

PTO Collaborates With UK Counterpart to Address Standard-Essential Patents

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On June 3, 2024, Under Secretary of Commerce for Intellectual Property and US Patent & Trademark Office (PTO) Director Kathi Vidal and Chief Executive Officer of the UK Intellectual Property Office (IPO) Adam Williams signed a memorandum of understanding (MOU) designed to tackle various issues related to standard-essential patents (SEPs).

SEPs are patents that have been declared essential to a particular technical standard. Common examples of technical standards with active SEP bases include cellular communication and other wireless standards, such as LTE, 5G and Wi-Fi. Standards are typically adopted by Standard Setting Organizations (SSOs). To have input on standard adoption, many SSOs require participants agree to license any patents that result from discussions with potential licensees on Fair, Reasonable and Non-Discriminatory (FRAND) terms (See e.g., [ETSI Intellectual Property Rights Policy](#)).

But what are FRAND terms, and who gets to decide whether they issue? While individual patents are territorial (e.g., a US-issued patent is only enforceable in the United States), patent owners often obtain patent coverage in multiple jurisdictions. This can lead to challenges wherein a court in one jurisdiction may determine FRAND terms for a patent in that jurisdiction, which may then set or significantly influence the FRAND rate for the patent owner's corresponding patents in other jurisdictions.

While the MOU is not public at this time, the PTO indicated that the MOU sets forth a framework for the following action items:

- Cooperate on activities to facilitate collaboration and exchange of information on policy matters concerning SEPs to better ensure a balanced standards ecosystem.
- Explore means to educate small- and medium-sized enterprises seeking to implement or contribute to the development of technical interoperability standards on FRAND terms.
- Examine ways of improving transparency in the FRAND licensing of technical interoperability standards.
- Engage in outreach to stakeholders to raise awareness of issues related to SEPs.
- Discuss means to incorporate additional jurisdictions into the PTO and IPO's activities concerning SEPs, including exploring a venue for broader discussions.

The agreement remains in place through June 3, 2029. PTO Director Vidal emphasized that “[t]his important collaboration with UKIPO will help us work together toward a fair and balanced international standard essential patent ecosystem that benefits all businesses in our two countries, including small and medium-sized enterprises and new market entrants.”

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