

### Analysis of the IPR policy of IEEE

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>

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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.

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 recent 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?

The principal IPR policy is described in Chapter 6 of the SB bylaws of the IEEE Standards Associations:

IEEE-SA Standards Board Bylaws, as approved by the IEEE-SA Board of Governors, March 2012. Available from <http://standards.ieee.org/develop/policies/bylaws/index.html> and [http://standards.ieee.org/develop/policies/bylaws/sb\\_bylaws.pdf](http://standards.ieee.org/develop/policies/bylaws/sb_bylaws.pdf). Here referred as SB Bylaws.

See also <http://standards.ieee.org/develop/policies/index.html> as well as <https://standards.ieee.org/develop/policies.html>.

The policies, procedures, rules, and regulations by which the IEEE and IEEE-SA Standards Board activities are governed are embodied in six documents. See the SB Bylaws at §3 for more information. Of those documents, the following one is relevant in our context:

IEEE-SA Standards Board Operations Manual, Approved by the IEEE-SA Standards Board

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December 2011. Available from <http://standards.ieee.org/develop/policies/opman/index.html> and [http://standards.ieee.org/develop/policies/opman/sb\\_om.pdf](http://standards.ieee.org/develop/policies/opman/sb_om.pdf) Here referred as Operations Manual.

Other relevant documents include:

- Patent Letter of Assurance (LOA) Form, <https://development.standards.ieee.org/myproject/Public/mytools/mob/loa.pdf>. Further referred to as LoA Form.
- Patent Letter of Assurance (LOA) Cover Letter (the letter that a chair can send to a party it suspects to own SEP) [https://development.standards.ieee.org/myproject/Public/mytools/mob/cover\\_letter.doc](https://development.standards.ieee.org/myproject/Public/mytools/mob/cover_letter.doc)
- Patent Letter of Assurance (LOA) Process Flowchart <https://development.standards.ieee.org/myproject/Public/mytools/mob/flowchart.pdf>
- Patent Slides for Standards Development Meetings (also: "Instructions for the WG Chair") <https://development.standards.ieee.org/myproject/Public/mytools/mob/slideset.pdf>
- Patent Slides for Pre-PAR Meetings <https://development.standards.ieee.org/myproject/Public/mytools/mob/preparslides.pdf>
- Patent Policy Tutorial ("IEEE-SA Patent Policy: Introduction and guide to IEEE-SA patent policy effective 1 May 2007") <https://development.standards.ieee.org/myproject/Public/mytools/mob/patut.pdf> Here referred as Patent Tutorial.
- FAQs: Understanding Patent Issues during IEEE Standards Development <http://standards.ieee.org/faqs/patents.pdf>
- Relationship of IEEE-SA Patent Policy/LoAs to Modification of IEEE Standards by Other Standards Bodies <https://development.standards.ieee.org/myproject/Public/mytools/mob/relationship.pdf>

General references to all the above documents are available at <http://standards.ieee.org/about/sasb/patcom/materials.html>

A list of published LoA's is at <http://standards.ieee.org/about/sasb/patcom/patents.html> (see also Question D18 for details)

General references:

IEEE Standards site: <http://standards.ieee.org/>

PATcom site: <http://standards.ieee.org/about/sasb/patcom/index.html>

Explanation on how IEEE standards are developed: <https://standards.ieee.org/develop/wg.html>

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

The IEEE revised its IPR policy in 2007. Among other reforms, the new IEEE policy allows ex ante

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disclosure of licensing terms and encourages disclosure of third-party patents.

(We did not examine these changes in great detail).

### 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 IPR policy is part of the IEEE-SA SB Bylaws, and some relevant clauses can be found in the Operations Manual. (We have not studied in detail how these documents are binding, but we assume these are binding to members, and in particular to participants at meetings, who face specific obligations in this policy.)

The specific obligations relating to licensing commitments are made part of the obligatory forms (templates) that are used for the LoA's. Once signed, these conditions become binding to the submitters.

(See also the next question.)

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

IEEE SA has two types of members: individual members and corporate members. The type of membership determines in which projects a member can participate. The processes also differ; 'corporate standards' are balloted using a "one-company, one-vote" principle. The IPR policy does not talk in terms of members, though. (In fact, the word 'member' does not even occur once in the IPR policy.)

The policy creates binding rules in the following way

- A number of elements in the IPR policy include obligations to individual participating in standards (especially the disclosure obligation). **Although we have not checked this, we assume there is a mechanism in which these SB Bylaws are binding to these participants.**

- The part of the policy where IPR owners are asked for a LoA is **not binding** - these are requests to an IPR owner, member or not, and such requests are without coercion.

- Once a party (member or not) has signed an LoA, it is bound to the specific stipulations in that document (it is a fixed format agreement that the submitter may not modify). A number of obligations in the IPR policy (including those on the transfer of patents, for instance) are copied verbatim into the LoA agreement, thereby making them binding to the parties signing them - member or not.

#### Sources and additional details:

TWO TYPES OF PROCESSES. TWO TYPES OF MEMBERSHIP.

The type of membership necessary depends on the types of projects on which you wish to participate. Read more below:

#### Individual Membership & Projects

Individual Membership is designed for individuals and independent professionals interested in participating in standards development with the IEEE-SA. While membership is not required for participation, membership

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allows participants to ballot on standards and assume leadership roles in standards working groups.

Individual projects follow a set path from concept to completion, which adheres to the principles of due process, openness and consensus building. These principles allow for equity and fair play, so that no one dominates the process. While participants may represent the interests of their employers, individual members participate in the process and ballot as individuals, rather than as a corporate entity.

### **Corporate Membership & Projects**

Corporate Membership is recommended for companies in which standards play a pivotal role in research, product development and marketing. Corporate participants enjoy networking and exposure across a broad cross-section of industry thought leaders and standards participants.

The Corporate Program allows companies to engage and influence technology development to ensure their business interests are heard and represented. Ensuring a uniform playing field among standards collaborators, all corporate standards are balloted using a "one-company, one-vote" principle.

