

AES policy and guidelines – Standards and patent rights

Abstract

This document revises the long-standing AES patent policy that is administered by the AES Standards Committee (AESSC). In this revision, the essential intent is unchanged, but a number of details are clarified to harmonize with the common patent policy documents of ITU-T, ITU-R, ISO, and IEC, in its Revision 1, effective 23 April 2012.

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Foreword

The AES patent policy has remained unchanged from before 2001, requiring in general terms that participants notify the working group and secretariat of any patents that would affect the implementation of the draft document, and to provide a formal declaration to, “assure the AES that it is willing to negotiate licenses under reasonable and non-discriminatory terms and conditions with applicants throughout the world” in case the draft is published.

As AES standard documents become more sophisticated, they may increasingly involve patented technologies, and greater clarity will be needed to avoid misunderstandings with their concomitant time and costs.

The IEC and ISO have addressed exactly this issue in recent years. More recently still, an understanding has been reached between ITU-R, ITU-T, ISO, and IEC for a common patent policy.

This 2014 revision of the AESSC policy and guidelines on standards and patent rights is intended to be consistent with this common patent policy. It was approved by the AES Standards Committee on 2014-03-31.

Mark Yonge
AES Standards Secretary
2014-04-04

Note on normative language

In AES standards documents, sentences containing the word “shall” are requirements for compliance with the document. Sentences containing the verb “should” are strong suggestions (recommendations). Sentences giving permission use the verb “may”. Sentences expressing a possibility use the verb “can”.

AESSC policy and guidelines – Patent rights

1 Introduction

The AES has had a patent policy for many years, the purpose being to provide in simple words practical guidance to the participants in the AES Standards Committee (AESSC) Technical Bodies in case patent rights matters arise. In this document, the AES patent policy is brought into close agreement with the Common Patent Policy of the ITU-T, ITU-R, ISO and IEC.

Considering that the technical experts are normally not familiar with the complex issue of patent law, a main operative part of the Policy is a checklist, covering the three different cases which may arise if a Deliverable requires licences for Patents to be practiced or implemented, fully or partly.

The Patent Policy encourages the early disclosure and identification of Patents that may relate to Deliverables under development. In doing so, greater efficiency in standards development is possible and potential patent rights problems can be avoided.

The rules of the Policy are simple and straightforward. Deliverables are drawn up by technical and not patent experts; thus, they may not necessarily be very familiar with the complex international legal situation of intellectual property rights such as patents. The AES is not, and should not be, involved in evaluating patent relevance or essentiality with regards to Deliverables, interfere with licensing negotiations, or engage in settling disputes on Patents; this is a matter for the parties concerned.

Deliverables are non-binding; their objective is to ensure compatibility of technologies and systems on a worldwide basis. To meet this objective, which is in the common interests of all those participating, it must be ensured that Deliverables, their applications, use, and so on, are accessible to everybody. It follows, therefore, that a patent embodied fully or partly in a Deliverable must be accessible to everybody without undue constraints. To meet this requirement in general is the sole objective of the Policy.

2 Explanation of terms

Contribution

Any document submitted for consideration by a Technical Body.

Free of charge

Patent Holder 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.).

NOTE - However, while the Patent Holder in this situation is committing to not charging any monetary amount, the Patent Holder is still entitled to require that the user of the deliverable sign a license agreement that contains other reasonable terms and conditions such as those relating to governing law, field of use, reciprocity, warranties, etc.

Patent

Essential patent or similar right, utility model or other statutory right based on invention, including any application for any of the foregoing.

Patent Holder

Person or entity that owns, controls and/or has the ability to license Patents.

Reciprocity

Limitation of the requirement for the Patent Holder to license a prospective licensee only if such prospective licensee commits to license its essential patent(s) or essential patent claim(s) (if any) for implementation of the same deliverable free of charge or under reasonable terms and conditions.

Deliverable

AES standards documents.

NOTE - The various types of Deliverable are referred to as "Document types" in the Patent Statement and Licensing Declaration Form attached as Annex B.

Technical Body

subordinate group of the AES Standards Committee, including subcommittees, working groups, and task groups.

Participant

member of a Technical Body or recipient of a draft deliverable at any stage in the standards development process.

3 Patent Statement and Licensing Declaration Form

The purpose of the Declaration Form is to ensure a standardized submission to the AES of the declarations being made by Patent Holders and to strongly encourage the submission of supporting information and an explanation if a Patent Holder declares unwillingness to license under option 1 or 2 of the Declaration Form (that is, declares option 3 of the Declaration Form).

The Declaration Form gives Patent Holders the means of making a licensing declaration relative to rights in Patents required for implementation of a specific Deliverable. Specifically, by submitting the Declaration Form the submitting party declares its willingness/unwillingness to license, according to the Patent Policy, Patents held by it and whose licence would be required to practice or implement part(s) or all of a specific Deliverable.

The statement contained in the Declaration Form remains in force as long as it has not been replaced, for example in case of obvious errors.

Multiple Declaration Forms are appropriate if the Patent Holder has identified several Patents and classifies them in different options of the Declaration Form and/or if the Patent Holder classifies different claims of a complex patent in different options of the Declaration Form.

