

## Patent Policy for Japanese Industrial Standards Committee (JISC)

April 18, 2006  
Japanese Industrial Standards Committee  
Authorized by Standards Boards

### 1. Major progress

#### (1) The 8th long-term plan for promoting industrial standardization

In the field of significant technical innovation, standardization efforts in the private sector are rapidly increasing. As a result, it is sometimes necessary to establish Japanese Industrial Standards (JIS) based on private sector standards containing patent and/or related rights (hereinafter referred to as "patent rights"). In this context, in order to promote the establishment and smooth deployment of JIS, the Japanese Industrial Standards Committee (JISC) proposed a "procedure for establishment of JIS using technologies protected by patent rights" in its 8th long-term plan.

The procedure is based on the provisions of ISO/IEC Directives, Part 2, Annex A, "Reference to patented items" (effective May 31, 1995). According to the procedure, JIS shall be established only when all holders of patent rights submit written consent to the effect that they "agree to licensing under nondiscriminatory and reasonable terms and conditions."

#### (2) Report by "Special Study Committee for Standardization in the 21st Century"

In May 2000, JISC published a report by the "Special Study Committee for Standardization in the 21st Century," which included a policy proposal related to industrial property rights that include JIS. The proposal referred to ITU rules and drafted a statement on patent licensing agreements, and stipulated that the statement shall include a fixed declaration form.

In response to this proposal, in February 2001, JISC added the declaration form to the "procedure for establishment of JIS which include technologies protected by patent rights," and made the necessary revisions. Subsequently, the ITU further discussed this issue and summarized the reciprocity principle. This was incorporated into the declaration form (July 2004). ISO/IEC also initiated collaboration with ITU-T to unify their patent policies (February 2005). Such international organizations further discussed the issue of industrial property rights.

For this reason, JISC plans to revise the "procedure for establishment of JIS which include technologies protected by patent rights." This revision is intended to ensure that rules for JIS-related industrial property rights conform to rules for industrial property rights that have been adopted by international standardization organizations.

## 2. Procedure for establishment of JIS which include patent rights

This procedure shall apply not only to proposed draft JIS which include patented technology, or which may possibly include such technology, but to all draft JIS and draft revisions to existing JIS (hereinafter, both initial draft JIS and draft revisions to existing JIS shall be collectively referred to as "draft JIS").

JISC will not be involved in any way in individual contract arrangements between the holders, applicants, or managers of patent rights (hereinafter referred to as "patent holders") and their licensees.

In this document, "patent rights" refers to patent rights used in conjunction with the implementation of JIS, as well as publicly announced applications for patents based on Patent Law Article 64 and utility model rights. (On January 1, 1994, a new Utility Model Law took effect. As a result, this definition includes publicly announced applications for utility model registration that were filed up to December 31, 1993.)

### [Stage 1: Before submitting drafts to JISC]

#### (1) When a competent minister proposes establishing JIS in accordance with Article 11 of the Industrial Standardization Law

When a competent minister requests an entity (hereinafter referred to as "contractor") to undertake the drafting of a specific JIS, the contractor shall take the steps noted in the following paragraph. However, this does not apply when draft JIS are identical to ISO/IEC standards (standards must conform to ISO/IEC Directives, Part 2, Annex F (established in December 2004)) or when draft JIS require minor editorial changes, but remain identical in technical content.

#### ○ Conduct of a patent search and submission of a declaration

A contractor must conduct a patent search for the technology relevant to the draft JIS. If, as a result of their investigation, the contractor finds that the draft JIS contains patented technology, they shall then coordinate as necessary with all patent rights holders so that all such rights holders submit a declaration as per Attachment 1. Contractors shall submit the draft JIS and the statement to the competent minister(s). However, it is not necessary for the patent search to extend beyond such patent rights as are known to the developers of the draft JIS.

#### (2) When an interested party desires to establish JIS in accordance with Article 12 of the Industrial Standardization Law

Those who propose establishing JIS (hereinafter referred to as "applicants") shall take the steps noted in the following paragraph. However, this does not apply when draft JIS are identical to ISO/IEC standards (standards must conform to ISO/IEC Directives, Part 2, Annex F (established in December 2004)) or when draft JIS require minor editorial changes, but remain identical in technical content.

○ **Conduct of a patent search, and submission of a declaration**

Applicants must conduct a patent search for the technology relevant to the draft JIS. If, as a result of their investigation, the contractor finds that the draft JIS contains patented technology, they shall then coordinate as necessary with all patent rights holders so that all such rights holders submit a declaration as per Attachment 1. Contractors shall submit the draft JIS and the statement to the competent minister(s). However, it is not necessary for the patent search to extend beyond such patent rights as are known to the developers of the draft JIS.