From: <http://standards.ieee.org/membership/index.html>

In order for IEEE's patent policy to function efficiently, individuals participating in the standards development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any potential Essential Patent Claims of which they are personally aware and that are not already the subject of an existing Letter of Assurance, owned or controlled by the participant or the entity the participant is from, employed by, or otherwise represents; and (b) should inform the IEEE (or cause the IEEE to be informed) of any other holders of such potential Essential Patent Claims that are not already the subject of an existing Letter of Assurance. (SB Bylaws, at §6.2, Paragraph 12)

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

There is an explicit definition of affiliates, which includes parent firms, subsidiaries, and other subsidiaries of the parent firm.

When submitting a LoA, organizations agree that the Assurance is binding to all affiliates, unless some specific affiliates are specified as not to be included. In such a case, IEEE will seek separate LoA's from these excluded parties.

### **Sources and additional details:**

With respect to any Essential Patent Claims that an Affiliate has the ability to license, the Submitter agrees that (i) the licensing positions described in parts C and D above apply to any Essential Patent Claims within the scope of the assurance described in part E; and (ii) the terms of this assurance are binding on each such Affiliate; provided, however, that such representations and commitments shall not apply to Affiliates identified below: (LoA form, at F)

[Definition of] "Affiliate" shall mean an entity that directly or indirectly, through one or more intermediaries, controls the Submitter, is controlled by the Submitter, or is under common control with the Submitter. For the purposes of this definition, the term "control" and its derivatives, with respect to for-profit entities, means the legal, beneficial or equitable ownership, directly or indirectly, of more than fifty percent (50%) of the capital stock (or other ownership interest, if not a corporation) of an entity ordinarily having voting rights. "Control" and its derivatives, with respect to nonprofit entities, means the power to elect or appoint more than fifty percent (50%) of the Board of Directors of an

entity. (SB Bylaws, at §6.1, definitions)

The Submitter and all Affiliates (other than those Affiliates excluded in a Letter of Assurance) shall not assign or otherwise transfer any rights in any Essential Patent Claims that are the subject of such Letter of Assurance that they hold, control, or have the ability to license with the intent of circumventing or negating any of the representations and commitments made in such Letter of Assurance. (SB Bylaws, at §6.2)

Those excluded may be contacted by the IEEE with a request for LOA (Patent Policy Tutorial (“IEEE-SA Patent Policy: Introduction and guide to IEEE-SA patent policy effective 1 May 2007”), at <https://development.standards.ieee.org/myproject/Public/mytools/mob/patut.pdf>).

This assurance shall apply to the Submitter and its Affiliates except those Affiliates the Submitter specifically excludes on the relevant Letter of Assurance. (SB Bylaws, at §6.2, paragraph 7)

### Part C: Patent disclosure Patent disclosure, general

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

The IEEE policy is a bit different from that of other SDO's in the sense there are actually two different processes where essential IPR may be disclosed. For this analysis, the questions of disclosure will have two different parts:

#### A. Participant disclosure process

This is the procedures as specified the SB Bylaws § 6.2 para 12.

Disclosure obligations are directed to individuals participating at meetings (even if they are not part of an organization), and not to organizational members as such.

Individual participants are obliged to disclose patents that are aware of and owned by the organization they work for or represent.

Individual participants are encouraged (but not required) to disclose patents of third parties. The encouragement is particularly strong for patents held by non-participants.

At any standards-development meeting (Working Group, Task Force, Task Group, Ad Hocs, conference calls) a call for patents is made.

#### B. Disclosure in LoA process

This is the disclosure of patents by organizations that submit a LoA.

A LoA may be submitted after a chair of an WG has asked a certain organization (member or not) to do so, or own the own initiative of the organization, for instance when an employee is also participant as in (A) and is aware that his or her own firm owns essential IPR.

Submitting a LoA is not obligatory, although they will of course be appreciated.

In a LoA a party may (1) disclose that one owns patents but not identify individual patents ('Blanket Letter of Assurance) or (2) identify specific patents.

**Sources and additional details:**

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In order for IEEE's patent policy to function efficiently, individuals participating in the standards development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any potential Essential Patent Claims of which they are personally aware and that are not already the subject of an existing Letter of Assurance, owned or controlled by the participant or the entity the participant is from, employed by, or otherwise represents; and (b) should inform the IEEE (or cause the IEEE to be informed) of any other holders of such potential Essential Patent Claims that are not already the subject of an existing Letter of Assurance. (SB Bylaws, at §6.2, Paragraph 12)

Concerning the words 'shall' and 'should' there is a specific explanation in the Operations Manual:

The word shall indicates mandatory requirements strictly to be followed in order to conform to the standard and from which no deviation is permitted (shall equals is required to).

The word should indicates that among several possibilities one is recommended as particularly suitable, without mentioning or excluding others; or that a certain course of action is preferred but not necessarily required (should equals is recommended that). (Operations Manual, § 6.4.7)

Although this definition in the operators manual is particularly aimed at the usage of these words in standards documents, we feel its safe to assume they have the same meaning for interpretation the IPR policy and other policy documents. In particular because these interpretations are fully in line with the explanations in the Patent Tutorial.

- Participants are not required to notify the IEEE that they are aware of any potential Essential Patent Claims held by a third party. Participants may make such disclosure at their own discretion.
- Although there is no obligation to notify the IEEE of third party patent holders, the IEEE encourages participants to do so.
- This encouragement is particularly strong as the third party may not be a participant in the standards process. (Patent Tutorial, page 18.)

The chair or the chair's delegate shall ask any patent holder or patent applicant of a Patent Claim that might be or become an Essential Patent Claim to complete and submit a Letter of Assurance in accordance with Clause 6 of the IEEE-SA Standards Board Bylaws. Information about the draft standard will be made available upon request. (Operations Manual,, at §6.3.2)

Call shall be made at every standards-development meeting

- Working Group, Task Force, Task Group, Ad Hoc, conference calls
- Working Group chair or designee makes the call
  - State that if an individual believes a patent claim might be an Essential Patent Claim, such individual should make the Working Group aware of this
- Record in minutes that call for patents was made
- Record in minutes any response
  - When informed, Working Group chair shall contact holder requesting an LOA
- Sample letter provided at <http://standards.ieee.org/about/sasb/patcom/index.html> • [\[https://development.standards.ieee.org/myproject/Public/mytools/mob/cover\\_1etter.doc\]](https://development.standards.ieee.org/myproject/Public/mytools/mob/cover_1etter.doc) (Patent Tutorial, page 5.)

