
**The N&M Handbook on the Operation of the
ETSI Interim IPR Policy**

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N&M Consultancy Limited was founded in 1991 by Ron Nicholson, who has now retired from the company, and Roger Miselbach, who has sadly passed away. Ron and Roger were closely involved in the development of the ETSI Interim IPR Policy in the early to mid 1990's; they could not have anticipated how successful standardisation was going to be in creating truly global telecommunications standards, but nor could they have anticipated the extent to which the ETSI IPR policy was to be at the centre of so much intellectual debate, policy making and litigation.

In 1995, N&M published the N&M Handbook on the Operation of the ETSI Interim IPR Policy, and 20 years on, the telecommunications industry has undergone huge change. We have decided to re-print the Handbook as we thought it would be of general interest to those involved in the standardisation process today. Some aspects of the implementation of ETSI's IPR policies have moved on and some have been successful; some have not.....

We would be interested to hear from individuals and companies on where they think, over the past 20 years, ETSI's IPR policies have been successful and where they have not, and where and how they think they could still be improved.

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THE N&M HANDBOOK
ON
OPERATION OF THE ETSI INTERIM IPR POLICY

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and
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THE WORK

THE POLICY

THE POLICY

THE N&M HANDBOOK
ON
OPERATION OF THE ETSI INTERIM IPR POLICY

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THE N&M HANDBOOK
ON
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FOREWORD

Once upon a time, after one of the many tedious meetings on IPRs and ETSI Standards which occurred with amazing frequency throughout the five years it took to produce the ETSI Interim IPR Policy, I dropped in on my boss and good friend Karl Heinz Rosenbrock, Director of ETSI. We discussed the Undertaking (which has since been abandoned). I said to Karl Heinz: "This IPR will kill me one of these days. I am getting to the point where I no longer need an Undertaking but rather an undertaker".

Now, some years later, two highly rated and acknowledged experts, Ron Nicholson and Roger Miselbach, who were deeply involved with the ETSI IPR Policy and Undertaking, (now dead - the Undertaking that is), established a consultancy called N&M Consultancy Limited. Karl Heinz's immediate reaction, on hearing about N&M Consultancy, was to start referring to its Directors, as the "Undertakers".

The Undertakers have now written this Handbook and asked me to write a foreword for it. I said to them: "You must be joking! I would be buried alive by some of our members if I did this. I would then need some real undertakers for sure. Ah, but we now have a survival guide and survivors don't get buried."

However, ETSI now has an Interim IPR Policy in place but, of course, without an Undertaking. The European Commission has also blessed us with a "comfort letter" for our Interim IPR Policy, so now I feel a little more comfortable with IPRs. I must tell you, dear readers, that the Undertakers' Handbook is not ETSI IPR Policy. The rights and obligations relating to the ETSI Interim IPR Policy are stipulated in that Policy and nowhere else. We, at ETSI, have also issued an IPR survival guide which we think will be invaluable for the Chairmen of ETSI's Technical Committees.

What then of the Undertakers' Handbook? It expresses an independent view point of the ETSI Interim IPR Policy. I am sure that some will like it and some will not. However, I take the view that a book written by two authors as experienced as the Undertakers, in IPR and Standards issues, must be regarded as a valuable contribution to understanding the interaction between IPRs and standardization. They have explained how they believe IPR issues should be handled in order to comply with the ETSI Interim IPR Policy. Because of their perspective, the Undertakers advice on such matters can only be beneficial to those involved in ETSI standardization.

The Annexes to the Handbook, which includes authorized reproductions of ETSI documentation, will undoubtedly provide a good source of information for those people involved in the formulation and implementation of ETSI Standards.

Some people say that the Undertakers are the guys responsible for making the ETSI Interim IPR Policy complex and have established N&M Consultancy in order to profit from this complexity. To these people I would say that the present Policy is not complicated. The now defunct Undertaking was

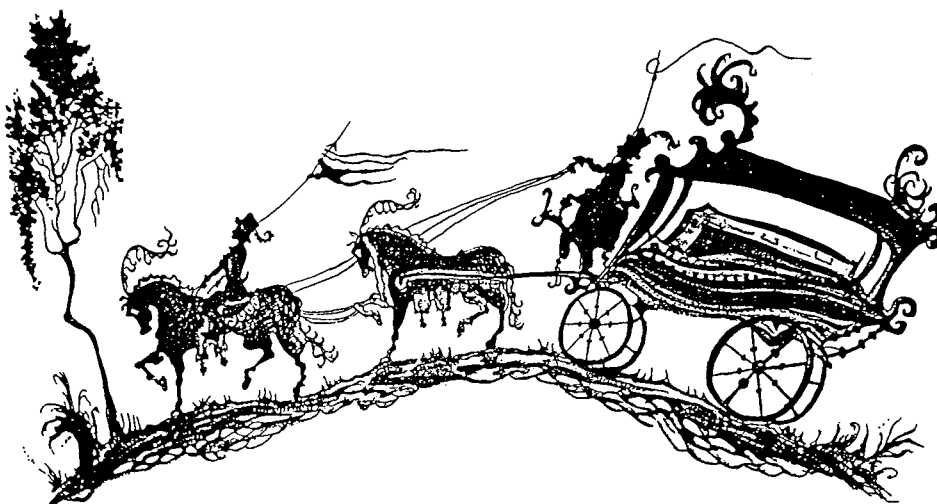
complicated, far too complicated! However, this should not surprise anyone since it was written by a drafting group of some 80 people. It is difficult to imagine two IPR experts agreeing on the wording of a document, so what chance did 80 have?

As the Americans say: "Don't shoot the pianist because the piano is out of tune". Now I would say: "Don't bury the Undertakers, you might need them one day" - message received?

*"The grave's a fine and private place,
But none I think do there embrace."*

(Andrew Marvel 1621 -1678)

Frede Ask
Deputy Director of ETSI



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1. INTRODUCTION

1.1 Intellectual Property Rights (IPRs) and Standards

Whenever the technical content of an ETSI Standard falls within the scope of an IPR and, in particular, a patent, the IPR has the potential to block the implementation of the Standard, i.e. there is a potential conflict between the IPR and the Standard.

If the IPR is 'Essential', i.e. the Standard cannot be implemented without infringement of the IPR, then the owner of the Essential IPR is in a position to stop others from complying with the Standard. The Standard-blocking capability of an Essential IPR depends on the geographic scope of the IPR and, more particularly, the terms and conditions, if any, on which licences can be obtained in respect of the IPR.

The ETSI Interim IPR Policy which was adopted by the 21st General Assembly on 23rd November 1995, forms part of the ETSI Rules of Procedure. This means that the rights and obligations specified by the Interim IPR Policy have the same weight as all the others in the Rules of Procedure and are binding on all ETSI members.

The ETSI Interim IPR Policy sets out the objectives that ETSI has set itself in relation to the interaction between IPRs and Standards and the need to strike a fair balance between the interests of the owners of the IPRs and the users of Standards. The realisation of the technical objectives of the European telecommunications sector, with regard to standardisation, depends on ETSI who must, therefore, ensure that ETSI Standards are based on technical solutions which best meet these technical objectives and are available for use. ETSI must ensure that the risk of wasted investment by ETSI Members, and others, in the preparation, adoption and application of ETSI Standards, due to non-availability of licences for Essential IPRs, is minimised whilst, at the same time, recognising that a fair balance must be struck between the rights and interests of the owners of the Essential IPRs and the needs of standardisation, for public use, in the field of telecommunications.

ETSI has made a commitment to take whatever reasonable measures are available, within its power, to ensure that its Standards will be made available to potential users in accordance with the general principles of standardisation.

This means that ETSI must endeavour to ensure that licences, under IPRs that are Essential to ETSI Standards and, in particular, mandatory Standards, are made available, for the implementation of those Standards, on fair, reasonable and non-discriminatory terms and conditions for the geographic area, including all European countries, in which the Standard concerned is to be implemented.

The ETSI Interim IPR Policy does not stand on its own, its interpretation and implementation is influenced by:

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- the Chairman's Intellectual Property Rights Survival Guide which is set out in Annex V of this Handbook;
- EC's Communication on IPR and Standardization, COM (92) 45 final of 27th October 1992 which is set out in Annex VII;
- Temp Doc 5, submitted by the European Commission at GA21; and
- ETSI/GA22(95)5, tabled by the Chairman of the ETSI General Assembly, and known as the "Mechanism".

The above-mentioned documents, together with the Decision of the ECJ in the Magill case (6/4/95), joined cases C-241/91 P and C-242/91 P - see Annex VI of this Handbook - constitute secondary sources of IPR policy for ETSI.

It can be expected that ETSI will adopt, so far as possible, a non-interventionist approach to enforcement of its Interim IPR Policy. It is for ETSI's Members to ensure that the Interim IPR Policy is adhered to by themselves and others. The Interim IPR Policy provides a tool for avoiding IPR-Standards conflicts, it is up to ETSI Members to use that tool and, more particularly, ensure that those of their employees, who attend ETSI Committee meetings, are fully conversant with the provisions of the Interim IPR Policy.

1.2 Objects of Handbook

ETSI has produced the "Chairman's Intellectual Property Rights Survival Guide", a document intended to assist the Chairmen of ETSI's technical committees in dealing with IPR issues. This document is necessarily brief and provides, in an admirably compact form, an introduction to the procedures which ETSI intends to adopt, in order to implement its Interim IPR Policy. However, ETSI will, in most cases, only implement actions, in respect of IPR issues, if requested to do so by its members. If members of ETSI, or others, wish to take full advantage of the provisions of the ETSI Interim IPR Policy, it is their responsibility to take appropriate action. This manual is intended to explain the procedures which are either explicitly set out in the ETSI Interim IPR Policy, or implicit in that document, when considered in the light of the secondary sources of policy, referred to in Section 1.1 above.

This Handbook is intended to be of assistance to all those involved with the ETSI standardisation process, whether they are holders of large patent portfolios, seeking to protect their position, or SME's wishing to enter the European market for Standardized telecommunications equipment and services.

1.3 Structure of the Handbook

Section 2 of the Handbook provides a brief introduction to IPRs. The remaining Sections of the Handbook explain the manner in which operation of the ETSI Interim

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IPR Policy can be effected, in the context of the IPR, contractual and licensing issues which are relevant to the availability of ETSI Standards. The Annexes treat many of the topics, discussed in these sections, in greater detail.

1.4 How to use the Handbook

It is important that those concerned with European telecommunications standardization have some appreciation of the background issues which lead to conflict between Standards and IPRs, and know when to seek further assistance if problems arise. It is, therefore, important that the body of this Handbook should be read. Where desired, knowledge of the topics discussed, in the body of the Handbook, may be supplemented by use of the Annexes. The Annexes should be regarded as reference material and need only be consulted when a problem occurs.

