

### Analysis of the IPR policy of OASIS

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.

### Part A: Adoption and general aspects of 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?

On the OASIS website at <https://www.oasis-open.org/policies-guidelines/ipr>, there is a page called "Intellectual Property Rights (IPR) Policy" that defines the IPR policy. (Here referred to as "IPR Policy"). At the bottom of the page, it indicates that it is approved on 2 May 2012 and is effective from 21 June 2012. The text includes two forms, called "Feedback License" and "Copyright License Grant".

An OASIS representative clarified: *"The policy is under version control, with prior versions kept posted (e.g., see <https://www.oasis-open.org/policies-guidelines/ipr-2005-01-20>), because they continue to have relevance to a user implementing a specification published at that time (e.g., 2005) under that policy version."*

The web site also includes a document OASIS Intellectual Property Rights (IPR) Policy Frequently Asked Questions (FAQ) (here referred to as IPR FAQ), which is dated 4 February 2005.

## Supplement 6 - Analysis of the IPR policy of OASIS

---

[https://www.oasis-open.org/who/ipr/ipr\\_faq.php](https://www.oasis-open.org/who/ipr/ipr_faq.php). An OASIS representative clarified That this FAQ is still the current version and that it is a normative helper text.

The OASIS MEMBERSHIP APPLICATION AND AGREEMENT, of which the current version is dated 20 January 2005: <https://www.oasis-open.org/join/membership-agreement.pdf>. Section 2.2 of this document refers to the IPR policy.

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

Each distinct version of the policy can be found at <https://www.oasis-open.org/policies-guidelines/ipr> (box on the right side called “versions available”)

Below is an overview of some major changes:

### **An earlier IPR policy was adopted in 2009:**

In 2009, OASIS Introduces Non-Assertion Mode to Its Intellectual Property Rights Policy for Standards Development <https://www.oasis-open.org/news/pr/oasis-introduces-non-assertion-mode-to-its-intellectual-property-rights-policy-for-standards>.

The 2009 policy is available at <https://www.oasis-open.org/policies-guidelines/ipr-2009-05-19>. It was approved on 19 May 2009 and effective from 4 August 2009.

### **An earlier IPR policy was adopted in 2005:**

OASIS INTELLECTUAL PROPERTY RIGHTS POLICY Approved by the OASIS Board of Directors January 20, 2005 and effective as of 15 April 2005. <http://xml.coverpages.org/OASIS-IPR200502.pdf>

There is an “OASIS Intellectual Property Rights (IPR) Transition Policy Frequently Asked Questions (FAQ)” (here referred to as [Transition Policy](#)) which also dated 4 February 2005 and indicated to be a “Legacy document” [https://www.oasis-open.org/who/ipr/transition\\_faq\\_a4\\_05\\_02\\_04.pdf](https://www.oasis-open.org/who/ipr/transition_faq_a4_05_02_04.pdf).

OASIS Intellectual Property Rights (IPR) Policy Frequently Asked Questions (FAQ), which provides non-normative overview of the OASIS IPR Policy as revised by the OASIS Board of Directors in January 2005. [https://www.oasis-open.org/who/ipr/ipr\\_faq\\_a4\\_05\\_02\\_04.pdf](https://www.oasis-open.org/who/ipr/ipr_faq_a4_05_02_04.pdf)

Additional background information is provided in the news article / press release titled “OASIS Revises Intellectual Property Rights Policy International Standards Consortium Allows Committee Members to Choose IPR Mode” dated 7 February 2005 and available at <https://www.oasis-open.org/news/pr/oasis-revises-intellectual-property-rights-policy>.

This January 2005 policy received criticism: In February 2005, CNET<sup>1</sup> reported that the OASIS patent policy sparked a boycott of the open-source and free-software movements. A number of people signed “A call to action on OASIS patent policy” <http://lwn.net/Articles/124548/>. Eweek.com. OASIS Overhauls Intellectual Property Rights Policy <http://www.eweek.com/c/a/Web-Services-Web-20-and-SOA/OASIS-Overhauls-Intellectual-Property-Rights-Policy/> Others has commented that the critics were short lived, though, see

---

<sup>1</sup> CNET. OASIS patent policy sparks boycott. By Paul Festa, February 22, 2005. [http://news.cnet.com/OASIS-patent-policy-sparks-boycott/2100-7344\\_3-5585711.html](http://news.cnet.com/OASIS-patent-policy-sparks-boycott/2100-7344_3-5585711.html).

## Supplement 6 - Analysis of the IPR policy of OASIS

<http://www.consortiuminfo.org/essentialguide/intellectual.php>.

An OASIS representative clarified: *“At the time there was, apparently, a misunderstanding from a handful of open source activists who noticed that the policy permitted election among several licensing modes -- and, although it's rarely used, took umbrage at the presence of one mode (of the four) which permitted the incorporation of royalty-bearing patents. The majority of them recanted shortly afterwards, when they noticed that all of OASIS's peer SDOs also had similar, royalty-bearing options or exceptions. One resource of possible note as to the OASIS policy and open source can be found in the following posted legal opinion letter: [www.softwarefreedom.org/resources/2006/OpenDocument.pdf](http://www.softwarefreedom.org/resources/2006/OpenDocument.pdf)”*

On a web page, short comments of the OASIS board on issues raised by members are provided [https://www.oasis-open.org/private/member\\_review\\_log.2005-02-01.php](https://www.oasis-open.org/private/member_review_log.2005-02-01.php). The detailed comments, however, are not publicly available.

The transition policy FAQ document was updated as “TRANSITION POLICY FOR THE NEW OASIS IPR POLICY Revisions Approved by the OASIS Board of Directors on 26 August 2005”. It says: *“The following revised OASIS IPR Transition Policy is effective as of 1 October 2005. It governs the manner in which the OASIS IPR Policy adopted on 20 January 2005 [...] will apply to the operation of OASIS Committees formed prior to 15 April 2005.”* [https://www.oasis-open.org/who/ipr/transition\\_policy\\_a4\\_2005\\_08\\_26.pdf](https://www.oasis-open.org/who/ipr/transition_policy_a4_2005_08_26.pdf)

### **An earlier IPR policy was adopted in 2000:**

An older version of the policy can still be downloaded at <https://www.oasis-open.org/policies-guidelines/ipr-2000-01-1>. It was approved on 13 January 2000 and effective from the same date.

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

An OASIS representative clarified: *“We continually review the policies for improvement but, as they represent the signed contractual commitments of many large entities, and any change causes a rolling legal review in many companies, we try to version them sparingly.”*

## **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)?

Members are bound to the OASIS policies (including the IPR policy) once they sign the OASIS Membership Agreement.

An OASIS representative clarified: *“That's correct, and a distinctive feature of OASIS. Participants in our work are bound by a signed contract to the IPR Policy, as to which users (who rely on the licensing) likely are third party beneficiaries. That set of obligations, with more concrete legal documentation to provide better evidence of assent and enforceability, was a deliberate enhancement in 2005.”*

The IPR FAQ explicitly mentions it is not normative, i.e. it has no binding nature.

