

July 20, 2010

British Standards Institution
389 Chiswick High Road
London, W4 4AL
UNITED KINGDOM

Re: AIPLA Response to Request for Comments on
Draft BSI PAS 98 Standards Consortia – Part I and Part II

Ladies and Gentlemen:

The American Intellectual Property Association (“AIPLA”) welcomes this opportunity to submit comments on *BSI PAS 98 Standards consortia – Part I: Good practice in the establishment and management of standards related consortia*, and *BSI PAS 98 Standards consortia – Part II: Evaluating standards related consortia* (collectively, “Proposed Submissions”) released by the British Standards Institution (“BSI”).

AIPLA is a voluntary bar association with more than 15,000 members who work daily with patents, trademarks, copyrights, and trade secrets, and the legal issues that they present. Members include attorneys in private and corporate practice, as well as government service. AIPLA’s membership is intimately involved with the legal and business issues underlying the development, commercialization, exploitation, and licensing of intellectual property (“IP”). In recognition of the growing importance of IP in the context of standards setting, AIPLA formed a committee focused on standards. Consistent with this focus, AIPLA is keenly interested in laws, rules, regulations, and guidelines concerning standards setting that may impact IP rights.

Although AIPLA appreciates the apparent effort that went into drafting the Proposed Submissions, AIPLA questions the need for best practices guidelines for standards development and consortia considering the diversity of the current standards setting ecosystem as is more fully discussed below. As is also further described below, AIPLA’s concern relates to normative statements, or implied norms, and the “recommendations” in the Proposed Submissions regarding SSO patent policies. These statements or norms could create unreasonable beliefs regarding what constitutes “good” or “bad” SSOs, especially to the extent that negative conclusions are drawn in connection with patent policies that deviate from these suggested norms.¹

¹ Because the AIPLA’s interests relate to intellectual property rights, these comments are limited to IP considerations raised by the Proposed Submission. No inference should be drawn that AIPLA either concurs with or objects to any other issue raised by or statement made in the Proposed Submissions that are not addressed by these comments.

No Single Set of Patent Policy Attributes Is Appropriate for All SSOs

The area of standardization and IP—primarily patent rights—can be complex and presents many challenges in balancing the interests of all stakeholders. Although standards may be viewed as a public good, private ownership of patent rights, and the potential return on investment play an important role in providing incentives for companies to invest in research and development to further technological advances. These technological advances can then serve as the basis for efficient, high quality standards. It is the experience of AIPLA’s members that the patent policies adopted by many SSOs are necessary to create a balance between widespread implementation of standards and providing incentive for investments in innovation. If the SSO cannot adequately balance the interests of all relevant stakeholders, the standards setting process and the success of any standards developed under that process are not likely to be effective.

The Proposed Submissions appear to have been designed as teaching tools. In fact, they expressly purport to “set[] out recommended good practice for establishing and managing consortia” and to “offer[] guidance on how to assess the appropriateness and operation of consortia.”² AIPLA is concerned, however, that the Proposed Submissions could be construed to provide incorrect, incomplete, and misleading data to the reader. Indeed, a reader who is unfamiliar with SSOs could read the Proposed Submissions and come away believing that there is really only one form of base IP policy for SSOs—one that requires members³ to disclose patents and requires licensing of all “relevant” IP—and the only differentiating feature is whether the “required” licensing model allows contributing members to, or prohibits contributing members from, charging a royalty.

The Proposed Submissions appear to conclude that most of the major information and communications technology SSOs in existence today do not follow good practices. Yet empirical data shows that, after careful negotiation among many skilled lawyers representing varied and disparate interests, well-known SSOs have not all reached the same conclusions and have not all agreed to adopt the same IP policy approaches for their organizations. Indeed, the patent policies of any two different SSOs could be quite different, but each SSO’s policy could be optimal for that organization and its membership. There simply is no support in the empirical evidence that all SSOs have adopted the same patent policy—or even patent policies that are substantially similar on all material issues—nor any evidence that, had they done so, they would somehow have been “better.”

² BSI PAS 98 Standards consortia – Part I: Good practice in the establishment and management of standards related consortia, Foreword lines 5–6. See BSI PAS 98 Standards consortia – Part II: Evaluating standards related consortia, Foreword lines 85–86.

³ Some SSO policies apply to participants even if they are not members in the SSO. References to “members” include such participants.

It is not surprising that there is no such evidence. It is counterintuitive to believe that the same patent policy provisions or framework would somehow serve as the right balance for all SSOs in light of the differences in technology and industry, and that the memberships in disparate SSOs may be comprised of different businesses, individuals, and public entities, each with their own unique goals and interests. This diversity among SSOs is generally recognized as a strength of the information and communications technology standards ecosystem—enabling agility and innovation in SSO approaches and promoting healthy competition and choice.

