

**FRAND COMMITMENT FOR
ESSENTIAL WEIGHTLESS PATENT CLAIMS**

THIS AGREEMENT is dated _____ 20__.

BETWEEN:

- (1) **Weightless Management** registered in England with company registration number 08006561 whose registered office is at Suite 42 Innovation Centre, Cambridge Science Park, Milton Road, Cambridge, CB4 0EY United Kingdom (“Weightless Management”); and
- (2) **[Insert name of the Participant]** a company incorporated under the laws of [insert country] [with company registration number] [insert registered number] and whose [registered office]/[principal place of business] is at [insert address] (the “Participant”).

BACKGROUND

The Participant wishes to participate in the Weightless SIG as an Associate Member. Weightless Management is willing to permit the Participant to do so in accordance with the Bylaws of the Weightless SIG on condition that the Participant provides an undertaking to grant licences under its Essential Patent Claims (as defined below) on the terms set out in this Agreement.

THE PARTIES AGREE AS FOLLOWS:-

1. Definitions

In this Agreement the following words and expressions shall have the following meanings:-

- 1.1 Affiliate means any entity that directly or indirectly controls, is controlled by, or is under common control with another entity, for so long as such control exists, and:-
 - (i) in the case of companies and corporations “control” and “controlled” means beneficial ownership of more than fifty percent of the voting stock, shares, interest or equity in an entity; and
 - (ii) in the case of any other legal entity, “control” and “controlled” shall exist through the ability to directly or indirectly control the management and/or business of the legal entity;
- 1.2 Agreement means this agreement;

- 1.3 Certified Weightless Product means a product that complies with the Weightless Specifications and for which there is a valid and in force certification of compliance with the Weightless Specifications, issued by or on behalf of Weightless Management; and that is listed on the Weightless Certified Product Database;
- 1.4 Essential Patent Claims means any Patent Claims claiming any invention that
- (i) is technically necessary for compliance with all or any part of the Weightless Specifications; and/or
 - (ii) is the only economically feasible way of complying with all or any part of the Weightless Specifications;
- for the avoidance of doubt, where two or more Licensable Patent Claims cover all of the economically feasible ways of complying with all or any part of the Weightless Specification, those claims shall all be deemed to be “Essential Patent Claims” for the purposes of this Agreement;
- 1.5 Licensable Patent Claims means any Patent Claims under which the Participant or any of its Affiliates is, for the time being, under an obligation to grant licences on request in accordance with Clause 2.1;
- 1.6 Member of the Weightless SIG means any entity that for the time being fulfils the membership requirements for any level of membership as set out in the Bylaws of the Weightless SIG;
- 1.7 Patent(s) means (i) any patents (or their legal equivalent) issued or registered at any time in any country, including petty patents and utility models; (ii) any re-issues or renewals of such patents and any extensions of the exclusivity granted in connection with such patents; and (iii) any patent applications (or their legal equivalent) pending at any time in any country, including any continuation applications, divisional applications or continuation-in-part applications;
- 1.8 Patent Claims means any one or more claims of a Patent;
- 1.9 Weightless Certified Product Database means the database of certified Weightless products as maintained by or on behalf of Weightless Management;
- 1.10 Weightless Specifications means the entirety of any single version of a specification that relates to terminal to base station air interface features and has been adopted by Weightless Management including all mandatory and optional elements and including corrections, extensions or revisions of, to or derived from that version that have been adopted by Weightless Management;

