

## **GEM handy dandy Technical Committees Patents Guide 4/14/99**

### **Meeting call for patents:**

Technical Committees and/or Technical Committee Task Groups and their ad hocs (working groups) should make regular calls for patents required to comply with the requirements in committee draft as well as published standards and technical reports. **A document is available from ANSI, "Procedures for the Development and Coordination of American National Standards", at no charge. This document is also on the WWW at [tp://www.ncits.org/help/ansi\\_sdo.html](http://www.ncits.org/help/ansi_sdo.html). Section 1.2.11 contains the ANSI patent policy. Amy Marasco manages patent issues for ANSI and can be contacted at [amarasco@ansi.org](mailto:amarasco@ansi.org) or 212-642-4954.**

**A call is hereby made for patents and/or patent applications that may be necessary to comply with the requirements in Tnn standards, draft standards, technical reports, or draft technical reports.**

### **Project actions:**

If the Chair receives a definitive response to the call for patents, depending upon the specificity of the response, the Chair should send a letter to the organization holding the rights to the patents and/or patent applications asking if a license is required to conform to the standard or technical report, providing where to obtain information on the ANSI patent policy, and requesting that if the a license is required that the organization offer to grant such licenses in accordance with the ANSI patent policy.

If the organization concludes that licenses are required and refuses to offer them according to the ANSI patent policy, the Chair and technical editor need to take the appropriate steps to remove the offending requirement from the standard or technical report.

The technical editor, with guidance from the Chair needs to choose one of two patent statements from Option 1 and 2 highlighted below and insert it in the front matter of the draft standard or draft technical report depending upon the result of the call for patents. (During the editing of ISO/IEC drafts the technical editor needs to adjust the patent statement to the ISO/IEC version also given below. The IR has additional information on how the patent statement can be made more general if needed.)

### **NCITS patent policy:**

Unfortunately the NCITS patent policy contained in SD-9 is obsolete. Although obsolete it is quoted here for your information or misinformation as the case may be. Two clauses are given. The one in 4.16 has the correct choices of patent statements to be entered into the draft standard or technical report:

“2.9 The ANSI Patent Policy

Source: ANSI

Date: September 1993

Document Number: ANSI Patent Policy - Annex I - Procedures for the Development and Coordination of American National Standards

Related Policies: See SD-9, Section 2.9 & 4.16

Change from previous policy: New

## Annex I

### ANSI's Patent Policy

#### I.1 Inclusion of patents in American National Standards

There is no objection in principle to drafting a proposed American National Standard in terms that include the use of a patented item, if it is considered that technical reasons justify this approach.

If the Institute receives a notice that a proposed American National Standard may require the use of a patented invention, the procedures in Clause I.2 through I.5 shall be followed.

#### I.2 Statement from patent holder

Prior to approval of such a proposed American National Standard, the Institute shall receive from the patent holder (in a form approved by the Institute) either: assurance in the form of a general disclaimer to the effect that the patentee does not hold and does not anticipate holding any invention that use would be required for compliance with the proposed American National Standard or assurance that:

- a) A license will be made available without compensation to applicants desiring to utilize the license for the purpose of implementing the standard; or
- b) A license will be made available to applicants under reasonable terms and conditions that are demonstrably free of any unfair discrimination.

The terms and conditions of any license shall be submitted to ANSI for review by its counsel, together with a statement of the number of independent licensees, if any, which have accepted or indicated their acceptance of terms and conditions of the license.

#### I.3 Record of statement

A record of the patent holder's statement (and a statement of the basis for considering such terms and conditions free of any unfair discrimination) shall be placed and retained in the files of the Institute.

## I.4 Notice

When the Institute receives from a patent holder the assurance set forth in I.2(a) or 1.2(b), the standard shall include a note as follows:

NOTE - The user's attention is called to the possibility that compliance with this standard may require use of an invention covered by patent rights. "

### 4.16 Policy Statement on Patent Statements in X3 Standards

Source: X3 - approved by meeting vote X3/93-2059

Date: October 25, 1993

Document Number: X3/93-1900R

Related Policies: See X3/SD-9; Sections 2.9 & 6.1

Change from previous policy: New

#### Options for X3 Standards

At its June meeting, X3 reviewed a letter on patent issues from Mr. Smoot (X3/93-1327). Mr. Smoot reported that ANSI had informed him that "...a patent statement different from that in Section I4 of the procedures may be used by submitting a letter explaining the proposed statement when processing the standard." Mr. Smoot inferred that a permanent change could be made by a broader request by X3.

