

Analysis of the IPR policy of ANSI

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.

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.

Note: we acknowledge that ANSI is not an SDO as such. In the main report, more attention is paid to the consequences of that observation. Nevertheless, for the purpose of this analysis, we try as much as possible to reflect on an ANSI-accredited SDO that implements the 'minimum' IPR requirements by ANSI. (As a matter of fact, quite some ANSI-accredited SDOs simply copy the ANSI text into their own rules.

Part A: Adoption and general aspects of 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?

The most recent version of the ANSI patent policy is defined in Section 3.1 of the following document: **ANSI Essential Requirements: Due process requirements for American National Standards**. Edition: January 2012.¹. Below we will simply refer to **ANSI Essential Requirements**

Further clarifications are offered in the Guidelines (which are explained to be 'suggestions' and adherence is not obligatory): **Guidelines for Implementation of the ANSI Patent Policy: An Aid to**

¹ Available from

http://publicaa.ansi.org/sites/apdl/Documents/Standards%20Activities/American%20National%20Standards/Procedures,%20Guides,%20and%20Forms/2012%20ANSI%20Essential%20Requirements%20and%20Other%20Updated%20Procedures/2012_ANSI_Essential_Requirements.pdf

Supplement 4 - Analysis of the IPR policy of ANSI

More Efficient and Effective Standards Development In Fields That May Involve Patented Technology. Revised February 2011.² Earlier versions were published in February 2007³, in 1997⁴ and September 1991⁵. Below we will simply refer to **ANSI Guidelines**.

Earlier versions of the ANSI Patent Policy date back to 1932 and earlier versions of the ANSI Guidelines date back to 1991.

Also relevant are the ANSI Constitution and By-laws, which define the role of the Intellectual Property Rights Policy Committee (IPRPC) (see also Question B1 below).

There is a separate document on Software in standards: *ANSI Guidelines on Software in Standards*, published in 2008, available at <http://publicaa.ansi.org/sites/apdl/Documents/Standards%20Activities/American%20National%20Standards/Procedures,%20Guides,%20and%20Forms/ANSI%20Guidelines%20on%20Software%20in%20Standards.pdf>

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

An ANSI representative clarified: *“There have been a number of changes made to the ANSI Patent Policy over a number of years driven by many things. Currently the IPRPC is responsible for suggesting changes to the Patent Policy and there are currently ongoing discussions within IPRPC Task Groups on a number of topics. The latest change to the ANSI Patent Policy occurred in 2008. See:*

<http://publicaa.ansi.org/sites/apdl/Documents/Standards%20Activities/American%20National%20Standards/Procedures,%20Guides,%20and%20Forms/ANSI%20Patent%20Policy%20-%20Revised%202008.pdf>

The approved changes were to: (1) remove the ambiguity in the Patent Policy created by the reference to “identified party” in section 3.1.1 and to clarify that an assurance shall be received either from the patent holder or someone authorized to make an assurance on its behalf; and (2) make clear in the same section of the Policy that the assurance can be received in either written or electronic form.”

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 ANSI’s repository for its IPR policy⁶, there is a reference for “Supporting Documentation: Survey on the Sufficiency of the ANSI Patent Policy”. I was not able to locate that document.

² Available from:

<http://publicaa.ansi.org/sites/apdl/Documents/Standards%20Activities/American%20National%20Standards/Procedures,%20Guides,%20and%20Forms/Guidelines%20for%20Implementation%20of%20ANSI%20Patent%20Policy%202011.pdf>

³ Available from: <http://publicaa.ansi.org/sites/apdl/Reference%20Documents%20Regarding%20ANSI%20Patent%20Policy/63-Guidelines%20for%20Implementation%20of%20Patent%20Policy%20June%202007%20edited.pdf>

⁴ <http://publicaa.ansi.org/sites/apdl/Reference%20Documents%20Regarding%20ANSI%20Patent%20Policy/25-Apr1997GuidelinesWithRevisedANSIPatentPolicyExhibitA.pdf>