## Supplement 6 - Analysis of the IPR policy of OASIS

---

Signing the OASIS Membership Agreement simply attests that the member agrees to be bound to OASIS policies. (IPR FAQ § 2.5)

The membership agreement is available at <https://www.oasis-open.org/join/membership-agreement.pdf>

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

OASIS members are typically companies, and some administrations and other bodies (see <https://www.oasis-open.org/member-roster>)

An OASIS representative clarified: *“Individual persons, unaffiliated with organizations, also can be members, and thus full participants who bind themselves to the policies.”*

OASIS Membership levels include Foundational Sponsors, Sponsors, and Contributors. There seem to be no differences between these membership levels in terms of obligations and rights related to the IPR policy.

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

All obligations hold for affiliates as well. This category is precisely defined.

### Sources and additional details:

This Policy applies to all members of OASIS and their Affiliates (as defined below). (IPR Policy, §1)

Affiliate—any entity that directly or indirectly controls, is controlled by, or is under common control with, another entity, so long as such control exists. In the event that such control ceases to exist, such Affiliate will be deemed to have withdrawn from OASIS pursuant to the terms set forth in the withdrawal provisions in Section 11. For purposes of this definition, with respect to a business entity, control means direct or indirect beneficial ownership of or the right to exercise (i) greater than fifty percent (50%) of the voting stock or equity in an entity; or (ii) greater than fifty percent (50%) of the ownership interest representing the right to make the decisions for the subject entity in the event that there is no voting stock or equity. below). (IPR Policy, §2, definitions)

## Part C: Patent disclosure

### Patent disclosure, general

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

A participant in a Technical Committee has a disclosure **obligation** concerning its patents owned by its own organization (see also C5-C8 for knowledge of such patents).

A participant in a Technical Committee has a disclosure **obligation** concerning third party

## Supplement 6 - Analysis of the IPR policy of OASIS

patents that he or she knows of, but the wording is less strong than that for patents owned by its own organization ('should' instead of 'shall'). There is no obligation if this participant would breach a confidentiality obligation by doing so.

All OASIS members that are not participant in a specific TC are **requested and encouraged** to disclose patents for that TC but do not face an obligation. Such disclosure requests are included with all public review copies of OASIS Standards Final Deliverables.

Note that:

1. Those parties that provide 'feedback' and thus are under a licensing obligation but they are NOT under an obligation to disclose.
2. Similarly, parties that withdraw from a TC do not have a disclosure obligation any more once they left.

An OASIS representative clarified that *"It may be useful to note that, with the 2005 policy changes, we deliberately strengthened \*licensing\* obligations, and thereby mitigated the well-known uncertainties of the precision of \*disclosure\* obligations. In layman's terms, as a TC participant, you must license the rights you have that read on certain artifacts from that TC -- whether or not you disclose them or are aware of them."*

### Sources and additional details:

Disclosure Obligations - Each TC Party shall disclose to OASIS in writing the existence of all patents and/or patent applications owned or claimed by such TC Party that are actually known to the TC Member directly participating in the TC, and which such TC Member believes may contain any Essential Claims or claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable as such document then exists (collectively, "Disclosed Claims"). (IPR Policy, Section 8.1)

Disclosure of Third Party Patent Claims - Each TC Party whose TC Members become aware of patents or patent applications owned or claimed by a third party that contain claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable should disclose them, provided that such disclosure is not prohibited by any confidentiality obligation binding upon them. It is understood that any TC Party that discloses third party patent claims to OASIS does not take a position on the essentiality or relevance of the third party claims to the OASIS Standards Final Deliverable in its then-current form. (IPR Policy, Section 8.2)

In both cases (Sections 8.1 and 8.2), it is understood and agreed that such TC Party(s)' TC Member(s) do not represent that they know of all potentially pertinent claims of patents and patent applications owned or claimed by the TC Party or any third parties. For the avoidance of doubt, while the disclosure obligation under Sections 8.1 and 8.2 applies directly to all TC Parties, this obligation is triggered based on the actual knowledge of the TC Party's TC Members regarding the TC Party's patents or patent applications that may contain Essential Claims. (IPR Policy, between §8.1 and §8.2)

3. Disclosure Requests - Disclosure requests will be included as described in Section 12 with all public review copies of OASIS Standards Final Deliverables. All OASIS Parties are encouraged to review such OASIS Standards Final Deliverables and make appropriate disclosures. (IPR Policy, Section 8.3)

TC Participants are obligated to disclose claims that are actually known to be, or might become essential to a Committee Specification or OASIS Standard. When an OASIS Standard is balloted, supporting documentation includes a list of current TC Participants. OASIS also publishes a call to all members for the disclosure of any essential claims during the public review of each approved specification. (IPR FAQ §3.1)

## Supplement 6 - Analysis of the IPR policy of OASIS

The relation between providing 'feedback' and obligation to disclose follows from member comments on [https://www.oasis-open.org/private/member\\_review\\_log.2005-02-01.php](https://www.oasis-open.org/private/member_review_log.2005-02-01.php) and the response of the OASIS board to this comments:

**OASIS member comment 81 (summarized):** "Feedback License should include obligation to disclose" **OASIS Board reply:** Subcommittee concluded that rights provided under the license were sufficient; and too much burden on commenters would retard public input. No change made.

**OASIS member comment 82 (summarized):** "Should Disclosure Obligation survive withdrawal?" **OASIS Board reply:** Subcommittee declined to expand burden on a departing TC member. No change made.

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 specific exceptions are 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)?

There are not explicit elements in the policy about the timing of disclosure. The wording of the disclosure obligations suggests that this should be done when the party becomes aware.

*An OASIS representative clarified that "Some of the well-known industry problems with that timing issue, e.g., in the Rambus cases, gave us reason in 2005 to take the more licensing-centric approach described above. We must reserve comment on issues regarding the time at which a disclosure obligation attaches."*

### Sources and additional details:

TC Participants are *obligated to disclose* claims that are actually known to be, or might become essential to a Committee Specification or OASIS Standard. When an OASIS Standard is balloted, supporting documentation includes a list of current TC Participants. OASIS also publishes a call to all members for the disclosure of any essential claims during the public review of each approved specification. (IPR FAQ §3.1)

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

Third party patent owners are requested to give indication of its willingness to grant patent licenses to such patent claims in a manner consistent with the IPR Mode of the OASIS Technical Committee that produced this deliverable.

Note that also OASIS member that do not have a contribution or participation obligation are requested the same thing.

