

WORLD TRADE ORGANIZATION

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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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REMARKS ON REVOCATION OF PATENTS AND THE TRIPS AGREEMENT BY THE UNITED STATES OF AMERICA

The United States delegation has requested that the following remarks, made at the meeting of the Council for TRIPS that took place from 22 to 25 July 1996, be circulated.

The United States is offering these remarks in an attempt to clarify the issue of revocation of patents under the TRIPS Agreement. These remarks have been prompted by discussions of the issue of revocation of patents that have occurred in other bodies of the World Trade Organization.

The Agreement on Trade-Related Aspects of Intellectual Property (TRIPS) addresses the issue of revocation of patents through Articles 27, 29 and 33:

- Pursuant to Article 27, WTO Members must grant patents for those inventions that are new, involve an inventive step and are capable of industrial application;
- Article 29 requires as a condition for the grant of a patent that the applicant disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art;
- Article 33 provides that a patent that has been granted by a Member must last not less than 20 years from the earliest effective filing date claimed in the patent.

The effect of these three provisions is clear; the only basis upon which a WTO Member can revoke a patent are those grounds that the Member would have been justified in relying upon to *deny the original grant of a patent on the application*. As the provisions of Article 27 and 29 indicate, those grounds are that the invention for which patent protection is sought is not new, lacks an inventive step or is not capable of industrial application, or that the application does not disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. Article 33 serves to define the term of protection that WTO Members are obligated to provide for those patents that meet these standards of patentability.

Provisions exist in Article 27 which permit WTO Members to exclude certain inventions from eligibility for patent protection. These provisions do not speak to the issue of revocation of patents but instead permit a Member to deny the *original* grant of a patent for certain categories of inventions.

Article 32 of the TRIPS Agreement requires Members to provide an opportunity for judicial review of any decision to revoke a patent. This obligation does not speak to the grounds for the revocation, but simply requires Members to provide an avenue for reviewing any decision by the relevant authority to revoke the patent.