



**Guidelines to the
Intellectual Property Rights Policy
of the
Telecommunications Industry Association**

**Edition 1
March 2005**

TIA has an Intellectual Property Rights (IPR) Policy, the full text of which can be found in the 4th edition of the TIA Engineering Manual (www.tiaonline.org/standards/sfg/procedures). These guidelines serve as a companion document to the 4th edition of the TIA Engineering Manual and are not intended to substitute for the Policy itself but rather to provide a review of major changes and an explanation of the rationale behind some of these changes.

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Guidelines to the Intellectual Property Rights Policy of the Telecommunications Industry Association

Introduction

The Telecommunications Industry Association (TIA) is accredited by the American National Standards Institute (ANSI) to develop standards intended to enhance and promote the beneficial use of telecommunications products manufactured by its member companies in the United States and throughout the world. In this process, representatives of member companies and others having an interest in the subject matter under consideration come together for the formulation of standards and other publications useful in the telecommunications industry.

TIA is the administrator of the standards formulation process; TIA is not the writer of standards. This latter work is carried on by the many participants in the Formulating Groups and its sub-elements (also known as Engineering Committees, Subcommittees and Working Groups) who carry on the writing and developing of standards with the administrative oversight and assistance of TIA and its Standards and Technology Department.

Utilizing contributions submitted by participants in Formulating Groups, and enhanced by a process of discussion and the interchange of ideas, the work culminates in a consensus document which, after a process of balloting and the resolution of differences, is ultimately published and made available.

An area of great importance in the process is the treatment of intellectual property rights (IPR). On the one hand, there is an important industry and public interest in the availability of the latest technological ideas and developments for inclusion in new products and services for the benefit of users. At the same time, inventors and innovative creators rightfully expect to reap the benefits of their time, expense and creativity. Thus, it is the policy of ANSI and TIA, when necessary, to permit the inclusion in standards of technology protected by certain statutory IPR. However, this is permitted pursuant to a policy that seeks to make the IPR available on a reasonable and non-discriminatory basis for all that would use it to fashion products contemplated by the standard in question.

For many years, TIA has published an Engineering Manual for the instruction of its various Formulating Groups engaged in the authorship of standards. An integral part of this manual is its IPR policy, which was formerly referred to as the Patent Policy (the Policy). Recently, this portion of the Manual was revised by TIA's IPR Standing Committee, which operates under the Technical Committee of TIA. Among other things, the Policy has been broadened to cover published patent applications and certain software copyrights as well as issued patents, resulting in the Policy now being referred to as the

IPR Policy. The revised Policy was the subject of a ballot and, having been approved, was officially published and became effective on March 2005.

These Guidelines are intended to review the major changes made in the Policy, with an explanation of the rationale behind the most important changes and some explanation of the intent of the IPR Standing Committee. It is the hope of the Standing Committee that the Guidelines will assist the chairs and members of the many TIA Formulating Groups who participate in their important work.

The participant's first commitment

An “important notice” is now contained in the introduction of the Engineering Manual. It should be read carefully by every participant and chair, as it makes it clear that whatever is stated or presented in writing, or otherwise disclosed, during attendance at or participation in a Formulating Group activity can, without compensation, be published or distributed by TIA, or posted on its web site, unless an exception is made by the designated officer of TIA. *It is the intention of this language to make it clear that TIA is granted the right to publish any submission to a Formulating Group, even if a submission cover is omitted, to the same extent as if a submission cover was submitted.* It is not intended to excuse the provision of a submission cover, which is still mandated.

This “important notice for participation” does not imply that a person making a statement or submitting a writing at a Formulating Group meeting, without explicit language to such effect, makes any representations as to the content of such statement or writing. It does constitute a license to TIA of whatever rights the submitter may have to publish or distribute the same or post it in the TIA web site. However, when a submission constitutes a Contribution, the Manual provisions on Contributions are applicable (see paragraph below entitled “Submissions”).