1.5 Sources of Additional Information

Additional information on the ETSI Interim IPR Policy, and the manner in which operation of the Interim IPR Policy can be effected, can be obtained from:

- the ETSI Secretariat; or
- N&M Consultancy Limited; or
- the Handbook on the ETSI Interim IPR Policy (not yet available).

1.6 Terminology

The ETSI Interim IPR Policy gives special definitions to a number of terms. The terminology used in this Handbook corresponds to that used in the ETSI Interim IPR Policy.

Terms which have a special meaning are used with a capitalised initial letter in this Handbook. The precise definition of these terms can be found in the ETSI Interim IPR Policy, set out in Annex IV, and an explanation of the meaning of these definitions can be found in Annex I of this Handbook.

A term of special significance is 'Essential' and readers are recommended to consult Annex I before proceeding further.

2. IPRS AND STANDARDS

Intellectual property rights (IPRs) and Standards are covered, in broad outline, only. For more detailed information, reference should be made to Annex II (IP and IPRs) of this Handbook and/or Annex III (The Standardization Process) of this Handbook.

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2.1 Key Points on IPRs

The main IPRs of relevance to ETSI Standards are patents, although copyright and mask works may also be of relevance.

The monopoly conferred by a patent is only effective in the country where the patent has been granted. For example, the existence of a US patent does not necessarily mean that equivalent patents exist in other countries, i.e. the countries in which an ETSI Standard is to be implemented.

The claims of a patent define the invention for which protection has been obtained and, in particular, the monopoly granted by the patent.

Infringement of copyright, mask works and design rights, requires a deliberate act of copying, whereas the monopoly conferred by a patent, and patent like IPRs, for example, registered designs and utility models, does not require an act of deliberate copying for infringement to be established. It is, therefore, much easier to avoid copyright infringement, i.e. do not copy, than it is to avoid patent infringement.

Unless there has been a deliberate act of copying, the only IPRs that need to be considered, during the standardisation process, are patent like IPRs, referred to above. However, a Standard-compliant product may infringe several IPRs.

The owner of an infringed IPR can initiate a court action to stop infringement and claim damages from the infringing party.

2.2 Patents

The monopoly scope of a patent, i.e. its blocking power in the market place, is defined by the claims of the patent.

The claims of a patent can cover hardware, software, methods and processes and, in particular, can cover the following:

- a product (of a process); or
- a process, or method; or
- an apparatus, or device.

The monopoly claimed is usually broader than the technical description of the invention but the patent claims must relate to the technical description. A single patent may cover a number of inventions provided they have a common inventive concept.

In the countries of Europe, the term of protection for a patent is 20 years from the date of filing the application for the patent which may, or may not, be the priority

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date. Other countries have different patent terms.

Furthermore, in the countries of Europe, patent applications are published 18 months after the date of filing the patent application. This means that patent searches will not identify patent applications filed less than 18 months before the date of the search.

The monopoly conferred by a patent cannot be enforced until the patent is granted although it may be possible to claim damages from the date of publication of the patent application.

2.3 Software

It is generally accepted that computer programs, i.e. software, are literary works and are, therefore, protected by copyright.

In most countries, computer programs (software), cannot be patented, as such, because computer programs are considered to be literary works.

It is, however, possible to obtain patent protection for software-related inventions, for example, a programmed computer, or a process that utilises a computer program. Patent protection can be obtained for a method of operating a known machine. The machine, or computer, although of known type, is regarded as having been temporarily modified by the computer program. It must, however, be shown that the operation of the computer, or the process, in accordance with a computer program, gives rise to a technical effect, and that the invention covered by the claims of the patent are directed to that technical effect and satisfy the other criteria for patentability, namely, novelty and inventive step (i.e. not obvious to a person skilled in the art to which the invention relates).

Thus, a telecommunications apparatus, or system, controlled by a computer program would be patentable, provided it is directed to a technical effect and satisfies the criteria for patentability. It is unsafe to assume, in the field of telecommunications, that software will not be subject to patent protection.

THE RISK OF SOFTWARE INFRINGING PATENTS CANNOT BE IGNORED.

2.4 Patent Searches

In order to ensure that searches for Essential IPRs can be undertaken, at an early stage of the standardisation process, the individual work items of the ETSI work programme should be defined with sufficient detail to enable such IPR searches to be performed, i.e. for patents that are, or may become, Essential to the Standard concerned and for which licences would be required for implementation of the Standard.

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ETSI is responsible for the preparation and definition of the work programme and is, therefore, responsible for insuring that the items, contained in the work programme, are defined in a manner which facilitates the conduct of IPR, particularly patent, searches.

Thus, the scope statements of work items, introduced into the ETSI work programme, must be such that a search statement can be derived therefrom and should include:

- a broad technical field statement;
- a description of any broad system concepts;
- the identity of any standard related to the work item, or on which the work item is based;
- a list of features which the standard will define, or on which the standard will place limitations;
- a technical description of each feature listed, in broad terms; and
- a list of any criteria which the standard must satisfy.

In practice, the individual items of the ETSI work programme are defined by the members of the Technical Committee (TC) and/or Sub-Technical Committee (STC) concerned. Such members should, therefore, in view of the foregoing, ensure that the scope statements of ETSI Work Items are sufficiently comprehensive to provide the basis for patent search statements.

Any changes to the work item, made during the standardisation process, which would give rise to a modification of the original definition of the work item, should be immediately reported to the ETSI Secretariat, so that ETSI can revise the definition and distribute it to ETSI Members. Depending on the nature of these changes, it may be necessary to undertake a further patent search. It is the individual members of the TC/STC concerned, and not ETSI, who will have the necessary competence to determine the need, or otherwise, for a further patent search. The ETSI members concerned should, therefore, exercise due diligence in respect of these matters in order to protect their best interest. This is the only really effective means of minimising IPR/Standards conflicts.

Thus, when an ETSI Technical Committee formulates a work item for the ETSI work programme, the Chairman of the ETSI Technical Committee concerned should consider commissioning a state of the art search, i.e. a search for patents covering the technical field to which the proposed work item relates. If such a search is commissioned, then a searchable definition must be available.

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An ideal format for TC/STC Chairmen to use in the formulation of clearly defined scope statements for the ETSI work programme is the ETSI form entitled 'ETSI Work Programme New Work Item' set out on page 12 of the ETSI document entitled 'Work Item Management'.

It should be understood that the accuracy of patent searches cannot be guaranteed because account cannot be taken of unpublished applications and because of inherent errors in the search process.

Further, more detailed, information on patent searching is given in Annex XIII of this Handbook.

2.5 Key Stages in the Standardisation Process

The key stage in the standardisation process, with regard to IPR issues, is the definition of ETSI work items.

There are no provisions in the ETSI Interim IPR Policy that require ETSI to send ETSI Members a copy of all additions and amendments to the ETSI work programme. Any Essential IPRs, of which Members become aware, can be notified to ETSI, by the Member concerned, pursuant to Clause 4.1 of the ETSI Interim IPR Policy. This information will assist Members to decide whether, or not, to inform ETSI of their intentions concerning the availability, or otherwise, of licences under any identified Essential, or potentially Essential, IPRs for the Standard concerned.

Any changes to the ETSI work programme must, therefore, be adequately defined in terms that will enable Members to determine whether, or not, any of their IPRs are likely to be Essential, or potentially Essential, to the Standard concerned.

Again, the individual members of the TC/STC concerned are in an ideal position to ensure that all additions and amendments to the ETSI work programme are, whenever practicable, made available to ETSI Members and others. Other than undertaking specific searches for such additions and amendments, this is the only means of ensuring that Members are in a position to be able to fulfil their obligations pursuant to Clause 4.1 of the ETSI Interim IPR Policy. An ideal vehicle for the distribution of this information is the ETSI IPR Bulletin - see Annex IX to this Handbook.

2.6 Types of Work Item

Not all ETSI work items will result in a clearly defined deliverable, for example, MIs (Miscellaneous Items) may not be intended to result in a document. It is unlikely that any work item which does not:

- result in a published document;

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- constitute the specification for an ETSI Standard; or
 - constitute an input for the development of an ETSI Standard,
- can have Essential IPRs associated with it.

The following types of work item may, however, have Essential IPRs associated with them:

- European Telecommunications Standards (ETS);
- Interim European Telecommunications Standards (I-ETS);
- Europäische Norm/Vornorm (EN/ENV);
- Technical Committee Reference Technical Reports (TCR-TR);
- Candidate Norme Européenne de Télécommunication (NET);
- Technical Basis for Regulation (TBR); and
- Technical Specification (TS)

Because mandatory standards are especially vulnerable to the effects of Essential IPRs, NETs and TBRs, which may form the basis of regulation, need to be treated with special care.

The following types of work item are unlikely to have Essential IPRs associated with them:

- ETSI Technical Reports;
- Technical Committee Reports (TC-TR); and
- Miscellaneous Items (MI).

The following types of work item have yet to be fully assessed in terms of possible IPR implications:

- Functional Specifications (FS); and
- International Standards Profiles (ISP).

Further information on the different types of work item, and the relevance of IPRs to them, can be found in Annex III.

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Not all ETSI work items in the first group, set out above, will be associated with Essential IPRs. In particular, it is unlikely that a work item will have an Essential IPR associated with it if:

- it is based on technology which is more than 20 years old;
- it merely specifies performance parameters;
- it relates to inherently unpatentable subject matter; or
- relates to software languages, or terminology.

Any Standard which specifies a method of operation, system architecture, hardware design, signalling, data format, code, or computer program should be regarded as likely to have Essential IPRs associated with it. The members of the TCs/STCs, concerned with such Standards, should ensure that all possible steps are taken to determine whether, or not, there are any Essential, or potentially Essential, IPRs covering these Standards. Members must make a concerted effort and ensure that such determinations are made at the earliest possible stage of the standardization process. This is the only effective means of minimising IPR/Standard conflicts.

2.7 Key Issues

The key issues that have to be addressed when considering whether, or not, a Standard is likely to be affected by IPRs are:

- is an ETSI work item properly defined in the scope statement;
- do IPRs exist which are Essential, or potentially Essential, to the work item;
- will the resultant Standard refer to other standards which do not originate from ETSI;
- who made technical contributions to the Standard;
- are technical contributions freely available;
- was the work item developed collaboratively;
- does the work item incorporate Confidential Information directly, or by reference; and
- will any Standard, resulting from the work item, be freely available, for use by all Members, in all countries in which the Standard concerned will be implemented.

