

Analysis of the IPR policy of the HDMI Forum

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.tn.tue.nl/rbekkers/nas>

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This analysis has the following parts:

Part A: Adoption and general aspects of the IPR policy

Part B: Formal aspects and principles of the IPR policy

Part C: Patent disclosure

-- general

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

-- relating to standard

-- relating to patent identities

-- other

Part D: Licensing commitments

Part E: SDO procedures and public

Part F: Conflicts and enforcement

Part G: Other

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

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

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

Short introduction and summary

The IPR policy of the HDMI Forum has several unusual features. The FORUM aims to further develop one single standard (known as HDMI) and the initial version of this standard was already there before the Forum was established.

With over 2 billion HDMI-enabled devices being sold to date (www.hdmiforum.org) and over 100 companies that implement the specification (<http://en.wikipedia.org/wiki/HDMI>) this standard can be seen as a substantial success.

The development of the original HDMI standard, up to a version known as 1.4b, was the activity of a closed group of seven companies. IPR on these versions of the standard is owned by the 'HDMI Founders' and they license it (and continue to do so) for a fee via a collective licensing programme administered by HDMI Licensing, LLC.

In October 2011, this was turned into an open standard, by the creation of the HDMI Forum. Now other companies can join and contribute to the development of the standard. Additional IPR essential to newer versions of the standard, as developed by the Forum, is subject to a non-assert obligation that each Forum member agrees to. Beneficiary of the non-assert covenant are any member or licensee of the Forum. Having a non-assert obligation, these patent owners receive no

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compensation for these patents, but the Forum has the right to charge fees for the non-assert agreements.

Part A: Adoption and general aspects of the IPR policy

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

The formal policy is Annex C of the following document:

Bylaws of the HDMI Forum, dated 25-10-2011

The document is not publicly available via the Forum's website, but was provided by us on request.

For the purpose of this analysis, we will refer to the 'Bylaws' as the full document, and to 'IPR Policy' as just to Annex C of that document.

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

Since the HDMI Forum was established in September 2011, we must assume that this is the first version of the IPR Policy

Part B: Formal aspects and principles of the IPR policy

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

The IPR Policy constitutes a part of the Bylaws, which are binding to members.

Sources and additional details:

"IPR Policy" means the policy as set out in Annex C hereto and constitutes part of the Bylaws. (Bylaws, at §2)

This Intellectual Property Policy (hereinafter mentioned as "IPR Policy") is designed to fix the scope of activity to state clearly the expectation of the Forum, with regard to any Member's IPRs, as well as IPRs of the Forum, the HDMI Founders and the HDMI Licensing, LLC, respectively, and this IPR Policy shall apply to any Member effective as of the date such Member becoming a Member. (IPR Policy, page 1)

Each Member agrees to abide by the terms of this IPR Policy including with respect to any Final Specifications, which were adopted during its Membership. In addition to all contractual remedies which may be available to the Forum and its Members and Licensee under applicable law, Members failing to abide by this IPR Policy are subject to termination from the

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Forum in accordance with Section 4.8.3 of these Bylaws. (IPR Policy, page 1)

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

Membership is open to any company or other organization. All the rules are identical for any member. Note, however, that the 'HDMI members' are not bound for the non-assertion obligation as far it concerns the 'original standard' (see also below).

Sources and additional details:

"Member" shall mean an Entity which has qualified as a member of the Forum pursuant to the Bylaws and continues to comply with the requirements as set forth in these Bylaws. (Bylaws, at §2)

"Membership" means the status of being a Member of the Forum. (Bylaws, at §2)

"Entity" means any corporation, partnership, joint venture, association, joint-stock company, trust, unincorporated organization or governmental body or other legal entity having interest in participating in one of the activities of the Forum. (Bylaws, at §2)

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

The policy (and, explicitly, the non-assert obligation) is binding as well to parent companies, subsidiaries or itself, and other subsidiaries of the parent firms.

