

Open Industry 4.0 Alliance

# INTELLECTUAL PROPERTY RIGHTS POLICY

As of April 23<sup>rd</sup> 2021



This Open Industry 4.0 Alliance Intellectual Property Rights (IPR) Policy governs (i) the objectives and collaboration principles of the Open Industry 4.0 Alliance (“OI4 Alliance”) (Section 1), (ii) the intellectual property in deliverables by OI4 Alliance and the members of OI4 Alliance (“Members”) and potentially third parties (Section 2); (iii) the licensing of certain IPR by Members to other Members in the context of the implementation of certain specifications (Section 3); (iv) the licensing of the right to use certain names and logos by and to OI4 ALLIANCE (Section 4).

This Policy has been adopted by the Board of OI4 Alliance on April 23rd, 2021 and, based on Section 9 of the bylaws of OI4 Alliance, dated October 4th, 2019 applies to and is binding on all Members.

## 1. General Principles

- a. OI4 ALLIANCE aims at the development, documentation and promotion of better interoperability, which foster economic interpenetration and encourage the creation of new and improved products for the Industrial Internet of Things. OI4 Alliance discusses, interprets and creates non-binding implementation and utilization guidelines and specifications for the interoperability of products and services in workgroups of OI4 Alliance (“OI4 Alliance Deliverables”). These interoperability guidelines and specifications are solely focused on requirements to facilitate interoperability of products as well as services which use both existing standards (e.g. OPC UA, eClass, IDSA, MQTT) or de facto standards (e.g. Docker, etc.). Such interoperability requirements may comprise, for example, the definition of reference architectures, profiles and semantics based on existing standard interfaces and protocols, selection of appropriate connection methods, synchronization mechanisms, security requirements in each case solely with respect to interoperability.
- b. **Unrestricted Member Participation:** All Members are free and encouraged to contribute to and participate in activities for OI4 Alliance Deliverables and, ultimately, for collective work as defined in Section 2.c.
- c. **Disclosure Obligations:** Members shall participate in activities for OI4 Alliance Deliverables in good faith and use reasonable efforts to draw the attention of OI4 Alliance in a timely fashion to potential

IP Rights that might be relevant for OI4 Alliance Deliverables, including but not limited to adopting Specifications as defined in Section 3 below.

- d. **Contribution to OI4 Alliance Deliverables and Evaluation and Selection of Contributions:** Members and their employees may contribute to OI4 Alliance Deliverables. They shall evaluate all such contributions solely based on their technical merits and potential to serve OI4 Alliance interoperability objectives as further outlined in this policy and other internal rules, if any.
- e. **Access to OI4 Alliance Deliverables.** Members shall give access to OI4 Alliance Deliverables on fair, reasonable and non-discriminatory terms, as further outlined in Section 3.

## 2. Copyright license to Contributions.

- a. **Contributors and Contributions.** Any work of authorship intentionally provided to OI4 Alliance by Members or third parties bound by this Policy for potential inclusion in a draft or final OI4 Alliance Deliverable will be deemed a “Contribution.” The entity or individual making the Contribution is the “Contributor.” To the extent that an employee of a Contributor is making the Contribution, the Member shall ensure that it has obtained all rights required from such employee to enable it to grant the rights and comply with all the provisions under this Section 2.
- b. **Copyright license to Contributions.** Each Contributor grants OI4 Alliance a worldwide, irrevocable, non-exclusive, royalty-free, fully-sublicensable license to reproduce, distribute, display, perform, create derivative works of and otherwise exploit the Contributions. For clarification purposes: Any license granted by a Member under this Section 2 shall continue after the membership of a Member has ended.
- c. **OI4 Alliance copyrights.** Subject to the Contributor’s continued copyright ownership in their Contributions, OI4 Alliance and not the Members, shall solely and fully own the full copyright worldwide in any collective works, compilations, joint works or derivative works created in connection with OI4 Alliance activities, in particular to OI4 Alliance Deliverables, and shall in

particular own the copyright in any such collective works, compilation, joint works or derivative works created by OI4 Alliance, its employees or its agents (collectively referred to as “New Works”). To the extent that such rights vest in one or more Members or their employees, the Members hereby fully transfer the copyright to such New Works to OI4 Alliance. This includes all kinds of exploitation presently known or becoming known in the future. In countries, where copyright cannot be transferred, this shall include a transfer and grant of unlimited rights of exploitation, to the extent permitted by applicable local law.

- d. **Attribution; moral rights.** Each Contributor, and each individual making a Contribution, waives any moral rights (or similar rights) to the maximum extent permitted by applicable law, and the Members shall ensure that all their employees making or contributing to a Contribution have waived any and all moral rights (or similar rights) to the maximum extent permitted by applicable law. OI4 Alliance Deliverables will be attributed to OI4 Alliance. However, OI4 Alliance will honor reasonable requests related to individual attribution when feasible, where required by applicable law.
- e. To the extent that such rights have not been granted or transferred by the above or can not be granted or transferred in advance, each Contributor and Member shall cause to be delivered or made available to OI4 Alliance any additional documents or take any actions as OI4 Alliance may reasonably require to complete the license and ownership transfer according to Section 2(b) and 2(c) above and do such other things reasonably necessary to give full effect to this Section 2 of this Policy.