Perceived Infirmities in the Proposed Submissions

§	Text	Comments
Part I, §2.4 Part II, §2.4	Intellectual Property Rights policy (IPR) policy that governs the treatment of intellectual property, including copyright, licensing terms, and patent disclosure procedures, in the production of the consortium’s deliverables	The inclusion of licensing terms and patent disclosure procedures appears to be unusual. This definition implies that there will always be <i>some</i> IP licensing terms, which is rarely the case, and that there will always be <i>some</i> patent disclosure procedures, which is also not always the case, thereby making an implied value judgment about SSOs that are organized differently.
Part I, §2.6 Part II, §2.6	openness generalized commitment to inclusive concepts and practices, such as consensus (see 2.2) (or majority) driven procedures, appropriate IPR policy rules, and operational transparency	We agree with the goal to be inclusive and balanced; however, there is a concern that reference to “appropriate” IPR policy rules, creates an implication that there are “inappropriate” IPR policy rules. Specifically this definition could be read to imply that many common patent policy provisions are somehow “inappropriate” and not sufficiently “open” merely because these common alternatives were not identified or described to the reader.
Part I, Concept notes to §6.11	Concept notes to 6.11 Many consortia establish RAND or FRAND as the minimal licensing mode that its members need to agree to when participating in consortium work or sometimes, when joining the consortium.	There are a number of different licensing models, but several of them are not described. While some SSOs do require a minimal license commitment, other SSOs (many of which are well known) have no such requirement. This statement in the context of a best practices guideline implies that SSOs that do not require any license commitments (including those well-known SSOs) have flawed patent policies.

Part I, Concept notes to §6.11	Concept notes to 6.11 ... In most cases, though, it is universal practice to commit members who participate in consortium output to disclose their relevant IP in that area.	Mandatory disclosure is one model, but, as discussed below, many very well-known SSOs do not follow this model. The vast majority of well-known SSOs also do not require members to disclose “relevant” IP at all. Rather, they more commonly seek disclosure of patents likely to include “necessary” or “essential” patent claims.
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Many Well-Known SSOs Do Not Require Their Members to License Patents at All

The IP references in the Proposed Submissions imply that there must be licensing obligations for an SSO to exhibit “good” practices. This simply does not track with empirical evidence.

For example, many well-known SSOs have a “disclosure based” patent policy. Under such a policy, participating members are encouraged or required to disclose that they likely hold “essential” patents, but they may not be required to identify the specific patents. Moreover, the member identifying a patent under this type of patent policy is not generally obligated to license its essential patent claims, but rather is often just required to make a statement whether it will agree to license its essential patent claims on a “reasonable and non-discriminatory” (“RAND”) or any other basis. And, a statement by a member that it will not license on RAND terms is often permitted.

Well-known SSOs that have some form of a disclosure-based patent policy and do not require any minimal licensing commitment include ISO⁴/IEC⁵/ITU⁶, CEN⁷/CENELEC⁸, ETSI⁹, AFNOR¹⁰, Ecma International¹¹, OMG (Object Management Group)¹², PWG (Printer Working Group)¹³, TTA (Telecommunications Technology Association of Korea)¹⁴, TTC (Telecommunication Technology Committee in Japan), and ANSI-accredited SSOs (such as the IEEE¹⁵, TIA¹⁶, ATIS¹⁷, and ASTM¹⁸).

⁴ http://isotc.iso.org/livelink/livelink/fetch/2000/2122/3770791/Common_Policy.htm

⁵ <http://www.iec.ch/tctools/patent-common.html>

⁶ <http://www.itu.int/ITU-T/dbase/patent/patent-policy.html>

⁷ http://www.cen.eu/CEN/sectors/sectors/iss/pm/Pages/exploitation_rights.aspx

⁸ http://www.cen.eu/CEN/sectors/sectors/iss/pm/Pages/exploitation_rights.aspx

⁹ http://www.etsi.org/WebSite/document/Legal/ETSI_IPR-Policy.pdf

¹⁰ <http://www.afnor.org/en/legal-information#p13283>

¹¹ <http://www.ecma-international.org/memento/codeofconduct.htm>

¹² <http://www.omg.org/cgi-bin/doc?omg/06-02-01.pdf>

¹³ http://www.pwg.org/chair/membership_docs/pwg-ip-policy.pdf

¹⁴ <http://www.tta.or.kr/English/new/standardization/procedure.jsp>

¹⁵ <http://standards.ieee.org/board/pat/pat-material.html>

¹⁶ http://www.tiaonline.org/standards/procedures/manuals/documents/tia_eng_manual-5th_edition_102009_final.pdf
(IP Policy: pgs iii-vi, Annex H and H-1)

¹⁷ [http://www.atis.org/legal/Docs/OP/OP-%20Version%205%200%20Final%20\(8-17-09\).pdf](http://www.atis.org/legal/Docs/OP/OP-%20Version%205%200%20Final%20(8-17-09).pdf)

¹⁸ <http://www.astm.org/Itpolicy.pdf>

The Proposed Submissions fail to inform the reader about disclosure-based IP policies and, therefore, appear to imply that all of these well-known SSOs—and indeed any other SSO that adopted a disclosure-based policy—are somehow illegitimate and did not engage in “good” practices.

