

IEEE-SA Patent Policy

Introduction and guide to the
IEEE-SA patent policy
effective 15 March 2015

- This presentation covers a variety of topics related to the 2015 and 2007 updates to the IEEE Standards Association Patent Policy.
- Not all parts of the Patent Policy are discussed or referenced. No meaning is to be ascribed to specific text's presence or absence.
- These slides are merely illustrative and educational. The Patent Policy itself, as contained in the IEEE Standards Association Standards Board Bylaws clause 6, is the definitive statement of the policy.

Inclusion of Potential Essential Patent Claims

Inclusion of Essential Patent Claims in standard

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-SA Standards Board approved Letter of Assurance form, from the patent holder or patent applicant. The IEEE shall request this assurance without coercion.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 1

“Essential Patent Claim” shall mean any Patent Claim the practice of which was necessary to implement either a mandatory or optional portion of a normative clause of the IEEE Standard when, at the time of the IEEE Standard’s approval, there was no commercially and technically feasible non-infringing alternative implementation method for such mandatory or optional portion of the normative clause. 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.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 7

“Patent Claim(s)” shall mean one or more claims in issued patent(s) or pending patent application(s).

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 9

Inclusion of Essential Patent Claims in standard

“Compliant Implementation” shall mean any product (e.g., component, sub-assembly, or end-product) or service that conforms to any mandatory or optional portion of a normative clause of an IEEE Standard.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 5

“Enabling Technology” shall mean any technology that may be necessary to make or use any product or portion thereof that complies with the IEEE Standard but is neither explicitly required by nor expressly set forth in the IEEE Standard (e.g., semiconductor manufacturing technology, compiler technology, object-oriented technology, basic operating system technology, and the like).

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 6

Inclusion of Essential Patent Claims in standard

- Essential Patent Claim
 - In issued or pending patent applications
 - Either mandatory or optional portions of standard
 - Determined as of time of the standards approval
 - Necessary to create Compliant Implementation
 - No commercially and technically feasible non-infringing alternative
 - Doesn't include Enabling Technology
 - Unless functionally necessary or a normative requirement of the standard
 - Patent claims related to C language compiler are an example
- Assurance only applies to Essential Patent Claims
 - Some claims in a patent may be essential, some not
- Potential Essential Patent Claims can be included
 - But **DO NOT** discuss
 - Interpretation, validity, or essentiality of patents/patent claims
 - For these purposes, potential essentiality is based on assertion of holder
- Letter of Assurance form is the only acceptable template
 - Modified Letter of Assurance form will not be accepted
 - Filling in the form is not considered a modification
 - 'Free form' letters will no longer be accepted
 - Attachments to the LOA form are permitted only where explicitly allowed

Call for patents

The chair or the chair's delegate of an IEEE standards-developing working group or the chair of a Standards Committee shall be responsible for informing the participants at a meeting that if any individual believes that Patent Claims might be Essential Patent Claims, that fact should be made known to the entire working group and duly recorded in the minutes of the working group meeting. This request shall occur at every standards-developing meeting once the PAR is approved by the IEEE-SA Standards Board.

The chair or the chair's delegate shall ask any patent holder or patent applicant of a Patent Claim that might be or become an Essential Patent Claim to complete and submit a Letter of Assurance in accordance with Clause 6 of the *IEEE-SA Standards Board Bylaws*. Information about the draft standard will be made available upon request.

IEEE-SA Standards Board Operations Manual Subclause 6.3.2

- Call shall be made at **every** standards-development meeting
 - Working Group, Task Force, Task Group, Ad Hoc, conference calls
 - Working Group chair or designee makes the call
 - State that if an individual believes a patent claim might be an Essential Patent Claim, such individual should make the Working Group aware of this
 - Record in minutes that call for patents was made
 - Record in minutes any response
- When informed, Working Group chair shall contact holder requesting an LOA
 - Sample letter provided at <http://standards.ieee.org/about/sasb/patcom/index.html>
 - [https://development.standards.ieee.org/myproject/Public/mytools/mob/cover_letter.doc]

Duty on participants

In order for IEEE's patent policy to function efficiently, individuals participating in the standards development process: (a) shall inform the IEEE (or cause the IEEE to be informed) of the holder of any potential Essential Patent Claims of which they are personally aware and that are not already the subject of an Accepted Letter of Assurance, that are owned or controlled by the participant or the entity the participant is from, employed by, or otherwise represents; ...