It is intended that this “important notice of participation” as contained in the Manual be reproduced in every notice for the meeting of a TIA Formulating Group, or any of their sub-elements, as well as on every attendance roster. In the case of teleconference meetings, the chair is requested to read the notice at the beginning of the call.

IPR in standards

As in the past, a patented invention (and in more limited cases, certain software) may be included in a standard. Also as in the past, TIA is not responsible for identifying patents or making any inquiry into the validity or scope of any patent. The new Manual (Section 1.1 of the Statements of Policy) also formalizes what has been the policy of TIA--that it will neither be a party to the discussion of licensing terms and conditions nor will it get involved in the issue of whether proposed licensing terms and conditions are reasonable or non-discriminatory. *These are matters for resolution by the parties, and they are not the proper subject matter for any discussion at a meeting of TIA or any of its committees or working groups.*

Disclosure

The Manual has been revised to make even more clear what has been the TIA policy on disclosure (Section 6.5 and its subparts). TIA encourages--but does not require--voluntary disclosure, and preferably early disclosure, of patents and published patent applications which may be essential to the practice of a standard or any other TIA Publication. TIA Publication is now defined as including publications of the Standards and Technology Department available for sale to the general public, but does not include literature distributed only to formulating group members. In addition, it should be noted that the Manual now stresses the voluntary nature of disclosure, which is desired, beneficial and requested, but not mandated.

In pursuit of this policy, the Manual has, and continues to have a suggested policy which encourages early disclosure to assure that participants in the standards formulation process are aware of the TIA IPR policy. A three-part approach will be used by TIA to encourage voluntary disclosure (preferably early) of Essential Patent(s) and published pending patent application(s).

At that beginning of each meeting, a chair ensures that all participants are aware of the early disclosure policy per Section 6.5.1.

The second part of the approach is that the TIA will place a notification on each ballot for a proposed Standard.

The third part of the approach may be the placement of an optional, voluntary disclosure statement by the Source(s) on a submission cover sheet to a Formulating Group. Such a submission cover sheet might take the form attached hereto as Annex G.1 and use a statement in the form shown in Section 6.4.7.

The policy specifically does not require companies to conduct patent searches to comply with the policy (Section 6.5.1).

Submissions and Contributions

The term “Contribution” is newly defined in the Manual (Section 6.4.2), clarifying what is, and what is not, a Contribution (Section 6.4.3). In the past, defining what a Contribution is has often perplexed Formulating Group chairs, who have had to decide if a submission is a Contribution, requiring a submission cover (with its grant of rights to TIA for publication).

It is called to the participant's attention that every Contribution is a submission, however, not every submission is a Contribution under the definition in Section 6.4.2. There are several types of submissions that can be made to a TIA Formulating Group but not all submissions are intended for incorporation into a TIA Publication. Some submissions are purely for information while others are for reference or backup material. When a submission is intended to or may be incorporated into a TIA Publication and fits the definition contained in Section 6.4.2 then the submission is formally called a Contribution. The submitter is now required to declare the intent or the purpose of the submission (See Section 6.4.5)

The Manual now defines a Contribution as an “expression in tangible form,” (*e.g.*, a writing but not an oral statement) “which is intended to or may be incorporated in...any TIA Publication or...work product “ of a TIA formulating group...”

To further clarify the definition of Contribution, a series of items frequently presented at meetings (such as meeting notices, agendas and minutes) is specifically excluded from being considered as a Contribution (Section 6.4.2) and submitters of such submissions expressly waive any copyright. The author or editor of a draft ballot should be asked also to provide a submission cover in the brief form required by the Manual.

Third Party Writings

A category of writings which do not require a submission cover sheet, but which requires further consideration is *third party writings*. When such writings are casual in nature (such as correspondence meant to be read at a meeting), they are excepted from submission cover requirements under new Section 6.4.3, but the identity of the third party author must be disclosed.

If the third party writing is to be reproduced or distributed, appropriate permission from the author should be obtained in advance to do so. In addition, if the writing is to be incorporated in a TIA Publication, new section 6.4.4 requires a copyright license to TIA substantially in the form contemplated in the Manual for all submissions.

