

## **ADVANCED MEDIA WORKFLOW ASSOCIATION IPR POLICY**

### **FREQUENTLY ASKED QUESTIONS**

**October 24, 2013**

**NOTE: THIS FAQ IS PROVIDED TO ASSIST YOU IN UNDERSTANDING THE AMWA IPR POLICY. ABSOLUTLY NONE OF THE CONTENTS OF THIS FAQ ARE TO BE CONSTRUED AS BEING PART OF THE AMWA IPR POLICY. THE AUTHORITATIVE TEXT IS CONTAINED IN THE AMWA IPR POLICY ITSELF.**

Q: The current policy is different from the old one. Why did the AMWA change its policy?

A: Please see a detailed explanation below. To summarize, the AMWA found that its old policy was making it difficult for some companies to join the organization. Furthermore, the AMWA became aware that some of the defined terms and other language in its old policy deviated significantly from current standards development organization norms, making it difficult to review and evaluate. Additionally, the old policy required members to make IPR declarations regarding projects they were not interested in. The AMWA believes that the current policy is easier to interpret, more fair, and reduces the burden on members and potential members.

Q: When does the new policy take effect?

A: The new policy is scheduled to go into effect on January 1, 2014.

Q: What if I am unwilling to be bound by the new AMWA IPR Policy?

A: Then you may notify the AMWA that you wish to terminate your membership. You will not receive a refund of membership fees, however.

Q: Why does the AMWA have an IPR policy?

A: The AMWA is an organization that develops and maintains specifications and other deliverables. By definition, this means that the AMWA needs to have the legal right to distribute these materials without violating the copyrights of its members. In some cases, it is also possible that a specification or other material developed by the AMWA and its members might, if used as intended, result in the infringement of a patent claim by the user of that material. The AMWA and its members wish to ensure that when someone implements an AMWA Specification, it does not knowingly infringe upon patent rights of any member or, to the extent possible, any non-member. All formal specifications organizations have IPR policies for these reasons, although the exact terms of a given organization's IPR policy will vary somewhat depending upon the conventions of the industry it serves, the composition of its membership, the technologies involved, and other factors.

Q: Are the AMWA's concerns different from other standards and specifications organizations?

A: No. The AMWA's IPR policy addresses common concerns of organizations that create specifications.

Q: To whom does the AMWA IPR Policy apply?

A: It applies to every AMWA member, and to every individual that represents a member in connection with the AMWA technical process when they are serving in that role. When we use the word "you" below, we are referring to all of these individuals and entities. The policy also applies to non-members who receive copies of AMWA Draft Specifications, but only if those non-members comment on the draft.

Q: I am a member of the FIMS (Framework for Interoperable Media Services) project, or a task force or other joint project, and I have signed a participation agreement. Am I bound to this new IPR Policy?

A: Yes. In accordance with the participation agreement, you will be bound to the new AMWA IPR Policy, just as if you were an AMWA Member.

Q: Does the new policy allow both RAND and RAND-Z projects?

A: Yes; this is a major change from the old policy. The old policy only allowed RAND-Z projects. The new policy requires that each project be declared, at the outset, either RAND or RAND-Z only. RAND-Z only projects require licensing free of charge. RAND projects allow both RAND and RAND-Z declarations, where an owner can agree to license technology on RAND terms either with or without charge.

Q: I liked the fact that all AMWA Specifications were RAND-Z.

A: The AMWA will still have RAND-Z projects – in fact, all existing projects, and all existing AMWA Specifications will remain RAND-Z. It is only new projects that may be declared at the outset to be RAND, where implementers of AMWA Specifications might be charged a licensing fee.

The AMWA Board of Directors found that some companies would not join our organization because it did not allow selected projects to operate with RAND licensing. Furthermore, it is not uncommon for a base Specification to be RAND-Z, but for enhancement layers to be provided on a RAND basis. The new policy allows both modes, and requires that the mode be declared at the beginning of each project.

Q: The old policy contained a provision that bound members to providing a RAND-Z license to implementers if they failed to respond to an IPR review. Is this still a provision of the new policy?

