



SCP/36/12
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Standing Committee on the Law of Patents

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

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. In the absence of Ms. Lisa Jorgenson, Deputy Director General, the thirty-sixth session of the Standing Committee on the Law of Patents (SCP) was opened by Mr. Andras Jokuti, Director, Patent and Technology Law Division, who welcomed the participants. Due to the unavailability of Mr. Tanyaradzwa Milne Manhombu (Zimbabwe), elected Chair of the SCP, Ms. Vita Kascénė (Lithuania), elected Vice Chair of the SCP, chaired the session. Mr. Andras Jokuti acted as Secretary.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

2. The SCP adopted the draft agenda (document SCP/36/1 Prov.3), with addition of a working document SCP/36/11 under agenda item 10.

AGENDA ITEM 3: ELECTION OF A CHAIR AND TWO VICE-CHAIRS

3. The SCP unanimously elected, for the subsequent two consecutive sessions, Mr. Christoph Spennemann (Switzerland) as Chair and Ms. Lucie Zamykalová (Czech Republic) and Ms. Denisse Pérez (Chile) as Vice Chairs.

AGENDA ITEM 4: ADMISSION OF AN OBSERVER

4. Discussions were based on document SCP/36/10.

5. The SCP approved the accreditation of ACT | The App Association as *ad hoc* observer.

AGENDA ITEM 5: REPORT ON THE INTERNATIONAL PATENT SYSTEM: CERTAIN ASPECTS OF NATIONAL/REGIONAL PATENT LAWS

6. Discussions were based on document SCP/36/2.
7. Some delegations shared information on recent developments of their national and regional patent laws with the Committee.
8. The SCP agreed that the information concerning certain aspects of national/regional patent laws [http://www.wipo.int/scp/en/annex_ii.html] would be updated, based on input received from Member States.

AGENDA ITEM 6: EXCEPTIONS AND LIMITATIONS TO PATENT RIGHTS

9. Discussions were based on documents SCP/14/7, SCP/19/6 and SCP/36/3.
10. The Committee held a discussion on the draft reference document on the exception regarding extemporaneous preparation of medicines (document SCP/36/3). The Committee continued discussion on the issues regarding the exceptions and limitations to patent rights.
11. Some delegations suggested activities to be carried out by the Committee with respect to exceptions and limitations to patent rights. The Committee recalled its decision at the thirty-fourth session that the subsequent type of exceptions and limitations to be covered by a draft reference document would be the exception regarding farmers' and/or breeders' use of patented inventions.

AGENDA ITEM 7: QUALITY OF PATENTS, INCLUDING OPPOSITION SYSTEMS

12. Discussions were based on documents SCP/17/7, 8 and 10, SCP/18/9, SCP/19/4, SCP/20/11 Rev., SCP/23/4, SCP/24/3, SCP/30/5, and SCP/36/4 and 5.
13. The Committee held a discussion on document SCP/36/4 on unity of invention. As only the summary of document SCP/36/4 (document SCP/36/4 SUMM) was made available in the six WIPO languages, one delegation requested that document SCP/36/4 be translated and made available in these languages.
14. The Secretariat presented a dedicated webpage on expedited examination programs, which would be updated regularly on the basis of the information received from Member States and regional patent offices, in accordance with the agreement made within the Committee during SCP/35.
15. In addition, the Committee held a discussion on document SCP/36/5 that updated document SCP/30/5 (Background document on patents and emerging technologies).
16. Presentations by external experts were also made on the use of artificial intelligence (AI) technology for generation of new technical solutions or in R&D processes.
17. Furthermore, the Committee held a sharing session on the use of various tools, including AI, for effective patent examination procedures and challenges faced by IP Offices in developing, deploying and using such tools.