4 Internal AES provisions**4.1 Committee procedures**

Early disclosure of Patents contributes to the efficiency of the process by which Deliverables are established. Therefore, each Technical Body, in the course of the development of a proposed Deliverable, will request the disclosure of any known Patents essential to the proposed Deliverable.

Convenors of Technical Bodies shall ask, in each meeting, whether anyone has knowledge of Patents, the use of which may be required to practice or implement the Deliverable being considered. The fact that the question was asked shall be recorded in the meeting report, along with the response (including 'No response').

It is expected that discussions in Technical Bodies include consideration of including patented material in a Deliverable, however the Technical Bodies may not take a position regarding the essentiality, scope, validity or

specific licensing terms of any claimed Patent. As long as the AES has received no indication of a Patent Holder selecting option 3 (see clause A.2) of the Patent Policy, the Deliverable may be approved using the appropriate and respective rules of the AES.

4.2 Patent Information publication

In order to facilitate both the standards-making process and the application of Deliverables, the AES shall make available to the public a Patent Information listing composed of information that was communicated to the AES by the means of Declaration Forms. The Patent Information listing may contain information on specific Patents, or may contain no such information but rather a statement about compliance with the Patent Policy for a particular Deliverable.

The Patent Information listings are not certified to be either accurate or complete, and inform only that the information has been communicated to the AES. As such, the Patent Information listings may be viewed as alerting users that they may wish to contact the entities who have communicated Declaration Forms to the AES in order to determine if patent licenses must be obtained for use or implementation of a particular Deliverable.

4.3 Document notices

4.3.1 Draft documents

All drafts submitted for comment shall include on the cover page the following text:

“Recipients of this draft are invited to submit, with their comments, notification of any relevant patent rights of which they are aware and to provide supporting documentation.”

4.3.2 Published documents

A published document, for which no patent rights are identified during the preparation thereof, shall contain the following notice in the foreword:

“Attention is drawn to the possibility that some of the elements of this document may be the subject of patent rights. AES shall not be held responsible for identifying any or all such patent rights.”

A published document, for which patent rights have been identified during the preparation thereof, shall include the following notice in the introduction:

“The AES draws attention to the fact that it is claimed that compliance with this document may involve the use of a patent concerning (... *subject matter* ...) given in (... *subclause* ...).”

The AES takes no position concerning the evidence, validity and scope of this patent right.

The holder of this patent right has assured the AES that he/she is willing to negotiate licences under reasonable and non-discriminatory terms and conditions with applicants throughout the world. In this respect, the statement of the holder of this patent right is registered with the AES. Information may be obtained from:

name of holder of patent right ... address ...

Attention is drawn to the possibility that some of the elements of this document may be the subject of patent rights other than those identified above. The AES shall not be held responsible for identifying any or all such patent rights.”

Annex A (normative): AES Patent Policy

A.1 Disclaimer and disclosure

The AES is not in a position to give authoritative or comprehensive information about evidence, validity or scope of patents or similar rights, but it is desirable that the fullest available information should be disclosed. Therefore, a party participating in the work of the AES shall draw the attention of the AES, through its Standards Manager, to any known patent or to any known pending patent application, either their own or of other organizations that affects, or may affect, the application of a Deliverable. Such information shall be disclosed as early as possible during the development of the Deliverable, **and provided in good faith and on a best effort basis**. A communication drawing the attention to a Patent shall be addressed to the AES in writing. The potential Patent Holder will then be requested by the AES to submit a Declaration Form.

In addition to the above, a party not participating in any Technical Body may draw the attention of the AES to any known Patent, either their own and/or of a third-party.

NOTE 1 - The involvement of a patent might not be apparent from early drafts of a Deliverable.

NOTE 2 - 'in good faith and on a best effort basis' means that a participant is under a duty to inform, and consult with, his/her employer concerning relevant, or potentially relevant, patent matters. An employer is under a duty to provide a participant with relevant information on the existence of patents.

NOTE 3 - AES sets no requirement for patent searches to be carried out.

The Patent Policy also applies to any Patent disclosed or drawn to the attention of the AES subsequent to the approval of a Deliverable.

Whether the identification of the Patent took place before or after the approval of the Deliverable, if the Patent Holder informs AES of unwillingness to license under options 1 or 2 of the Patent Policy, the AES will promptly advise the Technical Bodies responsible for the affected Deliverable so that appropriate action can be taken. Such action may include, but not be limited to, a review of the Deliverable or its draft.

A.2 Licensing

When information as referred to in Clause A.1 has been disclosed, one of three different situations may arise in respect of licensing. These options are:

1	The patent holder is willing to negotiate licences free of charge with other parties on a non- discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside the AES.
2	The patent holder is willing to negotiate licences with other parties on a non-discriminatory basis on reasonable terms and conditions. Such negotiations are left to the parties concerned and are performed outside the AES.
3	The patent holder is not willing to comply with the provisions of either paragraph A.2 option 1 or paragraph A.2 option 2; in such case, the Deliverable shall not include provisions depending on the patent.