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It is in the best interests of ETSI Members, and others involved in the standardization process, to ensure that full account is taken of all of the foregoing matters. Clearly, the ETSI Secretariat do not have the necessary resources to make these determinations. Thus, the minimisation of IPR/Standards conflicts is in the hands of the ETSI membership, and others having an interest in the exploitation of ETSI Standards. All ETSI Members must use their reasonable endeavours to inform ETSI of Essential IPRs pursuant to Clause 4.1 of the Interim IPR Policy and/or ensure that appropriate searches are undertaken by ETSI, for example, pursuant to Clause 6.2 of the Interim IPR Policy.

3. TECHNICAL DISCLOSURES

This Section of the Handbook addresses the following procedures which involve the participation of ETSI Members, as well as the ETSI Secretariat:

- Acceptance of Confidential Information;
- Technical proposals;
- Marking Confidential Information;
- Origin of standardisation proposals; and
- Confidential Information in Standards.

Confidentiality and, in particular, acceptance of confidential information by ETSI Technical Committees, is covered by Clause 10 of the ETSI Interim IPR Policy but the other matters, referred to above, are not specifically addressed by the Interim IPR Policy but are, nevertheless, of importance to the minimisation of IPR/Standards conflicts.

3.1 Confidentiality

3.1.1 Nature of Confidential Information

Technical information may be treated as confidential information, that is to say, its disclosure, treatment, and use, may be limited and controlled by actual, or implied, contractual terms.

It is, therefore, quite possible for a technical disclosure to be made to an ETSI Technical Committee, in confidence. If this is done in circumstances in which the recipients of the disclosure have, or can reasonably be assumed to have, accepted the information as confidential, then the technical disclosure will constitute Confidential Information. This means that further disclosure, or use, of that information can only be made with the permission of the discloser.

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It follows, from the foregoing, that material disclosed in confidence is not available for use in the standardisation process, unless the discloser has specifically agreed to that use.

It is, therefore, of importance for ETSI Members to ensure that any limitations on the use, and subsequent disclosure, of Confidential Information, submitted to, and/or used by, an ETSI Technical Committee, is clearly recorded and understood, if barriers to the use of any Standard, incorporating that Confidential Information, are to be avoided.

3.1.2 Acceptance of Confidential Information by Technical Committees

The ETSI Interim IPR Policy, (Clause 10), states that information disclosed to ETSI's Technical Committees is to be regarded as non-confidential, unless the following criteria are satisfied:

- the information is recorded in a physical form, i.e. it is not disclosed orally, or in some other ephemeral manner;
- the information is clearly identified, in writing, as confidential, at the time it is submitted; and
- the information is first submitted to the Chairman of the ETSI Technical Committee and accepted by him as confidential.

It is intended that any member of an ETSI Technical Committee should be in a position to refuse the acceptance of Confidential Information, disclosed to that ETSI Technical Committee, by absenting himself from any part of a Committee meeting at which Confidential Information is disclosed, or discussed. If a Committee Chairman approves the acceptance of Confidential Information, the members of the Technical Committee concerned must be informed of the impending disclosure and given the opportunity to leave the meeting, prior to disclosure of the Confidential Information.

It is the responsibility of ETSI Members to ensure that the, or each, ETSI Committee, on which they are represented by an employee, establishes procedures fully compliant with Clause 10 of the ETSI Interim IPR Policy. Do not assume that someone else has taken responsibility for this task.

In general, acceptance of Confidential Information by ETSI's Technical Committees is to be avoided, if possible.

3.1.3 Recording Confidential Disclosures

Where an ETSI Technical Committee receives Confidential Information, a record must be kept of the disclosure, together with any terms and conditions which apply to the subsequent use of that information by ETSI, or other recipients, (members of the

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ETSI Technical Committee), of the information. The disclosure should be minuted in the ETSI Technical Committee's minutes and reported to the ETSI Secretariat for recordal on the ETSI Database. The following information should be supplied to the ETSI Secretariat:

- a brief non-confidential description of the nature of the Confidential Information;
- the name of the person disclosing the information and the organisation/company that the person represents;
- the name of the owner of the Confidential Information, if different from the discloser;
- the Standard/work item to which the disclosure relates;
- the identity of the ETSI Technical Committee to which the disclosure is made, and the members of that ETSI Technical Committee present when the disclosure was made;
- the date of the disclosure; and
- any terms and conditions which apply to the use, or subsequent disclosure, of the Confidential Information that differ from the terms set out in Section 3.1.4 below.

The simplest way of communicating this information to the ETSI Secretariat is to ensure that the above information is available from the minutes of the meeting and to supply the ETSI Secretariat with a copy of the minutes. The policing of this procedure can be effected by all ETSI Members, represented on TCs/STCs, ensuring that the information is, in fact, recorded in the minutes of the meetings, at which Confidential Information is disclosed. If not, then the matter should be referred back to the TC/STC Chairman for action.

3.1.4 Standard Terms for the Acceptance of Confidential Information

The normal provisions that apply to acceptance of Confidential Information are as follows:

- the Confidential Information shall only be used for a specified purpose (furthering ETSI's objectives, i.e. for generating standards);
- the information shall remain confidential for a specified period (2 years from the date it was first disclosed to an ETSI Technical Committee is suggested as appropriate), after which any person in possession of the information is free to use it for any purpose, or disclose it to others; and

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- if the Confidential Information is incorporated in an ETSI Standard, a draft Standard, or a published ETSI Technical specification, it should cease to be confidential from the date of publication of the Standard.

It should be noted that a member of an ETSI Technical Committee should not be bound to treat information as confidential if:

- the information is already available to the general public;
- the member in question is in possession of the information at the time it was disclosed;
- the member independently generates the information without reference to the material which was disclosed to him; or
- the information is legitimately supplied to him by another who is not bound by confidentiality.

Clause 10 of the ETSI Interim IPR Policy relates to the disclosure of Confidential Information to ETSI's Technical Committees. The Chairmen of ETSI's Technical Committees, as well as committee members, should be familiar with these provisions. In any event, the Committee Chairmen must have sufficient knowledge of these procedures to be in a position to advise Committee members on the general provisions that apply to disclosure and acceptance of Confidential Information.

3.1.5 Non-standard Confidentiality Terms and Conditions

It is possible that the owner of technical information will wish to disclose it to an ETSI Technical Committee on terms which may not be acceptable to ETSI. Thus, all disclosures to an ETSI Technical Committee which are subject to terms which differ from those set out in Section 3.1.4 above, should not be accepted without the prior knowledge of the ETSI Secretariat.

The ETSI Secretariat are responsible for determining the terms and conditions on which confidential technical information should be accepted by an ETSI Technical Committee. None-the-less, circumstances may occur where it is necessary to accept technical information on non-standard terms and conditions. There is no provision in the ETSI Interim IPR Policy preventing acceptance of information, in confidence, on any terms which the owner of that information chooses to impose. Equally there is no obligation on ETSI, or any of its Technical Committees, to accept information in confidence. Where it is proposed that information be disclosed on non-standard terms and conditions, it is vital to have the proposed terms and conditions checked and approved by the ETSI Secretariat. This is clearly the responsibility of the Chairman of the ETSI Committee concerned but, since members of that Committee have a responsibility to protect the best interests of their employers, they should report the matter to their employers and give every possible support/guidance to the Committee

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Chairman, and/or the ETSI Secretariat, in the decision making process. In this regard, it should be noted that Committee members must, individually, accept the terms and conditions which the owner wishes to apply to the disclosure of Confidential Information.

Ideally, from the point of view of the owner of the Confidential Information, this should be done by requiring each member of the ETSI Technical Committee to sign an individual confidentiality agreement. From ETSI's point of view, it is sufficient to minute the terms and conditions and the names of those members of the ETSI Technical Committee who agreed to accept the information, together with the special provisions that apply to the disclosure. The particular option that is selected will probably vary on a case-by-case basis but, in the final analysis, it is the responsibility of the members of the Technical Committee concerned to determine, in association with the ETSI Secretariat, which option is selected.

3.1.6 Marking Confidential Information

The ETSI Interim IPR Policy requires that technical information only be accepted, in confidence, if it is clearly marked as Confidential Information and is recorded in a physical form to which such a marking is applied. It is of importance, if Confidential Information is copied, or reproduced, that all copies, or reproductions, carry an appropriate marking indicating that the information contained in the copy is Confidential Information. An appropriate form of marking is as follows:

"The information contained herein is the Confidential Information of and may only be used for the purposes of furthering ETSI's objectives. The information was first disclosed to ETSI on, and will cease to be confidential on"

ETSI Members must ensure that this marking requirement is complied with in respect of any Confidential Information they submit to TCs/STCs.

3.1.7 Incorporation of Confidential Information in a Standard by Reference

It may happen, especially where a technical disclosure relates to software, that the owner wishes to disclose the information only in part, and the totality of the information will only be incorporated in the Standard, to which it relates, by reference. This means that a person, wishing to implement the Standard, will have to apply directly to the owner of the Confidential Information, in order to obtain it. It will, of course, be necessary to obtain a declaration from the owner that licences will be available, on appropriate terms and conditions. Whenever this situation arises, the ETSI Secretariat must be advised immediately, and the information should neither be accepted, nor written into a Standard by reference, until the matter has been fully investigated and approved by the ETSI Secretariat. In practice, it may be necessary to refer such issues to an ETSI General Assembly, or Technical Assembly.

3.2 Origin of Technical Proposals

3.2.1 Importance of Identifying the Origin of Technical Proposals

The Chairmen of ETSI TCs/STCs, and committee members, should make every effort to identifying all those who have contributed to the development of a Standard, either directly, or indirectly, because this information will make it possible to determine the parties most likely to own IPRs Essential to that Standard.

Determination of the true origin of a technical proposal is, therefore, a matter of considerable importance, not least because technical proposals do not necessarily belong to the organisation(s) supporting those proposals.

3.2.2 Proposer, Origin and Ownership

A technical proposal may be advanced by the owner of the information contained in the proposal, or by another person with a vested interest in the adoption of the technical proposal. This is especially true when the proposer is a representative of a trade association, or a PTT. In the first case, the owner of the technical material contained in the proposal will probably be a member of the trade association, while in the second case the owner may be a key supplier to the PTT. These examples illustrate the importance of looking beyond the immediate supplier of technical information to determine the true origin of that information. In neither example is the proposer necessarily attempting anything underhand, or illegal. Merely advancing his own interests, or that of his members.

3.2.3 Technical Proposals and IPRs

At first sight it may appear that if technical material is supplied to an ETSI Technical Committee free of confidentiality, then ETSI, and its Members, are free to use that information, in any way, without risk of IPR infringement. That is not the case. A clear distinction must be drawn between technical information and the IPRs, especially patents, which may be infringed by use of that technical information.

