



The Global Language of Business

GS1 IP Advisory Group (IPAG) Process Manual

describes the role and operating procedures of the GS1 IP Advisory Group (IPAG) within the framework of the GSMP and GS1 IP Policy

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Table of Contents

1	Introduction	4
2	IP Advisory Group (IPAG).....	4
2.1	What is an IPAG and when is it formed	4
2.2	Role of the IPAG	4
2.3	IPAG Composition	5
2.4	IPAG Charter	5
3	Communication of IP Declarations.....	5
3.1	IP Declarations relating to published patents (not withdrawn).....	6
3.1.1	Communication to the IPAG and Working Group	6
3.1.2	Communication to the General Public.....	6
3.2	IP Declarations relating to published patents (withdrawn)	6
3.2.1	Communication to IPAG and the Working Group	6
3.2.2	Communication to the General Public	6
3.3	IP Declarations related to unpublished patent applications.....	6
3.3.1	Communication to IPAG and the Working Group	6
3.3.2	Confidentiality Agreement.....	6
3.3.3	Withdrawn IP Declarations - unpublished patent applications.....	7
3.4	Disclaimer.....	7
3.5	Treatment of Confidentiality Agreements by IPAG members	7
4	Treatment of IP Declarations.....	7
4.1	IP Declarations related to unpublished patents and design-arounds.....	7
4.2	Communication of IP Declarations - Summary	8
5	Timing of IP Disclosures	8
5.1	Recommendations regarding the disclosure of relevant IP	9
6	Publication of names of Working Group Members.....	9
7	Document Retention	9

1 Introduction

While no standards development organisation can guarantee that all of its standards will always be free from third party patent claims, through its IP Policy, GS1 seeks to develop standards that can be practiced on a royalty-free basis to the greatest extent possible.

As a condition for participating in a GS1 standards development Working Group, participants are required to sign the GS1 IP Policy and agree to its terms and conditions. The objective of the IP Policy is to obtain royalty-free or RAND (reasonable and non-discriminatory) licensing commitments from companies participating in GS1 Working Groups.

The IP Policy covers Necessary Claims in patents that cover the required features or functions in a GS1 standard. A patent claim is a Necessary Claim only when it is not possible to avoid infringement as there is no non-infringing alternative for implementing the required features or functions of the standard.

Patent claims covering optional features and improvements relative to a standard are outside the scope of the IP Policy.

Under the IP Policy, a Working Group participant may request RAND licensing terms for its Necessary Claims in patent rights rather than giving a royalty-free license. If such is the case, the participating company needs to submit an IP Declaration to GS1. The IP Declaration Form can be downloaded from the following website:

http://www.gs1.org/sites/default/files/docs/ip/GS1_IP_Declaration.pdf

If a participating company does not submit an IP Declaration relative to its Necessary Claims covering the required features or functions in a standard, any such Necessary Claims are licensed royalty-free.

2 IP Advisory Group (IPAG)

2.1 What is an IPAG and when is it formed

An IPAG (IP Advisory Group) is an ad-hoc group that is set up at the request of the Working Group or at the initiative of GS1 to help resolve or avoid anticipated intellectual property (IP) issues. An IPAG may be launched in one of the following circumstances:

- At the very beginning of the standard development work and the creation of the Working Group, when it is anticipated that the standard in question may face IP issues (e.g. technology area).
- During the standard development process, as soon as an IP Declaration is made by a Working Group participant or when a patent with Necessary Claims from outside the Working Group is revealed that may not be available on royalty-free terms. In the event of an IP Declaration, the Working Group Facilitator will inform the members of the Working Group that an IP Declaration has been received and that an IPAG will be formed to address the IP Declaration. Working Group members with voting rights will be invited to join the IPAG. Participation is voluntary.

2.2 Role of the IPAG

The responsibilities of the IPAG will include the following:

- a. Reviews IP Declarations made by Working Group participants.
- b. Sends incomplete IP declarations back to the IP Declarant for completion when required information is missing.
- c. Evaluates if the declared claims in the IP Declaration are Necessary Claims relative to the standard and whether such claims are valid claims. The opinion of legal counsel will be sought where necessary.

- d. Negotiates to have the IP Declarant withdraw its IP Declaration and grant a royalty free license.
- e. If following the IP review process, the cited claims are considered Necessary Claims, can either
 - i. accept the RAND licensing terms or,
 - ii. send the specification back to the Working Group for possible revision ('design around') to eliminate the required features or functions covered by the Necessary Claim(s).
- f. Can decide to terminate the standard development effort and the Working Group.
- g. Makes the IP Declaration available to the Working Group members (see [3.1](#) and [3.4](#)).
- h. Decides to initiate prior art reviews at the onset of a standard development activity or following an IP declaration.
- i. Ensures that the RAND licensing terms, where applicable, are communicated in conjunction with the published standard.
- j. Ensures that the appropriate disclaimer is released in conjunction with the published standard.

