
Standing Committee on the Law of Patents (SCP)
Twenty-eighth session (July 9 to 12, 2018)

Presentation by the Secretariat
Feasibility study on the disclosure of INN (SCP/21/9)

**INN:** Unique, universal nonproprietary name to identify a pharmaceutical substance; widely used by health professionals
- ex. ibuprofen, paracetamol, atazanavir, sofosbuvir

Currently, an applicant may choose any indication as long as the invention is sufficiently disclosed.

<table>
<thead>
<tr>
<th>atazanavir (INN)</th>
<th>198904-31-3 (CAS Reg. number)</th>
<th>Methyl N-[[1S]-1-[[2S,3S]-3-hydroxy-4-[2S]-2-[(methoxycarbonyl)amino]-3.3-dimethyl-N’-[[4-(pyridin-2-yl)]... (IUPAC chemical name)</th>
</tr>
</thead>
<tbody>
<tr>
<td>BMS-232632 (manufacturer name)</td>
<td>C38H52N6O7 (Molecular formula)</td>
<td>(Chemical structure)</td>
</tr>
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</table>
Feasibility study on the disclosure of INN (SCP/21/9)

- INN cannot be disclosed in patent applications before it is assigned.
- To search a founder patent with an INN keyword, the INN must be retroactively linked to the founder patent.

→ Various issues to be considered

- Alternative ways to improve patent search on pharmaceutical substances (ex. Orange Book, ICT development)?

Patenting activities of atazanavir

<table>
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<tr>
<th>Invention Families</th>
<th>Invention</th>
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<td>[Graph showing patenting activities from 1995 to 2010]</td>
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INN Atazanavir 2003
Feasibility Study on the Disclosure of INN (SCP/21/9)
- Discussed at SCP/21, SCP/23 and SCP/25 between 2014 and 2016

Updated Feasibility Study on the Disclosure of INN (SCP/28/5)
- Maintains the same structure as SCP/21/9
- Continues to be confined to fact finding, without engaging in evaluations and recommendations
- Reflects the developments since 2014
  - Statistical information regarding INN
    - ex. INN on biologics (40% in 2014 → 46%)
- Discussions at the SCP sessions
Observation regarding PLT Article 6(1): PCT Rule 10 (Terminologies and Signs) may be construed as being part of the requirements under PLT Article 6(1).

Finalization of the Guidelines for Examination of Patent Applications in the Field of Pharmaceuticals published by the Office of the Controller General of Patents, Designs and Trademarks of India.

Observations relating to searchability of applications filed/patent granted before the publication of INN during the SCP sessions

- Patent offices should implement a new procedures later in the prosecution process in order to incorporate the INN information in already filed applications/ granted patents.
- Some national laws might not provide a mechanism for reopening the prosecution of already granted patents (resource intensive).
- SCP discussions should be confined to the disclosure of INN in a patent application if the corresponding INN is known to the applicant.
- Applicants could voluntarily indicate INN in a patent application if it is known at the time of filing, and in practice, they usually do so.
Further development of patent search databases using software algorithms to match INN to a given compound

- PATENTSCOPE chemical structure search, SureCHEMBL

Special databases that link medicine data and patent data

- MedsPaL, SIGA (Mexico), Pat-INFORMED
Thank you.