

# Understanding Patent Issues During IEEE Standards Development

## Patented Technology in IEEE standards

This guide offers information concerning the IEEE Standards Association and its patent policies but does not state the IEEE-SA Patent Policy. Definitive statements of the IEEE Standard Association's policies and procedures concerning patents can be found in the *IEEE-SA Standards Board Bylaws* and the *IEEE-SA Standards Board Operations Manual*.

A complete package of patent-related materials is available at <http://standards.ieee.org/about/sasb/patcom/materials.html>. This package includes all the documentation you need to comply with the IEEE Standards Association Patent Policy concerning essential patents. A flowchart with additional guidance on the methodologies used by the [IEEE-SA Standards Board Patent Committee](#) is part of this package. If you include patented technology in your standard, then you may have incorporated an essential patent.

## Essential Patent Claims

### 1. *What is an Essential Patent Claim?*

An Essential Patent Claim means any Patent Claim [including claims in issued patent(s) or pending patent application(s)] the use of which was necessary to implement either a mandatory or optional portion of a normative clause of the IEEE Standard when, at the time of the IEEE Standard'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. See clause 6.1 of the IEEE-SA Standards Board Bylaws at <http://standards.ieee.org/develop/policies/bylaws/sect6-7.html#6.1>.

### 2. *Does the IEEE determine whether a patent is essential when seeking a Letter of Assurance?*

No.

## Call for Essential Patents Claims at IEEE Standards Developing Meetings

### 3. *What is a call for patents?*

40 A call for patents is a reminder made by the chair, or the chair's designee, at an IEEE  
41 standards development meeting. The chair or the chair's designee informs the  
42 participants that if any individual believes that Patent Claims might be Essential Patent  
43 Claims, that fact should be made known to the entire working group and duly recorded  
44 in the minutes of the working group meeting.

- 45  
46 4. *How often should a Working Group chair issue a call for potential Essential Patent*  
47 *Claims?*

48  
49 A Working Group chair or his or her designee shall issue the call at every Working  
50 Group meeting. If the Working Group does not meet face-to-face or telephonically, the  
51 Working Group should be issued a call via written communications (electronic or  
52 otherwise) on a regular basis. It is strongly recommended that the IEEE-SA Standards  
53 Board Patent Committee-developed slide set be used. Note that a call for patents shall  
54 be made at every standards development meeting. This includes, but is not limited to,  
55 working group and task force meetings.

- 56  
57 5. *Should a Call for Patents be issued at a Study Group or other pre-PAR meeting?*

58  
59 No. However, it is recommended that the *Patent Slides for pre-PAR Meetings* be used  
60 in these meetings.

- 61  
62 6. *Our group gathers for several days during a single week. Does the chair have to*  
63 *announce the IEEE-SA Patent Policy every day?*

64  
65 The Working Group chair or his or her designee shall issue the call at every Working  
66 Group meeting. If a group is meeting for consecutive days and the attendance is  
67 substantially the same for each day of the gathering, the policy only needs to be read  
68 once. If the chair plans not to read or display the policy each day, then the chair must  
69 either (a) ensure that the policy or a URL for it has been sent out to all attendees prior  
70 to the meeting (and is available in the registration packet for any on-site registrants),  
71 or (b) announce each day that the meeting is subject to the IEEE-SA Patent Policy as  
72 read or displayed on the first day. Note, though, that this rule applies separately to  
73 each group that is meeting during the week. For example, if a working group holds a  
74 meeting during the same week as its task group and/or task force, the chair of each of  
75 those groups must read or display the policy at the beginning of that group's first day  
76 of meeting.

- 77  
78 7. *How does the chair determine that the participation in a group that is meeting for*  
79 *consecutive days is substantially the same?*

80

81 The chair has to use his/her judgment to determine this. It could, for example, be  
82 done based on the attendance numbers each day. The default action is to read the  
83 IEEE-SA Patent Policy slides.

84

85 8. *What if a group meets telephonically?*

86 If the Working Group meets telephonically, you can send the slides in an email to the  
87 participants in advance of the call, or include a link in the meeting announcement. The  
88 chair must then ask at the start of the call whether there is anybody participating that  
89 has not read the policy. If someone says they have not, then the chair must either (a)  
90 read the IEEE-SA Patent Policy slides aloud, or (b) send the policy or URL electronically  
91 and pause the call until all participants have read the policy.

92 9. *What if the group does not meet either in person or by telephone – for example, the*  
93 *group meets only through email or other interactive electronic means?*

94

95 If the group does not meet face-to-face or telephonically, the chair of the group should  
96 issue the call for patents via written communications (electronic or otherwise) on a  
97 regular basis.

98

#### 99 **Letter of Assurance**

100

101 10. *What is a Letter of Assurance?*

102

103 In general, a letter of assurance is a document stating a Submitter's position with  
104 respect to ownership, enforcement, or licensing an Essential Patent Claim that may be  
105 incorporated into a specifically referenced IEEE Standard. The specific requirements for  
106 an IEEE Letter of Assurance are defined in clause 6.1 of the *IEEE-SA Standards Board*  
107 *Bylaws* at <http://standards.ieee.org/develop/policies/bylaws/sect6-7.html#6.1>.

108

109 11. *When does the IEEE send out a request for a Letter of Assurance?*

110

111 The Working Group chair or, where appropriate, the Sponsor chair will send out a  
112 request for a Letter of Assurance whenever the chair is notified, at any time and by  
113 any means, that the [Proposed] IEEE Standard may require the use of a potential  
114 Essential Patent Claim.

115

116 12. *How will a participant know if the IEEE has accepted a Letter of Assurance?*

117

118 Accepted Letters of Assurance can be found on the IEEE-SA's web site at  
119 <http://standards.ieee.org/about/sasb/patcom/patents.html>.