2.3 IPAG Composition

Working Group members with voting rights, GS1 staff members participating in the Working Group and GS1's legal counsel may participate in the IPAG. Working Group members that have submitted an IP Declaration are automatically included in the IPAG. In addition, GS1 Global Office senior management may participate in the IPAG, if judged necessary (e.g. complex and important IP issue). Outside experts may be invited to join at the discretion of the IPAG. There is no limit to the number of members unless otherwise specified in the IPAG Charter.

Working Group members are not obliged to join the IPAG and participation is on a voluntary basis. Non-voting Working Group members are not eligible to join an IPAG. The members will choose a Chairman from among the members of the IPAG.

2.4 IPAG Charter

Each IPAG will develop its own Charter. The Charter will define the following areas:

- Clear goals for the IPAG, including target dates where applicable
- Expected duration of the IPAG
- Confidentiality status – when reviewing declarations covering unpublished patent applications (see [3.3](#))
- Maximum number of participants, if applicable.

The IPAG may agree changes to its Charter, as appropriate. The Charter will be made available to the members of the Working Group. During the time the IPAG is operating, the Working Group may continue its technical work within the bounds of its Charter.

3 Communication of IP Declarations

IP Declarations from Working Group participants may cover published patents or unpublished patent applications. The scope and target of the communication will differ depending on whether the IP declaration refers to published patents or unpublished patent applications and whether the IP declaration is subsequently withdrawn by the IP declarant.

3.1 IP Declarations relating to published patents (not withdrawn)

3.1.1 Communication to the IPAG and Working Group

IP Declarations relating to published patents are communicated to members of the IPAG and the Working Group. However, the IP Declaration is not immediately shared with the Working Group members. During a 2-3 week consultation period, the IPAG will first attempt to encourage the IP declarant to withdraw its IP Declaration and grant a royalty-free license to its Necessary Claims relative to the draft standard under development. Only if the IP declarant does not wish to withdraw its IP Declaration and grant a royalty-free license to its Necessary Claims will the IPAG share the IP Declaration with the Working Group.

3.1.2 Communication to the General Public

An abridged version of the IP Declaration will be made available to the general public via the GS1 website once the standard is released. For the avoidance of doubt, the general public comprises subscribers to the GS1 GSMP Community and the public at large. The communication to the general public will be limited to the following information:

- name of the patent owner/assignee
- patent number/country
- the RAND licensing terms where applicable.

Other information contained in the IP Declaration such as the description of the asserted Necessary Claims, list of relevant sections of the GS1 standard covered and, justification for the assertion that the subject matter of the cited Necessary Claim(s) is considered necessary to implement the standard is not communicated to the general public with the published standard.

3.2 IP Declarations relating to published patents (withdrawn)

3.2.1 Communication to IPAG and the Working Group

If the IP Declaration is withdrawn during the 2-3 week consultation period with the IP declarant, the IPAG no longer needs to share it with the Working Group.

3.2.2 Communication to the General Public

The abridged version of an IP Declaration relating to a published patent that has been withdrawn is not shared with the general public, unless the IP declarant agrees.

3.3 IP Declarations related to unpublished patent applications

3.3.1 Communication to IPAG and the Working Group

IP Declarations related to unpublished patent applications will be communicated to GS1 and the members of the IPAG. The information is not communicated to the whole Working Group, except in the case of an attempted 'design around' (see [4.1](#)).

3.3.2 Confidentiality Agreement

If requested by the IP declarant, the IPAG members (company representative or individual if representing him/herself) will be asked to sign a Confidentiality Agreement before reviewing the IP Declaration relating to an unpublished patent application. If an IPAG member is unwilling to sign the Confidentiality Agreement and does not wish to receive a copy of the IP Declaration, the member will be asked to withdraw from the IPAG but can remain a member of the Working Group.

3.3.3 Withdrawn IP Declarations - unpublished patent applications

If the IP declaration relating to an unpublished patent application is withdrawn during the 2-3 weeks consultation period, it is not shared with the members of the Working Group. These withdrawn declarations are never communicated to the general public.

3.4 Disclaimer

All GS1 standards will be published with a disclaimer stating that compliance with the standard may require a license under certain patent rights and certain implementations. Users will be reminded that the determination of a need for a license should be made by the company or organisation itself in consultation with its patent counsel.

3.5 Treatment of Confidentiality Agreements by IPAG members

When an IP Declaration is made related to an unpublished patent application and the IP Declarant has requested that its contents may only be communicated under a Confidentiality Agreement, each member of the IPAG will need to determine:

- Whether the Confidentiality Agreement is signed on behalf of member's company/organization or, by the IPAG member representing him/herself.
- If the Confidentiality Agreement is signed on behalf of the member's company/organisation, to which extent the information contained in the IP Declaration may be shared within the company/organisation. This is a decision for the company/organisation in consultation with its legal counsel.