2. Licence Undertaking

- 2.1 Subject to the provisions of Clauses 2.2, 2.3 and , the Participant shall, and shall procure that its Affiliates shall, grant to all Members of the Weightless SIG that request a licence, a worldwide, non-exclusive licence under (i) any Essential Patent Claims that are owned in whole or in part by the Participant and/or its Affiliates and (ii) any Essential Patent Claims that are licensed to the Participant and/or its Affiliates, in each case at any time during the term of this Agreement, to develop, make, have-made, use, keep, market, import, distribute, sell, hire or otherwise supply, offer to sell, hire or otherwise supply Certified Weightless Products on terms that are reasonable, non-discriminatory and demonstrably fairly based.
- 2.2 Subject to the provisions of Clause 2.4, the obligation in clause 2.1 shall not apply to any Essential Patent Claim if the Participant and/or its Affiliates is under an obligation:
- 2.2.1 to obtain the consent of any third party prior to the grant of a licence or sub-licence under such Essential Patent Claim; and/or
- 2.2.2 to make any payment to any third party in respect of the grant of a licence or sub-licence under such Essential Patent Claim.
- 2.3 In establishing whether the terms of a licence under clause 2.1 are reasonable, non-discriminatory and demonstrably fairly based, no regard shall be given to any arrangement whereby the Participant has granted a licence under the Essential Patent Claims on royalty-free terms to a third party granting a royalty-free licence to the Participant under that third party's own Essential Patent Claims.
- 2.4 The Participant shall not and shall procure that its Affiliates shall assign or otherwise transfer or agree to any encumbrance of any rights or interests in any Essential Patent Claims with the intent of circumventing in bad faith the commitment made in Clause 2.1.
- 2.5 **[Optional: delete this Clause 2.5 if it is not applicable]** The Participant and its Affiliates are willing to offer licences pursuant to Clause 2.1 in consideration of the following fees:-
- 2.5.1 a one-off administration fee (if any) of \$[]; and
- 2.5.2 royalties (if any) of \$[] per licensed device.
- This Clause 2.5 shall not be deemed to constitute acceptance by Weightless Management that the consideration set out in this Clause 2.5 satisfies the requirements of Clause 2.1.
- 2.6 The obligation in Clause 2.1 shall not require the Participant or its Affiliates to grant a licence:

- 2.6.1 to any party who is not and none of whose Affiliates are obliged under an agreement analogous to this Agreement to grant to the Participant and its Affiliates licences under Essential Patent Claims to develop, make, have-made, use, keep, market, import, distribute, sell, hire or otherwise supply, offer to sell, hire or otherwise supply Certified Weightless Products on terms that are reasonable, non-discriminatory and demonstrably fairly based; nor
- 2.6.2 to any party under a patent the validity of which is being challenged in a court of law, patent office or other competent legal tribunal by that party or an Affiliate thereof.

3. Transfers of Essential Patents

The Participant shall not, and shall procure that its Affiliates shall not, assign or otherwise transfer any right, title or interest in any Essential Patent Claim that is subject to the commitment made in Clause 2.1 and which the Participant and/or its Affiliates (i) know to be an Essential Patent Claim and/or (ii) have represented to be an Essential Patent Claim, except if such assignment or transfer is to a third party that has entered into an agreement with Weightless Management on the same terms as this Agreement.

4. Assignment of this Agreement

- 4.1 Neither party shall be entitled to assign, transfer, charge or otherwise deal in this Agreement or any of its rights or obligations under this Agreement except as set out in Clause 4.2.
- 4.2 Weightless Management shall be entitled to assign this Agreement (or any of its rights or obligations under this Agreement) to any Affiliate of Weightless Management or any third party that is to continue the role previously carried out by Weightless Management, provided that in each case that the assignee is a not-for-profit entity.

5. Third Party Beneficiaries

- 5.1 The Contracts (Rights of Third Parties) Act 1999 and any legislation amending or replacing this Act shall not apply in relation to this Agreement or any agreement, arrangement, understanding, liability or obligation arising under or in connection with this Agreement and nothing in this Agreement shall confer on any third party the right to enforce any provision of this Agreement, save that Members of the Weightless SIG shall have the benefit of, and be entitled to enforce the provisions of Clauses 2 to 4.
- 5.2 No variation to the provisions of this Agreement shall require the consent of any third party.

6. Term and Termination

- 6.1 The Participant may terminate this Agreement at any time after the Participant ceases to be an Associate member of the Weightless SIG by giving Weightless Management immediate notice of termination.
- 6.2 On termination of the this Agreement, the parties shall have no further obligations under this Agreement save that the provisions of this Agreement shall continue in full force and effect solely in relation to any Essential Patent Claim for an invention made prior to the date of termination if such Essential Patent Claim would, but for termination, have been subject to the commitment set out in Clause 2.1.

7. Miscellaneous

- 7.1 For the avoidance of doubt, although this Agreement contains a commitment to grant licences, it does not itself contain any licences; and
- 7.2 For the avoidance of doubt, neither party shall have any obligation under this Agreement to carry out any patent searches.

8. Law and Jurisdiction

The validity, construction and performance of this Agreement shall be governed by English law and the parties irrevocably submit to the exclusive jurisdiction of the English courts in respect all matters relating to this Agreement.

AGREED by the parties through their duly authorised representatives on the date written at the start of this Agreement:

For and on behalf of **Weightless Management**

For and on behalf of

.....
[Insert name of Participant]

Signed:

Signed:

Full Name:

Full Name:

Title:

Title: