Effectiveness of Updated Patent Policy Text: More Clarity Needed

Presentation to IEEE-SA Patent Committee Meeting

Agenda Item 5.2
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Current Situation

- Unclear what patent policy text applies as to PARs begun after effective date of updated patent policy text

- Some companies take position that policy text in effect on LoA submission date governs forever
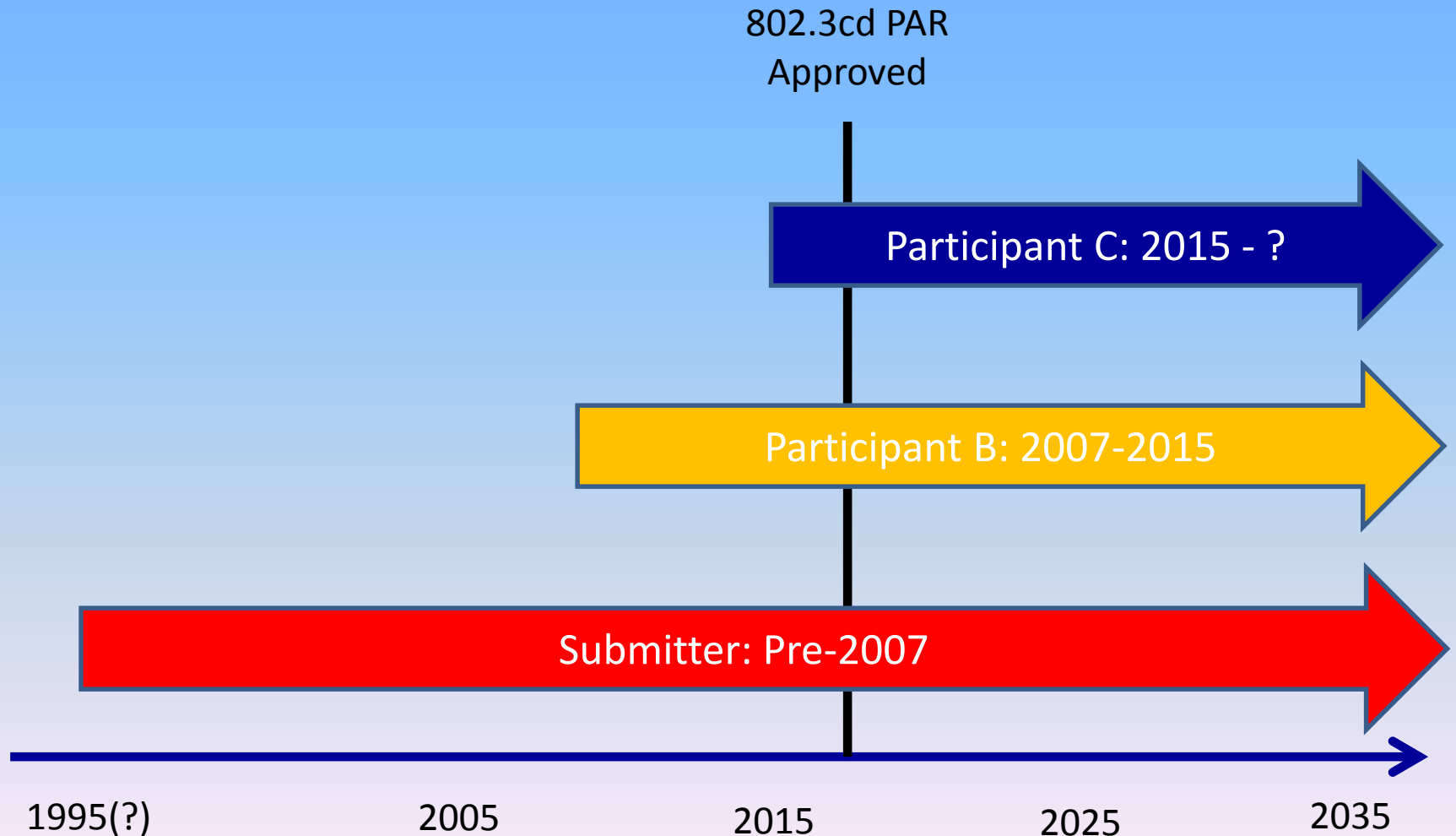
Example

- 2005 LoA committing to license patents essential to 802.3:
  - Submitter makes technical contribution to 802.3cd (PAR approved May 12, 2016)
  - What patent policy text governs LoA?

