

Standard-Essential Patents

Legal and Technical Challenges

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Roadmap

- Why do we have standards?
- Standards organizations – an overview
- Legal challenges specific to standards-setting organizations
- Drafting and prosecuting a patent application with standardization in mind

Why standards?

Interoperability



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Best solution for a problem



Standards-setting organizations (SSOs)

- Companies submit technological solutions
- Solutions are studied and debated
- Standardized products created



Communication standards development

- Trend to convergence, Internet of Things (IoT)



Issues specific to SSOs

- Intellectual Property Rights (IPR) policies
- Licensing policies
- Antitrust issues

Intellectual Property Rights (IPR) Policies

- Definition of standard-essential patent (SEP)
- Definition of IPR policy
- Goals of IPR policy
 - Avoid patent holdup
 - Incorporate the “best” patents

Typical components of an IPR policy

- Disclosure requirement
- License terms – must be fair, reasonable and non-discriminatory (FRAND)
- What happens if someone fails to license?

Enforcement of licensing policies

- Determination of royalties
 - Georgia-Pacific with adjustment for FRAND
- Bottom-up versus Top-down approach
- Royalty stacking
- High-profile cases
 - *Top down approach used in Unwired Planet and TCL v. Ericsson*

Antitrust issues

- US government enforcement agencies
 - DOJ, FTC
 - Antitrust Guidelines
- Key antitrust issues in SEP context
 - Market power
 - Tying
 - Patent hold-up

Drafting and prosecuting a patent application with standardization in mind

- Typical inventor scenario
- Disclosure interview
- Use of standards lingo
- Consistent prosecution
- Continuation practice

Typical inventor scenario

- Inventor makes contributions to standards organization or working group thereof
- Timing may be of the essence

Disclosure interview

- Know the topic
- The “typical” disclosure
- What questions to ask
- The “nontypical” disclosure



Use of standards lingo

- Use exact terms from the standard in your claims and specification
- Boilerplate to at least mention other standards, synonyms for the different components, and prediction of possible trends

Consistent prosecution

- Have one agent in charge of the entire family
- Potential EP and CN issues regarding amendments
- When is consistency not desirable?



Continuation practice

- Keep on the inventors for any standards updates
- Adjust the claims as the standard changes
- Look for standardization opportunities in implementation applications
- Look for implementation opportunities in standards applications

Takeaways

- The future: convergence of standards
- Keeping an eye on IPR policy and FRAND case law
- Application drafting for maximal SEP benefit

Thanks for your attention! Questions?



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