



SMPTE Standards Administrative Guideline AG-08 Patent Statement

Effective January 31, 2015

Approved December 22, 2014

This Standards Administrative Guideline forms an adjunct to the use and interpretation of the SMPTE Standards Operations Manual. In the event of a conflict, the Operations Manual shall prevail.

1. Purpose:

This Administrative Guideline sets forth the Patent Statement that must be completed to accompany submission of a draft Engineering document, or in response to a Patent inquiry concerning a proposed SMPTE Engineering Document.

2. Intellectual Property Policy

In accordance with the provisions of section 9.1 of the SMPTE Standard Operation Manual (available at <https://www.smpete.org/about/policies-and-governance>), a completed SMPTE Patent Statement is required when a draft new Engineering Document is submitted to SMPTE on behalf of a company or other outside organization. Additionally, following the notice of possible Essential Claims, the Director of Engineering shall perform a Patent Inquiry, requesting the reported owner of the intellectual property in question to complete a SMPTE Patent Statement if the owner considers that it does own or control patents or pending applications likely to include Essential Claims for implementation or use of the Engineering Document.

Patent statements shall be submitted on the form in Annex B.

For the convenience of the person completing this Patent Statement, section 9.1 of the Standards Operation Manual (version 3), which is in force as of January 31, 2015, is reproduced in Annex A.

Annex A: Intellectual Property Policy

(copied in its entirety from the Standards Operation Manual, in force as of January 31, 2015)

9. Intellectual Property & Confidentiality Policy

9.1. Patent Policy

Engineering Documents may include technology that is subject to Essential Claims (see section 9.1.2) but only if all known patent holders are prepared to agree to terms that are “Reasonable and Non-Discriminatory” (RAND) for all Essential Claims. All Engineering Committees and Groups, as described in section 3, are entitled to give preference to technologies that are believed to be free of Essential Claims or for which a free-of-charge license will be available, provided any such solution is believed to be technically adequate. A Committee shall not discuss or otherwise consider specific licensing terms for such technologies.

It is important that, whenever possible, Committees are able to make a choice of technology based on all relevant information, including the existence, or potential existence, of any Essential Claims that may encumber a technology under consideration.

This Policy imposes an obligation on all Committee Participant Members and Observer Members (Members) and Guests, in accordance with section 9.1.4, to notify the Technology Committee Chair, as early as possible in the development process if they are aware, based on their actual personal knowledge, of patents or patent applications, anywhere in the world, that might contain Essential Claims to a technology being proposed for inclusion in an Engineering Document.

9.1.1. Notice to Meetings

At the start of each meeting the Chair shall read a statement in a form approved by the Standards Committee reminding Members and Guests of the obligations imposed by this Policy.

9.1.2. Essential Claims

An Essential Claim is “essential” to an Engineering Document only if it is necessarily infringed by implementing the Normative Text of that Engineering Document and is “necessarily infringed” only when there is no commercially-reasonable non-infringing alternative for implementing the Engineering Document. Essential Claims to an Engineering Document exclude those essential to enabling technologies, which are those technologies that may be necessary to make or use any implementations but are not expressly set forth in the Engineering Document. Essential Claims to an Engineering Document also exclude claims essential to any Normative Reference included in the Engineering Document.

9.1.3. Patent Statement to Accompany Engineering Document Submission from External Organizations

A completed SMPTE Patent Statement is required when a draft new Engineering Document is submitted to SMPTE on behalf of a company or other outside organization. The Patent Statement shall be made by the company or organization using the form approved by the Standards Committee and shall include the information required on that form.

A Technology Committee may agree by Administrative Vote to consider a draft document, or contribution to a draft document, without a Patent Statement, provided assurance is received from the submitter that the Patent Statement will be provided within 45 days. If no Patent Statement is received within 45 days of the submission, the Technology Committee Chair shall inform the Standards Vice President, who may suspend work on the submission.

A Member or Guest making any contribution to the Normative Text of a proposed Engineering Document shall provide any declaration required under Section 9.1.4.

9.1.4. Declaration of Knowledge of Relevant Intellectual Property

This Policy imposes an obligation on all Members and Guests to notify the Technology Committee Chair, as early as possible in the development process, if they are aware, based on their actual personal knowledge, of patents or patent applications that might contain Essential Claims to a technology being proposed for inclusion in an Engineering Document.