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 20

- If you personally know of a potential Essential Patent Claim that is not covered by an existing LOA
 - Then if the potential Essential Patent Claim is owned by you or the entity you are affiliated with, you have a duty to ensure that IEEE is informed of the holder
 - See *IEEE-SA Standards Board Operation Manual* subclause 5.1.2.3 'Disclosure of affiliation' for more on the definition of Affiliation
 - This includes corporate affiliates
 - To inform IEEE of the holder you could, for example,
 - Inform the Working Group chair, or;
 - Inform the appropriate person in your company and make sure they submit an LOA to IEEE.

Third party claims

In order for IEEE's patent policy to function efficiently, individuals participating in the standards development process: ... (b) should inform the IEEE (or cause the IEEE to be informed) of any other holders of potential Essential Patent Claims that are not already the subject of an Accepted Letter of Assurance.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 20

- If you personally know of a potential Essential Patent Claim that is not covered by an existing LOA:
 - Participants are not required to notify IEEE that they are aware of any potential Essential Patent Claims held by a third party. Participants may make such disclosure at their own discretion.
 - Although there is no obligation to notify IEEE of third party patent holders, the IEEE encourages participants to do so.
 - This encouragement is particularly strong as the third party may not be a participant in the standards process.

Timing

If the patent holder or patent applicant provides an LOA, 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 LOA should be provided prior to the Standards Board's approval of the standard.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 2

- Early assurance is encouraged and expected
 - The more information the better when selecting between proposals
- Identification can be made at any time
 - Just inform the Working Group chair
 - Whether in the meeting or otherwise
- Delivery of assurance
 - Prior to Standards Board approval of standard is preferred

What if Licensing Assurance cannot be obtained?

An asserted potential Essential Patent Claim for which licensing assurance cannot be obtained (e.g., an LOA is not provided or the LOA indicates that licensing assurance is not being provided) shall be referred to the Patent Committee.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 2

- If there is no Accepted LOA for an asserted potential Essential Patent Claim:
 - Inform IEEE-SA Standards Board Patent Committee (PatCom)
 - PatCom will consider
 - May make recommendation to IEEE-SA Standards Board
 - Ultimately IEEE-SA Standards Board will decide

Distribution of LOAs

Copies of an Accepted LOA may be provided to participants in a standards development meeting. Discussion of essentiality, interpretation, or validity of Patent Claims is prohibited during IEEE-SA standards-development meetings or other duly authorized IEEE-SA standards-development technical activities. IEEE-SA shall provide procedures stating when and the extent to which patent licensing terms may be discussed (see subclause 5.3.10 of the IEEE-SA Standards Board Operations Manual).

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 17

Upon written request, the IEEE will make available copies of any Accepted Letter of Assurance and its attachments. Letters received after 31 December 2006 shall be posted on the IEEE-SA website.

IEEE-SA Standards Board Operations Manual Subclause 6.3, Para 3

- Accepted LOA can be distributed in meetings
- But remember:
 - **Don't** discuss interpretation, validity, or essentiality of patents/patent claims
 - **Don't** discuss specific license rates, terms, or conditions
 - Relative costs and technical merits may be discussed and considered
- LOAs received after 31 Dec 2006 will be made available on web
- LOAs received on or before 31 Dec 2006 are available by contacting PatCom Administrator
 - Activity underway to add these to web as well

Legal compliance and other issues

5.3.10 Legal compliance and other issues

5.3.10.1 Compliance with laws

All IEEE-SA standards meetings shall be conducted in compliance with all applicable laws, including antitrust and competition laws. In the course of IEEE standards development, participants shall not engage in fixing product prices, allocating customers, dividing sales markets, or other conduct that violates antitrust or competition laws.

5.3.10.2 Discussion of litigation, patents and licensing

No discussions or other communications regarding the following topics shall occur during IEEE-SA working group standards-development meetings or other duly authorized IEEE-SA standards-development technical activities:

- The status or substance of ongoing or threatened litigation
- The essentiality, interpretation, or validity of patent claims
- Specific patent license terms or other intellectual property rights, other than distribution of Accepted Letters of Assurance as permitted under the IEEE-SA patent policy (see 6.2 of *IEEE-SA Standards Board Bylaws*)

5.3.10.3 Discussion of relative cost/benefit analyses

When comparing different technical approaches in IEEE-SA standards development technical activities, participants may discuss the relative costs (in terms, for example, of percentage increases or decreases) of different proposed technical approaches in comparison with the relative technical performance increases or decreases of those proposals. The relative costs may include any potentially Essential Patent Claims, but not the price at which compliant products may or will be sold. Technical considerations should be the main focus of discussions in IEEE-SA standards development technical activities.