A: Yes – but with a few twists.

Participants in Working Groups are under an ongoing obligation, from the outset, to draw the attention of the AMWA to any known IPR contained in any Draft Specification or Contribution. Working Group chairpersons are required to present a Patent Call at the beginning of each Working Group activity reminding members of this obligation.

For RAND-Z projects. Participants are required to provide a RAND-Z license for any Owned IPR. A Participant may choose not to provide a license of any kind, but we require that the Member withdraw from the project, and to withdraw from the AMWA without a refund of member fees if the Member is unwilling to provide a RAND-Z license. It is a fundamental tenet of RAND-Z Only Working Groups that everyone Participating agrees to license IPR on a RAND-Z basis. The policy seeks to prevent game-playing by Members who might try to take advantage of others in a RAND-Z environment.

For RAND projects. Participants in RAND projects may agree to provide either a RAND license or a RAND-Z license for any Owned IPR. However, for the same reason as above, it is permitted for a Member to not license under either of these terms, but that Member must withdraw from the Working Group and their membership in the AMWA will be terminated without a refund of fees.

Q: Having to resign without a refund for withholding a license sounds extreme. How do I know I will not find myself in this position?

A: Every Project will have an Approved Project Proposal, which will provide a detailed description of the scope and nature of the deliverable that the Project has been chartered to develop. Any Member should be able to use this document as a way to assess whether it does or does not have patented technology that might be useful in creating that deliverable. If it would not want to make that technology available, it can avoid all obligations simply by not joining the Project, or commenting on a draft of the deliverable. And in a RAND (as compared to a RAND-Z) Project, it will be free to charge a fee for its technology if it does get included in the deliverable.

Q: How will I know if I need to worry about patents at all when I consider joining a Project?

A: The Project Proposal must also designate whether the Project expects to produce an AMWA Specification or "Other Work Product." Other Work Product means material such as a white paper, guidance document or other material that is highly unlikely to have the potential to infringe a patent.

Q: Can I look at documents without becoming a Participant?

A: The new policy contains a "free look" period of sixty days from the launch date of each project. Members may attend meetings and look over any Working Group documents within that period without becoming a Participant. However, once the initial sixty-day period is over, all Members who remain in the Working Group will become Participants and the obligations of a Participant will apply. If you join a

Working Group later than sixty days after the launch date, you become a Participant immediately; the “free look” period does not apply.

Q: If I make a contribution to an AMWA project, do I give up ownership of that contribution?

A: Absolutely not. You remain the owner of all contributions made to the AMWA. However, you do grant the AMWA the right to make Specifications from your contribution, and to copyright that work.

Q: I am a consultant and am under a Non-Disclosure Agreement (NDA) with one of my clients. What are my obligations under the AMWA’s IPR policy if I’m aware of a patent owned by the client that might be infringed by a draft AMWA specification?

A: As long as you have not entered the NDA in order to avoid having to make disclosures under the IPR Policy, then you are only obligated to make a disclosure that does not violate the terms of the NDA. However, at a minimum you will still be required to disclose the fact that you have knowledge of what may be a Necessary Claim, and you would also be required to identify the portion of the Draft Specification that would result in infringement of the Necessary Claim.

Q: The old policy required that every contribution be accompanied by a written, standardized contribution form. Is this still the case?

A: Yes – all contributions made to any Working Group require a standardized written contribution form. This form requires the disclosure of any Necessary Claims contained in the contribution, and the terms under which the contribution is made.

Q: What is the basis for making an IPR disclosure?

A: The new policy states “Any Member Participating in a Working Group should, from the outset, draw the attention of the AMWA to any known IPR contained in any Draft Specification or Contribution”. It further states, “the information shall be provided in good faith and on a best-effort bases, based upon the personal knowledge of the Member’s Representative”.

Q: Does the AMWA require a patent search?

A: The AMWA never requires a patent search.

