



TO: Working Group Chairs and Sponsor Chairs

RE: IEEE-SA Patent Licensing Policy

The IEEE-SA Standards Board Patent Committee has completed the definition of a procedure that should ease the process by which working groups gather information concerning intellectual property rights. This procedure is for handling essential patents that may relate to the standards under development within the IEEE.

Over the next six months, an operations manual will be developed explaining the process in more detail. However, this basic material may be used immediately. The following three items are enclosed for your use:

1. A Process Flowchart, for WG Chair reference.
2. Material for the WG Chair to forward to the Intellectual Property manager of a company identified as potentially holding patents relevant to the standard. This material includes:
 - a. A cover letter to the IP manager. This letter should *not be altered*, except for customizing the first paragraph with the WG and Standard specifics.
 - b. A copy of the official Letter of Assurance. This form should be customized (Items 1-3) with the name and number of the standard

The Patent Committee envisions the following general sequence of events: (The enclosed flowchart provides more detail.):

1. The WG Chair is made aware of a company potentially having essential patents, relating to the standard under development. This awareness may come from employees of the company responding to a call for patents; a third party notification; information gained from a trade article or paper; or another source.
2. The WG Chair sends the attached cover letter and LoA form (each suitably customized with the WG's standard's title and number) to the appropriate individual within the company.
3. The authorized company representative completes the LoA and returns it to the IEEE Standards Office, copying the WG Chair.
4. The relevant information is placed in the IEEE Patent Database by the IEEE-SA staff

This is the ideal case. If the company returns the form to staff, agreeing to license (either for free or for a reasonable and nondiscriminatory fee), there is no further action required of the WG Chair. The flowchart identifies a number of other cases (e.g. no response from the company; refusal to license; alteration of the LoA; request for special consideration, etc). In these instances, WG Chair should follow the action indicated on the flowchart or refer the matter to the Patent Committee.

If I can answer any questions or you have suggestions to improve or clarify this process, please feel free to contact either myself or Dave Ringle.

Regards,

A handwritten signature in black ink, appearing to read 'Clyde R. Camp', written over a horizontal line.

Clyde R. Camp
Chair, 2001 IEEE Patent Committee

Letter of Assurance Process Flowchart

Intended to guide Working Group
Chairs in soliciting and processing
Letters of Assurance regarding
essential patents

General Notes:

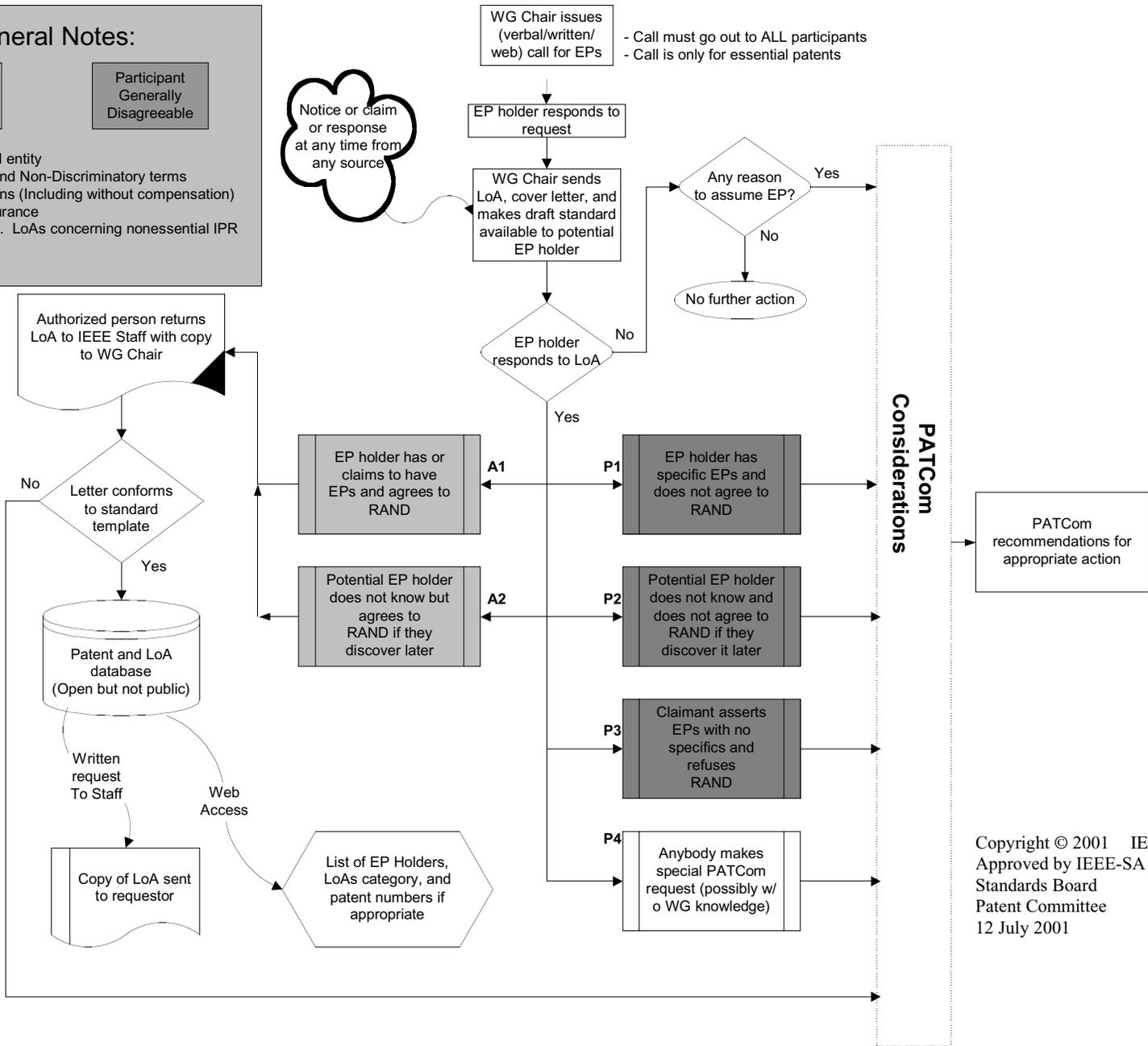
Participant
Generally
Agreeable

Participant
Generally
Disagreeable

Participant = Any legal entity
RAND = Reasonable And Non-Discriminatory terms and conditions (Including without compensation)
LoA = Letter(s) of Assurance
EP = Essential Patents. LoAs concerning nonessential IPR are not needed

Notice or claim or response at any time from any source

WG Chair issues (verbal/written/web) call for EPs
 - Call must go out to ALL participants
 - Call is only for essential patents



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 patents" with respect to this standard. Essential patents, as defined by the IEEE, are those patents whose infringement is unavoidable in a compliant implementation of the standard and where there is no other reasonable technical alternative.

According to the IEEE-SA Standards Board Patent Committee, working group chairs to whom patent issues have been raised should solicit Letters of Assurance for Essential Patents (Letters of Assurance) from patent holders having potential essential 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 (+1-732-562-1571)]

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

All published IEEE-SA 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 shall not be responsible for identifying patents for which a license may be required by an IEEE standard or for conducting inquiries into the legal validity or scope of those patents that are brought to its attention."

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 within the standard:

"A patent holder has filed a statement of assurance that it will grant licenses under these rights without compensation or under reasonable rates and nondiscriminatory, reasonable terms and conditions to all applicants desiring to obtain such licenses. The IEEE makes no representation as to the reasonableness of rates and/or terms and conditions of the license agreements offered by patent holders. Further information may be obtained from the IEEE Standards Department."

The IEEE-SA Standards Board Bylaws state that the terms of a letter of assurance apply from the date of the standard's approval to the date of the standard's withdrawal and are irrevocable during that period. For your reference, the complete IEEE standards patent policy can be found in:

- ◆ IEEE-SA Standards Board Bylaws, Clause 6
[<http://standards.ieee.org/guides/bylaws/sect6-7.html#6>]
- ◆ IEEE-SA Standards Board Operations Manual, Clause 6.3
[<http://standards.ieee.org/guides/opman/sect6.html#6.3>]

Please address questions to the Secretary of the IEEE-SA Standards Board Patent Committee [David Ringle, d.ringle@ieee.org, +1-732-562-3806 voice, +1-732-562-1571 fax].

Sincerely,

Working Group [_____] Chair

Mailing Address
Phone/Fax/Email

LETTER OF ASSURANCE FOR ESSENTIAL PATENTS

Please return or FAX to: Secretary, IEEE-SA Standards Board Patent Committee
Institute of Electrical and Electronics Engineers, Inc.
445 Hoes Lane
Piscataway, NJ 08855 USA
FAX (+1 732-562-1571)

No license is implied by submission of this Letter of Assurance

1. PATENT HOLDER/ORGANIZATION:

Legal Name of Organization: _____

2. PATENT HOLDER'S CONTACT FOR LICENSE APPLICATION:

Name & Department: _____
Address: _____
Telephone: _____ Fax: _____ E-mail: _____

3. IEEE STANDARD or PROPOSED IEEE STANDARD:

Number: _____
Title: _____

4. PATENT HOLDER'S POSITION REGARDING LICENSING ESSENTIAL PATENT RIGHTS

If the Patent Holder owns or controls granted patent(s) and/or pending applications that it believes may be infringed by compliance with the Proposed IEEE Standard, please specify the patent number, published application, and/or relevant claims. (A patent search is not required.)

Patent Number(s) (if known): _____

Relevant Claims (optional): _____

The Patent Holder states that its position with respect to licensing such patent(s) is as follows (**check one box only**):

1. The Patent Holder is prepared to grant a free license to an unrestricted number of applicants on a worldwide, non-discriminatory basis to comply with the [Proposed] IEEE Standard.
2. The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to comply with the [Proposed] IEEE Standard.
3. The Patent Holder is unwilling to grant licenses according to the provisions of either 1 or 2 above.

Note: The Patent Holder is not deemed to discriminate for denying a license based on pending or ongoing patent litigation with an applicant. It is not deemed unreasonable for the Patent Holder to include a reciprocity requirement within the license.

4. I am not aware of any patent(s) and/or patent claim(s) that my company may hold that would be relevant to the subject matter of the [Proposed] Standard

5. SIGNATURE

Print name of authorized person: _____

Title of authorized person: _____

Signature of authorized person: _____ Date: _____