Thus, wherever a technical proposal represents a new and non-obvious solution to a technical problem, it is probably subject to patent protection. In many cases, where the proposal is not new at the date of standardisation, it may be subject to patents. If patented technology is built into a Standard, it will necessarily create an IPR problem which may, or may not, be easy to resolve. Tracing the true owner of a technical proposal greatly facilitates the identification of IPR problems and their solution.

Whilst Chairmen of ETSI's Technical Committees play a key role in determining the true owners of technical proposals made to their Committees, it is important for Committee members to give their Chairman every possible assistance in making this determination.

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It is in the best interests of all concerned to identify the true owner of a technical proposal.

3.2.4 Right to Contribute

Where a technical contribution is made by an engineer, representing a first organisation, and the technical material belongs to a second organisation, there is always the possibility that, through some misunderstanding, the material is being disclosed without the permission of the true owner. Committee Chairmen should, therefore, at least ask those parties who advance technical proposals, the contents of which are owned by organisations other than their own, whether they have the authority to disclose the technical material relating to the proposal. Where authority to disclose is in doubt, a technical proposal should not be placed before an ETSI Technical Committee.

3.2.5 Existence of IPRs

It will not be apparent from a particular technical proposal whether, or not, IPRs Essential to that proposal exist. Irrespective of whether the technical proposal originates from an ETSI Member, or a non-ETSI Member, it will be necessary to determine whether IPRs Essential to that technical proposal exist and, if so, whether, or not, licences will be available under any such IPRs.

Thus, ETSI and, in particular, TC/STC Chairmen should ensure that technical proposals are not built into ETSI Standards where this will result in a Standard being blocked by an IPR. An assurance, by the originator of a technical proposal, that no IPRs Essential to that technical proposal exist, does not guarantee the non-existence of IPRs, but it does substantially reduce the risk that such IPRs do exist.

Where a technical proposal is put before an ETSI Technical Committee, the Chairman of the ETSI Technical Committee should try to determine the origin of the technical proposal and ensure that the following information is recorded in the minutes of the meeting :

- summary of the technical proposal;
- origin of the technical proposal, if known;
- Standard to which the technical proposal relates;
- identity of the proposer of the technical proposal (name of individual and organisation he/she represents); and
- any information which is offered, or known, about the existence of IPRs and the availability of licences.

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This will ensure that the information, concerning the origin of a technical disclosure, is made available to the ETSI Secretariat and any other party having an interest in the ETSI Work Item/Standard to which the technical proposal relates.

In deciding whether, or not, to investigate the background to a technical proposal, a degree of common sense should be used. It is not necessary to investigate minor, or insubstantial proposals, nor is it necessary to investigate any proposal which clearly will not be incorporated into a Standard

3.2.6 IPR Statements and their Use

When a technical proposal is presented to a TC/STC, then, if there is a possibility that it is subject to Essential IPRs, the Chairman of the TC/STC should endeavour to obtain an appropriate statement, from the originator of the proposal, on the existence of IPRs and the availability of licences. In particular, the Chairman should seek an assurance that:

- the originator does not own IPRs Essential to the technical proposal; and
- the originator is not aware of any IPRs Essential to the Technical proposal.

The ETSI Secretariat cannot be expected to take action of its own volition in these circumstances. It is, therefore, necessary for ETSI Members, with an interest in the technical proposal, to ensure that the appropriate action is taken, either through the Chairman of the Technical Committee concerned, or by drawing the attention of the ETSI Secretariat to the matter.

If the originator does own IPRs Essential to his technical proposal, assurances and/or a declaration that licences will be available on appropriate terms and conditions should be sought from the originator, to ensure that any Standard incorporating the technical proposal will not be blocked by IPRs owned by the originator.

Where IPRs are believed to exist which are Essential to a technical proposal, the matter should be investigated and the appropriate action taken. It is the responsibility of those concerned with the Standard, to which the technical proposal relates, to ensure that this is done.

3.2.7 Searching for Essential IPRs

The conduct of IPR searches for Essential IPRs is an expensive and complex exercise, see Section 3.4 below and Annex XIII. Whenever the Chairman of an ETSI Technical Committee suspects that a technical proposal may be subject to IPRs, for whatever reason, and regardless of the suspected owner, he should advise the ETSI Secretariat who will initiate the appropriate action.

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It should not be overlooked that basing an ETSI Standard on a standard produced by another standardisation body, for example, ITU, ANSI etc., does not guarantee that IPRs, Essential to that Standard, do not exist, or, if they do exist, will necessarily be made available for licence to ETSI Members.

It is clearly in the best interests of ETSI Members, who intend to commercialise a Standard, to ensure that this is done for the Standard concerned.

3.2.8 Third Party Technical Proposals

Where a technical proposal for standardization is received directly from a third party, the ETSI Secretariat should be immediately advised. The ETSI Secretariat will act, as described above, to determine whether any Essential IPRs exist and, if so, whether, or not, licences will be available on terms acceptable to ETSI.

The refusal, or acceptance, of a third party technical proposal for a Standard may have legal consequences for ETSI, and its Members, and the ETSI Secretariat must, therefore, be in a position to assess these, before any irrevocable action is taken.

3.3 Availability of Licences

Where IPRs Essential to a work item are known to exist, it will be necessary to determine whether, or not, licences are available under those IPRs on terms and conditions which are in accordance with the ETSI Interim IPR Policy. Formally, this is the responsibility of the Director of ETSI. However, any ETSI Member can, and should whenever possible, express a view on these matters, pursuant to Clause 4.1 of the ETSI Interim IPR Policy.

The issues involved are briefly discussed in this section.

If requested so to do, the ETSI Secretariat will, pursuant to Clause 6.1 of the ETSI Interim IPR Policy, seek a declaration, or other binding assurance, that licences will be available to users of any Standard, to which the IPRs are Essential, on terms and conditions that are fully in accordance with the Interim IPR Policy. The ETSI Secretariat will, of course, take into account any views expressed by the ETSI Technical Committee responsible for the work item at issue.

Where the adoption of a standard, produced by another standards body, is involved, the issue of IPRs Essential to that standard, and the availability of licences under those IPRs, is one of some sensitivity.

Where a Standard, or work item, has several Essential IPRs associated with it, the issue of cumulative royalties may be of concern to ETSI Members, and others having an interest in exploiting the Standard. It may be argued that, while the individual royalties payable under each IPR is not excessive, the combined effect of

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all royalties is such that the Standard is not commercially viable and will, therefore, be blocked. This again is a sensitive issue which ETSI Members may, with advantage, refer to the ETSI Secretariat, with all relevant information, or raise at a Technical Assembly, or General Assembly. The ETSI Secretariat have the sole responsible for resolving these matters.

Arguments about whether, or not, the terms and conditions of licences offered under IPRs, especially patents, truly comply with the provisions of the ETSI Interim IPR Policy will, no doubt, arise from time-to-time, the ETSI Secretariat will do their best to resolve such disputes by encouraging mutual agreement.

In the event that licences are not available, under an IPR Essential to an ETSI work item, it may be necessary to abandon the work item. Decisions to abandon a work item, because of non-availability of appropriate licences for Essential IPRs, will be taken by the ETSI Technical Assembly. However, the ETSI Secretariat may, in some circumstances, need the active cooperation of the ETSI Technical Committee, responsible for a work item, in order to formulate recommendations to be put to the Technical Assembly.

3.4 Patents Searching

Searching for patents Essential to ETSI Standards and work items is discussed in some detail in Annex XIII of this Handbook. It should, however, be noted by ETSI Members that:

- patent searches are expensive and time consuming;
- patent searches require the input of both technical and professional (IPR) resource; and
- the results of a patent search never give a 100% guarantee that Essential IPRs do not exist.

Carefully consideration should, therefore, be given as to whether, or not, a patent search is really necessary before requesting the performance of such a search. If in doubt, it is better to seek advice from the ETSI Secretariat, or ETSI's IPR Advisers, before instructing the performance of such a search. However, the failure to perform patent searches may result in a Standard with considerable IPR problems, as was the case with the GSM Standards.

The need for patent searches can be substantially reduced by proper attention to the identification of origin of technical proposals - see Section 3.2 of this Handbook. It is suggested that patent searching should always be considered in the following situations:

- a work item is based on the standard of another standardisation body;

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- the work item relates to a NET, or TBR;
- a work item is based on a system, or method, which did not exist 20 years ago; or
- a work item incorporates a technical proposal of unknown origin.

It should be remembered that it is particularly important that any Standard that is likely to form the basis of a regulation, i.e. a NET, or TBR, is free from IPR problems.

Where it is believed that a patent search on a particular item is desirable, the ETSI Secretariat should be notified and supplied with the following information:

- the identity of the work item in question;
- the scope statement for that item;
- a description of any technical proposal which is suspected of being subject to patent protection;
- any other technical descriptions which may be relevant; and
- *most important of all, the name, address, facsimile number and telephone number of at least one engineer/technologist who is expert in the field of the work item and is prepared to assist in the formulation of a search strategy and the analysis of search results.*

It is the responsibility of all ETSI Members, involved in the standardization process, to address these issues because, in the absence of any other information, patent searches are the only means of minimising IPR/Standards conflicts.

4. IPR POLICIES

This Section of the Handbook addresses procedures for: -

- Identification and disclosure of Essential IPRs - the relevant provisions of the ETSI Interim IPR Policy, relating to this matter, are set out in Clause 4 and, in particular, Clause 4.1;
- Availability of Licences, i.e. Standard-specific IPR declarations - the relevant provisions of the ETSI Interim IPR Policy, relating to this matter, are set out in Clause 6 and, in particular, Clause 6.1;
- Non-ETSI standards - this matter is not specifically addressed by the

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ETSI Interim IPR Policy but procedures are, nevertheless, required to ensure that the inclusion of standards developed by other Standards bodies, in ETSI Standards, does not create IPR/Licensing problems for ETSI Members, and others, having an interest in the ETSI Standard; and

- Interpretative letters - this matter is not specifically addressed by the ETSI Interim IPR Policy but procedures are, nevertheless, required for the production, approval and publication of letters establishing the official ETSI interpretation of any aspect of the ETSI Interim IPR Policy, on which an ETSI member has expressed concern, or uncertainty, as to its precise meaning.

All of the foregoing procedures are of significance to ETSI Members, and others having an interest in ETSI Standards, because the matters addressed by these procedures are directly related to ETSI's main objective of minimising IPR/Standards conflicts.

4.1 ETSI Interim IPR Policy

4.1.1 Introduction

The ETSI Interim IPR Policy is set out, in detail, in Annex IV of this Handbook.

