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Zhu Xianghua
Standardization Theory and Strategy Department
China National Institute of Standardization
4 Zhichun Road, Haidian District,
Beijing 100088, P.R. China

Re: The proposed CNIS standard No. 20090445-Z-424, "Guide for Implementation of the Inclusion of Patents in National Standards," ANSI Comments

Dear Mr. Xianghua

The American National Standards Institute (ANSI) is pleased to submit these preliminary comments on the Draft Disposal Rules of Inclusion of Patents in National Standards, issued by the China National Institute of Standardization (CNIS) on January 21, 2010. We appreciate the opportunity to share this input, and look forward to further discussion on the points included herein.

ANSI is the established forum for the voluntary standardization community in the United States. ANSI also serves as the United States representative to the International Organization for Standardization (ISO) and, through the United States National Committee, the International Electrotechnical Commission (IEC). In its role as the only accreditor of U.S. voluntary consensus standards developing organizations (SDOs), ANSI ensures the integrity of the standards development process and determines whether standards meet the necessary criteria to be approved as American National Standards. ANSI's approval of these standards (currently numbering approximately 9,500) is intended to verify that the principles of openness and due process have been followed and that a consensus of all interested stakeholder groups has been reached.

ANSI has enjoyed longstanding and active cooperation with China on various aspects of standardization and conformity assessment. This includes memoranda of understanding with the Standardization Administration of China (SAC) and the Certification and Administration of China (CNCA), as well as very active cooperation on various initiatives with the China National Institute for Standardization (CNIS). ANSI places a high priority on this cooperation and sees this as a key mechanism to pursue mutual opportunities and to address areas or concern between the U.S. and China.

ANSI supports China's efforts to implement concise rules relating to the inclusion of technology covered by patent claims in Chinese National Standards. We also strongly support CNIS' attempts to align its proposed policy with the ISO/IEC/ITU patent policy and Guidelines. However, we have some significant questions and concerns on the draft "Guide for Implementation of the Inclusion of Patents in National Standards", which are outlined in the attached comments. We are confident that through further dialogue, discussion and information sharing ANSI's questions and concerns can be resolved. We hope that the final Guide will appropriately balance the interests of those who will implement the standard with the interests and voluntary cooperation of those who own the intellectual property rights essential to the implementation of the standard, as does the common patent policy of ISO, IEC, ITU-T, and ITU-R, as well as ANSI's Patent Policy for American National Standards. (Copies of the ANSI Patent Policy and Guidelines for Implementation of the ANSI Patent Policy are attached for your convenience.)

As a next step, we would be pleased to organize an opportunity for ANSI and its members to exchange views with CNIS and other relevant experts in China on the attached comments. Ms. Bei Gu, Representative of the ANSI China Program will follow up with you later this month to discuss timing and logistics for this meeting.

Thank you and best regards.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Patricia A. Griffin', with a stylized flourish at the end.

Patricia A. Griffin

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**ANSI对标准编号为20090445-Z-424之“国家标准涉及专利的实施指南”
建议稿的相关意见**

尊敬的朱翔华先生：

美国国家标准学会（ANSI）很高兴就中国国家标准化管理委员会于2010年1月21日发布的国家标准涉及专利的处置规则征求意见稿提交相关初步意见。我们重视有机会与贵方分享这些意见，并期待就这些意见要点与贵方作深入的讨论。

ANSI是为美国的自愿性标准化社团而设立的论坛。ANSI也在国际标准化组织（ISO）中行使国家代表职能，并通过美国国家委员会行使美国在国际电工委员会的代表职能。作为美国唯一自愿性标准制定机构的认可者，ANSI保证标准制定过程的一致完整性以及确认那些即将被批准成为美国国家标准名副其实。ANSI对这些标准（目前约为9500个标准）的核准旨在确认其符合公开、正当程序的原则，并确认所有利益相关方已达成共识。

ANSI与中国在标准和合格评定的许多领域享有长期和积极的合作，其中包括和中国国家标准化管理委员会（SAC）以及中国国家认证认可管理委员会签订的谅解备忘录，以及同中国国家标准化管理委员会（CNIS）在不同项目上的十分活跃的合作。ANSI高度重视与中国的这种合作，并视其为寻求共同机会和解决美中之间关注的问题的关键机制。

ANSI支持中国对涉及专利技术的相关国家标准实施明确规定的努力，我们也坚决支持CNIS将其拟议的政策和ISO/IEC/ITU的专利政策和指南趋于一致的努力。但是，我们对“国家标准涉及专利处置规则”（意见征求意见稿）有一些重要的问题和关注，详细内容请参阅附件。我们坚信通过进一步的沟通、讨论和信息共享，ANSI的这些问题和关注能够得以解决。我们希望最终的规则将合理地平衡实施标准者的利益和实施这些标准不可或缺的知识产权拥有者的利益和自愿合作，正如ISO、IEC、ITU和ITU-R所采用的共同的专利政策那样，也与ANSI有关美国国家标准的专利政策一致（本函附件还有ANSI专利政策和实施ANSI专利政策的指南，供参考）。

