



Developments in International Patent Law: Issues Debated under the Standing Committee on the Law of Patents (SCP)

Joint program
WIPO and Ono Academic Law School

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Standing Committee on the Law of Patents (SCP)

- Established in 1998
- Member States' committee (IGOs and NGOs: observers)
 - In general, around 90-100 Member States, 5-10 IGOs and 25-30 NGOs participate in a session
- Forum to discuss issues, facilitate coordination and provide guidance concerning the progressive international development of patent law, including the harmonization of national laws and procedures
- Forum that deals with a cluster of issues rather than each issue in isolation
- Main achievement - the negotiation of the Patent Law Treaty (PLT), 2005

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Discussions on the draft **Substantive Patent Law Treaty** (SPLT)

- Initial agreement was to focus on issues of direct relevance to the grant of patents
(novelty, inventive step and industry applicability, structure and interpretation of claims and the requirements of the sufficient disclosure of the invention)
- Other issues at a later stage
(first-to-file versus first-to-invent, 18-month publication of application and post grant opposition system)
- Content of the draft SPLT was broadened

SPLT discussion stalled

Developed countries

- Definition of prior art
- Grace period
- Novelty
- Inventive step

Group of Friends of Development

- Development and patent policy flexibility
- Exclusions from patentable subject matter
- Exceptions to the rights
- Anti-competitive practices
- Disclosure of origin/source of genetic resources and TK, prior informed consent and benefit sharing
- Effective mechanisms to challenge validity of patents
- Sufficiency of disclosure
- Technology transfer
- Alternative model to promote innovation

==> No agreement on the SCP work program;
deadlock from 2006 - 2008

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Since 2008, the SCP worked towards the establishment of a work program

- [Report on the International Patent System](#) (doc. SCP/12/3 Rev.2)
- [Preliminary studies](#) on selected issues:
 - exclusions from patentable subject matter and exceptions and limitations to the rights (document SCP/13/3)
 - patents and standards (document SCP/13/2)
 - client-patent attorney (patent advisor) privilege (documents SCP/13/4 and SCP/14/2)
 - dissemination of patent information (documents SCP/13/5 and SCP/14/3)
 - transfer of technology (documents SCP/14/4 and SCP/14/4 Rev.)
 - opposition systems (document SCP/14/5)
- SCP/16, May 2011: agreement on [five issues](#) for future work

The five issues for future work

- Exceptions and limitations to patent rights
- Confidentiality of communications between patent advisors and their clients
- Quality of patents (including opposition systems)
- Transfer of technology
- Patents and health

Exceptions and Limitations

Exceptions and limitations to patent rights

- Exercising the exclusive patent rights in all circumstances may not meet the ultimate goal of the patent system: promoting innovation and enhancing public welfare
 - Avoid inhibiting further research and innovation
 - Reflecting conflicts with public policies and fundamental rights



Exceptions and limitations

- Certain flexibility in deciding which actions shall constitute exceptions and limitations to infringement
- Choices reflect different needs in different countries

**Balance between patentee's rights
and public interest**

Exceptions and limitations to patent rights

Found in many laws:

- private acts for non-commercial purposes;
- acts for the purpose of teaching;
- acts for experimental purposes or scientific research;
- preparation of medicines prescribed by doctors;
- continued use by a prior user;
- certain uses on foreign vessels, aircrafts and land vehicles which temporarily or accidentally entered the national territory;
- acts for obtaining regulatory approval for pharmaceuticals;
- acts performed for a farmer's own use and for the development of new varieties;
- governmental use and compulsory licenses.

