

Standing Committee on the Law of Patents

Twenty-Ninth Session
Geneva, December 3 to 6, 2018

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

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

AGENDA ITEM 2: ADOPTION OF THE AGENDA

2. The SCP adopted the draft agenda (document SCP/29/1 Prov.), with inclusion of documents SCP/28/10 Add. and SCP/29/6 Corr.

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

3. The Committee adopted the draft report of its twenty-eighth session (document SCP/28/12 Prov.2), as proposed.

AGENDA ITEM 4: REPORT ON THE INTERNATIONAL PATENT SYSTEM

4. Discussions were based on document SCP/29/2.

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 and SCP/29/3.

8. The Committee held discussions on the draft reference document on research exception (SCP/29/3). 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/28/7 and 8 and SCP/29/4.

10. A sharing session was held with respect to approaches used by delegations to ensure the quality of the patent grant process within IP offices, including opposition systems, any challenges faced and how they have been overcome.

11. In addition, a half-day conference on cooperation between patent offices in search and examination, including sharing of information concerning the corresponding foreign applications and grants, was held.

12. Furthermore, a further study on inventive step (part II) (document SCP/29/4) was discussed.

13. The Committee continued discussion on the issues and the proposals by the Member States relating to this agenda item, including the proposal by Spain (document SCP/28/7), in accordance with the decision of the twenty-eighth session of the SCP. 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/28/9, 9 Add., 10 and 10 Add.

15. A half-day conference on publicly accessible databases on patent information status and data, on medicines and vaccines, was held, 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).

16. In addition, practitioners shared their experiences on negotiating licensing agreements with the Committee, 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).

17. 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). In addition, as decided at the twenty-eighth session of the SCP, the Committee continued 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, Chile and Switzerland (SCP/28/10 and 10 Add.), without prejudice to other proposals with respect to this agenda item. 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

18. Discussions were based on document SCP/29/5.

19. The Committee discussed document SCP/29/5 (Confidentiality of Communications between Clients and their Patent Advisors: Compilation of Laws, Practices and other Information), which constituted an update of document SCP/20/9. 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, or noted that it was premature to discuss an international framework on this issue.

AGENDA ITEM 9: TRANSFER OF TECHNOLOGY

20. Discussions were based on document SCP/29/6 and 6 Corr.

21. The Committee discussed patent law provisions that had contributed to effective transfer of technology, including sufficiency of disclosure (document SCP/29/6 and 6 Corr.). 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

22. 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/28, the Secretariat will continue to work on a draft reference document on exceptions and limitations to patent rights in conjunction with patent protection, and will prepare a draft reference document on the exception regarding compulsory licensing for SCP/30. The Secretariat will invite Member States to send any additional inputs for the preparation of the draft reference document on the exception regarding compulsory licensing. The draft reference document on the research exception (document SCP/29/3) will be kept open for future discussion by the Committee. At SCP/30 the Committee will decide on the topic for SCP/31.

Quality of Patents, including Opposition Systems

- The Secretariat will prepare a further study on inventive step (part 3), giving a particular attention to the topics suggested in paragraph 8 of Annex to document SCP/24/3 (Proposal by the Delegation of Spain).
- The Secretariat will prepare a background document on patents and emerging technologies and submit it to SCP/30.
- With a view to prepare a study based on paragraph 7(b) of document SCP/28/8 on approaches to the quality of the patent grant process, to be submitted to SCP/31, the delegations will continue sharing their practices on this issue, including opposition systems. As a next step, special attention should also be given to the capacity building of patent examiners and offices.

Patents and Health

- The Committee will carry out a work program contained in the proposal by the Delegations of Argentina, Brazil, Chile and Switzerland (SCP/28/10 REV) regarding a regular update on publicly accessible databases of patent status information concerning medicines and vaccines, which was revised during SCP/29.
- The Secretariat will commence work on a review of existing research on patents and access to medical products and health technologies, as contained in document SCP/28/9, as revised during SCP/29, and will present a final report at SCP/31.
- The Secretariat, as well as invited relevant institutions, will share their experiences on capacity building activities relating to negotiating licensing agreements at SCP/30, giving a 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).

Confidentiality of Communications between Clients and Their Patent Advisors

- The Secretariat will continue update 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 based on document SCP/29/5.

Transfer of Technology

- The Secretariat will continue to compile information on patent law provisions and practices that contributed to effective transfer of technology, including sufficiency of disclosure, based on the inputs to be received from Member States and discussion within the SCP.

23. The Secretariat informed the SCP that the dates of its thirtieth session, to be held in Geneva, were tentatively scheduled from June 24 to 27, 2019.

24. 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.

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

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