### Sources and additional details:

The following text appears in the OASIS IPR policy and is to be included in OASIS Standards Final Delivery documents:

## Supplement 6 - Analysis of the IPR policy of OASIS

*[OASIS requests that any OASIS Party or any other party that believes it has patent claims that would necessarily be infringed by implementations of this OASIS Standards Final Deliverable, to notify OASIS TC Administrator and provide an indication of its willingness to grant patent licenses to such patent claims in a manner consistent with the IPR Mode of the OASIS Technical Committee that produced this deliverable.] (IPR policy, at §14.1)*

13.2.2. Where the OASIS TC Administrator is formally notified of rights, or claimed rights under Section 8.8 with respect to entities other than Obligated Parties, the OASIS President shall attempt to obtain from the claimant of such rights a written assurance that any Licensee will be able to obtain the right to utilize, use, and distribute the technology or works when implementing, using, or distributing technology based upon the specific OASIS Standards Final Deliverable (or, in the case of an OASIS Standards Draft Deliverable, that any Licensee will then be able to obtain such a right) under terms that are consistent with this Policy. All such information will be made available to the TC that produced such deliverable, but the failure to obtain such written assurance shall not prevent votes from being conducted, except that the OASIS TC Administrator may defer approval for a reasonable period of time where a delay may facilitate the obtaining of such assurances. The results will, however, be recorded by the OASIS TC Administrator, and made available to the public. The OASIS Board of Directors may also direct that a summary of the results be included in any published OASIS Standards Final Deliverable. (IPR Policy at 13.2.2)

### 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?

Disclosure rules are limited to parties participating in the TC that develops the standard in question. Non-participants are encouraged to disclose (this request can be found in public review copies of OASIS standards public deliverables) but are not required.

Interestingly, parties that are not TC participants but do submit a contribution (dubbed 'Feedback' in the policy) are not required to disclose any essential patents they own.

An OASIS representative clarified that "One could take the position that their plenary grant of rights under the Feedback License obviates that need. See Section 2 of that form."

### Sources and additional details:

TC Participants are obligated to disclose claims that are actually known to be, or might become essential to a Committee Specification or OASIS Standard. When an OASIS Standard is balloted, supporting documentation includes a list of current TC Participants. OASIS also publishes a call to all members for the disclosure of any essential claims during the public review of each approved specification. (IPR FAQ §3.1)

The relation between providing 'feedback' and obligation to disclose follows from member comments on [https://www.oasis-open.org/private/member\\_review\\_log.2005-02-01.php](https://www.oasis-open.org/private/member_review_log.2005-02-01.php) and the response of the OASIS board to this comments:

OASIS member comment 81 (summarized): "Feedback License should include obligation to disclose" OASIS Board reply: Subcommittee concluded that rights provided under the license were sufficient; and too much burden on commenters would retard public input. No change made.

## Supplement 6 - Analysis of the IPR policy of OASIS

---

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

The disclosure requirement uses the words 'may contain' and 'might become essential'.

### Sources and additional details:

Disclosure Obligations - Each TC Party shall disclose to OASIS in writing the existence of all patents and/or patent applications owned or claimed by such TC Party that are actually known to the TC Member directly participating in the TC, and which such TC Member believes may contain any Essential Claims or claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable as such document then exists (collectively, "Disclosed Claims"). (IPR Policy, Section 8.1)

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

Disclosure is conditional on the actual knowledge of an individual participant about patents or patent applications that may contain Essential Claims. It is not specified what the knowledge of that participant is supposed to be. Yet the policy states that the company should act in 'good faith', suggesting it is incompatible with the policy to willingly send individuals to meetings that do not know about certain patents.

An OASIS representative clarified that *"See the comments above about licensing-centrism, and a decreased reliance on disclosure rules, as being too imprecise to protect users by themselves."*

### Sources and additional details:

Disclosure Obligations - Each TC Party shall disclose to OASIS in writing the existence of all patents and/or patent applications owned or claimed by such TC Party that are actually known to the TC Member directly participating in the TC, and which such TC Member believes may contain any Essential Claims or claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable as such document then exists (collectively, "Disclosed Claims"). (IPR Policy, Section 8.1)

Section 8.2. Disclosure of Third Party Patent Claims - Each TC Party whose TC Members become aware of patents or patent applications owned or claimed by a third party that contain claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable should disclose them, provided that such disclosure is not prohibited by any confidentiality obligation binding upon them. It is understood that any TC Party that discloses third party patent claims to OASIS does not take a position on the essentiality or relevance of the third party claims to the OASIS Standards Final Deliverable in its then-current form. (IPR Policy, Section 8.2)

In both cases (Sections 8.1 and 8.2), it is understood and agreed that such TC Party(s)' TC Member(s) do not represent that they know of all potentially pertinent claims of patents and patent applications owned or claimed by the TC Party or any third parties. For the avoidance of doubt, while the disclosure obligation under Sections 8.1 and 8.2 applies directly to all TC Parties, this obligation is triggered based on the actual knowledge of the TC Party's TC Members regarding the TC Party's patents or patent applications that may contain Essential Claims. (IPR Policy, between §8.2 and §8.3)

In contrast to what the first line of this paragraph states, the last line only refers to knowledge about one's own patent and thus only concerns §8.1 and not §8.2



## Supplement 6 - Analysis of the IPR policy of OASIS

A disclosure request and the obligation to disclose set forth above do not imply any obligations on the recipients of disclosure requests (collectively or individually) or on any OASIS Party to perform or conduct patent searches. Nothing in this Policy nor the act of receiving a disclosure request for an OASIS Standards Final Deliverable, regardless of whether it is responded to, shall be construed or otherwise interpreted as any kind of express or implied representation with respect to the existence or non-existence of patents or patent applications which contain Essential Claims, other than that such TC Party has acted in good faith with respect to its disclosure obligations. (IPR Policy at §8.4)

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

The policy explicitly specifies that patent searches are not required.

### Sources and additional details:

A disclosure request and the obligation to disclose set forth above do not imply any obligations on the recipients of disclosure requests (collectively or individually) or on any OASIS Party to perform or conduct patent searches. Nothing in this Policy nor the act of receiving a disclosure request for an OASIS Standards Final Deliverable, regardless of whether it is responded to, shall be construed or otherwise interpreted as any kind of express or implied representation with respect to the existence or non-existence of patents or patent applications which contain Essential Claims, other than that such TC Party has acted in good faith with respect to its disclosure obligations. (IPR Policy at §8.4)

### 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?

It is purely technical essentiality. Interestingly, it is defined at which time the test for the existence of alternatives must be done: at the approval of the standard.

An OASIS representative clarified: *"Note, however, that one may view the date to which the licensing obligation relates back as the date on which the draft artifact first might infringe and the obligated party is present. The specification's later final approval simply is a condition subsequent to the licensing duty."*

### Sources and additional details:

Essential Claims - those claims in any patent or patent application in any jurisdiction in the world that would necessarily be infringed by an implementation of those portions of a particular OASIS Standards Final Deliverable created within the scope of the TC charter in effect at the time such deliverable was developed. A claim is necessarily infringed hereunder only when it is not possible to avoid infringing it because there is no non-infringing alternative for implementing the Normative Portions of that particular OASIS Standards Final Deliverable. Existence of a non-infringing alternative shall be judged based on the state of the art at the time the OASIS Standards Final Deliverable is approved. (IPR Policy at §2, item 9)

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).

## Supplement 6 - Analysis of the IPR policy of OASIS

---

Since disclosures are specific to TC's, the disclosure event already tells us for which TC the disclosure is made. Moreover, the IPR policy states that where reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable must be indicated.

### Sources and additional details:

Any disclosure of Disclosed Claims shall include (a) in the case of issued patents and published patent applications, the patent or patent application publication number, the associated country and, as reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable; and (b) in the case of unpublished patent applications, the existence of the unpublished application and, as reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable. (IPR Policy at §8.5)

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 features are defined to be part of the 'normative portion' of the standard and therefore patents on optional features are also essential patents.

