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Our ref ISO/IEC JTC 1/SC 17

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Patents and standards

Dear Freda,

Many thanks for your letter dated 3 July 2001. We have now had the opportunity to discuss this with Dr Eicher and Mr Amit.

At the outset, we can say that there was a great deal of sympathy for the frustrations that you and other SC 17 officers must have been experiencing, especially as we were all aware of other similar cases. At the same time, however, we had to note that during the recent revision of the ISO/IEC Directives, there were no suggestions that the current ISO/IEC IPR policy was deficient in any way and that the policy in the new edition of the Directives is consequently identical with that in the previous edition.

As we are sure you appreciate, our IPR policy is based on the assumption that participants in ISO and IEC work act, and will act, in good faith. However, we know there have been difficulties in the past caused by slightly different IPR policies practised by some national bodies (for example, some do not require that pending patents be declared whereas ISO and IEC do). We know that, in some cases, this difference has been the cause of late declarations of patents, but there have also been instances in which individual experts have declared that they were not aware that their employer held relevant patents and this is quite conceivable, especially in the bigger organizations. Nevertheless, we do believe that we probably need to ensure that those participating in ISO and IEC work are reminded of our IPR policy periodically, one suggestion being to draw attention on draft agendas for meetings to the obligation of participants to declare any patents or like rights of which they are aware and which are relevant to the items to be discussed.

We noted the proposal that meeting participants be requested to sign the proposed form acknowledging the ISO/IEC IPR policy, but considered that this might be contentious as well as being of dubious legal validity. Again, therefore, we believe that the reminder on meeting agendas would serve to sensitize participants to their obligations whilst also leaving the presumption of good faith. This would not preclude, however, the possibility that when a WG convenor or other committee officer has strong grounds to suspect that an expert is withholding information about patents, he could request ISO or IEC to raise the issue with the expert's employer.

With respect to the other issues you raise, let us comment first on the claim to hold patents when there are none. As you no doubt know, the boiler plate text we include in ISO and IEC (and ISO/IEC) standards includes a number of disclaimers. One of these is that ISO and IEC, as relevant, take no position with respect to the validity or scope of identified patents. One consequence of this is that we consider that it is the responsibility of the end-user to decide whether their implementation will require them to seek a license or not, and we do not expect ISO or IEC committees to make a determination about the relevance of a particular patent. If, therefore, an organization claims to hold a patent, and is willing to abide by our terms and conditions for issuing licenses, then we will make mention of the patent in the International Standard. If an end-user considers that their implementation does not infringe a particular patent, then they may well be required to prove it before a court of law. You will appreciate however that we by far prefer that situation to one in which WE have to prove that a particular patent is not relevant to a particular standard.

As you might imagine, there has been at least one case in the past in which an organization claimed to hold a relevant patent, but refused to abide by ISO/IEC licensing rules. This is the only instance we are aware of in which the WG did make the determination that it was possible to engineer round the patent, but we nevertheless drew attention to the patent in the standard

With regard to the problem of particular organizations "staffing" ISO or IEC committees to improve the chance of adoption of their technologies, this is unfortunately not something that we can really legislate against. We recall the correspondence on this subject a good few years ago and that at the time we appealed to the national bodies concerned to ensure that their national representation contained a balance of interests and that a similar balance was maintained in the international forum. Unfortunately we cannot do much more than this, but we would also need to assume that even if a company was successful in such a ploy, the market place would decide whether to apply that particular standard or not.

Finally, with regard to the question of patent holders making the granting of licenses conditional upon acceptance of other patented technologies in standards, again the only thing we can suggest is that in such cases the ISO and IEC CEOs as appropriate be requested to contact the patent owner to explain the rules for granting of licenses.

It has been agreed that we should issue within ISO and IEC circulars to committee secretariats reminding them of ISO/IEC IPR policy and asking them similarly to remind meeting participants of the policy. We propose to cite some of the problems you have encountered in that circular (we will not of course identify SC 17) and invite committees to contact the ISO and IEC central offices when they encounter similar problems.

For SC 17 in particular, please understand that we do not object to there being a guidance document available to SC 17 delegates so long as it does not change, add to, or delete from the basic ISO and IEC patent policy and rules. Guidance documents exist in numerous ISO and IEC TCs and SCs that can be considered as explanations of the policies and rules in the Directives and these are neither formally approved nor carefully scrutinized by the ISO/IEC hierarchy, unless they are contested. Naturally we would not like to get into the position of having to approve or endorse individual explanations and guidance documents for more than 1000 TCs and SCs.

In the vast majority of cases, the current IPR policy has been tried and tested and been found to be workable, to the extent that many consortia in the IT field, including IETF and W3C, are basing their own IPR policies on essentially the same principles. Again therefore we would strongly recommend that when such problems arise, they be brought immediately to our attention so that we can try to reach some agreement with the patent owners. Of course in some instances we may be unsuccessful which would require committees to look for alternative solutions, but hopefully this would spare you and others the level of frustration that you have encountered recently.

With best wishes,

Yours sincerely,

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