

Standing Committee on the Law of Patents

Twentieth Session
Geneva, January 27 to 31, 2014

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. The twentieth session of the Standing Committee on the Law of Patents (SCP) was opened by Mr. Jim Pooley, Deputy Director General, who welcomed the participants. Mr. Marco Aleman (WIPO) acted as Secretary.

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE CHAIRS

2. The SCP unanimously elected, for one year, Dr. Mokhtar Warida (Egypt) as Chair and Ms. Song Jianhua (China) as Vice-Chair.

AGENDA ITEM 3: ADOPTION OF THE DRAFT AGENDA

3. The SCP adopted the draft agenda (document SCP/20/1 Prov.3) with the addition of a new agenda item 11: Contribution of the SCP to the implementation of the respective Development Agenda Recommendations (see document SCP/20/1), on the understanding that it was not a standing agenda item.

AGENDA ITEM 4: ADOPTION OF THE DRAFT REPORT OF THE NINETEENTH SESSION

4. The Committee adopted the draft report of its nineteenth session (document SCP/19/8 Prov.2) as proposed.

AGENDA ITEM 5: REPORT ON THE INTERNATIONAL PATENT SYSTEM

5. Discussions were based on documents SCP/20/2 and 2 Corr.

6. The SCP agreed that the information concerning certain aspects of national/regional patent laws [http://www.wipo.int/scp/en/annex_ii.html] would be updated based on input received from Member States.

AGENDA ITEM 6: EXCEPTIONS AND LIMITATIONS TO PATENT RIGHTS

7. Discussions were based on documents SCP/14/7, SCP/19/6 and SCP/20/3 to 7.

8. A Seminar on Exceptions and Limitations to Patent Rights was held during the twentieth session of the SCP. The Seminar addressed the five exceptions and limitations, i.e., private and/or non-commercial use; experimental use and/or scientific research; preparation of medicines; prior use; and use of articles on foreign vessels, aircrafts and land vehicles. It consisted of the following three segments:

(i) a presentation of documents SCP/20/3 to 7 by the Secretariat;

(ii) presentations by the Chief Economist, Mrs. Cathy Garner, Board member of the Council on Health Research for Development (COHRED), London, United Kingdom, and Mr. Nikolaus Thumm, Visiting Fellow, Max Planck Institute, Center for Innovation and Entrepreneurship, Munich, Germany, on, *inter alia*, the effectiveness of exceptions and limitations when addressing developing concerns and how national capacities affect the use of exceptions and limitations; and

(iii) presentations by Member States of case studies on implementation of the above exceptions and limitations.

9. Delegations shared their experiences in implementing the exceptions and limitations, and discussed their challenges and solutions to overcome difficulties. The presentations will be posted on the SCP electronic forum.

AGENDA ITEM 7: QUALITY OF PATENTS, INCLUDING OPPOSITION SYSTEMS

10. Discussions were based on documents SCP/17/7, 8, 10, SCP/18/9, SCP/19/4 and 5, and SCP/20/8 and 11 Rev.

11. Proposals submitted by the Delegations of Canada and the United Kingdom (document SCP/18/9) and the Delegation of Spain (document SCP/19/5) were supported by some delegations. Some delegations supported the proposal made by the Delegations of the Republic of Korea, the United Kingdom and the United States of America (document SCP/20/11 Rev.), which was subsequently co-sponsored by the Delegation of Japan. Some other delegations supported certain elements contained in the above proposals, or requested clarifications on those proposals. Some other delegations stated that a common understanding on the definition of the term "quality of patents" was necessary in order to take further steps on this issue. Some delegations proposed that the requirement of sufficiency of disclosure for the quality of patents be studied. Some other delegations proposed that a compilation of models on opposition and administrative revocation systems be made, and a study on challenges for work sharing among various offices be conducted. Further, the Committee shared a general understanding that the proposals which had been submitted with

respect to the quality of patents did not lead to harmonization of substantive patent law and to automatic acceptance of work sharing products. Some delegations stated that any study should be a collection of factual information, and contain no analysis or recommendation.

AGENDA ITEM 8: PATENTS AND HEALTH

12. Discussions were based on documents SCP/16/7, SCP/16/7 Corr. and SCP/17/11.

13. A sharing session on countries' use of health-related patent flexibilities has been organized during the twentieth session of the SCP. A summary of the sharing session was distributed during that session, and will be posted on the SCP electronic forum website. Some delegations underlined the important role of the patent system in promoting innovation and development of new medicines. Some delegations stated that the SCP should undertake its work on this topic based on the proposal submitted by the Delegation of South Africa on behalf of the African Group and the Development Agenda Group (documents SCP/16/7 and 7 Corr.). Some delegations supported the proposal by the Delegation of the United States of America (document SCP/17/11). Some delegations called for a balanced and evidence-based approach in discussing the issue of patents and health, taking into account interests of all stakeholders and various relevant interfaces and factors.

AGENDA ITEM 9: CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS

14. Discussions were based on document SCP/20/9.

15. Some delegations supported the continuation of the discussion of this issue at the SCP and suggested that the issue be studied further. Some other delegations suggested the elaboration of non-binding minimum standards on possible remedies to solve cross-border issues, which could be used as a voluntary guide by national authorities. Some other delegations opposed that proposal, emphasizing that the issue was in the domain of private law and the matter for each national law. They also raised concerns about limiting disclosure of evidence as well as harmonization in this area.