Q: I noticed that in a RAND-Z Working Group Participants are not allowed to make an IPR election during the IPR Review Period. Furthermore, at the beginning of the IPR Review Period, all Participants will be automatically deemed to have granted a RAND-Z license to any Owned IPR at that time. This seems wrong.

A: Remember – everyone Participating in a RAND-Z Working Group has an ongoing obligation to disclose any Owned IPR, and an obligation to license that IPR on RAND-Z terms. They can choose not to license Owned IPR on these terms, but

they must withdraw from the Working Group, and their membership in the AMWA will be forfeited. This strict obligation is mitigated by the requirement that every project have an Approved Project Proposal describing the scope of the project, and the sixty-day "free look" period at the beginning of the project. A Member may withdraw from a Working Group prior to the expiration of the sixty-day period without becoming a Participant. However, once the sixty-day period has elapsed, the obligations of a Participant apply.

If you are a Participant of a RAND-Z Working Group, then by the time the Draft Specification is ready for IPR review, you have already seen multiple drafts, and you have had ample time to make any IPR declarations. You have also been notified that the Draft Specification is going to be posted for IPR Review. If you are still Participating, and you have not made any indication that you intend to withhold IPR, then the default position is that you grant a RAND-Z license to any Owned IPR in the Draft Specification. Therefore, a formal election is not required and the AMWA does not request one.

One reason we take this position is to force the early declaration of IPR. If a Member were to withhold the fact that they know about IPR in a Draft Specification until the last moment, it might make it difficult or impossible for the Working Group to remove that Necessary Claim from the Specification.

Q: Unlike RAND-Z Only projects, you allow Participants to make IPR elections during the IPR Review Period for RAND projects. But the default for non-responsive Participants is still to grant a RAND-Z license – correct?

A: This is correct. The election is necessary because Participants in a RAND Working Group may choose to grant RAND or RAND-Z licenses to any Owned IPR. We want to give Members the opportunity to declare which license they wish to offer. However, as you correctly note, if an IPR Review Period closes and a Participant fails to respond, they will be deemed to have elected to provide RAND-Z licenses to all implementers.

Q: You keep referring to Participating in a Working Group and a Participant. This seems like an important concept. Who, exactly, is a Participant? What is meant by Participating?

A: You are a Participant if you are Participating in a Working Group. Of course, this begs the question, what is the definition of Participating. You are Participating if a) you remain in a Working Group after the initial sixty-day "free look" period, b) if you join a Working Group after the initial sixty-day period, c) if you are a non-Member attending a Working Group, or d) regardless of whether you are a Member or non-Member, if you submit comments on a Draft Specification prior to its becoming an AMWA Specification.

Let's look at each of these cases. The first three are pretty clear-cut. If you remain in a Working Group after the "free look" period, or if you join a Working Group after the "free look" period has ended, then you are a Participant. If you are

invited to attend a Working Group meeting, even if you are a non-Member, then you are a Participant.

Finally, If a Member or non-Member submits a comment on a Draft Specification, as part of an IPR Review, then they are Participating by virtue of their submission. The fundamental idea is that, if you can influence the content of an AMWA Specification, then you should be subject to the obligations of a Participant. Otherwise, all a non-Project Member would have to do would be to submit a suggested addition to a Draft Specification, and then wait until lots of companies had already started selling compliant products. It could then charge whatever it wanted to, and on a discriminatory basis as between vendors. On the other hand, if you have no interest in the activities of a particular AMWA Working Group, and you have not met any of the conditions above, then you should not have to pay attention to Draft Specifications, nor should you be subject to default declarations for any Owned IPR.

Q: The old policy required me to enter an IPR declaration for every Draft Specification that was sent to members for IPR review, even if I had no interest in the project. Is this still the case? There are some projects in the AMWA that I do not care about.

A: We have changed the policy in this regard. Any IPR policy is a balance of risk and benefit. We have decided that requiring every member to conduct an IPR review is both costly and inconvenient. We have also decided that the place where someone could cause the most mischief is in the Working Group during the drafting stage when someone could introduce language or offer edits that steer the draft in the direction of a patent. For that reason, we only require that Participants make IPR elections, and that only Participants are subject to default declarations if they fail to respond.

