



Higher Regional Court Karlsruhe

6 U 183/16

Decision of 30 October 2019

[...]

Grounds

I.

The Plaintiff is suing the Defendant for injunctive relief, information/accounting, destruction and recall/removal from the distribution channels on account of an alleged patent infringement and is seeking a declaration of the obligation to pay damages.

[...]

A licence agreement covering the patent has not yet been concluded between the Plaintiff and the [A.] group of undertakings. The status of the "licence negotiations" can be summarised as follows:

On 13 October 2014 (Annex K4a), the Plaintiff informed [A.], prior to bringing the action, in writing and enclosing a list of the patents concerned, that the distribution of mobile telephones infringes UMTS and LTE patents essential to the Plaintiff's standard. Meetings offered by the Plaintiff in the following period did not take place due to several cancellations by [A.]. By letter of 28 July 2015 (Annex K4g), the Plaintiff again drew the attention of [A.] to a patent infringement, in particular by comparing patent claims and parts of the UMTS/LTE standard (see Annex K4g, Annex 3, No. 13), by means of a letter of 28 July 2015 (Annex K4g), and offered to conclude a licence agreement in accordance with the Plaintiff's patent licence programme in respect of UMTS/LTE patents, including the draft licence agreement. It asked for information as to whether [A.] was interested in a licence for UMTS/LTE patents held by the Plaintiff. Further technical information was



provided by the Plaintiff by e-mail of 25 September 2015. Until the filing of the action at the Regional Court on 19 October 2015, the Plaintiff received no reaction from [A.] or the Defendant. By letter dated 16 October 2015 (Annex [B]10), sent by post on 20 October 2015, [A.] stated that it was always prepared to negotiate in good faith the terms of a licence for valuable patents. After bringing the action, [A.], by letter of 25 August 2016 (Annex [B]16), submitted to the Plaintiff an offer of a licence which differed from the terms of the Plaintiff's licence agreement (Annex [B]17). In accordance with the counteroffer and the information provided on the sales figures so far accrued, an amount of approximately EUR [...] has in the meantime been deposited in favour of the Plaintiff. Lastly, representatives of the Plaintiff and the [A.] group of undertakings met in [...] on 3 September 2019 to discuss again various possible to discuss contract modalities.

The Plaintiff took the view that the Defendant's domestic marketing of the contested designs infringed the patent. These challenged embodiments working according to the LTE standard made direct use of the patent-appropriate teaching of the granted claim 7 of the Plaintiff's patent because the specifications of the LTE standard for the compilation of data for UL-SCH implemented the patent-appropriate teaching. The objection raised by the Defendant under antitrust law was unfounded. In this respect, the Plaintiff submits that it, for its part, had already fulfilled all the obligations formulated by the Court of Justice of the European Union in the Huawei v. ZTE decision before the action was brought. In particular, it provided sufficient information on the method of calculating the licence fee for its FRAND offer. In that regard, the Plaintiff submits that the notification of the unit licence fee requested and the references in the letters of 13 October 2014 (Annex K4a), 28 July 2015 (Annex K4g) and 25 September 2015 (Annexes K4h and K4i) to the scope and territorial coverage of the patent portfolio and to the Plaintiff's technical contribution to the development of the UMTS/LTE standard are sufficient. In any event, it was not obliged to provide further explanations to the Defendant, which in its view was in principle unwilling to license.

The Defendant has argued against the action that there is no patent infringement. It has denied the use of a patent in so far as the realisation of feature c, feature group d and feature f is not conclusively demonstrated on the basis of the standard, but, according to



a correct understanding of the patent, is in any event to be denied. At the very least, the objection to compulsory licensing under antitrust law precludes the enforcement of claims for injunctive relief, recall and destruction. Before bringing the action, the Plaintiff never explained why the unit licence which it requested complied with FRAND conditions. The [A.]'s declaration of readiness for licensing by letter of 16 October 2015 was not late, since a sufficient period of time was to be allowed for the examination of the documents provided.

