

Inbound and outbound IP flow

Goals

We want a "flat" IP-flow policy, whereby the right to use contributions to the Spec (and to the RI and TCK where applicable) are granted directly to implementers rather than flowing through the Spec Lead. (The Spec Lead should be treated as just another implementer.)

Definitions

- **Contribution:** any comments, specifications, code or other materials, or ideas made or disclosed to an Expert Group by any means concerning the subject matter of the JSR for which that Expert Group is formed.
 - The current version of the JSPA has a weird distinction between contributions that are disclosed in “recorded form” and those that are not. This should be eliminated.
 - This definition must be broad enough to cover direct contributions to the RI and/or the TCK. (Non-JSPA signatories who contribute to the RI or TCK must be covered separately by some other kind of CLA.)
- **Compatible:** an implementation of a Java technology is Compatible if it meets the requirements specified in the language equivalent to (a) – (c) of Section 5.B in the current version of the JSPA.
- **Essential Patent:** a patent for which a Compatible implementation of a Specification cannot be created in a technically feasible manner without violation.
- **Output:** the Specification and associated Reference Implementation and Technology Compatibility Kit generated by an Expert Group with respect to the JSR for which that Expert Group is formed.
- **Process:** the version of the Process Document under which a particular JSR is being run.

Inbound IP flow

IP Grants from Contributors

Everyone who contributes to a JSR (whether or not they are members of the Expert Group) with respect to their copyrights, trade secrets, and Essential Patent Rights in their Contributions, grants a perpetual, non-exclusive, worldwide, royalty-free, fully paid-up license permitting those Contributions to be:

- disclosed, distributed, reviewed, and publicly discussed as necessary to meet the transparency requirements of the Process before and after the JSR is completed.
- modified and incorporated into the Output and into future versions of the Output as these are evolved through the Process.
 - The Spec Lead has the right to create derivative works but other implementers do not. Can we word this in such a way that the Spec Lead is not called out as “special”? Do we need to use the term *derivative works* at all?
- incorporated into Compatible implementations of the current and any future revisions of the Spec.
 - We should remove the current distinction between implementations derived from the RI and Independent Implementations.

IP grants with respect to Contributions are absolute, and may not be withdrawn.

Essential Patent grants from EG members with respect to material they did not contribute

Expert Group members make royalty-free grants with respect to their Essential Patents even as these relate to material contributed by others. Grants with respect to material that they did not Contribute may be revoked if they disclose the relevant patents and withdraw from the Expert Group prior to Public Review.

Is Public Review the appropriate time? Things may still change after that.

Instead – permit withdrawal at any milestone. If you let the milestone pass without disclosing and withdrawing then you’re on the hook for any patents that are Essential to the spec as it was at that point.

Note: the current JSPA obligates EG members to disclose Essential Patents at any time they acquire knowledge of them. We should probably add a similar requirement.

W3C and OASIS encourage EG members to speak up if they suspect another company may have an Essential Patent. Should we do the same?

Not in the JSPA. Maybe put this as a “recommendation” in the Spec Lead Guide.

Essential Patent licenses from non-EG members

- This obligation is considerably weaker than the current Section 6. Is this what we want? If so, doesn't that run counter to a desire for full ex-ante disclosure?
 - Yes - this is the goal. We want full disclosure of what you know about but are not willing to require a patent-search.
- For the record: do we want to drop "section 6" (the obligation that those who are not members of the EG and who do not otherwise contribute to a JSR must license Essential Patents) altogether?
- For the record: if we want to keep "section 6 obligations" do we want to switch the obligation from FRAND to Royalty-Free?
- Who must disclose? The primary contact for the member? Anyone who has served on an EG on behalf of the member?
 - The PMO will issue Disclosure Requests to the primary contact for member organizations as JSRs reach specified stages of the process (at each stage of the process?) These will remind members of their obligation to disclose.
 - **How** a member chooses to respond (who within the organization to ask, whether to do a patent-search) is up to them.
- In addition, the download page for each JSR could contain a general notice asking the world to inform the Spec Lead if they know of or suspect the existence of an Essential Patent (whether or not held by them).
 - Do we want to (is it even legal to) encourage people to "inform" on others?
- Section 6 currently permits declared patents to be withheld. Do we want to make a similar provision?
 - Yes. Otherwise there would be no way for a member company to protect its "crown jewel" patents without withdrawing from the JCP (and withdrawal is not an option for Oracle).
- Is there any obligation to license patents that are **not** disclosed?
 - Yes.
- If a patent is not disclosed is the patent-holder later able to assert it and to demand royalties?
 - The RAMBUS case suggests yes.
- Would we want to ensure that non-disclosed patents could not be asserted if this were legally possible?
 - If so, maybe we can write explicit language into the JSPA saying "I commit not to assert any of my Essential Patents unless I disclose them at the appropriate time." Ask the lawyers.
 - Another possibility: penalties for asserting non-disclosed patents – perhaps losing IP rights granted through the JCP in a manner similar to what we will propose in the *Defensive Termination* situation?

