

Version 1.2

24 October 2002, Geneva, Switzerland

The UN/CEFACT Steering Group (CSG) reviewed the draft version 1.2 of the IPR policy, which had been recommended to it by one of the Legal Rapporteurs, Mr. David Marsh, and his colleagues. The CSG unanimously approved the document and adopted it as their policy. Therefore, this becomes the provisional policy of UN/CEFACT.

The next steps will be to forward the document to the Heads of Delegation with the request for an intersessional approval. In the meantime, the provisional policy will be distributed as widely as possible through all channels available to UN/CEFACT including its website, list servers and the FCT.

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PROVISIONAL UN/CEFACT INTELLECTUAL PROPERTY POLICY Effective as of 24 October 2002

1. About this Policy. The policy described in this document (the “Policy”) is the complete and exclusive statement of UN/CEFACT’s Intellectual Property policy, and applies to and governs all of UN/CEFACT’s activity moving forward. This Policy supersedes any and all prior documentation regarding UN/CEFACT’s intellectual property policy, including, but not limited to, the intellectual property language provided in UN/CEFACT’s Open Development Process for Technical Specifications and its User Guide. Any revisions to this Policy will be effective only after: (a) all UN/CEFACT Members and Participants are notified in writing (such as by e-mail) of such revisions; (b) a clear and conspicuous link to the revised Policy (with the revisions highlighted) is posted on the home page of the UN/CEFACT website (currently <http://www.unece.org/cefact/>); and (c) Participants are afforded at least thirty (30) days from the date of receiving notice of such revisions to withdraw from UN/CEFACT. Any Participant that withdraws from UN/CEFACT prior to the end of this thirty (30)-day period will not be subject to the revised UN/CEFACT Policy.

2. Definitions. Capitalized terms in this Policy shall have the following meanings:

(a) **“Affiliate”** means an entity that directly or indirectly controls, is controlled by, or is under common control with another entity. Control, for purposes of this Policy, means direct or indirect beneficial ownership of more than fifty percent of the voting stock, or decision-making authority in the event that there is no voting stock, in an entity. All references to “Participant” in this Policy shall be deemed to include such entity’s Affiliates.

(b) **“Contribution”** means material that (1) exists in a tangible form of expression (including in electronic media), or verbal statements made by a Participant at a UN/CEFACT group meeting that are memorialized in written documentation within such group; and (2) satisfies all the additional criteria for a Contribution set out in Section 3 of this Policy, subject to the limitations and qualifications also set out in Section 3.

(c) **“Intellectual Property”** means all copyrights and patent claims.

(d) **“Member”** means (1) UN/ECE member States; (2) other UN member States; (3) inter-governmental organizations; and (4) non-governmental organizations recognized by ECOSOC.

(e) **“Necessary Claims”** means claims of a granted patent or [published] patent application, excluding design patents and design registrations, that (1) are owned or controlled by the contributing Participant now or at any future time; and (2) are necessarily infringed by implementing the Contribution as disclosed with particularity in the Specification, because there is no technically plausible non-infringing alternative for implementing the Contribution and still comply with such Specification. Necessary Claims do not include (i) any claims that may be

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contained in the same patent as Necessary Claims but are not themselves Necessary Claims; (ii) any claims that may read on any portions of any product and any combinations thereof that are not required for compliance with the Specification; (iii) any claims that relate to any enabling technologies (e.g., semiconductor manufacturing technology, compiler technology, object oriented technology, basic operating system technology, computers, networks, connectivity protocols, application programs, integrated circuits or the like) not expressly described in the Specification; or (iv) implementation examples.

(f) “Participant” means an individual, association, organization, corporation, or other entity that has formally joined a UN/CEFACT Permanent or Ad-hoc group under the group’s membership rules. Except as used in Section 6(a), Participant means the legal entity on whose behalf an authorized individual acts. For purposes of Section 6(a), Participant means the particular individual himself or herself.

(g) “Specification” means a technical specification developed by a UN/CEFACT group. Specifications may include (1) business methods and business processes, or (2) data structures and data formats that enable such business methods or business processes, but shall not include product specifications.

3. Contributions of Intellectual Property in groups. Each group must, at the outset of its work, carefully define the scope of its work and the expected output. For purposes of this Policy, a Participant in a particular group’s Specification development effort will be deemed to have made a Contribution of all Intellectual Property that (i) it owns or controls; (ii) is actually submitted by such Participant to the group in the process of developing such Specification; and (iii) is ultimately incorporated into a published final Specification developed pursuant to such effort, subject to the following limitations and qualifications:

(a) The Participant must have formally joined the project team of a particular Specification development effort pursuant to the UN/CEFACT Open Development Process approved by the UN/CEFACT Plenary. Subsequent withdrawal from the group by the Participant will have no effect on the Participant’s obligations under this Policy; *except*, if the final output of a group’s particular Specification development effort differs substantially from the expected output that was documented at the time the group commenced, then a Participant (including a Participant that has previously submitted a proposed Contribution to such Specification development effort) that has withdrawn promptly from a group prior to final approval of the applicable Specification will have no obligations under Sections 3 and 4 of this Policy in connection with such Specification. (*See also* Section 8 of this Policy regarding withdrawal of a Participant from UN/CEFACT in its entirety.)

