AIPPI

AIPPI POSITION PAPER

AIPPI has attended the 12th SCP meeting held in Geneva on June 23 to 27, 2008, resuming the debate closed since 2005. As a result, and following the recommendations of the Chairman of the meeting, AIPPI would like to comment as follows:

- AIPPI, which is an association of around 9,000 members coming from more than 100 countries, either developing countries or developed ones, is particularly interested in the process of the elaboration of a working programme at the SCP;

- AIPPI notes the content of the tentative working programme drafted in June 2008, including the 18 issues to be worked, and more especially the short list of 4 issues;

- Among such issues, it should be pointed out that AIPPI has:

  - co-organized with WIPO a seminar on the "Client-Attorney Privilege" issue in May 2008, particularly important directions from which were:
    - first, clients need to rationalize IP professional advice they obtain from country to country where it differs,
    - secondly, in most countries protection from disclosure of that advice is in effect provided by enforceable laws on privilege, professional secrecy or confidentiality,
    - thirdly, such national laws need support by international agreement because in many cases they become ineffective nationally when IP advice is transmitted internationally, and
    - fourthly, the present lack of international support for the particular national laws is a serious issue because it adversely affects development by clients of IPRs and trade; by discouraging the transfer of technology internationally, the present lack of international support for the particular national laws on non-disclosure of IP professional advice, is contrary to the principal objective of the Paris Convention

  - adopted a resolution at its Boston Congress in September 2008, concerning the "Impact of public health issues on exclusive patent rights"; in that resolution, AIPPI re-affirmed the crucial importance of public health and considered that compulsory licenses in case of national emergency in the health field may be used in practice as a means to react to this emergency. AIPPI also took a position on other exceptions to the exclusive rights of a patentee in this context (see the enclosed copy of said resolution).

- AIPPI remains strongly in favour of harmonization in the patent system, through an international Treaty; such harmonization should be beneficial for both developing and developed countries, simplifying the patent system, making it more affordable for users, and avoiding the duplication of work among governments' IP offices. Furthermore, AIPPI is of the opinion that a high quality standard of patents should be pursued in order to avoid the granting of patents not fulfilling the patentability criteria. A harmonization Treaty would facilitate the achievement of this goal.

- AIPPI is ready to contribute in the resolution of the present difficulties, it being reminded that the patent system should be balanced, taking into consideration both the interests of the patentees and also those of the public in general.

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International Association for the
Protection of Intellectual Property

General Secretariat
Tödistrasse 16
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Resolution

Question Q202

The impact of public health issues on exclusive patent rights

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AIPPI

Noting that:

1) The focus of this resolution is exceptions to exclusive patent rights applicable to medicines and other medical products.

2) Access to affordable medicines and other medical products is a pressing issue but exceptions to exclusive patent rights alone cannot resolve this issue.

3) AIPPI has studied exceptions to exclusive patent rights in previous questions, leading in particular to:

   i) The resolution of the Executive Committee of Barcelona in 1990 – Question Q101, Yearbook 1991/I, page 298 entitled 'Parallel Import Of Patented Products' (***Barcelona Parallel Import Resolution***);

   ii) The resolution of the Executive Committee of Tokyo in 1992 – Question Q105, Yearbook 1992/III, pages 282-283 entitled 'Experimental Use as a Defence to a Claim of Patent Infringement' (***Tokyo Experimental Use Resolution***); and

   iii) The resolution of the 38th Congress of Melbourne in 2001 – Question Q156, Yearbook 2001/I, pages 511-512 entitled 'International Exhaustion of Industrial Property Rights' (***Melbourne International Exhaustion Resolution***).

4) The Barcelona Parallel Import Resolution resolved that a patentee be able to invoke its patent against parallel import of a patented product, notwithstanding the circumstances under which such product has first been put on the market in a given country "B", subject to exception by contractual agreement authorising import into another country "A".

5) Paragraph 3 of the Tokyo Experimental Use Resolution resolved that each country should except acts done for experimental purposes from the rights of the patentee on the basis that experimental use:

i) Includes any use of the patented invention performed for academic purposes and having no commercial nature;

ii) Includes testing to evaluate the teaching of the patent and validity of the patent;

iii) Includes any use of the patented invention to an extent appropriate to experimentation (as opposed to commercial use) which is for the purpose of improving the invention or making an advance over the invention or finding an alternative to the invention, but not the commercial exploitation of the subject of any improvement or advance; and

iv) Should be subject to the overriding principle that the use must involve work on the subject of the patent; use merely to obtain the advantage of the invention disclosed by the patent is not experimental use.

6) The Melbourne International Exhaustion Resolution affirmed the Barcelona Parallel Import Resolution and resolved that there should be no international exhaustion of industrial property rights (patents, trademarks, designs and plant breeder's rights) notwithstanding that regional exhaustion may be applied in order to foster regional integration of different national economies under a uniform regulatory and legal framework.

7) The patent law in some countries provides for an exception to exclusive patent rights for an "extemporaneous" preparation of a medicine in a pharmacy for individual cases in accordance with a medical prescription issued by a medical doctor (commonly referred to as the individual prescriptions exception).

8) A number of WTO Members have not yet ratified Article 31bis of the TRIPs.

Considering that:

1) Patent law provides for a number of exceptions to exclusive patent rights which may play a role in providing access to patented medicines and other medical products.

2) Compulsory licensing is a more appropriate and proportionate means of providing access to patented medicines and other medical products than expropriation of patent rights.

Resolves that:

1.1) Patent law should provide for an exception to the rights of a patentee, allowing a party to undertake, without the authorisation of the patentee, experiments relating to the subject-matter of the invention, irrespective of whether the ultimate aim of the experiments may be commercial.

1.2) Paragraph 3 of the Tokyo Experimental Use Resolution is affirmed insofar as it is not in conflict with paragraph 1.1.

2) Patent law should provide for an exception to the rights of a patentee, allowing a party to undertake, without the authorisation of the patentee, acts necessary for the purpose of

obtaining regulatory approval for medicines and other medical products such as medical devices, diagnostics, research tools and the like.

3) The Barcelona Parallel Import Resolution and the Melbourne International Exhaustion Resolution are each affirmed.

4) To the extent that the patent law provides for an individual prescriptions exception, the exception should be limited to preparation of medicines as and when required for an individual patient and should not extend to situations where medicines are prepared on a larger scale.

5) To the extent that the patent law permits patentability of methods of medical treatment, the law should provide for an exception to the rights of a patentee, allowing medical personnel to use patented methods of medical treatment, without the authorisation of the patentee, in circumstances where it is not practicable to negotiate a licence before treatment.

6) Concerning public health:

   a) the patent law should provide that a compulsory license can only be granted in exceptional and strictly defined circumstances.

   b) the law should not permit expropriation of patent rights.

7) Article 31bis of the TRIPs should be promptly ratified by WTO Members that have not yet done so.