An OASIS representative clarified: *"Optionality is precisely addressed in the definition of "normative portion" in Section 2.16 of the policy -- which is the defined term describing the boundaries of the work to which a licensing obligation applies."*

### Sources and additional details:

[definition of] Covered Product - includes only those specific portions of a product (hardware, software or combinations thereof) that (a) implement and are compliant with all Normative Portions of an OASIS Standards Final Deliverable produced by a Non-Assertion Mode TC that must be implemented to comply with such deliverable, and (b) to the extent that the product implements one or more optional portions of such deliverable, those portions that implement and are compliant with all Normative Portions that must be implemented to comply with such optional portions of the deliverable. (IPR Policy at §2, item 7)

[definition of] Normative Portion - a portion of an OASIS Standards Final Deliverable that must be implemented to comply with such deliverable. If such deliverable defines optional parts, Normative Portions include those portions of the optional part that must be implemented if the implementation is to comply with such optional part. Examples and/or reference implementations and other specifications or standards that were developed outside the TC and which are referenced in the body of a particular OASIS Standards Final Deliverable that may be included in such deliverable are not Normative Portions.

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)?

Not specified in the policy.

## Supplement 6 - Analysis of the IPR policy of OASIS

---

### Patent disclosure, relating to patent identities

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

Blanket disclosures are not allowed since the policy specifies that disclosures shall include identification of the patent(s).

When asked whether blanket disclosures nevertheless exist in practice, an OASIS representative clarified: *"Rarely if ever. But OASIS faithfully reposts what disclosures we receive, without editing."*

#### Sources and additional details:

Any disclosure of Disclosed Claims shall include (a) in the case of issued patents and published patent applications, the patent or patent application publication number, the associated country and, as reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable; and (b) in the case of unpublished patent applications, the existence of the unpublished application and, as reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable. (IPR Policy at §8.5)

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 patent applications, both published and unpublished.

Although it is called an IPR policy, which has IPR modes, the actual disclosure and commitment rules refer to patents (and patent claims) only. (See also question G2)

#### Sources and additional details:

Disclosure Obligations - Each TC Party shall disclose to OASIS in writing the existence of all patents and/or patent applications owned or claimed by such TC Party that are actually known to the TC Member directly participating in the TC, and which such TC Member believes may contain any Essential Claims or claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable as such document then exists (collectively, "Disclosed Claims"). (IPR Policy, Section 8.1)

Disclosure of Third Party Patent Claims - Each TC Party whose TC Members become aware of patents or patent applications owned or claimed by a third party that contain claims that might become Essential Claims upon approval of an OASIS Standards Final Deliverable should disclose them, provided that such disclosure is not prohibited by any confidentiality obligation binding upon them. It is understood that any TC Party that discloses third party patent claims to OASIS does not take a position on the essentiality or relevance of the third party claims to the OASIS Standards Final Deliverable in its then-current form. (IPR Policy, Section 8.2)

Any disclosure of Disclosed Claims shall include (a) in the case of issued patents and published patent applications, the patent or patent application publication number, the associated country and, as reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable; and (b) in the case of unpublished patent applications, the existence of the unpublished application and, as reasonably practicable, the relevant portions of the applicable OASIS Standards Final Deliverable. (IPR Policy at §8.5)

## Supplement 6 - Analysis of the IPR policy of OASIS

---

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

This is 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?

There is no form available. Disclosures as made available are written in free format, although they do need to include specific information concerning the patent identity (see also question 13).

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?

This is not specified in the policy.

An OASIS representative clarified: *"Parties may gain some benefits from updated disclosure, moving them to volunteer revised text, which we then post."*

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)

This is not specified in the policy.

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?

There are no other disclosure modes as those already described.

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?

While one part of the IPR policy stipulates that all received disclosures are published (on the relevant TC IPR page), another part of the policy seems to say some disclosures (particularly those made by those that are not the patent owner) MAY be published.

An OASIS representative clarified: *“As a practical matter, we publish all claim assertions that are sent to us for publication”*

### Sources and additional details:

Yes. Each OASIS TC’s IPR page documents all disclosures received by OASIS, principally from its members, in relation to the work of that Committee. Information on TC Participants and their respective participation periods also is posted at the OASIS web site. (IPR FAQ § 3.1)

13.2. Where any copyrights, trademarks, patents, patent applications, or other proprietary rights are known, or claimed, with respect to any OASIS Deliverable and are formally brought to the attention of the OASIS TC Administrator, OASIS shall consider appropriate action, which may include disclosure of the existence of such rights, or claimed rights. The OASIS Technical Committee Process shall prescribe the method for providing this information. (IPR Policy at 13.2)

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?

Whether a patent is essential or not (with the associated, perpetual licensing obligation) is determined at the time of the approval of the standard. Should it be not essential any more any moment later in time than that does not change anything.

### Sources and additional details:

Essential Claims - those claims in any patent or patent application in any jurisdiction in the world that would necessarily be infringed by an implementation of those portions of a particular OASIS Standards Final Deliverable created within the scope of the TC charter in effect at the time such deliverable was developed. A claim is necessarily infringed hereunder only when it is not possible to avoid infringing it because there is no non-infringing alternative for implementing the Normative Portions of that particular OASIS Standards Final Deliverable. Existence of a non-infringing alternative shall be judged based on the state of the art at the time the OASIS Standards Final Deliverable is approved. (IPR Policy at §2, item 9)

## 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.

Licensing commitments arise from participation or contribution (see below) and not from submitting a licensing declaration. They are not linked to having disclosed patents.

Licensing commitments arise when parties meet one of the two following criteria:

- By submitting a contribution to an OASIS Technical Committee proposed for inclusion in a standard (can be in a meeting, in a teleconference or by submitting to a mailing list). In such a case, any essential patents covered by that contributions must be licensed according the IPR mode of the TC in question. (1)

- By being a ‘participant’ in the respective Technical Committee. The exact definition of being a

## Supplement 6 - Analysis of the IPR policy of OASIS

participant is precisely defined. (See also question D7 for opt-out options.)

(1) For 'technical committee members' this obligation is defined as such in the policy. For a non-TC member, the obligation arises from a clause in the obligatory 'Feedback Form' that must be issued when a non-TC member wants to submit a proposal for inclusion in the

The IPR FAQ at §2 is somewhat unclear about who incurs licensing obligations. It has different paragraphs on 'TC observers', 'any OASIS Member who makes a specific contribution to technical work' and 'non-committee participants who submit comments', but does not specify whether these three categories are identical and all have to issue a 'Feedback License'. (This terminology cannot be found back in the IPR Policy.)

An OASIS representative clarified: *"The FAQ is nonnormative"*.