作为下一步，我们将很高兴安排一个机会，让 ANSI 及其会员就本函附件内容与 CNIS 及其他中方专家交换意见。美国国家标准学会中国项目的代表顾珩女士将在本月早些时候与您联系，协商是项会议的时间和会务安排。

谢谢并问候！

致敬，

Patricia A. Griffin

Disposal Rules for the Inclusion of Patents in National Standards

(Draft for Comments)

国家标准涉及专利的处置规则

(征求意见稿)

A N S I F e e d b a c k F o r m

美国国家标准学会反馈表

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No. of chapter and article 章节名称	Suggestions on Revision 修改建议	Reason for Revision 修改理由	

<p>Articles 3.2 and 3.3 第 3.2 条和第 3.3 条</p>	<p>ANSI recommends that the term “Essential Patents” be deleted and replaced with the term “Essential Claims”.</p> <p>ANSI 建议删除“必要专利”一词，以“必要权利要求”代替。</p>	<p>ANSI recommends that that all references to “patents” in the Draft Rules should be replaced by “Essential Patents” in connection with issues related to <u>disclosures</u> and by “Essential Claims” in connection with <u>commitments</u> to offer a license. Some SDOs cover such Essential Patent Claims from patents “whenever issued,” to cover the case of published pending patent applications.</p> <p>ANSI 建议处置规则中所有与披露事项有关的“专利”应该改为“必要专利”，与提供许可的承诺有关的“专利”应该改为“必要权利要求”。一些标准组织涵盖“无论何时公布”的专利的必要专利权利要求，以包含专利申请之前公布的情况。</p> <p>Patent licensing commitments made to standards bodies generally apply only to those claims within a patent that are essential in connection with the final version of the standard. Accordingly, it would be helpful if Articles 3.2 and 3.3 refer to Essential Claims (and not Essential Patents).</p> <p>对于标准组织作出的专利许可承诺，一般只适用于标准的最终版本中只含有一项必要专利的情形。因此，如果第 3.2 条和第 3.3 条是指必要权利要求（而不是必要专利）将会更有益。</p>
<p>Article 3.3 第 3.3 条</p>	<p>ANSI recommends that the term “royalty free” be clarified mean without payment of any fee. “Refers to the licensing option selected by the licensor, subject to the rights of reciprocity or defensive suspension, allowing all implementers of a given standard, to implement Essential Patents included in such standard on reasonable and non-discriminatory basis, without payment of any fee.”</p> <p>ANSI 建议明确“免费许可”意味着没有任何费用。“指的是许可方选定的许可方式，在互惠或防御性终止权利的前提下，允许标准的所有实施者在合理和非歧视的基础上免费实施该标准。”</p>	<p>This clarification would include all types of fees including royalties, annual/periodic license fees and one-time payments</p> <p>此说明包括所有类型的费用，包括使用费，每年/定期的许可费和一次性费用。</p>

