

# **APT PATENT POLICY**

*Guideline 13 (MC-37, Vientiane, 2013)*

**Source Document: MC-37/OUT-05 (Rev.1)**

# APT PATENT POLICY<sup>1</sup>

Guideline 13 (MC-37, Vientiane, 2013)

The following is a "code of practice" regarding patents covering, in varying degrees, the subject matters of APT Recommendations (APT Recommendations are referred to as "Recommendations"). The rules of the "code of practice" are simple and straightforward. Recommendations are drawn up by technical and not patent experts; thus, they may not necessarily be very familiar with the complex international legal situation of intellectual property rights such as patents, etc.

Recommendations are non-binding; their objective is to ensure compatibility of technologies and systems on a worldwide basis. To meet this objective, which is in the common interests of all those participating, it must be ensured that Recommendations, their applications, use, etc. are accessible to everybody.

It follows, therefore, that a patent embodied fully or partly in a Recommendation must be accessible to everybody without undue constraints. To meet this requirement in general is the sole objective of the code of practice. The detailed arrangements arising from patents (licensing, royalties, etc.) are left to the parties concerned, as these arrangements might differ from case to case.

This code of practice may be summarized as follows:

1. The APT is not in a position to give authoritative or comprehensive information about evidence, validity or scope of patents or similar rights, but it is desirable that the fullest available information should be disclosed. Therefore, any party participating in the work of the APT should, from the outset, draw the attention of the Secretary General of the APT, to any known patent or to any known pending patent application, either their own or of other organizations, although the APT is unable to verify the validity of any such information.

2. If a Recommendation is developed and such information as referred to in paragraph 1 has been disclosed, three different situations may arise:

- 2.1 The patent holder is willing to negotiate licences free of charge with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside the APT.

- 2.2 The patent holder is willing to negotiate licences with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside the APT.

- 2.3 The patent holder is not willing to comply with the provisions of either paragraph 2.1 or paragraph 2.2; in such case, the Recommendation shall not include provisions depending on the patent.

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<sup>1</sup> The APT Patent Policy follows the "Common Patent Policy for ITU-T/ITU-R/ISO/IEC". The modifications were made only to the extent of adapting it to the APT context.

3. Whatever case applies (2.1, 2.2 or 2.3), the patent holder has to provide a written statement to be filed at APT Secretariat, using the appropriate "Patent Statement and Licensing Declaration" Form. This statement must not include additional provisions, conditions, or any other exclusion clauses in excess of what is provided for each case in the corresponding boxes of the form.

# GUIDELINES FOR IMPLEMENTATION OF THE APT PATENT POLICY<sup>2</sup>

## 1. PURPOSE

The purpose of these guidelines is to provide in simple words practical guidance to the participants in the Technical Bodies in case patent rights matters arise.

Considering that the technical experts are normally not familiar with the complex issue of patent law, the APT Patent Policy (hereafter referred to as the “Patent Policy”) was drafted in its operative part as a checklist, covering the three different cases which may arise if a Recommendation requires licenses for Patents to be practiced or implemented, fully or partly.

The Guidelines for Implementation of the APT Patent Policy (hereafter referred to as the “Guidelines”) are intended to clarify and facilitate implementation of the Patent Policy, a copy of which can be found in Annex 1 and also on the web site of the APT.

The Patent Policy encourages the early disclosure and identification of Patents that may relate to Recommendations under development. In doing so, greater efficiency in standards development is possible and potential patent rights problems can be avoided.

The APT should not be involved in evaluating patent relevance or essentiality with regards to Recommendations, interfere with licensing negotiations, or engage in settling disputes on Patents; this should be left to the parties concerned.

## 2. EXPLANATION OF TERMS

**Contribution:** Any document submitted for consideration by a Technical Body.

**Free of charge:** The words “Free of Charge” do not mean that the Patent Holder is waiving all of its rights with respect to the Patent. Rather, “Free of Charge” refers to the issue of monetary compensation; *i.e.*, that the Patent Holder will not seek any monetary compensation as part of the licensing arrangement (whether such compensation is called a royalty, a one-time licensing fee, etc.). However, while the Patent Holder in this situation is committing to not charging any monetary amount, the Patent Holder is still entitled to require that the implementer of the relevant Recommendation sign a license agreement that contains other reasonable terms and conditions such as those relating to governing law, field of use, warranties, etc.

