

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

This analysis is a supplement to *A study of IPR policies and practices of a representative group of Standards Developing Organizations worldwide*, prepared by Rudi Bekkers and Andy Updegrave. See <http://home.tm.tue.nl/rbekkers/nas>

Copyright © National Academies of Science, 2012

This analysis has the following parts:

Part A: Adoption and general aspects of the IPR policy

Part B: Formal aspects and principles of the IPR policy

Part C: Patent disclosure

-- general

-- relating to the knowledge of the party about its IPR

-- relating to standard

-- relating to patent identities

-- other

Part D: Licensing commitments

Part E: SDO procedures and public

Part F: Conflicts and enforcement

Part G: Other

This analysis has the format of a structured survey, with numbered questions. Text in **green** indicates our own conclusions and observations. All the SDO's we analyzed were given the opportunity to review this document and comment on it. Text in **orange** are comments, complimentary explanations and corrections received by representatives of the SDO. Areas where we experienced uncertainty or believed to see inconsistencies are indicated with **red text**.

Note: this analysis has been performed to the best of our knowledge, using the various public documents concerning the IPR policy of your SDO. See also the disclaimers in the main report.

Note: in this analysis, the work 'policy' generally refers to the whole set of binding rules, not necessarily only to the document which is titled 'policy'. An exception is where we make specific references to documents.

### Part A: Adoption and general aspects of the IPR policy

A1. What is the most version of or a reference (internet) to the formal, current IP policy of your SDO? What are relevant to additional documents such as guidelines, explanations, forms, and so on?

These three bodies have a common *patent* policy, but not a common *IPR* policy. For instance, ITU has additional copyright guidelines and guidelines on the inclusion of marks (i.e. trademarks, service marks and certification marks) in ITU-T Recommendations, which currently do not exist at IEC and ISO.

The common patent policy document defines, as the name suggest, common elements, but also has some sections that have additional stipulations for one of the organizations only. For instance, only ITU has a 'general patent statement'.

Finally, each of the organizations may also have additional provisions relating to essential patents or to essential IPR that are defined in other documents than the common IPR policy.

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

IEC	ISO	ITU-T and/or IT-R
Primary internet site: <a href="http://www.iec.ch/tctools/patent-guidelines.htm">www.iec.ch/tctools/patent-guidelines.htm</a>	Primary internet site: short link: <a href="http://www.iso.org/patents">www.iso.org/patents</a> . Otherwise <a href="http://www.iso.org">www.iso.org</a> , about ISO -> ISO strategies and Policies -> ISO intellectual property right policies -> ISO patent policy	Primary internet site: <a href="http://www.itu.int/en/ITU-T/ipr/">http://www.itu.int/en/ITU-T/ipr/</a>
<p>IEC, ISO &amp; ITU. Common Patent Policy for ITU-T/ITU-R/ISO/IEC. (From here on called 'common policy').</p> <ul style="list-style-type: none"> <li>- The version of this document on the ITU website is undated. Note however that ITU does provide a record of revisions to the patent policy, forms and guidelines (including this document) which can be found at <a href="http://www.itu.int/en/ITU-T/ipr/Pages/revpatent.aspx">http://www.itu.int/en/ITU-T/ipr/Pages/revpatent.aspx</a>.</li> <li>- The ISO Website indicates that it is "Last updated 2007-04-18".</li> <li>- Version on the IEC website has no further data indication.</li> </ul>		
<p>IEC, ISO &amp; ITU. Guidelines for Implementation of the Common Patent Policy for ITU-T/ITU-R/ISO/IEC. Dated 23/04/2012, applicable as from 23 April 2012. (From here on called 'Guidelines')</p> <p>Notes:</p> <ul style="list-style-type: none"> <li>- Version on the ITU website lists "Edition 2.0, Published first revision"</li> <li>- Version on ISO and IEC website has different front matter that indicates 'Revision 1, effective 23 April 2012; Revises initial edition of 1 March 2007'</li> <li>- But in the end, the actual content of the documents seems similar.</li> </ul>		
<p>IEC ISO ITU. Patent Statement and Licensing Declaration for ITU-T or ITU-R Recommendation   ISO or IEC Deliverable (23 April 2012). This form is available from the website and is also attached to the Guidelines for Implementation of the Common Patent Policy.</p>		
		ITU. General Patent Statement and Licensing Declaration for ITU-T or ITU-R Recommendation (23 April 2012). This form is available from the website and is also attached to the Guidelines for Implementation of the Common Patent Policy.
		ITU. Software Copyright Guidelines, dated 7/12/2011. Applicable as from 13 April 2012.
		ITU. Software Copyright Statement and Licensing Declaration form (dated 7 December 2011). This form is available from the website and is also attached to the ITU Software Copyright Guidelines.
		ITU-T Guidelines related to the inclusion of Marks in ITU-T Recommendations. Issue 2.0 – November 2005.
The online IEC patent database is available at <a href="http://patents.iec.ch">http://patents.iec.ch</a>	<p>The online ISO patent database is split between 'regular' ISO standards and standards developed in JTC-1. Both databases are contained in long text documents and available from <a href="http://www.iso.org/patents">www.iso.org/patents</a> (at the bottom of the page)</p> <p>(Note: after the data collection for this study, ISO updated its online database and now offers a single MS Excel file that has all disclosures for both ISO and JTC-1.)</p>	<p>The online ITU-T Patent Information Database is available at <a href="http://www.itu.int/ipr/IPRSearch.aspx?iprtype=PS">http://www.itu.int/ipr/IPRSearch.aspx?iprtype=PS</a></p> <p>The online ITU-T Software Copyrights Database is available at <a href="http://www.itu.int/ipr/IPRSearch.aspx?iprtype=SW">http://www.itu.int/ipr/IPRSearch.aspx?iprtype=SW</a></p> <p>Patents declarations for ITU-R are not available from the above databases (even though a radio button in these databases suggests so), but can be found instead at: <a href="http://www.itu.int/ITU-R/index.asp?redirect=true&amp;category=study-groups&amp;mlink=patents&amp;lang=en&amp;company=&amp;recommendation=&amp;patent=&amp;country=&amp;receiveddate_type=&amp;receiveddate_dd=&amp;receiveddate_mm=&amp;receiveddate_yyyy=&amp;SearchText=">http://www.itu.int/ITU-R/index.asp?redirect=true&amp;category=study-groups&amp;mlink=patents&amp;lang=en&amp;company=&amp;recommendation=&amp;patent=&amp;country=&amp;receiveddate_type=&amp;receiveddate_dd=&amp;receiveddate_mm=&amp;receiveddate_yyyy=&amp;SearchText=</a></p>
<p>Press release: IEC, ISO and ITU, the world's leading developers of International Standards, agree on common patent policy. (Issued 19 March 2007)</p>		

A2. What changes to the policy have been made over time, and have there been additional clarifications or additions? What prompted these changes?

A significant event was the introduction of a harmonized, common policy for all three organizations in 2007. This common policy has not undergone changes since its introduction, but the accompanying guidelines were revised in 2012.

### Specifically concerning ITU:

Between 1999 and 2007, ITU made regular changes to its IPR policy, forms and guidelines. Changes are summarized in a document called '*Record of revisions to the Patent Policy, the Forms and the Guidelines (23 April 2012)*' (<http://www.itu.int/en/ITU-T/ipr/Pages/revpatent.aspx>)

Complementary to its patent policy, and different from ISO and IEC, ITU introduced Software Copyright Guidelines in 2002, which were updated at several occasions. Changes are summarized in a document called "*Record of revisions to the Software Copyright Guidelines (13 April 2012)*". ITU-T has also adopted Guidelines related to the inclusion of Marks in ITU-T Recommendations.

A3. What are current discussions going on in this SDO concerning the IP policy? What is being discussed, and what prompted these discussions?

