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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-seventh session from December 11 to 15, 2017, and the twenty-eighth session from July 9 to 12, 2018. Both sessions were chaired by Mr. Dámaso Pardo from Argentina.
2. During these two sessions, the SCP continued to address the following five topics: (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 advancing their understanding of each topic. In addition, sharing sessions held during both sessions provided a good opportunity for Member States to share their views and experiences, challenges and solutions on each of those issues.
4. Specifically, during the twenty-seventh session, the Committee had discussions on a draft reference document on exception regarding acts for obtaining regulatory approval from authorities (the so-called Bolar exception), and on the updated responses to the Questionnaire on the Term “Quality of Patents” and Cooperation between Patent Offices in Search and Examination. Furthermore, the Committee continued discussing the constraints faced by developing countries and least developed countries (LDCs) in making full use of patent

flexibilities and their impacts on access to affordable especially essential medicines for public health purposes in those countries. During the said session, two half-day information exchange sessions and four sharing sessions among Member States were also held as follows: (i) a half-day information session on cooperation between patent offices in search and examination; (ii) a half-day information session on publicly accessible databases on patent information status and data on medicines and vaccines; (iii) a sharing session on patents and other related issues on access to medicines; (iv) a sharing session on examples and cases relating to assessment of inventive step; (v) a sharing session on the experiences of Member States in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues; and (vi) a sharing session on patent law provisions that contributed to effective transfer of technology. Moreover, the Secretariat presented the webpage on opposition and administrative revocation mechanisms, available on the SCP Electronic Forum webpage. In accordance with the decision of the Committee at its twenty-sixth session, the Secretariat also organized an informative session on legislative assistance in the field of patents and related capacity building.

5. During the twenty-eighth session of the SCP, the Committee discussed a second draft of a reference document on exception regarding acts for obtaining regulatory approval from authorities, and a further study on inventive step. With respect to patents and health, an updated feasibility study on the disclosure of International Nonproprietary Names (INN) in patent applications and patents was discussed. Furthermore, Member States shared their experiences and exchanged information on various topics pertaining to patent systems as follows: (i) opposition and administrative revocation mechanisms; (ii) cooperation between patent offices in search and examination, including sharing of information concerning the corresponding foreign applications and grants; (iii) enhancing examiners capacity; (iv) publicly accessible databases on patent information status and data on medicines and vaccines; (v) experiences of Member States in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues; and (vi) patent law provisions that contributed to effective transfer of technology. In relation to item (iii), above, the Secretariat also presented a report on WIPO's technical assistance activities in that area.

6. As regards the future activities of the Committee, the SCP will further advance its work based on the agreement on its future work reached at its twenty-eighth session. The Committee agreed that the non-exhaustive list of issues would remain open for further elaboration and discussion at the twenty-ninth 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. The future work program of the five topics under the SCP's agenda is as follows:

(i) With respect to the topic "exceptions and limitations to patent rights", the Committee agreed that the Secretariat would continue to work on a draft reference document on exceptions and limitations to patent rights in conjunction with patent protection. The Secretariat will prepare a draft reference document on research exception, which will be submitted to the twenty-ninth session of the SCP, and following the preparation and presentation of that draft reference document, a draft reference document on exception regarding compulsory licensing will be prepared by the Secretariat for the thirtieth session of the SCP. Both reference documents will follow the style and structure of the draft reference document on exception regarding acts for obtaining regulatory approval from authorities. The Secretariat will invite Member States to send any additional inputs for further preparation of the draft reference document.

(ii) Regarding the topic "quality of patents, including opposition systems", it was agreed that the Secretariat would prepare a further study on inventive step (part 2), giving particular attention to the topics suggested in paragraph 8 of document SCP/24/3

(Proposal by the Delegation of Spain). In addition, a half-day conference on cooperation between patent offices in search and examination, including sharing of information concerning the corresponding foreign applications and grants, will be held. Moreover, a sharing session will be held on approaches used by delegations to ensure the quality of the patent grant process within IP offices, including opposition systems, and any challenges faced and how they have been overcome, taking into consideration paragraph 7.a. of Annex to document SCP/28/8 (Proposal by the Delegations of the Czech Republic, Kenya, Mexico, Singapore and the United Kingdom). The Committee will continue discussions on the proposal by the Delegation of Spain (document SCP/28/7).

(iii) As regards the topic “patents and health”, it was decided that a half-day conference on publicly accessible databases on patent information status and data on medicines and vaccines will be held, taking into consideration the issues addressed in paragraphs 18 and 19 of the Annex to document SCP/24/4 (Proposal by the African Group for a Work Program on Patents and Health). In addition, the Secretariat will invite practitioners to share their experience on negotiating licensing agreements, giving particular attention to paragraph 20(a) of Annex to document SCP/24/4 (Proposal by the African Group for a Work Program on Patents and Health). Furthermore, the Committee will continue discussion on the proposal by the Delegations of Argentina, Brazil, Canada and Switzerland (document SCP/28/9 and 9 Add.) and the proposal by the Delegations of Argentina, Brazil and Switzerland (SCP/28/10), without prejudice to other proposals with respect to this agenda item.

(iv) Concerning the topic “confidentiality of communications between clients and their patent advisors”, the SCP agreed that the Secretariat will update document SCP/20/9 (Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information). This update will also be reflected on the dedicated website “Confidentiality of Communications between Clients and Their Patent Advisors”. The Secretariat will invite Member States to send any additional inputs for the preparation of the updated document.

(v) As regards the topic “transfer of technology”, the Committee agreed that, based on the discussions within the SCP, including those during the sharing sessions, the Secretariat will compile information on patent law provisions that contribute to effective transfer of technology, including sufficiency of disclosure.

7. 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.

8. *The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Patents” (document WO/GA/50/4).*

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