Many Well-Known Patent Policies Do Not Require Patent Disclosure

The IP references in the Proposed Submissions also imply that, for a particular SSO to be exhibiting “good” practices, that SSO’s patent policy must require members to disclose patents. This also does not track with empirical evidence.

For example, one set of patent policies generally requires members to license essential patent claims merely as a consequence of participating in the SSO or one or more of its technical working groups. These participation-based patent policies typically require SSO members to license their essential or necessary patent claims on a RAND or a “reasonable and non-discriminatory, royalty-free” (“RAND-RF”) basis.

It is important to note in this regard that nothing in such an SSO’s patent policy would typically *preclude* a member from making a patent disclosure if it chose to do so. It is also important to note that a disclosure requirement, depending on how it is phrased, can be exceedingly burdensome to a large, institutional patent owner. To the extent, for example, that a given disclosure requirement would require a member to search its patent portfolio on a regular basis, the administrative overhead of this obligation may be a sufficient basis for a large, institutional patent owner to decide not to join the SSO.

Some SSOs that use a participation-based approach include the Bluetooth SIG¹⁹, GS1²⁰, BIAN²¹ (Banking Industry Architecture Network), DVB²², Infiniband Association²³, MIPI Alliance²⁴, SD Card Association²⁵, Serial ATA International Organization²⁶, SIGIS²⁷, WiFi Alliance²⁸, WiMAX Forum²⁹, and the W3C.³⁰

¹⁹ <https://www.bluetooth.org/Membership/agreements.htm>

²⁰ http://www.gs1.org/docs/ip/GS1_Intellectual_Property_Policy.pdf

²¹ http://www.bian.org/content/e190/e217/e279/CBIANIPRv030_en.pdf

²² <http://www.dvb.org/documents/MoU.English.2001.pdf> (See Section 14)

²³ <http://www.infinibandta.org/img/pdfs/mem-agreement.pdf>

²⁴ <http://mipi.org/MIPI-MA-2006.pdf>

²⁵ <http://www.sdcard.org/developers/join/ippolicy32909.pdf> [Participants must disclose if they make a Contribution and are otherwise encouraged to disclose known essential IPR rights]

²⁶ http://www.sata-io.org/documents/SATA-IOBylaws_000.pdf

²⁷ <http://www.sig-is.org/imwp/download.asp?ContentID=12502>

²⁸ http://www.wi-fi.org/files/gd_8_RevisedMarch1.2006WFAIPRPolicy.pdf (strong encouragement to disclose but no obligation)

²⁹ http://www.wimaxforum.org/sites/wimaxforum.org/files/page/2009/12/WIMAX_Forum_IPR_Policy_2006_09_25_FINAL.pdf (strong encouragement to disclose but no obligation)

³⁰ <http://www.w3.org/Consortium/Patent-Policy-20040205/>

The Proposed Submissions do not inform the reader about participation-based IP policies that have no patent disclosure obligations. As above, the Proposed Submissions appear to imply that all of these well-known SSOs—and indeed any other SSO that adopted a participation-based policy—are somehow inappropriate and do not engage in “good” practices.

IP Policies Are Almost Always Limited to “Essential” or “Necessary” Patent–Not “Relevant IP”

The Proposed Submissions refer to “relevant” rather than “essential” or “necessary” IP,³¹ state that patent policies require disclosure of “relevant IP” and imply that licensing commitments extend to “relevant IP.” Almost all SSO’s patent policies are limited to “essential” or “necessary” patent claims. Specifically, patent policies that have disclosure rules seek disclosure of patents likely to contain essential or necessary patent claims, and patent policies that address licensing commitments limit those commitments to essential or necessary patent claims. Some definitional examples from well-known SSOs are provided in Attachment B. The Proposed Submissions, however, do not inform the reader that there is any standard other than “relevant” IP for use in structuring an SSO patent policy.

Conclusion

A proposed general framework for “good practices” in establishing, managing, and evaluating SSOs should not inherently or expressly make value judgments among the different patent policies adopted by various SSOs. Moreover, proposing a general framework for standardization that both eschews some of the most common patent policy provisions found in well-known SSO patent policies and that fails to mention other common patent policy provisions can be misleading and lead to the erroneous conclusion that there is a “one size fits all” patent policy despite the evidence to the contrary.

AIPLA appreciates the opportunity to comment on the Proposed Submissions and welcomes questions or responsive comments from BSI.

Respectfully submitted,



Alan J. Kasper
President

³¹ See Concept notes to Section 6.11 to Part I of the Proposed Submissions.