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(b) Only business methods and business processes, or data structures and data formats that enable such business processes or business methods will be deemed a Contribution. That is, in no case will patent claims in granted patents and patent applications that address anything other than business methods or business processes, or data structures or data formats that enable such business processes or business methods, be deemed contributed, even if it otherwise appears to qualify as a Contribution per this Section 3.

(c) No Participant in a group or Specification development effort is obligated to contribute or license (or will be deemed to have contributed or licensed) its Intellectual Property that is used in or becomes part of a Specification based on an unauthorized submission of that Intellectual Property by another. Only Intellectual Property under which the Participant making the submission has a right to grant the licenses required by this Policy without obligation of payment or other material consideration to an unrelated third party will be deemed a Contribution.

(d) No Participant will submit Intellectual Property that it knows it does not have the right to license as required by this Policy or that it knows requires such obligation of payment or other material consideration.

(e) No Participant will include software code in its Contributions. No draft or final Specification shall include software code.

(f) A written statement or an oral statement that is memorialized in writing and which is submitted to UN/CEFACT or to an UN/CEFACT group by an individual or entity that is not a Participant of UN/CEFACT (“non-Participant”), such as an invited expert that has not been approved by a Member, for incorporation into a Specification, shall be treated as a Contribution under this Section 3 and shall be subject to the licensing obligations under Section 4, provided that the additional requirements and restrictions under this Section 3 are satisfied other than the requirement in Section 3(a) that the Contribution come from a Participant that has formally joined a group.

(g) No Intellectual Property owned or controlled by a Participant, or by a contributing non-Participant, will be deemed contributed except as described in this Section 3, or, where applicable, in Section 6(c). Further, each Participant in each Specification development effort and each contributing non-Participant will retain ownership of all Intellectual Property rights that such entity owned prior to participation or contribution and that may vest in the course of participation. Except as specifically set forth in this Policy, Participants and contributing non-Participants do not grant any licenses to, or otherwise limit their rights in or to, their Contributions or any other Intellectual Property.

4. Use of Contributions. In connection with each Contribution, the contributing Participant agrees as follows:

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(a) Copyright. The Participant grants UN/CEFACT a non-exclusive, perpetual, irrevocable *royalty-free* license under the Participant's copyright rights in the Contribution to reproduce, distribute, perform, display and create derivative works of the Contribution, solely for the purpose of creating, implementing, and promoting Specifications. UN/CEFACT may sublicense these rights to implementers of Specifications, or otherwise, as necessary to advance this purpose.

(b) Patents. A Participant agrees that it will grant to any third party implementing a published final Specification that incorporates a Contribution from such Participant, on *royalty-free* and otherwise reasonable and non-discriminatory terms, a non-exclusive, non-transferable, world-wide license under any Necessary Claim that reads on such Contribution to use, make, have made, import, sell and offer to sell, lease, and otherwise distribute and dispose of those portions of Specification-compliant products that implement such Contribution. License terms may include but are not limited to: (1) conditioning the license on a grant of a reciprocal royalty-free license to all Necessary Claims owned or controlled by the licensee and/or its Affiliates that would necessarily be infringed by implementation of the applicable Specification; (2) revocation of the license should a suit for patent infringement be brought by licensee against the licensor; (3) a requirement that an implementer manifests an intent to accept the terms of the royalty-free license as offered by the licensor within a reasonable period of time; and (4) a prohibition on sublicensing.

(c) Trade secrets. Participants acknowledge that recipients of information disclosed in the context of a Specification development effort will have no obligation to keep such information confidential.

(d) Trademarks. No trademark licenses are granted in connection with UN/CEFACT participation or the submission of a Contribution.

(e) Warranties. Any and all Contributions are furnished "AS IS" with respect to this Policy. Participants do not make any warranties, express, implied, or statutory, including without limitation any warranty of merchantability or fitness for a particular purpose with respect thereto.

(f) Implementers of Specifications. Any individual or entity, including those that are not Members or Participants of UN/CEFACT, may implement a published final Specification, provided that the implementer abides by any Participant's, or any UN/CEFACT, reasonable and nondiscriminatory licensing terms that may apply.

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5. UN/CEFACT's Intellectual Property rights and obligations.

(a) Ownership of Specification Copyrights. UN/CEFACT shall own the copyright in draft and published final Specifications, subject to the underlying copyright rights of the contributing Participants and other copyright owners.

(b) No charge for Specifications. UN/CEFACT will not charge royalties or any similar fees in connection with the implementation or use of Specifications.

