

Standing Committee on the Law of Patents

Twenty-First Session
Geneva, November 3 to 7, 2014

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. The twenty-first session of the Standing Committee on the Law of Patents (SCP) was opened by Mr. James Pooley, Deputy Director General, who welcomed the participants. The session was chaired by Mr. Mokhtar Warida (Egypt). Mr. Marco Aleman (WIPO) acted as Secretary.
2. The SCP unanimously elected Mrs. Bucura Ionescu (Romania) and Mr. Victor Portelli (Australia) as ad hoc Vice Chairs for the twenty-first session.

AGENDA ITEM 2: ADOPTION OF THE DRAFT AGENDA

3. The SCP adopted the draft agenda (document SCP/21/1 Prov.2).

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE TWENTIETH SESSION

4. The Committee adopted the draft report of its twentieth session (document SCP/20/13 Prov.2) as proposed.

AGENDA ITEM 4: REPORT ON THE INTERNATIONAL PATENT SYSTEM

5. Discussions were based on document SCP/21/2.

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 5: EXCEPTIONS AND LIMITATIONS TO PATENT RIGHTS

7. Discussions were based on documents SCP/14/7, SCP/19/6 and SCP/21/3 to 7.

8. A Seminar on Exceptions and Limitations to Patent Rights was held during the twenty-first session of the SCP. The Seminar addressed the following four exceptions and limitations: (i) acts for obtaining regulatory approval from authorities; (ii) exhaustion of patent rights; (iii) compulsory licensing and/or government use; and (iv) exceptions and limitations relating to farmers' and/or breeders' use of patented inventions. It consisted of the following three segments:

(i) a presentation of documents SCP/21/3 to 7 by the Secretariat;

(ii) presentations by the Chief Economist of WIPO, Ms. Margaret K. Kyle, Professor, MINES ParisTech, France, and Ms. Jayashree Watal, Counsellor, Intellectual Property Division, World Trade Organization, Switzerland 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, and made suggestions to move forward. The presentations will be posted on the WIPO website.

AGENDA ITEM 6: 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 Rev. and SCP/20/11 Rev.

11. A sharing session regarding Member States' experiences on international work sharing and collaboration was organized during the twenty-first session of the SCP. A number of delegations shared their experiences relating to various international work sharing and collaboration initiatives. A summary of the sharing session as well as presentations were distributed during the session, and will be posted on the WIPO website.

12. A proposal made in document SCP/20/11 Rev. was supported by some delegations. 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 that issue. Some other delegations proposed that a study on opposition systems and constraints relating to the use of those systems be carried out. Further, a proposal to carry out a study on whether and how work sharing programs could assist patent offices in conducting more efficient searches and examinations was made.

13. Some delegations expressed their gratitude for improving the PCT-PPH webpage. Some delegations stated that a separate webpage should be developed to include all work sharing and collaborative activities between patent offices.

AGENDA ITEM 7: PATENTS AND HEALTH

14. Discussions were based on documents SCP/16/7, SCP/16/7 Corr., SCP/17/11 and SCP/21/8 and 9.

15. With respect to the 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 (document SCP/21/8), delegations discussed various issues that were addressed in that study, for example, the effect of the patent system in promoting innovative medicines and transfer of technology, the role of non-patent based factors, issues arising from the use of certain indicators and WHO work on patents and pharmaceutical research and development.

16. As regards the feasibility study on the disclosure of International Nonproprietary Names (INN) in patent applications and/or patents, some delegations discussed the usefulness of the disclosure of INN in patent applications and/or patents, and stated that burdens, if any, associated with the disclosure were marginal if the respective INN was known. Some other delegations emphasized the aspects of costs and burdens of such disclosure, and underlined that INN disclosure did not facilitate patent search.

17. In addition, the Committee discussed the potential of a study on the implementation of flexibilities concerning different types of exhaustion of rights in Member States and its contents. Some delegations were of the view that activities under the agenda item “exceptions and limitations to patent rights” had sufficiently covered the issue. Some other delegations stated that analysis on how different types of exhaustion affected accessibility, quality and price of medicines had not been carried out in the documents prepared under that agenda item.

AGENDA ITEM 8: CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS

18. A Seminar on the Confidentiality of Advice from Patent Advisors was held during the twenty-first session of the SCP. The seminar addressed cross-border issues relating to the confidentiality of advice from patent advisors, and practical experiences of clients as well as patent advisors were presented during the Seminar. Patent advisors' perspectives were presented by Mr. Pravin Anand, Anand and Anand, India, Mr. Jeffery Lewis, Patterson Belknap Webb & Tyler, United States of America, Mr. Wouter Pors, Bird & Bird, Netherlands, and Mr. Steven Garland, Smart & Biggar/Fetherstonhaugh, Canada. Those presentations were made on behalf of the associations of which they were members, i.e., AIPPI, AIPLA and FICPI. Clients' perspectives were presented by Mr. Hans Blöchle, Head Global Intellectual Property of the Schindler Group, Switzerland and Ms. Manisha A. Desai, Assistant General Patent Counsel, Eli Lilly and Company, United States of America. The Secretariat presented a webpage containing comprehensive information that had been produced through the work of the Committee on the subject.

19. Some delegations suggested that the Committee develop a non-binding soft law instrument (ex. WIPO Recommendation, non-binding model law, non-binding guidelines) to address cross-border aspects of the confidentiality of advice by patent advisors. Some other delegations opposed that proposal, emphasizing that the issue was a matter of each national law, and thus should not be discussed within the SCP. Some delegations suggested that a questionnaire exploring obstacles to introducing client-patent advisor privilege be carried out by the Secretariat.

AGENDA ITEM 9: TRANSFER OF TECHNOLOGY

20. Discussions were based on documents SCP/21/10.

21. Some delegations suggested that the Secretariat compile information on national/regional regulations, guidelines, practices and jurisprudence regarding voluntary licenses. Some other delegations suggested that the Committee further study patent-related impediments to transfer of technology. Some delegations stated that new activities on transfer of technology in the SCP should not be launched 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 other delegations suggested that further activities on the issue of technology transfer be pursued.

AGENDA ITEM 10: FUTURE WORK

22. The Delegation of Paraguay on behalf of the Group of Countries of Latin America and the Caribbean (GRULAC), suggested that the Secretariat prepare draft modalities and terms of reference for the revision of the WIPO Model Law for Developing Countries on Inventions of 1979. Some delegations stated that the current five substantive agenda items that reflected a balance of different priorities should be maintained. The Chair noted that the proposal by GRULAC could be presented and discussed at the next session.

23. The Committee decided its future work as follows:

24. The following two studies will be prepared by the Secretariat and submitted to the twenty-second session of the SCP as agreed at its twentieth session:

- (i) 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
- (ii) a study on sufficiency of disclosure that contains the following elements: the enabling disclosure requirement, support requirement and written description requirement.

25. The Secretariat informed the SCP that the dates of its twenty-second session, to be held in Geneva, would be announced in due course.

26. 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.

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

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