In the ITU, there is an Ad Hoc Group on IPR that is responsible for studies in this area. Participation is open to Member States and ITU-T Sector Members. Information is at <http://www.itu.int/en/ITU-T/ipr/Pages/adhoc.aspx> and the Terms of Reference: <http://www.itu.int/en/ITU-T/ipr/Pages/tor.aspx>

In October 2012, there is an ITU Patent Roundtable, which is organized to examine the 'effectiveness of RAND-based patent policies'. It is aimed at a wider audience (see <http://www.itu.int/en/ITU-T/Workshops-and-Seminars/patent/Pages/default.aspx> and <http://www.itu.int/md/T09-TSB-CIR-0291/en>). The structure of the roundtable can be found at [http://www.itu.int/dms\\_pub/itu-t/oth/06/5B/T065B0000220099MSWE.docx](http://www.itu.int/dms_pub/itu-t/oth/06/5B/T065B0000220099MSWE.docx)

## Part B: Formal aspects and principles of the IPR policy

B1. What is the legal foundation of the IPR policy (statutes, undertaking, contract, etc.)? What is the legal status of those that are involved (e.g. member, participant)?

The common policy document, which is no more than one page of text, refers to itself as a 'code of practice'. The guidelines state that they are to 'clarify and facilitate the implementation of the patent policy'.

The actual legal foundation is different for each of the three organizations:

- The actual legal foundation of ITU is a rather complex one, which is due to the fact that this organization is much more than a standard developing organization, and is also a UN agency. Below, the details are discussed.
- Also ISO and IEC each have their own structure, related to their role and legacy.

Note that an inherent difficulty of having a common policy is that the underlying organizations are different. One important example is here is the difference in membership. In ITU, members are typically commercial firms or other organizations (e.g. Sector Members, Associates and academia), while in IEC and ISO the "members" are the national bodies (National Committees in IEC, Member bodies in ISO). These differences make it hard to simply refer to 'members' in a common policy.

### ITU

On its website, the ITU explains its legal structure:

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

The legal framework of ITU comprises, in particular, the following legal instruments of the Union, which have treaty status:

The Constitution and Convention of the International Telecommunication Union signed on 22 December 1992 (Geneva) and which entered into force on 1 July 1994. Since their adoption in 1992, the ITU Constitution and Convention have been amended by Plenipotentiary Conferences (Kyoto, 1994; Minneapolis, 1998 and Marrakesh, 2002). Those amendments entered into force on 1 January 1996, 1 January 2000 and 1 January 2004.

The Administrative Regulations (Radio Regulations and International Telecommunication Regulations), which complement the Constitution and the Convention. The last revision of the Radio Regulations was signed on 4 July 2003 (Geneva), and the majority of the provisions entered into force on 1 January 2005. The International Telecommunication Regulations were signed on 9 December 1988 (Melbourne), and entered into force on 1 July 1990.

<http://www.itu.int/net/about/legal.aspx>

The basic texts that govern the ITU are the following (Collection of the Basic Texts of the International Telecommunication Union adopted by the Plenipotentiary Conference 2011, available at <http://www.itu.int/pub/S-CONF-PLN-2011/en>):

- Constitution of the International Telecommunication Union
- Convention of the International Telecommunication Union
- General Rules of conferences, assemblies and meetings of the Union
- Optional Protocol
- Decisions
- Resolutions
- Recommendations .
- List of decisions, resolutions and recommendations adopted, revised or abrogated by the Plenipotentiary Conference (Kyoto, 1994), (Minneapolis, 1998), (Marrakesh, 2002), (Antalya, 2006) and (Guadalajara, 2010)

Neither of these texts do contain any reference to IPRs or an IPR policy.

*Additional comment by an ITU representative: "Indeed, the legal basis of the patent policy is not addressed in these documents".*

ITU-T further explains that its working rules are defined in (<http://www.itu.int/en/ITU-T/stratops/Pages/workingrules.aspx>)

- A). General Rules of Conferences, Assemblies and Meetings of the Union
- B). Resolution 1 ("Rules of procedure [...]")
- C). the 'A Series Recommendations'

While (A) has no reference to IPR policies, (B) and (C) do:

In document B)<sup>1</sup>, there is the following reference to the IPR policy:

9.3.8 Recommendations are to be elaborated in accordance with the Common Patent Policy for ITU-T/ITU-R/ISO/IEC available at <http://www.itu.int/ITU-T/ipr/>. For example:

9.3.8.1 Any party participating in the work of ITU-T should, from the outset, draw the attention of the Director of TSB to any known patent or to any known pending patent application, either of their own or of other organizations. The "Patent Statement and Licensing Declaration" form from

---

<sup>1</sup> ITU-T WTSA-08 – Resolution 1 “Rules of procedure of the ITU Telecommunication Standardization Sector (ITU-T)”, adopted at the World Telecommunication Standardization Assembly meeting in Johannesburg, 21-30 October 2008 ([http://www.itu.int/dms\\_pub/itu-t/opb/res/T-RES-T.1-2008-PDF-E.pdf](http://www.itu.int/dms_pub/itu-t/opb/res/T-RES-T.1-2008-PDF-E.pdf)),

the ITU-T website is to be used.

9.3.8.2 ITU-T non-member organizations that hold patent(s) or pending patent application(s), the use of which may be required in order to implement an ITU-T Recommendation, can submit a "Patent Statement and Licensing Declaration" to TSB using the form available at the ITU-T website.

In addition, art. 9.4.2 of Resolution 1 provides that "if TSB has received a statement (or statements indicating that the use of intellectual property, e.g. the existence of a patent, or a copyright claim, may be required in order to implement a draft Recommendation, the Director shall indicate this situation in the circular announcing the intention to invoke the Res. 1 approval process".

Several documents in the 'A series of Recommendations' (C), provide explicit reference to or implementation of the IPR policy of the ITU:

### Recommendation ITU-T A.1 (Work Methods for Study Groups of ITU-T):

1.4.6 [conduct of meetings] Chairmen will ask, during each meeting, whether anyone has knowledge of patents or software copyrights, the use of which may be required to implement the Recommendation being considered. The fact that the question was asked shall be recorded in the working party or study group meeting report, along with any affirmative responses.

2.3.3.12 [study group management – roles of rapporteurs][...] Rapporteurs will ask, during each meeting, whether anyone has knowledge of patents or software copyrights, the use of which may be required to implement the Recommendation being considered. The fact that the question was asked shall be recorded in the meeting report, along with any affirmative responses

3.1.3 [submission of contributions] contributors are reminded, when submitting contributions, that early disclosure of patent information is desired, as contained in the statement on Common Patent Policy for ITU-T/ITU-R/ISO/IEC (available at the ITU-T website). Patent declarations are to be made using the "Patent Statement and Licensing Declaration Form for ITU-T/ITU-R Recommendation | ISO/IEC "Deliverable" available at the ITU-T website. See also clause 3.1.4 below.

3.1.4 General Patent Statement and Licensing Declaration: Any ITU Member State or ITU-T Sector Member or Associate may submit a general patent statement and licensing declaration using the form available at the ITU-T website. The purpose of this form is to give patent holders the voluntary option of making a general licensing declaration relative to the patented material contained in any of their contributions. Specifically, the submitter of the licensing declaration declares its willingness to license, in case part(s) or all of any proposals contained in contributions submitted by the organization are included in ITU-T Recommendation(s) and the included part(s) contain items that have been patented or for which patent applications have been filed and whose use would be required to implement ITU-T Recommendations.

The general patent statement and licensing declaration is not a replacement for the individual (per Recommendation) patent statement and licensing declaration but is expected to improve responsiveness and early disclosure of the patent holder's compliance with the Common Patent Policy for ITU-T/ITU-R/ISO/IEC

3.1.6 A contributor submitting software for incorporation in the draft Recommendation is required to submit a software copyright statement and licensing declaration form available at the ITU-T website. The form must be provided to TSB at the same time the contributor submits the software.

### Recommendation ITU-T A.7 (Focus Groups: Working methods and procedures)

#### 9. Intellectual Property Rights

The Common Patent Policy for ITU-T/ITU-R/ISO/IEC is to be used.

The chairman of a focus group should recall this during every meeting and record all responses in the meeting report.

The copyright provisions in Recommendation ITU-T A.1 are to be followed.