⁵ <http://publicaa.ansi.org/sites/apdl/Reference%20Documents%20Regarding%20ANSI%20Patent%20Policy/12-GuidelinesImplementaionANSIPatentPolicySept1991.pdf>

⁶ <http://publicaa.ansi.org/sites/apdl/Documents/Forms/DispForm.aspx?ID=1986&Source=http%3A%2F%2Fpublicaa%2Eansi%2Eorg%2Fsites%2Fapdl%2FDocuments%2FForms%2FAllItems%2Easpx%3FRootFolder%3D%252Fsites%252Fapdl%252FDocuments%252FNews%2520and%2520Publications%252FLinks%2520Within%2520Stories%26SortField%3DLinkFilename%26SortDir%3DAsc%26View%3D%257B21C60355%2DAB17%2D4CD7%2DA090%2DBABEEC5D7C60%257D&RootFolder=%2Fsites%2Fapdl%2FDocuments%2FNews%20and%20Publications%2FLinks%20Within%20Stories>

<http://publicaa.ansi.org/sites/apdl/Reference%20Documents%20Regarding%20ANSI%20Patent%20Policy/Forms/AllItems.aspx>

An ANSI representative clarified: *“The link referenced in footnote 6 leads to a copy of the ANSI Patent Policy that accompanied an online news article asking ANSI members to take part in a survey. The survey is not in the public library. Any current discussion regarding the patent policy would take place in the IPRPC, which has password-protected documents and are not made publically available unless otherwise specified by the committee.”*

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)?

ANSI is a special case, as it is not a standards body itself. Instead, ANSI accredits other standards bodies (ASD: ANSI-accredited standards developer) and, under the conditions their standards meet certain criteria, can give these standards the American National Standards (ANS) status.

ANSI has a patent policy and it stipulated that all accredited standards developer (ASD) needs to have a policy that is compliant with that one. Such policies may be more detailed and may require additional obligations from the participants / members, but need at least to include the ANSI policy stipulations.

The legal foundation of ANSI-accredited standards developers may differ (membership structure, other structure).

Note that the above requirement of compliance is insofar the ASD developers American National Standards (ANS). For other standards, that are not to become ANS, they are free to develop standards that are not ANSs in accordance with their own procedures, including a patent policy that is different from ANSI's.

Sources and additional details:

Every ANSI-Accredited Standards Developer (ASD) shall comply with the normative policies contained in this section. The ASD may choose to: 1) include the text that follows, as appropriate, in their accredited procedures along with any additional information as required; or 2) submit to ANSI a written statement of full compliance with these policies in addition to policy statements that satisfy the requirements set-forth in this section. (ANSI Essential Requirements, §3.0)

The Intellectual Property Rights Policy Committee (IPRPC). The Intellectual Property Rights Policy Committee shall be responsible for broad-based policy and position decisions regarding national, regional and international intellectual property matters, including the global trade aspects of such matters (except as otherwise delegated by the Board to another body or to the extent such decision would significantly change or affect the strategic direction of the Institute or the federation). The Intellectual Property Rights Policy Committee shall also be responsible for developing Institute positions on issues relating to the incorporation of essential patents or other proprietary intellectual property in national, regional or international standards and for developing Institute positions relating to exploitation rights to the copyright in standards and the recognition of copyright protection for standards by courts, legislation, regulatory bodies, industry and others. (ANSI Status and By-laws, Section 6.05).

Supplement 4 - Analysis of the IPR policy of ANSI

An ANSI representative clarified: “ASDs (i.e., SDOs accredited by ANSI) must have a compliant patent policy in place for ANSs. They are free to develop standards that are not ANSs in accordance with their own procedures, including a patent policy that is different from ANSI’s. ANSI would have no jurisdiction over such non-ANS activities.”

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

This depends on the organization of the ANSI-accredited standards developer in question. See Question B1, above.

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

This depends on the organization of the ANSI-accredited standards developer in question. See Question B1, above.

Unlike most other SDO’s the ANSI patent policy underlines that patented technology should only be considered to part of a standard “if it is considered that technical reasons justify this approach”.

