it would be prejudicial if secret prior art were to be taken into account to determine the obviousness of an invention. He recalled the definitions of novelty and inventive step contained in draft Article 11 and stated that the concept of novelty was intended to facilitate an objective determination as to whether an invention was new, while the concept of inventive step required a determination as to whether an invention merited patentability in view of the inventive activity involved. The consequence of applying the last sentence of draft Article 13(1)(a) would be to deny patentability on the grounds of obviousness based upon prior art that the inventor could not have known about.

975.3 He also indicated that there was a link between the provisions of draft Article 13(1)(a) and draft Article 13(4).

976. Mrs. DIVOY (France) said that her Delegation also supported the proposal made by Sweden for two reasons. Firstly, with regard to the arguments put forward by the American Delegation, her Delegation did not think that the second sentence of the first paragraph of Article 13, as presently

drafted, could solve the problem described. Furthermore, the provision concerned constituted an exception, and as all exceptions, should be interpreted strictly.

977. Ms. BACH (Denmark) stated that her Delegation supported the proposal of the Delegation of Sweden for the reasons given by that Delegation and by the Delegation of Germany.

978. Mr. ENÇ (Turkey) stated that his Delegation supported the proposal of the Delegation of Sweden.

979.1 Mr. KIRK (United States of America) stated that, to the extent that it was unfair to apply a former application for the purposes of determining if an invention claimed in another application satisfied the requirement of inventive step (non-obviousness), it was equally unfair to apply it for the purposes of determining the novelty of that invention. In both cases it was secret prior art that was being applied and no distinction should be made in applying it also between novelty and non-obviousness.

979.2 He also stated that, while it had been argued that it was not fair to apply a former application for determining the non-obviousness of an invention, it was equally arguable that it was unfair to the public to issue two patents for substantially the same subject matter.

979.3 He added that applying a former application for determining both the novelty and the non-obviousness of an invention would also lead to greater consistency and harmonization.

980.1 Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for the proposal of the Delegation of Sweden. He agreed with the Delegation of the United States of America to the extent that that Delegation had suggested that, when considering the whole contents of a former application for determining the patentability of an invention claimed in an application, fairness did not come in.

980.2 He stated that the governing principle was that it was undesirable to have two patents for the same invention granted to different persons. In such a case, the applicant who was second should not get a patent. The question of obviousness raised different considerations. A rough justice was obtained by denying patentability to a second application which was not novel over a first application, but there was no need to extend that rough justice to the question of obviousness.

981.1 Mr. SHACHTER (Israel) stated that if the "whole contents" doctrine raised issues of "morality" it was equally immoral to apply the whole contents of a former application for the purpose of determining novelty of an invention as it was for the purpose of determining whether the invention involved an inventive step (was non-obvious), though it may be convenient to do so.

981.2 There was the danger that, if one did not apply "whole contents" also in connection with non-obviousness, it was possible to issue patents to different applicants of almost the same scope.

982. Mr. PAAERMAA (Finland) expressed the agreement of his Delegation with the statements of the Delegations of Germany and the United Kingdom and stated that he supported the proposal of the Delegation of Sweden.

983. Mr. SANTARELLI (AIPPI) expressed the support of his Organization for the proposal of the Delegation of Sweden.

984.1 Mr. SCHATZ (EPO) stated that the Treaty should be a basis for harmonization of practice of patent offices as well as for further rationalization through cooperation among these offices.

984.2 He recalled that the President of the EPO, Mr. Braendli, had said in his opening statement that at least the provisions defining the state of the art should be harmonized. Reservations by Contracting Parties were seen as running contrary to that basic objective.

984.3 He stated that his Delegation supported the positions taken by the Delegations of the United Kingdom and Germany. He considered that the application of the principle of "whole contents" for the purpose of determining both novelty and inventive step would defeat the interests of both the inventor having filed first and the inventor having filed subsequently.

984.4 He gave the example of a situation where the prior art was considered also in respect of inventive step and where a second application could become prior art for an inventor who had filed a first application, with respect to a later filing on an improvement of that first application. He stated that in a first-to-file system it was normal for an inventor to file later applications directed to improvements of his initial invention, which improvements might or might not be inventive over his first own invention. If, however, the application filed second was given a full prior art effect concerning both novelty and inventive step, it could be used to deny protection for the application including the improvement over the first application. He considered such a result as being counter to the interests of the inventor having filed first.

985. Ms. LILJEGREN (Norway) stated that her Delegation supported the proposal of the Delegation of Sweden.

986. Mr. BULGAR (Romania) stated that his Delegation supported the proposal of the Delegation of Sweden.

987. Mrs. DE CUYPERE (Belgium) said that her Delegation also supported the proposal by Sweden.

988. Mr. RAFFNSØE (FICPI) expressed the support of his Organization for the proposal of the Delegation of Sweden. He stated that the experience with a modified "whole contents" under the European Patent Convention had shown that such a system worked quite easily.

989. Ms. RODRIGUES MITTELBACH (Brazil) stated that her Delegation supported the proposal of the Delegation of Sweden.

990. Mr. CHISUM (AIPLA) stated that there was nothing inherently superior in any of the systems that had been discussed to resolve the senior right problem. He shared concerns that there was a disparity in the manner in which the novelty standard was applied and that, unless this disparity could be eliminated, there could be no harmonization.

991. Mr. BRUNET (NYPTC) stated that his Organization was opposed to the proposal of the Delegation of Sweden. He stated that the provision was dependent upon the definition of novelty, which did not presently exist. If obviousness were accepted in the application of the principle of the "whole contents" then the definition of novelty was less important. He considered that without the application of obviousness, patents not distinct from one another would issue, which would be a burden on third parties.

992.1 The CHAIRMAN cautioned against exaggerating the problem, stating that experience in the European Patent Organization had shown that only 2-3% of applications would be affected. He concluded that, with the exception of the Delegation of the United States of America, all delegations had supported the proposal of the Delegation of Sweden which thus would be part of the basis of further considerations in the Diplomatic Conference.

992.2 He then turned to a discussion of the proposal of the Delegation of Japan, contained in document PLT/DC/19, to add a new subparagraph (d) to paragraph (1) of the basic proposal and invited the Delegation of Japan to present its proposal.

993.1 Mr. UEMURA (Japan) drew the attention of the Committee to Note 13.01, contained in document PLT/DC/4, which read as follows:

"Since the term 'application' only means an application for a patent (see Article 2(i)), applications for other titles protecting inventions (for example, utility models) do not have the prior art effect provided for in Article 13. However, where an application for a patent invokes the priority of an earlier application for a utility model, or other title protecting an invention, the prior art effect of the said application for a patent commences (for matter in both the application and the earlier application for a utility model, or other title protecting an invention, which has been invoked) from the priority date (see paragraph (1)(b))."

993.2 His Delegation considered it to be essential in such systems as in Japan, to prevent "double patenting" in respect of two titles of protection: patents and utility models. The purpose of the proposal of his Delegation was to clarify that the prior art effect of utility model applications in respect of patent applications should be left to national law.

994. The CHAIRMAN observed that Note 13.01 clarified that a prior application was taken into account only if it was an application for a patent. He stated that the Delegation of Japan wanted the option to take into account applications for utility models.

995. Ms. RODRIGUES MITTELBACH (Brazil) stated that her Delegation supported the proposal of the Delegation of Japan. Her country had a system for the protection of utility models. The distinction between an invention and utility model title, in a great number of cases, is a question of level of inventiveness and during the substantive examination many cases of patent invention applications are changed to utility model title. She observed that the prior art effect of a patent was from the priority date, whether that priority date was established on the basis of an application for a utility model or a patent application. She concluded, therefore, that there was no technical or legal reason not to give the option called for in the proposal of the Delegation of Japan.

996. Mr. ROMERO (Chile) stated that protection for utility models was provided for in his country. Given the optional nature of proposed new subparagraph (d), and the arguments put forward by the Delegation of Brazil, his Delegation supported the proposal by the Delegation of Japan.
997. Mr. QIAO (China) stated that the principle of the "whole contents" should apply to both utility models and patents and that, therefore, his Delegation supported the proposal by the Delegation of Japan.
998. Mr. NEERVOORT (Netherlands) indicated that his Delegation had always considered it self-evident that utility model applications would be dealt with in the same manner as patents and only came to a different conclusion upon reading Note 13.01. He stated, therefore, that his Delegation supported the proposal of the Delegation of Japan as it clarified the situation.
999. Mr. IANNANTUONO (Italy) stated that his Delegation supported the proposal of the Delegation of Japan as it would allow his country to keep its legislation the way it was.
1000. Mr. PARK (Republic of Korea) indicated that his Delegation supported the proposal by the Delegation of Japan.
1001. Mr. PAAERMAA (Finland) announced that his country would have new legislation in relation to utility models that would come into effect on January 1, 1992. His Delegation supported the proposal of the Delegation of Japan.
- 1002.1 Mr. KIRK (United States of America) indicated that it was the first time that the draft Treaty, outside of considerations on priority, had considered utility models. He questioned the appropriateness of bringing utility models into the Treaty without consideration of all of the implications. He suggested that the question of utility models and their relationship to draft Article 13, as well as to all of the other Articles of the draft Treaty not be considered until the second part of the Conference.
- 1002.2 He drew attention to the fact that, in Japan, 200,000 utility model applications were filed each year which, potentially, could result in 200,000 pieces of prior art. He stated that this could be a particular disadvantage to foreign nationals seeking patent protection in Japan. While he indicated that it might be appropriate to treat utility models in the manner proposed by the Delegation of Japan, he felt that the matter warranted further study.
1003. The CHAIRMAN recalled that it had been said on many occasions that the draft Treaty applied to one system--the protection of inventions by patent. If a Contracting Party had a system of protection in addition to patents, that additional system need not necessarily comply with the requirements of the draft Treaty.
1004. Mrs. MKWANAZI (Swaziland) supported the proposal of the Delegation of Japan.
1005. Mr. ENÇ (Turkey) stated that the draft law of his country considered utility models as part of the prior art, in the same manner as draft Article 13(1)(a) in the case of patents. He indicated, therefore, that his Delegation supported the proposal of the Delegation of Japan.

1006. Mr. SCHENNEN (Germany) indicated that it would not be necessary for his country to avail itself of the option proposed by the Delegation of Japan, but that his Delegation could support the proposal. He observed that the draft Treaty did not deal with the substantive requirements relating to utility models protection, and that the proposal was limited to a consideration of whether utility models could be secret prior art for the purposes of draft Article 13(1).

1007. The CHAIRMAN indicated that there was no doubt that utility models were part of the state of the art for the purposes of draft Article 11.

1008. Mr. VON ARNOLD (Sweden) supported the position of the Delegation of the United States of America that caution should be exercised in dealing with the matter of utility models in the draft Treaty.

1009. Mr. SUGDEN (United Kingdom), while not opposed to the proposal of the Delegation of Japan, also urged caution. While noting the optional nature of the proposal, he observed that it had not previously been discussed. He expressed the wish to have a background paper to explain the proposal in depth.

1010. Mr. SALIM (Syria) indicated that his Delegation supported the proposal of the Delegation of Japan.

1011. Mr. ORTEGA LECHUGA (Spain) stated that his Delegation supported the proposal of the Delegation of Japan.

1012. Mr. GARIEPY (Canada) expressed sympathy for the proposal of the Delegation of Japan, but urged caution and further study.

1013. Mr. ROMERO (Chile) considered that optional subparagraph (d), proposed by the Delegation of Japan, should also refer to other titles of protection, such as inventors' certificates.

1014. The CHAIRMAN observed that a number of delegations had supported the proposal of the Delegation of Japan, while none had clearly opposed it. Some had urged caution and had considered that it was necessary to examine the context of the proposal and the way in which other Articles of the draft Treaty were affected. He suggested that the drafting of the proposal might be improved, such as by indicating that its provisions only related to utility models as filed in, or with effect for, a Contracting Party, as provided for in draft Article 13(1)(a) in relation to patent applications.

1015. Mr. UEMURA (Japan) indicated that the proposal related to utility model applications filed in the same country where the patent application had been filed. He indicated that his Delegation was flexible in terms of including other titles of invention, stating that in the proposal the words "a utility model" could be replaced with "other titles for the protection for inventions." He stated that, while there was a large number of utility model applications filed in Japan, and the majority were by nationals of his country, the system was open to anyone and the choice of using it or the patent system was left to the applicant.

1016.1 The CHAIRMAN concluded the discussion on the proposal of the Delegation of Japan stating that, subject to some re-drafting which would take into consideration the observations made, it could serve as the basis for further discussions.

Article 13(4): [Self-Collision]

1016.2 He proposed taking up consideration of draft Article 13(4), noting that subparagraph (b) was in brackets and would, therefore, have to be proposed as an amendment to the basic proposal in order to be considered.

1017. Mr. SCHENNER (Germany) stated that his Delegation supported the proposal contained in paragraph (4)(b).

1018. Mrs. SANDBERG (Sweden) stated that her Delegation also supported the inclusion of paragraph (4)(b) in the Treaty.

1019. Mr. KIRK (United States of America) stated that his Delegation opposed the inclusion of paragraph (4)(b) in the Treaty. He expressed the view that it would be unfair to applicants if the Treaty did not mandatorily preclude self-collision. He indicated that the proposal of his Delegation, contained in document PLT/DC/51, to add a new paragraph (5) related also to the question under discussion.

1020. The CHAIRMAN observed that the wording of draft paragraph (4)(b) was not consistent with the conclusion that had been reached in respect of the last sentence of draft paragraph (1)(a).

1021. Mr. OGAWA (APAA) stated that paragraph (4) should be mandatory and that subparagraph (b), thereof, should be deleted. He stated that, if the grace period were adopted, a published disclosure by an inventor would not be prior art with respect to a later-filed application. However, if subparagraph (b) were kept, protection against self-collision would not be available, so that an inventor's unpublished disclosure in an earlier application would be prior art for a later application filed by him, a result which he considered to be unreasonable.

1022. Mr. MESSERLI (Switzerland) stated that his Delegation was not in favor of a provision against self-collision. He stated that, as long as the last sentence of Article 13(1)(a) remained, such a provision would be necessary but that, if that sentence were deleted, there was no need for paragraph (4).

1023. Mr. SANTARELLI (AIPPI) stated that his Organization had always been in favor of a provision excluding self-collision and, therefore, called for the deletion of subparagraph (b).

1024. Mr. BAKER (Australia) questioned whether paragraph (4)(b) should remain if the last sentence of paragraph (1)(a) were deleted.

1025. The CHAIRMAN directed the question of the Delegation of Australia to the Delegation of Sweden since they had proposed the deletion of the last sentence of Article 13(1)(a) and proposed keeping paragraph (4)(b).

1026. Mrs. SANDBERG (Sweden) indicated that her Delegation wished to have paragraph (4) in its entirety if the last sentence of paragraph (1)(a) was retained, but would prefer having no provisions on self-collision at all.

1027. The CHAIRMAN stated that paragraph (4)(b) as it stood would leave the option to Contracting Parties to have self-collision if prior applications are considered prior art only for the purpose of determining novelty. He

questioned, however, whether paragraph (4) would be necessary if the last sentence of paragraph (1)(a) were deleted.

1028. Mr. UEMURA (Japan) stated that his Delegation was against self-collision and supported the deletion of subparagraph (b).

1029.1 Mr. SUGDEN (United Kingdom) stated that, if the last sentence of paragraph (1)(a) were deleted, the preference of his Delegation would be to treat the question of self-collision on an optional basis. Thus, Contracting Parties would be free to establish anti-self-collision provisions, if they chose to.

1029.2 He stated that anti-self-collision provisions could be used by applicants to obtain another 12 months of protection since another application, filed within one year of the filing date of the first application, could lead to the grant of another patent, having a full 20 years of protection from its filing date. He indicated that he wished to listen to interested circles to see if that was a desirable result or not.

1030.1 The CHAIRMAN identified two possible solutions. Firstly, paragraph (4) could be deleted, leaving no possibility to prevent self-collision. Secondly, the provisions of paragraph (4) could be made optional, which could be accomplished by integrating the provisions of subparagraphs (a) and (b) so as to provide that any Contracting Party would be free to provide for anti-self-collision.

1030.2 He then suspended the meeting.

[Suspension]

1031.1 The CHAIRMAN, on the basis of discussions, came to preliminary conclusions in relation to paragraph (4). He recalled that, in relation to the last sentence of paragraph (1)(a), only the Delegation of the United States of America wished to retain it and that all other delegations had supported the proposal of the Delegation of Sweden which called for its deletion. He stated that the position reached as the basis for further discussion was that the last sentence of paragraph (1)(a) should be deleted.

1031.2 With respect to paragraph (4) he saw three alternatives: firstly, paragraph 4(a) could stand by itself and would be mandatory on all Contracting Parties; secondly, paragraph (4) as a whole could be made optional and would include language such as "any Contracting Party shall be free to provide that paragraph (1) does not apply"; and, thirdly, the whole of paragraph (4) could be deleted. He suggested that, with respect to the first two possibilities, it also remained to be considered whether the proposal of the Delegation of the United States of America to introduce a new paragraph (5), contained in document PLT/DC/51, could be added.

1032.1 Mr. SUGDEN (United Kingdom) explained that in his earlier intervention he should have said 18, rather than 12 months. He stated that the first-filed application in the situation to which he referred would be published at 18 months which would destroy the novelty of applications having a later filing date. The second application would have been filed, however, prior to the

date of publication of the first application. The rights in the first application would start at the date of publication, while the term of the second application would start at the filing of the second application. As a consequence, he considered many companies might want to take advantage of that situation.

1032.2 He suggested that, if paragraph (4) were to remain, its provisions should be re-worded so as to avoid reference to the terms "application" and "patent," it being essential that the first and the second applications were made by the same person, having the right to apply.

1033. Mr. NEERVOORT (Netherlands) stated that, based on the assumption that the last sentence of paragraph (1)(a) would be deleted, his Delegation would prefer the deletion of paragraph (4) as a whole. He indicated that, if a number of delegations wished to retain paragraph (4), it could be retained as an optional provision.

1034. Mr. HATOUM (Lebanon) stated that, because his Delegation supported the proposal of the Delegation of Sweden, it was in favor of the deletion of paragraph (4).

1035. Mrs. DE CUYPERE (Belgium) stated that, to the extent that the last sentence of paragraph (1)(a) was deleted, her Delegation favored the deletion of paragraph (4)(a).

1036.1 Mr. KIRK (United States of America) expressed the desire to take up consideration of the proposal of his Delegation contained in document PLT/DC/51 to add a new paragraph (5) to Article 13.

1036.2 He observed that the current formulation of paragraph (4) included subparagraphs (a) and (b), with subparagraph (b) optional. Of the proposals for change that had been discussed, he indicated that his Delegation preferred retaining subparagraph (a) of paragraph (4) by itself. This would establish a rule against self-collision. He observed that, if paragraph (4) were deleted in its entirety, self-collision would be mandatory.

1036.3 As to the concern expressed that the patent term might be extended in the absence of self-collision, he stated that that problem would be addressed by a combination of the provisions of paragraph (4)(a) and proposed paragraph (5). He stated that the provisions of the proposed paragraph (5) would not require that the whole contents of an earlier application be applied to a later one, but that it would prevent the issuance of two patents to the same inventor or applicant for the same invention.

1036.4 He also stated that the problem of the issuance of patents on obvious variations could be addressed with terminal disclaimers.

1037. Mrs. SANDBERG (Sweden) stated that her Delegation supported the deletion of paragraph (4).

1038.1 Mr. SCHENNEN (Germany) stated that his Delegation was in favor of keeping the gist of subparagraph (b) and keeping subparagraph (a) optional. He stated that the general topic under discussion was that of novelty, which meant there should have been no identical preceding publication and which was to be assessed without a mosaic approach. Paragraph (4) was addressed to

identical inventions, so that, if something was added to one invention, it would be new. He could see no reason to let an applicant file an application for the same thing again. Moreover, he stated that his country did not want to be obliged to issue applications to two identical inventions.

1038.2 To allay fears that an applicant might be denied protection of an invention described in an application, but not claimed, he pointed out that draft Article 14 would allow a modification of the claims, provided they were supported by the original disclosure.

1038.3 He stated that his Delegation wanted at least the faculty to continue the practice under the European Patent Convention that the prior art effect of an earlier application was applied without regard to the identity of the applicant.

1039.1 Mr. UEMURA (Japan) supported the proposal of the Delegation of the United States of America, in particular as calling for a combination of paragraph (4)(a) and proposed paragraph (5), but only on the understanding that terminal disclaimers were not obligatory for all.

1039.2 He stated that, in countries where novelty was very narrowly interpreted, there was no harm in having self-collision provisions, but since there was no guarantee that it would be narrowly interpreted he still had concerns about the matter.

1040. Mr. OUSHAKOV (Soviet Union) stated that it was not acceptable to his Delegation to allow two claims or applications for one invention. He therefore urged the deletion of paragraph (4). He stated, however, that, if paragraph (4)(a) was kept as an option, his Delegation would support the proposal of the Delegation of the United States of America to add a new paragraph (5).

1041. Mr. MESSERLI (Switzerland) recalled that his Delegation was against anti-self-collision provisions and stated that his Delegation therefore supported the deletion of paragraph (4), for the reasons given by the Delegation of the United Kingdom. He stated that the only situation in which it would be desirable to retain paragraph (4)(a) and (b) would be if the last sentence of paragraph (1)(a) were retained.

1042. Mrs. LINCK (AIPLA) stated that her Organization was very strongly in favor of Article 13. She recalled that resolutions of her organization had expressed support for the first-to-file system as part of a package including the provisions found in the last sentence of paragraph (1)(a) and paragraph (4). She indicated that deletion of those provisions from the draft Treaty would jeopardize the support of her Organization for the proposed Treaty.

1043. Mr. BAKER (Australia) stated that his Delegation supported the position of the Delegation of the United States of America to retain paragraph (4)(a) and to adopt a new paragraph (5).

1044. Mr. KAMEL (Egypt) expressed the support of his Delegation for the basic proposal, with the exception of paragraph (3), since his country was not a member of the Patent Cooperation Treaty (PCT). He indicated that his Delegation supported the proposal of the Delegation of Sweden for the deletion

of the last sentence of paragraph (1)(a). He further stated that his Delegation supported the proposal to delete paragraph (4) or retain only the provisions found in paragraph (4)(a).

1045. Mr. SHACHTER (Israel) stated that his Delegation supported the position of the Delegation of the United States of America to retain paragraph (4) and to add the proposed paragraph (5).

1046. Mr. PARK (Republic of Korea) indicated that his Delegation supported the proposal of the Delegation of the United States of America to combine paragraph (4) with the proposed new paragraph (5).

1047.1 Mr. BETON (UNICE) indicated that the matters under discussion had been widely discussed in European industrial circles and that the general conclusion was one of satisfaction with the European Patent Convention and a desire to have it preserved. He stated that his Organization preferred that draft paragraph (4) be cancelled with or without the last sentence of draft paragraph (1)(a). He stated that his Organization disapproved of double patenting, and could support the proposal by the Delegation of the United States of America in that regard.

1047.2 He expressed concern that, if anti-self-collision is associated with whole contents limited to novelty, one could get a "cloud" of little patents. In particular, he pointed to the provisions of Article 21 which called for claims to be considered to cover equivalents. He pointed out that the proposal of the Delegation of the United States of America did not talk of overlapping extent of protection but to overlapping claims.

1048.1 Mr. RAFFNSØE (FICPI) stated that his Organization favored retaining paragraph (4). He supported the observation made by the APAA that it was unfair and illogical to excuse certain disclosures by an inventor as a consequence of the grace period provisions, while not including secret earlier disclosures in a patent application.

1048.2 He stated that it frequently occurred in practice that an application was drafted with certain information withheld so as to prevent self-collision should a later application be filed. He saw the provisions of paragraph (4) as providing benefits to both applicants, in preventing self-collision, and the public, in encouraging greater disclosure.

1048.3 He recalled that a statement had been made that there was no need for anti-self-collision since the prior art effect of an application was limited to novelty. He stated, however, that the situation was more complex than that. He postulated an application directed to a chemical compound, a first application for which did not include the results of an experiment which revealed ranges and examples to support a broad claim. A broad claim could not be obtained in a second application due to the prior art effect of the first application, nor could the broad claims be obtained in the first application due to the lack of examples to support such a claim.

1049. Mr. BULGAR (Romania) stated that his Delegation felt that paragraph (4) should be optional, supplemented as proposed by the Delegation of the United States of America by a new paragraph (5) to prevent double patenting.

1050. Mr. SEGURA (Argentina) stated that his Delegation supported the deletion of the last sentence of draft paragraph (1)(a) and the retention of paragraph (4)(a). He wondered how two patents having the same claims could be granted to the same applicant.

1051. Ms. RODRIGUES MITTELBAACH (Brazil) stated that her Delegation supported the retention of paragraph (4) in an optional form and the addition of new paragraph (5), as proposed by the Delegation of the United States of America.

1052. Mr. SANTARELLI (CNCBI) stated that his Organization was in favor of paragraph (4)(a) as being more favorable to the applicant.

1053. Mr. SCHATZ (EPO) stated that his Delegation considered that, whether paragraph (4)(a) was to be maintained as an optional or a mandatory provision, it should only relate to true cases of self-collision. He also stated that, if it were based only upon the identity of the inventor, there might be no proper basis for excluding self-collision, such as were the inventor switched from one employer (who had filed a first application) to another (who had filed a second application). Similarly, if the applicants were originally different for two applications but, as a consequence of assignment, came to be the same, self-collision should not be excluded.

1054. Mr. PARKES (UEPIP) endorsed the position of UPEPI and urged the adoption of paragraph (4)(a), in conjunction with the proposed paragraph (5). He stated that the absence of anti-self-collision provisions lead to an injustice if there was a full disclosure of subject matter in an earlier application which the same applicant sought to claim in a later application.

1055. Mr. WALLIN (IFIA) stated that his Organization felt that the last sentence of paragraph (1)(a) and paragraph (4)(b) should be deleted and that paragraph (4)(a) should remain in the draft Treaty. In his view, the proposal of the Delegation of the United States of America should be accepted if paragraph (4)(a) were retained.

1056. Mr. SUGDEN (United Kingdom) stated that, although his Delegation supported the proposal of the Delegation of the United States of America in document PLT/DC/51 in principle, as worded, its operation was not clear. In particular, he felt it was unclear as to what the consequences would be in the event there were two applications claiming identical subject matter. In such a case, he wondered which of the two applications would be subject to refusal or revocation. Moreover, he wondered whether the two applications would be allowed to continue if only one or several, but not all, of the claims were to identical subject matter. He noted that internal priority provisions would allow an applicant to file divisional applications having a common filing date.

1057. Ms. KRUDO SANES (Uruguay) stated that her Delegation considered that paragraph (4)(a) should be optional and that the proposed new paragraph (5) should be added to the draft Treaty.

1058. Mr. SCHENNEN (Germany) indicated that his Delegation joined in the concerns raised by the Delegation of the United Kingdom in respect of the proposal of the Delegation of the United States of America to add a new paragraph (5). He stated that its provisions were too broad and might lead to a situation where an Office must revoke overlapping claims, which he saw as being contrary to the philosophy behind paragraph (1).

1059. Mr. CHISUM (CASRIP) stated that his Organization felt there should be no self-collision as the administrative inconvenience was outweighed by the danger of the possible loss of protection for certain subject matter as a result of self-collision.

1060. Mr. HOSOE (JPA) stated that his Organization believed that paragraph (4)(a), in combination with proposed paragraph (5), should be retained. He considered that it would be necessary to protect inventors and applicants that may lose rights due to lack of knowledge about filing procedures.

1061. Mr. OGAWA (APAA) supported the combination of paragraph (4)(a) and the proposed new paragraph (5). He observed that the main problems raised against anti-self-collision provisions had been the possibility of double patenting and the possible extension of the patent term. In respect of double patenting, he stated that the proposed new paragraph (5) obviated it. In respect of the extension of patent term, he stated that, if an invention claimed in a junior application was directed to substantially the same invention as in the senior patent application, then the junior application would be rejected. He stated that there was a need to define the terms used in the proposed draft paragraph (5), in particular the term "identical subject matter."

1062. Mrs. PURI (India) stated that Article 13 as a whole was at variance with the Indian Patents Act in that, in accordance with that Act, rejected and abandoned, but published applications were also considered for prior art purposes. Further, only the claims, and not the whole contents, of a former application were considered in the novelty examination, but after acceptance of the application for opposition the whole contents of the former application were considered for a determination of both novelty and inventive step. She indicated that while her Delegation recognized the need for harmonization, she wished these points to be taken into consideration by the Committee.

1063. Mr. BRUNET (ABA) stated that his Organization supported making paragraph (4)(a) at least optional and deleting paragraph (4)(b). Thus, a Contracting Party could provide no self-collision where the inventor or the applicant were the same. He shared the concern of a proliferation of similar patents to different entities and the extension of the term of patent protection. He suggested, in response to those concerns, modifying the first line of paragraph (4)(a) to replace the word "when" with "so long as." Thus, if at a later time the ownership of the two patents were split, the benefits of anti-self collision would no longer apply. He also urged that provision be made such that the term of the second, or junior, patent end at the same time as the term of the first, or senior, patent.

1064. Mr. BETON (UNICE) identified two different problems under discussion: firstly, that of overlapping protection and, secondly, that of the existence of unclaimed subject matter in a senior application. As to the first problem, overlapping protection, he felt that it should not be allowed as a form of double patenting and as to the second problem, he felt that there should be some protection, provided that it did not lead to overlapping protection.

1065. Mr. SCHATZ (EPO) stated that his Delegation felt that the proposal by the Delegation of the United States of America in document PLT/DC/51 proposing a new paragraph (5) presented special problems for the European Patent

Organization (EPO). He stated that applications directed to the same invention could be filed in parallel with national office and with the EPO. This problem was taken care of after grant and it was left to the Contracting States to deal with it in their own legislation. Consequently, this should be taken into consideration in the drafting of the proposal.

1066.1 The CHAIRMAN noted that several speakers had expressed fears with regard to disclosure of a second invention, of an improvement that was to be found in the prior application, but which had not been claimed and which was capable of being invoked in opposition to a second application. He pointed out that the possibility existed in such cases of making a divisional application and that there was a Rule on divisional applications. Such divisional applications could be filed during a fairly long period and, if there had truly been a disclosure in the prior application, there was no difficulty in obtaining allocation of the filing date of the initial application for the divisional application.

1066.2 To conclude, he noted that views were very divided on the various possibilities he had attempted to outline when discussions had been resumed following the break. There was nevertheless a slight majority in favor of what was known as the optional solution and that would indeed seem to be more or less the possible compromise that would perhaps enable the somewhat diverging views to be reconciled. That would be paragraph (4) in an optional form taking as a basis the wording of subparagraph (a), but making it optional by the addition of words such as "Any Contracting Party may provide that"

1066.3 He noted that several delegations, that had supported that solution, had expressed a wish to add a paragraph (5) derived from the proposal made by the United States of America. He observed that those delegations were generally agreed on the objective of such a provision, but perhaps somewhat less in agreement on its formulation, and that the remarks that had been made were perhaps a little more than just editorial matters. He suggested that the delegations resume discussions the following day on the concept which was the basis of the proposal by the Delegation of the United States of America (contained in document PLT/DC/51).

1067. Mr. NEERVOORT (Netherlands) endorsed the statement of the European Patent Organization and drew attention to a concern that the proposal of the Delegation of the United States of America might not be compatible with registration systems.

1068. The CHAIRMAN closed the meeting.

Twelfth Meeting
Friday, June 14, 1991
Morning

Article 13: Prior Art Effect of Certain Applications (continued from paragraph 1068)

1069.1 The CHAIRMAN opened the meeting and summarized the provisional conclusions of the discussions of the preceding day on Article 13.

1069.2 He stated that there was a certain majority in favor of a wording which would make the provision in Article 13(4) optional.

1069.3 He noted that several delegations had supported the proposal made by the Delegation of the United States of America, contained in document PLT/DC/51, which was to add a new paragraph (5) stipulating that not more than one patent would be granted on two or more applications by the same applicant or inventor to the extent that they claimed identical subject matter.

1069.4 Three questions with respect to the proposal by the Delegation of the United States of America contained in document PLT/DC/51 had to be clarified before the delegations took a position. Firstly, he noted that the current wording of the proposal could only apply to Offices that had a substantive examination system. If there was a general wish to extend the rule contained in the proposal to all Offices, the wording would have to be reexamined to make the first sentence say that there could only be one valid patent. Secondly, he noted that the Delegations that had supported the proposal by the Delegation of the United States of America had all done so in connection with paragraph (4) of Article 13. Consequently, it would have to be specified that paragraph (5) applied to the Contracting Parties that chose to apply paragraph (4). Thirdly, he noted that the wording of paragraph (5) would have to allow for the problem raised by the Delegation of the EPO, that had observed that, under the European system, it was possible for a national patent and a European patent containing claims to identical subject matter to be granted for the same territory. The same problem existed with regard to the PCT and also those States that applied internal priority.

1069.5 He suggested that, should Main Committee I be in favor of such a paragraph (5), the task of examining the wording and submitting a new text to the second part of the Conference should be entrusted to the Secretariat.

1070. Mr. SCHENNEN (Germany) announced that his Delegation had drawn up a new written proposal on the basis of the summary made by the Chairman the preceding day. He asked whether the Chairman would like his Delegation to present that proposal at once or whether he preferred to leave it until the discussions the following week.

1071. The CHAIRMAN asked the Delegations whether they agreed to postpone the examination of the new proposal by the Delegation of Germany to the discussions the following week.

1072. Mr. KIRK (United States of America) stated that his Delegation wished to leave the question of preparing a new draft of paragraph (5) of Article 13 to the Secretariat and to return to that new draft in the second part of the Conference. If the alternative course of discussing new proposals during the first part of the Conference were to be followed, his Delegation would wish to be aware of that course of action since it might itself wish to prepare other proposals.

1073. Mr. TALUKDAR (Bangladesh) asked whether any Delegation could clarify for him the circumstances in which an applicant would submit more than one application so as to call for the possible application of the rule that only one patent could be granted in respect of the same invention. He also asked whether the proposal of the United States of America contained in document PLT/DC/51, was intended to apply only to prohibit one and the same Contracting Party from granting more than one patent in respect of identical subject matter.

1074. The CHAIRMAN observed, in reply to the second question by the Delegation of Bangladesh, that the proposal by the Delegation by the United States of America concerned the granting of more than one patent with effect in a single Contracting Party. He referred the first question to the Delegation of the United States of America.

1075. Mr. KIRK (United States of America) stated that a situation could easily arise in which an applicant filed a first application that contained a very extensive disclosure and claimed more than one invention. Subsequently, the applicant might file another application that claimed certain of the unclaimed parts of the first application. In such a situation, the possible application of the rule against granting more than one patent in respect of identical subject matter might need to be examined.

1076. Mr. TALUKDAR (Bangladesh) asked whether the discussion did not therefore concern the question of complete or incomplete applications.

1077.1 The CHAIRMAN concluded that the task of drafting a new paragraph (5) according to the proposal by the Delegation of the United States of America, contained in document PLT/DC/51, was to be entrusted to the Secretariat, that would also take into account the proposal made by the Delegation of Germany.

1077.2 He proposed to move to Article 14 (Amendment or Correction of Application). He announced that there had been a proposal for amendment by the Delegation of Israel, contained in document PLT/DC/65, to insert a new paragraph (4). He suggested that delegations should first examine paragraphs (1) to (3) of the text of Article 14 in the basic proposal. He observed that there were no proposals for amendment of those paragraphs.

1078. Mr. UEMURA (Japan) stated that, before the discussion commenced on Article 14, his Delegation wished it to be recorded that it reserved its position on the proposal of the Delegation of the United States of America, contained in document PLT/DC/51. Although his Delegation had sympathy for that proposal, it also had difficulty in accepting the notion of a terminal disclaimer. It wished its position to be taken into account in the process of preparing a new draft of paragraph (5) for Article 13.

1079. The CHAIRMAN observed that the Secretariat would of course take into account all comments made during the discussions. He moved to Article 14 (Amendment or Correction of Application).

Article 14: Amendment or Correction of Application

1080.1 Mr. VAN HORN (United States of America) stated that his Delegation wished to raise two questions concerning paragraphs (1) and (2) of Article 14.

1080.2 In relation to paragraph (1), his Delegation wished to clarify that, where a continuing application was filed which claimed exactly the same subject matter as the parent application and the Office had already allowed an opportunity for amendment or correction in respect of the parent application, the Office would not be obliged, by virtue of paragraph (1), to give the applicant a further opportunity to amend or correct to the extent that no new issues were raised by the continuing application. His Delegation did not necessarily seek an amendment to paragraph (1), but would, rather, be satisfied with an explanatory note clarifying that in the stated circumstances paragraph (1) would not apply.

1080.3 In relation to paragraph (2), his Delegation sought confirmation that the paragraph would not apply to require an Office to extend the right to an applicant to amend or correct the application when the first substantive communication from the Office to the applicant consisted of a communication that the application was in order for grant and that the required fee for grant was payable.

1081.1 Mr. CURCHOD (WIPO) stated that, concerning the second situation raised by the Delegation of the United States of America, since the first substantive communication from the Office was an indication that the application was in order for grant, the Office would not be obliged to allow the applicant the right to amend or correct the application in reply to or after that communication.

1081.2 Concerning the first situation raised by the Delegation of the United States of America, he asked for further clarification from the Delegation of the United States of America.

1082. Mr. VAN HORN (United States of America) stated that the question of his Delegation concerned a situation in which the first application had been examined. Thereafter, a continuation application was presented which contained exactly the same claims as the first application and which raised no new issues. His Delegation sought confirmation that, under those limited circumstances, the Office would not be required by paragraph (1) to extend to the applicant the opportunity as a matter of right to amend or correct the continuation application.

1083.1 The CHAIRMAN confirmed that paragraph (2) of Article 14 gave the applicant the right to amend or correct his application, at his own initiative, up to the time at which the application was in order for grant of a patent. If the first communication from the Office concerning the substance was a communication that the application was in order for grant, the applicant no longer had the right to amend or correct the application on his own initiative.

1083.2 As for the first item raised by the Delegation of the United States of America, he observed that it was for Main Committee I to give its view. It seemed to him that the applicant's right to be heard was exhausted in such cases.

1084. Mr. CURCHOD (WIPO) pointed out that he shared the Chairman's view.

1085. The CHAIRMAN asked the delegations whether they also shared that point of view.

1086. Mr. SCHAEFERS (Germany) stated that the cases outlined by the Delegation of the United States of America indicated that the rule of reason or common sense ought to apply. His Delegation would have no difficulty with a statement in the records of the Diplomatic Conference that reflected that paragraphs (1) and (2) of Article 14 would not apply in the situations outlined.

1087. Mr. RAFFNSØE (FICPI) stated that his Organization considered that the scope of the provision in paragraph (2) was too limited. It would like to see the addition of a provision that would make it clear that, even after the first substantive communication from an Office, an amendment of the application was possible with the consent of the Office. Such a provision would correspond to the practice of the EPO.

1088. The CHAIRMAN admitted that he failed to see how the current wording of the basic proposal did not permit amendment on the initiative of the applicant and with the consent of the Office following a first communication by the Office with respect to the substance.

1089. Mr. SCHATZ (EPO) stated that his Delegation wished to confirm the interpretation given by the Chairman. He did not see any need to modify the text of paragraph (2) in order to satisfy the concern of the Representative of FICPI. Paragraph (2) dealt only with the right of the applicant to amend or correct, on his own initiative, the application. Any Office could allow further amendments or corrections if it wished.

1090.1 Mr. UEMURA (Japan) stated, in relation to the point of clarification sought by the Delegation of the United States of America in connection with paragraph (1), that it may not always be clear that a divisional or continuation application had exactly the same claims as the parent application. It might therefore be necessary to assess on a case-by-case basis whether the Office was obliged to allow an opportunity to amend or correct. His Delegation did not disagree that, if the divisional or continuation application were an exact copy of the parent application, no further opportunity to amend or correct the application would be required to be given by the Office.

1090.2 He stated also that his Delegation considered paragraph (2) to contain a very lenient approach. However, if the general wish of the Conference was to include the provisions of paragraph (2) in the draft Treaty, his Delegation could agree.

1091. Mr. SUGDEN (United Kingdom) stated that he considered that there should be a cross-reference in paragraph (3) to Article 17. Article 17(2) dealt with the case of obvious mistakes and clerical errors to which different rules

applied from other changes requested in a patent. In the view of his Delegation, paragraph (3) of Article 14, which contained the rule that amendments or corrections in the application could not go beyond what had been disclosed in the application as filed, should be expressed to be without prejudice to the provisions of Article 17.

1092. The CHAIRMAN observed that Article 17(4) appeared to prohibit any amendment of the patent beyond the disclosure made in the application as filed.

1093. Mr. SUGDEN (United Kingdom) pointed out that paragraph (4) of Article 17 referred only to paragraphs (1) and (3) of Article 17 and not to paragraph (2) of Article 17. As had been discussed in the Committee of Experts, his Delegation did not consider that corrections of obvious mistakes and clerical errors should be limited by the rule against corrections going beyond what had been disclosed in the application as filed.

1094. Mr. CURCHOD (WIPO) did not think that simple reference to Article 17 could give effect to the comments made by the Delegation of the United Kingdom since Article 17 concerned only the time following the grant of a patent. He wondered whether there was not a need for a provision within Article 14 itself.

1095. Mr. KIRK (United States of America) recalled that there was a proposal presented by the Delegation of Japan in document PLT/DC/22 concerning Article 17 which had the effect of extending the rule against disclosure of new matter to the correction of obvious errors and clerical mistakes dealt with in Article 17(2). His Delegation agreed with that proposal. He suggested that discussion on the question raised by the Delegation of the United Kingdom could be held over until Article 17, since a similar problem would be involved at that stage.

1096. Mr. SCHAEFERS (Germany) stated that, in his view, paragraph (2) of Article 14 also covered the case that had been raised by the Delegation of the United Kingdom, namely, the correction of obvious mistakes and clerical errors. Similarly, in his view, the provision in paragraph (3) also applied in relation to the correction of obvious mistakes and clerical errors in the application.

1097.1 Mr. BAKER (Australia) stated that his Delegation agreed with the Delegation of the United Kingdom that it would be desirable to have an explicit authorization in Article 14 permitting the correction of obvious mistakes or clerical errors that went beyond the disclosure in the application as filed.

1097.2 He asked whether it might not be a better approach to combine Articles 14 and 17 into one Article dealing with the amendments before the grant of the patent.

1097.3 He also sought clarification as to whether the rule in paragraph (3) prohibited the amendment of claims in such a way that new matter could be claimed.

1098. The CHAIRMAN observed that there had been a time when the draft Treaty discussed by the Committee of Experts had contained only one Article dealing with amendments. He added that it still remained possible to deal now with

Articles 14 and 17 together and then to separate them again at the second part of the Conference.

1099. Mr. BAKER (Australia) stated in reply to the Chairman that there were numerous examples of obvious mistakes or clerical errors, such as a typographical error in an application in the chemical field which indicated a range of temperature between 0 and 35 degrees instead of between 0 and 350 degrees.

1100. Mr. KORCHAGUIN (Soviet Union) said that his Delegation was fully satisfied with the text of Article 14 in the basic proposal. He counselled against the consideration by the meeting of situations which were too detailed, stating that the Article as drafted in the basic proposal contained broad principles which did not need to deal with all possible eventualities of practice.

1101. Mr. UEMURA (Japan) stated that his Delegation was satisfied with the text of paragraph (3) in the basic proposal. He considered that the concerns raised by the Delegation of Australia in connection with paragraph (3) would seem to be accommodated by the term "disclosed" that was used in paragraph (3).

1102. Mr. TALUKDAR (Bangladesh) stated that his Delegation wished to place on record its anxiety that, since Bangladesh was a least-developed country, the implementation of the principle contained in paragraph (2) would involve an additional burden for its Office that would impose a further restraint on the administrative services of his country.

1103. Mr. SUGDEN (United Kingdom) stated that his Delegation would be very concerned if paragraph (3) applied to corrections of clerical errors and obvious mistakes. As had been indicated by the Delegation of Australia, mistakes could very easily occur in the description of a range. If the range applied concerned, for example, the active ingredient in a pharmaceutical, it might be obvious that the resultant substance would be lethal, so that the mistake would be an obvious one. His Delegation found it even more surprising that such mistakes could not be corrected without going beyond what had been disclosed in the application as filed before even the publication of the application. The capacity to correct such mistakes in the errors was a fundamental right of the applicant which it was extremely important to make clear.

1104. The CHAIRMAN noted that the question raised by the Delegation of the United Kingdom was whether the ruling contained in paragraph (3) of Article 14 was limited to amendments or corrections other than those resulting from obvious mistakes and clerical errors. He proposed that the question be discussed when Article 17 was dealt with since the same question would be examined with relation to the amendment of patents.

1105. Mr. WIERZBICKI (New Zealand) stated that his Delegation shared the same concerns as the Delegations of the United Kingdom and Australia. He stated, in particular, that, since Article 14 concerned the amendment or correction of the application before grant, it seemed to his Delegation to be particularly important to make allowance for the correction of obvious mistakes and clerical errors even if those corrections went beyond the disclosure in the application as filed.

1106.1 Mr. SCHAEFERS (Germany) stated that, for the avoidance of doubt, he wished to repeat that, in his view, paragraph (2) of Article 14 applied to obvious mistakes and clerical errors. His Delegation did not, however, consider that it was necessary to make explicit reference to that type of correction in paragraph (2), since it was obviously covered.

1106.2 Concerning the interpretation of paragraph (3) and the question that had been raised by the Delegation of Australia, his Delegation believed that new matter should not be included in an application if it went beyond the disclosure in the application as filed, whether that new matter was introduced by way of the description or the claims. The purpose of extending the rule to the claims as well as the description was that the scope of protection of a patent was to be determined by the claims, in the light of the description, so that the disclosure in the claims, as well as in the description, could produce difficulties during infringement proceedings in determining the appropriate scope of protection.

1107. Mr. SEGURA (Argentina) expressed the agreement of his Delegation with the observations made by the Delegation of the Soviet Union. Clarifications of the finer points concerning the subject matter of Article 14 should be dealt with in the notes.

1108. Mr. ABDALLA (Sudan) expressed the agreement of his Delegation with the statement made by the Delegation of Bangladesh that the implementation of the principle contained in paragraph (2) would involve an excessive burden on the administrative services of the least developed countries.

1109. Mr. BRUNET (NYPTC) stated that his Organization considered that the principle in paragraph (3) did not necessarily mean that the Office was required to permit amendments or corrections up to the limit of what had been disclosed in the application as filed. Rather, that principle only stated that amendments or corrections could not go beyond the disclosure contained in the application as filed. He considered that an appropriate provision making clear that the Office was required to accept amendments or corrections that did not conflict with paragraph (3) should be included in the notes.

1110. The CHAIRMAN expressed his view that if amendment of the claims did not go beyond the disclosure made in the application as filed, paragraph (3) raised no problem.

1111.1 Mr. PAGENBERG (DVGR and MPI) stated, in his capacity as Representative of DVGR, that his Organization was in favor of the deletion of the clause commencing with the word "however" in paragraph (2), as his Organization wished to see more flexibility with respect to the right of the applicant to amend or correct on his own initiative.

1111.2 In his capacity as Representative of MPI, he expressed the view that the principle in paragraph (3) did not apply to new matter introduced as a result of the correction of obvious mistakes or clerical errors.

1112. Mr. RAFFNSØE (FICPI) expressed the agreement of his Organization with the views that had been expressed by the Delegations of the United Kingdom and New Zealand. He did not think, however, that the problem with respect to paragraph (3) was limited to the cases of obvious mistakes and clerical errors. He indicated that, for example, it was not uncommon in the

context of applications in the chemical field for examiners to ask for further examples to support a broad claim. He cited, in this respect, Article 123 of the European Patent Convention as permitting amendments provided that the scope of the application was not thereby extended.

1113. Mr. SCHATZ (EPO) stated that he was concerned that the European Patent Convention should not be misquoted. Article 123 of that Convention provided that the European patent application or the European patent might not be amended in such a way that it contained "subject matter which extends beyond the content of the application as filed." He considered that provision to be in perfect harmony with Article 14(3) of the basic proposal. He added that an Office could often ask for further examples to show that an invention was workable or that it reached the necessary inventive step. Such further examples were not, however, included in the application, but were maintained on the file concerning the application.

1114. Mr. SANTARELLI (AIPPI) stated that his organization could accept paragraphs (1) and (2) of Article 14 as drafted in the basic proposal. As for paragraph (3), it held that even if an obvious mistake or a clerical error could lead to an extension of the disclosure, it should nevertheless remain possible to correct the mistake or error.

1115. Ms. LEVIS (ALIFAR) stated that her Organization supported the text of paragraph (3) in the basic proposal.

1116. Mr. BLAKEMORE (UNICE) stated that his Organization had the same concerns as those expressed by the Delegation of the United Kingdom concerning the interpretation of paragraph (3). He did not consider that obvious mistakes and clerical errors should be subject to the principle contained in paragraph (3). He supported the right of the applicant to make corrections of obvious mistakes or clerical errors regardless of the enlargement of the disclosure that resulted therefrom. His Organization was also opposed to any approach that would not permit the applicant to broaden claims within the disclosure that had initially been made in the application as filed.

1117. Mr. NEUKOM (CIPA) stated that his Organization would be most uncomfortable if the correction of obvious mistakes or clerical errors leading to an extension of the disclosure were to be prohibited by paragraph (3). The correction should be on the record at the earliest opportunity.

1118.1 The CHAIRMAN noted that discussion on Article 14 was finished, with the exception of the proposal of the Delegation of Israel, contained in document PLT/DC/65, which aimed at adding a new paragraph (4) to Article 14.

1118.2 He also noted that a whole series of delegations had supported the wording of the Article in the basic proposal.

1118.3 He proposed that the admissibility of amendments to correct obvious mistakes and clerical errors should be discussed when examining Article 17.

1118.4 He noted, in relation to the question raised by the Delegation of Australia, that the interpretation of paragraph (3) had not been called into question and that the text concerned amendment both of claims and of the description alone.

1118.5 He proposed to move to the proposal for amendment presented by the Delegation of Israel, contained in document PLT/DC/65.

1119. Mr. SHACHTER (Israel) stated that it was the practice in many countries to allow an amendment which went beyond the original disclosure contained in the application as filed on condition that the date of filing was amended accordingly. Such a provision had existed in the national law of his country for some 24 years. New paragraph (4) proposed by his Delegation, contained in document PLT/DC/65, was directed at permitting Contracting Parties to continue such a practice. He noted that a result of the adoption of his Delegation's proposal would be to give effect to the continuation-in-part procedure known in the United States of America without the necessity of filing a new application.

1120.1 The CHAIRMAN explained that where it was ascertained that amendments submitted went beyond the initial content of the disclosure in the application, various procedures were possible. Firstly, the Office would inform the applicant and give him the possibility of withdrawing the amendments. If the applicant maintained them, there were three possible procedures. Firstly, the Office could reject the application, which was the practice of the European Patent Office. Secondly, the Office could postpone the filing date, which was the current practice at the Swiss Federal Intellectual Property Office. Thirdly, the applicant could divide the application by filing a divisional application containing either the amendments that went beyond the content of the application as filed or the content of the initial application together with the amendments, in which case the filing date for the divisional application would be the date of filing of the amendments.

1120.2 He noted that the first and third procedures did not conflict with the present wording of paragraph (3). However, he was not sure whether the second procedure would be compatible with that text.

1121. Mr. SCHAEFERS (Germany) stated that his Delegation was not opposed to the proposal of the Delegation of Israel contained in document PLT/DC/65. Concerning the observations that had been made by the Chairman, he considered that they concerned procedural matters in respect of which a variety of approaches was possible. He did not consider that it was sensible to make all such approaches explicit. There were, in addition to the approaches mentioned by the Chairman, two other approaches, namely, that an extension of the disclosure beyond what was contained in the application as filed could be made a ground of invalidity of any patent that was issued, or could be left to the infringement stage, in which case the court apprised of the infringement proceedings could deny that rights would be derived from any added disclosure. His Delegation was opposed to the addition of any new paragraph dealing explicitly with any of these approaches.

1122. The CHAIRMAN suggested that an explanatory note should specify that the consequences of failure to comply with the ruling in paragraph (3) would be determined by national law.

