

Standing Committee on the Law of Patents

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REPORT ON WIPO'S TECHNICAL ASSISTANCE ACTIVITIES RELATING TO OPPOSITION SYSTEMS AND OTHER ADMINISTRATIVE REVOCATION MECHANISMS

Document prepared by the Secretariat

INTRODUCTION

1. The Standing Committee on the Law of Patents (SCP), at its thirtieth session, held in Geneva from June 24 to 27, 2019, agreed that the Secretariat would submit, at the thirty-first session of the SCP, a report on its technical assistance activities relating to opposition systems and other administrative revocation mechanisms. Consequently, this document contains information on WIPO's technical assistance activities relating to these areas.

2. It should be noted that the majority of the relevant WIPO technical assistance activities described in this document does not necessarily focus on the opposition systems and other administrative revocation mechanisms only. Rather, the issues are addressed within the broader technical assistance activities that support the designing of the patent system and facilitate operation and use of the patent system. This is understandably so, because the opposition system, for example, can be one element of the national patent system as a whole, which has to be operated in the context of the unique set of circumstances, aspirations and challenges in each country.

3. In addition, since the discussions in the SCP cover not only the opposition systems and administrative revocation mechanisms *per se*, but also re-examination systems and a third party observation mechanism, this document covers WIPO's technical assistance activities that relate to any of these systems and mechanisms. In general, in countries where patent examiners carry out the opposition/re-examination procedures, trainings for patent examiners to improve

their substantive patent examination skills may also support proper assessment of cases under those procedures.

TECHNICAL ASSISTANCE ACTIVITIES BY WIPO RELATING TO OPPOSITION SYSTEMS AND OTHER ADMINISTRATIVE REVOCATION MECHANISMS

Legislative and policy advice

4. WIPO provides legislative and policy advice in the area of patents upon request of Member States on a confidential basis. The requests received by WIPO vary, from reviewing an entire patent law or regulations to more targeted inquiries on specific topics. Advice, delivered in the form of seminars, consultations and written comments, describes the requirements established by a country's international commitments as well as options for implementing their legislative and regulatory framework, taking into account of the specific circumstances of each country. This includes, as appropriate, a discussion of options and practices relating to an opposition system, third party observations, and an administrative revocation mechanism.

5. When providing the related advice, WIPO works with countries to identify their specific policy objectives. With respect to opposition systems, third party observations, and administrative revocation mechanisms, a number of factors related to the local environment are also reviewed when developing the advice. This may include, for example, the level of technical expertise within the country, the existing patent examination procedure, the availability of patent related documentation and the resources needed to manage current and future processes. The advice may relate to both substantive and procedural aspects.

WIPO Academy

6. Under the Professional Development Program of the WIPO Academy, a number of patent courses are offered in partnership with patent offices for the benefit of developing countries and countries with economies in transition. Through these training courses, for instance in 2018 and 2019, topics such as administrative revocation systems, invalidation mechanisms and litigation systems as well as trial and appeal proceedings have been covered in these programs.

7. In addition, the WIPO Distance Learning Course DL-301 (Patents) also touches upon opposition systems and administrative revocation mechanisms, among other matters.

8. Furthermore, in all of the WIPO Joint Master's Degree Programs, there are modules relating to industrial property. The teaching of these modules incorporates patent opposition systems and administrative revocation mechanisms.

Resource and Management Diagnostic Project for Intellectual Property (IP) Offices

9. WIPO has been conducting a Project entitled "Resource and Management Diagnostic on Intellectual Property (IP) Offices" in a number of countries in Asia. The objective of the project is to assist IP offices in identifying gaps and weaknesses in resource development and management plans and to make practical recommendations to the IP offices so as to enhance delivery of IP services effectively and efficiently to the user community.

10. The Project involves: (i) undertaking a comprehensive strategic review of the participating IP office's mandate and its legal/institutional/human resource/operational frameworks; (ii) making careful assessment and determination of resources needed to implement its mandates/visions/goals effectively, taking into consideration future projections of growth, and

external factors; (iii) auditing the existing organizational, human, financial and infrastructure resources; and (iv) exploring feasible/practical solutions and mechanisms to address the gap between existing and needed resources and management systems.