Sources and additional details:

There is no objection in principle to drafting an American National Standard (ANS) in terms that include the use of an essential patent claim (one whose use would be required for compliance with that standard) if it is considered that technical reasons justify this approach. (ANSI Essential Requirements, §3.0)

Part C: Patent disclosure

Patent disclosure, general

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

In the ANSI policy itself, there is no obligation to disclose essential patents, though ANSI-accredited standards developers are encouraged to add elements to their policy that would promote disclosure – yet does not specify whether this should or could be an obligatory element.

Drafted by a task force formed by ANSI for the purpose of studying the Patent Policy, the Guidelines seek to encourage the early disclosure and identification of patents that may relate to standards under development, so as to thereby promote greater efficiency in standards development practices. (Guidelines, at I)

Generally, it is desirable to encourage disclosure of as much information as possible concerning the patent, including the identity of the patent holder, the patent’s number, and information regarding precisely how it may relate

Supplement 4 - Analysis of the IPR policy of ANSI

to the standard being developed. Further, to assist in international standardization, a standards developer may deem it appropriate to encourage the disclosure of relevant unexpired foreign patents. (Guidelines, at IIIA)

Similarly, a standards developer may wish to encourage participants to disclose the existence of pending U.S. patent applications relating to a standard under development. Of course, in such a situation the extent of any disclosure may be more circumscribed due to the possible need for confidentiality and uncertainty as to whether an application will mature into a patent and what its claimed scope will ultimately be. (Guidelines, at IIIA)

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).

The policy provides no information on this.

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.)?

Parties are encouraged to do so at an early stage. At the same time, it is understood that only at the time a standard is sufficiently mature, a party may be able to

Sources and additional details:

Drafted by a task force formed by ANSI for the purpose of studying the Patent Policy, the Guidelines seek to encourage the early disclosure and identification of patents that may relate to standards under development, so as to thereby promote greater efficiency in standards development practices. (Guidelines, at I)

Experience has indicated that early disclosure of essential patents or essential patent claims is likely to enhance the efficiency of the process used to finalize and approve standards. *Early disclosure* permits notice of such patent claims to the standards developer and ANSI in a timely manner, provides participants the greatest opportunity to evaluate the propriety of standardizing the patented technology, and allows patent holders and prospective licensees ample time to negotiate the terms and conditions of licenses outside the standards development process itself. (Guidelines, at IIIA)

The early identification of relevant essential patents or essential patent claims should also increase the likelihood of an early indication from the patent holder that it is willing to license its invention, that it is prepared to do so on reasonable terms and conditions demonstrably free of unfair discrimination, or that the patent in question is not required for compliance with the proposed standard. A patent holder may have a strong incentive to provide an early assurance that the terms and conditions of the license will be reasonable and demonstrably free of unfair discrimination because of its inherent interest in avoiding any objection to the standardization of its proprietary technology. As a consequence, patent holders and prospective licensees would be provided greater opportunities to negotiate acceptable license terms. (Guidelines, at IIIB)

It should be reiterated, however, that the determination of specific license terms and conditions, and the evaluation of whether such license terms and conditions are reasonable and demonstrably free of unfair discrimination, are not matters that are properly the subject of discussion or debate at a

Supplement 4 - Analysis of the IPR policy of ANSI

development meeting. Such matters should be determined only by the prospective parties to each license or, if necessary, by an appeal challenging whether compliance with the Patent Policy has been achieved. (Guidelines, at IIIB)

It should also be emphasized that, notwithstanding the incentive for patent holders to indicate any early willingness to license, it may not be possible for potential patent holders to give such an assurance until the standards development process has reached a relatively mature stage. It might be that only at that time will the patent holder be aware that its patent may be required for use of the proposed standard. This should not, however, preclude a patent holder from giving an assurance that if its patent is required for use of the standard it will license on reasonable terms and conditions demonstrably free of unfair discrimination. (Guidelines, at IIIB)

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

Third party disclosures are allowed.