<p><u>Articles 4.1.1, 4.5, and 5.4.1</u> <u>第 4.1.1, 4.5, 5.4.1 条</u></p>	<p>Article 4.1.1 should be modified so that it says: “The standardization technical committee or the organization in charge shall encourage all of the organizations or individuals participating in the formulation or revision of a standard to disclose any Essential Patents that are known to the participating individual as soon as possible during the formulation or revision of such standard.</p> <p>Individuals who are not participating in the formulation or revision of a standard are encouraged to disclose, on a voluntary basis, any Essential Patents that are known to the non-participating individual. Non-participants are not required or expected to review any draft Chinese National Standards.”</p> <p>第 4.1.1 条应当修改为，“专业标准化技术委员会或归口单位应鼓励所有参与制定或修订标准的组织或个人，在标准的制定和修订过程中，尽早披露其所知悉的与标准有关的所有必要专利。</p> <p>鼓励没有参与制定或修订标准的个人，在自愿的基础上，披露其所知悉的必要专利。不要求或期待未参与标准制定或修订的人参与审查任何国家标准草案。”</p>	<p>Since non-participants would not be involved in the Chinese standards setting process and would not have entered into any agreement to license their Essential Patent Claims, it would be best to address disclosures from non-participants in a second sentence. ANSI recommends that Articles 4.1.1, 4.5 and 5.4.1 be modified to acknowledge that non-participants are not required or expected to review draft Chinese National Standards and make disclosure regarding patents</p> <p>由于未参与者不参与标准制定的过程，没有关于许可其必要专利权利要求的协议，因此从未参与者处获得披露最好放在第二位。</p> <p>ANSI 建议第 4.1.1 条，第 4.5 条和第 5.4.1 条进行修改，以明确未参与者不被要求或期待参与审查国家标准草案和进行相关专利披露。</p> <p>In addition, for participants in the standardization process, disclosure should be based on the knowledge of the individual who is participating in the technical committee activity.</p> <p>此外，对于标准化过程的参与者，应根据其在专业标准化委员会中所参与的程度要求其进行信息披露。</p>
<p><u>Articles 4.1.1, 4.5, 5.3.1, 5.3.2, 5.4.1</u> <u>第 4.1.1, 4.5, 5.3.1, 5.3.2, 5.4.1 条</u></p>	<p>ANSI recommends that the following text be added: “No individual or organization is expected or required to conduct patent searches in order to comply with any rules regarding the inclusion of patented technology in Chinese National Standards.”</p> <p>ANSI 建议增加以下规定：“不要求任何组织或个人进行专利检索，以期与中国国家标准中包含专利技术的规定相一致。”</p>	<p>ANSI recommends that it be made explicit in the Final Rules that there is no duty to conduct a patent search. ANSI is not aware of any SDO that requires patent searches which are very burdensome and expensive, and which make it very difficult for patent holders to participate in the standardization process.</p> <p>ANSI 建议在处置规则终稿中明确，没有义务进行专利检索。ANSI 未发现任何标准组织要求进行专利检索，专利检索不仅繁琐而昂贵，并且使得专利权人很难参与标准化过程。</p>

Article 4.1.2
第 4.1.2 条

ANSI recommends that the text be clarified to indicate the important relevant information that is required in the Patent Information Disclosure Form.

ANSI 建议明确指出在专利信息披露表中要求的证明材料的含义。

"When disclosing patent information, a patent information disclosure form (refer to Table A.1 in Annex A) shall be completed, and submitted together with **Relevant information** to the standardization technical committee or the organization in charge. ~~Evidence of a granted patent shall be a copy of the title page of the patent certificate.~~ **Relevant Information** of a published patent application but not granted shall be an publication of the patent application. **Relevant Information** of an unpublished patent application shall be the number of the patent application and date of application.

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"在披露专利信息时，应填写专利信息披露表（见附录 A 的表 A.1），并将证明材料一起提交至所属的专业标准化技术委员会或归口单位。~~已授权专利的证据应当是专利证书复印件或扉页。~~已公开但尚未授权的专利的证明材料是专利申请公告。未公开的专利申请的证明材料为专利申请号和申请日期。

The English version of this section varies from translation to translation and it is unclear whether specific fields in the Patent Information Disclosure Form are mandatory or optional. ANSI recommends that the text in this section be clarified to state that the completion of certain of the Patent Information Disclosure Form are required while others may be optional but not required. This clarification is necessary because not all information is available in all circumstances (e.g. unpublished applications) and some information would be difficult if not impractical to obtain except under unique circumstances.

本条款的英文翻译版本各不相同，目前尚不清楚专利信息披露表格中的特定部分是强制性的还是可选择的。ANSI 建议，在本条中明确地指出，专利信息披露表中的某些需要完成，而有些则可能是可选的，而不是必须的。这一明确是必要的，因为并非所有的信息在任何情况下都是可获得的（例如，未公开的申请），除了在特殊情况下，一些信息如果不太实际则很难获得。