Formulating Groups should be aware that additional steps may be required if the third party writing is the product of another standards developer or otherwise could involve essential IPR which is to be incorporated in a normative fashion in a TIA Publication. In such case, compliance with the Manual’s procedures respecting IPR must be assured. Chairs should consult with TIA staff to obtain appropriate copyright permission from another standards developer, or to have TIA staff ascertain another organization’s IPR policy is consistent with TIA’s Policy.

Submission Cover Sheet

A submission cover is still required for every submission and should be requested by the Chairs of any Formulating Group or its sub-elements. However, unlike the prior editions of the Manual, which required a lengthy cover sheet on a Contribution, the Manual requires the brief information detailed in Section 6.4.5 be included on a submission cover sheet. The required four elements are:

- the name of the Source (a defined term)
- the name of the person submitting
- the purpose of the submission
- a *mandatory* statement –*in exact language*-- which incorporates all the provisions of Manual Sections 6.4.1 through 6.4.6 in the submission just as if they were contained in it word for word.

For convenience, a suggested format for the cover sheet to be used when submitting a document to a TIA Formulating Group or its sub-elements is contained in Annex G. Regardless of whether this format is used or not, there are four required elements that must be contained in a cover sheet in whatever form the submitter prepares. Annexes I or J may apply when a submission contains software. *If any text is added to the required language (or to the optional language mentioned below) which is inconsistent with the required text, the inconsistent part is without any force or effect.*

Since a submission with required four elements on the submission cover sheet has the effect of incorporating in the submission the language of Manual Section 6.4.6.2, a section substantially revised from prior Manual versions, the contributor grants to TIA a non-exclusive, worldwide, irrevocable license (with the right to sublicense) broadly to copyright and include all or any part of the submission in any TIA Publication, with rights to sell the TIA Publication. Section 6.4.6.2 also requires the submission to disclose any known limitations on the Source's rights to license. *It is intended by this provision that if no such limitations are disclosed, the contributor is asserting there are none.*

Two optional paragraphs may be included in a submission cover sheet (Section 6.4.7). These two optional paragraphs are intended to further encourage the voluntary disclosure of IPR in line with TIA's policy previously mentioned.

Representatives of U.S. government agencies have in the past found it difficult to submit submission cover sheets purporting to license copyrights because of the absence of copyright in writings produced for the agencies. The addition of Section 6.4.6.3 in the Manual addresses this concern.

Dealing with disclosed or identified IPR

What is the IPR policy intended to achieve? Allowing the inclusion of essential IPR in a standard permits the selection by the Formulating Group of the best available technology, a clear advantage for the ultimate user.

Requiring reasonable and non-discriminatory (RAND) licenses to all applicants prevents the inclusion of patented technology from resulting in a patent holder securing a monopoly in any market as a result of the standardization process. Thus, licensing offers which defeat this intention are likely to fail the RAND test and do not comply with the Policy. But the precise terms and conditions are left to the parties, or if the parties fail to agree and dispute the reasonable and non-discriminatory character of what the licensor offers, the matter is left to the courts.

The term "non-discriminatory" does not mean or imply that licensing terms must be the same for all applicants. Discrimination and difference are not the same. It is understood that the process of license negotiation and the components of consideration between parties can vary substantially yet be fair. The term "non-discriminatory" implies a standard of even-handedness. An example of conduct that would constitute discrimination is a willingness to license all applicants except for competitors of the licensor.

As noted above, the policy of TIA is to encourage voluntary disclosure of the existence of patents and published patent applications essential to the practice of Normative (a defined term as mentioned below) portions of a standard.

