



## **GSM Association Intellectual Property Rights Regulations**

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*This is a Binding Permanent Reference Document of the GSMA*

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### **Antitrust Notice**

The information contain herein is in full compliance with the GSM Association's antitrust compliance policy.

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## 1 Introduction

- 1.1 This document ("the IPR Regulations") contains the regulations of the Association in relation to Intellectual Property Rights (as defined below).
- 1.2 Unless expressly specified by the Association in writing, the IPR Regulations are applicable to any activities undertaken by an Association's project, forum, task force or any other group, constituted in accordance with the Articles of Association (as defined below).

## 2 Definitions and Interpretation

### 2.1 Definitions

"Activity"	means any activity undertaken by an Association's project, forum, task force or any other group constituted in accordance with the Articles of Association.
"Activity Participant"	means (a) a Member and its Affiliates; or (b) pursuant to the provisions set out in Clause 9: i. an Associate Member or Rapporteur; or ii. a non-member, by invitation of the Association;  participating in an Activity.
"Adopted Deliverables"	means Deliverables officially adopted by an Association body, committee, forum, task force or group, associated with a particular Activity.
"Affiliate"	means any subsidiary or holding company of an Activity Participant, any subsidiary of any of its holding companies and any partnership, company or undertaking (whether incorporated or unincorporated) in which an Activity Participant has the majority of the voting rights or economic interest.
"Articles of Association"	of means the articles of association governing the Association.
"Association"	means GSM MoU Association or the GSM Association or GSMA.
"Associate Member or Rapporteur"	means a specific group or organisation which has been recognised by the Association in accordance with the Articles of Association" as an associate member or rapporteur within the Association.
"Association Participant"	means Members, Associate Members or Rapporteurs.
"Beneficiary of the Undertaking"	means anyone wishing to Implement the Adopted Deliverables to which the Essential IPR relates.
"Chairman"	means the person, appointed by the Association in order to preside over an Activity.

“Declaration” or to “Declare”	means a declaration in accordance with Clauses 3.4 and 3.5.
“Deliverable(s)”	means any deliverable that has been or is being initiated, produced or developed through any work associated with an Activity.
“Essential IPR”	“Essential” as applied to “IPR” means, IPR, where it would be impossible on technical (but not necessarily commercial) grounds, taking into account normal technical practice and the state of the art generally available at the time of approval of an Adopted Deliverable, to Implement the Adopted Deliverable without making use or infringement of this IPR. The meaning of “Essential Patent” is construed accordingly. For the avoidance of doubt in exceptional cases where an Adopted Deliverable can only be implemented by technical solutions, all of which are infringements of IPRs, all such IPRs shall be considered “Essential”.
“FRAND Terms”	means fair, reasonable and non-discriminatory terms.
“Implement”	means in the context of Deliverables: <ul style="list-style-type: none"> <li>i. to make, market, sell, licence, lease, otherwise dispose or make use of equipment; or</li> <li>ii. repair, use or operate equipment; or</li> <li>iii. use methods;</li> </ul> as specified in the respective Adopted Deliverables
“Intellectual Property Rights” or “IPR”	means any copyright, Patent, registered design, and any application thereof. Notwithstanding the foregoing, IPR does not include trademarks, trade secrets, moral rights, right of know-how and confidential information.
“Member”	means a specific organisation which has been recognised by the Association in accordance with the “Articles of Association” as a member of the Association.
“Patent”	means patent, utility model or any application for such.
“Participation Rights”	means the right of an Activity Participant to: <ul style="list-style-type: none"> <li>i. participate in; and</li> <li>ii. receive an “Undertaking” pursuant to Clause 5 for any Essential IPR in relation to;</li> </ul> a particular Activity (and Adopted Deliverable) to which the Essential IPR relates.
“Right of Refusal to License”	means, subject to Clause 3.5, an Activity Participant's right of refusal to grant an “Undertaking”
“Undertaking”	means an undertaking in accordance with Clause 5.1.

2.2 The headings, marginal notes and references to them, in this document shall be deemed not to be part of this document and shall not be taken into consideration in the interpretation of this document.

- 2.3 References to any gender shall include the other and words in the singular include the plural and vice versa.