<p>Article 4.3 第 4.3 条</p>	<p>ANSI suggests that the text say: “When a patent holder makes a disclosure to the Chinese standards body, it shall fill in a patent licensing statement (refer to Table A.3 in Annex A. This statement is not a license, but rather a statement to the effect that the patent holder is willing to offer licenses in connection with its Essential Claims.”</p> <p>ANSI 建议条文修改为：“当专利权人向标准化组织做出披露时，应填写专利许可声明表（见附录 A 的表 A.3）。此许可声明表并不是一种许可，而是一种为了达到专利权人愿意对于其必要权利要求提供许可的效果而做出的声明。”</p>	<p>ANSI recommends that it be clarified that only “Essential Claims” will be subject to the licensing commitment selected by the patent holder and that the commitment made to the organization to offer licenses is different than an actual license which may be negotiate between parties at a future date.</p> <p>ANSI 建议应明确只有“必要权利要求”才能适用专利权人选择的许可承诺，对于标准化组织做出的提供许可的承诺与实际的许可不同，后者将在未来某时通过在各方之间进行协商达成。</p>
<p>Article 4.3.4 第 4.3.4 条</p>	<p>ANSI recommends that this section be clarified based the handling of such license commitments under Chinese Law and what can be realistically requested of parties submitting commitments.</p> <p>ANSI 建议本条文明确在中国法下处理许可承诺为基础，可以对提交承诺一方提出何种现实的要求；If this section is intended to state the disposition of Chinese Law it is fine as written.</p> <p>如果本条目的是明确在中国法下的处置则是可行的，然而如果本条的目的是对于提供专利信息披露表的一方提出要求，则需要进一步明确。</p> <p>However, if the intent of this section is to require some action by the party submitting a Patent Information Disclosure Form, more clarity is needed.</p>	<p>It is unclear to ANSI whether licensing assurances and/or commitments under Chinese law apply to an assigned patent. Also, in the various English language translations of this section, some translators make reference to the “patent rights” being assigned and then the translations vary as to whether they state the “commitment to license” remains valid or the “licenses themselves” transfer to the assignee. Several International standards organizations (including the ITU-T) are currently revising their patent policy guidelines to provide that the patent holder making a commitment to the organization should use reasonable efforts to notify its assignee of a known licensing commitment.</p> <p>ANSI 目前还不清楚根据中国法律许可证和/或承诺是否适用于已转让的专利。此外，在本条文的各种不同的英文翻译中，有些译者指的是“专利权”转让，而译文中到底指的是“许可承诺”仍然有效，或者“许可本身”转移至受让人并不一致。一些国际标准组织（包括 ITU - T）目前正在修改其专利政策指导方针，规定专利持有人对标准组织作出承诺，应该通过合理的努力将已知的许可承诺通知其受让人。</p>

