

## 9.8 Inclusion of Products

NEMA Standards shall ordinarily include all technically adequate equipment in the field; that is, all products which fall within the definitions or the criteria of the Standard.

Note: There may be certain limited circumstances, such as interchangeability Standards, where not all technically adequate products need necessarily be included.

## 9.9 NEMA patent policy - Inclusion of Essential Patent Claims in NEMA Standards

There is no objection in principle to drafting a NEMA Standard in terms that include the use of an essential patent claim if it is considered that technical reasons justify this approach.

No participant in the development of a NEMA Standard or proposed NEMA Standard shall knowingly conceal from NEMA or the other firms or persons participating in the development of a NEMA Standard or proposed NEMA Standard any patent or published patent application containing an essential patent claim that the participant (or any Affiliate) owns, controls, or has the ability to license.

Each participant in the development of a NEMA Standard or proposed NEMA Standard is encouraged to bring to the attention of NEMA and the other participants at any time during and after the development of the Standard any patent(s) or published patent application(s) that are believed to contain an essential patent claim, which (a) the participant owns, controls, or has the ability to license, or (b) is owned by others in the manner set forth in this policy. Participants in the development of a NEMA Standard or proposed NEMA Standard are encouraged to identify and disclose early in the Standards development process essential patent claims of which the participant has knowledge and provide a written statement as required by [9.9.3.3b](#) so that the relevant technical committee may consider this information in the course of the development of a NEMA Standard.

### 9.9.1 Definitions

#### 9.9.1.1 Essential Patent Claim

An “essential patent claim” means a claim contained in a patent or published patent application, the use of which is necessary to create a compliant implementation of the mandatory portions of the normative clauses of the NEMA Standard or proposed NEMA Standard when there is no commercially and technically feasible non-infringing alternative. An essential patent claim does not include any claim that is essential only for enabling technology (technology that may be necessary to make a product that complies with the NEMA Standard, but is neither explicitly required by nor expressly set forth in the NEMA Standard) or any claim other than that set forth above even if contained in the same patent as the essential patent claim.

#### 9.9.1.2 Knowledge or Knowingly

“Knowledge” or “knowingly” means or refers to the actual personal awareness by an individual of information relating to a particular matter. Knowledge shall not be deemed to include knowledge held by other personnel of the relevant individual participant’s sponsor or employer; *provided however*, that such sponsor or employer will not deliberately withhold relevant information from individual participants in NEMA standardization activities for the purpose of avoiding disclosure or licensing under this policy.

#### 9.9.1.3 Participant or Individual Participant

“Participant” means a NEMA Member of a Product Group authorized under Sections 5.1 or 5.3 to develop a NEMA Standard, and it also refers to an individual participant. “Individual participant” means the individual person representing or employed by a participant in the development of a NEMA Standard.

#### **9.9.1.4 Affiliate**

“Affiliate” means an entity that directly or indirectly through one or more intermediaries, controls, is controlled by, or is under common control with such entity. “Control” means ownership of or ability to direct more than 50% of the voting power of a corporation or other organization.

#### **9.9.1.5 Development**

“Development” means the entire effort in proposing, drafting, meeting and discussing, voting upon, revising, and reaffirming a NEMA Standard or proposed NEMA Standard.

### **9.9.2 No Requirement to Search Patent Portfolio**

Participants in the development of a NEMA Standard or proposed NEMA Standard do not have an affirmative duty to search their patent portfolio to determine if they own a patent containing an essential patent claim.

### **9.9.3 Disclosures of Essential Patent Claims**

To implement the policy of Section 9.9, the procedures in Sections [9.9.3](#) - [9.9.8](#) shall be followed.

#### **9.9.3.1 Self-Disclosure by Patent Holder**

A participant in the development of a NEMA Standard or proposed NEMA Standard, on behalf of itself, shall disclose in writing to NEMA essential patent claims that they (including any Affiliate) own, control, or have the ability to license as expeditiously as possible after that participant recognizes it has an obligation of disclosure under this policy. The disclosure shall be accompanied by the written statement required by [9.9.3.3B](#) below. A participant may also submit to NEMA at any time a written disclaimer as provided in [9.9.3.3A](#) below.

#### **9.9.3.2 Disclosure at Request of NEMA**

At the request of any firm or person who states that another identified party owns, controls, or has the ability to license an essential patent claim, NEMA shall request, without coercion, that the identified party, on behalf of itself (or any Affiliate as appropriate), provide the statement required by [9.9.3.3A](#) or [9.9.3.3B](#) below.

#### **9.9.3.3 Written Disclosure Statements.**

A participant or an identified party providing a written statement under [9.9.3.1](#) or [9.9.3.2](#) shall submit a written communication addressed to NEMA Vice President of Operations containing either:

- A. a statement containing an assurance in the form of a general disclaimer to the effect that such party (including any Affiliate) does not own, control or have the ability to license patents or published patent applications containing essential patent claim(s), but in the event that it is later discovered that such party (or any Affiliate as appropriate) does own, control or have the ability to license such patents, a license will be made available as prescribed in [9.9.3.3 B\(c\)](#); or
- B. a statement:
  - (a) identifying the patent registration or application number(s) of the patent(s) or published patent applications that is believed to contain essential patent claim(s);
  - (b) identifying the NEMA Standard or proposed NEMA Standard and the part and/or section of the NEMA Standard or proposed NEMA Standard that would include the use of an essential patent claim; and
  - (c) containing an assurance that a license to such essential patent claim(s) will be made

available by such party (or any Affiliate as appropriate) to applicants desiring to utilize the license for the purpose of implementing the Standard either:

- (1) under reasonable terms and conditions that are demonstrably free of any unfair discrimination; or
  - (2) without compensation and under reasonable terms and conditions that are demonstrably free of any unfair discrimination, or
  - (3) containing an assurance that the participant or identified party will not enforce any present and/or future essential patent claims against any person or entity making using, selling, offering to sell, importing distributing, or implementing such a compliant implementation; or
  - (4) provided that the written communication is received five (5) calendar days prior to the Codes & Standards Committee's approval of a NEMA Standard proposed for adoption, revision or reaffirmation, a statement that the participant or identified party is unwilling or unable to grant licenses according to [9.9.3.3 B\(c\)\(1\)](#) or (2) or to agree that it will not enforce its essential patent claims as described in [9.9.3.3 B\(c\)\(3\)](#) above, and
  - (5) at the option of the participant or identified party, that such license under (c)(1) or (2) is subject to a condition of reciprocity, where reciprocity means with respect to other parties that have a patent or published patent application containing an essential patent claim, the assurance under (c) is conditioned on their willingness to license their patent(s) containing an essential patent claim on these terms. A participant or identified party who provides an assurance to license without compensation under [9.9.3.3 B\(c\)\(2\)](#) on a condition of reciprocity, may require a license with compensation on reasonable terms and conditions that are demonstrably free of discrimination if the reciprocating licensee will only license on such terms.
- (d) stating that the assurance contained in the written communication will be brought to the attention of any future assignees or transferees of the essential patent claim, that the assurance will be included in any documents transferring ownership of patents subject to the assurance together with provisions sufficient to ensure that the commitments in the assurance are binding on the transferee, and that the transferee will similarly include appropriate provisions in the event of future transfers with the goal of binding each successor-in-interest. The assurance shall also indicate that it is intended to be binding on successors-in-interest regardless of whether such provisions are included in the relevant transfer documents.
- C. Without prejudice to any existing licenses granted to persons implementing a NEMA Standard, the assurance provided under [9.9.3.3B\(c\)\(1\)](#) or (2) may be withdrawn when it is established that there are commercially and technically feasible non-infringing alternatives to creating a compliant implementation of the NEMA Standard.
- D. A statement under this paragraph may be made in the form provided in Appendix F.

#### 9.9.4 Timing of Disclosure Statements

For so long as a participant is a Member of NEMA or, an individual participant in NEMA Standards development activities, a participant in the development of a NEMA Standard or proposed NEMA Standard shall continue to satisfy the requirements of [9.9](#). At the time a NEMA Standard or proposed NEMA Standard is submitted for approval by letter ballot under [5.3.2](#) or for a vote under [5.4.2](#), the participant shall provide the written statement required by [9.9.3.3](#). NEMA letter ballots shall contain a statement for compliance with [9.9](#), which states: "I state that [check one]:

- I am not aware of patents or published patent applications containing essential patent claims, which I or my employer or sponsor (or an affiliate of any of them) own, control or have the ability to license, but if it is later discovered after the NEMA Standard is approved that I, or my employer or sponsor do own, control or have the ability to license such patents, a license will be made available as required by NEMA

Standardization Policies and Procedures, [9.9.3.3B\(c\)\(1\)](#) or (2) or an assurance will be made pursuant to [9.9.3.3B\(c\)\(3\)](#);

- I am aware of patents or published patent applications containing essential patent claims, which I or my employer or sponsor (or an affiliate of them) own, control or have the ability to license, and a written statement has been submitted to NEMA as required by NEMA Standardization Policies and Procedures, [9.9](#).

#### **9.9.5 Record of Statement**

A record of the patent holder's statement under [9.9.2](#) shall be retained in the files of NEMA. The Vice-President, Operations shall cause a copy of the written communication to be sent to the firms or persons participating in the development of the NEMA Standard or proposed NEMA Standard that would include the use of an essential claim.

#### **9.9.6 Notice**

When NEMA receives from a patent holder the assurance set forth in [9.9.3.3](#) (c) above, the Standard shall include a note substantially as follows:

*Note – The user's attention is called to the possibility that compliance with this Standard could require use of an invention covered by patent rights.*

*By publication of this Standard, no position is taken with respect to the validity of any such claim(s) or of any patent rights in connection therewith. If a patent holder has filed a statement of willingness to grant a license under these rights on reasonable and nondiscriminatory terms and conditions to applicants desiring to obtain such a license, then details may be obtained from NEMA.*

#### **9.9.7 Responsibility for identifying patents**

NEMA is not responsible for identifying patents or published patent applications for which a license may be required by a NEMA Standard or for conducting inquiries into the legal validity or scope of those patents that are brought to their attention.

#### **9.9.8 Discussions of patent issues at technical committee meetings**

At technical committee meetings, firms or persons shall not discuss the following:

- (a) the construction, validity, or essentiality of patents or patent claims;
- (b) specific license rates, licensing costs, terms or conditions, or the relative costs of different technical approaches to the Standard; or
- (c) the status or substance of ongoing or threatened patent litigation.

#### **9.10 Metrication**

NEMA supports voluntary metrication of Standards. Each NEMA Product Group is required to make an informed decision whether to metricate its Standards. Product Groups shall identify Standards that will utilize the metric system and determine whether "soft" (exact conversion from imperial to metric) or "hard" (change product dimensions to conform more rationally to metric measurements) conversion is to be used.

Standards outside the control of the Product Group shall be brought to the attention of those responsible for the Standard. Additionally, each Product Group shall consider the impact of metrication of their Standards on other NEMA Product Groups.