1123. Mr. MESSERLI (Switzerland) stated that the position of his Delegation was similar to that of the Delegation of Germany and that it was not necessary to deal in the text with the legal implications of failure to comply with the ruling contained in paragraph (3). He added that the procedure whereby the

filing date was postponed where an amendment went beyond the disclosure made in the application as filed did not seem to run counter to the ruling contained in paragraph (3).

1124. Mr. SHACHTER (Israel) asked whether the Chairman and the Delegation of Germany had said that an approach such as that contained in document PLT/DC/65 would be possible without contravening paragraph (3).

1125. The CHAIRMAN stated his view that the legal consequences of filing an amendment that did not comply with the ruling contained in paragraph (3) were not defined by the Treaty.

1126. Mr. SCHAEFERS (Germany) confirmed the interpretation given by the Chairman. Paragraph (3) of the basic proposal did not deal with the procedural consequences of a violation of the principle which it contained. It merely stated the general principle and left the consequences to national law. It was the understanding of his Delegation that the system used in Israel was in compliance with paragraph (3) of the basic proposal.

1127. Mr. SUGDEN (United Kingdom) expressed the sympathy of his Delegation for the position of the Delegation of Israel. His country used to have a similar procedure but it had abandoned it. His Delegation considered, however, that paragraph (3) prohibited the continuation of such a procedure. The fact that the draft Treaty made express provision in respect of the late filing of drawings in Article 8(3) indicated that an express authorization was required in order to add new material to an application beyond what had been disclosed in the application as filed, even if the date of filing was in consequence post-dated.

1128. Mr. UEMURA (Japan) stated that the proposition of the Delegation of Israel contained in document PLT/DC/65 seemed to raise a number of complicated issues which required more time for further reflection. As a preliminary comment, his Delegation considered that the proposition might raise difficulties because the practice of according a new filing date could lead to a mosaic of patent terms.

1129. Mr. KIRK (United States of America) stated that the proposal of the Delegation of Israel bore similarity to the practice of continuation-in-part applications in the United States of America, which worked very well. If a Contracting Party wished to adopt the practice suggested in the proposal of the Delegation of Israel, his Delegation could not see any difficulty but, rather, a number of benefits for applicants. He considered that the difficulty voiced by the Delegation of Japan concerning different patent terms could be solved in various ways. Moreover, the proposal of the Delegation of Israel offered a possible way of dealing with the question of obvious mistakes and clerical errors whose correction involved the introduction of new matter.

1130. Mr. KHRIESAT (Jordan) supported the text of Article 14 in the basic proposal. His Delegation was against the proposal of the Delegation of Israel contained in document PLT/DC/65 on the basis that it would introduce confusion.

1131. Mr. SHACHTER (Israel) observed that the Delegation of Germany had earlier expressed the view that the proposal of his Delegation was a matter for national law and could be dealt with accordingly in an explanatory note.

He now had heard the view of the Delegation of the United Kingdom which read paragraph (3) as imposing an absolute limitation which would prohibit the practice treated in the proposal of his Delegation. He indicated that, if it were generally accepted that the matter could be dealt with in an explanatory note, his Delegation would be satisfied. Concerning the difficulty raised by the Delegation of Japan, he did not consider that involved an unusual problem since multiple priorities were rather common.

1132. Mr. GARIEPY (Canada) indicated that a similar system to that proposed by the Delegation of Israel had existed in Canada, where it had been abandoned because it had caused a number of problems. His Delegation had serious concerns about the proposal of the Delegation of Israel and considered that it would constitute a step away from harmonization. He recommended that any decision concerning the proposal be delayed pending further consideration of it.

1133. Mr. SALIM (Syria) stated that his Delegation agreed with the Chairman's statement concerning the ways in which an amendment or correction extending beyond the original disclosure could be dealt with. In the view of his Delegation, paragraph (3) of the basic proposal was clear and exhaustive and no addition was needed to the text of Article 14.

1134. Mr. WIERZBICKI (New Zealand) stated that his Delegation was favorably disposed to the proposal of the Delegation of Israel, pointing out that a similar provision was contained in his national legislation.

1135.1 Mr. SMITH (Australia) stated that his Delegation had sympathy for the proposal of the Delegation of Israel. He considered that, if the interpretation of paragraph (3) that had been given by the Delegation of Germany was correct and could be incorporated in a note, his Delegation would have no difficulty that the proposal of the Delegation of Israel not be included in the draft Treaty. However, he agreed with the interpretation of paragraph (3) that had been given by the Delegation of the United Kingdom that suggested that the practice of giving a new filing date to an application following an amendment which extended the initial disclosure was not permitted under paragraph (3).

1135.2 He drew attention to certain difficulties that his Delegation had with the drafting of the proposal of the Delegation of Israel. In particular, he wondered whether the substitution of the term "priority date" for the term "filing date" in that proposal might not resolve the problem that had been raised by the Delegation of Japan. With such a modification, his Delegation could support the proposal.

1136. Mr. MESSERLI (Switzerland) pointed out for information that postponing the date resulted in a single new filing date and not in two filing dates.

1137. Mrs. DIVOY (France) wished to reserve the position of her Delegation, but stated that the principle addressed by paragraph (3) constituted one of the cornerstones of the draft Treaty. She pointed out that the desired flexibility had not to be confused with anarchy. She also pointed out that, if an amendment introduced new matter, the applicant could always withdraw the application and file a new one up to the date of publication of the application.

1138. Mr. TALUKDAR (Bangladesh) wondered how far the adoption of the proposal of the Delegation of Israel would contribute to harmonization.

1139. Ms. SANDBERG (Sweden) sought clarification on whether paragraph (3) prohibited an applicant from updating the description with newly discovered references to the prior art. Such updating was a common practice in Sweden when the application was found to be in order for grant and the claims had been approved, at which stage the applicant was invited by the Office to include in the description any new references to the prior art that had been found.

1140. The CHAIRMAN observed that the practice described by the Delegation of Sweden concerned the regularization of the description once the Office had consented to a given version of the claims. That regularization could comprise updating of the prior art which did not affect disclosure in the application since it added nothing to the disclosure of the invention in the application. He asked delegations to confirm his interpretation.

1141. Mr. SCHAEFERS (Germany) confirmed the interpretation by the Chairman that the practice adopted in Sweden was not incompatible with paragraph (3).

1142. Mr. CLIVEMO (Sweden) stated that his Delegation was nevertheless concerned that paragraph (3) stated expressly that no amendment could go beyond what had been "disclosed" in the application as filed.

1143. The CHAIRMAN explained that the disclosure dealt with in the ruling contained in paragraph (3) was disclosure of the invention and not of the prior art.

1144. Mr. KOLLE (EPO) stated that he was grateful for the confirmation that had been given that Article 14(3) was not intended to preclude the practice of updating references to the prior art. He wondered whether the text of paragraph (3) in the basic proposal might not be ambiguous and whether it might not be clearer if it prohibited amendments or corrections which went beyond the disclosure of the invention in the application as filed or beyond the disclosure of the subject-matter of the application as originally filed.

1145. Mr. SHACHTER (Israel) stated that he was grateful to the Delegation of Australia for the clarification concerning the use of the term "priority date" instead of the term "filing date." The substitution of the term "priority date" for the term "filing date" would mean that several priorities, but only one filing date, would be possible.

1146. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the text of paragraph (3) of the basic proposal without amendment.

1147.1 Mr. UEMURA (Japan) clarified, in relation to his preceding statement, that his Delegation was not opposed to a plurality of priority dates, but was opposed to a plurality of filing dates. He considered that there would be a series of problems involved if a constant expansion of a single application were permitted.

1147.2 Concerning the question raised by the Delegation of Sweden, he concurred that new references to the prior art could be included after the filing date without contravening the principle contained in paragraph (3).

1148. Mr. JAKL (Czechoslovakia) stated that his Delegation agreed with the observations made by the Delegation of the EPO that paragraph (3) should be re-drafted so as to refer to the disclosure of the subject matter of the application.

1149. Mrs. DE CUYPERE (Belgium) went along with the position expressed by the Delegation of France. She was opposed to the proposal made by the Delegation of Israel, contained in document PLT/DC/65, and emphasized the importance of the principle referred to in paragraph (3).

1150.1 The CHAIRMAN concluded that it was clear that the meeting could not take a position on the proposal made by the Delegation of Israel, contained in document PLT/DC/65, without having had an opportunity for longer reflection.

1150.2 He noted that there was general agreement on the fact that adding new references to the description of the prior art, as done in practice in Sweden, was compatible with the ruling contained in paragraph (3), which applied only to additions to disclosure of the invention.

1150.3 He also noted that an explanatory note would have to be inserted saying that the principle involved in paragraph (3) did not govern matters of procedure, nor the legal consequences of amendments not complying with that principle.

1150.4 He closed the meeting.

Thirteenth Meeting
Friday, June 14, 1991
Afternoon

1151.1 The CHAIRMAN opened the meeting and proposed that, in view of time constraints, only written proposals should be discussed. Oral proposals would not be discussed, but would be noted in the summary minutes and the Committee could revert to them at a later stage, if sufficient time became available.

Article 15: Publication of Application

1151.2 The CHAIRMAN proposed opening discussion on Article 15 ("Publication of Application") and recalled that there were three proposals in respect of Article 15, one by the Delegation of Japan, contained in document PLT/DC/20; a second by the Delegation of Norway, contained in document PLT/DC/7; and a third by the Delegation of the United States of America, contained in document PLT/DC/52. He invited the Delegation of Japan to present its proposal.

1152.1 Mr. UEMURA (Japan), in introducing the proposal of his Delegation in document PLT/DC/20, stated that it contained two alternatives that differed in drafting rather than substance. As far as paragraph (1)(a) was concerned, he

stated that the 18-month period provided for in that paragraph struck a balance between the need to disclose technology as early as possible, on the one hand, and the priority period embodied in the Paris Convention and the necessary period for the technical preparations for the publication, on the other hand. He also noted that a significant number of countries had adopted the 18-month period. Subparagraph (b) of paragraph (1) of Article 15 provided for a period of 24 months that, in his view, constituted a retreat from the spirit of harmonization. He recalled that one of the main objectives of the publication system was to avoid repetitive investment on research and development and, for that reason, his Delegation strongly supported the 18-month period as the sole mandatory time limit for publication. The aim of the proposal of his Delegation was to restrict the right of Contracting Parties to provide for a period of 24 months to a limited number of years.

1152.2 As far subparagraph (c) was concerned, he recalled that, according to note 15.02 contained in document PLT/DC/4, the determination of the commencement of the 18-month or 24-month time limit in the case of divisional applications, continuation applications, or continuation-in-part applications was left to the applicable national or regional law. In the view of his Delegation the absence of such a determination was a loophole that could be used to unduly delay publication. He provided an example as to how the publication could be delayed for a period of a significant number of years. In accordance with paragraph (c) as proposed by his Delegation, the time limit would commence at the filing date of the earliest-filed application or, where priority was claimed in the earliest-filed application, from the priority date.

1153. The CHAIRMAN indicated that, if he understood correctly, the proposal by the Delegation of Japan had two alternatives that only differed in their drafting. He requested the Delegation of Japan to provide clarification on the time limit it envisaged for the transitional measure according to which Contracting Parties would have the faculty to provide for 24 month period.

1154. Mr. UEMURA (Japan), in response to the Chairman's request, stated that the objective of his Delegation was to ensure that, in the long run, harmonization would be achieved and that that harmonization would be based on the 18-month period. Since it was difficult for some countries that did not provide for publication to cope with the requirements of the Treaty in that respect, the proposal would allow those countries to provide for a 24-month period for a number of years. As for the exact number of years, he stated that his Delegation was open to enter into consultations in order to define it once the principle embodied its proposal was accepted.

1155. The CHAIRMAN asked whether any delegation supported the proposal by the Delegation of Japan.

1156. Mr. NEERVOORT (Netherlands) affirmed the attachment of his Delegation to establishment of a single period of 18 months and he regretted that it was not possible to agree on such a single period. Since the proposal by the Delegation of Japan would eventually reduce the gap between the 18-month period and the 24-month period, his Delegation supported it. He observed that, in accordance with that proposal, a single period would be reached in the long term and so the objective of harmonization would materialize. As for the alternatives proposed by the Delegation of Japan, his Delegation preferred Alternative X.

1157. Mr. SCHAEFERS (Germany) stated that his Delegation was not in favor of the proposal of the Delegation of Japan. His Delegation was aware of the fact that an 18-month period appeared to be a cornerstone in several national laws, as well as international treaties. However, it was not an irremovable one. He stated that discussions had taken place in his country on a possible extension of the 18-month period to 24 months and some merit had been seen in it because it would facilitate the examination process. In addition, he expressed the understanding of his Delegation for the situation of countries like the United States of America that did not provide in their national legislation for publication of the application. Those countries should be allowed to have recourse to a longer period as envisaged in paragraph (1)(b) of Article 15 of the basic proposal.

1158. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the 18-month period and for the text of Article 15 as envisaged in the basic proposal.

1159. Mrs. DE CUYPERE (Belgium) said that her Delegation was very attached to a period fixed at 18 months. Consequently, she supported the proposal made by the Delegation of Japan.

1160. Mr. TALUKDAR (Bangladesh) expressed the support of his Delegation for the text of paragraph (1) of Article 15, as it was envisaged in the basic proposal, because it would advance the cause of harmonization.

1161. Mr. MESSERLI (Switzerland) expressed the support of his Delegation for the proposal of the Delegation of Japan which would advance the cause of harmonization since it would provide, in the long term, for a single period of 18 months. He recalled that such period was consistent and in harmony with the one established in the PCT.

1162.1 Mr. KIRK (United States of America) recalled that the content of paragraph (b) in the basic proposal followed the suggestion made at the Committee of Experts by his Delegation. He stated that in his country there was no provision for publication at 18 months but, instead, patents were granted on average at 18 months from the filing date. Publication at the eighteenth month would entail a significant expenditure for the United States of America. He stated that publication of all the applications after 24 months would entail a cost of approximately 31 million dollars.

1162.2 His Delegation did not understand why it would be necessary to establish a mandatory single period of 18 months. His Delegation was attached to paragraph (1)(b) because a provision establishing a 24-month time limit could eventually be accepted by the interested circles and the Congress of his country. He reiterated that in the United States of America patents were granted on the average at 18 months from the filing date; in those cases where the patent was granted in a longer period, publication would take place, pursuant to paragraph (1)(b), after 24 months and at that moment the technology would be disclosed. He mentioned that in Japan technology was disclosed--in the Japanese language--at the eighteenth month. He could not see why it would be a matter of great importance for foreign countries that the United States published at 24 months. For all those reasons, his Delegation was opposed to the proposal of the Delegation of Japan which could deprive Contracting Parties of the option established in paragraph (b) of Article 15 of the basic proposal.

1162.3 As far as paragraph (c) of Alternative X of the proposal of the Delegation of Japan was concerned, he stated that, in accordance with paragraph (1) of Article 15 in the basic proposal, the publication of the application should take place as soon as possible after the expiration of 18 months from the filing or priority date. He added that, in accordance with Article 2, item (ii), of the basic proposal, the priority date for the purpose of computing time limits was the filing date of the earliest-filed application. In the view of his Delegation, the proposal of the Delegation of Japan was therefore unnecessary, since it was already embodied in Article 15 read in conjunction with Article 2 (ii) of the basic proposal.

1163. Mrs. DIVOY (France) stated that her Delegation would not oppose subparagraph (1)(b) of the basic proposal. She understood the difficulties experienced by the United States of America and noted the declaration of the United States with regard to the point of departure for calculating the time limits referred to in subparagraph (c) of Alternative X of the proposal by the Delegation of Japan. She added that it was perhaps not optimum since, at present, in the United States, patent applications concerning biotechnology had time limits of approximately 25.5 months and therefore even publication after 24 months would not solve that problem. However, she signaled her preference for the proposal by the Delegation of Japan since it appeared preferable for the dissemination of technical information that there be publication at 18 months, which was the time limit laid down by the PCT.

1164. Mr. PAGENBERG (DVGR) stated that his Organization had recently endorsed the adoption of a period of 24 months so as to allow the applicant to decide whether to withdraw his application after considering the search report. Therefore, he supported paragraph (1)(b) of Article 15 of the basic proposal, provided that it be amended so as to include within its scope all Contracting Parties and not only those whose legislation does not provide for the publication of application.

1165. Mr. NEERVOORT (Netherlands) drew attention to the fact that Article 15 required the publication of the application and, in accordance with Article 2, item (viii), the term "published" meant made accessible to the public. Therefore, what was envisaged by Article 15 was that the application be available to the public.

1166. The CHAIRMAN thanked preceding the speaker for his clarification and added that a national law of a Contracting Party might provide that the requirement of Article 15 be fulfilled by making the application accessible to the public.

1167. Mr. RAFFNSØE (FICPI) expressed the support of his Organization for the option of 24 months because of the significant legal and practical implications that that option entailed. His Organization could not, therefore, support the proposal by the Delegation of Japan.

1168. Mr. VON ARNOLD (Sweden) stated that the position of his Delegation was similar to that expressed by the Delegation of France. As a compromise it could support the text of paragraph (1)(b) of the basic proposal even though the preference of his Delegation would have been for a mandatory system providing for a single period of 18 months.

1169. Mr. SANTARELLI (AIPPI) stated that his Organization understood the concern of the Delegation of the United States of America and, thus, supported the text of paragraph (1)(b) of Article 15 as it was in the basic proposal.

1170. Mr. BRUNET (ABA) stated that his Organization did not support the publication of applications. However, he noted that the position of his Organization could change in the future in the context of a package that would include other issues.

1171. Mr. GARIEPY (Canada) expressed the support of his Delegation for the text of paragraph (1) as envisaged in the the basic proposal, since it would facilitate the participation of the United States of America in the Treaty.

1172. Mrs. RYAN (NYPTC) stated that her Organization supported the 24-month period for publication, provided that provisional rights were available to applicants after publication and provided that examination was sufficiently complete to enable applicants to take an informed decision as to whether they should withdraw their application.

1173. Mrs. LINCK (AIPLA) expressed the support of her Organization for early publication either at 18 months or 24 months.

1174. Mrs. ØSTERBORG (Denmark) stated that her Delegation was of the view that the treaty should establish a single mandatory period of 18 months. However, if it was absolutely necessary, her Delegation could accept as a compromise the establishment of an exceptional period of 24 months provided that it was limited to a specified time limit.

1175. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for paragraph (1) of Article 15 in the basic proposal. That paragraph was a compromise which would enable certain countries to accept the requirement of publication of the application. As for subparagraph (b), he suggested introducing drafting changes so as to make it clear that the possibility of publishing before the expiration of the 24 months, whenever possible, was not in any way precluded by that provision.

1176. Mr. KAMEL (Egypt) stated that the provision contained in paragraph (1) of Article 15 was a positive one which would supplement certain national legal systems that did not provide for a time limit. That was the case of the national legislation of his country.

1177. Mrs. PURI (India) recalled that, in accordance with the national legislation of her country, publication took place after substantive examination. For that reason it would be difficult for her Delegation to support the establishment of strict time limits.

1178. Mr. SEGURA (Argentina) expressed the support of his Delegation for the text envisaged in the basic proposal, noting that, in his country, there was no provision for publication.

1179. Mr. PAAERMAA (Finland) expressed the support of his Delegation for a single and mandatory period of 18 months. He drew attention to the relationship between Articles 15 and 16. In that context, his Delegation supported also subparagraph (b) of paragraph (1).

1180. Mr. BULGAR (Romania) expressed the support of his Delegation for the text of paragraph (1) of Article 15 as it was in the basic proposal.
1181. Mr. KHRIESAT (Jordan) expressed that his Delegation was in favor of a period of 18 months. However, he added that he saw no reason to oppose the 24-month option set forth in paragraph (1)(b) of the basic proposal.
1182. Mr. BOBROVSZKY (Hungary) expressed the support of his Delegation for the text of paragraph (1) of Article 15 in the basic proposal.
1183. Mr. TIGBO (Cameroon) expressed the support of his Delegation for the text of Article 15(1) in the basic proposal, since it represented a compromise solution.
1184. Mr. WARR (Malta) expressed the support of his Delegation for the text contained in the basic proposal.
1185. Mr. ELHUNI (Libya) stated that his Delegation did not have any difficulty accepting Article 15 of the basic proposal.
1186. Mr. QIAO (China) expressed the support of his Delegation for paragraph (1) in the basic proposal.
1187. Mr. BESPALOV (Soviet Union) stated that the national legislation of his country provided for a period of 18 months but, in a spirit of compromise, he could support the text in the basic proposal.
1188. The CHAIRMAN concluded that the discussion had shown the support of certain delegations for the proposal of the Delegation of Japan. However, that support was not sufficient to be considered as a possible amendment to the basic proposal. He noted that a rather clear majority of delegations had supported the text of paragraph (1) of Article 15 of the basic proposal.
1189. Mr. SCHATZ (EPO) stated that, since the proposal of the Delegation of Japan did not receive sufficient support, he wondered whether it would be possible to consider, perhaps in the second part of the Diplomatic Conference, an amendment to subparagraph (b) in order to extend the option foreseen in that provision to all the Contracting Parties, irrespective of their existing national legislation.
1190. The CHAIRMAN asked whether any delegation supported the second part of the proposal by the Delegation of Japan, which was reflected in paragraph (c) of Alternative X of that proposal. Since no delegation supported that part of the proposal, he noted that it could not be discussed.
1191. Mr. UEMURA (Japan) stated that his Delegation was satisfied with the explanation provided by the Delegation of the United States of America with respect to the second part of the proposal of his Delegation. However, he was of the view that the matter could nevertheless be explicitly clarified.
1192. Mr. SUGDEN (United Kingdom) stated that the problem which was raised by the Delegation of Japan was an important one and that it should be further considered. The text of the treaty should not have any loopholes that might be used to avoid the publication of patent applications.

1193. The CHAIRMAN concluded that the matter under discussion could be left open and that a new proposal might be submitted so as to meet the concerns expressed during the discussions.

1194. Mr. SEGURA (Argentina) suggested supplementing Article 15 so as to cover the case of applications which were pending at the time of the entry into force of the Treaty in respect of a given Contracting Party. He suggested that the Contracting Parties should have the faculty to publish the applications pending at that time at the request of the applicant.

1195. The CHAIRMAN stated that, since the proposal of the Delegation of Argentina was an oral one, it would be noted in the summary minutes and the Committee might revert to it at a later stage.

1196. Mr. TALUKDAR (Bangladesh) suggested that the last part of paragraph (2) should read as follows: "the Office shall, after the receipt of the request, duly publish the application."

1197. The CHAIRMAN observed that, the expression "without delay" was the result of a long discussion in the Committee of Experts. Since the suggestion by the Delegation of Bangladesh concerned the drafting of the paragraph, he took note of it so that it might be taken into account by the Drafting Committee. He then turned to Rule 8.

Rule 8: Announcement in the Gazette of the Publication of an Application
(ad Article 15(1))

1198. Mr. KIRK (United States of America) suggested supplementing Rule 8 so as to include the following new indications in the announcement in the official gazette of the publication of an application: firstly, date of publication; secondly, an abstract of the invention; thirdly, a representative drawing, and lastly, the name(s) of the inventor(s). The purpose of the suggestion was to ensure that adequate information would be provided to the public.

1199. The CHAIRMAN stated that note had been taken of the proposal of the United States of America and that it would be reflected in the summary minutes.

1200. Mr. NEERVORT (Netherlands) suggested adding in Rule 8(i), after the name of the applicant, the words "or his assignee."

1201. The CHAIRMAN stated that, in his view, that suggestion was not necessary since the word "applicant" in Rule 8(i) referred to the person who was the applicant at the time of the publication.

1202. Mr. KAMEL (Egypt) suggested supplementing Rule 8(i) to require more information on the applicant's name and address. That additional information might be more necessary in cases where the applicant was an enterprise.

1203. Miss RODRIGUEZ MITTELBAACH (Brazil) requested clarification as to the meaning of the requirement of mentioning the name of the Office in item (iv).

1204. Mr. CURCHOD (WIPO) stated that the Paris Convention required mention of the country where the application was filed for the purpose of ascertaining

that the priority was claimed under the Paris Convention. For national applications, the name of the Office of filing directly referred to the country of filing, whereas for regional and international applications, the name of the Office of filing and the identification number of the application seemed to be sufficient for the said purpose.

1205. Mr. MILLS (Ghana) expressed the support of his Delegation for Rule 8 in the basic proposal. He opposed the proposal by the Delegation of the United States of America since it would entail a burden to some offices, particularly those of developing countries.

1206. Mrs. DIVOY (France) said that it was necessary to modify item (v) of Rule 8 since the symbols of the International Patent Classification were always "available." For example, the words "if available" could be replaced by "if allocated to the application."

1207. Mr. KHRIESAT (Jordan) expressed the support of his Delegation for Rule 8 in the basic proposal. His Delegation opposed the proposal of the Delegation of the United States of America for the reason given by the Delegation of Ghana.

1208. Mr. JAKL (Czechoslovakia) requested clarification as to whether it was necessary under item (iv) of Rule 8 to publish the name of the Office or of the country of the Office.

1209. The CHAIRMAN drew attention to the reply that had already been given by the Secretariat.

Article 15(4): [Circumstances in Which Publication May Not Take Place]

1210. The CHAIRMAN said there were no comments on paragraph (3) of Article 15 and he invited the Main Committee to consider paragraph (4) in respect of which two proposals had been submitted, one by the Delegation of Norway, contained in document PLT/DC/7, and the other by the Delegation of the United States of America, reproduced in document PLT/DC/52.

1211.1 Mr. KIRK (United States of America) stated that paragraph (4) of Article 15 of the basic proposal contained language that his Delegation considered as somewhat indefinite. He mentioned, for instance, that subparagraph (b) stated that no application could be published if it had been rejected. In his country an application might have been rejected but prosecution might still be pursued and a dialogue between the attorney and the examiner might be underway. The purpose of the proposal of his Delegation was to provide more definite language.

1211.2 As far as paragraph (4)(a)(ii) was concerned, the purpose of the proposal of his Delegation was to temper that provision so as to take into account the actual circumstances and the practical difficulties that might be faced by an Office and that might even impede the latter from stopping publication of an application.

1212. The CHAIRMAN stated that the proposal of the Delegation of the United States of America had two parts: one, which concerned the first sentence of subparagraph (a) and subparagraph (b), was of a drafting nature, while the

other, which concerned item (ii) in subparagraph (a), was aimed at clarifying the scope of the obligation of the Contracting Party.

1213. Mr. UEMURA (Japan) stated that his Delegation could support the proposal of the Delegation of the United States of America in as far as subparagraph (a) was concerned. In his view, the term "not pending" covered the expression "withdrawn or abandoned." In addition, it covered certain situations which should be there as, for instance, the notion of nullification which was embodied in the national legislation of his country. As for the second proposal of the United States of America, which concerned item (ii) of subparagraph (a), he stated that the concern of the Delegation of the United States of America was a matter of interpretation of the notion of completion of technical operations for publication. Although he did not have a formal objection to that proposal, he was of the view that this should be dealt with not in the Treaty, but rather in a Note.

1214. Mr. SUGDEN (United Kingdom) recalled that, in the Committee of Experts, the notion of "not pending" had already been discussed. His Delegation could support either the text of the basic proposal or the text contained in the proposal by the United States of America. However, he was of the view that it would be necessary to introduce in that paragraph a reference to an additional circumstance, namely, the circumstance that the patent had been granted in which case publication should be made.

1215. Ms. LILJEGREN (Norway) stated that, since the purposes of the proposal of her Delegation were the same as those in the proposal by the United States of America, her Delegation could accept that latter proposal if that was preferred by the Committee.

1216. Mr. HATOUM (Lebanon) requested a clarification from the Delegation of the United States of America as to the meaning of the term "Contracting Party."

1217. Mr. KIRK (United States of America), in response to the preceding speaker, stated that a Contracting Party meant the industrial property office of a Contracting Party.

1218. Mr. CURCHOD (WIPO) recalled that the expression "... completes the technical preparations for publication" was taken from the Patent Cooperation Treaty (PCT) and that the International Bureau had always interpreted that expression in the sense indicated by the Delegation of the United States of America in its proposal, namely, as the point in time where the International Bureau could not technically stop the publication.

1219. Mr. SCHAEFERS (Germany) stated the support of his Delegation for the basic proposal and for the amendments suggested by the Delegation of Norway. As far as the meaning of the word "not pending" was concerned, he drew attention to the fact that Article 13(2) contained an indirect definition of that expression. That paragraph was concerned with applications that were no longer pending which it considered to correspond to cases where the application was withdrawn or abandoned, was considered withdrawn or abandoned or was rejected. As for the addition proposed by the Delegation of the United States of America to item (ii), in view of the statement by Mr. Curchod, his Delegation was of the view that the proposal was superfluous.

1220. Mr. BAKER (Australia) expressed the support of his Delegation for the statement of the Delegation of Germany. He added that the terms "withdrawn or abandoned" or "considered withdrawn or abandoned" were contained also in Article 9. In order to maintain consistency between the different provisions of the Treaty, he did not support the proposal the Delegation of the United States of America concerning Article 15(4).

1221. Mr. GARIEPY (Canada) expressed his support of his Delegation for the text of Article 15 in the basic proposal.

1222. Mr. KIRK (United States of America) stated that, if the proposal of his Delegation concerning the first sentence of Article 15(4)(a) was to be rejected, additional explanatory notes would be required as to the meaning of the terms "withdrawn or abandoned or is considered withdrawn or abandoned."

1223. The CHAIRMAN concluded that the discussion had shown that both the proposals of the Delegation of the United States of America and of the Delegation of Norway were more of a drafting than a substantial nature. Consequently, he indicated that those proposals should be forwarded to the Drafting Committee. He added that the wording used should be clear so as to avoid confusion and should be consistent with other provisions of the Treaty. Item (i) of subparagraph (a) gave the applicant the assurance that, if he withdraws the application more than two months before the expiration of the applicable time limit, publication would not take place. On the other hand, item (ii) of subparagraph (a) did not give the applicant any such assurance in case the application was withdrawn less than two months before the expiration of the applicable limit, but meant rather that publication would not take place if the Office was still able to stop it technically.

1224. Mr. TALUKDAR (Bangladesh) suggested that, in order to clarify paragraph (4), the term "may" could be deleted from subparagraphs (a) and (b).

1225.1 The CHAIRMAN noted the suggestion of the Delegation of Bangladesh and stated it would be taken into account by the Drafting Committee.

Article 16: Time Limits for Search and Substantive Examination

1225.2 The CHAIRMAN then turned to Article 16 in respect of which there were four proposals for amendment, the first submitted by the Delegation of Norway, contained in document PLT/DC/8; the second by the Delegation of Japan, contained in document PLT/DC/21; the third by the Delegation of Germany, contained in document PLT/DC/36; and the fourth by the Delegation of the United States of America, contained in document PLT/DC/53. He suggested considering simultaneously the proposals of the Delegation of Japan to delete the whole text of Article 16 and of the Delegation of Germany to delete paragraphs (1) and/or (2) of Article 16.

1226.1 Mr. UEMURA (Japan), in explaining its Delegation's proposal in document PLT/DC/21, stated that it would be a waste of resources to prepare search reports for applications in respect of which no request for examination had been made.

1226.2 He pointed out that, if a search report were to be produced at the time that the application was published, the burden on the Office would be substantial. Under the present circumstances it would be impossible for his

country's Office to cope with such a situation. In the view of his Delegation, the obligation to publish a search report at the time of publication would cause a tremendous increase in costs as well as a reduction in administrative efficiency and this would lead to a substantial further delay in examination fees. For those reasons, his Delegation proposed the deletion of Article 16.

1226.3 As far as the time limit for examination was concerned, his Delegation was of the view that it was not adequate. It was often the case that a longer period of time was required. He stated that, in his country, the period within which a request for examination could be filed was seven years. Twenty-five per cent of all requests by Japanese applicants were made during the seventh year, whereas forty per cent of all requests by foreign applicants were made in the last year. He added that those figures indicated that foreign applicants fully enjoyed the time limit specified in the national legislation of his country.

1226.4 He also underlined that examination period was greatly influenced by the number of applications, the number of requests for examination and by the disposal capacity of the Office. In the view of his Delegation the examination period should not be regulated by a treaty intended to harmonize patent law since that was a matter that should be left to the national legislation of each country.

1226.5 He pointed out that in his country there were approximately 600,000 requests for examination that had been made, but that had not yet been disposed of. His Government had been promoting comprehensive policy measures to reduce the examination period. He stated that, under the circumstances, it would be extremely difficult for his country to implement a provision on Article 16. For that reason, his Delegation had no alternative but to propose the deletion of Article 16.

1227.1 Mr. SCHAEFERS (Germany) recalled that his country had a system of deferred examination, which was introduced in 1967 following the model of the Netherlands, at a time of a constantly increasing demand for the services of the Patent Office. As far as the current patent situation was concerned, he indicated that approximately 40,000 applications were filed each year, some 32,000 being domestic applications, and that it was expected that that number might increase in the future due to the accession of the former German Democratic Republic to the Federal Republic of Germany. The system had worked well and to the satisfaction of both national and foreign users. He stated that the system operated within adequate time limits. The average period for disposal of a request for examination was between 20 and 24 months.

1227.2 He pointed out that consultations had taken place within interested circles in his country and the result was that, for reasons similar to those given by the Delegation of Japan, his Delegation favored the deletion of paragraphs (1) and (2) of Article 16. For his country it did not make sense to change a system that worked properly and to the satisfaction of users. He stated that, under the current rules applicable in Germany, search could be carried out immediately after the filing of the application upon a request of the applicant. There was also the possibility of immediately obtaining substantive examination upon request. At present, approximately 28,000 requests for examination were received per year.

1227.3 A change in the current system would require a significant increase in cost, as well as in terms of human resources. For all those reasons his Delegation could not accept paragraphs (1) and (2) of Article 16.

1228.1 Mr. PARK (Republic of Korea) supported the proposals of the Delegations of Japan and Germany. His Delegation was aware that search reports were useful and that they could be established on the basis of the conditions of patentability. However, he drew attention to the fact that duplication of work could result as a consequence of the overlap between the search report and substantive examination. Such a situation would impose a heavy burden upon national Offices and would produce further examination delays.

1228.2 As far as the time limit for examination was concerned, he expressed the concern of his Delegation because, in practice, the time for examination depended on the capacity of the Office, which was not under the control of the Office.

1228.3 He stated that Article 16 would be an obstacle for many countries to join the Treaty. Consequently, his Delegation supported the deletion of that Article.

1229. Mr. BAKER (Australia) stated that his Delegation supported the proposals by the Delegations of Japan and Germany for the reasons given by those Delegations. He recalled that his country also had a deferred examination system.

1230. Mr. GARIEPY (Canada) supported the proposals of the Delegations of Japan and Germany. Article 16 would be an obstacle for many countries to join the Treaty. He recalled that his country also had deferred examination system.

1231. Mr. NEERVOORT (Netherlands) expressed the sympathy of his Delegation for the proposals of the Delegations of Japan and Germany. He mentioned that his country not only had adopted the deferred examination system but had invented that system. He indicated that the system also worked extremely well. However, he added that his country was currently preparing new legislation on patent protection which would not provide for a system of deferred examination, but for simple registration. He explained that the change in the national legislation was not due to the fact that there was dissatisfaction with the deferred examination system, but that it was a consequence of the reduced number of applications that were filed at the national Office. He mentioned that the users preferred to apply to the European Patent Office in order to obtain a European patent. He stated that Article 16 went beyond the aims of harmonization and, if adopted, would entail a heavy financial burden on national Offices.

1232. Ms. RODRIGUEZ MITTELBACH (Brazil) expressed the support of her Delegation for the proposals by the Delegations of Japan and Germany for the reasons given by the preceding speakers and considered the particular case in her country wherein almost 13,000 applications were filed per year and 30% of them were not examined, since no requests for examination were made, nor were search reports established.

1233. Mr. TALUKDAR (Bangladesh) expressed the strong support of his Delegation for the deletion of Article 16. He stated that that Article would impose a heavy burden on national Offices and he shared the reasons given by the preceding delegations for deleting Article 16.

1234. Mr. BALTA (Turkey) expressed the support of his Delegation for the deletion of Article 16.

1235. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for Article 16 as envisaged in the basic proposal. As for the financial implications of Article 16 for national offices, he drew attention to the fact that fees could be imposed for the search report, as well as for the examination report.

1236. Mr. MOTA MAIA (Portugal) expressed the support of his Delegation for the proposals of the Delegations of Japan and Germany. He considered that the deletion of Article 16 would be the most prudent decision.

1237. Mr. PAAERMAA (Finland) expressed the support of his Delegation for the proposals of the Delegations of Japan and Germany.

1238. Mr. O'FARRELL (Ireland) expressed the support of his Delegation for the proposals of the Delegations of Germany and Japan.

1239. Ms. KRUDO SANES (Uruguay) expressed the support of her Delegation for the proposals of the Delegations of Japan and Germany.

1240. Mr. KUNKUTA (Zambia) expressed the support of his Delegation for the proposal of the Delegation of Japan.

1241. Mrs. DIVOY (France) said that her Delegation supported the basic proposal and suggested, to allow for the difficulties expressed by a number of Delegations, that a transitional period be allowed.

1242. The CHAIRMAN announced a meeting of the Steering Committee.

1243. Mr. KESOWO (Indonesia) announced the meeting of the Group of 77 and of the Coordinators of the Regional Groups of the Group of 77.

1244. Mr. ROMERO (Chile) announced a meeting of the Latin American Group.

1245. Mr. SAPALO (Philippines) announced a meeting of the Asian Group.

1246. The CHAIRMAN adjourned the meeting.

Fourteenth Meeting
Monday, June 17, 1991
Morning

Article 16: Time Limits for Search and Substantive Examination (continued from paragraph 1246)

1247.1 The CHAIRMAN extended thanks to the Benelux Trademark Office for the reception that it had hosted on the previous Friday evening and to the Netherlands Group of AIPPI and the Netherlands Institute of Patent Agents for the excursion that they had organized on the previous Sunday to the delta works.

1247.2 He indicated that discussion on draft Article 16 would be continued, especially in respect of the proposals of the Delegations of Japan, contained in document PLT/DC/21, and of Germany, contained in document PLT/DC/36.

1248.1 Mr. KIRK (United States of America) indicated that his Delegation felt that Article 16 was one of the most important Articles in the draft Treaty, stating that, without an obligation to grant patents within a reasonable period of time, the rest of the provisions in the Treaty were for naught.

1248.2 He stated that patent systems should stimulate the creative endeavors of inventors so as to achieve progress and to enhance the well-being of all the citizens of the world. He stated that all applications should receive a search report at the earliest possible time, and that 18 months, or the optional 24 months, were appropriate periods of time in that regard. He observed that the publication of an application without a search report, while arguably disclosing technology, had a chilling effect on corporate freedom of operation. In that regard, he stated that it was not an answer to the publication of a large number of unsearched documents to say that third parties could request search reports since that would place an undue burden on the third parties.

1248.3 He referred to one country in which 500,000 applications were published annually which, he stated, caused a problem for corporations to search for applications that might be of interest to them, in a language that might not be familiar to them. He considered that the applicant should pay for the search report, not the public.

1248.4 He recalled that there had been some comments that the publication of a search report with the publication of a patent established a "two stage" system. In response, he stated that his country could meet all of the requirements of Article 16 in one combined proceeding, including the establishment of a search report for an application.

1248.5 He asserted that three years in which to start the examination was an adequate period of time in most areas of technology for an applicant to determine if he still had a commercial interest in the invention, noting that

only in some fields, such as pharmaceuticals, might that not be the case. He stated that there was no excuse for delaying the examination of applications for an undue time, in particular, since the Treaty called for the term of the patent to begin at the date of filing. The two-year period for the completion of examination was an obligation that he considered most countries should be able to comply with.

1248.6 He observed that ability to comply on the part of some Contracting Parties was influenced by the number of examiners and other resources available, which might, in some cases, require a doubling of examiners. He stated that his country was asked to make many changes, without even considering the first-to-file/first-to-invent question. He considered that countries with resources like Japan should be able to comply if they had the political will to fulfill the obligations contemplated under Article 16. He noted that in his country the number of examiners had been doubled so as to reduce the time required for examination.

1249.1 Mr. VON ARNOLD (Sweden) indicated the full support of his Delegation for Article 16. He considered that some of the disquiet that had been expressed concerning it might have resulted from the reluctance of public agencies to set time limits for the conduct of their work and from concern that they might not be able to comply with such limits. He stated that the Conference was not to act as the guardian of patent offices, but to balance the interests at stake, including those of inventors, the public and of third parties.

1249.2 He stated that it was in the interest of inventors to receive search results at the earliest possible moment so as to determine if the application should be pursued. If the results were positive, it would encourage investors and signal competitors of expected protection. In that regard, he saw pending patent applications as acting as a block to technical developments.

1249.3 He considered that, in the interest of the public, Offices should fulfill their tasks in an efficient manner, and needed adequate resources to do so. He felt that Offices should be interested in expediting procedures as the total amount of work on a particular application would increase the longer it was pending.

1250. Ms. BACH (Denmark) indicated that her Delegation in principle supported Article 16 in the basic proposal for the reasons given by the Delegation of Sweden.

1251. Mr. LOSSIUS (Norway) indicated the support of his Delegation for the proposals by the Delegations of Japan and of Germany.

1252. Mr. KORCHAGUIN (Soviet Union) indicated the support of his Delegation for Article 16 in the basic proposal because there was a need to ensure a balance between the interests of inventors and third parties.

1253. Mr. VU HUY TAN (Viet Nam) stated that his Delegation was in favor of Article 16 in the basic proposal because it was consistent with the legislation in his country.

1254.1 Mr. JENNY (Switzerland) stated that his Delegation supported the deletion of Article 16, particularly of paragraph (2) thereof although he

supported the principle of a speedy examination of a patent application, provided that there was a desire for it.

1254.2 He expressed the opinion that a shortening of the deferred examination period would increase the search and examination backlogs in those offices which already today have difficulties in coping with their workload and this could drive those Offices into a mere registration system. He stated that a deferred examination system (even with a seven-year deferral) was preferable to a registration system from the point of view of legal security. He pointed out, furthermore, that third parties interests were taken into account in such systems because they, as well as the applicant, could request examination. He further said that time-limits imposed on Offices could have negative effects on requests for the extension of time-limits by applicants.

1255. Mr. SEGURA (Argentina) stated that his Delegation supported the position of the Delegation of Sweden and the text of Article 16 in the basic proposal because it was advantageous for third parties.

1256.1 Mr. COHN (Israel) supported the principle that a patent should be granted in a reasonable period of time and, in that regard, supported the positions taken by the Delegations of the United States of America and of Sweden.

1256.2 He stated that his country was not a member of a regional arrangement for the search and grant of patents and that, if a search report was relied upon in his country that had been generated in another jurisdiction, it could not be published in his country before it had been published in that other jurisdiction. He therefore expressed his Delegation's agreement to retain Article 16, provided that it was possible for a Contracting Party to satisfy its obligations thereunder by the adoption of a search report from another jurisdiction.

1257. Mr. ALELLA (Kenya) stated that his Delegation supported the deletion of Article 16. He recalled that national Offices were at different stages of development and that compliance with the obligations of Article 16 would be very expensive, requiring offices to double manpower and expertise. This, he stated, would be difficult for countries like his to comply with.

1258. Mr. KAMEL (Egypt) supported Article 16 as in the basic proposal, stating that it was in line with the practice of the Office in his country.

1259. Ms. RODRIGUES MITTELBAACH (Brazil) stated that more reflection should be given to Article 16, especially paragraph (1), because the separation of search and examination would require the commitment of more resources, especially with a deferred examination system and therefore would result in an increasing backlog, which goes against the main interest of patent applicants. Finally, she wanted to reinforce the Office's inability to comply with the time limits due to circumstances beyond its control. However, it was its wish in the spirit of compromise, to accept the principle in question and the provision of paragraph (2) but, only if paragraph (1) was deleted.

1260. Mr. BATOUM (Lebanon) stated that his Delegation supported Article 16 in the basic proposal for the reasons given by the Delegation of Sweden.

1261. Mr. QIAO (China) stated that his Delegation favored the deletion of Article 16 because it would not be possible for the Office in his country to comply with it owing to a lack of resources.

1262. Mr. BULGAR (Romania) stated that his Delegation supported Article 16 in the basic proposal, noting that it was consistent with the draft patent law of his country.

1263. Mr. CHISUM (AIPLA) associated his Organization with the positions of the Delegations of the United States of America and of Sweden in supporting Article 16 as a whole. He stated that his Organization favored, in principle, the international harmonization of patent laws, even if fundamental changes to the patent law of the United States of America would be required. In that regard he stated that his Organization had established a list of things it could not do without in pursuit of harmonization, which included the provisions of Article 16. He saw the advantages as being, in particular, the early resolution of rights, which would allow better decision making on the part of applicants and third parties.

1264. Mr. SANTARELLI (AIPPI) stated that his Organization supported Article 16 and agreed with the comments of the Delegations of the United States of America and Sweden. He stated that the patent systems of a number of countries suffered from slowness, especially in the case of deferred examination systems, which was a disadvantage to applicants and third parties. He suggested that, with respect to Offices that had financial problems in complying with the obligations under Article 16, international cooperation be expanded to make it possible to recognize search reports in other countries.

1265.1 Mr. PAGENBERG (DVGR and MPI) confirmed the observations made by the Delegation of Germany that applicants in Germany were satisfied with the system of deferred examination, which gave them an opportunity to explore the market before requesting examination. He noted that the deferred examination system was taken advantage of primarily by domestic applicants and that applicants, domestic and foreign, could get a fast grant if such were desired.

1265.2 He considered that the backlog problem should not be confused with a deferred examination system. He urged that Contracting Parties be given the liberty to have deferred examination systems, provided that an examination be conducted within a certain period of time from the request. He noted that the provisions of Article 16 did not apply to Contracting Parties with registration systems and argued that patents under registration systems had the same protection as during the period of deferral in a deferred examination system. He considered, therefore, that lack of protection was not a valid argument against a deferred examination system.

1266. Mrs. RYAN (NYPTC) stated that the provisions of Article 16 were a critical part of a balanced package. In particular, she stated that her Organization could endorse the publication of applications only in the context of receiving early search and examination reports.

1267. Mr. NEUKOM (CIPA) observed that those delegations that had supported the deletion of Article 16 had done so primarily on account of not being able to meet the requirements of paragraph (2). His Organization advocated that the provisions relating to the early publication of search reports of

paragraph (1) be retained, even if paragraph (2) were deleted. He considered that early publication of search reports was not only an aid to applicants, but that it also allowed third parties to review the situation at an early stage.

1268. Mr. CLARK (ABA) stated that his Organization was opposed to the publication of the application under Article 15(1), even after 24-months. He considered that such publication would require a change to the law of the United States of America which would be detrimental to small inventors, especially if they had no desire to file abroad.

1269. Mr. OKAWA (JPAA) stated that his Organization did not support Article 16 because it would require a duplication of effort by examiners in that they would examine applications that would, in some cases, be abandoned by the applicants. He considered that the provision usurped the jurisdiction of Offices and was not a matter for harmonization.

1270. Mr. MITCHELL (PTIC) stated that his Organization supported Article 16 in the basic proposal. He stated that a seven-year deferred examination system was too long and did not serve the interests of the public or third parties. For those countries that could not establish search reports or conduct substantive examination on their own, the possibility existed of relying on the work done in other countries.

1271. Mr. BEIER (CNIPA, FCPA and FICPI) stated that his Organizations supported the deletion of Article 16(1) because they considered that countries could not comply with its provisions, that it caused a duplication of work and was impractical. With respect to Article 16(2), he stated that the term "promptly" in subparagraph (b) was vague and suggested establishing a time limit from the filing date for the issuance of a report on the merits of an examination. On balance, he felt that it was more realistic to delete Article 16(2).

1272. Mr. TAKADA (JPA) stated that his Organization supported the position taken by MPI in favor of the deferred examination system. He considered that the three-year period established in Article 16(2) for requesting examination was too short and could lead to longer delays in examination.

1273. Mr. BANNER (IPO) stated that his Organization supported the positions taken by the Delegations of Sweden and the United States of America. He noted that the United States of America was familiar with the practical problems caused by a speedy search and examination system since that country had taken steps to issue patents on average within 18 months. He considered Article 16 to be of pivotal importance to American industry. He stated that such a system was necessary because people had to know, within a reasonable period of time, what they were entitled to do.

1274. Mr. MELLER (NYPTC) stated that his Organization was in favor of retaining Article 16 in its present form. While understanding the problems of offices, he considered that the ultimate aim of the Treaty should be to serve inventors and the corporations that employ them. If it was necessary to double the staffing levels of offices to achieve the requirements of Article 16, he considered that to be necessary in the interest of harmonization.

1275. Mr. BETON (UNICE) stated that his Organization supported the principle of a speedy examination but was opposed to stated time periods, especially with respect to examination.

1276. The CHAIRMAN observed that Article 16 in the basic proposal only concerned States having substantive examination systems. He noted that the number of member Delegations supporting the proposals of the Delegations of Japan and Germany was not sufficient to amend the basic proposal and, thus, the text of Article 16 would remain as the basis for further discussion. However, he would not exclude that a compromise be found through appropriate amendments to Article 16.

1277. The CHAIRMAN stated that there were two other proposed amendments to Article 16, one from the Delegation of Norway, contained in document PLT/DC/8, and the other from the Delegation of the United States of America, contained in document PLT/DC/53. He then asked the Delegation of Norway to introduce its proposal.

1278. Mr. LOSSIUS (Norway) stated that the proposal of his Delegation with respect to paragraph (1), contained in document PLT/DC/8, represented a compromise, related to the solution suggested by the Delegation of Israel, to allow Contracting Parties to rely on search reports established by the offices of other Contracting Parties. In particular, he saw the Patent Cooperation Treaty (PCT) as a ready-made tool for accomplishing that goal. He observed that the proposal of his Delegation took care of the problem of separate search and examination, especially if its proposal to amend paragraph (2) was accepted. He stated that, if the proposal made in respect of paragraph (1) was not accepted, then his Delegation would have to call for the deletion of that paragraph, if not of the whole of Article 16. He noted that in the Office of his country a third party might request a search of an application provided that he paid for it.

1279. The CHAIRMAN noted that there was no support for the proposal of the Delegation of Norway which, consequently, would not be discussed.

1280. Mr. BOGSCH (Director General of WIPO) stated that the problem of the duplication of searches, addressed in new paragraph (1)(d) of the proposal of the Delegation of Norway, could be avoided by an agreement between Contracting Parties to share search results. He felt that such cooperation could remove fears of Offices that they had too much to do and could not comply with the requirements of Article 16(1). He suggested that the matter could be considered in the context of the possible modification of the Patent Cooperation Treaty (PCT) system.

Article 16(2): [Time limits for Substantive Examination]

1281. The CHAIRMAN then turned to a discussion of Article 16(2) and noted that there were two proposals on Article 16(2)(c), one by the Delegation of Norway, contained in document PLT/DC/8, and the other by the Delegation of the United States of America, contained in document PLT/DC/53. He invited the Delegation of Norway to introduce its proposal.

1282. Mr. LOSSIUS (Norway) stated that the proposal of his Delegation, contained in document PLT/DC/58 was intended to merge the provisions of

subparagraph (a), which provided that substantive examination had to begin not later than three years from the filing date of the application, and subparagraph (c), which provided that a final decision had to be reached no later than two years after the start of substantive examination. He observed that, according to his proposal, the earlier a search report was established, the more time the applicant and the Office would be allowed to devote to reaching a good final decision on the merits of an application.

1283. The CHAIRMAN asked the Delegation of the United States of America to introduce its proposal.

1284.1 Mr. KIRK (United States of America) stated that the proposal of his Delegation, contained in document PLT/DC/53, was intended to augment the basic proposal by requiring that an Office reach final decisions on applications in no longer than an average of two years. He was concerned that the provisions of Article 16(2) in the basic proposal offered too much flexibility in requiring Offices "wherever possible" to reach final decisions on applications not later than two years after the start of examination. In particular, he felt that some Offices would use the provision to avoid non-compliance with the two-year limitation on all or most applications before it.