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<sup>2</sup> The Guidelines for Implementation of the APT Patent Policy follow the “Guidelines for Implementation of the Common Patent Policy for ITU-T/ITU-R/ISO/IEC” of 2012 version. The modifications were made only to the extent of adapting those to the APT context.

**Patent:** The word “Patent” means those claims contained in and identified by patents, utility models and other similar statutory rights based on inventions (including applications for any of these) solely to the extent that any such claims are essential to the implementation of a Recommendation. Essential patents are patents that would be required to implement a specific Recommendation.

**Patent Holder:** Person or entity that owns, controls and/or has the ability to license Patents.

**Reciprocity:** The word “Reciprocity” means that the Patent Holder shall only be required to license any prospective licensee if such prospective licensee will commit to license its Patent(s) for implementation of the same relevant Recommendation Free of Charge or under reasonable terms and conditions.

**Recommendations:** APT Recommendations are referred to as “Recommendations”.

**Technical Bodies:** ASTAP, AWG and other Work Programs of the APT.

### **3. PATENT DISCLOSURE**

As mandated by the Patent Policy in its paragraph 1, any party participating in the work of the APT should, from the outset, draw their attention to any known Patent or to any known pending Patent application, either its own or that of other organizations.

In this context, the words “from the outset” imply that such information should be disclosed as early as possible during the development of the Recommendation. This might not be possible when the first draft text appears since at this time, the text might be still too vague or subject to subsequent major modifications. Moreover, that information should be provided in good faith and on a best effort basis, but there is no requirement for patent searches.

In addition to the above, any party not participating in Technical Bodies may draw the attention of the APT to any known Patent, either their own and/or of any third-party.

When disclosing their own Patents, Patent Holders have to use the Patent Statement and Licensing Declaration Form (referred to as the “Declaration Form”) as stated in Section 4 of these Guidelines.

Any communication drawing the attention to any third-party Patent should be addressed to the APT in writing. The potential Patent Holder will then be requested by the APT to submit a Declaration Form, if applicable.

The Patent Policy and these Guidelines also apply to any Patent disclosed or drawn to the attention of the APT subsequent to the approval of a Recommendation.

Whether the identification of the Patent took place before or after the approval of the Recommendation, if the Patent Holder is unwilling to license under paragraph 2.1 or 2.2 of the Patent Policy, the APT will promptly advise the Technical Bodies responsible for the affected Recommendation so that appropriate action can be taken. Such action will include, but may not be limited to, a review of the Recommendation or its draft in order to remove the potential conflict or to further examine and clarify the technical considerations causing the conflict.

## **4. PATENT STATEMENT AND LICENSING DECLARATION FORM**

### **4.1 The purpose of the Declaration Form**

To provide clear information in the Patent Information databases of the APT, Patent Holders have to use the Declaration Form, which is available on the web site of the APT (the Declaration Form is included in Annex 2 for information purposes). They must be sent to the APT for the attention of the Secretary General of the APT. The purpose of the Declaration Form is to ensure a standardized submission to the APT of the declarations being made by Patent Holders.

The Declaration Form gives Patent Holders the means of making a licensing declaration relative to rights in Patents required for implementation of a specific Recommendation. Specifically, by submitting this Declaration Form the submitting party declares its willingness to license (by selecting option 1 or 2 on the Form) / or its unwillingness to license (by selecting option 3 on the Form), according to the Patent Policy, Patents held by it and whose license would be required to practice or implement part(s) or all of a specific Recommendation.

If a Patent Holder has selected the licensing option 3 on the Declaration Form, then, for the referenced relevant Recommendation, the APT requires the Patent Holder to provide certain additional information permitting patent identification. Multiple Declaration Forms are appropriate if the Patent Holder wishes to identify several Patents and classifies them in different options of the Declaration Form for the same Recommendation or if the Patent Holder classifies different claims of a complex patent in different options of the Declaration Form.

