

SCP/23 FUTURE WORK

AGENDA ITEM 11: FUTURE WORK

1. 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:

(1) Exceptions and Limitations to Patent Rights

(i) The Secretariat will prepare a document, compiling information to be submitted by Member States, regional patent offices and observers of the SCP, regarding their practical experiences on the effectiveness and challenges of exceptions and limitations, in particular in addressing development issues and economic strengthening.

(ii) A sharing session between Member States on case studies with respect to those exceptions and limitations that have proven effective to address development issues and/or economic strengthening.

(2) Quality of Patents, including Opposition Systems¹

(i) The Secretariat will circulate a Questionnaire prior to SCP/24 for comments from Member States and regional patent offices, which contains the following elements:

- how each Member State understands "quality of patents; and
- implementation of work sharing and collaborative activities between patent offices, including experiences, their impacts, exchanging search strategies, tools to share information and capacity building needs in the area of work sharing.

Based on the responses to the Questionnaire, a study will be submitted to SCP/25.

(ii) Based on input received from Member States and regional patent offices, the Secretariat will update the information contained in document SCP/18/4 (Opposition Systems and other Administrative Revocation and Invalidation Mechanisms), and publish the information on the SCP electronic forum website in more accessible and user-friendly format.

(iii) Continuation of a sharing session on examples and cases relating to assessment of inventive step.

¹ At its 22nd session, the Committee agreed that the Secretariat would improve the webpage on work sharing and collaborative activities by SCP/24.

(3) Patents and Health

- (i) Further discussion on the feasibility study on the disclosure of International Nonproprietary Names (INN) in patent applications and patents (document SCP/21/9), specifically where the INN is known to applicants at the time of filing. Member States and regional patent offices are invited to make presentations in order to clarify the issues and their concerns. The Secretariat is invited to make a presentation on the progress made in the Patentscope Chemsearch Project which facilitates patent search using INN.
- (ii) A sharing session among Member States on national experiences relating to use of health-related patent flexibilities for promoting public health objectives or the challenges thereof with a view to explore the issues to be examined in a study to be submitted to SCP/25.
- (iii) The study to be submitted to SCP/25 will be prepared by the Secretariat, consulting with independent experts, the WHO and the WTO, and will examine the constraints to, and full use of patent flexibilities and their impacts on the access to affordable especially essential medicines for public health purposes in developing countries and least developed countries (LDCs).

(4) Confidentiality of Communications between Clients and Their Patent Advisors

- (i) Based on the information received from members and observers of the SCP, a compilation will be prepared by the Secretariat of court cases with respect to cross-border aspects of client-patent advisor privilege including limitations or difficulties encountered in cross-border issues.

(5) Transfer of Technology

- (i) A sharing session on the relationship between patent systems and transfer of technology as well as examples and cases presented by experts from different regions with a view to deepening the understanding of the impact of sufficiency of disclosure on transfer of technology.