

Standing Committee on the Law of Patents

Fifteenth Session

Geneva, October 11 to 15, 2010

STATUS OF WORK RELATING TO THE NON-EXHAUSTIVE LIST OF ISSUES AGREED BY THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP)

Document prepared by the Secretariat

1. The present information document provides an overview of the status of work relating to the non-exhaustive list of issues agreed by the Standing Committee on the Law of Patents (SCP).
2. At the twelfth session of the SCP, which was held from June 23 to 27, 2008, in Geneva, the Chair proposed to compile a non-exhaustive list of topics which would include the points raised by the delegations (document SCP/12/5, paragraph 68). He stressed that the nature of the list was non-exhaustive, with no order of priority, and noted that the rationale behind the creation of such a list was to identify a limited number of issues which could be worked upon and developed by the Secretariat without excluding the other topics raised (document SCP/12/5, paragraph 86). The Chair clarified that delegations would still be allowed to raise new or other topics at future sessions of the SCP, and they would be able to come back to the various points on the list which were not covered exhaustively (document SCP/12/5, paragraphs 64 and 65). He stressed that the list was not the work program of the SCP, and that it was simply a list of issues which had been raised by delegations and which could be discussed in the future (document SCP/12/5, paragraph 108).

3. The non-exhaustive list, therefore, provides an idea of the preliminary views of delegations on items that were of interest for them for the future work of the SCP. A non-exhaustive list with 18 topics was established at the twelfth session of the SCP. At the thirteenth session, two additional topics were included in the non-exhaustive list. It should be noted, however, that some suggested topics are sub-categories of other suggested topics: for example, the scope of the topic “limitations to the rights” is broad enough to cover “research exemption” and “compulsory licenses”.
4. The Annex to this document provides, with respect to each topic in the non-exhaustive list, relevant SCP activities, recommendations and projects under the WIPO Development Agenda, and other related publications and recent activities carried out by the Secretariat of WIPO, including references to related programs under the WIPO Program and Budget (P&B) for the 2010/11 biennium, WIPO publications, and seminars and symposia organized by WIPO and held in Geneva during the last twelve months. In addition, a number of seminars, workshops and other events related to the topics contained in the non-exhaustive list have been held outside Geneva. WIPO’s website also provides information regarding those topics.
5. Concerning the Development Agenda recommendations, they are listed in the Annex only where the topic concerned is directly referred to in the recommendation. For example, while no Development Agenda recommendation directly refers to patents and health *per se*, the topic “patents and health” is obviously closely related to development concerns. Similarly, with respect to the topic “patent quality management systems”, various technical assistance and capacity building, institutional capacity building and development of infrastructure activities are all relevant to this topic.

[Annex follows]

STATUS OF WORK RELATING TO THE NON-EXHAUSTIVE LIST OF ISSUES

Non-exhaustive list of issues	SCP activities	Development Agenda	Other related publications and recent activities by WIPO
Technical dissemination and diffusion			
1. Economic impact of the patent system	SCP/12/3 (Report on the International Patent System)	Recommendations 34 and 35* “Intellectual Property and Socio-Economic Development” project (DA_35_37_01)	P&B 2010/11: Program 16 WIPO Publications: - The Economics of Intellectual Property (No. 1012) - The Economics of Intellectual Property in South Africa (No. 1013) - Intellectual Property in Asian Countries: Studies on Infrastructure and Economic Impact (No. 1018) WIPO Seminar Series on "The Economics of Intellectual Property"
2. Transfer of technology	SCP/12/3 (Report on the International Patent System) SCP/14/4 (Transfer of Technology)	Recommendations 10, 19*, 22, 23, 24, 25, 26, 27, 28, 29, 30 and 31 “Innovation and Technology Transfer Support Structure for National Institutions” project (DA_10_03) “Intellectual Property and Technology Transfer: Common Challenges – Building Solutions” project [not yet approved] (DA_19_25_26_28_01)	P&B 2010/11: Program 18 PCT/WG Recommendations 211 and 211bis WIPO Publications: - Exchanging Value – Negotiating Technology Licensing Agreements: A Training Manual (No. 906) - Successful Technology Licensing (No. 903) - IP Assets Development and Management: a Key Strategy for Economic Growth (No. 896) - Guidelines on Developing Intellectual Property Policy for Universities and R&D Institutions in African Countries (No. 848) - Technology Transfer, Intellectual Property and Effective University-Industry Partnerships (No. 928)