120

121 13. *What happens if the IEEE has not received assurances regarding all potential Essential*  
122 *Patent Claims incorporated in a [Proposed] IEEE Standard?*

123

124 If the IEEE is aware of an asserted potential Essential Patent Claim and no  
125 corresponding Letter of Assurance has been received, the matter will be referred to the  
126 IEEE-SA Standards Board Patent Committee through the PatCom Administrator. The  
127 IEEE-SA Standards Board Patent Committee will review the circumstances and make a  
128 recommendation to the IEEE-SA Standards Board.

- 129  
130 14. *How should Working Groups handle existing Letters of Assurance provided to IEEE*  
131 *when developing an amendment, corrigendum, edition, or revision of the particular*  
132 *standard referenced in the Letter of Assurance?*  
133

134 The Working Group chair shall initiate a request for a new Letter of Assurance from a  
135 known Submitter when re-using portions of, or technologies specified in, an existing  
136 IEEE Standard, amendment, corrigendum, edition, or revision referenced in an  
137 Accepted Letter of Assurance in a different IEEE Standard. For additional details, see  
138 section 6.3.5 of the IEEE-SA Standards Board Operations Manual, *Applicability of*  
139 *Letters of Assurance to Amendments, Corrigenda, Editions, or Revisions.*

- 140  
141 15. *How should Working Groups handle Letters of Assurance when re-using portions of a*  
142 *non-IEEE standard in an IEEE Standard?*  
143

144 The Working Group chair shall initiate a request for a Letter of Assurance from holders  
145 of potential Essential Patent Claims when re-using portions of a non-IEEE standard in  
146 an IEEE Standard. Any patent letters of assurance (or patent declarations) given to the  
147 developer of the non-IEEE standard cannot be stated to also apply to the IEEE  
148 Standard. In addition, there are specific requirements that must be incorporated into  
149 an IEEE Letter of Assurance in order for it to have the possibility of becoming an  
150 Accepted IEEE Letter of Assurance.

151  
152 **Participants and Notification to IEEE of Essential Patent Claims**  
153

- 154 16. *What obligation do individual participants have to notify the IEEE if they own, or their*  
155 *employer owns, potential Essential Patent Claims incorporated in an IEEE Standard?*  
156 *What if they are uncertain whether a Patent Claim they own, or their employer owns,*  
157 *is essential?*  
158

159 Individual participants of a call for patents are required to notify the IEEE of the  
160 identity of a holder of any potential Essential Patent Claims (but not the identity of the  
161 Essential Patent Claim) where (1) the individual participant is personally aware that  
162 the holder may have a potential Essential Patent Claim; (2) the holder is the  
163 participant or an entity the participant is from, employed by, or otherwise represents;  
164 and (3) the potential Essential Patent Claim is not already the subject of an Accepted  
165 Letter of Assurance. If such a participant is uncertain whether the patent is essential,  
166 the participant still shall notify the IEEE (or cause the IEEE to be notified) of the

167 possibility because they are personally aware of a claim that is a *potential* Essential  
168 Patent Claim.

169

170 17. *When is a potential Essential Patent Claim considered to be the subject of an Accepted*  
171 *Letter of Assurance?*

172

173 A potential Essential Patent Claim is the subject of an Accepted Letter of Assurance for  
174 a particular standard (a) if there is an Accepted Letter of Assurance for the potential  
175 Essential Patent Claim or related potential Essential Patent, (b) if there is an Accepted  
176 Blanket Letter of Assurance from the holder of the potential Essential Patent Claim, or  
177 (c) an Accepted Letter of Assurance for the potential Essential Patent Claim exists  
178 under the conditions defined in IEEE-SA Standards Board Operations Manual subclause  
179 6.3.5 *Applicability of Letters of Assurance to Amendments, Corrigenda, Editions, or*  
180 *Revisions* (see question 14).

181

182 18. *How do I find out if a particular company has submitted an Accepted Letter of*  
183 *Assurance?*

184

185 Accepted Letters of Assurance are listed on the IEEE-SA's web site at  
186 <http://standards.ieee.org/about/sasb/patcom/patents.html>. Letters of Assurance  
187 accepted after 31 December 2006 will be posted on the web site as they are accepted  
and Letters of Assurance accepted prior to that date will be posted over time.

188

189 19. *What are examples of the means by which an individual participant can notify the IEEE*  
190 *(or cause the IEEE to be notified) that his or her employer is the holder of a potential*  
191 *Essential Patent Claim incorporated in a [Proposed] IEEE Standard? Does the individual*  
192 *participant need to identify the Essential Patent Claim specifically?*

193

194 An individual participant could fulfill his or her duty to the IEEE by telling the Working  
195 Group chair that his or her employer is the holder of a potential Essential Patent Claim.  
196 Alternatively, the participant could request that his or her employer submit a Letter of  
197 Assurance or otherwise notify the IEEE that it is the holder of a potential Essential  
198 Patent Claim. In the latter case, the participant fulfills his or her duty to the IEEE only  
199 if his or her employer submits a Letter of Assurance or otherwise notifies the IEEE that  
200 it is the holder of a potential Essential Patent Claim. If the employer declines to submit  
201 a Letter of Assurance or otherwise notify the IEEE, the participant will have to tell the  
202 Working Group chair that his or her employer may be the holder of a potential  
203 Essential Patent Claim. In all cases, the duty on the participant is only to inform the  
204 IEEE of the identity of the holder of a potential Essential Patent Claim and not the  
205 patent, application, or particular claim itself. The response to the call for patents only  
206 needs to be made if the response relates to a potential Essential Patent Claim that is  
207 not already the subject of an Accepted Letter of Assurance or request for a Letter of  
208 Assurance.

209 20. *Can a response to the call for patents be made via email in advance or subsequent to a*  
210 *meeting?*

211  
212 The duty on the participant is to inform the IEEE of the identity of the holder of a  
213 potential Essential Patent Claim. The chair can be notified at any time (in advance or  
214 subsequent to a meeting is acceptable). The declaration must be made in a recordable  
215 manner.