1284.2 He explained that, if an Office could not reach final decision within two years in a particular area of technology, it would have to reach final decisions more quickly in other areas of technology so that final decisions in all cases would be reached, on average, within two years. He saw the provision as being an appropriate tightening of paragraph 2(c).

1285. The CHAIRMAN observed that in the French text the phrase "dans la mesure du possible" ("wherever possible" in English) appeared to apply to the whole paragraph, whereas it was only the first part of the provision to which it was intended to apply, the second part being mandatory.

1286. Mr. COHN (Israel) stated that the term "final decision" in paragraph (2)(c) would require clarification. In particular, he inquired whether it was intended to mean that an interference that had been declared in the United States Patent and Trademark Office would have to have been disposed of. He stated that in some countries disputes were resolved by other means, which could take longer than two years. He considered the proposal of the Delegation of Norway, contained in document PLT/DC/8, to be clearer and stated his support for it.

1287. Mr. KIRK (United States of America) stated that the term "final decision" meant that a patent had been granted or that the application had been refused or abandoned, including as a result of interferences that had been decided.

1288. Mr. VON ARNOLD (Sweden) indicated that his Delegation supported the proposal of the Delegation of Norway.

1289. Mr. GAO (China) stated that his Delegation supported the proposal of the Delegation of Norway.

1290. Mrs. DIVOY (France) wished to put a question with respect to the basic proposal and also to the proposals by the Delegation of Norway and the Delegation of the United States of America. She asked what would happen if the Office did not meet its obligation.

1291. The CHAIRMAN expressed the view that the response to the question raised by the Delegation of France was dependent upon the provisions contained in Article 30 ("Settlement of Disputes").

1292. Mrs. DIVOY (France) asked whether an individual could avail himself of the provisions on disputes, since that did not seem possible to her.

1293. The CHAIRMAN indicated that Article 30 was within the jurisdiction of Main Committee II and could not be taken up in a meeting of Main Committee I.

1294.1 Mr. BOGSCH (Director General of WIPO) stated that national laws varied as to whether private parties could bring an action against a national Office. Moreover, he stated that national practices differed in respect of how, and under what conditions, private parties could obtain the support of their national government to initiate a dispute with another Contracting Party.

1294.2 He stated that, in addition to the provisions of the Treaty found in Article 30 in respect of the settlement of disputes, there was always the possibility of public discussion, for example in WIPO meetings, of any allegation that a country did not seem to comply with its obligations under treaties. Such a discussion may have a persuasive effect.

1295. Mr. RAVN (Denmark) stated that his Delegation supported the proposal by the Delegation of Norway.

1296.1 Mr. UEMURA (Japan) stated that, while the intention of the proposition of the Delegation of Norway in respect of Article 16(2)(c) was to make the provisions of Article 16 more flexible, it was not flexible enough. Therefore, his Delegation could not support the proposal.

1296.2 In respect of the proposal of the Delegation of the United States of America, he stated that it was more strict than the basic proposal and that his Delegation could not, therefore, support it either.

1296.3 He considered that it was advisable to keep the proposal of the Delegation of Norway in respect of Article 16(1) open until the second part of the Conference so as to allow time for further consideration, since there had been insufficient time to study it in depth.

1297. The CHAIRMAN indicated that there was nothing to prevent a delegation from introducing all or part of a proposal in the second part of the Conference.

1298. Mr. HATOUM (Lebanon) stated that his Delegation favored the proposal by the Delegation of Norway as offering further flexibility with respect to time limits for search and examination.

1299. Mr. SUGDEN (United Kingdom), while reiterating that his Delegation had no problem with the basic proposal, stated that his Delegation had sympathy for the proposal of the Delegation of Norway in respect of paragraph (2)(c), particularly if paragraph (2)(a) were deleted. He considered it to be crucial that the examination be limited in time, indicating that his Office was required to complete examination within four and one-half years from the priority date. He felt that having no prescriptive limits as to what happened before grant provided greater flexibility.

1300. Ms. SANDBERG (Sweden) stated that the proposal of the Delegation of Norway in respect of new paragraph (1)(d) had merits and called for the retention of the paragraph until the second part of the Conference so that it could be thoroughly discussed in the meantime.

1301. Mr. MELLER (NYPTC) stated that the term of five years after the date of application to reach a final conclusion on an application was too long. He noted that the United States of America had set itself a target of 18 months, which it had reached, and that it was therefore inconceivable that the United States Congress would ratify a treaty with such a liberal approach.

1302. Mr. SANTARELLI (CNCBI), referring to the observation made by the Delegation of France, stated that he wished to take a stance on behalf of the French professionals. He would have liked the Treaty to impose time limits on the national offices since that was obviously in the interests of applicants. However, since no sanctions were provided for--and he was unable to see how sanctions could be imposed on the national offices--the French professionals held that paragraph (2)(c) would be of no effect. Consequently, he was in favor of its deletion.

1303. Mrs. DIVOY (France) said that her Delegation preferred the basic proposal with regard to the matter of time limits. However, if the proposal by the Delegation of Norway was able to obtain a large majority of countries, her Delegation would go along with that since it would represent progress when compared with the present situation. Her Delegation therefore repeated its wish that the consequences of failure to comply be dealt with whatever the alternative chosen since it did not think that Article 30 settled that problem.

1304. Mr. BOGSCH (Director General of WIPO) explained that he had attempted to sketch out the possible consequences of failure to comply. He asked the Delegation of France to give some idea of what it would like to see as a consequence of failure to comply.

1305. Mrs. DIVOY (France) observed that it was difficult to think of a reply that would be valid in all countries. There were countries in which a third party could take action against an office because it had not carried out the examination, but that did not seem to be the case in all countries. As to the possibility that the country itself in default would recognize the fact, she did not think that any country would put its own neck into the noose. She asked whether it was not a problem on which there should be reflection and for which proposals could be put forward at the second part of the Conference.

1306. The CHAIRMAN observed that the only truly effective sanction would be a paragraph saying that if examination was not completed the patent would be deemed to have been granted on the basis of the documents submitted up to such time.

1307.1 Mr. SUGDEN (United Kingdom) agreed that it was of great importance that the examination of applications be effected as rapidly as possible. His Delegation approved of paragraph (2) and he stated that it should be looked at in conjunction with paragraph (1). In particular, the early publication of the application and search report was crucial but a more relaxed approach seemed possible for the time limits in respect of the examination of applications. In that regard, he recalled that the Office in his country was required to complete the examination of applications within a fixed period of time.

1307.2 He stated that it was crucial that the search report be published at the same time as the publication of the application so that the applicant could withdraw the application if he desired and so that the interests of third parties could be safeguarded. Another safeguard for third parties would be to allow them to request the examination of applications.

1307.3 Though he applauded the accomplishment of the United States Patent and Trademark Office in reducing the examination time of applications to, on average, 18 months, he noted that applications in some technologies in that Office took longer, especially when continuation and continuation-in-part applications were taken into consideration.

1308. The CHAIRMAN concluded that there was not sufficient support for the proposals of the Delegations of the United States of America and Norway in respect of Article 16(2)(c) and that, in consequence, the basic proposal would provide the basis for further discussion. He urged the delegations to make an effort to find a generally acceptable solution for the second part of the Conference.

1309. Mr. BOGSCH (Director General WIPO) stated that, since some proposals had been submitted and published well before the first part of the Conference, the same could be done for the second part. He suggested that those Delegations that had submitted proposals that had prompted new ideas but were not adopted might wish to propose new amendments taking into consideration those new ideas, possibly with an explanatory note. He urged that proposals for the second part of the Conference be submitted well in advance of its beginning to allow sufficient time for their consideration by the invited countries and organizations.

1310. The CHAIRMAN observed that a number of proposals had not received all the attention they would deserve since they had been received late. He also urged delegations, therefore, to submit proposals as early as possible.

1311. The CHAIRMAN concluded that Article 16 of the basic proposal would be taken as a basis for further discussion.

1312. The CHAIRMAN then closed discussion on Article 16 and opened discussion on Article 17.

Article 17: Changes in Patents

1313. The CHAIRMAN noted that there were two proposals in respect of Article 17, one by the Delegation of Japan, contained in document PLT/DC/22, and the other by the Delegation of the United States of America, contained in document PLT/DC/54. He recalled, with respect to the proposal of the Delegation of Japan, that it had been decided when Article 14 was discussed that the question of changes relating to obvious mistakes and clerical errors would be examined not only in respect of changes to patents under Article 17, but also with respect to changes in applications under Article 14. He then invited the Delegation of the United States of America to introduce its proposal.

1314.1 Mr. KIRK (United States of America) stated that the proposal of his Delegation, contained in document PLT/DC/54, was to add to Article 17(1) in the basic proposal a sentence that read: "A Contracting Party shall be free

to provide that changes made must be to correct errors made in good faith." The concern of his Delegation was to enable Contracting Parties to require that an owner of a patent might only request changes in patents to correct errors made in good faith, not those resulting from a failure to disclose information in his possession.

1314.2 He gave the example of a hypothetical situation in which the owner of a patent obtained a patent with broad claims, while being aware of prior art that would narrow the claims. A third party became aware of the prior art and asserted that the claims were not valid as a consequence. If the owner of the patent then sought to narrow the claims so as to avoid invalidity on the basis of the prior art of which he was aware, he considered that Contracting Parties should be free not to allow the correction of such errors made in bad faith.

1315. The CHAIRMAN characterized the proposal of the Delegation of the United States of America as enabling a Contracting Party not to effect a change to a patent when the patentee knew, at the time that the patent was granted, that the claims were too broad.

1316.1 Mr. SUGDEN (United Kingdom) supported, in principle, the proposal of the Delegation of the United States of America, stating that limitations to the extent of protection should only be allowed if made in good faith. He indicated a preference that there be no reference to "errors," as in the proposal. Subject to drafting changes, therefore, his Delegation could accept the proposal.

1316.2 He stated furthermore that the requirement of "good faith" related to the changes themselves. He suggested that the wording of the proposal could be changed so that a Contracting Party would be free not to allow changes unless they had been made in good faith.

1317. Mr. UEMURA (Japan) stated that, while his Delegation had some sympathy for the proposal of the Delegation of the United States of America, it had some reservations concerning its usefulness. In particular, he wondered what the term "good faith" meant. He asked how the requirement applied to the following situations: (i) where the applicant retained, in secret, prior art known to him; (ii) where the applicant was aware of the existence of prior art, but did not understand its significance; and (iii) where the applicant did not know of the existence of the prior art. He felt it was necessary to clarify the terminology, lest it lead to a watering down of the right of the owner of a patent to make corrections to a patent.

1318. Mr. KIEK (United States of America) stated that only if an applicant knew of prior art and that he claimed more than he had a right to claim would it amount to bad faith.

1319.1 Mr. SCHAEFERS (Germany) stated that his Delegation had no sympathy for the proposal by the Delegation of the United States of America. He considered that the provisions contained in the proposal were of interest only to countries that placed a lot of emphasis on the good or bad faith of an applicant.

1319.2 He stated that his country had a procedure to limit patents after grant wherein it was possible for the owner of a patent to change the scope of the patent so as to avoid its invalidity. He observed that a similar possibility

existed in the Community Patent Convention, and in neither case was there a requirement of good faith. Such provisions should be quick and convenient for the patent owner.

1319.3 He stated that, in the United States of America, bad faith by the patentee or the applicant was already a ground for the invalidation of a patent. While this was accepted in the United States of America, it should not block the possibility of limitation proceedings being quick and inexpensive for patent owner in other jurisdictions.

1320. Mr. COHN (Israel) supported the position of the Delegation of Germany. He stated that the requirement of "good faith" would introduce subjective elements which would be difficult to prove or disprove. He felt that the procedure for the limitation of the extent of protection of a patent should be simple and straightforward and that the introduction of the requirement of "good faith" would run counter to that.

1321.1 Mr. MESSERLI (Switzerland) stated that his Delegation had some sympathy for the proposal of the Delegation of the United States of America, but saw it as running counter to the objective of harmonization.

1321.2 He stated that the proposal would present the owner of a patent with problems of discovery and proof that would be too complicated. He asked the Delegation of the United States if, due to bad faith, the owner of the patent could not limit his patent and the patent was attacked in nullity proceedings, whether the possibility of partial nullity would be available to the patent owner in that country. If such a possibility existed, then he could not see the reason for the proposal.

1322. Mr. KIRK (United States of America) inquired as to the meaning of the term "partial nullity."

1323. Mr. MESSERLI (Switzerland) stated that it applied where the claims were too broad and a tribunal limited the patent to the part that was not too broad and, hence, still valid.

1324.1 Mr. KIRK (United States of America) stated that the system in the United States of America was different. A judge would look at a claim so as to preserve its validity, interpreting it in a limiting way. If, however, the prior art was such that the patent was invalid, and no limiting interpretation could assist, the claim would be held invalid and the court would not re-write the claim.

1324.2 He stated that the proposal of his Delegation addressed the situation of an individual getting a right to which he was not entitled and his Delegation would like the facility to refuse giving such a right.

1325. Mr. SUGDEN (United Kingdom) envisaged a situation in which prior art would intrude on the original claims. If the applicant was aware of the prior art, or was dilatory in bringing the prior art to the attention of the Office, then there would be a lack of good faith and the patent owner would have to stand by the original claims and suffer the consequences, perhaps their invalidity.

1326. Mr. KIRK (United States of America) stated that his Delegation was in agreement in principle and result with the Delegation of the United Kingdom, but differed only in terms of the drafting of the proposal.
1327. Mr. BOGSCH (Director General of WIPO) stated that the proposal of the Delegation of the United States of America could perhaps be redrafted to the effect that limitation of claims should be allowed where the applicant had in good faith claimed more than what he should have claimed.
1328. Mr. HIDALGO LLAMAS (Spain) stated that his Delegation had sympathy for the proposal of the Delegation of the United States of America, considering it to be a good mechanism for countries such as his with no substantive examination, wherein the grant of patents was made without guarantee as to the conditions of patentability (that is, novelty and inventive step).
1329. Mr. VON ARNOLD (Sweden) associated his Delegation with the positions of the Delegations of Germany and Israel in rejecting the proposal of the Delegation of the United States of America.
1330. Mr. UEMURA (Japan) indicated that his Delegation had difficulty in accepting the proposal of the Delegation of the United States of America.
1331. Mr. PAGENBERG (MPI) stated that the provisions contained in the proposal of the Delegation of the United States of America could be dangerous in that infringement proceedings could focus on subjective elements. He emphasized that limitation proceedings should be inexpensive and speedy.
1332. Mr. PAAERMAA (Finland) supported the proposal of the Delegations of Germany and Israel, stating that the owner of a patent should be able to ask for the limitation of a patent without having to prove good faith.
1333. Mr. KOLLE (EPO) stated that his Delegation supported the basic proposal, since limitation proceedings were very useful and should be simple and straightforward. He considered it to be of benefit to third parties to have a mechanism for the limitation of patents that had been granted with too broad a scope of protection. He did not see it as appropriate to refuse a limitation due to bad faith as it could lead to more costly and complicated proceedings. Third parties could initiate invalidation proceedings which could lead to a complete loss of the patent, a result that he considered to be extreme.
1334. Mrs. BESAROVIC (Yugoslavia) indicated that her Delegation had reservations with respect to the proposal of the Delegation of the United States of America and that it supported Article 17 in the basic proposal. In particular, she saw the criterion of good faith as presenting certain dangers in practice in requiring proof of subjective elements.
1335. Mr. HATOUM (Lebanon) stated that the element of good faith was difficult to prove and was, therefore, against the proposal of the Delegation of the United States of America in document PLT/DC/54.
1336. Mr. SUGDEN (United Kingdom) pointed out that the proposal of the Delegation of the United States of America was intended to give an option to Contracting Parties. He stated that his country had observed incidents of bad faith on the part of applicants and wished to be able to take into

consideration the behaviour of applicants in determining whether to limit the extent of protection.

1337. Mr. RAVN (Denmark) stated that his Delegation did not support the introduction of the requirement of good faith in paragraph (1), even if it was an optional provision. He saw the addition of such a requirement as being a step away from harmonization and that it was in the interest of third parties and patent owners to be able to limit the extent of protection with few impediments. The patent holder's reasons for requesting limitation should not be questioned.

1338. The CHAIRMAN concluded that the question was not ripe. He observed that a number of delegations were hesitant to introduce the requirement of good faith, especially if it was to be decided by an Office.

1339.1 The CHAIRMAN suggested reflecting on the idea of confining the notion of good faith to certain specific concrete cases. He also suggested the possibility of replacing the requirement of good faith with the element of knowledge of prior art, by adding, for example, the following sentence to paragraph (1): "Nevertheless, the competent Office shall be free to refuse a requested limitation where the purpose of the limitation is to take into consideration an item of prior art of which the owner of the patent had knowledge at the time of the grant of the patent."

1339.2 He then adjourned the meeting.

<p><u>Fifteenth Meeting</u> <u>Monday, June 17, 1991</u> <u>Afternoon</u></p>

Article 17: Changes in Patents

1340. The CHAIRMAN convened the meeting to continue discussion of the proposal of the Delegation of the United States of America in respect of Article 17(1), contained in document PLT/DC/54.

1341. Mr. BEIER (FICPI and FCPA) supported the view of the Delegations of Germany and Israel, especially in light of the statement of the Delegation of the EPO.

1342. Mr. MELLER (ABA) associated his Organization with the statement of the Delegation of the United States of America and called attention to the portion of the patent law of that country which applied to re-issue applications and which allowed the reissue of patents which were wholly or partly inoperative or invalid "through error without any deceptive intention." He suggested, as a compromise, that the proposal be re-drafted to allow the correction of errors "made without any deceptive intent," rather than "made in good faith."

1343. Mr. LECCA (UEPIP) stated that the concept of fraud should not be introduced into the provisions of paragraph (1), since that was a matter that should be brought to the attention of courts.

1344. Mr. IANNANTUONO (Italy) indicated that his Delegation supported Article 17(1) as it appeared in the basic proposal. He raised the case of a patent owner having knowledge of a document which was in a language unknown to him, but which included a summary that did not disclose the point which would limit the scope of protection that he had claimed. If the patent owner then asked advice concerning the document and was apprised of the full disclosure of the document, he might not request limitation for fear of losing the patent, a result that was against the interest of the public.

1345.1 The CHAIRMAN noted that five member Delegations had supported the proposal by the Delegation of the United States of America in document PLT/DC/54, a number that was not sufficient for the proposal to be retained as the basis for further discussion.

1345.2 He noted that Article 17(1) only concerned limitation proceedings in Offices and that it did not deal with the proceedings in courts.

Article 17(4): [Changes Affecting the Disclosure]

1345.3 He proposed moving to the proposal by the Delegation of Japan in respect of paragraph (4), contained in document PLT/DC/22. He recalled that the questions raised during the consideration of Article 14 concerning the correction of obvious mistakes and clerical errors in applications would be taken into account in respect of Article 17. He then invited the Delegation of Japan to introduce its proposal.

1346.1 Mr. UEMURA (Japan) stated that clarification of the words "limit the extent of the protection conferred by [a patent]" in paragraph (1) was needed before paragraph (4) could be considered. For this purpose he introduced an informal paper which had been circulated by his Delegation which included a drawing, description and claim directed to a hypothetical invention in the field of golf putters.

1346.2 The hypothetical application described a golf putter having a slip-free grip and a head having an enlarged "sweet spot." It was stated only in the description that the enlarged "sweet spot" provided improved regulation of the direction of the ball once hit. The claim in the hypothetical application read: "A golf putter characterized by having a slip-free grip."

1346.3 A third party came forward with prior art which showed a slip-free grip in combination with a golf putter. The patent owner then asked the Office to limit the extent of protection of the patent by changing the claim to add the element of the enlarged "sweet spot" to the elements in the original claim.

1346.4 He stated that the object of the invention has shifted from the original one to a completely different one by the addition of an additional technical feature. Accordingly, his Delegation felt that such a change should not be considered to constitute a limitation that would come within the scope of paragraph (1).

1347. The CHAIRMAN cautioned the Committee about the delicacy of discussing a specific case.

1348.1 Mr. BARDEHLE (Germany) stated that his Delegation felt that the change to the claim postulated by the Delegation of Japan would be permitted as it was a further limitation to the claim. The first claim was to a golf putter having a slip-free grip, without regard to the head, and the later claim added a head with an enlarged "sweet spot."

1348.2 He stated that it appeared that the Delegation of Japan wanted to make a distinction between whether the newly claimed subject matter was originally claimed or simply disclosed, without being claimed. He considered that, if the subject matter was originally found in a sub-claim, there would be no doubt that it could be included within the later claim. Similarly, if the subject matter was simply disclosed, especially in relation to the overall invention, he could see no reason not to permit the limitation of the extent of protection.

1348.3 He stated that a limitation would not be permissible only if it shifted the invention to a completely different purpose, such as using the putter to cut grass. As long as it remained a golf putter, and with positive advantageous effects, he felt that the requested limitation should be permitted.

1349.1 The CHAIRMAN stated that, if the new claim had been a dependent claim in the patent, the requested limitation of the extent of protection would be permitted. He observed that the new claim covered the combination of the two characteristics--the slip-free grip and the enlarged "sweet-spot."

1349.2 He requested confirmation from the delegations of the following analysis. He stated that one could imagine a similar situation arising before grant. If the new claim in the example of the Delegation of Japan was presented to an Office in an application, the Office could object to the new claim on the ground of unity of invention. However, since lack of unity was not a ground for invalidation or revocation under Article 5(2), the introduction of the new claim in the patent, after grant, could not be objected to on the ground of lack of unity.

1350.1 Mr. NEERVOORT (Netherlands) stated that the practice of Offices was that, if an applicant wanted a second claim, then the question of unity of invention arose. The claim could be split off in a separate application but, if the applicant did not want a separate application, it could be included in a dependent claim.

1350.2 He stated that, after the patent was granted, the question of limitation arose. If, after grant, the addition of a "sweet spot" was desired, its addition had to be accepted as a limitation, but could not give rise to an exclusive right as it was never examined and might be found in the prior art.

1351. Mr. UEMURA (Japan) stated that he assumed that the enlarged "sweet spot" was not in the original claim as filed, only in the disclosure. He stated that it was the view of his Delegation that the portion of the disclosure relating to the "sweet spot" should be considered dedicated to the public and that the example that was given should not be considered as falling within the terms of paragraph (1).

1352. The CHAIRMAN noted the position of the Delegation of Japan and moved to a consideration of the proposal of that Delegation, contained in document PLT/DC/22, in relation to Article 17(4).

1353. Mr. UEMURA (Japan) stated that the proposal of his Delegation, contained in document PLT/DC/22, was to establish that changes in a patent to correct obvious mistakes or clerical errors should not be permitted if they resulted in the disclosure in the patent going beyond the disclosure contained in the application as filed. If the disclosure was so expanded, it could present problems such as to endanger the legal effect of the patent in relation to third parties. He added that the proposal was intended to treat changes to patents in the same way as amendments to applications.

1354.1 The CHAIRMAN expressed the view that "obvious mistake" meant a mistake in the text of an application or a patent which was obvious to one skilled in the art such that, when looking at the mistake in the context of the application or patent, he was in a position to correct it. Thus, not only was the presence of the mistake clear to one skilled in the art, but also the manner in which it was to be corrected.

1354.2 He suggested that the term "clerical error" included typing errors, such as the inversion of figures or letters, and errors of transcription.

1355. Mr. GARIEPY (Canada) stated that he associated the word "obvious" to mistakes, not clerical errors and asked whether the term "clerical error" should be qualified by the term "obvious."

1356. Mr. BOGSCH (Director General of WIPO) expressed the view that a clerical error might be unobvious and that it would be better to leave it to each Contracting Party to determine the meaning of the term "clerical errors."

1357.1 Mr. UEMURA (Japan) observed that Rule 91 of the Regulations under the Patent Cooperation Treaty (PCT) was limited to the rectification of "obvious errors" and that it was confusing in Article 17(2) to provide for two types of faults in patents--obvious mistakes and clerical errors. He stated that his Delegation had less difficulty in understanding the term "obvious mistakes" than the term "clerical errors." He observed that "clerical errors" might not be obvious.

1357.2 He observed that Note 17.06 in document HL/CE/VIII/3 stated that a clerical error by an applicant might be "an error [that] may have resulted from causes beyond his control" (such as a clerical error made within his organization). He considered, however, that the contents of an application were under the control of the applicant in his organization and that no clerical mistake in an application which occurred before filing with the Office should fall under the term "clerical errors" in paragraph (2).

1358.1 Mr. SCHAEFERS (Germany) stated that a balance of legal security, on the one hand, and fairness to applicants and the patent owner, on the other, must be struck. He recalled that his Delegation had been in favor of a liberal approach to the correction of applications during the discussion of Article 14. In the context of Article 17 in relation to changes in patents, he stated the situation was different in that there should have been sufficient time to correct clerical errors, which were assumed to be in the original application as filed and then retained during the examination of the application. He therefore supported the proposal of the Delegation of Japan.

1358.2 As to the interpretation that obvious mistakes are those that are obvious to one skilled in the art, he stated that this clarification could go into the rules or into an agreed statement.

1359. Mr. COHN (Israel) supported the proposal by the Delegation of Japan. He stated that it was a legal fiction that the applicant knew what he had filed, especially with respect to translations, which might present a problem if a translation error became apparent later.

1360. The CHAIRMAN observed that translation errors should be detected prior to the grant of a patent.

1361. Mr. COHN (Israel) stated that, in the case of a country having a registration system, the time between filing an application and the grant of a patent was short, reducing the possibility of detecting translation errors.

1362.1 Mr. KIRK (United States of America) stated that his Delegation supported the proposal of the Delegation of Japan. He stated that a clerical error might be obvious to one skilled in the art, but might change the scope of protection, so that the reference to paragraph (2) in paragraph (4) was necessary. In that regard, he gave as an example a claim reciting a range of 5-20, whereas later the patent owner wished a range of 5-25, and stated that it would be difficult to accept that as a clerical error.

1362.2 He stated, with respect to translations of application documents, that, under Article 8, an applicant could file an application which included the original documents along with a translation or could file an application by reference to another previously filed application, to be followed up by a translation. In such cases the translation of the documents would be able to be corrected at a later stage.

1363. Mr. MESSERLI (Switzerland) stated that his Delegation agreed with the definition given by the Chairman of the meaning of the term "obvious mistakes." According to that definition the mistake, as well as the correction, should be obvious. For that reason, he added, it was not possible to argue that, as a result of the changes in the patent to correct those obvious mistakes, the scope of the disclosure could be broadened. However, taking into account that, for a number of delegations, this matter gave rise to concern, his Delegation did not oppose the proposal by the Delegation of Japan.

1364.1 Mr. SUGDEN (United Kingdom) stated that his Delegation was opposed to the proposal by the Delegation of Japan. It was a matter of fairness to allow the applicant to request corrections for obvious mistakes or clerical errors in the granted patent. He emphasized that in a number of countries patents were granted without substantive examination, so that the chances of mistakes or errors were even greater. He added that such mistakes or errors could also be made in the context of systems that provided for substantive examination. 1364.2 His Delegation was aware that safeguards should be provided so as to protect third parties. He mentioned that an individual who acted in conformity with a patent should not be affected by a subsequent change in that patent. However, he was aware of the fact that other delegations did not share the same approach, so he suggested leaving the regulation of that matter to each Contracting Party.

1365. Mr. KORCHAGUIN (Soviet Union) expressed the support of his Delegation for the proposal made by the Delegation of Japan. He considered that the effect of corrections in the scope of the disclosure was too important to be ignored by the Treaty.

1366. Mr. PARK (Republic of Korea) expressed the support of his Delegation for the proposal of the Delegation of Japan for the reasons already given by the preceding delegations.

1367. Mr. KAMEL (Egypt) expressed the support of his Delegation for the whole text of Article 17 as envisaged in the basic proposal. He recalled that, in accordance with the national law of his country, it was possible to introduce corrections and changes in the description of the granted patent. He supported the requirement of good faith set forth in paragraph (3). However, he did not agree with the length of the time limit provided for in that paragraph.

1368. Mr. BAKER (Australia) stated that his Delegation was of the same view as the Delegation of the United Kingdom. He did not support the proposal by the Delegation of Japan and suggested that, if such a provision were to be included in the Treaty, it should be optional and not mandatory for the Contracting Parties.

1369. Mr. NEERVOORT (Netherlands) recalled that his Delegation and the Committee of Experts had expressed the view that there was no need to provide for the correction of obvious mistakes because any person skilled in the art would appreciate the existence of obvious mistakes and could read the patent as if those mistakes did not exist. However, since the majority of the delegations at the Committee of Experts were of the view that such a provision should be included, his Delegation could accept it, but not the proposal made by the Delegation of Japan.

1370. Mrs. DIVOY (France) said that her Delegation supported the proposal made by the Delegation of Japan.

1371. Mr. MITCHELL (PTIC) stated that his Organization shared the views expressed by the Delegation of the United Kingdom. He recalled that an obvious mistake or a clerical error might be made not only by the applicant but also by other parties involved, including the national office over which the applicant did not have any control.

1372. Mr. PAAERMAA (Finland) expressed the support of his Delegation for the proposal by the Delegation of Japan according to which a reference to paragraph (2) would be included in paragraph (4) of Article 17.

1373. Mr. SCHATZ (EPO) drew attention to the fact that, in his view, paragraph (2) dealt with two different matters: obvious mistakes and clerical errors. As concerned clerical errors, he stated that the French text ("erreurs matérielles") was perhaps more limited in scope than the English text. In fact, in the French text, the meaning of clerical errors could be limited to typographical mistakes, whereas in the English text, clerical errors were those made by clerks. In his view, before deciding whether a reference to paragraph (2) should be added to paragraph (4), the Committee should take a clear decision as to the meaning of the terms "obvious mistakes" and "clerical errors." If the meaning were a restricted one, then

paragraph (4) would probably not need to refer to paragraph (2). The contrary would be the case if the meaning were a broad one. He recalled that the competent bodies of the European Patent Organisation were considering the matter under discussion and it might be advisable to postpone further consideration of this matter to the second part of the Diplomatic Conference, so the developments within the European system could be taken into account.

1374. Mr. VON ARNOLD (Sweden) stated that it was the understanding of his Delegation that Article 17 would not affect the right of a third party that acted in conformity with the patent as published before the corrections were introduced into it. In his view, those third parties should have a sort of prior users' right in their favor. If the understanding of his Delegation was correct, then the approach for Article 17 could be a liberal one and his Delegation would be ready to support the basic proposal.

1375. Mr. KIRK (United States of America), in referring to the preceding speaker, stated that it was the understanding of his Delegation that, whenever the right of third parties may be affected by a change in a patent in accordance with Article 17, such a third party would have intervening rights to protect its interests.

1376. Mr. TALUKDAR (Bangladesh) recalled that a patent was granted after serious examination and long efforts. Therefore, according to his Delegation, one should be prudent in allowing changes to a patent. According to him the patent holder should not be entitled to significantly change the scope of the claims by resorting to the mechanism provided for in Article 17, since it would affect or may affect the rights of third parties. He suggested that the matter be further considered in the second part of the Diplomatic Conference.

1377. Mr. SANTARELLI (AIPPI) expressed the support of his Organization for the proposal of the Delegation of Japan.

1378. Mr. LOSSIUS (Norway) expressed the support of his Delegation for the proposal of the Delegation of Japan.

1379. Mr. BATOUM (Lebanon) stated that corrections of clerical errors or obvious mistakes should not affect the scope of disclosure. He therefore supported the proposal by the Delegation of Japan.

1380. Mr. GARIEPY (Canada) stated that his Delegation could not support the proposal of the Delegation of Japan, since the latter would unnecessarily exclude certain kinds of corrections from the scope of paragraph (2).

1381. Mr. SUGDEN (United Kingdom) stated that his Delegation shared the understanding expressed by the Delegation of Sweden. In order to make that understanding explicit, he suggested including in paragraph (2) the provision contained in the last part of paragraph (3), namely, that any change should not affect the rights of any third party which had relied on the patent as published.

1382. Mr. KHRIESAT (Jordan) expressed the support of his Delegation for the text of Article 17 in the basic proposal.

1383. Mr. NEUKOM (CIPA) expressed the support of his Organization for Article 17. He saw no reason why an obvious mistake or a clerical error should not be corrected as envisaged in the basic proposal.

1384. Mr. UEMURA (Japan), referring to the statement by the Delegation of Sweden, stated that the corrections made under Article 17 as amended by the proposal of his Delegation would have a retroactive effect. He stated that his Delegation did not support the oral proposal of the United Kingdom, since it was its understanding that the corrected text of the patent would have such a retroactive effect. Consequently, third parties which relied on the patent as published could not ignore the text of the patent as corrected.

1385.1 The CHAIRMAN stated that it was not easy to draw a conclusion from what had been said since a relatively limited number of Delegations had been heard, with some support for the proposal by the Delegation of Japan, but that was insufficient for a proposal for amendment. He attempted personally to draw not a conclusion, but certain ideas that he had noted during the debates.

1385.2 He pointed out that there were two systems for granting patents that were very broadly represented among the delegations, that was to say the examination system and the registration system. He also pointed out that, under a registration system, the matter of publication of the application did not normally arise since registration of the patent was fairly rapid. If account was taken of those two systems, he felt it very difficult to justify a differing rule in Article 14 and Article 17 since the only difference that was more or less justified was that third-party rights differed due to provisional protection, in one case, and final protection after grant, in the other case.

1385.3 He therefore felt that two solutions could be conceived: one solution would lay down the same treatment in either case, but would explicitly reserve third-party rights in modifications made after grant of the patent. A further, more liberal possibility would be to maintain the wording of the basic proposal in Article 17 and to liberalize the wording of Article 14, thereby giving a relatively restrictive definition in a rule of what was to be understood by "obvious mistake" and "clerical error." He stressed that, if neither of the two solutions were to be chosen, discussions in the second part of the Conference would concern the basic proposal.

1385.4 He invited delegations to give their views on either of those solutions.

1386. Mr. SCHAEFERS (Germany) stated that his Delegation was in favor of the Chairman's second alternative, namely, a liberal and more flexible approach. In order to clarify the provision under discussion, he suggested that the rules define the terms "obvious mistakes" and "clerical errors." He added that, in defining those notions in the rules, some flexibility would be built into the provision to ensure further development as experience was gained and circumstances changed.

1387. Mr. KIRK (United States of America) stated that there was significant support for the proposal of the Delegation of Japan and, in view of that, it was not clear to his Delegation that the text of the basic proposal should be considered as the basis for further discussion without taking into account the proposal by the Delegation of Japan.

1388.1 The CHAIRMAN stated that the support for the proposal by the Delegation of Japan was not enough to consider it as a basis for further discussion.

1388.2 Since no Delegation wished to comment on the other paragraphs of Article 17, the Chairman turned to Rule 9.

Rule 9: Announcement in the Gazette of the Publication of a Change in a Patent (Ad Article 17(5))

1388.3 There being no comments on Rule 9, the Chairman stated that the text of it in the basic proposal would serve as the basis of further discussion. He then turned to Article 18 ("Administrative Revocation").

Article 18: Administrative Revocation

1388.4 He drew attention to document PLT/DC/59 which contained a proposal by the Delegation of the United States of America concerning Article 18(1). He then invited that Delegation to introduce the first paragraph of its proposal.

1389. Mr. KIRK (United States of America), in introducing paragraph (1) of the proposal of his Delegation, stated that his Delegation was concerned that the public might not get all the information necessary to request the competent Office to revoke a patent in accordance with Article 18. In particular, his Delegation was concerned that the mere announcement in the Official Gazette did not provide the public with adequate information. For that reason, it proposed to amend paragraph (1)(b) so that the time limit established in that provision would commence from the date of publication of the patent and not from that of the announcement in the Official Gazette of the grant of the patent.

1390. Mr. BOGSCH (Director General of WIPO) recalled that, in accordance with an agreement reached at the last session of the Committee of Experts, Article 2(viii) stated that, for the purposes of the Treaty, "published" meant "made accessible to the public" and that those words were defined in Rule 1(3) so as to allow a Contracting Party to consider the laying open of a patent as a publication thereof. For the public to be sufficiently informed so as to be in a position to request revocation, the time limit for requesting revocation should therefore commence from the announcement in the official gazette of the grant of the patent.

1391. Mr. KIRK (United States of America) stated that, in view of the statement by the Director General, his Delegation would prefer that paragraph (1) of its proposal be considered after Article 2 had been discussed.

1392.1 The CHAIRMAN decided to leave the matter aside until the discussion of Rule 1.

1392.2 He then invited the Delegation of the United States of America to introduce paragraph (2) of its proposal in document PLT/DC/59.

1393.1 Mr. KIRK (United States of America) stated that subparagraphs (d) and (e) of paragraph (1) of Article 18 were of concern to his Delegation. Regarding subparagraph (d), he stated that a person that had made a request to a competent Office to revoke a patent could be involved in a repetitive process before the competent Office since the latter was under the obligation to ensure that the requesting party had an opportunity to present his arguments every time that the Office intended to depart from the request. As for subparagraph (e), he stated that provision overlooked the possibility that the owner of the patent himself might make a request under paragraph (1), for instance, to reduce the scope of the claim.

1393.2 He stated, furthermore, that both subparagraphs (d) and (e) did not acknowledge the owner's right to amend the claims.

1394.1 Mr. BOGSCH (Director General of WIPO) sought clarification from the Delegation of the United States of America as to whether it was necessary to include a reference in Article 18 to the right of the owner of the patent to amend the claims when Article 17(1) and Article 18(1) explicitly provided for that right.

1394.2 He added that it was his understanding that at the last session of the Committee of Experts there was an agreement that the procedural safeguard to be specified in the Treaty should correspond to a minimum guarantee for the interested parties to be heard so that the Contracting Parties wishing to avoid "ping-pong" situations would be free not to go beyond that minimum guarantee.

1395. Mr. KIRK (United States of America) stated that his Delegation would prefer to have, in Article 18, an express provision stating the right of the patent holder to amend the claims. He added that he agreed with the Director General that at the last session of the Committee of Experts an understanding was reached concerning the procedural safeguards. Indeed, it was his view that, without the amendment proposed by his Delegation, there was a risk that the parties to a revocation procedure might become involved in a "ping-pong" situation.

1396. Mr. MESSERLI (Switzerland) supported the proposal by the Delegation of the United States of America.

1397. Mr. ELHUNY (Libya) stated that his Delegation had legal difficulties in accepting subparagraph (1)(b). In the national legislation of his country there not such a thing as an administrative procedure for the revocation of a patent. He was, furthermore, of the view that the time limit of six months established in that provision, should be deleted. He sought clarification as to which party had the right to request revocation of the patent.

1398. The CHAIRMAN recalled that Article 18 dealt with an administrative procedure and in no way whatsoever affected the judicial remedies that could be applicable in accordance with the national legislation. As concerned who might request the revocation of a patent, he stated that it could be a third party as well as the owner of the patent.

1399. Mr. KAMEL (Egypt) expressed the support of his Delegation for the suggestion of the Delegation of Libya to delete from subparagraph (b) the time limit of six months. He considered that that period should be reduced to 60 days since recourse to the competent tribunals would be available in the context of the national legislation of his country.

1400. Mr. BOGSCH (Director General of WIPO) recalled that the recourse provided for in Article 18 could only be filed before the competent Office, that is to say, the Office that issued the patent or, in the case of the EPO, the national Office of a designated country as far as effect in that country was concerned. He added that Article 18 in no way affected the right of each Contracting Party to apply its national law, including the statute of limitations, for invalidation or revocation procedures before any instances other than the patent office. Such other instance might be administrative and/or judicial.

1401. Mr. JILANI (Tunisia) stated that the national legislation of his country did not provide for an administrative recourse as envisaged in Article 18. He suggested that the administrative procedure provided therein should be optional for each Contracting Party.

1402. Mr. BOGSCH (Director General of WIPO) stated that the administrative revocation provided for in Article 18 was new for a number of countries. Those countries would have to introduce the necessary changes in their national legislation so as to provide for such a procedure. He explained that this provision was included because it was thought that a simple recourse should be available so as to reduce the expenses, as well as the time, involved in invalidation procedures.

1403. The CHAIRMAN recalled that the provisions of Article 18 applied only in cases where the patent has been granted after a substantive examination, as defined in Article 2(ix), had taken place.

1404.1 Mr. UEMURA (Japan) stated that his Delegation had difficulties in accepting subparagraph (1)(b) of the basic proposal. In the explanatory note on Article 18, which appeared in paragraph 18.03 of document PLT/DC/4, it was stated that, if it was requested that claims A and B be revoked, a proposed decision to revoke only claim B or to revoke claims A, B and C would constitute a "departing from the request" and would require that an opportunity be given to the person making the request to present arguments on the grounds on which the Office intended to depart from the request. He wondered, however, in cases where a request was partially accepted by the Office, whether the person having made the request would have to be provided with an opportunity to present his arguments. Such an interpretation did not seem logical and would not be supported by his Delegation.

1404.2 As for the proposal by the Delegation of the United States of America, he stated that his Delegation considered it to be an improvement of Article 18 and therefore supported it. He expressed the doubts of his Delegation as to the term "claims" in the second sentence of paragraph (d), as proposed by the Delegation of the United States of America. He suggested replacing it by the term "application." He furthermore suggested replacing the word "made," in that sentence, by the word "presented." With the suggestions proposed by his Delegation, that sentence would read as follows: "The owner of the patent shall have at least one opportunity to amend the application and otherwise respond to all arguments and grounds presented for revocation before a decision is presented in respect of the revocation."

1405. Mr. KIRK (United States of America) stated that, as a first reaction, his Delegation did not oppose the suggestions of the Delegation of Japan.

1406. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the proposal by the Delegation of the United States of America. He also expressed the support of his Delegation for the statement by the Delegation of Lihya and suggested that each Contracting Party should establish the time limit referred to in subparagraph (1)(b).

1407. Mr. SCHENNEN (Germany) expressed the support of his Delegation for the text of Article 18 in the basic proposal. His Delegation could not support the proposal of the United States of America. It did not have any objection to the insertion in the text of Article 18 of a reference to the right of the

owner of the patent to have at least one opportunity to amend the claims. However, it believed that the rest of the proposal by the Delegation of the United States of America would deviate significantly from the principle which was embodied in the basic proposal according to which the owner of the patent and the third party should be subject to equal treatment. Secondly, he stated the reservations of his Delegation concerning the second sentence of the proposal by the Delegation of the United States of America in as much as it could lead to a "ping-pong" kind of situation, which was to be avoided.

1408. Mr. RAVN (Denmark) stated that his Delegation shared the view of the Delegation of the United States of America that the process of revocation should not be unduly prolonged by third parties.

1409.1 M. BOGSCH (Director General of WIPO) referred to the last sentence of the proposal by the Delegation of the United States of America, which stated that the decision of the Office could only be based on grounds or evidence on which the owner of the patent had had an opportunity to present its comments. He sought clarification as to whether the owner of the patent should be heard in accordance with that provision when the request for revocation was filed by the owner.

1409.2 He furthermore requested clarification from the Delegation of Japan as to whether the replacement of the word "claims" in the second sentence of subparagraph (d) of the proposal of the Delegation of the United States of America by the term "application" would not result in an overlapping with other provisions of the Treaty.

1410. Mr. KIRK (United States of America) stated that, as concerned the last sentence of his Delegation's proposal, he had in mind the case of an applicant who learned from examinations that had taken place in foreign countries that prior art might invalidate his claim. That applicant should be entitled to draw the attention of the Office to that prior art and to request a decision from the Office on the matter. If the Office concluded that the claim was not patentable, his Delegation believed that the owner of the patent should have the opportunity to amend the claims and to put forward his arguments and comments.

1411. Mr. UEMURA (Japan) stated that indeed, as was stated by the Director General, it might be possible that the second sentence of the proposal of the Delegation of the United States of America, as amended by the suggestion of his Delegation, could be redundant. He added that additional reflection would be necessary.

1412. Mr. BOGSCH (Director General of WIPO) requested further clarification from the Delegation of Japan as to whether the second sentence of paragraph (b), as proposed by the Delegation of the United States of America and amended by the suggestion of the Delegation of Japan, would really correspond to an Article on administrative revocation. If the request concerned changes in the description, for instance, he wondered whether such a request could be assimilated to a request for revocation of a patent.

1413. The CHAIRMAN stated that the revocation of a patent presupposed a change in the claims. He suggested that the second sentence of the proposal of the Delegation of the United States of America, as amended by the suggestion by the Delegation of Japan, be modified so as to read that the

owner of the patent should have at least one opportunity to amend "at least the claims." With that formula, he felt that it would be possible to meet the concern of the Delegation of Japan and to address the question raised by the Director General.

1414. Mr. KIRK (United States of America) expressed the willingness of his Delegation to negotiate a language that could meet the concern of the Director General.

1415. Mr. UEMURA (Japan) stated that, in most cases, the amendment referred to in the second sentence of the proposal by the Delegation of the United States of America would concern the claims. However, he could envisage cases where such amendment could concern the description. He mentioned, as an example, cases where the terms used in the claims were defined in the description.

1416.1 Mr. SUGDEN (United Kingdom) stated that his Delegation could support the proposal of the United States of America. In his view that provision should be limited to the request for revocation. It should be left to national legislation as to whether the Office could receive requests for advisory opinions.

1416.2 As for the first sentence of proposal of the United States of America, he underlined that the requesting party had the opportunity and not the obligation to present arguments. Regarding the second sentence, concerning the opportunity to amend, his Delegation agreed with the Director General that the opportunity was already provided for in Article 17. However, his Delegation did not have any objection in having that provision in Article 18. He suggested that, in order to avoid any possible conflict, that sentence could be supplemented by prescribing that the amendment should be in accordance with Article 17. As concerned the third and final sentence, he emphasized that the owner of the patent had the opportunity and not the obligation to present its comments.

1417. Mr. TALUKDAR (Bangladesh) stated that the proposal by the Delegation of the United States of America concerning subparagraph (1)(d) was in order. He was of the view that the last sentence might distort the balance established in the two first sentences of that subparagraph.

1418. Mr. BAKER (Australia) stated the preference of his Delegation for Article 18(1)(d) as proposed by the Delegation of the United States of America. He was of the view that the second sentence should be supplemented as suggested by the Delegation of the United Kingdom.

1419. Mr. BEIER (FICPI and FCPA) stated the preference of his Delegations for a more flexible time limit than that indicated in paragraph (1)(b) of Article 18. He referred to the time limit of three months applicable in a number of countries. He suggested establishing two kinds of time limits. A three months time limit to give notice of an opposition and a six months time limit to give reasons for such an opposition. He underlined the practical importance of having early knowledge, whether a patent is opposed, for instance, for licensing purposes.

1420. Mr. SCHAEFERS (Germany) stated that the intention behind paragraphs (1)(d) and (e) of Article 18 of the basic proposal was to provide

for a minimum of procedural safeguards to the parties so as to leave each Contracting Party the necessary freedom to decide which additional procedural safeguards should be adopted in the national legislation.

1421. Mr. GARIEPY (Canada) stated that his Delegation could support the proposal by the Delegation of the United States of America concerning new subparagraph (1)(d). In his view the proposal contained the necessary elements to protect the interests of third parties, as well as of the owner of patent. He also expressed the sympathy of his Delegation for the suggestion to delete the word "claims" in the second sentence and to replace it by the term "applications."

1422. Mr. COHN (Israel) expressed the support of his Delegation for the proposal by the Delegation of the United States of America. As far as subparagraph (1)(b) was concerned, he stated that he was opposed to fixing a time limit within which the request for revocation had to be filed.

1423. Mr. BOGSCH (Director General of WIPO) recalled the understanding reached at the Committee of Experts according to which the streamlined and inexpensive procedure envisaged in Article 18 would be open to third parties for a limited period of time only, whereas the owner of the patent would always be free to restrict the scope of his patent under Article 17.

1424. Mr. MOTA MAIA (Portugal) announced the meeting of Group B.

1425. The CHAIRMAN announced a meeting of the Steering Committee and adjourned the meeting.

Sixteenth Meeting
Tuesday, June 18, 1991
Afternoon

Article 18: Administrative Revocation (continued from paragraph 1425)

1426. The CHAIRMAN opened the meeting and invited delegations to resume discussions on Article 18 (Administrative Revocation). He first gave the floor to the Secretariat for a short communication.

1427. Mr. CURCHOD (WIPO) announced that the Secretariat wished to suggest a purely formal amendment in paragraph (1)(a). In the last line but one of the French text, following the words "activité inventive," the words "non-évidence" had to be added between brackets. In English, the term "non-obviousness" had to be added between brackets after the words "inventive step" in the last line of paragraph (1)(a). That would align the terminology of the Article with the remainder of the Treaty, particularly with Article 11.

1428.1 The CHAIRMAN noted that it was a simple matter of terminology and that there were no objections.

1428.2 Before pursuing discussion on Article 18, he reviewed the provisional conclusions of the previous day's debates.

1428.3 He pointed out that a proposal had been made by the United States of America in document PLT/DC/59, paragraph 1, with respect to paragraph 1(b). It had been agreed to discuss that matter in the Committee together with Article 2 and Rule 1 concerning the definition of the concept of publication.

1428.4 He observed that an oral proposal had been made calling into question the six-month time limit laid down at the end of paragraph 1(b) either by drafting it differently or even deleting it completely. He explained that the oral proposal would be noted in the minutes of the Conference, but pointed out that priority was given to written proposals.

1428.5 He also pointed out, to avoid any misunderstanding, that Article 18 concerned a procedure for administrative revocation by the patent office and in no way prejudged procedure before other authorities, particularly the judicial authorities, that would depend exclusively on domestic law.

1428.6 He further observed that the Committee had discussed paragraph 1(d) and 1(e) on the basis of a proposal by the United States of America contained in document PLT/DC/59. The aim of that proposal was to replace the two subparagraphs (d) and (e) by the text given in that document the aim of which was to provide a possibility for the person requesting revocation to present his arguments and also to give the owner of the patent an assurance that he would be able to make amendments and have a right to respond to the arguments put forward against him. The text also required that the decision of the office be based solely on grounds on which the patentee had been heard.

1428.7 He observed that those conclusions were obviously altogether provisional and noted that all the delegations that had spoken on that matter, with one exception, had supported the proposal, whilst making various observations on the drafting that would have to be entrusted to the Secretariat in order to cover certain points made during interventions.

1429. Mr. PARK (Republic of Korea) stated that his Delegation supported the proposal of the Delegation of the United States of America, contained in document PLT/DC/59, in relation to paragraph 1(d) and (e), since the procedure envisaged therein would be more efficient.

1430.1 Mr. CLARK (ABA) stated that his Organization supported the proposal of the Delegation of the United States of America.

1430.2 He expressed concern at the proposal of the Delegation of Japan to change the word "claims" to "application" in line four of new paragraph 1(d) proposed by the Delegation of the United States of America, contained in document PLT/DC/59. He had a similar concern in relation to the proposal of the Delegation of the United Kingdom to substitute the word "patent" for the word "claims," as well as for the proposal of the Delegation of Canada to substitute the words "description and claims" for the word "claims." He considered that each of those proposals invited the possibility of new matter being introduced to the patent through the back door. That possible danger was, in his view, compounded by the fact that the words "revocation," "opposition" and "re-examination" seemed to have been used by delegations interchangeably.

1430.3 He also wished to suggest that in line one of new paragraph (1)(d), as proposed by the Delegation of the United States of America, the words "in whole or in part" should be added, since those words appeared in subparagraph (e) of the basic proposal, which was to be deleted if the proposal of the Delegation of the United States of America were adopted.

1430.4 He also drew attention to the fact that the text of the basic proposal referred to "grounds" in relation to the opportunity to present arguments in subparagraphs (d) and (e), whereas the words "grounds or evidence" were used in subparagraph (d) of the proposal of the Delegation of the United States of America. He suggested that the drafting of the provisions of paragraph (1) of Article 18 might require further examination to ensure uniformity.

1431. Mr. YOSHIDA (JPA) expressed the support of his Organization, as an Organization representing users, for the text of the basic proposal and for the observations made by the Delegation of Germany. His Organization considered that, whenever a patent owner amended claims, there should be at least one opportunity given to object to any such amendment.

1432.1 Mr. SANTARELLI (AIPPI) said that his organization was happy neither with the basic proposal nor with the proposal by the Delegation of the United States of America contained in document PLT/DC/59. He referred to a resolution adopted at the meeting of the Executive Committee of his organization in Barcelona in 1990, with the aim of giving both the patentee and the petitioner the possibility of submitting their arguments throughout the whole duration of the revocation procedure. If his organization had to make a choice between the basic proposal and the proposal by the United States of America, its choice would fall on the latter.