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, no such exceptions have been specified.

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)?

### A. Participant disclosure process

In principle, patent disclosures should be made directly at meetings (Working Group, Task Force, Task Group, Ad Hoc, conference calls) where the standard is discussed. At any of these meetings, a call for patents shall be made.

Furthermore, patent disclosures can be made at any other time, also outside meetings.

### B. Disclosure in LoA process

See question D2.

### **Sources and additional details:**

The chair or the chair's delegate shall ask any patent holder or patent applicant of a Patent Claim that might be or become an Essential Patent Claim to complete and submit a Letter of Assurance in accordance with Clause 6 of the IEEE-SA Standards Board Bylaws. Information about the draft standard will be made available upon request. (Operations Manual, at §6.3.2)

Call shall be made at every standards-development meeting

– Working Group, Task Force, Task Group, Ad Hoc, conference calls

– Working Group chair or designee makes the call

• State that if an individual believes a patent claim might be an Essential Patent Claim, such individual should make the Working Group aware of this

– Record in minutes that call for patents was made

– Record in minutes any response

• When informed, Working Group chair shall contact holder requesting an LOA

– Sample letter provided at

<http://standards.ieee.org/about/sasb/patcom/index.html> •

[[https://development.standards.ieee.org/myproject/Public/mytools/mob/cover\\_letter.doc](https://development.standards.ieee.org/myproject/Public/mytools/mob/cover_letter.doc)] (Patent Tutorial, page 5.)

Identification can be made at any time

– Just inform the Working Group chair

– Whether in the meeting or otherwise (Patent Tutorial, page 8.)

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

### A. Participant disclosure process

Individual participants are obliged to disclose patents that are aware of and owned by the organization they work for or represent.

Individual participants are encouraged (but not required) to disclose patents that are aware of and owned by the organization they work for or represent. The encouragement is particularly strong for patents held by non-participants.

### B. Disclosure in LoA process

The LoA is only meant to disclose essential patents held by the assignee. If a party receives a

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request to submit a LoA but it does not believe to own essential IPR, it can declare that in the LoA.

### Sources and additional details:

See at question D1.

### 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?

#### A. Participant disclosure process

Disclosure here relates to the project that is the subject of the meetings in which the individual is participating.

#### B. Disclosure in LoA process

Disclosure here relates to the specific standard/project nr. that is specified in the LoA.

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

#### A. Participant disclosure process

Individual participants must disclose patents that are potentially essential.

#### B. Disclosure in LoA process

LoA's refer to patents it *may* own that *might be or become* essential patents.

### Sources and additional details:

In order for IEEE's patent policy to function efficiently, individuals participating in the standards development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any potential Essential Patent Claims of which they are personally aware and that are not already the subject of an existing Letter of Assurance, owned or controlled by the participant or the entity the participant is from, employed by, or otherwise represents; and (b) should inform the IEEE (or cause the IEEE to be informed) of any other holders of such potential Essential Patent Claims that are not already the subject of an existing Letter of Assurance. (SB Bylaws, at §6.2, Paragraph 12)

The Submitter may own, control, or have the ability to license Patent Claims that *might be or become* Essential Patent Claims. With respect to such Essential Patent Claims, the Submitter's licensing position is as follows [...]. (LoA form, at D option 1.)

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



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### A. Participant disclosure process

The disclosure policy (as in SB Bylaws § 6.2 para 12) refers to patents that the individual participant is “personally aware” of. There is no clarification of what knowledge that individual is supposed to possess.

### B. Disclosure in LoA process

The submitter of a LoA has good faith obligation when concluding that he owns no patents.

#### **Sources and additional details:**

In order for IEEE’s patent policy to function efficiently, individuals participating in the standards development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any potential Essential Patent Claims of which they are personally aware and that are not already the subject of an existing Letter of Assurance, owned or controlled by the participant or the entity the participant is from, employed by, or otherwise represents; and (b) should inform the IEEE (or cause the IEEE to be informed) of any other holders of such potential Essential Patent Claims that are not already the subject of an existing Letter of Assurance. (SB Bylaws, at §6.2, Paragraph 12)

The Submitter of the Letter of Assurance may, after Reasonable and Good Faith Inquiry, indicate it is not aware of any Patent Claims that the Submitter may own, control, or have the ability to license that might be or become Essential Patent Claims. If the patent holder or patent applicant provides an assurance, it should do so as soon as reasonably feasible in the standards development process once the PAR is approved by the IEEE-SA Standards Board. This assurance should be provided prior to the Standards Board’s approval of the standard. An asserted potential Essential Patent Claim for which an assurance cannot be obtained (e.g., a Letter of Assurance is not provided or the Letter of Assurance indicates that assurance is not being provided) shall be referred to the Patent Committee. (SB Bylaws, at §6.2)

[Definition of] “Reasonable and Good Faith Inquiry” includes, but is not limited to, a Submitter using reasonable efforts to identify and contact those individuals who are from, employed by, or otherwise represent the Submitter and who are known to the Submitter to be current or past participants in the development process of the [Proposed] IEEE Standard identified in a Letter of Assurance, including, but not limited to, participation in a Sponsor Ballot or Working Group. If the Submitter did not or does not have any participants, then a Reasonable and Good Faith Inquiry may include, but is not limited to, the Submitter using reasonable efforts to contact individuals who are from, employed by, or represent the Submitter and who the Submitter believes are most likely to have knowledge about the technology covered by the [Proposed] IEEE Standard. (SB Bylaws, at §6.1, definitions)

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

The policy states explicitly that no patent searches are required. This is true for both types of disclosure processes.

#### **Sources and additional details:**

Nothing in this policy shall be interpreted as giving rise to a duty to conduct a patent search. (SB Bylaws, at §6.2, paragraph 11)

Note: Nothing in this Letter of Assurance shall be interpreted as giving

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rise to a duty to conduct a patent search. (LoA form, at D.)

### 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?

Essential means there is no commercially and technically feasible non-infringing alternative. So it includes commercial essentiality.

