



Guidelines to the Telecommunications Industry Association Intellectual Property Rights Policy

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1st Edition

TIA has an Intellectual Property Rights (IPR) Policy. These guidelines serve as a companion document and are not intended to substitute for the Policy itself but rather to provide supplemental information to the TIA IPR Policy, the TIA Procedures for American National Standards (PANS) and the TIA Engineering Committee Operating Procedures (ECOP).

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1. Introduction

The Telecommunications Industry Association (TIA) is accredited by the American National Standards Institute (ANSI) to develop standards intended to enhance and promote the beneficial use of telecommunications products manufactured by its member companies in the United States and throughout the world. In this process, representatives of member companies and others having an interest in the subject matter under consideration come together for the formulation of standards and other publications useful in the telecommunications industry.

TIA is the administrator of the standards formulation process; TIA is not the writer of standards. This latter work is carried on by the many participants in Formulating Groups, Engineering Committees, Subcommittees, Task Groups and Working Groups who carry on the writing and developing of standards with the administrative oversight and assistance of TIA Standards Department.

Utilizing contributions submitted by participants, and enhanced by a process of discussion and the interchange of ideas, the work culminates in a consensus document which, after a process of balloting and the resolution of differences, is ultimately published and made available.

An area of great importance in the process is the treatment of intellectual property rights (IPR). On the one hand, there is an important industry and public interest in the availability of the latest technological ideas and developments for inclusion in new products and services for the benefit of users. At the same time, inventors and innovative creators rightfully expect to reap the benefits of their time, expense and creativity. Thus, it is the policy of ANSI and TIA, when necessary, to permit the inclusion in standards of technology protected by certain statutory IPR. However, this is permitted pursuant to a policy that seeks to make the IPR available on a reasonable and non-discriminatory basis for all that would use it to fashion products contemplated by the standard in question.

For many years, TIA has published a TIA *Engineering Manual* for the instruction of those groups engaged in the authorship of standards. An integral part of this process is the IPR policy. Recently, this portion of the Manual was revised by TIA's IPR Standing Committee, which operates under the Standards and Intellectual Property Policy Committee (SIPC) of TIA. Among other things, the Policy covers published patent applications and certain software copyrights as well as issued patents, resulting in the Policy now being referred to as the TIA IPR Policy.

These Guidelines are intended to review the Policy, with an explanation of the rationale and some explanation of the intent of the IPR Standing Committee. It is the hope of the Standing Committee that the Guidelines will assist the chairs and members of those groups engaged in the authorship of standards and other documents.

2. The Participant's First Commitment

An "Important Notice of Participation" makes it clear that whatever is stated or presented in writing, or otherwise disclosed, during attendance at or participation in those groups engaged in the authorship of standards and other documents can, without compensation, be published or distributed by TIA, or posted on its web site, unless an exception is made by the designated officer of TIA. *It is the intention of that language to make it clear that TIA is granted the right to publish any submission to a Formulating Group, even if a submission cover is omitted, to the same extent as if a submission cover was submitted.* It is not intended to excuse the provision of a submission cover, which is still mandated.

This "Important Notice of Participation" does not imply that a person making a statement or providing a submission, without explicit language to such effect, makes any representations as to the content of such statement or submission. It does constitute a license to TIA of whatever rights the submitter may have to publish or distribute the same or post it in the TIA web site. However, when a submission constitutes a Contribution, the provisions on Contributions are applicable (see the TIA *Engineering Committee Operating Procedures*).

3. IPR in standards

As in the past, a patented invention (and in more limited cases, certain software) may be included in a standard. Also as in the past, TIA is not responsible for identifying patents or making any inquiry into the validity or scope of any patent. The Statement on Responsibility for Identifying Patents (see the TIA *Engineering Committee Operating Procedures*) also formalizes what has been the policy of TIA--that it will neither be a party to the discussion of licensing terms and conditions nor will it get involved in the issue of whether proposed licensing terms and conditions are reasonable or non-discriminatory. *These are matters for resolution by the parties, and they are not the proper subject matter for any discussion at a meeting of TIA or any of its committees or working groups.*

3.1. Disclosure

TIA encourages--but does not require-- voluntary disclosure, and preferably early disclosure, of patents and published patent applications which may be essential

to the practice of a standard or any other TIA Publication. TIA Publication is now defined as including publications of the Standards and Technology Department available to the general public, but does not include literature distributed only to formulating group members.

A three-part approach will be used by TIA to encourage voluntary disclosure (preferably early) of Essential Patent(s) and published pending patent application(s).

At the beginning of each meeting, a chair ensures that all participants are aware of the early disclosure policy.