1432.2 As for the time limit laid down for presenting the request for revocation, his organization considered that a time limit of at least six months would be necessary to give the owner an assurance that his patent enjoyed legal security. His organization also preferred that there should be an upper limit of nine months in view of the fact that the time limit did not affect the possibility of a third party appeal to the courts.

1433. Ms. LINCK (AIPLA) stated that her Organization had recently expressed itself in favor of increased participation on the part of third parties in the re-examination procedure in the United States Patent and Trademark Office. She suggested that the proposal of the Delegation of the United States of America in respect of paragraph (1)(d) might be modified in its last sentence in order to permit both the requester and the patent owner to have an opportunity to present comments before any final decision was made.

1434.1 The CHAIRMAN confirmed his provisional conclusion that the Committee would take as a basis for its future debates the proposal made by the Delegation of the United States of America in document PLT/DC/59 as far as substance was concerned. The task of reviewing the wording of the proposal, taking into account the comments made during the debates, was entrusted to the Secretariat.

1434.2 He confirmed that paragraph (1) of Article 18 dealt with minimum rights and in no way prevented the establishment or maintenance by any Contracting Party of a system of administrative revocation affording more extensive rights.

1434.3 He confirmed that there was an understanding that the revocation dealt with by paragraph (1) of Article 18 could be either partial or full revocation and that the procedure could lead, if revocation was refused, to confirmation of the patent.

1434.4 He added that use could perhaps be made, in the second sentence of paragraph (1)(d), as proposed in document PLT/DC/59, of the phrase "to amend at least the claims" since there could be cases in which amendment of the claims would lead to amendment of other parts of the patent.

1434.5 He pointed out that the period to be laid down for presentation of the request for revocation began on announcement in the official gazette of the grant of the patent and that such announcement was covered by Rule 10 of the draft Regulations. He asked whether there were any observations on that Rule.

Rule 10: Announcement in the Gazette of the Grant of a Patent
(ad Article 18(1)(b))

1435. Mr. KIRK (United States of America) stated that his Delegation wished to make an oral proposal which it would like reflected in the records of the Conference. His Delegation proposed that the word "grant" in line one of Rule 10 should be replaced by the word "publication." In addition, his Delegation wished the list of data that was to be published to be extended so as to include (i) the date of publication of the patent, (ii) a claim, (iii) a drawing, and (iv) the name(s) of the inventor(s).

1436.1 The CHAIRMAN confirmed that the Conference would note the oral proposal made by the Delegation of the United States of America in the minutes.

1436.2 He moved to examination of paragraph (2) of Article 18.

Article 18(2): [Prohibition of the Pre-Grant Opposition]

1437.1 Mr. UEMURA (Japan) stated that his Delegation wished a statement to be recorded in relation to paragraph (2) of Article 18, which prohibited the maintenance of systems of pre-grant opposition.

1437.2 In the case of an administrative system of pre-grant opposition like the one that existed in Japan, where the rights attaching to the examined patent application were almost equivalent to the rights conferred by a patent, his Delegation saw no reason why a change should be required to a system of post-grant revocation.

1437.3 His Delegation was aware of the argument that pre-grant opposition could cause delays in the grant of a patent. It saw a similarity between the proposal to require a change from pre-grant opposition and the proposal to require a change from the first-to-invent system. The pre-grant opposition system could be regarded as ideal, since it assisted in ensuring that strong patents were granted. However, in reality, its practice could be accompanied by disadvantageous side-effects.

1437.4 His Delegation would give further consideration to its position if it were the general view of the Conference that the abolition of pre-grant opposition was an essential part of a grand package that included the

mandatory adoption of the first-to-file system, an appropriate term and early publication.

1438. Ms. KRUDO SANES (Uruguay) stated that, in her country, a system of pre-grant opposition existed. By virtue of the existing documentation in the Registry, as well as the required examination to consider absolute novelty, that system of pre-grant opposition ensured that better patents were granted. She reserved the position of her Delegation on paragraph (2) of Article 18.

1439. Mr. PARK (Republic of Korea) expressed the agreement of his Delegation with the observations that had been made by the Delegation of Japan, stating that an opportunity to maintain pre-grant opposition should be allowed in the interests of third parties.

1440.1 Mr. KIRK (United States of America) stated that he had listened with great interest to the statement of the Delegation of Japan and looked forward to the further consideration by that Delegation of the question under discussion.

1440.2 He stated that his Delegation did not believe that a transitional period should be allowed in respect of a change from pre-grant opposition to post-grant revocation. His Delegation considered that the delays in the grants of patents occasioned by pre-grant oppositions were to be avoided as soon as possible.

1441. Mr. SMITH (Australia) associated his Delegation completely with the statement that had been made by the Delegation of Japan concerning paragraph (2).

1442. Mr. HIDALGO LLAMAS (Spain) associated his Delegation with the statement that had been made by the Delegation of Japan, pointing out that his country would have in the future a system of pre-grant opposition, which was at present in force for utility models, industrial designs and trademarks.

1443.1 Mr. SUGDEN (United Kingdom) stated that his Delegation supported the text of paragraph (2)(a) in the basic proposal. It also regarded the abolition of pre-grant opposition as an essential part of the Treaty and of the grand package. He noted that his Delegation was also still hopeful that such a package could be achieved. His Delegation opposed pre-grant opposition in particular because of the extended period for which opposition proceedings could last.

1443.2 His Delegation also expressed sympathy for the view expressed by the Delegation of the United States of America concerning the transitional provision foreseen in paragraph (2)(b) of the basic proposal. It was against a long transition but would consider what term of transition might be appropriate in the context of the grand package.

1444. Mr. NEUKOM (CIPA) stated that his Organization hoped that the prohibition of pre-grant opposition foreseen in paragraph (2) of the basic proposal would not preclude the continuation of the practice of accepting observations from third parties before the grant of a patent. He drew attention in this regard to Article 115 of the European Patent Convention. He suggested that an explanatory note might make it clear that such a practice could be continued.

1445. The CHAIRMAN pointed out that the Committee of Experts, at its meetings, had agreed on the interpretation given by the representative of CIPA.

1446. Mr. KORCHAGUIN (Soviet Union) expressed the support of his Delegation for the abolition of pre-grant opposition as envisaged in paragraph (2)(a) of the basic proposal.

1447. Mr. DIVOY (France) said that her Delegation was very keen to see paragraph (2)(a) appear in the Treaty. As for the period of adaptation to a system of administrative revocation after grant of a patent, her Delegation was willing to accept the period laid down in paragraph (2)(b).

1448. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the text of paragraph (2)(a) in the basic proposal.

1449. Mr. LOSSIUS (Norway) stated that his Delegation agreed to the observations that had been made by the Delegation of the United Kingdom and that, in particular, the elimination of pre-grant opposition was to be considered as an essential part of the grand package.

1450. Mr. COHN (Israel) stated that his country presently had a system of pre-grant opposition, which it was prepared to change. However, he considered that a transitional period for change from pre-grant opposition to post-grant revocation was necessary in order to enable, amongst other things, existing proceedings to be terminated.

1451. Mr. VON ARNOLD (Sweden) indicated that his country presently maintained a system of pre-grant opposition but that it was, in the interest of achieving harmonization, ready to accept paragraph (2) of the basic proposal. He emphasized the need for a transitional period in which to adapt.

1452. Mr. QIAO (China) stated that, although his country presently had a system of pre-grant opposition, it was prepared to accept paragraph (2) of the basic proposal and to introduce a change to post-grant revocation.

1453. Mr. GARIEPY (Canada) stated that his Delegation supported the text of paragraph (2) of the basic proposal.

1454. Mr. THOFT (Denmark) expressed the support of his Delegation for the text of paragraph (2) in the basic proposal.

1455. Mr. CLARK (ABA) expressed the support of his Organization for the statement that had been made by the Delegation of the United States of America.

1456. Mr. BETON (UNICE) stated that his Organization was opposed to the maintenance of pre-grant opposition and supported the text of the basic proposal for paragraph (2). He also expressed concern that a right of appeal against the revocation of a patent pursuant to proceedings under paragraph (1) did not seem to be guaranteed and suggested that such a guarantee be included.

1457. Mrs. DE CUYPERE (Belgium) supported the text of paragraph (2) as worded in the basic proposal.

1458. Mr. MELLER (NYPTC) supported the abolition of pre-grant opposition as foreseen in paragraph (2) of the basic proposal. He noted that the trend

internationally was, in any case, towards post-grant revocation. He expressed concern over the length of time permitted for the transition from pre-grant opposition, indicating that he considered that no more than five years should be allowed for that purpose.

1459. Mr. PAAERMAA (Finland) stated that his country presently maintained a system of pre-grant opposition, but that, in the interests of harmonization, it was prepared to change to post-grant revocation.

1460. Ms. LINCK (AIPLA) stated that her Organization had passed a resolution that it was willing to support a change to the first-to-file system in exchange for six concessions, one of which was the prohibition of pre-grant opposition. Her Organization supported the statement that had been made by the Delegation of the United States of America, in particular in relation to the concern expressed over the proposed period of 10 years allowed for the phasing out of pre-grant opposition.

1461. Mr. SANTARELLI (AIPPI) said that his organization supported the text of paragraph (2) given in the basic proposal.

1462.1 Mr. MESSERLI (Switzerland) said that his Delegation was able to accept the text of paragraph (2) given in the basic proposal as part of a package of concessions.

1462.2 He said that his Delegation was most favorable to the idea put forward by the representative of UNICE concerning the possibility of providing a right of appeal to the courts pursuant to an administrative decision on a request for revocation.

1463. Mr. MOTA MAIA (Portugal) explained that his country still had a pre-grant opposition system, but that, in the interest of harmonization, the new draft law foresaw the change to a system of administrative revocation following grant of the patent. He supported the text as given in the basic proposal.

1464. Mr. BULGAR (Romania) supported the text of the basic proposal.

1465. Mr. BEIER (FICPI and FCPA) expressed the support of his Organizations for the text of paragraph (2) in the basic proposal. His Organizations also favored the introduction of a right of appeal in respect of revocation under paragraph (1), as suggested by the Delegation of Switzerland and the Representative of UNICE.

1466. Mr. TAKADA (JPA) stated that his Organization considered that pre-grant opposition had worked very well and had contributed to a high validity of patents granted, as well as to a decrease in the number of unnecessary disputes over patents. His Organization saw no reason to abolish the system but, in the context of a total package, could consider lending its support to a change to post-grant revocation.

1467. Mr. SCHAEFERS (Germany) expressed the agreement of his Delegation with the suggestion that had been made by the Delegation of Switzerland to ensure that a right to appeal should exist following the revocation of the patent. He considered that it would be useful to include such a guarantee in the text.

1468. Ms. LEVIS (ALIFAR) expressed the support of her Organization for the text of the basic proposal.

1469. Mr. BOGSCH (Director General of WIPO) wondered how necessary or desirable it was to include a provision concerning appeal in the text of the Treaty. He observed that, in the more frequent case of the denial of the grant of a patent, the draft Treaty made no provision for a right of appeal, so that the inclusion of a right of appeal with respect to the revocation of a patent in administrative proceedings might create an imbalance.

1470. Mr. KIRK (United States of America) stated that the express mention of the right of appeal by the patent holder in the event of the revocation of the patent, in whole or in part, following administrative revocation proceedings was desirable. In relation to the statement made by the Director General, he considered that it would be a useful addition to the text of the draft Treaty to include a right of appeal in respect of the denial of a patent.

1471. Mr. UEMURA (Japan) stated that his Delegation agreed with the statement that had been made by the Director General that there was no need to refer in Article 18 to a right of appeal. In relation to the question that had been raised by an observer organization as to the link between the first-to-file question and the abolition of pre-grant opposition, he pointed out that both involved a fundamental change in philosophy so that an analogy seemed to exist between the two issues. Furthermore, both constituted important elements of the grand package.

1472.1 The CHAIRMAN stated that the Committee had taken note of the reservations expressed by five delegations with regard to the wording of paragraph (2) in the basic proposal.

1472.2 He observed that a large number of delegations had supported the basic proposal, including delegations that were prepared to amend their domestic law where it contained pre-grant opposition. Consequently, the text of the basic proposal would constitute the basis for future discussions.

1472.3 He observed that the Committee was aware of the importance of that paragraph (2) as part of the "package" that was to be negotiated.

1472.4 He noted that several delegations had made remarks on the transitional period included in paragraph (2)(b) of the basic proposal, but he saw no reason to amend the basic proposal in that respect, although he pointed out that delegations could submit written amendments prior to the second part of the Conference.

1472.5 He moved to Article 20 (Prior User).

Article 20: Prior User

1472.6 The Chairman noted that there were two proposals for amendment, one from the Delegation of Switzerland, contained in document PLT/DC/9, and the other from the Delegation of the United States of America, contained in document PLT/DC/60. Before taking up the proposals, however, the Chairman invited delegations wishing to do so to make general statements in respect of Article 20.

1473. Mr. RAVN (Denmark), speaking on behalf of the Delegations of Belgium, Denmark, Finland, France, Norway and Sweden, stated that Article 20 had to be seen in connection with certain other Articles, namely, Article 9, which established the first-to-file principle, and Article 12, which established the grace period. While the delegations for which he spoke were not in favor of the grace period, if the first-to-file system became part of the Treaty, as a mandatory provision, they could accept the inclusion of the grace period in the Treaty. It was important to ensure that the grace period would not have the effect of a quasi-priority right. It had to be ensured that the first-to-file system did not degenerate into a first-to-publish system. As part of a parcel containing the elements of first to file and the grace period, he expressed the view that there was also a need for an Article relating to prior users' rights.

1474. Mr. SMITH (Australia) stated that his Delegation also believed that there was a relationship between prior users' rights and the first-to-file system which required ensuring some protection for inventors who commenced use without filing for a patent before another independent inventor filed for a patent. Similarly, his Delegation believed that a relationship existed between prior users' rights and the grace period. In his view, a grace period could only constitute an exception or a defense against the possibility of certain limited disclosures which destroyed the novelty of an invention and should not accord any substantive rights. It was in that context that his Delegation believed there should be a mandatory provision in the Treaty dealing with prior users' rights. A mandatory prior users' right in all Contracting Parties should serve to encourage inventors to file applications promptly, without relying too heavily on a grace period. While any disclosure prior to filing should not prevent the grant of a patent by virtue of the grace period, that disclosure could be used by a prior user. Such a possibility would ensure that applicants filed promptly and only relied on the grace period when it was essential to do so.

1475.1 The CHAIRMAN observed that Article 20 contained two alternatives: Alternative A, which would make Article 20 optional for Contracting Parties and upon which the proposal of the Delegation of the United States of America, contained in document PLT/DC/60, was based, and Alternative B, which would make Article 20 mandatory for all Contracting Parties and upon which the proposal of the Delegation of Switzerland, contained in document PLT/DC/9, was based.

1475.2 He invited the Delegation of Switzerland to introduce its proposal contained in document PLT/DC/9.

1476.1 Mr. MESSERLI (Switzerland) stated that his Delegation considered that in the context of a first-to-file system, it was a matter of justice that an inventor that made and used an invention should not be forced to give up the practice of the invention if another inventor happened to be the first to file a patent application. For that reason, the provision on prior users' rights should be mandatory as envisaged in Alternative B.

1476.2 The proposal included the addition of a sentence to clarify the relationship between the prior users' rights and the grace period provisions of Article 12. It was the view of his Delegation that the fact that prior use was based on information disclosed within the meaning of Article 12 should not prejudice the good faith of the prior user. The question of good faith should

be decided by the courts on the basis of other items. He considered that the proposal of his Delegation corresponded to the true nature of the grace period, which was not a quasi-priority right, but rather a safety net for inventors seeking patentability.

1477. The CHAIRMAN then invited the Delegation of the United States of America to introduce its proposal contained in document PLT/DC/60.

1478.1 Mr. KIRK (United States of America) observed that the Delegation of Switzerland had stated that, if someone had used an invention prior to the filing date of an application directed to the same invention made by another inventor, that individual should have the right to continue the use of the invention. Further, in the view of the Delegation of Switzerland, that right should be mandatory. He stated that his Delegation had no difficulty if Contracting Parties chose to adopt the right of prior user, but saw no need to make it mandatory on all Contracting Parties. Moreover, an optional character was appropriate since the provision was limited to use where the patent produced its effect: the home country of the inventor. He stated, therefore, that his Delegation supported Alternative A.

1478.2 His Delegation did not believe that a prior user's right should be able to be based on a disclosure made during the grace period. It should only arise in consequence of a prior independent invention by another. He gave as an example of what he considered should be contemplated within any prior user right an original inventor that went to a company to sell his invention. If the company acquired rights to the invention from the inventor and began preparations for the use of the invention without filing for patent protection, it should be able to acquire a prior user right.

1479. The CHAIRMAN recalled that Alternatives A and B were part of the basic proposal and, therefore, were under discussion, whereas the proposals by the Delegations of the United States of America and Switzerland were proposals for amendment each of which needed the support of another member Delegation before they could be discussed.

1480. Mr. SCHAEFERS (Germany) seconded the proposal of the Delegation of Switzerland.

1481. Mr. GARIEPY (Canada) expressed the support of his Delegation to the proposal by the Delegation by the United States of America because it was his Delegation's belief that prior users' rights should be extended only to the inventor and not to a user that learned about an invention through a disclosure of the invention during the grace period.

1482. Mr. KAMEL (Egypt) expressed the full support of his Delegation to Alternative A of Article 20 as envisaged in the basic proposal. He added that that provision was consistent with the national law of his country.

1483.1 Mr. NEERVOORT (Netherlands) expressed the support of his Delegation for Alternative B of the basic proposal as amended by the proposal by the Delegation of Switzerland. He recalled that it might be true that prior users' rights were based upon acts performed in the inventor's home country. However, those acts might also consist of importation--by a prior user--so that the inventor would need protection through a prior user's right in the country of importation as well.

1483.2 As concerned the additional sentence suggested by the Delegation of Switzerland, he stated that it was a necessary one because the prior right was only an exception against the argument that there was a lack of novelty.

1484. Mr. MOTA MAIA (Portugal) expressed the support of his Delegation for the additional sentence proposed by the Delegation of Switzerland at the end of paragraph (1). However, his Delegation was of the view that the right of prior use should be optional for each Contracting Party. Consequently, his Delegation supported Alternative A with the addition suggested by the Delegation of Switzerland.

1485. Mr. LOSSIUS (Norway) expressed the support of his Delegation to Alternative B, as amended by the proposal by the Delegation of Switzerland.

1486. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for Alternative B, as amended by the proposal of the Delegation of Switzerland. His Delegation attached great importance to the link between Article 20 and the Articles concerning the first-to-file principle and the grace period. He added that the discussion on Article 20 had shown that not all the Delegations had the same understanding as to the meaning of the grace period. The Delegation of the United States of America had referred to "the protected disclosure" and that was precisely what his Delegation did not envisage as a result of the grace period. For his Delegation, the grace period was an exception that could be used by the applicant whenever the novelty of his invention was being challenged because of a disclosure by the inventor himself.

1487. Mr. COHEN (Israel) expressed the support of his Delegation for Alternative B as envisaged in the basic proposal. He added that a mandatory provision was necessary in order to ensure harmonization in the field. He was not in a position to support the proposal by the Delegation of Switzerland, since it would introduce controversial issues that were not strictly necessary.

1488. Mr. GUERRINI (France) said that his Delegation supported alternative B and the proposal by the Delegation of Switzerland for the reasons that had been abundantly presented and which essentially took into account the concept of grace period, which ought to be more precisely presented as a period of immunity with respect to prior disclosure. His Delegation also supported the sentence added by the Swiss Delegation, but wished to point to an ambiguity: if the prior use based on disclosed information did not prejudice good faith, that could mean that good faith was not presumed. He felt it preferable to word the sentence as follows: "the fact that prior use is based on information disclosed within the meaning of Article 12 shall not in itself exclude good faith."

1489. Mr. DIENG (Senegal) expressed the support of his Delegation for Alternative B.

1490. Mr. GOMEZ MONTERO (Spain) expressed the support of his Delegation for the proposal of the Delegation of Switzerland because it was balanced and fully consistent with the notion of his country concerning the grace period. He also expressed the support of his Delegation for the drafting suggestion of the Delegation of France.

1491. Mr. SMITH (Australia) expressed the support of his Delegation for the proposal by the Delegation of Switzerland for the reasons given by the Delegation of the United Kingdom.

1492. Mr. O'FARRELL (Ireland) expressed the support of his Delegation for the proposal of the Delegation of Switzerland.

1493.1 Mr. UEMURA (Japan) stated that his Delegation considered that the prior users' rights were important and useful since they were necessary to strike a balance between the interests of the first inventor and the first-to-file principle. Consequently, his Delegation considered that the subject matter of Article 20 was appropriate for harmonization on a worldwide basis and his Delegation supported Alternative B of the basic proposal.

1493.2 His Delegation had certain hesitations as regards the expression "notwithstanding Article 19" at the beginning of paragraph (1) of Article 20. It was the understanding of his Delegation that, at the last session of the Committee of Experts, there had been general agreement that the explanatory notes should specify that Article 20 was not the only provision in the Treaty permitting a derogation from Article 19. He reserved the right of his Delegation to revert to this matter after the text of Article 19 had been considered by Main Committee II.

1493.3 His Delegation did not support the proposal by the Delegation of Switzerland. He recalled that his Delegation had submitted a proposal to the Committee of Experts that was subsequently withdrawn because it was thought that it could open the way for abuse. The proposal by the Delegation of Switzerland raised the same kind of concern, since it was feared that it could be abused by third parties that used the information provided by the inventor. It was the view of his Delegation that it was important to promote the early disclosure of inventions and, if prior users' rights were too broad, inventors would not make early disclosures under the protection of the grace period because of fear that the disclosed information could be used and such a use might, in its own turn, be protected by the prior users' rights.

1493.4 As far as the proposal by the Delegation of the United States of America was concerned, he stated that his Delegation saw great merit in it but did not understand why it was not mandatory but optional. His Delegation saw no reason why a third party would be entitled to a prior users' right only if that third party was himself the inventor. With reference to the proposal by the Delegation of Switzerland, he stated that his Delegation did not support a definition of the term "good faith" in the text of Article 20. He was satisfied with the explanatory notes contained in paragraph 20.01 of document PLT/DC/4.

1494. Mr. BOGSCE (Director General of WIPO) recalled that, in the last session of the Committee of Experts, an agreement had been reached to the effect that the explanatory notes should state that the definition of good faith was left to the applicable national or regional law. He noted that that had been done in Note 20.01 in document PLT/DC/4.

1495. The CHAIRMAN stated that, in his view, it would be appropriate to reexamine the link between Articles 20 and 19 after Article 19 had been discussed.

[Suspension]

1496. Mr. THOFT (Denmark) stated that his Delegation supported Alternative B as amended by the Delegation of Switzerland, in particular because it was mandatory. In view of the intervention by the Delegation of the United Kingdom, he would not insist on a more strict provision.

1497. Mr. KORCHAGUIN (Soviet Union) expressed the support of his Delegation to Alternative B of the basic proposal since it provided for a mandatory approach. He also expressed the support of his Delegation for the proposal by the Delegation of Switzerland.

1498. Mrs. NUORLAHTI-SOLARMO (Finland) expressed the support of her Delegation for Alternative B, since it was mandatory. She also expressed support for the proposal by the Delegation of Switzerland for the reasons given by the Delegation of the United Kingdom.

1499. Mr. TIGBO (Cameroon) stated that his Delegation supported Alternative B of the basic proposal, as amended by the proposal of the Delegation of Switzerland and subject to the drafting amendment suggested by the Delegation of France

1500. Mr. GALASSO (Italy) expressed the support of his Delegation to Alternative B of the basic proposal, as supplemented by the proposal by the Delegation of Switzerland.

1501. Mr. VON ARNOLD (Sweden) stated that his Delegation was of the view that the only effect of the grace period was that a disclosure by the inventor would not be detrimental to the novelty of the invention. For that reason, his Delegation supported Alternative B of the basic proposal as supplemented by the proposal by the Delegation of Switzerland.

1502. Mr. WARR (Malta) expressed the support of his Delegation for the proposal by the Delegation of Switzerland.

1503. Mr. SEGURA (Argentina) expressed the support of his Delegation for Alternative B of the basic proposal and for the proposal of the Delegation of Switzerland.

1504. Mr. SCHATZ (EPO) stated that good reasons had been given by the delegations that had taken the floor before him in support of the proposal by the Delegation of Switzerland. He mentioned that three basic principles of a patent law were relevant in connection with Article 20. The first principle was that everything which has been disclosed and belonged to the public domain could be freely used. The second principle was legal certainty, particularly for third parties and the third principle concerned the first-to-file system itself. In his view, the proposal by the Delegation of the United States of America would negatively affect each and all of those fundamental principles.

1505. Mr. MELLER (NYPTC) stated that many members of his Organization favored a provision on prior users' rights, but his Organization opposed a mandatory provision on the matter. He saw no good reason, and no good reason had been provided in the course of the discussions, to make that provision mandatory and emphasized that it was not necessary to harmonize national laws governing the prior users' rights since there was no international concern on the matter.

1506. Mr. QIAO (China) expressed the support of his Delegation for Alternative B as envisaged in the basic proposal.

1507. Ms. LINCK (AIPLA) stated that the grace period should not be diluted by prior users' rights since such a dilution would make meaningless the grace period that was necessary in order to persuade the United States of America to give up the first-to-invent principle.

1508. Mr. HATOUM (Lebanon) stated that his Delegation supported a non-mandatory provision on prior users' rights. For that reason he supported Alternative A of the basic proposal.

1509. Mr. COEN (Israel) stated that one further reason not to support the proposal by the Delegation of Switzerland was that it implied the reversal of the burden of proof in connection with good faith and that was, in the view of his Delegation, unfair.

1510.1 Mr. CLARK (ABA) stated that his Organization was opposed to the notion of prior users' rights and for that reason it supported the proposal by the Delegation of the United States of America.

1510.2 In response to the statement by the Representative of AIPLA, he confirmed the opposition of his Organization to a first-to-file principle.

1511. Mr. BULGAR (Romania) expressed the support of his Delegation for Alternative A of the basic proposal, for the reasons already given by previous speakers.

1512. Mr. MITCHELL (PTIC) stated that his Organization favored prior users' rights. However, in order to accommodate the concerns of the Delegation of the United States of America, it supported Alternative A which provided for an option for Contracting Parties. He recalled that most of the effects of the prior users' rights would take place in the national context. His Organization was against the proposal of the Delegation of Switzerland, because disclosure during the grace period should not give rise to prior users' rights.

1513. Mr. BEIER (FICPI) said that his Organization favored Alternative B but could also accept Alternative A.

1514. Mr. UEMURA (Japan) sought clarification from the Delegation of the United States of America as to whether its proposal envisaged that only the inventor and not third parties, that learned in good faith about the invention could benefit from the prior users' rights. He referred to the statements by the Delegations of Sweden and the EPO where it was mentioned that in principle any mention of technology that had been disclosed was freely available to the public. His Delegation did not agree with such a statement. He mentioned the case of an invention which was disclosed by the inventor after the filing of the application but prior to the publication thereof, which was clearly protected and would not give rise to prior users' rights.

1515. Mr. KIRK (United States of America), in response to the statement by the Delegation of Japan, stated that the proposal of his Delegation was intended to ensure that a disclosure made during the grace period did not give rise to prior users' rights.

1516. Mr. SUGDEN (United Kingdom) emphasized that prior users' rights were essential for the first-to-file system and involved consideration of justice and fairness. As far as the grace period was concerned, he expressed the concern of his Delegation with the time limit. In his view, one year was excessive. He said that it should be significantly reduced, for instance, to a period of three months. He noted that a very long time limit for the grace period would be detrimental to legal security.

1517. Mr. UEMURA (Japan) stated that, after reflection, and particularly in view of the clarifications provided by the Delegation of the United States of America, his Delegation was prepared to support the proposal of that Delegation, thus reviewing its earlier position.

1518. Mr. SCHATZ (EPO) stated that the statement by the United Kingdom could be considered as his reply to the comments of the Delegation of Japan.

1519.1 Mr. SCHAEFERS (Germany) stated that his country had experience with the three elements that had been mentioned during the discussion of Article 20, namely the first-to-file principle, the grace period and prior users' rights. He mentioned that, at a given point in time, the national legislation of his country provided for the three elements. At that time, it was felt that the prior users' rights were a necessary counter-balance to the grace period. The grace period had been significantly reduced as a consequence of the setting up of the European patent system. He added that it had not been possible to agree on further harmonization on the prior users' rights in the negotiations leading to the Community Patent Convention. For that reason, he expressed the satisfaction of his Delegation to have a new opportunity to advance the harmonization of that subject matter.

1519.2 As concerned the argument that prior users' rights were essentially concerned with the nationals of the countries involved, he mentioned that his Delegation was not persuaded by that argument. He mentioned that the national legislation of his country extended prior users' rights to both nationals as well as foreigners. The existence of discrepancies among national legislations was an argument in favor of further harmonization in the matter.

1519.3 He recalled that, in the notes prepared by the International Bureau for the eighth session of the Committee of Experts, it was stated that, if the disclosure was the result of a breach of confidence or an infringement of the rights of the patent owner, it would be understood that such disclosure would not be covered by the requirement of good faith.

1519.4 He reiterated that his Delegation supported the proposal by the Delegation of Switzerland since it was necessary in his view to provide a clarification in the text of Article 20 as to the meaning of the notion of good faith. As far as the burden of proof was concerned, his Delegation was of the view that it fell on the party alleging bad faith.

1519.5 As far as the proposal by the Delegation of United States of America was concerned, he stated that it appeared as a flexible one because it gave Contracting Parties an option. However, he drew attention to the fact that, by changing the words "the invention" for "his invention" it would impose on the Contracting Parties a first-to-publish system. He added that it was not clear to his Delegation why the proposal by the Delegation of the United States of America required the establishment of good faith on the side of the

prior user in spite of the fact that the prior use be made by and only by the independent second inventor.

1520.1 Mr. SANTARELLI (AIPPI and CNCBI) speaking as the Representative of AIPPI, stated that the preference of that Organization was for the mandatory approach embodied in Alternative B. However, as a compromise, it could support an optional approach to Article 20.

1520.2 Speaking as Representative of CNCBI, he stated that that Organization supported Alternative B as amended by the proposal of the Delegation of Switzerland and as amended by the drafting suggestion of the Delegation of France.

1521. Ms. LEVIS (ALIFAR) stated that the rights of the prior user should be safeguarded. For that reason her Organization supported Alternative B.

1522. Mr. BANNER (IPO) stated that his Organization shared the point of view expressed by the Delegation of Japan. He emphasized that it was not correct to state, as was suggested by some delegations, that any information or technology in the public domain could be used freely. He referred in this connection to the example provided by the Delegation of Japan. He was of the view that the early disclosure of information should be promoted and such a promotion could not take place in the context of a system that considered that everything that was in the public domain could be used freely.

1523. Mr. SCHATZ (EPO), in response to the statements of the Delegation of Japan and the Representative of IPO, recalled that, in the context of the first-to-file system, from the date of the filing of the application, the information was protected and thereby was not within the public domain.

1524. Mr. BANNER (IPO) stated that the understanding of his Organization was that, in the context of the first-to-file system, any disclosure taking place the day before the filing date was in the public domain.

1525. Mr. BETON (UNICE) stated that the rights of the prior user should be acknowledged and recognized by the Treaty and, further, it should take precedence over the grace period. Consequently, his Organization supported Alternative B, as well as the proposal by the Delegation of Switzerland.

1526.1 The CHAIRMAN said that several speakers had pointed to the link existing between Articles 20 and 9(2), on the one hand, and Article 12, on the other.

1526.2 To avoid any misunderstanding, he emphasized two points. Firstly, the fact of obtaining knowledge of a publication that had occurred during the grace period was not sufficient to create a right of prior user since serious preparation had to have been made or use of the invention had to have begun. Secondly, the principle of good faith meant that anyone obtaining knowledge of such publication had to obtain information on whether an application for a patent had already been filed; where such was the case, that person would no longer be acting in good faith.

1526.3 The Chairman noted that the Committee had discussed a whole number of possibilities: Alternative A alone; Alternative A with the amendment proposed by the Delegation of the United States of America; Alternative B alone; Alternative B with the amendment proposed by the Delegation of Switzerland and Alternative A with the sentence added by the Delegation of Switzerland. The text that had received the most support was Alternative B supplemented by the sentence proposed by the Delegation of Switzerland, of which the wording could be revised on the basis of the suggestion made by the Delegation of France. It was that text, as things stood, that could serve as a basis for the continued discussions.

1527. Mr. KESOWO (Indonesia) announced a meeting of the Group of 77.

1528.1 The CHAIRMAN adjourned the Meeting.

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1528.2 The CHAIRMAN opened the meeting. He wished to give an opportunity to delegations that had not spoken on the preceding day and who, on reflection, perhaps wished to do so, to give their views on Article 20.

1529. Mr. KIRK (United States of America) indicated that his Delegation, in light of the discussion of the day before, strongly preferred the basic proposal to the proposal of the Delegation of Switzerland. He stated that his Delegation hoped that the basic proposal would continue to be the basis for further discussion at the second part of the Conference.

1530. Mr. WIERZBICKI (New Zealand) stated that his Delegation had not spoken before because the patent law of his country did not provide for a prior user right or for a grace period. He added that there was a debate going on in his country concerning those issues and that his Delegation would be in a position to give views on those issues at the second part of the Conference.

1531. Mr. PARK (Republic of Korea) stated that his Delegation wished to reserve its position on Article 20.

1532. Ms. RODRIGUES MITTELBACH (Brazil) stated that her Delegation provisionally supported the basic proposal.

1533. Mr. TALUKDAR (Bangladesh) stated that his Delegation supported the basic proposal but indicated that it had not decided between Alternatives A or B due to the fact that a final decision had not been taken on Article 19, which was referred to in those Alternatives.

1534. Mr. RAVI (Zimbabwe) expressed the support of his Delegation for Alternative B of the basic proposal and the proposal made by the Delegation of Switzerland.

1535. Mr. IVÁNYI (Hungary) stated that his Delegation supported Alternative B and the proposal of the Delegation of Switzerland.

1536. Mrs. DE CUYPERE (Belgium) stated that her Delegation supported the proposal of the Delegation of Switzerland, with the amendment proposed by the Delegation of France.

1537. Mr. GARIEPY (Canada) indicated that, while his Delegation had sympathy for the proposal of the Delegation of the United States of America, it preferred the basic proposal. He stated that his Delegation did not support the proposal of the Delegation of Switzerland.

1538. Ms. LACHOWICZ (Poland) stated that her Delegation supported Alternative B, with the amendment proposed by the Delegation of Switzerland.

1539. Mr. UEMURA (Japan) recalled that, on the previous day, his Delegation, in its second intervention on the topic under discussion, had supported the proposal by the Delegation of the United States of America. He stated that it now supported the basic proposal with Alternative B.

1540. Mr. KIM (Democratic People's Republic of Korea) stated that his Delegation supported Alternative B and the amendment proposed by the Delegation of Switzerland.

1541. Ms. KRUDO SANES (Uruguay) stated that her Delegation supported Alternative B and the proposal of the Delegation of Switzerland.

1542. Mr. MBUYU (Zaire) stated that, in light of the discussions of the previous day, his Delegation supported Alternative B and the proposal of the Delegation of Switzerland.

1543. Mr. JAKL (Czechoslovakia) stated that his Delegation supported the text of the basic proposal with the amendment proposed by the Delegation of Switzerland.

1544. Mr. ELHUNI (Libya) indicated that his Delegation supported Alternative B in the basic proposal and the proposal by the Delegation of Switzerland.

1545. Mr. KHUMALO (Swaziland) stated that his Delegation favored Alternative B of the basic proposal with the amendment of the Delegation of Switzerland.

1546. Mr. NEUKOM (CIPA) stated that his Organization considered the prior user right to be an essential adjunct of the first-to-file system that the Treaty sought to make universal. His Organization had no position on Alternative A or B, since any country that did not adopt prior user rights puts its home industry at risk.

1547. Mr. MTETEWAUNGA (United Republic of Tanzania) stated that his Delegation supported Alternative B and the proposal of the Delegation of Switzerland.

1548. Mr. SCHAEFERS (Germany) observed that, while there seemed to be a clear majority in favor of Alternative B in the basic proposal and the proposal of the Delegation of Switzerland, a two-thirds majority did not seem to have crystallized. He indicated that, taking into account the situation in the United States of America, his Delegation would have no objection to the text of Alternative 20, including Alternatives A and B, being presented to the second part of the Conference, without the proposal of the Delegation of Switzerland.

1549. Mr. GOLDRIAN (BDI) stated that his Organization supported Alternative B and the proposal of the Delegation of Switzerland.

1550. Mr. MELLER (NYPTC) stated that the concept of prior user rights was a foreign concept in the United States of America and that it would be difficult to convince interested circles in that country of its desirability. He considered that making the provision on prior user rights compulsory would be to throw down the gauntlet and that making it optional would suffice.

1551. Mr. HATOUM (Lebanon) stated that his Delegation supported the view expressed by the Delegation of Germany.

1552. Mr. OKAWA (JPAA) stated that his Organization supported the basic proposal and considered the prior user right to be essential to a first-to-file system. Consequently, it believed that the provision on prior user rights should be mandatory.

1553. Mr. PAGENBERG (DVGR and MPI) stated that his Organizations favored Alternative B and the proposal of the Delegation of Switzerland.

1554. Mr. OGAWA (APAA) stated that his Organization supported the basic proposal without amendment.

1555. Mr. LECCA (UEPIP) stated that his Organization supported the position of the Delegation of the United States of America in preferring Alternative A. He considered that the decision as to whether prior user rights should be granted is one that affected national industry and that should be left to each Contracting Party to decide.

1556.1 The CHAIRMAN noted that the proposal by Switzerland had obtained the support of a larger number of delegations than on the preceding day. He likewise noted that the delegations that supported the basic proposal did so, as observed by the Delegation of Germany, in order to keep a choice open between a compulsory provision and an optional provision for the States.

1556.2 He provisionally concluded that, for the second part of the Conference, the basic proposal should leave a choice open, and also supplement Alternative B with the Swiss proposal.

1557. Mr. BOGSCH (Director General of WIPO) also held that the choice should be left open for the second part of the Conference. One solution that could be envisaged was to make the right of prior user compulsory for the Contracting Parties, but to permit them to enter a reservation on that provision.

1558.1 The CHAIRMAN proposed to conclude that it would be for the second part of the Diplomatic Conference to take a final decision and, in particular, to decide whether the provision should be compulsory or optional.

1558.2 He asked delegations whether they could agree to that conclusion. Since no request to take the floor was forthcoming, he confirmed that the sentence added by the Swiss Delegation had been chosen, but that a choice between an optional provision and a compulsory provision would remain open until the second part of the Conference.

Article 21: Extent of Protection and Interpretation of Claims

1558.3 The Chairman turned to a discussion on Article 21 and indicated that four proposals had been received in relation thereto, the first from the Delegation of Japan, contained in document PLT/DC/24 Rev., the second from the Delegation of the United States of America, contained in document PLT/DC/61, the third from the Delegation of France, contained in document PLT/DC/63, and the fourth from the Delegation of Canada, contained in document PLT/DC/64.

Article 21(1): [Determination of the Extent of Protection]

1558.4 He proposed examining each of the paragraphs of Article 21 and turned first to paragraph (1)(a) and (b), in respect of which no proposals for amendment had been received.

1559. Mr. KIRK (United States of America) proposed orally an amendment to paragraph (1)(b) to change, in the second and third sentences thereof, the term "shall" to "should." He indicated that his Delegation preferred that wording and additionally it was consistent with the Protocol to Article 69 of the European Patent Convention, which served as the basis for the provision being discussed.

1560. Mr. BOGSCH (Director General of WIPO) observed that it would be curious to include a provision of an advisory nature.

1561. The CHAIRMAN invited the Delegation of the European Patent Organisation to comment on the advisory nature of the Protocol to Article 69 of the European Patent Convention.

1562. Mr. SCHATZ (EPO) stated that the context of the provision in the basic proposal was somewhat different from that in the European Patent Convention. He did not see any need, therefore, to literally imitate the European Patent Convention in that regard.

1563. Mr. SUGDEN (United Kingdom) stated his Delegation favored the term "shall" rather than "should" because the provision should constitute an instruction, rather than advice.

1564. Mr. UEMURA (Japan) stated that his Delegation understood the sentiment of the proposal of the Delegation of the United States of America. He saw the introduction of the word "should" as providing a certain flexibility to judges, but he stated that his Delegation had not yet examined the implications of the proposed change and, therefore, reserved their position.

1565. Mr. GUERRINI (France) said that his Delegation attached great importance to its proposal and wished to maintain the indicative since that was also the style used in French legislation.

1566. Mr. SCHATZ (EPO) stated that he had compared the texts of the Protocol to Article 69 of the European Patent Convention in the two other languages (French and German) which, he stated, were equally binding. He observed that in German it was absolutely clear that it corresponded to "shall" and not to "should." He stated that the conclusion was similar for the French version which read: "l'article 69 ne doit pas être interprété." He saw the German and French texts as being in agreement, not with the English text of the Protocol to Article 69 of the European Patent Convention, but with the English text as proposed in the basic proposal.

1567. Mr. SCHAEFERS (Germany) stated that his Delegation had no objections to the proposal of the United States of America. He stated that the Protocol to Article 69 of the European Patent Convention was a part of that Convention and, therefore, was mandatory. He considered it to be necessary to give guidelines to courts to steer a middle course.

1568. Mr. BOGSCH (Director General of WIPO) asked whether the proposal of the Delegation of the United States extended also to the word "shall" which appeared in the first sentence of paragraph (1)(b), in addition to the second and third sentences.

1569. Mr. KIRK (United States of America) stated that his Delegation had recommended changing "shall" to "should" in the second and third sentences only of paragraph (1)(b) because situations might arise in which courts would need the flexibility to limit the interpretation of claims to their exact literal language.

1570. Mr. GUERRINI (France) observed that laws, just as judgments, were not based on hypothetical or dubitative grounds. The conditional was used neither in judgments nor laws. He reiterated that his Delegation was strongly attached to a text expressed in the manner in which laws had to be expressed, that is to say in the present indicative.

1571.1 Mr. SUGDEN (United Kingdom) stated that the previous observations made on behalf of his Delegation had been directed to the first sentence of paragraph (1)(b).

1571.2 He stated that his Delegation had sympathy with the view of the Delegation of the United States of America that the second and third sentences provided guidance to judges and, as suggested by that Delegation, circumstances might arise in which claims were to be interpreted strictly. He suggested that the result sought by the Delegation of the United States of America could also be achieved if the term "shall" were kept in the second sentence and if the modifier "necessarily" was added so that the sentence read: "In particular, the claims shall not necessarily be interpreted as being confined to their strict literal wording."

1572. The CHAIRMAN recalled that it was not the work of Main Committee I to solve linguistic or grammatical problems. He suggested that the summary minutes reflect all the comments made by delegations and that the matter be left to the Drafting Committee.

1573. Mr. TALUKDAR (Bangladesh) observed that Article 21 dealt with the extent of protection and the interpretation of claims and raised the question as to what point of time the claims were to be interpreted. He saw claims as evolving, even after they had been granted, and invited delegations to consider whether that matter should be part of the Treaty or if it should be dealt with in the Regulations or the Notes.

Article 21(2): [Equivalents]

1574.1 The CHAIRMAN suggested moving to paragraph (2) of Article 21 and noted that there were, in respect of paragraph (2)(a), two proposals: the first by the Delegation of Japan, contained in document PLT/DC/24 Rev. (document PLT/DC/24 Rev. Corr. in French), and the second by the Delegation of France, contained in document PLT/DC/63 (document PLT/DC/63 Corr. in Spanish).

1574.2 He invited the Delegation of Japan to introduce its proposal.

1575.1 Mr. UEMURA (Japan) observed that the proposal of his Delegation in document PLT/DC/24 Rev. called for the deletion of the phrase "notwithstanding paragraph (1)(b)" from paragraph (2)(a). He stated that the determination of equivalents should be within the limits of the extent of protection, determined in accordance with paragraph (1), and the phrase "notwithstanding paragraph (1)(b)" found in paragraph (2) might otherwise be read as a derogation from (1)(b) and was not necessary.

1575.2 He indicated that in subparagraph (b) of the proposal of his Delegation, the term "generally" was deleted from the first line. Subparagraph (b) did not seem to be the place for such a term since it was his understanding that subparagraph (b) was directed to the definition of an equivalent element. If the expression "generally" was to appear anywhere, it would be best placed in subparagraph (a). However, rather than the qualifier "generally" in subparagraph (a), his Delegation preferred the phrase "due account shall be taken." Without the phrase "due account shall be taken," the paragraph could be interpreted such that the requirement of equivalents would be automatically satisfied even if the equivalent was in the prior art, or if, through the application of the doctrine of equivalents, the heart of the invention was replaced by another element.

1575.3 There was also a need for defining the date upon which equivalents were to be determined and the proposal of his Delegation addressed that issue. He stated that the Committee of Experts raised the concern there should be some flexibility in determining the time of infringement to provide a certain latitude of interpretation or discretion to judges. The provision of such flexibility was another reason for the phrase "due account shall be taken" being included in the proposal of his Delegation.

1575.4 It was also proposed to delete the term "equivalent element" at the commencement of item (i) of subparagraph (b) and to replace it by "it."

1575.5 The proposal of his Delegation called for the deletion of the word "substantially" from subparagraph (b)(i) because the word did not figure in subparagraph (b)(ii) and its appearance in subparagraph (b)(i) was confusing.

1575.6 With respect to the tests of equivalence in subparagraph (b), he indicated that his Delegation had difficulty in accepting the test before coming to the Conference but, after a detailed and lengthy examination at the Committee of Experts, his Delegation had concluded that the tests in subparagraph (b), especially in subparagraph (b)(ii), were flexible enough to permit equivalence based on substitutability and ease of substitution. It was ease of substitution that his Delegation had been advocating for the determination of equivalence. He indicated that, therefore, his Delegation could support subparagraph (b). He expressed difficulty, however, in understanding how subparagraph (b)(i) could be interpreted, in particular the word "way." He had looked into court decisions, in particular of the United States of America, but there was no clear view as to what it meant. He stated, however, that he would not block subparagraph (b)(i) remaining in the text as it was an optional provision.

1576. Mr. BOGSCH (Director General of WIPO) drew attention to Note 21.01 in document PLT/DC/4, which stated:

"The phrase 'at the time of any alleged infringement' may be regarded as meaning at any time during the occurrence of the alleged infringement or only at the start of the alleged infringement."

He recalled that the discussions in the Committee of Experts had indicated a desire not to be too precise in terms of defining the time at which equivalents were to be determined.

1577. Mr. GUERRINI (France) asked whether it was possible to examine the amendment proposed by the Delegation of Canada, which based on an attempt to define equivalents, whereas the proposal by his own Delegation excluded such definition, since to proceed in that way would assist his Delegation, after having heard those speaking in favor of a definition, to more readily justify its proposal in that respect.

1578. The CHAIRMAN said that it was his intention to first reach a conclusion on the first paragraph. He pointed out the difference between the basic proposal--which said that a claim "shall be considered to cover not only all the elements as expressed in the claim but also equivalents"--and the proposal by the Delegation of France--which, as the proposal by the Delegation of Japan, used the expression "due account shall be taken of elements." He repeated his intention of returning to that item once it had been decided whether a definition of equivalents was necessary. He further noted that in the basic proposal the words "notwithstanding paragraph (1)(b)" could be deleted.

1579. Mr. GUERRINI (France) explained that his Delegation had acted on the same concerns as the Delegation of Japan. He noted that the "notwithstanding paragraph (1)(b)" contained in the wording of the basic proposal was not contained in the proposal by his Delegation. As for the rest, there was no difference between the proposal by Japan and the text of the proposal by the Delegation of France except that no reference was made to "any alleged infringement," an expression that was indeed to be found in the basic proposal since that was a reference to the concept of presumption. He pointed out that presumption was an element of proof and that it was perhaps preferable to use a more neutral term and not a term that could lead to interpretation. That was why his Delegation had preferred to say "at the date of the alleged infringement."

1580.1 Mr. UEMURA (Japan) stated that his Delegation had been aware of the Note regarding the phrase "at the time of any alleged infringement" referred to by the Director General when it had drafted its proposal, but that it did not think it contained an exhaustive list of possible situations. In particular, he felt that the provision regarding when equivalents were to be determined should be more flexible so as to encompass not only the start of infringement, but also threat of infringement.

1580.2 He considered that the deletion of the word "substantially" in paragraph (b)(i) was not seen as making the provision more rigid, but, on the contrary, more flexible. He indicated that his Delegation could accept having the term "substantially" appear in neither subparagraph (b)(i) and (ii), as envisaged in its proposal, or having the term in both of them.

1581. The CHAIRMAN observed that the choice lay between, on the one hand, the basic proposal and, on the other hand, the proposal of the Delegations of Japan and France.

1582.1 Mr. TALUKDAR (Bangladesh) expressed the anxiety of his Delegation as to the extent of protection accorded to equivalents. He considered that, if something was equivalent in all respects, it was identical and the doctrine of equivalents was not necessary. If something different was being discussed, then it was a deviation from identity.

1582.2 He offered an example of a person making yoghurt in his country by a traditional non-infringing technique. He stated that, if a person got a patent on yoghurt then the provisions of subparagraph (b)(i) might lead to unnecessary infringement suits against the traditional makers of yoghurt because it was substantially the same as the patented yoghurt. He considered that, therefore, his Delegation was opposed to the extension of claims to any equivalent unless it was equivalent in all respects and, therefore, identical.

1583. Mr. MESSERLI (Switzerland) stated that his Delegation preferred the proposals of Japan and France as being more flexible and, as between them, preferred the proposal of France.

1584.1 Mr. KIRK (United States of America) stated that his Delegation agreed with the proposal of the Delegation of Japan to delete the phrase "notwithstanding paragraph (1)(b)" from paragraph (2)(a).

1584.2 He indicated that his Delegation disagreed with the remainder of the proposal of the Delegation of Japan, and with that of the Delegation of France. He stated that it was correct that the proposals provided flexibility, but he saw them as providing too much flexibility. As to the provision in paragraph (2)(a) of the basic proposal that a claim "shall be considered to cover not only all the elements as expressed in the claim but also equivalents," his delegation felt that it was important to have such a mandatory requirement of equivalents to give a significant scope of protection so as to ensure that the patent holder obtains his just reward.

1584.3 Responding to the concern raised by the Delegation of Bangladesh concerning the doctrine of equivalents, he recalled that, if an invention was in the public domain, the claim would be considered invalid.

1585. Mr. KAMEL (Egypt) supported the proposal of the Delegation of France which he considered took into account equivalents more amply than the basic proposal.

1586. Mr. BOGSCH (Director General of WIPO) noted that the phrase "due account shall be taken" did not give any guarantee that the doctrine of equivalents would be applied and wondered whether it should not be amended at least, for example, by adding the word "generally" or the words "as a rule."

1587.1 Mr. SCHAEFERS (Germany) stated that his Delegation supported the basic proposal on the question of the doctrine of equivalents. He recalled that the doctrine of equivalents had been part of the patent law of Germany since the first such law in 1876 and that the courts in Germany had always been liberal in their application of the doctrine.

1587.2 In respect of the wording of paragraph (2)(a), his Delegation favored the texts proposed by the Delegations of France and Japan which gave more discretion to courts in infringement proceedings. He considered that courts would apply the rule of reason and doubted that there would be any substance to the concerns raised in that respect by the Delegation of the United States of America.

1587.3 He added that the expression "due account shall be taken" would, in his opinion, require a court to determine equivalents under the rule of reason.

1588. The CHAIRMAN pointed out that the English wording of the basic proposal was perhaps somewhat more flexible than the French text. The English text mentioned "elements as expressed in the claim but also equivalents" whereas the French text referred to "leurs équivalents," which appeared to concern "not only all the elements as expressed in the claims but also equivalents." He felt that the term "mais aussi sur leurs équivalents" in the French should be replaced by the words "mais aussi sur des équivalents."