It is on the basis of essential claims in patents, and it excludes claims in the same patent that are not essential.

#### Sources and additional details:

[Definition of] "Essential Patent Claim" 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. (SB Bylaws, at §6.1, definitions)

[Definition of] "Enabling Technology" 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). (SB Bylaws, at §6.1, definitions)

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).

#### A. Participant disclosure process

In this process, it follows from the standardization activity in which the individual is participating.

#### B. Disclosure in LoA process

In the LoA, there is an explicit part where the submitter specifies for which standards (or project number) the disclosed patents may be essential.

#### Sources and additional details:

In accordance with Clause 6.3.5 of the IEEE-SA Standards Board Operations Manual, this licensing position is limited to the following:  
Standard/Project Number... Title...: (LoA form, at C)

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

Optional normative clauses are explicitly included in the definition of essential patents.

### Sources and additional details:

[Definition of] “Essential Patent Claim” 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. (SB Bylaws, at §6.1, definitions)

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?

#### A. Participant disclosure process

This process does not define the content of the disclosures in much detail. In the most literal interpretation, only the name of the presumed holder of essential patents needs to be disclosed.

#### B. Disclosure in LoA process

There is an explicit option in the LoA to make a blanket disclosure. (Unless a submitter has selected option D2, the selection of option E2 means per definition that the submitter believes to own essential IPR and provides a blanket commitment (and blanket disclosure).

### Sources and additional details:

In order for IEEE’s patent policy to function efficiently, individuals participating in the standards development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any potential Essential Patent Claims of which they are personally aware and that are not already the subject of an existing Letter of Assurance, owned or controlled by the participant or the entity the participant is from, employed by, or otherwise represents; and (b) should inform the IEEE (or cause the IEEE to be informed) of any other holders of such potential Essential Patent Claims that are not already the subject of an existing Letter of Assurance. (SB Bylaws, at §6.2, Paragraph 12)

We found this sentence a bit strange, and believe that the mentioned “holder” is exactly the same as the “the participant or the entity [etc.]”.

[BOX TO TICK] When checked, this Letter of Assurance is a Blanket Letter of Assurance. As such, all Essential Patent Claims that the Submitter may currently or in the future have the ability to license shall be available under the terms as indicated above in part D.1; however, a Blanket Assurance shall not supersede any pre-existing or simultaneously submitted specific assurance identifying potential Essential Patent Claims. (LoA form, at E, option 2)

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[Definition of] "Blanket Letter of Assurance" shall mean a Letter of Assurance that applies to all Essential Patent Claims for which a Submitter may currently or in the future (except as otherwise provided for in these Bylaws and in the IEEE-SA Standards Board Operations Manual) have the ability to license. (SB Bylaws, at §6.1, definitions)

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?

Disclosure rules include applications, and implicitly also unpublished patent applications. (Similar to both disclosure processes as this is in the definition part of the policy).

IEEE has a 'patent' policy (not an 'IPR' policy). Non-patent IPR is not discussed anywhere.

### Sources and additional details:

[Definition of] "Patent Claim(s)" shall mean one or more claims in issued patent(s) or pending patent application(s). (SB Bylaws, at §6.1, definitions)

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

### A. Participant disclosure process

Not specified in the policy.

### B. Disclosure in LoA process

Not specified in the policy.

### 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?

### A. Participant disclosure process

No forms are available.

### B. Disclosure in LoA process

Yes, this disclosure goes via de AoL form that is discussed in Question D4.

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?

### A. Participant disclosure process

Not applicable.

### B. Disclosure in LoA process

A party that has submitted a LoA and later becomes aware of newer or other patents, it must submit an additional LoA for those new patents.

#### **Sources and additional details:**

If, after providing a Letter of Assurance to the IEEE, the Submitter becomes aware of additional Patent Claim(s) not already covered by an existing Letter of Assurance that are owned, controlled, or licensable by the Submitter that may be or become Essential Patent Claim(s) for the same IEEE Standard but are not the subject of an existing Letter of Assurance, then such Submitter shall submit a Letter of Assurance stating its position regarding enforcement or licensing of such Patent Claims. For the purposes of this commitment, the Submitter is deemed to be aware if any of the following individuals who are from, employed by, or otherwise represent the Submitter have personal knowledge of additional potential Essential Patent Claims, owned or controlled by the Submitter, related to a [Proposed] IEEE Standard and not already the subject of a previously submitted Letter of Assurance: (a) past or present participants in the development of the [Proposed] IEEE Standard, or (b) the individual executing the previously submitted Letter of Assurance. (SB Bylaws, at 6.2, paragraph 8)

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?

This is essentially the A. Participant disclosure process discussed above.

The chairman shall record in minutes any response to the call for patents. We have no information on who has access to these minutes (The participants of the WG? All IEEE members? The public?)

#### **Sources and additional details:**

The chair or the chair's delegate shall ask any patent holder or patent applicant of a Patent Claim that might be or become an Essential Patent Claim to complete and submit a Letter of Assurance in accordance with Clause 6 of the IEEE-SA Standards Board Bylaws. Information about the draft standard will be made available upon request. (Operations Manual, at §6.3.2)

- Call shall be made at every standards-development meeting
- Working Group, Task Force, Task Group, Ad Hoc, conference calls
  - Working Group chair or designee makes the call
    - State that if an individual believes a patent claim might be an Essential Patent Claim, such individual should make the Working Group aware of this
  - Record in minutes that call for patents was made

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### – Record in minutes any response

- When informed, Working Group chair shall contact holder requesting an LOA
- Sample letter provided at <http://standards.ieee.org/about/sasb/patcom/index.html> • [[https://development.standards.ieee.org/myproject/Public/mytools/mob/cover\\_letter.doc](https://development.standards.ieee.org/myproject/Public/mytools/mob/cover_letter.doc)] (Patent Tutorial, page 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?

### A. Participant disclosure process

See previous question.

### B. Disclosure in LoA process

Published LoA's are available at <http://standards.ieee.org/about/sasb/patcom/patents.html> (see also Question D18 for details).