That a party may have a patent or published patent application which is essential (a defined term in the Manual) to the practice of a standard may come to the attention of a Formulating Group or TIA staff by voluntary disclosure as encouraged, or by identification by a third party. When this occurs, the identified party will be asked to supply a Patent Holder Statement in the form attached to the Manual as Annex H. (Annex H.1 is an alternate form for use when reference to more than a single document or revision or edition of a document is intended). The Patent Holder Statement has undergone substantial revisions in the latest edition of the Manual, some of which are:

- Additional contact information is requested in the boxes at the beginning;
- The statement is limited to the IPR necessary for the practice of *any or all Normative portions* of the standard. The definition of Normative is discussed below.
- The statement reads as of the date of submittal of the form but is effective only when and if the document is approved as a standard.
- The required commitment is “to license only to the extent necessary for the practice of any or all of the Normative portions of the standard and only for the field of use of practice of the standard.” The latter provision makes it clear that a licensor can, by its license grant, restrict deployment of the licensed technology other than for the practice of the standard.
- The commitment as to published patent applications, by virtue of the definitions in the Manual, includes the patents issued thereon whenever issued.
- Essentiality, by virtue of the definitions in the Manual, is limited to claims that are essential.
- The commitment is irrevocable and the Patent Holder undertakes to notify its assignee or transferee of the commitment in the event of a transfer of rights in the relevant patents.

If no paragraphs are marked on the Patent Holder Statement, it is taken as a refusal to make any commitment.

Software copyrights

Entirely new to the Manual is Section 2 in the Statements of Policy on the inclusion of software as a Normative element in a standard. This Section is based in substantial part on similar discussions that have taken place in the International Telecommunication Union (ITU) Telecommunication Sector Bureau (TSB) Director's Ad Hoc Group. (TIA

has participated actively in the Patent Group of ANSI which provided input in the ITU process). This Section notes that inclusion of Software is to be discouraged, but guidance is given to a Formulating Group that decides that software covered by a copyright should be included in such a fashion that the standard cannot be practiced without infringing the copyright.

If the Formulating Group decides to include Software as a Normative element in a standard, then the Software Copyright Holder must furnish a statement in the form of Annex I “Software Copyright Holder Statement.” In addition to Annex I, the copyright holder must also complete the submission cover sheet with the four required elements such as the form shown in Annex G. If the Formulating Group so requires, other procedures for the inclusion of software including “Software Evaluation License” (Annex J) are now part of the Manual.

Definitions

Certain new or revised definitions in the Manual are deserving of special attention.

Essential Patent – only claim(s) of a patent (whenever issued) which is necessarily infringed by the practice of a Normative portion of a TIA Standard.

Patent Holder – a party having the legal ability to grant licenses with respect to patents under the conditions provided by the TIA IPR Policy.

Software Copyright Holder – a party having the legal ability to grant licenses with respect to software copyrights under the conditions provided by the TIA IPR Policy.

Source – the owner of the copyright or license right, if any, submitted in a Contribution. Examples include a company’s name, an individual’s name, or an organization’s name. In the case of a United States government agency, it is acceptable to list the agency name even though the material submitted by the government is in the public domain.

Software, Object Code and Source Code, have been added in view of new Section 2 on Inclusion of Software Copyright. The definitions are based on the ITU TSB Director’s Ad Hoc Group on IPR Software Guidelines, Issue 2.1.

Normative Elements, has been divided further into *Alternate, Mandatory and Optional Elements*. Each element requires compliance with the IPR policy. However, it came to the attention of the IPR Standing Committee that, in the past, absent a reference in the Manual, one or more companies believed that a commitment to license pursuant to a Patent Holder’s Statement covered only Mandatory Normative Elements. It is the intention that such an interpretation in the past was justified and not in violation of the TIA policy. However, compliance after the effective date of the new Manual as first above stated requires treating all of the kinds of Normative Elements alike.

The Manual also clearly spells out that the Normative Elements can be included only in standards, and not in a Telecommunications Systems Bulletin or any other TIA

Publication. The definition of *Telecommunications System Bulletin* (TSB) has been accordingly modified to emphasize that it is an informative document and that no Normative elements can be contained in a TSB.

The definition of *Standard* has also been modified, making it clear that a *Specification* is a type of Standard.