

Standards-related Patent Registers

Who needs them and what
should they look like?

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ETSI & EPO cooperation - a shining example

- ETSI database is leading example of 'shop window' for disclosed patents
- Enhancement with EPO input on patent families is one of a kind in the world
- Broad definition of 'patent family', includes divisionals
- More complete picture of all patents in family → maximum transparency

Patent Registers

Reliability

- Database is only as good as the core content
 - Disclosure of essential patents based on “self-certification” & delicate balance:
 - No or late disclosure → patent ambush (anti-competitive)
 - Over-disclosure distorts market perception of true ownership and licence dues
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- Onus on patent owner to “get it right”
 - General ex-ante FRAND declaration (for all essential patents) reduces reliance on database accuracy

A photograph of a green lawn with several colorful deck chairs (yellow, pink, green, blue, orange) scattered in the background. The text "What ifs.....?" is overlaid in white on the lower left portion of the image.

What ifs.....?

1. Prior Art

- EPO conducts “prior art” search on all patent applications

What If.....?

- For patent applications disclosed as essential to ETSI...
- EPO flags standard-related prior art not on ETSI database
- Tag on EPO database and/or notify ETSI
- More complete picture of standards–related patents
- No longer just “self-certification” by patent owners
- Covers patents owned by non-members of ETSI

BUT

- EPO cannot determine essentiality - or make a FRAND commitment

2. EPO complementing ETSI

- EU Patent Regulation includes **Licence of Right (LoR)** provision - Art. 20
- Patent owner can *voluntarily* notify the EPO that licences are available 'as of right' - in return for appropriate compensation
- Recorded on EPO database for all to see
- Third parties then entitled to use the patent as a contractual licensee
- Patent owner benefits from reduced renewal fees

BUT

- **FRAND Commitment is analogous to LoR.....**

2. EPO complementing ETSI

What If.....?

- Extend LoR to standards-related patents - prescribe in EU Patent Regulation
- FRAND declarations in ETSI may also be registered at EPO
 - Greater transparency
 - Enhances legal certainty about availability of licences – statutory basis
- Voluntary for essential patent owners
- Patent owners benefit from reduced renewal fees

- **Note:** this complements ETSI process. It does not replace or change it

Thank you

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