With the judgment under appeal, to which reference is made because of the findings and all other details, the Regional Court largely granted the claims based on an infringement of the granted patent claim 7, and partially dismissed the claim only with regard to the substantive requirements for recall and removal. The Regional Court assumed that, contrary to the Defendant's objections, the challenged embodiments made literal use of the doctrine in accordance with the Plaintiff's patent. The patent infringement to be established thereafter, based at least on negligence, is the basis for the claims pursued with the petitions for action to the extent granted pursuant to Art. 64 EPC in conjunction with Sec. 139 (1), (2), Sec. 140a (1) s. 1, (3) s. 1, Sec. 140b German Patent Law (PatG) in conjunction with Secs. 242, 259 German Civil Code (BGB). The judicial enforcement of injunctive relief, recall and destruction claims is not precluded by antitrust law. The Plaintiff fulfilled its obligation to provide information before bringing the action. In a letter dated 28 July 2015 to [A.], which acts as the contact person for licensing questions within the group, the Commission had already identified the patents affected by the infringement allegation and the challenged mobile stations and submitted a list in which sections of the standards had been named for each of the patents in support of the patent infringement allegation. In addition, it had additionally provided claim charts under 25 September 2015. The [A.]-group's willingness to license (request for licensing), which was required thereafter, had not been expressed in good time. A corresponding reaction did not take place until the filing of the complaint. The declaration, dated 16 October 2015 and sent by post on 20 October 2015, was not made within a reasonable period of time. The duration of the period within which the patentee can expect a reaction in good faith and within which the patent user must express his willingness to license depends on the



circumstances of the individual case. Since [A.] did not react either to the Plaintiff's letter of 28 July 2015 or to the e-mail of 25 September 2015, the Plaintiff was under the impression that [A.] had no interest in licence negotiations. Therefore, the Plaintiff cannot be accused of having abused a dominant market position and building up pressure in contradiction of antitrust law by filing the action on 19 October 2015, which constitutes the 'bringing of an action' within the meaning of the judgment of the European Court of Justice (ECJ). Finally, the Regional Court assumed that the licensing request to be explained by the patent user prior to filing an action according to the case-law of the ECJ on the infringement notice of the patent proprietor could not be made at a later date. The obligations affecting the patent user would be devalued if he could make up for them at will after filing the action and thus subsequently withdraw the basis from the action filed. There would then be no significant consequences if the latter did not enter into licence negotiations before filing the action. In the absence of a catching-up mechanism for the request for licensing, the question whether the Plaintiff's offer meets FRAND conditions is irrelevant. The fact that [A.] had submitted a different offer, provided information and deposited a considerable amount was also irrelevant.

The Defendant's appeal is directed against this.

The Defendant, in part by repeating and deepening its arguments of the first instance and in part by raising new objections, essentially states that, if the interpretation is correct, the Plaintiff's patent is not infringed, in particular to the extent of the limitation experienced by the patent court judgment.

[...]

Contrary to the assumption of the Regional Court, the Plaintiff is prevented from enforcing the claims for injunctive relief, recall/removal and destruction. Even the approach of the Regional Court that [A.] had not shown its willingness to obtain a licence in good time before filing the complaint was not tenable. The infringement notice of 28 July 2015 was not sufficient due to the lack of attached claim charts and did not have to trigger a reaction from the Defendant or the [A.] group of companies. To the extent that, in



accordance with that provision, a sufficient indication of infringement must be based on submission of the claim charts by e-mail dated 25 September 2015, the time remaining until the filing of the complaint must be regarded as inappropriate for a reaction in the form of a request for licensing. Apart from that, the request for licensing made by the post office on 20 October 2015 was made before the Plaintiff had paid the advance on court costs and the action was pending here had been served, which is why, contrary to the opinion of the Regional Court, the request for licensing was made in good time. In any event, the Regional Court did not take into consideration the fact that the Plaintiff had already sent a draft contract to [A.]. In that regard, the Regional Court did not deal with the question whether the Plaintiff had impliedly waived the separate submission of a request for licensing by sending the information. Moreover, the Regional Court (Regional Court) ultimately contradicted the requirements of the ECJ in the decision "Huawei. /ZTE" by assuming that the pre-litigation obligations of the patent user cannot be made good. The party's conduct after bringing the action must be taken into account. It was a matter of preventing conduct contrary to antitrust law from being asserted in court. The failure to take account of procedural conduct on the part of the Defendant led to a lack of equality of arms. A patent proprietor who brings an action contrary to antitrust law although he has not fulfilled his obligations - e.g. by submitting an offer that does not conform to FRAND - can do so at will. The Defendant and the [A.] associated with it had shown itself to be willing to grant a licence at the latest in the current trial. Rather, the Plaintiff refuses to comply with its obligations as a dominant SEP holder. The Plaintiff's licence offer does not comply with FRAND because, despite considerable evidence of discrimination against the [A.] group of companies against other licensees, the Plaintiff refuses to provide any further explanations and information on the other licence agreements, in particular because it does not submit those licence agreements, even though the Defendant or [A.] offered on several occasions, as a precautionary measure, a non-disclosure undertaking subject to contractual penalties. The so-called '[G.] - declaration' - a private expert opinion of Prof. [G.] from October 2017, last supplemented in August 2018 - does not release the Plaintiff from further explanations, in particular the fact that it by no means satisfies the requirements to be imposed on the method of calculating the licence fee. For example, it