<p>Article 4.6 第 4.6 条</p>	<p>ANSI recommends that the Draft Rules be modified to make clear that parties that participated in the development of an international or foreign standard, but not in the development of a Chinese National Standard based on the international or foreign standard, have <u>no obligations</u> under the Rules as a result of their prior participation in a separate standardization effort.</p> <p>ANSI 建议处置规则草案进行修改以明确参与国际或国外标准制定的各方，而不是以国际或国外标准为基础参与中国国家标准发展的各方，由于其在先的参与是单独的标准化过程，因而没有在此规则之下的任何义务。</p>	<p>Non-participants in the development of the Chinese National Standard should not have any obligations in connection with that standard. Generally an organization's disclosure and licensing statement are in connection with a specific standard and only apply to that standard.</p> <p>非国家标准参与者不应承担与该标准相关的任何义务。一般来说一个组织的信息披露和许可声明是与特定的标准相关的，而且只适用于该标准。</p>
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<p>Article 5.3.1. 5.3.2 第 5.3.1, 5.3.2 条</p>	<p>ANSI suggests that the text of article 5.3.1 should read: "All the individual participants in the standards-setting working group are encouraged to disclose Essential Patents of which they personally are aware that are held by themselves, organizations where they are employed, and or relevant stakeholders according to the 4.1.2 requirements."</p> <p>ANSI 建议第 5.3.1 条修改为：“鼓励标准制定工作组的所有成员按第 4.2.1 条的要求披露本人、成员所在单位及其关联者持有的专利。”</p> <p>ANSI also suggests that article 5.3.2 be revised to read: "All the organizations or individuals, who voluntarily make technical contributions during the formulation and revision of a standard shall, according to the 4.1.2 requirements, disclose the Essential Patents that are held by such organization or individual that are essential in connection with their technical contribution."</p> <p>ANSI 还建议第 5.3.2 条修改为：“向正在制修订的标准自愿提供技术贡献的所有单位或个人应按第 4.1.2 条的规定，披露本单位或个人持有的与技术贡献有关的必要专利。”</p>	<p>To be consistent with Article 4.1.1 above, these participants should be "encouraged" to disclose.</p> <p>ANSI recommends that it be made clear that only Essential Patents must be disclosed, that there is no duty to search, and that individuals participating or submitting contributions must disclose only those Essential Patents of their employers that such individuals are personally aware of.</p> <p>为了与上述第 4.1.1 条相一致，应该是“鼓励”这些参与者进行专利披露。ANSI 建议，应明确，只有必要专利必须披露，没有检索义务，参与或者提供技术贡献的个人必须披露那些其本人知悉的必要专利。</p>
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<p>Article 5.3.5 第 5.3.5 条</p>	<p>ANSI suggests that article 5.3.5 be revised to read: "In case the standardization technical committee or organization in charge fails to receive the patent licensing statement signed by the patent rights holder of an essential patent within the specified time limit, or if the holder selects the licensing option specified in 4.3.2 c), the proposed standard shall be returned to the relevant technical committee to determine whether the standard can be modified, other technical options are available or the standard should be abandoned. The specific time limit can be determined by the standardization technical committee or organization in charge."</p> <p>ANSI 建议 5.3.5 条修改为：“如果专业标准化技术委员会或归口单位在规定的期限内未收到必要专利的专利权人签署的专利许可声明表或必要专利的专利权人选择了 4.3.2c) 的许可方式，则被提案的标准应被退回至相关的专业标准化技术委员会以决定标准是否应被修改，有无其他可行的技术选择或者放弃该标准。具体期限由专业标准化技术委员会或归口单位自行决定。”</p>	<p>ANSI recommends that the Draft Rules be clarified to state that the proposed Chinese National Standard will be returned to the technical committee if a Licensing Statement cannot be obtained or if the patent holder indicates that it will not commit to negotiate licenses on RAND or RAND-compensation-free terms and conditions. Should the proposed standard be returned to the technical committee, the technical committee should determine whether other technical options are available or if the standard should be abandoned. If technical alternatives are available, the modified standard may be approved so long as licensing statements with a RAND or RAND-RF commitment have been received from all holders of Essential Patents.</p> <p>ANSI 建议处置规则草案予以明确，如果未获得许可声明，或者专利权人未达成在 RAND 原则或 RAND 补偿费的免费条款或条件下，被提案的国家标准将退回至专业标准化技术委员会。专业标准化技术委员会应确定是否有其他可供选择的技术，或者放弃该标准。如果存在技术的替代品，只要获得所有专利权人对于必要专利的 RAND 或者 RAND-RF 的许可声明，修订的标准将会被批准。</p>
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<p>Article 5.4.1 第 5.4.1 条</p>	<p>ANSI suggests that article 5.4.1 be revised to read: “When soliciting comments on a draft national standard including Essential Patents, relevant patent information of such standard shall be published according to the 4.2 requirements, bearing the words stating that the public is encouraged on a voluntary basis to notify the relevant technical committee that they disclose the Essential Patents they are aware of according to the 4.1.2 requirements. There is no penalty for a failure to make such a voluntary disclosure. If a member of the public notifies the technical committee of a possible Essential Patent that is held by a third party, then the standards authority will contact that third party to see if it is willing to make a disclosure on a voluntary basis”.</p> <p>ANSI 建议第 5.4.1 条修改为：“涉及专利的国家标准在征求意见时，应根据第 4.2 条的要求，公布标准相关信息。并鼓励社会公众在自愿的基础上，按照第 4.1.2 条的要求披露其所知悉的专利。</p> <p>对于此自愿披露不设定处罚措施。如果一社会成员通知专业标准化技术委员会一项可能的必要专利由第三方持有，则专业标准化技术委员会应与第三方取得联系，看第三方是否同意在自愿的基础上披露该专利。”</p>	<p>ANSI applauds this effort at greater transparency in the standardization process. ANSI recommends that the Draft Rules be modified so that it is clear that there is no obligation being imposed on non-participants in the standardization working group to make any disclosures in response to any public publication of the draft standard.</p> <p>ANSI 赞赏为标准化过程的更高透明度所作的努力。ANSI 建议处置规则草案修改，以明确，非标准制定工作组成员对于任何公开的标准草案没有任何披露义务。</p> <p>ANSI also would encourage CNIS to clarify that there is no obligation to disclose Essential Patents owned by another party. If another party informs the technical committee of a third party patent that it believes to be an Essential Patent, the relevant Chinese authorities should contact that third party patent holder to determine whether that patent holder would be willing to make a disclosure statement on a voluntary basis.</p> <p>ANSI 也鼓励中国标准化研究院(CNIS)明确，一方没有义务披露另一方拥有的必要专利。如果另一方通知专业标准化技术委员会，认为第三方专利是一个必要专利，相关机构应该与该第三方专利权人联系，以确定该专利权人是否愿意在自愿的基础上做出披露声明。</p>
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<p>Article 5.4.2 第 5.4.2 条</p>	<p>ANSI suggests that it be revised to read: "Members of the standardization technical committee responsible for the standard are encouraged to disclose any Essential Patents that are known to the participating individual as soon as possible during the formulation or revision of such standard, according to the 4.1.2 requirements." ANSI 建议修改为：“鼓励专业标准化技术委员会的委员，在标准制定和修订的过程中，根据 4.1.2 的要求向参与者披露其所知悉的必要专利信息。”</p>	<p>Using the term “are encouraged” makes this Article consistent with Article 4.1.1 above. 使用“鼓励”一词，使这一条款与上述第 4.1.1 条相一致。</p>
<p>Article 5.5 第 5.5 条</p>	<p>ANSI recommends that Article 5.5 be deleted. ANSI 建议删除第 5.5 条。</p>	<p>Technical committees do not have the necessary legal expertise to examine disclosed patents and make related assessments. Also, many companies do not permit their engineers to review other companies' patents. 专业标准化技术委员会并没有必需的法律专长审查所披露的专利，并进行相关的评价。此外，许多公司不允许他们的工程师审查其他公司的专利。</p>
<p>Annexes 附录</p>	<p>ANSI suggests making most of these requirements optional. ANSI 建议规定大多数要求为可选。The requirement contained in the column, titled "Patent-Involving Articles of the Standard (Number of Chapter and Article)", could be impractical for many companies and therefore should be clearly marked as "optional" and not be required. 表格中所列的题为“标准中涉及专利（章节号码）”对于很多企业均不适用，因此需明确标明“可选”，不强制使用。</p>	<p>The forms in the annexes appear to require a significant amount of information regarding the disclosed patents and their relationship with the standard. ANSI is not aware of any other standards body that requires this level of detailed information because it can be very burdensome to provide and thus would discourage participation in the standards development activities. 附录中的表格，要求填写大量所披露专利的信息和其与标准的关系。ANSI 从未见过有任何其他标准组织要求如此详细的信息，提供如此繁复的信息会成为沉重的负担，从而削减参与标准制定活动的积极性。</p>