Attachment A

Example Definitions

§	Example Definitions
Part I, §2.4 Part II, §2.4	<p>ETSI Intellectual Property Rights Policy, Annex 6: “15 Definitions 7 “IPR” shall mean any intellectual property right conferred by statute law including applications therefor other than trademarks. For the avoidance of doubt rights relating to get-up, confidential information, trade secrets or the like are excluded from the definition of IPR.” http://www.etsi.org/WebSite/document/Legal/ETSI_IPR-Policy.pdf</p> <p>IETF Intellectual Property Rights in IETF Technology, RFC 3979: “1(o) "IPR" or "Intellectual Property Rights": means patent, copyright, utility model, invention registration, database and data rights that may Cover an Implementing Technology, whether such rights arise from a registration or renewal thereof, or an application therefore, in each case anywhere in the world.” http://www.ietf.org/rfc/rfc3979.txt</p>
Part I, §2.6 Part II, §2.6	<p>ANSI Essential Requirements: Due process requirements for American National Standards (January 2010 edition): “2.1 Openness Timely and adequate notice of any action to create, revise, reaffirm, or withdraw a standard, and the establishment of a new consensus body shall be provided to all known directly and materially affected interests. Notice should include a clear and meaningful description of the purpose of the proposed activity and shall identify a readily available source for further information. In addition, the member’s name (or if membership is by organization, the name of the organization with a point of contact), affiliation and interest category of each member of the consensus body shall be made available to interested parties up on request.” http://publicaa.ansi.org/sites/apdl/Documents/Standards%20Activities/American%20National%20Standards/Procedures,%20Guides,%20and%20Forms/2010%20ANSI%20Essential%20Requirements%20and%20Related/2010%20ANSI%20Essential%20Requirements.pdf</p>

§	Example Definitions
Part I, Concept notes to §6.11	<p>ITU/ISO/IEC Common Patent Policy: “2. If a Recommendation Deliverable is developed and such information as referred to in paragraph 1 has been disclosed, three different situations may arise: 2.1 The patent holder is willing to negotiate licences free of charge with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside ITU-T/ITU-R/ISO/IEC. 2.2 The patent holder is willing to negotiate licences with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside ITU-T/ITU-R/ISO/IEC. 2.3 The patent holder is not willing to comply with the provisions of either paragraph 2.1 or paragraph 2.2; in such case, the Recommendation Deliverable shall not include provisions depending on the patent.” http://www.itu.int/en/ITU-T/ipr/Pages/policy.aspx</p> <p>ATIS Letter of Assurance: “The Party submitting this Statement may hold a patent covering an invention the use of which may be required for compliance with the ATIS-developed American National Standard or other ATIS deliverable identified in Section C, and with respect to claim(s) of such patent(s), as may be specified more particularly in Section E, that are required for compliance with that ATIS-developed American National Standard or other ATIS deliverable (check only one box): A license will be made available under reasonable terms and conditions that are demonstrably free of any unfair discrimination, without compensation, to applicants desiring to utilize the license for the purpose of implementing the American National Standard or other ATIS deliverable; Mark here if the Party submitting this Statement reserves the right to obtain compensation from applicants who are only willing to license, for compensation, their claim(s) of patents covering an invention, the use of which is required for compliance with the ATIS-developed American National Standard or other ATIS deliverable identified in Section C, on reasonable terms and conditions that are demonstrably free of any unfair discrimination. or A license will be made available under reasonable terms and conditions that are demonstrably free of any unfair discrimination, with compensation, to applicants desiring to utilize the license for the purpose of implementing the American National Standard or other ATIS deliverable; Mark here if such licensing assurance is subject to applicant reciprocity. or</p>

§	Example Definitions
	<p>Is unwilling or unable to grant licenses according to the provisions of either 2a or 2b.” http://www.atis.org/legal/Docs/Policy/ATIS%20Patent%20Assurance%20Form_Test%20Fields_semifinal.pdf</p> <p>ETSI IPR Information Statement and Licensing Declaration: “In accordance with Clause 6.1 of the ETSI IPR Policy the Declarant and/or its AFFILIATES hereby irrevocably declares the following (check one box only, and subordinate box, where applicable):</p> <p style="padding-left: 40px;">To the extent that the IPR(s) disclosed in the attached IPR Information Statement Annex are or become, and remain ESSENTIAL in respect of the ETSI Work Item, STANDARD and/or TECHNICAL SPECIFICATION identified in the attached IPR Information Statement Annex, the Declarant and/or its AFFILIATES are prepared to grant irrevocable licences under this/these IPR(s) on terms and conditions which are in accordance with Clause 6.1 of the ETSI IPR Policy.</p> <p style="padding-left: 40px;">This irrevocable undertaking is made subject to the condition that those who seek licences agree to reciprocate (check box if applicable).</p> <p style="padding-left: 40px;">The Declarant and/or AFFILIATES are not prepared to make the above IPR Licensing Declaration (reasons may be explained in writing in the attached IPR Licensing Declaration Annex).”</p> <p>http://www.etsi.org/WebSite/document/Legal/ETSI_IPR-Policy.pdf</p> <p>Advanced Television Systems Committee Patent Policy:</p> <p>1. “Prior to a vote on a Specification Document subject to a disclosed Essential Claim and no later than the time frames specified in Section 5, the ATSC shall receive from the person or entity that holds the Essential Claim written confirmation (using the attached form) that:</p> <ul style="list-style-type: none"> a) A license to the Essential Claim will be made available upon request without compensation to all applicants for the purpose of implementing the Specification Document, which license may be conditioned upon license reciprocity with respect to the same Specification Document; or b) A license to the Essential Claim will be made available upon request under reasonable and nondiscriminatory terms and conditions to all applicants for the purpose of implementing the Specification Document, which conditions may include license reciprocity with respect to the same Specification Document; or c) A license to the Essential Claim will not be provided under reasonable and nondiscriminatory terms and conditions to applicants for the purpose of implementing the Specification Document. <p>http://www.atsc.org/cms/policy_documents/B-4%202007-12-13_PATENT_POLICY.pdf</p>