216  
217 21. *Do participants have to notify IEEE of third party patent holders? For these purposes,*  
218 *third party means a person other than the participant or an entity the participant is*  
219 *from, employed by, or otherwise represents.*

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

226 22. *What duty does an individual participant have to the IEEE if a participant's employer*  
227 *owns a potential Essential Patent Claim but the individual participant doesn't have*  
228 *personal knowledge of such claim?*

229  
230 As noted in the answer to question 16, a participant only needs to notify the IEEE of  
231 the holder of a potential Essential Patent Claim if such participant is personally aware  
232 that his or her employer has a potential Essential Patent Claim. There is no duty for  
233 that employee (or anyone else in his or her organization) to conduct a patent search,  
234 but the IEEE does expect that participants will conduct themselves in good faith. This  
235 expectation arises both from the IEEE Code of Ethics and from the background legal  
236 rules. The IEEE Code of Ethics makes clear, for example, that participants "accept  
237 responsibility in making decisions consistent with the safety, health and welfare of the  
238 public." Similarly, the U.S. Supreme Court stated in the Allied Tube case that SDOs  
239 operate based on "the merits of objective expert judgments" using "procedures that  
240 prevent the standard-setting process from being biased by members with economic  
241 interests in stifling product competition." Consequently, while the policy does not  
242 require a patent search, the IEEE does encourage each participant to make sufficient  
243 inquiry to satisfy him or herself that s/he is not being deliberately shielded from  
244 relevant knowledge and that the employer does not have any potential Essential Patent  
245 Claims.

246  
247 23. *Can an individual participate in standards development activities if his or her employer*  
248 *is unwilling to submit a Letter of Assurance once requested or provide the assurance*  
249 *indicated in the IEEE-SA Patent Policy in a Letter of Assurance?*

250



251 Yes. As long as the participant complies with the requirement that he or she notify the  
252 IEEE that his or her employer is the holder of a potential Essential Patent Claim if the  
253 participant is personally aware that his or her employer is such a holder, the individual  
254 can continue to participate in standards development activities. See also question 19.  
255

256 24. *Does the IEEE-SA Patent Policy require participants or their employers to make an*  
257 *assurance or submit a Letter of Assurance?*

258 No. Submission of a Letter of Assurance is not a precondition to participation.  
259 Participants do have a duty to inform the IEEE if they or an entity they are from,  
260 employed by, or otherwise represents holds potential Essential Patent Claims. See  
261 questions 16, 21, and 23 for more information.

262 25. *Is the IEEE-SA's Patent Policy a disclosure policy?*  
263

264 No. The IEEE-SA's Patent Policy is a policy of assurance as further described in these  
265 frequently asked questions, not a policy of disclosure.  
266

267 26. *What does a participant's employer need to do to determine whether it has any*  
268 *potential Essential Patent Claims when it receives a request from the IEEE for a Letter*  
269 *of Assurance? Specifically,*  
270

271 (a) *Does the employer need to do a patent search?*  
272

273 No. The policy expressly states that there is no duty to conduct a patent search; but  
274 the employer may do so if it wishes.  
275

276 (b) *Does the employer need to talk to every person they have sent to the Working*  
277 *Group?*  
278

279 When the employer receives the request for a Letter of Assurance, the employer can  
280 state its licensing position with respect to any Patent Claims that might be or become  
281 Essential Patent Claims relating to the particular standard referenced in the Letter of  
282 Assurance. In the alternative, the employer can indicate that it is not aware of any  
283 Patent Claims that the employer may own, control, or have the ability to license that  
284 might be or become Essential Patent Claims, but **only if** the employer does a  
285 Reasonable and Good Faith Inquiry to determine the existence of any such Patent  
286 Claims. As described in clause 6.1 of the IEEE-SA Standards Board Bylaws, a  
287 "Reasonable and Good Faith Inquiry" includes, but is not limited to, the employer using  
288 reasonable efforts to identify and contact those individuals who are from, employed by,  
289 or otherwise represent the employer and who are known to the employer to be current  
290 or past participants in the development process of the [Proposed] IEEE Standard  
291 identified in the Letter of Assurance, including, but not limited to, participation in a  
292 Sponsor Ballot or Working Group. If the Submitter did not or does not have any

293 participants, then a "Reasonable and Good Faith Inquiry" may include, but is not  
294 limited to, the Submitter using reasonable efforts to contact individuals who are from,  
295 employed by, or represent the Submitter *and* who the Submitter believes are most  
296 likely to have knowledge about the technology covered by the [Proposed] IEEE  
297 Standard. As described above, the employer only needs to engage in a Reasonable and  
298 Good Faith Inquiry if it wants to avoid providing an assurance based on its assertion  
299 that it is not aware of any Patent Claims that the employer may own, control, or have  
300 the ability to license that might be or become Essential Patent Claims.

301  
302 **Submitting a Letter of Assurance**

303  
304 27. *Do the terms "potential Essential Patent Claims" and "Patent Claims that the Submitter*  
305 *may own, control, or have the ability to license . . ." include claims described in patent*  
306 *applications?*

307  
308 Yes. The definition of Patent Claims includes pending patent applications.

309  
310 28. *At what point should a Letter of Assurance be submitted?*

311 The IEEE encourages the submission of a Letter of Assurance as soon as reasonably  
312 feasible in the standards development process once the PAR has been approved by the  
313 IEEE-SA Standards Board.

314 29. *Who should submit a Letter of Assurance?*

315  
316 The IEEE will request licensing assurance on the IEEE-SA Standards Board approved  
317 Letter of Assurance form from any person upon being notified that an IEEE Standard  
318 may require the use of a potential Essential Patent Claim. Although the IEEE  
319 encourages any person receiving a request for assurance to submit the Letter of  
320 Assurance, the IEEE may not use any coercion in requesting the assurance. This  
321 means the IEEE cannot require that a person submit a Letter of Assurance or provide a  
322 particular assurance with respect to ownership, enforcement, or licensing of an  
323 Essential Patent Claim in order to participate in an IEEE standards development  
324 activity.

