

WIPO General Assembly

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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 its thirty-fourth session from September 26 to 30, 2022, in a hybrid format. The session was chaired by Mr. Leopoldo Soriano (Spain).
2. The SCP continued to address the following five topics during its thirty-fourth session: (i) exceptions and limitations to patent rights; (ii) quality of patents, including opposition systems; (iii) patents and health; (iv) confidentiality of communications between clients and their patent advisors; and (v) transfer of technology.
3. The discussions were based on a number of proposals submitted by various delegations and documents prepared by the Secretariat, and the exchange of views and experiences contributed to a better understanding of each topic. In addition, sharing sessions held during this session provided a good opportunity for Member States to share their views and experiences, challenges and solutions on a specific topic.
4. Specifically, during the thirty-fourth session, the Committee held discussions on the draft reference document on the exception regarding the exhaustion of patent rights, and a further study on the sufficiency of disclosure (Part I) that covered the issues relating to biological materials, such as microorganisms, and artificial intelligence (AI)-related inventions. The Committee also continued its discussion on a review of existing research on patents and access to medical products and health technologies. Furthermore, the Committee continued discussion on the proposals by the Member States, including the proposal by the Delegation of Canada for an information exchange on the topic of standard-essential patents. The Committee also took note of the Secretariat's report on the sharing session on the use of AI for examination of patent applications, held during the thirty-third session of the SCP.

5. In addition, the following four sharing sessions were held during the thirty-fourth session of the SCP: (i) sharing session on patentability of inventions using AI and by AI; (ii) sharing session on expedited patent examination mechanisms at intellectual property (IP) offices; (iii) sharing session focusing on cross-border aspects of confidentiality of communications between clients and their patent advisors; and (iv) sharing session on the positive contributions of the patent system in enhancing innovation, technology transfer and industrial development of countries as well as challenges therein.

6. Under the agenda item “patents and health”, the Committee heard presentations by: (i) the Representatives of the World Health Organization (WHO), World Intellectual Property Organization (WIPO) and World Trade Organization (WTO) on the trilateral cooperation relating to COVID-19 pandemic and patents; (ii) the Representative of WHO on the COVID-19 Technology Access Pool (C-TAP) initiative; and (iii) the Representative of Medicines Patent Pool (MPP) on its licensing activities. In addition, the Committee continued to receive updates on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines. In particular, the Committee was informed about the information sharing platform for patents on pandemic prevention against COVID-19 from the China Patent Information Center.

7. 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 thirty-fourth session. The Committee agreed that the non-exhaustive list of issues would remain open for further elaboration and discussion at the thirty-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. The future work program of the five topics under the SCP’s agenda, agreed by the Committee, is as follows:

(a) With respect to the topic “exceptions and limitations to patent rights”, the Secretariat will prepare a draft reference document on the exception regarding the use of articles on foreign vessels, aircrafts and land vehicles, and will submit it to the thirty-fifth session. The subsequent types of exceptions and limitations to be covered by a draft reference document will be the exceptions regarding extemporaneous preparation of medicines and farmers’ and/or breeders’ use of patented inventions.

(b) Regarding the topic “quality of patents, including opposition systems”, the Secretariat will prepare a further study on the sufficiency of disclosure (Part II) relating to inventions having an experimental nature in unpredictable art, such as chemistry and biotechnology, as proposed in document SCP/31/8 Rev. In addition, the Secretariat will prepare a document compiling information relating to the expedited examination programs of IP offices, including information on Prioritized Examination of COVID-19 related patent applications. Furthermore, the Secretariat will: (i) produce a compilation on how jurisdictions around the world address the issue of AI inventorship, through jurisprudence, legislation and practice to be updated on a regular basis, and present it at the thirty-fifth session of the SCP; and (ii) invite technical experts to the thirty-fifth session of the SCP to update the Committee on the state of play regarding AI generated inventions including AI technology capabilities and applications. The Secretariat will also submit a report of the information sharing session held during the thirty-fourth session on patentability of inventions using AI and by AI. In addition, during the thirty-fifth session, the Secretariat will organize an information sharing session on the use of AI for patent examination procedures.

(c) As regards the topic “patents and health”, at its thirty-fifth session, the Committee will, in accordance with document SCP/28/10 Rev., review and decide whether the regular update on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines be extended. In addition, the Secretariat will organize

a sharing session among Member States on practices involving licensing of medical technologies for the diagnosis, prevention and treatment of COVID-19, including examples of compulsory and voluntary licensing.

(d) Concerning the topic “confidentiality of communications between clients and their patent advisors”, the Secretariat will organize a sharing session by members and observers of the SCP as well as relevant practitioners on recent developments and experiences concerning this topic.

(e) As regards the topic “transfer of technology”, at the thirty-fifth session of the SCP, the Secretariat will organize a Member States sharing session on international cooperation in respect of technology transfer through the patent system, including technical assistance and capacity building, licensing of technology and collaboration involving both the public and private sectors. Furthermore, as proposed in document SCP/34/7 Rev., the Secretariat will organize a sharing session by SCP observers, intergovernmental organizations (IGOs) and other relevant stakeholders on their practical experiences on Standard-Essential Patents (SEPs) and Fair, Reasonable and Non-Discriminatory (FRAND) licensing related issues.

8. 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.

9. *The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Patents (SCP)” (document WO/GA/56/6).*

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