### **3 Declarations of Essential IPR**

- 3.1 The provisions pursuant to Clauses 3.3 and 3.4 below do not imply any obligation on the part of an Activity Participant to:
- i. subject to Clause 7, declare any Essential IPR; or
  - ii. conduct any searches of Essential IPR (including, without limitation, Patents); that the Activity Participant or any of its Affiliates hold.
- 3.2 Pursuant to Clause 7, by default and in the absence of any Declaration in accordance with Clauses 3.3, 3.4 and 3.5, for any Essential IPR associated with a particular Activity, an Activity Participant is deemed to have given an Undertaking for that Essential IPR associated with a particular Activity.
- 3.3 Subject to Clauses 3.1 and 3.2, prior to any official approval by the Association of any Deliverables associated with a particular Activity, each Activity Participant shall provide the Chairman with a written declaration of the Essential IPR relevant to the above Activity:
- i. in accordance with Clause 3.4 and 3.5; and
  - ii. in the form prescribed by the Association and with language consistent with the policies set forth herein.
- 3.4 Subject to Clause 3.1, the Declaration shall:
- i. to the Activity Participant's knowledge, list any potentially Essential IPR that, the Activity Participant or any of its Affiliates hold in relation to that particular Activity;
  - ii. identify all such Essential Patents by way of filing number, date, and if published its title; and
  - iii. identify the terms (i.e. explicitly the non-FRAND Terms (as opposed to Clause 5.1, but without specifying royalty rates or any other royalty terms)) on which the Activity Participant or its Affiliate is prepared to grant licenses to the Essential IPR to the Association Participants and any third parties; and
  - iv. identify whether the Declaration is made subject to the condition that those who seek licenses agree to reciprocate.
- 3.5 Any Declaration shall identify and describe in sufficient detail:
- i. by way of filing number, date, and if published, optionally its title, any Essential Patents, for which the Activity Participant or its Affiliate, in accordance with Clause 6.1, are unwilling or unable to give an Undertaking to any Beneficiary of the Undertaking pursuant to Clause 5; and
  - ii. the reasons (for each of the above Essential Patents identified in Clause 3.5(i)), why the Activity Participant or its Affiliate are unwilling or

unable to give an Undertaking for these Essential Patents to any Beneficiary of the Undertaking pursuant to Clause 5.

- 3.6 The Activity Participant agrees that any Declarations may be made available as the Association thinks fit.

## **4 Non-Assertion of Essential IPR**

- 4.1 Each Activity Participant agrees never to assert its Essential IPR against the Association in respect of the Association's publications and promotions of any Deliverables.

## **5 Licensing of Essential IPR**

- 5.1 Save in the case of any Essential Patents identified in accordance with Clause 3.5 and subject to Clause 8.1, an Activity Participant will have given an undertaking that it is prepared to grant licences:
- i. on FRAND Terms;
  - ii. to all its Essential IPR associated with this particular Activity;
  - iii. Beneficiaries of the Undertaking; and
  - iv. to the extent necessary to permit any Beneficiaries of the Undertaking to Implement the Adopted Deliverables to which the Essential IPR relates.
- 5.2 The Undertaking may be made subject to the condition that those who seek licences agree to reciprocate.
- 5.3 Both, the Activity Participant, who is deemed to have given the Undertaking pursuant to Clause 5.1, and any Beneficiary of the Undertaking wishing to acquire a licence in accordance with Clause 5.1, acknowledge and agree that:
- a) they will act in good faith, in order to negotiate a licence agreement pursuant to Clauses 5.1 and 5.2; and
  - b) if they both have not been able to agree on an Essential IPR license pursuant to Clauses 5.1 and 5.2, either party shall have the right to seek redress from the courts directly against the other in order resolve the matter.
- 5.4 Each Activity Participant will ensure that its Affiliates, and its Affiliates' successors in title will give an Undertaking pursuant to Clauses 5.1, 5.2 and 5.3 above. If an Activity Participant or its Affiliate transfers ownership of Essential IPR that is subject to an Undertaking pursuant to Clauses 5.1, 5.2 and 5.3 above, such Undertaking shall include appropriate provisions in the relevant transfer documents to ensure that the Undertaking is binding on the transferee and that the transferee will similarly include appropriate provisions in the event of future transfers with the goal of binding all successors-in-interest. The Undertaking shall be interpreted as binding on successors-in-interest regardless of whether such provisions are included in the relevant transfer documents.

- 5.5 It is acknowledged that the Activity Participant, owning any Essential IPR, shall be free to exploit such IPR outside the scope of the Association at its absolute discretion and any revenues or other benefits, which the Activity Participant may receive from such exploitation of such Essential IPR, shall be for the Activity Participant's own account.

## **6 Refusal to Licence**

- 6.1 An Activity Participant shall only be able to exercise its Right of Refusal to License with regards to Essential Patents, but no other Essential IPR, which is:
- i. not based on any information or input generated by the Association prior to or during the Activity Participants participation in the respective Activity;
  - ii. developed independently of other Activity Participants, their Affiliates or the Association;
  - iii. not initiated or developed with the intention to be part of a Deliverable; and
  - iv. Declared (in accordance with Clauses 3.3 and 3.4).
- 6.2 Where an Activity Participant, in accordance with Clause 3.5, has identified an Essential Patent, which the Activity Participant, or its Affiliates, is unwilling or unable to license in accordance with Clause 5, the Activity Participant will lose its Participation Rights in relation to the respective Activity and Adopted Deliverable to which an Essential Patent relates, if any other Activity Participants of the particular Activity, informs the Chairman within a reasonable period, in writing, that it:
- i. does not accept that the reasons by the Activity Participant's in the relevant Declaration (as required in accordance with in Clause 3.5(ii) are reasonable and justified; and
  - ii. based on its duly justified non-acceptance of these reasons pursuant to Clause 6.2(i), wishes that the aforesaid Activity Participant shall not be able to rely on its Participation Rights.