Sources and additional details:

A standards developer may also consider taking steps to make it clear that any participant in the process -- not just patent holder -- is permitted to identify or disclose essential patents or essential patent claims that may be required for implementation of the standard. (Guidelines, at IIIA)

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?

As indicated above, disclosure is not obligatory. ANSI-accredited standard developers might set more specific rules, though.

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

As indicated above, disclosure is not obligatory, so it does not include such definition either. ANSI-accredited standard developers might set more specific rules, though.

Sources and additional details:

There is no objection in principle to drafting an American National Standard (ANS) in terms that include the use of an essential patent claim (one whose use would be required for compliance with that standard) if it is considered that technical reasons justify this approach. (ANSI Essential Requirements, §3.1)

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

Supplement 4 - Analysis of the IPR policy of ANSI

This is not specified.

Sources and additional details:

The objective is to obtain early disclosure concerning the existence of patents, where known. (Guidelines, at IIIA)

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

Patent searches are explicitly not required.

Sources and additional details:

This is not to suggest that a standards developer should require any participant in the development process to undertake a patent search of its own portfolio or of any other. The objective is to obtain early disclosure concerning the existence of patents, where known. (Guidelines, at IIIA)

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?

Although the policy is not explicitly mention commercial essentiality, the provided definition of essentiality is about pure technical essentiality.

Sources and additional details:

There is no objection in principle to drafting an American National Standard (ANS) in terms that include the use of an essential patent claim (one whose use would be required for compliance with that standard) if it is considered that technical reasons justify this approach. (ANSI Essential Requirements, §3.1)

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).

As indicated above, disclosure is not obligatory, so it does not include such definition either. Yet, it is deemed desirable that as much as possible information is provided, including that on the specific standard. Note that the ANSI-accredited standards developer can request disclosure, not ANSI.

Sources and additional details:

Generally, it is desirable to encourage disclosure of as much information as possible concerning the patent, including the identity of the patent holder, the patent's number, and information regarding precisely how it may relate to the standard being developed. Further, to assist in international standardization, a standards developer may deem it appropriate to encourage the disclosure of relevant unexpired foreign patents. (Guidelines, at IIIA)

Supplement 4 - Analysis of the IPR policy of ANSI

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.

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?

The policy does not specifically talk about blanket disclosures. Then again, disclosures are not obligatory.

An ANSI representative clarified: *"Blanket disclosures are not addressed but are allowed in practice."*

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?

Again, disclosure is not obligatory by ANSI itself, although it notes that accredited standards developer may wish to encourage the disclosure of patent applications.

There is no word on other types of IPR and the policy is explicitly called a patent policy. This seems to exclude other types of IPR. But see also Question G2 on a separate ANSI document on Software in ANSI standards.

Sources and additional details:

Similarly, a standards developer may wish to encourage participants to disclose the existence of pending U.S. patent applications relating to a standard under development. Of course, in such a situation the extent of any disclosure may be more circumscribed due to the possible need for confidentiality and uncertainty as to whether an application will mature into a patent and what its claimed scope will ultimately be. (Guidelines, at IIIA)

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

Not specified, although it is commented that an accredited standard developer might want to encourage this.

Supplement 4 - Analysis of the IPR policy of ANSI

Sources and additional details:

Further, to assist in international standardization, a standards developer may deem it appropriate to encourage the disclosure of relevant unexpired foreign patents. (Guidelines, at IIIA)

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?

No disclosure form is available.

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?

The policy provides no information on this.

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?

Again, disclosure is not obligatory by ANSI itself.

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?

Disclosures as such are not made public, as far as I can find. The licensing commitments, though, may also include the disclosure of essential patents. But this is not necessarily so – ANSI also encourages early indications of willingness to license at FRAND or FRAND-z terms even before a party has in fact identified that it owns an essential patent. (See also question D18.)

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.

Patent holders are *required* to issue a commitment statement – ‘Letter of Assurance (LoA)’ – that confirms whether (a) they believe not to own essential patents, (b) that patents will be made available at FRAND conditions or (c) patents will be available at FRAND-z conditions.

