

6. Patents

6.1 Definitions

The following terms, when capitalized, have the following meanings:

“*Accepted Letter of Assurance*” and “*Accepted LOA*” shall mean a Letter of Assurance that the IEEE-SA has determined is complete in all material respects and has been posted to the IEEE-SA web site.

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

“*Applicant*” shall mean any prospective licensee for Essential Patent Claims. “*Applicant*” shall include all of its Affiliates.

“*Blanket Letter of Assurance*” shall mean a Letter of Assurance that applies to all Essential Patent Claims for which a Submitter may currently or in the future (except as otherwise provided for in these Bylaws and in the *IEEE-SA Standards Board Operations Manual*) have the ability to license.

“*Compliant Implementation*” shall mean any product (e.g., component, sub-assembly, or end-product) or service that conforms to any mandatory or optional portion of a normative clause of an IEEE Standard.

“*Enabling Technology*” shall mean any technology that may be necessary to make or use any product or portion thereof that complies with the ~~{Proposed}~~ IEEE Standard but is neither explicitly required by nor expressly set forth in the ~~{Proposed}~~ IEEE Standard (e.g., semiconductor manufacturing technology, compiler technology, object-oriented technology, basic operating system technology, and the like).

“*Essential Patent Claim*” shall mean any Patent Claim the usepractice of which was necessary to create a compliant implementation of implement either a mandatory or optional ~~portionsportion~~ of ~~thea~~ normative ~~clausesclause~~ of the ~~{Proposed}~~ IEEE Standard when, at the time of the ~~{Proposed}~~ IEEE ~~Standard’sStandard’s~~ approval, there was no commercially and technically feasible non-infringing alternative implementation method for such mandatory or optional portion of the normative clause. An Essential Patent Claim does not include any Patent Claim that was essential only for Enabling Technology or any claim other than that set forth above even if contained in the same patent as the Essential Patent Claim.

“*Letter of Assurance*” and “*LOA*” shall mean a document, including any attachments, stating the Submitter’s position regarding ownership, enforcement, or licensing of Essential Patent Claims for a specifically referenced IEEE Standard, submitted in a form acceptable to the IEEE-SA.

“*Patent Claim(s)*” shall mean one or more claims in issued patent(s) or pending patent application(s).

“*Prohibitive Order*” shall mean an interim or permanent injunction, exclusion order, or similar adjudicative directive that limits or prevents making, having made, using, selling, offering to sell, or importing a Compliant Implementation.

40 “Reasonable and Good Faith Inquiry” includes, but is not limited to, a Submitter using reasonable efforts
41 to identify and contact those individuals who are from, employed by, or otherwise represent the Submitter
42 and who are known to the Submitter to be current or past participants in the development process of the
43 [Proposed] IEEE Standard identified in a Letter of Assurance, including, but not limited to, participation in
44 a Sponsor Ballot or Working Group. If the Submitter did not or does not have any participants, then a
45 Reasonable and Good Faith Inquiry may include, but is not limited to, the Submitter using reasonable
46 efforts to contact individuals who are from, employed by, or represent the Submitter and who the
47 Submitter believes are most likely to have knowledge about the technology covered by the [Proposed]
48 IEEE Standard.

49 “Reasonable Rate” shall mean appropriate compensation to the patent holder for the practice of an
50 Essential Patent Claim excluding the value, if any, resulting from the inclusion of that Essential Patent
51 Claim’s technology in the IEEE Standard. In addition, determination of such Reasonable Rates should
52 include, but need not be limited to, the consideration of:

- 53 • The value that the functionality of the claimed invention or inventive feature within the Essential
54 Patent Claim contributes to the value of the relevant functionality of the smallest saleable
55 Compliant Implementation that practices the Essential Patent Claim.
- 56
- 57 • The value that the Essential Patent Claim contributes to the smallest saleable Compliant
58 Implementation that practices that claim, in light of the value contributed by all Essential Patent
59 Claims for the same IEEE Standard practiced in that Compliant Implementation.
- 60
- 61 • Existing licenses covering use of the Essential Patent Claim, where such licenses were not
62 obtained under the explicit or implicit threat of a Prohibitive Order, and where the circumstances
63 and resulting licenses are otherwise sufficiently comparable to the circumstances of the
64 contemplated license.
- 65

66 “Reciprocal Licensing” shall mean that the Submitter of an LOA has conditioned its granting of a license
67 for its Essential Patent Claims upon the Applicant’s agreement to grant a license to the Submitter with
68 Reasonable Rates and other reasonable licensing terms and conditions to the Applicant’s Essential Patent
69 Claims, if any, for the referenced IEEE Standard, including any amendments, corrigenda, editions, and
70 revisions. If an LOA references an amendment or corrigendum, the scope of reciprocity includes the base
71 IEEE Standard and its amendments, corrigenda, editions, and revisions.