is already unclear what is meant by 'terms essentially identical' in the declaration with regard to the Plaintiff's licence agreements on current licence fees cited above. The lump-sum licences granted to other undertakings, in particular to [Y.], which were not disputed under the declaration, were not explained in any rudimentary way as regards their terms and reasons. Moreover, it is clear that the Plaintiff only selectively enforces its rights, which must be regarded as not FRAND-compliant. The Defendant could demand the submission of the licence agreements concluded by the Plaintiff in accordance with Sec. 142, 131 German Civil Procedure Code (ZPO) and Sec. 421, 422 ZPO in conjunction with Art. 102 TFEU and the FRAND commitment of the Plaintiff or Sec. 809 German Civil Code (BGB) within the framework of the antitrust compulsory licence objection.

Since the Defendant is 'actively entitled' to raise the FRAND objection, it is also entitled to a substantive right to the submission of licence agreements, which it now asserts by way of counterclaim.

The Defendant claims that the Court should

1. set aside the judgment of the Regional Court and dismiss the action;
2. by way of counterclaim, order the Plaintiff to produce all licence agreements and/or settlement agreements in its possession, including any side letters, relating to individual and/or all patents and/or patent applications referred to in Enclosures (Annexes) 1 and 2 of Annex K4a, in particular contracts concluded with the undertakings '[X.]', '[Y.]' and '[Z.]' and the licence agreements to which the Plaintiff refers in the statement submitted in the pleading of 3 September 2019 pursuant to Annex K12 and which are marked as follows in Exhibit 2 to Exhibit 1 and Exhibit 2 to Annex K 12:

[...]

in the alternative, order the Plaintiff to submit the contracts with the undertakings '[Y.]', '[Z.]' and '[X.]' and the licence agreements listed in Annex K 12, Exhibit 2 to Exhibit 1 and Exhibit 2, as shown above.



The Plaintiff claims that the Court should

dismiss the appeal and dismiss the counterclaim.

The Plaintiff defends the regional court judgment by repeating and deepening its first-instance submission, whereby the Plaintiff's patent is finally asserted to the extent of patent claim 6 maintained by the Federal Patent Court.

[...]

The Plaintiff submits that the contested decision is in conformity with the requirements of the ECJ as regards the assessment of the FRAND objection. It was the intention of the ECJ, in the context of the fair balance of interests, that the parties should be able to conduct the licensing negotiations unencumbered by an action for injunctive relief, recall, removal and destruction. To that end, it is necessary that the obligations referred to by the ECJ be fulfilled before an action is brought. That is apparent directly from the judgment in paragraphs 60 and 61; it is precisely the correction of the decision of 15 December 2015 which makes it clear that the ECJ pays particular attention to the fact that not only the reference to patent infringement, but also all the obligations of the parties must be imposed before an action is brought. Accordingly, it is not mentioned at any point of the decision that the obligations of the patent proprietor or the infringer could be fulfilled after filing an action. Rather, any delayed acts could be interpreted as delaying tactics on the part of the infringer (para 65). Moreover, even if the action were upheld, the Defendant would not be left unprotected. The Plaintiff's obligation to grant licences on FRAND terms continues to apply. Failure to comply with that requirement constitutes a cartel infringement which the Defendant may report to the German Federal Cartel Office. If, contrary to expectations, it is assumed that the obligation of the patent user to submit a request for licensing can be made up for in the current proceedings, the Plaintiff has already satisfied its obligation to submit a FRAND licence offer. Contrary to the view taken by the Defendant and the Regional Court in the parallel dispute between the parties (Case