IEEE-SA Standards Board Operations Manual Subclause 5.3.10

Legal compliance and other issues

- All IEEE-SA standards meetings shall be conducted in compliance with all applicable laws, including antitrust and competition laws
- Don't discuss fixing product prices, allocation of customers, or dividing sales markets
- Don't discuss the status or substance of ongoing or threatened litigation
- Don't discuss specific license rates, terms, or conditions
- Don't be silent if inappropriate topics are discussed... do formally object
- Relative costs of different technical approaches may be discussed in standards development meetings
 - May include licensing costs of Essential Patent Claims, but only on a relative basis
 - This shall not be used to coerce those patent holders who have chosen not to disclose maximum licensing fees into disclosing such information
 - A comparison, however, may state that costs of a particular technology approach are not known
 - Technical considerations remain primary focus
 - For more information see “***Promoting Competition and Innovation: What You Need to Know about the IEEE Standards Association's Antitrust and Competition Policy***”
<https://standards.ieee.org/content/dam/ieee-standards/standards/web/documents/other/antitrust.pdf>

The Assurance

Letters of Assurance

The licensing 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, having made, using, selling, offering to sell, or importing any Compliant Implementation that practices the Essential Patent Claims for use in conforming with the IEEE Standard; or,
- b) A statement that the Submitter will make available a license for Essential Patent Claims to an unrestricted number of Applicants on a worldwide basis without compensation or under Reasonable Rates, with other reasonable terms and conditions that are demonstrably free of any unfair discrimination to make, have made, use, sell, offer to sell, or import any Compliant Implementation that practices the Essential Patent Claims for use in conforming with the IEEE Standard. An Accepted LOA that contains such a statement signifies that reasonable terms and conditions, including without compensation or under Reasonable Rates, are sufficient compensation for a license to use those Essential Patent Claims and precludes seeking, or seeking to enforce, a Prohibitive Order except as provided in this policy.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 3 & 4

Letters of Assurance

- The content of a Letter of Assurance shall be one of the following:
 - Assurance that Essential Patent Claims will not be enforced
 - Assurance that Essential Patent Claims will be licensed
 - Reasonable and nondiscriminatory terms and conditions
 - With or without monetary compensation
 - At Reasonable Rates, if monetary compensation is required.
 - At its sole option, Submitter may include
 - Not-to-exceed rates
 - Sample license agreement
 - Material licensing terms
 - A statement that Submitter is unable or unwilling to grant license
 - A statement that the Submitter is not aware of any potential Essential Patent Claims that it may hold
- Submission of an LOA is voluntary
 - Individuals or entities may participate in standards development regardless of whether an LOA has been submitted

Reasonable Rates

“Reasonable Rate” shall mean appropriate compensation to the patent holder for the practice of an Essential Patent Claim excluding the value, if any, resulting from the inclusion of that Essential Patent Claim’s technology in the IEEE Standard. In addition, determination of such Reasonable Rates should include, but need not be limited to, the consideration of:

- The value that the functionality of the claimed invention or inventive feature within the Essential Patent Claim contributes to the value of the relevant functionality of the smallest saleable Compliant Implementation that practices the Essential Patent Claim.
- The value that the Essential Patent Claim contributes to the smallest saleable Compliant Implementation that practices that claim, in light of the value contributed by all Essential Patent Claims for the same IEEE Standard practiced in that Compliant Implementation.
- Existing licenses covering use of the Essential Patent Claim, where such licenses were not obtained under the explicit or implicit threat of a Prohibitive Order, and where the circumstances and resulting licenses are otherwise sufficiently comparable to the circumstances of the contemplated license.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 12-15