**[Stage 2: From JISC deliberation to reporting]**

Departments in charge of draft JIS submitted for deliberation shall take the steps defined below.

① **Gathering of information on patent rights**

The department in charge of the draft JIS shall, in conjunction with the announcement of the public comment period, collect information on the existence and names of patent rights holders, etc., related to the draft JIS.

② **Submission of declarations**

As a result of the data collection stipulated in ① above, if patent rights related to the draft JIS under deliberation are found to include rights of patent holders who have not yet submitted a declaration, the department in charge of the draft JIS shall request those patent holders to submit a declaration as per Attachment 2.

③ **Notice concerning submission of a declaration**

In spite of a request for submission being made as in ② above, when a declaration is not submitted, or if patent rights holders have submitted a declaration under (3) of Item 2 of Attachment 2, then the department in charge of the draft JIS shall coordinate with contractors and/or applicants to make the necessary amendments to the draft JIS. JISC shall then deliberate the amended draft JIS.

④ **Conditions of reporting**

JISC shall not issue a report unless the procedures stipulated in ① to ③ above have been satisfactorily completed.

**[Stage 3: Publication in JIS]**

When JIS containing technology covered by patent rights are to be established, the said JIS shall carry the statement listed below in the Foreword.

If the number of patent holders is too numerous to be listed in the Foreword, it shall be so stated in the Foreword, and the patent holders shall be listed in an Annex.

- It should be noted that being in conformance with this Standard may involve the use of the patent rights held by the following person or entity.
  - Name:
  - Address:
- The holder of the abovementioned patent rights has declared that he/she is willing to negotiate licenses under reasonable and non-discriminatory conditions with any applicants. However, this is conditional upon reciprocal action being taken by the holders of other patent rights, etc. related to this Standard.
- It should be noted that being in conformance with this Standard does not necessarily imply that patent rights are being disclosed free of charge.
- Please be aware of the possibility that some elements of this Standard may be governed by patent rights other than those identified above. The competent minister(s) and Japanese Industrial Standards Committee are not responsible for identifying any or all such patent rights.
- Hereinafter, the term "patent rights" shall be include patent rights, patent applications that have been publicly announced, utility model rights, and utility model registration applications that have been publicly announced.

Moreover, when JIS which do not contain technology subject to related patent rights are to be established, the said JIS shall carry the following statement in the Foreword.

- Please note the possibility that some of elements of this Standard may be subject to patent rights, patent applications that have been publicly announced, utility model rights, or utility model registration applications that have been publicly announced. The competent minister(s) and Japanese Industrial Standards Committee are not responsible for identifying any or all such patent rights, patent applications that have been publicly announced, utility model rights, or utility model registration applications that have been publicly announced.

**[Stage 4: After JIS publication]**

(1) When appropriate use of JIS is obstructed

When those who submit a declaration on the use of patent rights under “reasonable and non-discriminatory conditions” do not, in fact, permit others to use rights under those conditions, and when there is a possibility that this refusal hinders the use of JIS related to the said patent rights, then the department in charge of the said JIS shall endeavor to ensure appropriate use by making the necessary request to those who submitted the declaration in question. If appropriate actions are not taken even after this request, the department in charge shall investigate the potential impact on the public welfare of revision or withdrawal of the said JIS, with the results of the investigation to be released to the public. Based on the results of the investigation, the department in charge shall take one of the following actions:

- Revise the said JIS so that they do not contain technology governed by the patent rights in question.
- Withdraw the said JIS.

In addition, if those who become licensees of patent rights through use of a standard meet the conditions specified in the “arbitration system operating procedures,” they may apply for arbitration related to the implementation of patent inventions, etc., according to the Patent Law.

(2) Upon discovery that established JIS contain related patent rights

If it is found that published JIS involve patent holders other than those who submitted a declaration on the use of patent rights, then the department in charge of the said JIS shall request the holders of the relevant patent rights to submit a declaration as per Attachment 2.

In spite of a request having been made, if a declaration is not submitted, or if holders of patent rights submit a declaration under (3) of Item 2 of Attachment 2, the department in charge shall investigate the potential impact on the public welfare of revision or withdrawal of the said JIS, with the results of the investigation to be released to the public. Based on the results of the investigation, the department in charge shall take one of the following actions:

- Revise the said JIS so that they do not contain technology governed by the patent rights in question.
- Withdraw the said JIS.

