



Administrative Circular
CA/148

15 April 2005

To Administrations of Member States of the ITU and Radiocommunication Sector Members

Subject: New forms for submission of patent statements and licensing declarations

At its meeting 22-26 November 2004, the Radiocommunication Advisory Group (RAG) discussed the subject of ITU-R patent policy, including the forms used for the submission of patent statements to ITU-R by holders of granted patents or pending patent applications. In particular, the RAG encouraged the Director to explore the possibility of aligning the forms used in the Radiocommunication Sector with those used in the Telecommunication Standardization Sector. To this end, revised forms have been developed for use in ITU-R which replace those previously contained in Circular CA/67 of 2 June 1999. The new forms, annexed to this circular, should be used as from **30 April 2005**.

The first form is a "Patent Statement and Licensing Declaration", given in Annex 1. The purpose of this form is to ensure a standardized submission to the BR of the declarations being made by patent holders and to provide supporting information and an explanation if a patent holder is unwilling to grant a licence (option 3 of the declaration). Typically, one form would be used for each Recommendation containing patented material.

The second form is a "General Patent Statement and Licensing Declaration", contained in Annex 2. The purpose of this form is to give patent holders the voluntary option of declaring, for **all** their patents associated with Recommendations contained in any of their contributions to the ITU-R, a willingness to waive their rights (option 1) or to grant a licence under reasonable and non-discriminatory terms and conditions (option 2).

Additional information on the ITU-R patent issues can be found at:

<http://www.itu.int/ITU-R/study-groups/patents/>

Please note that it is unnecessary to resubmit data already stored in the Patent Statements Database. Only new patent statement submissions should use these new standardized forms.

Finally, your attention is drawn to the importance of early disclosure and declaration of patents in order to avoid potential problems in the approval and eventual application of ITU-R Recommendations.

Valery Timofeev
Director, Radiocommunication Bureau

Annexes: 2

Distribution:

- Administrations of Member States of the ITU
- Radiocommunication Sector Members
- Chairmen and Vice-Chairmen of Radiocommunication Study Groups and Special Committee on Regulatory/Procedural Matters
- Chairman and Vice-Chairmen of the Radiocommunication Advisory Group
- Chairman and Vice-Chairmen of the Conference Preparatory Meeting
- Members of the Radio Regulations Board
- Secretary-General of the ITU, Director of the Telecommunication Standardization Bureau, Director of the Telecommunication Development Bureau

ANNEX 1

Patent Statement and Licensing Declaration

This declaration does not represent an implied license grant

Please return to: Director
Radiocommunication Bureau
International Telecommunication Union

Place des Nations
CH-1211 Geneva 20, Switzerland
Fax: +41 22 730 5785

Patent Holder/Organization:

Legal Name _____

Contact for license application:

Name & Department _____

Address _____

Tel. _____

Fax _____

E-mail _____

URL (optional) _____

ITU-R Recommendation:

Number _____

Title _____

Licensing declaration

The Patent Holder believes to hold granted patents and/or pending applications, whose use would be required to implement the above ITU-R Recommendation and hereby declares, in accordance with the Statement on ITU-R Patent Policy (see ITU-R website), that (check one box only).

1 The Patent Holder is prepared to grant – on the basis of reciprocity for the above ITU-R Recommendation – a free 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 ITU-R Recommendation.

Negotiations are left to the parties concerned and are performed outside the ITU-R.

Also mark here ____ if the Patent Holder reserves the right to license on reasonable terms and conditions (but not for free) to applicants who are only willing to license their patent claims, whose use would be required to implement the above ITU-R Recommendation, on reasonable terms and conditions (but not for free).

2 The Patent Holder is prepared to grant – on the basis of reciprocity for the above ITU-R Recommendation – 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 ITU-R Recommendation.

Negotiations are left to the parties concerned and are performed outside the ITU-R.

3 The Patent Holder is unwilling to grant licenses according to the provisions of either 1 or 2 above. In this case, the following information must be provided as part of this declaration:

- patent registration/application number;
- an indication of which portions of the Recommendation are affected;
- a description of the patent claims covering the Recommendation.

Free: The word “free” does not mean that the Patent Holder is waiving all of its rights with respect to the essential patent. Rather, “free” refers to the issue of monetary compensation; *i.e.*, that the 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.). 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 implementer of the ITU-R Recommendation 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: As used herein, the word “reciprocity” means that the Patent Holder shall only be required to license any prospective licensee if such prospective licensee will commit to license its essential patent(s) or essential patent claim(s) for implementation of the same ITU-R Recommendation for free or under reasonable terms and conditions.

Signature

Organization _____
Name of authorized person _____
Title of authorized person _____
Signature _____
Place, Date _____

FORM: 30 April 2005

Patent Information (desired but not required)			
No.	Registration Number/ Country	<u>Title/Inventor</u>	Status [granted/ pending]
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ANNEX 2

General Patent Statement and Licensing Declaration

Please return to: Director
Radiocommunication Bureau
International Telecommunication Union

Place des Nations
CH-1211 Geneva 20, Switzerland
Fax: +41 22 730 5785

Patent Holder/Organization:

Legal Name _____

Contact for license application:

Name & Department _____

Address _____

Tel. _____

Fax _____

E-mail _____

Licensing declaration

In case part(s) or all of any proposals contained in contributions submitted by the organization above are included in ITU-R Recommendation(s) and the included part(s) contain items that have been patented or for which patent applications have been filed and whose use would be required to implement ITU-R Recommendation(s), the above Patent Holder hereby declares, in accordance with the Statement on ITU-R Patent Policy (see ITU-R web site), that (check one box only):

- 1 The Patent Holder is prepared to grant – on the basis of reciprocity for the relevant ITU-R Recommendation(s) – a free 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 relevant ITU-R Recommendation(s).

Negotiations are left to the parties concerned and are performed outside the ITU-R.

Also mark here ____ if the Patent Holder reserves the right to license on reasonable terms and conditions (but not for free) to applicants who are only willing to license their patent claims, whose use would be required to implement the same ITU-R Recommendation(s), on reasonable terms and conditions (but not for free).

- 2 The Patent Holder is prepared to grant – on the basis of reciprocity for the relevant ITU-R Recommendation(s) – 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 relevant ITU-R Recommendation(s).

Negotiations are left to the parties concerned and are performed outside the ITU-R.

Free: The word “free” does not mean that the Patent Holder is waiving all of its rights with respect to the essential patent. Rather, “free” refers to the issue of monetary compensation; *i.e.*, that the 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.). 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 implementer of the ITU-R Recommendation 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: As used herein, the word “reciprocity” means that the Patent Holder shall only be required to license any prospective licensee if such prospective licensee will commit to license its essential patent(s) or essential patent claim(s) for implementation of the same ITU-R Recommendation for free or under reasonable terms and conditions.

Signature

Organization _____

Name of authorized person _____

Title of authorized person _____

Signature _____

Place, Date _____