§	Example Definitions
	<p>Ecma International Code of Conduct in Patent Matters: “2. If an Ecma International Standard is developed and a party may own or control a patent or application with claims that are required to implement such Ecma International Standard, three different situations may arise: 2.1 The patent holder is prepared to grant licenses free of charge to other parties on a non-discriminatory basis on reasonable terms and conditions. Negotiations are left to the parties concerned and are performed outside of Ecma International. 2.2 The patent holder is prepared to grant licenses to other parties on a non-discriminatory basis on reasonable terms and conditions. Negotiations are left to the parties concerned and are performed outside of Ecma International. For patented technology contributed to and incorporated into a Final Draft Ecma International Standard by a patent holder member, the patent holder member may select 2.1 or 2.2. If such patent holder member does not make a selection, 2.2 shall apply. 2.3 For patented technology contributed by a party other than the patent holder, the patent holder is not prepared to comply with the provisions of either Paragraph 2.1 or Paragraph 2.2.” http://www.ecma-international.org/memento/codeofconduct.htm</p> <p>Wi-Fi Alliance Intellectual Property Rights Policy: 4.2. LICENSING DECLARATIONS (1) “At the same time as a disclosure is made under Section 4.1, or as soon as practical thereafter, the participant shall also submit a written statement from a person authorized to represent the patent rights holder to Wi-Fi Alliance Management at joinnow@wi-fi.org declaring with regard to any Necessary Claims, pursuant to the terms of Section 3.2, that: (a) it will grant a license on royalty-free and other reasonable and nondiscriminatory terms and conditions; or (b) it will grant a license on reasonable and nondiscriminatory terms and conditions that may include a reasonable royalty or fee; or (c) its intention is to not license its Necessary Claims, if permitted under Section 4.2(2). http://www.wi-fi.org/files/gd_8_RevisedMarch1,2006WFAIPRPpolicy.pdf</p> <p>WiMAX Forum Intellectual Property Rights Policy: SECTION 5.3 OPT-OUT PROVISION. “In order to avoid a licensing obligation for non-contributed Necessary Claims in the Specification, a Member must, prior to the end of the review period, declare its intention <i>not</i> to license non-contributed Necessary Claims in the Specification and specify which noncontributed Necessary Claims it is not licensing; provided, however, any non-contributed Necessary Claims for which there is no declaration by the end of the review period shall be subject to the reasonable and nondiscriminatory license obligation set forth in Section 4.1. A member may also declare its intention not to license non-contributed Necessary Claims that it becomes aware of prior to the review period, provided, however, that a Member may only make such declarations with respect to specifically identified patents or patent applications.”</p>

§	Example Definitions
	<p data-bbox="369 370 1864 397">http://www.wimaxforum.org/sites/wimaxforum.org/files/page/2009/12/WIMAX_Forum_IPR_Policy_2006_09_25_FINAL.pdf</p> <p data-bbox="369 440 1136 467">Digital Video Broadcasting, The Statutes of the DVB Project:</p> <p data-bbox="369 475 1885 634">Article 14 Intellectual Property Rights, 14.1: “Within 90 days from notification of approval of a specification by the Technical Module, each Member shall, on behalf of itself and its affiliated companies, submit to the chairman of the Steering Board a list of all the IPRs owned or controlled by the Member or any of its affiliated companies, to the extent that the Member knows that such IPRs will be necessarily infringed when implementing such specification and for which it will not or has no free right to make licences available.”</p> <p data-bbox="369 643 1016 670">http://www.dvb.org/documents/MoU.English.2001.pdf</p> <p data-bbox="369 712 911 740">EPCglobal Intellectual Property Policy:</p> <p data-bbox="369 748 1902 943">3.3 Limited Agreement to Disclose. “After the Specification is approved by the Working Group, Participants therein shall be provided with at least 60 days notice prior to the anticipated date of ratification of the Specification by the Trustee. Notification of intent not to license shall be given no later than 30 days before the anticipated date of ratification of the Specification by the Trustee. Such notification shall specifically disclose and identify to the Trustee the claim(s) believed to be Necessary Claims and which are not subject to license. The Participant shall also identify any portion of a draft Specification or other work-in-progress, which is not subject to license.”</p> <p data-bbox="369 951 1398 979">http://www.epcglobalinc.org/what/ip_policy/031223EPCglobalIPPoly12152003A.pdf</p> <p data-bbox="369 1021 785 1049">GS1 Intellectual Property Policy:</p> <p data-bbox="369 1057 1906 1252">3.3 Limited Agreement to Disclose. “After the Standard/Specification is approved by the Working Group, Participants therein shall be provided with at least 60 days notice prior to the anticipated date of ratification of the Standard/Specification by the Trustee. Notification of intent not to license shall be given no later than 30 days before the anticipated date of ratification of the Standard/Specification by the Trustee. Such notification shall specifically disclose and identify to the Trustee the claim(s) believed to be Necessary Claims and which are not subject to license. The Participant shall also identify any portion of a draft Standard/Specification or other work-in-progress, which is not subject to license.”</p> <p data-bbox="369 1260 1150 1287">http://www.gs1.org/docs/ip/GS1_Intellectual_Property_Policy.pdf</p>

