

Standing Committee on the Law of Patents

Thirty-Sixth Session
Geneva, October 14 to 18, 2024

PATENT LAW PROVISIONS THAT CONTRIBUTE TO EFFECTIVE TRANSFER OF TECHNOLOGY, INCLUDING SUFFICIENCY OF DISCLOSURE

Document prepared by the Secretariat

1. At its thirty-fifth session, held from October 16 to 20, 2023, the Standing Committee on the Law of Patents (SCP) agreed that the Secretariat would update document SCP/32/6 (Patent Law Provisions that Contribute to Effective Transfer of Technology, including Sufficiency of Disclosure), based on the information received from Member States, and would submit it to the thirty-sixth session of the SCP.
2. On the subject addressed in document SCP/32/6, Member States shared information and their experiences during, in particular, the twenty-seventh and twenty-eighth sessions of the SCP, held in December 2017 and July 2018, respectively. In addition, prior to the discussion of document SCP/32/6 during the thirty-second session of the SCP held in December 2020, documents SCP/29/6, SCP/30/8 and SCP/31/7, which also compiled information on that subject, were submitted to the twenty-ninth, thirtieth and thirty-first sessions of the SCP, held in December 2018, June and December 2019, respectively.
3. This document follows the style of those previous documents on the same subject. It presents, on a country-by-country basis, a summary of the information received from Member States in response to Note C.9199 dated December 7, 2023.¹ It contains not only the specific

¹ The information received from the Member States are published on the website of the SCP electronic forum at: https://www.wipo.int/scp/en/meetings/session_36/comments_received.html. In addition to the Member States included in this document, the following Member States cited their national law provisions relating to the sufficiency of disclosure: Algeria (Article 22 of the Ordinance No. 03-07 of 19 Jomada El Oula 1424 (corresponding to July 19, 2003) on Patents), Lithuania (Article 16 of the Patent Law), and the Republic of Korea (Articles 42, 62 and 133 of the Patent Act). Portugal cited its national law provision regarding transfer of patent rights (Article 30 of the Industrial Property Code).

legal provisions under the patent law but also practical tools, programs and initiatives, which are based on, or promote the use of, such legal provisions.

4. As to the legal provisions relating to patent law, the following provisions were addressed in the Member States' submissions: sufficiency of disclosure; patent licensing, transfer of patent rights and their registration; and mechanisms to incentivize voluntary licensing (for example, license of rights).

Australia

Australian patent law provisions on technology transfer

5. Section 40(2)(a) of the *Patents Act 1990* requires that applicants must disclose their invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.

6. Patent licences contribute to effective technology transfer and are often involved when establishing a joint venture or a collaborative partnership. Patent licences are also typical in consortium arrangements and sponsored research agreements. The *Patents Act 1990* does not specify any formalities that must be satisfied for a patent licence to be valid and enforceable. However, as a matter of commercial practice, the terms of a patent licence are typically set out in a written document executed by the parties to the agreement.

IP Australia initiatives that facilitate technology transfer

7. If innovation is to be fully effective, it is crucial to ensure that new technology is incentivised and reaches the market. This can be difficult to achieve, and hence it is important to ensure patent protection is in place and to have initiatives to facilitate commercialisation.

8. Effective technology transfer can be facilitated through collaboration and establishing strong links between researchers and industry. Benefits of collaboration can include sharing of knowledge, research insights, improvement in methodologies, identifying opportunities for future research and improved market growth, all of which lead to better results in technology transfer and support cooperative or competitive downstream innovation.

9. IP Australia has developed resources that support users of the patent system and facilitate technology transfer. These include:

- Resources to support rights holders to commercialise their IP once they have made the decision to take it to market;²
- IP Basics factsheets that provide IP knowledge and tools needed to establish and grow a successful business;³
- Choosing the right IP tool that helps innovators identify what type of IP protection they may need;⁴
- Information about commercialization and collaboration for innovators;⁵

² <https://www.ipaustralia.gov.au/manage-my-ip/how-to-commercialise-my-ip>.

