consortiums, conferences (and other parties I have been to)

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STY (Finnish Industrial Property Association) 28 September 2006
form of consortium

- professional body
  - IEEE (Institute of Electronic and Electrical Engineers)

- supra-national body
  - ETSI (EU - European Telecommunications Standards Institute)
  - 3GPP (3rd Generation Partnership Project - ETSI, TIA, TTA (Korea), ARIB (Jap) )
  - ISO (International Standards Organisation)

- national statutory body
  - TIA (US - Telecommunications Institute of America)
  - SFS (Finland – Finnish Standards Association)

- non-profit company
  - OMA (Open Mobile Alliance)
  - WiMax

- a bunch of guys on a listserv (who sometimes meet in San Diego)
  - IETF
documentation

- memorandum of association
- bylaws / constitution / articles of association
- membership agreement
- IPR policy
- anti-trust policy
- meeting procedures
check the documents

- obligations / liabilities / procedures are spread across different documents
- different consortiums have obligations / liabilities / procedures in different places
- need to check all of the documents to check fundamental issues
issues

- membership rights
- contributions
- specifications
- disclosure of IPR
- IPR licence mechanism
- terms of licence
- surviving obligations
bylaws

- membership class
- voting rights
  - specification
  - directors
  - winding up of consortium
- directors
  - elections
  - right to appoint
- notice for meetings
- termination of membership
contributions

- who can contribute?
  - anyone
  - members
  - premium members

- who has access to contributions
  - anyone
  - members
  - working group participants
  - premium members

- liability for contributions
  - indemnity for any IPR infringement
  - “as is”, no liability, no warranty

- rights in contribution
  - contributor retain
  - contributor assign copyright
  - contributor patents must be licensed

- confidentiality of contribution
specifications

- Review process
  - Working groups
  - All members

- Approval process
  - All members
  - Working group + board “rubber stamp”
  - Board

- Majority needed for approval
  - Simple majority
  - Special resolution (75%)
  - Consensus

- Confidentiality
  - Draft specification
  - Final specification
disclosure of patents / patent applications

- in own contribution
- in any contribution
- during review period of draft specification
- within period after specification approval
- only if want to opt-out of compulsory royalty free licence
- only if want to opt out of compulsory licence

- make sure have enough resources to check within review deadline!
IPR licence mechanism

- we just set the standards...no obligations
  - (may be patent pool supporting the specification)
- members may elect to licence
- all members required to license unless opt-out
- all members required to license to anyone implementing the specification
- to members
- to anyone / members subject to reciprocity
scope of licence

- Essential patents
- Necessary claims

- patents that are necessarily infringed by implementing the specification

- necessarily infringed
  - no commercially reasonable alternative
  - no technically reasonable alternative
  - based on state of technology / expertise when specification approved
terms of licence

- **RAND**
  - reasonable and non-discriminatory terms
- **FRAND**
  - fair, reasonable and non-discriminatory terms
- **RF**
  - royalty free terms
- **RF and RAND**
  - royalty free and otherwise on reasonable and non-discriminatory terms
surviving obligations

- copyright licence in contributions
- patent licence
  - in specifications approved before withdrawal
  - in contributions
  - in new specifications if participated in working group drafting the new specification
  - in new specifications if withdraw during review period
  - in new specifications that are backwards compatible with specifications approved before withdrawal
- confidentiality
- unpaid membership fees
further reading

- Design of Patent Pools (Lerner, Strojwas, Tirole)

- Toward Greater Clarity And Consistency In Patent Disclosure Policies In A Post-Rambus World (Nicos L Tsilas)
  http://jolt.law.harvard.edu/articles/pdf/v17/17HarvJLTech475.pdf

- Criteria for evaluating patent policy
  GTW Associates
  http://www.gtwassociates.com/answers/draftIPRcriteria.htm