

Eco-Patent Commons: Joining or submitting additional patents to the Commons

1. Read this document.
2. Fill out the *Application/Pledge Form* including identification of patents submitted for pledging, and sign.
3. Enclose membership fee – at this time, there is no fee.
4. Submit:
 1. A soft copy of the Application/Pledge Form package, which includes the Form, Pledge, Ground Rules, and Structure document to:
ecopatent@eli.org
 2. A signed hard copy of the Application/Pledge form package, which includes the Form, Non-assert Pledge, Ground Rules, and Structure Document to:

Eco-Patent Commons Executive Board
The Environmental Law Institute (ELI)
2000 L Street, NW, Suite 620
Washington, DC 20036
5. You should normally receive notice in less than four weeks (especially if the patent is in a listed IPC classification that belongs to the Eco-Patent Commons Classification List)

For any additional information please see
www.ecopatentcommons.org or send an e-mail to ecopatent@eli.org.

Eco-Patent Commons

The mission of the Eco-Patent Commons is to manage a collection of patents pledged for unencumbered use by companies and intellectual property rights holders around the world to make it easier and faster to innovate and implement industrial processes that improve and protect the global environment. The following articulates the ground rules and structure and governance of the Eco-Patent Commons. It also includes the language and patent classifications list applicable to the Eco-Patent Commons and a membership application form.

The Eco-Patent Commons was launched in 2008 by IBM, Nokia, Pitney Bowes and Sony. The Environmental Law Institute (ELI) became the host organization in 2012.

Eco-Patent Commons™ ground rules

- The Eco-Patent Commons (“Commons”) has been established to promote the use of patented inventions to improve the global environment.
- The scope of patents considered for inclusion in the Commons is based on the patent classification of the patent in question. An Eco-Patent Commons Classifications List (“Classification List”) of selected International Patent Classifications (IPCs) will be published. A patent will be included into the Commons if:
 - a) It has a primary IPC class that is on the Classifications List
 - b) A written statement is provided by the patent holder nominating the patent for inclusion and highlighting the environmental benefit(s) of the claimed invention
 - c) The patent holder is or becomes (by filing a membership application) a member of the Commons. “Environmental benefits” are those which, either alone or when included in a product or service, exhibit such characteristics as reduced/eliminated natural resource consumption, or reduced/eliminated waste generation or pollution.
- Patents included in the Commons shall be subject to a covenant, or pledge, not to assert the patent against implementers' environmentally beneficial use of the pledged patent(s). That is, subject to defensive actions described below, the patent holders shall not assert their pledged patents against an implementer's infringing machines, manufactures, processes, or compositions of matter that alone, or when in a larger product or service, achieve environmentally beneficial results.
- Any company or other patent holder can participate as a Member in the Commons, whether or not a member of the The Environmental Law Institute (ELI). Membership in the Commons is contingent on a party
 - 1) Having one or more approved pledged patent(s) in force,
 - 2) Paying the applicable membership fees, and
 - 3) Having submitted a membership application form that has been approved by the Executive Board.

The Executive Board and the Members hereby grant to all Members the right to use the Eco-Patent Commons mark solely to indicate their membership in the Commons; for the avoidance of doubt, Members shall not have the right to use the Eco-Patent Commons mark in association with any product or service. Members agree not to challenge the validity of the Eco-Patent Commons mark. Members and the Commons will negotiate reasonable arrangements by which the Commons may include the Members' logos on the Commons' website or for similar uses. Nothing in this Package allows one Member to use another Member's marks.

- After receiving a membership application (with the applicable membership fee) and proposed pledged patents, the Executive Board (or designee) will verify ownership of pledged patents. The submitter will generally be notified, within four weeks, whether its membership has been approved based on the appropriateness of the submitted patents. If approved, the member will be added to the membership list and the patent information will be posted on appropriate lists. Patents having primary IPCs not currently on the Classification List will be put on hold until the Membership can consider the proposed patent(s) and primary IPCs and decide, by a majority of those voting, whether the patents and IPCs should be added to the respective lists, based on environmental benefit(s). If no patents of a submitter are included into the Commons, 75% of the applicable membership fee will be refunded and the submitter will not become a Member.
- Members are free to withdraw from the Commons at any time by notifying the Executive Board in writing before a renewal membership fee becomes due. A member is obligated to pay applicable membership fees due prior to withdrawal. Withdrawal will, as of the date of notice, result in loss of membership rights and privileges, and in removal from the membership list. Voluntary or involuntary withdrawal shall not affect the non-assert as to any approved pledged patent(s) – the non-assert survives and remains in force. The term “patent pledger” below includes both active members and withdrawn Members.
- Membership is voluntary and it is up to the discretion of each Member as to

which patent(s) it submits.