Sources and additional details:

"Affiliate" or "Affiliates" means any entity, now or hereafter, that is controlled by, under common control with or that controls the subject party. For purposes of this definition "control" means direct or indirect control of more than fifty percent (50%) of the voting power to elect directors of a corporation in the case of a corporate entity, or for any other entity, the power to direct management of such entity. (Bylaws, at §2)

1. Patent Non-Assertion.

Covenant to Not Assert. Effective upon adoption by the Forum of the Final Specification, each Member and its Affiliates (each acting as a Patent Owner) hereby agrees not to bring, commence, maintain or prosecute any action or other proceeding based on any Necessary Claims that they may now or in the future own or control, or to otherwise assert any such Necessary Claims, worldwide, against any Licensee or their Affiliates (each acting as a Patent Beneficiary), solely to make (including design and develop), have made (including have designed and have developed), use, import, and directly and indirectly, offer to sell, sell, lease, promote and otherwise distribute Compliant Portions; provided that such non-assertion agreement shall not extend to any part or function of a product in which a Compliant Portion is incorporated that is not itself a Compliant Portion. (IPR Policy, § 1).

Part C: Patent disclosure

Patent disclosure, general

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

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The policy does not include a disclosure element.

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).

N/A

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)?

N/A

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

N/A (see also Question E3)

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?

N/A

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

N/A

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

N/A

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

N/A

Patent disclosure, relating to standard

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

The definition is basically technical essentiality. It is explicitly states that there can not be another *non-infringing* implementation. (Most IPR policies just refer to any other implementation)

Enabling technologies are excluded.

Sources and additional details:

"Necessary Claims" means the claims of all patents, and patent applications to the extent such applications issue as patents throughout the world, which are necessarily infringed in order to implement and comply with the Final Specification, where such infringement could not have been avoided by another non-infringing implementation of such Final Specification. Necessary Claims shall not include: (a) claims necessarily infringed to implement and comply solely with the Formerly Adopted Specification; (b) informative implementation examples included in the Final Specification; (c) claims, which if subject to the non-assertion covenant hereunder, would require the payment of monetary consideration by the party making the non-assertion covenant to third parties (which shall not include Affiliates or employees within the scope of their employment); (d) claims relating to semi-conductor materials, semi-conductor manufacturing apparatus, semi-conductor manufacturing methods, semi-conductor circuit designs; (e) claims relating to copy protection technology; (f) claims necessarily infringed to make a compliant implementation with non-HDMI industry standards (including, without limitation, HDCP, E-DDC, E-EDID, I2C, CEA861 and Project 50) referenced in Formerly Adopted Specifications or the Final Specifications, except to the extent that such claims are necessarily infringed to make a compliant implementation of those portions of the HDMI on the product which or comply with corresponding non-HDMI industry standards; or (g) claims not necessarily infringed in implementing and complying with the Final Specification even if in the same patent as Necessary Claims. (Bylaws, at §2)

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).

N/A

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

There is no disclosure policy, but the non-assert obligation also holds for optional and 'alternative' portions of the standard.

Sources and additional details:

"Compliant Portion" means only those specific portions of a product (hardware, software or combinations thereof) that implement and are compliant with all relevant Normative Requirements of the Final Specification. "Normative Requirements" means those portions of the Final Specification, including text, design features, and tables, that are expressly identified as required for compliance with the Final Specification including those portions of an optional or alternative portion of the Final Specification that are identified as required for compliance with such

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optional or alternative portion. For clarity, those portions of the Final Specification, including any portions of an optional or alternative portion thereof, which are designated by the terms "must", "shall", "mandatory", "normative" or "required" are expressly identified as being required for compliance. For the avoidance of doubt, Compliant Portion does not include any portions of a product that implement and are compliant solely with Formerly Adopted Specifications. In the event that a product contains one or more portions that implement and are compliant with, respectively, the Final Specifications and the Formerly Adopted Specifications, such portions shall collectively be considered a Compliant Portion. (Bylaws, at §2)

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?

