

Standing Committee on the Law of Patents

Twenty-Eighth Session
Geneva, July 9 to 12, 2018

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. The twenty-eighth session of the Standing Committee on the Law of Patents (SCP) was opened by Mr. Dámaso Pardo, elected Chair of the SCP. Mr. Marco Aleman, Director, Patent Law Division, welcomed the participants on behalf of the Director General, and acted as Secretary.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

2. The SCP adopted the revised draft agenda (document SCP/28/1 Prov.3).

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE TWENTY-SEVENTH SESSION

3. The Committee adopted the draft report of its twenty-seventh session (document SCP/27/10 Prov.2) as proposed.

AGENDA ITEM 4: REPORT ON THE INTERNATIONAL PATENT SYSTEM

4. Discussions were based on document SCP/28/2.

5. Some delegations shared information on recent developments of their national/regional patent laws with the Committee.

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, SCP/28/3 and 3 Add.

8. The Committee held discussions on the second draft of a reference document on exception regarding acts for obtaining regulatory approval from authorities (SCP/28/3 and 3 Add.). The Committee continued discussion on the issues regarding exceptions and limitations to patent rights.

AGENDA ITEM 6: QUALITY OF PATENTS, INCLUDING OPPOSITION SYSTEM

9. Discussions were based on documents SCP/17/7, 8 and 10, SCP/18/9, SCP/19/4, SCP/20/11 Rev., SCP/23/4, SCP/24/3, SCP/28/4, 7 and 8.

10. A sharing session on opposition and administrative revocation mechanisms was held.

11. In addition, a further study on inventive step (document SCP/28/4) was discussed.

12. Furthermore, Member States shared experiences on cooperation between patent offices in search and examination, including sharing of information concerning the corresponding foreign applications and grants.

13. The Committee continued discussion on the issues under this agenda item. The Delegation of Spain introduced its proposal to conduct studies on new technologies and patentability (document SCP/28/7). The Delegation of the United Kingdom introduced a proposal by the Delegations of the Czech Republic, Kenya, Mexico, Singapore and the United Kingdom to explore the different approaches used by national and regional offices to ensure the quality of the patent grant process with a particular focus on search, examination and formalities procedures (document SCP/28/8). Some other delegations suggested other activities to be carried out by the Committee with respect to quality of patents, including opposition systems.

AGENDA ITEM 7: PATENTS AND HEALTH

14. Discussions were based on documents SCP/16/7 and 7 Corr., SCP/17/11, SCP/24/4, SCP/27/8 and 8 Add., SCP/28/5, 6, 9, 9 Add. and 10.

15. The Secretariat presented a report on WIPO's technical assistance activities in respect of enhancing patent examiners capacity (document SCP/28/6). Member States shared their experiences with respect to enhancing examiners capacity, particularly in small and medium-sized offices.

16. In addition, the Committee discussed the updated feasibility study on the disclosure of International Nonproprietary Names (INN) in patent applications and patents (document SCP/28/5).

17. Furthermore, the Committee continued exchanging information on publicly accessible databases on patent information status and data, on medicines and vaccines, taking the issues

addressed in paragraphs 18 and 19 of document SCP/24/4 (Proposal by the African Group for a Work Program on Patents and Health) into consideration.

18. The Committee continued further discussion on the aspects reflected in the proposals by the African Group (SCP/16/7 and 7 Corr. and SCP/24/4) and by the United States of America (SCP/17/11). The Delegation of Canada introduced a proposal by the Delegations of Argentina, Brazil, Canada and Switzerland to conduct a review of existing research on patents and access to medical products and health technologies (document SCP/28/9 and 9 Add.). The Delegation of Switzerland introduced a proposal by the Delegations of Argentina, Brazil and Switzerland asking for a regular update on publicly accessible databases of patent status information concerning medicines and vaccines (document SCP/28/10). Some other delegations suggested other activities to be carried out by the Committee with respect to patents and health.