- A patent approved for inclusion on the Patent List cannot be removed from the Patent List, except that it may be deleted for so long as the patent is not enforceable. An IPC class may be deleted from the Classification List only if the class is renumbered or (as determined by the Executive Board) is redefined to no longer be an appropriate classification for environmentally beneficial inventions, products and/or services. Deleting an IPC shall not affect the status of previously listed patents.
- Payments of maintenance fees on pledged patents are in the sole discretion of the patent holder. When a pledged patent lapses or otherwise becomes unenforceable, the patent holder shall provide written notice to the Commons and the Patent List (and Company List if appropriate) will be updated.
- The Pledge is intended to balance Patent Pledger interests and implementer interests. While these Ground Rules provide guidance and explanation, the Pledge language takes precedence over these Ground Rules in case of any inconsistency.
- Implementers can make, use, sell, and import infringing machines, manufactures, processes, or compositions of matter under patents on the Patent List without payment of any royalty or similar payments to Patent Pledgers if such infringing items alone, or when included in a product or service, achieve an environmentally beneficial result.
- The Pledge is subject to a defensive termination provision. A Patent Pledger may, at its option, terminate and render void *ab initio* its non-assert with respect to a party if:
 - (a) That party is a member of the Commons and such party (or someone acting in concert with that party) asserts an unpledged patent, with a primary IPC class on the Classification List, against that Patent Pledger's infringing machines, manufactures, processes, or compositions of matter (including products, services, and components thereof) where such infringing items alone (or when included in a product or service)

reduce/eliminate natural consumption, reduce/eliminate waste generation or pollution, or otherwise provide environmental benefit, or

(b) The party is not a Member of the Commons and asserts any patent infringement claim against that Patent Pledger or our infringing machines, manufactures, processes, or compositions of matter (including products, services, and components thereof). In the non-assert, the “party” and the “Pledger” includes their respective affiliates.

- The various lists (Patent List, Classification List) will be maintained by and posted on a website maintained by The Environmental Law Institute (ELI) under Executive Board guidance.
- It is the intent of the Executive Board and the Membership that these Ground Rules, and the Pledge terms, be interpreted in accordance with federal law, and the local laws of the State of New York, as applicable. Any term or condition of these Ground Rules or the Pledge terms held by a government body to be noncompliant with applicable law, will be modified as necessary to preserve intent, to achieve compliance, and to continue commitments.
- Expenses incurred by parties participating in the Commons will be borne by the respective parties.
- These Ground Rules can be modified prospectively with a two-thirds vote of all voting Executive Board Members. Revisions must be in writing and posted on the Commons website.

The ELI and each Patent Pledger are not responsible for third party claims arising from any act or failure to act hereunder by any other Patent Pledger. **The ELI, the Eco-Patent Commons Executive Board, Members and Patent Pledgers do not warrant or represent to each other or to implementers the success of the Commons, the validity or enforceability of patents pledged, the error-free management of the Commons program, or that any specific patent classification or any specific product, service, or component implemented by any other party is environmentally beneficial or that the**

patented technology is safe or effective for use, operation, or implementation, and that any party using the patented technology assumes the risk of doing so and hereby releases the Pledger and its affiliates from any and all liability relating in any way to the use of the pledged patents.

- The Commons is an unincorporated, non-profit association.

Non-assert Pledge

We, the holder(s) and pledger(s) of the patents listed in the pledge form, are committed to promoting the environmentally beneficial use of patented inventions to improve the global environment. Accordingly, we irrevocably (except as specified below) pledge and covenant to you that we will not assert any of our listed patents (including any worldwide counterparts) against you for any infringing machine, manufacture, process, or composition of matter claimed in such listed patent(s) where such infringing item alone (or when included in a product or service) reduces/eliminates natural resource consumption, reduces/eliminates waste generation or pollution, or otherwise provides environmental benefit(s). Listed patents shall have a primary International Patent Classification ("IPC") class included on the Classifications List.