N/A

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?

There is no disclosure, yet the IPR rules as such also cover patent applications. They also include copyrights and all other intellectual property rights conferred by statute or law.

Sources and additional details:

"Necessary Claims" means the claims of all patents, and patent applications to the extent such applications issue as patents throughout the world, [...] (Bylaws, at §2)

"IPRs" mean patent rights, utility model rights, rights deriving from inventor's certificates and other equivalent rights under any laws or international treaties or conventions, technical information, know-how, trade secrets, copyrights, and other intellectual property rights conferred by statute or law. (Bylaws, at §2)

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

There is no disclosure obligation as such. See Question D11 for geographic scope of non-assert obligations.

Patent disclosure, other

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

N/A

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?

N/A

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)

N/A

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?

N/A

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?

N/A

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?

N/A

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.

Members agree not to assert any of their essential patents to other members or to licensed implementers. This obligation does not exist for patents that were already essential to the earlier version of the HDMA standard, before the Forum was established.

The non-assert obligation has a direct effect and does not require a further statement or (licensing) contract between the IPR owner and the Forum, member of implementer.

Whereas the patent owner with a non-assert obligation cannot require a license and/or licensing fees, the Forum itself is entitled to "to establish and charge fees for the non-assertion agreements and other rights set forth in this IPR Policy."

We assume that the latter fee (which seems to be the 'royalty' mentioned in the FAQ) is not to be seen as a patent license fee, since that is impossible if a patent cannot be asserted, and the Forum is not entitled to do so absent a specific agreement with the IPR holder.

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Then, what fees can and will the Forum ask for? Is it perhaps a copyright license? If so, it would protect the implementation of specifications, merely access to and reproduction of the text of the specifications.

On a smaller note, why does the patent non-assertion clause in §1 not mention that such a non-assertion it is also against Members (not only licensees), whereas the definition of 'patent beneficiary' does include members? (I did not see a clause that Members are automatically also Licensees.)

In contrast to licensed implementers, implementers that only benefit from a non-assert might have the problem with the patent exhaustion doctrine. Suppose a chip maker produces a chip implementing HDMI, a television set manufacturer that buys that chip might be asserted. Is this addressed in any way?

Sources and additional details:

The Forum is committed to an inclusive standard and strives to establish specifications that can be implemented in a compliant manner by any interested party. Therefore, the Forum will only include proprietary technology in the Forum's specifications if the owner of that technology agrees to the non-assert covenants and terms as set forth below. (IPR Policy, at Page 1).

1. Patent Non-Assertion.

Covenant to Not Assert. Effective upon adoption by the Forum of the Final Specification, each Member and its Affiliates (each acting as a Patent Owner) hereby agrees not to bring, commence, maintain or prosecute any action or other proceeding based on any Necessary Claims that they may now or in the future own or control, or to otherwise assert any such Necessary Claims, worldwide, against any Licensee or their Affiliates (each acting as a Patent Beneficiary), solely to make (including design and develop), have made (including have designed and have developed), use, import, and directly and indirectly, offer to sell, sell, lease, promote and otherwise distribute Compliant Portions; provided that such non-assertion agreement shall not extend to any part or function of a product in which a Compliant Portion is incorporated that is not itself a Compliant Portion. (IPR Policy, § 1).

Separate Right to Enforce. Each Patent Beneficiary is a third party beneficiary of the non-assertion and other agreements made by each Patent Owner under this Section 1 of the IPR Policy, and may enforce its rights directly against the Patent Owner. (IPR Policy, § 1).

Royalty Fees. The Forum reserves the right to establish and charge fees for the non-assertion agreements and other rights set forth in this IPR Policy. (IPR Policy, § 1).

And from the HDMI Forum FAQ at <http://www.hdmiforum.org/faq.aspx>

Q: Will there be additional royalties?

A: The HDMI Forum will decide whether there will be any additional royalty for products built using the next version of the HDMI Specification.

