

November 14, 2008

## **Comments from Canada with respect to Document SCP/12/3**

Pursuant to the Summary of the Chair of the Standing Committee on the Law of Patents (SCP), contained in document SCP/12/4 Rev., Canada is grateful for the opportunity to provide the following comments to the International Bureau concerning document SCP/12/3 entitled *Report on the International Patent System*, including Annex II.

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### **Document SCP/12/3 - General**

Canada wishes to commend the efforts of the International Bureau in producing such a broad and comprehensive consideration of patent systems within the global context.

### **Part V - The Current Multilateral Framework, (e) Administrative Cooperation**

-page 44, (i) International Patent Classification, para. 154, second sentence: consideration should be given to substitute the eighth edition of the IPC by the ninth, which enters into force on January 1, 2009 and will thus be the "current" edition when the report is adopted/published next March.

- page 45, (ii) The Budapest Treaty, paras. 155 to 157: the Budapest Treaty is the only treaty mentioned in part V where the report does not specify the number of contracting parties. For the sake of being thorough, it could be mentioned that there are 71 contracting parties.

- page 45, (f) International Filing and Processing System, para. 159, fourth line: the number of contracting parties to the PCT is 139, not 138.

### **Part IX - The Innovation Incentive in the Context of Public Policy Objectives**

-page 81, para 293, last sentence re: pilot landscapes: The report mentions pilot landscapes projects undertaken by WIPO in collaboration with the WHO in the area of public health. Could the Bureau expand on such initiative and, if possible, provide a link to this work or more information on this project?

#### **(b) Biological Diversity and Traditional Knowledge**

In general, Canada would suggest the addition of "**fair** and equitable" wherever the term "equitable sharing of benefits" appears as this is consistent with CBD language (for example page 81, para 295: "and **fair** and equitable sharing of benefits arising from **the utilization of genetic resources**," to the first line, as well as "**fair** and equitable benefit sharing" further on in this paragraph).

-page 81, (b) Biological Diversity and Traditional Knowledge, para 294, first bullet: In regards to "legal definitions", could the Bureau clarify which legal definitions they are referring to? (i.e. the CBD definition of genetic resources? definition of patentable subject matter?). Canada would be grateful for further clarification on the object of this bullet.

-page 81, para 294, regarding the second bullet: The patent system is designed to only reward novel and non-obvious innovations, not knowledge already in the public domain. While patent

prosecution cannot guarantee defect-free patents, there are several available mechanisms to challenge the validity of unduly granted patents (e.g. re-examination, opposition, court challenges). Proposals to establish TK databases would greatly reduce the likelihood of anticipated patents being granted by providing patent examiners with additional sources of potential prior art.

-page 82, para 297: While there is comprehensive measure of "disclosure requirement" proposals, there is no mention of other proposals that have been put forward in various international fora to deal with genetic resources and access and benefit-sharing, including proposals calling for the establishment of a database on genetic resources to facilitate the task of patent examiners in their prior art searches, the use of contracts between users and providers of genetic resources and material transfer agreements.

-page 82, para 296: The term "TK" is a term of art that potentially captures a vast range of subjects. Work by WIPO highlights the fact that there is no internationally agreed upon definition of TK. The lack of a clear understanding as to what is meant by the term TK raises a number of potential issues. For example, when the document discusses the possible links between the grant or exercise of patent rights with GRs and associated TK, is a link also being made to TCEs, including TCEs that may already be protected by copyright laws?

-page 84, (c) Ethics, para 302, bullet 2: this bullet is drawing an analogy between the consent of prior informed consent (PIC) of human subjects in bioethics and PIC under article 15.5 of the Convention on Biological Diversity, which refers to the consent of Contracting parties to the CBD. The two seem very different given that the PIC obligation under the CBD is not for individuals but rather for countries.

#### **Part X - Development related concerns**

-page 85, para 305: The Development Agenda consists of 45 recommendations; is the Bureau including the establishment of the CDIP as a recommendation?

-page 87, para 311: Last sentence regarding the international patent system: While discussions are on-going as to whether or not the international patent system should be used to support the objectives of the CBD, this paragraph presumes that there is a link between the patent system and biodiversity and that the use of the patent system is necessary.

-page 88, para 315: Canada has some concern with the sentence "The first question is whether the current, or any future, international patent system could be compatible with national policy objectives", this paragraph suggests that there is currently incompatibility between the international patent system and national policy objectives. It would be better to state: "The first question is whether or not the current, or any future, international patent system could be considered incompatible with national policy objectives."

#### **Annex II - Certain Aspects of National/Regional Patent Laws**

##### **Section (1) Prior Art** - on page 3, for information pertaining to Canada

-Replace "Subject-matter" with "Everything" so that the item 1 now reads "Everything available to the public before the filing date (priority date)."

##### **Section (2) Novelty** - on page 14, for information pertaining to Canada

-Replace the existing text with the following:

The subject matter of the invention had not been disclosed:

- (a) to the public, more than one year before the filing date by the applicant or by a person who obtained knowledge from the applicant;
- (b) to the public, before the filing date (priority date) by a person not mentioned in (a);
- (c) in a Canadian patent application with an earlier filing date (priority date) filed by a person other than the applicant.

**Section (3) Inventive Step (Obviousness)** - on page 28, for information pertaining to Canada

-Replace the existing text with the following:

The invention must not be obvious to a person skilled in the art having regard to information disclosed to the public:

- (a) more than one year before the filing date by the applicant or by a person who obtained knowledge from the applicant; and
- (b) before the filing date (priority date) by a person not mentioned in (a).

**Section (5) Sufficiency of Disclosure** - on page 60, for information pertaining to Canada

-Replace the existing text with the following:

A specification shall correctly and fully describe the invention and its operation or use in sufficiently full, clear, concise and exact terms to enable any person skilled in the art to carry it out.

**Section (6) Exclusions from Patentable Subject Matter** - on page 75, for information pertaining to Canada

-Replace the existing text with the following:

Scientific principles and abstract theorems (by law); methods of medical treatment, higher life forms, aesthetic creations (by jurisprudence).