A.3 Patent Statement and Licensing Declaration

In all cases (options 1, 2 or 3), the patent holder shall provide a written statement to be filed by the AES using the appropriate "Patent Statement and Licensing Declaration" Form which is available on the AES web site (also included in Annex B for information purposes). The statement shall not include additional provisions, conditions, or any other exclusion clauses in excess of that provided for each case in the corresponding boxes of the form.

Completed forms shall be sent to the AES for the attention of the Standards Manager. Contact information shall be given that is expected to remain valid over time. The Registered Office of a corporate entity that is the Patent Holder shall be given. Patent Holders should, if possible, indicate the same contact point on all Declaration Forms submitted.

The AES Standards secretariat shall accept each patent statement that is complete and is received from an individual within the issuing organization whose title suggests authority for intellectual property and legal matters. The secretariat's duties with regard to patent statements shall otherwise be purely ministerial (that is, without regard to or exercise of secretariat discretion regarding the content of the patent statements received).

With a view to maintaining up-to-date information in the Patent Information database of the AES, it is requested that the AES be informed of any change or corrections to the Declaration Form submitted in the past, especially with regard to the contact data.

Information contained in a Declaration Form may be corrected in case of obvious errors, such as a typographical mistake in a standard or patent reference number. The licensing declaration contained in the Declaration Form shall remain in force unless it is superseded by another Declaration Form containing more favourable licensing terms and conditions from a licensee's perspective reflecting (a) a change in commitment from option 3 to either option 1 or option 2, (b) a change in commitment from option 2 to option 1 or (c) unchecking one or more sub-options contained within option 1 or 2.

A.4 Assignment or Transfer of Patent Rights

In the event that a Patent Holder assigns or transfers ownership or control of Patents for which the Patent Holder reasonably believes it has made a license undertaking to the AES, the Patent Holder shall notify the AES via its Standards Manager immediately, and make reasonable efforts to notify such assignee or transferee of the existence of such license undertaking. In addition, if the Patent Holder specifically identified patents to the AES, then the Patent Holder shall have the assignee or transferee agree to be bound by the same licensing commitment as the Patent Holder for the same patent. If the Patent Holder did not specifically identify the patents in question to the AES, then it shall use reasonable efforts (but without requiring a patent search) to have the assignee or transferee to agree to be so bound. By complying with the above, the Patent Holder has discharged in full all of its obligations and liability with regards to the licensing commitments after the transfer or assignment. This clause is not intended to place any duty on the Patent Holder to compel compliance with the licensing commitment by the assignee or transferee after the transfer occurs.

Annex B - Patent statement and licensing declaration form for AES deliverable

This declaration conforms to the "AES policy and guidelines – Standards and patent rights" as revised 2014 and in accordance with the AESSC Rules - it does not represent an actual grant of a license.

Please return the completed form to the AES at the following address:

**Standards Manager
 Audio Engineering Society
 60, East 42nd Street, Suite 2520
 New York
 NY 10165-2520
 USA**

Patent Holder:

Legal Name:	
Contact for license application:	
Name & Department Address:	
Telephone:	
Fax:	
E-mail:	
URL (optional):	

Document type: (AES Deliverable: Standard; Information Document; Report)

Document or project number:	AES
Document title:	

Free of charge

Patent Holder 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.).

NOTE - However, while the Patent Holder in this situation is committing to not charging any monetary amount, the Patent Holder is still entitled to require that the user of the deliverable sign a license agreement that contains other reasonable terms and conditions such as those relating to governing law, field of use, reciprocity, warranties, etc.

Reciprocity

Limitation of the requirement for the Patent Holder to license a prospective licensee only if such prospective licensee commits to license its essential patent(s) or essential patent claim(s) (if any) for implementation of the same deliverable free of charge or under reasonable terms and conditions.

Licensing declaration:

The Patent Holder believes that it holds granted and/or pending applications for the patents listed below, the use of which would be required to implement the above document and hereby declares, in accordance with the AES Patent Policy, that (check one box only):

1		The Patent Holder is prepared to grant a free of charge license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and under other reasonable terms and conditions to make, use, and sell implementations of the above document. Negotiations are left to the parties concerned and are performed outside the AES.
		Also mark here if the Patent Holder's willingness to license is conditioned on reciprocity for the above document.
		Also mark here if the Patent Holder reserves the right to license on reasonable 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 above document, on reasonable terms and conditions (but not free of charge).
2		The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the above document. Negotiations are left to the parties concerned and are performed outside the AES.
		Also mark here if the Patent Holder's willingness to license is conditioned on reciprocity for the above document.
3		The Patent Holder is unwilling to grant licenses in accordance with provisions of either option 1 or option 2 above. In this case, the following information is strongly desired by the AES as part of this declaration: <ul style="list-style-type: none"> • granted patent number or patent application number (if pending); • an indication of which portions of the above document are affected; • a description of the patent claims covering the above document.

Patent Information

<i>No.</i>	<i>Status Granted/ Pending</i>	<i>Country</i>	<i>Patent number or Application number</i>	<i>Title</i>
1				
2				
3				
4				

Signature:

Patent Holder	
Name of authorized person	
Title of authorized person	
Signature	
Place, Date	