### **Sources and additional details:**

Copies of an Accepted LOA may be provided to the working group, but shall not be discussed, at any standards working group meeting. (Operations Manual §6.2 paragraph 6)

Upon written request, the IEEE will make available copies of any Accepted Letter of Assurance and its attachments. Letters received after 31 December 2006 shall be posted on the IEEE-SA website. (Operations Manual §6.3 paragraph 3)

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 provides no information on this.

## **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.

If the IEEE receives notice that a [Proposed] IEEE Standard may require the use of a potential Essential Patent Claim, the IEEE shall request licensing assurance from the patent holder or patent applicant. The IEEE shall request this assurance without coercion.

Does the IEEE send out a request for a LoA for a specific standard (and does not require to report patents or make licensing obligations for any other standard), or is it a general request covering any IEEE standard?

The suspected SEP holder can then submit the LoA form in which it can provide:

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- Assurance that Essential Patent Claims will not be enforced
- Assurance that Essential Patent Claims will be licensed at FRAND-z
- Assurance that Essential Patent Claims will be licensed at royalty bearing FRAND
- A statement that Submitter is unable or unwilling to grant license

At its sole option, Submitter may include (see also at Question D16 on ex-ante)

- Not-to-exceed rates
- Sample license agreement
- Material licensing terms

The LoA is either a blanket assurance (including all current and future essential patents for the standard in question), or specifically identifies the patents (and optionally claims) for which the commitment is made.

### Sources and additional details:

IEEE standards may be drafted in terms that include the use of Essential Patent Claims. If the IEEE receives notice that a [Proposed] IEEE Standard may require the use of a potential Essential Patent Claim, the IEEE shall request licensing assurance, on the IEEE Standards Board approved Letter of Assurance form, from the patent holder or patent applicant. The IEEE shall request this assurance without coercion. (SB Bylaws, at §6.2)

A Letter of Assurance shall be either:

- a) A general disclaimer to the effect that the Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling, offering to sell, importing, distributing, or implementing a compliant implementation of the standard; or Quotes from policy
- b) A statement that a license for a compliant implementation of the standard will be made available to an unrestricted number of applicants on a worldwide basis without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination. At its sole option, the Submitter may provide with its assurance any of the following: (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more material licensing terms. (SB Bylaws, at §6.2)

The Submitter is unwilling or unable to grant licenses according to the provisions of either a or b above or to agree that it will not enforce its Essential Patent Claims as described in c above. (LoA form, at D, option 1D) This option is not mentioned in SB Bylaws, see also below.

[Definition of] "Accepted Letter of Assurance" and "Accepted LOA" shall mean a Letter of Assurance that the IEEE-SA has determined is complete in all material respects and has been posted to the IEEE-SA web site. (SB Bylaws, at §6.1, definitions)

[Definition of] "Blanket Letter of Assurance" shall mean a Letter of Assurance that applies to all Essential Patent Claims for which a Submitter may currently or in the future (except as otherwise provided for in these Bylaws and in the IEEE-SA Standards Board Operations Manual) have the ability to license. (SB Bylaws, at §6.1, definitions) See also the LoA Form for the blanket assurance.

"Letter of Assurance" and "LOA" shall mean a document, including any attachments, stating the Submitter's position regarding ownership, enforcement, or licensing of Essential Patent Claims for a specifically referenced IEEE Standard, submitted in a form acceptable to the IEEE-SA. (SB Bylaws, at §6.1, definitions)

[Definition of] "Submitter" when used in reference to a Letter of Assurance shall mean an individual or an organization that provides a completed Letter

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of Assurance. A Submitter may or may not hold Essential Patent Claims. (SB Bylaws, at §6.1, definitions)

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.

A LoA should be submitted soon as reasonably feasible in the standards development process once the PAR is approved by the IEEE-SA Standards Board.

This assurance should be provided prior to the Standards Board's approval of the standard. this.

### Sources and additional details:

The Submitter of the Letter of Assurance may, after Reasonable and Good Faith Inquiry, indicate it is not aware of any Patent Claims that the Submitter may own, control, or have the ability to license that might be or become Essential Patent Claims. If the patent holder or patent applicant provides an assurance, it should do so as soon as reasonably feasible in the standards development process once the PAR is approved by the IEEE-SA Standards Board. This assurance should be provided prior to the Standards Board's approval of the standard. An asserted potential Essential Patent Claim for which an assurance cannot be obtained (e.g., a Letter of Assurance is not provided or the Letter of Assurance indicates that assurance is not being provided) shall be referred to the Patent Committee. (SB Bylaws, at §6.2)

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, the policy is identical for any working group or standard.

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

Yes, there is a form and the use of that form is obligatory (also because it is also a written agreement that binds the submitter to a number of clauses about patent transfer and other obligations, that otherwise might not have been binding).

Letter of Assurance form is the only acceptable template; "Free form" letters will no longer be accepted.

Modified Letter of Assurance form will not be accepted. In case that sample licensing conditions or other documents are attached to the LoA that are incompatible with the commitment indicated in the LoA, the commitment will prevail.

### Sources and additional details:

- Patent Letter of Assurance (LOA) Form, <https://development.standards.ieee.org/myproject/Public/mytools/mob/loa.pdf>. Further referred to as LoA Form.
- Patent Letter of Assurance (LOA) Cover Letter (the letter that a chair can send to a party



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it suspects to own SEP)

[https://development.standards.ieee.org/myproject/Public/mytools/mob/cover\\_letter.doc](https://development.standards.ieee.org/myproject/Public/mytools/mob/cover_letter.doc)

- Letter of Assurance form is the only acceptable template
- Modified Letter of Assurance form will not be accepted • Filling in the form is not considered a modification
- „Free form“ letters will no longer be accepted (Patent Tutorial, page 13.)

To the extent there are inconsistencies between the Letter of Assurance Form and any sample licenses, material licensing terms, or not to exceed rates provided in connection with 1.a. or 1.b. below, the terms of the Letter of Assurance Form shall control. (LoA form, front page)

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

To any implementer.

This is explicit for the non-assert covenant ('against any person or entity'), but implicit also for the other licensing options.