Patents and patent classes may be added to the Patent List and Classifications List, respectively, as appropriate, in the manner set forth in the Ground Rules. We may, at our option, terminate and render void *ab initio* our non-assert to you if:

- (a) You are a member of the Commons and you (or someone acting in concert with you) assert an unpledged patent, with a primary IPC on the Classification List, against our infringing machines, manufactures, processes, or compositions of matter (including products and components thereof) where such infringing items alone (or when included in a product or service) reduce/eliminates natural resource consumption, reduce/eliminate waste generation or pollution, or otherwise provide environmental benefit, or
- (b) You assert any patent against us or our infringing machines, manufactures, processes, or compositions of matter (including products and components thereof) and you are not a Member of the Commons. In either case, we shall provide you notice of termination with a 30 day period to cure to our satisfaction.

This pledge is available to everyone directly from us. The term "you" and "Pledger" includes affiliates – that is, an entity that, directly or indirectly, controls, is under common control with, or is controlled by, another entity - as defined by majority control of voting stock or, if there is no voting stock, management

control. This pledge is personal in that it does not flow from you to your suppliers, business partners, distributors, customers or others. This pledge only applies to the patents on the Patent List, and no other license or non-assert is conferred as a result of this non-assert, by implication, estoppel, or otherwise. Any assignment or transfer of a pledged patent shall be subject to the continuation of this nonassert pledge or reserve right or take other measures to achieve that effect. If the patent holder becomes a debtor in bankruptcy, it is intended that you be treated as if a licensee who can elect to retain its benefit under this non-assert.

Eco-Patent Commons Structure and Governance

The Eco-Patent Commons will be governed by an Executive Board, subject to matters decided by Membership vote, in accordance with the Ground Rules and responsibilities outlined below.

The Executive Board is responsible for the following:

- Administering the operations of the Commons and making decisions regarding communications, marketing, Website, and any necessary legal functions
- Maintaining the charter and operational rules of the Commons
- Maintaining the non-assert Pledge governing the Commons
- Maintaining and posting the Company List, Patent List, and Classifications List for the Commons
- Determining and approving the budget for the Commons and setting the membership fee as deemed necessary. The membership fee is initially set to zero
- Carrying out the management and leadership roles. This will include a minimum of two co-chairs and a Project Manager
- Exploring ways to grow the Commons over time by increasing the number of Members and the number of pledged patents.

Executive Board positions are appointed by simple majority vote of all Members for a term of two years commencing the 1st day of appointment, except as provided below.

The Executive Board will primarily communicate via email and will meet by phone quarterly to discuss any pending issues. There will be one face-to face annual meeting, as feasible, hosted either by a participating company or the ELI. Additional meetings by phone or in person will then be scheduled as needed. Decisions by the Executive Board are made by consensus as much as possible, or by vote as provided herein. The Ground Rules, Structure and Governance, Non-assert, and Pledge Form documents can be revised by a 2/3 vote of the Executive Board. In case no consensus can be found, the chairs may organize a vote at their discretion.

Initial Executive Board

The Executive Board is initially constituted of representatives of the founding members and the host organization . These are representatives of: International Business Machines Corporation, Nokia Corporation, Sony Corporation, Pitney Bowes Inc., and the host organization. IBM and Nokia are initially appointed for a term of two years, while Pitney Bowes and Sony are initially appointed for a term of one year. The host organization is appointed for the lifetime of the Project.

Eco-Patent Commons Membership Application/Pledge Form

Name of Member's Representative (or individual patent holder):

E-mail address:

Legal name of company/organization or individual patent holder:

Address of your company/organization's headquarters (if you represent an organization) or your address:

Are you already a member of the Eco-Patent Commons? Yes ___ No___

Patents proposed for pledging (use separate sheet if needed):

Patent number	Title	Country	Primary IPC Patent Classification	Brief statement highlighting how the invention reduces/eliminates natural resource consumption or reduces/eliminates waste or pollutants, or otherwise provides environmental benefit(s)

By signing below, the signing party or the organization he/she represents (if any) agrees to the terms of the Eco-Patent Commons Non-assert Pledge. The signing party has read and understood the Eco-Patent Commons Ground Rules and Governance Structure and the signing party and organization he/she represents (if any) agrees to comply with the terms and conditions included therein.

*Party authorized to bind organization*_____

*Title*_____

*Signature*_____

*Organization*_____

*Date*_____

Please return signed form to: **Eco-Patent Commons Executive Board at
The Environmental Law Institute, 2000 L Street, NW, Suite 620, Washington,
DC 20036**