Given that a number of X3 standards are on hold and that published standards are also involved, this may be a good time for X3 to make a broader request. Any proposed text should cover the following circumstances:

- a. Compliance to the standard requires the use of an invention and compliance letters are on file at ANSI.
- b. Compliance to the standard requires the use of an invention covered by patent but neither the developer nor the publisher had notice at the time of publication. This may be true even if the conditions in (a) have been met.

#### **Option 1 (when notice and commitment to license exist):**

**CAUTION:** The developers of this standard have requested that holders of patents that may be required for the implementation of the standard disclose such patents to the publisher. However, neither the developers nor the publisher have undertaken a patent search in order to identify which, if any, patents may apply to this standard.

As of the date of publication of this standard, following calls for the identification of patents that may be required for the implementation of the standard, notice of one or more such claims has been received.

By publication of this standard, no position is taken with respect to the validity of this claim or of any rights in connection therewith. The known patent holder(s) has (have), however, filed a statement of willingness to grant a license under these rights on reasonable and nondiscriminatory terms and conditions to applicants desiring to obtain such a license. Details may be obtained from the publisher.

No further patent search is conducted by the developer or publisher in respect to any standard it processes. No representation is made or implied that this is the only license that may be required to avoid infringement in the use of this standard.

**Option 2 - (when neither the developer nor the publisher had notice at the time of publication)**

**CAUTION:** The developers of this standard have requested that holders of patents that may be required for the implementation of the standard disclose such patents to the publisher. However, neither the developers nor the publisher have undertaken a patent search in order to identify which, if any, patents may apply to this standard.

As of the date of publication of this standard and following calls for the identification of patents that may be required for the implementation of the standard, no such claims have been made. No further patent search is conducted by the developer or publisher in respect to any standard it processes. No representation is made or implied that licenses are not required to avoid infringement in the use of this standard.

**ANSI, "Procedures for the Development and Coordination of American National Standards":**

The following quotes pertain to patents:

**“1.2.11 ANSI patent policy**

Inclusion of patents in American National Standards. There is no objection in principle to drafting a proposed American National Standard in terms that include the use of a patented item, if it is considered that technical reasons justify this approach.

If the Institute receives a notice that a proposed American National Standard may require the use of a patented invention, the procedures in 1.2.11.1 through 1.2.11.4 shall be followed.

**1.2.11.1 Statement from patent holder**

Prior to approval of such a proposed American National Standard, the Institute shall receive from the patent holder (in a form approved by the Institute) either:

assurance in the form of a general disclaimer to the effect that the patentee does not hold and does not anticipate holding any invention the use of which would be required for compliance with the proposed American National Standard or assurance that:

- a) a license will be made available without compensation to the applicants desiring to utilize the license for the purpose of implementing the standard; or
- b) a license will be made available to applicants under reasonable terms and conditions that are demonstrably free of any unfair discrimination.

The terms and conditions of any license shall be submitted to ANSI for review by its counsel, together with a statement of the number of independent licensees, if any, which have accepted or indicated their acceptance of terms and conditions of the license.

#### 1.2.11.2 Record of statement

A record of the patent holder's statement (and a statement of the basis for considering such terms and conditions free of any unfair discrimination) shall be placed and retained in the files of the Institute.

#### 1.2.11.3 Notice

When the Institute receives from a patent holder the assurance set forth in 1.2.11.1 a) or b), the standard shall include a note as follows:

NOTE - The user's attention is called to the possibility that compliance with this standard may require use of an invention covered by patent rights. By publication of this standard, no position is taken with respect to the validity of this claim or of any patent rights in connection therewith. The patent holder has, however, filed a statement of willingness to grant a license under these rights on reasonable and nondiscriminatory terms and conditions to applicants desiring to obtain such a license. Details may be obtained from the publisher.