1589.1 Mr. SUGDEN (United Kingdom) recalled that his Delegation had expressed its opposition to the inclusion of paragraph (2), stating that the full situation was dealt with fully in paragraph (1), which precluded a strict literal interpretation of claims and struck a fair balance between the interests of the inventor and third parties.

1589.2 He stated that he realized that the Delegation of the United States of America was attached a doctrine of equivalents, but that he had looked at the relevant case law in that country and could discern no clear thread as to how the doctrine was applied. He found that the courts of that country allowed only slight changes to be considered as equivalents for the purposes of infringement.

1589.3 He stated that making the application of such a doctrine a mandatory requirement went far beyond the provisions of paragraph (1)(b), since it could include inventions that had not been contemplated by the applicant.

1589.4 He stated that there was a need for more flexibility and saw the proposal of the Delegation of France as being instructive in this regard, calling on the courts to apply the rule of reason in determining equivalents. His Delegation could not go along with the wording in the basic proposal.

1590.1 The CHAIRMAN suspended the meeting.

[Suspension]

1590.2 The Chairman continued the discussion of Article 21, indicating that the discussion would initially be limited to paragraph (2)(a) and the proposals of the Delegations of Japan and France contained in documents PLT/DC/24 Rev. (document PLT/DC/24 Rev. Corr. in French) and PLT/DC/63 (document PLT/DC/63 Corr. in Spanish), respectively.

1591. Mr. EFON (OAPI) stated that his Delegation preferred the proposal of the Delegation of France, since it had the advantage of indicating that date at which equivalents were to be determined.

1592.1 Mr. COHN (Israel) stated that his Delegation was in favor of the inclusion of a provision on the doctrine of equivalents in the Treaty, stating that similar provisions existed in the law of his country. He indicated that his Delegation had no strong feelings as to whether the provisions in the basic proposal, subject to the removal of the language "notwithstanding paragraph (1)(b)," or the proposals of the Delegations of France or Japan were adopted.

1592.2 He considered that there was a problem with all of the proposals in making the application of the doctrine of equivalents mandatory in that there might be circumstances in which it should not be applied.

1593. Mr. IANNANTUONO (Italy) expressed the support of his Delegation for the proposal of the Delegation of France. He observed that it was difficult to define the doctrine of equivalents in all countries and that it was best to define it through judicial interpretation.

1594. Mr. GARIEPY (Canada) indicated that his Delegation supported the basic proposal as being more in line with the proposal of his Delegation, contained in document PLT/DC/64, concerning Article 21(2). He stated that his Delegation could, however, agree with the deletion of the phrase "notwithstanding paragraph (1)(b)" from paragraph (2)(a).

1595.1 Mr. GUERRINI (France) stressed the importance of the phrase "due account shall be taken." The doctrine of equivalents should not be applied in a blind and systematic manner.

1595.2 He quoted the example of a decision by the Federal Circuit Court concerning the alleged infringement of a calculator, the first of the type patented by the firm of Texas Instruments. That electronic calculator had led to claims referred to in the specialists' jargon as "means plus function," reading: a miniature, portable electronic calculator operating on batteries comprising: (a) means of input comprising a keyboard enabling figures, numbers and arithmetic commands to be entered into the said calculator and to generate signals corresponding to ten figures and up to ten commands, etc.; (b) electronic means corresponding to the said signals enabling the performance of calculations on the figures entered into the calculator permitting the generation of control signals; the said electronic means comprising also an integrated semiconductor circuit located essentially on one plane, which integrated semiconductor circuit comprises memory means permitting the numbers to be entered into the calculator to be recorded, means ... "

1595.3 The claims were examined on appeal by the Federal Circuit which held that there had not been infringement with regard to a device which apparently fulfilled the same function since in reality the innards had been changed (to

simplify) and what existed was something quite new. The court observed that the whole technology incorporated in the new device was what had to be compared with the description in the patent. It was that overall global assessment that replaced an assessment, element by element, of the theory of equivalents and therefore led the judge to decide against infringement.

1595.4 It therefore appeared to him that the expression "due account shall be taken" appeared more reasonable.

1596.1 Mr. NEERVOORT (Netherlands) stated that his Delegation favored the proposal of the Delegation of Japan because it gave greater flexibility. In that regard, he did not share the fears that the words "due account shall be taken" were too vague. He stated that the phrase was qualified by the term "due" and that it was not an instruction for barristers, but for judges which, therefore, provided some guarantees that equivalence would be dealt with in a satisfactory manner.

1596.2 As to the proposal of the Delegation of France to delete subparagraph (b) of paragraph (2), he stated that his Delegation was of the impression that it was necessary to provide more guidance as to the interpretation of equivalence. He observed that in the States party to the European Patent Convention there were judges' symposia every two years and saw the advantages of such symposia in harmonizing jurisprudence, especially in the area of the doctrine of equivalents. He supported, therefore, the inclusion of the definitions of equivalence in paragraph (2)(b)(i) and (ii), seeing the definition in subparagraph (h)(i) being directed to the United States of America and that in subparagraph (b)(ii) to European countries.

1597. Mr. ESCUDERO CACERES (Chile) stated that his Delegation had sympathy for the proposal of the Delegation of France, especially because it called for the deletion of the phrase "notwithstanding paragraph (1)(b)" found in paragraph (2)(a).

1598. Mr. PARK (Republic of Korea) stated that his Delegation supported the proposal of the Delegation of France for the reasons given by that Delegation and by the Delegation of the United Kingdom.

1599. Mr. HATOUM (Lebanon) stated that his Delegation was in favor of the proposal of the Delegation of Japan because it was clear and had a certain flexibility.

1600. Mr. BAKER (Australia) stated that the mandatory nature of paragraph (2) went too far because courts needed flexibility to deal with a variety of facts before them. He stated that his Delegation preferred the proposals of the Delegations of France and Japan.

1601.1 Mr. KIRK (United States of America) referred to the comments of the Delegation of France on the case in the United States Court of Appeals for the Federal Circuit that it had cited. He stated that the definitions in subparagraphs (b)(i) and (ii) were needed to come to grips with the doctrine of equivalents and that, in appropriate cases, such as the one cited, if the definitions are not satisfied then no infringement would be established.

1601.2 His Delegation considered that the phrase "due account" was so weak as to make the obligation meaningless. He stated that the question of the doctrine of equivalents was a complex one, to be decided on a case-by-case

basis, examining the claims in the patent, its prosecution history, the prior art, and the elements in the accused device. His Delegation was concerned that, without some definition of equivalence, the patent owner would be deprived of his just reward.

1602. Mr. AGOUH (Central African Republic) stated that his Delegation preferred the proposal of the Delegation of France.

1603. Mr. HIDALGO LLAMAS (Spain) stated that his Delegation supported the proposal of the Delegation of France.

1604.1 Mr. MOTA MAIA (Portugal) pointed out that the practical application of the doctrine of equivalents had always been a source of concern for his Delegation. He acknowledged that the doctrine of equivalents was useful for giving an inventor the most adequate scope of protection possible. However, particularly in the developing countries, the doctrine of equivalents could also be used to prevent the development of processes that could replace a patented process. With those concerns in mind, he stated that if a preference had to be expressed then he would prefer the proposal made by the Delegation of France.

1604.2 As for the basic proposal, he stated that, in paragraph (2)(b), the basic proposal would best suit his Delegation if the condition was that the two following conditions had to be satisfied, not one or the other, but only if it were the two at the same time.

1605. The CHAIRMAN indicated that the question of the definition of equivalents would be returned to.

1606. Mr. FITZPATRICK (Ireland) stated that his Delegation supported the proposal of the Delegation of France.

1607. Mr. KIRK (United States of America) stated that his Delegation had sympathy with the proposal of the Delegation of France and wondered if it was possible to combine paragraph (2) of that proposal with paragraph (2)(a) of the basic proposal. Accordingly, paragraph (2)(a) of the basic proposal would read as follows:

"For the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements which, at the date of the alleged infringement, are equivalent to the elements expressed in the claims so that a claim shall be considered to cover not only all the elements as expressed in the claims but also equivalents."

1608. Mr. BANGAR (India) stated that the doctrine of equivalents contained in Article 21(2) was not consistent with the Indian Patent Act. He stated that the question of equivalents should be left to the courts to decide on the basis on what was claimed and considered that the acceptance of Article 21(2) would fetter the freedom of the courts.

1609. Mr. RATTANASUWAN (Thailand) stated that his Delegation agreed with the statement of the Delegation of the United Kingdom. Since the matters dealt with in paragraph (2) were already dealt with in paragraph (1), he considered that paragraph (2) could be deleted.

1610.1 Mr. CLARK (ABA) stated that he had heard explanations as to what the doctrine of equivalents meant that did not correspond to the doctrine. He had not heard any mention with respect to the proposal of the Delegation of France that it contained only paragraph (2) and that subparagraphs (a), (b), and (c) thereof had disappeared. He considered those deletions as emasculating the provisions in relation to the doctrine of equivalents. Furthermore, the language "take into account" could mean that the provisions would be ignored.

1610.2 He recalled that it had been the consistent position of his Organization to have a provision in relation to the doctrine of equivalents so as to give the inventor a reasonable scope of protection. He disagreed with the conclusions reached by the Delegation of the United Kingdom in respect of its analysis of the case law of the United States of America on the doctrine of equivalents. He considered that the doctrine of equivalents was designed to protect the inventor against those that would snip away at his protection and that the United States of America should not consider the doctrine of equivalents as a bargaining chip to throw away to secure the Treaty.

1611.1 Mr. SUGDEN (United Kingdom) asked the Delegation of the United States of America to repeat its proposal because he felt that that new proposal was getting closer to what he had read about the doctrine of equivalents. He stated that that proposal sounded to be somewhat more limiting than the present text, which implied a possibility that the owner of the patent could allege that all sorts of things he had never contemplated fell within the scope of his claims.

1611.2 He agreed with the Representative of the ABA that many of the delegations did not understand the way in which the doctrine of equivalents was applied in the United States of America and that they would appreciate a full exposition of how that occurred. He stated that it did not appear from the literature to correspond with the statement in paragraph (2).

1611.3 He quoted from a publication from the United States of America that several of the decisions of the Court of Appeals for the Federal Circuit had generated a great deal of confusion regarding the doctrine of equivalents. He stated that, as he understood the doctrine of equivalents from other publications, it was a restrictive doctrine on the whole and that the widening aspects of it were relatively few. He stated that the doctrine required a study of whether the overall apparatus or device achieved substantially the same result, did substantially the same work, and if that was not the case the literal infringement inquiry was ended, and it was only after that inquiry that one looked at the question of equivalents, on an element by element basis. He understood that part of the doctrine of equivalents was to ensure that each element of the claim was actually present in the allegedly infringing device.

1612. Mr. KIRK (United States of America) recalled that the proposal of his Delegation was to take the proposal of the Delegation of France in respect of paragraph (2), make it (2)(a) and to add to it the provisions of paragraph (2)(a) of the basic proposal. He stated that that would replace the provisions of paragraph (2)(a) in the basic proposal.

1613. Mr. GUERRINI (France) confirmed that the wording would be as follows: "For the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements which, at the date of the

alleged infringement, are equivalent to the elements expressed in the claims in such a way that they be considered to cover not only all the elements as expressed in the claims, but also their equivalents." He stated that his Delegation had no objections in principle, but that it was not sure that the proposed amendment would add anything.

1614.1 Mr. PAGENBERG (DVGR and MPI) stated that the Organizations that he represented supported the basic proposal and that the provision in the proposal of the Delegation of France that "due account" be taken of equivalents was too vague.

1614.2 He stated that it must be expressed in the Treaty that equivalents were inherent to the scope of any patent claim, indicating that this was the case law of the German courts. He stated that a limitation to the wording of a claim should be the exception, as was correctly provided for in paragraph (1)(b) where it said that the literal wording was not the rule. He indicated that there were exceptions where equivalents were not to be protected, such as, for example, with respect to how to treat prior art and stated that such exceptions could be enumerated in the Regulations. He felt that a vague paragraph (2)(a) could result in the disregard of equivalents and that the present text of paragraph (2)(a) should be the rule.

1614.3 He considered that the proposal of the Delegation of the United States of America to combine the proposal of the Delegation of France with the basic proposal was a good compromise.

1615. Mrs. RYAN (NYPTC) stated that her Organization felt that "due account" was too vague a standard and supported the compromise proposal of the Delegation of the United States of America.

1616. Mr. SANTARELLI (AIPPI) stated that his Organization had always been in favor of the doctrine of equivalents and that it should be part of the Treaty in order to protect against close infringements. He considered that there should be some constant rules in the application of the doctrine and, therefore, supported the basic proposal. He stated that the oral proposal of the Delegation of the United States of America could solve the doubts raised. He agreed with the Representative of DVGR and MPI that there were some situations where the doctrine of equivalents did not apply.

1617. Ms. LEVIS (ALIFAR) stated that a provision on the doctrine of equivalents should not be included in the Treaty but that, if such a provision were included, the proposals of the Delegations of Japan and France were more acceptable than the basic proposal.

1618. Mr. YOSHIDA (JPA) stated that his Organization desired the elimination of the language "notwithstanding paragraph (1)(b)" from paragraph (2)(a) to retain the spirit of paragraph (1)(b) for judging equivalence. He supported the proposals of the Delegations of Japan and France, seeing the provision that "due account shall be taken" as establishing that the doctrine of equivalents be applied under the rule of reason to prevent its automatic application and to provide some flexibility as to the timing of its application.

1619. Mr. SCHAEFERS (Germany) stated that his Delegation was in favor of the proposals of the Delegations of Japan and France in respect of

paragraph (2)(a), but not to exclude the definition of equivalent elements in subparagraph (b)(i) and (ii). He indicated that his Delegation could go along with the oral proposal of the Delegation of the United States of America to combine the proposal of the Delegation of France with the basic proposal and stated that the words "so that" could be replaced by "with the understanding

1620. The CHAIRMAN indicated that the definition provisions of paragraph would be dealt with at a later time.

1621.1 Mr. BETON (UNICE) stated that his Organization was concerned that third parties should have reasonable certainty and, therefore, did not support the definitions of equivalents contained in paragraph (2)(b), since they were too broad.

1621.2 He indicated that his Organization considered the rule of reason to be vital in the assessment of equivalents. He stated that the proposed European wording was too wide and that it arrogated the results of the determination of equivalents to the patentee. He thought it was best to leave the matter to the good sense of judges to take "due account" of equivalents.

1621.3 He stated that, if the definitions of equivalents were retained, the Regulations should recite the cases in which equivalents were not to be found, such as: where the equivalent to the claimed invention reads onto the prior art, where it reads onto a senior right, or where it would be inequitable to allow it to fall under the patent right. He saw that last item as including at least five cases: because it was not a pioneer invention, it did not contribute particularly to the progress of the pertinent art, the invention was in a crowded art, the equivalent was taught to the art solely by the infringer, or someone connected with him, or the equivalent was so different to the claimed invention that, for competitors, the patent amounted to a "submarine" that could not have been predicted. He stated that the advantage of placing such matters in the Regulations was that they could be revised from time to time as practice developed.

1622. Mr. MESSERLI (Switzerland) supported the proposal of the Delegation of France, stating that the oral proposal of the Delegation of the United States of America could also serve as a compromise without prejudice as to whether equivalents should be defined.

1623. Mr. OKAWA (JPAA) stated that his Organization supported the proposal of the Delegation of Japan as providing necessary flexibility for the judge to decide, on a case-by-case basis, the question of infringement of claims. He considered that, in the United States of America, there was not a clear consensus as to the definition of the doctrine of equivalents.

1624. Mr. LECCA (UEPIP) stated that his Organization approved of the protection under the doctrine of equivalents, except in respect of cases in the public domain. He expressed concern about the practical application of Article 21 and wondered what would be the sanction should a judge not apply the Treaty.

1625. The CHAIRMAN stated that such a question was within the mandate of Main Committee II.

1626. Mr. BEIER (FICPI) stated that his Organization supported the basic proposal and was in agreement with the oral proposal of the Delegation of the United States of America.

1627. Mr. TALUKDAR (Bangladesh) stated that there was a great deal of confusion on the topic of the doctrine of equivalents and unfamiliarity with the subject matter. He stated that there had been comments that too much was being written into the Treaty and that his Delegation was strongly opposed to Article 21. He asked the delegations to work towards a treaty that was less ambitious, but had more member States.

1628. Mr. SUGDEN (United Kingdom) stated that his Delegation had reflected on the oral proposal of the Delegation of the United States of America and had a fairly positive reaction. While reserving a final decision on the precise wording, he observed that the proposal might meet the concerns of both sides in the debate.

1629.1 The CHAIRMAN observed that there was clear agreement to delete the phrase "notwithstanding paragraph (1)(b)" from paragraph (2)(a).

1629.2 He stated that, following the lunch break, discussion would be resumed on paragraph (2)(a) and that the oral proposal of the Delegation of the United States of America to combine the proposals of the Delegations of Japan and France with paragraph (2)(a) of the basic proposal would serve as the basis of discussion. He then adjourned the meeting.

Nineteenth Meeting
Wednesday, June 19, 1991
Afternoon

Article 21(2): [Equivalents] (continued from paragraph 1629)

1630.1 The CHAIRMAN opened the meeting and stated that, provisionally, the basis for further discussion of paragraph (2)(a) would be the proposals of the Delegations of France and Japan, to which would be added the text of the basic proposal. He observed that the exact links between the two parts had to be decided upon.

1630.2 He then turned discussion to subparagraphs (b) and (c) of paragraph (2) and indicated that they contained the definition of equivalents. He then summed up the four possibilities for the two subparagraphs, based upon the proposals that had been received. First, the basic proposal, subparagraph (b) and (c), covered two definitions for equivalent element, in subparagraphs (b)(i) and (b)(ii), plus, in subparagraph (c), the choice for a Contracting Party to apply either only one or both of the definitions. Secondly, the

proposal of the Delegation of Japan, contained in document PLT/DC/24 Rev. (document PLT/DC/24 Rev. Corr. in French), also included two definitions in subparagraphs (b)(i) and (b)(ii), but modified the text of them as compared to the basic proposal. He indicated that in that proposal, there was no subparagraph (c) so that the two definitions provided for would seem to be applicable in each Contracting Party. Thirdly, there was the proposal of the Delegation of France, contained in document PLT/DC/63 (document PLT/DC/63 Corr. in Spanish), which included no definition and, therefore, no subparagraph (b) or (c). Fourthly, there was the proposal of the Delegation of Canada, contained in document PLT/DC/64, wherein the two definitions in subparagraphs (b)(i) and (b)(ii) were cumulative.

1631. Mr. UEMURA (Japan) clarified that the proposal of his Delegation, contained in document PLT/DC/24 Rev. (document PLT/DC/24 Rev. Corr. in French), was not intended to delete subparagraph (c), but that the proposal was only directed to subparagraphs (a) and (b).

1632. The CHAIRMAN thanked the Delegation of Japan for the clarification that its proposal concerned only Article 21(2)(a) and (b) and that subparagraph (c) was intended to remain as in the basic proposal.

1633. M. GUERRINI (France) confirmed that his delegation proposed that it not have a definition. His Delegation wished to try to justify this position during the course of the debate that would develop on proposals that included one definition or several definitions.

1634.1 Mr. GARIEPY (Canada) stated that Article 21 was important for establishing the principles on which patent protection was extended. Article 21(2)(b) set forth two tests to determine equivalents, which had been extensively discussed in the Committee of Experts. The basic proposal addressed all facets of the problem in defining and circumscribing the problem for all parties concerned, namely, inventor, examiner, drafter of the application, possible infringer and the courts in countries where the tests to determine equivalents were applied.

1634.2 He stated that the text of the basic proposal unfortunately offered a choice which would lead to different results. In order to overcome that result, he proposed that the texts in subparagraph (b)(i) and (ii) be combined. With that combination, there would be no need for subparagraph (c) and it should, therefore, be deleted.

1635.1 Mr. KIEK (United States of America) stated that his Delegation supported subparagraph (b)(i) and (ii) as in the basic proposal, asserting that the definition of equivalents was important, if not essential, to move to a harmonized approach to the doctrine of equivalents. He stated that, while the basic proposal did allow a choice, it harmonized practice by eliminating everything else. His Delegation saw this as an important first step, which could later lead to further harmonization.

1635.2 His Delegation disagreed with the proposal of the Delegation of Japan to eliminate the word "substantially" from subparagraph (b)(i), as it would result in the inappropriate narrowing of that definition. His Delegation would have no objection to placing the word "substantially" in subparagraph (b)(ii) so as to make the two definitions the same in that regard.

1635.3 He directed a question to the Delegation of Japan as to what was intended by the deletion of the phrase "equivalent element" from subparagraph (b) and what was the purpose of rearranging the text in subparagraph (2)(ii).

1636. Mr. UEMURA (Japan) stated, in responding to the questions of the Delegation of the United States of America, that the use of the term "equivalent element" was a tautology because an element became an equivalent element when it passed the tests in subparagraph (b)(i) and (ii). As to the reordering of subparagraph (b)(ii), he indicated that it was purely a drafting matter because the term "elements" appeared twice and it was necessary to distinguish between the element in the claim and the element in the accused infringing device.

1637.1 Mr. KIRK (United States of America) indicated that part of the problem in subparagraph (b)(ii) was caused by the elimination of the reference to the "equivalent element."

1637.2 His Delegation opposed the proposal of the Delegation of Canada, on the basis that the combination of the two definitions would lead to confusion. His Delegation considered that it was more appropriate and flexible to have two separate definitions and to allow a choice between them by Contracting Parties.

1638.1 Mr. SCHAEFERS (Germany) stated that his Delegation supported the basic proposal in respect of subparagraph (b), with the modifications agreed upon in respect of subparagraph (a). He indicated that the modifications of subparagraph (a) would necessitate certain modifications to subparagraph (b), including the deletion of the word "generally" because the generality would be provided for in subparagraph (a). He stated further that, in the second and third line, the words "at the time of any alleged infringement" had to be deleted, as was pointed out by the Delegation of Japan, because it was provided for in subparagraph (a).

1638.2 As to the proposal of the Delegation of Japan to delete the word "substantially," he indicated that his Delegation was flexible and open as he saw it as a text based on the jurisprudence in the United States of America.

1638.3 His Delegation was, however, against the proposal of the Delegation of Canada because subparagraph (b)(ii) was derived from the jurisprudence of European courts and its combination with subparagraph (b)(i) would be inappropriate.

1639. Mr. COHN (Israel) stated that his Delegation considered that a definition of equivalents was desirable and supported the basic proposal. He advocated, however, that subparagraph (c) be deleted because in his country ratification of a treaty did not make it law, but required domestic legislation. He stated that his country would not be in a position at the time of depositing an instrument of ratification to elect subparagraph (b)(i) or (ii) or both. He did not see the advantage of making such a statement at the time of ratification, nor who would benefit from it.

1640. Mr. NEERVOORT (Netherlands) stated that his Delegation was in favor of the proposal of the Delegation of Japan, with the clarification that it included subparagraph (c).

1641.1 Mr. UEMURA (Japan) stated that, while his Delegation had some sympathy for the proposal of the Delegation of France, it did not support that proposal because it was the aim of his Delegation to strive to set up a test for equivalents as the first step to worldwide harmonization.

1641.2 In respect of the proposal of the Delegation of Canada, he stated that his Delegation had difficulty accepting it because the test in subparagraph (b)(i) was difficult to apply and, under the proposal of that Delegation, it would be obligatory to apply both the tests in subparagraph (b)(i) and (ii).

1641.3 He observed that the Delegation of Germany had indicated there had been agreement with respect to paragraph (2)(a). He stated, however, that he saw little difference between the oral proposal of the Delegation of the United States of America and the basic proposal. His Delegation was willing to consider the oral proposal, but with some hesitation.

1642.1 Mr. SUGDEN (United Kingdom) stated that, while it was useful to provide guidelines to judges as to the definition of equivalents, such definitions should be placed in the Regulations under the Treaty. He considered that the doctrine of equivalents was still being developed in the United States of America, whilst elsewhere it was a new concept. Accordingly, the definitions were best placed in the Regulations where they could be looked at in light of experience.

1642.2 As to the timing of the determination of equivalents, his Delegation considered that equivalents should be looked at before the start of the first infringement. Acts of infringement might come in sequence and the equivalence had to be established before the first in the sequence. He stated that this would allow the question of preparations to be taken into account.

1642.3 He stated that his Delegation would prefer that subparagraph (c) be retained. In respect of the definition of subparagraph (b)(i), he was in agreement with the Delegation of the United States of America, that the term "substantially" should be retained as providing a necessary flexibility. He stated that the preferred test of his Delegation was the one contained in subparagraph (b)(ii). In connection with that test, it should be noted that an equivalent might not be an obvious one even though it worked in the same way.

1643. The CHAIRMAN observed that the idea of transferring all or part of paragraph (2) to the Regulations had been raised in the Committee of Experts, but that it had been dismissed for fear that a judge might not take into account or have access to those provisions.

1644. Mr. EFON (OAPI) stated that his Organization agreed with the proposal of the Delegation of Canada to establish a link between subparagraphs (b)(i) and (ii).

1645. Mr. KHRIESAT (Jordan) stated that Article 21 was controversial and that the ball was between the Delegations of Japan and the United States of America and France and the United Kingdom. He believed that a fixed concept of the doctrine of equivalents had not yet been reached. He stated that, with respect to the question of equivalents, the freedom to adopt a proper method should be allowed so as to give further flexibility. He asked for this

flexibility particularly in the case of developing countries, stating that it was not a simple thing to change national legislation. He considered, therefore, that the provision should be optional.

1646. Mr. SANTARELLI (AIPPI) stated that there must be a definition of equivalents in the Treaty to give the courts rules to follow. He stated that he did not support the proposal of the Delegation of France but, rather, supported the basic proposal. His Organization did not support the proposal of the Delegation of Canada, but advocated the deletion of subparagraph (c).

1647. Mr. SANTARELLI (CNCBI) stated that his Organization would like to have a definition of equivalents in the Treaty, but not like those found in subparagraph (b)(i) or (ii). He stated that the definition in subparagraph (b)(i) was too rigid as requiring the equivalent element to operate in substantially the same way. His Organization was against the definition in subparagraph (b)(ii) as it seemed to try to establish a result not found in French law. His Organization therefore supported the proposal of the Delegation of France which called for no definition to be included in the Treaty. If a definition were adopted, however, it should be mandatory, so that subparagraph (c) should be deleted.

1648. Mr. PAGENBERG (MPI) stated that subparagraph (c) should be deleted as it should not be for Contracting Parties to decide to exclude one definition, but for the judge to determine and find equivalence if either test was satisfied. He stated that his Organization was against the deletion of the term "substantial" from subparagraph (b)(i), which would be too limiting.

1649.1 Mr. MITCHELL (PTIC) stated that his Organization had long advocated a definition of equivalents which would not apply equivalents to elements that were considered essential in a claim and to bring into focus the intent of the inventor when the application was filed or patent obtained.

1649.2 He stated that the proposal of the Delegation of Canada seemed to go part of the way to solving that problem by the combination of subparagraph (b)(i) and (ii). He gave the example of the sail on a sail-board which has a wish-bone to keep the sail stretched and to serve as a handle. If the wish-bone was claimed as being metal, then one made of fiberglass might be an equivalent and obvious. If, however, the wish-bone was replaced by a stiff strut with a handle, having the same function and working in the same way, which was not obvious, there should be no infringement.

1650. Mr. BEIER (CNIPA, FCPA and FICPI) stated that Article 21 was crucial for industry. He stated that it would influence claim drafting, so that harmonization was important. His Organizations were in favor of subparagraph (b) and urged the cancellation of subparagraph (c). He recognized that it was difficult to define the principle of equivalents, but subparagraph (b)(i) and (ii) gave a complete picture if joined by an "or." He stated that both definitions were true and good ones, but that if a choice between them was made by Contracting Parties, it could lead to disharmonization.

1651. Mr. GOLDRIAN (BDI) stated that his Organization supported the last statement of the Delegations of the United States of America and Germany. He stated that subparagraph (b)(i) and (ii) should be joined by an "or." He further stated that his Organization agreed with the position of the

Delegation of the United States of America that the term "the same result" in subparagraph (b)(ii) should be preceded by the word "substantially."

1652. Mr. OGAWA (APAA) stated that his Organization was of the opinion that the inclusion of a definition of equivalents was important and that it was in favor of the basic proposal as concerns subparagraph (b)(i) and (ii), but that paragraph (c) should be deleted.

1653.1 Mr. GUERRINI (France) noted that there were several definitions, with alternatives also, on which one could reflect. Thus, in subparagraph (b)(i), reference was made to substantially the same function and substantially the same result, whereas subparagraph (b)(ii) mentioned the same result and no longer substantially the same result. In the proposal made by the Delegation of Japan, a remark of the same type could be made; that concept of similarity as to the function or the result had not been taken into account. Those were therefore differences which led to difficulties of interpretation since the question had to be put what those differences in drafting could well hide in substance.

1653.2 He noted, moreover, that other delegations, particularly the Delegation of Canada, had attempted to solve that problem, that had indeed been perceived and which resulted from the awkward situation of having two definitions. He observed that those two definitions were contained in a provision that demanded a choice to be made since the States had to make a solemn declaration, meaning that a twofold solution was to be anchored in a treaty on harmonization.

1653.3 He noted that the Delegation of Canada had proposed solving the difficulty by making the algebraic sum of the two elements, item (i) and item (ii). That approach also seemed to present drawbacks. It had therefore been proposed, particularly by the Delegation of Israel, to delete subparagraph (c). It had also been said by the representative of CFBI that the reference to the result in item (ii) also had drawbacks since, in most systems of law, a result was not protected. An additional comment had been made which was that in many systems of law to improve was to infringe whereas item (ii), with its reference to the concept of obviousness to a person skilled in the art, appeared to run counter to that well-established solution. He nevertheless declared that his Delegation would be able to accept such a definition.

1653.4 He stated his willingness to envisage the introduction of a third definition which could consist in stating that the equivalent element was an element that substantially performed the same function with a view to the same result or a similar result or of the same nature if not the same degree. That could be a definition that would suit everyone, but it would also be an additional element of definition. It had therefore to be acknowledged that it was difficult to agree on a concept where it was felt that it was essentially a matter for case law and that to codify a concept that remained at the level of a legal standard indeed proved a delicate undertaking. He therefore felt that harmonization in that matter had reached a sufficient level when attempting to promote the principle of taking equivalents into account and that, for the remainder, harmonization could be sought in a much more effective manner by meetings of judges specializing in patents such as those organized by the European Patent Office: in that type of bi-annual meeting specialized judges from quite a number of countries compared their experience and solutions.

1653.5 To conclude, he appealed to delegations, since they were not able to achieve a single definition, to avoid reaching an iniquitous solution which would involve a twofold solution and to entrust the matter to the judges in such a way that they would compare their experience and knowledge and thus, little by little, and on the basis of the essential principles laid down in the Treaty, one would hope to achieve practical and effective harmonization of the concept of equivalents.

1654. Mr. BOGSCH (Director General of WIPO) recalled that the solution in paragraph (h) was a product of the history of the negotiations. At the last meeting of the Committee of Experts that solution had been reached, namely, that in some countries only the test in (i) would apply, while in other countries only the test in (ii) would apply. He indicated that the purpose of subparagraph (c) was to provide security so that applicants would know where they stood. He added that, in his view, the word "substantially" could be added in (ii).

1655. Mr. UEMURA (Japan) stated that his Delegation supported the position taken by the Delegation of the United Kingdom with respect to the timing of the determination of equivalents, indicating that the question of timing was one of the reasons his Delegation was seeking more latitude in the provision.

1656. Mr. HATOUM (Lebanon) indicated that his Delegation did not support the proposal of the Delegation of Canada as he saw it as difficult to apply. He stated that his Delegation was for the deletion of subparagraph (c) as he did not find it practical or applicable.

1657.1 Mr. MESSERLI (Switzerland) stated that the issues being discussed touched on the field of activity of tribunals and that flexibility was needed in order to allow consideration of special cases. His Delegation was, therefore, sympathetic to the deletion of the definition of equivalents. If, however, there was to be a definition, he preferred the definitions in paragraph (h)(i) and (ii) of the basic proposal, together with subparagraph (c) to allow the Contracting Parties the freedom to decide which test they would adopt.

1657.2 He endorsed the idea of the Delegation of the United Kingdom to put the definition of equivalents in the Regulations. He saw that as providing the advantage of flexibility, because in the future it would be easier to change the Regulations than the Treaty. As to the fear expressed that provisions in the Rules would not be noticed by judges, he indicated that it was up to Contracting Parties to draw the attention of judges to such provisions.

1658. Ms. RODRIGUES MITTELBACH (Brazil) stated that her Delegation supported the doctrine of equivalents and favored the basic proposal with the amendment of the Delegation of Germany. Her Delegation wished, however, to reserve its final decision on paragraph (2) until the second part of the Diplomatic Conference.

1659. Mr. NEUKOM (CIPA) saw justification in the concerns regarding time of infringement of the Delegations of the United Kingdom and Japan. His Organization was especially concerned in relation to the reference in subparagraph (b)(ii) to "a person skilled in the art," since skill in the art changed with time so that one would be tracing a moving target.

1660. Ms. LINCK (AIPLA) stated that her Organization had resolved that the extent of protection should extend to a reasonable equivalent. She expressed sympathy with the difficulty expressed by the Delegation of France in defining equivalents, but considered that it was necessary to include a definition of equivalents to give claims an effective scope. Her Organization supported paragraph (2)(h) and (c) as in the basic proposal.

1661.1 Mr. SCHATZ (EPO) said that his Delegation wished to give two additional reasons for the suggestion that had been made, firstly by the Delegation of the United Kingdom and then by the Delegation of Switzerland, that was to say to transfer the definitions to the Regulations.

1661.2 The first reason was that, as far as his Delegation was aware, no law throughout the world contained an example of a statutory definition of equivalents; it was a principle that was extensively applied, but which had arisen for reasons of good justice in the courts. Consequently, since there was already some uncertainty as to the interpretation of the definition formulated in the meeting, even in those countries in which the doctrine of equivalents existed, he wondered how those definitions would be applied and interpreted in countries which had not hitherto had any case law on equivalents and where the case law achieved results that were just as good, but on other bases, such as "purposive construction" in Britain.

1661.3 Secondly, as already mentioned by the Delegation of France, the meeting was in the course of defining divergences of law whereas it seemed to him that each, depending on his system, achieved the same overall result. Now however, the courts were obliged, since the lawmaker would make a choice between the two definitions, say "my definition is different from the definition which my lawmaker has not chosen." Consequently, there was a true incentive to divergency and it was certainly desirable not to completely eliminate the possibilities of overcoming that possible tendency to divergence. If the Regulations could be amended by a broad consensus, the Treaty itself, once signed and in force, would be extremely difficult to amend in the forthcoming decades.

1662. Mr. UEMURA (Japan) observed that some interventions had indicated that the proposal of his Delegation would lead to the interpretation of claims changing scope from time to time. He stated that this comment applied also to the basic proposal because, as the Delegation of the United Kingdom had pointed out, the act of infringement comprised a series of actions. Moreover, technology developed over time so that the general common knowledge changed from time to time. He stated that his Delegation had, because of those concerns, advocated that the question of equivalents be determined at the filing date of the application but that, after a lengthy discussion, had come to a compromise to which his Delegation could now subscribe.

1663.1 The CHAIRMAN observed that the large number of proposals discussed had meant that each of them had been supported only by a very small number of other delegations and that the delegations that had not been able to support those proposals had practically all reverted to the basic proposal. He concluded that the continuing discussion on paragraph (2) of Article 21 in the second part of the Conference would be based on the basic proposal and that the Secretariat would be required to reflect on a certain number of suggestions that had been made. He briefly reviewed them.

1663.2 There was firstly the suggestion to add in subparagraph (a) the greater part of the text of the proposals by the Delegations of France and Japan, whilst maintaining after that the wording of subparagraph (a) of the basic proposal.

1663.3 Then there was the suggestion to add to subparagraph (b)(ii) the word "substantially."

1663.4 There was subsequently the problem of the manner of expressing the reference date. The expression of that date had to be sufficiently flexible to cover also the very beginnings of an alleged infringement, including its preparation.

1663.5 Finally, there was a problem of deciding whether it was advisable to insert the contents of subparagraphs (b) and (c) in a new Rule that would be drafted for that purpose.

1664. Mr. BOGSCH (Director General of WIPO) thought it would be better to maintain in the Treaty the contents of subparagraphs (b) and (c). However, if there were to be a two-thirds majority for transferring those subparagraphs (b) and (c) to a Rule, his view was that the Rule should be amendable only by unanimity.

1665. The CHAIRMAN then gave the floor to the Delegation of the United States of America to make a general statement.

General Statement

1666.1 Mr. MANBECK (United States of America) thanked the Chairman and the delegations for the opportunity to speak at that time. He asked for everyone's forbearance for he wished he could have made the statement closer to the end of the Conference but had to speak now, if at all, since he had to return to the United States the following day.

1666.2 He expressed the hope that all present understood and believed that the United States would like to see the development of a successful harmonization treaty which would simplify and expedite the obtaining of patent protection around the world and strengthen the protection once granted. During the series of meetings of the Committee of Experts that preceded the Diplomatic Conference, a draft treaty evolved that required changes in the laws of all countries in the interests of harmonization, yet allowed countries to optionally maintain certain aspects of their existing national or regional patent laws. The United States was being asked to make a number of changes in its laws. The changes included, apart from first-to-file, mandatory publication of applications, a patent term measured from the filing date, the right to prevent importation of patented products, elimination of the Hilmer rule concerning the effective date of foreign-origin United States patents, to mention a few. It was that draft treaty that had been considered by the various interest groups in the United States and supported by some and objected to by others. Some of the support had been conditioned on the inclusion of certain features, as had been heard from some United States interest groups, and some of the objections were limited to certain provisions, namely, of course, first-to-file.

1666.3 What now faced the United States negotiators during the interval between the sessions of the Diplomatic Conference was the task of convincing its various interest groups and the United States Congress that the present package was still of overall benefit to the United States' interests. That would be difficult to do because the text that had evolved during the first session of the Diplomatic Conference represented a shift away from United States interests.

1666.4 He stated that his Delegation understood the disappointment of many participants regarding its request to amend Article 9 in order to maximize its chances of participation in the final version of the treaty. It had heard them and understood that they wanted it to reconsider its position and to seek a consensus that would allow it to move to a first-to-file system. He hoped they would understand when he told them that, based on the direction of negotiations during those past three weeks, the interested circles in the United States might never get to the point of approving first-to-file because they might well lose interest and enthusiasm while evaluating the many changes the Treaty would presently require in the law of the United States of America, coupled with the loss of the strengthening improvements sought by the Delegation of the United States of America in the basic proposal. If the United States had to make major changes in its law, and obtain no improvements in the laws of others, it was not realistic to think that a treaty along such lines could be approved in the United States.

1666.5 He turned then to some of the specific problems that had been created for the United States at the Conference. First, it would be particularly difficult for its various interest groups to understand and agree to a provision in the treaty which would require the United States to consider oral disclosures anywhere in the world as prior art. He did not believe his Delegation could explain satisfactorily to its Congress that it would be required to issue patents on inventions which differed only in obvious details from the disclosures contained in earlier-filed United States patent applications--imposing confusion on the U.S. public in the name of reducing so-called secret prior art. It would be precluded from its present practice of always including the inventor's name on patent documents. It would be required to accept changes in its claim practice regarding multiple dependent claims even though no one at the Conference could cite a compelling example of the need to have that type of practice.

1666.6 Not only was the United States being asked to make those changes to its law, but it was now facing the possibility that a number of improvements it had sought in the protection of inventions in other countries would not be realized. One of the major improvements it thought the Treaty would provide was an effective Article regarding the time limits for promptly completing examination. Although that Article had not been deleted, it noted that a majority of the government delegations present spoke against it. Without some discipline on time limits, there would be no guarantee in the Treaty of obtaining a meaningful term of patent protection. Likewise, the requirement to provide applicants with the ability to file by referring to earlier applications had been made optional. Its interested circles would not like that. The elimination of self-collision seemed not to be achievable based on the discussion on that topic. His Delegation simply did not understand why. Prior user rights were also a difficult subject, new to it, and as to which it trusted a suitable compromise would be achieved.

1666.7 It was his hope that in the interval between the sessions careful consideration would be given to accommodating the interests of all countries, and particularly those of the United States, so that a significant number of countries, such as his, that would be required to make fundamental changes to their laws would have sufficient reasons to conclude that, overall, the Treaty was beneficial and warranted adherence. His Delegation would work to satisfy the needs of other delegations and hoped that it could do so, but it would certainly not be successful unless others could likewise agree to satisfy its needs.

1667. The CHAIRMAN adjourned the meeting.

Twentieth Meeting
Thursday, June 20, 1991
Morning

1668. The CHAIRMAN opened the meeting and gave the floor to the Delegation of Czechoslovakia to make a general statement.

General Statement

1669.1 Mr. JAKL (Czechoslovakia) drew attention to the fact that that day his country became a party to the Patent Cooperation Treaty (PCT) and stated that the accession took effect in the context of important changes that had occurred in his country after 1989 that had brought about a progressive restoration of a market economy.

1669.2 In that framework, his country had been preparing a complete revision of the patent system in order to encourage inventiveness, to facilitate and secure the transfer of foreign technology and to harmonize the national patent system with the European Patent Convention and developments in other parts of the world. As a first and major step in that direction, he mentioned the new law concerning protection of inventions and industrial designs which had entered into force in January 1991. That new law envisaged a better system of industrial property protection and provided for publication of patent applications after a period of 18 months, substantive examination, a patent term for 20 years and the patentability of chemical and pharmaceutical products. He added that, as from July 1991, a new law on patent attorneys would enter into force and that the Patent Office had submitted for the consideration of the Government and the Parliament proposals of new laws on integrated circuits and on utility models. He expected that the first one would enter into force by January 1992, and the second one by July 1992.

1669.3 He expressed his satisfaction because all those changes were facilitated by international cooperation with the World Intellectual Property Organization, the European Communities, the Government of the United States of America and with other countries of the world. He expressed his gratitude personally to the Director General, Mr. Arpad Bogoch, and his staff, the European Communities, the European Patent Office and all countries and patent offices cooperating with his country.

1670. Mr. BOGSCH (Director General of WIPO), on behalf of the International Bureau, congratulated the Delegation of Czechoslovakia on both the revision of the Patent Law at the domestic level, and the accession to the Patent Cooperation Treaty (PCT) at the international level. He recalled that, from that day, all Central European States were parties to the PCT.

1671.1 The CHAIRMAN expressed the congratulations of all Contracting States of the PCT to the Delegation of Czechoslovakia. He then turned to Article 21.

Article 21: Extent of Protection and Interpretation of Claims (continued from paragraph 1664)

Article 21(3): [Prior Statements]

1671.2 He invited the Committee to consider paragraph (3) of Article 21, in respect of which there were two proposals, one in document PLT/DC/61, by the Delegation of the United States of America, and the other in document PLT/DC/63, by the Delegation of France.

1672. Mr. KIRK (United States of America) stated that paragraph (3) of Article 21 provided that, in the interpretation of a claim, due account must be taken of any statements limiting the scope of the claims made by the applicant or the owner of the patent during procedures concerning the grant or the validity of the patent. He expressed the support of his Delegation for that provision since it was thought that a patent owner should be consistent in his or her claims. He noted, however, that there was nothing in that provision that required that, when determining the extent of protection of a patent, the changes made in the claims in response to the citation of prior art during the examination process be taken into account. It was the view of his Delegation that patent owners should not be allowed to argue, under the doctrine of equivalents, in a manner which would be inconsistent with the changes made in a claim in response to citations of prior art. That was the reason why his Delegation proposed to supplement paragraph (3) with a mandatory provision stating that changes made in the claims in response to the citation of prior art should be taken into account when determining the extent of protection.

1673. Mr. GUERRINI (France) stated that the first aim of the proposal by his Delegation in document PLT/DC/63 was simply to render optional, and not compulsory as in the basic proposal, the possibility of taking into account statements that might have been made by the applicant during the patent granting procedure and which limited the scope of protection. The purpose of the second amendment proposed by his Delegation, and the most important in his view, was to specify that the statement was of a non-equivocal nature; there would be no problem therefore of interpreting the presumed will of the holder of the right, of the applicant or of the patentee.

1674. The CHAIRMAN asked whether any delegations wished to support the proposals by the Delegation of the United States of America and by the Delegation of France.

1675. Mr. SCHAEFERS (Germany) expressed the support of his Delegation for the proposal of the Delegation of France.

1676. Mr. BULGAR (Romania) expressed the support of his Delegation for the proposal of the Delegation of France.

1677. Mr. SCHACHTER (Israel) expressed the support of his Delegation for the proposal of the Delegation of the United States of America.

1678. The CHAIRMAN observed that, leaving aside the question whether the provision under discussion should be optional, as envisaged in the proposal by the Delegation of France, or mandatory, as envisaged in the proposal by the Delegation of the United States of America, it could be possible to combine both proposals.

1679. Mr. GARIEPY (Canada) observed that his Delegation would support the combination of both proposals since, in his view, it was possible to provide for the addition proposed by the Delegation of the United States of America and, at the same time, introduce the notion of lack of ambiguity proposed by the Delegation of France.

1680. Mr. MESSERLI (Switzerland) expressed the support of his Delegation for the approach suggested by the Delegation of Canada.

1681. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for the approach suggested by the Delegation of Canada. He underlined that in the view of his Delegation the provision contained in paragraph (3) should be mandatory for Contracting Parties.

1682. Mr. NEERVOORT (Netherlands) expressed the support of his Delegation for a mandatory approach in paragraph (3). He also stated that his Delegation supported the proposal by the Delegation of the United States of America on the understanding that the changes referred to in that proposal were those reducing the scope of the claims.

1683. The CHAIRMAN stated that there seemed to be support for the proposal by the United States of America and for the proposal by the Delegation of France in respect of the addition of the word "unequivocally." He also stated that there was support for a mandatory provision. As concerns the understanding expressed by the Delegation of the Netherlands, he stated that it was obvious that the changes referred to in the proposal by the Delegation of the United States of America would have to be changes that reduced the scope of the claims.

1684. Mr. CLARK (ABA) stated that his Organization was concerned by the proposal of the Delegation of France, at least as far as the insertion of the word "unequivocally" was concerned. He stated that it would be extremely difficult to arrive at a single definition of that word, even within the United States of America. He requested clarification from the Delegation of the United States of America as to where the citation of prior art referred to in its proposal should come from.

1685.1 Mr. KIRK (United States of America) stated that it was not relevant, in the context of his Delegation's proposal, who made the citation of prior art. However, it was important that the citation should have been considered relevant by the Office.

1685.2 As concerns the proposal by the Delegation of France, he expressed the concern of his Delegation for the insertion of the term "unequivocally" in paragraph (3), because it would unduly reduce the scope of the limitation provided for in paragraph (3). In the view of his Delegation there were many statements that limited the scope of the claims and that could be relevant but, at the same time, could not qualify as "unequivocal" statements limiting the scope of the claims made by the applicant or the owner of the patent during procedures concerning the grant or the validity of the patent.

1686. Mr. UEMURA (Japan) expressed the support of his Delegation for the text of the basic proposal. However, his Delegation could also support the proposal of the Delegation of France if such were the wish of the Committee. As far as the proposal by the Delegation of the United States of America was concerned, he recalled that, in accordance with paragraph (1), the extent of the protection conferred by the patent was to be determined by the claims, therefore it would be unnecessary to include in paragraph (3) a reference to changes made in the claims during the examination process. It would be only natural that the courts would take those changes into account when interpreting the claims. He drew attention to the fact that the reference in the proposal by the Delegation of the United States of America to the citation of prior art, and only to the citation of prior art, could be interpreted, a contrario, as an exclusion of any other change that could be relevant in the interpretation of a claim. In order to avoid such an a contrario interpretation, he suggested adding the words "in particular" before the reference to the citation of prior art.

1687.1 Mr. BARDEHLE (Germany) stated that, in the view of his Delegation and in accordance with the basic proposal, the changes made in the claims in response to a citation of prior art would have to be taken into account in any case when determining the extent of protection and, therefore, the proposal by the Delegation of the United States of America was superfluous. In that regard, he agreed with the Delegation of Japan.

1687.2 He drew attention to the fact that many changes occurred during the procedures leading to the granting of a patent and, if all those changes were to be taken into account, as was envisaged in the proposal by the Delegation of the United States of America, litigation could become extremely complex and the said provision would give rise to undue delays in judicial procedures. He reiterated the support of his Delegation for the proposal by the Delegation of France in its totality.

1688. Mr. GUERRINI (France) said that his Delegation shared the view expressed by the Delegations of Japan and of Germany. It seemed to him that two types of situation existed. There was a situation in which the claim itself was affected by the amendments made during the procedure. In such case, the claim could be assessed by reference to the preceding claims. There was a different situation--which could interest the United States by reason of its estoppel procedure--in which, in the presence of a given claim, it would be possible to have recourse to elements extraneous to the claim which could have been introduced during the administrative or judicial procedures and which would be taken into account in interpreting the claim and in limiting its literal scope. Those two situations were quite different. In the first case, there was no problem. The second case, on the other hand, raised numerous difficulties since recourse to extraneous elements in order to interpret the claims could lead to negative results, particularly for the

patentee. Therefore, and as foreseen in the proposal by his Delegation, he preferred to leave that matter to the domestic law of each Contracting Party. He repeated that any statement used in opposition to the holder of the right had to be unequivocal.

1689. The CHAIRMAN, in summarizing the discussion, stated that he could envisage that a text combining the proposal by the Delegation of France and the proposal by the Delegation of the United States of America would have two elements. First, the Courts would have to take into account the changes introduced in the claims during the procedure leading to the granting of patent, it being understood that those changes would have to refer to limitations in the scope of the claims. Secondly, other elements in the file would have to be taken into account to the extent that they were unequivocal, it being understood that the term "unequivocal" did not mean "explicit."

1690. Mr. HATOUM (Lebanon) expressed the support of his Delegation for the proposal of the United States of America, for the reasons mentioned by the Delegation of the United Kingdom. His Delegation was not in a position to support the proposal by the Delegation of France because of the problems that its adoption and implementation would give rise to.

1691. Mr. SUGDEN (United Kingdom) stated that it was no secret that interested circles were concerned by the lengthy estoppel procedure that occurred in the United States of America. For that reason, his Delegation was interested in avoiding situations giving rise to unduly lengthy procedures. His Delegation was very much attached to the insertion of the word "unequivocally," as proposed by the Delegation of France, or of an equivalent word. He suggested that, in order to meet some of the concerns expressed during the discussions, the term "unequivocally" be replaced by "unambiguously."

1692. Mr. VON ARNOLD (Sweden) expressed the support of his Delegation for the text of the basic proposal. He added that the debate had not persuaded his Delegation of the need to amend Article 21(3) of the basic proposal.

1693. Mr. BETON (UNICE) expressed the support of his Organization for the mandatory approach to paragraph (3). An optional approach could give rise to a variety of systems of interpretation, a situation that was to be avoided. He added that the interpretation should be limited to the text of the claims and any kind of subjective elements should be avoided, as well as any interpretation which would require the public to take into account elements other than those contained in the patent. His Organization was in favor of the proposal by the Delegation of France to insert the word "unequivocally" in order to qualify the statements referred to in paragraph (3).

1694. Mr. MITCHELL (PTIC) expressed the concern of his Organization at the proposal by the United States of America, since it involved a cross border definition that would require national courts to take into account changes to claims that were introduced in a foreign jurisdiction.

1695. Mr. PAGENBERG (MPI) expressed the support of his Organization for the proposal by the Delegation of the United States of America, he stated that it would facilitate a uniform interpretation of the claims. He expressed the support of his Delegation to the proposal by the Delegation of France to insert in paragraph (3) the word "unequivocally" so as to ensure a more uniform and consistent interpretation of the claims.

1696. Mr. MELLER (NYPTC) expressed the support of his Delegation for the text of the basic proposal as supplemented by the proposal of the Delegation of the United States of America. He stated that his Organization could not support the proposal by the Delegation of France to insert the word "unequivocally" in paragraph (3) since it would give rise to tremendous differences in interpretation and to legal uncertainty and unpredictability.

1697. Mr. SANTARELLI (AIPPI) stated that his Organization would prefer a mandatory approach to paragraph (3) and expressed the support of his Organization for the proposal by the United States of America. However, he stated that he understood the concerns of the Delegations of Germany, France and other countries and, for that reason, his Organization supported the insertion of the word "unequivocally" in paragraph (3).

