

# 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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