### Sources and additional details:

Obligated Party - a TC Party that incurs a licensing or non-assertion obligation for its Essential Claims by either a Contribution Obligation or a Participation Obligation. (IPR Policy, §2 definitions)

Contribution Obligation - a licensing or non-assertion requirement, as described in Section 10 that results from making a Contribution as described in Section 9.1. (IPR Policy, §2 definitions)

Contribution - any material submitted to an OASIS Technical Committee by a TC Member in writing or electronically, whether in an in-person meeting or in any electronic conference or mailing list maintained by OASIS for the OASIS Technical Committee and which is or was proposed for inclusion in an OASIS Deliverable. (IPR Policy, §2 definitions)

Participation Obligation - a licensing or non-assertion requirement, as described in Section 10, that arises from membership in an OASIS Technical Committee, as described in Section 9.2. (IPR Policy, §2 definitions)

Feedback - any written or electronic input provided to an OASIS Technical Committee by individuals who are not TC Members and which is proposed for inclusion in an OASIS Deliverable. All such Feedback must be made under the terms of the Feedback License (Appendix A). (IPR Policy, §2 definitions)

Contribution Obligation. A TC Party has a Contribution Obligation, which arises at the time the Contribution is submitted to a TC, to license or provide under non-assertion covenants as appropriate for the IPR mode described in Section 10, any claims under its patents or patent applications that become Essential Claims when such Contribution is incorporated (either in whole or in part) into (a) the OASIS Standards Final Deliverable produced by the TC that received the Contribution, or (b) any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable. (IPR Policy, §9.1)

Participation Obligation: A TC Party has a Participation Obligation to license or provide under non-assertion covenant as appropriate for the IPR mode, as described in Section 10, any claims under its patents or patent applications that would be Essential Claims in the then current OASIS Standards Draft Deliverable, if that draft subsequently becomes an OASIS Standards Final Deliverable, even if the TC Party is not a Contributor, when all of the following conditions are met:

An OASIS Standards Final Deliverable is finally approved that incorporates such OASIS Standards Draft Deliverable, either in whole or in part;  
The TC Party has been on, or has been represented by TC Member(s) on such TC for a total of sixty (60) calendar days, which need not be continuous;  
The TC Party is on, or is represented by TC Member(s) on such TC after a period of seven (7) calendar days after the ballot to approve such OASIS Standards Draft Deliverable has elapsed.

## Supplement 6 - Analysis of the IPR policy of OASIS

Once the foregoing conditions are met, that TC Party's Participation Obligation so to license or provide a non-assertion covenant continues with respect to that OASIS Standards Final Deliverable, and any Final Maintenance Deliverable subsequently approved with respect to that OASIS Standards Final Deliverable.

For organizational TC Parties, the membership threshold is met by one or more employees or organizational designees of such Parties having been a TC Member on any 60 calendar days, although any given calendar day is only one day of membership, regardless of the number of participants on that day. Each time a new OASIS Standards Draft Deliverable is approved by the TC, the Participation Obligation adjusts to encompass the material in the latest OASIS Standards Draft Deliverable seven days after such draft has been approved for publication. (IPR Policy, §9.2)

A novel element is what could be called a prototype license. Here, TC members automatically grant a non-assertion covenant to other TC members for the purpose of testing and developing implementations of the standard being developed in that TC. It does not cover selling or distributing, and ends when a standard is adopted or the TC is close.

One might argue that in some legislations, such use is already made possible by research exemptions in patent law. Nevertheless, this clause ensures that such use is possible regardless the (specificities of the) legislation in question.

### Sources and additional details:

#### 6. LIMITED PATENT COVENANT FOR DELIVERABLE DEVELOPMENT

To permit TC Members and their TC Parties to develop implementations of OASIS Standards Draft Deliverables being developed by a TC, each TC Party represented by a TC Member in a TC, at such time that the TC Member joins the TC, grants to each other TC Party in that TC automatically and without further action on its part, and on an ongoing basis, a limited covenant not to assert any Essential Claims required to implement such OASIS Standards Draft Deliverable and covering making or using (but not selling or otherwise distributing) an implementation of such OASIS Standards Draft Deliverable, solely for the purpose of testing and developing such deliverable and only until either the OASIS Standards Draft Deliverable is approved as an OASIS Standards Final Deliverable or the Technical Committee is closed. (IPR policy, §6)

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.

There are no licensing statements.

However, licensing obligations coming from 'contribution obligation' arise at the time of contributing. Licensing obligations coming from 'contribution obligation' come in existence when the final deliverable is adopted.

An OASIS representative clarified: *"However, parties publishing a license claim disclosure may, and often do, announce in that notice (1) the method by which a user may obtain an explicit written license (if such is required or desirable); or (2) other terms of the license offered, which terms must be within the degrees of freedom set by the "IPR Mode" applicable to that TC's outputs."*

## Supplement 6 - Analysis of the IPR policy of OASIS

### Sources and additional details:

Contribution Obligation. A TC Party has a Contribution Obligation, which arises at the time the Contribution is submitted to a TC, to license or provide under non-assertion covenants as appropriate for the IPR mode described in Section 10, any claims under its patents or patent applications that become Essential Claims when such Contribution is incorporated (either in whole or in part) into (a) the OASIS Standards Final Deliverable produced by the TC that received the Contribution, or (b) any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable. (IPR Policy, §9.1)

The time the obligations arising from the obligations comes into force can be implicitly understood from:

Participation Obligation: A TC Party has a Participation Obligation to license or provide under non-assertion covenant as appropriate for the IPR mode, as described in Section 10, any claims under its patents or patent applications that would be Essential Claims in the then current OASIS Standards Draft Deliverable, if that draft subsequently becomes an OASIS Standards Final Deliverable, even if the TC Party is not a Contributor, when all of the following conditions are met: [...]

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?

Each TC can choose its own 'licensing mode', which basically defined the level of commitment required by the owners of essential patents. The licensing mode is part of the proposal to start a TC and is formalized in the charter for the TC. This charter cannot be changed at a later date. Should parties wish to work under another mode, they must agree to dismantle the existing TC and propose to form another one using another licensing mode.

See also question D6.

As of June 2012, out of the 83 currently 'active committees', the large majority (60) opted for the 'RF on limited terms' model. Another 16 opted for 'RF on RAND', and 6 for 'Non-assertion'. Not one single committee has opted for the 'RAND' mode. Out of all 83 committees, only 14 actually have received one or more notifications (declarations and/or commitments). This includes some notifications that parties indicate they do not own patents. The committees that did receive notifications that did usually received only one or a very few. The maximum is one committee that received notification from 11 firms.

	RAND	RF on RAND	RF on limited terms	Non-assertion
Total of active committees with this model	0	16	60	6
Ibid, for which one or more notification is present	0	5	9	0

Note: the mode of one committee ('Web Site Upgrade') could not be determined because its web page was missing.

An OASIS representative clarified: "This data looks substantially correct. Also, there have been one or two committees historically that elected RAND mode; however, they eventually transitioned to a successor royalty-free project. We think it is interesting data that, in the mode election "marketplace", our members have chosen to avoid the royalty-bearing mode."



### Sources and additional details:

#### 4. TC FORMATION

At the time a TC is chartered, the proposal to form the TC must specify the IPR Mode under which the Technical Committee will operate. This Policy describes the following IPR Modes:

1. RAND - requires all Obligated Parties to license their Essential Claims using the RAND licensing elements described in Section 10.1.
2. RF on RAND Terms - requires all Obligated Parties to license their Essential Claims using the RF licensing elements described in Sections 10.2.1 and 10.2.2.
3. RF on Limited Terms - requires all Obligated Parties to license their Essential Claims using the RF licensing elements described in Sections 10.2.1 and 10.2.3.
4. Non-Assertion - requires all Obligated Parties to provide an OASIS Non-Assertion Covenant as described in Section 10.3.

