

Standing Committee on the Law of Patents

Seventeenth Session
Geneva, December 5 to 9, 2011

**REVISED PROPOSAL FROM THE DELEGATIONS OF CANADA
AND THE UNITED KINGDOM**

Document prepared by the Secretariat

1. The Annex to this document contains a revised proposal from the Delegations of Canada and the United Kingdom in respect of a work program on quality of patents, for consideration under item 6 of the revised draft agenda: Quality of Patents, including Opposition Systems.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

REVISED PROPOSAL ON QUALITY OF PATENTS

I. INTRODUCTION

1. The WIPO Standing Committee on the Law of Patents (SCP) reconvened in June 2008 after a three-year hiatus that was prompted by lack of agreement among Member States on the future work of the Committee.

2. Since June 2008, the Committee has met several times to discuss papers developed by the WIPO Secretariat and outside experts pursuant to mandates from Member States and covering a variety of topics with a view to developing a balanced work program for the Committee. While the discussions have been helpful in promoting a greater understanding of these issues, the Committee is still to develop its consideration of the prepared papers and studies into areas of concrete action.

3. These discussions are also taking place against the background of the Development Agenda, a number of agreed recommendations of which touch on subject matter relevant to or within the scope of the work of this Committee. Given this relationship, we believe the SCP is in a position to make a meaningful contribution to achieving positive, concrete results related to the Development Agenda.

4. The SCP was established “to serve as a forum to discuss issues, facilitate coordination and provide guidance concerning the progressive international development of the law of patents” (SCP/1/2, paragraph 3; see also A/32/2, Main Program 09, “Development of Industrial Property Law”). .

5. An important aspect of the patent system is the quality of patents. The patent system must function properly and achieve the appropriate balance of interests as between innovators, third parties and the public if it is to serve its purpose of promoting innovation and fostering technological, social and economic development, and to contribute to the transfer and dissemination of technology. The quality of patents is a key aspect of how the patent system functions in order to deliver economic and social policy objectives.

6. Patent offices make a significant contribution to the well-functioning of the patent system by taking appropriate measures to ensure that the patents they grant meet the standards that foster the policy objectives of the national and regional patent system. However, it is also the case that in nations which do not have an examining patent office it is the judicial system which acts as arbiter of quality. By focusing on the work that patent offices and judicial systems do to promote high quality patents, the Committee can engage in technical patent law, practice and procedure discussions.

7. Focusing on patent quality will also further basic aims of the Development Agenda, such as building the capacity of patent offices and providing technical assistance to such offices as needed.

8. To encourage development and progress on this issue the delegations of Canada and the United Kingdom put forward a proposal for a work program on the quality of patents at the 16th session of the SCP. At the time of the 16th session many delegations which took the floor to intervene on the agenda item relating to the proposal. While a number of delegations suggested work proposals which would fit within a work program on the quality of patents, other delegations expressed concerns and were not ready to fully endorse the proposal.

9. This revised paper seeks to address the concerns raised by Member States.

II. QUALITY OF PATENTS – A DEFINITION

10. At the 16th session of the SCP no specific definition of “quality of patents” was given: we did not wish to be prescriptive. Our reluctance to give a definition was due to our desire to allow each member state to maintain its own definition of what constitutes quality based, in part, on internal patent office priorities, national patent policies, and the impact of patents on their respective social and economic realities. However, it is apparent that some member states feel unable to commit the Committee to pursuing work on this issue without clarification on this matter. To this end it is suggested that as patents aim to satisfy the legal, social, and economic requirements within national jurisdictions, and national and regional patent offices, and judicial systems, exist to ensure those requirements are met, the degree to which they achieve this, in conjunction with stakeholders, within their jurisdictions, is a measure of quality. ‘Quality of patents’ therefore encompasses the quality of the totality of features and characteristics of the work national and regional patent offices and judicial systems pursue in satisfying their legal, social and economic requirements.

11. To better illustrate the definition, the following examples of activities which might fall under it are offered, though are not intended to limit:

- (a) The proper examination of patent applications based on the criteria or requirements as set out by respective patent offices. E.g. quality control of the patent examination process at patent offices ensures that patents granted meet the respective legal, social, and economic requirements or criteria.
- (b) The role quality management systems play in improving the internal control, risk management, and governance within patent offices.
- (c) The relationships patent offices have with their stakeholders which ensure that applications received enable offices to grant patents which fulfill the legal, social, and economic requirements to the greatest possible extent.

