



USPTO and UKIPO Announce Collaboration Effort on Standard Essential Patent Policies

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The United States Patent and Trademark Office (USPTO) and the United Kingdom Intellectual Property Office (UKIPO) have signed a memorandum of understanding (MoU) that outlines a new framework for collaboration between the two offices on policies relating to Standard Essential Patents (SEPs).

SEPs are patents that have been declared by the patent owner as “essential” to practice a particular technical standard such as Wi-Fi, LTE, 5G, Bluetooth and HEVC. In order to have input on a standard, owners of SEPs are often required by the organization developing the standard to agree to license SEPs to licensees on Fair, Reasonable and Non-Discriminatory (FRAND) terms.

Unlike patents, which are limited in jurisdictional scope, standards are commonly implemented globally. In recent years, as increased interoperability and interconnectivity has become ubiquitous across all manner of technology, the patchwork nature of SEP policies and laws in countries around the world has grown increasingly more nuanced and complex. As such, this recent announcement of the U.S. and U.K. patent offices to work together to harmonize SEP policies has the potential to positively impact the broader SEP global policy landscape.

The USPTO has outlined certain key objectives of the agreement that aim to see the two patent offices:

- Cooperate on activities to facilitate collaboration and exchange of information on policy matters concerning SEPs, to better ensure a balanced standards ecosystem.
- Explore means to educate small and medium-sized enterprises seeking to implement or contribute to the development of technical interoperability standards on FRAND terms.
- Examine ways of improving transparency in the FRAND licensing of technical interoperability standards.
- Engage in outreach to stakeholders to raise awareness of issues related to SEPs.
- Discuss means to incorporate additional jurisdictions into the USPTO's and the UKIPO's activities concerning SEPs, including exploring a venue for such broader discussions.

The term of the MoU is five years, and it comes at a pivotal time for SEPs globally. For example, although SEP license negotiations commonly involve global patent portfolios, the parties to those negotiations often lack basic guidance as to what court (if any) has the authority to determine a global FRAND rate, as well as what country's law applies to a given FRAND rate determination analysis.

Critically, the European Patent Office is presently working closely with lawmakers at the European Parliament on significantly streamlining many of these and similar issues, including mandatory SEP registrations, SEP essentiality checks, FRAND determinations and potential alternative forms of dispute resolution, among others. All of these issues are highly relevant to parties with U.S. and/or U.K. intellectual property interests. To that end, the specifically stated objectives of the U.S. and U.K. to bring other jurisdictions to the table has the potential to further harmonize key issues across the globe.

Categories

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Patent Law

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