### Sources and additional details:

A Letter of Assurance shall be either:

a) A general disclaimer to the effect that the Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling, offering to sell, importing, distributing, or implementing a compliant implementation of the standard; or Quotes from policy

b) A statement that a license for a compliant implementation of the standard will be made available to an unrestricted number of applicants on a worldwide basis without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination. At its sole option, the Submitter may provide with its assurance any of the following: (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more material licensing terms. (SB Bylaws, at §6.2)

1. The Submitter may own, control, or have the ability to license Patent Claims that might be or become Essential Patent Claims. With respect to such Essential Patent Claims, the Submitter's licensing position is as follows (must check a, b, c, or d and any applicable subordinate boxes):

a. The Submitter will grant a license without compensation to an unrestricted number of applicants on a worldwide basis with reasonable terms and conditions that are demonstrably free of unfair discrimination. (Optional) A sample of such a license (or material licensing terms) that is substantially similar to what the Submitter would offer is attached.

b. The Submitter will grant a license under reasonable rates to an unrestricted number of applicants on a worldwide basis with reasonable terms and conditions that are demonstrably free of unfair discrimination. (Optional) These reasonable rates will not exceed \_\_\_\_\_ (e.g., percent of product price, flat fee, per unit). (Optional) A sample of such a license (or material licensing terms) that is substantially similar to what the Submitter would offer is attached.

c. The Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling,

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offering to sell, importing, distributing, or implementing such a compliant implementation.

d. The Submitter is unwilling or unable to grant licenses according to the provisions of either a or b above or to agree that it will not enforce its Essential Patent Claims as described in c above.

2. After a Reasonable and Good Faith Inquiry, the Submitter is not aware of any Patent Claims that the Submitter may own, control, or have the ability to license that might be or become Essential Patent Claims. (LoA form, at D)

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 minimum commitment is RAND, but the policy also offers explicit options where the patent owners indicates willingness to license at RAND-RF, or not to assert patents.

Commitment types do not depend on working group or standardization activity.

### Sources and additional details:

A Letter of Assurance shall be either:

a) A general disclaimer to the effect that the Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling, offering to sell, importing, distributing, or implementing a compliant implementation of the standard; or Quotes from policy

b) A statement that a license for a compliant implementation of the standard will be made available to an unrestricted number of applicants on a worldwide basis without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination. At its sole option, the Submitter may provide with its assurance any of the following: (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more material licensing terms. (SB Bylaws, at §6.2)

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?

In its LoA, a submitter can indicate that it is unwilling or unable to grant licenses according to the sought conditions. It can also limit its commitment to specified, identified patents only.

It was not clear to use that when a submitter chooses to use option E1 in the LoA form, and provides patent identities, it can be assumed that the specified patents indeed include ALL essential patents that the submitter believes to own? Could it also own other patents, perhaps even patents it is not willing or able to license?

The option for a LoA submitter to declare that it is unwilling or unable to grant licenses is present in the LoA form, but does not seem to be mentioned anywhere in the IPR Policy (SB Bylaws) itself. Is there a reason for this?

### Sources and additional details:

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The Submitter is unwilling or unable to grant licenses according to the provisions of either a or b above or to agree that it will not enforce its Essential Patent Claims as described in c above. (LoA form, at D, option 1D)

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?

The policy has no explicit provisions related to reciprocity, or to any other specific condition that licensors may include in their contracts.

We assume that it would be up the interpretation of a judge or other appropriate authority to judge whether various forms of reciprocity or any other conditions meet the requirements of 'fair, reasonable and non-discriminatory' or not.

### Sources and additional details:

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?

The commitment covers any essential patents for the specified standards, unless the submitter has opted to provide specific patent identities. In the latter case, the commitment is only for those identified standards.

See also question D9

### Sources and additional details:

The Submitter may, but is not required to, identify one or more of its Patent Claims that it believes might be or become Essential Patent Claims. (Submitter must check box 1 or box 2 below)

1. When checked, this Letter of Assurance only applies to the Patent Claims identified below that are or become Essential Patent Claims. (If no Patent Claim is identified below, then this Letter of Assurance applies to all Essential Patent Claims supported by the disclosure in the patent or patent applications listed below.) (LoA form, at E)

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)

It seems not to be bound. The text below "with respect to such Essential Patent Claims" refers to the definition of this term (it is written in capitals) and this is a definition of being actually essential.

### Sources and additional details:

The Submitter may own, control, or have the ability to license Patent Claims that might be or become Essential Patent Claims. With respect to such Essential Patent Claims, the Submitter's licensing position is as follows [...]. (LoA form, at D option 1.)

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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)?

If a party elects to make a FRAND or FRAND-RF commitment, it is word wide by definition (explicit in policy).

If a party elects to make non-assert commitment, it seems to be a word wide commitment (implicit in policy).

### Sources and additional details:

A Letter of Assurance shall be either:

a) A general disclaimer to the effect that the Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling, offering to sell, importing, distributing, or implementing a compliant implementation of the standard; or Quotes from policy

b) A statement that a license for a compliant implementation of the standard will be made available to an unrestricted number of applicants on a worldwide basis without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination. At its sole option, the Submitter may provide with its assurance any of the following: (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more material licensing terms. (SB Bylaws, at §6.2)

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?

This is only explicitly stated for the non-assert option. For all the other licensing commitments, this is not explicitly stated, although one might argue that this was the intent of the makers of the policy. The LoA form, at Item C, states that the commitment is limited to a specific standard, but this is not exactly the same to say that the licensing as such is only for implementing those features that are required to comply to the standard.

### Sources and additional details:

1. The Submitter may own, control, or have the ability to license Patent Claims that might be or become Essential Patent Claims. With respect to such Essential Patent Claims, the Submitter's licensing position is as follows (must check a, b, c, or d and any applicable subordinate boxes):

a. The Submitter will grant a license without compensation to an unrestricted number of applicants on a worldwide basis with reasonable terms and conditions that are demonstrably free of unfair discrimination. (Optional) A sample of such a license (or material licensing terms) that is substantially similar to what the Submitter would offer is attached.

b. The Submitter will grant a license under reasonable rates to an unrestricted number of applicants on a worldwide basis with reasonable terms and conditions that are demonstrably free of unfair discrimination. (Optional) These reasonable rates will not exceed \_\_\_\_\_ (e.g., percent of product price, flat fee, per unit). (Optional) A sample of such a license (or material licensing terms) that is

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substantially similar to what the Submitter would offer is attached.

c. The Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling, offering to sell, importing, distributing, or implementing such a compliant implementation.

d. The Submitter is unwilling or unable to grant licenses according to the provisions of either a or b above or to agree that it will not enforce its Essential Patent Claims as described in c above.