We did not fully understand the clause below. Does it refer to a patent license agreement? A license of the copyright? Or does this differ for the two organizations mentioned?

Sources and additional details:

4. Commercial use of the Final Specifications

Commercial use of the Final Specifications requires a separate written

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definitive license agreement to be consummated between Member and the Forum and/or the HDMI Licensing, LLC as appropriate. Members agree that the Forum, each member of the HDMI Founders and the HDMI Licensing, LLC shall have standing and rights to enforce their respective interests in any intellectual property rights covered by this IPR Policy. (IPR Policy, at §4).

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.

No licensing statement are required.

The non-assert obligation start at the moment the a final specification is adopted.

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

No differences between Working Groups, and no differences related to the role of members.

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

No licensing statement are required.

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

The beneficiary of the non-assert covenants are any members or licensees (ie those that take a license from HDMI Forum to implement the specification)

It is not entirely clear to use how a party can become an HDMI Forum Licensee as referred to the Bylaw's definition. Instead, the Forum's FAQ refers to 'Adopter Agreements', but these seem to be contracts between HDMI Licensing, LLC and an implementer, not the Forum. Also, the 'participation agreement' as found in Annex B is effectively for becoming a member.

Sources and additional details:

"Patent **Beneficiary**" means (i) in the case of a Member, Member and its Affiliates and (ii) in the case of a Licensee, a Licensee and its Affiliate, who receives the benefit of the patent non-assert set forth in the IPR policy. (Bylaws, at §2)

"Licensee" means any Entity which takes a license from the HDMI Forum to the Final Specifications. (Bylaws, at §2)

And from the HDMI Forum FAQ at <http://www.hdmiforum.org/faq.aspx>

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Questions about HDMI 1.x Adopters, the Annual Fee, and Royalties

How does this affect the current HDMI v1.x License?

The HDMI Consortium will continue to operate and manage all licenses of the HDMI Specification v1.4b.

How does this affect current HDMI Adopters?

We anticipate no change in the HDMI Adopters' day-to-day relationship with HDMI Licensing, LLC. There is no plan to raise the Annual Fee or change procedures. The Annual Fee is separate from membership fees to join the HDMI Forum.

Current HDMI Adopters have the opportunity to participate in the future development of the HDMI Specification by becoming a Member of the HDMI Forum, but are not required to do so.

Will current Adopters be required to sign a new Adopter Agreement?

Current HDMI Adopters are required to sign an addendum to their current Adopter Agreement if they choose to adopt the next version of the HDMI Specification, but are not required to do so.

Will current Adopters be required to pay an additional Annual Fee if they choose to adopt the next version of the HDMI Specification?

No. There is no additional Annual Fee for HDMI Adopters who choose to license the next version of the HDMI Specification.

Will there be an increase in royalties for current HDMI Adopters?

HDMI Adopters will continue to pay the same royalties on HDMI 1.x products in accordance with the existing Adopter Agreement.

Can non-HDMI Adopters license only the next version of the HDMI Specification?

No. The next version of the HDMI Specification will refer to the HDMI Specification v 1.4b and backwards-compatibility is required. Therefore, any company seeking to develop HDMI-enabled products using the new Specification must also license the HDMI Specification v.1x.

Will there be additional royalties?

The HDMI Forum will decide whether there will be any additional royalty for products built using the next version of the HDMI Specification.

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 policy seeks non-assert covenants for any IPR holder

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?

There does not seem to be an opt-out strategy. Even in case of membership termination, the non-assert obligation survives.

4.10 Survival.

Upon termination in accordance with this Section 4, the ex-Member's rights and obligations under these Bylaws shall cease, except that any obligation as a Member which accrued before such termination, including, but not limited to the obligation of non-assertion covenant and the licenses granted

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by such ex-Member (and its Affiliates) under the IPR Policy (but only within the scope as set forth in Section 7 of the IPR Policy), and the obligations of confidentiality under Section 10.9, shall remain in full force and effect and survive termination. (Bylaws, at §4.10)

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 non-assert obligation is automatically conditioned on individual reciprocity.