72 “Statement of Encumbrance” shall mean a specific reference to an Accepted LOA or a general statement
73 in the transfer or assignment agreement that the Patent Claim(s) being transferred or assigned are subject to
74 any encumbrances that may exist as of the effective date of such agreement. An Accepted LOA is an
75 encumbrance.

76 “Submitter” ~~when used in reference to a Letter of Assurance~~ shall mean an individual or an organization
77 that provides a completed Letter of Assurance. A Submitter may or may not hold Essential Patent Claims.
78 “Submitter” shall include all of its Affiliates unless specifically and permissibly excluded.

79 6.2 Policy

80

81 IEEE standards may be drafted in terms that include the use of Essential Patent Claims. If the IEEE
82 receives notice that a [Proposed] IEEE Standard may require the use of a potential Essential Patent Claim,
83 the IEEE shall request licensing assurance, on the IEEE-SA Standards Board approved Letter of Assurance
84 form, from the patent holder or patent applicant. The IEEE shall request this assurance without coercion.

85 The Submitter of ~~the~~ Letter of Assurance may, after Reasonable and Good Faith Inquiry, indicate it is not
86 aware of any Patent Claims that the Submitter may own, control, or have the ability to license that might be

87 or become Essential Patent Claims. If the patent holder or patent applicant provides an assuranceLOA, it
88 should do so as soon as reasonably feasible in the standards development process once the PAR is
89 approved by the IEEE-SA Standards Board. This assuranceLOA should be provided prior to the Standards
90 Board's approval of the standard. An asserted potential Essential Patent Claim for which anlicensing
91 assurance cannot be obtained (e.g., a Letter of Assurancean LOA is not provided or the Letter of
92 AssuranceLOA indicates that licensing assurance is not being provided) shall be referred to the Patent
93 Committee.

94 A Letter of AssuranceThe licensing assurance shall be either:

- 95 a)- A general disclaimer to the effect that the Submitter without conditions will not enforce any
96 present or future Essential Patent Claims against any person or entity making, having made, using,
97 selling, offering to sell, or importing, distributing, or implementing a compliant implementation of
98 any Compliant Implementation that practices the standardEssential Patent Claims for use in
99 conforming with the IEEE Standard; or,
- 100 b)- A statement that a license for a compliant implementation of the standardthe Submitter will be
101 mademake available a license for Essential Patent Claims to an unrestricted number of
102 applicantsApplicants on a worldwide basis without compensation or under reasonable
103 ratesReasonable Rates, with other reasonable terms and conditions that are demonstrably free of
104 any unfair discrimination-- to make, have made, use, sell, offer to sell, or import any Compliant
105 Implementation that practices the Essential Patent Claims for use in conforming with the IEEE
106 Standard. An Accepted LOA that contains such a statement signifies that reasonable terms and
107 conditions, including without compensation or under Reasonable Rates, are sufficient
108 compensation for a license to use those Essential Patent Claims and precludes seeking, or seeking
109 to enforce, a Prohibitive Order except as provided in this policy.

110 At its sole option, the Submitter may provide with its assuranceLetter of Assurance any of the following:
111 (i) a not-to-exceed license fee or rate commitment, (ii) a sample license agreement, or (iii) one or more
112 material licensing terms.

113 Copies of an Accepted LOA may be provided to the working group, but shall not be discussed, at any
114 standards working group meeting.

115 An Accepted Letter of Assurance shall apply to the Submitter, including its Affiliates. The Submitter,
116 however, may specifically exclude certain Affiliates identified in the Letter of Assurance, except that a
117 Submitter shall have no ability to exclude Affiliates if the Submitter has indicated Reciprocal Licensing on
118 an Accepted Letter of Assurance.

119 The Submitter shall not condition a license on the Applicant's agreeing (a) to grant a license to any of the
120 Applicant's Patent Claims that are not Essential Patent Claims for the referenced IEEE standard, or (b) to
121 take a license for any of the Submitter's Patent Claims that are not Essential Patent Claims for the
122 referenced IEEE standard.

123 On a Letter of Assurance, the Submitter may indicate a condition of Reciprocal Licensing. If an Applicant
124 requires compensation under Reciprocal Licensing to its Essential Patent Claims, then a Submitter may
125 require compensation for its Essential Patent Claims from that Applicant even if the Submitter has
126 otherwise indicated that it would make licenses available without compensation.

127 The Submitter and all Affiliates (other than those Affiliates excluded in a Letter of Assurance) shall not,
128 with the intent of circumventing or negating any of the representations and commitments made in the
129 Accepted Letter of Assurance, assign or otherwise transfer any rights in any Essential Patent Claims that
130 are the subject of such Letter of Assurance that they hold, control, or have the ability to license with the
131 intent of circumventing or negating any of the representations and commitments made in suchand for

132 which licensing assurance was provided on the Accepted Letter of Assurance.

