

## **Standing Committee on the Law of Patents**

**Thirty- First Session**  
**Geneva, December 2 to 5, 2019**

### **REVISED PROPOSAL BY THE DELEGATIONS OF BRAZIL AND SPAIN**

*Document prepared by the Secretariat*

1. The Annex to this document contains a revised proposal regarding a further study on sufficiency of disclosure, submitted by the Delegations of Brazil and Spain for consideration by the Committee under item 6 of the draft agenda: Quality of patents, including opposition systems.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

THIRTY-SECOND SESSION OF THE STANDING COMMITTEE ON THE LAW OF PATENTS

PROPOSAL FROM BRAZIL AND SPAIN

FURTHER STUDY ON SUFFICIENCY OF DISCLOSURE

1. At the twenty-second session of the Standing Committee on the Law of Patents (SCP), held in Geneva from July 27 to 31, 2015, the Committee discussed a study on sufficiency of disclosure prepared by the Secretariat (document SCP/22/4).
2. The study was based on the information submitted by Members and Regional Patent Offices to the International Bureau in response to Note C. 8403, dated December 15, 2014. In total, 58 Member States and three Regional Patent Offices provided information on their national laws in relation to the requirement of sufficiency of disclosure.
3. The document SCP/22/4 presents valuable information on national laws and their application of the main general principles of sufficiency of disclosure, notably: (i) the enabling disclosure requirement; (ii) the support requirement; and (iii) the written description requirement.
4. This first compilation document contributed to the sharing of best practices and solutions adopted by Members on the role of sufficiency of disclosure with a view to ensure the granting of high-quality patents. However, because it is a mere compilation of national legislations, the document does not delve into the threshold of analysis of actual patent applications, as was the case with the Committee's work on the inventive step requirement, based on the proposal submitted by Spain (SCP/24/3).
5. According to Article 29 of the TRIPS Agreement, Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor. Sufficiency of disclosure is thus a central element of a balanced patent system and a necessary counterpart for the granting of a patent.
6. Given the importance of this subject for the topic of Quality of Patents, Brazil and Spain believe that the discussion on sufficiency of disclosure should move to the Agenda Item "Quality of Patents, including Opposition Systems". It is also proposed that the Secretariat prepare a study on sufficiency of disclosure to address specific aspects of the description in patent requests related to the chemical sector.
7. Due to the complexity of this technological sector, it is of paramount importance that the patent description is sufficient in a manner that a person skilled in the art is able to reproduce the invention without undue experimentation and/or further consultations with the patent owner. It is well-recognized by Members that patent description is paramount to assure the full reproduction of the invention when licensing the patent to third parties and after the patent expires. This allows for the effective use of a patent and contributes to the research and development (R&D) of new products and processes.
8. Brazil and Spain thus believe that a further study on sufficiency of disclosure would increase transparency on how the analysis of this requisite is carried out by Patent Offices and the different approaches adopted to guarantee the effective reproduction of the invention by third parties once the patent has expired or when the patent is licensed.

9. During the discussions that took place at the thirty-first session of the SCP on the first version of this proposal, several delegations welcomed the proposal. Other delegations, including that of Spain, stated that sufficiency of disclosure is an issue of interest not only for the chemical sector but also for others. A clear example of a technological sector in which sufficiency of disclosure is an issue of great importance is that of microorganisms. The Budapest System was implemented precisely to address it.

10. Another technological sector that has drawn a great deal of attention not only in this Committee but also in WIPO at large is that of artificial intelligence (AI). In the case of inventions that refer to deep learning, it is not well known what happens between input and output and some experts compare this situation to a black box. There is also uncertainty as to whether the training data and the method of training should be made available to the public. Therefore, there is a clear need to address the issue of sufficiency of disclosure in the field of AI.

11. Brazil and Spain propose that the study cover inorganic and organic chemistry, including pharmaceuticals, as well as microorganisms, AI and any other technological sector in which the fulfilment of the sufficiency of disclosure deserves special attention. We thus suggest the following non-exhaustive list of topics for the study on sufficiency of disclosure:

- Chemical compounds defined by Markush Formula;
- Esters, ethers, salts, N-oxides;
- Stereoisomers (enantiomers, diastereomers, Cis-trans and E-Z isomerism);
- Pro-drugs;
- Compositions and formulations;
- Polymorphic forms and crystalline, co-crystals, hydrates, solvates;
- New use of a known compound;
- Manufacturing process of chemical products;
- Microorganisms (different aspects related to the implementation of the Budapest System);
- Artificial Intelligence.

8. The study would be based on the information submitted by Members and Regional Patent Offices, and consist of a collection of factual information on their practices.

9. Following the publication and presentation of the study by the Secretariat to the SCP, Members States are invited to participate in sharing sessions to present their own examination experiences and practices.

[End of Annex and of document]