The requirement to notify the Technology Committee Chair of actual personal knowledge of actual or potential Essential Claims is an ongoing obligation that begins with becoming a Participant Member or Observer Member of a Technology Committee, or attending a meeting as a Guest, and continues through any form of participation in the work or proceedings of the Technology Committee, including any form of participation by electronic means such as receipt of emails. Any required notice shall be given as soon as practically possible and in all cases shall be given within 45 days after the knowledge is obtained and in advance of any vote on the Engineering Document. The notice shall be either in the form of a verbal statement at a meeting, which shall be recorded in the minutes of the meeting, or in written form to the Chair of the responsible Technology Committee. The notice shall include all relevant information available to the Member or Guest, such as patent or application number(s) and owner of the intellectual property, and shall identify the part(s) of the Engineering Document believed to be subject to Essential Claims.

The receipt of such a notice shall create a Technology Committee action item for the Director of Engineering, who shall follow the procedures of section 9.1.5 to solicit a Patent Statement from the reported owner of the intellectual property.

This Policy does not require any patent search and specifically recognizes that sponsorship of a Member or Guest does not create any obligation to perform a patent search.

This Policy recognizes that all Members and Guests act as individuals and that obligations imposed by this Operations Manual apply to the Member or Guest rather than to any sponsoring organization. For this reason, the obligation to disclose is created by the actual personal knowledge of the Member or Guest and applies to any potential Essential Claims known to the Member or Guest, whether or not the patent or patent application is owned by a sponsor. Nothing in this Policy shall impute knowledge of a Member or Guest by reason of employment, sponsorship, or any other association or connection with a patent applicant or holder.

This Policy does not require a Member or Guest to form a legal opinion as to the applicability or enforceability of Essential Claims, but does require a disclosure if the Member or Guest has actual personal knowledge of a patent or patent application that, in the good faith judgment of the Member or Guest, is likely to include Essential Claims to implementation of the proposed Engineering Document.

It is recognized that, on occasion, this obligation may conflict with terms of employment or contractual agreements. Members and Guests shall use reasonable efforts to obtain clearance to declare any relevant Essential Claims. No Member may support the adoption of an Engineering Document or technology while knowing or believing that undeclared Essential Claims exist. A Member or Guest who cannot obtain clearance to reveal an Essential Claim shall notify the Technology Committee Chair that s/he will cease to participate in discussion of, and withdraw from all Ballots concerning, the proposed document.

9.1.5. Inquiry to Possible Patent Holders

Following notice of possible Essential Claims, the Director of Engineering shall perform a Patent Inquiry, requesting the reported owner of the intellectual property in question to complete a SMPTE Patent Statement if the owner considers that it does own or control patents or pending applications likely to include Essential Claims for implementation or use of the Engineering Document. The Patent Statement, in a form approved by the Standards Committee, shall identify whether licensing of any Essential Claims would be available under RAND terms.

If no reply is received within 30 days, the Director of Engineering shall repeat the Patent Inquiry. If no reply is received within a further 30 days, the Director of Engineering shall report this to the Technology Committee and no further correspondence with the entity shall be required.

9.1.6. Conduct of Ballots, Votes and Audits with Associated IP Statements

When an Engineering Document is Balloted for elevation to FCD, the Director of Engineering shall issue, in conjunction with the Ballot notification, a "Call for Patents" in a form approved by the Standards Committee. The FCD Ballot shall reference any Patent Statements already submitted with respect to the proposed Engineering Document. If a notice of possible Essential Claims has been made as described in section 9.1.4, and if the Director of Engineering has not received an affirmative response to the Patent Inquiry described in section 9.1.5, then the Director of Engineering shall post a Comment against the FCD Ballot regarding the outstanding Patent Inquiry.

Receipt of a statement in response to a Patent Inquiry shall be noted as a Comment response and shall resolve the Comment unless the Patent Statement indicates that Essential Claims exist and that there is no RAND assurance. If any entity provides a completed Patent Statement that indicates Essential Claims exist and that there is no RAND assurance, the Technology Committee may either revise the Engineering Document to exclude the protected technology or terminate work on the Engineering Document. If the Technology Committee considers that the completed Patent Statement may be frivolous or invalid it may choose to seek the direction of the Standards Committee. If any entity has failed to respond to a Patent Inquiry and there is no suitable alternative technology, these facts shall be noted as a Comment response, and the Technology Committee may choose to retain the technology in question by conducting a Disposition Vote on the Comment.

All relevant Patent Statements, Patent Inquiries, and Disposition Votes shall be part of the Standards Committee Audit.

9.1.7. Patent Statement in Published Documents

All published Engineering Documents shall include an appropriate statement, in a form approved by the Standards Committee; calling attention to the possibility that implementation of the Engineering Document may require the use of Essential Claims.

9.1.8. Transfers of Essential Claims

(a) Each party submitting a Patent Statement shall agree that it will not transfer, and confirm that it has not transferred, ownership in patents or patent applications having Essential Claims for the purpose of circumventing such party's obligations under this Policy.