Information contained in a Declaration Form may be corrected in case of obvious errors, such as a typographical mistake in a standard or patent reference number. The licensing declaration contained in the Declaration Form remains in force unless it is superseded by another Declaration Form containing more favourable licensing terms and conditions from a licensee's perspective reflecting (a) a change in commitment from option 3 to either option 1 or option 2, (b) a change in commitment from option 2 to option 1 or (c) un-checking one or more sub-options contained within option 1 or 2.

### **4.2 Contact information**

In completing Declaration Forms, attention should be given to supplying contact information that will remain valid over time. Where possible, the "Name and Department" and e-mail address should be generic. Also it is preferable, where possible, that parties, particularly multinational organizations, indicate the same contact point on all Declaration Forms submitted.

With a view to maintaining up-to-date information in the Patent Information database of the APT, it is requested that the APT be informed of any change or corrections to the Declaration Form submitted in the past, especially with regard to the contact person.

## **5. CONDUCT OF MEETINGS**

Early disclosure of Patents contributes to the efficiency of the process by which Recommendations are established. Therefore, each Technical Body, in the course of the

development of a proposed Recommendation, will request the disclosure of any known Patents essential to the proposed Recommendation.

Chairmen of Technical Bodies will, if appropriate, ask, at an appropriate time in each meeting, whether anyone has knowledge of patents, the use of which may be required to practice or implement the Recommendation being considered. The fact that the question was asked shall be recorded in the meeting report, along with any affirmative responses.

As long as the APT has received no indication of a Patent Holder selecting paragraph 2.3 of the Patent Policy, the Recommendation may be approved using the appropriate and respective rules of the APT. It is expected that discussions in Technical Bodies will include consideration of including patented material in a Recommendation, however the Technical Bodies may not take position regarding the essentiality, scope, validity or specific licensing terms of any claimed Patents.

## **6. PATENT INFORMATION DATABASE**

In order to facilitate both the standards-making process and the application of Recommendations, the APT makes available to the public a Patent Information database composed of information that was communicated to the APT by the means of Declaration Forms. The Patent Information database may contain information on specific patents, or may contain no such information but rather a statement about compliance with the Patent Policy for a particular Recommendation.

The Patent Information databases are not certified to be either accurate or complete, but only reflect the information that has been communicated to the APT. As such, the Patent Information databases may be viewed as simply raising a flag to alert users that they may wish to contact the entities who have communicated Declaration Forms to the APT in order to determine if patent licenses must be obtained for use or implementation of a particular Recommendation.

## **7. ASSIGNMENT OR TRANSFER OF PATENT RIGHTS**

In the event a Patent Holder participating in the work of the APT assigns or transfers ownership or control of Patents for which the Patent Holder reasonably believes it has made a license undertaking to the APT, the Patent Holder shall make reasonable efforts to notify such assignee or transferee of the existence of such license undertaking. In addition, if the Patent Holder specifically identified patents to the APT, then the Patent Holder shall have the assignee or transferee agree to be bound by the same licensing commitment as the Patent Holder for the same patent. If the Patent Holder did not specifically identify the patents in question to the APT, then it shall use reasonable efforts (but without requiring a patent search) to have the assignee or transferee to agree to be so bound. By complying with the above, the Patent Holder has discharged in full all of its obligations and liability with regards to the licensing commitments after the transfer or assignment. This paragraph is not intended to place any duty on the Patent Holder to compel compliance with the licensing commitment by the assignee or transferee after the transfer occurs.

## **8. GENERAL PATENT STATEMENT AND LICENSING DECLARATION FORM**

Anyone may submit a General Patent Statement and Licensing Declaration Form which is available on the web sites of the APT (the form in Annex 3 is included for information purposes). The purpose of this form is to give Patent Holders the voluntary option of making a general licensing declaration relative to material protected by Patents contained in any of their Contributions. Specifically, by submitting its form, the Patent Holder declares its willingness to license its Patents owned by it in case part(s) or all of any proposals contained in its Contributions submitted to the APT are included in Recommendation(s) and the included part(s) contain items for which Patents have been filed and whose license would be required to practice or implement Recommendation(s).

