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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-ninth session from December 3 to 6, 2018, chaired by Mr. Dámaso Pardo (Argentina), and the thirtieth session from June 24 to 27, 2019, chaired by Ms. Sarah Whitehead (United Kingdom).
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-ninth session, the Committee had discussions on a draft reference document on research exception, and on Part II of the further study on inventive step. The Committee also discussed an updated document that compiled laws, practices and other information relating to confidentiality of communications between clients and their patent advisors. Furthermore, the Committee continued discussing the patent law provisions that had contributed to effective transfer of technology, including sufficiency of disclosure. During the

said session, two half-day conferences and two sharing sessions were also held as follows: (i) a conference on cooperation between patent offices in search and examination, including sharing of information concerning the corresponding foreign applications and grants; (ii) a conference on publicly accessible databases on patent information status and data, on medicines and vaccines; (iii) a sharing session on approaches used by delegations to ensure the quality of the patent grant process within IP offices, including opposition systems; and (iv) sharing of experiences by practitioners on negotiating licensing agreements.

5. During the thirtieth session of the SCP, the Committee discussed a draft reference document on compulsory licensing, Part III of the further study on inventive step and a background document on patents and emerging technologies. In addition, Member States shared their experiences and exchanged information on approaches used by delegations to ensure the quality of the patent grant process within IP offices, including opposition systems. With respect to patents and health, the Secretariat and invited relevant institutions shared their experiences on capacity building activities relating to negotiating licensing agreements. Furthermore, the Committee agreed which initiatives on publicly accessible databases of patent status information concerning medicines and vaccines would be invited to the thirty-first session of the SCP in order to provide updates on the advances of their information platforms. Member States also took note of the updated information regarding the confidentiality of communications between clients and their patent advisors, and held discussions on patent law provisions that contributed to effective transfer of technology.

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 thirtieth 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:

(a) 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 Committee will discuss the reference document on the exception regarding compulsory licensing at the thirty-first session of the SCP. The Secretariat will prepare a draft reference document on the exception regarding prior use for discussion at the thirty-second session of the SCP, taking into account any additional inputs from Member States for the preparation of the said draft document.

(b) Regarding the topic "quality of patents, including opposition systems", it was agreed that the Secretariat would prepare a study based on paragraph 7(b) of document SCP/28/8 on approaches to the quality of the patent grant process, taking into account the issues raised during the sharing sessions on that topic, which were held during the twenty-ninth and thirtieth sessions of the SCP. In addition, during the thirty-first session of the SCP, the Secretariat will organize a session to share experiences and information on the use of artificial intelligence for the examination of patent applications. During the thirty-second session, the Secretariat will organize a one-day information sharing session on issues related to the patentability of inventions, such as artificial intelligence software as computer-implemented inventions, the use of artificial intelligence as an aid to the creation of inventions or inventions generated independently by artificial intelligence. Moreover, the Secretariat will submit a report on its technical assistance activities relating to opposition systems and other administrative revocation mechanisms. The Part III of the further study on inventive step will be kept open for further discussions by Member States.

(c) As regards the topic “patents and health”, it was decided that the following initiatives on publicly accessible databases of patent status information concerning medicines and vaccines will be invited to the thirty-first session to present an update, in accordance with document SCP/28/10 Rev.: (i) MedsPaL; (ii) Pat-INFORMED; (iii) Approved Drug Products with Therapeutic Equivalence Evaluations (Orange Book); and (iv) List of Off-Patent, Off-Exclusivity Drugs without an Approved Generic. In addition, the Secretariat will submit a review of existing research on patents and access to medical products and health technologies, as contained in document SCP/28/9 Rev. It will also prepare a report of the sharing session regarding the experiences on capacity building activities related to negotiating licensing agreements, which was held during the thirtieth session of the SCP. Moreover, the Committee agreed that the Secretariat will organize, during the thirty-second session of the SCP, a sharing session by Member States on challenges and opportunities in relation to types of patent licensing provisions in the healthcare technologies.

(d) Concerning the topic “confidentiality of communications between clients and their patent advisors”, the SCP agreed that the Secretariat will organize a sharing session by practitioners and Member States on recent developments and experiences with respect to confidentiality of communications between clients and their patent advisors, covering policy and practical issues and with a particular attention to cross-border elements.

(e) As regards the topic “transfer of technology”, the Committee agreed that the Secretariat will continue to compile information on patent law provisions and practices that contributed to effective transfer of technology, including sufficiency of disclosure, for the thirty-first session of the SCP, based on the inputs to be received from Member States and discussion within the SCP. In addition, during the thirty-second session, a sharing session by Member States on patent law provisions and practices that contributed to effective transfer of technology, including sufficiency of disclosure, will be organized by the Secretariat.

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. With respect to the developments in the SCP during 2018 and its contribution to the implementation of respective Development Agenda (DA) Recommendations, reference is made to paragraphs 42 to 45 of document CDIP/23/2.¹ During the thirtieth session of the SCP, the Delegation of Uganda, speaking on behalf of the African Group, recalled the decision of the WIPO General Assembly in 2010 concerning “Coordination Mechanisms and Monitoring, Assessing and Reporting Modalities”, and requested the Secretariat to include in its annual report to the Assemblies, a description of the SCP’s contribution to the implementation of the respective Development Agenda Recommendations. The Delegation of Canada, speaking on behalf of Group B, noted that the established and agreed practice for the consideration of such issues should be followed.

9. *The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Patents” (document WO/GA/51/6).*

[End of document]

¹ Document CDIP/23/2 (Director General’s Report on the Implementation of the Development Agenda).