12. While it may be a laudable objective to come to a common definition of quality, we believe that there enough common elements of interest to enable work in this area to now be undertaken.

III. PROPOSAL FOR AN SCP WORK PROGRAM ON QUALITY OF PATENTS

13. It is contended that every member state would have an interest in the quality of patents within its jurisdiction, and it is thought that this definition is broad enough to encompass activities of interest to all Member States. Therefore, we think it appropriate that the work of this Committee should focus on the quality of patents and, accordingly, we propose the following work program.

14. The proposed work plan for the SCP has three main components:

- (a) Technical infrastructure development;
- (b) Information access and exchange on quality of patents;
- (c) Process improvement.

15. Technical infrastructure development is intended to focus on information technology solutions to improve access to information relevant to patentability. Such improvements can help build search and examination capacity by leveraging technology to enhance existing

examination resources, and promote higher quality by providing access to new sources of information or new and improved ways of accessing existing information.

16. Information access and exchange on quality of patents is intended to help patent offices gain a greater understanding of the role of quality in patent office processes as they may contribute to the well-functioning of the patent and legal systems. The primary focus of this information exchange would be on patent office administrative processes and operations issues as they relate to quality assurance in the grant of patent rights. It is intended that patent offices of interested Member States will collect views and experiences from their users relating to quality of patent office processes and operations and share them with the Committee for further consideration. This work could allow patent offices to identify areas for improvement of patent office operations and processes affecting patent quality.

17. Process improvement is intended to identify ways offices can improve their patent granting processes to ensure an appropriate degree of quality, taking into account resource and other constraints as well as flexibilities provided for under international agreements. The primary focus of this component would be on search and examination processes. However, it could also consider relevant processes beyond grant, for example opposition procedures or the quality of applications filed.

18. It is envisioned that work will proceed on each component of the work plan concurrently, with a view to realizing near-term results and gains where possible. By making discrete progress initially, the Committee can build momentum toward greater gains in the future.

IV. DUPLICATION

19. This committee has long sought, with good reason, to avoid duplicating the work of other WIPO bodies. It is considered that the proposals fitting within the above work program would not be duplicative of work carried out in other bodies.

20. At the 16th session of the SCP it was suggested that this issue of duplication arose between this committee and those WIPO bodies concerned with the Patent Cooperation Treaty (PCT). While it is the case that the issue of quality of international work reports has been discussed in the Meeting of International Authorities, and that several member states of the SCP also act as International Authorities, many others act under the PCT only in a national capacity and have no direct influence on the quality of international work products. Furthermore, many more member states of the SCP are not signatories to the PCT, and are excluded from those discussions on quality. By raising the issue of quality of patents in the SCP it is believed that this issue of universal importance can be considered by the greatest number of interested parties.

V. LINKS TO THE DEVELOPMENT AGENDA

21. This proposal, in our view, is inclusive of a broad range of interests of member states at different levels of development, as well as interests of users of the patent system and society more generally. More particularly, we believe this work plan is in keeping with the mandate and core expertise of this Committee as well as a number of recommendations of the Development Agenda, including, but not limited to:

- (a) Recommendation 10: To assist Member States to develop and improve national intellectual property institutional capacity through further development of infrastructure and other facilities with a view to making national intellectual property institutions more efficient and promote fair balance between intellectual property protection and the public interest.

This technical assistance should also be extended to sub-regional and regional organizations dealing with intellectual property;

(b) Recommendation 11: To assist Member States to strengthen national capacity for protection of domestic creations, innovations and inventions and to support development of national scientific and technological infrastructure, where appropriate, in accordance with WIPO's mandate;

(c) Recommendation 19: To initiate discussions on how, within WIPO's mandate, to further facilitate access to knowledge and technology for developing countries and LDCs to foster creativity and innovation and to strengthen such existing activities within WIPO; and

(d) Recommendation 29: To include discussions on intellectual property related technology transfer issues within the mandate of an appropriate WIPO body.

[End of Annex and of document]