Report
on
Second Session
of
WIPO Committee of Experts
on the
Harmonization of Certain Provisions in
Laws for the Protection of Inventions
Geneva, May 26 to 30, 1986

PIPA

Seventeenth International Congress

November 5-7, 1986

Kanazawa, Japan

Committee No. 3 U.S. Group

Karl F. Jorda
Corporate Patent Counsel
CIBA-GEIGY Corporation
Ardsley, New York

I. Introduction

The so-called "Committee of Experts" on Harmonization of Certain Provisions in Laws for the Protection of Inventions held its second session in Geneva at WIPO headquarters from May 26 to 30, 1986. Thirty countries including, e.g., Canada, China, France, Germany, Indonesia, Italy, Japan, Philippines, Korea, Soviet Union, Switzerland, United Kingdom, and the United States were represented and 21 non-governmental organizations participated via observers, including, e.g., American Intellectual Property Law Association (AIPLA) (T. F. Smegal; H. C. Wegner), Asian Patent Attorneys Association (APAA) (F. Ohtsuka; I. Shamoto), GRUR, Inter-American Association of Industrial Property (ASIPI), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), Japanese Patent Attorneys Association (JPAA) (T. Yamaguchi), Chartered Institute of Patent Agents (CIPA), The New York Patent, Trademark and Copyright Law Association (NYPTC) (J. O. Tramontine), Union of Industries of the European Community (UNICE) and, of course, the Pacific Industrial Property Association (PIPA) (K. F. Jorda).

According to the WIPO announcement of and the invitation to the Meeting of the Committee of Experts, "observers will fully participate in the discussions". This is true, observers can indeed speak to their hearts' content but their turn comes only after all the Experts have been heard.

The Committee of Experts unanimously elected Mr. J.-L. Comte of Switzerland as Chairman and Mr. M. K. Kirk (United States of America) and Mr. V. Belov (Soviet Union) as Vice-Chairmen. Mr. L. Baeumer (Director, Industrial Property Division, WIPO) acted as Secretary to the Committee of Experts. In addition, Dr. Arpad Bogsch, WIPO Director General and Dr. Klaus Pfanner, WIPO Deputy Director (now deceased), participated very actively in the deliberations, especially the latter who was always present. Other WIPO officials and staff members as well as WIPO consultants assisted. It was obvious that WIPO considered this meeting as very significant and put in a great deal of effort.

Incidentally, the Japanese delegation consisted of Koji Hirayama, Deputy Director, Examination Standards Office, Coordination Division, 2nd Examination Department, Japanese Patent Office and Yoshihiro Masuda, First Secretary, Permanent

Mission, Geneva and the U.S. delegation was made up of Michael K. Kirk, Assistance Commissioner for External Affairs, United States Patent and Trademark Office (PTO); Harvey J. Winter, Director, Office of Business Practices, Department of State; Louis I. Maassel, Patent Practice and Procedure Specialist, (PTO); Lee J. Schroeder, Intellectual Property Specialist, (PTO); and Jan Jancin, Jr., Counsel, Intellectual Property Law, IBM, Arlington, Virginia.

Mr. Jancin represented the private sector. It is commendable that the U.S. government delegation frequently has private sector representation.

Both the Japanese and U.S. delegations made many objective and positive comments and suggestions, with measured constraint and diplomatic caution and are to be commended for this. The WIPO staff also "kept their cool". With over 50 countries and organizations in attendance, deliberations often became debates and debates often became heated. On many issues representatives were extolling their countries' laws and

practices as though they were saying we are all in favor of harmonization as long as our system is adopted or as long as we don't have to change our system. At one point Dr. Bogsch stated with a touch of impatience that "there was no such thing as a new (harmonization) treaty under which somebody would not need to change its practices."

With all the haggling and jockeying that was going on and all the reservations made to this or that proposal or provision, it was difficult to see how a harmonization treaty would or could ever see the light of day but nevertheless a lot of progress I believe was made indeed. WIPO concluded itself:

> "Significant progress was made towards reaching an agreement on the solutions proposed by the International Bureau in respect of the seven questions considered by the Committee of Experts". (INDUSTRIAL PROPERTY, No. 7/8, July/August 1986, p. 309)

Seven subjects were under study by the Committee of Experts:

1) the grace period for public disclosure of an invention before filing an application;

2) the requirements in respect of the granting of a filing date to a patent application;

3) the requirements in respect of the naming of the inventor and in respect of evidence to be furnished concerning the entitlement of the applicant;

4) the requirements in respect of the manner of claiming in patent applications;

5) the requirements in respect of unity of invention in patent applications;

6) the extension of patent protection of a process to the products obtained by that process and proof of infringement of a process patent; and

7) the prior art effect of previously filed but yet unpublished patent applications.