³ <https://www.ipaustralia.gov.au/tools-and-research/business-resources/ip-basics>.

⁴ <https://www.ipaustralia.gov.au/tools-and-research/business-resources/choosing-the-right-ip-tool>.

⁵ <https://www.ipaustralia.gov.au/manage-my-ip/how-to-commercialise-my-ip/commercialisation-and-collaboration>.

- Non-disclosure contract generator to help create NDAs. It builds a contract in four simple steps using the user's business details and those of the other party;⁶ and
- Resources to assist in obtaining professional IP advice that can help innovators at different stages of their IP journey including commercialisation. IP Australia recommends seeking professional advice and provides resources to help find IP professionals who can provide assistance.⁷

China

10. The Patent Law of China provides for the transfer and licensing of patents. Article 10 of the Patent Law provides that "the right to file a patent application and a patent right may be transferred." It stipulates that where a Chinese entity or individual transfers the right to file a patent application or a patent right to a foreigner, a foreign enterprise or any other foreign organization, the transfer shall go through formalities in accordance with the relevant laws and administrative regulations.

11. In addition, where the right to file a patent application or a patent right is transferred, the parties concerned shall enter into a written contract and register it with the patent administration department under the State Council, in accordance with the Patent Law. The patent administration department under the State Council shall make an announcement about the registration. The transfer of the right to file a patent application or the patent right shall take effect as of the date of registration.

12. With respect to patent licenses, Article 12 of the Patent Law provides that any entity or individual exploiting the patent of another person shall enter into a license contract for exploitation with the patentee and pay the patentee a royalty for the exploitation of the patent. The licensee has no right to authorize any entity or individual, other than that referred to in the contract, to exploit the patent. In addition, Articles 50 to 52 of the Patent Law as well as Rules 85 to 88 of the Implementing Regulations of the Patent Law provide for open license.⁸

13. As regards the sufficiency of disclosure, paragraph 3 of Article 26 of the Patent Law provides that "the description shall contain a clear and comprehensive description of the invention or utility model so as to enable a person skilled in the relevant field of technology to carry it out." Rule 20 of the Implementing Regulations of the Patent Law provides for the drafting requirements of the description.

Germany

Patent law provisions with respect to voluntary licensing

14. Pursuant to Section 23 of the German Patent Act, an applicant can declare their willingness to license. It is a voluntary restriction of one's own right by the patent seeker or patent proprietor, by which the latter declares in writing and unconditionally to the Patent Office that they are willing to allow anyone to use the invention in return for appropriate remuneration. Pursuant to Article 2(2) of the European Patent Convention (EPC), Section 23 is also applicable to European patents designating the Federal Republic of Germany. The consequence of the declaration of willingness to license is that the annual fees due for the patent are reduced to half of the amount specified in the tariff (Section 23, paragraph 1, sentence 1).

⁶ <https://www.ipaustralia.gov.au/tools-and-research/business-resources/non-disclosure-agreements/Non-disclosure-contract-generator>.

⁷ <https://www.ipaustralia.gov.au/understanding-ip/get-professional-assistance-with-your-IP>.

⁸ The "open license" refers to a mechanism similar to the license of right in some countries.

15. Such reduction of annual fees by half is of particular interest for small and medium-sized enterprises (SMEs). At the same time, the likelihood of the invention being exploited is increased by enabling any third party to use the invention in return for appropriate remuneration, thus promoting technology transfer.

16. Subsequent to the declaration being entered, if a person wishes to use the invention under a license, he/she shall inform the proprietor of the patent of this intention (Section 23, paragraph 3). The information is deemed to have been effected if it has been dispatched by registered letter to the person entered in the Register as the proprietor of the patent or to his/her registered representative or the person authorized to accept service. The information must indicate how the invention is to be used.