The exact definition of the requirement will be in the factual ASD policy, not in the ANSI text. Although the ANSI Guidelines suggest that an “identified party or patent holder must supply [a licensing commitment]”, the actual policy in ASD’s will probably be a bit more precise and lay this obligation only upon parties that are bound by the policy (e.g. members).

Sources and additional details:

The ASD shall receive from the patent holder or a party authorized to make assurances on its behalf, in written or electronic form, either:
(a) assurance in the form of a general disclaimer to the effect that such party does not hold and does not currently intend holding any essential patent claim(s); or
(b) assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard either:
(i) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or
(ii) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination. (ANSI Essential Requirements, §3.1.1)

An ANSI representative clarified: “In is not the intent of the ANSI Patent Policy or Guidelines to impose obligations on patent holders to make licensing commitments. ANSI would, of course, have no basis on which to impose such a requirement on a patent holder. What the ANSI Patent Policy and Guidelines say is that in a situation where an ASD receives a notice that a proposed ANS or an approved ANS may require the use of an essential patent claim -- in order for that standard to be approved as an ANS (or maintain that status if already approved) -- the ASD must receive from the patent holder (or authorized party) one of the assurances listed in the policy. The Guidelines make this same point and also give illustrations of possible actions an ASD might take if they encounter a situation where a potentially essential patent claim becomes known or identified to the developer but the developer does not receive one of the assurances listed.”

While the above was somewhat indirect (“The ASD shall receive, which implies that the patent owners shall send”), somehow different wording is used in the Guidelines, which explicitly lay this obligation at the patent owner itself.

In particular, the identified party or patent holder must supply the ANSI-accredited standards developer (“ASD”) with either:
(a) an assurance in the form of a general disclaimer to the effect that such party does not hold and does not anticipate holding any essential patent claim(s); or (b) an assurance that a license to such essential patent

Supplement 4 - Analysis of the IPR policy of ANSI

claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard, either:
(1) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or (2) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination. (Guidelines, at II)

ANSI also encourages patent holders to provide an early commitment that *if it should own patents that would be essential to standards that it will license on FRAND conditions, and make this commitment before it was able to identify such patents (e.g. because the standard is still very immature). While providing such an early commitment is voluntary, choosing not to issue might be a reason for participants to consider alternative technologies.*

An ANSI representative clarified: "ANSI's Patent Guidelines – which are suggestions to consider by ASDs and are not binding – encourage the early identification of relevant essential patents or essential patent claims because such early disclosure could increase the likelihood of receiving from the patent holder an early indication that it is willing to license the invention, that it is prepared to do so on reasonable terms and conditions demonstrably free of unfair discrimination or that the patent in question is not required for compliance with the proposed standard."

Sources and additional details:

It should also be emphasized that, notwithstanding the incentive for patent holders to indicate any early willingness to license, it may not be possible for potential patent holders to give such an assurance until the standards development process has reached a relatively mature stage. It might be that only at that time will the patent holder be aware that its patent may be required for use of the proposed standard. This should not, however, preclude a patent holder from giving an assurance that if its patent is required for use of the standard it will license on reasonable terms and conditions demonstrably free of unfair discrimination.

Thus, standards developers may wish to adopt procedures that would permit and encourage the early indication by patent holders of their willingness to comply with the Patent Policy by providing one of the assurances specified therein. Such encouragement might take the form of simply advising participants in the development effort that assurances may be made at an early stage, explaining the advantages of early negotiations, or through other means. While participants in the standards development effort might consider a refusal to provide assurances (or a refusal to commit to offer acceptable licensing terms and conditions) as a ground for favoring an alternative technology, the patent holder is only required to provide assurances as called for by the Patent Policy. (Guidelines, at IIIB)

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.

Upon the reception of a formal request of the SDO to do so.

An ANSI representative clarified: "The disclosures and assurances can come in at any time – the Guidelines speak to the ideal situation."

