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Patent Guidelines for Participation in Standards Development Organization Activities

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Introduction

In the aftermath of the recent FTC decisions in *Rambus* (FTC Docket No. 9302 [2006]) and *Negotiated Data Solutions* (FTC File No. 510094 [2008]), many electronics and telecom manufacturers have been reexamining their standards activities and how such activities could implicate their patent portfolios. These same companies are also taking a keener interest in what the competition may be doing to incorporate their patents into consensus industry standards. Fish & Richardson has developed the following guidelines to assist clients in these matters.

Prior to Joining an SDO:

- ◆ Notify general counsel of your planned/current participation in any Standards Development Organization (SDO). Identify your role or the function you will serve (e.g., observer, technical member, convenor). General counsel should also be notified if your role or function changes.
- ◆ Forward a copy of the SDO's written patent policies to general counsel. Review these policies carefully and discuss them with general counsel if you have questions or concerns.

SDO patent policies vary. It should not be assumed that the patent notification or certification requirements for one SDO will be effective according to or acceptable to any other SDO.
- ◆ Provide general counsel with a summary of the standards and technical work program in which you will be involved.

General counsel will be in the best position to determine whether joining a particular SDO implicates the company's patent portfolio or

might impact the company's patent strategies. It is also important to communicate to general counsel any significant changes in the technical work program or its direction.

After Joining an SDO:

- ◆ Familiarize yourself with the organizational documents, procedures, and policies of the SDO, as well as the committees and/or working groups in which you will be participating, particularly as they pertain to patent disclosures.

Individual committees or working groups may take different approaches to implementing an SDO's written patent policy.

- ◆ Determine whether there are unwritten patent policies followed by the SDO, its committees, and/or working groups, and communicate such policies to general counsel.

Decisions in various court cases indicate that SDO members have a duty to follow unwritten SDO patent policies that they know about or have reason to know about.

- ◆ Maintain a current working knowledge of company patents and patent applications that could pertain to the SDO activities in which you are engaged.

Knowledge of a company's patents and its standards activities are generally imputed in both directions: that is, patent attorneys will be presumed to know what standards activities the company is engaged in, and standards engineers will be presumed to know what patents have been issued or are under development by the company. It is this imputed knowledge that gives rise to the company's legal obligations.

- ◆ Confer with general counsel regarding any patents or applications that you think may relate to your SDO activities.

Court decisions indicate that where a company has a duty to disclose the existence of a patent or pending application and fails to discharge that duty, it may be estopped from enforcing the patent and may be subject to monetary damages.

- ◆ Contact general counsel upon receiving any written or verbal request from an SDO committee or working group for disclosure, certification, or other statement as to the company's patents or pending patent applications.

General counsel will be in the best position to determine the scope and content of any disclosures. Some SDOs require patent statements from all members; others require statements only from members identified as holding patents (or applications) that come within their policies. A company's disclosure obligations will vary depending on the SDO — for example, when such disclosures must be made (e.g., during committee meetings, prior to standards approval), how closely connected to the standards activities a patent must be to trigger disclosure (e.g., “related to,” “required for compliance with,” “necessarily infringed by”), and what information must be disclosed (e.g., pending applications, member's intention not to patent in a particular area).

- ◆ All patent disclosures, certifications, or statements made to an SDO must be submitted by general counsel.

The form of disclosure may vary among SDOs. Some SDOs will not accept a disclosure that is not in strict conformance with their disclosure forms; others will not accept conditional language or license terms accompanying the disclosure.

- ◆ Periodically review the patent disclosures, certifications, or statements filed by other SDO members in the areas in which you are working, and report these to general counsel. Make special note of technical contributions made by members who have patent disclosures on file with the SDO.

This information will assist the company in monitoring the patent activities of others and may alert the company as to possible legal concerns.

- ◆ Should you become aware of any third-party patents or pending applications that appear to be related to the standards activities in which you are engaged, contact general counsel for instructions on how to report this information to the SDO.

General counsel is in the best position to decide whether the company can or should report to the SDO any information learned about a competitor's patent activities.

Before Withdrawing from an SDO:

- ◆ Before withdrawing from an SDO and its committees and/or working groups, make an appointment with general counsel for an “exit interview” concerning company patents and/or applications that may be related to your standards work.

A “defensive disclosure” to an SDO may be required in certain cases to avoid the appearance that the company is withdrawing from the standards activity specifically to avoid the patent disclosure requirement.

Conclusion

Contact general counsel before providing to company inventors or patent agents information or data that may be related to your standards activities. Similarly, contact general counsel before providing to SDO committees or working groups any technical contributions that come from information or data obtained from company inventors or patent agents. General counsel will be in the best position to determine whether it is permissible to use information obtained from your standards activities in the development of company patents. Similarly, general counsel will be in the best position to determine whether it is advisable to include information in a technical submission that requires, or may eventually require, a patent disclosure.

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