A TC may not change its IPR Mode without closing and submitting a new charter. (IPR policy, §4)

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

Not applicable, as this standard developer does not require licensing statements.

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

The licensing obligation is bonding to any implementer of the standard.

### Sources and additional details:

From the IPR policy, at §10: [...] it will grant to any OASIS Party or third party: a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant) under its Essential Claims covered by its Contribution Obligations or Participation Obligations on fair, reasonable, and non-discriminatory terms [...]

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 actual licensing regime is decided per Technical Committee, at the time it receives its charter.

The regimes are:

- RAND
- RF on RAND
- RF on limited terms
- Non-assertion (which was added as per 2009).

### Sources and additional details:

From the IPR policy, at §10:

10.1 RAND Mode TC Requirements

## Supplement 6 - Analysis of the IPR policy of OASIS

For an OASIS Standards Final Deliverable developed by a RAND Mode TC, except where a Licensee has a separate, signed agreement under which the Essential Claims are licensed to such Licensee on more favorable terms and conditions than set forth in this section (in which case such separate signed agreement shall supersede this Limited Patent License), each Obligated Party in such TC hereby covenants that, upon request and subject to Section 11, it will grant to any OASIS Party or third party: a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant) under its Essential Claims covered by its Contribution Obligations or Participation Obligations on fair, reasonable, and non-discriminatory terms to make, have made, use, market, import, offer to sell, and sell, and to otherwise directly or indirectly distribute (a) Licensed Products that implement such OASIS Standards Final Deliverable, and (b) Licensed Products that implement any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable. Such license need not extend to features of a Licensed Product that are not required to comply with the Normative Portions of such OASIS Standards Final Deliverable or Final Maintenance Deliverable. For the sake of clarity, the rights set forth above include the right to directly or indirectly authorize a third party to make unmodified copies of the Licensee's Licensed Products and to license (optionally under the third party's license) the Licensee's Licensed Products within the scope of, and subject to the terms of, the Obligated Party's license.

At the election of the Obligated Party, such license may include a term requiring the Licensee to grant a reciprocal license to its Essential Claims (if any) covering the same OASIS Standards Final Deliverable and any such Final Maintenance Deliverable. Such term may require the Licensee to grant licenses to all implementers of such deliverable. The Obligated Party may also include a term providing that such license may be suspended with respect to the Licensee if that Licensee first sues the Obligated Party for infringement by the Obligated Party of any of the Licensee's Essential Claims covering the same OASIS Standards Final Deliverable or any such Final Maintenance Deliverable.

License terms that are fair, reasonable, and non-discriminatory beyond those specifically mentioned above are left to the Licensees and Obligated Parties involved.

### 10.2 RF Mode TC Requirements 10.2.1 Common

For an OASIS Standards Final Deliverable developed by an RF Mode TC, except where a Licensee has a separate, signed agreement under which the Essential Claims are licensed to such Licensee on more favorable terms and conditions than set forth in this section (in which case such separate signed agreement shall supersede this Limited Patent License), each Obligated Party in such TC hereby covenants that, upon request and subject to Section 11, it will grant to any OASIS Party or third party: a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant) under its Essential Claims covered by its Contribution Obligations or Participation Obligations without payment of royalties or fees, and subject to the applicable Section 10.2.2 or 10.2.3, to make, have made, use, market, import, offer to sell, and sell, and to otherwise directly or indirectly distribute (a) Licensed Products that implement such OASIS Standards Final Deliverable, and (b) Licensed Products that implement any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable. Such license need not extend to features of a Licensed Product that are not required to comply with the Normative Portions of such OASIS Standards Final Deliverable or Final Maintenance Deliverable. For the sake of clarity, the rights set forth above include the right to directly or indirectly authorize a third party to make unmodified copies of the Licensee's Licensed Products and to license (optionally under the third party's license) the Licensee's Licensed Products, within the scope of, and subject to the terms of, the Obligated Party's license.

At the election of the Obligated Party, such license may include a term requiring the Licensee to grant a reciprocal license to its Essential Claims (if any) covering the same OASIS Standards Final Deliverable and any such Final Maintenance Deliverable. Such term may require the Licensee to grant licenses to all implementers of such deliverable. The Obligated Party may also include a term providing that such license may be suspended with respect to the Licensee if that Licensee first sues the Obligated Party for infringement by the Obligated Party of any of the Licensee's Essential Claims covering the same OASIS Standards Final Deliverable and any such Final Maintenance Deliverable.

### 10.2.2 RF on RAND Terms

With TCs operating under the RF on RAND Terms IPR Mode, license terms that are fair, reasonable, and non-discriminatory beyond those specifically mentioned in Section 10.2.1 may also be included, and such additional RAND terms are left to the Licensees and Obligated Parties involved.

### 10.2.3 RF on Limited Terms

With TCs operating under the RF on Limited Terms IPR Mode, Obligated Parties may not impose any further conditions or restrictions beyond those specifically mentioned in Section 10.2.1 on the use of any technology or intellectual property rights, or other restrictions on behavior of the Licensee, but may include reasonable, customary terms relating to operation or maintenance of the license relationship, including the following: choice of law and dispute resolution.

### 10.3. Non-Assertion Mode TC Requirements

10.3.1. For an OASIS Standards Final Deliverable developed by a Non-Assertion Mode TC, and any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable, each Obligated Party in such TC hereby makes the following world-wide "OASIS Non-Assertion Covenant". Each Obligated Party in a Non-Assertion Mode TC irrevocably covenants that, subject to Section 10.3.2 and Section 11 of the OASIS IPR Policy, it will not assert any of its Essential Claims covered by its Contribution Obligations or Participation Obligations against any OASIS Party or third party for making, having made, using, marketing, importing, offering to sell, selling, and otherwise distributing Covered Products that implement an OASIS Standards Final Deliverable developed by that TC and Covered Products that implement any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable.

10.3.2. The covenant described in Section 10.3.1 may be suspended or revoked by the Obligated Party with respect to any OASIS Party or third party if that OASIS Party or third party asserts an Essential Claim in a suit first brought against, or attempts in writing to assert an Essential Claim against, a Beneficiary with respect to a Covered Product that implements the same OASIS Standards Final Deliverable or any such Final Maintenance Deliverable.

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?

For parties that are not be willing to have a licensing obligation as arises from participation in a TC, there is an option to withdrawing its participation from the TC within the first 7 days after the approval of a standard (by ballot). Then it has no licensing obligation.

A party cannot back out of licensing obligation that arose from its own contributions.