Sources and additional details:

Supplement 4 - Analysis of the IPR policy of ANSI

If an ANSI-Accredited Standards Developer (ASD) receives a notice that a proposed ANS or an approved ANS may require the use of such patent claim, the procedures in this clause shall be followed.

3.1.1 Statement from patent holder

The ASD shall receive from the patent holder or a party authorized to make assurances on its behalf, in written or electronic form, either: [etc.] (ANSI Essential Requirements , §3.1)

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?

The policy provides no information on this.

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

No licensing commitment form is available. Declarations can be sent in written or electronic form. One may, however, refer to the specific clause in the ANSI policy in order to indicate what commitment one is making.

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

Any party that desires to implement the standard.

Sources and additional details:

assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard either: [etc] (ANSI Essential Requirements , §3.1)

We need to assume here that 'applicants' is to be read as 'any applicant'

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 type is RAND, and there is also the explicit option is mentioned to commit to RAND with no royalties.

Note that parties can also state that they do not own IPR

Although the policy does not explicitly state this option (see below), an ANSI representative has

Supplement 4 - Analysis of the IPR policy of ANSI

clarified that IPR owners can also chose not to license.

Sources and additional details:

The ASD shall receive from the patent holder or a party authorized to make assurances on its behalf, in written or electronic form, either:

(a) assurance in the form of a general disclaimer to the effect that such party does not hold and does not currently intend holding any essential patent claim(s); or

(b) assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard either:

(i) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or

(ii) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination. (ANSI Essential Requirements, §3.1.1)

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?

See at question D6.

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 provides no information on this.

An ANSI representative clarified: *"In practice this is allowed."*

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 policy provides no information on this.

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)

The policy provides no information on this.

Supplement 4 - Analysis of the IPR policy of ANSI

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)?

The policy provides no information on this.

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?

Commitments are limited to those using the patents for the purpose of implementing the standard.

Sources and additional details:

The ASD shall receive from the patent holder or a party authorized to make assurances on its behalf, in written or electronic form, either:

(a) assurance in the form of a general disclaimer to the effect that such party does not hold and does not currently intend holding any essential patent claim(s); or

(b) assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard either:

(i) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or

(ii) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination. (ANSI Essential Requirements, §3.1.1)

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 provides no information on this.

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

The policy provides no information on this.

Supplement 4 - Analysis of the IPR policy of ANSI

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

The policy provides no information on this.

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?

The policy provides no information on this.

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 record of the commitment is kept in the administration of both ANSI and the accredited standard developed.

Although ANSI policy does not specify they will be publicly published, they are indeed available on the internet at www.ansi.org/patentletters (or <http://publicaa.ansi.org/sites/apdl/Patent%20Letters/Forms/AllItems.aspx>)

In addition, some ASDs do make IPR database publicly available, but not all ASDs do so.

Sources and additional details:

A record of the patent holder's statement shall be retained in the files of both the ASD and ANSI. (ANSI Essential Requirements, §3.1.2)

An ANSI representative clarified: "[...] some ASDs maintain patent databases online that are publically accessible, as does ANSI. In addition, all ANSs for which essential patent claims are made and for which an assurance has been received are required to include a notice to this effect within the ANS."

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)?

Interestingly, and unlike almost any other SDO, ANSI itself (or more specific: its Board of Standards Review) can take decision as whether terms and conditions satisfy the FRAND or the FRAND-Z requirements.

This could be interpreted in several ways. The narrow way is that this Board merely reviews the literal text provided by the patent owners and sees whether the exact wording of its licensing commitment is believed to meet the FRAND or FRAND-z requirement. The broader way is that this Board considers the terms and conditions as the patent holder actually uses in its licensing agreements with licensees. Also, it should be noted that this power is the 'exclusive province' of this board. Is it not true that (also) courts can rule on such issues?

