

WIPO General Assembly

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REPORT ON THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP)

prepared by the Secretariat

1. During the period under consideration, the Standing Committee on the Law of Patents (SCP) held its thirty-fifth session from October 16 to 20, 2023, in a hybrid format. The session was chaired by Mr. Tanyaradzwa Milne Manhombo (Zimbabwe).
2. The Committee adopted the amendments of the [Special Rules of Procedure of the SCP](#) as outlined in paragraph 4, item (i) of document SCP/35/10. Specifically, the length of term of SCP officers, i.e., a Chair and two Vice-Chairs, was changed from “one year” to “two consecutive sessions”. Furthermore, the outgoing Chair and Vice-Chairs shall no longer be immediately eligible for re-election to the office which they have held. The amendments entered into force immediately upon its adoption on October 16, 2023. The SCP also agreed on the transitional arrangement for the election of officers at the thirty-fifth and thirty-sixth sessions of the SCP, as referred to in paragraph 4, item (iii) of document SCP/35/10.
3. The SCP continued to address the following five topics during its thirty-fifth session: (i) exceptions and limitations to patent rights; (ii) quality of patents, including opposition systems; (iii) patents and health; (iv) confidentiality of communications between clients and their patent advisors; and (v) transfer of technology.
4. The discussions were based on a number of proposals submitted by various delegations and documents prepared by the Secretariat, and the exchange of views and experiences contributed to a better understanding of each topic. In addition, sharing sessions held during this session provided a good opportunity for Member States to share their views and experiences, challenges and solutions on specific topics.
5. Specifically, during the thirty-fifth session, the Committee held discussions on the draft reference document on the exception regarding the use of articles on foreign vessels, aircraft

and land vehicles, and on a further study on the sufficiency of disclosure (Part II) that covered issues relating to sufficiency of disclosure of inventions having an experimental nature in unpredictable art, such as chemistry and biotechnology. In addition, the Committee discussed the expedited examination programs of Intellectual Property Offices (IPOs), including information on prioritized examination of COVID-19 related patent applications, as well as a compilation on how jurisdictions around the world addressed the issue of artificial intelligence (AI) inventorship, through jurisprudence, legislation, and practice. The Committee also discussed a document submitted by the Secretariat concerning a review of the regular updates on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines. Furthermore, the Committee took note of the Secretariat's report of the sharing session on patentability of inventions using AI and by AI, held during the thirty-fourth session of the SCP.

6. In addition, the following five sharing sessions were held during the thirty-fifth session of the SCP: (i) sharing session on the use of AI for patent examination procedures; (ii) sharing session among Member States on practices involving licensing of medical technologies for the diagnoses, prevention and treatment of COVID-19, including examples of compulsory and voluntary licensing; (iii) sharing session by members and observers of the SCP as well as relevant practitioners on recent developments and experiences concerning confidentiality of communications between clients and their patent advisors; (iv) sharing session on international cooperation in respect of technology transfer through the patent system, including technical assistance and capacity building, licensing of technology and collaboration involving both the public and private sectors; and (v) sharing session by SCP observers, intergovernmental organizations (IGOs) and other relevant stakeholders on their practical experience on Standard-Essential Patents (SEPs) and Fair, Reasonable and Non-Discriminatory (FRAND) licensing related issues. Furthermore, the Committee also invited technical experts to make presentations on the state of play regarding AI generated inventions during the thirty-fifth session of the SCP.

7. As regards the future activities of the Committee, the SCP will further advance its work based on the agreement on its future work reached at its thirty-fifth session. The Committee agreed that the non-exhaustive list of issues would remain open for further elaboration and discussion at the thirty-sixth session of the SCP. In addition, without prejudice to the mandate of the SCP, the Committee agreed that its work for the following session be confined to fact-finding and should not lead to harmonization at that stage. The future work program of the five topics under the SCP's agenda, agreed by the Committee, is as follows:

(a) With respect to the topic "exceptions and limitations to patent rights", the Secretariat will prepare a draft reference document on the exception regarding extemporaneous preparation of medicines, to be submitted to the thirty-sixth session of the SCP, and a draft reference document on the exception regarding farmers' and/or breeders' use of patented inventions, to be submitted to its thirty-seventh session.

(b) Regarding the topic "quality of patents, including opposition systems", based on the information received from Member States and regional patent offices, the Secretariat will submit to the thirty-sixth session of the SCP: (i) a study on various aspects of the unity of invention, including divisional applications, in different fields of technology; and (ii) an updated document SCP/30/5 which will compile current laws and practices relating to the patentability of AI-related inventions. Furthermore, with a view to further clarifying the interaction between humans and AI and how AI may impact the role of humans in the inventive process, the Secretariat will invite experts to the thirty-sixth session of the SCP to update the Committee on how AI technology is used by researchers to generate new technical solutions and by users of the patent system in their research and development process. Moreover, the Secretariat will organize a sharing session on the use of various tools, including AI, for effective patent examination procedures. The sharing session will

also address challenges faced by IPOs in developing, deploying and using such tools. In addition, a report of that sharing session as well as of the sharing session on the use of AI for patent examination procedures held during the thirty-fifth session, will be submitted to the thirty-seventh session of the SCP. In addition, the Secretariat will submit the updated document SCP/35/7, Annex, Sections V (National/Regional Legal Frameworks Regarding the Concept of Inventorship) and VI (The “DABUS” Case) to the thirty-seventh session of the SCP. Regarding Section VI, the Secretariat will also include information regarding new cases and decisions on AI as inventor, based on the information received from Member States and regional patent offices. Finally, the Secretariat will create a dedicated webpage on the expedited examination programs of IPOs and update it regularly on the basis of the information received from Member States and regional patent offices.

(c) As regards the topic “patents and health”, the Secretariat will update document SCP/26/5 (Constraints Faced by Developing Countries and Least Developed Countries (LDCs) in Making Full Use of Patent Flexibilities and their Impact on the Access to Affordable Especially Essential Medicines for Public Health Purposes in those Countries), based on the information received from Member States, in view of their experiences relating to the COVID-19 pandemic. In addition, at its thirty-sixth and thirty-seventh sessions, the Committee will continue to receive updates on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines and include a sharing session on experiences of Member States on their use, and to invite the providers of the data to participate.

(d) Concerning the topic “confidentiality of communications between clients and their patent advisors”, the Secretariat will continue updating a dedicated webpage on laws and practices relating to confidentiality of communications between clients and their patent advisors, including in-house counsel. In addition, the Secretariat will update document SCP/25/4 (Compilation of Court Cases with respect to Client-Patent Advisor Privilege), based on the information received from Member States.

(e) As regards the topic “transfer of technology”, based on information received from Member States, the Secretariat will submit two documents to the thirty-sixth session of the SCP: (i) updated document SCP/32/6 (Patent Law Provisions that Contribute to Effective Transfer of Technology, including Sufficiency of Disclosure); and (ii) a study on patent inventorship and ownership issues arising from collaborative research and cross-border collaboration and their implications for technology transfer. In addition, at the thirty-sixth session of the SCP, the Secretariat will organize: (i) a sharing session by Member States on policy experiences on SEPs and FRAND licensing related issues; and (ii) a roundtable to which technology transfer experts will be invited. The latter will address issues relating to patent inventorship and ownership with respect to university inventions and their implications for technology transfer, including the creation of e.g., spin-offs and start-ups. A report of the roundtable will be submitted to thirty-seventh session of the SCP.

8. It was also agreed by the Committee that the information concerning certain aspects of national/regional patent laws would be updated, based on input received from Member States.

9. *The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Patents (SCP)” (document WO/GA/57/4).*

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