#### Sources and additional details:

Participation Obligation: A TC Party has a Participation Obligation to license or provide under non-assertion covenant as appropriate for the IPR mode, as described in Section 10, any claims under its patents or patent applications that would be Essential Claims in the then current OASIS Standards Draft Deliverable, if that draft subsequently becomes an OASIS Standards Final Deliverable, even if the TC Party is not a Contributor, when all of the following conditions are met:

An OASIS Standards Final Deliverable is finally approved that incorporates such OASIS Standards Draft Deliverable, either in whole or in part;  
The TC Party has been on, or has been represented by TC Member(s) on such TC for a total of sixty (60) calendar days, which need not be continuous;  
The TC Party is on, or is represented by TC Member(s) on such TC after a period of seven (7) calendar days after the ballot to approve such OASIS Standards Draft Deliverable has elapsed.

## Supplement 6 - Analysis of the IPR policy of OASIS

Once the foregoing conditions are met, that TC Party's Participation Obligation so to license or provide a non-assertion covenant continues with respect to that OASIS Standards Final Deliverable, and any Final Maintenance Deliverable subsequently approved with respect to that OASIS Standards Final Deliverable.

For organizational TC Parties, the membership threshold is met by one or more employees or organizational designees of such Parties having been a TC Member on any 60 calendar days, although any given calendar day is only one day of membership, regardless of the number of participants on that day. Each time a new OASIS Standards Draft Deliverable is approved by the TC, the Participation Obligation adjusts to encompass the material in the latest OASIS Standards Draft Deliverable seven days after such draft has been approved for publication. (IPR Policy, §9.2)

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

The policy explicitly allows parties to include a reciprocity requirement to their licenses.

The allowance of other licensing terms depend on the licensing mode of the TC in question.

The 'RAND mode' and the 'RF on RAND' mode allows for other terms and conditions, as long they are fair, reasonable, and non-discriminatory.

The 'RF on Limited Terms' does not allow other terms and conditions as those specifically listed in the policy (such as reciprocity and defensive termination). It does allow reasonable, customary terms relating to operation or maintenance of the license relationship, including the following: choice of law and dispute resolution.

### Sources and additional details:

**For RAND Mode and RF mode licensing requirements an identical text is in the policy:** At the election of the Obligated Party, such license may include a term requiring the Licensee to grant a reciprocal license to its Essential Claims (if any) covering the same OASIS Standards Final Deliverable and any such Final Maintenance Deliverable. Such term may require the Licensee to grant licenses to all implementers of such deliverable. The Obligated Party may also include a term providing that such license may be suspended with respect to the Licensee if that Licensee first sues the Obligated Party for infringement by the Obligated Party of any of the Licensee's Essential Claims covering the same OASIS Standards Final Deliverable or any such Final Maintenance Deliverable. (Same text appears both as §10.1 and as §10.2.1)

**For the RAND mode, at §10.1:** License terms that are fair, reasonable, and non-discriminatory beyond those specifically mentioned above are left to the Licensees and Obligated Parties involved.

**For the RF on RAND mode, at 10.2.2:** With TCs operating under the RF on RAND Terms IPR Mode, license terms that are fair, reasonable, and non-discriminatory beyond those specifically mentioned in Section 10.2.1 may also be included, and such additional RAND terms are left to the Licensees and Obligated Parties involved.

**For the RF on Limited Terms mode, at §10.2.3:** With TCs operating under the RF on Limited Terms IPR Mode, Obligated Parties may not impose any further conditions or restrictions beyond those specifically mentioned in Section 10.2.1 on the use of any technology or intellectual property rights, or other restrictions on behavior of the Licensee, but may include reasonable,

## Supplement 6 - Analysis of the IPR policy of OASIS

---

customary terms relating to operation or maintenance of the license relationship, including the following: choice of law and dispute resolution.

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?

If a licensing commitment arises because of participation in a TC, then the commitment covers any essential patents for that TC.

If a licensing commitment arises because of contribution (but not participation), then the commitment covers any essential patents covered by that contributions.

### Sources and additional details:

See at Question D1, above.

Each Contribution of technical work received by OASIS is submitted to one specific OASIS Committee, not the Consortium as a whole. Licensing obligations for a Contribution are tied directly to the Committee which received it. Parties who submit Contributions to one OASIS Committee are not obligated to grant licenses to implement specifications developed by other Committees, although OASIS does encourage submissions to multiple Committees when warranted. (IPR FAQ §3.2)

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

No, the policy explicitly states the commitment is only for patents that are eventually essential for an approved standard.

### Sources and additional details:

Licensing obligations (whether through contribution or participation) apply only to patents having essential claims that would be necessarily infringed by an implementation of an approved Committee Specification or an OASIS Standard. (IPR FAQ, §3.3)

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 licensing obligation is explicitly defined to be worldwide. There is no relation between disclosure and licensing obligation.

### Sources and additional details:

From the IPR policy, at §10: [...] it will grant to any OASIS Party or third party: a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant) under its Essential Claims covered by its Contribution Obligations or Participation Obligations on fair, reasonable, and non-discriminatory terms [...]

## Supplement 6 - Analysis of the IPR policy of OASIS

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?

It is explicitly stated that the licensing obligation is only for products that comply with the standard in question.

An OASIS representative clarified: *"It may be useful to note that some read this to conclude that an implementation which falls out of compliance with a standard's conformance requirements also falls out of the protection of these license grants."*

### Sources and additional details:

From the IPR policy, at §10:

10.1 RAND Mode TC Requirements  
[...] a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant) under its Essential Claims covered by its Contribution Obligations or Participation Obligations on fair, reasonable, and non-discriminatory terms to make, have made, use, market, import, offer to sell, and sell, and to otherwise directly or indirectly distribute (a) Licensed Products that implement such OASIS Standards Final Deliverable, and (b) Licensed Products that implement any Final Maintenance Deliverable with respect to that OASIS Standards Final Deliverable. Such license need not extend to features of a Licensed Product that are not required to comply with the Normative Portions of such OASIS Standards Final Deliverable or Final Maintenance Deliverable.

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.)

No.

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)?

It is explicitly states that licensing obligations are irrevocable ('perpetual'). Defensive suspension conditions and reciprocity conditions are both explicitly allowed.

### Sources and additional details:

From the IPR policy, at §10: [...] it will grant to any OASIS Party or third party: a nonexclusive, worldwide, non-sublicensable, perpetual patent license (or an equivalent non-assertion covenant) under its Essential Claims covered by its Contribution Obligations or Participation Obligations on fair, reasonable, and non-discriminatory terms [...]

Obligated Party may also include a term providing that such license may be suspended with respect to the Licensee if that Licensee first sues the Obligated Party for infringement by the Obligated Party of any of the Licensee's Essential Claims covering the same OASIS Standards Final Deliverable or any such Final Maintenance Deliverable.

For the Non-assertion mode, at §10.3.2. The covenant described in Section 10.3.1 may be suspended or revoked by the Obligated Party with respect to any OASIS

## Supplement 6 - Analysis of the IPR policy of OASIS

---

Party or third party if that OASIS Party or third party asserts an Essential Claim in a suit first brought against, or attempts in writing to assert an Essential Claim against, a Beneficiary with respect to a Covered Product that implements the same OASIS Standards Final Deliverable or any such Final Maintenance Deliverable.

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

The policy has a provision that to address bankruptcy situations in specific.