325  
326 Additionally, a Submitter of a Letter of Assurance is required to submit a Letter of  
327 Assurance if, after providing a Letter of Assurance to the IEEE, the Submitter of the  
328 Letter of Assurance becomes aware of additional Patent Claim(s) not already covered  
329 by an Accepted Letter of Assurance as further described in the answer to question 26.  
330 Any person or entity that believes that it holds a potential Essential Patent Claim is  
331 encouraged to submit a Letter of Assurance, even if not specifically requested to do so.

332  
333 30. *Who should sign a Letter of Assurance?*



335 Only a person who is authorized to sign and bind the Submitter (including its Affiliates  
336 unless specifically and permissibly excluded) to the assurance shall sign the Letter of  
337 Assurance. Unless the Letter of Assurance is received from an individual whose title  
338 suggests authority for intellectual property and legal matters, the IEEE-SA Standards  
339 Board Patent Committee Administrator will take follow-up action.  
340

341 31. *What duty does a Submitter have to provide an additional assurance if it becomes*  
342 *aware of additional Essential Patent Claims not already covered by an Accepted Letter*  
343 *of Assurance?*  
344

345 If a Submitter becomes aware of additional Patent Claim(s) that are not already  
346 covered by an Accepted Letter of Assurance, that are owned, controlled, or licensable  
347 by the Submitter, and that may be or become Essential Patent Claim(s) for the same  
348 IEEE Standard, then such Submitter shall submit a Letter of Assurance stating its  
349 position regarding enforcement or licensing of such Patent Claims. For the purposes of  
350 this commitment, the Submitter is deemed to be aware if any of the following  
351 individuals who are from, employed by, or otherwise represent the Submitter have  
352 personal knowledge of additional potential Essential Patent Claims, owned or controlled  
353 by the Submitter, related to a [Proposed] IEEE Standard and not already the subject of  
354 a previously Accepted Letter of Assurance: (a) past or present participants in the  
355 development of the [Proposed] IEEE Standard; or (b) the individual executing the  
356 previously Accepted Letter of Assurance. See also question 29.  
357

358 32. *Can the Letter of Assurance form be modified?*

359 No. In submitting a Letter of Assurance, usage of the IEEE LOA form is mandatory.  
360 (Completing the form is not considered a modification.)

361 33. *What happens when a Letter of Assurance is not accepted?*  
362

363 The Submitter will be informed by the PatCom Administrator that the Letter of  
364 Assurance was not accepted and why it was not accepted.  
365

366 34. *Are attachments a part of the Accepted Letter of Assurance?*  
367

368 Yes. See also question 51.  
369

370 35. *Who can enforce an Accepted Letter of Assurance?*  
371

372 Users and implementers may seek to enforce the terms of any Accepted Letter of  
373 Assurance. In certain circumstances and at its sole discretion, the IEEE may also seek  
374 to enforce the terms of an Accepted Letter of Assurance.  
375

376 **Affiliates**

377  
378  
379  
380  
381  
382  
383  
384  
385  
386  
387  
388  
389  
390  
391  
392  
393  
394  
395  
396  
397  
398  
399  
400  
401  
402  
403  
404  
405  
406  
407  
408  
409  
410  
411  
412  
413  
414  
415  
416  
417  
418

36. *Who is an Affiliate?*

An Affiliate is 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, or 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. See clause 6.1 of the *IEEE-SA Standards Board Bylaws* available at <http://standards.ieee.org/develop/policies/bylaws/sect6-7.html#6.1>. For example, the parent corporation of a Submitter, any brother or sister corporation of the Submitter, and any Submitter subsidiary in which the Submitter owns more than 50% are considered Affiliates.

37. *Does the Letter of Assurance bind the Submitter's Affiliates?*

Yes, other than those Affiliates permissibly excluded in a Letter of Assurance. Note that a Submitter cannot exclude Affiliates if the Submitter has indicated Reciprocal Licensing on an Accepted Letter of Assurance.

**Application of LOA to Successors of Essential Patent Claims Covered by LOA**

38. *What does the Submitter of an Accepted Letter of Assurance have to do if the Submitter transfers one or more Essential Patent Claims covered by the Letter of Assurance to a third party?*

The Submitter of an Accepted Letter of Assurance is required to provide notice of the Letter of Assurance to any assignee or transferee of any Essential Patent Claims covered by the Letter of Assurance. That notice can be provided by notifying the assignee or transferee that the Essential Patent Claims are subject to an Accepted Letter of Assurance or by a general statement in the transfer or assignment agreement that the Essential Patent Claims being transferred or assigned are subject to any encumbrances that may exist as of the effective date of such agreement.

In addition, the Submitter shall require that the assignee or transferee agree to provide the same notice to any subsequent assignees or transferees and require its subsequent assignees or transferees to do the same.

419 39. *Does the Submitter have any responsibility to ensure that its assignees and*  
420 *transferees provide notice of an Accepted Letter of Assurance to subsequent*  
421 *transferees?*  
422

423 No. As long as the Submitter provides the required notice to its assignees and  
424 transferees and requires that its assignees and transferees agree to provide the  
425 required notice and bind its assignees and transferees to the same, the Submitter is  
426 not responsible for the actions of any downstream assignees and transferees.  
427

428 **Compliant Implementation**

429  
430 40. *Why does the definition of Compliant Implementation include the phrase “component,*  
431 *sub-assembly, or end-product”?*  
432

433 Compliant Implementation is defined as “...any product (e.g., component, sub-  
434 assembly, or end-product) or service that conforms to any mandatory or optional  
435 portion of a normative clause of an IEEE Standard” to reflect how IEEE standards are  
436 written and how they are implemented in the marketplace. The examples of any  
437 product (“component, sub-assembly, or end-product”) are included for clarity.  
438

439 41. *Can a Submitter offer a license to an Essential Patent Claim for use only to conform to*  
440 *the IEEE Standard?*  
441

442 Yes. A Submitter’s commitment is to make available licenses “to make, have made,  
443 use, sell, offer to sell, or import any Compliant Implementation that implements the  
444 Essential Patent Claims for use in conforming with the IEEE Standard.” A Submitter  
445 may limit its license to cover only implementations that are created for use in  
446 conforming with the IEEE Standard. The Submitter is free to offer a license that is  
447 broader than what the policy requires but must make available at least the license  
448 required under the policy.  
449