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3.0 Normative American National Standards Policies

Every ANSI-Accredited Standards Developer (ASD) shall comply with the normative policies contained in this section. The ASD may choose to: 1) include the text that follows, as appropriate, in its accredited procedures along with any additional information as required; or 2) submit to ANSI a written statement of full compliance with these policies in addition to policy statements that satisfy the requirements set-forth in this section.

3.1 ANSI patent policy - Inclusion of Patents in American National Standards

There is no objection in principle to drafting an American National Standard (ANS) in terms that include the use of an essential patent claim (one whose use would be required for compliance with that standard) if it is considered that technical reasons justify this approach.

If an ANSI-Accredited Standards Developer (ASD) receives a notice that a proposed ANS or an approved ANS may require the use of such a patent claim, the procedures in this clause shall be followed.

3.1.1 Statement from patent holder

The ASD shall receive from the patent holder or a party authorized to make assurances on its behalf, in written or electronic form, either:

(a) assurance in the form of a general disclaimer to the effect that such party does not hold and does not currently intend holding any essential patent claim(s); or

(b) assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard either:

- (i) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or
- (ii) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination.

3.1.2 Record of statement

A record of the patent holder's statement shall be retained in the files of both the ASD and ANSI.

3.1.3 Notice

When the ASD receives from a patent holder the assurance set forth in 3.1.1 b above, the standard shall include a note substantially as follows:

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

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

3.1.4 Responsibility for identifying patents

Neither the ASD nor ANSI is responsible for identifying patents for which a license may be required by an American National Standard or for conducting inquiries into the legal validity or scope of those patents that are brought to their attention.

Guidelines for Implementation of the ANSI Patent Policy

**An Aid to More Efficient and Effective
Standards Development In Fields That
May Involve Patented Technology**

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Updated September 2008 to reflect updates to the ANSI Patent Policy approved by the Patent Group and the IPRPC
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About the American National Standards Institute

ANSI is a nonprofit, privately funded membership organization that coordinates the development of U.S. voluntary national standards and is the U.S. member body to the International Organization for Standardization (ISO) and, via the United States National Committee (USNC), the International Electrotechnical Commission (IEC).

The Institute was founded in 1918, prompted by the need for an “umbrella” organization to coordinate the activities of the U.S. voluntary standards system and eliminate conflict and duplication in the development process. For over seventy years, this system has been successfully administered by the private sector, via ANSI, with the cooperation of federal, state and local governments. The Institute serves a diverse membership of over 1300 companies, 250 professional, technical, trade, labor and consumer organizations and some 30 government agencies. Standards exist in all industries, including safety and health, telecommunications, information processing, petroleum, medical devices, etc.

Some of the Institute's key functions include:

- Coordinating the self-regulating, due process consensus based U.S. voluntary standards system;
- Administering the development of standards and approving them as American National Standards;
- Providing the means for the U.S. to influence development of international and regional standards;
- Promoting awareness of the growing strategic significance of standards technology to U.S. global competitiveness.

I Purpose

These Guidelines are intended to assist voluntary standards developers, and those that participate in the standards development process, in understanding and implementing the ANSI Patent Policy (the “Patent Policy”, see Exhibit A). Drafted by a task force formed by ANSI for the purpose of studying the Patent Policy, the Guidelines seek to encourage the early disclosure and identification of patents that may relate to standards under development, so as to thereby promote greater efficiency in standards development practices.