An OASIS representative clarified: *“Outside of insolvency proceedings, the policy relies on existing law regarding the degree to which a patent, subject to an encumbrance, continues to be burdened by that encumbrance after its transfer.”*

### Sources and additional details:

13.3. Solely for purposes of Section 365(n) of Title 11, United States Bankruptcy Code, and any equivalent law in any foreign jurisdiction, the promises under Section 10 will be treated as if they were a license and any OASIS Party or third-party may elect to retain its rights under this promise if Obligated Party, as a debtor in possession, or a bankruptcy trustee in a case under the United States Bankruptcy Code, rejects any obligations stated in Section 10. (IPR Policy, at §13.3)

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

The policy has no elements relating to ex-ante disclosure if licensing terms.

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 or OASIS practices have no elements relating to patent pools.

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?

Yes. Each OASIS TC’s IPR page documents all disclosures received by OASIS, principally from its members, in relation to the work of that Committee. Information on TC Participants and their respective participation periods also is posted at the OASIS web site. (IPR FAQ § 3.1)

## Part E: SDO procedures and public

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

An OASIS representative clarified: *“OASIS would not expect generally to be a necessary direct party to an action by a beneficiary (e.g., a user of a final standard) to compel a license from a contributing*

## Supplement 6 - Analysis of the IPR policy of OASIS

*participant, on the strength of its reliance on, or third party beneficiary interest in, the participant's undertakings in the OASIS IPR policy."*

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 does not allow such a choice, apart from those companies that normally would have licensing obligations on the basis of TC participation but decide to withdraw the TC within 7 days after the approval (ballot) of the standard (see question D7).

Companies that do not have licensing obligations (these that do not participate or do not have an obligation resulting from contributing) may decide not to enter into licensing commitments.

If it becomes clear that some parties own essential IPR but are not committed to license, a TC can nevertheless vote but the approval might be delayed to 'facilitate the reception of assurances'.

What happens if assurances are not received in the end does not seem to be defined in the policy (e.g. whether the standard is never approved, or technical workaround are sought that does not cover the essential patent).

### Sources and additional details:

13.2.2. Where the OASIS TC Administrator is formally notified of rights, or claimed rights under Section 8.8 with respect to entities other than Obligated Parties, the OASIS President shall attempt to obtain from the claimant of such rights a written assurance that any Licensee will be able to obtain the right to utilize, use, and distribute the technology or works when implementing, using, or distributing technology based upon the specific OASIS Standards Final Deliverable (or, in the case of an OASIS Standards Draft Deliverable, that any Licensee will then be able to obtain such a right) under terms that are consistent with this Policy. All such information will be made available to the TC that produced such deliverable, but the failure to obtain such written assurance shall not prevent votes from being conducted, except that the OASIS TC Administrator may defer approval for a reasonable period of time where a delay may facilitate the obtaining of such assurances. The results will, however, be recorded by the OASIS TC Administrator, and made available to the public. The OASIS Board of Directors may also direct that a summary of the results be included in any published OASIS Standards Final Deliverable. (IPR Policy at 13.2.2)

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 Question C4.

### Sources and additional details:

13.2. Where any copyrights, trademarks, patents, patent applications, or other proprietary rights are known, or claimed, with respect to any OASIS Deliverable and are formally brought to the attention of the OASIS TC Administrator, OASIS shall consider appropriate action, which may include disclosure of the existence of such rights, or claimed rights. The OASIS Technical Committee Process shall prescribe the method for providing this information. (IPR Policy at 13.2)

13.2.2. Where the OASIS TC Administrator is formally notified of rights, or claimed rights under Section 8.8 with respect to entities other than Obligated Parties, the OASIS President shall attempt to obtain from the claimant of such rights a written assurance that any Licensee will be able to obtain the right to utilize, use, and distribute the technology or works



## Supplement 6 - Analysis of the IPR policy of OASIS

when implementing, using, or distributing technology based upon the specific OASIS Standards Final Deliverable (or, in the case of an OASIS Standards Draft Deliverable, that any Licensee will then be able to obtain such a right) under terms that are consistent with this Policy. All such information will be made available to the TC that produced such deliverable, but the failure to obtain such written assurance shall not prevent votes from being conducted, except that the OASIS TC Administrator may defer approval for a reasonable period of time where a delay may facilitate the obtaining of such assurances. The results will, however, be recorded by the OASIS TC Administrator, and made available to the public. The OASIS Board of Directors may also direct that a summary of the results be included in any published OASIS Standards Final Deliverable. (IPR Policy at 13.2.2)

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?

Not specified in policy.

### 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?

Have not found 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 OASIS representative clarified: “[It is] public data, and thus potentially treated as known prior art. Specified in the TC Process policy: <https://www.oasis-open.org/policies-guidelines/tc-process#visibility>”

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.)

Although it is called an IPR policy, which has IPR modes, the actual disclosure and commitment rules refer to patents (and patent claims) only.

An OASIS representative clarified: “See the separate treatment of copyrights and trademarks conveyed as part of a contribution, in Section 5: <https://www.oasis-open.org/policies-guidelines/ipr#contributions>. However, OASIS TCs do not create software as we understand it, so there is no need (for example) for an outgoing software-specific license to benefit users.”

13.2. Where any copyrights, trademarks, patents, patent applications, or

## Supplement 6 - Analysis of the IPR policy of OASIS

---

other proprietary rights are known, or claimed, with respect to any OASIS Deliverable and are formally brought to the attention of the OASIS TC Administrator, OASIS shall consider appropriate action, which may include disclosure of the existence of such rights, or claimed rights. The OASIS Technical Committee Process shall prescribe the method for providing this information. (IPR Policy at 13.2)

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

OASIS is the only standard developer that has explicit rules in its policy on how changes in policy affect existing stakeholders, by providing 'instructions for transition'. This was indeed done for the 2005 policy change.

*An OASIS representative clarified: "Note that (1) our membership agreement contractually obligates members to the IPR policy, as it changes from time to time, with each version applying to the standards approved during its pendency, but also (2) OASIS is obligated explicitly to inform members of changes to the IPR Policy, thereby giving them a withdrawal opportunity before they are bound to the changed terms. Thus the '60 days' below."*

### Sources and additional details:

The OASIS Board of Directors may amend this Policy at any time in its sole discretion. In the event of such change to this Policy, the Board will provide instructions for transition of membership and Technical Committees to the new Policy; however, no amendment to this Policy will be effective in less than 60 calendar days from the date that written notice of such amendment is given to the Member at its address of record with OASIS. (IPR Policy § 1)

### Additional aspects.

OASIS is the only standard developer that has explicit rules in its policy on how changes in policy affect existing stakeholders, by providing 'instructions for transition'. This was indeed done for the 2005 policy change.

### Sources and additional details:

The OASIS Board of Directors may amend this Policy at any time in its sole discretion. In the event of such change to this Policy, the Board will provide instructions for transition of membership and Technical Committees to the new Policy; however, no amendment to this Policy will be effective in less than 60 calendar days from the date that written notice of such amendment is given to the Member at its address of record with OASIS. (IPR Policy § 1)

OASIS explicitly states that its policy is designed to encourage the submission of existing technical work (IPR FAQ, at §1)