Exceptions and limitations to patent rights

- **Study by external experts** on exclusions, exceptions and limitations: coordinated by Professor Lionel Bently, Cambridge Univ. Several authors from various parts of the world
- **Proposal by Brazil**, 3 step approach:
 - Exchange of information
 - Relevance of exceptions and limitations to development
 - Non-exhaustive, non-binding Manual
- **Countries supporting**: African Group, Asian Group, GRULAC, Russia, China and others.
- **Countries opposing**: Group of Central European and Baltic States, EU, Group B and others.
- **Questionnaire** was submitted to Member States and results are available on WIPO's website

Questionnaire on Exceptions and Limitations to Patent Rights

Table and links to the replies received from member states and regional offices to the SCP.

- Questionnaire [DOC](#) [PDF](#)

Country	Section 1: General	Section 2: Private and/or non-commercial use	Section 3: Experimental use and/or scientific research	Section 4: Preparation of medicines	Section 5: Prior use	Section 6: Use of articles on foreign vessels, aircraft and land vehicles	Section 7: Acts for obtaining regulatory approval from authorities	Section 8: Exhaustion of patent rights	Section 9: Compulsory licensing and/or government use	Section 10: Exceptions and limitations related to farmers' and/or breeders' use of patented inventions	Section 11: Other exceptions and limitations
Albania [PDF]	x	x	x	x	x	x	x ²⁵	x	x	x	–

Information on **policy objectives, applicable laws and the scope of the exception, implementation challenges**

- Replies received from 88 Member States
- <http://www.wipo.int/scp/en/exceptions/>

Algeria [PDF]

Armenia [PDF]

Exceptions and limitations to patent rights

Implementation Challenges

- Most Member States responded that:
 - The legal framework of the exceptions was adequate to meet the objectives sought;
 - No challenges in relation to the practical implementation of the exceptions

- A Seminar on Exceptions and Limitations to Patent Rights was held during the 20 and 21 session of the SCP (January and November 2014, respectively)

Exceptions and limitations to patent rights

SCP 22, July 2015

Future work:

- Compilation by the Secretariat of Member States' experiences and case studies on the effectiveness of exceptions and limitations, in particular, in addressing development issues

Confidentiality of communications between a client and his patent advisor

Confidentiality of communications between clients and their patent advisors : the issue

- In order to ensure acquisition and enforcement of IP rights, IP owners often consult patent attorneys and patent agents (IP advisor)
- Free and frank communications between them are necessary for obtaining high quality advice.
- To do that, IP owners must be sure that any such communication will stay confidential and will not be revealed in court or to a third party or otherwise made public.
- Confidentiality of communication between **a client** and **his lawyer** guaranteed by:
 - Attorney-client privilege (common law countries)
 - Professional secrecy obligation (civil law countries)
- Confidentiality of communication between **a client** and **his patent advisor** guaranteed? – differences among national laws

Confidentiality of communications between patent advisors and their clients: the issue

- The **national dimension**

- Communications between a client and his IP advisor may be forced to disclose by courts in some countries.

- The **international dimension (cross-border aspects)**

- In some countries, confidentiality of communication with national IP advisors is protected, but not with foreign IP advisors
- Once confidentiality is lost in one country, it is lost globally.

- Protection, and consequently advice, are more and more sought in many jurisdictions on the same IPR → More litigation in various jurisdictions

Confidentiality of communications between patent advisors and their clients: the issue

Current status of discussions

- Numerous studies were prepared by the Secretariat examining, *inter alia*:
 - national laws and rules dealing with cross-border aspects of confidentiality of communications between clients and patent advisors; as well as problems and possible remedies to cross-border aspects (Documents SCP/13/4, SCP/14/2, SCP/16/4 Rev., SCP/17/5 and SCP/18/6)
- A Seminar on the Confidentiality of Advice from Patent Advisors was held during the 21st session of the SCP
- A webpage containing comprehensive information on the subject was developed:
http://www.wipo.int/scp/en/confidentiality_advisors_clients/

Confidentiality of communications between patent advisors and their clients: the issue