By definition, guidelines are suggestions -- adherence is not essential for standards developers to be found in compliance with ANSI’s Patent Policy. Rather, this is an effort to identify possible procedures that a standards developer may wish to adopt, either in whole or in part, for purposes of effectively implementing the Patent Policy. Additional or different steps may also be selected for such purposes.

II An Overview of the ANSI Patent Policy

The Patent Policy is set forth in Section 3.1 of ANSI’s “Essential Requirements: Due process requirements for American National Standards” as approved by the ANSI Board of Directors (the “ANSI Essential Requirements”). Compliance (or non-compliance) with the Patent Policy is one of the criteria to be considered by ANSI’s Board of Standards Review (“BSR”) in determining whether to approve (or withdraw approval of) an American National Standard. See ANSI Essential Requirements, Section 4.2.

As set forth in the ANSI Procedures:

There is no objection in principle to drafting an American National Standard (“ANS”) in terms that include the use of an essential patent claim (one whose use would be required for compliance with that standard) if it is considered that technical reasons justify this approach. ANSI Essential Requirements, Section 3.1.

However, where a proposed ANS or an approved ANS may require the use of such patent claim, the procedures detailed in Sections 3.1 must be followed.

In particular, *the identified party or patent holder* must supply the ANSI-accredited standards developer (“ASD”) with either:

- (a) an assurance in the form of a general disclaimer to the effect that such party does not hold and does not anticipate holding any essential patent claim(s); or
- (b) an assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard, either:
 - (1) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or
 - (2) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination.

ANSI Essential Requirements, Section 3.1.1.

The Patent Holder’s statement of intent to comply shall be retained in the files of both the ASD and ANSI ANSI Essential Requirements, Section 3.1.2.

While ANSI’s counsel will verify that the information required from the patent holder has been supplied, counsel will not undertake to evaluate whether the terms and conditions satisfy the substantive test set forth in Section 3.1 (i.e. whether the terms and conditions are “reasonable” and/or “free of any unfair discrimination”). Such a decision is the exclusive province of the Board of Standards Review (or, on appeal, the ANSI Appeals Board) if the issue is raised during the approval process or in a petition for withdrawal of approval. In making its decision, the BSR shall consider all information of record it finds relevant.

Neither the standards developer submitting a standard for approval nor ANSI is responsible for identifying patents for which a license may be required by an American National

Standard or for conducting inquiries into the legal validity or scope of any patents brought to their attention. (ANSI Essential Requirements, Section 3.1.4.)

A standards developer seeking approval of a proposed American National Standard should take steps that it reasonably concludes are sufficient to permit a representation to ANSI that the Patent Policy has been met. In turn, ANSI, through its BSR, will take those steps that it reasonably concludes are sufficient to determine that the Patent Policy has been met based on the record before the BSR. Upon publication, the standard shall bear a notice in form specified in Section 3.1.3.

III Possible Procedures for Implementing the Policy

A Early Disclosure of Patent Rights

Experience has indicated that early disclosure of essential patents or essential patent claims is likely to enhance the efficiency of the process used to finalize and approve standards. Early disclosure permits notice of such patent claims to the standards developer and ANSI in a timely manner, provides participants the greatest opportunity to evaluate the propriety of standardizing the patented technology, and allows patent holders and prospective licensees ample time to negotiate the terms and conditions of licenses outside the standards development process itself.

Accordingly, during the development period, standards developers may wish to adopt procedures whereby one or more requests are made to participants for the disclosure of patents that may be required for use of standards in process. Such a request could be made, for example, by including it on letter ballots used in connection with the development of a proposed standard. Alternatively, other means could be adopted so that requests are repeated throughout the course of the standards development process – e.g., by a semi-annual notice mailed to each participant in the development process or appropriate working group(s).

This is not to suggest that a standards developer should require any participant in the development process to undertake a patent search of its own portfolio or of any other. The objective is to obtain early disclosure concerning the existence of patents, where known.

A standards developer may also consider taking steps to make it clear that any participant in the process -- not just patent holder -- is permitted to identify or disclose essential patents or essential patent claims that may be required for implementation of the standard. Generally, it is desirable to encourage disclosure of as much information as possible concerning the patent, including the identity of the patent holder, the patent's number, and information regarding precisely how it may relate to the standard being developed. Further, to assist in international standardization, a standards developer may deem it appropriate to encourage the disclosure of relevant unexpired foreign patents.

Similarly, a standards developer may wish to encourage participants to disclose the existence of pending U.S. patent applications relating to a standard under development. Of course, in such a situation the extent of any disclosure may be more circumscribed due to the possible need for confidentiality and uncertainty as to whether an application will mature into a patent and what its claimed scope will ultimately be.