1698. Mr. BEIER (FICPI and FCPA) drew attention to the case of those inventors that filed an application by themselves without legal assistance. He was of the view that in such cases the addition of the "unequivocal" condition in paragraph (3) would serve the purpose of excluding from the scope of paragraph (3) those changes that were the result of the lack of legal expertise of the applicant. He added that the Organizations he represented were concerned with the cross border effects of the amendments proposed by the Delegation of the United States of America.

1698. Mr. BOGSCH (Director General of WIPO) appealed to the delegations to approach the issues under discussion in a spirit of negotiation with a view to reaching compromise solutions.

1699. Mr. SCHAEFERS (Germany) stated that the priorities of his Delegations were the following: first, his Delegation was in favor of the proposal by the Delegation of France, but it could also support the basic proposal as envisaged in document PLT/DC/3; secondly, his Delegation could support the proposal of the Delegation of Canada to combine the proposal by the Delegation of France and the proposal by the Delegation of the United States of America, provided that certain clarifications were introduced both in the text of paragraph (3) itself as well as in the explanatory notes. In that connection, he suggested adding, after the words "citation of prior art," the words "and appearing in the final version of the claim or claims"; he also suggested that, in order to meet the concerns expressed by the Delegation of France, the terms "during substantive examination, revocation or similar proceedings" be added after the words "citation of prior art."

1700. Mr. KIRK (United States of America) stated that, in the spirit of negotiations referred to by the Director General, his Delegation considered that the replacement of the term "unequivocally" as proposed by the Delegation of France by the term "unambiguously" would be an improvement and would avoid the harsher consequences of the first of those terms.

1701. The CHAIRMAN, in summing up the discussions, stated that the provisions of paragraph (3) which would be the basis for further discussion should contain the following elements. First, paragraph (3) should be a mandatory provision and not an optional one. Secondly, the nature of the statement referred to in paragraph (3) should be specified by adding a term which would qualify the type of statements that could be taken into account in determining the extent of protection in accordance with that paragraph. He recalled that two terms had been considered during the discussions, namely "unequivocally"

and "unambiguously." In any case, the statement should be clearly recognizable as constituting a limitation. Thirdly, the basic proposal should be supplemented with the essence of the proposal by the Delegation of the United States of America, provided that the changes referred to in that proposal were changes that appeared in the final version of the claim or claims and that the changes were the result of the citation of prior art which was taken into account during procedures concerning the grant or the validity of the patent. Finally, it should be understood that the patent referred to at the end of paragraph (3) in the basic proposal was the very patent whose extent of protection was under consideration and any other patent such as a patent of the same family.

1702. Mr. GUERRINI (France) asked why it was necessary to add the wording proposed by the Delegation of the United States of America if, in fact, the scope of protection had to be determined in relation to the final claims and not in relation to the draft of successive claims. If the proposal by the United States of America concerned the interpretation of a current claim and if its aim was to avoid a literal interpretation of that claim, it would then be necessary to draft the proposal somewhat differently.

1703. The CHAIRMAN stated that, in accordance with the intended provision, it would not be possible for a patent owner to argue, under the doctrine of equivalents, that a claim could cover the very same point that was removed by the applicant, during the procedures for the granting of the patent, in order to limit the scope of the claim.

1704. Mr. UEMURA (Japan) stated that his Delegation supported the summary made by the Chairman. However, he recalled that his Delegation had stated its concerns concerning an a contrario interpretation. He was not, however, insisting in having in the text of paragraph (3) the words he suggested in his previous intervention. He suggested that the explanatory notes should make it clear that changes other than those mentioned in paragraph (3) might be taken into account if those changes were relevant.

Article 21(4): [Examples]

Article 21(5): [Abstract]

1705.1 The CHAIRMAN stated that, since there were no proposals, nor comments, on paragraphs (4) and (5) of Article 17, the text of those provisions in the basic proposal would constitute the basis for further discussion. He then turned to Article 23.

Article 23: Enforcement of Rights

1705.2 He recalled that there were three proposals in respect of Article 23, the first by the Delegation of the Netherlands, contained in document PLT/DC/15, the second by the Delegation of the United States of America, contained in document PLT/DC/62, and the third by the Delegation of Germany, contained in document PLT/DC/67. He invited the Committee to examine first the proposals for amendments concerning paragraph (1) of Article 23 submitted the Delegations of the Netherlands and the United States of America.

Article 23(1): [Enforcement Based on Patents]

1706. Mr. NEERVOORT (Netherlands) stated that the proposal of his Delegation concerned paragraph (1)(ii) of Article 23 which established the right to obtain damages from any person who performed certain acts where the said person was or should have been aware of the patent. He added that that Article went too far in establishing a presumption of awareness. The national legislation of his country required positive awareness and, for that reason, his Delegation proposed that the definition of liability be left to the national law of each Contracting Party. Such a definition, in his view, was a matter to be dealt with by civil law rather than by patent law. The idea behind his Delegation's proposal was to leave to each Contracting Party the competence to define the conditions under which a person was or should be considered aware of the patent.

1707.1 Mr. KIRK (United States of America) stated that, as far as paragraph (1)(ii) was concerned, the proposal of his Delegation had the same objective as the proposal of the Netherlands. In his view the notion of knowledge should be left to the national legislation of each Contracting Party. For that reason his Delegation proposed deleting the last part of the subparagraph (1)(ii) and replacing it by a new sentence establishing the right of every Contracting Party to require, in accordance with its national law, notice of the patent as a condition to obtaining damages.

1707.2 He stated that the proposal of his Delegation envisaged also the addition to paragraph (1) of Article 23 of new subparagraph (b), which would allow Contracting Parties to determine liability for products directly resulting from the use of a patented process where the products were in possession or transit prior to becoming aware of the patent. He stated that there were provisions in the national legislation of his country, which represented a sensitive compromise, dealing with the extension of a process patent to the resulting product. Under those relevant provisions, an innocent party in possession of a product resulting from the unauthorized use of the patented process was allowed to dispose of any product which was in his possession or which had been put in transit before the receipt of notice. He drew attention to the fact that the amendment of those provisions of the national legislation would be exceedingly difficult and that was the reason why his Delegation had made the proposal to supplement paragraph (1) with a new subparagraph (b).

1707.3 As concerns the new subparagraph (c), proposed by his Delegation, he stated that it was his Delegation's belief that whenever an invention was used or manufactured by or for a Contracting Party for public non-commercial purposes, that Contracting Party must not be subject to an injunction. He added that, of course, Contracting Parties would be liable for damages as any person responsible for the infringement of patents. He added that the terms "public non-commercial purposes" might not be very crisp, nonetheless, he underlined that what his Delegation had in mind, was the exercise of appropriate government functions, such as national defense.

1708. The CHAIRMAN invited the Committee to consider paragraph (1)(ii) and asked whether any Delegation wished to support any of the amendments concerning that provision.

1709. Mr. NEERVOORT (Netherlands) stated that, since the proposal by the Delegation of the United States of America, in as far as subparagraph (1)(ii) was concerned, met the concerns behind the proposal by his Delegation, his Delegation supported the proposal by the Delegation of the United States of America.

1710. The CHAIRMAN requested clarification from the Delegation of the United States of America as to the nature of the notice which was required under subparagraph (ii) of paragraph (1). He wondered, for example, whether the bibliographic data of the patent or the whole text of the patent would have to be communicated.

1711. Mr. KIRK (United States of America) stated that the nature of the awareness could be different according to different national legislation. In some cases, actual knowledge was required, while in others constructive knowledge was considered sufficient. The proposal of his country was aimed at leaving that matter, as well as the details concerning the notice, to be regulated by the national legislation of each Contracting Party.

1712. Mr. SCHAEFERS (Germany) stated that his Delegation could support the text of the basic proposal. However, his Delegation understood the concerns expressed by the Delegation of the Netherlands as well as those of the United States of America. In the spirit of compromise referred to by the Director General, his Delegation suggested considering the possibility of combining the text of the basic proposal with the addition proposed by the Delegation of the United States of America in such way that the subjective element necessary to obtain damages could be specified by the national law of each Contracting Party.

1713. Mr. COHN (Israel) stated that his Delegation could support the text of the basic proposal. In accordance with the national law of this country, knowledge of patent was presumed. Consequently he could support the deletion of the phrase "where the said person was or should have been aware of the patent" from the basic proposal and he could support also the amendment by the Delegation of the United States of America.

1714. Mr. TALUKDAR (Bangladesh) expressed the support of his Delegation for the proposal by the Delegation of the United States of America and suggested to make it mandatory so that the notice would be a necessary condition for obtaining damages.

1715.1 Mr. UEMURA (Japan) stated that his Delegation could support the text of the basic proposal. As concerns the proposal of the United States of America, he stated that the deletion of the last part of paragraph (2), as envisaged in the basic proposal, and the insertion of a new sentence allowing Contracting Parties to require notice, could give rise to an a contrario interpretation according to which a Contracting Party could not provide for any requirement other than the notice specified in paragraph (2). He mentioned that some other requirements could be fundamental, such as the requirement of negligence by the third party. He considered that the proposal by the Delegation of the United States of America was not user friendly, since it might be the case that a significant damage took place before the notice and, in accordance with the proposal of that Delegation, it would be impossible for the patent holder to obtain compensation for that damage.

1715.2 As regards the proposal by the Delegation of Germany to combine the basic proposal with the proposal by the Delegation of the United States of America, he stated that his Delegation saw in that combination a possible compromise solution.

1716. Mr. KAMEL (Egypt) expressed the support of his Delegation for paragraph (1) of Article 23 in the basic proposal. He stated that both the contents of subparagraph (i) as well as of subparagraph (ii) were consistent with the national legislation in force in his country.

1717. Mr. LOSSIUS (Norway) stated that his Delegation could support the text in the basic proposal. However, in the spirit of compromise referred to by the Director General, he expressed the support of his Delegation for the compromise solution suggested by the Delegation of Germany of combining the basic proposal with the proposal by the Delegation of the United States of America.

1718. Mr. CLARK (ABA) expressed the support of his Organization for the proposal by the Delegation of the United States of America.

1719. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for the text of the basic proposal. However, in the spirit of compromise referred to by the Director General, his Delegation could also support the text of the basic proposal supplemented by the additional sentence proposed by the Delegation of the United States of America, provided that the notion of awareness was not deleted.

1720. Mr. HATOUM (Lebanon) expressed the full support of his Delegation for the proposal and the ideas put forward by the Delegation of the United States of America with respect of subparagraphs (i) and (ii). As concerns subparagraph (h) of the proposal by the Delegation of the United States of America, he stated that his Delegation could not support the inclusion of that new subparagraph. As concerns subparagraph (c) proposed by the Delegation of the United States of America, he expressed the support of this Delegation for the insertion of such a paragraph because it was consistent with what was provided in the national legislation of his country.

1721. Mr. KIRK (United States of America) stated that his Delegation could not agree with that part of subparagraph (ii) that stated that the infringer should have been aware of the patent. The aim of his Delegation was not to tell other Contracting Parties how they should legislate on the matter but to leave each Contracting Party the freedom to require either actual knowledge or constructive knowledge. In order to achieve that aim, other possible solutions could be found and his Delegation was open to discuss such new approaches. For instance, he suggested to retain part of paragraph (ii) but with the addition of the words "at least" so it would read as follows "at least where the said person was aware of the patent."

1722. Mr. WIERZBICKI (New Zealand) stated that his Delegation was prepared to support the compromise solution suggested by the Delegation of Germany consisting of the combination of the proposal by the United States of America and the basic proposal. He also expressed the preliminary support of his Delegation for the latest oral proposal by the Delegation of the United States of America.

1723. Mr. LOSSIUS (Norway) expressed the support of his Delegation for the oral proposal made by the Delegation of the United States of America.

1724. Mr. DIENG (Senegal) expressed the support of his Delegation for the text of the basic proposal, which he noted was consistent with the national legislation of his country.

1725. Mr. SCHAEFERS (Germany) stated that his Delegation was not convinced that it was not possible to combine the text of the basic proposal with the text of the proposal by the Delegation of the United States of America. He suggested the following drafting for the last part of (ii): "at least in the case where the said party was aware of the patent. A Contracting Party shall be free to require notice of the patent as a condition to obtaining damages."

1726. Mr. NEERVOORT (Netherlands) stated that the addition of the proposal by the Delegation of the United States of America to the basic proposal would in fact be tantamount to an overruling of the text of the provision of the basic proposal. He suggested to insert the word "However," before the addition of the sentence proposed by the Delegation of the United States of America.

1727. Mr. UEMURA (Japan) stated that his Delegation could not support the oral proposal of the Delegation of the United States of America because the addition of the word "at least" would, in fact, make the text of that provision tantamount to the one suggested by the Delegation of the Netherlands, which meant that any Contracting Parties could impose other conditions that might be detrimental to the right of the patent holder to obtain adequate damages.

1728.1 The CHAIRMAN pointed out that there was a first proposal to add the sentence proposed by the Delegation of the United States to the end of item (ii) of the basic proposal without deleting the passage suppressed in document PLT/DC/62.

1728.2 There was also a proposal stressing the exceptional nature of the sentence proposed for addition by the Delegation of the United States. It could read "however, a Contracting Party may require that ..." or "a Contracting Party shall be free to require that ...". The basic proposal read "where the said person was or should have been aware ..." If that "or" was interpreted as meaning that in an actual case the condition was that the person was aware or should have been aware of the patent, an exception had to be created and "however ..." added. On the other hand, if it was considered that the word "or" gave the Contracting Parties the freedom to chose between two alternatives, it could be held that the added sentence gave additional precision to one of the two alternatives.

1728.3 As for the proposal to say "at least where the said person was or should have been aware of a patent," he thought that it fitted well in the general context of the Article which, in the introduction, said "the owner of the patent shall have at least the right..." and which consequently, endeavored to define the minimum rights of the patentee. It was obvious that the Contracting Parties could go further and could say that the owner had the right to damages, not only where a third party was aware, but also where he should have been aware of the patent and, possibly even, where publication of the patent was held to constitute knowledge of the contents of the patent for everyone.

1729. Mr. KIRK (United States of America) stated that his Delegation agreed with the Chairman that the addition of the words "at least" would ensure that at the very minimum the party involved should have knowledge. Contracting parties were of course free to go beyond that minimum condition, for instance, by requiring only constructive knowledge as a condition to obtain damages.

1730. Mr. SCHAEFERS (Germany) stated that his Delegation did not share the view point of the Delegation of the United States of America as concerns the consequences of the introduction of the words "at least" in item (ii). In the view of his Delegation, the words "at least" in item (ii) would mean that any Contracting Party could go beyond requiring awareness in the sense that damages might also be granted in cases where the infringer was innocent, negligent or grossly negligent. He recalled that, as mentioned in his first statement, his Delegation could support the text envisaged in the basic proposal since what was required in the national legislation of his country was a subjective element involving guilt.

1731. Mr. KIRK (United States of America), in referring to the statement by the Delegation of Germany, stated that there were two different interpretations of the insertion of the words "at least" and he underlined that it was not the intention of his Delegation to hold liable an innocent person. However, his Delegation was of the view that that question could be dealt with appropriately in the notes. He reiterated that what his Delegation wanted to avoid was a rule according to which all Contracting Parties would have to provide for damages in cases involving only constructive knowledge of the patent.

1732.1 Mr. TALUKDAR (Bangladesh) stated that, in view of the links between Article 19 and Article 23, everything that could be agreed upon in connection with Article 23 would be contingent on a subsequent agreement on Article 19.

1732.2 As far as paragraph (1)(ii) was concerned, he stated that that provision dealt with one side of the problem, but ignored the other side of the problem, the case of the innocent infringer. In this connection, his Delegation wished to make a formal proposal for a new item (iii) which would read as follows: "(iii) Contracting States shall provide that a patent holder shall not be entitled to any damage, in respect of any infringement of the patent, from any defendant who proves that at the date of the infringement he or she was not aware, nor had the reasonable means to be aware, of the existence of the patent."

1733. The CHAIRMAN, in response to the statement of the Delegation of Bangladesh, stated that it was understood that the discussions on Article 23 were linked to the outcome of the discussions on Article 19.

1734. Mr. SUGDEN (United Kingdom) stated that his Delegation viewed the proposal made by the Delegation of Bangladesh very positively because it could be useful to have a negatively drafted provision safeguarding the situation of an innocent party.

1735. Mr. UEMURA (Japan) stated that it was difficult to follow the discussions with so many oral proposals. He requested to have those proposals in a written form.

1736. Mr. WIERZBICKI (New Zealand) drew the attention of the Committee to the difficulty caused by Article 23 since it involved subjective issues. In addition, in the tradition of the common-law system, the matter under discussion was one of those that was suitable for a case-by-case determination concerning the "awareness" element. He also expressed the interest of his Delegation in the idea put forward by the Delegation of the United Kingdom to deal with the matter through negative drafting.

1737. Mr. GARIEPY (Canada) wondered whether it would be possible, in subparagraph (1)(ii) in the proposal by the Delegation of the United States of America, to delete the word "notice" and replace it by the word "advice."

1738. Mr. ZAVAREIE (Islamic Republic of Iran) expressed the support of his Delegation for the oral proposal by the Delegation of Bangladesh.

1739. The CHAIRMAN announced that a meeting of the Main Committee II would be held and adjourned the meeting.

Twenty-First Meeting
Friday, June 21, 1991
Morning

Article 23(1): [Enforcement Based on Patents] (continued from paragraph 1739)

1740.1 The CHAIRMAN opened the meeting and thanked the Government and the Delegation of the Netherlands for the magnificent reception the preceding evening which had been perfect in all respects and which constituted the culminating event of the Conference. (The delegations showed their appreciation by applause.)

1740.2 He recalled that it remained for the Main Committee to complete examination of Article 23 and to examine Articles 1 and 2.

1740.3 With respect to Article 23, he recalled that the Committee had examined paragraph (1)(ii) on the preceding day and that there had been two proposals, one by the Delegation of the Netherlands, contained in document PLT/DC/15, and one by the Delegation of the United States, contained in document PLT/DC/62. There had also been a series of oral proposals, particularly a suggestion to replace the final part of item (ii) by the words "at least in the case where the said party was aware of the patent."

1741. Mr. SCHAEFERS (Germany) stated that it was the understanding of his Delegation that the discussions of the previous evening had produced agreement that the remedy of damages must be available whenever the alleged infringer was aware or had actual notice of the patent. A clear understanding had also been reached that any Contracting Party should be free to require written notice of the patent as a condition to obtaining damages. He suggested that

the agreement and understanding which his Delegation believed had been reached could be reflected in the addition of the words "at least" at the commencement of the last clause of paragraph (1)(ii).

1742. The CHAIRMAN asked delegations whether they went along with the summary made by the Delegation of Germany.

1743. Mr. UEMURA (Japan) stated that, while his Delegation did not object to the summary that had been given by the Delegation of Germany, it was concerned that it might produce too much open-endedness in the formulation of paragraph (1)(ii). His Delegation therefore wished to reserve its position for the time being.

1744. Mr. SUGDEN (United Kingdom) stated that his Delegation wished to add to the summary that had been given by the Delegation of Germany the substance of the proposal made by the Delegation of Bangladesh in document PLT/DC/68. That proposal expressed a position with which his Delegation agreed, namely, that any person who was able to prove that he did not know and had no reason to know of the existence of a patent should not be liable to damages.

1745. Mr. BOGSCH (Director General of WIPO) asked what the relationship would be between item (ii) and new item (iii) proposed by the Delegation of Bangladesh. He also asked whether the Delegation of Germany could clarify the language which it proposed for item (ii) of paragraph (1).

1746.1 Mr. SCHAEFERS (Germany) suggested that the words "where the said person was or should have been aware of the patent" in item (ii) of paragraph (1) be replaced by the words "at least in the case where the said person was aware or had actual knowledge of the patent" and that the following sentence be added: "Each Contracting Party shall be free to require that actual knowledge be established by written notice. He indicated that the words "at least" in the new clause suggested by him should be understood as meaning that any Contracting Party would be free to offer damages where the owner could establish constructive knowledge or negligence on the part of the defendant, and he suggested that such explanation be reflected in a note.

1746.2 He added that the proposal of the Delegation of Bangladesh in document PLT/DC/68 seemed to be going in the wrong direction since it was drafted as a negative demarcation line. His Delegation preferred a positive statement of the circumstances in which the owner of a patent was entitled to damages.

1747. Mr. BOGSCH (Director General of WIPO) asked what was the intended relationship between awareness and actual knowledge. He wondered whether it was possible to be aware of something without having actual knowledge of it.

1748. Mr. SCHAEFERS (Germany) stated that he had proposed the use of both the term "awareness" and the expression "actual knowledge" in a spirit of compromise. A formula such as "aware or should have been aware" would be completely satisfactory for his country as a civil-law country. However, he had observed that many common-law countries preferred to use the notion of actual knowledge. The understanding that a Contracting Party could require actual knowledge on the basis of a written notice had been added by him in the same spirit of compromise to accommodate those countries having such a requirement.

1749. Mr. GUERRINI (France) considered that a person acted either with awareness of the patent or without being aware of it, but that there could not be an intermediate case. As for the formulation of a provision concerning the right of a Contracting Party to require notification, he suggested adding the sentence "any Contracting Party may require that such awareness shall result from notification of the patent to the infringer."

1750. Mr. SUGDEN (United Kingdom) observed that the basic proposal required awareness or constructive awareness before damages could be awarded. The addition of the words "at least" proposed by the Delegation of Germany seemed, however, to allow for the possibility of damages being awarded where there was no awareness. His Delegation had understood from the discussions on the previous day that there seemed to be general agreement that a lack of awareness of a patent should constitute a defense to the award of damages.

1751. Mr. BOGSCH (Director General of WIPO) stated that he understood that the Delegation of the United Kingdom approved the notion that the remedy of damages would not be available where the alleged infringer had no reason to know or to believe that a patent existed. The question arose, however, as to what constituted knowledge of the existence of a patent for such purposes. He drew attention to the three ways in which patents were commonly published, the first being through the laying open of the patent for inspection, the second being through the publication in the official gazette of bibliographical data of the patent, together with a notice that the patent was available for inspection, and the third being the publication of printed copies of the patent. He asked which of the three methods would suffice as a basis for establishing that an alleged infringer was aware of the patent.

1752. Mr. SUGDEN (United Kingdom) stated that the domestic law of his country provided that lack of awareness of the existence of a patent constituted a defense to an award of damages. There might be a number of different ways in which that lack of awareness could be proved. His Delegation did not believe that those ways should be specified in the Treaty, but considered it to be important that this form of defense to an award of damages should be recognized.

1753. The CHAIRMAN invited the Delegation of Bangladesh to present its proposal contained in document PLT/DC/68.

1754. Mr. TALUKDAR (Bangladesh) introduced the proposal of his Delegation contained in document PLT/DC/68, stating that it was intended to provide a balance to the provision contained in item (ii) of paragraph (1). He expressed his gratitude for the support given to his proposal by the Delegation of the United Kingdom. Concerning the observation that had been made that the proposal sought to draw a negative demarcation line, he indicated that this was a matter of perspective and that the character of the proposal could be considered either positive or negative depending on one's viewpoint.

1755. Mr. KAMEL (Egypt) expressed the support of his Delegation for the proposal of the Delegation of Bangladesh, considering it to be a balanced one. He also indicated that there seemed to be general agreement that the decision on whether to award damages should be taken by the court.

1756. Mr. UEMURA (Japan) stated that his Delegation saw some merit in the proposal of the Delegation of Bangladesh, but needed to consider it further before expressing any final position.

1757. Mr. SCHAEFERS (Germany) expressed concern that the proposal of the Delegation of Bangladesh would have the effect of placing the burden of proof on the alleged infringer. He recalled that there seemed to be general agreement that awareness or knowledge was a necessary element for an award of damages. However, the requirement foreseen in the proposal of the Delegation of Bangladesh to allow a defendant to prove innocence as a defense seemed to be going against the presumption of innocence.

1758. Mr. VAN HORN (United States of America) stated that his Delegation supported the position that had been outlined by the Delegation of Germany and which required either awareness or actual knowledge before damages had to be awarded. He considered that the proposal of the Delegation of Bangladesh left some question as to the relationship between item (ii) of paragraph (1) and the proposed new item (iii) of that paragraph. In addition, he wondered what meaning should be given to the term "reasonable means" in the proposal of the Delegation of Bangladesh.

1759. Mr. SUGDEN (United Kingdom) observed that the Delegation of Germany had stated that it considered that awareness or actual knowledge should be a prerequisite to an award of damages and that the Delegation of the United States of America seemed to agree with that statement. However, the addition of the words "at least" in the place indicated by the Delegation of Germany, namely, in the proposed final clause reading "at least where the said person was or should have been aware of the patent," indicated that any Contracting Party could go further and award damages even when there was no awareness or actual knowledge.

1760. Mr. SCHAEFERS (Germany) stated that he had sought to indicate that the words "at least" could be interpreted by way of agreed minutes. However, it had become apparent that there was a desire to require the owner of the patent to establish some sort of guilt, for example, negligence or constructive notice. Such requirement should, then, be written in the Treaty.

1761. Mr. TALUKDAR (Bangladesh) considered that harmonization should seek to strike a balance between the interests of three parties, namely, the patent owner, the government and third parties. Item (ii) of paragraph (1) contained a rule defining the circumstances in which the patent owner was entitled to damages. Item (iii) of that paragraph, as proposed by his Delegation, sought to establish a rule on the circumstances in which a third party was entitled to protection from such damages. As to the question that had been raised concerning the meaning of the term "reasonable means," he considered that that expression would be interpreted by the court.

1762. Mr. GUERRINI (France) stated that the Treaty should not go into too much detail since that should be left to domestic legislation. It could suffice for the Treaty to stipulate that damages would be due in the case at least of effective knowledge of the patent.

1763. Mr. SANTARELLI (AIPPI) said that his organization supported the last suggestion made by the Delegation of France.

1764. Mr. HATOUM (Lebanon) stated that the proposal of the Delegation of Bangladesh was closely linked to the provision in Article 24 concerning the reversal of the burden of proof. His Delegation supported the proposal of the Delegation of Bangladesh.

1765. Mr. UEMURA (Japan) stated that he considered it to be undesirable for the Treaty to deal with the details concerning the burden of proof. In his own country, an infringer was presumed to be negligent, that presumption of course being rebuttable. However, his Delegation did not believe that the burden of proof should be dealt with in the present context in the Treaty.

1766. Mr. BOGSCH (Director General of WIPO) suggested that consideration be given to keeping the text of item (ii) in the basic proposal and elaborating on that text, either in the treaty itself or in the explanatory notes, by making it clear that the expression "should have been aware" would be left to the interpretation of each Contracting Party.

1767. Mr. VAN HORN (United States of America) stated that his Delegation found the clause "should have been aware" to be unacceptable because it would include constructive knowledge and would require Contracting Parties to recognize liability for damages on the basis only of constructive knowledge. His Delegation believed that the patent owner also had a responsibility to police the enforcement of his patent. The Treaty should not require liability for damages in any circumstances other than awareness or actual knowledge.

1768. Mr. BOGSCH (Director General of WIPO) asked whether actual knowledge had to result from a notice on the part of the patent owner.

1769. Mr. VAN HORN (United States of America) replied in the affirmative to the question raised by the Director General.

1770. Mr. GALASSO (Italy) stated that his Delegation did not support the proposal of the Delegation of Bangladesh, since that proposal was already included, at least implicitly, in item (ii) of paragraph (1). He indicated that his Delegation also had reservations concerning item (ii) following the discussions which had taken place, since those discussions indicated that the matter was not yet ripe for harmonization. He suggested that references to knowledge or awareness be deleted from item (ii), which would simply contain a basic obligation on the part of Contracting Parties to make available damages according to national law.

1771. Mr. TALUKDAR (Bangladesh) observed that it seemed to be universally recognized that an innocent infringer should not be liable to damages.

1772. Ms. LINCK (AIPLA) observed that there seemed to be two extremes in the positions expressed in relation to item (ii) of paragraph (1). At one extreme was the requirement of written notice before damages would be awarded. At the other extreme was the approach of strict liability, which disregarded the defendant's state of mind. She expressed concern that written notice might be required in all circumstances, since it was possible to have a deliberate knowing infringer who continued to infringe without having received written notice and who should, nevertheless, be liable to damages. While her Organization believed that damages should not be available without a form of knowledge, it also believed that constructive knowledge should satisfy that requirement of knowledge.

1773.1 The CHAIRMAN observed that, when faced with a series of written and oral proposals made in relation to paragraph (1)(ii), the only solution he could see for continuing discussions was to return to the basic proposal and to change it as little as possible since every addition appeared to raise even more problems.

1773.2 He observed that the main problem with the wording of the basic proposal was the interpretation of the word "or" in the third line of paragraph (1)(ii). Most delegations supported an interpretation that would require damages to be available both when there had been effective knowledge and also when there should have been knowledge. However, several delegations were unable to accept the obligation to provide damages in the second case. He therefore suggested a new interpretation of the word "or" according to which it would be for each Contracting Party to choose to provide damages either where the infringer had effective knowledge or where such person should have had knowledge of the existence of a patent. In the latter case, it should be possible to prove the contrary.

1773.3 He concluded that the wording of the basic proposal ought to be maintained as the basis for future discussions, with as few amendments as possible, and that the text be supplemented by explanatory notes.

1774. Mr. SCHAEFERS (Germany) expressed the support of his Delegation for the summary given by the Chairman. He suggested that the question of liability to damages where a person should have been aware of the patent might be expressed in item (ii) on a facultative basis by the words "or, at the option of any Contracting Party, should have been aware."

1775. Mr. BOGSCH (Director General of WIPO) stated that, in his view, liability to damages should exist in circumstances in which awareness was established even by means other than written notice from the patent owner.

1776. The CHAIRMAN observed that the formulation he had proposed in his summary did not prohibit the defense of innocence and therefore did not exclude what was wished by the Delegation of Bangladesh.

1777. Mr. TALUKDAR (Bangladesh) stated that new item (iii) as proposed by his Delegation could be considered to be independent of item (ii) as a means of protecting the innocent infringer.

1778.1 The CHAIRMAN pointed out that it remained possible to submit such a proposal to the second part of the Conference.

1778.2 He invited the Delegation of the United States of America to present its proposal in respect of paragraph (1)(b) and (c) contained in document PLT/DC/62.

1779.1 Mr. VAN HORN (United States of America) stated that paragraph (1)(b) in document PLT/DC/62 was intended to give Contracting Parties the freedom to determine whether or not liability should be imposed in respect of products directly resulting from the use of a patented process where the products were already in possession or had been put in transit prior to the alleged infringer becoming aware of the patent. A provision on that subject-matter had been introduced into the law of his country after lengthy discussion.

1779.2 In relation to the proposed new paragraph (1)(c), he indicated that it would allow a Contracting Party to provide for the Government not to be enjoined where the Government used or manufactured an invention or caused it to be used or manufactured for public, non-commercial purposes, such as defense or space. He emphasized that the proposed exception to the award of an injunction was confined to a very narrow area.

1780. Mr. BOGSCH (Director General of WIPO) suggested that Article 23 might not be the appropriate place in which to treat the subject matter dealt with in the proposal of the Delegation of the United States of America contained in document PLT/DC/62. He observed that paragraph (1)(b) in that proposal would allow a Contracting Party to deny the right of a patent owner in certain circumstances, and that such an exception to the exclusive right of the patent owner should be discussed in connection with Article 19 ("Rights Conferred by the Patent"). In relation to proposed new paragraph (1)(c), he observed that the provision amounted to a compulsory license and therefore should be discussed in connection with Article 26 ("Remedial Measures Under National Legislation"), where compulsory licenses were dealt with. He noted that both Article 19 and Article 26 were within the competence of Main Committee II.

1781.1 The CHAIRMAN observed that without knowing the content of Articles 19 and 26 it was difficult to discuss the new subparagraphs (h) and (c) proposed by the Delegation of the United States of America. Those proposals should therefore be presented again, but in a context which placed them clearly within the competence of Main Committee II.

Article 23(2): [Enforcement Based on Published Applications]

1781.2 He moved on to paragraph (2) of Article 23 and announced that there were two proposals for amendment, one by the Delegation of the United States of America, contained in document PLT/DC/62, and the other by the Delegation of Germany, contained in document PLT/DC/67. He invited the Delegation of the United States of America to present its proposal.

1782.1 Mr. VAN HORN (United States of America) introduced the proposal of his Delegation contained in document PLT/DC/62. He stated that his Delegation could not support the text of the basic proposal for paragraph (2)(c), since that text could require a retroactive scope of protection. His Delegation believed that the text of paragraph (2)(c) in both the basic proposal and the proposal of the Delegation of Germany in document PLT/DC/67 might produce an unintended result. He cited the example of an application which, as published, gave a range for the presence of an ingredient of one to ten percent. In the patent as granted, the ranges of 12 to 15 percent or 8 to 12 percent were cited. Both of the ranges cited in the grant would be narrower in scope than the application as published, but would, nevertheless, on the basis of paragraph (2)(c) in the basic proposal and in the proposal of the Delegation of Germany require that protection be accorded.

1782.2 His Delegation considered that the text of the basic proposal could lead to the danger of very broad omnibus claims being drafted which did not give any fair or sufficient notice of the protection that would result from the grant of patent.

1782.3 His Delegation therefore sought to present a proposal which would achieve a better balance. That proposal was based on a minimum approach which would require that provisional protection be accorded at least to the extent that the claims in the application as published were of substantially the same scope as the claims in the application as granted. Contracting Parties would be free to go further.

1783. The CHAIRMAN invited the Delegation of Germany to present its proposal concerning paragraph (2)(c).

1784. Mr. SCHENNEN (Germany) introduced the proposal of his Delegation contained in document PLT/DC/67. He indicated that the purpose of the proposal was to delete the last sentence of the text of paragraph (2)(c) in the basic proposal. His Delegation believed that, whereas the scope of the patent as granted should retroactively limit the scope of the protection in the application as published, any enlargement or limitation in the scope of protection during the time between the publication of the application and the grant of the patent should not be taken into account. Taking into account such enlargements or limitations would be unduly complicated and would, furthermore, not be compatible with the principle that the scope of protection should be determined by the claims.

1785. The CHAIRMAN summarized the two proposals that had been presented. He explained that the proposal by the Delegation of Germany was to delete the last sentence of paragraph (2)(c), with the effect that account would have to be taken of the claims shown in the published application and those in the patent, but not claims which might have been published in the meantime. The proposal by the Delegation of the United States of America, for its part, resembled an approach already discussed in the Committee of Experts under which provisional protection concerned everything covered by the claims in the published application as also by the claims in the patent.

1786. Mr. BOGSCH (Director General of WIPO) endorsed the formulation given by the Chairman, namely, that provisional protection would apply to the extent that the alleged infringement was covered by both the claims in the application as published and the claims in the patent as granted. He considered that it should meet the concerns of the Delegation of Germany, which was against adjusting the scope of protection during the period between the publication of the application and the grant of the patent and would seem also to cover the concern of the Delegation of the United States of America that the scope of protection should have been clearly indicated in the application as published.

1787. Mr. SUGDEN (United Kingdom) expressed the support of his Delegation for the formulation given by the Chairman and endorsed by the Director General. His Delegation also supported the deletion of the second sentence in the text of paragraph (2)(c) in the basic proposal, as proposed by the Delegation of Germany. However, his Delegation had difficulty in understanding the precise nature of the concerns of the Delegation of the United States of America.

1788. Mr. CLARK (ABA) stated that his Organization was not in agreement with the principle of provisional protection, since it did not support the early publication of application. Insofar as any principle was contained in the Treaty on provisional protection, however, his Organization agreed with the Delegation of the United Kingdom that the last sentence of paragraph (2)(c) in

the basic proposal was more confusing than clarifying. He also drew attention to Note 23.08 in document PLT/DC/4 and indicated that it would need to be amended to take into account the discussions that were taking place.

1789. Mr. UEMURA (Japan) stated that, where amendments were made after the publication of the application and such amendments were themselves published, there seemed to be no need to exclude them from the consideration of the scope of protection for the purposes of paragraph (2). This would seem to be the case even more so in Japan where a warning was necessary in order to obtain compensation. In relation to the concerns raised by the Delegation of Germany about taking account of enlargements or limitations in the scope of protection after publication of the application and before grant, he drew attention to the words "at least" in the opening lines of paragraph (2), which would seem to imply that any Contracting Party would have the right to take such enlargements or limitations into account.

1790. Ms. LINCK (AIPLA) stated that her Organization supported the proposal of the Delegation of the United States of America. Concerning the suggestion made by the Chairman, she indicated that, in her view, it did not resolve the problem raised by broad generic claims in published patent applications, which did not enable third parties to determine the scope of protection on the basis of the published application.

1791.1 Mr. SCHENNER (Germany) recalled that the discussion was not about the determination of minimum rights but the extent of protection conferred. His Delegation wished to give, in its proposal, a principle which would enable the extent of the protection conferred by a published application to be determined, that extent being dependent on the patent as granted. His Delegation did not see the need to take into account any enlargements or limitations in the claims during the processing of the application after its publication and before grant. If an amendment narrowed the scope of the claims, and that amendment appeared in the granted patent, the result would be a limitation in the extent of protection. If an amendment broadened the scope of the claims and appeared in the patent as granted, the broadening would not be taken into account. Thus, provisional protection could not go beyond the limits of protection as established in the application as published.

1791.2 He expressed some concern at the language used in the proposal of the Delegation of the United States of America, which he considered to contain some slight contradictions. His Delegation would not, however, oppose the principle that the claims in the application as published and in the patent as granted should be of substantially the same scope. He considered that it might be possible to combine the proposal of his Delegation with the last line of the proposal of the Delegation of the United States of America.

1792. Mr. SUGDEN (United Kingdom) stated that his Delegation was also prepared to consider the possibility of a draft combining the proposals of the Delegations of Germany and the United States of America. He stated that he was aware of the danger of broad generic claims in published applications that had been pointed out by the Delegation of the United States of America, but was not convinced that the proposal of that Delegation overcame the difficulty presented by such claims. He noted that there was a specific provision on this matter which appeared in the law of his country to the effect that, if the court considered that it was not reasonable to expect the defendant to

think that the patent would be granted, the court could reduce the damages or provide for no damages. The freedom of Contracting Parties to so provide could be covered in an explanatory note.

1793. Mr. BEIER (FICPI) stated that his Organization supported the proposal of the Delegation of Germany. He recalled that, in the opening statement of his Organization, it had been said that provisional protection was one of the major concerns of the Organization.

1794. Mr. GUERRINI (France) supported the proposal by the Delegation of Germany for the reasons set out by that Delegation.

1795.1 Mr. UEMURA (Japan) stated that, if the effect of the proposal of the Delegation of Germany was that amendments made after the publication of the application were not to be considered as part of the application, his Delegation was opposed to that proposal.

1795.2 In relation to paragraph (2)(b), his Delegation considered that it would be preferable to delete the word "not," which appeared twice, so that the provision was drafted in a positive manner to enable actions to be initiated after the grant of the patent on a published application.

1796. Mr. SANTARELLI (AIPPI) stated that the right to institute proceedings should be afforded in paragraph (2)(b) before grant of the patent. In that respect, he preferred the proposal by the Delegation of Germany to the text in the basic proposal. Nevertheless, his organization would like to maintain the latter part of paragraph (2)(b) of the basic proposal which afforded the owner a reasonable period of time for initiating action if the action could only be initiated after grant of the patent. He observed that an identical provision was lacking in the proposal by the Delegation of Germany and asked whether it would not be possible to add that sentence to the proposal concerned.

1797.1 The CHAIRMAN observed that, in view of the small number of delegations that had spoken so far on paragraph (2)(c), it would be unreasonable not to take the basic proposal as the point of departure for any future discussions.

1797.2 He suspended the meeting.

[Suspension]

1797.3 The Chairman opened the meeting and invited the Delegation of Germany to present its proposal relating to Article 23(2)(a).

1798.1 Mr. SCHENNEN (Germany) stated that there were two objectives to the proposal of his Delegation contained in document PLT/DC/67, the first concerning the subjective element necessary on the part of a defendant to establish liability, and the second being of a drafting nature.

1798.2 Concerning the subjective element required for liability, his Delegation intended to bring the provisions of paragraph (2)(a) into line with those established for paragraph (1)(ii). It was aware that there was a difficulty in determining the precise wording to describe the requisite subjective element, but it considered that the same concept should be utilized in paragraph (2)(a) and paragraph (1)(ii).

1798.3 The objective of his Delegation's proposal in relation to drafting was to endeavor to refine the wording of paragraph (2)(a) so as to make it clear that the provisional protection dealt with in that paragraph related only to the protection extended up to the grant of the patent and not after the grant of the patent.

1799. The CHAIRMAN pointed out that the proposal by the Delegation of Germany consisted of two elements, the first of which aimed to align the requirement of awareness under paragraphs (1)(ii) and (2)(a), whereas the second aimed to specify that provisional protection concerned solely the period following publication of the application and preceding grant of the patent.

1800. Mr. COHN (Israel) asked whether the words "the grant of a patent" in the proposal of the Delegation of Germany indicated the point at which the patent was granted or were intended to indicate the period at which the grant of the patent was confirmed following either the expiration of the period allowed for opposition or an opposition. He drew attention to the situation in which a person might be required to pay post-grant royalties and wondered at what point such royalties should start.

1801. Mr. SCHENNEN (Germany) stated that the grant of the patent was intended to indicate that moment at which the patent was granted without any consideration being given to opposition. That point was also the starting point for protection under paragraph (1) of Article 23.

1802. The CHAIRMAN asked the Secretariat to take into account the need to align the concept of awareness in paragraphs (1)(ii) and (2)(a).

1803. Mr. UEMURA (Japan) pointed out that his Delegation had made a reservation concerning the subjective element necessary for liability under paragraph (1)(ii) and so could not commit itself to the use of the same formulation in paragraph (2)(a) as had been proposed for paragraph (1)(ii).

1804. The CHAIRMAN concluded that the point of departure of discussions at the second part of the Conference would be the wording of paragraph (2)(a) in the basic proposal as amended by the proposal made by the Delegation of Germany in document PLT/DC/67.

1805. Mr. SCHENNEN (Germany) stated that his Delegation wished to withdraw its proposal concerning paragraph (2)(b) in document PLT/DC/67.

1806.1 The CHAIRMAN confirmed that the wording of paragraph (2)(b) of the basic proposal would constitute the point of departure for discussions at the second part of the Conference.

Article 1: Establishment of a Union

1806.2 He moved to Article 1 ("Establishment of a Union") and noted that there was a proposal by the Delegation of the Netherlands contained in document PLT/DC/12. He invited that Delegation to present its proposal.

1807.1 Mr. NEERVOORT (Netherlands) explained that, during the preparatory work, his Delegation had already mentioned that his country was in the process of drawing up a new draft law under which two titles could be granted for

inventions. The conditions had to be identical for each title but the conditions for grant varied according to the maximum duration of protection. In order to grant a title of 20 years duration, a search report (and therefore a longer procedure) would be needed, whereas a search report would not be necessary to grant the title of six years duration.

1807.2 He stated that the future existence of these two titles in his national law was likely to be somewhat awkward with relation to the Treaty. Article 22, for example, laid down a compulsory patent term of 20 years. He did not see how the definition of "patent" in item (iv) of Article 2 solved the problem of potential application of the Treaty to the short-term title provided for by the draft law of his country. The proposal made by his Delegation attempted to resolve that problem by specifying that the obligation of a Contracting State to provide protection for inventions by patents in conformance with the provisions of the Treaty did not affect the freedom of those States to provide other titles of protection for inventions which did not satisfy the obligations under the Treaty.

1808. The CHAIRMAN pointed out that, during the discussions in the Committee of Experts, numerous delegations had observed that their countries possessed two types of titles of protection for inventions with granting conditions or afforded rights that differed. It had been agreed during the discussions that if a Contracting Party established a system that complied with all the provisions of the Treaty, that did not prevent it from establishing other systems that did not comply with the provisions of the Treaty.

1809.1 Mr. BOGSCH (Director General of WIPO) observed that there were certain differences between the proposal of the Delegation of the Netherlands and the text of the basic proposal. In particular, the proposal of the Delegation of the Netherlands seemed to limit the obligation of Contracting Parties to the Treaty itself, whereas such Contracting Parties would also have obligations to fulfill in relation to patents for inventions under the Paris Convention. In addition, the proposal of the Delegation of the Netherlands referred to "States party to the Treaty," whereas the basic proposal referred to "Contracting Parties."

1809.2 He asked whether it would not be sufficient to insert an understanding in the summary minutes that any Contracting Party which complied with the provisions of the Treaty by the provision of one title of patent for inventions would be considered to be in compliance with its obligations under the Treaty, irrespective of whether it chose to make available other titles for inventions.

1810.1 Mr. NEERVOORT (Netherlands) stated that the problem as seen by his Delegation was that it was intended that his country should have two types of patents. It wished, accordingly, to make it crystal clear that if one type of patent conformed to the provisions of the Treaty, the other need not. He did not consider that this could be sufficiently covered in a note or in the summary minutes.

1810.2 Concerning the obligations imposed by the Paris Convention, he remarked that the present Treaty was to be concluded within Article 19 of that Convention so that, if there were any conflict, it would be the Paris Convention that prevailed.

1810.3 Concerning the use of the term "States party," he stated that it was the intention of his Delegation that the terminology should be adjusted to the decisions taken on the nature of the entities that could become party to the Treaty.

1811. Mr. UEMURA (Japan) reserved the position of his Delegation on Article 1 since there was a reference to intergovernmental organizations.

1812. Mr. SCHAEFERS (Germany) express sympathy for the idea underlying the proposal put forward by the Delegation of the Netherlands. He stated that it had always been considered during the discussions in the Committee of Experts that some sort of intellectual link should be indicated between the various Articles. The Treaty as such did not attempt or intend to set up a complete system of protection for inventions or for patents, but it was constantly felt that a certain intellectual link should be there. On the other, he considered that it would be sufficient if there were some sort of agreed minutes so that a provision need not appear in the text of the Treaty itself. Thus, his Delegation had sympathy for the idea and sympathy as far as the expression was concerned, but a certain hesitation or reservation whether it could not be done in a different manner.

1813. Mrs. DE CUYPERE (Belgium) said that her Delegation supported the proposal by the Netherlands. The adoption of that addition to Article 1 would provide an implicit possibility for States to adopt a parallel system of patents in addition to that established by the Treaty and was generally supported by industrial enterprises and the concerned circles. At the present time in Belgium, a choice existed for the applicant to opt either for a 20-year patent or for shorter-term patents (six years). The scope of protection under those two types of patent was identical. The six-year patents were, however, less expensive and therefore adequately responded to the interests of small inventors. Their reduced term also suited inventions in fields in which technical development was very rapid. For those reasons therefore the proposal by the Netherlands found the support of Belgium.

1814.1 The CHAIRMAN noted that, on substance, delegations were agreed that if a Contracting Party provided for a system of protection for inventions that complied in all respects with the present Treaty, it had satisfied its obligations and that would not prevent it from establishing at the same time a further system of protection for inventions, whatever the name given to that system. Such second system did not have to comply in all respects with the Treaty; it could differ in certain respects, such as conditions of validity, term and subject matter that was patentable.

1814.2 He noted that the divergency concerned the need or not to include a corresponding provisions in the text of the Treaty and that such a matter was rather one of form than of substance. He felt that the Committee could return to that matter at the second part of the Conference, it being understood that the minutes of the Conference would record the agreement on substance.

Article 2: Definitions

1814.3 He moved to Article 2 and noted that it contained the definitions of a number of terms to be found in the Treaty and that the Committee had voluntarily postponed examination until the discussions on the other Articles

had been concluded to enable the link between those definitions and the provisions in which the corresponding terms appeared to be perceived more clearly. He noted that the provisional results reached by the Committee with respect to the other Articles meant necessarily that the conclusions it could reach on Article 2 would also have to be provisional. He also pointed out that there was a corresponding Rule to be examined, that was to say Rule 1.

1814.4 He pointed out that there were two proposals for amendments, the proposal by the Delegation of the Netherlands, contained in document PLT/DC/13, and the proposal by the Delegation of Israel, contained in document PLT/DC/29. He invited the Delegation of the Netherlands to present its proposal relating to item (ii) of Article 2.

Article 2(ii): "Priority Date"

1815. Mr. NEERVOORT (Netherlands) stated that the International Bureau had done an excellent job in defining the priority date under item (ii) of Article 2 and had rightly made a distinction between the case where priority played a role in computing time limits and the case where priority has been claimed for other reasons. His Delegation wished to suggest a precision. It acknowledged that where priority rights had been invoked for computing time limits, it did not matter whether the priority had been validly invoked. If one took the most important such example where priority had been invoked, namely, the publication of the application after 18 months from the priority date, he knew of no Office that checked whether in those cases priority had been validly claimed. In contrast, where the priority had been invoked with the intention of influencing substantive rights, for example, the novelty test and defining the state of the art, it was of the utmost importance that the priority has been validly claimed. In order to make clear that distinction, his Delegation had suggested adding under paragraph (b) of item (ii) at the end the phrase "and provided that the priority has been validly claimed."

1816. Mr. UEMURA (Japan) asked for clarification of the meaning of the words "other titles protecting the invention" in item (ii). He also stated that, in relation to the proposal of the Delegation of the Netherlands, his Delegation had difficulty in understanding whether the term "validly" applied to requirements of substance or to formality requirements. If "validly" was intended to encompass not only substantive requirements but also formality requirements, his Delegation considered that it should also apply to subparagraph (a), since the Paris Convention clearly prescribed certain formality requirements, such as the declaration with a certified copy and the period of priority.

1817. Mr. NEERVOORT (Netherlands) stated that it was certainly not the intention of his Delegation to refer to any formalities checks. His Delegation had intended to refer to the entitlement to the priority right.

1818. Mr. VON ARNOLD (Sweden) recalled that, in some countries, there was a prohibition of the patenting of plant varieties and a special form of protection for this type of development was provided for, namely, plant breeders' rights. In other countries, however, it was possible to obtain a patent for plant varieties which fulfilled the conditions of patentability. He also recalled that, in March of that year, a diplomatic conference on the

revision of the International Convention on the Protection of New Varieties of Plants (UPOV) had been held. At that Conference, there had been a long debate concerning whether it would be possible to claim the priority of an application for a patent in one country, for example, the United States of America, concerning a plant variety, for the purposes of an application for a plant breeder's right for that same variety in a country which did not allow for the possibility of patents for plant varieties. Some Delegations at that Conference, among them the Delegation of Sweden, were concerned that there should not be an imbalance between the systems. They considered that it would be acceptable to have an arrangement of priority on the basis of patent applications in countries which gave plant variety protection provided that an application for plant variety protection could give rise to priority when the breeder applied for a patent. The Secretary General of UPOV, also the Honorable Director General of WIPO, stated at that Conference that the matter of reciprocity could not be solved in the UPOV conference but should be taken up, for example, in the present Conference. His Delegation wished to know whether the words "or other title protecting an invention" covered also applications for plant breeders' rights in those cases where the plant variety in question fulfilled the conditions for obtaining a patent.

1819. Mr. BOGSCH (Director General of WIPO) replied in the affirmative to the question of the Delegation of Sweden, stating that it should be in principle possible to ask for priority on the basis of plant breeders' rights protection. But the words indicated that there must be an invention. Furthermore, whether it would be a valid priority would depend on the content of the application. Did it describe the plant variety in a way which also could be taken into account as covering the same scope of protection? In practice, many of the first applications for a plant breeders' right might not stand up to scrutiny as being a valid priority base, but it was not excluded.

1820.1 The CHAIRMAN stated that the questions raised by the Delegation of Sweden had been noted. He also took note of the reservation entered by the Delegation of Japan.

1820.2 He noted that the proposal made by the Delegation of the Netherlands had not been adopted for lack of support. However, he observed that there was no problem on substance since where the validity of a patent was to be judged on the basis of the patentability conditions, it was necessary for the priority date to be justified from a material point of view if that date was to be taken into account.

1821. Mr. SUGDEN (United Kingdom) stated that his Delegation had no difficulty with the principle expressed in the definition of "priority date" in item (ii) nor with the consideration of the priority date from two different points of view depending on the purpose for which the priority date was used. His Delegation had some concerns on the wording of the definition in relation, for example, to the notion of "element of the invention." It would, however, come to those concerns in the second part of the Conference.