Current status of discussions

- Some delegations suggested a **non-binding soft law instrument** (ex. WIPO Recommendation, non-binding model law, non-binding guidelines)
 - CEBS Group, Group B, EU, Czech Republic, Denmark, Japan, Montenegro, Poland, Sweden, Switzerland, the United Kingdom, Republic of Korea
- Some other delegations state that this is a matter of national law, procedural law, or law of evidence over which **WIPO has no mandate**
 - African Group, China, Germany, India, Iran, Kenya, Pakistan, Philippines, Zambia
- No agreement on any normative work

Confidentiality of communications between patent advisors and their clients: the issue

SCP 22, July 2015

Future work:

- Sharing session among Member States concerning confidentiality protection applied to different types of patent professionals and to national and foreign patent advisors

Quality of Patents

Quality of patents

- Quality of patents is an **essential aspect of the patent system** in order for the patent system to serve its purpose
- Errors in patent grant and administration procedures lead to **legal uncertainty** and **costs** for all users
- **Quality-related aspects of the system:**
 - search and examination, third party observation and opposition mechanisms
 - practical guidelines for patent office employees and their training programs, codes of conduct for patent applicants, quality control and quality management systems

Quality of patents

- **Proposal by Canada and the United Kingdom (SCP/16/5)**
 - Technical infrastructure development
 - IT solutions to improve access to prior art
 - Information exchange on quality of patents
 - Administrative and operation processes relating to quality assurance
 - Process improvement
 - Identify ways to improve search and examination processes (primary focus); may include opposition procedures and the quality of applications filed
- **Proposal by Denmark (SCP/17/7)**
 - Information exchange on the use of foreign search and examination work
- **Proposal by the United States of America (SCP/17/10)**
 - survey on high-level goals of patent offices for high quality patents
 - questionnaire on national metrics for measuring quality

Quality of patents

- Proposals by the Delegations of Canada and the United Kingdom: [Questionnaire on Quality of Patents](#) (document SCP/18/9)
- Proposal by the United States of America regarding [Efficiencies of the Patent System](#) (SCP/19/4)
- Proposal by Spain and other Member States of the European Union for the improvement of understanding of the [requirement of inventive step](#) (document SCP/19/5)
- Proposal made by the Republic of Korea, the United Kingdom and the United States of Regarding [Worksharing between Offices in order to Improve Efficiencies of the Patent System](#) (document SCP/20/11 Rev.)

Quality of patents

Status of discussions:

- Some delegations supported the above proposals or certain elements contained in those proposals
 - Australia, Canada, CEBS Group, Colombia, Cuba, Denmark, Ecuador, EU, Group B, Paraguay, Republic of Korea, Russian Federation, Spain, UK, US.
- Some other delegations stated that a common understanding on the definition of the term “quality of patents” was necessary before commencing any work
 - African Group, Algeria, Asian Group, Brazil, Chile, China, DAG, Dominican Republic, Egypt, GRULAC, India, Iran, LDCs

Quality of patents

- Some other arguments:
 - Quality of patents is a question of national law that refers to the ability of patent offices to apply their domestic patent laws, and thus patentability criteria might be applied differently in different jurisdictions in accordance with national priorities and policy objectives (Argentina, India).
 - The proposed initiatives would result in harmonization of practices in the field of patent law, which would be prejudicial to the provisions of flexibility in national legislation (Iran)

Quality of patents

- A sharing session regarding Member States' experiences on international work sharing and collaboration was organized during the SCP 21 (November, 2014), which clarified:
 - work sharing is not a substitute for conducting patent search and examination in accordance with the national law
 - work sharing does not lead to harmonization
 - necessity: work sharing reduces duplication and increases efficiency and quality of granted patents

Quality of patents

- The following two studies were prepared by the Secretariat and submitted to SCP 22:
 - a study on inventive step that contains the following elements: the definition of the person skilled in the art, methodologies employed for evaluating an inventive step and the level of the inventive step; and
 - a study on sufficiency of disclosure that contains the following elements: the enabling disclosure requirement, support requirement and written description requirement.