7 O 18/17, pending before the Senate as an appeal under Case 6 U 41/18), the Plaintiff is under no obligation to further explain the licence rates. An obligation to provide information on existing licence agreements cannot be inferred from the case-law of the ECJ. A disclosure of already existing contracts is not justified by the fact that the infringer cannot know whether he is being discriminated against. A general requirement of transparency is foreign to antitrust law. In addition, a far-reaching obligation on the SEP holder to provide information is contrary to the distribution of the burden of proof regulated in Art. 2 of the Cartel EU Directive. In so far as the Defendant and the Regional Court in the parallel legal dispute consider that there is evidence in need of explanation of discrimination in the different methods of payment used by the licensees, this is clearly too short-sighted. Any unequal treatment leading to a competitive disadvantage cannot be assessed solely on the basis of a direct price comparison, but must take into account all the commercial circumstances and conditions of the contracts to be compared and compare them as 'packages'. Finally, an obligation to provide information or to submit documents is contrary to the legitimate, internationally recognised confidentiality interests of the parties involved. The fact that the Plaintiff may base the licensing of its standard essential patents on different contractual conditions and must even base the licensing of its standard essential patents on different contractual conditions in the case of undertakings in different competitive situations directly shows that the Plaintiff has an interest worthy of protection in keeping those licensing conditions secret. In addition to the confidentiality interests of licensees, notably because their bargaining position would be weakened, a disclosure obligation would also give rise to competition concerns because it would, to a certain extent, lead to an open price agreement between licensees.
[...]

II.

The admissible appeal is only partially successful.

The admissible action proves to be only partially justified in the context of the examination under appeal.

[...]



Insofar as the Regional Court has recognised injunctive relief, recall/removal from the distribution channels and destruction, the judgment is subject to amendment because the Plaintiff is thus prevented from asserting its claim for antitrust reasons (D).

The counterclaim lodged at the appeal stage is in any case unfounded and must be dismissed (G).

In detail:

[...]

D.

The claims under Art. 64 (3) EPC in conjunction with Sec. 139 (1), Sec. 140a (1) and (3) PatG for injunctive relief, recall and removal from the distribution channels and destruction arising from the established patent infringement are currently unenforceable. The enforceability of these claims is opposed as a dilatory objection by the prohibition under Union law of the abuse of a dominant market position pursuant to Art. 102 TFEU.

1.

In the case at hand, the enforcement of the claims shall be subject to review on the basis of the prohibition of abuse under antitrust law.

The Plaintiff is the addressee of Art. 102 TFEU. As the proprietor of the LTE standard essential patent, it holds a dominant position in the domestic market, i.e. in a substantial part of the internal market, as is not disputed between the parties. This is because compliance with the standard is a mandatory prerequisite for access to the market for LTE-enabled mobile devices. The Defendant has unopposedly stated at first instance that mobile telephones which do not comply with the LTE standard are not marketable. In contrast, the Plaintiff has not argued that the LTE technology is demand-side or supply-side substitutable.

It can then be left open whether or not the obligations derived from Art. 102 TFEU and to be observed in the enforcement of the claim also rise independently of an antitrust obligation solely from the Plaintiff's ETSI-FRAND declaration / declaration of readiness to



license - i.e. the commitment given to the standardization organization ETSI by the proprietor of a patent declared to be standardessential, (for a consideration of the ETSI-FRAND declaration as a constitutive obligation under French law without the reservation of a concurrent antitrust obligation: cf. McGuire, GRUR 2018, 128, 134; other opinion: Bold, Hdb. Patent infringement, 11th edition, Cape E para. 305, 314).

2.