11. In the course of the Project, the issues relating to the opposition system and administrative revocation, among many other things, were also looked into from the angle of improving practical resource and operational management within IP offices, for example, doing away with redundancies and inefficiency. Following the comprehensive desk research and consultation meetings, a tailor-made and confidential report with specific recommendations was prepared for each IP office. The Project is at various stages of the implementation in a number of countries.¹

Third Party Observation System under the Patent Cooperation Treaty (PCT)

12. The International Bureau of WIPO has been organizing technical assistance activities *vis-à-vis* the PCT Member States as well as states considering accession to the PCT. The activities cover various aspects of the PCT system, including the third party observation system that allows third parties to make observations through ePCT without strong authentication. Third parties may refer to prior art which they believe to be relevant to the question of whether the invention claimed in the international application is novel and/or involves an inventive step. A comprehensive user guide of this free-of-charge Third Party Observation system is available online.²

13. Through these activities, various stakeholders, i.e., not only applicants but also possible competitors (third parties), can draw examiners' and others attention to a piece of prior art which may be potentially relevant to the patentability of the invention in question. The Third Party Observation System under the PCT started in July 2012. After the first five years of operation, Member States have been invited to provide information on the effect of third party observations on national processing of the PCT international applications. So far, insufficient information is available to make an effective assessment.

Provision of information

14. The WIPO website contains rich information on opposition systems and other administrative revocation mechanisms. While provision of information may be not considered as "technical assistance activities" in a strict sense, unbiased and accurate information may assist policy makers to make well-informed decisions for designing a national/regional patent system. Even if patent policies, legal frameworks and practices of each country are different, relevant information and experiences of countries from a broad spectrum may be a useful resource for any country. Specifically, the SCP has developed a dedicated website on the opposition systems, re-examination systems, administrative revocation mechanisms and third party observations,³ in which detailed descriptions about the rationales and objectives as well as explanations on the relevant international, regional and national laws are provided. The website is regularly updated, in cooperation with the Member States. In addition, WIPO Lex provides access to laws and regulations of the Member States of WIPO.

15. Many WIPO publications, which are made available on the website, contain the description of opposition systems and other administrative revocation mechanisms. The provision of information in easily accessible digital format would support governments and users of the patent system alike. According to the Terms of Use of the WIPO website, from November 15, 2016, new WIPO publications, i.e., publications bearing an ISBN or WIPO

¹ Brunei Darussalam, Indonesia, Iran (Islamic Republic of), Lao PDR, Myanmar, Philippines and Thailand.

² https://www.wipo.int/export/sites/www/pct/en/epct/pdf/epct_observations.pdf.

³ https://www.wipo.int/scp/en/revocation_mechanisms/.

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16. For example, the following publications made available on the WIPO website contain, among other issues, the description of opposition systems and other administrative revocation mechanisms:

- (i) Inventing the Future - An Introduction to Patents for Small and Medium-Sized Enterprises (2018)⁴;
- (ii) Intellectual Property Basics: A Q&A for Students (2019)⁵;
- (iii) Key Questions on Patent Disclosure Requirements for Genetic Resources and Traditional Knowledge (2017)⁶;
- (iv) Alternatives in Patent Search and Examination (2014)⁷;
- (v) Promoting Access to Medical Technologies and Innovation: Intersection between Public Health, Intellectual Property and Trade (2012)⁸; and
- (vi) WIPO Intellectual Property Handbook (2004)⁹.

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⁴ <https://www.wipo.int/publications/en/details.jsp?id=4350&plang=EN>.

⁵ https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1056.pdf.

⁶ https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1047.pdf.

⁷ https://www.wipo.int/edocs/pubdocs/en/wipo_pub_guide_patentsearch.pdf.

⁸ https://www.wipo.int/edocs/pubdocs/en/global_challenges/628/wipo_pub_628.pdf.

⁹ https://www.wipo.int/edocs/pubdocs/en/intproperty/489/wipo_pub_489.pdf.