

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, is controlled by the Submitter, or is under common control with the Submitter. 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.

“*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 a component, product, or service that conforms to mandatory and/or optional portions of the normative clauses 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 use of which was necessary to create a ~~Compliant Implementation of either mandatory or optional portions of the normative clauses of the [Proposed] IEEE Standard~~ when, at the time of the [Proposed] IEEE Standard’s approval, there was no commercially and technically feasible non-infringing alternative. 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 injunction, exclusion order, or similar judicial or regulatory directive that limits, prevents, or conditions the making, using, selling, offering to sell, importing, distributing or implementing a Compliant Implementation.

“*Reasonable and Good Faith Inquiry*” includes, but is not limited to, a Submitter using reasonable efforts to identify and contact those individuals who are from, employed by, or otherwise represent the Submitter and who are known to the Submitter to be current or past participants in the development process of the [Proposed] IEEE Standard identified in a Letter of Assurance, including, but not limited to, participation in a Sponsor Ballot or Working Group. If the Submitter did not or does not have any participants, then a

Reasonable and Good Faith Inquiry may include, but is not limited to, the Submitter using reasonable efforts to contact individuals who are from, employed by, or represent the Submitter and who the Submitter believes are most likely to have knowledge about the technology covered by the [Proposed] IEEE Standard.

“Reasonable Rate” shall be a rate that is based on all relevant factors. Some of the factors to be considered in license negotiation or in dispute resolution should include:

1. The value of the invention or inventive feature within an Essential Patent Claim compared with alternatives available when the invention or inventive feature was considered for inclusion in the [Proposed] IEEE Standard.
2. The value that an Essential Patent Claim contributes to the total value of the component, product, or service into which it is incorporated.
3. The aggregate value that all Patent Claims contribute to the component, product, or service.

“Reciprocal Licensing” shall mean that the Submitter of an LOA has conditioned its granting of a license for all of its Essential Patent Claims upon the applicant’s agreement to grant a reciprocal license with reasonable terms and conditions to all of the applicant’s Essential Patent Claims, if any, for the referenced IEEE standard, including any amendments, corrigenda, editions, and revisions. If an LOA references an amendment or corrigendum, the scope of reciprocity includes the base standard and its amendments, corrigenda, editions, and revisions.

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

“Submitter” when used in reference to a Letter of Assurance shall mean an individual or an organization that provides a completed Letter of Assurance. A Submitter may or may not hold Essential Patent Claims.

6.2 Policy

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

The Submitter of the Letter of Assurance may, after Reasonable and Good Faith Inquiry, indicate it is not aware of any Patent Claims that the Submitter may own, control, or have the ability to license that might be or become Essential Patent Claims. If the patent holder or patent applicant provides an assurance, it should do so as soon as reasonably feasible in the standards development process once the PAR is approved by the IEEE-SA Standards Board. This assurance should be provided prior to the Standards Board’s approval of the standard. An asserted potential Essential Patent Claim for which an assurance cannot be obtained (e.g., a Letter of Assurance is not provided or the Letter of Assurance indicates that licensing assurance is not being provided) shall be referred to the Patent Committee.

Licensing assuranceA Letter of Assurance shall be either:

- a) A general disclaimer to the effect that the Submitter without conditions will not enforce any present or future Essential Patent Claims against any person or entity making, using, selling, offering to sell, importing, distributing, or implementing any Compliant Implementation ~~of the standard~~; or
- b) A statement that the Submitter will grant a license for Essential Patent Claims to an unrestricted

86 number of applicants on a worldwide basis without compensation or under Reasonable Rates,
87 with reasonable terms and conditions that are demonstrably free of any unfair discrimination to
88 make, use, sell, offer to sell, import, distribute, or implement any Compliant Implementation. a
89 compliant implementation of the standard will be made available to an unrestricted number of
90 applicants on a worldwide basis without compensation or under reasonable rates, with reasonable
91 terms and conditions that are demonstrably free of any unfair discrimination.

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

95 On a Letter of Assurance, the Submitter may indicate a condition of Reciprocal Licensing. The Submitter
96 shall not require the applicant (a) to grant a license to any of the applicant's Patent Claims that are not
97 Essential Patent Claims for the referenced IEEE standard, or (b) to take a license for any of the Submitter's
98 Patent Claims that are not Essential Patent Claims for the referenced IEEE standard.

99 Nothing in this policy shall prohibit a licensor and licensee from voluntarily negotiating any license under
100 terms mutually agreeable to both parties.

101 Copies of an Accepted LOA may be provided to participants in a standards development ~~the working~~
102 ~~group, but shall not be discussed, at any standards working group meeting.~~ Discussion of essentiality,
103 interpretation, or validity of Patent Claims, or specific patent license terms is prohibited during IEEE-SA
104 standards-development meetings or other duly authorized IEEE-SA standards-development technical
105 activities.