Article 2(ix): "Substantive Examination"

1822. The CHAIRMAN asked whether there were other observations on item (ii) of Article 2. There being no request for the floor, he moved to the proposal by the Delegation of Israel, contained in document PLT/DC/29, which concerned Article 2(ix). He invited the Delegation of Israel to present its proposal.

1823. Mr. COHN (Israel) stated that the proposal of his Delegation was a simple and easy one. It concerned the definition of substantive examination to which his Delegation wished to add after the words "satisfies" in line 3 of the basic proposal the words "at least," so that the sentence would then read "substantive examination means the examination of an application by an Office to determine whether the invention claimed in the application satisfies at least the conditions of patentability referred to Article 11(1), (2) and (3)." The reason for the addition was that, at least in some countries, substantive examination covered not only novelty and inventive step or non-obviousness, but also matters such as whether the invention was contrary to good order or morality.

1824. Mr. UEMURA (Japan) expressed the support of his Delegation for the proposal of the Delegation of Israel. In particular, his Delegation was concerned that paragraph (1) of Article 11 was not referred to in the definition contained in item (ix). It did not see any reason to limit the references in item (ix) to paragraphs (2) and (3) of Article 11.

1825. Mr. SUGDEN (United Kingdom) stated that his Delegation did not object to the proposal of the Delegation of Israel.

1826. The CHAIRMAN pointed out that it was more a matter of clarification and that no one had thought of limiting the substantive examination under paragraphs (2) and (3) of Article 11.

1827. Mr. CLARK (ABA) expressed the support of his Organization for the statement made by the Delegation of Japan, stating that, if item (xi) referred only to paragraphs (2) and (3) of Article 11, the importance of paragraph (1) of Article 11 would thereby be diminished.

1828. Mr. KHRIESAT (Jordan) stated that his Delegation agreed to the text of the basic proposal for item (ix), which it considered to be very clear.

1829. Mr. KAMEL (Egypt) stated that his Delegation supported the text of Article 2 as a whole in the basic proposal.

1830. Mr. ELHUNI (Libya) stated that his Delegation was not opposed to the text of Article 2 in the basic proposal. However, he considered that it was important that the term "Contracting Party" be defined. Such a definition was contained in the Vienna Convention on the Law of Treaties and he suggested that that practice be followed in the present Treaty.

1831. The CHAIRMAN observed that the suggestion broadly corresponded to the text of Article 1 and asked what was the difference between the suggested amendment and the text of Article 1 of the basic proposal.

1832. Mr. ELHUNI (Libya) stated that it was merely a question of drafting. He suggested that, instead of the corresponding provision in Article 1, Article 2 should define who the Contracting Parties were.

1833. Mr. BOGSCH (Director General of WIPO) observed that there had been a lot of hesitations in drafting the basic proposal as to whether to start with the text which is now in Article 1 or that which is in Article 2. If the text presently in Article 2 had been chosen as the starting point, a definition of "Contracting Party" would have been necessary. He suggested that the matter be left for decision by the Drafting Committee.

1834. Mr. ELHUNI (Libya) stated that Article 1 could start with the words "The Contracting Parties constitute" and that the definition of Contracting Parties should be contained in Article 2, a practice which would be totally in keeping with other treaties.

1835. The CHAIRMAN noted the observation by the Delegation of Libya and stated that it would be entrusted to the Drafting Committee at the appropriate time.

Rule 1: Definitions (ad Article 2)

1836. Mr. VAN HORN (United States of America) referred to Rule 1(3) which set out the circumstances in which an application, a search report, a patent or any change in a patent is deemed to be "accessible to the public" for the purposes of item (viii) of Article 2. His Delegation considered that an announcement in the Gazette should be considered a necessary condition before something could be considered to be "accessible to the public."

1837.1 The CHAIRMAN asked whether there were other observations or not on Rule 1. There being no request for the floor, he concluded that the text of the basic proposal would serve as a basis for discussions for the second part of the Conference.

1837.2 He pointed out that the discussions in Main Committee I of the first part of the Conference were completed. He first expressed his gratitude to the member delegations, the special delegations and the observer delegations for their most active participation and for the discipline that had been maintained during discussions.

1837.3 He thanked the Secretariat, particularly the Director General who had been present during all meetings and who, by his interventions, had made an important contribution to the discussions. He likewise thanked Mr. Ludwig Baeumer and Mr. François Curcbod from the Secretariat who had given great assistance to the work. He also thanked the other members of the Secretariat.

1837.4 He expressed his gratitude to the interpreters.

1837.5 He mentioned the Government of the Kingdom of the Netherlands, but pointed out that it was not of his competence to express gratitude to that Government for its splendid hospitality.

1837.6 He expressed his hope that the delegations would meet again soon and closed the meetings of Main Committee I of the first part of the Conference.

MAIN COMMITTEE II OF THE DIPLOMATIC CONFERENCE

Chairman: Mr. A. Trombetta (Argentina)

Secretary: Mr. F. Gurry (WIPO)

<p><u>First Meeting</u> <u>Thursday, June 6, 1991</u> <u>Afternoon</u></p>

1. Mr. BOGSCH (Director General of WIPO) declared open the first meeting of Main Committee II and, referring to the election of the Chairman and Vice-Chairmen reported in paragraph 124 of the summary minutes of the Plenary, above, invited the Chairman, Mr. Trombetta (Argentina), to take the chair.
2. Mr. TROMBETTA (Chairman) welcomed the delegates and observers and expressed his gratitude for his unanimous election as Chairman of Main Committee II. He was aware of the responsibilities assigned to him and stated that he intended to conduct the proceedings of the Committee in an objective manner with a view to achieving fruitful results. He then invited the Committee to examine the Preamble of the Treaty as envisaged in the basic proposal.
3. All delegations and representatives of organizations which took the floor expressed their warm congratulations to the Chairman on his unanimous election as Chairman of Main Committee II and expressed their confidence that, thanks to his competence and experience, he would lead the Committee to a successful result.
4. Mr. BOGSCH (Director General of WIPO) explained that the Preamble consisted of five paragraphs. The first paragraph stated the desire of the Contracting Parties to strengthen international cooperation in respect of the protection of inventions; the second established that such protection was facilitated by a harmonization of patent law; the third referred to the public policy objectives underlying national patent laws; the fourth referred to the development, technological and public interest objectives of the Contracting Parties; and the fifth and final paragraph stated that the Contracting Parties had concluded the Treaty and that it constituted a special agreement in accordance with Article 19 of the Paris Convention.
- 4.2 The basic proposal contained two alternative texts for the Preamble. While Alternative A encompassed all the above-mentioned paragraphs, Alternative B consisted of paragraphs one, two and five, which paragraphs had not been controversial in the discussions of the Committee of Experts.

- 4.3 The Director General stated that it was difficult to adopt final decisions on the Preamble before the text of the Treaty was known. The Committee might, therefore, consider it necessary to revert to a consideration of the Preamble after the text of the Articles became known. However, a preliminary exchange of views could be useful.
5. The CHAIRMAN recalled that, in accordance with the Rules of Procedure adopted by the Conference, Alternatives A and B had equal status.
6. Mr. ARAGON (Philippines) stated that, for developing countries, Alternative A was the preferred one. That Alternative was consistent with the position of developing countries in respect of Article 10, concerning fields of technology.
7. Mr. KAMEL (Egypt) expressed his support for Alternative A, but he reserved the position of his Delegation in respect of paragraph 4, which he considered could lead to conflicting interpretations because the objectives mentioned in that paragraph were not defined in the same manner by developing and developed countries.
8. Mr. ROMERO (Chile), speaking on behalf of Latin American Group, stated that, since there was a close relationship between industrial property and economic development, it was necessary to include in the Preamble a reference to the technological objectives of the Contracting parties. His Delegation supported, consequently, Alternative A.
9. Mr. SCHAEFERS (Germany) expressed his preliminary preference for Alternative B. However, he was of the view that the Preamble should be examined again after the examination of the Articles was concluded. Germany was aware that different stages of development should be taken into account in the harmonization process. He mentioned, in this respect, the fifth paragraph of the Preamble to the Patent Cooperation Treaty (PCT) which referred to the desire of Contracting parties to foster and accelerate the economic development of developing countries. That paragraph, he recalled, was proposed by Latin American countries at the Washington Conference. He suggested that, once the text of the Treaty was agreed upon, and in the light of its provisions, references to public policy, development, technological and public interest objectives might eventually be included in the Preamble.
10. Mr. BULGAR (Romania) expressed his support for Alternative A since it covered the interests of his country.
11. Mrs. PURI (India) expressed the support of her Delegation for Alternative A. She recalled that the preamble sets the tone and the philosophy of a treaty and that, from that viewpoint, it was worth considering the Preamble before the Articles. Since the Preamble reflects the philosophy of the Treaty, she was of the view that it should contain references not only to harmonization, but also to ensure that the harmonization is in the context of accommodation of some fundamental objectives and interests of developing countries. Those objectives included consideration of public policy, development, technological and public interests.
12. Mr. KHUMALO (Swaziland) expressed his support for Alternative A. He was of the view that the Preamble set the general lines along which the Treaty should be drafted and he considered that the objectives mentioned in paragraphs three and four should be reflected in the relevant Articles of the Treaty if it was to be of benefit to developing countries.

13. Mr. JAYASINGHE (Sri Lanka) stated that, since the first paragraph referred to the strengthening of international cooperation in respect of the protection of inventions, it was necessary, in order to attain a balance, to include references to the objectives mentioned in paragraphs three and four.

14. Mr. COMBALDIEU (France) was in agreement with the delegations that proposed returning to the matter again at the end. As for the fourth paragraph, he thought that the wording should be improved and suggested the following text: "CONSIDERING that the aim of the parties is to contribute to economic and social development, to the progress of technology and to the general interest."

15. Mr. NEERVOORT (Netherlands) stated that it was difficult to consider the Preamble without knowing the text of the Treaty. Notwithstanding, he had a preliminary preference for Alternative B.

16. Mr. SUGDEN (United Kingdom) stated that his Delegation was not in a position to take a firm decision on the Preamble without knowing the overall package that would be contained in the Treaty. He expressed understanding for the view expressed by some speakers that patent law should take account of public policy objectives. Nevertheless he trusted that all parties involved would have similar objectives--to encourage invention and innovation. It would be desirable perhaps to make this point clear in the preamble. His Delegation was interested in studying the proposed clarification just suggested by the Delegation of France.

17. Mr. TOURE (Cote d'Ivoire) expressed his support for Alternative A since the objective of the Treaty was not only the strengthening of the patent system but also to strengthen solidarity.

18. Mr. MOTA MAIA (Portugal) stated that the Preamble, which was at the beginning of the Treaty, should be considered after the text of the Treaty has been agreed upon. He considered paragraph 3 to be too restrictive, since it was not only national patent laws but also international treaties that were based on public policy considerations.

19. Mr. HIEN (Burkina Faso) expressed his support for Alternative A which took into account the philosophy of patent law. He sought, from the Chairman, clarification of the terms "special agreement" in the last paragraph of the Preamble.

20. The CHAIRMAN clarified that Article 19 of the Paris Convention allowed States party to conclude "special agreements" for the protection of industrial property in so far as those agreements did not contravene the provisions of the Paris Convention. The term "special agreements" was broad enough to cover treaties supplementing or complementing the Paris Convention, provided that they did not reduce the levels of protection enshrined in the Paris Convention.

21. Mr. MANZOLILLO DE MORAES (Brazil) expressed his preference for Alternative A because it reflected objectives that were of importance to developing countries. In his view, the Preamble could be further considered after the adoption of the text of the Articles.

22. Mr. HATOUM (Lebanon) proposed to add the terms "and solidarity" after the word "cooperation" in the first paragraph and to merge paragraphs three and four so as to read as follows: "RECOGNIZING the need to take into consideration the public policy, development, technological and public interest objectives of the Contracting Parties."

23. Mr. BETON (UNICE) expressed the preference of his Organization for Alternative B. In his view, paragraph 3 was unnecessary because public policy objectives were inherent in a patent law treaty. As far as paragraph 4 was concerned, he stated that, since the objectives mentioned therein were not the same for all countries, it would be difficult to ascertain the content of such a paragraph.

24. The CHAIRMAN concluded that the discussions on the Preamble had been useful because they had clarified the issues involved and had revealed the existence of a constructive attitude that would facilitate future work on the matter. He then adjourned the meeting.

<p><u>Second Meeting</u> <u>Tuesday, June 18, 1991</u> <u>Morning</u></p>

25.1 The CHAIRMAN opened the second meeting of Main Committee II. He expressed his acknowledgement of the masterly work that had been carried out by Mr. Comte as Chairman of Main Committee I, which had enabled the work of that Committee to progress effectively.

25.2 He indicated that discussions were still taking place in the regional groups concerning a number of the Articles for which, according to Rule 12 of the Rules of Procedure, Main Committee II was responsible. Pending the completion of those discussions in the groups, he suggested that, in order to progress the work of Main Committee II, the meeting commence with a consideration of Article 27 ("Assembly").

Article 27: Assembly

25.3 He asked the Director General to introduce paragraph (1) of Article 27.

Article 27(1): [Composition]

26.1 Mr. BOGSCH (Director General of WIPO) stated that subparagraph (a) of paragraph (1) established an Assembly consisting of the Contracting Parties. The question of which entities could be Contracting Parties was to be discussed in a later Article.

26.2 He indicated that subparagraph (b) was a provision of the usual kind found in treaties administered by WIPO.

26.3 He explained that subparagraph (c) was necessary because there was no provision for the Union to be established by the Treaty to have a budget. He drew attention, however, to Note 27.01 in document PLT/DC/4 which indicated that subparagraph (c) did not preclude the Assembly from requesting financial assistance for the expenses of the participation of all or some delegations from sources outside the Union, such as WIPO or the Paris Union.

27.1 The CHAIRMAN noted that there were no observations on paragraph (1) and that the text of that paragraph in the basic proposal would thus serve as the basis for further discussion.

Article 27(2): [Tasks]

27.2 He invited the Director General to introduce paragraph (2).

28. Mr. BOGSCH (Director General of WIPO) stated that the provisions of paragraph (2) were similar, with very few differences, to the analogous provisions to be found in all treaties administered by WIPO which created new Unions, with one notable exception, namely, the provision in paragraph (2)(a)(ii), which envisaged that the Assembly would have power to modify any time limit provided for in Articles 3 to 26 of the Treaty.

29. The CHAIRMAN first invited discussion on items (i) to (iv) of paragraph (2)(a).

30. Mr. SUGDEN (United Kingdom) indicated that his Delegation was generally in favor of the text of the basic proposal for items (i) to (iv) of subparagraph (a). However, his Delegation had one reservation, which concerned item (ii). It agreed with the principle that time limits provided for in Articles 3 to 26 of the Treaty should be modifiable by the Assembly, but it considered that the requirement of unanimity for any such modification was extremely stringent. It accepted that a greater majority might be required for such modifications than for changes in the regulations, which required a three-quarters majority. He suggested that the matter be considered later in the context of amendments to the regulations (Article 29(2)) and that, perhaps, the meeting could consider majorities such as three-quarters for amendments to the regulations and five-sixths for amendments to the time limits, or two-thirds for amendments to the regulations and three-quarters for amendments to the time limits.

31. Mr. BOGSCH (Director General of WIPO) indicated his agreement with the observations made by the Delegation of the United Kingdom. He suggested that it might be wise to postpone any provisional decisions on item (ii) until the content of all the substantive Articles (Articles 3 to 26) was known, since the time limits foreseen in some of those Articles might lend themselves easily to modification by a reduced majority, whereas the time limits foreseen in other Articles might require a greater majority, if not unanimity.

32. Mr. ESCUDERO CACERES (Chile) expressed the agreement of his Delegation with the observations that had been made by the Delegation of the United Kingdom, stressing that a requirement of unanimity was too rigid. He also

endorsed the suggestion that had been made by the Director General to tackle item (ii) when the content of the substantive Articles in the Treaty was known.

33. Mr. KAMEL (Egypt) pointed out that there were regional organizations to which his country belonged that had experienced difficulties in decision making because of the requirement of unanimity. He stressed the importance of flexibility in decision making and wondered whether a two-thirds majority might not suffice for the modifications of the time limits foreseen in item (ii).

34. Mr. COHN (Israel) stated that his Delegation also had difficulties with the requirement of unanimity in item (ii). He noted that a requirement of unanimity had caused difficulties in the context of the revision of the Paris Convention and he wondered whether a cross-reference to the resolution of that matter within that context would not be desirable.

35. Mr. BOGSCH (Director General of WIPO) pointed out that the problem dealt with in item (ii) was not the same as the problem being considered in the context of the revision of the Paris Convention. Item (ii) did not deal with the revision of the proposed Treaty in every respect, but only with the modification of time limits in the substantive Articles.

36. Mr. HAYASHI (Japan) stated that his Delegation considered that item (ii) was not sufficiently specific. He drew attention to the fact that the time limits provided for in Articles 3 to 26 of the Treaty would have a significant effect on national law. His Delegation opposed the possibility of modifying those time limits and proposed the deletion of item (ii).

37. M. GUERRINI (France) pointed out that account would also have to be taken of the conditions laid down in Article 29 for amendment to the Regulations under which any amendment to the Regulations would require three-fourths of the votes cast. He felt that the amendment of the time limits given in the Treaty should not be subject to more flexible conditions than amendment of the Regulations.

38.1 Mr. SCHAEFFERS (Germany) endorsed the suggestion of the Director General, stating that it was premature to take a view on item (ii) until such time as the contents of Articles 3 to 26 were known.

38.2 He also expressed the view that the requirement of unanimity was too strict. There were certain time limits dealt with in the substantive Articles, such as the 18-month time limit for publication of the application in Article 15, which constituted cornerstones of the proposed Treaty and which might require unanimity or a very strict majority for modification. Other time limits, however, would seem to require a lesser majority.

38.3 He also suggested that, in the case of time limits which were provided by way of an option for Contracting Parties, such as the time limit of 24 months for publication provided for certain Contracting Parties in Article 15, any modification should require either unanimity or the consent of any Contracting Party that had made use of the option.

39. Mr. KIRK (United States of America) stated that his Delegation fully agreed with the observations that had been made by the Director General and by

the Delegation of Germany. He requested clarification of the opposition that had been expressed to item (ii) by the Delegation of Japan.

40. Mr. GARIEPY (Canada) stated that the requirement of unanimity was too strict. He welcomed the suggestion that had been made by the Director General and agreed with the observation that had been made by the Delegation of Germany.

41. Mr. HAYASHI (Japan) stated that his Delegation considered that time limits were an essential part of the proposed Treaty and that any modification of them would have a direct effect on the national law of each Contracting Party. Accordingly, his Delegation considered that any modification of time limits should be effected pursuant to the strict procedure that was envisaged for the revision of the proposed Treaty.

42. Mr. WIERZBICKI (New Zealand) expressed that view that unanimity was too strict a requirement. He agreed with the suggestion made by the Director General to defer any provisional decision on item (ii) until such time as the content of the substantive Articles was known.

43. Ms. FERNÁNDEZ (Argentina) stated that her Delegation agreed that the requirement of unanimity was too rigid. She also expressed the agreement of her Delegation with the observations that had been made by the Director General and by the Delegations of the United Kingdom and Germany.

44. Mr. TALUKDAR (Bangladesh) expressed the agreement of his Delegation with the suggestion made by the Director General to defer any provisional decision on item (ii) until the content of Articles 3 to 26 was known.

45. Mr. OUSHAKOV (Soviet Union) stated that his Delegation also agreed with the suggestion of the Director General.

46. Mr. HATOUM (Lebanon) stated that his Delegation supported the fixing of the required majority in relation to item (ii) at that time, whether that majority be unanimity, two-thirds or three-quarters.

47. Mr. SMITH (Australia) stated that his Delegation found itself to be in a dilemma because of the importance of time limits and that, in that regard, it had some sympathy with the view that had been expressed by the Delegation of Japan. As had been pointed out by the Delegation of Germany, certain time limits assumed particular importance. His Delegation therefore agreed with the suggestion of the Director General to await the outcome of the consideration of Articles 3 to 26 before taking any provisional decisions on item (ii).

48. Mr. DIENG (Senegal) said that his Delegation was not in favor of the requirement of unanimity laid down in item (ii) and that it preferred a three-fourths majority. He supported the suggestion made by the Director General to look at item (ii) again once the meeting had dealt with the provisions of Articles 3 to 26.

49. Ms. FUCHS (Mexico) stated that she agreed with the observations that had been made by the Delegation of Australia and favored the consideration of item (ii) after the conclusion of consideration of Articles 3 to 26.

50. Mr. SALIM (Syria) expressed the support of his Delegation for a majority of three-quarters in item (ii).

51.1 The CHAIRMAN noted that no observations had been made concerning items (i), (iii) and (iv) of paragraph (2)(a) and that, therefore, the text of those provisions in the basic proposal would serve as the basis for further discussion.

51.2 He noted that a majority of Delegations had expressed the view that the requirement of unanimity in item (ii) of paragraph (2)(a) was too rigid, but that most Delegations also considered that any further consideration of that provision should take place only after decisions had been taken on the content of Articles 3 to 26.

51.3 He then invited the Delegations to consider items (v) to (ix) of paragraph (2)(a).

52. Mr. HAYASHI (Japan) stated that his Delegation wished to reserve any consideration of item (viii) until after discussion had taken place of Article 33, since the two provisions were closely related.

53. The CHAIRMAN noted the statement of the Delegation of Japan. With that reservation, he concluded that the text of items (v) to (ix) were, in the absence of any other observations, acceptable and should serve as the basis of further discussion.

Article 27(3): [Representation]

54.1 He then invited the Delegations to consider paragraph (3) of Article 27. There being no observations, he noted that the text of paragraph (3) in the basic proposal would serve as the basis of further discussion.

Article 27(4): [Voting]

54.2 He then opened discussion on paragraph (4) and asked the Director General to introduce that provision.

55.1 Mr. BOGSCH (Director General of WIPO) observed that the text of paragraph (4) in the basic proposal represented the text that had been agreed to in the last meeting of the Committee of Experts. It dealt, in particular, with the exercise by two types of intergovernmental organizations of the right to vote of their member States that were Contracting Parties.

55.2 The first such type of intergovernmental organization was referred to in Article 33(1)(ii), namely, an intergovernmental organization which was competent in matters governed by the Treaty and which had established, on such matters, norms that were binding on all its member States, provided that all those States were party to the Paris Convention for the Protection of Industrial Property. No such intergovernmental organization presently existed, but the European Communities would constitute such an organization if and when they established, on matters covered by the Treaty, norms binding on all its member States.

55.3 The second type of intergovernmental organization was referred to in Article 33(1)(iii), namely, an intergovernmental organization which maintained an Office granting patents with effect in more than one State, provided that all its member States were party to the Paris Convention for the Protection of Industrial Property. There were two such intergovernmental organizations at the present time, the Organisation africaine de la propriété intellectuelle (OAPI) and the European Patent Organisation (EPO).

55.4 He noted that, if the text of Article 33 in the basic proposal were adopted, both OAPI and the EPO would be eligible for membership of the Union to be established by the Treaty. He noted that Article 27(4) did not provide for OAPI or the EPO, or for any similar future organization, to have a vote of its own. Rather, Article 27(4)(c) provided that those intergovernmental organizations could vote instead of their member States and in the name of their member States if their member States so authorized them to do through a formal notification to the Director General of the authorization. Furthermore, it was provided that the intergovernmental organization would automatically lose the right to exercise the vote of any of its member States if any of them participated in the vote or expressly abstained.

55.5 He drew attention to the words in square brackets in subparagraphs (b) and (c) of paragraph (4). Since those words appeared in square brackets, they did not constitute part of the basic proposal. The basic proposal required the presence of a member State of an intergovernmental organization before that organization could exercise the right to the vote of that member State. The words in square brackets, if included in the text of the Treaty, would allow the right to vote of the member State to be exercised by the intergovernmental organization, even if the member State was absent. The words in square brackets had been included in that form, as pointed out in Note 27.02 in document PLT/DC/4, at the request of the member States of OAPI.

55.6 He explained that subparagraph (d) of paragraph (4) provided a safeguard by way of a rule against the right to vote of a State being exercised by more than one intergovernmental organization.

55.7 He suggested that the provision in subparagraph (e) of paragraph (4) be reserved because, at that stage, no discussion had taken place on the question of reservations under Article 35.

56.1 The CHAIRMAN invited the Delegations to consider first subparagraph (a) of paragraph (4). There being no observations, he noted that the text of that provision in the basic proposal would serve as the basis for further discussion.

56.2 He then moved to a consideration of subparagraphs (b) and (c) of paragraph (4).

57. Mr. HIDALGO LLAMAS (Spain) suggested that the consideration of subparagraphs (b) and (c) be postponed until after the discussion of Article 33.

58. Mr. TALUKDAR (Bangladesh) asked whether the authorization given by the member States of an intergovernmental organization under subparagraph (c) would apply to one particular session of the Assembly, to one item on the agenda of a session of the Assembly or on an indefinite basis.

59.1 Mr. BOGSCH (Director General of WIPO) stated, in reply to the question raised by the Delegation of Bangladesh, that the authorization would be valid for as long as it was not withdrawn.

59.2 Concerning the suggestion made by the Delegation of Spain, he indicated that any provisional decision on paragraphs (b) and (c) would be subject to any possible amendment to Article 33.

60. The CHAIRMAN observed that there were many parts of the Treaty, such as subparagraphs (b) and (c), that were linked, but that deserved some discussion despite the linkage to provisions that had not yet been considered in order to elicit preliminary views and ideas.

61. Mr. SUTRISNO (Indonesia) drew attention to the fact that, if the words in square brackets in subparagraphs (b) and (c) were included in the Treaty, the member States of the EPO and OAPI would be able to vote in the Assembly even if not present, whereas developing countries which did not belong to any such intergovernmental organization could not participate in the Assembly unless present. He considered that result to be unbalanced.

62. Mr. KHRIESAT (Jordan) asked whether, if a State were a member of more than one intergovernmental organization, each of those intergovernmental organizations could exercise the right to vote of that State in such a way that the State would have more than one vote exercised.

63. Mr. BOGSCH (Director General of WIPO) stated that there was no possibility under the text of the basic proposal for any State to exercise or to cause to be exercised more than one vote. Any vote cast by an intergovernmental organization would be a vote instead of the vote of its member States and not in addition to the vote of its member States. If a State were a member of more than one intergovernmental organization, subparagraph (d) of paragraph (4) clearly indicated that only one vote could be exercised in respect of that State.

64. The CHAIRMAN added that, under Article 36, each intergovernmental organization was required to notify its list of member States so that there would be transparency with respect to which organizations could exercise votes for which States.

65. Mr. SALIM (Syria) stated that his Delegation could not accept subparagraph (b) and (c) since they would extend privileges to certain countries who would be able to have exercised their right to vote even if absent, while developing countries not members of pertinent intergovernmental organizations could not participate in votes in the Assembly if not present.

66. Mr. BOGSCH (Director General of WIPO) emphasized that the result referred to by the Delegation of Syria depended on which text was adopted for subparagraphs (b) and (c). In the text of the basic proposal, a vote could be exercised for a member State of an intergovernmental organization by that organization only if the member State were present. There were words in square brackets, which did not constitute part of the basic proposal and which would have to be moved as an amendment to the basic proposal, which would allow an intergovernmental organization to exercise the right to vote of a member State even if that member State were not present. Those words had been

suggested by the member States of OAPI for precisely the reason mentioned by the Delegation of Syria, namely, to facilitate the participation of certain developing countries in votes in the Assembly even if they were absent.

67. Ms. FERNÁNDEZ (Argentina) stated that the clarifications given by the Director General were most useful. She also drew attention to the fact that the last sentence of each of subparagraphs (b) and (c) were similar but contained small differences of wording. She wished to know if the differences in wording were intended to indicate a substantive difference in the operation of the two sentences.

68. Mr. BOGSCH (Director General of WIPO) expressed his gratitude to the Delegation of Argentina for its observations, stating that both sentences in question were intended to produce the same result and that the differences should be eliminated.

69. Mr. KAINAMURA (Uganda) stated that, if his country were absent from a meeting of the Assembly, it could not give a proxy to another country to vote on its behalf whereas, if the member States of OAPI were not present, they could give a proxy to OAPI to vote on their behalf. He could not see the rationale for that distinction.

70. Mr. BOGSCH (Director General of WIPO) stated that the difference in treatment alluded to by the Delegation of Uganda was the reason for which the basic proposal left out the words contained in square brackets and permitted an intergovernmental organization to exercise the right to vote for one of its member States only if that member State were present. The basic proposal did not permit any exercise of the right to vote of a member State which was absent. He noted that the words in square brackets, not being part of the basic proposal, would have to be moved as an amendment and that no Delegation had done so yet.

71. Mr. TALUKDAR (Bangladesh) wondered whether, for the purposes of balance, provision could not be made for postal voting by any State not present at the meetings of the Assembly.

72. Mr. BOGSCH (Director General of WIPO) stated that the draft Treaty foresaw the possibility of voting by correspondence only where there was no quorum. He considered that voting by correspondence should be an exceptional measure as it would be contrary to all international practice, which sought to bring States together for the purposes of discussion, to generalize postal voting.

73. Mrs. JESSEL (CEC) emphasized the difficult and complex nature of the matter under examination. She pointed out that if the European Communities were to become party to the Treaty one day then they would do so under Article 33(1)(ii). Therefore, the right to vote of the European Communities as a potential Contracting Party could only be exercised under Article 27(4). She explained that it was essential for the Article to correspond not only to the precise nature of the European Communities, but also to their specific rules for expressing themselves. If such were not the case, that would compromise possible accession by the European Communities to the Treaty despite Article 33 and the possibility provided therein. For that reason, the Commission of the European Communities felt that when the matter was examined finally at the second part of the Diplomatic Conference, the Communities were likely to propose an amendment to Article 27(4).

74. Mr. THIAM (OAPI) stated that, to avoid differences in treatment, his organization was willing to ask that the words between square brackets in paragraph (4)(b) and (c) be deleted.
75. Mr. LECCA (UPEPI) wondered whether OAPI and EPO ought to be treated in the same manner in paragraph (4)(c) since the member States of OAPI did not have national offices.
76. Mr. TIGBO (Cameroon) explained that OAPI constituted the office for each of the member States of the Organization. His Delegation supported the deletion of the square brackets and maintenance of the words given between square brackets in paragraph (4)(b) and (c).
77. Mr. ESCUDERO CÁCERES (Chile) wondered why a State would deny itself the exercise of its right to vote in favor of an intergovernmental organization. He reserved the position of his Delegation until the position with respect to subparagraphs (b) and (c) became clearer. At present, it seemed that those subparagraphs created a difference between two types of Contracting Parties, those that could delegate the exercise of their right to vote and those that could not.
78. The CHAIRMAN pointed out that a State does not deny itself the right to vote but, rather, might choose to delegate the exercise of that right.
79. Mrs. MKWANAZI (Swaziland) expressed the support of her Delegation for the statement of the Delegation of Cameroon. Her Delegation supported the removal of the square brackets in subparagraphs (b) and (c) and considered that the member States of an intergovernmental organization should be able to delegate the exercise of their right to vote when not present. She also sought clarification on the last sentence of subparagraph (c) and whether it meant that, if only one member State of an intergovernmental organization participated in a vote or expressly abstained, that organization was precluded from exercising the right to vote of all of its other member States in that vote.
80. The CHAIRMAN stated, in reply to the clarification sought by the Delegation of Swaziland, that one member State of an intergovernmental organization could prevent the intergovernmental organization from exercising the right to vote of all of its other member States in a vote by participating in that vote.
81. Mr. MESSERLI (Switzerland) supported the basic proposal. His Delegation was opposed to maintenance of the wording between square brackets in paragraph 4(b) and (c). He held that the presence of the member State of an intergovernmental organization was essential for its right to vote to be exercised by that organization. Moreover, the wording of the basic proposal took into account the concern expressed by the Delegations of Indonesia and of Syria, who were not members of international organizations as referred to in paragraph (4)(b) and (c) and did therefore not have the possibility of their right to vote being exercised if they were absent from sessions of the Assembly.
82. Mr. LY (Senegal) supported the position expressed by the Delegation of Cameroon. He emphasized the special nature of OAPI and supported maintenance in paragraph (4)(b) and (c) of the wording in square brackets.

83. The CHAIRMAN suspended the meeting.

[Suspension]

84. The CHAIRMAN reconvened the meeting.

85. Mr. SCHAEFERS (Germany) stated that his Delegation supported the text of the basic proposal in paragraph (4)(c).

86. Mr. WIERZBICKI (New Zealand) expressed the agreement of his Delegation with the comments made by the Delegation of Switzerland. His Delegation supported the text of subparagraphs (b) and (c) in the basic proposal with the deletion of the text within square brackets in both those paragraphs.

87. Mr. SMITH (Australia) expressed the agreement of his Delegation with the observations that had been made by the Delegation of Switzerland. His Delegation supported the text of paragraph (4)(b) and (c) in the basic proposal and, thus, the deletion of the text within square brackets in that paragraph. He added that his Delegation could also support the position of those that preferred the deletion of subparagraphs (b) and (c) of paragraph (4) and, if that were done, there would be little need for items (ii) and (iii) of Article 33(1), but he reserved the position of his Delegation on that last question.

88. Mr. NEERVOORT (Netherlands) asked whether the authorization given under paragraph (4)(c) would be specific to certain subjects or more general and wondered how other Contracting Parties would know on which questions the intergovernmental organization was entitled to exercise the right to vote of its member States.

89. The CHAIRMAN observed that delegates generally had the authority extended to them in the instrument of delegation.

90. Mr. BOGSCH (Director General of WIPO) stated that it would depend on each member State as to whether an authorization were generalized or not. Other Contracting Parties would know the scope of authority to exercise a vote enjoyed by an intergovernmental organization because the Director General would inform them following the receipt of the notification.

91. Mr. HATOUM (Lebanon) supported the text of subparagraph (b) and (c) in the basic proposal and the deletion of the text appearing within square brackets.

92. Mr. ELHUNI (Libya) stated that it was very difficult for his Delegation to accept subparagraphs (b) and (c) unless it was specified that an intergovernmental organization could exercise the right to vote of only those of its member States which were present. He considered that the text within square brackets would, if included, have a discriminatory effect. He recommended the solution that had been adopted in respect of the question under discussion in the Treaty on Intellectual Property in Respect of Integrated Circuits where it was made clear that an intergovernmental organization could exercise the right to vote only of such of its member States who were present.

93. Mr. LOSSIUS (Norway) expressed the support of his Delegation for the text of subparagraphs (b) and (c) in the basic proposal for the reasons that had been given by the Delegation of Switzerland.
94. Mr. HAYASHI (Japan) stated that his Delegation wished to reserve its position on the question whether an intergovernmental organization could become party to the Treaty. If it were decided that intergovernmental organizations could become party to the Treaty, his Delegation considered the text of subparagraph (b) in the basic proposal to be generally acceptable, provided that, as foreseen in the basic proposal, an intergovernmental organization could exercise the right to vote of only such of its member States who were present.
95. Mr. VON ARNOLD (Sweden) expressed the support of his Delegation for the text of subparagraph (h) of paragraph (4) in the basic proposal. He reserved its position on subparagraph (c) of paragraph (4).
96. Mr. GARIEPY (Canada) stated that his Delegation supported the text of subparagraphs (b) and (c) in the basic proposal and, thus, the deletion of the words in square brackets.
97. Mr. JILANI (Tunisia) expressed the agreement of his Delegation with the position taken by the Delegation of Libya. He supported the deletion of the text appearing in square brackets in subparagraphs (b) and (c) and the necessity for a member State to be present before an intergovernmental organization could exercise the right to vote of that State. He asked whether a decision could be taken on those provisions by Main Committee II.
98. The CHAIRMAN stated, in response to the question raised by the Delegation of Tunisia, that, during the first part of the Conference, Main Committee II could examine each of the Articles for which it was responsible in depth, but that it had been decided by the extraordinary session of the Assembly of the Paris Union that no final decision should be taken.
99. M. LY (Senegal) pointed out that notification by the member States of an intergovernmental organization as referred to in paragraph (4)(c) was more than just a formal condition and could have substantive legal implications. He repeated the support of his Delegation for deletion of the square brackets and maintenance of the text in square brackets in paragraph (4)(b) and (c).
100. Mr. PAAERMAA (Finland) expressed the support of his Delegation for the text of subparagraphs (b) and (c) in the basic proposal and, thus, the deletion of the text within square brackets.
101. Mr. TALUKDAR (Bangladesh) raised three questions. He asked, in the first place, whether, if the text within square brackets were accepted, absentee voting could take place in secret. Secondly, he asked, if the text in square brackets were included, whether any Contracting Party should be permitted to delegate the exercise of its right to vote to any other Contracting Party. Thirdly, he asked whether there were any precedents for the delegation of the exercise of the right to vote by one Contracting Party to another Contracting Party.
- 102.1 The CHAIRMAN outlined the preliminary conclusions that had been reached after an extensive exchange of views.

102.2 He stated that the text of subparagraph (a) had been approved.

102.3 He noted that certain Delegations had reserved their position on the question whether intergovernmental organizations should be entitled to become party to the Treaty.

102.4 He stated that the text of subparagraphs (b) and (c) of paragraph (4) had received broad acceptance and that there was little support for the inclusion of the words appearing within square brackets in those subparagraphs. There being a large majority for the text of the basic proposal, that text would be retained as the basis for further discussion.

102.5 He noted that a small difference in wording had been observed in the last sentence of each of subparagraphs (b) and (c) of paragraph (4) and that the Secretariat would attend to the harmonization of those two sentences for the second part of the Conference.

102.6 Concerning subparagraph (d) of paragraph (4), he noted that the text of the basic proposal had been broadly accepted and would provide a basis for further discussion.

102.7 He observed that all Delegations had reserved their position on, and not discussed, subparagraph (e) of paragraph (4) pending the clarification of the final text of Article 35 ("Reservations") of the Treaty.

Article 27(5): [Quorum]

102.8 He then moved to paragraph (5) of Article 27 and observed that the part of that provision which referred to Article 35 should be considered reserved pending the discussion of Article 35. He noted that there were no observations on paragraph (5) and that the text of that paragraph in the basic proposal would thus serve as the basis for further discussion.

Article 27(6): [Majorities]

102.9 He then invited discussion on paragraph (6) of Article 27.

103. Mr. BOGSCH (Director General of WIPO) observed that paragraph (6)(a) envisaged that certain decisions were of such an important nature that they would require higher majorities. He suggested that the discussion of paragraph (6) be delayed until such time as the text of the Treaty was final with respect to those matters on which the Assembly was empowered to take decisions.

Article 27(7): [Sessions]

104.1 The CHAIRMAN invited consideration of paragraph (7). There being no observations, he noted that the text of paragraph (7) in the basic proposal would provide the basis for further discussion.

Article 27(8): [Rules of Procedure]

104.2 He moved to paragraph (8) and, there being no observations, declared that the text of that paragraph in the basic proposal would provide the basis for further discussion.

Article 27(9): [Guidelines]

104.3 He then asked for observations concerning paragraph (9). There being no such observations, he noted that the text of that paragraph in the basic proposal would provide the basis for further discussion.

Rule 11: Absence of Quorum in the Assembly (ad Article 27)

104.4 He invited consideration of Rule 11 ("Absence of Quorum in the Assembly"), which related to Article 27(5). There being no observations, he noted that the text of Rule 11 in the basic proposal was adopted as the basis for further discussion.

Article 28: International Bureau

104.5 The Chairman invited Delegations to address Article 28 ("International Bureau").

105. Mr. BOGSCH (Director General of WIPO) noted that the provisions of Article 28 were similar to analogous provisions in the other treaties administered by WIPO.

106.1 The CHAIRMAN noted that there were no observations and that the text of Article 28 in the basic proposal would form the basis for further discussion.

Article 29: Regulations

106.2 The Chairman invited the Delegations to make observations on Article 29 ("Regulations"). There being no such observations, he declared the text of that Article in the basic proposal to be adopted as the basis for further discussion.

Rule 12: Requirement of Unanimity for Amending Certain Rules (ad Article 29(3))

106.3 He invited observations on Rule 12. There being none, he noted that the text of that Rule in the basic proposal would provide the basis for further discussion.

Article 31: Revision of the Treaty

106.4 The Chairman invited observations on Article 31 ("Revision of the Treaty").

107. Mr. HAYASHI (Japan) stated that his Delegation was of the view that the question of the capacity in which any intergovernmental organization should participate in any future diplomatic conferences for the revision of the Treaty should be discussed on the occasion of each such diplomatic conference, since it could not be foreseen at the present time what the competence of each intergovernmental organization would be in the future.

108.1 The CHAIRMAN noted the statement of the Delegation of Japan and stated that it would be reflected in the records. There being no other observations, he declared that the text of Article 31 in the basic proposal was adopted as the basis for future discussion.

Article 32: Protocols

108.2 He then invited the delegations to address Article 32 ("Protocols").

109. Mr. HAYASHI (Japan) asked why Article 32 provided for the possibility of protocols to the proposed treaty in addition to the possibility of revising the proposed Treaty that was provided for under Article 31. His Delegation considered that the purposes of the further development of the harmonization of patent law could be achieved simply by the revision of the proposed Treaty.

110. Mr. BOGSCH (Director General of WIPO) stated that there was a formal reason and a substantive reason for the two Articles in question. The formal reason was that all of the preparatory meetings to the Diplomatic Conference had accepted the separate procedures of revision and protocol foreseen in Articles 31 and 32, respectively. The substantive reason was that in some cases it was simpler and easier to make a protocol than to revise a treaty.

111. Mr. HAYASHI (Japan) stated that his Delegation wished to consider further the need for Article 32.

112.1 The CHAIRMAN noted the position of the Delegation of Japan.

112.2 He concluded that the text of Article 32 in the basic proposal was adopted as the basis for further discussion.

112.3 He transmitted a message on behalf of the coordinator of the African Group concerning the convening of a meeting of that Group and adjourned the meeting.

Third Meeting
Wednesday, June 19, 1991
Afternoon

113.1 The CHAIRMAN declared open the third meeting of Main Committee II and indicated that accord had been reached as to how to proceed with respect to those substantive Articles of the Treaty that fell within the competence of

Main Committee II, namely, Articles 10 (Fields of Technology), 19 (Rights Conferred by the Patent), 22 (Term of Patents), 24 (Reversal of Burden of Proof), 25 (Obligations of the Right Holder), and 26 (Remedial Measures Under National Legislation). After a series of discussions it had been agreed that the foregoing Articles, along with Article 35 (Reservations), would be dealt with together in their general aspects.

113.2 He then invited the Spokesman of the Group of Developing Countries to present the statement of that Group.

114.1 Mr. KESOWO (Indonesia), speaking on behalf of the Group of Developing Countries, stated that the Group of 77 fully understood and was of the opinion that optimization of the remaining time left for the completion of the discussions on the draft Patent Law Treaty and the Regulations in that Diplomatic Conference was now becoming very important.

114.2 Having carefully observed the process of deliberations which had taken place, the Group of 77 therefore agreed with the Steering Committee's idea that, for practical reasons, the remaining time left in the first part of the Diplomatic Conference should be maximized for the conclusion of the discussions on the Articles in the draft Treaty and Regulations which mainly dealt with technical and administrative aspects.

114.3 The Group of 77 therefore agreed to the suggestion made by the Steering Committee that a package of seven substantive Articles which as of then appeared as Articles 10, 19, 22, 24, 25, 26, and 35 in the draft Patent Law Treaty, contained in the document PLT/DC/3 dated December 21, 1990, be discussed in the second part of the Diplomatic Conference. The Group wished to recall that those Articles contained alternatives that were formally proposed by several developing countries and presented in the document HL/CE/VIII/22 dated June 13, 1990, for incorporation into the basic proposal.

114.4 In that regard, the Group of 77 wished to formally declare that the package of Articles as aforementioned had been endorsed by the Group which would further pursue them at the second part of the Diplomatic Conference. By taking that position, the Group considered it necessary to reiterate some of the fundamental reasons that underlay its proposals in the aforementioned Articles.

114.5 It was absolutely necessary to acknowledge the reality that there were differences of level of socio-economic conditions and attainment among States, as well as in the level of technological capabilities and national legal regimes. This real situation had reflected the differences in needs, interests and priorities in their development concepts and their public policy objectives. To whatever extent they considered the importance of technology and the patent system, it was absolutely imperative that the socio-economic conditions, the needs, the level of development, interest and its priorities, and the public policy objectives, should be taken into proper consideration.

114.6 A Treaty which was meant to harmonize the patent laws should not simply be measured and based on the high standard and practices of technological capabilities obtained in the developed countries, or their high degree of complexity of their patent administration system. Harmonization should result in a genuine harmonization which would not create unwanted problems at later stages when the Treaty was to be accepted and implemented.

114.7 The Treaty should not deal only with rights of the patent's holders but should also reflect a balanced concept and arrangement between rights and obligations.

114.8 By underlining its views, the Group of 77 wished to make it clear that with respect to its position on Article 10 on fields of technology, there should be a degree of flexibility that allowed countries to exclude certain types of technology from their respective patent system. To the developing countries, those exclusions had a very substantial importance in the improvement of people welfare, the enhancement of industrial development and other aspects in their national development. The Group believed that, in that regard, moral and ethical principles that were generally accepted should be taken into consideration. The report produced by the International Bureau contained in the document HL/CM/INF/1 Rev. clearly showed the practices of exclusions in a significant number of countries.

114.9 With regard to Article 19 on the rights conferred by the patents, the Group of 77 was of the view that such elaboration should not go beyond the basic rights of the patent, namely, rights in connection with industrial exploitation of the patented invention and the selling of the resulting products.

114.10 In respect of product patents, the Group was firmly convinced that those basic rights should only consist of the making, selling and using of the patented product, while whether or not the patent confers a right of importation should be left to the national laws.

114.11 As regards process patents, the Group believed that the fundamental rights conferred to the patent holder was to prevent unauthorized use of patented process. They should not extend the protection to products directly obtained from the process because it could allow extension of protection to unpatentable subject matter, or extend the term of product patent that should have lapsed.

114.12 On Article 22 on term of patent, the Group of 77 firmly believed that it should take into consideration the characteristic of modern technological development where a rapid rate of innovation promptly rendered earlier innovation obsolete. The Group was of the view that a single uniform across the board duration or term of patent was not justified as there was a serious disparity at the development level between the developed and developing countries. Therefore, duration of patent protection should be left to national laws.

114.13 The Group of 77 also found immense difficulties with Article 24 on the concept of reversal of burden of proof simply because this was in contradiction with the fundamental and universally accepted legal principle. The inclusion of this concept created further difficulties to the goal of harmonization, since this was only applied in a very limited number of countries. The introduction of this concept would imply that a person might not be able to use or make a product without being placed at risk to proving that he was not infringing somebody's patent.

114.14 The Group of 77 was also of the opinion, that with regard to Article 25 on obligation of rights holders and Article 26 on remedial measures under national legislation, those Articles were vital in insuring the balance

between the exclusive rights conferred by patent and the obligations patent holders have to the public.

114.15 Article 25 which dealt with the rights of a Contracting Party to establish the obligation of working of the patented invention in its territory, represented one of the major requirements, in particular of the developing countries, for granting patent protection.

114.16 The remedial measures under national legislation had been proposed in order to provide for remedies such as grant of non-voluntary licences, revocation and government use in case of non-compliance by patent holders with their obligations.

114.17 With respect to Article 35 on the reservation clause, the Group of 77 expressed its objections to this Article because this provision contained a transitional element that in fact gave no real reservation as widely acknowledged in the international law of treaties.

114.18 Whilst it was the endeavor of the Group of 77 to continue rendering its support to the harmonization exercise, the Group of 77 wished that the present statement could provide for distinct cognizance to this Conference on the Group's position on this important package of Articles contained in the draft Patent Law Treaty. The Group also wished to place it on record that in the Group's view the discussion of this package of Articles would be given priority at the second part of the Diplomatic Conference.

115. The CHAIRMAN invited the Delegation of Portugal to present the statement of the Group B countries.

116.1 Mr. MOTA MAIA (Portugal), speaking on behalf of the Group B countries, stated that Group B was conscious of the diversity of the preoccupations of States, linked to the particularities of their respective situations, namely--but not only--based on economic situation. It was natural that those preoccupations he expressed here and that each one present would favor that the harmonization of industrial property laws, more particularly patent laws, be also in harmony with their respective aspirations. However, it was necessary that the basic grounds for negotiation be assured and that all the elements necessary for decision be covered. Such would not be the case, the delegations would agree, except for purely technical points.

116.2 For certain important topics, to be considered by Main Committee II, many countries were still debating the issues. Likewise, at the international level, as was known, negotiations were being carried out in other fora. At that stage, it was difficult to predict the outcome of those deliberations. Under the present circumstances, it would not be advisable to initiate on these subjects discussions which could not lead to decisions for the reasons known. In that case, the risk would be run, if that route were to be followed, of disrupting national debates or the present negotiations, without gain for anyone.

116.3 The second session of this Diplomatic Conference should be able to examine these problems and find an acceptable solution for all. Group B proposed that efforts now be focussed, as they had started to be, on settling items which could then be settled. Much work remained to complete in the few days at the disposal of the first part of the Conference.

116.4 He then stated that Group B wished to make clear its reactions to the present proposals on the Articles to be considered.

116.5 Article 10: Group B preferred strong patent protection since this better served the development of technology. Further, Group B supported the general trend to provide patent protection in all fields of technology for both products and processes. Therefore Group B believed there should be an Article 10 dealing with fields of technology. In particular, patents should be available both for pharmaceutical and chemical products and for processes for their manufacture.

116.6 Any exclusion from patent protection should be minimal and in any case optional. That was why Group B could not subscribe to paragraph (1) of Alternative A in the Basic Proposal in its present form. Likewise, the Group could not subscribe to paragraph (2) because it would allow arbitrary exclusions from patent protection. It was to be noted that the patent system benefitted all countries, both developed and developing, and that, if technological fields were excluded arbitrarily, incentives for research work would be suppressed. That would be detrimental to all countries.

116.7 Article 19: A provision dealing with the rights conferred by a patent was an essential component of this Treaty. Therefore it should be maintained. Group B prefers a provision specifying the rights conferred by a patent along the lines of Alternative B in Article 19 of the Basic Proposal. In particular, a patent holder should be able to control the commercialization of the patented product, which included the act of putting the product on the market and, therefore, comprised the act of importation. The right to prevent the making of a patented product was only controllable territorially, and a loophole in the protection would occur if a third party could import an infringing product manufactured in a country other than the country where the patent had been granted. The right to control importation was therefore a necessary corollary to the right to make the patented product.

116.8 A right to prevent acts in respect of products directly obtained from a patented process was also essential to ban the distribution of products that had been obtained by infringing the patented process. Where, after the actual infringement of the process, the infringer wanted to market the product obtained by the infringement, he should not be allowed to do so. The provision, therefore, aimed at protecting the patented process, not the resulting product as such. It would avoid circumvention of patents for processes to produce products, the economic value of which existed in the products obtained by the use of the processes. The provision aided the enforcement of a process patent whether it was being infringed secretly within a country or through imports from other countries where the process was being used. In the latter cases, the holder of the process patent should have the possibility of preventing imports of the products obtained by the process. The provision contained in paragraph (2)(ii) of the basic proposal did not restrict third party freedom to use a different process for the manufacture of the relevant products.

116.9 He emphasized that Group B also wished to underline the importance of a provision on contributory infringement since cases of such infringements were becoming more and more frequent.

116.10 Article 22: The countries of Group B believed it was essential that the Treaty include a provision requiring an adequate patent term. One of the most important and essential features of the patent system was that it be capable of providing an adequate reward for investment in research and development. The term of patents had to be set in relation to that objective.

116.11 Article 24: The countries of Group B had a common objective to enhance the protection of process patents. The protection provided by process patents was inherently weak, especially with regard to preventing the commercialization of products obtained from using patented processes. It was frequently difficult, if not impossible, for the patent owner to show that a product was made by a patented process. It was particularly difficult to make such a determination when the products were produced outside the country that granted the process patent. It was therefore essential that a technique be established to place on the alleged infringer the burden of establishing in certain cases that a product was not made by a patented process. Therefore, Group B supported provisions along the lines contained in Alternative B of Article 24.