Quality of patents

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Future work:

- ½ day sharing session on experiences of experts from different regions on inventive step assessment in examination, opposition and revocation procedures

Patents and Health

Patents and Health

Some issues:

Impact on public health – access to medicine

Impact on research and development: Market-oriented patent system may not provide incentives for innovations relating to neglected diseases (WHO Commission on IP, Innovation and Public Health, 2006)

- The proposal submitted by the Delegation of South Africa on behalf of the African Group and the Development Agenda Group (document SCP/16/7)

- Studies

- Compulsory and government use licenses
- Exhaustion of rights
- Mandatory disclosure of International Nonproprietary Names (INNs)
- Cost-benefit analysis of Markush claims

- Information exchange

- Sharing of experience and information on various issues
- Develop a DB on the patent status of diagnostic tools and medicines in Member States

- Technical assistance

- Develop targeted technical assistance programs

Patents and Health

- Proposal by the United States of America (SCP/17/11):

Weakening patent protection for innovative medicines is not the right approach to improving the availability of medicines, as many other factors are playing a role as well; Instead, alternative approaches should be examined: vol. licenses, patent pools, partnership etc.

- WHO's presentation on the availability of generic medicines in developing countries (non-patent barriers, effects of falsified medicines)
- Study on positive impact of patent systems in providing medicines in developing countries
- Study on availability of medicines not protected by patents and the reasons for their lack of availability

Patents and Health

- WIPO's activities on patents and health (SCP/17/4)
- WIPO, the WHO and the WTO publication entitled "Promoting Access to Medical Technologies and Innovation: Intersections between Public Health, Intellectual Property and Trade"
- Various views:
 - Some MS supported South African proposal, others- the proposal from the USA
 - Some MS stated that both proposals contained elements which deserve consideration
 - With respect to both proposals, concerns were raised about the duplicative nature of the proposed activities with the work undertaken by other WIPO fora (e.g., CDIP) or other relevant intergovernmental organizations, such as WHO and WTO.
 - Some MS stated that, as a United Nations agency, WIPO and the SCP had the mandate to address the topic of patents and public health, and that the proposal submitted by the Delegation of South Africa would not constitute any duplication with any other processes within or outside of WIPO.
- During SCP/20 a sharing session on countries' use of health-related patent flexibilities was held

Patents and Health

SCP 22, July 2015

Future work:

- ½ day seminar on the relationship between patent systems and, *inter alia*, challenges related to availability of medicines in developing countries and 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 least developed countries

Transfer of Technology

- The role of the patent system and its effects on the technology transfer
- Studies:
 - Transfer of Technology (SCP/14/4 Rev 2.)
 - WIPO's Activities on Transfer of Technology (SCP/18/7)
 - Patents and Transfer of Technology: Examples and Experiences (SCP/18/8)
 - Patents and Transfer of Technology: Further Practical Examples and Experiences (SCP/20/1)
- Current status:
 - Some delegations suggested the compilation of information on national/regional regulations, guidelines, practices and jurisprudence regarding voluntary licenses.
 - Some other delegations suggested that the Committee further study patent-related impediments to transfer of technology.
 - Some MS did not support continue working only on patent-related impediments.
 - Some delegations stated that new activities on transfer of technology in the SCP should not be launched before the completion of the CDIP project on Intellectual Property and Technology Transfer: Common Challenges – Building Solutions

Transfer of Technology

Future work (SCP 22, July 2015):

- Discussion on transfer of technology vis-à-vis sufficiency of disclosure, based on document SCP/22/4

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Challenge:

- To identify area(s) of common interests and concerns
- To find a balanced work package, respecting the interest of various countries

- SCP work at this stage is confined to fact-finding and should not lead to harmonization at this stage
- Topics are discussed without pre-set objectives
- All 5 topics are linked; no one could move forward alone with one specific topic (balanced agenda)

Thank you!