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

19. Member States continued sharing their experiences and court cases in implementing the confidentiality of communication between clients and their patent advisors through national legislation, including cross-border issues. Some delegations suggested activities to be carried out by the Committee under this agenda item. Some other delegations suggested that the issue be left to national laws.

AGENDA ITEM 9: TRANSFER OF TECHNOLOGY

20. Member States continued sharing information on patent law provisions that contributed to effective transfer of technology. Some delegations suggested activities to be carried out by the Committee under this agenda item. Some other delegations suggested that discussion on this topic should take place in the CDIP.

AGENDA ITEM 10: FUTURE WORK

21. The Committee decided its future work as follows:

- The non-exhaustive list of issues will remain open for further elaboration and discussion at the next session of the SCP.
- Without prejudice to the mandate of the SCP, the Committee agreed that its work for the next session be confined to fact-finding and not lead to harmonization at this stage, and would be carried out as follows:

Exceptions and Limitations to Patent Rights

- In accordance with the agreement within the Committee at SCP/26, the Secretariat will 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 research exception, which will be submitted to SCP/29. Following the preparation and presentation of the draft reference document on the research exception, the Secretariat will prepare a draft reference document on the exception regarding compulsory licensing for SCP/30. Both reference documents will follow the style and structure of the draft reference document on the exception regarding acts for obtaining regulatory approval from

authorities (document SCP/28/3). Document SCP/28/3 will be kept open for future discussion by the Committee. The Secretariat will invite Member States to send any additional inputs for the preparation of the draft reference document on the research exception.

Quality of Patents, including Opposition Systems

- The Secretariat will prepare a further study on inventive step (part 2), giving particular attention to the topics suggested in paragraph 8 of Annex to document SCP/24/3 (Proposal by the Delegation of Spain).
- A half-day conference on cooperation between patent offices in search and examination, including sharing of information concerning the corresponding foreign applications and grants, will be held at SCP/29.
- A sharing session will be held at SCP/29 on approaches used by delegations to ensure the quality of the patent grant process within IP offices, including opposition systems, and any challenges faced and how they have been overcome, taking into consideration paragraph 7.a. of Annex to document SCP/28/8 (Proposal by the Delegations of the Czech Republic, Kenya, Mexico, Singapore and the United Kingdom).
- The Committee will continue discussion on the proposal by the Delegation of Spain (document SCP/28/7).

Patents and Health

- A half-day conference on publicly accessible databases on patent information status and data, on medicines and vaccines, will be held at SCP/29, taking into consideration the issues addressed in paragraphs 18 and 19 of the Annex to document SCP/24/4 (Proposal by the African Group for a Work Program on Patents and Health).
- The Secretariat will invite practitioners to share their experience on negotiating licensing agreements at SCP/29, giving particular attention to paragraph 20.a of Annex to document SCP/24/4 (Proposal by the African Group for a Work Program on Patents and Health).
- The Committee will continue discussion on the proposal by the Delegations of Argentina, Brazil, Canada and Switzerland (document SCP/28/9 and 9 Add.) and the proposal by the Delegations of Argentina, Brazil and Switzerland (SCP/28/10) at SCP/29, without prejudice to other proposals with respect to this agenda item.

Confidentiality of Communications between Clients and Their Patent Advisors

- The Secretariat will update document SCP/20/9 (Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information), and submit it to SCP/29. This update will also be reflected on the dedicated website "Confidentiality of Communications between Clients and Their Patent Advisors". The Secretariat will invite Member States to send any additional inputs for the preparation of the updated document.

Transfer of Technology

- Based on the discussions within the SCP, including those during the sharing sessions, the Secretariat will compile information on patent law provisions that contribute to effective transfer of technology, including sufficiency of disclosure.

22. The Secretariat informed the SCP that the dates of its twenty-ninth session, to be held in Geneva, were tentatively scheduled from December 3 to 6, 2018.

23. 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.

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

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