Reasonable Rates

- Shall be appropriate compensation to the patent holder for the practice of an Essential Patent Claim excluding the value, if any, resulting from the inclusion of that Essential Patent Claim's technology in the IEEE Standard.
 - This does not mean that an Essential Patent Claim covering an invention created solely to enhance an IEEE standard can never have value.
- In addition it should include, but need not be limited to, the consideration of three non-mandatory “factors” -
 - The value contributed to the smallest saleable Compliant Implementation
 - The value contributed to the smallest saleable Compliant Implementation in light of the value contributed by all Essential Patent Claims on the same IEEE Standard
 - Any comparable existing licenses including but not limited to:
 - Licenses that cover the use of the same Essential Patent Claim(s);
 - Licenses that were negotiated without the threat of Prohibitive Orders; and,
 - Licenses that were negotiated in comparable circumstances.
- A Submitter and an implementer are free to consider other factors they believe are appropriate.
- 'Rate' means compensation, which can take a variety of forms.

Assurance of non-awareness

'The Submitter of a 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.'

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 2

"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 Standards Association 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.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 11

Assurance of non-awareness

- Submitter may state in LOA that it is not aware of any Patent Claims that might be or become Essential Patent Claims.
- After ‘Reasonable and Good Faith Inquiry’
 - For example, reasonable efforts to identify and contact
 - If Submitter has participants in project identified in the LOA
 - Current and past participants
 - » This includes, but is not limited to, WG and Standards Association ballots
 - If the Submitter doesn’t have participants in project identified in the LOA
 - Those of its employees that the Submitter believes likely to have knowledge of the technology

Affiliates

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

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 9

An Accepted Letter of Assurance shall apply to the Submitter, including its Affiliates. The Submitter, however, may specifically exclude certain Affiliates identified in the Letter of Assurance, except that a Submitter shall have no ability to exclude Affiliates if the Submitter has indicated Reciprocal Licensing on an Accepted Letter of Assurance.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 6

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- Assurance shall not intentionally be circumvented through sale or transfer
 - Assurance shall apply to Affiliates unless explicitly excluded
 - Those excluded may be contacted by IEEE with a request for LOA
 - May not exclude any affiliates if Reciprocal Licensing is indicated on LOA

Reciprocal Licensing

“Reciprocal Licensing” shall mean that the Submitter of an LOA has conditioned its granting of a license for its Essential Patent Claims upon the Applicant’s agreement to grant a license to the Submitter with Reasonable Rates and other reasonable licensing terms and conditions to 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 IEEE Standard and its amendments, corrigenda, editions, and revisions.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 16

The Submitter shall not condition a license on the Applicant’s agreeing (a) to grant a license to any of the Applicant’s Patent Claims that are not Essential Patent Claims for the referenced IEEE standard, or (b) to take a license for any of the Submitter’s Patent Claims that are not Essential Patent Claims for the referenced IEEE standard.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 7

On a Letter of Assurance, the Submitter may indicate a condition of Reciprocal Licensing. If an Applicant requires compensation under Reciprocal Licensing to its Essential Patent Claims, then a Submitter may require compensation for its Essential Patent Claims from that Applicant even if the Submitter has otherwise indicated that it would make licenses available without compensation.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 8

Reciprocal Licensing

- The Submitter may condition its license to the Applicant on receiving a license from the Applicant only for the Applicant's Essential Patent Claims on the same IEEE Standard.
- Demands for licenses to an Applicant's Patent Claims that are not Essential Patent Claims for the same standard are not permitted unless mutually and voluntarily agreed by both parties.
- If the Submitter has offered its license without compensation but an Applicant holding Essential Patent Claims for the same standard demands compensation then the Submitter may also demand compensation.
- If Reciprocal Licensing is indicated on LOA, no Affiliates may be excluded.

Durability of assurance

An Accepted Letter of Assurance is intended to be binding upon any and all assignees and transferees of any Essential Patent Claim covered by such LOA. The Submitter agrees (a) to provide notice of an Accepted Letter of Assurance either through a Statement of Encumbrance or by binding its assignee or transferee to the terms of such Letter of Assurance; and (b) to require its assignee or transferee to (i) agree to similarly provide such notice and (ii) to bind its assignees or transferees to agree to provide such notice as described in (a) and (b).

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 10

“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.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 17

- Submitter agrees to:
 - Notify assignees/transferees of the existence of assurance
 - Either through stating in the agreement to assign/transfer
 - The existence of a specific LOA
 - Or by a general statement
 - Or binding assignees/transferees to LOA
 - Require the assignee/transferee to agree to similarly provide notice to subsequent assignee/transferee which sets up a cascading notice requirement.

