

# Intellectual Property Rights (IPR) Policy of PROFIBUS Nutzerorganisation e.V. (PNO)

## 1. Introduction and Scope

PNO has adopted the following IPR Policy as a basis for dealing with Copyrights and Industrial Property Rights in the Committees and Working Groups. The work undertaken by the Committees and Working Groups is aimed at producing Work Results that can be used and integrated into products by Members of PNO, of the related Regional PI Associations (RPA), Members of Partner Organizations in joint projects and other third parties to the extent agreed herein.

For the use of the Work Results, **Copyrights** or Industrial Property Rights (**patents** and utility models or applications) of the Members may be affected.

PNO aims at keeping the Work Results in principle free of license fees for the Members of PNO, for the Members of the RPA as well as for Members of Partner Organizations.

This IPR Policy applies to all technologies specified internally by PNO or in joint projects with Partner Organizations, unless otherwise regulated in individual cases.

This IPR Policy applies to all Members of PNO and the RPA and to all third parties participating in PNO activities.

## 2. Definitions

- **Affiliates** are affiliated companies within the meaning of §§ 15 et seq. German Stock Corporation Act (AktG).
- **Call for Experts** is the information to all Members about a new topic within a PG/WG, associated with the invitation to participate in the PG/WG or Joint-WG.
- **Committee** is a technical committee of PNO, consisting of representatives or Participants of the Members and, if applicable, guests.
- **Contributions** are information, software, feedback, or documents which a Participant intentionally provides to a PG/WG or Joint-WG for potential use in the Work Results; this applies in particular to copyrighted Contributions.
- **Copyrights** are the rights of the author in his work.

- **Industrial Property Rights** are patents and/or utility models (technical property rights) and/or applications for patents and/or utility models, but not designs or trademarks and applications for designs or trademarks.
- **Joint-WG** is a Working Group in a joint project of PNO with one or more Partner Organizations, consisting of representatives or Participants of the Members as well as Members of the Partner Organizations and, if applicable, guests.
- **Member** is a legal entity, partnership, or an individual, within the meaning of § 3 of Statutes of PNO or of related RPA. For clarification: the term "Member" without additions always refers to the Members of PNO and/or the RPA.
- **Member of a Partner Organization** is a legal entity, partnership, or an individual, within the meaning of the respective articles of association or internal regulations of the Partner Organization.
- **Participant** means an individual duly identified to PNO as authorized to participate in a PG/WG, Joint-WG or Committee of PNO on behalf of the Member or of a non-member, as the case may be, and to submit Contributions on behalf of such Member or non-member and/or its Affiliates.
- **PG/WG** is a Working Group of PNO, consisting of representatives or Participants of the Members and, if applicable, guests.
- **PNO Specification** means a technical description of a PNO technology (such as PROFINET or OPC UA Safety), developed in a PG/WG (PNO-internal), in a Joint-WG (jointly with one or more Partner Organizations) or in a Committee, as well as all revisions and new versions thereof.
- **Process** in this context means a process that is compliant with a PNO Specification.
- **Product** in this context means a product that is compliant with a PNO Specification.
- **RAND-R License** is a worldwide, irrevocable, perpetual, non-exclusive license, sublicensable only to Affiliates, limited to the Relevant Claims, to make, have made, use, import, offer for sale, lease, sell, market and otherwise distribute and dispose of the portions of the implementing entity's products and services that implement a PNO Specification, optionally subject to license fees and otherwise granted on reasonable and non-discriminatory terms.
- **RAND-Z License** is a worldwide, irrevocable, perpetual, non-exclusive license, sublicensable only to Affiliates, limited to the Relevant Claims, to make, have made, use, import, offer for sale, lease, sell, market and otherwise distribute and dispose of the portions of the implementing entity's products and services that implement a PNO Specification, granted on royalty-free and otherwise reasonable and non-discriminatory terms.
- **Relevant Claim** are those claims of an Industrial Property Right, which and to the extent that they are indispensable for the implementation of a PNO Specification. In case of unauthorized

use, the realization of a Product or Process based on the PNO Specification would lead to an infringement of the Relevant Claim. A Relevant Claim is necessarily infringed only if it is technically impossible to avoid its infringement or if there is no commercially reasonable non-infringing alternative to implementing a PNO Specification.