#### 1.2.11.4 Responsibility for identifying patents

The Institute shall not be responsible for identifying all patents for which a license may be required by an American National Standard or for conducting inquiries into the legal validity or scope of those patents that are brought to its attention.

#### 1.2.12 Consideration of standards proposals

Prompt consideration shall be given to proposals made for developing new standards, or revising or withdrawing existing American National Standards.

#### 1.2.13 Records

Records shall be prepared and maintained to provide evidence of compliance with these procedures. Records shall be retained for a period of time after the

adoption, reaffirmation, or withdrawal of an American National Standard as specified by the standards developer.

### **ISO/IEC JTC 1 Patent Policy:**

Directives ISO/IEC – Part 2, Amend. 1 – 1 –

#### **FOREWORD**

This amendment has been approved by ISO/CEI Councils in 1994.

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5.7 Reference to patented items

Replace the title and text of 5.7 by the following:

5.7 Reference to patent rights

If, in exceptional situations, technical reasons justify such a step, there is no objection in principle to preparing an International Standard in terms which include the use of items covered by patent rights – defined as patents, utility models and other statutory rights based on inventions, including any published applications for any of the foregoing – even if the terms of the standard are such that there are no alternative means of compliance. The rules given in annex A shall be applied.

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Replace the existing annex A by the following:

### **Annex A** (normative) **Reference to patent rights**

**A.1** A published International Standard for which no patent rights are identified during the preparation thereof, shall contain the following notice:

“Attention is drawn to the possibility that some of the elements of this International Standard may be the subject of patent rights. ISO [ and/or] IEC shall not be held responsible for identifying any or all such patent rights.”

**A.2** If technical reasons justify the preparation of an International Standard in terms which include the use of items covered by patent rights, the following procedures shall be complied with.

a) The originator of a proposal for an International Standard shall draw the attention of the technical committee or sub-committee to any patent rights of which the originator is aware and considers to cover any item of the proposal. Any party involved in the preparation of a standard shall draw the attention of the technical committee or sub-committee to any patent rights of which it becomes aware during any stage in the development of the standard.

b) If the proposal is accepted on technical grounds, the originator shall ask any holder of such identified patent rights for a statement that the holder would be willing to negotiate worldwide licences under his rights with applicants throughout the world on reasonable and non-discriminatory terms and conditions. Such negotiations are left to the parties concerned and are performed outside the ISO or IEC. A record of the right holder's

statement shall be placed in the registry of the ISO Central Secretariat or IEC Central Office as appropriate, and shall be referred to in the introduction to the relevant International Standard (see item e) below). If the right holder does not provide such a statement, the technical committee or sub-committee concerned shall not proceed with inclusion of an item covered by a patent right in the International Standard without authorization from ISO Council or IEC Council as appropriate.

c) All drafts submitted for comment shall include on the cover page the following text: "Recipients of this document are invited to submit, with their comments, notification of any relevant patent rights of which they are aware and to provide supporting documentation."

d) An International Standard shall not be published until the statements of the holders of all identified patent rights have been received, unless the Council concerned gives authorization.

e) A published International Standard for which patent rights have been identified during the preparation thereof, shall include the following notice in the introduction: "The International Organization for Standardization (ISO) [ and/or] International Electrotechnical Commission (IEC) draws attention to the fact that it is claimed that compliance with this International Standard may involve the use of a patent concerning (.. subject matter..) given in (.. subclause..).

The ISO [ and/or] IEC take[s] no position concerning the evidence, validity and scope of this patent right.

The holder of this patent right has assured the ISO [ and/or] IEC that he is willing to negotiate licences under reasonable and non-discriminatory terms and conditions with applicants throughout the world. In this respect, the statement of the holder of this patent right is registered with the ISO [ and/or] IEC. Information may be obtained from: [... name of holder of patent right...]  
[... address...]

Attention is drawn to the possibility that some of the elements of this International Standard may be the subject of patent rights other than those identified above. ISO [ and/or] IEC shall not be held responsible for identifying any or all such patent rights."

**A.3** Should it be revealed after publication of an International Standard that licences under patent rights, which appear to cover items included in the standard, cannot be obtained under reasonable and non-discriminatory terms and conditions, the International Standard shall be referred back to the relevant technical committee or sub-committee for further consideration.