450 42. *Who determines whether a product is a Compliant Implementation?*  
451

452 Third-party organizations conduct conformity/compliance assessments for some IEEE  
453 Standards. For other IEEE Standards, there may not be any third-party compliance or  
454 conformance program. Ultimately, determination of compliance or conformance is left  
455 to implementers, their customers, Submitters, and, if necessary, courts.  
456

457 **Reasonable Rates**

458  
459 43. *In discussing Reasonable Rates, what is an example of the value that is excluded in*  
460 *the statement: “...excluding the value, if any, resulting from the inclusion of that*  
461 *Essential Patent Claim’s technology in the IEEE Standard”?*  
462

463 The IEEE-SA Patent Policy states that a “Reasonable Rate shall mean appropriate  
464 compensation to the patent holder for the practice of an Essential Patent Claim  
465 excluding the value, if any, resulting from the inclusion of that Essential Patent Claim’s  
466 technology in the IEEE Standard.” For example, during the development of a  
467 standard, a working group considers alternatives and makes a decision based on many  
468 factors. Suppose two and only two alternative technologies are available, both  
469 patented and both offering the same performance, implementation cost, and all other  
470 qualities. Therefore, the value of the two options is exactly the same, although only  
471 one will be selected. Any incremental value imputed to the selected option because of  
472 its inclusion in the standard is excluded.

- 473  
474 44. *In discussing Reasonable Rates, what is an example of the “value of the relevant  
475 functionality of the smallest saleable Compliant Implementation”?*

476  
477 The smallest saleable Compliant Implementation (e.g., an integrated circuit, a service,  
478 a sub-assembly of multiple components into a circuit card or other intermediate  
479 product) that practices an Essential Patent Claim may have multiple functions. For  
480 example, if an integrated circuit implements IEEE Standard 802.11™, 4G LTE™ and  
481 Bluetooth™ but the Essential Patent Claim relates only to the circuit’s IEEE 802.11  
482 function, then the “relevant functionality” is only that IEEE 802.11 functionality. The  
483 parties should consider the value contributed by the Essential Patent Claim’s claimed  
484 invention to that relevant functionality.

- 485  
486 45. *In discussing Reasonable Rates, what is an example of a “smallest saleable Compliant  
487 Implementation that practices the Essential Patent Claim”?*

488  
489 Determining the smallest saleable Compliant Implementation that practices the  
490 Essential Patent Claim is a function both of the claims in the patent and of the product  
491 or products that implement a standard. For example, an airplane might include an  
492 entertainment system that itself includes an IEEE 802.11 compliant chip that practices  
493 the Essential Patent Claim. In this example, the chip is the smallest saleable  
494 Compliant Implementation.

- 495  
496 46. *In discussing Reasonable Rates, what is an example of considering “...in light of the  
497 value contributed by all Essential Patent Claims for the same IEEE Standard practiced  
498 in that Compliant Implementation”?*

499  
500 Many IEEE Standards require the use of multiple Essential Patent Claims to create a  
501 Compliant Implementation. If the value of any given Essential Patent Claim is viewed  
502 in isolation from other Essential Patent Claims, then the resulting determination of  
503 value for that single patent may be inappropriate. For example, suppose a standard  
504 requires implementation of 100 Essential Patent Claims of equal value held by 100  
505 Submitters. If each Submitter were to be entitled to a royalty of 2% of the  
506 implementation’s selling price, then the implementation would never be produced  
507 because the total royalties (200% of the implementation’s selling price) would exceed

any possible selling price. Therefore, when determining a Reasonable Rate, the value of all the Essential Patent Claims should be considered. In practice, the number and value of the Essential Patent Claims and the structure of requested royalties won't be as simple as in the example; however, at some point, the parties (or court) can agree that they have sufficient information to make a determination.

47. *In discussing Reasonable Rates, what are some examples of an "explicit or implicit threat of a Prohibitive Order?"*

A patent holder's request that a court issue a Prohibitive Order against an implementer who does not have a license would be an example of an explicit threat. A patent holder's suggestion to an implementer that the patent holder could seek a Prohibitive Order if the implementer does not agree to the requested rate would be an example of an implicit threat.

48. *In discussing Reasonable Rates, are other considerations allowable in addition to those listed?*

Yes. The IEEE-SA Patent Policy recommends considerations for use in determining a Reasonable Rate. The policy does not prevent parties from considering additional factors in negotiating license terms if both parties believe those additional factors are appropriate.

### **Licensing Terms Provided with Letters of Assurance**

49. *A Submitter of a Letter of Assurance is permitted to provide a not-to-exceed license fee or rate commitment. What is the purpose of permitting a Submitter to provide a not-to-exceed license fee or rate commitment?*

The purpose of the policy is to facilitate the development of standards that will serve the interests of industry, government, and the public. Relative costs of implementation for different proposed technical approaches in comparison with the relative technical performance increases or decreases of those proposals is a legitimate topic for discussion and a legitimate basis for decision-making in the standards development process. The policy attempts to provide participants with greater certainty and precision in their understanding of relative costs.

50. *Is a Submitter of a Letter of Assurance required to provide a not-to-exceed license fee or rate commitment?*

No. The IEEE permits, but does not require, the Submitter to provide not-to-exceed royalty rates or other terms.

51. *Does the IEEE make a judgment about whether any terms provided with the Letter of Assurance are reasonable or non-discriminatory?*

553  
554  
555  
556  
557  
558  
559

No. The IEEE is not responsible for determining whether any licensing terms or conditions provided in connection with submission of a Letter of Assurance, if any, or in any licensing agreements are reasonable or non-discriminatory. Acceptance of a Letter of Assurance does not imply that the IEEE has made any determination of the foregoing.