B Early Indication of a Willingness to License

The early identification of relevant essential patents or essential patent claims should also increase the likelihood of an early indication from the patent holder that it is willing to license its invention, that it is prepared to do so on reasonable terms and conditions demonstrably free of unfair discrimination, or that the patent in question is not required for compliance with the proposed standard. A patent holder may have a strong incentive to provide an early assurance that the terms and conditions of the license will be reasonable and demonstrably free of unfair discrimination because of its inherent interest in avoiding any objection to the standardization of its proprietary technology. As a consequence, patent holders and prospective licensees would be provided greater opportunities to negotiate acceptable license terms.

It should be reiterated, however, that the determination of specific license terms and conditions, and the evaluation of whether such license terms and conditions are reasonable and demonstrably free of unfair discrimination, are not matters that are properly the subject of discussion or debate at a development meeting. Such matters

should be determined only by the prospective parties to each license or, if necessary, by an appeal challenging whether compliance with the Patent Policy has been achieved.

It should also be emphasized that, notwithstanding the incentive for patent holders to indicate any early willingness to license, it may not be possible for potential patent holders to give such an assurance until the standards development process has reached a relatively mature stage. It might be that only at that time will the patent holder be aware that its patent may be required for use of the proposed standard. This should not, however, preclude a patent holder from giving an assurance that *if* its patent is required for use of the standard it will license on reasonable terms and conditions demonstrably free of unfair discrimination.

Thus, standards developers may wish to adopt procedures that would permit and encourage the early indication by patent holders of their willingness to comply with the Patent Policy by providing one of the assurances specified therein. Such encouragement might take the form of simply advising participants in the development effort that assurances may be made at an early stage, explaining the advantages of early negotiations, or through other means. While participants in the standards development effort might consider a refusal to provide assurances (or a refusal to commit to offer acceptable licensing terms and conditions) as a ground for favoring an alternative technology, the patent holder is only required to provide assurances as called for by the Patent Policy.

C Subsequently Discovered Patents

The Patent Policy applies with equal force to situations involving (1) the discovery of essential patent claims that may be required for use of a standard subsequent to its adoption and (2) the initial issuance of a patent after adoption. Once disclosure is made, the holder is obligated to provide the same assurances to ASD as are required in situations where essential patent claims exist or are known prior to approval of a proposed standard as an American National Standard.

Thus, if notice is given of a patent that may be required for use of an already approved American National Standard, a standard developer may wish to make it clear to its

participants that the ANSI procedures require the patent holder to provide the assurances contained in the Patent Policy or suffer the withdrawal of ANSI's approval of the standard as an American National Standard.

IV Conclusion

Good standards development is often time consuming and demands considerable effort by those participating in the process. In fields that may involve the use of patented technology in a standard, therefore, it is particularly important that a patent holder's willingness and intention to comply with ANSI's Patent Policy be ascertained as soon as possible. Doing, so, however, does not require participants in standards development meetings to become involved in negotiating the terms and conditions of a possible license with the patent holder. To the contrary, what is required is the use of effective procedures designed to assure an understanding of the Patent Policy and to foster prompt compliance with it.

Exhibit A

ANSI Essential Requirements, Section 3.1

ANSI's Patent Policy

3.1 ANSI patent policy - Inclusion of Patents in American National Standards

There is no objection in principle to drafting an American National Standard (ANS) in terms that include the use of an essential patent claim (one whose use would be required for compliance with that standard) if it is considered that technical reasons justify this approach.

If an ANSI-Accredited Standards Developer (ASD) receives a notice that a proposed ANS or an approved ANS may require the use of such patent claim the procedures in this clause shall be followed.

3.1.1 Statement from patent holder

The ASD shall receive from the patent holder or a party authorized to make assurances on its behalf, in written or electronic form, either:

- (a) assurance in the form of a general disclaimer to the effect that such party does not hold and does not currently intend holding any essential patent claim(s); or
- (b) assurance that a license to such essential patent claim(s) will be made available to applicants desiring to utilize the license for the purpose of implementing the standard either:
 - (i) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or
 - (ii) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination.

3.1.2 Record of statement

A record of the patent holder's statement shall be placed and retained in the files of ASD and ANSI .

3.1.3 Notice

When the ASD receives from a patent holder the assurance set forth in 3.1.1 (b) above, the standard shall include a note as follows:

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

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

3.1.4 Responsibility for identifying patents

Neither the ASD nor ANSI is responsible for identifying patents for which a license may be required by an American National Standard or for conducting inquiries into the legal validity or scope of those patents that are brought to their attention.