17. The remuneration is fixed by the Patent Division upon the written request of a party (Section 23, paragraph 4). The request may be directed against more than one party. When fixing the amount of the remuneration, the German Patent and Trade Mark Office (DPMA) may make an order requiring the party opposing the request to bear the costs of the procedure in full or in part. After the expiry of a period of one year following the last fixing of remuneration, any party affected thereby may apply for its adjustment if, in the meantime, circumstances have arisen or become known which make the remuneration fixed appear obviously inappropriate (Section 23, paragraph 5).

18. The declaration may be withdrawn in writing *vis-à-vis* the DPMA at any time, as long as the proprietor of the patent has not yet been informed of any intention to use the invention. The withdrawal takes effect when it is filed. The sum by which the annual renewal fees have been reduced is to be paid within one month following withdrawal of the declaration (Section 23, paragraph 7).

19. The declaration of willingness to license is to be distinguished from the non-binding declaration of license interest, which merely states that there is an interest in further exploitation by third parties. Although it is published by the DPMA in the register and in the Patent Gazette, it can be withdrawn at any time and has no effect on the amount of the annual fees. It becomes invalid with the submission of a declaration of willingness to license pursuant to Section 23 or the registration of an exclusive license pursuant to Section 30, paragraph 4 of the German Patent Act.

Patent law provisions with respect to sufficiency of disclosure

20. Sufficiency of disclosure is regulated in Section 34, paragraphs 3 and 4 of the German Patent Act. The invention shall be disclosed in the patent application, which shall include the request, the description, the claims and the drawings (Section 34, paragraph 3).

21. In general, an invention is deemed to be disclosed in a clear and complete manner within the meaning of Section 34, paragraph 4, if the information contained in the patent application provides the reader skilled in the art with technical information that is sufficient for him/her to successfully execute the invention in practice using his/her specialist knowledge and skills, without undue difficulties and without needing inventive skill. Hereby, the average person skilled in the art has to be taken into consideration.

Japan

WIPO GREEN

22. WIPO GREEN was launched in 2013 for the purpose of supporting the development and the diffusion of environmental innovation. Through its online database and regional activities, WIPO GREEN connects green tech seekers and providers. At present, the WIPO GREEN

database containing information about more than 129,000 technologies, needs and experts is utilized by more than 2,500 users across the world.

23. The Japan Patent Office (JPO) is committed to actively supporting the activities of WIPO GREEN and to promoting the wider use of environmentally sound technologies worldwide. The JPO became a partner of WIPO GREEN in February 2020. Many Japanese companies have actively participated in WIPO GREEN (Japan ranks No.1 in terms of the number of partners and No. 2 in terms of the numbers of registered technologies in the world). The number of Japanese partners has increased to 51. Under the support of the Funds-in-Trust Japan Industrial Property Global (FIT Japan IP Global), various support activities for WIPO GREEN, including promotional activities for Japanese companies and support for the WIPO GREEN Acceleration Project, have been conducted.

FIT Japan IP Global

24. Japan has been making voluntary contributions to WIPO since 1987 through the FIT Japan IP Global. At the time it was established, the geographical area supported by the fund was limited to the Asia Pacific region. However, Africa was also included in the areas under support in 2008.

25. Furthermore, the fund's name was changed in 2019 to the "Global Fund" so that it could provide support globally without any regional limitations. It has been running on that basis ever since. Over 36 years since its establishment, Japan has contributed an aggregate amount of approximately 10 billion yen that has been used to provide support to more than 100 countries. FIT Japan IP Global has contributed to the development of IP systems in developing countries through a variety of initiatives over the years, such as holding high level meetings with various members of countries and regions to promote cooperation in the field of IP, sending experts to develop IP legal systems and operations, holding various workshops, and supporting the digitization of IP Offices. The JPO also focuses on fostering human resources who will play an important role in the development of IP systems. In addition, the JPO is committed to sharing knowledge on procedures and preparations for acceding to the treaties by sending its staff to these workshops as lecturers. The JPO began sending experts to the Asia Pacific region in 1987 and to Africa in 2009 and had sent approximately 400 experts in total to developing countries by FY 2022.