560 52. *Can a Submitter demand a license to a prospective licensee's non-essential patent*  
561 *claims?*

562  
563  
564  
565  
566  
567  
568

No. A Submitter cannot, as a condition of granting a license to an Essential Patent Claim, require a prospective licensee to grant licenses to patent claims that are not Essential Patent Claims for the referenced IEEE standard. The IEEE-SA Patent Policy, however, does not prevent parties from mutually and voluntarily agreeing to a cross-license covering any patents (e.g., a portfolio license).

569 53. *Can a Submitter demand a prospective licensee take a license for the Submitter's non-*  
570 *essential patent claims?*

571  
572  
573  
574  
575  
576  
577

No. A Submitter cannot, as a condition to granting a license to an Essential Patent Claim, require a prospective licensee to take licenses to patent claims that are not Essential Patent Claims for the referenced IEEE standard. The IEEE-SA Patent Policy, however, does not prevent parties from mutually and voluntarily agreeing to a cross-license covering any patents (e.g., a portfolio license).

578 54. *Can a Submitter include a defensive suspension clause in a license agreement to*  
579 *protect the Submitter's access to Essential Patent Claims for the same IEEE Standard?*

580  
581  
582  
583  
584  
585  
586

A defensive suspension clause is a provision in a patent license agreement permitting the licensor to suspend the license if certain triggering conditions are satisfied. An appropriately drafted defensive suspension clause that protects a Submitter's access to Essential Patent Claims for the same IEEE Standard may be included as a reasonable and non-discriminatory term or condition if it is otherwise consistent with the policy.

### 587 **Prohibitive Orders**

588  
589  
590  
591  
592  
593  
594  
595

55. *The definition of Prohibitive Order says that it includes an "adjudicative directive that limits..." Would that include an order from a court that determines the amount of a reasonable royalty?*

No. An order that merely determines a past or future royalty is not a Prohibitive Order.

596 56. *Does the IEEE-SA Patent Policy give a patent holder a right to seek a Prohibitive*  
597 *Order?*



598  
599  
600  
601  
602  
603  
604  
605  
606  
607  
608  
609  
610  
611  
612  
613  
614  
615  
616  
617  
618  
619  
620  
621  
622  
623  
624  
625  
626  
627  
628  
629  
630  
631  
632  
633  
634  
635  
636  
637  
638  
639  
640  
641  
642

No. The policy does not create a right that does not already exist in a specific jurisdiction.

57. *Does the IEEE-SA Patent Policy prevent an implementer from raising issues of patent validity, patent infringement, or any other claims or defenses against the Submitter or change the requirements for that litigation?*

No. The policy does not prevent the parties from litigating those issues, and it does not change any jurisdiction's rules on allocating burdens of proof or production of evidence.

58. *Why does the IEEE-SA Patent Policy text on Prohibitive Orders use the phrase "... by one or more courts..."?*

In some jurisdictions, a single court does not have the authority to decide all issues. For example, a jurisdiction may empower one court to determine patent validity but another court to determine infringement or compensation. The policy was drafted so that it could apply in such a jurisdiction.

59. *What is a first-level appellate review?*

A first-level appellate review is a proceeding conducted by a court at the next judicial level (e.g., a court of appeals or a court of second instance) to review the decision of the next-lower body (e.g., a trial court or a court of first instance).

60. *What are some examples that constitute a failure "to participate in, or to comply with the outcome of, an adjudication"?*

A failure to participate in an adjudication occurs, for example, when the prospective licensee is not subject to the jurisdiction of the court(s) with the power to determine and award reasonable compensation to the Patent Holder and does not voluntarily submit to such jurisdiction. Failing to comply with the outcome of an adjudication occurs, for example, when a trial court has made a decision, that decision has been affirmed in whole or in relevant part through a first-level appellate review (or the time for seeking such a review has passed without review being sought), and the prospective licensee refuses to pay past or future royalties as so determined.

61. *What should a Submitter do if it faces an unwilling licensee?*

Whether a party is willing or unwilling is a matter of perspective. Any party that is dissatisfied with the progress of negotiations is free to begin litigation, consistent with the policy.

**Working Groups and LOAs**

643

644 62. *Can copies of Accepted Letters of Assurance be handed out at a standards*  
645 *development meeting?*

646

647 Yes. A participant may provide an Accepted Letter of Assurance to other participants  
648 by handing out paper copies of an Accepted Letter of Assurance (including a copy of  
649 the sample license or material licensing terms, if provided as part of the Letter of  
650 Assurance) or a data file with an image of the Accepted Letter of Assurance as it  
651 resides on the IEEE web site.

652

653 63. *Can the link to the IEEE web site for an Accepted Letter of Assurance be provided?*

654

655 Providing or displaying the IEEE URL for an Accepted Letter of Assurance is also  
656 acceptable.

657

658 64. *Can the actual Accepted Letter of Assurance be displayed on a screen?*

659

660 Yes, but it is not recommended. The Letter of Assurance consists of multiple pages of  
661 often very small type. Therefore, the display is not going to be legible except in the  
662 smallest of rooms. The lack of legibility may lead to impermissible questions or  
663 discussion. Nevertheless, displaying the Accepted Letter of Assurance as it resides on  
664 the IEEE web site is not a violation of the IEEE-SA Patent Policy provided a participant  
665 does not read aloud, present, or answer questions about the displayed Letter of  
666 Assurance.

667

668 65. *Can a Working Group chair provide participants with a list of requested LOAs?*

669

670 Yes. The Working Group chair should maintain a list of the requests that the chair (or  
671 his/her designee) has made and the date of each request. The chair may make this  
672 information available to participants in the working group and should make it available  
673 to participants upon request.

674

675 66. *How does a participant know if IEEE has requested a Letter of Assurance from a*  
676 *particular company?*

677

678 A participant may ask the Working Group chair for this information. Accepted Letters  
679 of Assurance are available on the IEEE's web site.

680

681 67. *Can a working group discuss the absence of a requested Letter of Assurance?*

682

683 The working group should not discuss the reasons for the absence of an LOA. The chair  
684 or a working group participant may state whether there is or is not an Accepted Letter  
685 of Assurance in response to the request.

