



James M. Conrad, Ph.D.
President, IEEE-USA

18 February 2020

The Hon. Makan Delrahim
Assistant Attorney General for
Antitrust, Antitrust Division,
U.S. Department of Justice,
950 Pennsylvania Avenue NW
Washington, DC 20530

The Hon. Andrei Iancu,
Under Secretary of Commerce
for Intellectual Property and
Director of the U.S. Patent &
Trademark Office,
600 Dulany Street
Alexandria, VA 22313

The Hon. Walter Copan,
Under Secretary of Commerce
for Standards and Technology
and Director of the National
Institute of Standards and
Technology,
100 Bureau Drive
Gaithersburg, MD 20899

Re: IEEE-USA supports the U.S. Joint Policy Statement on Remedies for Standards-Essential Patents Subject to Voluntary FRAND Commitments

Dear Assistant Attorney General Delrahim and Under Secretaries Iancu and Copan:

On behalf of the IEEE-USA, I write in support of the recent U.S. joint policy statement on Remedies for Standards-Essential Patents Subject to Voluntary Fair, Reasonable, and Non-Discriminatory (FRAND) Licensing Commitments (“Joint Policy Statement”).¹

IEEE-USA, the U.S. affiliate of The Institute of Electrical and Electronics Engineers (IEEE), represents nearly 180,000 engineers, scientists, and allied professionals whose livelihoods depend on American technology companies and their domestic research and development (R&D) operations. Our members work for large and small companies, and as individual inventors or entrepreneurs, and depend on a strong American patent system that incentivizes and protects investments in domestic R&D and commercialization of new inventions.

IEEE-USA commends you for the adoption of the Administration’s Joint Policy Statement predicated on the underlying recognition that the patent system “promotes innovation and economic growth by providing incentives to inventors to apply their knowledge, take risks, and make investments in [R&D].” Often, those investments are capital-intensive, high risk undertakings where returns are not only uncertain but many years off. The U.S. Constitution empowered Congress to confer an exclusive patent right for sustaining these incentives, *i.e.*, the right to exclude others from exploiting the inventor’s creation for a limited time, through equitable remedies including injunctions or exclusion orders. IEEE-USA believes that “enforcing and defending IP property rights is essential for securing the property rights necessary for investment. When innovators are unable to secure the property right embodied in a patent, investment is deterred and commercial activity, innovation and job creation impeded.”²

¹ Department of Justice, the U.S. Patent & Trademark Office, and the National Institute for Standards and Technology, *Policy Statement on Remedies for Standards-Essential Patents Subject To Voluntary F/RAND Commitment*. (December 19, 2019). Available at www.justice.gov/atr/page/file/1228016/download.

² IEEE-USA Position Statement, *Balance in U.S. Patent Law*, at 2 (Nov. 22, 2019). Available at <https://ieeusa.org/wp-content/uploads/2019/11/PatentBalance1119.pdf>.

The Joint Policy Statement noted that a prior agency policy statement of 2013 (now withdrawn) may have “been misinterpreted to suggest that a unique set of legal rules should be applied in disputes concerning patents subject to a F/RAND commitment that are essential to standards (as distinct from patents that are not essential), and that injunctions and other exclusionary remedies should not be available in actions for infringement of standards-essential patents [(Essential Patents)].” The Joint Policy Statement now makes clear that there can be no such presumption—the exclusive patent right is *not* diminished where the invention finds use in a device or system necessary to implement a technical standard. As the Joint Policy Statement now makes clear, there is no special set of legal rules for FRAND-assured Essential Patents, and the courts, the U.S. International Trade Commission (ITC), and other adjudicators are able to assess appropriate remedies based on current law and relevant facts.

The Joint Policy Statement clarifies that when licensing negotiations fail, appropriate remedies for patent infringement, including injunctive relief, should be available to Essential Patent holders. IEEE-USA agrees. It is our position that injunctive relief for patent owners including Essential Patent holders should be presumptively available in the courts,³ and at the ITC, except where the Essential Patent holder expressly waived its right to such relief.⁴

IEEE-USA is grateful for this important clarification. It is needed to strengthen our patent system and ensure it continues to serve as an engine for innovation, U.S. competitiveness in global markets, domestic job creation, and economic growth in the United States.

Sincerely,



James M. Conrad, Ph.D.
President, IEEE-USA

³ *Id.* at 3 (IEEE-USA supports reforms that ensure “that, for issuance of an injunction after a full adjudication on validity and infringement, irreparable harm is presumed.”)

⁴ IEEE-USA Position Statement, *Availability of Exclusion Orders at the U.S. International Trade Commission*, at 2 (January 3, 2020) (“The fact that the patent holder has pledged to license [Essential Patents] under [FRAND] terms should not *per se* trigger the public interest exception to deny issuance of an exclusion order, nor its disapproval.... However, when such patent holder’s pledge expressly waived its right to an exclusion order, standard implementers are entitled to rely on such pledged waiver.”) Available at <https://ieeeyusa.org/wp-content/uploads/2020/01/ITCExclusionOrders0120.pdf>.