18. Some delegations suggested activities to be carried out by the Committee with respect to quality of patents, including opposition systems. The Committee recalled its decision at the thirty-fifth session that the Secretariat would update document SCP/35/7, Annex, Sections V and VI, based on the information received from Member States and regional patent offices, which would be submitted to SCP/37. Regarding Section VI, the Secretariat would also include information regarding new cases and decisions on AI as inventor, based on the information received from Member States and regional patent offices. The Committee also recalled its decision at the thirty-fifth session that the Secretariat would submit to SCP/37 a report on the sharing session on the use of AI for patent examination procedures held during SCP/35 and the sharing session on the use of various tools, including AI, for effective patent examination procedures held during SCP/36.

AGENDA ITEM 8: PATENTS AND HEALTH

19. Discussions were based on documents SCP/16/7 and 7 Corr., SCP/17/11, SCP/24/4, SCP/26/5 and SCP/36/6.

20. The Committee discussed document SCP/36/6 that updated document SCP/26/5 (Constraints faced by developing countries and least developed countries (LDCs) in making full use of patent flexibilities and their impacts on access to affordable especially essential medicines for public health purposes in those countries).

21. In addition, the Committee continued to receive updates on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines. In particular, presentations on the following initiatives were made: Pat-INFORMED; MedsPal; and a patent status database for medicines and/or vaccines from the Republic of Korea. In addition, members and observers of the SCP shared their experiences in operating, using or providing data to databases of patent status information concerning medicines and vaccines.

22. Some delegations suggested other activities to be carried out by the Committee with respect to patents and health. The Committee recalled its decision at the thirty-fifth session that it would continue to receive updates on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines during SCP/37.

AGENDA ITEM 9: CONFIDENTIALITY OF COMMUNICATIONS BETWEEN CLIENTS AND THEIR PATENT ADVISORS

23. Discussions were based on documents SCP/25/4 and SCP/36/7.

24. The Committee held a discussion on document SCP/36/7 that updated document SCP/25/4 (Compilation of court cases with respect to client-patent advisor privilege).

25. Some delegations suggested activities to be carried out by the Committee under this agenda item.

AGENDA ITEM 10: TRANSFER OF TECHNOLOGY

26. Discussions were based on documents SCP/32/6 and SCP/34/7 Rev., SCP/36/8, 9 and 11.

27. The Committee discussed document SCP/36/8 that updated document SCP/32/6 (Patent law provisions that contribute to effective transfer of technology, including sufficiency of disclosure).

28. The Committee also held a discussion on document SCP/36/9 (Study on patent inventorship and ownership issues arising from collaborative research and cross-border collaboration and their implications for technology transfer).

29. In addition, a roundtable on patent inventorship and ownership with respect to university inventions and their implications for technology transfer was held.

30. Furthermore, the Secretariat organized a sharing session by Member States on policy experiences on Standard Essential Patents (SEPs) and Fair, Reasonable and Non-Discriminatory (FRAND) licensing related issues.

31. The Committee also discussed the proposal by the Delegation of Canada concerning a report and compilation of information on SEPs (document SCP/36/11).

32. Some delegations suggested activities to be carried out by the Committee under this agenda item. Some other delegations stated that discussion on this topic in the SCP should avoid duplication of work with other bodies. The Committee recalled its decision at the thirty-fifth session that the Secretariat would prepare a report of the roundtable held during SCP/36 and submit it to SCP/37.

AGENDA ITEM 11: FUTURE WORK

33. The Committee decided its future work as follows:

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:

Exceptions and Limitations to Patent Rights

- a. In accordance with the agreement within the Committee at SCP/26 and following the decision of the Committee at SCP/35, the Secretariat will prepare a draft reference document on the exception regarding farmers' and/or breeders' use of patented inventions, to be submitted to SCP/37.
- b. The Secretariat will prepare a draft reference document on the exception regarding private and/or non-commercial use to be submitted to SCP/38.

Quality of Patents, including Opposition Systems

- a. In accordance with the agreement within the Committee at SCP/35, the Secretariat will update document SCP/35/7, Annex, Sections V (National/Regional Legal Frameworks Regarding the Concept of Inventorship) and VI (The "DABUS" Case), based on the information received from Member States and regional patent offices, which will be submitted to SCP/37. 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.