- **Work Results** are PNO Specifications, other documents and software created in the cooperation work within PG/WGs or Joint-WG.

### **3. Regulations on Industrial Property Rights**

#### **3.1 Disclosure of Relevant Claims**

Through the Call for Experts, all Members are informed about a new topic of a PG/WG, Joint-WG or Committee and invited to participate in a PG/WG, Joint-WG or Committee. As of this date, Members are obliged to disclose their own Relevant Claims and Relevant Claims of their Affiliates to PNO as soon as they become aware that they or their Affiliates hold Relevant Claims. There is no disclosure obligation for inventions until the filing of a patent application.

Further, upon commencement of the review process of a Specification, PNO will send to all Members a notice and a substantially complete draft of each Specification for review, also with regard to the disclosure of Relevant Claims. Members have six weeks to complete this review.

For the disclosure of the Relevant Claims, the Form in the Annex to this IPR Policy shall be used or an adequate contract shall be concluded. PNO will make available a list of the reported Relevant Claims to PG/WG or Joint-WG Participants and Members.

Even if a Member fails to notify a Relevant Claim during the above-mentioned period from the Call for Experts until the completion of the review process, the licensing obligations under Article 3.2 shall apply.

Furthermore, Members will inform PNO of Relevant Claims pertaining to third-parties of which they are aware.

There is no requirement for Members or for PNO to conduct a patent search or a search for Industrial Property Rights.

## **3.2 Terms of Use**

- 3.2.1 In the case of PNO Specifications that are created internally by PNO or within joint projects with other Partner Organizations, Members grant to PNO a RAND-Z License in their own Relevant Claims and in Relevant Claims of their Affiliates with the right to sublicense them to the other Members, insofar as no opt-out has been declared in accordance with Article 3.3. The Members shall automatically be granted a RAND-Z License from PNO.
- 3.2.2 In the case of PNO Specifications which are created internally, Members agree to grant to non-members, upon request, a RAND-R license in their own Relevant Claims and in Relevant Claims of their Affiliates, subject to reciprocity, insofar as no opt-out has been declared in accordance with Article 3.3.
- 3.2.3. In the case of PNO Specifications created within joint projects with other Partner Organizations, Members agree to grant to non-members, upon request, a RAND-Z license in their own Relevant Claims and in Relevant Claims of their Affiliates, to the extent that the Relevant Claims are necessary for the implementation of the respective jointly created PNO Specification, and subject to reciprocity, insofar as no opt-out has been declared in accordance with Article 3.3.
- 3.2.4. Reciprocity: The patent licensing obligation of Members to non-members shall apply only if the licensee commits to substantially the same licensing obligations to Members and non-members with respect to its own Relevant Claims or Relevant Claims of its Affiliates for the relevant PNO Specification.
- 3.2.5 For clarification: The above regulations 3.2.1 to 3.2.4 apply accordingly to non-members insofar as they participate in the development of a PNO-internal Specification or a PNO Specification within joint projects with Partner Organizations (if PNO is the host).

## **3.3 Opt-Out Regulation**

Up to the end of the review period (see the Relevant Claim Form in the Annex), a Member may, with respect to Relevant Claims,

- refuse to grant use rights to PNO or to the Members and non-members in accordance with Article 3.2 of this IPR Policy; or
- offer a license under terms and conditions to be negotiated. The PNO Advisory Board decides how to proceed with such an offer.

A further prerequisite for an opt-out is a statement as detailed as possible in accordance with the requirements in the Form as to which parts of the Specification would be infringed by the Relevant Claim. Unsubstantiated/general opt-out declarations are not allowed.