4 Treatment of IP Declarations

The IPAG and GS1's legal counsel will determine whether the cited patent rights in the IP Declaration contain Necessary Claims relative to the standard under development. If the IPAG and GS1's legal counsel are of the opinion that the cited claims are Necessary Claims, the IPAG will encourage the IP declarant to withdraw its IP declaration and grant a royalty-free license to its Necessary Claims.

If the IP declarant does not agree to withdraw its IP Declaration, the IPAG will send the specification back to the Working Group for possible revision to eliminate the requirement for the feature or function covered by the Necessary Claims.

If no design-around is possible and provided the IP declarant agrees to grant a license under acceptable RAND conditions, GS1 and the Working Group will continue with the standard development effort. The standard will be published with a disclaimer listing the patents cited in the IP declaration(s) and information about the RAND licensing terms.

If the licensing terms proposed by the IP declarant are considered unacceptable by GS1 and the Working Group, the standards development effort will be stopped and the Working Group disbanded.

4.1 IP Declarations related to unpublished patents and design-arounds

In the event of an attempted 'design around' the Necessary Claims cited in a patent application, the Working Group members may be asked to sign a Confidentiality Agreement, if requested by the IP declarant. The need for a Confidentiality Agreement may be waived if the IPAG and IP declarant agree that sufficient information about the cited patent claims can be shared with the Working Group (or a sub-section of the Working Group) to attempt a 'design-around' without revealing the details of the patent application.

The Working Group members will be asked to sign a Confidentiality Agreement, if the IPAG believes that the entire IP Declaration needs to be shared with the Working Group in order to attempt the design-around and if the IP declarant requests the signing of such a Confidentiality Agreement.

If the IP declarant does not agree to allow its IP Declaration to be communicated to members of the Working Group under a Confidentiality Agreement, in the case of a design-around effort, the declarant will be asked to leave the Working Group.

4.2 Communication of IP Declarations - Summary

IP Declaration	Communicated to IPAG	Communicated to Working Group	Communicated to General Public
Published patents	Yes	Yes – after 2-3 week negotiation period between IPAG & IP declarant	Yes. Communication limited to patent number(s), patent owner/assignee and requested RAND terms.
Unpublished patent applications	Yes – may require Confidentiality Agreement	Yes – in the case of an attempted 'design - around'. May require Confidentiality Agreement.	No
Withdrawn declarations: published patents	Yes	No – if withdrawn during 2-3 week negotiation period with IPAG.	No – unless IP declarant agrees.
Withdrawn declarations: unpublished patent applications	Yes – may require Confidentiality Agreement	No – if withdrawn during 2-3 week negotiation period with IPAG	No

5 Timing of IP Disclosures

The GS1 IP Policy states that if a Working Group participant is unwilling to grant a royalty-free license to its Necessary Claims in the standard, it must give written notice to GS1 by submitting an IP Declaration no later than 30 days before the anticipated final date of the ratification of the standard.

Some Working Group participants wait until the last moment before submitting an IP declaration. The discovery of Necessary Claims during the late stages of a standards development effort may lead to uncertainty and unacceptable delays. The process will be more efficient if the existence of Necessary Claims and any licensing conditions are made known as early as possible in the development process.

Early disclosure clarifies the patent landscape and allows GS1 members and Working Group participants the greatest opportunity to request information about patent holders' licensing terms. Furthermore, GS1 will have a better idea of whether it is desirable to advance a standard incorporating patented technology.

At present, Working Group participants only declare IP from their own organisations, but rarely declare IP from other organisations. There is potentially a lot of IP knowledge within the GS1 community. Leveraging such knowledge will facilitate and speed up the assessment of the IP landscape when developing a standard and help to reduce the overall IP risk and uncertainty for GS1 users.

5.1 Recommendations regarding the disclosure of relevant IP

It is strongly recommended that Working Group participants disclose patents containing Necessary Claims that may be relevant to a proposed standard as soon as possible following the Call for Participation or formation of the Working Group. The disclosure can relate to issued or pending patents owned by the declarant, another member of the Working Group or third parties.

At the beginning of each session of the Working Group, the Chairman of the meeting will ask if any participant has knowledge (including personal knowledge) of patent applications or granted patents that may not be available on royalty-free terms and which may be required to implement the standard under development. If such knowledge is available, the member should promptly inform the Working Group Facilitator.

6 Publication of names of Working Group Members

To acknowledge the contribution made by GS1 member companies that have participated in the development of a GS1 standard and to indicate that such organisations have committed to license any patents they hold with Necessary Claims on royalty-free terms, the names of such companies and organisations will be documented in the published standard. Participants that do not wish to be included in the list of contributors to a published standard should inform the Working Group facilitator before the end of the final IP Review period.

The list of contributors for each published standard will be also maintained on the GS1 website.

7 Document Retention

GS1 shall retain in its records a copy of all IP Declarations, IP Contribution disclosures and related correspondence with IP holders applicable to a standard until the expiration of the standard and all revisions and derivatives thereof, or the expiration of all Claims contained in the IP disclosures.