- b. In accordance with the agreement within the Committee at SCP/35, the Secretariat will prepare a report on the sharing session on the use of AI for patent examination procedures held during SCP/35 and the sharing session on the use of various tools, including AI, for effective patent examination procedures held during SCP/36, and will submit it to SCP/37.
- c. The Secretariat will organize an expert exchange at SCP/37 on legal and policy options in the areas of patentability criteria and AI inventorship, based on documents SCP/36/5, SCP/35/7 and WIPO's IP Policy Toolkit on "Getting the Innovation Ecosystem Ready for AI".
- d. At SCP/38, the Secretariat will organize a sharing session on the use of various tools, including AI, for effective patent examination procedures and challenges faced by IP Offices in developing, deploying and using such tools.
- e. The Secretariat will prepare a study on substantive and procedural requirements regarding voluntary division of patent applications by applicants, including prohibition of double patenting, to be submitted to SCP/37.

Patents and Health

- a. In accordance with the agreement within the Committee at SCP/35, the Committee will continue to receive updates on the initiatives on publicly accessible databases of patent status information concerning medicines and vaccines during SCP/37.
- b. The Secretariat will provide a status update on implementation of WIPO's Development Agenda Recommendation 14 as it relates to WIPO's provision of technical assistance to developing countries and LDCs, at SCP/37.

Confidentiality of Communications between Clients and Their Patent Advisors

- a. The Secretariat will invite Member States to provide information on their national legislation concerning confidentiality of communications between clients and their patent advisors to continue updating a dedicated webpage on laws and practices relating to this topic.
(https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html).
- b. The Secretariat will prepare a study on the categories of professionals who enjoy protection against forcible disclosure of confidential communications between clients and their patent advisors in court proceedings under national/regional laws, to be submitted to SCP/38.

Transfer of Technology

- a. In accordance with the agreement within the Committee at SCP/35, the Secretariat will prepare a report of the roundtable held during SCP/36 on issues relating to patent inventorship and ownership with respect to university inventions and their implications for technology transfer and submit it to SCP/37.
 - b. The Secretariat will prepare a report of the sharing sessions on SEPs and FRAND licensing related issues held during SCP/35 and SCP/36.
 - c. Based on information submitted by Member States, the Secretariat will prepare a compilation of SEP-related legislative and policy measures adopted by Member States, which could also include, where appropriate, references to notable case law, to be presented on a dedicated page on the SCP website.
 - d. Further to the Study on Patent Inventorship and Ownership Issues Arising from Collaborative Research and Cross-border Collaboration (SCP/36/9), the Secretariat will prepare a further study on the determination of inventorship and conditions of foreign filing, with a view to identifying potential challenges for innovators in the cross-border collaborative environment. Based on a survey of Member States as well as information from other sources, the study will be submitted to SCP/38.
 - e. The Secretariat will prepare a study on best practices and challenges in technology transfer in the health and green technology sectors focusing on industry-academia collaboration, considering national and international regulatory frameworks, to be submitted to SCP/38. The study should identify licensing models and contract structures, including effective clauses for remuneration schemes and IP management. The study should incorporate case studies and practical examples to illustrate successful strategies. In preparation of this study, an expert exchange will be organized at SCP/37.
34. The Secretariat informed the Committee that the thirty-seventh session of the SCP was tentatively scheduled to be held from November 3 to 7, 2025.
35. The SCP noted that the present document was a summary established under the responsibility of the Chair. The Committee noted that in line with paragraph 30 of the Summary Report of the sixty-second series of Meetings of the Assemblies of the Member States of WIPO (document A/62/12), the verbatim reports of the SCP would be replaced by automated speech-to-text transcripts and translations. Accordingly, the official report of the current session will be made available in that form. In order to help improve the automated speech-to-text technology, delegations are requested to provide corrections of substantial nature to the Secretariat, preferably four weeks before the following session of the Committee.
36. The SCP noted the contents of this summary by the Chair.

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