With respect to ITU-R, compliance with the Common Patent Policy is achieved through Resolution ITU-R 1-6<sup>2</sup>, which notes in article 6.1.2 that:

6.1.2 [Recommendation] [...] NOTE 2 – Recommendations should be drafted taking account of the Common Patent Policy for ITU-T/ITU-R/ISO/IEC on intellectual property rights, as given in Annex I.

By virtue of the legal instruments currently in effect, i.e. Resolution 1 adopted by WTSA (Johannesburg, 2008) for ITU-T and Resolution 1-6 adopted by the Radiocommunication Assembly (2012) for ITU-R, all ITU Recommendations should comply with the Common Patent Policy. In that sense, the Common Patent Policy is binding for the ITU and the contributors participating in ITU study groups. This is also indicated in art. 3.1.3 of ITU-T A.1 (on Work methods for study groups of ITU-T), which makes direct reference to the Common Patent Policy.

While ITU does have 'Member States' and 'Sector Members', as well as 'Associates', and 'academia', the policy nor guidelines do refer to members in terms of obligations and duties (also not in the part of the Guidelines that provides specific provisions to ITU). There is a sentence in these Guidelines, however that – indirectly - suggests that non-members are those 'outside the Recommendation development process' and therefor would by definition not be participants (a word that is used in the policy).

[...] whether asserted by ITU members or others outside of the Recommendation development process. (Guidelines, at II.1)

Another approach here is to look at the phrasing of the obligations and duties in the documents in question.

1. On the ITU website, it is stated that *'the study group must comply with the [policy and guidelines]'*. This implies that at least the ITU representatives (e.g. chairman) are bound. (Additional comment by ITU representative: *"Indeed, the term Study Group covers all participants in the Group, not only ITU representatives, who might have additional responsibilities (e.g. chairman)"*). For the ITU Software Copyright Guidelines and Guidelines related to the inclusion of Marks, a weaker statement is given, in that these documents are to 'provide guidance'. (Additional comment by an ITU representative: *"This is indeed mentioned in the summary. The actual content of the guidelines includes stronger statements. E.g. "Study Groups shall not accept Software contributions that, if included in a Recommendation, will require implementers to be subject to a third-party Software license that does not meet the licensing requirements set forth herein" (2.1. Software Guidelines)"*)

2. The common policy has a number statements addressing parties, in particular:

Therefore, any party participating [1] 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 (Common policy)

The Guidelines repeat this statement, and add a footnote to the term "party participating": In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process.

-> This implies binding duties to participants.

[...] the patent holder has to provide a written statement [...], using the

---

<sup>2</sup> Resolution ITU-R 1-6 "Working methods for the Radiocommunication Assembly, the Radiocommunication Study Groups, and the Radiocommunication Advisory Group" (1993-1995-1997-2000-2003-2007-2012) ([http://www.itu.int/dms\\_pub/itu-r/opb/res/R-RES-R.1-6-2012-PDF-E.pdf](http://www.itu.int/dms_pub/itu-r/opb/res/R-RES-R.1-6-2012-PDF-E.pdf))

appropriate "Patent Statement and Licensing Declaration" form.

In the statement form (template) itself, it is also explained that this patent holder, in case of 'option 3' shall provide detailed patent information including a description of the patent,

-> It is not completely clear how a patent policy can include binding provisions to patent holders that are neither member nor participants.

Additional comment by ITU representative: *"Indeed, the policy is binding only to patent holders who are participating in the work of the Organizations".*

3. The guidelines include the following phrases:

In the event a Patent Holder participating in the work of the Organizations assigns or transfers ownership or control of Patents for which the Patent Holder reasonably believes it has made a license undertaking to the ITU/ISO/IEC, the Patent Holder shall make reasonable efforts to notify such assignee or transferee of the existence of such license undertaking.

-> This implies binding duties to certain participants (For ITU, this presumably includes members, although it is not defined that way)

Additional comment by ITU representative: *"Participation to Study Groups is open for members of ITU (including Sector Members, Associates and academia)."*

### IEC

The most recent IEC STATUTES AND RULES OF PROCEDURE (2001 edition) do not refer to IPRs or an IPR policy.<sup>3</sup>

However, the common policy is reprinted as Annex I in the ISO/IEC Directives, Part 1, Procedures for the technical work, Ninth edition, 2012.<sup>4</sup> This annex is indicated to be 'normative' and is dated 2 December 2010 (suggesting this is not yet the new 2012 version, even though these Directives are from 2012). Although I cannot find this literary as such in the Statutes and Rules of Procedure, I assume that these directives should be considered binding to members as such.

The issue remains, as also indicated for ITU above, that the common policy (as made part of the directive) also seems to stipulate binding obligations to third parties (i.e. to patent holders that may not be participants in IEC).

Additional comment by a representative on behalf of both ISO and IEC: *"In a strict legal sense it is not binding for third parties. There is no contract in place that obliges patent owners to fill out the patent statement form."*

### ISO

We could not review the ISO statutes as these are not available on-line. The Common Policy is, however, part of the (common) ISO/IEC Directives, as discussed above, so the same situation (and concern) seems to apply as in IEC.

Additional comment by a representative on behalf of both ISO and IEC: *"In a strict legal sense it is not binding for third parties. There is no contract in place that obliges patent owners to fill out the patent statement form."*

---

<sup>3</sup> [http://www.iec.ch/members\\_experts/refdocs/governing.htm](http://www.iec.ch/members_experts/refdocs/governing.htm)  
[http://www.iec.ch/members\\_experts/refdocs/iec/stat-2001e.pdf](http://www.iec.ch/members_experts/refdocs/iec/stat-2001e.pdf)

<sup>4</sup> See list of Statutes / Directives / Agreement at  
[http://www.iec.ch/members\\_experts/refdocs/governing.htm](http://www.iec.ch/members_experts/refdocs/governing.htm)

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

B2. What is the nature of SDO membership (companies, individuals)? How does this relate to the rules on disclosure and/or commitments?

See above. All three organizations have membership structures (albeit different ones) but the IPR policy generally refers to participants, not members. (As discussed, membership in the three organizations has totally different meanings.)

B3. Are the specific rules on firms that are subsidiaries? Do obligations that follow from the IPR policy also apply to parent companies?

Not specified in the policy.

Additional comment by ITU representative: The rules should apply to the patent holders, regardless of their legal status as parent or subsidiary companies.

### Part C: Patent disclosure

#### Patent disclosure, general

C1. What is the nature of disclosure rules? (E.g. obligation vs. invitation / encouragement)

Disclosure is an obligation for parties participating in technical bodies etc., plus, for ISO and IEC, those parties that are 'a recipient of a draft standard at any stage in the standards development process'. Disclosure should be done 'in good faith and on a best effort basis', but there is no requirement for patent searches (see also below).

Other parties *may* disclose patents (of themselves or others) but are not required or encouraged to do so.

#### Sources and additional details:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

In addition to the above, any party not participating in Technical Bodies may draw the attention of the Organizations to any known Patent, either their own and/or of any third-party. (Guidelines, at §3)

Moreover, that information should be provided in good faith and on a best effort basis, but there is no requirement for patent searches. (Guidelines, at §3)

At ISO and IEC:



## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

"All drafts submitted for comment shall include on the cover page the following text: Recipients of this draft are invited to submit, with their comments, notification of any relevant patent rights of which they are aware and to provide supporting documentation." (Guidelines, at II.1).

The word 'invited' here seems to contradict the stronger requirement in the principal disclosure obligation as defined in the Common policy.

C2. Are there any exemptions to the disclosure rules? (For instance, a policy could specify that if a company makes a RF / RAND-z commitment, there is no more requirement for specific patent disclosure).

No such exceptions are defined. (See Question A13 on specific disclosures vs. blanket disclosures, but these are options in the policy, not exemptions).

C3. At what point in time are parties required to disclose essential patents? Is it related to when a standardization activity reaches a particular state of advancement, and/or events relating to the specific member (joining the SDO, joining a WG, etc)?

Essential patents need to be disclosed as soon the work on the standard has reached a sufficiently mature level that a party can reasonably assess whether a patent would be essential. To this end, chairman of Technical Bodies will at appropriate moments remind parties of their disclosure duties.