686

687 68. *Can a participant make a presentation or answer questions about the not-to-exceed*  
688 *license fee or rate, material licensing terms, or sample license agreement?*  
689

690 No, except that using one or more not-to-exceed rates as components in a  
691 presentation comparing relative costs is acceptable. Further information can be found  
692 in [Promoting Competition and Innovation: What You Need to Know about the IEEE](#)  
693 [Standards Association's Antitrust and Competition Policy](#).  
694

695 69. *What can standards development groups discuss about Letters of Assurance or*  
696 *submitted license terms?*  
697

698 Nothing, other than distribution of the Letter of Assurance as described in question 62.  
699 In addition, using one or more not-to-exceed rates as components in a presentation  
700 comparing relative costs is acceptable. Further information can be found in [Promoting](#)  
701 [Competition and Innovation: What You Need to Know about the IEEE Standards](#)  
702 [Association's Antitrust and Competition Policy](#).  
703

704 70. *Doesn't it make sense to discuss license terms as part of an overall evaluation of a*  
705 *proposed technology?*  
706

707 IEEE-SA standards development meetings consist primarily of engineers who are there  
708 primarily to discuss the technical merits of competing solutions. Some knowledge of  
709 relative cost is entirely appropriate, and the policy provides for exactly that. But  
710 licensing issues can be complex and involve not just technical issues but legal and  
711 business issues as well, and those discussions can require a different set of people  
712 than are present for the technical meetings.  
713

714 71. *What do I do if the standards development group launches into a discussion of patent*  
715 *licensing terms?*  
716

717 A participant should object to, and a Working Group chair shall close down, any  
718 discussion that is not permitted under IEEE-SA policies.  
719

720 72. *What should the chair do if a participant wants to modify the terms of an Accepted*  
721 *Letter of Assurance during the meeting?*  
722

723 An Accepted Letter of Assurance cannot be modified, either in the meeting or  
724 elsewhere. Anyone who wishes to submit an additional Letter of Assurance may do so  
725 (although any previous Accepted Letters of Assurance will continue to be available).  
726 The chair should instruct the individual to submit a new Letter of Assurance as  
727 provided in the [IEEE-SA Standards Board Operations Manual](#). See also response to  
728 question 78.  
729

730 73. *What about conversations in the hallway? Can participants discuss the particulars of*  
731 *license terms there?*  
732

733 The IEEE-SA regulates what goes on in forums that the IEEE-SA provides, such as  
734 meeting rooms and email reflectors. The IEEE-SA has no ability to regulate purely  
735 private conduct of its participants. There are some topics that participants should not  
736 discuss regardless of where they are (such as prices that each of them as competitors  
737 will charge for compliant products). There are other topics that participants shall not  
738 discuss in IEEE-SA forums and shall not discuss in immediately adjacent spaces that  
739 might reasonably lead outside observers to believe it is just a continuation of the  
740 formal meeting. Further information can be found in [Promoting Competition and](#)  
741 [Innovation: What You Need to Know about the IEEE Standards Association's Antitrust](#)  
742 [and Competition Policy](#). Please also see IEEE-SA Standards Board Operations Manual  
743 5.3.10.  
744

745 74. *If a Letter of Assurance is submitted without the Submitter having exercised the option*  
746 *of providing a not-to-exceed license fee or rate commitment or other license terms, is*  
747 *it okay for a Working Group participant to request or encourage the Submitter to file*  
748 *an additional Letter of Assurance to provide that information?*  
749

750 No. Although relative cost comparisons can certainly note the absence of cost  
751 information, participants shall not request license fees, terms, or conditions during  
752 technical standards-development meetings or in other IEEE-SA forums for technical  
753 discussions (such as email reflectors).  
754

755 75. *What can be discussed about patents in a standards development group meeting or in*  
756 *an IEEE-SA email reflector?*  
757

758 You can discuss the technical merits of using the technology included even if it is  
759 included within a potential Essential Patent Claim. You can discuss and compare the  
760 relative costs of technology claimed in potential Essential Patent Claims. You must not  
761 discuss subjects such as how a patent should be licensed, or essentiality, validity, or  
762 interpretation of a patent claim. These are not appropriate topics for discussion in a  
763 standards development committee. Further information can be found in [What You](#)  
764 [Need to Know About IEEE Standards and the Law](#). Please also see IEEE-SA Standards  
765 Board Operations Manual 5.3.10.  
766

767 76. *Can someone submit a different Letter of Assurance for different Essential Patent*  
768 *Claims within the same standard?*  
769

770 Yes. A Submitter may submit separate Letters of Assurance providing its licensing  
771 positions for different potential Essential Patent Claims.  
772

773 77. *If a person submits a Letter of Assurance but doesn't identify a specific Essential*  
774 *Patent Claim covered by the Letter of Assurance, are the assurances binding on all of*  
775 *the Essential Patent Claims owned by the Submitter?*

776  
777 Yes.

778  
779 78. *Can a Submitter change the terms of the assurance it has given after an LOA has been*  
780 *accepted by the IEEE? For example, what if the Submitter decided to lower the not-to-*  
781 *exceed price it would offer to license for an Essential Patent Claim?*

782  
783 A Letter of Assurance is irrevocable once submitted and accepted and shall apply, at a  
784 minimum, from the date of the standard's approval to the date of the standard's  
785 transfer to inactive status. Thus, a Submitter cannot change the terms of an Accepted  
786 Letter of Assurance for a particular Essential Patent Claim once it is accepted.  
787 However, over time, a Submitter may provide multiple assurances for a given Essential  
788 Patent Claim by submitting multiple Letters of Assurance for such claim, each of which  
789 shall be binding on the Submitter. Each potential licensee may choose to invoke the  
790 terms of any applicable Letter of Assurance accepted by the IEEE. Thus, the Submitter  
791 desiring to lower the not-to-exceed price that it would offer to license for an Essential  
792 Patent Claim can submit an additional Letter of Assurance with the revised not-to-  
793 exceed price and each potential licensee may choose to invoke the terms of either  
794 Letter of Assurance.