The enforcement of the claim may be opposed by a direct objection under Art. 102 TFEU that the infringement action, insofar as it seeks the exclusion of the Defendant from the downstream market by omission, recall/removal from the distribution channels and destruction of infringing products, appears itself to be an abuse of the dominant position conferred by the standard essential patent.

a)

Following the decision of the ECJ in the case "Huawei Technologies v CTE" (ECJ, Judgment of 16 July 2015 - C-170/13, GRUR 2015, 764), it is possible to classify the Plaintiff's exercise of the rights under a standardessential patent (SEP) standardised by a standardisation organisation as abusive if the action for infringement is capable of preventing products which comply with the standard from entering or remaining on the market (see ECJ, loc. cit. para. 54, 55 et seq, 73). The objection of abuse can then be raised against applications for actions aimed at injunctive relief and recall/removal from the distribution channels (see ECJ, loc. cit. para. 73) or at destruction (general opinion, see Higher Regional Court (OLG) Düsseldorf, GRUR 2017, 1219 para. 220 - Mobiles Kommunikationssystem). If the objection of abuse proves to be well-founded, the action must be dismissed as currently unfounded with regard to these applications (see OLG Düsseldorf, loc. cit. para. 220 - Mobiles Kommunikationssystem; Kühnen, Hdb. Patent infringement, 11th edition, Cape E para. 324).

b)

The abuse objection shall be well-founded if the SEP holder has its antitrust objection, does not fulfil obligations influenced by the commitment.

In so far as the Plaintiff, in its unabated pleading of 9 October 2019, deepened its view that a distinction had to be drawn between the substantive issue of the SEP holder's



obligations and the procedural objection in the infringement proceedings, the Senate took the view that this approach lacked any basis. Rather, it is the violation of those (antitrust) duties that constitutes the substantive bar to enforcement resulting from the procedural objection with regard to the patent infringement claims pursued by way of action.

In the "Huawei Technologies/ZTE" case, the ECJ identified the antitrust obligations of the SEP holder and their violation leading to abuse as follows:

aa)

In principle, the SEP holder abuses its dominant market position if it refuses to grant a licence under FRAND conditions - "fair, reasonable and non-discriminatory" (see ECJ, loc. cit. para. 53 et seq.; as a result also in conjunction with the "dolo petit" objection from Sec. 242 BGB to a "defacto standard": Federal Court of Justice (BGH), judgment of 6 May 2009 - KZR 39/06, GRUR 2009, 694 - Orange Book Standard). Such a refusal exists if the SEP holder refuses to grant a license in principle or is only prepared to conclude a contract under conditions that are not FRAND in terms of content.

bb)

Apart from such a (clear) refusal to grant a licence, the judicial assertion of infringement claims turns out to be abusive within the meaning of Art. 102 TFEU (see ECJ loc. cit. para. 55, 60) if the SEP holder does not fulfil certain obligations which guarantee a fair balance between the interests concerned (see ECJ loc. cit. para. 55, 59). This applies in particular to constellations in which there is no agreement as to which requirements are imposed by FRAND conditions (see ECJ loc. cit. para. 54).

(1)

In determining the obligations to be complied with by the SEP holder, the interests of the SEP holder in the protection of intellectual property rights (Art. 17 (2) GRCh) and his right to effective judicial protection (Art. 47 GRCh) shall be taken into account and on the other hand - in order to maintain free competition - the legitimate expectations of the third parties using the standardised technology that the patent holder would actually grant licences under FRAND conditions (in accordance with the irrevocable commitment to the relevant standardisation organisation) are to be taken into account (see ECJ loc. cit. para. 57 and 59).



In concretising this position of duty, the ECJ has established criteria which, if complied with - to the extent that they are decisive according to the particular legal and factual circumstances of the specific case (see ECJ loc. cit. nos. 56, 70) - preclude abuse. The judicial assertion does not therefore present itself as abusive if

- in a first step, the SEP holder informs the infringer regarding the alleged patent infringement, indicating the SEP in question and the manner in which it should be infringed (infringement notice, see ECJ loc. cit. para. 61),
- the SEP holder, after the infringer has expressed his intention to conclude a licence agreement on FRAND terms (licensing request), submits a concrete written licence offer on FRAND terms (FRAND licence offer) and, in particular, indicates the licence fee and the method of its calculation (information obligations; see ECJ loc. cit. para. 63),
- the infringing party does not react to this offer with care and, if the offer is not accepted, does not make a concrete counteroffer in writing within a short period which corresponds to FRAND conditions (FRAND counteroffer; see ECJ loc. cit. para. 65), and
- the infringer who (continues to) use the patent before concluding a licence agreement does not provide adequate security or submit a statement of account including past acts of use from the time at which the patent proprietor has rejected his counter-offer (see ECJ loc. cit. para. 67).