2. After a Reasonable and Good Faith Inquiry, the Submitter is not aware of any Patent Claims that the Submitter may own, control, or have the ability to license that might be or become Essential Patent Claims. (LoA form, at D)

In accordance with Clause 6.3.5 of the IEEE-SA Standards Board Operations Manual, this licensing position is limited to the following:

Standard/Project Number... Title...: (LoA form, at C)

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.)

The policy provides no information on this.

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)?

The policy explicitly states that licensing commitments are irrevocable. .

In the Operations Manual (§6.3, paragraph 3) it is explained that older LoA will (might) not be posted on the website age. These that are not posted will not meet the literal definition of an "accepted letter of assurance" in the Bylaws and one could argue that then also the requirement or irrevocability does not hold for such assurances. Is this intended?

### Sources and additional details:

The assurance is irrevocable once submitted and accepted and shall apply, at a minimum, from the date of the standard's approval to the date of the standard's transfer to inactive status. (SB Bylaws, at §6.2, paragraph 9)

Upon written request, the IEEE will make available copies of any Accepted Letter of Assurance and its attachments. Letters received after 31 December 2006 shall be posted on the IEEE-SA website. (Operations Manual at §6.3, paragraph 3).

[Definition of] "Accepted Letter of Assurance" and "Accepted LOA" shall mean a Letter of Assurance that the IEEE-SA has determined is complete in all material respects and has been posted to the IEEE-SA web site. (SB Bylaws, at §6.1, definitions)

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

In IEEE, a submitter of an LoA agrees to:

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1. Notify the new owner that the patent in question is encumbered by a commitment.
2. Require the new owner to take on the same notification requirement to any subsequent owner.

If a party that submitted a blanket LoA acquires a new essential patent, then that patent will be under the same commitment as in the blanket LoA.

Our understanding is that the submitter of a LoA MAY bind its assignee to the terms of the existing Letter of Assurance, but is not required to do so. So the obligation is not necessarily transferred:

The Submitter of a Letter of Assurance shall agree

(a) to provide notice of a Letter of Assurance either through a Statement of Encumbrance **or** by binding any assignee or transferee to the terms of such Letter of Assurance;

**and** (b) to require its assignee or transferee to (i) agree to similarly provide such notice **and** (ii) to bind its assignees or transferees to agree to provide such notice as described in (a) and (b). (SB Bylaws, at §6.2, paragraph 6)

There seems to be some ambiguity to whether the Statement of Encumbrance as such would perhaps bind its assignee to the terms of the existing Letter of Assurance, but we feel that the language there is too 'open' to assume this is the case. Our view seems backed by the explanatory text in the Patent Tutorial.

It was not clear top us to degree does IEEE need to be informed about such transfers (and its specific as to whether or not commitments are transferred)? Is the new patent owner expected to send an LoA? (The policy does not seem to require this.)

### Sources and additional details:

The Submitter of a Letter of Assurance shall agree (a) to provide notice of a Letter of Assurance either through a Statement of Encumbrance or by binding any assignee or transferee to the terms of such Letter of Assurance; and (b) to require its assignee or transferee to (i) agree to similarly provide such notice and (ii) to bind its assignees or transferees to agree to provide such notice as described in (a) and (b). (SB Bylaws, at §6.2, paragraph 6)

Although the above does not state whom needs to be notified, this can be understood from the definition of the statement of encumbrance:

"Statement of Encumbrance" shall mean a specific reference to an Accepted LOA or a general statement in the transfer or assignment agreement that the Patent Claim(s) being transferred or assigned are subject to any encumbrances that may exist as of the effective date of such agreement. An Accepted LOA is an encumbrance. (Bylaws Subclause 6.1, Para 10)

In the Patent Tutorial, it is summarized as follows:

Submitter agrees to:

- Notify assignees/transferees of the existence of assurance
  - Either through stating in the agreement to assign/transfer
    - The existence of a specific LOA
    - Or by a general statement
  - Or binding assignees/transferees to LOA
- Require the assignee/transferee to agree to similarly provide notice to subsequent assignee/transferee
  - Sets up a cascading notice requirement (Patent Tutorial, page 18.)

If, after providing a Blanket Letter of Assurance, the Submitter acquires an

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Essential Patent Claim or a controlling interest in an entity that owns or controls an Essential Patent Claim, the existing Submitter's Blanket Letter of Assurance shall apply to such acquired Essential Patent Claims unless the acquired entity or the prior holder of the acquired Essential Patent Claim has submitted a Letter of Assurance before the acquisition. Any Blanket Letter of Assurance submitted by the acquired entity or the prior holder of the acquired Essential Patent Claim before the acquisition shall continue to apply to acquired Essential Patent Claims covered by such assurance (but not to the acquirer's Essential Patent Claims). Letters of Assurance covering specified Essential Patent Claims shall continue to apply to specified Essential Patent Claims, whether acquired in the acquisition or held by the acquirer before the acquisition, as provided in this Operations Manual. Nothing in this paragraph shall prevent an acquiring party from asking a seller of an acquired Essential Patent Claim or an acquired entity to submit additional Letters of Assurance before closing of the acquisition. (Operations Manual at §6.3.4, paragraph 3).

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

The policy explicitly gives parties that issue a LoA an option to provide (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more material licensing terms.

This is a voluntary choice, though.

The IEEE policy confirms that the relative costs of different technical approaches - including licensing fees of essential patents - may be discussed and may impact the decisions taken. As explained above, IPR holders have the option to inform IEEE about the maximum or actual fees they would be charging. Also, the publicly available declarations at IEEE clearly show which patents will be available at RAND-RF, and which patents may only be available at a royalty-bearing basis. As expressed by IEEE: "The more information the better when selecting between proposals (Patent Tutorial, page 8.).