Non-exhaustive list of issues	SCP activities	Development Agenda	Other related publications and recent activities by WIPO
3. Competition policy and anti-competitive practices	SCP/12/3 (Report on the International Patent System) SCP/13/2 (Standards and Patents) [with respect to standardization-related issues]	Recommendations 7*, 22, 23 and 32 “IP and Competition Policy” project (DA_7_23_32_01)	Creation of the Intellectual Property and Competition Policy Division WIPO Symposium on Intellectual Property and Competition Policy (May 11, 2010)
4. Dissemination of patent information (including the registration of licenses)	SCP/12/3 (Report on the International Patent System) SCP/13/5 (Dissemination of Patent Information) SCP/14/3 (Technical Solutions to Improve Access to, and Dissemination of, Patent Information)	Recommendations 8, 10, 16, 19*, 20, 24, 25, 27, 28, 30 and 31 “Specialized Databases’ Access and Support” project (DA_08_01) “Smart IP Institutions” project (DA_10_02) “IP, Information and Communication Technologies (ICTs), the Digital Divide and Access to Knowledge” project (DA_19_24_27_01) “Developing Tools for Access to Patent Information” project (DA_19_30_31_01) “Intellectual Property and the Public Domain” project (DA_16_20_01)	P&B 2010/11: Programs 12 to 15 PCT/WG Recommendations 165(c), 185, 207, 211 and 211<i>bis</i> WIPO Publications: - Patentscope® Series (No. L434) - WIPO Patent Information Services for Developing Countries (No. 493) Global Symposium of Intellectual Property Authorities (September 17 and 18, 2009; September 16 and 17, 2010)

Non-exhaustive list of issues	SCP activities	Development Agenda	Related publications and recent activities by WIPO
5. Standards and patents	SCP/12/3 (Report on the International Patent System) SCP/13/2 (Standards and Patents)		
6. Alternative models for innovation	SCP/12/3 (Report on the International Patent System)	Recommendation 36	
<i>Patent system and existing forms of cooperation</i>			
7. Harmonization of basic notions of substantive patentability requirements (e.g. prior art, novelty, inventive step, industrial applicability, disclosure)	In the context of the draft Substantive Patent Law Treaty (SPLT), issues relating to the definition of prior art, novelty, inventive step, industrial applicability and sufficiency of disclosure were discussed. SCP/12/3 (Report on the International Patent System) Discussions on “Enlarged” Concept of Novelty” SCP/9/5 (“Industrial Applicability” and “Utility” Requirements: Commonalities and Differences) SCP/6/INF/2 (Information Provided by Members of the Standing Committee on the Law of Patents (SCP) Concerning the Definition of Prior Art - Brief Summary)		

Non-exhaustive list of issues	SCP activities	Development Agenda	Related publications and recent activities by WIPO
	SCP/5/4 (Results of the Questionnaire Concerning Disclosure of Information on the Internet and Other Issues Relating to the Internet) SCP/4/5 (Disclosure of Technical Information on the Internet and its Impact on Patentability)		
8. Disclosure of inventions	In the context of the draft SPLT, issues concerning sufficiency of disclosure were discussed. SCP/12/3 (Report on the International Patent System) SCP/7/6 (Requirements Concerning the Relationship of the Claims to the Disclosure)		PCT/WG Recommendation 211 <i>bis</i>
9. Database on search and examination reports	SCP/12/3 (Report on the International Patent System) SCP/13/5 (Dissemination of Patent Information) SCP/14/3 (Technical Solutions to Improve Access to, and Dissemination of, Patent Information)	Recommendation 10	PCT/WG Recommendations 146 and 147 Global Symposium of Intellectual Property Authorities (September 17 and 18, 2009; September 16 and 17, 2010)