(Note: universal reciprocity would have meant that also non-members and non-licensees of the Forum would become indirect beneficiaries of the non-assert obligation, which is probably not what was intended here.

Does the wording 'does not agree to a reciprocal non-assert for all of their Necessary Claims' suggest some action on the side of this patent owner? Or simply this is the case if it does assert its patents?

Sources and additional details:

Conditions to Non-Assertion. Each Patent Owner's non-assertion agreement is conditioned upon the applicable Patent Beneficiary(ies) agreeing to a reciprocal non-assert for the benefit of the Patent Owner. For purposes of clarification, if a Patent Beneficiary(ies) does not agree to a reciprocal non-assert for all of their Necessary Claims (relating to a Final Specification), then the applicable Patent Owner will also have no obligation to not assert Necessary Claims against such Patent Beneficiary(ies). (IPR Policy, at §1).

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?

Any patents that are actually essential to the standard.

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)

N/A, there are no disclosures.

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 geographic scope of the non-assert is throughout the world.

Sources and additional details:

"Necessary Claims" means the claims of all patents, and patent applications to the extent such applications issue as patents throughout the world, which are necessarily infringed in order to implement and comply with the Final

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Specification, [...] (Bylaws, at §2)

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

Yes.

1. Patent Non-Assertion.

Covenant to Not Assert. Effective upon adoption by the Forum of the Final Specification, each Member and its Affiliates (each acting as a Patent Owner) hereby agrees not to bring, commence, maintain or prosecute any action or other proceeding based on any Necessary Claims that they may now or in the future own or control, or to otherwise assert any such Necessary Claims, worldwide, against any Licensee or their Affiliates (each acting as a Patent Beneficiary), solely to make (including design and develop), have made (including have designed and have developed), use, import, and directly and indirectly, offer to sell, sell, lease, promote and otherwise distribute Compliant Portions; provided that such non-assertion agreement shall not extend to any part or function of a product in which a Compliant Portion is incorporated that is not itself a Compliant Portion. (IPR Policy, § 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 non-assert obligations are irrevocable. Even in case of membership termination, the non-assert obligation survives.

4.10 Survival.

Upon termination in accordance with this Section 4, the ex-Member's rights and obligations under these Bylaws shall cease, except that any obligation as a Member which accrued before such termination, including, but not limited to the obligation of non-assertion covenant and the licenses granted by such ex-Member (and its Affiliates) under the IPR Policy (but only within the scope as set forth in Section 7 of the IPR Policy), and the obligations of confidentiality under Section 10.9, shall remain in full force and effect and survive termination. (Bylaws, at §4.10)

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

The policy has a solid set of regulations in case of transfer.

Additionally, non-assert obligations survive membership termination.

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Sources and additional details:

Transfer of Necessary Claims. Any transfer by a Patent Owner to an unaffiliated third party of a patent having Necessary Claims shall be subject to the terms and conditions of this IPR Policy. Any agreement for assigning, exclusively licensing or otherwise transferring the right to enforce Necessary Claims shall include a provision binding the assignee, exclusive licensee or transferee to the same non-assertion agreements to which the Patent Owner was bound. Each Patent Owner further represents and warrants that it has not and agrees that it will not intentionally transfer or encumber its patents that reasonably may contain Necessary Claims or patent applications that reasonably may support Necessary Claims for the purpose of circumventing the obligation to grant non-asserts contained in this IPR Policy. (IPR Policy, at §1).

4.10 Survival.

Upon termination in accordance with this Section 4, the ex-Member's rights and obligations under these Bylaws shall cease, except that any obligation as a Member which accrued before such termination, including, but not limited to the obligation of non-assertion covenant and the licenses granted by such ex-Member (and its Affiliates) under the IPR Policy (but only within the scope as set forth in Section 7 of the IPR Policy), and the obligations of confidentiality under Section 10.9, shall remain in full force and effect and survive termination. (Bylaws, at §4.10)

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

N/A

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?