- Pre-2007:
  - No obligation to conduct reasonable and good faith inquiry before stating that submitter has no essential patents
  - No application of licensing commitment to corporate affiliates
  - No application of licensing commitment to purchasers of essential patent
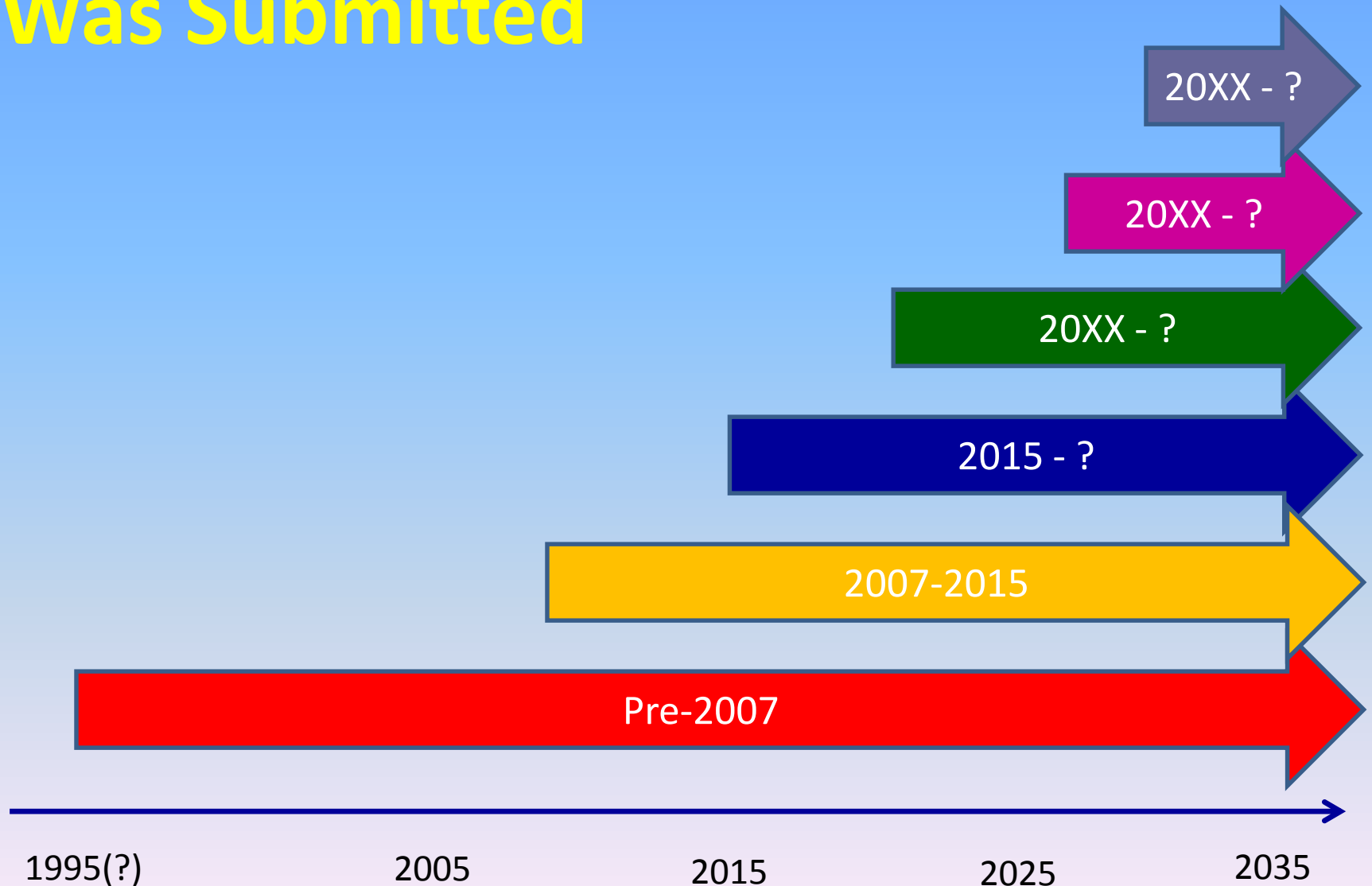
What Policy Text Applies? Potential Answers