The ETSI Interim IPR Policy is a statement of the actions which ETSI intends to take with respect to its Members, and others, in certain circumstances. The carrying out of these actions by ETSI and, in particular, the Director of ETSI, may, in some instance, require the participation of the TC/STC Chairmen.

4.1.2 Policy Objectives

The policy objectives, as set out in Clause 3 of the ETSI Interim IPR Policy, form the basis of the decision making process underlying ETSI's IPR procedures.

4.1.3 Identification and Disclosure of Essential IPRs

The disclosure of the identity of potentially Essential, or Essential IPRs, to ETSI, is covered by the provisions of Clause 4 of the ETSI Interim IPR Policy. The objective of these provisions is to ensure that owners of Essential, or potentially Essential, IPRs are committed to grant licences, under appropriate terms and conditions, which make the Standard available to users in those countries in which the Standard concerned will be implemented.

If an Essential IPR is identified, the ETSI Secretariat will, as indicated in Section 5.3 below, initiate the procedure set out in Clause 6 (Availability of Licences) of the ETSI Interim IPR Policy and, in particular, Clause 6.1 of the Policy. In essence, the

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owner of the Essential IPR will be requested to give a 'Standard-specific IPR declaration', i.e. an undertaking to grant irrevocable licences on fair, reasonable and non-discriminatory terms and conditions under the Essential IPR, to ETSI.

Any Essential, or potentially Essential, IPRs, identified during the formulation of an ETSI work item and/or in the course of standardisation work, must be promptly notified to the ETSI Secretariat. Since the existence of such IPRs may strongly influence the direction/future direction of the standardisation work, ETSI Members should make every effort to ensure that such IPRs whether, or not owned by them, are identified to ETSI. Any confidentiality undertakings that may have been made, by Members, in respect of any such IPRs must, of course be respected. This does not, however, mean that such Members should not encourage the owners of such rights to disclose them to ETSI. The Chairmen of ETSI's Technical Committees may find themselves acting as the focal point for the notification of IPRs but should only request IPR declarations, or the like, from the IPR owner(s) concerned, in accordance with the Chairmen's Intellectual Property Survival Guide - see Annex V to this Handbook.

Where, in respect of a particular Standard, the owner of an Essential IPR, whether, or not, a Member of ETSI, is not prepared to license the Essential IPR, in respect of the Standard, the ETSI Technical Assembly will undertake a review of the requirement for the Standard.

If the requirement for the Standard cannot be satisfied by a viable alternative technology which is not blocked by the Essential IPR, for which licences have been refused, then work on the Standard will cease and the Director of ETSI will take appropriate action, pursuant to Clause 8.2 of the ETSI Interim IPR Policy, to resolve the issue. This action will involve requesting the right owner to reconsider its position, with a view to obtaining withdrawal of the refusal to licence, but if this action fails, then future actions will involve the ETSI Technical and General Assemblies and, in the final analysis, the European Commission. If these actions do not lead to a solution, the Standard will either be amended to avoid the Essential IPR, or withdrawn, if amendment is not possible.

Information concerning the searches that can be undertaken to identify third party IPRs are outlined in Sections 2.4 and 5.3 of this Handbook.

4.1.4 Geographical Scope of Licences

ETSI has the responsibility for reviewing, determining and recording, for each Standard, the countries in which the Standard has been, and/or will be, implemented because this will determine the geographical scope of the licences to which ETSI Members, and others, are entitled, from the Essential IPR owners.

4.2 Other Standards Bodies

ETSI has established formal collaborative arrangements with a number of

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organisations, many of whom are Standards bodies, see the ETSI document 'TA Working Procedures - Section H: Procedures for co-operation with outside bodies'.

Whilst the ETSI Interim IPR Policy is not necessarily in conflict with the IPR policies of other Standards bodies, such as ISO, there are significant differences in the manner in which conflicts, between standards and IPRs, are resolved by the different bodies.

Nevertheless, it is ETSI's stated objective to respect the IPR policies of other Standards bodies and nothing should, therefore, be done by ETSI Members to frustrate this objective. To this end, the ETSI Secretariat should be consulted, in respect of all IPR issues that may arise out of discussions with third party Standards bodies and no agreements should be entered into, involving such issues, without the prior approval of the ETSI Secretariat.

However, in establishing a relationship with another Standards body, for the purposes of:

- collaboration; or
- basing ETSI's Standards on that body's standards; or
- basing the standards of another Standards body on ETSI's Standards;

it is perfectly reasonable for the parties concerned to request the following information from the Standards body concerned:

- the nature of their IPR Policy; and
- the steps that have been taken to implement that policy in respect of a particular standard.

For the purposes of good housekeeping, and the establishment of a dialogue between the Standards body and ETSI, it would be preferable for all such requests to be made by, or through, the ETSI Secretariat. It is the responsibility of any ETSI Member involved in such dialogue/negotiations to ensure that this is done.

Furthermore, all parties involved in the ETSI standardisation process, including TC/STC Chairmen, should be aware that it is ETSI's main objective to ensure that:

- any IPRs that become Essential to ETSI Standards, as a result of the relationship with a third party Standards body, are available for license to ETSI Members;
- any technology on which a Standard is based, originating from a third party, should not have to be regarded as secret/confidential, by ETSI, or

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its Members; and

- in those cases where ETSI Standards are used as a basis for international standardisation, a clear statement is available listing any IPRs which are Essential to the Standard, together with the licensing terms and conditions which will attach to those IPRs.

In view of the foregoing matters, concerning non-ETSI standards, it is the responsibility of the Chairmen of ETSI's Technical Committees, and/or any other ETSI Member that may be involved in the standardization process/discussions, to ensure that the ETSI Secretariat and/or ETSI's IPR Advisers are kept advised of, and/or consulted in respect of, all discussions/correspondence involving third party Standards bodies. No unilateral action should be taken by Committee Chairmen, and/or other ETSI Members, in respect of these matters.

4.3 Inclusion of other Standards Bodies Standards in ETSI Standards

When consideration is being given to the inclusion of a standard developed by another Standards body in an ETSI Standard, the Chairman of the TC/STC concerned should inform the ETSI Secretariat and, in particular, the Deputy Director of ETSI, before commencing the work on the Standard.

As stated in Section 4.2 above, the ETSI Secretariat should obtain, from the Standards body concerned, the nature of the Standards body's IPR Policy and the steps, if any, that the body has taken to implement that policy in respect of the non-ETSI standard on which the ETSI Standard will be based.

In particular, it will be the responsibility of the ETSI Secretariat to request the following information from the Standards body concerned:

- copies of any IPR declaration, or IPR statement that may have been given to the Standards body;
- details of any procedural steps taken; and
- the results of any IPR searches that may have been undertaken by, or on behalf of, the Standards body;

in respect of IPRs that are deemed, by the Standards body, to be Essential to the standard on which the ETSI Standard is to be based. The Chairman of ETSI's Technical Committees may be requested to assist the ETSI Secretariat in obtaining this information from the Standards body. This may involve soliciting the assistance of other ETSI Members who should make every effort, within their power, to help the ETSI Secretariat in achieving their objectives.

In the absence of IPR declarations and/or licensing commitments, the ETSI

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Secretariat will request the Standards body to give an assurance that there are no IPRs, known to the Standards body, which are Essential to the implementation of the standard on which the ETSI Standard will be based.

The ETSI Secretariat will be responsible for reporting the outcome of the collaboration with the Standards body to the Technical Assembly (TA), and the TC/STC Chairman concerned, with a view to the TA deciding whether, or not, the inclusion of the standard developed by the Standards body, in the ETSI Standard, should be permitted and, if so, on what basis.

All ETSI Members should make it their responsibility to obtain an understanding of the provisions of the ETSI Interim IPR Policy and to seek advice, from the ETSI Secretariat and/or ETSI's IPR Advisers, if any aspect of the Policy is not fully understood. It is only through such an understanding that ETSI Members will be able to maximise their position in respect of, and be fully compliant with the provisions of, the ETSI Interim IPR Policy.

4.4 Interpretative Letters

If an ETSI Member is concerned about any aspect of the ETSI Interim IPR Policy, i.e. the Member is doubtful about the interpretation of certain of the provisions of the Interim IPR Policy and/or the manner in which the Policy is being given effect, then the Member concerned should inform the ETSI Secretariat, about its concerns, and request ETSI to issue an 'interpretative letter' on the subject. This 'interpretative letter' could, in fact, be made the subject of an ETSI Collective Letter, and circulated to the ETSI membership, as a whole, if the matter is considered by the ETSI Secretariat to be of sufficient importance to merit wider circulation.

5. IPR STATEMENTS

This Section of the Handbook addresses the following matters:

- Identification and disclosure of Essential IPRs - the relevant provisions of the ETSI Interim IPR Policy, relating to this matter, are set out in Clause 4 and, in particular, Clause 4.1;
- Non-availability of licences - the relevant provisions of the ETSI Interim IPR Policy, relating to this matter, are set out in Clause 8 and, in particular, Clause 8.1 (Member's refusal to licence) and Clause 8.2 (Non-availability of licences from third parties);
- Availability of Licences, i.e. Standard-specific IPR declarations - the relevant provisions of the ETSI Interim IPR Policy, relating to this matter, are set out in Clause 6 and, in particular, Clause 6.1;

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- Searching for Essential IPRs - covered, in part, by Clause 6.2 of the ETSI Interim IPR Policy, i.e searching undertaken by ETSI at the request of the European Commission; and
- Licensing compliance - the relevant provisions of the ETSI Interim IPR Policy, relating to the required scope for Essential IPR licences, are set out in Clause 6.1.

5.1 Introduction

An IPR statement is a formal disclosure statement made by, or on behalf of, an organisation, or company, pursuant to Clause 4.1 of the ETSI Interim IPR Policy, about the identities of IPRs which are known, or believed, to be potentially Essential, or Essential, to a Standard, work item, or technical proposal. For example, a company proposing a particular technical solution for a Standard may make a formal statement, in writing, that they do not own any IPRs Essential to their technical solution. Alternatively, the company may, pursuant to Clause 4.1 of the Interim IPR Policy, identify by patent number, several patents which they own and believe to be Essential to a particular Standard. The same company may make a statement, in accordance with the provisions of Clause 6.1 of the Interim Policy (Availability of Licences), that they are prepared to grant licences, to those implementing the Standard, on specified terms and conditions.

An IPR statement is, therefore, a statement of known, or believed, fact, it is not an undertaking to do anything.

To the extent that it can be shown that a person making an IPR statement knew that the statement was false, at the time it was made, the person concerned may incur liability for the losses of those who acted in good faith, on the basis of the statement.

Where the proposer of a technical solution for a Standard is prepared to make an IPR statement, it provides some assurance that IPR problems will not exist with regard to that Standard.