### **Member Obligations (copyrights and trademarks)**

Q: What are my obligations regarding copyrights?

A: Like the IPR policies of other organizations, the AMWA IPR Policy says that members continue to own the copyright in any submissions or other contributions they make, while requiring members to acknowledge that the AMWA will own the copyright in every final AMWA Specification and Other Work Product.

Q: That leaves trademarks. What are the rules there?

A: The AMWA can't use the trademark of a member (other than to indicate that it is a member) without its permission, and a member can't use a trademark owned by the AMWA (except to indicate its membership in AMWA) except with the permission of the AMWA. In particular, members cannot use the AMWA name, the name of an AMWA Specification, any AMWA Mark, or the title of any Other Work Product in a member product or service name, as this could destroy the AMWA's ability to use its trademarks to maintain the quality of its AMWA Specifications and Other Work Products in the marketplace.

## **Process and Administration**

Q: How are Necessary Claims disclosed?

A: In the case of Projects that develop AMWA Specifications, the AMWA uses standardized forms where all you need to do is check the box of the option that you choose. In the case of Projects that develop Other Work Product, there are no forms to be filled out or other special requirements.

Q: What if we have a patent with Necessary Claims, but don't want to bother with licenses?

A: It's fine to simply commit not to sue an implementer.

Q: What if an implementer sues me, though?

A: The IPR Policy would allow you to revoke your commitment not to sue them for infringing your patent. In fact, if they sue any other implementer, your commitment not to sue them would no longer apply. This levels the playing field, and provides an incentive for the pool of protection to grow.

## **New IPR Policy**

Q: Why is the AMWA adopting a new IPR Policy?

A: The AMWA's original IPR Policy was adopted at a time when the AMWA was taking over the Advanced Authoring Format (AAF) from the organization that had originally created it. Because the original policy related to a single AMWA Specification, it was reasonable for it to be very restrictive. Also, the predecessor organization had specific goals they wanted to achieve with its policy, some of which are not applicable to the AMWA. Unfortunately, this resulted in a policy which deviated significantly in some areas from the norm for organizations developing specifications. The AMWA now has more members, more Projects and more deliverables, and it would be unnecessarily burdensome to require all members to continue to be subject to each of these restrictions. The original policy also required prospective members and members to conduct thorough patent searches; something that was a significant burden for companies with tens of thousands of patents, and a focused interest in the activities of a specific AMWA Project. The new policy has dropped this requirement. Finally, the original policy was also rather lengthy, and included language that some members and potential members found difficult to understand. For all of these reasons, the AMWA has found it difficult to recruit new members, which is restricting its ability to execute on its mission. As a result, the AMWA Board of Directors decided that it would best serve the needs of the AMWA's current and future members if a new policy was adopted that was shorter, clearer, less restrictive, and more consistent with the IPR Policies of other organizations.

Q: What has changed?

A: Here is a summary of the most meaningful changes:

- The IPR Policy no longer binds a member's parent, sister companies, or subsidiaries. The old, more expansive term made it difficult to recruit large companies with complicated corporate structures.
- The definition of a "Contribution" is now narrower than it used to be (it used to capture anything, for example, that was mentioned in the minutes of a meeting). Now, only a submission made in writing, accompanied by a Contribution Form, is subject to the licensing requirement. This makes it more likely that companies with very large patent portfolios will feel comfortable joining AMWA.
- New members no longer must agree to provide a RAND-Free license to all of their Necessary Claims under AMWA's already existing AAF Specification, meaning that potential members need no longer review their patent portfolios in order to determine what immediate effect joining might have on their intellectual property rights.
- Standard forms must now be used in connection with a Contribution or a licensing commitment. This protects against the consequences of inadvertent vagueness or deliberate game-playing.

Q: If I have any other questions, who can I contact?

A: Send inquiries to [ipr@amwa.tv](mailto:ipr@amwa.tv).