In both cases, PNO will inform its Members accordingly without delay. A license according to Art. 3 will not apply unless an agreement is reached with the Member.

If a license shall apply, the Member holding the Relevant Claim shall enter into appropriate licensing agreements with PNO or with interested Members or non-members.

Members acknowledge that excluding a Relevant Claim late in the process of developing a PNO Specification may considerably interfere with the development of a PNO Specification and may result in significant costs to PNO and other Members; accordingly, Members agree to use the opt-out option of a Relevant Claim only in the narrowest limits in accordance with good faith.

Members may not exclude their own Relevant Claims or Relevant Claims of their Affiliates directly related to their own Contributions or Contributions of Affiliates in a PG/WG or Joint-WG.

### **3.4 Decision of the Advisory Board in cases of doubt**

The PNO Advisory Board evaluates the consequences of the exclusion (opt-out) of a Relevant Claim regarding the development of a PNO Specification and decides on further steps.

## **4. Provisions on Copyrights**

Each Participant submitting a Contribution to a PG/WG or a Joint-WG grants to PNO a royalty-free, worldwide, non-exclusive, perpetual, irrevocable, sublicensable right to fully use and exploit the Contributions to fulfill the purposes of PNO with the following rights:

- PNO may use the Contributions in all types of use in any manner; in particular adapt, translate, reproduce in the original or in modified, adapted or transformed form, against compensation or free of charge, on any medium or any technical device in digital or analogue form, publish, distribute and rent in material or non-material form, make available to the public, broadcast, communicate, communicate publicly and non-publicly, and grant third parties use rights for all types of use. This right also extends to unknown types of use.

- PNO grants Members royalty-free sublicenses with the right to use and reproduce the Contributions in Products and Processes to the extent necessary to implement a PNO Specification. The right to adapt or transform PNO Specifications is excluded. Exceptions to this are the software examples included in PNO Specifications. Members may only a) sublicense to their Affiliates; b) sublicense use rights to third parties, insofar as these rights are necessary for the manufacture or development of Products and/or Processes on behalf of the Member (contract manufacturing); c) sublicense use rights to customers insofar as these rights are necessary for the contractual use of the Products.
- PNO may grant sublicenses to non-members free of charge or against compensation with the right to use and reproduce the Contributions in Products and Processes insofar as this is necessary for the implementation of a PNO Specification. The right to adapt Work Results and especially PNO Specifications is excluded. Non-members may only a) grant sublicenses to their Affiliates; b) sublicense use rights to third parties insofar as these rights are necessary for the manufacture or development of Products and/or Processes on behalf of the Member (contract manufacturing); c) sublicense use rights to customers insofar as these rights are necessary for the contractual use of the Products.
- Subject to the rights in pre-existing works of the Participant or his company, PNO owns the rights of use in all Contributions and Work Results for the fulfillment of its own purposes (including cooperation with Partner Organizations). PNO will be designated as the owner of all rights of use (Copyright Owner) in all PNO Specifications created internally and as part of joint projects and will include appropriate Copyright notices. In the case of joint projects, the Partner Organizations will agree separately on Copyright regulations, in particular on additional Copyright notices.
- PNO may grant sublicenses to additional third parties, such as RPAs or Partner Organizations on joint projects, to fulfill its own or the joint purposes.

Members shall use their best efforts to ensure that they are entitled to all necessary rights in order to effect the above granting of rights of use pursuant to this Article 4, by entering into agreements to the extent necessary, with the respective authors, any Affiliates concerned and/or other third parties.

Members agree and shall use their best efforts - to the extent necessary - to ensure that the respective authors of the affected Contributions agree not to exercise moral rights (recognition of authorship, publication, distortion of the work) to the extent permitted by law and not otherwise agreed with PNO in individual cases.