At the same time, IEEE provides appropriate safeguards to ensure discussions in working groups do not lead to antitrust concerns. One may not coerce a licensing holder that has chosen not to provide information about fees, and also the price at which a compliant product would be sold may not be discussed.

### Sources and additional details:

A Letter of Assurance shall be either: [...] b) A statement that a license for a compliant implementation of the standard will be made available to an unrestricted number of applicants on a worldwide basis without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination. At its sole option, the Submitter may provide with its assurance any of the following: (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more material licensing terms. (SB Bylaws, at §6.2)

**5.3.10.3 Discussion of relative cost/benefit analyses:** When comparing different technical approaches in IEEE-SA standards development technical activities, participants may discuss the relative costs (in terms, for example, of percentage increases or decreases) of different proposed technical approaches in comparison with the relative technical performance increases or decreases of those proposals. The relative costs may include any potentially Essential Patent Claims, but not the price at which compliant products may or will be sold. Technical considerations should be the main focus of discussions in IEEE-SA standards development technical activities. (IEEE-SA Standards Board Operations Manual Subclause 5.3.10)

Copies of an Accepted LOA may be provided to the working group, but shall not be discussed, at any standards working group meeting. (SB Bylaws, at §6.2)

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Early assurance is encouraged and expected— The more information the better when selecting between proposals ([Patent Tutorial, page 8.](#))

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

In 2008, IEEE and Vialicensing entered into a 2-year cooperation.

<http://www.ieee.org/about/news/2008/8dec.html>

Public sources reported that the aim was to set up pools ‘soon after standards were issued’, and that the participation in pools would be voluntary. <http://www.eetimes.com/electronics-news/4080218/IEEE-joins-move-to-patent-pools>

### Sources and additional details:

See also:

<http://news.softpedia.com/news/IEEE-and-Via-Licensing-Announce-Move-to-Patent-Pools-99643.shtml>

[http://www.pcworld.com/article/155111/ieee\\_to\\_set\\_up\\_patent\\_pools\\_to\\_simplify\\_standards\\_adoption.html](http://www.pcworld.com/article/155111/ieee_to_set_up_patent_pools_to_simplify_standards_adoption.html)

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?

A list of published LoA's is at <http://standards.ieee.org/about/sasb/patcom/patents.html>

While the policy states that at least all LoA received after 31 December 2006 are on the IEEE-SA website, the current version of the website suggest that all LoAs from 1993 on are now available, as well as some older ones.

### Sources and additional details:

Copies of an Accepted LOA may be provided to the working group, but shall not be discussed, at any standards working group meeting. ([Operations Manual §6.2 paragraph 6](#))

Upon written request, the IEEE will make available copies of any Accepted Letter of Assurance and its attachments. Letters received after 31 December 2006 shall be posted on the IEEE-SA website.

([Operations Manual §6.3 paragraph 3](#))

- Accepted LOA can be distributed in meetings
- But remember:
  - Don't discuss interpretation, validity, or essentiality of patents/patent claims
  - Don't discuss specific license rates, terms, or conditions
- LOAs received after 31 Dec 2006 will be made available on web
- Existing LOAs available by contacting PatCom Administrator
  - Activity underway to add these to web as well ([Patent Tutorial, page 10](#))

It was first compiled in 1993 to provide information about the known patents that may affect the practice of IEEE Standards. Information about LOAs from 1993 forward have been posted. Some LOAs received prior to 1993 have also been included (others may only be available in archived IEEE files). ([from the web page where the LoA are made public, at](#)



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<http://standards.ieee.org/about/sasb/patcom/patents.html>

### 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)?

We have not seen anything in the policy on this, although it could be in one of the other, more general documents than the SB Bylaws.

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

In such a case, the Patent Committee (PatCom) will be involved and will advise the IEEE-SA Standards Board.

The policy does not elaborate on what PATCOM can decide, and what its considerations will be.

#### Sources and additional details:

An asserted potential Essential Patent Claim for which an assurance cannot be obtained (e.g., a Letter of Assurance is not provided or the Letter of Assurance indicates that assurance is not being provided) shall be referred to the Patent Committee. (SB Bylaws, at §6.2 paragraph 2)

- If there is no LOA for an asserted potential Essential Patent Claim:
  - Inform IEEE-SA Standards Board Patent Committee (PatCom)
- PatCom will consider
  - May make recommendation to IEEE-SA Standards Board
  - Ultimately IEEE-SA Standards Board will decide

(Patent Tutorial, p. 9)

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?

See above.

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?

The policy determines that the PatCom performs check submissions on material aspects m signed by a person that has a clear authority to do so, etc.

#### Sources and additional details:

Letters of Assurance are to be e-mailed, faxed, or mailed to the IEEE Standards Association (to the attention of the PatCom Administrator). The PatCom Administrator shall accept each Letter of Assurance that is complete and is received from an individual within the issuing organization whose title suggests authority for intellectual property and legal matters. The

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PatCom Administrator's duties with regard to Letters of Assurance shall be purely ministerial (i.e., without regard to or exercise of the PatCom Administrator's discretion regarding the content of the Letters of Assurance received). For each Accepted Letter of Assurance, the PatCom Administrator shall record the date on the signed Letter of Assurance and the date upon which the IEEE accepted such. (Operations Manual, §6.3 paragraph 2)

- LOA irrevocable once submitted and accepted
  - Accepted by PatCom Administrator
  - Accepted when
    - IEEE-SA determines LOA form is complete in all material respects
    - And LOA has been posted to web site <http://standards.ieee.org/about/sasb/patcom/patents.html>
  - LOA must be signed by person with clear authority
    - If not, Submitter will be contacted for confirmation
  - LOA applies at a minimum from Standards approval to transfer to inactive status (Patent Tutorial, page 22.)

### 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.

The parts of the policy we examined provided no information on this. But it could be in one of the other, more general documents than the SB Bylaws.

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.)

IEEE has a 'patent' policy (not an 'IPR' policy). Non-patent IPR is not discussed anywhere.

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.

### Other

It is explicitly mentioned that a licensing commitment does not imply a license.

#### Sources and additional details:

No license is implied by the submission of a Letter of Assurance. (SB Bylaws, at §6.2, paragraph 11)

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No license is implied by submission of this Letter of Assurance ([LoA form, at top](#))

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