- Text in effect at time LoA was submitted
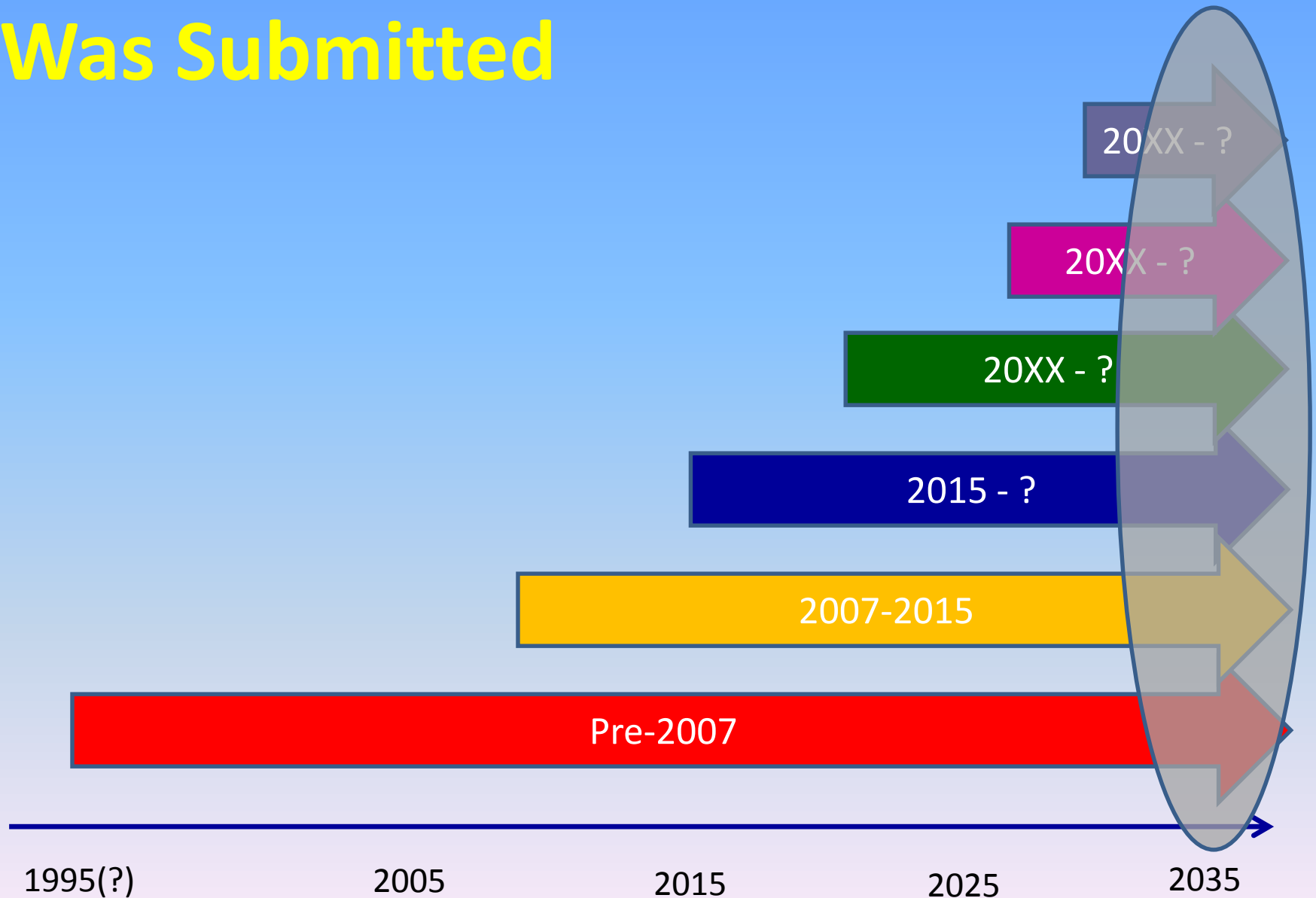- Text in effect on date PAR was approved
- Other choices?

Proposal

- Focus on date of PAR approval
  - objective
  - definite

- If that date is after effective date of new policy text, previously submitted LoA is governed by new policy text

- Exception: If patent governed by previous LoA is subject to continued obligation to license under OpsMan 6.3.5, then patent policy text at time of submission of LoA continues to govern

What's the Right Choice?

- Should different participants in same standards development project be governed by different policy texts?

- Or should IEEE-SA adopt rule that applies same policy text to all participants at any point in time?

Objections

Proposal applies updated patent policy text retroactively

- No:
  - Updated text only applies to new activities
  - Patented invention "recycled" in revision or amendment governed by policy text at time of LoA
  - If not sufficient, permit withdrawal of previous LoA as to new PARs
    - requires tweak to By-Laws statement re LoA irrevocability and revision to OpsMan 6.3.4

Objections

Proposal rewrites contract between submitter and IEEE-SA

- No:
  - Submitters recognize that patent policy text can change under IEEE-SA governance process
  - Fair to apply updated text to current participation, particularly when:
    - Previous inventions used in new revisions created under new PARs continue to be governed by previous LOAs (OpsMan 6.3.5)
    - If OpsMan 6.3.4 is revised, participant can withdraw old LoA with prospective effect

Time for clarity ....

- Time for PatCom to address this issue
  - More than two years since effective date of policy updates
- Working groups are asking for clarity on this issue
- Implementers of IEEE-SA standards benefit from clarity relative to patent licensing programs and negotiations

Thank you