116.12 Article 25: Group B was in favor of Alternative A, that is to say not to have an Article on the obligations of the right holder in the text of the Treaty. It had serious difficulties with most of the provisions appearing as Alternative B in the Basic Proposal as supported by the Group of 77.

116.13 The other relevant Articles of the draft Treaty contained already well-balanced obligations of inventors seeking patent protection and the rights conferred on them if patents eventually issued from the granting procedure. Therefore, a summary of basic obligations of the patent owner appeared to be unnecessary and redundant, in particular, in the mandatory form as proposed in Alternative B.

116.14 Paragraph (2), referring to any other obligations established in the national law of the State where protection was sought or obtained, was definitely too vague and imprecise and its legal impact unforeseeable.

116.15 Article 26: Group B was in favor of Alternative A, that is to say, not to have an Article or remedial measures under national legislation in the Treaty and strongly opposed to the inclusion of the proposal appearing under Alternative B in the Treaty. In the view of Group B, the list of obligations of the patent owner as contained in Alternative B of Article 25 of the basic proposal was neither necessary nor appropriate, and should not appear in the Treaty. For this reason paragraph (1) of Article 26 loses its reference and starting point and should, therefore, also be deleted. Paragraph (2) of Article 26 refers back to paragraph (1) of the same Article. With the disappearance of Article 25 and paragraph (1) of Article 26, it loses its meaning and, as a consequence, should also be deleted.

116.16 As regards paragraph (3), it was obvious that States could take measures to ensure compliance with conditions attached to the exercise of the rights conferred by the grant of the patent. The scope of and limitation to such measures had been discussed before, in particular, in the context of the attempted revision of the Paris Convention. No agreement could be reached on the matter in those discussions and Group B could not find any merit in repeating those discussions now in the context of the Patent Law Treaty.

116.17 In summary, neither Article 25 nor Article 26 should appear in the text of the Treaty.

116.18 Article 35: As a general rule, a great majority of the member States of Group B were of the opinion that a provision containing certain reservations on the basis of Article 35 could be accepted. Such an Article on reservations could allow a larger number of countries to adhere to the Treaty by providing the necessary time for adaptation. However, it was the hope of Group B in the interest of harmonization that reservations would be kept to a minimum. Group B was continuing to study the scope and nature of the reservations needed to take account of the special interests of developing countries and others.

116.19 It appeared to be too early to express final views on the contents of that Article. It was indispensable first to reach agreement on the contents of those Articles to which the proposed reservations refer.

117. The CHAIRMAN invited the Delegation of China to make its statement.

118.1 Mr. GAO (China) stated that his Delegation wished to present a statement on Articles 10, 19, 22, 24, 25, 26 and 35.

118.2 Like others, it, too, shared the opinion that Article 10, Fields of Technology, was of great importance and therefore needed special emphasis. As had been voiced before, it was the opinion of his Delegation that the question of fields of technology to be covered by patent protection had everything to do with the level of science and technology and economy of various countries. Bearing that in mind, his Delegation thought it reasonable, for the time being, not to set forth identical requirements for all countries. Its third comment was that it was still working on the revision of its law. Therefore, it would be very willing to hear more opinions from all sides on this issue, and one thing was certain, it would do its best to follow the general international trend of harmonization in that regard.

118.3 On Article 19, his Delegation first considered the issue concerning "rights conferred by patents" to be an issue of great importance. Without sufficient protection for the rights of the patentees, there would be no incentives and encouragement for inventors and inventive activities. This was one of the reasons why the patent system in China had been established. In accordance with this, over one thousand patent law suits had been dealt with by the courts or the administrative authorities for patent affairs in China since the enforcement of the Patent Law. This showed that his Delegation attached great emphasis to the protection of the rights conferred by patents.

118.4 Second, his Delegation knew quite clearly that there was some distance between its law and those of most developed countries so far as the level of rights was concerned. But it, too, adopted a positive attitude to this issue. As the first step, it was going to extend the effect of process patents to the products directly obtained by it, which had already been included in the draft revision of the law.

118.5 The present Chinese Patent Law, as those of many countries, took scientific discoveries, rules and methods for mental activities and methods for diagnosis or for the treatment of diseases as non-patentable subject

matter and excluded, for the time being, food, pharmaceutical products, chemical substances and animal and plant varieties from patent protection, while patents were granted for the processes in producing the same products.

118.6 Nevertheless, his Delegation adopted a positive attitude towards the enlargement of fields of technology. While making a comprehensive and deep study on the subject, based on experiences both at home and abroad, it had also outlined to enlarge the scope of field of technology for which patent protection was granted in the days to come, step-by-step.

118.7 Therefore, it was his Delegation's conclusion that, on the one hand, it could certainly agree to a solution to this issue which was supported by the majority and, on the other hand, it agreed to maintain the proposed reservations in the basic proposal, if a broader scope or field of technology, for example, including pharmaceuticals and chemicals, were finally adopted in the Treaty. It thought this would leave more room for more countries to become Contracting Parties.

118.8 As far as the present wording of Alternative B was concerned, it seemed to be so broad that his Delegation would feel it very difficult to accept, even with reservations.

118.9 On Article 22, "Term of Patents," his Delegation noted that the term of a patent for invention as provided for in its current patent law was 15 years from the filing date. However, as stated earlier, it had been working on the revision of our Patent Law which was intended to take into account the proposals made for the patent law harmonization. Extension of the term of patent was one of the major issues being considered for the revision. In fact, it had already been proposed in the draft revision that the term of patent for invention be extended from 15 years to 20 years from the filing date. His Delegation could, therefore, go along with the 20-year minimum duration of protection, as contained in the basic proposal.

118.10 With respect to Article 24, "Reversal of Burden of Proof," his country's current Patent Law contained a similar provision to the same effect, i.e. where the subject matter of the patent was a process for obtaining a product, the burden of establishing that a product was not made by that process was on the alleged infringer. His Delegation believed that such provision provided a practical and effective way for the confirmation of infringement of a process patent, which would facilitate infringement proceedings. For that reason it would reconfirm that Article in its revised patent law in a more clarified way. His Delegation, therefore, was in favor of the provision of the reversal of burden of proof.

118.11 In respect of Articles 25 and 26, "Obligations of the Right Holder" and "Remedial Measures Under National Legislation," his Delegation considered that the rights conferred by the patent and the obligations of the right holder were like the two sides of a matter. A proper balance between the two sides seemed to be appropriate and necessary. Accordingly, it thought that, if Alternative B of Article 19 providing for the rights conferred by the patent prevailed, as a measure of balance, it was appropriate to provide for certain necessary obligations of the right holder and remedial measures for non-compliance with the obligations. Of course, like the rights conferred by the patent, the obligations of the right holder and the remedial measures

should be carefully deliberated before they finally went into the Treaty. For example, revocation and forfeiture of a patent for non-compliance with the obligations for the text of Alternative B of Article 26, seemed inappropriate.

118.12 With respect to Article 35, "Reservations," his Delegation recognized that the objective of the treaty was to harmonize the patent laws of the member States so as to strengthen international cooperation in respect of the protection of inventions. To achieve that objective, it thought that two important points should be kept in mind. One was to try to achieve a high degree of universality of the provisions of the patent laws commonly observed by the member States; and the other was to allow as many States as possible to be members of the Treaty. The two points were equally important and necessary. The lack of any one of the two would greatly diminish the significance of the Treaty. Moreover, in the endeavor for harmonization, it was necessary to be realistic and not to ignore the differences between countries in the various aspects concerned.

118.13 In consideration of the above, and in order to conclude the Treaty at an early date and to have more States join the Treaty, his Delegation was convinced that an option of conditional reservations was necessary. It seemed that reservation was contrary to the concept of harmonization and made harmonization less meaningful, but such an option would pave the way for harmonization and push the member States to move towards the right direction of full harmonization. Otherwise, the risk was that there might be no harmonization at all. His Delegation, therefore, supported the option for making conditional reservations.

119. The CHAIRMAN invited the Delegation of the Soviet Union to make its statement.

120.1 Mr. OUSHAKOV (Soviet Union) stated that the Delegation of the Soviet Union wished to express its opinion and its approach to the Articles appearing in the draft Treaty which were under consideration in Main Committee II. It was difficult for it to confine itself to general phraseology and, therefore, he intended to speak in detail in respect of all those Articles, while trying to be very brief.

120.2 First of all, his Delegation considered of paramount importance the inclusion into the text of the Treaty of Article 10 defining the fields of technology in which patent protection was provided to inventions. It preferred Alternative B, since it responded in the best way to the interests of harmonization, as well as those of inventors. Contrary to that, Alternative A in fact preserved the existing situation which prevented harmonization. Moreover, the proposed wording of Alternative A did not suit it since it provided for certain exclusions from patent protection. Such exclusions were not provided for in the patent law of his country. This fully applied to subparagraphs (ii) and (iv) of paragraph (1). Provided those two subparagraphs were deleted from paragraph (1), his Delegation was ready, along with other delegations, to find an acceptable wording for Article 10.

120.3 Article 19, appearing in the draft Treaty, should definitely remain in the text of the Treaty, because it dealt with the most important issue, that is the legal effects of the grant of patents. His Delegation subscribed to Alternative B of Article 19.

120.4 He hoped that Article 22, dealing with the term of patents, remained in the text of the Treaty, that is, his Delegation subscribed to Alternative B of that Article.

120.5 His Delegation supported the wording of Article 23, dealing with enforcement of rights, as appearing in the basic proposal.

120.6 During the sessions of the Committee of Experts, considerable time was devoted to the debate on Article 24, dealing with the reversal of the burden of proof. His Delegation considered that the wording appearing in the basic proposal was quite satisfactory and therefore it supported Alternative B in Article 24.

120.7 Turning to Article 25, which dealt with the obligations of the right holder, in the opinion of his Delegation, in essence, there would be no difference at all whether this Article remained in the text of the Treaty or not. It considered that Article to be of a clearly declarative nature. The obligations listed in Article 25 were also contained in other Articles of the draft Treaty. Therefore, it did not provide for any additional obligations for the right holders. Of course, if consensus should be reached on this article, it would be prepared to do its part and consider acceptable alternatives.

120.8 In respect of Article 26, dealing with remedial measures under national legislation, his Delegation supported Alternative A.

120.9 Article 35 deserved a special mention. The best solution serving the purpose of harmonization would be no such article in the text of the Treaty. Such a solution in the opinion of his Delegation was quite possible provided the key articles of the Treaty were considered as a package. That package, in its opinion, covered Article 9, providing that the patent shall belong to the first applicant and Article 12, as well as Articles 19 to 24.

120.10 Proceeding from the debate, it was clear that quite a number of Articles lack the necessary consensus. Considering that situation, the Delegation of the Soviet Union considered it possible as a first step in the direction of harmonization, for the Articles enumerated, to proceed from Alternative B in Article 35. That Alternative could be supplemented by a paragraph providing for a transitional period to introduce in all countries the system of the first to file.

120.11 To conclude his intervention, he drew certain conclusions in respect of the Articles under consideration. His Delegation considered that it would not be appropriate to make the debate on the said Articles dependent on the results of the Uruguay Round Negotiations within GATT and to defer approval until such negotiations were over. It presumed that the delegations participating in the Conference were confident and experienced enough to show their expertise in the search for compromise solutions which would eventually make it possible to reach agreement on the text of the Treaty and sign it. But, as it understood, it created certain difficulties for a number of delegations. Nevertheless, it looked forward with optimism to the process of finalizing the Treaty on harmonization.

121. The CHAIRMAN stated that due note would be taken of the statements and that they would be reflected in the records of the Conference. He observed that those statements concluded discussion on Articles 10, 19, 22, 24, 25, 26

and 35 for the first part of the Conference, but that an in-depth discussion on those Articles would take place in the second part. In that regard, the basic proposal would be considered as the basis for further discussion in the second part of the Conference, as well as the proposals for amendment that had been submitted during the first part.

Fourth Meeting
Thursday, June 20, 1991
Afternoon

122.1 The CHAIRMAN opened the meeting and stated that it was his intention to proceed in a stream-lined manner in order to complete consideration of the Articles that had not been yet examined by Main Committee II.

Article 33: Becoming Party to the Treaty

122.2 He turned to Article 33 ("Becoming Party to the Treaty") and invited the Director General to introduce the first paragraph of that Article.

Article 33(1): [Eligibility]

123.1 Mr. BOGSCH (Director General of WIPO) stated that paragraph (1) of Article 33 specified the entities that could become party to the Treaty. Item (i) of the paragraph provided that States could become a party, but not all States: only those States that were party to the Paris Convention and in respect of which patents might be obtained either through the State's own Office or through the Office of another Contracting Party.

123.2 Item (ii) of paragraph (1) dealt with one kind of intergovernmental organization that could become party to the Treaty, namely, an intergovernmental organization that was competent in matters governed by the Treaty and which had established on such matters norms that were binding on all its members States, provided that all those States were party to the Paris Convention. At that time, there was no organization that fulfilled those requirements; however, it might be expected that in the future one or more intergovernmental organizations might be in a position to accede to the Treaty by virtue of that provision. In particular, that could be the case for the European Communities.

123.3 Item (iii) of paragraph (1) dealt with another kind of intergovernmental organization, namely, an intergovernmental organization which maintained an Office granting patents with effect in more than one State, provided that all its member States were party to the Paris Convention. The Organisation africaine de la propriété intellectuelle (OAPI) and of the European Patent Organisation (EPO) would fit into that category.

124. Mr. HIDALGO LLAMAS (Spain) stated that, following instructions from his Government, his Delegation reserved its position on paragraph (1)(ii) of Article 33.

125. Mr. VON ARNOLD (Sweden) stated that his Delegation reserved its position on item (iii) of paragraph (1).

126. Mr. HAYASHI (Japan) stated his Delegation reserved its position on items (ii) and (iii) of paragraph (1). He added that his Delegation had some concerns as to whether items (ii) and (iii) were consistent with Article 19 of the Paris Convention, which provided for the right of Contracting States to the Paris Convention to conclude between themselves special agreements for the protection of industrial property. If Article 19 did not prohibit the conclusion of special agreements with intergovernmental organizations, his Delegation considered it necessary that the legal basis for such assertion be elucidated and made explicit.

127.1 Mr. BOGSCH (Director General of WIPO), in response to the previous speaker, stated that the question whether an intergovernmental organization could become party to a Treaty was a question of public international law. In recent years intergovernmental organizations had become party to an important number of treaties and the capacity of those organizations to conclude those treaties was well established.

127.2 In relation to the question whether States party to the Paris Convention could conclude special agreements under Article 19 with entities not party to the Paris Convention, he stated that, in that respect, there was also a well-established practice. There were many instances of agreements for the protection of industrial property among parties and non-parties to the Paris Convention. One such example was the agreement on the creation of an industrial property organization for English-Speaking Africa (ARIPO). An eventual agreement on trade related aspects of intellectual property rights (TRIPS) in the Uruguay Round of trade negotiations could also be another instance of a special agreement open to the participation of States that were not party to the Paris Convention. As far as he was aware, no suggestion had been made in order to exclude from an eventual TRIPS agreement the States that were not party to the Paris Convention.

128. Mr. SMITH (Australia) stated that his Delegation reserved its position concerning items (ii) and (iii) of paragraph (1). He added that the explanations provided by the Director General would be taken into account in defining the position of his Delegation.

129. Mr. ROMERO (Chile) requested from the Director General clarification as to the meaning of the terms "competent in matters governed by this Treaty" in item (ii).

130. Mr. BOGSCH (Director General of WIPO) observed that the words referred to by the Delegation of Chile had been discussed in the Committee of Experts. What was envisaged was the situation of an intergovernmental organization that would have competence on some of the matters concerning patents that would be governed by the Treaty. He reiterated that, at that moment, there was no such intergovernmental organization, but the possibility of the European Communities, and perhaps also of intergovernmental organizations in other parts of the world, having some competence in the future should be taken into account.

131.1 Mrs. JESSEL (CEC) stated that, some years back, one could understand the hesitation in certain quarters in recognizing the European Communities as a contracting party to an international treaty. The European Communities were a reality that went beyond the framework of existing legal categories; they did not of course constitute a State, but nor were they a simple international organization in the usual meaning of the word.

131.2 An international treaty had the vocation of addressing the future. It would therefore be quite incoherent, in her view, at the close of the 20th century for a treaty whose substantive provisions endeavored to regulate the protection of the industrial property of tomorrow not also to be aimed at the future with regard to the parties that could accede to it. She pointed out that it was a treaty concerning industrial property, and more particularly patents, which had an acknowledged economic impact and it was therefore not possible for the European Communities not to introduce the industrial property dimension into their policies. She added that it was a basic principle of the European Communities that they exercised, in well-defined fields, their competence as such in lieu of their member States. It would therefore be regrettable if, for the want of a possibility for the Communities to accede to the Treaty at the appropriate time, essential matters concerned by the Treaty would escape a non-negligible part, to say the least, of today's world.

132. Mr. LOSSIUS (Norway) stated that his Delegation did not have final instructions in respect of subparagraph (ii) and therefore he reserved the position of his Delegation.

133.1 The CHAIRMAN stated that due note was taken of the reservations expressed during the discussions of paragraph (1). He added that the text of that paragraph in the basic proposal would be the basis for further discussion in the second part of the Diplomatic Conference.

133.2 He then invited observations on paragraphs (2) and (3) of Article 33.

Article 33(2): [Signature; Deposit of Instrument]

Article 33(3): [Condition as to Effect of Instrument]

134. Mr. BOGSCH (Director General of WIPO) drew attention to a mistake in the text of paragraph (3)(a). The reference to "paragraph (1)(i) or (iii)" should have read "paragraph (1)(i) to (iii)."

135. Mr. HAYASHI (Japan) requested clarification as to the reasons why paragraph (3) provided for conditional deposits.

136. Mr. BOGSCH (Director General of WIPO) stated that, as had been discussed in the Committee of Experts, a State might be willing to become bound by the Treaty only on the condition that certain other States or intergovernmental organizations were also bound by it. Paragraph (3), therefore, provided for conditional deposits that would allow States or intergovernmental organizations to issue their respective instruments of accession or ratification with a declaration making their deposit effective on the deposit of the instrument of accession or ratification of other eligible States or intergovernmental organizations.

137.1 The CHAIRMAN concluded that the text of paragraphs (2) and (3) in the basic proposal would be the basis for further discussion.

Article 34: Effective Date of Ratifications and Accessions

137.2 He invited the Committee to consider Article 34 ("Effective Date of Ratifications and Accessions").

138.1 Mr. BOGSCH (Director General of WIPO) observed that Article 34 did not have the same significance as in other treaties, in view of the provisions in Article 33 concerning conditional deposit of instruments of accession and ratification.

138.2 He recalled that the Committee of Experts had discussed the number of instruments of ratification or accession that would have to be deposited in order that the Treaty could enter into force. The text of the basic proposal reflected those discussions and provided for a number of eight instruments of ratification or accession from either States or intergovernmental organizations.

139. Mr. HAYASHI (Japan) stated that the reference to intergovernmental organizations in paragraph (1) should be deleted because it could give rise to double counting in cases where instruments had been deposited by an intergovernmental organization and one of its member States.

140. Mr. BOGSCH (Director General of WIPO) observed that there would not necessarily be double counting since, where an intergovernmental organization may become party to Treaty even if none of its member States were party to the Treaty, the question of double counting could not even arise.

141.1 The CHAIRMAN stated that due note had been taken of the concern of the Delegation of Japan. He concluded that the text of Article 34 in the basic proposal would be the basis for further discussion.

Article 36: Special Notifications

141.2 He then invited the Committee to consider Article 36 ("Special Notifications").

142. Mr. BOGSCH (Director General of WIPO) stated that Article 36 was important because in some countries patents were granted by intergovernmental organizations or, at the choice of the applicant, by a national Office or an intergovernmental organization. The purpose of Article 36 was to ensure that those situations were known to all the Contracting Parties. He added that, naturally, the reservations put forward by some delegations in respect of the eligibility of intergovernmental organizations to become parties to the Treaty extended, where applicable, to Article 36.

143.1 There being no observations from the delegations, the CHAIRMAN concluded that the text of Article 36 in the basic proposal would be the basis for further discussion.

Article 37: Denunciation of the Treaty

143.2 There being no comments on this Article, he concluded that the text of Article 37 in the basic proposal would be the basis for further discussion.

Article 38: Language of the Treaty; Signatures

143.3 Since there were no comments on Article 38, he concluded that the text of Article 38 in the basic proposal would be the basis for further discussion.

Article 39: Depositary

143.4 He invited the Committee to consider Article 39 ("Depositary").

144. Mr. HAYASHI (Japan) requested clarification as to why Article 39 did not specify the functions of the depositary authority.

145. Mr. BOGSCH (Director General of WIPO) stated that the matter had been discussed in previous diplomatic conferences convened by WIPO where it had been considered that, since the functions of the depositary were spelt out in the Vienna Convention on the Law of Treaties, there was a general understanding of what the tasks of a depositary were.

146. There being no other comments, the CHAIRMAN concluded that the text of Article 39 in the basic proposal would be the basis for further discussion.

147. Mr. BOGSCH (Director General of WIPO) congratulated and thanked the Chairman of Main Committee II for his work and for the efficient manner in which he had conducted the proceedings of the Committee.

148.1 The CHAIRMAN thanked the Director General for the efficient cooperation of the Secretariat and expressed his gratitude to the interpreters.

148.2 He adjourned the meeting.

[End]

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 Intervention in the Plenary: 96

EFON V. (OAPI)

Head of the Delegation: 547
 Intervention in the Plenary: 97
 Intervention in Main Committee I: 1591; 1644

EGGER P. (Switzerland)

Delegate: 543

ELHUNI S. (Libya)

Head of the Delegation: 536
 Intervention in the Plenary: 63; 1185
 Interventions in Main Committee I: 108; 187; 305; 465; 650;
 845; 1185; 1397; 1544;
 1830; 1832; 1834
 Intervention in Main Committee II: 92

ENAJARVI M. (Finland)

Head of the Delegation: 530
 Interventions in the Plenary: 18; 51

ENÇ E.A. (Turkey)

Alternate Head of the Delegation: 544
 Interventions in Main Committee I: 447; 550; 655; 800; 850;
 978; 1005

ENGELS M.A.J. (Netherlands)

Head of the Delegation: 536
 As President of the Conference: 39; 40; 41; 48; 49; 60;
 65; 111; 124; 126; 129;
 136; 137; 138; 140; 142; 147

ENGHOLM C. (Sweden)

Adviser: 543

ERHAN V. (Romania)

Alternate Head of the Delegation: 540
 Intervention in the Plenary:

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- ESCUADERO CACERES S. (Chile)
Delegate: 528
Interventions in Main Committee I: 436; 1597
Interventions in Main Committee II: 32; 77
- ESSAMA D. (Cameroon)
Delegate: 527
- EVERITT C.J. (FICPI)
Observer: 552
Interventions in Main Committee I: 484; 684
- FAWCETT R. (United Kingdom)
Delegate: 544
- FEIRING K. (FICPI)
Observer: 552
- FERNÁNDEZ M.I. (Srta.) (Argentina)
Delegate: 525
Interventions in Main Committee II: 43, 67
- FERRAO L. (CEC)
Observer: 549
- FIORITO E.G. (United States of America)
Adviser: 545
- FITZPATRICK S. (Ireland)
Alternate Head of the Delegation: 533
Intervention in Main Committee I: 1606
- FOROUDI E. (Mrs.) (Iran (Islamic Republic of))
Delegate: 533
- FORTINI M. (Italy)
Head of the Delegation: 534
Intervention in the Plenary: 86
- FUCHS A. (Srta.) (Mexico)
Head of the Delegation: 537
Intervention in the Plenary: 74
Intervention in Main Committee II: 49

FUJITA K. (Japan)

Head of the Delegation: 534

Intervention in the Plenary:

GALASSO A. (Italy)

Delegate: 534

Interventions in Main Committee I: 1500; 1770

GAO L. (China)

Head of the Delegation: 528

Interventions in the Plenary: 16; 68

Interventions in Main Committee I: 32; 98; 146; 475; 640; 1289

Intervention in Main Committee II: 118

GARIEPY J.H.A. (Canada)

Head of the Delegation: 527

Interventions in the Plenary: 24; 75

Interventions in Main Committee I: 14; 63; 86; 177; 237;
280; 350; 370; 426; 526;
580; 623; 799; 846; 943;
1012; 1132; 1171; 1221;
1230; 1355; 1380; 1421;
1453; 1481; 1537; 1594;
1634; 1679; 1737

Interventions in Main Committee II: 40; 96

GAULTIER G. (AIPPI)

Observer: 550

GELISSEN M.J.W. (APA)

Observer: 550

GEUZE M.C. (GATT)

Observer: 549

GOEBEL F. P. (Germany)

Delegate: 531

GOLDRIAN H. (BDI)

Observer: 550

Interventions in Main Committee I: 36; 893; 1549; 1651

GOLDRIAN H. (DVGR)

Observer: 551

Intervention in the Plenary: 120

Intervention in Main Committee I: 36

GOLDRIAN H. (UNICE)

Observer: 553

Intervention in the Plenary: 120

GOMEZ MONTERO J. (Spain)

Delegate: 541

Intervention in Main Committee I: 1490

GORMLEY J. (Ireland)

Delegate: 534

GREVER F. (CIPS)

Observer: 551

GROSSENBACHER R. (Switzerland)

Head of the Delegation: 543

Interventions in the Plenary: 26; 54

Intervention in Main Committee I: 6

GÜEMEZ NAUT I. (Dominican Republic)

Head of the Delegation: 530

GUERRINI M. (France)

Alternate Head of the Delegation: 530

Interventions in Main Committee I: 90; 381; 389; 405; 422;
431; 455; 501; 728; 771;
773; 1488; 1565; 1570;
1577; 1579; 1595; 1613;
1633; 1653; 1673; 1688;
1702; 1749; 1762; 1794

Intervention in Main Committee II: 37

GURRY F. (WIPO)

Special Assistant, Office of the Director General: 553

HACHEME A. (Benin)

Head of the Delegation: 526

Intervention in the Plenary: 28; 106; 199

HADJ-SADOK D. (Algeria)

Head of the Delegation: 525

Interventions in Main Committee I: 472; 561; 639; 801

HANNEMAN H.W.A.M. (CIPS)

Observer: 551

HARA M. (Japan)

Delegate: 535

HARDEN B.G. (United Kingdom)

Deputy Head of the Delegation: 544

Interventions in Main Committee I: 275; 294

HARTNACK P. (United Kingdom)

Delegate: 544

HATOUM M.S. (Lebanon)

Head of the Delegation: 535

Interventions in the Plenary: 21; 69

Interventions in Main Committee I: 33; 65; 81; 189; 288;
337; 339; 342; 388; 390;
441; 482; 489; 517; 586;
588; 613; 719; 738; 751;
753; 768; 804; 859; 873;
948; 1034; 1146; 1158;
1216; 1260; 1298; 1379;
1406; 1448; 1508; 1551;
1599; 1656; 1690; 1720; 1764

Interventions in Main Committee II: 22; 46; 91

HAVERMANS A.J.E. (Burgomaster of The Hague)

Intervention in the Plenary: 4

HAYASHI H. (Japan)

Delegate: 535

Intervention in Main Committee II: 36; 41; 52; 94; 107; 109;
111; 126; 135; 139; 144

HENNESSEY W. (ABA)

Observer: 550

Intervention in Main Committee I: 35

HIDALGO LLAMAS M. (Spain)

Delegate: 541

Interventions in Main Committee I: 1328; 1442; 1603

Interventions in Main Committee II: 57; 124

HIEN M. (Burkina Faso)

Head of the Delegation: 527

Interventions in the Plenary: 27; 55

Interventions in Main Committee I: 16; 111; 202; 448; 643;
887; 931

Intervention in Main Committee II: 19

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- HIJMANS D. (APA)
Observer: 550
Interventions in Main Committee I: 480; 568
- HIRSCH M-R. (FICPI)
Observer: 552
- HOOGSTRAATEN W.C.R. (UNICE)
Observer: 553
- HOOGSTRATEN W.C.R. (CIPS)
Observer: 551
- HOPTROFF C.G.M. (United Kingdom)
Delegate: 544
- HORVÁTH Z. (Hungary)
Delegate: 532
- HOSOE T. (JPA)
Observer: 552
Interventions in Main Committee I: 892; 1060
- HOWARD A. (CEC)
Observer: 549
- HUYGENS A.V. (CIPS)
Observer: 551
- HUYGENS A.V. (UNICE)
Observer: 553
- HY A.A. (Sudan)
Delegate: 542
- IANNANTUONO P. (Italy)
Alternate Head of the Delegation: 534
Interventions in Main Committee I: 558; 780; 867; 913; 999;
1344; 1593
- IDDI S.A. (United Republic of Tanzania)
Head of the Delegation: 545
Interventions in the Plenary: 47; 90
Interventions in Main Committee I: 316; 665

INOUE Y. (APAA)

Observer: 550

IVÁNYI I. (Hungary)

Head of the Delegation: 532

Interventions in Main Committee I: 560; 973; 1535

JAKL L. (Czechoslovakia)

Head of the Delegation: 529

Intervention in the Plenary: 81

Interventions in Main Committee I: 34; 147; 293; 556; 629;
762; 1148; 1208; 1543; 1669

JANSSEN F. (UPEPI)

Observer: 553

JAYASINGHE K. (Sri Lanka)

Head of the Delegation: 542

Interventions in the Plenary: 20; 78; 927; 929

Intervention in Main Committee I: 129

Intervention in Main Committee II: 13

JENNY F.A. (Switzerland)

Delegate: 543

Interventions in Main Committee I: 255; 257; 904; 936; 1254

JESSEL S. (Mme) (CEC)

Observer: 549

Intervention in the Plenary: 113

Interventions in Main Committee I: 31; 128

Interventions in Main Committee II: 73; 131

JILANI A. (Tunisia)

Head of the Delegation: 543

Interventions in the Plenary: 31; 91

Interventions in Main Committee I: 104; 435; 548; 616; 627;
835; 1401

Intervention in Main Committee II: 97

JIMÉNEZ D. (Sra.) (Mexico)

Alternate Head of the Delegation: 537

KAINAMURA B. (Uganda)

Head of the Delegation: 544

Intervention in the Plenary: 103

Interventions in Main Committee I: 466; 646; 877

Intervention in Main Committee II: 69

KAMEL S. (Egypt)

Head of the Delegation: 530
Interventions in the Plenary: 45; 110; 139
Interventions in Main Committee I: 15; 99; 141; 184; 289;
440; 491; 521; 648; 745;
848; 1044; 1176; 1202;
1258; 1367; 1399; 1482;
1585; 1716; 1755; 1829
Interventions in Main Committee II: 7; 33

KANE F. (Senegal)

Head of the Delegation: 540

KANG J. (Republic of Korea)

Delegate: 540

KEEFAUVER W.L. (United States of America)

Adviser: 545

KENT J.W. (Argentina)

Head of the Delegation: 525
Intervention in the Plenary: 67

KESOWO B. (Indonesia)

Alternate Head of the Delegation: 533
Interventions in the Plenary: 125; 144; 155
Interventions in Main Committee I: 100; 157; 307; 454; 490;
519; 656; 803; 1243; 1527
Intervention in Main Committee II: 114

KHRIESAT M.A. (Jordan)

Head of the Delegation: 535
Intervention in the Plenary: 80
Interventions in Main Committee I: 119; 183; 395; 523; 674;
805; 837; 1130; 1181;
1207; 1382; 1645; 1828
Intervention in Main Committee II: 62

KHUMALO Z.A. (Swaziland)

Head of the Delegation: 542
Interventions in the Plenary: 25; 70
Interventions in Main Committee I: 26; 205; 631; 883; 1545
Intervention in Main Committee II: 12

KIM C. (Republic of Korea)

Head of the Delegation: 539
Interventions in the Plenary: 22; 130
Interventions in Main Committee I: 28; 112; 563; 645

KIM J-K. (Republic of Korea)
 Delegate: 540

KIM U.H. (Democratic People's Republic of Korea)
 Head of the Delegation: 529
 Intervention in the Plenary: 94
 Interventions in Main Committee I: 115; 662; 1540

KIMURA H. (Japan)
 Delegate: 535
 Intervention in the Plenary:

KIRK M.K. (United States of America)
 Alternate Head of the Delegation: 545
 Interventions in Main Committee I: 52; 59; 73; 92; 138; 179;
 185; 216; 221; 228; 234;
 245; 279; 321; 325; 334;
 354; 367; 376; 394; 396;
 403; 415; 438; 514; 535;
 604; 618; 663; 669; 716;
 723; 732; 794; 808; 810;
 814; 828; 831; 833; 839;
 856; 896; 905; 918; 920;
 944; 959; 961; 972; 979;
 1002; 1019; 1036; 1072;
 1075; 1095; 1129; 1162;
 1198; 1211; 1217; 1222;
 1248; 1284; 1287; 1314;
 1318; 1322; 1324; 1326;
 1362; 1375; 1387; 1389;
 1391; 1393; 1395; 1405;
 1410; 1414; 1435; 1440;
 1470; 1478; 1515; 1529;
 1559; 1569; 1584; 1601;
 1635; 1637; 1672; 1700;
 1707; 1711; 1721; 1729; 1731
 Intervention in Main Committee II: 39

KLAPWIJK D. (IFIA)
 Observer: 552

KNITTEL H. (Austria)
 Delegate: 526
 Intervention in the Plenary: 76
 Interventions in Main Committee I: 23; 109; 148; 192; 292;
 450; 544; 626

KOLLE G. (EPO)
 Delegate: 547
 Interventions in Main Committee I: 197; 353; 442; 909; 1144;
 1333

KONO N. (Japan)

Adviser: 535

KORCHAGUIN A.D. (Soviet Union)

Delegate: 541

Interventions in Main Committee I: 107; 145; 191; 295; 444;
761; 849; 1100; 1252;
1365; 1446; 1497

KOTARBA W. (Poland)

Head of the Delegation: 539

Intervention in the Plenary:

KRUDO SANES L.N. (Srta.) (Uruguay)

Head of the Delegation: 546

Intervention in the Plenary: 32

Interventions in Main Committee I: 117; 452; 673; 884; 1057;
1239; 1438; 1541

KUNHARDT H. (CEC)

Observer: 549

KUNKUTA M.C.J. (Zambia)

Head of the Delegation: 546

Intervention in the Plenary: 89

Interventions in Main Committee I: 477; 666; 864; 1240

KUSUMO PRIYO H. (Indonesia)

Delegate: 533

LACHOWICZ G. (Ms.) (Poland)

Delegate: 539

Intervention in the Plenary: 98

Interventions in Main Committee I: 40; 206; 299; 557; 630;
765; 974; 1538

LAGMAN S. (Sweden)

Adviser: 543

LANGTON D. (PTIC)

Observer: 552

Intervention in the Plenary: 119

LECCA J. (UEPIP)

Observer: 553
 Interventions in Main Committee I: 1343; 1555; 1624
 Intervention in Main Committee II: 75

LEDAKIS G. (WIPO)

Legal Counsel and Director, General Administrative Services: 553
 Interventions in the Plenary: 42; 141

LEVIS M.N. (Sra.) (ALIFAR)

Observer: 550
 Intervention in the Plenary: 117
 Interventions in Main Committee I: 132; 1115; 1468; 1521; 1617

LICARI J. (Malta)

Head of the Delegation: 537
 Intervention in Main Committee I: 661

LILJEGREN E. (Ms.) (Norway)

Delegate: 538
 Interventions in Main Committee I: 204; 866; 985; 1215

LIMSCHOON B. (Thailand)

Delegate: 548

LINCK N.J. (Mrs.) (AIPLA)

Observer: 550
 Intervention in Main Committee I: 1042; 1173; 1433; 1460;
 1507; 1660; 1772; 1790

LIU G. (China)

Adviser: 528

LOSSIUS P.T. (Norway)

Head of the Delegation: 538
 Interventions in Main Committee I: 106; 284; 476; 509; 530;
 659; 1251; 1278; 1282;
 1378; 1449; 1485; 1717; 1723
 Intervention in Main Committee II: 93; 132

LY M.B. (Senegal)

Adviser: 540
 Interventions in Main Committee I: 121; 451
 Interventions in Main Committee II: 82; 99

MACKEY L.B. (United States of America)
Adviser: 545

MADARI T. (Hungary)
Delegate: 532
Intervention in the Plenary:

MAKHETHA K. (Ms.) (UN)
Observer: 549

MAKWINJA B.Y.M. (Malawi)
Delegate: 536

MALDONADO R. (SELA)
Observer: 549
Intervention in the Plenary:

MANBECK, H.P. Jr. (United States of America)
Head of the Delegation: 545
Intervention in the Plenary: 64
Interventions in Main Committee I: 4; 46; 1666

MANSALA M-L. (Mrs.) (Finland)
Delegate: 530

MANTERE E. (Finland)
Delegate: 530
Interventions in Main Committee I: 114; 554

MANZOLILLO DE MORAES V. (Brazil)
Delegate: 526
Intervention in the Plenary: 107
Interventions in Main Committee I: 89; 445; 503
Intervention in Main Committee II: 21

MARS P. (UNICE)
Observer: 553

MARTÍN BURGOS J.A. (Spain)
Delegate: 541
Intervention in Main Committee I: 885

MATHABELA A.M (Swaziland)
Delegate: 542

MAZA LLOVET B. (Sra.) (Cuba)
 Delegate: 529

MAZURRA HERNANDEZ G. (Cuba)
 Head of the Delegation: 529

MBUYU K. (Zaire)
 Head of the Delegation: 546
 Intervention in the Plenary: 84
 Interventions in Main Committee I: 25; 468; 532; 634; 878;
 1542

MEBIUS E.J. (GIFAP)
 Observer: 552

MEDHURST R. (IPO)
 Observer: 552

MELLER M.N. (ABA)
 Observer: 550
 Interventions in Main Committee I: 1342; 1505; 1696

MELLER M.N. (NYPTC)
 Observer: 553
 Interventions in Main Committee I: 1274; 1301; 1458; 1505; 1550

de MELLO-FRANCO A.A. (Brazil)
 Head of the Delegation: 526
 Intervention in the Plenary: 23

MERRYLEES D. (ABPI)
 Observer: 550

MESSERLI P. (Switzerland)
 Alternate Head of the Delegation: 543
 Interventions in Main Committee I: 57; 93; 160; 186; 239;
 285; 336; 373; 419; 428;
 497; 512; 537; 591; 599;
 601; 612; 644; 705; 713;
 746; 861; 968; 1022; 1041;
 1123; 1136; 1161; 1321;
 1323; 1363; 1396; 1462;
 1476; 1583; 1622; 1657; 1680
 Intervention in Main Committee II: 81

-
- MICHEL J. (EPO)
Delegate: 547
- MIKAMI Y. (Japan)
Adviser: 535
- MILANDOU P. (Congo)
Head of the Delegation: 529
Intervention in the Plenary: 102
- MILLS D.M. (Ghana)
Head of the Delegation: 531
Interventions in Main Committee I: 181; 300; 459; 531; 679;
755; 871; 1205
- MIRANDA J.A. (AMPPI)
Observer: 550
- MITCHELL R.E. (PTIC)
Observer: 552
Interventions in Main Committee I: 1270; 1371; 1512; 1649; 1694
- MKWANAZI B.R. (Mrs.) (Swaziland)
Delegate: 542
Intervention in Main Committee I: 1004
Intervention in Main Committee II: 79
- MNGOMEZULU P.S. (Swaziland)
Alternate Head of the Delegation: 542
- MOAYEDODDIN M.H. (Iran (Islamic Republic of))
Delegate: 533
- MOHAMED MOCTAR O.Y. (Mauritania)
Head of the Delegation: 537
- MOITA F.M.B. (Portugal)
Head of the Delegation: 539
- MOLINOS L. (Sra.) (Venezuela)
Delegate: 548
Intervention in Main Committee I: 127

MOSSAZ B. (WIPO)

Head, Conference, Communications and Procurement Section: 553

MOTA MAIA J. (Portugal)

Alternate Head of the Delegation: 539

Interventions in the Plenary: 43; 53; 143

Interventions in Main Committee I: 9; 61; 74; 97; 287; 402;
564; 760; 1236; 1424;
1463; 1484

Interventions in Main Committee II: 18; 116

MOUJJEVLEV V. (WIPO)

Senior Translator: 553

MOUSSA F. (IFIA)

Observer: 552

MSOSA A.S.E. (Malawi)

Alternate Head of the Delegation: 536

Interventions in Main Committee I: 660; 882

MTETEWAUNGA S.D. (United Republic of Tanzania)

Delegate: 545

Interventions in Main Committee I: 123; 1547

MTETWA A. (Zimbabwe)

Head of the Delegation: 547

Intervention in the Plenary: 108

MÜHLENS P. (Germany)

Delegate: 531

MWINYIMBEGU K.S. (United Republic of Tanzania)

Delegate: 545

MYRICK R.E. (IPO)

Observer: 552

NAGORE SAN MARTIN L. (Spain)

Delegate: 541

NAZAR ESPECHE F.A. (ALIFAR)

Observer: 550

NEERVOORT W. (Netherlands)

Deputy Head of the Delegation: 538

Interventions in Main Committee I: 13; 60; 154; 174; 240;
273; 286; 385; 430; 499;
725; 759; 796; 842; 916;
935; 970; 998; 1033; 1067;
1156; 1165; 1200; 1231;
1350; 1369; 1483; 1596;
1640; 1682; 1706; 1709;
1726; 1807; 1810; 1815; 1817

Intervention in Main Committee II: 15; 88

NÉMETH A. (Ms.) (Hungary)

Delegate: 532

NEUKOM J.U. (CIPA)

Observer: 551

Interventions in Main Committee I: 951; 1117; 1267; 1383;
1444; 1546; 1659

NEUKOM J.U. (CNIPA)

Observer: 551

NEUKOM J.U. (EPI)

Observer: 552

NGOUA-MEYO B. (Gabon)

Head of the Delegation: 531

Intervention in the Plenary: 133

NGUYEN LUONG (Viet Nam)

Head of the Delegation: 546

NIEDERLEITHINGER E. (Germany)

Head of the Delegation: 531

NICAISE J. (Netherlands)

Delegate: 538

NOLA E. (Italy)

Delegate: 534

NORICHIKA K. (JPA)

Observer: 552

NORICHIKA K. (PIPA)

Observer: 553

NOSOLINY J.A. (Guinea Bissau)

Head of the Delegation: 532

Intervention in the Plenary: 135

NTAHOMVUKIYE E. (Burundi)

Head of the Delegation: 527

Interventions in the Plenary: 37; 100

Interventions in Main Committee I: 664; 806

NUCRLAHTI-SOLARMO E. (Mrs.) (Finland)

Delegate: 530

Interventions in Main Committee I: 678; 915; 1498

NYILIMBILIMA J.M.V. (Rwanda)

Head of the Delegation: 540

Intervention in the Plenary: 79

Interventions in Main Committee I: 96; 473; 692; 756

O'FARRELL B. (Ireland)

Delegate: 534

Interventions in Main Committee I: 113; 165; 463; 493; 495;
505; 641; 874; 1238; 1492

O'LEARY D. (Ireland)

Head of the Delegation: 533

OGAWA N. (APAA)

Observer: 550

Interventions in Main Committee I: 1021; 1061; 1554; 1652

OKAWA A. (JPAA)

Observer: 552

Interventions in Main Committee I: 1269; 1552; 1623

OLCAY H. (Turkey)

Delegate: 544

OLD F.P. (APAA)

Observer: 550

Interventions in Main Committee I: 45; 411; 486

OLD F.P. (Australia)

Adviser: 525

OPHIR M. (Israel)

Head of the Delegation: 534

Intervention in the Plenary: 83

Interventions in Main Committee I: 21; 49; 62; 75; 163; 168;
201; 260; 291

ORANGE J.R. (FICPI)

Observer: 552

ORANGE J.R. (PTIC)

Observer: 552

Interventions in Main Committee I: 570; 902

ORTEGA LECHUGA C. (Spain)

Delegate: 541

Interventions in Main Committee I: 439; 504; 594; 596; 798;
910; 937; 1011

ØSTERBORG L.D. (Mrs.) (Denmark)

Delegate: 530

Interventions in Main Committee I: 397; 540; 652; 757; 824;
851; 934; 1174

OTTEVANGERS S. (UEPIP)

Observer: 553

OUATTARA K.J. (Burkina Faso)

Delegate: 527

OUSHAKOV V. (Soviet Union)

Deputy Head of the Delegation: 541

Interventions in the Plenary: 9; 145

Interventions in Main Committee I: 971; 1040

Interventions in Main Committee II: 45; 120

PAAERMAA R.P. (Finland)

Alternate Head of the Delegation: 530

Interventions in Main Committee I: 865; 982; 1001; 1179;
1237; 1332; 1372; 1459

Intervention in Main Committee II: 100

PAGENBERG J. (AIPPI)

Observer: 550

Intervention in Main Committee I: 710

PAGENBERG J. (DVGR)

Observer: 551

Interventions in Main Committee I: 1111; 1164; 1265; 1553; 1614

PAGENBERG J. (Max-Planck-Institute)

Observer: 552

Interventions in Main Committee I: 485; 567; 683; 710; 1111;
1265; 1331; 1553; 1614;
1648; 1695

PAK C.I. (Democratic People's Republic of Korea)

Delegate: 529

PARK B.C. (Republic of Korea)

Alternative Head of the Delegation: 539

Interventions in Main Committee I: 437; 844; 947; 969; 1000;
1046; 1228; 1366; 1429;
1439; 1531; 1598

PARKES A.J. (UEPIP)

Observer: 553

Interventions in Main Committee I: 483; 689; 950; 1054

de PASSEMAR B. (CEIPI)

Observer: 551

PEREIRA da CRUZ J. (Portugal)

Delegate: 539

PEREPELKIN I.B. (Soviet Union)

Delegate: 541

PEREZ-FERNANDEZ I. (WIPO)

Translator-Reviser: 553

PETERSEN R.C. (CIPA)

Observer: 551

Intervention in the Plenary: 115

Interventions in Main Committee I: 38; 130; 481; 566; 686

PETERSEN R.C. (CNIPA)

Observer: 551

Intervention in the Plenary: 115

Interventions in Main Committee I: 38; 130; 481; 566; 686

PETERSEN R.C. (EPI)

Observer: 552

Intervention in the Plenary: 115

Interventions in Main Committee I: 38; 253; 269; 566; 686

PFUSTERSCHMID-HARDTENSTEIN H. (Austria)

Head of the Delegation: 526

PII N. (Mrs.) (Lesotho)

Head of the Delegation: 536

POPPLEWELL K.B. (New Zealand)

Head of the Delegation: 538

Intervention in Main Committee I: 424

PORDEA V. (Romania)

Delegate: 540

PRAVEL B.R. (United States of America)

Adviser: 545

PURI L. (Mrs.) (India)

Head of the Delegation: 548

Intervention in the Plenary: 109

Interventions in Main Committee I: 124; 312; 559; 677; 709;
1062; 1177

Intervention in Main Committee II: 11

QIAO D. (China)

Delegate: 528

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Delegate: 528

RAFFNSØE K. (FICPI)

Observer: 552Interventions in Main Committee I: 707; 820; 988; 1048; 1087;
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RAITH R. (CEC)

Observer: 549

RATTANASUWAN S. (Thailand)

Delegate: 548

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RAVI C.K. (Zimbabwe)

Delegate: 547

RAVN N. (Denmark)

Delegate: 530

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REMANDAS R. (Mrs.) (EPO)

Observer: 547

RODRIGUES MITTELBACH M.M. (Ms.) (Brazil)

Delegate: 526

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ROMERO P. (Chile)

Head of the Delegation: 528

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RONUGHI H. (Iran (Islamic Republic of))

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ROSLOV V.N. (Soviet Union)

Delegate: 541

RYAN A. (Mrs.) (NYPTC)

Observer: 553

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SABORÍO VALVERDE M. (Costa Rica)

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- SACONNEY P. (Italy)
Delegate: 534
- SACONNEY P. (LES)
Observer: 553
- SALAZAR F.S. (SELA)
Observer: 549
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- SALIM F. (Syria)
Head of the Delegation: 543
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- SANDBERG B. (Ms.) (Sweden)
Alternate Head of the Delegation: 542
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- SANTARELLI M. (AIPPI)
Observer: 550
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- SANTARELLI M. (CNCBI)
Observer: 551
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- SANTARELLI M. (CNIPA)
Observer: 551
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- SAPALO I.S. (Philippines)
Deputy Head of the Delegation: 539
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- SAPRYKINE M. (Soviet Union)
Delegate: 541

SASAJIMA F. (JPAA)

Observer: 552

SATELER R. (WIPO)

Assistant Legal Counsel: 553

SCHAEFERS A. (Germany)

Deputy Head of the Delegation: 531

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Observer: 551

SCHALKWIJK P.C. (CIPS)

Observer: 551

SCHALKWIJK P.C. (UNICE)

Observer: 553

SCHAPER T. (AIPPI)

Observer: 550

SCHATZ U. (EPO)

Delegate: 547

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SCHENNEN D. (Germany)

Delegate: 531

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SCHLESSER F. (Luxembourg)

Head of the Delegation: 536

SCHMITT-NILSON G. (CNIPA)

Observer: 551

SCHMITT-NILSON G. (FCPA)

Observer: 551

SCHMITT-NILSON G. (FICPI)

Observer: 552

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SCHROEDER L. (United States of America)

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SCHULZE-STEINEN H.-J. (BDI)

Observer: 550

SCHULZE-STEINEN H.-J. (DVGR)

Observer: 551

SCHULZE-STEINEN H.-J. (UNICE)

Observer: 553

SCHUYLER, W.E., Jr. (United States of America)

Adviser: 545

SCHWAB B. (CEC)

Observer: 549

SEGURA R.J. (Argentina)

Delegate: 525

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SELL D.M. (United States of America)

Adviser: 545

SHACHTER I. (Israel)

Delegate: 534

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SIAHAAN R.R. (Indonesia)

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Observer: 550

SKUKA B. (Libya)

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SMEGAL T.F. (ABA)

Observer: 550

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Adviser: 546

SMITH P.A.D. (Australia)

Head of the Delegation: 525

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SMITH R.S. (United States of America)

Adviser: 546

SMORENBURG J.J. (CIPS)

Observer: 551

SOELISTYO BUDHI H. (Indonesia)

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SONN H. (FICPI)

Observer: 552

SOUMANA A. (Niger)

Head of the Delegation: 538

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STEWART R. (FICPI)

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SUEDI K. (WIPO)

Director, Bureau for Relations with International
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SUGDEN A. (United Kingdom)

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- TAKAMI K. (AIPPI)
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- THOMPSON W.S. (AIPLA)
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- THOMPSON W.S. (United States of America)
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UKAI K. (Japan)

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UNAN B. (Turkey)

Head of the Delegation: 544

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VAN DER EIJK W. (Netherlands)

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VAN GRAFHORST A. (APA)

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VAN HORN C.E. (United States of America)

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VAN ROOY Y.M.T.C. (Netherlands)

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VEKÁS G. (Hungary)

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VELASCO NIETO C. (Spain)

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VILLIERA J.B. (Malawi)

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VON ARNOLD F. (Sweden)

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Alternate Head of the Delegation: 546
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WALLIN B-G. (IFIA)

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WANG Z. (China)

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WARR G. (Malta)

Delegate: 537
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WATANABE T. (Japan)

Delegate: 535

WATERS A.C. (Miss) (United Kingdom)

Delegate: 544

WIERZBICKI A.F. (New Zealand)

Delegate: 538
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- WILDER R. (WIPO)
Senior Legal Officer: 553
- WITTE R.C. (United States of America)
Adviser: 546
- WU X. (China)
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- WYATT D.W. (United States of America)
Adviser: 546
- XU H. (China)
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- YAMADA N. (Japan)
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- YAMAGUCHI I. (JPA)
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- YAMAGUCHI T. (JPAA)
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- YOSHIDA T. (Japan)
Alternate Head of the Delegation: 534
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- YU G. (WIPO)
Special Assistant, Office of the Director General: 553
- ZAVAREIE S.R. (Iran (Islamic Republic of))
Head of the Delegation: 533
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ZHOU C. (China)

Adviser: 528

ZOLBOOT D. (Mongolia)

Delegate: 537

ZWANE S.H. (Swaziland)

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