## **7 Absence of a Declaration or Failure to Declare**

- 7.1 Where an Activity Participant has elected not to Declare or has failed to Declare any Essential IPR for a given Activity in accordance with Clauses 3.3, 3.4 and 3.5, the Activity Participant shall be deemed to have given the Undertaking in accordance with the terms of Section 5.

## **8 Disputes regarding Ownership of Essential IPR**

- 8.1 If more than one Activity Participant claims ownership of any Essential IPR, the Activity Participants claiming ownership shall:

- i. act in good faith when negotiating and resolving the question of ownership; and
- ii. if they cannot agree on who owns the Essential IPR pursuant to Clause 8.1(i), have the right to seek redress from the courts against each other in order to resolve the matter.

## **9 Participation of Associate Members, Rapporteurs and Non-Members of the Association in Activities**

- 9.1 It is acknowledged, that, from time to time, the Association may set up fora, projects or other groups in which Association Participants and non-members of the Association may take part.
- 9.2 Participation of that Associate Member, Rapporteur or non-member in that particular Activity shall be subject to:
- a) the Associate Member or Rapporteur having expressly committed, by way of signing up to the appropriate provisions in its associate or rapporteur membership agreement, to be bound by the provisions set out in these IPR Regulations for the entire duration of its membership in the Association; or
  - b) the Associate Member, Rapporteur or non-Association Participant, on a case by case basis expressly agreeing in writing for each individual Activity (it wishes to participate in), that, for this particular Activity, it is:
    - i. bound by the terms and obligations as set out in these IPR Regulations; and
    - ii. not being granted the benefit of any rights and privileges in excess to those being granted to any Activity Participant under these IPR Regulations.

## **10 General**

- 10.1 Neither the Activity Participants, nor the Association, make any representations or give any warranties as to the non-infringement of third party intellectual property rights, with regards, or in relation, to any provision of these IPR Regulations.
- 10.2 All Activity Participants acknowledge and agree that any obligation placed on (but no rights bestowed upon) an Activity Participant by virtue of:
- a) Clause 4 (Non-Assertion of Essential IPR);
  - b) Clause 5 (Licensing of Essential IPR);
  - c) Clause 7 (Absence of a Declaration or Failure to Declare); and
  - d) Clause 8 (Disputes regarding Ownership of Essential IPR);
  - e) with regards to any Essential IPR of the Activity Participant, relevant to this Activity or Deliverable, but no other Essential IPR, which is:



- i. based on any information or input generated by the Association prior to or during the Activity Participants participation in the respective Activity;
- ii. not developed independently of other Activity Participants their Affiliates or the Association; or
- iii. initiated or developed with the intention to be part of an Activity or Deliverable;
- iv. shall survive participation of an Activity Participant in an Activity, even if such Activity Participant has withdrawn from or ceased to be a Member, Associate Member or Rapporteur of the Association.

10.3 In the event that any Association Participant or non-member (participating in an Activity in accordance with Clause 9.2) is in breach of any of its obligations under these IPR Regulations, the Association reserves the right to take any actions available to it under its policies, procedures and regulations or at law as it deems necessary in order to protect the interests of the Association, other Association Participants and non-members, including;

- i. any legal actions;
- ii. the exclusion from any Activities; and
- iii. termination of the Association Participant's membership of the Association.

10.4 Any dispute arising in relation to these IPR Regulations shall be resolved:

- i. in good faith;
- ii. in a reasonable manner;
- iii. in accordance with the Articles of Association;
- iv. within a reasonable period of time; and
- v. failing that, by seeking redress in a court of a competent jurisdiction.

10.5 The IPR Policy shall be interpreted in accordance with English Law.

## Document Management

### Document History

Version	Date	Brief Description of Change	Approval Authority	Editor / Company
3.0.0	October 2000	Approved at Plenary 44	GSMA Board	GSMA Board
3.0.1	December 2003	Change owner of document to GSMA Board	GSMA Board	GSMA Board
3.1	December 2006	Board approved Amendments	GSMA Board	GSMA Board
4.0	September 2013	Changes Since Last Version - Extension of benefit of "Undertaking" and transfer of Essential IPR	GSMA Board	GSMA Board

It is our intention to provide a quality product for your use. If you find any errors or omissions, please contact us with your comments. You may notify us at [prd@gsma.com](mailto:prd@gsma.com)

Your comments or suggestions & questions are always welcome.