JPO/IPR training courses

26. At present, the JPO is conducting training courses by inviting trainees according to the objectives and specific details of each course. The courses are designed for government officials from IP offices and other agencies, including examiners working in developing countries and IP experts of the private sector, with the objective of enhancing their knowledge in the field of IP.

27. The JPO conducted the "JPO/IPR Training Course on Academia-Industry Collaboration and Technology Transfer" in 2023. A total of 22 trainees from 17 countries and one organization participated in the course, which was targeted toward staff of IP Offices and ministries in charge of, or supporting, technology development, company employees in charge of IP, and professionals from universities and research institutes involved in IP management and usage to promote industry-academia-government collaboration and technology transfer.

28. The purpose of this course was to learn efficient and effective IP management methods in universities and research institutes. Trainees shared information regarding the current status of IP policies and strategies in their countries and challenges they faced in their implementation. The trainees also deepened their understanding through lectures and discussions on IP

management, industry-academia-government collaboration, and technology transfer methods to the private sector.

Project for dispatching IP Strategy Designers to universities

29. The IP Strategy Designer Dispatching Project aims to: (i) design IP strategies, such as the timing of obtaining IP rights or research findings that should be protected by IP rights, by dispatching IP expert, "IP Strategy Designer", to universities; and (ii) to identify superior research achievement in universities. In addition to promoting social implementation initiatives, including the transfer of technology by universities, this project helps university research administrators enhance knowledge and awareness of IP by teaming up with them.

Russian Federation

30. Under Article 1375 of the Civil Code of the Russian Federation, an application for an invention patent should contain a description of the invention disclosing its essence sufficient to enable a person skilled in the art to carry out the claimed invention.

31. In accordance with Article 1386(2) of the Civil Code, the substantive examination of an invention application should include verification of the sufficiency of disclosure of the essence of the claimed invention provided in the application documents, specified in Article 1375(2), subparagraphs 1 to 4 of the Civil Code (patent application, invention description, claims, drawings and other materials if they are necessary to understand the essence of the invention).

32. Currently, the requirements for the information to be provided in the application in order to ensure compliance with the sufficiency of disclosure requirement are set forth in the Requirements for the Application Documents for an Invention Patent (Requirements)⁹. In addition, taking into account the law enforcement practice existing in the Russian Federation, the approaches to verifying compliance with the sufficiency of disclosure requirement were clarified in Regulations for Drafting, Filing and Examination of Documents Forming the Basis for Performing Legally Significant Actions for the State Registration of Inventions (Regulations)¹⁰.

33. Compliance with the sufficiency of disclosure requirement is checked in accordance with paragraphs 53 to 57 of the Regulations. Under paragraph 53, the following aspects should be verified:

- (1) whether the purpose of the invention is indicated;
- (2) whether the technical problem to be solved by the invention and the technical result to be obtained are indicated;
- (3) whether a set of essential features necessary to achieve the technical result indicated by the applicant is disclosed;
- (4) whether at least one example of implementation of the invention is provided. The example should confirm by experimental data or theoretical justification of the possibility to achieve the purpose of the invention, including the of the technical result;
- (5) whether the application documents or the state of the art as of the date of filing of the application disclose methods and means necessary to carry out the invention with

⁹ Approved by the Order No. 107 "On the State Registration of Inventions" of the Ministry of Economic Development of the Russian Federation dated February 21, 2023 (as amended by the Order No. 148 of the Ministry of Economic Development of the Russian Federation, dated March 15, 2024, which entered into force on May 5, 2024).

¹⁰ Approved by the Order No. 107 "On the State Registration of Inventions" of the Ministry of Economic Development of the Russian Federation, dated February 21, 2023.

realization of the purpose as characterized in each of the claims including in the case of the use of general concept(s) to characterize the feature(s); and

(6) whether an example of the invention is given, showing how the invention can be carried out using at least one particular form of realization of the feature expressed by the general concept, or at least one value of a parameter within an interval, if at least one general concept or an interval of values of a parameter is used in the claims to characterize a feature of the invention. The example should confirm by experimental data or theoretical justification of the possibility of realizing the purpose of the invention with the achievement of a technical result, using at least one precise form of realization of the feature, expressed by the general concept or one parameter value, included in the interval of parameter values.

34. In case the application documents do not contain information on the methods and means necessary to carry out the invention, the said information may be described in a source that became publicly available before the filing date of the application or, if the application claims a priority earlier than the filing date, before the priority date of the invention (paragraph 54 of the Regulations).

35. Compliance with the sufficiency of disclosure is checked by taking into account the provisions of the Requirements (paragraph 54 of the Regulations). At the same time, where the claims contain several features expressed by common terms, the test in accordance with paragraph 53(5) and (6) of the Regulations should be carried out with respect to each of these features. If the invention achieves two or more technical results, the test under paragraph 53(3), (4) and (6) of the Regulations is carried out with respect to each technical result.

36. Pursuant to paragraph 55 of the Regulations, if, as a result of the examination, it is established that the application documents submitted on the filing date do not meet the requirements set forth in paragraph 53(1), (3) and (5) of the Regulations and the applicant's arguments do not change the conclusion that the disclosure of the essence of the invention is not sufficient, a decision should be made to refuse the issuance of a patent.

37. Similarly, pursuant to paragraph 56 of the Regulations, a decision should be made to refuse the issuance of a patent if, as a result of the examination, it is established that the application documents submitted on the filing date do not contain at least one example, specified in paragraph 53(4) and (6) of the Regulations and the applicant's arguments do not change the conclusion about the inconsistency with the sufficiency of disclosure.

38. However, in case where an example is provided but the application document does not comply with the requirements of paragraph 53(4) and (6) of the Regulations¹¹, the applicant should be proposed to submit additional documents. Likewise, the applicant is invited to submit additional materials, if the applicant's use of a general concept or an interval of values of a parameter is not justified.¹²

¹¹ In particular, such a situation may arise if the application documents do not contain experimental data or theoretical justification of the possibility of accomplishing the purpose of the invention with the achievement of a technical result, including the use of at least one particular form of realizing a feature, expressed by a general concept, or one value of a parameter falling within the range of values of the parameters, specified in the claims, or the example does not confirm the possibility of carrying out the purpose of the invention with the achievement of a technical result, or it does not have any possibility to achieve the purpose of the invention with the achievement of a technical result.

¹² This situation may arise where, for example, the examples of embodiments given in the description of the invention are insufficient to confirm the possibility of achieving the purpose of the invention with obtaining the technical result, indicated by the applicant over the entire range of values claimed.

39. At the same time, in case the applicant was invited to submit additional materials, he/she should be informed that the newly submitted examples would be considered as additional ones, however, these examples may not supplement the description of the invention. Furthermore, it should be indicated that, if a patent is granted, any interested person will be able to familiarize himself/herself with the application document, including the additionally submitted materials.

40. Pursuant to paragraph 57 of the Regulations, if, based on the examination results, it was established that the application documents submitted on the filing date do not indicate the technical problem to be solved with the invention, do not indicate the technical result accomplished by the invention or it does not result from the description of the invention for a specialist, the examination of the application should be carried out taking into account the fact that the technical problem may consist of the expansion of the means for a certain purpose that is solved by creating a technical result of the invention.

41. In this case, the combination of features of the invention necessary for the invention to fulfil the purpose indicated in the generic concept is determined, while the features of the invention contained in the claims which are not necessary for the invention to fulfil its purpose are considered to be immaterial.

42. Thus, the results of the test of compliance with the requirement of sufficiency of disclosure of the nature of the invention may reveal avoidable and irrecoverable inconsistency with that requirement. The presence of such irrecoverable inconsistency is an independent ground for the Federal Service for Intellectual Property (ROSPATENT) to refuse to grant a patent of the Russian Federation for the invention.

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