The General Patent Statement and Licensing Declaration Form is not a replacement for the "individual" (see clause 4) Declaration Form, which is made per Recommendation, but is expected to improve responsiveness and early disclosure of the Patent Holder's compliance with the Patent Policy. Therefore, in addition to its existing General Patent Statement and Licensing Declaration in respect of its Contributions, the Patent Holder should, when appropriate (e.g. if it becomes aware that it has a Patent for a specific Recommendation), also submit an "individual" Patent Statement and Licensing Declaration Form:

- for the Patents contained in any of its Contributions submitted to the APT which are included in a Recommendation, any such "individual" Patent Statement and Licensing Declarations may contain either the same licensing terms and conditions as in the General Patent Statement and Licensing Declaration Form, or more favourable licensing terms and conditions from a licensee's perspective as defined in the "individual" (see clause 4.1) Declaration Form; and
- for the Patents that the Patent Holder did not contribute to the APT which are included in a Recommendation, any such "individual" Patent Statement and Licensing Declarations may contain any of the three options available on the Form (see clause 4.1), regardless of the commitment in its existing General Patent Statement and Licensing Declaration.

The General Patent Statement and Licensing Declaration remains in force unless it is superseded by another General Patent Statement and Licensing Declaration form containing more favourable licensing terms and conditions from a licensee's perspective reflecting (a) a change in commitment from option 2 to option 1 or (b) un-checking one or more sub-options contained within option 1 or 2. The APT Patent Information database also contains a record of General Patent Statement and Licensing Declarations.

## **9. NOTIFICATION**

Text shall be added to the cover sheets of all new and revised APT Recommendations, where appropriate, urging users to consult the APT Patent Information database. The wording is:

"The APT draws attention to the possibility that the practice or implementation of this Recommendation may involve the use of a claimed Intellectual Property Right. The APT takes no position concerning the evidence, validity or applicability of claimed Intellectual



Property Rights, whether asserted by the APT members or others outside of the Recommendation development process.

As of the date of approval of this Recommendation, the APT [had/had not] received notice of intellectual property, protected by patents, which may be required to implement this Recommendation. However, implementers are cautioned that this may not represent the latest information and are therefore strongly urged to consult the APT Patent Information database.”

## ANNEX 1

### APT PATENT POLICY<sup>3</sup>

The following is a "code of practice" regarding patents covering, in varying degrees, the subject matters of APT Recommendations (APT Recommendations are referred to as "Recommendations"). The rules of the "code of practice" are simple and straightforward. Recommendations are drawn up by technical and not patent experts; thus, they may not necessarily be very familiar with the complex international legal situation of intellectual property rights such as patents, etc.

Recommendations are non-binding; their objective is to ensure compatibility of technologies and systems on a worldwide basis. To meet this objective, which is in the common interests of all those participating, it must be ensured that Recommendations, their applications, use, etc. are accessible to everybody.

It follows, therefore, that a patent embodied fully or partly in a Recommendation must be accessible to everybody without undue constraints. To meet this requirement in general is the sole objective of the code of practice. The detailed arrangements arising from patents (licensing, royalties, etc.) are left to the parties concerned, as these arrangements might differ from case to case.

This code of practice may be summarized as follows:

1. The APT is not in a position to give authoritative or comprehensive information about evidence, validity or scope of patents or similar rights, but it is desirable that the fullest available information should be disclosed. Therefore, any party participating in the work of the APT should, from the outset, draw the attention of the Secretary General of the APT to any known patent or to any known pending patent application, either their own or of other organizations, although the APT is unable to verify the validity of any such information.
2. If a Recommendation is developed and such information as referred to in paragraph 1 has been disclosed, three different situations may arise:
  - 2.1 The patent holder is willing to negotiate licenses free of charge with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside the APT.
  - 2.2 The patent holder is willing to negotiate licenses with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside the APT.
  - 2.3 The patent holder is not willing to comply with the provisions of either paragraph 2.1 or paragraph 2.2; in such case, the Recommendation shall not include provisions depending on the patent.