Of these seven subjects four (4-7) were on the agenda for the first time; two (2-3) for the second time and one (1) for the third time.

II. Prior WIPO Sessions of the Committee of Experts on Harmonization

As just intimated, subjects 1) to 3) had been under considertation at Meetings of the Committee of Experts in Geneva once or twice before, i.e. in the "First Session" on the "Grace Period for Public Disclosure of an Invention Before Filing an Application" which was held between May 7 and 11, 1984 and in the "First Session" on the "Harmonization of Certain Provisions in Laws for the Protection of Inventions" which took place between July 8 and 12, 1985. Only 11 countries and 8 non-governmental organizations were in attendance at the first session in 1984 but participation grew to 22 countries and 18 non-governmental organizations in the second session in 1985. With the further increases in attendance at the 3rd session earlier this year, it appears that the momentum is gaining, the bandwagon is rolling.

In the 1984 session, WIPO was apparently merely testing the waters as not much happened. Note the WIPO summary:

> "Several delegations and most of the organizations expressed strong support for the solution proposed in the study, militating in favor of the proposed general grace period system. Other delegations expressed reservations as to the proposed system of a general grace period". (INDUSTRIAL PROPERTY, 1984, p. 313)

In the 1985 session, there was not only improved attendance but also an expansion of the agenda to include two new subjects: 1) requirements in respect of the naming of the inventor by an applicant who is not the inventor and in respect of evidence to be furnished concerning the entitlement of such applicant; and 2) requirements for granting a filing date to an application for a title of protection for an invention. With respect to this session WIPO concluded as follows:

> "... the Committee of Experts agreed that the three questions deserved a continued effort of harmonization at the international level. The Committee of Experts recommended, in essence, that the draft treaty provisions on the grace period should be revised in the light of its conclusions and, as far as the questions of the naming of the inventor and the requirements for granting a filing date were concerned, the International Bureau should, taking into account the recommendations that the Committee had made, not only revise the draft treaty provisions but also the arguments supporting them. (INDUSTRIAL PROPERTY, 1985, p. 268)

III. General Observations

As mentioned earlier, at the session this past May four new subjects were added and a goodly number of additional countries and non-governmental organizations showed up.

The discussions were based not only on a WIPO document, entitled "Draft Treaty on the Harmonization of Certain Provisions in Laws for the Protection of Inventions" (HL/CE/II/2) but also on a set of elaborate working papers or WIPO documents with the following titles:

> "Requirements in Respect of the Granting of a Filing Date to a Patent Application" (HL/CE/II/2 Supp. 1);
>
> "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 Supp. 2);
>
> "Requirements in Respect of the Manner of Claiming in Patent Applications" (HL/CE/II/3);
>
> "Requirements in Respect of Unity of Invention in Patent Applications" (HL/CE/II/4);
>
> "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);

"Prior Art Effect of Previously Filed but Yet Unpublished Patent Applications" (HL/CE/II/6).

As a matter of fact, these subjects were discussed not only in general but the documents themselves were gone over paragraph by paragraph and in great detail so that not only principles and fundamentals but also language and terminology were under scrutiny.

With respect to general and preliminary observations made by participants, the delegation of Japan, for instance, expressed general support for WIPO's activity concerning the harmonization of certain provisions in laws for the protection of inventions but inquired as to the extent to which it was intended that also the terminology of national laws be harmonized along the lines of the proposed draft Treaty provisions.

The Director General's reply was that it was not intended that the terminology and wording of national laws had to be harmoninzed fully under the proposed draft Treaty. It was, however, important that the implementation of the Treaty

provisions was such that it resulted in harmonized practices. This did not, however, prevent the rules of the implementing legislation from being expressed in different ways. No member State was obliged to transfer the rules of the future Treaty word by word.

The U.S. Delegation expressed its appreciation of WIPO's efforts in the harmonization of patent laws and agreed that WIPO could play a useful and important role in strengthening industrial property protectionby setting standards--a role which should be recognized when discussing intellectual property matters within the framework of the General Agreement on Tariffs and Trade (GATT).

Poland suggested that instead of working out a new Treaty the Paris Convention should be revised and revamped and Italy felt that many of the proposed Treaty provisions should not be in the Treaty but in implementing regulations enacted at the national level. Dr. Bogsch in replying indicated that the standards of the Paris Convention were too loose and the proposed Treaty would be a special arrangement within the Paris Convention like PCT or the Budapest Treaty.

