

## **WIPO General Assembly**

### **Forty-Eighth (26<sup>th</sup> Extraordinary) Session Geneva, October 3 to 11, 2016**

#### **REPORT ON THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP)**

*prepared by the Secretariat*

1. During the period under consideration, the Standing Committee on the Law of Patents (SCP) held two sessions, namely, the twenty-third session from November 30 to December 4, 2015, and the twenty-fourth session from June 27 to 30, 2016. Both sessions were chaired by Mrs. Bucura Ionescu from Romania.
2. During these two sessions, the SCP continued to address the following five topics:<sup>1</sup> (i) exceptions and limitations to patent rights; (ii) quality of patents, including opposition systems; (iii) patents and health; (iv) the confidentiality of communications between clients and their patent advisors; and (v) transfer of technology.
3. The discussions at these two sessions were based on a number of proposals submitted by various delegations and documents prepared by the Secretariat. Delegations discussed those proposals and documents from various viewpoints, exchanged their views and experiences which contributed to advance their understanding of each topic. In particular, a seminar on “the relationship between patent systems and, *inter alia*, challenges related to availability of medicines in developing countries and least developed countries (LDCs), including on the promotion of innovation and fostering of the requisite technology transfer to facilitate access to generic and patented medicines in developing and LDCs”, as well as two sharing sessions regarding inventive step assessment and confidentiality protection applied to different types of patent professionals, provided a good opportunity for Member States to share their views and experiences, challenges and solutions on each of those issues.

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<sup>1</sup> The summaries of the discussions at the twenty-third and twenty-fourth sessions of the SCP are contained in the respective Summary by the Chair (documents SCP/23/5 and SCP/24/5), available at: [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=323086](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=323086) and [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=342596](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=342596), respectively.

4. In addition, during its twenty-third session, the Committee held discussions on Member States' experiences and case studies on the effectiveness of exceptions and limitations and on transfer of technology *vis-à-vis* sufficiency of disclosure. Further, it continued discussing the feasibility study on disclosure of International Nonproprietary Names (INN) in patent applications and patents. Moreover, an improvement made on a webpage regarding work sharing and collaborative activities was presented by the Secretariat at the twenty-fourth session.

5. The Committee will further advance its work based on the agreement on its future work reached at its twenty-fourth session. The Committee agreed that the non-exhaustive list of issues would remain open for further elaboration and discussion at the twenty-fifth session of the SCP. In addition, without prejudice to the mandate of the SCP, the Committee agreed that its work for the following session be confined to fact-finding and should not lead to harmonization at that stage.

6. With respect to the topic "exceptions and limitations to patent rights", the Committee agreed that the Secretariat would prepare a document, compiling information to be submitted by members and observers of the SCP, regarding their practical experiences on the effectiveness of, and challenges associated to, exceptions and limitations, in particular in addressing development issues. In addition, a sharing session among Member States on case studies, including court cases, on those exceptions and limitations that have proven effective to address development issues and/or economic strengthening.

7. Regarding the topic "quality of patents, including opposition systems", it was agreed that the Secretariat would circulate a draft Questionnaire prior to the twenty-fifth session of the SCP for comments from Member States and regional patent offices, which would contain the following elements: (i) how each Member State understands "quality of patents"; and (ii) implementation of cooperation and collaboration between patent offices in search and examination of patent applications, including experiences, their impacts, exchanging search strategies, tools to share information and capacity building needs in the area of such cooperation and collaboration. Based on the responses to the Questionnaire, a compilation of information by the Secretariat will be submitted to the twenty-sixth session of the SCP. Further, based on input received from Member States and regional patent offices, the Secretariat will update the information contained in document SCP/18/4 (Opposition Systems and other Administrative Revocation and Invalidation Mechanisms), and publish the information on the SCP electronic forum website in more accessible and user-friendly format. Moreover, the Committee will hold a sharing session on examples and cases relating to assessment of inventive step, including, but not limited to, the topics suggested in document SCP/24/3, paragraph 8, at the next session.

8. As regards the topic "patents and health", it was decided that, at its twenty-fifth session, the Committee would hold a sharing session on national experiences relating to use of health-related patent flexibilities for promoting public health objectives or the challenges thereof with a view to exploring the issues to be examined in a study to be submitted to the twenty-sixth session. That study would be prepared by the Secretariat, consulting with independent experts, the World Health Organization (WHO) and the World Trade Organization (WTO), and would examine the constraints faced by developing countries and LDCs in making full use of patent flexibilities and their impacts on the access to affordable, especially essential medicines for public health purposes in developing countries and LDCs. The SCP also decided that further discussion on the feasibility study on the disclosure of INN in patent applications and patents (document SCP/21/9), specifically where the INN is known to applicants at the time of filing. Members and regional patent offices are invited to make presentations in order to clarify the issues and their concerns. Furthermore, the Secretariat is invited to make a presentation on the PATENTSCOPE Chemsearch which facilitates patent search using the INN.

9. Concerning the topic “confidentiality of communications between clients and their patent advisors”, the SCP agreed that based on the information received from members and observers of the SCP, the Secretariat would prepare a compilation of court cases with respect to aspects of client-patent advisor privilege including limitations or difficulties encountered.

10. As regards the topic “transfer of technology”, the Committee agreed to hold a sharing session on the relationship between patent systems and transfer of technology as well as examples and cases presented by experts from different regions with a view to deepening the understanding of the impact of sufficiency of disclosure on transfer of technology. Furthermore, the Secretariat would update the WIPO webpage on transfer of technology.

11. It was also agreed by the Committee that the information concerning certain aspects of national/regional patent laws would be updated, based on input received from Member States.

12. In addition, a proposal submitted by the Group of Latin American and Caribbean Countries (GRULAC), entitled “Revision of 1979 WIPO Model Law for Developing Countries on Inventions”, was discussed by the Committee at its twenty-third and twenty-fourth sessions. Following some discussions, the Chair suggested continuing discussing the issue at the next session of the SCP and that the interested delegations might make contributions.

*13. The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Patents” (document WO/GA/48/4).*

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