

## Resolution



### Question Q170

#### Substantive Patent Law Treaty

#### AIPPI

##### Considering that:

- a cycle of meetings has started in 2001 organized by WIPO with the aim of elaborating a draft on a Substantive Patent Law Treaty (SPLT);
- a deadlock situation appeared from the discussions in May 2003 with the consequence that the meeting initially scheduled in November 2003 was cancelled;
- a Resolution was adopted at the AIPPI Executive Committee held in Lucerne on October 25 - 28, 2003, such Resolution a) confirming that it is in the interest of users to adopt a harmonization treaty at the earliest possible date and b) proposing to concentrate the discussions to a limited number of articles of the draft SPLT, in order to avoid a postponement in the adoption of a Treaty;
- among the articles on which the discussions should focus, articles 8 (Prior art) and 9 (Grace period) were specifically listed in said Resolution;
- concerning article 8, one of the issues was related to the effect of an earlier application with a later publication (on novelty alone or both on novelty and inventive step);
- a Resolution on Q167 was previously adopted at the AIPPI Executive Committee held in Lisbon on June 2002, limiting such effect to the novelty alone;

##### And whereas:

##### **PART A** (concerning Article 8):

- the issue of the contents of the earlier application need to be clarified so as to determine which parts of the application (specification, drawings, claims, abstract) have to be considered;
- a clarification is also needed concerning the date which should be considered as the date of forming prior art of an earlier application, referring to the respective content of the earlier application and the priority document of that application when said earlier application claims a priority;
- the origin of the earlier application is also an issue when it is a PCT application depending upon the possible outcome of the PCT application, whether or not entering into the national phase procedure; in this respect, the risk of double patenting has to be compared with the advantage of earlier certainty, and the complexity of the system has also to be considered;
- another question is related to the identity or partial identity of the applicant of the earlier application and that of the later application, leading to the “self-collision” issue;

**PART B** (concerning Article 9):

- the principle of a grace period system has been already accepted in previous Resolutions (Buenos-Aires in 1980 and Moscow in 1982 - Q75), but specific conditions have to be determined;
- the safety net provided by such grace period must respect both the interests of the party disclosing the invention before the filing of any patent application and those of third parties;
- the term for the grace period is a key issue;
- another key issue is whether the filing of a declaration by the party invoking such a grace period should be required;
- the prior users rights have also to be considered; in this respect, the provisions of the Resolution on Q89D adopted at the Amsterdam Executive Committee in 1989 shall apply.

**Adopts the following Resolution:**

**PART A**

- 1) the whole contents (i.e. claims, description and drawings) of the earlier application shall be taken into consideration;
- 2) earlier applications in a country shall be considered only when assessing the novelty of the later application in that country wherein the concept of novelty shall not be limited to photographic novelty but shall also include what the person skilled in the art reads as disclosed in the application;
- 3) when the earlier application is considered as an earlier application only as a result of claiming a priority, it will be considered as prior art only when the relevant information is contained both in the earlier application and in the priority document;
- 4) only PCT applications which have entered into the national or regional phase shall be considered as elements of the prior art;
- 5) there may be an exception for earlier applications which have been made by, at least partly, the same applicant as the later application or for disclosures contained in earlier applications based on misuse of information derived from the later applicant;

**PART B**

- 6) the term for the grace period shall be 12 months before the filing date or, if a priority is claimed, the priority date, i.e. the patent application shall be filed no later than 12 months after the public disclosure coming directly or indirectly from the inventor;
- 7) a declaration by the applicant confirming that he is entitled to benefit from such grace period may be required.