Yes and no. There is a pool (or joint licensing programme) for the patents of the 'formerly adopted specifications', but it does not apply to the patents that are subject to this patent policy.

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?

N/A.

The public may assume that any (publicly known) member of the Forum as a non-assert obligation.

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)?

The policy includes remedies, which include the termination of membership from the organization.

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Sources and additional details:

Each Member agrees to abide by the terms of this IPR Policy including with respect to any Final Specifications, which were adopted during its Membership. In addition to all contractual remedies which may be available to the Forum and its Members and Licensee under applicable law, Members failing to abide by this IPR Policy are subject to termination from the Forum in accordance with Section 4.8.3 of these Bylaws. (IPR Policy, page 1)

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.

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?

This is not clear to us. While the policy states that it will only include proprietary technology in the Forum's specifications if the owner of that technology agrees to a non-assert covenant, there seems to be no mechanism in which the Forum might be informed about essential IPR held by non-members, and what steps will be taken in such case.

Sources and additional details:

The Forum is committed to an inclusive standard and strives to establish specifications that can be implemented in a compliant manner by any interested party. Therefore, the Forum will only include proprietary technology in the Forum's specifications if the owner of that technology agrees to the non-assert covenants and terms as set forth below. (IPR Policy, at Page 1).

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?

N/A

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?

N/A

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

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to consider whether such information should or should not be considered when examining prior art in (new) patent applications.

The policy provides no information on this. But most likely not, as the adopted specification are not public either.

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.)

The IPR rules also include copyrights. They are treated the same as patents.

Sources and additional details:

"IPRs" mean patent rights, utility model rights, rights deriving from inventor's certificates and other equivalent rights under any laws or international treaties or conventions, technical information, know-how, trade secrets, copyrights, and other intellectual property rights conferred by statute or law. (Bylaws, at §2)

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

This was not entirely clear to us.

Sources and additional details:

Scope. The Forum shall ensure that all Final Specifications approved under its authority shall: (a) be backward-compatible with the Formerly Adopted Specification, and (b) only prescribe technologies related to the bi-directional transmission, retransmission, and reception of audiovisual content, control information, data, and power from one or more source and/or repeater devices to one or more repeater and/or sink devices, by means of physical connectors. For purposes of the foregoing, the physical connectors shall not include an optical connector. In the event that the Forum incorporates technology from any third party generally accepted standard, either in whole or in part, in any Final Specification, Forum should make reference to such standard rather than include it in any Final Specifications. (IPR Policy, at page 1)

"Necessary Claims" means the claims of all patents, and patent applications to the extent such applications issue as patents throughout the world, which are necessarily infringed in order to implement and comply with the Final Specification, where such infringement could not have been avoided by another non-infringing implementation of such Final Specification. Necessary Claims shall not include: (a) claims necessarily infringed to implement and comply solely with the Formerly Adopted Specification; (b) informative implementation examples included in the Final Specification; (c) claims, which if subject to the non-assertion covenant hereunder, would require the payment of monetary consideration by the party making the non-assertion covenant to third parties (which shall not include Affiliates or employees within the scope of their employment); (d) claims relating to semi-conductor materials, semi-conductor manufacturing apparatus, semi-conductor manufacturing methods, semi-conductor circuit designs; (e) claims relating to copy protection technology; (f) claims necessarily infringed to make a compliant implementation with non-HDMI industry standards (including, without limitation, HDCP, E-DDC, E-EDID, I2C, CEA861 and Project 50) referenced in Formerly Adopted Specifications or the Final Specifications, except to the extent that such claims are necessarily infringed to make a

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compliant implementation of those portions of the HDMI on the product which or comply with corresponding non-HDMI industry standards; or (g) claims not necessarily infringed in implementing and complying with the Final Specification even if in the same patent as Necessary Claims. (Bylaws, at §2)

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