795  
796 **Reciprocal Licensing**

797  
798 79. *Many IEEE Standards have amendments and corrigenda and are revised every ten*  
799 *years. How does the selection of Reciprocal Licensing work in these situations?*

800  
801 Reciprocity is based on licensing Essential Patent Claims “for the referenced IEEE  
802 Standard, including any amendments, corrigenda, editions, and revisions.” If a  
803 Submitter checks the box selecting Reciprocal Licensing, the scope of that Reciprocal  
804 Licensing for both the Submitter and the Applicant is the entire IEEE Standard. Please  
805 also note section 6.3.5 of the IEEE-SA Standards Board Operations Manual,  
806 *Applicability of Letters of Assurance to Amendments, Corrigenda, Editions, or*  
807 *Revisions*. See also questions 14 and 15.

808  
809 80. *Can a Submitter select Reciprocal Licensing while excluding specific Essential Patent*  
810 *Claims from its licensing commitment?*

811  
812 No. When a Submitter checks the Reciprocal Licensing box, neither the Submitter nor  
813 the Applicant can exclude from its licensing commitment to the other party any  
814 Essential Patent Claims for the referenced IEEE standard.

815  
816 81. *Why can't a Submitter exclude its Affiliates when demanding Reciprocal Licensing?*  
817

818 In situations similar to those described in question 80 above, Essential Patent Claims  
819 might not be available for licensing if they are owned by an excluded Affiliate. Since  
820 the Applicant has no ability to exclude any Affiliate or any Essential Patent Claims held  
821 by such Affiliate, the same limitation must be applied to the Submitter.  
822

### 823 **Blanket Letter of Assurance**

824

825 82. *What is a "Blanket Letter of Assurance"?*

826

827 A Blanket Letter of Assurance is a Letter of Assurance referencing a standard or project  
828 that applies to all Essential Patent Claims for which a Submitter may currently or in the  
829 future (except as otherwise provided for in the [IEEE-SA Standards Board Bylaws](#) and in  
830 the [IEEE-SA Standards Board Operations Manual](#)) have the ability to license. This is  
831 defined in clause 6.1 of the IEEE-SA Standards Board Bylaws available at  
832 <http://standards.ieee.org/develop/policies/bylaws/sect6-7.html#6.1>.  
833

834

835 83. *What happens if the Submitter submits a Blanket Letter of Assurance after previously*  
836 *offering a specific Letter of Assurance?*

837

838 If a Submitter has signed and submitted a Letter of Assurance specifically identifying  
839 an Essential Patent Claim before or concurrently with signing and submitting a Blanket  
840 Letter of Assurance where Reciprocal Licensing has not been selected, the Blanket  
841 Letter of Assurance cannot be invoked as to the specified Patent Claim. If any of the  
842 Submitter's Accepted LOAs on a standard has selected Reciprocal Licensing, then an  
843 Applicant can invoke the terms of Reciprocal Licensing.

844

845 84. *Does a Blanket Letter of Assurance apply to Essential Patent Claims that my company*  
846 *acquires after submitting the Letter of Assurance?*

847

848 For LOAs that did not select Reciprocal Licensing, a Blanket Letter of Assurance does  
849 apply unless the acquired entity or the prior holder of the acquired Essential Patent  
850 Claim submitted a Letter of Assurance before the acquisition. Any Blanket Letter of  
851 Assurance, where Reciprocal Licensing was not selected and submitted by the acquired  
852 entity or the prior holder of the acquired Essential Patent Claim before the acquisition,  
853 shall continue to apply to acquired Essential Patent Claims covered by such assurance  
854 (but not to the acquirer's Essential Patent Claims). An acquiring party can ask a seller  
855 of an acquired Essential Patent Claim or an acquired entity to submit additional Letters  
856 of Assurance before closing of the acquisition.

857

858 If any Accepted LOAs on a standard have selected Reciprocal Licensing, then an  
859 Applicant can invoke the terms of Reciprocal Licensing.

860

### 861 **Implementation of updated IEEE-SA Patent Policy**

861



862 85. *What is the effective date of the updated IEEE-SA Patent Policy?*

863

864 The effective date of the updated IEEE-SA Patent Policy set forth in the [IEEE-SA](#)  
865 [Standards Board Bylaws](#) and [IEEE-SA Standards Board Operations Manual](#) is 1 January  
866 2015.

867

868 86. *Will the updated IEEE-SA Patent Policy apply to existing standards development*  
869 *projects currently underway as well as new standards development projects?*

870

871 Yes. The updated policy will apply to any LOAs submitted after the effective date. See  
872 also question 85.

873

### 874 **Essential Patent Claims during Ballot Resolution**

875

876 87. *During ballot resolution, what should be the response to a comment regarding the lack*  
877 *of an LOA?*

878

879 If an LOA has not been requested from the indicated holder of a potential Essential  
880 Patent Claim, the process for requesting an LOA should be followed (See [6.3.2 Call for](#)  
881 [patents](#) in the [IEEE-SA Standards Board Operations Manual](#)).

882

883 Further, the comment response should state that the IEEE is not responsible for:

884

- 885 – Identifying Essential Patent Claims for which a license may be required
- 886 – Determining the validity, essentiality, or interpretation of Patent Claims;
- 887 – Determining whether any licensing terms or conditions provided in connection  
888 with submission of a Letter of Assurance, if any, or in any licensing agreements  
889 are reasonable or non-discriminatory;
- 890 – Determining whether an implementation is a Compliant Implementation.

890

891 (Taken from the subclause 6.2 *Public notice* of the IEEE-SA Standards Board Bylaws)

892

893 and that no discussions or other communications regarding the

894

- 895 – Essentiality of patent claims
- 896 – Interpretation of patent claims
- 897 – Validity of patent claims

898

899 shall occur during IEEE-SA working group standards-development meetings or other  
900 duly authorized IEEE-SA standards-development technical activities.

901

902 (Note: This is not a complete list of the items for non-discussion. Adapted from  
903 [5.3.10.2 Discussion of litigation, patents, and licensing](#) of the IEEE-SA Standards Board  
904 [Operations Manual](#)).