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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-first session from December 2 to 5, 2019, chaired by Ms. Sarah Whitehead (United Kingdom). Due to the COVID-19 pandemic, the thirty-second session, which was scheduled to take place from June 2 to 5, 2020, had to be postponed.
2. During its thirty-first session, 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 during the thirty-first session of the Committee 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 this session provided a good opportunity for Member States to share their views and experiences, challenges and solutions on each of those issues.
4. Specifically, during this session, the Committee held discussions on the draft reference document on compulsory licensing, a study on approaches to the quality of patent grant process, and Part III of the further study on inventive step. The Committee also discussed a review of existing research on patents and access to medical products and health technologies as well as patent law provisions that had contributed to effective transfer of technology, including sufficiency of disclosure. Furthermore, the Committee continued discussion on the

proposals by the Member States, including the proposal by the Delegation of Brazil regarding a further study and sharing sessions on the requirement of sufficiency of disclosure.

5. In addition, the following two sharing sessions were held during the thirty-first session: (i) sharing session with respect to the use of artificial intelligence for examination of patent applications; and (ii) a sharing session held 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. With respect to patents and health, update on publicly accessible databases of patent status information concerning medicines and vaccines was provided by the invited institutions. Furthermore, the Committee agreed which initiatives on publicly accessible databases of patent status information concerning medicines and vaccines would be invited to the thirty-second session of the SCP to provide updates on the advances of their information platforms.

6. Member States also took note of the Secretariat's reports on: (i) WIPO's technical assistance activities relating to opposition systems and other administrative revocation mechanisms; and (ii) the sharing session regarding the experiences on capacity building activities related to negotiating licensing agreements, which had been held during the thirtieth session of the SCP.

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-first session. The Committee agreed that the non-exhaustive list of issues would remain open for further elaboration and discussion at the thirty-second 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 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, during the thirty-second session of the Committee, the Secretariat would organize a one-day information sharing session on issues related to the patentability of inventions, such as artificial intelligence (AI) software as computer-implemented inventions, the use of AI as an aid to the creation of inventions or inventions generated independently by artificial intelligence. In addition, the Committee will continue discussion on the proposal by the Delegation of Brazil regarding a further study and sharing sessions on sufficiency of disclosure. Furthermore, the Secretariat will submit at the thirty-second session of the Committee a report of the sharing session held during its thirty-first session, with respect to the use of AI for examination of patent applications, and information relating to WIPO's technical assistance activities relating to use of AI as tools for patent offices. Moreover, the Committee will continue discussions on document SCP/31/3 (Study on Approaches to the Quality of Patent Grant Process).

(c) As regards the topic "patents and health", it was decided that the Secretariat would organize a sharing session by Member States on challenges and opportunities in relation to types of patent licensing provisions in the healthcare technologies at the thirty-second session of the Committee. It was also decided that document SCP/31/5 (Review of Existing Research on Patents and Access to Medical Products and Health Technologies)

would be made available in the six official languages for further discussion at the thirty-second session of the Committee. Furthermore, national/regional patent offices would be invited to share information on their collaborations with initiatives on publicly accessible databases of patent status information concerning medicines and vaccines, such as MedsPaL at the thirty-second session of the SCP. In addition, the Health Canada Patent Register will be invited to present its database at that session.

(d) Concerning the topic “confidentiality of communications between clients and their patent advisors”, the SCP agreed that the Committee would continue discussion on recent developments and experiences with respect to confidentiality of communication between clients and their patent advisors, and on any suggestions/proposals by Member States. It was also agreed that the Secretariat would submit, at the thirty-second session of the Committee, a report of the sharing session held during its thirty-first session, by practitioners and Member States on recent developments and experiences with respect to confidentiality of communications between clients and their patent advisors.

(e) As regards the topic “transfer of technology”, the Committee agreed that, in accordance with the decision taken at the thirtieth session of the SCP, the Secretariat would organize, at its 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. The Committee also agreed that the Secretariat would continue to compile information on patent law provisions and practices that contributed to effective transfer of technology, based on inputs received from Member States and discussions in the Committee.

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. With respect to the developments in the SCP during 2019 and its contribution to the implementation of respective Development Agenda (DA) recommendations, during the thirty-first session of the SCP, the Delegation of Uganda, speaking on behalf of the African Group, underlined the importance of reporting the SCP’s contribution to the implementation of the DA recommendations to the WIPO General Assembly in accordance with its decision in 2010 concerning “Coordination Mechanisms and Monitoring, Assessing and Reporting Modalities”. The Delegation of Iran (Islamic Republic of) commended the Committee for its activities which significantly contributed to the implementation of some of the DA recommendations and expressed its anticipation for more substantive report by the Committee in the future. The Delegation of Croatia, speaking on behalf of the Central European and Baltic States (CEBS) Group, as well as Delegations of Switzerland, the United Kingdom and the United States of America noted that an established practice for reporting of Committee’s contribution to the DA recommendations should be followed. In this respect, reference is also made to the SCP’s contribution to the implementation of respective DA recommendations during 2019, contained in the Director General’s Report on the Implementation of the Development Agenda (document CDIP/25/2, paragraphs 65 to 68). An excerpt from that Report is reproduced, as follows:

“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. The discussions addressed, among others, WIPO’s technical assistance activities (DA Recommendation 5), flexibilities in international IP agreements (DA Recommendation 17), potential flexibilities, exceptions and limitations for Member States (DA Recommendation 22) and IP-related transfer of technology (DA Recommendations 19, 22, 25, 29 and 31).

“The activities of the SCP continued to be Member State driven and inclusive (DA Recommendation 15). In order to facilitate the dialogue among Member States, they were based on open and balanced consultations, in accordance with DA Recommendation 21. The SCP advanced discussions based on documents prepared by the Secretariat and proposals made by Member States.

“Discussions were also guided by sharing sessions and information exchange sessions. They facilitated the exchange of information on Member States’ laws, practices and experiences gained through national and/or regional implementation of laws. They also contributed to a participatory process, which took into consideration the interests and priorities of all Member States, as well as viewpoints of other stakeholders, including accredited IGOs and NGOs (DA Recommendations 15 and 42).

“In 2019, a number of those information and experience sharing sessions on topical issues continued to increase the understanding of the subjects addressed among Member States, namely: (i) capacity building activities relating to negotiating licensing agreements; (ii) approaches used by delegations to ensure the quality of the patent grant process within IP offices, including opposition systems (with special attention to the capacity building of patent examiners and offices); (iii) use of artificial intelligence for the examination of patent applications; (iv) update on publicly accessible databases of patent status information concerning medicines and vaccines; and (v) recent developments and experiences with respect to confidentiality of communications between clients and their patent advisors.”

10. The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Patents” (document WO/GA/53/4).

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