(b) Licensing undertakings made pursuant to this Policy shall be interpreted as encumbrances that bind all successors-in-interest. Recognizing that this interpretation may not be enforceable in all legal jurisdictions, any party who has submitted a licensing undertaking according to this Policy who transfers ownership of any patent or patent application having Essential Claims subject to such undertaking shall include appropriate provisions in the relevant transfer documents to ensure that the undertaking is binding on the transferee and that the transferee will similarly include appropriate provisions in the event of future transfers with the goal of binding all successors-in-interest. The undertaking shall be interpreted as binding on successors-in-interest regardless of whether such provisions are included in the relevant transfer documents.

9.1.9. Essential Claims Revealed After Publication

In the event that an Essential Claim is first revealed by a Member or Guest following adoption and publication of a Engineering Document, the owner or controller of the Essential Claim shall be asked to make a licensing commitment to the Essential Claim in the same manner as if it related to technology proposed for adoption by such Member or Guest during the development of the Engineering Document in question. If such request is refused, the Engineering Document in question shall be referred back to the relevant Technology Committee for consideration and possible action.

9.1.10. Irrevocability and Binding Nature of Commitments

All commitments made under this Policy shall be irrevocable, except that the owner of an Essential Claim may include a “reciprocity” or “defensive suspension” term in a license to its Essential Claims. For purposes of this policy, (a) reciprocity shall mean that a licensor may require a licensee to provide a reciprocal RAND license with respect to any Essential Claim(s) owned by the licensee with respect to the same Engineering Document, and (b) defensive suspension shall mean that a licensor may revoke a license granted to an implementer if that implementer asserts an Essential Claim (other than under RAND license terms) in connection with the same Engineering Document against the licensor or its Affiliates.

An Affiliate of a party shall mean a company or other legal entity which now or, hereafter, controls or is controlled by or is under common control with such party, but any such company or other legal entity shall be deemed to be an Affiliate only as long as such control exists, and for the purposes of this definition, “control” shall mean direct or indirect ownership of more than 50% of the voting power, capital or other securities of the controlled or commonly controlled entity.

9.1.11. Third Party Beneficiaries

In the event that any party brings an infringement action against an implementer of an Engineering Document relating to an Essential Claim(s) under such document with respect to which such Essential Claim owner is under a licensing obligation under this Policy, SMPTE shall have no obligation to intervene, but such implementer shall be entitled to assert that it is a third party beneficiary under such licensing obligation.

9.1.12. Survival of Obligations

(a) Any disclosure or other obligation that any Member or Guest incurs under this Policy shall continue in force after the Member ceases to be a Member, or the Guest ceases to be a participant, for any reason. However, no Member or Guest shall become subject to any new obligation under this Policy after ceasing to be a Member or Guest.

(b) Any licensing obligation incurred by any party under this policy shall continue in force until the expiration of all Patents that include Essential Claims and shall be binding upon successors of ownership and control as specified in 9.1.8.

(c) All persons and entities that are intended third party beneficiaries of rights and obligations incurred under this Policy shall remain entitled to enforce the same, notwithstanding any termination, dissolution or winding up of SMPTE.

Annex B: Patent Statement Declaration With Respect to SMPTE Engineering Documents

To accompany submission of a draft document

In response to an inquiry concerning a proposed SMPTE Engineering Document.

SMPTE Document Number and Title or other identifier: _____

Paragraphs related to this Statement: _____

Note that SMPTE Intellectual Property Policy does not require a patent search, and that no statement on this form shall make or imply any warranty of patent coverage, validity, or enforceability.

Submitter identified below hereby declares, in accordance with the SMPTE Patent Policy, that:

<p>A1. <input type="checkbox"/></p>	<p>No Claimed Patents</p> <p>Submitter is not aware of holding or controlling any patents, and/or applications for patents, that contain Essential Patent Claims, as defined in the SMPTE Intellectual Property Policy, the use of which would be necessary to implement the above-named document.</p> <p>Submitter, nevertheless, is required also to select an option from section B on an irrevocable basis in the event Essential Patent Claims are later discovered to be in Submitter's possession on the date of this declaration.</p>
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<p>A2. <input type="checkbox"/></p>	<p>Claimed Patents</p> <p>Submitter believes that it holds or controls patents, and/or applications for patents, that contain Essential Patent Claims, the use of which would be necessary to implement the above document. Submitter will provide within 45 days sufficient information to identify its patent claims from issued patents and patent applications and the part(s) of the submitted document covered by those patents. Submitter hereby declares, in accordance with the SMPTE Patent Policy, that (check <u>one</u> box, B1 or B2 only):</p>
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And Submitter further declares, in accordance with the SMPTE Patent Policy, that:

<p>B1. <input type="checkbox"/></p>	<p>Licensing Free of Charge</p> <p>Submitter is prepared to grant a <u>free of charge</u> license to its Essential Patent Claims in the above document to an unrestricted number of applicants on a worldwide, non-discriminatory basis and under other reasonable and non-discriminatory terms and conditions to make, use, and sell implementations that conform to the above document.</p> <p>Negotiations are left to the parties concerned and are performed outside SMPTE.</p> <p><i>Also mark here <input type="checkbox"/> if the Patent Holder's willingness to license is conditioned on reciprocity for the above document.</i></p> <p><i>Also mark here <input type="checkbox"/> if the Patent Holder reserves the right to license on reasonable and non-discriminatory 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 same above document, on reasonable terms and conditions (but not free of charge).</i></p> <p><i>Reciprocity: Notwithstanding the commitment above, Submitter is entitled to license on reasonable and non-discriminatory terms and conditions (but not <u>free of charge</u>) applicants who are only willing to license their patent claims, whose use would be required to implement the same above document, on reasonable and non-discriminatory terms and conditions (but not <u>free of charge</u>).</i></p> <p><i>Free of charge: The words "free of charge" do not mean that the Submitter is waiving all of its rights with respect to the essential patent. Rather, "free of charge" refers to the issue of monetary compensation; i.e., that Submitter 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 Submitter in this situation is committing to not charging any monetary amount, Submitter is still entitled to require that the implementer of the above document sign a license agreement that contains other reasonable terms and conditions such as those relating to governing law, field of use, reciprocity, warranties, etc.</i></p>
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Patent Statement Declaration With Respect to SMPTE Engineering Documents

	<p>Non-Assert</p> <p><i>Note: Submitters who have checked B1 may optionally check one of the following:</i></p>
	<p><input type="checkbox"/> B1.1. In addition to the license commitment set forth above, Submitter (“I” or “me”) irrevocably promises not to assert any Essential Claims (as defined in the SMPTE Intellectual Property Policy) against any entity (“you”) for making, using, selling, offering for sale, importing or distributing any implementation to the extent it conforms to the document above (“Covered Implementation”), subject to the following. This is a personal promise directly from me to you, and you acknowledge as a condition of benefiting from it that no rights from me are received from suppliers, distributors, or otherwise in connection with this promise. If you file, maintain or voluntarily participate in a patent infringement lawsuit against an implementation of such Covered Specification, then this personal promise does not apply with respect to any Covered Implementation of the document above made or used by you. To clarify, this conditional, reserved right to non-assert covers those claims of patents owned or controlled by me that are necessary to implement only the required portions of the Final Specification that are described in detail and not merely referenced in such Final Specification. This promise is not an assurance either (i) that any of my issued patent claims covers a Covered Implementation or are enforceable or (ii) that a Covered Implementation would not infringe patents or other intellectual property rights of any third party. No other rights except those expressly stated in this promise shall be deemed granted, waived or received by implication, exhaustion, estoppel, or otherwise.</p> <p><input type="checkbox"/> B1.2. In addition, Submitter will make its patents and/or patent applications that contain Essential Patent Claims in the above document available in accordance with the non-assert attached.</p>
<p>B2. <input type="checkbox"/></p>	<p>Licensing RAND</p> <p>Submitter is prepared to grant a license to its Essential Claims to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable and non-discriminatory terms and conditions to make, use and sell implementations that conform to the above document.</p> <p>Negotiations are left to the parties concerned and are performed outside SMPTE.</p> <p><i>Also mark here _____ if the Patent Holder’s willingness to license is conditioned on reciprocity for the above document.</i></p> <p><i>Reciprocity: Notwithstanding the commitment above, Submitter shall only be required to license any prospective licensee if such prospective licensee will commit to license its essential patent(s) or Essential Claim(s) under reasonable and non-discriminatory terms and conditions) for implementation of the same above document.</i></p>
<p>In the event that Submitter assigns or transfers a patent, which the Submitter has at the time of the assignment or transfer previously identified to SMPTE as containing Essential Patent Claims pursuant to A2 above as it relates to the above document, the Submitter agrees to comply with the terms of Section 9.1.8 of the IPR Policy.</p>	

Patent Statement Declaration With Respect to SMPTE Engineering Documents

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Declaration & Contact Information:

Company submitting declaration:

Patent Holder (if no patent, leave blank):

Submitter declares that he/she is authorized to make this declaration on behalf of above-named company.

Name of authorized person:

Title of authorized person

Place & Date of signature

Signature

Mailing Address:

Phone:

Email:

Website:

Patent Information

Patent Number and Claim(s) deemed to be Essential	Title	Status	Country
		Pending Granted	

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