It will be seen from Clause 4.1 of the ETSI Interim IPR Policy that ETSI Members, who submit a technical proposal for a Standard, are required to draw ETSI's attention, on a bone fide basis, to any of that Member's IPRs which might be Essential if that proposal is adopted, i.e. make an IPR statement about the technical proposals, they make to ETSI's Technical Committees. If such a statement is not made by an ETSI Member who makes a technical proposal for standardisation, then such a statement should be requested by the Chairman of the Technical Committee concerned. It should be noted that there is nothing in the ETSI Interim IPR Policy to prohibit this course of action by Committee Chairmen. It is in the best interests of all concerned that possible IPR conflicts should be resolved at the earliest possible time in the standardization process. In this regard, reference should be made to Section

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3.2 above, and Annex V of this Handbook (Chairmen's Intellectual Property Rights Survival Guide) which address this issue. A suitable format for an IPR statement is given in Annex V.

It is important to note that IPR statements provide a valuable tool for ETSI Members, which can only be used with the consent of all of the parties involved, in ascertaining whether, or not, Essential IPRs relevant to a work item, technical proposal, or Standard, exist.

5.2 Non-ETSI Standards

Many standards bodies require that those engaged in the formulation of new standards make IPR statements covering both the existence of Essential IPRs and the availability of licences. Where ETSI adopts a standard developed by another standards body, or incorporates such a standard into an ETSI Standard, such IPR statements have considerable value in assessing whether, or not, IPR problems exist. (The content of a non-ETSI standard may be incorporated into an ETSI Standard by writing the specification into the ETSI Standard in either modified, or unmodified form, or by reference). The Chairmen of ETSI's Technical Committees should enquire as to whether any member of their committee has knowledge of such IPR statements, and communicate any copies of, or information relating to, such statements, to the ETSI Secretariat.

Situations may also arise, from time-to-time, where another Standards body, intending to adopt an ETSI Standard, requests ETSI to supply an IPR statement. Such requests should be referred to the ETSI Secretariat.

The Chairmen of ETSI's Technical Committees cannot be expected to make statements about the existence, or otherwise, of IPRs Essential to ETSI Standards.

5.3 ETSI Standards/Work Items

An ETSI Member is obliged, pursuant to Clause 4.1 of the ETSI Interim IPR Policy, to use its reasonable endeavours to disclose to ETSI, in a timely manner, any IPRs, of which it becomes aware, that is Essential to an ETSI Standard and/or an ETSI work item. These obligations do not, however, imply any obligation on ETSI Members to conduct IPR searches (see Clause 4.2 of the ETSI Interim IPR Policy). *In normal circumstances, such persons should not be specifically requested to make IPR statements. However, there may be circumstances in which it appears desirable to obtain IPR statements, in relation to a particular work item/Standard, before commencement of the standardisation work.* In all such cases, the advice of the ETSI Secretariat should be obtained before a request is made.

It is likely that any disclosure of the identity of Essential, or potentially Essential IPRs, pursuant to Clause 4.1 of the ETSI Interim IPR Policy, will be made via the Chairmen of ETSI's Technical Committees. On being informed of the existence of

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such an IPR, the Chairman concerned should immediately pass the information to the ETSI Secretariat, who will obtain professional advice on the relevance of the IPR(s) to the Standard/work item in question. The following information should be passed to the ETSI Secretariat:

- identity of the IPR (in the case of a patent, or patent application, the patent number, or application number);
- the Standard/work item to which the IPR is alleged to be Essential; and
- the name of, and organisation represented by, the person notifying the IPR.

Where licences are not available under an Essential IPR, the ETSI Secretariat will initiate the procedures specified in Clause 8 (Non-availability of Licences) of the ETSI Interim IPR Policy. The Chairmen of ETSI's Technical Committees may be called upon to assist in these procedures. This may involve the Chairmen having to request the assistance of other ETSI Members who should make every effort, within their power, to help the ETSI Secretariat in achieving their objectives.

When an Essential IPR is identified, the ETSI Secretariat will initiate the procedure set out in Clause 6.1 of the ETSI Interim IPR Policy. This procedure requires that the owner of the IPR, as a first step, be asked to give a declaration to grant licences, to those who wish to implement the Standard to which the IPR applies, on specified terms and conditions, (fair, reasonable and non-discriminatory), although the provisions of Clause 6.1 of the ETSI Interim IPR Policy make no mention of the territorial extent of the licences that are required to be granted. This procedure is a matter for the ETSI Secretariat, and the Chairmen of ETSI's Technical Committees, or any other ETSI Member, should not ask for IPR declarations, or the like, from Essential IPR owners, without first seeking the advice of the ETSI Secretariat.

In certain circumstances, for example, where a work item is a NET, TBR, or EN/ENV, funding may be available for the conduct of searches for IPRs Essential to a Standard/work item from the European Commission and/or the EFTA Secretariat, pursuant to Clause 6.2 of the ETSI Interim IPR Policy. Where, in the opinion of an ETSI Member and/or the Chairman of an ETSI Technical Committee, an IPR search is desirable, he/she should advise the ETSI Secretariat, giving a brief explanation of why an IPR search is considered desirable, so that an application for financial support can be made to the European Commission. In all such cases, the work item should be clearly identified by number and type.

The mere offer to grant licences under IPRs Essential to a Standard/work item does not guarantee that the Standard/work item in question will not be blocked. It is important that all offers of licences be checked to ensure compliance with ETSI's needs. The task of checking licensing compliance requires professional assistance and the Chairmen of ETSI's Technical Committees, or any other ETSI Member, should

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under no circumstances purport to advise a right owner whether, or not, a particular licensing offer, or declaration, complies with ETSI's requirements. However, ETSI Members are perfectly free to express any views they may have, in respect of these matters, provided they do not suggest that such views represent the official ETSI position.

ETSI cannot be expected to monitor every licence issued under an Essential IPR to determine whether, or not, it is compliant with the ETSI Interim IPR Policy, or an IPR declaration given by the owner of an Essential IPR. The responsibility for ensuring compliance rests firmly with the ETSI membership. However, where a dispute arises between licensee and licensor over compliance of a particular licence with the ETSI Interim IPR Policy, ETSI should be specifically requested to use its good offices to arrange an amicable agreement. If this fails, it is always open to the aggrieved party to raise the matter in the ETSI Technical Assembly, or General Assembly, or even lodge a complaint with the European Commission.

5.4 Technical Proposals

The principle requirement for IPR statements arises in connection with technical proposals made to ETSI's Technical Committees, see Section 3.2.

It should be remembered that such statements should be made by the originator of the technical proposal and not the proposer.

6. CONTRACTS AND AGREEMENTS

This Section of the Handbook addresses the following matters:

- Collaborative arrangements and contracts; and
- Contracts of employment.

Whilst none of these matters are specifically addressed by the ETSI Interim IPR Policy, they are nevertheless of importance to ETSI Members because they cover contractual matters which are likely to affect ETSI Members and, more particularly, those of their employees who may be involved, from time-to-time, in the ETSI standardization process. Furthermore, the related contractual terms and conditions could have a profound impact on the availability of Standards.

6.1 Contract/Agreement Terms and Conditions

Contracts and agreements which relate to technology and standards, invariably contain provisions affecting IPRs and their availability. For this reason, the terms and conditions of contracts/agreements, to which ETSI is a party, could, as stated above, have a profound impact on the availability of Standards.

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In this regard, it should be noted that the IPR provisions of contracts/agreements may cover:

- ownership of IPRs created during the course of work under the contract/agreement, i.e. foreground IPRs;
- availability of licences for the foreground IPRs and the IPRs existing at the date of the contract/agreement, i.e. background IPRs;
- confidentiality;
- warranties; and
- indemnification.

It is the responsibility of the ETSI Secretariat, and not the ETSI Membership, to ensure that the IPR provisions of the contracts/agreements, to which ETSI is a party, meet ETSI's needs/requirements. There is, however, nothing to prevent the ETSI membership from monitoring such contracts/agreements, whenever possible, to ensure that their best interests are being protected. Any contractual problems and/or potential difficulties that may be identified by an ETSI Member should be immediately reported to the ETSI Secretariat.

6.1.1 Ownership of IPRs

In most, but not all, contracts/agreements, the ownership of foreground IPRs, i.e. IPRs created during the course of work under the contract/agreement, will vest in the party who created the IPR, and there will be specific contract provisions relating to these matters.

It is extremely unlikely that the ownership of background IPRs will be affected by any contract/collaboration entered into by ETSI, although licences under such IPRs may be required and the contract/collaboration terms and conditions should reflect this need, as appropriate.

6.1.2 Availability of Licences

It is likely that the contracting parties will own background IPRs relating to the subject matter of the contract/collaboration and that use of the results of the contract/collaboration cannot be effected without infringement of the background IPRs.

Thus, in order to enable each of the parties to the contract/collaboration to exploit the results of the contract/collaboration, the related terms and conditions will require each of the parties to make licences available to the other party(ies), on appropriate terms and conditions, under foreground rights and those of their background IPRs that are necessary for the exploitation of the foreground rights for,

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at least, the purposes of the contract/collaboration.

In addition, in certain ETSI contracts where licences are made available to ETSI for the exploitation of the contract results, it may be appropriate for the ETSI Secretariat to make provision for sub-licensing rights for the benefit of ETSI Members.

6.1.3 Confidentiality

In general, the contract/collaboration will include confidentiality provisions relating to the information, i.e. the know-how, which is not in the public domain, contributed by the parties to the contract/collaboration. Such provisions will provide for the standard exceptions to confidentiality, as set out in Section 3.1.4 of this Handbook.

6.1.4 Warranties

Typical warranty clauses found in contract/collaboration/licence agreements may include the following:

- a warranty that the licensor is entitled to grant licences which the agreement purports to grant;
- a warranty concerning the ownership of IPRs;
- a denial of a warranty that exercise of the licence and/or results of a contract/collaboration will not result in the infringement of third party IPRs;
- a denial of a warranty that the products manufactured and/or the processes used, by the licensee, in exercising his licence, will be capable of industrial application, useful, or free from hazard to the user, or the environment; and
- a denial of a warranty that the exploitation of the results of the contract/collaboration will result in a commercially viable product, or system;

6.1.5 Indemnities

There are always IPR risks associated with the exploitation of the results of a contract/collaboration. As a consequence of this, R&D contracts/collaboration agreements will always address the question of who will carry the risk of:

- infringement of third party IPRs in the course of exercising the rights granted under a licence, or exploiting the results of a contract/collaboration; and

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- product liability, i.e. the risk that sub-standard products will result from exercising the rights granted under a licence, or exploiting the results of a contract/collaboration, thereby incurring liability to a third party.

