

# Inbound and outbound IP flow

## Goals

We want a "flat" IP-flow policy, whereby the right to use contributions to the Spec (and to the RI and TCK where applicable) are granted directly to implementers rather than flowing through the Spec Lead. (The Spec Lead should be treated as just another implementer.)

## Definitions

- **Contribution:** any comments, specifications, code or other materials, or ideas made or disclosed to an Expert Group by any means concerning the subject matter of the JSR for which that Expert Group is formed.
  - The current version of the JSPA has a weird distinction between contributions that are disclosed in “recorded form” and those that are not. This should be eliminated.
  - This definition must be broad enough to cover direct contributions to the RI and/or the TCK. (Non-JSPA signatories who contribute to the RI or TCK must be covered separately by some other kind of CLA.)
- **Compatible:** an implementation of a Java technology is Compatible if it meets the requirements specified in the language equivalent to (a) – (c) of Section 5.B in the current version of the JSPA.
- **Essential Patent:** a patent for which a Compatible implementation of a Specification cannot be created in a technically feasible manner without violation.
- **Output:** the Specification and associated Reference Implementation and Technology Compatibility Kit generated by an Expert Group with respect to the JSR for which that Expert Group is formed.
- **Process:** the version of the Process Document under which a particular JSR is being run.

## Inbound IP flow

Everyone who contributes to a JSR (whether or not they are members of the Expert Group) with respect to their copyrights, trade secrets, and Essential Patent Rights in their Contributions, grants a perpetual, non-exclusive, worldwide, royalty-free, fully paid-up license permitting those Contributions to be:

- disclosed, distributed, reviewed, and publicly discussed as necessary to meet the transparency requirements of the Process before and after the JSR is completed.
- modified and incorporated into the Output and into future versions of the Output as these are evolved through the Process.
  - The Spec Lead has the right to create derivative works but other implementers do not. Can we word this in such a way that the Spec Lead is not called out as “special”? Do we need to use the term *derivative works* at all?
- incorporated into Compatible implementations of the current and any future revisions of the Spec.
  - We should remove the current distinction between implementations derived from the RI and Independent Implementations.

Expert Group members make royalty-free grants with respect to their Essential Patents. Grants with respect to material that they did not Contribute themselves may be revoked if they disclose the relevant patents and withdraw from the Expert Group prior to Public Review.

Is Public Review the appropriate time? Conceivably things may change after that point?

Note: the current JSPA obligates EG members to disclose Essential Patents at any time they acquire knowledge of them. We should probably add a similar requirement.

JCP members who are not members of the Expert Group and who do not contribute to the JSR have an obligation to disclose any Essential Patents of which they have personal knowledge. Having done so they are obligated to grant rights to these patents on FRAND terms.

- This obligation is considerably weaker than the current Section 6. Is this what we want? If so, doesn't that run counter to a desire for full ex-ante disclosure?
- Who must disclose? The primary contact for the member? Anyone who has served on an EG on behalf of the member?
  - We suggested that the PMO could routinely issue Disclosure Requests at specified times during the process.
  - We agreed that **how** a member chose to respond (how deeply to research) was up to them.
- Section 6 currently permits declared patents to be withheld. Do we want to make a similar provision?
- Is there any obligation to license patents that are **not** disclosed?
  - If yes, then companies have no way to protect their “crown jewels” other than to withdraw from the JCP (and Oracle has no way at all to do so, since it cannot withdraw).

- If no, then this would seem to provide an incentive for a “sneak attack” (withhold information about Essential Patents and then later reveal them and demand royalties). On the other hand, this would permit people to retain their “crown jewels” since they could simply not disclose them.
- If a patent is not disclosed is the patent-holder later able to assert it and to demand royalties?
  - Scott Jameson says “case-law permits this” but surely we can write language into the JSPA that says “I commit not to assert any of my Essential Patents unless I disclose them at the appropriate time.”?
  - If Scott is correct then wouldn’t any non-assert patent clause be ineffective?

No member is obliged to grant patent rights to those who are unwilling to make a reciprocal grant.

Patent grants are terminated if the licensee initiates litigation with respect to technologies developed through the JCP. (A Spec Lead initiating litigation in defense of the subject specification would not trigger this defensive termination clause.)

Should offenders lose all the rights they have been granted through the JCP or only the rights for the particular JSR?

Although defensive termination clauses make sense with respect to Royalty Free patent grants they don’t seem to align with FRAND grants. (It makes no sense to make FRAND grants part of your IPR policy and at the same time to say that anyone who actually tries to collect royalties will suffer retaliation.) If this is so, then we would have to limit defensive termination clauses to the RF grants made by contributors. (This seems to be what the current JSPA does.) If so, then there would seem to be no consequences for not disclosing Essential Patents at any time during the process.

Should we use non-assertion language as an alternative to the specific granting of patent licenses?

Since Oracle is not the “You” specified in the JSPA we must include language stating that Oracle makes similar commitments.

Copyright in the “collective work” of the Spec will vest in the Spec Lead.

## ***Outbound IP Flow***

Will be covered by the Spec License (which will grant all necessary IP rights to Compatible implementations of the spec) by the approved Open Source RI and TCK licenses, and the approved Commercial RI and TCK licenses.