Regardless the above obligations, patents *can* be disclosed at any time, even after publication of a standard.

### Sources and additional details:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

In this context, the words "from the outset" imply that such information should be disclosed as early as possible during the development of the Recommendation | Deliverable. This might not be possible when the first draft text appears since at this time, the text might be still too vague or subject to subsequent major modifications. (-> as soon the work on the standard has reached a sufficiently mature level that a party can reasonably assess whether a patent would be essential) Moreover, that information should be provided in good faith and on a best effort basis, but there is no requirement for patent searches. (Guidelines, §3)

Early disclosure of Patents contributes to the efficiency of the process by which Recommendations | Deliverables are established. Therefore, each Technical Body, in the course of the development of a proposed Recommendation | Deliverable, will request the disclosure of any known Patents essential to the proposed Recommendation | Deliverable. Chairmen of Technical Bodies will, if appropriate, ask, at an appropriate time in each meeting, whether anyone has knowledge of patents, the use of which may be required to practice or implement the Recommendation | Deliverable being considered. The fact that the question was asked shall be recorded in the meeting report, along with any affirmative responses.

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

(Guidelines, §5)

C4. How is dealt with disclosure of patents owned by other (third) parties (non-members / non-participants)?

Disclosure obligation explicitly includes patents held by other organizations.

### Sources and additional details:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

### Patent disclosure, relating to the knowledge of the party about its IPR

All the following items are about the knowledge the claimant has about its patents, or should have about its patents.

C5. Are the disclosure rules limited to patents (1) covering its own contributions, (2) standards developed in the working group the party is participating in, (3) any standard developed in the SDO?

Disclosures rules are limited to standards developed in the working group the party is participating in plus, for ISO and IEC, those parties that are 'a recipient of a draft standard at any stage in the standards development process'.

### Sources and additional details:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

Although this text does not literally limit the obligation, it is set in the context of participation and it seems plausible to assume that the obligation is specifically about the particular work the participant is participating in. (This interpretation was confirmed by an ITU representative.)

C6. Does the policy refer to patents that 'are' essential, 'believed' to be essential, 'may' be essential, etc.?)

This is not clearly defined / consistent in the policy. Some parts refer to patents that *are* [believed to be] actually essential; other parts refer to patents that *may be* essential.

### Sources and additional details:

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

### The common policy states:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

### Where the word patent is defined as:

Patent: The word "Patent" means those claims contained in and identified by patents, utility models and other similar statutory rights based on inventions (including applications for any of these) solely to the extent that any such claims are essential to the implementation of a Recommendation | Deliverable. Essential patents are patents that would be required to implement a specific Recommendation | Deliverable. (Guidelines, §2) (Note that this definition is actually one for an *essential patent* than that of a *patent* as such.)

The objective criterion for considering the essential character of a patent is whether the claims of such patent are essential to the implementation of a Recommendation | Deliverable (Guidelines, §2, Part I)

The Patent Holder believes that it holds granted and/or pending applications for Patents, the use of which would be required to implement the above document and hereby declares [...] (Patent statement and licensing declaration)

### And, only for the ITU:

In case part(s) or all of any proposals contained in Contributions submitted by the Patent Holder above are included in ITU-T/ITU-R Recommendation(s) and the included part(s) contain items for which Patents have been filed and whose use would be required to implement ITU-T/ITU-R Recommendation(s) [...] (General Patent Statement and Licensing Declaration for ITU-T or ITU-R Recommendation)

### Furthermore, for all three standards bodies, there are the following texts:

The Patent Policy encourages the early disclosure and identification of Patents that may relate to Recommendations | Deliverables under development. (Guidelines, at summary)

Chairmen of Technical Bodies will, if appropriate, ask, at an appropriate time in each meeting, whether anyone has knowledge of patents, the use of which may be required to practice or implement the Recommendation | Deliverable being considered. (Guidelines, §5)

C7. What knowledge is assumed to be known to the party and/or its representatives in meetings?

The primary obligation clauses refer to patents 'known' to the participant, but do not define what is assumed to be known. Other parts of the policy refer to 'good faith and on a best effort basis', but it remains unclear how this should be interpreted.

### Sources and additional details:

The common policy states:

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

The Patent Holder believes that it holds granted and/or pending applications for Patents, the use of which would be required to implement the above document and hereby declares [...] (Patent statement and licensing declaration)

Moreover, that information should be provided in good faith and on a best effort basis, but there is no requirement for patent searches. (Guidelines, at §3)

C8. Are patent searches required, encourage, or not required?

The policy explicitly cites that patent searches are not required.

### Sources and additional details:

Moreover, that information should be provided in good faith and on a best effort basis, but there is no requirement for patent searches. (Guidelines, at §3)

### Patent disclosure, relating to standard

C9. How exactly is 'essentiality' defined and/or to be interpreted? Is it 'purely' technical essentiality or are there elements of commercial essentiality?

The common policy, guidelines and the patent statements do not make any distinction and do not mention of something like 'commercial essentiality'.

However, from the clauses where essentiality is discussed and defined, essentiality is (implicitly) defined as technical essentiality.

### Sources and additional details:

Throughout the relevant documents there are a number of different – implicit – definitions of what essentiality and an essential patent is. Although the wording differs, all these definitions are fairly similar. Although 'commercial essentiality' is not explicitly excluded, all definitions suggest that they should be interpreted as 'strict' technical essentiality.

The common policy states:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

Where the word patent is defined as:

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

Patent: The word "Patent" means those claims contained in and identified by patents, utility models and other similar statutory rights based on inventions (including applications for any of these) solely to the extent that any such claims are essential to the implementation of a Recommendation | Deliverable. Essential patents are patents that would be required to implement a specific Recommendation | Deliverable. (Guidelines, §2) (Note that this definition is actually one for an *essential patent* than that of a *patent* as such.)

The Patent Holder believes that it holds granted and/or pending applications for Patents, the use of which would be required to implement the above document and hereby declares [...] (Patent statement and licensing declaration)

And, only for the ITU:

In case part(s) or all of any proposals contained in Contributions submitted by the Patent Holder above are included in ITU-T/ITU-R Recommendation(s) and the included part(s) contain items for which Patents have been filed and whose use would be required to implement ITU-T/ITU-R Recommendation(s) [...] (General Patent Statement and Licensing Declaration for ITU-T or ITU-R Recommendation)

Furthermore, for all three standards bodies, there are the following texts:

The Patent Policy encourages the early disclosure and identification of Patents that may relate to Recommendations | Deliverables under development. (Guidelines, at summary)

Chairmen of Technical Bodies will, if appropriate, ask, at an appropriate time in each meeting, whether anyone has knowledge of patents, the use of which may be required to practice or implement the Recommendation | Deliverable being considered. (Guidelines, §5)

C10. Do disclosures have to specify for which standard(s) the patents are believed to be essential? How specific is this information required to be? (e.g. WG/SC/TC, specific standard, version of the specific standard / year).

Yes. The patent statement and licensing form clearly require the relevant deliverable (recommendation in ITU, deliverable in ISO or IEC) to be listed and for all organizations, the public disclosure database invariably provides this information.

C11. How should the submitter deal with mandatory vs. optional portions of the standard, or with informative portions / informative references in the standard, etc.?

The policy provides no information on this.

Additional comment by an ITU representative: "Only mandatory portions of the standard can be considered as "essential".

C12. How should the submitter deal with elements of the standards that only affect certain product categories (terminal vs. base stations, or encoders vs. decoders)?

The policy provides no information on this.

### Patent disclosure, relating to patent identities

C13. Are blanket disclosures (general declarations) allowed and, if relevant, under what circumstances?

Blanket disclosures are allowed, although specific disclosures are 'desired'.

At the ITU there is an exception to this: when a party declares that it is not willing to license its essential patents, it needs to provide patent identification, information on what exact parts of the standards are covered by that patent, and a description of the patents. In the same situation at IEC and ISO, such information is not required but it is 'strongly desired'.

While the literal interpretation seems suggests this is an obligation to any patent owners, it is hard to see how such a provision could be binding to a third party patent owner.

*Additional comment by an ITU representative: "Indeed this is not binding to non-participant patent owners."*

*Addition comment by a representative on behalf of both ISO and IEC: "In a strict legal sense it is not binding for third parties. There is no contract in place that obliges patent owners to fill out the patent statement form."*

#### Sources and additional details:

Patent Information (desired but not required for options 1 and 2; required in ITU for option 3. (Patent statement and licensing declaration))

If a Patent Holder has selected the licensing option 3 on the Declaration Form, then, for the referenced relevant ITU Recommendation, the ITU requires the Patent Holder to provide certain additional information permitting patent identification. In such a situation, for any relevant ISO or IEC Deliverable, the ISO and IEC strongly encourage (but do not require) the Patent Holder to provide certain additional information permitting patent identification. (Guidelines)

The Patent Holder is unwilling to grant licenses in accordance with provisions of either 1 or 2 above.

In this case, the following information must be provided to ITU, and is strongly desired by ISO and IEC, as part of this declaration:

- granted patent number or patent application number (if pending);
- an indication of which portions of the above document are affected;
- a description of the Patents covering the above document. (Patent statement and licensing declaration)

C14. Do disclosure rules only apply to granted patents, or also to (published / unpublished) patent applications? Do other types of IP (copyright etc.) need to be disclosed?

For the IEC/ISO/ITU common policy, only patents (and utility models and similar statutory rights based on inventions) and applications therefor need to be disclosed.

ITU (only) has an additional (separate) policy on software as part of a deliverable or the inclusion of marks (i.e. trademarks, service marks and certification marks) in ITU-T recommendations.

#### Sources and additional details:

The policy is called the Common Patent Policy, and nowhere in the document any reference is made to other IPR than patents.

The definition of a patent is particular. In fact, it seems to be a definition for what an essential patent is....

Patent: The word "Patent" means those claims contained in and identified by patents, utility models and other similar statutory rights based on inventions (including applications for any of these) solely to the extent that any such claims are essential to the implementation of a Recommendation | Deliverable. Essential patents are patents that would be required to implement a specific Recommendation | Deliverable. (Guidelines, §2)

Specifically for ITU, Article 3.1.6 of ITU-T Rec. A1 reads:

"A contributor submitting software for incorporation in the draft Recommendation is required to submit a software copyright statement and licensing declaration form available at the ITU-T website. The form must be provided to TSB at the same time that the contributor submits the software.

Article 3.1.5 of ITU-T Rec. A1 reads: "Material such as text, diagrams, etc., submitted as a contribution to the work of ITU-T is presumed to be by ITU to have no restrictions in order to permit the normal distribution of this material for discussions within the appropriate groups and possible use, in whole or in part, in any resulting ITU-T Recommendations that are published. By submitting a contribution to ITU-T, authors acknowledge this condition of submission. In addition, authors may state any specific conditions on other uses of their contribution.

C15. Are there requirements for disclosing equivalent patents in different patent legislations? (i.e. patent family members)

The policy provides no information on this.

Additional clarification by an ITU representative: "However, considering the global reach of an ITU Recommendation, it is expected that the whole patent family protecting a single invention will be disclosed."

### Patent disclosure, other

C16. Does the SDO make available specific (paper or electronic) patent disclosure forms? If so, is the use of these forms mandatory?

For the disclosure of own essential patents, it is mandatory to use the disclosure form that is made available by IEC/ISO/ITU. In effect, this form is a licensing declaration at the same time.

Disclosure of third party patents must be in writing, but there is no standardized form for that. (Note that patent statements must be provided by the patent owner, regardless of who disclosed the patent in question).

#### Sources and additional details:

When disclosing their own Patents, Patent Holders have to use the Patent Statement and Licensing Declaration Form (referred to as the "Declaration Form") as stated in Section 4 of these Guidelines. (Guidelines, at §3)

Any communication drawing the attention to any third-party Patent should be addressed to the concerned Organization(s) in writing. The potential Patent Holder will then be requested by the Director/CEO of the relevant Organization(s) to submit a Declaration Form, if applicable. (Guidelines, at 3)

C17. Are there provisions concerning updating of disclosures in case of changes in the (proposed / final) standard or the (applied / granted / rejected / expired) patent, or updated information concerning the patent identities?

No such provisions are present.

**Sources and additional details:**

Interestingly, there is a provision that requests parties to update address information in their declarations.

With a view to maintaining up-to-date information in the Patent Information database of each Organization, it is requested that the Organizations be informed of any change or corrections to the Declaration Form submitted in the past, especially with regard to the contact person. (Guidelines, §4.2)

C18. Are there requirements to withdraw disclosures when patents 'lose' their essentiality (e.g. due to the surfacing of a new, alternative implementation that can also fulfill the required element of the standard in question)

The policy provides no information on this.

C19. In addition to the formal, written disclosure statements, what information on potentially essential patents do participants need to provide during standardization meetings? Is it different for own proposals vs. proposals by others? Is this information (oral statements?) recorded, and to whom is it available?

See question C1. Patent disclosure statements made during meetings must be recorded in the meeting report.

*Additional comment by an ITU representative: "The meeting report is available to ITU Members. Furthermore, patent disclosure statements made during meetings should also be filed in the format of a Patent Statement and Licensing Declaration of the Common Patent Policy."*

*Addition comment by a representative on behalf of both ISO and IEC: "Anyone can get a copy of such reports upon request. Please note that any patent owner who claims to own an essential patent needs to submit patent statements to our organizations and that the content of the submitted patent statements is reflected in the patent databases, and in the respective standard."*

**Sources and additional details:**

Chairmen of Technical Bodies will, if appropriate, ask, at an appropriate time in each meeting, whether anyone has knowledge of patents, the use of which may be required to practice or implement the Recommendation | Deliverable being considered. The fact that the question was asked shall be recorded in the meeting report, along with any affirmative responses. (Guidelines, §5)

C20. Are all patent disclosures being made public? Where and in what form? Is there any information in the disclosures that is not made public?



In principle, all patent disclosures that are part of a licensing declaration (currently via the 'Patent Statement and Licensing Declaration' form) are made public in a database. The format and the actual available information differ considerably, however. ITU has even two quite different databases (for ITU-R and ITU-T, respectively). ISO has separate but identical databases for patents on JTC-1 standards and those on other standards. Only IEC allows access to the original declarations in facsimile format.

Patent disclosure statements can also be done at Technical Body meetings. This information is to be recorded by the chairman.

*Additional comment by an ITU representative: "The meeting report is available to ITU Members. Furthermore, patent disclosure statements made during meetings should also be filed in the format of a Patent Statement and Licensing Declaration of the Common Patent Policy."*

*Addition comment by a representative on behalf of both ISO and IEC: "Anyone can get a copy of such reports upon request. Please note that any patent owner who claims to own an essential patent needs to submit patent statements to our organizations and that the content of the submitted patent statements is reflected in the patent databases, and in the respective standard."*

### Sources and additional details:

**6 Patent Information database.** In order to facilitate both the standards-making process and the application of Recommendations | Deliverables, each Organization makes available to the public a Patent Information database composed of information that was communicated to the Organizations by the means of Declaration Forms. The Patent Information database may contain information on specific patents, or may contain no such information but rather a statement about compliance with the Patent Policy for a particular Recommendation | Deliverable. (Guidelines, §6)

The above refers to 'declaration forms' and thus excludes disclosure statements made at Technical Body meetings.

It is not entirely clear whether the last sentence means that the SDO may decide not to publish information on specific patents, or whether this simply reflects the fact that not parties chose to issue specific declarations.

Chairmen of Technical Bodies will, if appropriate, ask, at an appropriate time in each meeting, whether anyone has knowledge of patents, the use of which may be required to practice or implement the Recommendation | Deliverable being considered. The fact that the question was asked shall be recorded in the meeting report, along with any affirmative responses. (Guidelines, §5)

A summary of database locations is given at Question A1.

C21. How does the SDO deal with situations in which a party claims that a disclosed patent is not in fact essential or not any longer essential? Have such situations occurred?

