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WORKING PAPER

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TECHNICAL ADVISORY GROUP ON MACHINE READABLE TRAVEL DOCUMENTS

Sixteenth Meeting

(Montreal, 26 to 28 September 2005)

Agenda Item 2: Implementation of e-passports
Agenda Item 2.2: Report of the New Technologies Working Group

IMPACT OF PATENTS ON THE E-PASSPORT PROGRAM

(Presented by the New Technologies Working Group)

1. BACKGROUND

1.1 During its fifteenth meeting; i.e. Montreal, 17-21 May 2004, the Technical Advisory Group on Machine Readable Travel Documents (TAG-MRTD) received an introductory briefing on patents entitled *Review of Patents*, which summarized details on a number of patent applications that have been filed with a number of patent-granting authorities across the world.

1.2 A patent is an exclusive right to make, use or sell an invention in a certain country. As such it is a government-granted monopoly on an invention. This means that the holder of a patent can forbid (exclude) anyone from making, using, selling or importing that invention in the country in which the patent is valid, even if the other party has independently made the invention. A patent is valid for 20 years; after which the invention may freely be used by anyone.

1.3 The briefing at TAG/15 informed TAG-MRTD that the patent applications referenced in *Review of Patents* contained a number of claims that might *potentially*, if approved as claims in a granted patent, be interpreted in a court proceeding as describing aspects of the process of issuance of the new e-Passport, or technology used therein; or the processing of a presented e-Passport, including confirming the presenter as the rightful holder.

1.4 TAG-MRTD considered the introductory information and instructed the NTWG to review the various patent applications and claims therein and determine a course of action, should any action be deemed necessary.

1.5 Since TAG/15, a number of individual members of the NTWG have considered the information from the perspective of a specific Contracting State. NTWG also considered the information at its meeting in Tokyo, 31 August – 3 September 2004.

2. RECOMMENDATION

2.1 NTWG recommends that Contracting States, Issuing Authorities and Control Authorities take note of the various patents that have been granted, as well as filed, containing method, method of use and apparatus claims that may be relevant to the fabrication and issuance of the e-Passport and the processing of a presented e-Passport, including confirming the presenter as the rightful holder.

2.2 NTWG further recommends that Contracting States, Issuing Authorities and Control Authorities familiarize themselves with the general issues surrounding the use of methods (processes) and apparatus that may, in whole or in part, be embraced by patent claims. Those issues are:

- Patent Infringement – Patent infringement occurs when someone, without authorization, makes, uses, sells or offers to sell something covered by the claims of someone else's unexpired patent without authority from the patent owner. The patent owner may ask the court for an injunction to prevent the continuation of the patent infringement and may also ask the court for an award of damages
- Contributory Infringement of a Patent - Contributory infringement can be committed by knowingly selling or supplying an item for which the only use is in connection with a patented invention; and
- Indemnification against legal action brought by a Patent Owner – Indemnification is often a condition of the contractual relation between a purchaser and a supplier, which is designed to save the purchaser harmless; to secure them against loss or damage; to insure them; to compensate them for actual loss or damage or for trouble and annoyance in the event a patent owner seeks restitution for an alleged patent infringement.

2.3 NTWG acknowledges that the above issues vary depending on the jurisdiction (country) and whether the user is deemed to be the Government. For example, in the United States if the Government infringes a patent, the patent owner has a remedy for damages in the United States Court of Federal Claims. The Government of the United States may use any patented invention without permission of the owner under the government's eminent-domain powers (deriving from a public interest consideration), but the owner is entitled to obtain compensation for the use by or for the Government. The use of a patented invention by a Government without the permission of the owner is not universal and is governed by the law of an individual Contracting State.

2.4 NTWG recommends that Contracting States, Issuing Authorities and Control Authorities seek the counsel of experts familiar with patent law within their State to determine if granted patents and the issues surrounding a patented invention defined in paragraph 2.2 above need to be taken into consideration.

2.5 In making the above recommendations *NTWG is not expressing a view as to the validity of various patent applications, the claims cited in each or whether any have validity with respect to the issuance of the e-Passport or the processing of a presented e-Passport, including confirming the presenter as the rightful holder.*

3. **ACTION BY THE TAG/MRTD**

3.1 The NTWG invites the TAG-MRTD to:

- a) note the work of the NTWG to date on the subject of patents; and
- b) instruct the NTWG to continue to monitor the subject of patents and bring to the attention of TAG-MRTD any issues that could negatively impact on the successful implementation of ICAO's e-Passport program.

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