This is usually a matter for negotiation between the parties but, in general, the party carrying the risk will be the one whose actions are likely to give rise to problems and who will be in the best position to mitigate the risk.

6.2 Types of Agreement

The agreements with which ETSI will be involved can be categorised, as follows:

- contracts of employment;
- R&D contracts;
- collaboration agreements;
- licence agreements;
- IPR declarations; and
- other agreements, for example, adoption of standards and confidentiality agreements.

These contracts are not mandated by the ETSI Interim IPR Policy but they do relate to IPRs and, as such, they must have the same objective as the ETSI Interim IPR Policy regarding the availability of Essential IPRs for the purposes of standardisation, i.e. minimising risk that ETSI Standards will be blocked by IPRs, for which licences are unavailable.

Thus, ETSI Members, as well as the ETSI Secretariat, have a responsibility to ensure, whenever possible, that the terms and conditions of the contracts/agreements, with which ETSI is, or will be, involved, are not inconsistent with the provisions of the ETSI Interim IPR Policy.

6.2.1 Contracts of Employment

The formulation of contracts of employment and secondment is the responsibility of the ETSI Secretariat but will be subject to the approval of the ETSI membership, particularly in the case of secondment contracts.

6.2.2 R&D Contracts

The formulation of standard R&D contracts is the responsibility of the ETSI

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Secretariat and, in particular, the Deputy Director of ETSI and/or ETSI's IPR Advisers.

In general, ETSI will only place contracts for the performance of R&D, on terms and conditions which guarantee licences of a scope, and on terms and conditions, which fully meet ETSI's needs.

6.2.3 Collaboration Agreements

The formulation of standard collaboration agreements is the responsibility of the ETSI Secretariat and, in particular, the Deputy Director of ETSI and/or ETSI's IPR Advisers.

As stated in Section 4.2 of this Handbook, in establishing relationships with other Standards bodies, ETSI needs to respect the IPR Policies of other Standards bodies. In addition, ETSI:

- is in the process of compiling a library of the IPR policies of other Standards bodies, as an aide to negotiation; and
- will explain its IPR objectives to other Standards bodies, so that they clearly understand ETSI's needs, with regard to the availability of licences for Essential IPRs.

The precise actions that need to be taken will, of course, depend on a number of factors, namely:

- the nature of the collaboration, and
- ETSI's contract/agreement policy,

and will require the exercise of judgement by those involved in the negotiation.

6.2.4 Other Matters

It is ETSI's responsibility to record all contracts/agreements on a suitable database and ensure, in liaison with the Chairmen of ETSI's Technical Committees, that all collaborations/contracts are properly monitored and resulting IPRs recorded.

6.2.5 Licence Agreements

The formulation of licence agreements is the responsibility of the parties concerned. Whilst the Director of ETSI is not obliged, pursuant to the ETSI Interim IPR Policy, to make a standard model licence, such a licence, approved by ETSI, will be made available by the ETSI Secretariat for use by ETSI Members (see Section 7 of this Handbook). Thus, any requests received by the Chairmen of ETSI's Technical Committees for model licence agreements should be referred to the ETSI Secretariat.

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6.2.6 IPR Statements/Declarations

IPR statements/declarations are discussed, in detail, in Section 5 of this Handbook.

6.2.7 Other Agreements

Other agreements relevant to standardisation include agreements for the adoption of third party standards, as an ETSI standard, or vice versa, and confidentiality agreements.

6.3 Effects of Agreements re: IPRs

The main issue influencing the negotiations of R&D contracts and/or collaborative agreements, is the ownership, and/or licensing, of IPRs which are Essential, or potentially Essential, to the subject of the contract/collaboration.

It is important for ETSI's reputation that it does not knowingly induce other Standards bodies to adopt ETSI Standards which may be blocked by non-availability of Essential IPR licences in territories for which such Standards bodies are responsible.

It is, therefore, prudent for ETSI to examine those of its Standards which it intends to promote, on an international basis, to determine whether, or not, there are any IPRs Essential to those Standards. If such IPRs exist, it will then be necessary to determine if there are any restrictions, on the scope of licences available, or the nationality of the licensee.

It will be the responsibility of the ETSI Secretariat to resolve these issues, and to prepare, and obtain approval for, statements on IPRs of relevance to the subject of the collaboration and the availability of licences for such IPRs, including both foreground and background IPRs.

The Chairmen of ETSI's Technical Committees may have a part to play in this process, particularly in relation to the approval phase, because this may involve ETSI Technical Committee members.

7 LICENSING AND DECLARATIONS

This Section of the Handbook addresses the following matters:

- a Model licence agreement - not specifically addressed by the ETSI Interim IPR Policy; and

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- Licensing compliance - the relevant provisions of the ETSI Interim IPR Policy, relating to the required scope for Essential IPR licences, are set out in Clause 6.1.

7.1 Introduction

The primary aim of ETSI's Interim IPR Policy is to ensure that ETSI Standards are not blocked by IPRs, in other words, to ensure that licences are available under IPRs which are Essential to ETSI Standards, in accordance with the provisions of Clause 6.1 of the ETSI Interim IPR Policy.

Where Essential IPRs exist, there is no initial commitment to grant licences, and it is necessary to determine whether, or not, the owner(s) of such IPRs will be prepared to grant licences and the terms and conditions that will be applied to any licences they are willing to grant. Clause 6.1 of the Interim IPR Policy requires the Director of ETSI, in practice the ETSI Secretariat, to make these determinations.

In general, the Chairmen of ETSI's Technical Committees are not, therefore, directly involved in decisions relating to either the availability of licences under Essential IPRs, or the terms and conditions on which such licences are granted.

It should be noted that ETSI will not involve itself in the resolution of arguments over the precise terms and conditions contained in licences offered under Essential IPRs, unless specifically requested by the parties involved in the licensing negotiations. Even when ETSI does intervene in a licensing negotiation, its role will almost certainly be limited to using its good offices to try and bring the parties together to resolve any outstanding issues before they develop into a full blown dispute.

7.2 Effect of ETSI Interim IPR Policy

There is no obligation, pursuant to the ETSI Interim IPR Policy, that requires ETSI Members to grant licences in respect of those of their IPRs which are, or may become, Essential to an ETSI Standard.

7.3 Parties not Bound

Since any person, or entity, owning an IPR Essential to an ETSI work item, or Standard, is not bound by the ETSI Interim IPR Policy to grant licences for the Essential IPR to ETSI Members, and/or others, it will be necessary for the ETSI Secretariat to secure an appropriate form of declaration from that person, or entity, in relation to the IPR and Standard, or work item, at issue.

7.4 Object of IPR Declarations

Where an Essential IPR is identified, ETSI needs an assurance that the IPR concerned will not be used to block the Standard, or work item, to which it relates.

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This means that, either the owner of the IPR must be persuaded to give a commitment to grant licences under that IPR, or the work item, or Standard, to which the IPR relates, must be changed so that the IPR is no longer Essential. A commitment to grant licences, conveniently, takes the form of a contract to grant licences on request, usually referred to as a declaration. Such declarations will normally specify the scope, and certain terms and conditions, of the licences to be granted.

7.5 Scope of Licences

A licence agreement, in the context of standardization, should define, inter alia:

- the countries in which licences are granted;
- the IPRs, or parts of IPRs, which are licensed;
- the purposes for which the licence may be used;
- the technical scope of the licence; and
- the terms and conditions on which the licence is granted.

7.6 Terms and Conditions

The terms and conditions on which IPR owners may be asked to grant licences are discussed in Section 7.7 below.

Clearly, a declaration to grant licences may attract criticism from the ETSI membership if it permits the owner of an Essential IPR to impose terms, or conditions, on licensees, which are unreasonable.

7.7 Licensing Requirements

The scope of licences which must be made available under an Essential IPR, are defined in Clause 6.1 of the ETSI Interim IPR Policy, and are paraphrased below:

- Manufacture, sale, lease, or other disposal of, Standard-compliant equipment within the licensed territory;
- repair, use, or operation, of Standard-compliant equipment, Manufactured in the licensed territory, anywhere;
- use of Standard-compliant Methods within the licensed territory; and
- procure customized components and sub-systems to the licensees own design for use in manufacture of Standard-compliant equipment in those countries to which the licence extends.

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The intent is that licences granted under an Essential IPR should enable a licensee to fully comply with the Standard, to which the licensed IPR is Essential, but need not grant any rights beyond those necessary for Standard-compliance.

However, it is not only the ETSI Interim IPR Policy that must be considered, when determining the scope of a licence granted under an Essential IPR, but also the views expressed by the European Commission in their Communication, namely, "EC's Communication on IPR and Standardization" - COM(92)45 of 27th October 1992.

It is quite clear from the Commission's Communication that licences granted under IPRs Essential to ETSI Standards must permit the import of Standard-compliant equipment into the EC. This means that:

- a procurer of equipment is entitled to a licence permitting importation of Standard-compliant equipment into the EC; and
- an overseas manufacturer is entitled to a licence permitting export of Standard compliant-equipment into the EC.

However, no requirement can be inferred requiring the grant of licences to manufacture Standard compliant-equipment outside the CEPT countries.

The territorial scope of licences that must be granted under Essential IPRs is not clearly defined by the ETSI Interim IPR Policy. However, it can be inferred that such licences should at least cover the countries of the administrations who are members of ETSI, i.e. the CEPT countries.

The real issue is: If licences are not available under an Essential IPR in a given country must ETSI change, or withdraw, the affected Standard? This is not an easy question to answer with precision, and it is open to the parties to a licence negotiation to argue the question of territoriality in these terms. Furthermore, the importation requirement does not have to be extended to non-EC countries, although the affect of the Agreement on Technical Barriers to Trade may have the affect of forcing a general application of the import requirements.

In the light of the above comments, licence terms and conditions which should be regarded as unacceptable are:

- provisions which permit early termination of the licences by the licensor;
- provisions which restrict importation of Standard-compliant equipment from countries where it has been legitimately manufactured; and
- provisions which restrict the licensees freedom in, or between, countries to which the licensed IPR does not extend, (such a provision would infringe competition law).

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Terms and conditions which should be included in licences are:

- grant of non-exclusive irrevocable licences on fair, reasonable, and non-discriminatory terms and conditions;
- grant of licences for the full life of the licensed IPRs; and
- a provision permitting the licensee to terminate the licences at any time.

In addition, careful consideration must be given to the reasonableness of grant back licences and the form of any non-monetary consideration requested. It should, however, be noted that the provisions of Clause 6.1 of the ETSI Interim IPR Policy (Availability of Licences) are such that the licensing declarations, given by owners of Essential IPRs, may be made subject to the condition that those who seek licences agree to reciprocity.

