

## **Drafting and litigating standard essential patents**

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Interoperability between electronic devices is vital to innovation. Imagine a world wherein Apple's iPhones communicate between them with a proprietary protocol but are unable to talk with other devices. Only two scenarios are possible: either Apple gets the monopoly with no interest in innovating their products, or this market might disappear because too complicated. None of these scenarios makes sense and that's why mobile phones manufacturers work together in standardization committees to improve communication protocols.

They respond to calls necessary to improve the standard or solve a problem found by the standardization committee or by the technical community in general. Before responding to the call and sharing information with the other committee members, manufacturers patent their ideas and when accepted by the committee, patents become SEP (Standard Essential Patents)

This is true not only for mobile phones, but also for TV, digital imaging, automotive and so on.

Taking part to standardization committees and patenting solutions responding to real problems faced by the technical community offers the possibility to have patents that can be licensed to all those who make use of the standardized technology, with a return on the research investment.

In the past I have been involved in drafting patents that became essential for DVB-T2 (Digital Video Broadcasting), for JPEG, for IEEE 802.3cg. The job was simply amazing: being at the edge of technology, dealing with complex solutions, running against time as the companies had to respond to a call for technology.

Drafting SEPs is, in my opinion, a little bit different from drafting a patent for a disruptive innovation and requires a particular attention to the wording of the standard: companies do not need very broad patents that can be objected by examiners or later in litigation, but patents that perfectly fit the standard and can be litigated without fear to be invalidated.

Licensing and litigation are, in fact, important issues connected to SEPs, and having a patent with a wording that clearly reads on the standard makes obtaining injunctions or convincing the customs to stop importation of infringing devices easy.

I've been litigating SEPs relating to mobile phones communications (3G and 4G), television standards (DVB), telecommunication protocols (ADSL). Every time a litigation starts, the problem of interpreting the claims and defining the scope of protection arises because the wording of the patent does not fit exactly with the standard. I remember some Philips patents of which the description was clearly describing a DVB Transport Stream, with subtitle data transmitted separated from the video (as required by the standard) while the claim was directed to a video frame including the subtitle, which is not in the standard.

In my experience, when the patent has been drafted during the works of the standardization committee and the wording used exactly fits with the standard, the patent is more easily licensed and only seldom litigated. If possible, since standardization committees are time consuming, I suggest to my clients to take part to the standardization committee and find there opportunities for drafting good SEPs that can be licensed.