Duty to update assurance

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

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 15

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- If after submitting an LOA the Submitter becomes aware of other potential Essential Patent Claims, the first LOA commits the Submitter to submit a new LOA
 - A Submitter's awareness applies to either (a) past or present participants or (b) the individual executing the previously Accepted Letter of Assurance

Acceptance and validity of LOA

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

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 16

“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.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 1

Letters of Assurance are to be e-mailed, faxed, or mailed to the IEEE Standards Association (to the attention of the PatCom Administrator). The PatCom Administrator shall accept each Letter of Assurance that is complete and is received from an individual within the issuing organization whose title suggests authority for intellectual property and legal matters. The PatCom Administrator's duties with regard to Letters of Assurance shall be purely ministerial (i.e., without regard to or exercise of the PatCom Administrator's discretion regarding the content of the Letters of Assurance received). For each Accepted Letter of Assurance, the PatCom Administrator shall record the date on the signed Letter of Assurance and the date upon which the IEEE accepted such.

IEEE-SA Standards Board Operations Manual Subclause 6.3, Para 2

Acceptance and validity of LOA

- An LOA is irrevocable once submitted and accepted
 - Accepted by PatCom Administrator
 - Accepted when
 - IEEE-SA determines LOA form is complete in all material respects
 - And LOA has been posted to web site
<http://standards.ieee.org/about/sasb/patcom/patents.html>
- LOA must be signed by person with clear authority
 - If not, Submitter will be contacted for confirmation
- LOA applies at a minimum from Standards approval until its transfer to inactive status

Other Features

Negotiation and Arbitration

The Submitter and the Applicant should engage in good faith negotiations (if sought by either party) without unreasonable delay or may litigate or, with the parties' mutual agreement, arbitrate: over patent validity, enforceability, essentiality, or infringement; Reasonable Rates or other reasonable licensing terms and conditions; compensation for unpaid past royalties or a future royalty rate; any defenses or counterclaims; or any other related issues.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 11

Nothing in this policy shall preclude a Submitter and an implementer from agreeing to arbitrate over patent validity, enforceability, essentiality, or infringement; Reasonable Rates or other reasonable licensing terms and conditions; compensation for unpaid past royalties or a future royalty rate; any defenses or counterclaims; reciprocal obligations; or any other issues that the parties choose to arbitrate.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 13

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

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 14

Negotiation and Arbitration

- The Submitter and Applicant are encouraged to negotiate a license agreement on a timely basis.
- If they are unable to come to an agreement, either party may initiate litigation to resolve issues including but not limited to:
 - Patent validity, enforceability, essentiality, or infringement
 - Reasonable Rates or other reasonable licensing terms and conditions
 - Compensation for unpaid past royalties or a future royalty rate
 - Any defenses or counterclaims.
- The parties may mutually and voluntarily agree to arbitrate the issues rather than litigate.
- The parties are free to include other licensing terms agreeable to both parties in their license agreement.

Prohibitive Orders

“Prohibitive Order” shall mean an interim or permanent injunction, exclusion order, or similar adjudicative directive that limits or prevents making, having made, using, selling, offering to sell, or importing a Compliant Implementation.

IEEE-SA Standards Board Bylaws Subclause 6.1, Para 10

The Submitter of an Accepted LOA who has committed to make available a license for one or more Essential Patent Claims agrees that it shall neither seek nor seek to enforce a Prohibitive Order based on such Essential Patent Claim(s) in a jurisdiction unless the implementer fails to participate in, or to comply with the outcome of, an adjudication, including an affirming first-level appellate review, if sought by any party within applicable deadlines, in that jurisdiction by one or more courts that have the authority to: determine Reasonable Rates and other reasonable terms and conditions; adjudicate patent validity, enforceability, essentiality, and infringement; award monetary damages; and resolve any defenses and counterclaims. In jurisdictions where the failure to request a Prohibitive Order in a pleading waives the right to seek a Prohibitive Order at a later time, a Submitter may conditionally plead the right to seek a Prohibitive Order to preserve its right to do so later, if and when this policy’s conditions for seeking, or seeking to enforce, a Prohibitive Order are met.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 12