(2)

In the Senate's view, this concept developed by the ECJ lays down procedural and substantive obligations for the SEP holder (in particular the obligation to give notice of infringement, the obligation to offer a FRAND licence and information obligations), the existence and scope of which depend on the circumstances of the individual case. However, these obligations exist only vis-à-vis the patent user, who seriously and not only in words wants to acquire a license (if courts consider the patent as infringed and legally valid). The infringer must therefore comply with certain obligations (licensing request, FRAND counteroffer, security deposit and settlement) in order to confirm his willingness to license without delay tactics.

The obligations of the SEP holder safeguard the antitrust claim of the patent user who wishes to obtain a license on the granting of a license under "fair" (fair), reasonable



(reasonable) and non-discriminatory conditions. There is no universal answer to the question of what is meant by FRAND (cf. European Commission, Communication on the EU's handling of standard essential patents, COM(2017) 712, p. 8). In this respect, it is - as far as can be seen - predominantly assumed that FRAND conformity exists in principle for a certain range of licence conditions and not only for a single point result, i.e. that FRAND concerns a corridor which - in particular with the indeterminate concepts of fairness and appropriateness - leaves room for manoeuvre which cannot be examined under a rigid approach (cf. Fuchs in Immenga/Mestmäcker, Wettbewerbsrecht 6. Ed, Art. 102 TFEU para. 370; Block/Rätz, GRUR 2019, 797, 798 citing further references; UK Court of Appeal, judgment of 23 October 2018, [2018] EWCA Civ 2344 para. 121 - "Unwired Planet vs Huawei": "...the reality is that a number of sets of terms may all be fair and reasonable in a given set of circumstances."). The FRAND content is also usually specified taking into account the specific circumstances of the individual case in bilateral negotiations between patent proprietors and patent users, which are conducted according to the principle of good faith (Hinojal/Mohsler, GRUR 2019, 674). The parties to a SEP licence agreement negotiating in good faith are best placed to determine the most appropriate FRAND terms for their particular situation (European Commission loc. cit. p. 12). Accordingly, the obligations of the SEP holder substantiated by the ECJ - in conjunction with the obligations of the patent user - in expression of the fairness criterion of the commitment are intended in particular procedurally (cf. on classification as procedural requirements also: Eilmansberger/Kruis in Streinz, EUV/AEUV 3. edition of the German Patent and Trade Mark Ordinance, Art. 102 TFEU para. 125) to provide a negotiating framework which allows fair licence negotiations aimed at reaching agreement on a licence agreement on FRAND terms. These obligations, which secure the granting of a licence under FRAND conditions, can be summarised as negotiation obligations.

If the SEP holder fails to fulfil his negotiating obligations, the enforcement of claims intended to exclude the patent user from using the patent in the future will regularly prove to be an unjustified abuse of market power. If, however, the infringer does not comply with his obligations, he will regularly show himself to be unwilling to license or not acting in good faith, e.g. relying on delay tactics, whereby the (further) negotiation obligations of



the SEP holder may be suspended and the enforcement of rights may then appear as a justified reaction of the SEP holder.

3.

On the basis of the principles outlined above, on which the Regional Court also based its decision in the starting point, it must be stated that the Plaintiff is currently abusing its dominant position as a SEP holder with the applications for injunctive relief, recall/removal and destruction pursued in the proceedings. The Plaintiff, which does not in principle refuse to grant a licence under FRAND conditions, has so far not fully complied with its obligations to negotiate.

a)

Contrary to the opinion of the Regional Court, the Plaintiff is not relieved of these obligations because the Defendant (or the company [A.] responsible for licensing in the Defendant's group of companies) would have been late in expressing its will to license.

aa)

However, the Regional Court rightly assumed that the Plaintiff had already provided the infringement notice required in principle in its letter of 28 July 2015.

This was addressed to the correct addressees. The Plaintiff was not required to approach each of the national sales companies of the Defendant's group of undertakings individually. In accordance with customary practice and thus with the legitimate expectations of the patent user in constellations such as in a dispute in which portfolio patents are valid in several protective states and products using patents are sold in several of these protective states, it is appropriate to approach the group company which is responsible for license negotiations and licensing in the group, namely the parent company (see OLG Düsseldorf loc. para. 145 - Mobile communication system; Kühnen, Hdb. Patent infringement, 11th edition, Ch. E para. 339). According to the unchallenged findings of the Regional Court, [A.] as the recipient of the letter is the company within the Defendant's group of companies that acts as the contact person in licensing matters.