The second part of the approach is that the TIA will place a notification on each ballot for a proposed document.

The third part of the approach may be the placement of an optional, voluntary disclosure statement by the Source(s) on a submission cover sheet.

4. Submission Cover Sheet

For convenience, a suggested format for the cover sheet to be used for a submission will be provided by the TIA Standards Department. Regardless of whether this format is used or not, there are four required elements that must be contained in a cover sheet in whatever form the submitter prepares. Note that there are specific forms that may apply when a submission contains software.

A submission with the required four elements on the submission cover sheet has the effect of incorporating the language of the TIA IPR Policy, which means the contributor grants to TIA a non-exclusive, worldwide, irrevocable license (with the right to sublicense) broadly to copyright and include all or any part of the submission in any TIA Publication, with rights to sell the TIA Publication. The submission also discloses any known limitations on the Source's rights to license. *It is intended by this provision that if no such limitations are disclosed, the contributor is asserting there are none.*

Two optional paragraphs may be included in a submission cover sheet. These two optional paragraphs are intended to further encourage the voluntary disclosure of IPR in line with TIA's policy previously mentioned.

Representatives of U.S. government agencies have in the past found it difficult to submit submission cover sheets purporting to license copyrights because of the absence of copyright in writings produced for the agencies.

5. Dealing with Disclosed or Identified IPR

What is the IPR policy intended to achieve? Allowing the inclusion of essential IPR in a standard permits the selection by the Formulating Group of the best available technology, a clear advantage for the ultimate user.

Requiring reasonable and non-discriminatory (RAND) licenses to all applicants prevents the inclusion of patented technology from resulting in a patent holder securing a monopoly in any market as a result of the standardization process. Thus, licensing offers which defeat this intention are likely to fail the RAND test and do not comply with the Policy. But the precise terms and conditions are left to the parties, or if the parties fail to agree and dispute the reasonable and non-discriminatory character of what the licensor offers, the matter is left to the courts.

The term “non-discriminatory” does not mean or imply that licensing terms must be the same for all applicants. Discrimination and difference are not the same. It is understood that the process of license negotiation and the components of consideration between parties can vary substantially yet be fair. The term “non-discriminatory” implies a standard of even-handedness. An example of conduct that would constitute discrimination is a willingness to license all applicants except for competitors of the licensor.

As noted above, the policy of TIA is to encourage voluntary disclosure of the existence of patents and published patent applications essential to the practice of Normative (a defined term as mentioned below) portions of a standard.

That a party may have a patent or published patent application which is essential (an “Essential Patent” is a defined term) to the practice of a standard may come to the attention of a Formulating Group or TIA staff by voluntary disclosure as encouraged, or by identification by a third party. When this occurs, the identified party will be asked to supply a Patent Holder Statement. The Patent Holder Statement has undergone revisions, some of which are:

- Additional contact information is requested in the boxes at the beginning;
- The statement is limited to the IPR necessary for the practice of *any or all Normative portions* of the standard. The definition of Normative is discussed below.

- The statement reads as of the date of submittal of the form but is effective only when and if the document is approved as a standard.
- The required commitment is “to license only to the extent necessary for the practice of any or all of the Normative portions of the standard and only for the field of use of practice of the standard.” The latter provision makes it clear that a licensor can, by its license grant, restrict deployment of the licensed technology other than for the practice of the standard.
- The commitment as to published patent applications, by virtue of the definitions in the Manual, includes the patents issued thereon whenever issued.
- Essentiality, by virtue of the definitions in the Manual, is limited to claims that are essential.
- The commitment is irrevocable and the Patent Holder undertakes to notify its assignee or transferee of the commitment in the event of a transfer of rights in the relevant patents.
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If no paragraphs are marked on the Patent Holder Statement, it is taken as a refusal to make any commitment.

6. Software Copyrights

The Statements of Policy on the inclusion of software as a Normative element in a standard are based in substantial part on similar discussions that have taken place in the International Telecommunication Union (ITU) Telecommunication Sector Bureau (TSB) Director's Ad Hoc Group. (TIA has participated actively in the Patent Group of ANSI which provided input in the ITU process). This Section notes that inclusion of Software is to be discouraged, but guidance is given to a Formulating Group that decides that software covered by a copyright should be included in such a fashion that the standard cannot be practiced without infringing the copyright.

If the Formulating Group decides to include Software as a Normative element in a standard, the TIA IPR Policy requires that the Software Copyright Holder furnish a Software Copyright Holder Statement in addition to the submission cover sheet with the four required elements. If the Formulating Group so requires, there are other procedures for the inclusion of software including a “Software Evaluation License”.