Prohibitive Orders

- Prohibitive Orders include a variety of potential actions by a court or other government adjudicator to stop an activity. These include both permanent and temporary injunctions, exclusion orders, etc.
- Negotiating without the threat of a Prohibitive Order will lead to licenses providing appropriate compensation to the patent holder for the value of practicing the Essential Patent Claim rather than any value resulting from the inclusion of that Essential Patent Claim's technology in the IEEE Standard.
- The Submitter of an LOA providing licensing assurance is voluntarily agreeing not to seek or seek to have enforced a Prohibitive Order until certain conditions are met, including:
 - A decision by a court in the Submitter's favor is upheld by an appellate court and the implementer refuses or is unable to comply.
 - The implementer fails to participate in the adjudication process of the court(s) with the power to determine and award reasonable compensation to the Patent Holder.
 - The implementer is not subject to the jurisdiction of the court(s) with the power to determine and award reasonable compensation to the Patent Holder and does not voluntarily submit to such jurisdiction.
- A Submitter can conditionally seek a Prohibitive Order early in a jurisdiction if not doing so means it will permanently be unable to do so in that jurisdiction.

IEEE Public Notice Disclaimer

The IEEE is not responsible for

1. Identifying Essential Patent Claims for which a license may be required;
2. Determining the validity, essentiality, or interpretation of Patent Claims;
3. Determining whether any licensing terms or conditions provided in connection with submission of a Letter of Assurance, if any, or in any licensing agreements are reasonable or non-discriminatory; or,
4. Determining whether an implementation is a Compliant Implementation.

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 18

- IEEE is explicitly stating several items for which it is not responsible.

IEEE Public Notice Disclaimer

The following notice shall appear in all draft and approved IEEE standards.

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 by the IEEE with respect to the existence or validity of any patent rights in connection therewith. If a patent holder or patent applicant has filed a statement of assurance via an Accepted Letter of Assurance, then the statement is listed on the IEEE-SA website. Letters of Assurance may indicate whether the Submitter is willing or unwilling to grant licenses under patent rights without compensation or under reasonable rates, with reasonable terms and conditions that are demonstrably free of any unfair discrimination to applicants desiring to obtain such licenses.

Essential Patent Claims may exist for which a Letter of Assurance has not been received. 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 provided in connection with submission of a Letter of Assurance, if any, or in any licensing agreements are reasonable or non-discriminatory. Users of this standard are expressly advised that determination of the validity of any patent rights, and the risk of infringement of such rights, is entirely their own responsibility. Further information may be obtained from the IEEE Standards Association.

IEEE-SA Standards Board Operations Manual Subclause 6.3.1

IEEE Public Notice Disclaimer

- IEEE-SASB Operations Manual prescribes a statement concerning potential patented technology that is to be included in every published standard. This includes text that, among other things:
 - Warns of the potential existence of patented technology in the standard
 - Warns that IEEE takes no position regarding the existence or validity of any patent rights
 - Tells the reader that any statements regarding licensing assurance are available on the IEEE Standards Association's web site
 - Warns the reader that IEEE takes no position regarding the reasonableness or non-discriminatory nature of any offered licensing terms
- The IEEE working group developing the standard is not responsible for including the text in the standard. The prescribed text will be inserted by IEEE Standards Association staff before publication.

Patent searches and no licenses by LOA

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

IEEE-SA Standards Board Bylaws Subclause 6.2, Para 19

- No duty
 - Voluntary patent searches are not prohibited.
- No license is granted by submitting an LOA

Questions and Resources

- Questions? Contact the IEEE-SA Standards Board Patent Committee Administrator at patcom@ieee.org, or
- Visit these resources:
 - Patent Policy (IEEE-SA Standards Board Bylaws clause 6), <https://standards.ieee.org/about/policies/bylaws/sect6-7.html>
 - Understanding Patent Issues During IEEE Standards Development, <https://standards.ieee.org/content/dam/ieee-standards/standards/web/documents/other/patents.pdf>
 - PatCom Patent Materials, <https://standards.ieee.org/about/sasb/patcom/materials.html>
 - Promoting Competition and Innovation: What You Need to Know about the IEEE Standards Association's Antitrust and Competition Policy, <https://standards.ieee.org/content/dam/ieee-standards/standards/web/documents/other/antitrust.pdf>
 - IEEE-SA Standards Board Resolution (2 June 2015), <https://standards.ieee.org/about/sasb/resolutions.html>