

Standing Committee on the Law of Patents

Thirty-Sixth Session
Geneva, October 14 to 18, 2024

PROPOSAL BY THE DELEGATION OF CANADA FOR A REPORT AND COMPILATION OF INFORMATION ON STANDARD-ESSENTIAL PATENTS

Document prepared by the Secretariat

1. Further to the Proposal by the Delegation of Canada for an information exchange on standard-essential patents (SEPs) (document SCP/34/7 Rev.) and the two sharing sessions held on SEPs and fair, reasonable and non-discriminatory (FRAND) licensing at the thirty-fifth and thirty sixth sessions of the Standing Committee on the Law of Patents (SCP), the Annex to this document contains a proposal from the Delegation of Canada for a report on the information provided by WIPO Member States, observers, and other relevant stakeholders during those sharing sessions, as well as a compilation by the Secretariat of recent legislative and policy developments on SEPs and FRAND licensing, based on information submitted by members of the SCP. This proposal is submitted for consideration by the Committee under item 10 of the revised draft agenda: Transfer of technology (see document SCP/36/1 Prov.3).
2. The members of the SCP are invited to consider the contents of the Annex.

[Annex follows]

PROPOSAL BY THE DELEGATION OF CANADA FOR A REPORT AND COMPILATION OF
INFORMATION ON STANDARD-ESSENTIAL PATENTSIntroduction

1. At the thirty-fourth session of the WIPO Standing Committee on the Law of Patents (SCP), Canada proposed an information exchange among WIPO Member States, as well as SCP observers and other relevant stakeholders, on experiences related to standard-essential patents (SEPs) (SCP/34/7 Rev.). That proposal encouraged an exchange of experiences on a range of SEP-related topics, including with respect to transparency and predictability in fair, reasonable and non-discriminatory (or FRAND) licensing arrangements; efficiency of FRAND negotiations; balancing the interests of SEP owners and standard development organization (SDO) implementers; providing balanced, predictable, and efficient enforcement and dispute resolution frameworks; and encouraging the development of FRAND expertise, including for small and medium-sized enterprises and start-ups. The first information exchange on these topics, among SCP observers and other relevant stakeholders, took place at SCP/35 in October 2023, with the second exchange, among WIPO Members, scheduled to take place at SCP/36 during the week of October 14-18, 2024.

2. As this discussion has highlighted thus far, engagement between SDOs, implementers, patent owners, governments, and other domestic and international players, plays an important role in the incorporation of patented technologies into standards and the negotiation of FRAND licenses. In turn, this engagement can have an impact on the availability and accessibility of standardized technologies, with the negotiation of SEP licenses on FRAND terms facilitating the diffusion of technology to users, while providing patent holders with a return on investment and time spent on research and development. As the forthcoming information exchange at SCP/36 can also be expected to demonstrate, legislative and policy developments within WIPO Members also play a key role in shaping the emerging ecosystem for the incorporation of patents into standards and the negotiation of FRAND licensing terms.

3. More generally, we note that WIPO has identified SEPs as an important topic as part of the ongoing work towards an IP system that facilitates innovation in an inclusive and balanced manner. As WIPO has identified, SEPs constitute an area that deserves special attention, particularly with respect to how the licensing and enforcement of SEPs contributes to the overall balance in the IP system. Within this context, in May 2024, WIPO published the “WIPO Strategy on Standard Essential Patents 2024-2026”,¹ which sets out a three-year strategic plan for WIPO in this area. The strategy, which is based on the guiding principles of “neutrality”, “complementarity”, and “voluntary nature”, provides an overview of WIPO’s current activities related to SEPs, and sets forth the four pillars of WIPO’s upcoming work in this area, namely, to serve as a global platform for discussion, enhance transparency, be a hub of knowledge and data, and provide meaningful services in the SEP area. For instance, WIPO recently prepared a collection of SEP case law, which includes more than 100 court rulings related to SEPs,² also recently launched a dedicated web page on SEPs on the WIPO website.³

¹ <https://www.wipo.int/publications/en/details.jsp?id=4719&plang=EN>

² https://www.wipo.int/wipolex/en/collections/profile/sep_caselaw

³ <https://www.wipo.int/web/patents/topics/sep>

Proposal for a report and compilation of information on SEPs

4. Further to the exchanges held on SEPs at recent sessions of the SCP, we propose that the Secretariat prepare a report on the SCP/35 and SCP/36 sharing sessions on SEPs and FRAND licensing, based on information presented by Members, observers, and other relevant stakeholders. This report, which would be factual in nature and would contain no original recommendations, would be prepared by the Secretariat for SCP/37, to be reviewed by WIPO Members at that session.

5. In addition, and in advance of SCP/37, we propose that the Secretariat prepare a compilation of fully enacted and presently in-force SEP-related legislative and policy measures undertaken by Members, to be presented as a dedicated page on the SCP website and linked from WIPO's web page on SEPs. This compilation could also include summaries of notable case law submitted by Members relating to SEPs and FRAND licensing in their jurisdiction. This compilation would be based on information submitted by WIPO Members and would serve as an informational resource for WIPO Members, observers, and relevant stakeholders on recent developments related to SEPs and FRAND licensing.

[End of Annex and of document]