133 ~~The Submitter of a~~An Accepted Letter of Assurance ~~shall agree~~is intended to be binding upon any and all
134 assignees and transferees of any Essential Patent Claim covered by such LOA. The Submitter agrees (a) to
135 provide notice of ~~a~~an Accepted Letter of Assurance either through a Statement of Encumbrance or by
136 binding ~~any~~its assignee or transferee to the terms of such Letter of Assurance; and (b) to require its
137 assignee or transferee to (i) agree to similarly provide such notice and (ii) to bind its assignees or
138 transferees to agree to provide such notice as described in (a) and (b).

139 ~~This assurance shall apply to the Submitter and its Affiliates except those Affiliates the Submitter~~
140 ~~specifically excludes on the relevant Letter of Assurance.~~

141 ~~If, after providing a Letter of Assurance~~The Submitter and the Applicant should engage in good faith
142 negotiations (if sought by either party) without unreasonable delay or may litigate or, with the parties'
143 mutual agreement, arbitrate: over patent validity, enforceability, essentiality, or infringement; Reasonable
144 Rates or other reasonable licensing terms and conditions; compensation for unpaid past royalties or a future
145 royalty rate; any defenses or counterclaims; or any other related issues.

146 The Submitter of an Accepted LOA who has committed to make available a license for one or more
147 Essential Patent Claims agrees that it shall neither seek nor seek to enforce a Prohibitive Order based on
148 such Essential Patent Claim(s) in a jurisdiction unless the implementer fails to participate in, or to comply
149 with the IEEE, the outcome of, an adjudication, including an affirming first-level appellate review, if sought
150 by any party within applicable deadlines, in that jurisdiction by one or more courts that have the authority
151 to: determine Reasonable Rates and other reasonable terms and conditions; adjudicate patent validity,
152 enforceability, essentiality, and infringement; award monetary damages; and resolve any defenses and
153 counterclaims. In jurisdictions where the failure to request a Prohibitive Order in a pleading waives the
154 right to seek a Prohibitive Order at a later time, a Submitter may conditionally plead the right to seek a
155 Prohibitive Order to preserve its right to do so later, if and when this policy's conditions for seeking, or
156 seeking to enforce, a Prohibitive Order are met.

157 Nothing in this policy shall preclude a Submitter and an implementer from agreeing to arbitrate over patent
158 validity, enforceability, essentiality, or infringement; Reasonable Rates or other reasonable licensing terms
159 and conditions; compensation for unpaid past royalties or a future royalty rate; any defenses or
160 counterclaims; reciprocal obligations; or any other issues that the parties choose to arbitrate.

161 Nothing in this policy shall preclude a licensor and licensee from voluntarily negotiating any license under
162 terms mutually agreeable to both parties.

163 If a Submitter becomes aware of additional Patent Claim(s) that are not already covered by an
164 existingAccepted Letter of Assurance, that are owned, controlled, or licensable by the Submitter, and that
165 may be or become Essential Patent Claim(s) for the same IEEE Standard ~~but are not the subject of an~~
166 ~~existing Letter of Assurance~~, then such Submitter shall submit a Letter of Assurance stating its position
167 regarding enforcement or licensing of such Patent Claims. For the purposes of this commitment, the
168 Submitter is deemed to be aware if any of the following individuals who are from, employed by, or
169 otherwise represent the Submitter have personal knowledge of additional potential Essential Patent Claims,
170 owned or controlled by the Submitter, related to a [Proposed] IEEE Standard and not already the subject of
171 a previously ~~submitted~~Accepted Letter of Assurance: (a) past or present participants in the development of
172 the [Proposed] IEEE Standard, or (b) the individual executing the previously ~~submitted~~Accepted Letter of
173 Assurance.

174 ~~The assurance~~A Letter of Assurance is irrevocable once submitted and accepted and shall apply, at a
175 minimum, from the date of the standard's approval to the date of the standard's transfer to inactive status.

176 Copies of an Accepted LOA may be provided to participants in a standards development meeting.

177 Discussion of essentiality, interpretation, or validity of Patent Claims is prohibited during IEEE-SA
178 standards-development meetings or other duly authorized IEEE-SA standards-development technical
179 activities. IEEE-SA shall provide procedures stating when and the extent to which patent licensing terms
180 may be discussed (see subclause 5.3.10 of the IEEE-SA Standards Board Operations Manual).

181 The IEEE is not responsible for ~~identifying~~

- 182 1. Identifying Essential Patent Claims for which a license may be required, ~~for conducting inquiries~~
183 ~~into;~~
- 184 2. Determining the ~~legal~~ validity, essentiality, or ~~scope~~ interpretation of ~~these~~ Patent Claims, ~~or for~~
185 ~~determining;~~
- 186 3. Determining whether any licensing terms or conditions provided in connection with submission of
187 a Letter of Assurance, if any, or in any licensing agreements are reasonable or non-
188 discriminatory; ~~or,~~
- 189 4. Determining whether an implementation is a Compliant Implementation.

190 Nothing in this policy shall be interpreted as giving rise to a duty to conduct a patent search. No license is
191 implied by the submission of a Letter of Assurance.

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