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<sup>3</sup> The APT Patent Policy follows the "Common Patent Policy for ITU-T/ITU-R/ISO/IEC". The modifications were made only to the extent of adapting it to the APT context.

3. Whatever case applies (2.1, 2.2 or 2.3), the patent holder has to provide a written statement to be filed at the APT Secretariat, using the appropriate "Patent Statement and Licensing Declaration" Form. This statement must not include additional provisions, conditions, or any other exclusion clauses in excess of what is provided for each case in the corresponding boxes of the form.

ANNEX 2

PATENT STATEMENT AND LICENSING DECLARATION FORM FOR APT  
RECOMMENDATION



**Patent Statement and Licensing Declaration  
for APT Recommendation**

*This declaration does not represent an actual grant of a license*

Please return to the following per recommendation:

Secretary General  
Asia-Pacific Telecommunity  
12/49, Soi 5 Chaengwattana Road  
Bangkok 10210  
Thailand  
Fax: +66 2 573 7479 Email: aptmail@apt.int

**Patent Holder:**

Legal Name \_\_\_\_\_

**Contact for license application:**

Name & \_\_\_\_\_

Department \_\_\_\_\_

Address \_\_\_\_\_

\_\_\_\_\_

Tel. \_\_\_\_\_

Fax \_\_\_\_\_

E-mail \_\_\_\_\_

URL (optional) \_\_\_\_\_

**Recommendation:**

(\*)Number \_\_\_\_\_

(\*)Title \_\_\_\_\_

**Licensing declaration:**

The Patent Holder believes that it holds granted and/or pending applications for Patents, the use of which would be required to implement the above document and hereby declares, in accordance with the APT Patent Policy, that (check one box only):

1. The Patent Holder is prepared to grant a Free of Charge license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and under other reasonable terms and conditions to make, use, and sell implementations of the above document.

Negotiations are left to the parties concerned and are performed outside the APT.

*Also mark here \_\_ if the Patent Holder's willingness to license is conditioned on Reciprocity for the above document.*

*Also mark here \_\_ if the Patent Holder reserves the right to license on reasonable terms and conditions (but not Free of Charge) to applicants who are only willing to*

*license their Patent, whose use would be required to implement the above document, on reasonable terms and conditions (but not Free of Charge).*

2. The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the above document.

Negotiations are left to the parties concerned and are performed outside the APT.

*Also mark here \_\_\_ if the Patent Holder's willingness to license is conditioned on Reciprocity for the above document.*

3. The Patent Holder is unwilling to grant licenses in accordance with provisions of either 1 or 2 above.

In this case, the following information must be provided to the APT, as part of this declaration:

- granted patent number or patent application number (if pending);
- an indication of which portions of the above document are affected;
- a description of the Patents covering the above document.

Free of Charge: The words "Free of Charge" do not mean that the Patent Holder is waiving all of its rights with respect to the Patent. Rather, "Free of Charge" refers to the issue of monetary compensation; *i.e.*, that the Patent Holder will not seek any monetary compensation as part of the licensing arrangement (whether such compensation is called a royalty, a one-time licensing fee, etc.). However, while the Patent Holder in this situation is committing to not charging any monetary amount, the Patent Holder is still entitled to require that the implementer of the same above document sign a license agreement that contains other reasonable terms and conditions such as those relating to governing law, field of use, warranties, etc.

Reciprocity: The word "Reciprocity" means that the Patent Holder shall only be required to license any prospective licensee if such prospective licensee will commit to license its Patent(s) for implementation of the same above document Free of Charge or under reasonable terms and conditions.

Patent: The word "Patent" means those claims contained in and identified by patents, utility models and other similar statutory rights based on inventions (including applications for any of these) solely to the extent that any such claims are essential to the implementation of the same above document. Essential patents are patents that would be required to implement a specific Recommendation.