The policy does not provide information on this.

*Additional comment by an ITU representative: "This question relates to the discussion supra, on whether a patent is (or believed to be, or maybe) essential. As stated above, this consideration/argumentation on the merits regarding the scope of a patent (and therefore, its essentiality vis-à-vis the standard in question) is left outside the standardization process. This*

*approach is also reflected in the wording of the Patent Statement and licensing declaration ("the Patent Holder believes that it holds granted and/or pending applications for Patents, the use of which would be required to implement the above document [...]").*

### Part D: Licensing commitments

D1. What best characterizes the commitment model? For instance, (1) Parties are committed to license by default and do not have to make a commitment statement (or make a general statement when joining the SDO); (2) Parties are *required* to issue a commitment statement (even if it's a statement of refusal to license) or (3) Parties are *invited* to issue a commitment statement.

Any patent holder (for which patents have been disclosed, either by himself or by any party) is obliged to provide a 'patent statement and licensing declaration' indicating whether or not it is willing to license at RAND-z terms, RAND terms, or not at all. Statements use an obligatory form and are for specific standards (recommendations at ITU, deliverables at ISO or IEC).

**It is not clear how the policy can include binding obligations to third parties.**

*Additional comment by ITU representative: "Indeed, the policy is binding only to patent holders who are participating in the work of the Organizations"*

*Addition comment by a representative on behalf of both ISO and IEC: "In a strict legal sense it is not binding for third parties. There is no contract in place that obliges patent owners to fill out the patent statement form."*

In addition, ITU (only) encourages (but not obliges) parties to submit a 'General Patent Statement and Licensing Declaration', in order to improve responsiveness and early disclosure of the Patent Holder's compliance with the Patent Policy. This form allows a party to make a licensing commitment, but it does not constitute a disclosure: a submitted form does not necessarily mean that the company believes it owns essential patents; it only indicates that SHOULD it own essential patents on its own proposals, then it would license them at the indicated conditions. The general statement covers *all* activities in the standards body in question, not only one specific standard or activity. These general statements do not release a party of its duty to submit regular 'patent statement and licensing declarations' for a specific

#### Sources and additional details:

Whatever case applies (2.1, 2.2 or 2.3), the patent holder has to provide a written statement to be filed at ITU-TSB, ITU-BR or the offices of the CEOs of ISO or IEC, respectively, using the appropriate "Patent Statement and Licensing Declaration" form. (Common policy)

**The Guidelines do refer to a 'request' instead of an 'obligation' for third parties to submit a declaration form. Yet, the Common policy probably prevails over the Guidelines.**

Any communication drawing the attention to any third-party Patent should be addressed to the concerned Organization(s) in writing. The potential Patent Holder will then be requested by the Director/CEO of the relevant Organization(s) to submit a Declaration Form, if applicable. (Guidelines, at 3)

D2. If licensing statements are used, when must they be made? For instance: (1) Upon joining the SDO, (2) when a patent disclosure is made, (3) when a draft standard reaches a particular state of advancement, (4) when requested by the SDO.

If a participant owns essential patents itself, a licensing declaration must be provided at the same time of the disclosure, which is 'from the outset' (see Question C3 above on the timing of disclosures). All disclosure and commitment rules however also apply for patents that are disclosed after the approval of a standard, even though that is obviously much later than 'at the outset'.

If a non-participant (to the specific standard) or a third party is believed to own an essential standard, it must provide a licensing statement upon a request of the Director/CEO of the relevant standards organization (which the director/CEO will make after being informed about a potential essential patent owned by that party).

*(It is not clear how the policy can include binding obligations to third parties.)*

*Additional comment by ITU representative: "Indeed, the policy is binding only to patent holders who are participating in the work of the Organizations"*

*Addition comment by a representative on behalf of both ISO and IEC: "In a strict legal sense it is not binding for third parties. There is no contract in place that obliges patent owners to fill out the patent statement form."*

In addition, ITU (only) has a voluntary 'General Patent Statement and Licensing Declaration' (see question D1 above). From its purpose it follows that parties are encouraged that form as early as possible, preferably upon joining the SDO.

### Sources and additional details:

When disclosing their own Patents, Patent Holders have to use the Patent Statement and Licensing Declaration Form (referred to as the "Declaration Form") as stated in Section 4 of these Guidelines. (Guidelines, at §3)

Any communication drawing the attention to any third-party Patent should be addressed to the concerned Organization(s) in writing. The potential Patent Holder will then be requested by the Director/CEO of the relevant Organization(s) to submit a Declaration Form, if applicable. (Guidelines, at §3)

The Patent Policy and these Guidelines also apply to any Patent disclosed or drawn to the attention of the Organizations subsequent to the approval of a Recommendation | Deliverable. (Guidelines, at §3)

D3. Are there differences between licensing commitment policies between working groups or standardization activities? To what degree do the commitment requirements depend on whether a member/participant is actually participating in a working group (or standardization activity) or not?

No such differences could be found in the policies.

D4. Does the SDO make available specific (paper or electronic) licensing commitment forms? If so, is the use of these forms mandatory?

It is mandatory to use the harmonized form that is made available by IEC/ISO/ITU.

### Sources and additional details:

Whatever case applies (2.1, 2.2 or 2.3), the patent holder has to provide a

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

written statement to be filed at ITU-TSB, ITU-BR or the offices of the CEOs of ISO or IEC, respectively, using the appropriate "Patent Statement and Licensing Declaration" form. (Common policy)

When disclosing their own Patents, Patent Holders have to use the Patent Statement and Licensing Declaration Form (referred to as the "Declaration Form") as stated in Section 4 of these Guidelines. (Guidelines, at §3)

To provide clear information in the Patent Information databases of each Organization, Patent Holders have to use the Declaration Form, which is available on the web site of each Organization (Guidelines, at §4.1)

**It is not clear how the policy can include binding obligations to third parties.**

*Additional comment by ITU representative: "Indeed, the policy is binding only to patent holders who are participating in the work of the Organizations"*

*Addition comment by a representative on behalf of both ISO and IEC: "In a strict legal sense it is not binding for third parties. There is no contract in place that obliges patent owners to fill out the patent statement form."*

D5. Are issued licensing commitments binding to other members of the SDO only, or to any implementer of the standard requesting a license?

The commitment is binding to any party wishing to implement the standard.

### Sources and additional details:

There is not any text in the documents that suggests licensing commitments only relate to other members.

D6. Is there a specific or 'minimal' commitment type required or requested by the SDO? (e.g. FRAND, FRAND-z, RF, non-assertion ) If so, does this specific or 'minimal' commitment type depend on the working group or standardization activity?

The minimal commitment that is sought is Reasonable and Non-Discriminatory, but the policy also explicitly allows parties to commit themselves to RAND free of charge.

D7. Is there any 'opt-out' option for patent holders (indicating it is not willing to license certain patents), or any 'opt-down' option (e.g. from RAND-z to RAND)? How does it work and when does it need to be exercised? What are the consequences of such a choice?

Patent owners are in principle free to refuse to license any of their IPR at RAND conditions. (option '3' on the licensing declaration), unless it made an earlier ITU general declaration and the patent in question is covered in its own contribution.

Patent owner are *not* allowed to opt-down (change to less favorable licensing conditions from the perspective of licensees), but they are able to opt-up (change to more favorable licensing conditions from the perspective of licensees)

### Sources and additional details:

The licensing declaration contained in the Declaration Form remains in force unless it is superseded by another Declaration Form containing more

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

favourable licensing terms and conditions from a licensee's perspective reflecting (a) a change in commitment from option 3 to either option 1 or option 2, (b) a change in commitment from option 2 to option 1 or (c) un-checking one or more sub-options contained within option 1 or 2.

D8. Does the policy require, allow or forbid parties to include specific licensing terms as part of their commitment (such as conditions of bilateral or universal reciprocity, scope of use, etc.)? Does the policy (or the forms) explicitly specify such options, or does it simply tolerate it in practice?

There is an explicit option to offer (not free of charge) RAND licenses on the condition of reciprocity for licenses for the same standard.