AGENDA ITEM 10: TRANSFER OF TECHNOLOGY

16. Discussions were based on documents SCP/20/10.

17. Some delegations suggested that the Committee continue working on the practical aspects of transfer of technology by sharing examples and experiences, particularly in least developed countries. Some delegations stated that they were not in favor of launching new activities on transfer of technology in the SCP before the completion of the CDIP project on Intellectual Property and Technology Transfer: Common Challenges – Building Solutions. Some delegations, however, emphasized the different nature of the activities proposed in the SCP and the CDIP project. Some delegations recalled the impact of sufficiency of disclosure on transfer of technology. Some other delegations suggested that further activities on the issue of technology transfer be pursued.

AGENDA ITEM 11: CONTRIBUTION OF THE SCP TO THE IMPLEMENTATION OF THE RESPECTIVE DEVELOPMENT AGENDA RECOMMENDATIONS

18. A number of delegations made statements on the contribution of the SCP to the implementation of the respective Development Agenda Recommendations. The Chair stated that all statements would be recorded in the report for the twentieth session of the SCP and that they would be transmitted to the WIPO General Assembly in line with the decision taken by the 2010 WIPO General Assembly relating to the Development Agenda Coordination Mechanism. Some delegations requested that the issue be a standing agenda item, while some other delegations stated that the item should not be a standing agenda item.

INFORMATION ON THE PATENT-RELATED ACTIVITIES OF THE IP GLOBAL CHALLENGES PROGRAM (PROGRAM 18)

19. In accordance with the decision by the Assemblies held in December 2013, Mr. Christian Wichard, Deputy Director General, and Mr. Anatole Krattiger, Director, Global Challenges Division, informed Member States on the patent-related aspects of the activities of the IP and Global Challenges Program (Program 18).

AGENDA ITEM 12: FUTURE WORK

20. The Committee decided its future work as follows:

20.1. The non-exhaustive list of issues will remain open for further elaboration and discussion at the next session of the SCP.

20.2. Without prejudice to the mandate of the SCP, the Committee agreed that its work for the next session (SCP/21) be confined to fact-finding and not lead to harmonization at this stage, and would be carried out as follows:

(1) *Exceptions and Limitations to Patent Rights*

(i) The Secretariat will prepare a document, based on input received from Member States, on how the following exceptions and limitations are implemented in Member States, without evaluating the effectiveness of those exceptions and limitations: acts for obtaining regulatory approval from authorities; exhaustion of patent rights; compulsory licensing and/or government use; and exceptions and limitations relating to farmers' and/or breeders' use of patented inventions. The document should also cover practical challenges encountered by Member States in implementing them.

(ii) A 1/2 day seminar as proposed in document SCP/19/6 will be organized during SCP/21 on the above exceptions or limitations.

(2) *Quality of Patents, including Opposition Systems*

(i) The following two studies will be prepared by the Secretariat and submitted to SCP/22. They will be based on the information provided by Member States, and will be a collection of factual information without analysis or recommendation:

- (a) a study on inventive step that contains the following elements: the definition of the person skilled in the art, methodologies employed for evaluating an inventive step and the level of the inventive step; and
 - (b) a study on sufficiency of disclosure that contains the following elements: the enabling disclosure requirement, support requirement and written description requirement.
- (ii) The Committee will have an information sharing session during SCP/21 among Member States regarding experiences on international work sharing and collaboration. The Committee shared the understanding that discussions on work sharing and collaboration do not imply any automatic acceptance of work sharing products and do not prejudice the sovereign rights of Member States in processing patent applications and patents in accordance with the applicable law.
- (iii) Document SCP/20/11 Rev. will be added to the working documents listed in the agenda of the next session of the SCP.
- (iv) The Secretariat will improve the WIPO webpage (PCT-PPH) on work sharing initiatives.
- (3) *Patents and Health*
- (i) The Secretariat, in collaboration, to the extent possible, with the WHO and WTO, will carry out, for SCP/21, a feasibility study on the disclosure of International Nonproprietary Names (INNs) in patent applications and/or patents.
 - (ii) The Secretariat will prepare, for the next session of the SCP, a study on the role of patent systems in promoting innovative medicines, and in fostering the technology transfer necessary to make generic and patented medicines available in developing countries/least developed countries.
 - (iii) At SCP/21, the potential of a study on the implementation of flexibilities concerning different types of exhaustion of rights in Member States and its contents will be discussed.
- (4) *Confidentiality of communications between clients and their patent advisors*
- (i) The Secretariat will publish the information contained in document SCP/20/9 on the SCP electronic forum website in more accessible and user-friendly format, and update regularly.
 - (ii) The Committee will conduct, at the next session, a half-day seminar on the confidentiality of advice from patent advisors and practical experiences of clients as well as patent advisors.
 - (iii) Member States are invited to submit proposals on this topic.

(5) *Transfer of Technology*

(i) The Secretariat will collect further practical examples and experiences on patent-related incentives and impediments to transfer of technology from members and observers of the SCP, in particular from least developed countries, taking into account the dimension of absorptive capacity in technology transfer.

(ii) Member States are invited to submit proposals on this topic.

21. The Secretariat informed the SCP that its twenty-first session would tentatively be held from November 3 to 7, 2014 in Geneva.

22. The SCP noted that the present document was a summary established under the responsibility of the Chair and that the official record would be contained in the report of the session. The report would reflect all the interventions made during the meeting, and would be adopted in accordance with the procedure agreed by the SCP at its fourth session (see document SCP/4/6, paragraph 11), which provided for the members of the SCP to comment on the draft report made available on the SCP Electronic Forum. The Committee would then be invited to adopt the draft report, including the comments received, at its following session.

23. The SCP noted the contents of this summary by the Chair.

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