### 3. Patent license obligations for Specifications.

- a. **Specifications.** One type of deliverable that OI4 Alliance produces within the Scope of the Alliance are technical guidelines and specifications that define requirements necessary to facilitate interoperability between Members’ or third party products or services, including through the use

of existing non-OI4 Alliance standards. Once approved as final by the OI4 Alliance Board on the basis of an objective and transparent process pursuant to Section 1 and as further outlined in Internal Rules of Operation, if any, these are “Specifications.” Every Member that participates in a particular working group is obligated to license certain patent claims in connection with Specifications developed by that working group (an “Obligated Member”), as described in this Section 3. A Member will remain an Obligated Member with respect to Specifications developed by that working group even after termination of such Member’s participation in the working group.

- b. **License obligation to Members.** Each Obligated Member agrees that if a patent claim that is owned, controlled or (sub-) licensable (without additional consideration other than to employees or Affiliates) by that Obligated Member or an Affiliate of the Obligated Member (“Member Patent”) becomes a Necessary Claim pursuant to Sec.3.b.iii, then the Obligated Member grants a royalty free license under fair reasonable and not discriminatory terms to that Necessary Claim for use within the Scope of the Alliance and Working Group Scope for the implementation of that Specification to all other Members provided such Member that implements the Specification upon request to it grants a reciprocal license (royalty free, fair, reasonable and non-discriminatory terms) to its and its Affiliate’s IP rights that would constitute Necessary Claims if the Member was an Obligated Member (if any) with respect to such Specification and subject to the definitions, limitations and exceptions described below. If such Member does not grant such reciprocal license, the Obligated Member(s) shall not be obligated to license the Necessary Claim(s) to that Member.

- I. An “Affiliate” is any entity that, directly or indirectly, owns, is owned by, or is under common ownership with, the Member, as indicated by ownership of more than 50% of the stock or other equity interests entitled to vote for the election of directors or an equivalent governing body of the relevant entity.
- II. “Scope of the Alliance” shall mean non-binding implementation and utilization guidelines and specifications for the interoperability of products and services of Members discussed, interpreted and/or created by workgroups of the Alliance. These interoperability guidelines and specifications are solely focused on requirements to facilitate interoperability of products as well as services which use both existing standards (e.g. OPC

UA, eClass, IDSA, MQTT) or de facto standards (e.g. Docker, etc.). Such interoperability requirements comprise for example the definition of reference architectures, profiles and semantics based on existing standard interfaces and protocols, selection of appropriate connection methods, synchronization mechanisms, security requirements in each case solely with respect to interoperability.

- III. A “Necessary Claim” is any claim in an Obligated Member Patent in any jurisdiction that would necessarily be infringed by an implementation of the relevant Specification that is within the applicable Working Group Scope. A claim is necessarily infringed only when it is impossible to avoid infringing it, because there is no commercially reasonable non-infringing alternative for implementing the Specification. All other claims, even if contained in the same patent as Necessary Claims, are not Necessary Claims. Necessary Claims, however, do not include claims to the extent they would read on the following:
- enabling technologies that may be necessary to make or use any product or service, or portion thereof, that may comply with the OI4 Alliance Deliverables, but are not themselves expressly specified in the OI4 Alliance Deliverables (e.g., manufacturing technology, compiler technology, object oriented technology, basic operating system technology, etc.); and/or
  - portions of any product and any combinations thereof the purpose or function of which is not required for certification for compliance, if any, with the guidelines/specifications; and/or
  - any non-OI4 Alliance standard provided by third parties which is referenced in the OI4 Alliance Deliverable.
- IV. The royalty free license granted on reasonable and non-discriminatory terms is a worldwide, non-exclusive license, limited to Necessary Claims, to make, have made, use, have used, import, export, offer to sell, lease, sell, promote and otherwise distribute the portions of the Member’s products and services only to the extent they implement the Specification.