Those parties offering a RAND free of charge commitment have the option to require 'normal reciprocity' (which means that the other party must be willing to license at RAND or RAND-z). It may also opt, however, to offer RAND free of charge only to those that reciprocate RAND free of charge, and 'only' commit to (not free of charge) RAND if the other party only is willing to offer on (not free of charge) RAND.

No other conditions are allowed.

### Sources and additional details:

#### Licensing declaration:

The Patent Holder believes that it holds granted and/or pending applications for Patents, the use of which would be required to implement the above document and hereby declares, in accordance with the Common Patent Policy for ITU-T/ITU-R/ISO/IEC, that (check one box only):

1. The Patent Holder is prepared to grant a Free of Charge license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and under other reasonable terms and conditions to make, use, and sell implementations of the above document.

Negotiations are left to the parties concerned and are performed outside the ITU-T, ITU-R, ISO or IEC.

*Also mark here \_\_\_ if the Patent Holder's willingness to license is conditioned on Reciprocity for the above document.*

*Also mark here \_\_\_ if the Patent Holder reserves the right to license on reasonable terms and conditions (but not Free of Charge) to applicants who are only willing to license their Patent, whose use would be required to implement the above document, on reasonable terms and conditions (but not Free of Charge).*

2. The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the above document.

Negotiations are left to the parties concerned and are performed outside the ITU-T, ITU-R, ISO, or IEC.

*Also mark here \_\_\_ if the Patent Holder's willingness to license is conditioned on Reciprocity for the above document.*

The common policy explicitly forbids any other condition than reciprocity:

This statement must not include additional provisions, conditions, or any other exclusion clauses in excess of what is provided for each case in the corresponding boxes of the form. (Common policy)

D9. Does a commitment (1) cover any patents that are essential to the developed standards, (2) only cover those patents that are actually disclosed, or (3) only cover patents relating to the own contributions of the patent holder?

Although the policy and forms are not explicit on this, it seems that the commitment for any patent the party owns that is essential to a specified standard (recommendation at ITU, deliverable at ISO or IEC).

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

ITU (only) has a voluntary 'general patent statement and licensing declaration', and this only covers patents related to one's own contributions (to any ITU standard). But it is still obligatory to submit a 'Patent statement and licensing declaration' once parties meet the disclosure requirement.

D10. Is a patent holder still bound to a licensing commitment should an earlier disclosed patent eventually turn out not to be essential? (e.g. differences in adopted standard, differences in granted patent)

No, it seems not. The declaration refers to the word Patent (written in capital) as defined in the Guidelines. This definition is actually about a patent that is actually essential (a bit of an unusual definition, though, but this is what it says).

So, if a patent is no longer essential, it is not a 'Patent' any more in the wording of the policy, and the licensing commitment disappears.

*An expert commented that "[the term 'Patent'] was redefined to make it clear that the commitment only applies to essential claims and only to those that end up being essential for implementation. This was the intent of those revisions."*

*Additional comment by an ITU representative: 'The licensing obligation based on FRAND applies only to essential patents. Whether, however, the patent is actually essential is not a consideration that is discussed during the standardization process.'*

D11. What is the geographic scope of the commitments? Relatedly, do commitments relate only to the disclosed patents, or also to all equivalent patents in other jurisdictions (i.e. patent family members)?

Commitments are worldwide.

### Sources and additional details:

The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the above document. (Patent statement and licensing declaration)

D12. Are commitments limited to the use of these patented technologies only in order to produce products that comply to specific standards? Or all standards developed by the SDO, or not limited at all?

The commitments are to be limited to the use of these patented technologies only in order to produce products that comply to the specific standards indicated by the submitter.

### Sources and additional details:

The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the above document. (Patent statement and licensing declaration)

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

D13. Does the policy specify any legal restriction concerning commitments? (For instance, a policy may specify that a FRAND commitment implies that an injunctive relief may not be sought.)

Not specified by the policy.

D14. Does the policy explicitly require that commitments are irrevocable? If so, does the policy mention allowable exceptions (such as defensive suspension, or if the licensee refuses to offer a reciprocal license)?

Commitments are irrevocable. Declarations may be superseded, but only if the new one has more favorable conditions than the old one (from the perspective of the licensee).

### Sources and additional details:

Although the word irrevocable is not used, the fact wording below should be considered to have the same effect:

The licensing declaration contained in the Declaration Form remains in force unless it is superseded by another Declaration Form containing more favourable licensing terms and conditions from a licensee's perspective reflecting (a) a change in commitment from option 3 to either option 1 or option 2, (b) a change in commitment from option 2 to option 1 or (c) un-checking one or more sub-options contained within option 1 or 2. (Guidelines, at §4.2)

D15. What does the policy specify about the eventual transfer of patents for which commitments have been made?

The common policy has a specific section on patent transfer, defining obligations for the original patent holder. Essentially, a patent holder that has entered into a licensing commitment must ensure that the transferee also is bound to the same commitment (so a free of charge license should remain a free of charge license).

However, (1) there are ambiguous in the definition which patent holders exactly have this obligation, (2) in the case the original licensing commitment did not disclose specific patents ('blanket disclosure') the exact obligation, and (3) when a second transfer takes place, the new owner might not be bound to any commitment any more.

### Sources and additional details:

In the event a Patent Holder participating in the work of the Organizations assigns or transfers ownership or control of Patents for which the Patent Holder reasonably believes it has made a license undertaking to the ITU/ISO/IEC, the Patent Holder shall make reasonable efforts to notify such assignee or transferee of the existence of such license undertaking. (Guidelines, at §7)

Additional clarification by an ITU representative: *"The phrase "participating in the work of the organizations" covers any member of the company/organization who was present at the discussion of a technical matter in the context of the technical body in question."*

This clause seems to leave some ambiguity about who is bound to these rules, even after the

clarification above. It seems as if a party that made a license undertaking *but was not present at the discussion of a technical matter in the context of the technical body in question* is not bound by this rule.

Addition clarification by a representative on behalf of both ISO and IEC: *"In principle any patent owner who submitted a patent declaration should make such efforts."*

Note that the ISO/IEC clarification differs somewhat from the ITU clarification, as it refers to any patent owner who submitted a statement, not only those that participated in the work of the organization.

It is assumed that this only holds for license undertakings of the 1 and 2 type, not the 3 type (refusal) (Additional comment by an ITU representative: "indeed").

In addition, if the Patent Holder specifically identified patents to ITU/ISO/IEC, then the Patent Holder shall have the assignee or transferee agree to be bound by the same licensing commitment as the Patent Holder for the same patent. (Guidelines, at §7)

This says 'shall', so it is a binding obligation. Also, 'the same licensing commitment', so a free of charge license should remain a free of charge license.

Although the policy as such does not seem to specify that that the new assignee has to make an undertaking to the SDO, an ITU representative clarified that *"the transferee or assignee should make an undertaking to the ITU, by submitting a new patent statement and licensing declaration form, for updating the patent information database with the new contact details. In this context, ITU asks for written confirmations by the new owners that the transfer has indeed taken place, in order to update the database accordingly. Furthermore, in accordance with our Guidelines for Implementation of the Common Patent Policy, if the Patent Holder specifically identified patents to the organization, then the Patent Holder shall have the assignee or transferee agree to be bound by the same licensing commitment as the Patent Holder for the same patent."*

Addition clarification by a representative on behalf of both ISO and IEC: *"[...] in a strict legal sense the common patent policy cannot bind third parties. It could therefore be that the assignee of a patent is not bound according to the licensing declaration of the assignor."*

If the Patent Holder did not specifically identify the patents in question to ITU/ISO/IEC, then it shall use reasonable efforts (but without requiring a patent search) to have the assignee or transferee to agree to be so bound. (Guidelines, at §7)

What these reasonable efforts then are is not so clear. Since it is not required to do a patent search, to what should the transferee be bound? This obligation may be satisfied by the new transferee making a blanket statement as well, but this is not exactly what this text says.

An ITU representative clarified that *"The use of the chosen flexible wording was required in order to accommodate all possible actions that could be taken in this regard."*

Addition clarification by a representative on behalf of both ISO and IEC: *"A blanket declaration is one option that would be in compliance with the Guidelines"*.