IV. The Grace Period

Most of the discussions were concerned with the grace period because of a fundamental disagreement with, if not diametrical opposition to, the concept of any grace period on the part of the Scandinavian delegations. At last year's session they were apparently dead set against any grace period for reasons of legal certainty. But at the May session this year they gave ground a little. At the very outset Denmark floated a proposal for a very limited grace period and moved that this subject be taken up first. This proposal was supported by the delegations of Finland, Norway and Sweden as well as Iceland. This proposal, embodied in WIPO Document HL/CE/II/7 and intended to constitute Art. 201 of the Harmonization Draft Treaty, reads as follows:

> (1) A patent shall not be refused or held invalid under any national law by virtue of the fact that a disclosure was made which may affect the patentability of the invention that is the subject of an application for a patent or of a patent, provided that the said disclosure was made:
>
> > (i) by the inventor, or a person acting on his behalf, in connection with a testing of the invention, provided that it occurred only to an extent considered reasonable in view of the nature of the invention, and provided that reasonable measures had been taken to keep the invention secret, or

(ii) by a third party, including an industrial property office, based on information obtained from, or in consequence of acts performed by, the inventor, if the third party was under an obligation to keep the invention secret, or if the information had been obtained by an unlawful appropriation, provided that the applicant and his legal predecessor had done all that could reasonably be required to keep the invention secret,

and provided that the said disclosure occurred no more than six months before the date on which the application was filed or, where priority is claimed, before the priority date, and provided, furthermore, that the said application was filed as soon as possible after the disclosure.

This proposal, in other words, would recognize only a six-month grace period and only

1) for a disclosure by the inventor or a person acting on his behalf, but further only if such disclosure occurred in connection with the technical testing of the invention, and

2) for a disclosure of an invention by a third party, including an industrial property office, but further only if the third party was under an obligation to keep the invention secret or if the information had been obtained by an unlawful appropriation, provided that the applicant had done all that could be reasonably required to keep the invention secret.

Several participants opposed and debated this because the purpose of any grace period was to protect inventors, in particular those who did not have sufficient knowledge of patent law and that, in addition to testing, there were other cases which deserved the same treatment. At the end the Delegation of Denmark was asked and promised to further elaborate its proposal prior to the next session, taking into account the discussion that had taken place.

Otherwise, a number of delegations and organizations agreed with the proposed grace period draft treaty provision, according to which there should be a general grace period of six or 12 months for any disclosure by the inventor or someone having obtained the information on the invention from the inventor, regardless of the grounds or methods of such disclosure. Opinions of government delegations were about equally divided as regards the question of whether the general grace period should be a six-month period or a 12-month period, whereas most of the organizations present favored a 12-month period. Opinions were similarly divided as to the question whether there should be an obligation to notify formally the industrial property office of any prior disclosure: government

delegations were about equally divided as regards such a requirement, whereas all of the organizations were against such a requirement. It was agreed that third party rights in respect of the continued exploitation of the patented invention which had been started before the filing or priority date should be safeguarded in the future treaty, subject to clarification that such third party rights were limited to persons who had made the invention independently from the person invoking the grace period.

V. Other Agenda Items

(For the summarizations in this section the "NOTE" which appeared in the INDUSTRIAL PROPERTY, July/August issue (p. 309) has been heavily relied upon.)

A. Filing Date Requirements

Since the majority of the Committee of Experts, at the session held in 1985, had already agreed on the basic approach of providing, as a matter of principle, for both obligatory ("minimum") requirements and additional option ("maximum") requirements, the Committee of Experts this time focused on thesubstance of the proposed requirements.

It was generally agreed that the first among the proposed obligatory minimum requirements, namely that there must be an indication that protection for an invention was sought, would be satisfied by a request for the grant of a patent or another title of protection for an invention, such as an inventor's certificate, utility model or certificate of addition. As to the question whether the obligatory minimum requirement of an identification of the applicant should also include an indication of the applicant's address, it was argued that giving the applicant's address may be necessary in some, but not all, cases and that a solution should be formulated with this possible need in mind. Views were also divided as regards two further proposed obligatory minimum requirements, namely that the application must contain a part which, on its face, appeared to be a description, and a part which, on its face, appeared to be a claim or claims. Several delegations and representatives of organizations stated that what was important was that an application contain a disclosure of the invention in order to be accorded a filing date but that it was not necessary that such disclosure include a claim or claims. In conclusion, it was agreed that a compromise solution might consist of providing that any national law would, on the one

hand, be free to require the presence of a claim or claims in an application as a condition of according a filing date but would, on the other hand, be obliged to require the presence of a description as a condition of according a filing date.