Supplement 4 - Analysis of the IPR policy of ANSI

An ANSI representative clarified: *“The BSR has not to date had an occasion to opine on whether the Guidelines language referenced above should be construed “narrowly” or “broadly” as described in the survey question. Issues requiring a consideration of actual licensing terms are generally addressed by the courts as are related questions such as validity, infringement and the like. ANSI acknowledges that its process is distinct from the judicial system and the reference to the “exclusive province” was not intended to preclude access to any courts having jurisdiction.”*

Sources and additional details:

While ANSI’s counsel will verify that the information required from the patent holder has been supplied, counsel will not undertake to evaluate whether the terms and conditions satisfy the substantive test set forth in Section 3.1 (i.e. whether the terms and conditions are “reasonable” and/or “free of any unfair discrimination”). Such a decision is the exclusive province of the Board of Standards Review (or, on appeal, the ANSI Appeals Board) if the issue is raised during the approval process or in a petition for withdrawal of approval. In making its decision, the BSR shall consider all information of record it finds relevant. (Guidelines, at II)

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

The policy describes a non-exhaustive range of possible reactions of the SDO, depending on the context.

Sources and additional details:

Occasionally ASDs have encountered situations where a potentially essential patent claim(s) becomes known or identified to the ASD but the ASD does not receive a Letter of Assurance (“LoA”). This situation may arise for various reasons and appropriate responses will vary depending on the circumstances. The following is an illustrative list of possible actions based on actions ASDs have taken in the past. Note that this is not an exhaustive list and the items listed may not be appropriate in particular circumstances. Possible actions before an American National Standard (ANS) issued and while the document is under development:

- ASD stops the ANS approval process (i.e., no ANS issued)
- ASD publishes the document but not as an ANS
- ASD substitutes alternative technology for the suspected technology (i.e., a work around)
- ASD determines (possibly on the advice of IP legal counsel) that the patent claim is not essential and thus the document meets the criteria of the ANSI Essential Requirements (ERs)
- ASD reasonably believes the document meets the criteria of the ANSI ERs (in particular, the Patent Policy) but desires further guidance from ANSI. For example, ASD submits an explanation of the relevant circumstances to ANSI.

Possible actions after an American National Standard (ANS) is issued:

- ASD withdraws the standard as an ANS and abandons the process
- ASD withdraws the standard as an ANS and publishes the document, but not as an ANS
- ASD withdraws the standard as an ANS and re-initiates the ANS process for a document which substitutes alternative technology for the suspected technology (i.e., a work around)
- ASD determines (possibly on the advice of IP legal counsel) that the patent claim is not essential and thus the document meets the criteria of the ANSI Essential Requirements (i.e., original ANS remains as issued)
- ASD reasonably believes the document meets the criteria of the ANSI ERs

Supplement 4 - Analysis of the IPR policy of ANSI

(in particular, the Patent Policy) but desires further guidance from ANSI. For example, ASD submits an explanation of the relevant circumstances to ANSI. (Guidelines, at IIIB)

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?

Central to the policy is that anyone can disclose/inform about a patent held by another party, and that the owner is then approached and requested to issue a commitment.

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 provides no information on this.

An ANSI representative clarified: *"More accurately this is left to the SDOs."*

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?

I have found no information on this.

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 ANSI representative clarified: *"The ANSI Essential Requirements do not require that all documentation related to technical work be made public and it is up to the individual ASDs to make determinations about whether content of meetings and other materials are accessible to the public. Relatedly, some ASDs maintain patent databases online that are publically accessible, as does ANSI. In addition, all ANSs for which essential patent claims are made and for which an assurance has been received are required to include a notice to this effect within the ANS."*

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.)

Supplement 4 - Analysis of the IPR policy of ANSI

There is a separate document on Software in standards: *ANSI Guidelines on Software in Standards*, published in 2008, available at <http://publicaa.ansi.org/sites/apdl/Documents/Standards%20Activities/American%20National%20Standards/Procedures,%20Guides,%20and%20Forms/ANSI%20Guidelines%20on%20Software%20in%20Standards.pdf>

These guidelines apply to the inclusion of normative software [footnote 1] in American National Standards which software is intended to be extracted from the standard and used in implementations of the standard. [footnote 2]. *ANSI Guidelines on Software in Standards, at 1.*

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

I have found no information on this.

<< end >>