106 An Accepted Letter of Assurance shall apply to the Submitter and its Affiliates except that the Submitter
107 may specifically exclude certain Affiliates identified in the Letter of Assurance.

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109 The Submitter and all Affiliates (other than those Affiliates excluded in a Letter of Assurance) shall not,
110 with the intent of circumventing or negating any of the representations and commitments made in the
111 Accepted Letter of Assurance, assign or otherwise transfer any rights in any Essential Patent Claims ~~that~~
112 ~~are the subject of such Letter of Assurance~~ that they hold, control, or have the ability to license and for
113 which licensing assurance was provided on an Accepted Letter of Assurance ~~with the intent of~~
114 ~~circumventing or negating any of the representations and commitments made in such Letter of Assurance.~~

115 The IEEE intends that any terms contained in an Accepted Letter of Assurance shall be binding upon any
116 and all assignees and transferees of any Essential Patent Claim covered by such LOA. The Submitter of an
117 Accepted Letter of Assurance providing licensing assurance therefore shall agree (a) to provide notice of a
118 Letter of Assurance either through a Statement of Encumbrance or by contractually binding any assignee or
119 transferee to the terms of such Accepted Letter of Assurance; and (b) to contractually require its assignees
120 or transferees to (i) agree to similarly provide such notice and (ii) to contractually bind their
121 transferees to agree to provide such notice as described in (a) and (b); the terms of such Accepted Letter of
122 Assurance. In jurisdictions in which providing notice by a Statement of Encumbrance has the effect of
123 binding successors to the foregoing obligations, a Submitter may satisfy its obligations by a Statement of
124 Encumbrance.

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126 A Submitter of an Accepted LOA who has committed to license Essential Patent Claims on reasonable
127 terms and conditions that are demonstrably free of any unfair discrimination has implicitly acknowledged
128 that a royalty is sufficient compensation for a license to use those Essential Patent Claims.

129 A Submitter of an Accepted LOA who has committed to license Essential Patent Claims shall neither seek,
130 nor seek to have enforced, a Prohibitive Order in any jurisdiction based on alleged infringement of the

131 | Essential Patent Claims identified in the LOA against any alleged infringer unless such alleged infringer
132 | fails to participate in proceedings before, or fails to comply with a final and non-appealable judgment of,
133 | an appropriate court(s) in that jurisdiction. An appropriate court is one that has authority to adjudicate
134 | patent validity and infringement; determine reasonable licensing rates, terms and conditions; award
135 | monetary compensation for unpaid past royalties and declare a future royalty rate; and resolve defenses and
136 | counterclaims. Nothing shall preclude parties from agreeing to arbitrate any such issues.

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

140 | If, after providing a Letter of Assurance to the IEEE, the Submitter becomes aware of additional Patent
141 | Claim(s) not already covered by an Acceptedexisting Letter of Assurance that are owned, controlled, or
142 | licensable by the Submitter that may be or become Essential Patent Claim(s) for the same IEEE Standard
143 | but are not the subject of an Acceptedexisting Letter of Assurance, then such Submitter shall submit a
144 | Letter of Assurance stating its position regarding enforcement or licensing of such Patent Claims. For the
145 | purposes of this commitment, the Submitter is deemed to be aware if any of the following individuals who
146 | are from, employed by, or otherwise represent the Submitter have personal knowledge of additional
147 | potential Essential Patent Claims, owned or controlled by the Submitter, related to a [Proposed] IEEE
148 | Standard and not already the subject of a previously Acceptedsubmitted Letter of Assurance: (a) past or
149 | present participants in the development of the [Proposed] IEEE Standard, or (b) the individual executing
150 | the previously submitted Letter of Assurance.

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

153 | The IEEE is not responsible for identifying Essential Patent Claims for which a license may be required,
154 | for conducting inquiries into the legal validity or scope of ~~those~~ Patent Claims, or for determining whether
155 | any licensing terms or conditions provided in connection with submission of a Letter of Assurance, if any,
156 | or in any licensing agreements are reasonable or non-discriminatory.

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

159 | In order for IEEE's patent policy to function efficiently, individuals participating in the standards
160 | development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any
161 | potential Essential Patent Claims of which they are personally aware and that are not already the subject of
162 | an Acceptedexisting Letter of Assurance, that are owned or controlled by the participant or the entity the
163 | participant is from, employed by, or otherwise represents; and (b) should inform the IEEE (or cause the
164 | IEEE to be informed) of any other holders of ~~such~~ potential Essential Patent Claims that are not already the
165 | subject of an Acceptedexisting Letter of Assurance.

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