B. Inventorship Designation Requirements

It was suggested that the indication of the name of the inventor should include both his family name and his given name. It was also suggested that it should be required that the inventor's address be indicated. It was furthermore suggested that national laws should be free to require that either the applicant or his representative make the declaration indicating the legal grounds of entitlement to file the application. It was also agreed to study further the question of whether the sanction for non-compliance with the requirements of naming the inventor and the declaration of entitlement should be that the application must be refused or must, instead, be deemed to have been withdrawn.

C. Manner of Claiming Requirements

The memorandum prepared by the International Bureau had a relatively liberal aproach, in order to facilitate the drafting

and reading of claims. It was pointed out that harmonization in this field was of great interest to the users of the patent system. A number of detailed suggestions for the improvement of the proposal of the International Bureau were made.

D. Unity of Invention Requirements

The International Bureau had made a proposal for the harmonization of the presently largely divergent practices under national laws, in order to facilitate the drafting of patent applications. The usefulness of harmonization in this field was recognized, and several suggestions were made in respect of the International Bureau's proposal. It was generally agreed that the principle, proposed by the International Bureau, according to which a patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept, was acceptable. Additional information was requested from governments, particularly on the actual practice of their industrial property offices, since the differences amoung the various countries seemed to consist in the practical application of the general principle of unity of invention.

E. Process Patent Protection

As concerns the extension of patent protection of a process to the product obtained by that process and proof of infringement of a process patent, the solution proposed by the International Bureau was that the Treaty should require such an extension, as well as the reversal of the burden of proof in the case where the process is for the manufacture of a new product. That solution was in general considered as acceptable.

However, there were differences of opinion on certain details. In connection with the reversal of the burden of proof, views were divided on the questions whether that reversal should apply only where the defendant's product is identical to the one described in the process patent and whether the product had to be new. As regards the question of whether products had to be obtained directly by the patented process in order to be covered by the proposed, extended process patent protection, there was a general view that this should be the rule.

F. Prior Art Effect of Prior Patent Applications

As regards the prior art effect of previously filed but yet unpublished patent applications, the Committee of Experts, in general, took a favorable view of the principles of a solution submitted by the International Bureau, according to which the treaty would require that Contracting States consider the whole contents of a patent application, to the extent that they are subsequently published, as prior art from the filing date or the priorty date of the application.

As regards the meaning of "whole contents," it was suggested that the prior art effect of previously filed but yet unpublished patent applications should be dated back to the priority date only with respect to subject matter which had also been disclosed in the priority application and that the filing date should be the effective date for prior art purposes for any other subject matter which had not been disclosed in the priority application.

Moreover, it was pointed out that the proposed solution should make it absolutely clear that previously filed but yet unpublished patent applications were meant to be taken into

account as prior art only for purposes of determining novelty and not for purposes for evaluating inventive step.

In addition, it was suggested that the proposed solution should include measures to prevent that a conflict between several patent applications filed by the same applicant cause the applicant to destroy the novelty of his own invention merely by reason of having described his invention in a patent application previously filed by him but not yet published.

VI. Conclusions

The conclusions regarding this last Session as stated by WIPO were to the effect that the Committee of Experts and/or WIPO agreed (INDUSTRIAL PROPERTY, 1986, p. 311) that

1) the "questions discussed deserved a continued effort of harmonization at the international level",

2) "(o)ther possible topics for inclusion in the draft treaty should be studied, such as exclusion of certain categories of inventions from patent protection, interpretation of patent claims, duration of patents, first-to-file versus first-to-invent principle, manner of description, and rights conferred by the patent",

3) the proposed provisions of the draft treaty would be revised or new provisions formulated in light of the discussions, and

4) the "revised" text of the draft treaty as well as memoranda on one or several of the new topics to be studied would be submitted to the Committee of Experts at its next session."

The next session, which was initially scheduled for November of this year, has now been set for March 23 to 27, 1987 and announcements and invitations have been issued. It is to be hoped - and this is my plea today - that PIPA will again seize the opportunity and be represented in an observer capacity. Since observers can participate in the deliberations, it is to be hoped further that PIPA will study the issues on the agenda, formulate positions and issue instructions or guidelines to the observer(s) so that PIPA will have input and will be able to affect the outcome.

Harmonization is in the air. It is an idea whose time has come. Harmonization efforts are gaining momentum and the trend toward harmonization appears irreversible.

Karl F. Jorda