

Standards Companion

Note: The terms and definitions set forth in the IEEE Patent Policy, IEEE-Standards Board Bylaws and IEEE-SA Standards Board Operations Manual are incorporated herein.

Patents

You can draft your standard to include use of patented material if technical reasons justify this and if a letter of assurance covering this material has been submitted and accepted prior to the approval of the standard. It's beneficial to your working group and to the IEEE to obtain letters of assurance as early in your development process as possible.

Within the working group, you are required to announce the IEEE Standards patent policy, as outlined in the IEEE-SA Standards Board Bylaws and Operations Manual, at every standards-developing meeting. The best way to do this is to use the slide set provided by the Patent Committee (PatCom). Other approaches may be acceptable but the same content has to be covered. Individual participants are required to identify (or cause the IEEE to be informed of the identity of) any holders of potential essential patent claims of which they are aware that are owned or controlled by the participant, the entity the participant is from, employed, by or otherwise represents when called for at the meeting or at any other time they become aware. In contrast, individual participants should identify (or cause the IEEE to be informed of the identity of) any other holders of potential essential patent claims that are not already the subject of an existing letter of assurance.

If the working group learns about potentially essential patent claims or patent application claims(s) relevant to their standards project, the chair should contact an appropriate authority for the patent holder to request that the patent holder submit a letter of assurance to the PatCom Administrator as required by the IEEE Standards patent policy. The PatCom Administrator will inform you when a letter of assurance is received related to your working group and will post it to the IEEE-SA website. If you receive a copy of the letter of assurance, you should supply a copy of the letter of assurance to the PatCom Administrator if it appears that a copy has not already been sent to the PatCom Administrator. The letter of assurance should include patent numbers and claim numbers, if and when possible. For patent applications, appropriate identifying information should be provided as indicated on the letter of assurance form.

A letter of assurance may contain information about specific rates, terms and conditions that a patent holder would offer to a potential licensee. If provided, these rates, terms conditions are binding. You should forward any letters of assurance you receive to the IEEE Standards Department as soon as possible to avoid complications with your standard.

When an IEEE standards-developing working group incorporates part(s) of another proposed or approved standard directly or through a normative reference to that standard (even an IEEE standard) or industry document, the chair or the chair's delegate shall

request of the responsible Standards Development Organization (SDO) the following information:

- Has the SDO requested the identification of any potential Essential Patent Claims for the included or referenced material?
- The identification of, and contact information for, any claimed holder of any potential Essential Patent Claim for the included or referenced material.

Note: The IEEE staff can assist with identification of contact information for SDOs. The chair shall share this information with the IEEE standards-developing working group that is considering the incorporation of part(s) of another standard through normative reference and, the chair shall treat each potential Essential Patent Claim holder from the queried SDO in the same manner as if the potential Essential Patent Claim holder had been identified through a working group call for identification of patents.

If an IEEE standard incorporates by reference another standard in whole and unmodified, an implementation that is built to conform to the IEEE standard will, by definition, also conform to the referenced standard; therefore, there should ordinarily be no need to invite LOAs for this case.

Neither you, your working group nor the IEEE is responsible for patent searches or determining the validity of any patent. Your working group shall not become involved in determining a reasonable fee for use of the patent claims or any other condition that the patent holder may seek to impose. If you do find yourself involved in a patent issue, remember that your IEEE Standards Staff Liaison is available for assistance. PatCom can be used for guidance as well.

Sidebar Information

The patent policy is contained in the IEEE-SA Standards Board Bylaws with supplemental information in the IEEE-SA Standards Board Operations Manual.

A helpful guide on patents is available.

The recommended method for announcing the IEEE-SA Patent Policy is the PatCom provided slideset. Those are available here.

For a sample patent letter of assurance request letter and a blank letter of assurance, click here. PatCom strongly recommends that you use the sample patent letter of assurance request letter but you are required to include the blank letter of assurance.

Keep in mind that when a standard is withdrawn, all patent letters of assurance related to it are no longer enforceable.

More information on patents can be found here.

Cover Letter for LOA Request

To General Counsel--Patents,

I am the Chair of the IEEE Standards Association (IEEE-SA) Working Group [_____]. Through the course of development of IEEE Pnnn (*standard title*), it has come to my attention that your organization may have “essential patent claims” with respect to this standard. Essential patent claims, as defined by the IEEE, are any Patent Claims 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.

According to the IEEE-SA Standards Board Operations Manual, working group chairs to whom patent issues have been raised shall solicit Letters of Assurance for Essential Patent Claims (Letters of Assurance) from patent holders having potential essential patent claims. As the individual within your organization having authority for intellectual property rights management, the IEEE would appreciate your completing and signing the attached Letter of Assurance and returning it to the IEEE Standards Department at:

Secretary, IEEE-SA Standards Board Patent Committee
IEEE
445 Hoes Lane
Piscataway, NJ 08855 USA
[Fax: Attn: PatCom Secretary (+1-732 875 0524)]

As Working Group Chair, I would appreciate a copy for my records as well.

All published IEEE Standards include the following disclaimer at the beginning of the standard:

"Attention is called to the possibility that implementation of this standard may require use of subject matter covered by patent rights. By publication of this standard, no position is taken with respect to the existence or validity of any patent rights in connection therewith. The IEEE is not responsible for identifying Essential Patent Claims for which a license may be required, for conducting inquiries into the legal validity or scope of Patents Claims or determining whether any licensing terms or conditions are reasonable or non-discriminatory. Further information may be obtained from the IEEE Standards Association"

Additionally, when a Letter of Assurance is received from a known patent holder prior to publication of the specified standard, the following language is also included in the front matter of the standard:

"Attention is called to the possibility that implementation of this standard may require use of subject matter covered by patent rights. By publication of this standard, no position is taken with respect to the existence or validity of any

1 *patent rights in connection therewith. A patent holder or patent applicant has*
2 *filed a statement of assurance that it will grant licenses under these rights without*
3 *compensation or under reasonable rates, with reasonable terms and conditions*
4 *that are demonstrably free of any unfair discrimination to applicants desiring to*
5 *obtain such licenses. Other Essential Patent Claims may exist for which a*
6 *statement of assurance has not been received. The IEEE is not responsible for*
7 *identifying Essential Patent Claims for which a license may be required, for*
8 *conducting inquiries into the legal validity or scope of Patents Claims, or*
9 *determining whether any licensing terms or conditions are reasonable or non-*
10 *discriminatory. Further information may be obtained from the IEEE Standards*
11 *Association.”*

12 *.”*

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14 The *IEEE-SA Standards Board Bylaws* state that the assurance is irrevocable once
15 submitted and accepted and shall apply, at a minimum, from the date of the standard's
16 approval to the date of the standard's withdrawal. For your reference, the complete IEEE
17 standards patent policy, including definition of terms, can be found in:

- 18
19 ♦ *IEEE-SA Standards Board Bylaws*, Clause 6
20 [<http://standards.ieee.org/guides/bylaws/sect6-7.html#6>]
21 ♦ *IEEE-SA Standards Board Operations Manual*, Clause 6.3
22 [<http://standards.ieee.org/guides/opman/sect6.html#6.3>]
23

24 Please address questions to the the IEEE-SA Standards Board Patent Committee
25 Administrator [patcom@ieee.org].
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28 Sincerely,
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31 Working Group [_____] Chair
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33 Mailing Address

34 Phone/Fax/Email
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