No member is obliged to grant patent rights to those who are unwilling to make a reciprocal grant.

Discussion at the September f2f meeting

Our current "three wise men" proposal:

JCP members who are not members of the Expert Group and who do not contribute to the JSR have an obligation to disclose any Essential Patents of which they have personal knowledge. Having done so they are obligated to grant rights to these patents on FRAND terms.

This language is vague – and may be unenforceable.

Alternative proposal:

Replace the section 6 obligation to license essential patents on FRAND terms with language stating that if you institute a lawsuit against someone for patent infringement then you lose all the royalty-free grants that have been made to you for any JSR.

Options (what problem are we trying to solve)?

1. No change
2. Remove the obligation that non-EG-members (and non-contributors) have to license Essential Patents on FRAND terms.
3. Keep the obligation, but limit to personal knowledge
4. The "three wise men" proposal
5. Drop the obligation but add a defensive termination clause (may be restricted to a particular area or may be "all of Java"). The defensive clause applies only if you don't disclose. Restricted scope: rights to patents on the JSR. If the JSR is included in an umbrella JSR then the rights to all patents bearing on all JSRs contained within the umbrella JSR.

Proposal from Mike Milinkovich

Add a defensive patent license termination clause.

- a. This will need to be in the JSPA, and the Spec License.
 - i. The JSPA to handle #2 below for signatories
 - ii. The Spec License to provide a defensive patent license termination clause for the entire Java ecosystem.

Any lawsuit that attacks any conforming implementation on the grounds of infringement of Essential Patents will trigger a termination of patent licenses granted as specified in the *Proposed Scope* below.

- b. Proposed scope of patent license termination (based on the assumption that all of Java is too broad):
 - i. Patent license to the Specification (e.g. JSR) in question.
 - ii. PLUS, if that Specification is included in an umbrella JSR, then in addition to (i), all patent licenses granted by all of the individual JSRs contained in the umbrella JSR would also be terminated.

2. Remove the obligation that non-EG-members (and non-contributors) have to license Essential Patents on FRAND terms.

- a. This will need to be in the JSPA.
- b. But, similar to the existing 6(ee): “if, with respect to the Spec (or RI or TCK related thereto) in question, You identify prior to Public Review the nature of the perceived infringement with specificity...” then “You” will have complete freedom of action with respect to your patents, without the threat of the defensive patent license termination.

Defensive termination

Patent grants are terminated if the licensee initiates litigation with respect to technologies developed through the JCP. (A Spec Lead initiating litigation in defense of the subject specification would not trigger this defensive termination clause.)

- Should offenders lose all the rights they have been granted through the JCP or only the rights for the particular JSR?
- NOTE: Although defensive termination clauses make sense with respect to Royalty Free patent grants they don't seem to align with FRAND grants. (It makes no sense to make FRAND grants part of your IPR policy and at the same time to say that anyone who actually tries to collect royalties will suffer retaliation.) If this is so then we would have to limit defensive termination clauses to the RF grants made by contributors (which seems to be what the current JSPA does) and possibly also to the case where a member asserts a non-disclosed Essential Patent under the “section 6” obligations.

Non-assertion language as an alternative to explicit patent grants

Should we use non-assertion language as an alternative to the specific granting of patent licenses?

If so, this non-assert language should probably be restricted to the RF grants made by contributors since – once again – it doesn't seem to fit with FRAND grants.

Since Oracle is not the “You” specified in the JSPA we must include language stating that Oracle makes similar commitments.

Copyright in the “collective work” of the Spec will vest in the Spec Lead.

Outbound IP Flow

Will be covered by the Spec License (which will grant all necessary IP rights to Compatible implementations of the spec) by the approved Open Source RI and TCK licenses, and the approved Commercial RI and TCK licenses.