Non-exhaustive list of issues	SCP activities	Development Agenda	Related publications and recent activities by WIPO
10. Opposition systems	SCP/12/3 (Report on the International Patent System) SCP/14/5 (Opposition Systems)		PCT/WG Recommendation 149 (third party observation)
11. Exceptions from patentable subject matter	SCP/12/3 (Report on the International Patent System) SCP/13/3 (Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights) SCP/14/7 (Proposal from Brazil) SCP/15/3 (External Experts' Study)	Recommendations 17* and 22	
12. Limitations to the rights	SCP/12/3 (Report on the International Patent System) SCP/13/3 (Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights) SCP/14/7 (Proposal from Brazil) SCP/15/3 (External Experts' Study)	Recommendations 17* and 22 CDIP/5/4 (Patent-Related Flexibilities)	

Non-exhaustive list of issues	SCP activities	Development Agenda	Related publications and recent activities by WIPO
13. Research exemption	SCP/12/3 (Report on the International Patent System) SCP/13/3 (Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights) SCP/14/7 (Proposal from Brazil) SCP/15/3 (External Experts' Study)	Recommendations 17* and 22 CDIP/5/4 (Patent-Related Flexibilities)	
14. Compulsory licenses	SCP/12/3 (Report on the International Patent System) SCP/13/3 (Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights) SCP/14/7 (Proposal from Brazil) SCP/15/3 (External Experts' Study)	Recommendations 17* and 22 CDIP/5/4 (Patent-Related Flexibilities)	
<i>Support structures for the patent system</i>			
15. Patent quality management systems	SCP/12/3 (Report on the International Patent System)		Quality management in the PCT framework PCT/WG Recommendations 143, 165, 170 and 176

Non-exhaustive list of issues	SCP activities	Development Agenda	Related publications and recent activities by WIPO
16. Client-attorney privilege	SCP/12/3 (Report on the International Patent System) SCP/13/4 (The Client-Attorney Privilege) SCP/14/2 (The Client-Patent Advisor Privilege)		
<i>Patents in the context of public policy objectives</i>			
17. Patents and health (including exhaustion, the Doha Declaration and other WTO instruments, patent landscaping)	SCP/12/3 (Report on the International Patent System) Conference on Intellectual Property and Public Policy Issues (July 13 and 14, 2009)	“Developing Tools for Access to Patent Information” project (DA_19_30_31_01) CDIP/5/4 (Patent-Related Flexibilities) [exhaustion]	P&B 2010/11: Program 18 Symposia on Life Sciences and IP Policy (ongoing) Access to Medicines: Pricing and Procurement Practices, A Joint Technical Symposium by WHO, WIPO and WTO (July 16, 2010)
18. Relationship between the patent system and the CBD (Genetic resources/Traditional knowledge/Disclosure of origin)	SCP/12/3 (Report on the International Patent System) Conference on Intellectual Property and Public Policy Issues (July 13 and 14, 2009)	Recommendation 18*	P&B 2010/11: Program 4 Intergovernmental Committee on Genetic Resources, Traditional Knowledge and Folklore (IGC) WIPO Publications: - Intellectual Property Needs and Expectations of Traditional Knowledge Holders (No. 768) - WIPO-UNEP Study on the Role of Intellectual Property Rights in the Sharing of Benefits Arising from the Use of Biological Resources and Associated Traditional Knowledge (No. 769) - WIPO Technical Study on Patent Disclosure Requirements Related to Genetic Resources and Traditional Knowledge (No. 786)

Non-exhaustive list of issues	SCP activities	Development Agenda	Related publications and recent activities by WIPO
19. Relation of patents with other public policy issues	SCP/12/3 (Report on the International Patent System) Conference on Intellectual Property and Public Policy Issues (July 13 and 14, 2009)	“Developing Tools for Access to Patent Information” project (DA_19_30_31_01)	P&B 2010/11: Program 18 WIPO Publications: - Intellectual Property and Human Rights (No. 762) - Intellectual Property and Bioethics - An Overview (No. B932/IPB) Symposia on Life Sciences and IP Policy (ongoing)
20. Patents and the environment, with particular attention to climate change and alternative sources of energy	Conference on Intellectual Property and Public Policy Issues (July 13 and 14, 2009)	“Developing Tools for Access to Patent Information” project (DA_19_30_31_01)	P&B 2010/11: Program 18

*Development Agenda recommendations with an asterisk were identified by the 2007 General Assembly for immediate implementation.

[End of Annex and of document]