Software: The regulations in this Article 4 apply accordingly to use rights in Copyright regarding software which is provided as a Contribution to a PG/WG or Joint-WG. Participants may possibly agree on additional or different (e.g., licensing) arrangements with PNO, however, the license of the Participants to PNO shall be generally free of charge. PNO may grant sublicenses of contributed software to Members and non-members on separate license terms to the extent necessary to support the implementation of a PNO Specification.

As far as Member Contributions contain software components that are subject to open-source software license terms, the respective Participants shall ensure that only such Contributions are made available that can be used by PNO to the extent described in this Article 4, producing the applicable open-source software license terms.

## **5. Miscellaneous**

- The IPR Policy applies to all activities of PNO. The IPR Policy supersedes all previous IPR Policies of PNO.
- Upon becoming a Member of the association, Members are bound by the provisions of this IPR Policy.
- New Members are subject to the patent licensing obligations described in Section 3.2 for all their Relevant Claims (and those of their Affiliates) that relate to a PNO Specification that was adopted prior to the date of the New Member's membership.
- Application to non-members: The IPR Policy applies accordingly to non-members to the extent that they participate in the development of a PNO-internal PNO Specification or a PNO Specification within joint projects with Partner Organizations (if PNO is the host). Non-members shall sign a corresponding written declaration to PNO.
- Effect of withdrawal from PNO:
  - Upon a Member's withdrawal from PNO, all licenses granted by the Member or its Affiliates shall remain in effect.
  - Upon a Member's withdrawal from PNO, all licenses granted to the Member or its Affiliates shall remain in effect.
  - After the date of its withdrawal, the former Member shall still be obligated to grant licenses under Articles 3 and 4 of this IPR Policy, and to ensure that its Affiliates grant them, for those Relevant Claims that became Relevant Claims prior to the withdrawal date and for Relevant Claims relating to those parts of future versions of a PNO Specification that are substantially the same as the

versions released prior to the withdrawal date. Otherwise, no new licensing obligations arise after the withdrawal date.

- Members or Affiliates holding Relevant Claims who transfer Relevant Claims to a third party undertake to impose upon the acquirer their licensing obligations under this IPR Policy in respect of the Industrial Property Rights to be transferred. Further, they undertake to use their best efforts to ensure that their Affiliates transferring Relevant Claims to third parties impose upon the acquirer the licensing obligations under this IPR Policy regarding the Industrial Property Rights to be transferred.
- The Members commit to ensure that bodies or employees of the Members affected by obligations arising from this IPR Policy comply with by them as if they were themselves directly bound by this IPR Policy.
- This IPR Policy is governed by German substantive law to the exclusion of conflict-of-law rules.

*This document is a translation of the German version of the „Intellectual Property Rights (IPR) Policy der PROFIBUS Nutzerorganisation e.V. (PNO)“. The English text constitutes only a non-binding translation. The German text is binding.*

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This document titled "Intellectual Property Rights (IPR) Policy of the PROFIBUS Nutzerorganisation e.V. (PNO)" was issued by the Board of Directors and Advisory Board of PROFIBUS Nutzerorganisation e.V., Karlsruhe, Federal Republic of Germany, on March 11, 2022, and confirmed by the General Assembly Meeting on April 25, 2022.



# Annex

## Form for Reporting a Relevant Claim:

(Please attach a copy of the Claim).

<b>Proprietor of the Relevant Claim:</b>	
<b>Official reference number:</b>	
<b>Internal reference number:</b>	
<b>Title:</b>	
<b>Relevant Claims:</b>	
<b>PNO Specification concerned:</b>	
<b>Relevant sections of PNO Specification:</b>	
<b>Granting of license:</b>	<input type="checkbox"/> License to be granted in accordance with PNO IPR Policy (normal scenario) <input type="checkbox"/> Request for licensing under deviating conditions (exceptional/special case) (Justification on additional sheet) <input type="checkbox"/> No licensing desired (exceptional/special case) (Justification on additional sheet)
<b>Comments:</b>	
<b>Contact person:</b> (Name, phone, e-mail)	
..... Place, Date	..... Name in block letters Signature