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**Patent Information** (desired but not required for options 1 and 2; required for option 3 (NOTE))

No.	Status [granted/ pending]	Country	Granted Patent Number or Application Number (if pending)	Title
1				
2				
3				

Check here if additional patent information is provided on additional pages.

NOTE: For option 3, the additional minimum information that shall also be provided is listed in the option 3 box above.

**Signature (include on final page only):**

Patent Holder \_\_\_\_\_

Name of authorized person \_\_\_\_\_

Title of authorized person \_\_\_\_\_

Signature \_\_\_\_\_

Place, Date \_\_\_\_\_

ANNEX 3

GENERAL PATENT STATEMENT AND LICENSING DECLARATION FORM FOR  
APT RECOMMENDATION



**General Patent Statement and Licensing Declaration**  
**for APT Recommendation**

*This declaration does not represent an actual grant of a license*

Please return to the following:

Secretary General  
Secretariat  
Asia-Pacific Telecommunity  
12/49, Soi 5 Chaengwattana Road  
Bangkok 10210  
Thailand  
Fax: +66 2 573 7479  
Email: aptmail@apt.int

**Patent Holder:**

Legal Name \_\_\_\_\_  
**Contact for license application:**  
Name & \_\_\_\_\_  
Department \_\_\_\_\_  
Address \_\_\_\_\_  
\_\_\_\_\_

Tel. \_\_\_\_\_  
Fax \_\_\_\_\_  
E-mail \_\_\_\_\_  
URL (optional) \_\_\_\_\_

**Licensing declaration:**

In case part(s) or all of any proposals contained in Contributions submitted by the Patent Holder above are included in APT Recommendation(s) and the included part(s) contain items for which Patents have been filed and whose use would be required to implement APT Recommendation(s), the above Patent Holder hereby declares, in accordance with the APT Patent Policy (check one box only):

1. The Patent Holder is prepared to grant a Free of Charge license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and under other reasonable terms and conditions to make, use, and sell implementations of the relevant APT

Recommendation.

Negotiations are left to the parties concerned and are performed outside the APT.

Also mark here \_\_\_ if the Patent Holder's willingness to license is conditioned on Reciprocity for the above APT Recommendation.

Also mark here \_\_\_ if the Patent Holder reserves the right to license on reasonable terms and conditions (but not Free of Charge) to applicants who are only willing to license their patent claims, whose use would be required to implement the above APT Recommendation, on reasonable terms and conditions (but not Free of Charge).

2. The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the relevant APT Recommendation.

Negotiations are left to the parties concerned and are performed outside the APT.

Also mark here \_\_\_ if the Patent Holder's willingness to license is conditioned on Reciprocity for the above APT Recommendation.

Free of Charge: The words "Free of Charge" do not mean that the Patent Holder is waiving all of its rights with respect to the Patent. Rather, "Free of Charge" refers to the issue of monetary compensation; *i.e.*, that the Patent Holder will not seek any monetary compensation as part of the licensing arrangement (whether such compensation is called a royalty, a one-time licensing fee, etc.). However, while the Patent Holder in this situation is committing to not charging any monetary amount, the Patent Holder is still entitled to require that the implementer of the relevant APT Recommendation sign a license agreement that contains other reasonable terms and conditions such as those relating to governing law, field of use, warranties, etc.

Reciprocity: The word "Reciprocity" means that the Patent Holder shall only be required to license any prospective licensee if such prospective licensee will commit to license its Patent(s) or essential patent claim(s) for implementation of the relevant APT Recommendation Free of Charge or under reasonable terms and conditions.

Patent: The word "Patent" means those claims contained in and identified by patents, utility models and other similar statutory rights based on inventions (including applications for any of these) solely to the extent that any such claims are essential to the implementation of the relevant Recommendation. Essential patents are patents that would be required to implement a specific Recommendation.

**Signature:**

Patent Holder

Name of authorized  
person

Title of authorized  
person

Signature

Place, Date

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