By complying with the above, the Patent Holder has discharged in full all of its obligations and liability with regards to the licensing commitments after the transfer or assignment. This paragraph is not intended to place any duty on the Patent Holder to compel compliance with the licensing commitment by the assignee or transferee after the transfer occurs. (Guidelines, at §7)

D16. Does the policy specify anything about ex-ante disclosure of most restrictive licensing terms? (e.g. forbidden, voluntary, mandatory, recommended, endorsed)



## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

Not specified by the policy.

D17. Is there any link between the IPR policy – or the SDO in general – and a patent pool or other licensing programs? Can you describe this link?

Not specified by the policy. (An ITU representative clarified that there is no such link.)

D18. Are all licensing commitments being made public? Where and in what form? Is there any information in the disclosures that is not made public?

In principle, all licensing commitments are made public in a database. The format and the actual available information differs considerable, however. ITU has even two quite different databases (for ITU-R and ITU-T, respectively). ISO has separate but identical databases for patents on JTC-1 standards and those on other standards. Only IEC allows access to the original declarations in facsimile format.

(Note: after the data collection for this study, ISO updated its online database and now offers a single MS Excel file that has all disclosures for both ISO and JTC-1.)

### Sources and additional details:

**6 Patent Information database.** In order to facilitate both the standards-making process and the application of Recommendations | Deliverables, each Organization makes available to the public a Patent Information database composed of information that was communicated to the Organizations by the means of Declaration Forms. The Patent Information database may contain information on specific patents, or may contain no such information but rather a statement about compliance with the Patent Policy for a particular Recommendation | Deliverable. (Guidelines, §6)

The above refers to 'declaration forms' and thus excludes disclosure statements made at Technical Body meetings. (Additional comment by an ITU representative: 'Patent disclosure statements made during meetings should also be filed in the format of a Patent Statement and Licensing Declaration of the Common Patent Policy'.)

It is not entirely clear whether the last sentence means that the SDO may decide not to publish information on specific patents, or whether this simply reflects the fact that not parties chose to issue specific declarations. (Additional comment by an ITU representative: "The Patent Information Database shows all information that has been submitted by the parties. If a patent is not identified in the database it's because it has not been identified by the patent holder".)

A summary of database locations is given at Question A1.

## Part E: SDO procedures and public

E1. What are the remedies available to SDO in case of non-compliance with the policy (e.g. failure to disclose, failure to provide licensing commitments, other violations of the policy)?

An ITU representative clarified: "The remedies available for the organization in case of non-

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

*compliance is the revision of the standard with the purpose of avoiding the subject matter covered by the patent(s) in question, or, in case such avoidance is not possible, the withdrawal of the standard”*

*A representative on behalf of both ISO and IEC clarified: “If a patent owner who owns a patent of which the use is required to implement the deliverable (standard) is not prepared to license under option one or two of the licensing declaration form a remedy would be to change the deliverable in a manner that the use of the patent is no longer required to implement the deliverable.”.*

E2. How does the policy deal with companies that chose not to enter into licensing commitments (insofar as the policy allows such a choice)?

If an essential IPR holder for any specific standard declares to be unwilling to license at RAND or RAND free of charge conditions, the SDO will take appropriate actions, including a review of the standard so that the IPR in question would not be essential any more.

Should there be indications of such unwillingness before the standard is approved, then the approval should be postponed until there is certainty.

### Sources and additional details:

Whether the identification of the Patent took place before or after the approval of the Recommendation | Deliverable, if the Patent Holder is unwilling to license under paragraph 2.1 or 2.2 of the Patent Policy, the Organizations will promptly advise the Technical Bodies responsible for the affected Recommendation | Deliverable so that appropriate action can be taken. Such action will include, but may not be limited to, a review of the Recommendation | Deliverable or its draft in order to remove the potential conflict or to further examine and clarify the technical considerations causing the conflict. (Guidelines, at §3)

As long as the Organization concerned has received no indication of a Patent Holder selecting paragraph 2.3 of the Patent Policy, the Recommendation | Deliverable may be approved using the appropriate and respective rules of the Organization concerned. (Guidelines, at §5)

E3. How does the SDO deal with non-members (third parties), for instance when it is brought to the attention of the SDO that such a third party owns IPR essential to one of its standards?

Any participant has the duty to disclose essential patents it is aware of, including those not owned by itself (See also question C4). If the patent is indeed owned by another party (and that party is not a participant itself, having its own disclosure obligation), then the director/CEO of the SDO will contact this third party and this party is obliged (or requested, if it is a non-member) to make a licensing declaration.

### Sources and additional details:

Therefore, any party participating [1] 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

[1]: In the case of ISO and IEC, this includes any recipient of a draft standard at any stage in the standards development process. (Common policy)

Whatever case applies (2.1, 2.2 or 2.3), the patent holder has to provide a

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

written statement to be filed at ITU-TSB, ITU-BR or the offices of the CEOs of ISO or IEC, respectively, using the appropriate "Patent Statement and Licensing Declaration" form. (Common policy)

The Guidelines do refer to a 'request' instead of an 'obligation' for third parties to submit a declaration form. Yet, the Common policy probably prevails over the Guidelines.

Any communication drawing the attention to any third-party Patent should be addressed to the concerned Organization(s) in writing. The potential Patent Holder will then be requested by the Director/CEO of the relevant Organization(s) to submit a Declaration Form, if applicable. (Guidelines, at 3)

E4. What are the policy and practices about (1) handling and possible rejection of incomplete disclosure or licensing statement, (2) correction of clerical errors (including patent identities), (3) resubmission of statements in any of the above cases?

Information contained in a Declaration Form may be corrected in case of obvious errors, such as a typographical mistake in a standard or patent reference number

### Sources and additional details:

Information contained in a Declaration Form may be corrected in case of obvious errors, such as a typographical mistake in a standard or patent reference number (Guidelines, §4.1)

I assume this correction may be done by the administrative staff of the SDO. (Additional comment by an ITU representative: "Indeed. However, ITU does not make any corrections to the patent titles, number, country in which said patent is granted, etc.")

## Part F: Conflicts and enforcement

F1. Can you please describe the main disputes (if any) that have arisen in terms of respecting or interpretation the IPR policy?

An ITU representative clarified: "As such disputes take the form of litigation between private parties, the role of the ITU as a neutral facilitator does not permit any involvement in such litigation."

## Part G: Other

G1. Is the content of meetings of Technical Committees, Technical Bodies or similar groups considered to be public information? This is especially relevant for patent examiners, who need to consider whether such information should or should not be considered when examining prior art in (new) patent applications.

An ITU representative clarified: "The assessment of whether such content is public information and whether it should be included in the prior art should be considered in accordance with the rules for substantive examination which govern the competent patent office.

That being said, the ITU has already entered into an agreement with the EPO, for granting the latter

## Supplement 1 - Analysis of the IPR policy of IEC/ISO/ITU

---

*access to a large volume of data such as technical contributions and draft ITU-T Recommendations used by ITU-T Study Groups at different stages of the standard development process. Such access has been agreed so that EPO can use such documentation for the purposes of the patenting procedure in all its phases, including the compilation and distribution of search reports and inspection files, with a view to improving the quality of patents being granted. Whether such documentation will be considered as prior art is a decision that lies exclusively with the EPO.”*

G2. Are there any specific provisions on software / copyright when that software is part of the content of the standard? (This question does not concern the copyright on the text of the standard as such.)

ITU (only) has an additional (separate) policy on software as part of a deliverable. [ITU-T has an additional policy on the use of Marks in ITU-T Recommendations.](#)

ISO and IEC do not have such a policy.

G3. Are there any rules in relation to IPR in standards of other SSOs that are normatively referenced in a standard?

The policy provides no information on this.

*An ITU representative clarified: “However, Recommendation ITU-T A.5 (Generic procedures for including references to documents of other organizations in ITU-T Recommendations) requires that such information be qualified. Appendix I of said Recommendation provides the format for documenting a study group or working party decision with respect to making the reference.”*

<< end >>