- V. “Working Group Scope” means that scope set forth in the particular working group charter that defines the deliverables with specificity that the working group will develop.
- c. **Opt out;** review period. The Board will provide notice and a substantially complete draft version of each Specification to all Members for review no less than 60 days prior to its formal, final approval of the Specification. Such final approval requires a declaration in text form of the Board. A Member may declare that it opts out concerning a specific patent claim by specifically identifying a particular claim and the applicable portion of the relevant draft specification in writing to the Board prior to the end of the review period. Members acknowledge that opt-outs made late in the specification development process are highly disruptive to the process and potentially costly to OI4 Alliance and other Members; accordingly, Members agree to use the opt-out option only in the strictest good faith. The Member will endeavor to make such opt-out notification promptly upon becoming aware that the claim potentially may be a Necessary Claim and deciding that they are unwilling to license it, even if such awareness arises prior to the initiation of a review period. Members may not, however, opt out concerning patent claims that read directly on Contributions made by that Member that are embodied in a Specification. If a Member provides an opt out in accordance with this provision to the Board of Directors, the license obligation described in Section 3(b) and 3(f) will not apply to patent claims that the Member has opted out.
- d. **Effect of withdrawal from OI4 Alliance.** Even after the date on which a Member formally withdraws from OI4 Alliance (the “Withdrawal Date”), a Member that has withdrawn will continue to have an obligation to grant licenses as described in this Section 3 to those claims that became Necessary Claims prior to the Withdrawal Date, as well as to Necessary Claims that read on future versions of a Specification, limited to those portions of the future version that are substantially the same as in the Specification as it was approved prior to the Withdrawal Date. Otherwise, no new obligations attach post Withdrawal Date.
- e. To the extent that a license provided for in this Section can not be granted in this Policy or in advance, the Member concerned shall cause to be delivered or made available to the other Member, upon its request, any additional documents or take any actions as may reasonably be

required to complete the license according to this Section 3 and do such other things reasonably necessary to give full effect to such license.

- f. **Licenses obligation to Non-Members, FRAND Commitment.** Obligated Members commit to license Necessary Claims to third parties upon their request to the Obligated Member on the basis of fair, reasonable and non-discriminatory terms (“FRAND Commitment”) for use within the same scope as granted to Members for the implementation of Specifications provided such third party upon request to it grants a reciprocal license (fair, reasonable and non-discriminatory terms) to its and its Affiliate’s IP rights that would constitute Necessary Claims if the third party was an Obligated Member (if any). Such FRAND Commitment is a prerequisite for the final approval of a Specification.
- g. Should a Member terminate its membership it will become an “Ex-Member.” Ex-Members will retain any licenses that have been granted herein to the Ex-Member during the term of its membership for “Legacy Products and Services,” which are products or services that were sold or otherwise made available by the Ex-Member during its term of membership. Thus, an Ex-Member may continue to make, have made, use, have used, import, export, offer to sell, lease, sell, promote and otherwise distribute such Legacy Products and Services.

#### 4. Trademarks.

Section 9.3 of the By-Laws of OI4 Alliance contains provisions concerning names and logos, which apply.

#### 5. Confidentiality.

Information disclosed by Members to other Members in the context of OI4 Alliance or to OI4 Alliance shall be OI4 Alliance Confidential Information unless declared otherwise by the disclosing Member, until it is published as (part of) a Deliverable, including Specifications, following the written approval of such Deliverable made in a written declaration of the Board. OI4 Alliance Confidential Information may not be



shared with any third parties who are not members of OI4 Alliance or Members that are not Obligated Members of the specific Working Group or who have not executed a confidentiality agreement with OI4 Alliance and may not be used for any purposes other than participation in OI4 Alliance matters, except by the disclosing Member. If a Member that is not an Obligated Member of a specific Working Group requests OI4 Alliance Confidential Information from such Working Group it does not participate in, it shall be treated as an Obligated Member of that Working Group with respect to such OI4 Alliance Confidential Information. All non-public drafts of the OI4 Alliance Deliverables will also be deemed OI4 Alliance Confidential Information and be subject to the non-disclosure and non-use obligations. The Board will determine the timing and nature of any public release of deliverables.

## 6. Amendments; authority.

- a. **Sole agreement for OI4 Alliance activities.** This IPR Policy is the definitive and exclusive statement of intellectual property-related rights and obligations provided herein, subject to the Board's authority to define OI4 Alliance trademark and software license terms.
- b. **Assent to terms.** Participation in OI4 Alliance as a Member indicates assent to the terms of the Policy. Any party that desires to not be bound by the terms of this IPR Policy must abstain from joining OI4 Alliance as a Member and must not engage in OI4 Alliance activities.
- c. **Amendments.** The OI4 Alliance Board may amend this Policy at any time in its sole discretion in line with applicable law. No amendment to this Policy will be effective in less than 60 calendar days from the date that written notice of such amendment is sent to all Members.
- d. **Authority.** This Policy will be communicated to future Members before they join OI4 Alliance. By joining OI4 Alliance, Members are agreeing to be bound to the terms herein.

## **7. Governing law, Disputes.**

- a. This Policy shall be governed by and construed according to the laws of Switzerland.
- b. All disputes between at least one Member and the OI4 Alliance arising out of or in connection with the present policy shall be settled exclusively by the competent courts of Zurich, Switzerland.
- c. In the event of a dispute arising between Members, the Members concerned will use all means to endeavour to solve the dispute by internal conciliation.