6. Disclosure and licensing of Intellectual Property other than in Contributions.

(a) Ongoing disclosure obligation. If an individual Participant in UN/CEFACT (even a Participant that is not part of a particular group) becomes aware that the legal entity on whose behalf the individual Participant is acting ("Represented Entity") owns or controls Intellectual Property that would, in the opinion of such individual, necessarily be infringed in the course of implementing or using a published final or draft Specification (excluding Intellectual Property that has been contributed in accordance with this Policy), then the individual Participant or the Represented Entity must alert the UN/CEFACT secretariat to this fact (such disclosure obligation shall endure even after the end of the review period discussed in Section 6(b)). For purposes of this Section 6(a), "awareness" means actual specific knowledge by an individual Participant who actively participates in UN/CEFACT meetings of both (1) this disclosure obligation; and (2) of the potential infringement of a particular published final or draft Specification. The UN/CEFACT secretariat will notify the UN/CEFACT Steering Group of this claim. However, nothing in this Section or anything else in this Policy imposes: (i) any positive duty or obligation to search Intellectual Property portfolios for such necessary Intellectual Property; or (ii) any licensing obligation on a Participant or Represented Entity that discloses such necessary Intellectual Property prior to the end of the review period discussed in Section 6(b), although if a Participant or Represented Entity chooses, in its discretion, to license such necessary Intellectual Property, it must do so on reasonable and nondiscriminatory terms.

(b) Review period. Each Participant (including those Participants that are not part of a particular group) shall have the opportunity to review any draft Specification (along with all other parties) prior to such draft Specification being approved and published as a final Specification. The Participants in the group that developed such Specification will confer and agree upon an amount of time, not less than thirty (30) days and not to exceed sixty (60) days, in which the review must be completed and the date on which the review will commence. Such review period shall be prominently announced on the UN/CEFACT website, and all UN/CEFACT Participants (including those outside the group that developed the draft Specification under review) shall be informed in writing (such as by e-mail) about the commencement of such review period. During the review period, all Participants shall have an opportunity to: (1) review the draft

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Specification; (2) identify any Intellectual Property owned or controlled by such Participant (other than Intellectual Property which such Participant has already contributed to the Specification under Section 3) that is either incorporated into such draft Specification (as the result of an unauthorized submission or otherwise) or that would, in the opinion of the Participant, necessarily be infringed in the course of implementing or using such Specification; (3) state the Participant's intention to license, under reasonable and non-discriminatory terms, or to decline to license, the Intellectual Property identified under the previous subparagraph; and (4) raise any specific objections to the draft Specification. In the event any Participant raises specific objections to a draft Specification in writing, or discloses its intention not to license certain of its necessary Intellectual Property, the group will confer and attempt to resolve such objections and issues during the review period. If, after such review period ends, a draft Specification is substantially modified, a subsequent review period shall be conducted, under the terms of this subsection, before the revised draft Specification is approved and published as a final Specification.

(c) Licensing obligation for necessary patent claims not disclosed prior to the end of the review period. Failure on the part of a Participant to disclose, either prior to or during a review period, any patent claims in its granted patents or [published] patent applications that would, in the opinion of such Participant, necessarily be infringed in the course of implementing or using the Specification under review, will result in an obligation by such Participant to grant licenses under Necessary Claims as if such infringing portions of the Specification were "Contributions" made by such Participant under Section 3.

7. Mechanism for accepting royalty-bearing Intellectual Property in extraordinary circumstances. If a UN/CEFACT Participant, which has not already formally joined a particular group, believes that a potential Contribution would significantly advance the efforts of that group but is unwilling to contribute in accordance with this Policy, the Participant may invoke the following process. The Participant can discuss a potential Contribution with the group without having the discussion be deemed a "Contribution" for the purposes of this Policy, provided that the Participant clearly identifies the potential Contribution as a "discussion document: not a Contribution" in writing in advance of the discussion and has not yet become a documented Participant in that group. If the group decides that the potential Contribution is so compelling as to warrant departure from the principle of royalty-free Contributions as set forth in this Policy, the group can recommend this course of action to the UN/CEFACT Steering Group. Upon such recommendation, the UN/CEFACT Steering Group will vote on the matter, and by majority vote can choose to accept the Contribution if (a) the UN/CEFACT Steering Group believes that the offered Contribution is unique, compelling, and necessary; and (b) the Participant offers the Contribution to all UN/CEFACT users on reasonable and non-discriminatory license terms. Any Specification that includes such a royalty-bearing Contribution will be clearly labeled accordingly. However, such "potential Contribution" identified as a "discussion document: not a Contribution", would not, in any case, be deemed a royalty-free Contribution without the consent of the Participant.

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8. Withdrawal of a UN/CEFACT Participant outside the context of a group. A

Participant may withdraw from UN/CEFACT at any time by notifying the UN secretariat in writing of its intention to withdraw. Withdrawal shall be effective upon receipt of such notice by the secretariat. To the extent a Participant is currently a part of a UN/CEFACT group, the withdrawal provision of Section 3(a) shall govern any rights and obligations of such Participant with respect to the Specification(s) being developed by such group. To the extent a Participant is not currently a part of a UN/CEFACT group, any rights and obligations that have arisen with respect to particular Specification(s) prior to the effective date of such withdrawal (such as a licensing obligation arising under Section 6(c) for failure to disclose necessary patent claims) shall continue in effect with respect to the particular Specification(s), even after the Participant's withdrawal. All rights and obligations of the withdrawing Participant other than those specifically referenced in this Section 8 or in Section 3(a) shall cease upon such withdrawal.