§	Example Definitions
	<p>Infiniband Trade Association Membership Agreement: 5.2 Limited Agreement to Disclose. “In the event that the Member has actual knowledge that the Member would be unwilling to provide other Members with a license to a work-in-progress of any Working Group, such Member agrees to promptly provide written notification to the Secretariat and appropriate Work Group chairperson of such Member’s intent not to license.” http://www.infinibandta.org/img/pdfs/mem-agreement.pdf</p> <p>THE MOBILE INDUSTRY PROCESSOR INTERFACE (MIPI) ALLIANCE BYLAWS: Article X Specification Development and Approval (1): “(c) Licensing Objections. In the event that a Contributor, Promoter or Founder Member in good faith believes that the utilization of Necessary Claims in a Draft MIPI Specification would require a license from that Member under Paragraph 3.1(a) or 3.1(b) of the MIPI Membership Agreement and such Member does not wish to grant such license under its Necessary Claims in accordance with the terms of both or either of such Paragraphs of the MIPI Membership Agreement, that Member must within the First Draft Review Period provide written notification to the Secretary of the Board of its intent not to grant licenses under such Necessary Claims (“Licensing Objection”). (d) Second Draft Licensing Objections. In the event that a Contributor, Promoter or Founder Member in good faith believes that the utilization of Necessary Claims in a Second Draft of a MIPI Specification would require a license from that Member under Paragraph 3.1(a) or 3.1(b) of the MIPI Membership Agreement, but the draft thereof before revision would not, and such Member does not wish to grant such license under its Necessary Claims in accordance with the terms of either or both of such Paragraphs of the MIPI Membership Agreement, that Member must within the Second Draft Review Period provide written notification to the Secretary of the Board of its intent not to grant such required license (“Second Draft Licensing Objection”).” http://mipi.org/MIPI-Bylaws-2009.pdf</p> <p>SIGIS: Special Interest Group for IAS Standards IPR Policy: 3.3 IPR Review Process. “No later than the end of the close of the IPR Review Period, each Member must identify any patents or patent applications likely to contain Necessary Claims of that Member or any of its Affiliates for which the Member or its Affiliate is unwilling to agree to grant the Royalty Free License pursuant to Section 3.1 above (referred to hereinafter as a “Necessary Claims Notification”).” http://www.sig-is.org/imwp/download.asp?ContentID=12502</p>

<p>Part I, Concept notes to §6.11</p>	<p>In addition to the policies that have no disclosure obligation except when a party wants to “opt out” or “exclude” necessary or essential patent claims (some of which are included above), the following are examples of policies that do not mandate patent disclosure.</p> <p>ITU/ISO/IEC Common Patent Policy: “It follows, therefore, that a patent embodied fully or partly in a Recommendation Deliverable must be accessible to everybody without undue constraints. To meet this requirement in general is the sole objective of the code of practice. The detailed arrangements arising from patents (licensing, royalties, etc.) are left to the parties concerned, as these arrangements might differ from case to case. This code of practice may be summarized as follows: 1. The ITU Telecommunication Standardization Bureau (TSB), the ITU Radio communication Bureau (BR) and the offices of the CEOs of ISO and IEC are not in a position to give authoritative or comprehensive information about evidence, validity or scope of patents or similar rights, but it is desirable that the fullest available information should be disclosed. Therefore, any party participating in the work of ITU, ISO or IEC should, from the outset, draw the attention of the Director of ITU-TSB, the Director of ITU-BR, or the offices of the CEOs of ISO or IEC, respectively, to any known patent or to any known pending patent application, either their own or of other organizations, although ITU, ISO or IEC are unable to verify the validity of any such information.” http://www.itu.int/en/ITU-T/ipr/Pages/policy.aspx</p> <p>ATIS Operating Procedures, Version 5: 10.4.1: “If reference to a patented invention shall be made in a standard, guideline or other ATIS deliverable, disclosure of the patented invention should be encouraged at the earliest possible time in the development of the standard, guideline or other ATIS deliverable.” http://www.atis.org/legal/Docs/OP/OP-%20Version%205%200%20Final%20(8-17-09).pdf</p> <p>Ecma International Code of Conduct in Patent Matters: 1. “Therefore, Ecma desires that any party participating in a technical committee of Ecma International promptly disclose any patent or pending patent application that it believes contain claims that may be required to implement an Ecma International Standard, in accordance with the following provisions.” http://www.ecma-international.org/memento/codeofconduct.htm</p>
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Telecommunications Industry Association Engineering Manual:

6.5.1 Encouragement of Voluntary Disclosure: “A three-part approach will be used by TIA to encourage voluntary disclosure (preferably early) of Essential Patent(s) and published pending patent application(s).