It is to be expected that licences granted by owners of Essential IPRs will contain many terms and conditions not referred to above, for example, warranty and indemnity clauses of varying form.

7.8 Licensing Compliance

Where an IPR Essential to an ETSI Standard exists, a declaration, given in respect of the licensing of that IPR, can only be said to comply with ETSI's requirements if licences will be granted to all persons who wish to implement the Standard and have the effect of permitting all such persons to implement the Standard.

For licensing compliance to be demonstrated it must be shown that:

- the technical scope of the licences is such that the Standard can be implemented by all sectors of the telecommunications industry;
- licences will be available in all countries in which the Standard is to be implemented;
- the terms and conditions of licences will be fair, reasonable and non-discriminatory; and
- licences will be available to all persons who wish to implement the Standard.

If licences are denied to any person who wishes to implement the Standard, or are unavailable in any country in which the Standard is to be implemented, a licensing declaration may be regarded as non-compliant.

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Of course, if licences are available on a broader base than indicated above, then that is clearly an advantage for the licensee.

The precise wording of licensing declarations given by ETSI Members is not of critical importance since, by joining ETSI and maintaining their membership of ETSI, such entities have tacitly accepted that they are bound by the ETSI Interim IPR Policy which, as previously stated, forms part of the ETSI Rules of Procedure.

It is difficult to see how an ETSI Member can reconcile continued membership of ETSI with a refusal to grant licences under IPRs they have declared available for licence on terms and conditions which do not comply with the ETSI Interim IPR Policy. However, the position when an Essential IPR is owned by a non-member of ETSI is different. In these circumstances there can be no presumption that the provisions of the ETSI Interim IPR Policy will, in default of a clear statement of licence scope and licensing terms and conditions, have any bearing on the terms and conditions of a licence. Thus, where an Essential IPR is owned by a non-ETSI member it is important that a precisely drafted IPR declaration is obtained. It is in the clear interests of ETSI Members to ensure that such a document is available before a Standard is formally adopted.

If the owner of an IPR Essential to an ETSI Standard, or work item, declines to give a declaration to grant licences which are compliant with ETSI's requirements, alternative action must be considered, as discussed in Section 4 of this Handbook, including:

- amending the Standard, or work item, to avoid the Essential IPR;
- abandoning the Standard, or work item; or
- in extreme cases, seeking the assistance of the European Commission.

It should be noted that the ETSI Secretariat will adopt a non-interventionist role with regard to disputes involving IPRs and Standards. This means that it is the responsibility of ETSI's membership to deal with these issues through the various fora available within ETSI.

The function of the ETSI Secretariat is to make information available to Members, issue reminders, from time-to-time, and ensure that a simple mechanism exists for implementing the will of the ETSI membership. The ETSI Secretariat will not provide unsolicited opinions on detailed licensing terms and conditions. However, should a Member seek advice on the compliance of licensing terms and conditions with the ETSI Interim IPR Policy, such advice will be given. Furthermore, any person who feels aggrieved by the terms offered by the licensor of an Essential IPR must raise the matter himself through the ETSI Committee structure. The ETSI Secretariat cannot be expected to take a position as between individual Members of ETSI.

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8. Standards Documentation

This section of the Handbook addresses issues relating to 'Copyright in Standards documentation'.

8.1 IPRs in Standards Documentation

Pursuant to Clause 9.1 of the ETSI Interim IPR Policy, the ownership of copyright in Standards documentation and reports created by ETSI, or any of its Committees, vests in ETSI but due acknowledgement must be given to copyrights owned by third parties that are identifiable in ETSI copyright works.

The Technical Committees of ETSI are the main generators of ETSI copyright works and it is, therefore, of importance that the Chairmen of ETSI's Technical Committees should be familiar with the copyright provisions of the ETSI Interim IPR Policy and the manner in which such provisions should be operated.

The object of the copyright provisions is to ensure that:

- all copyrights subsisting in ETSI documentation and, in particular, Standards documentation, are identified;
- any necessary copyright licences, or assignments, are executed by the parties concerned - this will primarily be the concern of the ETSI Secretariat and/or ETSI's IPR Advisers but the Chairmen of ETSI's Technical Committees may be requested to assist;
- due acknowledgements are given to copyright owners; and
- rights of identified authors are respected - the Chairmen of ETSI's Technical Committees will have a part to play in identifying, and notifying ETSI of, the names of the authors of the documentation submitted to their respective Committees.

The main elements of the ETSI copyright provisions are that:

- all documentation submitted to, and/or generated by, ETSI's Technical Committees should be recorded in the ETSI database, together with other relevant information; and
- the rules of procedure of ETSI's Technical Committees, concerning the acceptance of third party contributions, should reiterate the copyright provisions of Clause 9.1 of the ETSI Policy.

In addition, the Chairmen of ETSI's Technical Committees should ensure that operation of the copyright provisions, i.e. the provisions of Clause 9.1 of the ETSI

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Interim IPR Policy, is effected in a manner whereby:

- all documents submitted to an ETSI Technical Committee are recorded in the minutes of the meeting concerned, together with any restrictions on, or requirements relating to, use of each document and its contents in the standardization process;
- if such restrictions/requirements include a need to acknowledge author's rights, then the Chairman of the ETSI Technical Committee concerned, or someone appointed by the Chairman, will inform the ETSI Secretariat of, and an appropriate entry will be made on, the document;
- the ETSI Secretariat will determine (if necessary, in liaison with the Chairman of ETSI's Technical Committees, or ETSI's IPR Advisers) whether copyright licences/assignments are required and, if so, obtain such licences/assignments from the copyright owner prior to using the document;
- the ETSI Secretariat will ascertain whether, or not, the copyright owner is prepared to execute any necessary licences/assignments and, if so, to provide a written declaration to this effect, within a specified time scale - this is necessary in order to prevent any undue delays in clearing the document for use in the standardisation process;
- if a licensing/assignment declaration is given by the copyright owner, the Chairman of the ETSI Technical Committee concerned will be advised by the ETSI Director that work can proceed on the basis of the document concerned; and
- the ETSI editorial staff are responsible for determining, in liaison with the Technical Committee Chairman, which, if any, third party copyrights have to be acknowledged.

This is an ideal, which may prove difficult to implement in practice, but it is the best interests of ETSI Members to ensure that all possible steps are taken to maximise the benefits that can be derived from these provisions.

8.2 ETSI's Requirements

As a Standards maker, ETSI is required to make available, to all interested parties, details of ETSI Standards and any related documentation.

Thus, in order to avoid copyright infringement problems, ETSI must be in a position to license any copyright subsisting in the technical specifications of ETSI Standards, and/or the related documentation.

8.3 Marking

The marking of ETSI documentation is required to signify the following:

- confidentiality of information;
- copyright ownership; and
- author's rights.

8.3.1 Confidential Information

An appropriate marking for use on ETSI documentation to indicate that the document contains confidential information is set out in Section 3.1.6 of this Handbook.

8.3.2 Copyright Ownership

The marking requirements are, in general, dictated by the international copyright conventions, namely, the Berne Copyright Convention which has no particular requirements concerning the application of a copyright notice to copyright works, and the Universal Copyright Convention (UCC) which has marking requirements.

The UCC has a three element marking requirement, for published documents, which comprises the letter 'c' in a circle, followed by the name of the copyright owner and the year of first publication.

For the purposes of the UCC marking requirement, the word 'published' means that copies of the copyright work have been:

- issued to the general public; or
- supplied to third parties without any restrictions having been placed on the recipients concerning disclosure, or use, i.e. without a confidentiality agreement.

Thus, for ETSI, the three element marking requirement of the UCC would read as follows:

'© European Telecommunications Standards Institute 1995. All rights reserved'

Since copyright protection does not extend to the use, or disclosure, of the information content, as such, of the copyright work, the copyright marking used on published ETSI documentation should read as follows:

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'© European Telecommunications Standards Institute 1994. All rights reserved.

No part may be reproduced except as authorized by written permission. The copyright and the foregoing restriction on reproduction extend to all media.'

For other ETSI works, e.g Technical Committee working drafts, the copyright marking should read as follows:

'© European Telecommunications Standards Institute 1994. All rights reserved.

Reproduction is only permitted for the purpose of standardization work. The copyright and the foregoing restriction on reproduction extend to all media'

The acknowledgement of copyrights, owned by third parties, which are identifiable in ETSI copyright works, should be effected, as follows:

'Some material contained herein is the copyright of, or has been supplied by...(insert name of party in question).'

This legend is to be endorsed on the ETSI documents and/or media concerned and should immediately follow the copyright legend(s) referred to above.

All ETSI deliverables made available to Committees should, in addition to the copyright markings referred to above, carry the following legend:

'For internal use within ETSI TCs & STCs!. Copies for third parties are not permitted'

Finally, although it is concerned with civil liability and not copyright, all diskettes supplied by ETSI should bear the following legend in addition to the markings referred to above:

'This diskette has been virus checked at ETSI, (using the MCAFFEE Virus Scan 2.10 software). You are advised to check the diskette before use.'

8.3.3 Author's Rights

As, and when, author's rights are asserted, the marking to be used is as follows:

'The right of...(insert name(s) of author(s)) of...(insert name of the employer of the, or each author)...to be identified as the author(co-authors) of this work has been asserted.'

This legend is to be endorsed on the ETSI documents and/or media concerned and should immediately follow the copyright legend(s) referred to above.

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8.4 Need to Identify Authors and Owners

8.4.1 Authors

Moral Rights which are also known as Droit de Suite, or Author's Rights, have always been part of the copyright laws of most European countries and the requirements of the law are such that the creator of a copyright work has the right to be identified as the author of a copyright work, but only if that right is asserted.

8.4.2 Owners

The main advantages to be gained from marking ETSI documentation, with a copyright legend signifying ownership and related matters, is that it satisfies the requirements of the Universal Copyright Convention (UCC) and avoids claims of 'innocent infringement' by those parties who copy, rather than purchase, ETSI documentation.

9. ETSI DATABASE

The successful implementation of the ETSI Interim IPR Policy requires that considerable quantities of data be held in a readily accessible and searchable form. The ETSI Database provides a vehicle for the storage and recovery of data relating to Standards. As yet the ETSI Database has not been adapted to deal with IPR matters.

10. THE ETSI IPR BULLETIN

The ETSI Interim IPR Policy, and its operational aspects, require that certain information, relating to IPRs and Standards, be circulated to all Members of ETSI. The vehicle for achieving this is the ETSI IPR Bulletin, which is a formal Journal in which notices and information relating to IPRs and Standards is published. The ETSI IPR Bulletin is published on a bi-monthly basis and copies may be obtained from the ETSI Secretariat. Further details of the ETSI IPR Bulletin are set out in Annex XIV.