In addition, if those who become licensees of patent rights through use of a standard meet the conditions specified in the “arbitration system operating procedures,” they may apply for arbitration related to the implementation of patent inventions, etc., according to the Patent Law.

(Attachment 1 form)

Date  
Name of company  
Name of patent holder/manager

**Declaration concerning the treatment of patent rights and licensing  
in connection with draft Japanese Industrial Standards  
(Before submission to Japanese Industrial Standards Committee)**

The Patent Holder named above believes that it holds or administers patents and/or pending applications for patents (including patent rights, patent applications that have been publicly announced, utility model rights, etc.), the use of which would be required in order to implement the draft JIS noted in Item 1 below. The Patent Holder hereby declares that it will treat all patent rights used in the implementation of the JIS noted below according to the procedures specified in box (1) or (2) of Item 2 below, as indicated by the box checked.

Details

**1. Corresponding JIS**

Establishment or revision	JIS number	Title of JIS

**2. Treatment of patent rights**

- (1) With regard to the use of its patent rights in the JIS noted in Item 1 above, the Patent Holder hereby declares it is prepared to grant a free-of-charge license to an unrestricted number of applicants on a non-discriminatory basis, subject to reasonable terms and conditions. The Patent Holder excludes from this grant those who hold other patent rights related to the said JIS and who do not permit the use of their own patent rights under the conditions of this paragraph (1) or paragraph (2) below.  
However, when other patent rights holders grant licenses under the conditions of (2) below (except in the case of free-of-charge licenses), the Patent Holder named above agrees to grant a usage license to such other rights holders according to the terms contained in (2) below.
- (2) With regard to the use of its patent rights in the JIS noted in Item 1 above, the Patent Holder hereby declares it is prepared to grant a license to an unrestricted number of applicants on a non-discriminatory basis, subject to reasonable terms and conditions. The Patent Holder excludes from this grant

those who hold other patent rights related to the said JIS and who do not permit the use of their own patent rights under the conditions of this paragraph (2) or paragraph (1) above.

**3. Corresponding patent rights (Filling in this item is optional)**

Kinds of patent rights	Registration number	Title/inventor	Stage

(Point of contact for this matter) Name of company, department, section, and person

Note: When this form is used by an individual, association, or organization other than a company, the word "company" shall be replaced by the appropriate word.

(Attachment 2 form)

Date  
Name of company  
Name of patent holder/manager

**Declaration concerning the treatment of patent rights and licensing  
in connection with draft Japanese Industrial Standards  
(After deliberation by Japanese Industrial Standards Committee)**

The Patent Holder named above believes that it holds or administers patents and/or pending applications for patents (including patent rights, patent applications that have been publicly announced, utility model rights, etc.), the use of which would be required in order to implement the draft JIS noted in Item 1 below. The Patent Holder hereby declares that it will treat all patent rights used in the implementation of the JIS noted below according to the procedures specified in box (1), (2), or (3) of Item 2 below, as indicated by the box checked.

Details

**1. Corresponding JIS**

Establishment or revision	JIS number	Title of JIS

**2. Treatment of patent rights**

- (1) With regard to the use of its patent rights in the JIS noted in Item 1 above, the Patent Holder hereby declares it is prepared to grant a free-of-charge license to an unrestricted number of applicants on a non-discriminatory basis, subject to reasonable terms and conditions. The Patent Holder excludes from this grant those who hold other patent rights related to the said JIS and who do not permit the use of their own patent rights under the conditions of this paragraph (1) or paragraph (2) below.  
However, when other patent rights holders grant licenses under the conditions of (2) below (except in the case of free-of-charge licenses), the Patent Holder named above agrees to grant a usage license to such other rights holders according to the terms contained in (2) below.
- (2) With regard to the use of its patent rights in the JIS noted in Item 1 above, the Patent Holder hereby declares it is prepared to grant a license to an unrestricted number of applicants on a non-discriminatory basis, subject to reasonable terms and conditions. The Patent Holder excludes from this grant

those who hold other patent rights related to the said JIS and who do not permit the use of their own patent rights under the conditions of this paragraph (2) or paragraph (1) above.

- (3) With regard to the use of its patent rights in the JIS noted in Item 1 above, the Patent Holder hereby declares it is unwilling to grant licenses to the patent rights listed in Item 3 below in accordance with the provisions of either paragraph (1) or (2) above.

**3. Corresponding patent rights (filling in this item is mandatory when (3) in Item 2 above is selected)**

Kinds of patent rights	Registration number	Title/inventor	Stage

(Point of contact for this matter) Name of company, department, section, and person

Note: When this form is used by an individual, association, or organization other than a company, the word "company" shall be replaced by the appropriate word.