The first part of the approach is that Formulating Group Chairs will ensure that participants and attendees are aware that:

TIA's Intellectual Property Rights Policy can be found in Statements of Policy and subsequent sections of the TIA Engineering Manual. Participants in the work of the TIA Formulating Group are urged to review the appropriate Sections. Individual participants are encouraged to notify TIA of any patent(s) or published pending patent application(s) of which they are aware that may be essential to the practice of a proposed TIA Publication, including requirements introduced through normative references, early on in its development to reduce the possibility for delays in the development process and increase the likelihood that the proposed TIA Publication will become a Standard. However, a Patent Holder who has provided TIA with the statement set forth in ANNEX H with respect to the applicable proposed TIA Publication need not (but may elect to) identify its specific patent(s) or published pending patent application(s) that may be essential to the practice of the proposed TIA Publication in question. Patent searches are not required to comply with the TIA Intellectual Property Rights Policy.

The second part of the approach is that the TIA will place a notification on each ballot for a proposed Standard that the TIA IPR Policy is applicable to the Reference Document, which encourages identification of Essential Patent(s) or published pending patent application(s) necessary for the practice for any or all of the Normative portions of the Reference Document and, if appropriate, the filing of a Patent Holder Statement.

The third part of the approach may be the placement of an optional, voluntary disclosure statement by the Source(s) on a submission cover sheet to a Formulating Group. Such a submission cover sheet might take the form attached hereto as ANNEX F.1 and use a statement in the form shown in Section 6.4.7.”

http://www.tiaonline.org/standards/procedures/manuals/documents/tia_eng_manual-5th_edition_102009_final.pdf

Telecommunications Technology Association of Korea (TTA) Intellectual Property Rights Policy:

1. Disclosure of IPRs: “TTA is not in a position to search for information about IPRs which may cover subject matters of proposed TTA standards, but it is desirable the fullest available information should be disclosed. Therefore, anyone proposing a TTA standard or anyone having interests in it should, from the outset, draw the attention of TTA to any known IPR or to any known pending IPR application, by notifying relevant information to the Secretary-General of TTA, although TTA is unable to verify the validity of any such information.”

http://www.tta.or.kr/English/new/standardization/procedure_sub02.htm

Wi-Fi Alliance Intellectual Property Rights Policy:

SECTION 4.1. DISCLOSURE STANDARD (1) General Disclosure Standard. “All individuals Participating (both Contributors to a Specification and non-contributors) are strongly encouraged on an ongoing basis to disclose certain patent rights held by themselves or their represented Members where such patent rights include Necessary Claims related to a draft specification.”

http://www.wi-fi.org/files/gd_8_RevisedMarch1,2006WFAIPRPolicy.pdf

WiMAX Forum Intellectual Property Rights Policy:

SECTION 3.1. DISCLOSURE BY WORKING GROUP PARTICIPANTS (a) General Disclosure Standard. “All individuals participating in any way in a particular Working Group are strongly encouraged on an ongoing basis to disclose patents or patent applications held by themselves or their represented Members where such patents or patent applications include claims that may be necessary to implement a Draft Specification or a Specification (as such terms are defined under this Policy) that is generated, developed, reviewed or revised by such Working Group.”

http://www.wimaxforum.org/sites/wimaxforum.org/files/page/2009/12/WIMAX_Forum_IPR_Policy_2006_09_25_FINAL.pdf

Attachment B

Sample Definitions of “Essential” or “Necessary” IP

SSO	IP Policy Link	Definition of Essential Claim
Bluetooth	https://www.bluetooth.org/DocMan/handlers/DownloadDoc.ashx?doc_id=67	<p>(o) “Necessary Claims” means claims of a patent or patent application that (a) are owned or controlled by a party or its Affiliates (Licensor) now or at any future time while this License Agreement remains in effect; and (b) are necessarily infringed by implementing those portions of a Bluetooth Specification and/or Foundation Specification within the bounds of the Scope, wherein a claim is necessarily infringed only when it is not possible to avoid infringing it because there is no technically reasonable non-infringing alternative for implementing such portions of the Bluetooth Specification and/or Foundation Specification within the bounds of the Scope. Notwithstanding the foregoing sentence, Necessary Claims do not include any claims (i) other than those set forth above even if contained in the same patent as Necessary Claims; (ii) that read solely on any implementations of any portion of the Bluetooth Specification or Foundation Specification that are not within the bounds of the Scope; or (iii) that, if licensed, would require a payment of royalties by the Licensor to unaffiliated third parties.</p>
ETSI	http://www.etsi.org/WebSite/document/Legal/ETSI_IPR-Policy.pdf	<p>“ESSENTIAL” as applied to IPR means that it is not possible on technical (but not commercial) grounds, taking into account normal technical practice and the state of the art generally available at the time of standardization, to make, sell, lease, otherwise dispose of, repair, use or operate EQUIPMENT or METHODS which comply with a STANDARD without infringing that IPR. For the avoidance of doubt in exceptional cases where a STANDARD can only be implemented by technical solutions, all of which are infringements of IPRs, all such IPRs shall be considered ESSENTIAL.</p>

SSO	IP Policy Link	Definition of Essential Claim
IEEE	http://standards.ieee.org/guides/bylaws/sect6-7.html#6	<p><i>“Essential Patent Claim”</i> shall mean any Patent Claim the use of which was necessary to create a compliant implementation of either mandatory or optional portions of the normative clauses of the [Proposed] IEEE Standard when, at the time of the [Proposed] IEEE Standard's approval, there was no commercially and technically feasible non-infringing alternative. An Essential Patent Claim does not include any Patent Claim that was essential only for Enabling Technology or any claim other than that set forth above even if contained in the same patent as the Essential Patent Claim.</p> <p><i>“Patent Claim(s)”</i> shall mean one or more claims in issued patent(s) or pending patent application(s).</p> <p><i>“Enabling Technology”</i> shall mean any technology that may be necessary to make or use any product or portion thereof that complies with the [Proposed] IEEE Standard but is neither explicitly required by nor expressly set forth in the [Proposed] IEEE Standard (e.g., semiconductor manufacturing technology, compiler technology, object-oriented technology, basic operating system technology, and the like).</p>
IETF	http://www.ietf.org/rfc/rfc3979.txt	<p>n. "Covers" or "Covered" mean that a valid claim of a patent or a patent application in any jurisdiction or a protected claim, or any other Intellectual Property Right, would necessarily be infringed by the exercise of a right (e.g., making, using, selling, importing, distribution, copying, etc.) with respect to an Implementing Technology. For purposes of this definition, "valid claim" means a claim of any unexpired patent or patent application which shall not have been withdrawn, cancelled or disclaimed, nor held invalid by a court of competent jurisdiction in an unappealed or unappealable decision.</p>

SSO	IP Policy Link	Definition of Essential Claim
OASIS	http://www.oasis-open.org/who/intellectualproperty-2009-05-19.pdf	<p>2.9. Essential Claims - those claims in any patent or patent application in any jurisdiction in the world that would necessarily be infringed by an implementation of those portions of a particular OASIS Final Deliverable created within the scope of the TC charter in effect at the time such deliverable was developed. A claim is necessarily infringed hereunder only when it is not possible to avoid infringing it because there is no non-infringing alternative for implementing the Normative Portions of that particular OASIS Final Deliverable. Existence of a non-infringing alternative shall be judged based on the state of the art at the time the OASIS Final Deliverable is approved.</p>
OMA (Open Mobile Alliance)	http://www.openmobilealliance.org/document/OMA-Reference-2007-0002R01.pdf (Section 5)	<p>5.12.2. “Essential IPR” means IPR without which it is not possible on technical but not commercial grounds, taking account of normal technical practice and the state of the art generally available, to make, sell, lease, otherwise dispose of, repair, use or operate equipment or methods, which comply with a Specification without infringing that IPR.</p>
SD Card Association	http://www.sdcard.org/developers/join/ippolicy32909.pdf (Section 2)	<p>Essential Patent Claim(s): Patent Claims which are required to implement the Adopted Specifications</p> <p>As used herein, the term “Patent Claims” means the claims of a patent, whether issued and existing or pending, which are either owned and under the control of such party or licensed and sub-licensable by such party under the terms set forth herein.</p>

SSO	IP Policy Link	Definition of Essential Claim
WFA	http://www.wifi.org/files/gd_8_RevisedMarch1,2006WFAIPRPolicy.pdf	<p>(e) “<u>Necessary Claims</u>” shall mean claims of a patent or patent application throughout the world that (a) are owned or controlled by a Member or its Affiliates now or at any future time; and (b) are necessarily infringed by implementing those relevant portions of the Specification required for certification within the bounds of the Scope (as defined in Section 1(g)), wherein a claim is necessarily infringed only when it is not possible to avoid infringing the claim because there is no commercially reasonable non-infringing alternative for implementing such relevant portions of the Specification required for certification within the bounds of the Scope. Notwithstanding the foregoing sentence, Necessary Claims do not include any claims: (i) other than those set forth above even if contained in the same patent or patent application as Necessary Claims; (ii) that read solely on any implementations of any portion of the Specification that are not within the bounds of the Scope; or (iii) that, if licensed, would require consent from, and/or a payment of royalties by the licensor to unaffiliated third parties.</p>
W3C	http://www.w3.org/Consortium/Patent-Policy-20040205/	<p>8.1. Essential Claims "Essential Claims" shall mean all claims in any patent or patent application in any jurisdiction in the world that would necessarily be infringed by implementation of the Recommendation. A claim is necessarily infringed hereunder only when it is not possible to avoid infringing it because there is no non-infringing alternative for implementing the normative portions of the Recommendation. Existence of a non-infringing alternative shall be judged based on the state of the art at the time the specification becomes a Recommendation.</p>