The letter was also sufficient as an indication of infringement in terms of content. The patent of the action was designated by stating how it should be infringed. The list provided in the letter lists the patent in suit together with the claim asserted and identifies the



standard document implementing the technical doctrine of the patent in suit with reference to the relevant section. This is sufficient to enable the addressee to form his own impression of the quality of the infringement allegation (if necessary with expert assistance or by obtaining legal advice) and to gain clarity about the interest in obtaining a licence. A conclusive assessment of the infringement allegation, which the infringer can in any case have reviewed by the court both with regard to the question of the essential character of the patent for the standard and with regard to the actual use (of the standard) (see ECJ loc. cit. para. 69), must therefore not be made possible by the notice of infringement. Accordingly, further detailed technical or legal explanations of the infringement allegation are not necessary (see OLG Düsseldorf loc. cit. para. 143 - Mobiles Kommunikationssystem; Kühnen, Hdb. Patent infringement, 11th edition, Ch. E para. 338). The Regional Court then correctly stated that it was not necessarily necessary to provide claim charts in the context of the notice of infringement, even if this corresponded to a customary practice in licence negotiations, because in the situation to be assessed here the patent user was not yet prepared to conclude a licence agreement on FRAND terms. Contrary to the Defendant's assertion with the appeal, the submission of the claim charts by e-mail dated 25 September 2015 was therefore not decisive for the required notice of infringement.

bb)

The Regional Court also rightly assumed that the licensing request in the case at hand was initially submitted late.

As a request for licensing, at the earliest the reaction of [A.] with the letter dated 16 October 2015, posted on 20 October 2015 and received by the Plaintiff on 21 October 2015 at the earliest can be understood - as the Regional Court rightly justified in detail (cf. reasons for decision IV.c) aa)) and against which the appeal does not argue - as a request for licensing. The examination and deliberation period triggered by the notice of infringement in a letter dated 28 July 2015 was exceeded at the time of the request for licensing. That period for examination and deliberation shall be relatively short and shall not normally exceed two months (see Kühnen, Hdb. Patentverletzung, 11th ed., Chapter E, para. 344). This is because the assessment of the time limit must take into account the fact that the infringer



is prohibited from postponing the conclusion of a licence agreement by means of delay tactics and that the infringer does not acquire any rights through the initiation of licence negotiations, but is rather free to subject the validity of the patent and/or the patent infringement to judicial examination (see ECJ loc. cit. para. 69). He is only expected to declare his willingness to conclude a license agreement if the patent is judged to be legally valid by the competent courts and is considered to be infringed by the challenged form of execution. In this respect, the Regional Court therefore also correctly stated that the patent user must show his colours at an early stage and express whether he is in principle prepared to take a licence or whether he consistently refuses to do so, so that it makes sense for the patent proprietor to submit an offer to him and to explain the way in which the licence rate is calculated in order to enter into concrete negotiations. In order to become clear about a willingness to license understood in this way and to express this through a request for licensing, no periods of time are required, as may possibly be necessary for a detailed examination of the allegation of infringement and the existence of rights in the individual case. Rather, it is sufficient to have a period of time in which it is possible to obtain an initial overview of the quality of the infringement allegation, in particular in order to assess whether the allegation is a priori unfounded or whether it could be justified because it does not appear to be unjustifiable. The Senate agrees with these statements of the Regional Court.

cc)

Insofar as the appeal argues that the pre-litigation delay in the request for licensing is irrelevant because the Plaintiff either impliedly waived such a request for licensing or because this request for licensing had been made at least in good time before the "bringing of an action", the questions raised in this respect may be left unanswered. In particular, in the case at hand, there is no need to determine whether the term "bringing an action" used by the Court of Justice of the European Union is to be understood in accordance with Union law simply as the time at which the action was brought or as the time "at which the Plaintiff has taken all the precautions necessary to conduct the legal proceedings so that it is no longer in his hands whether and when the legal proceedings continue" (Kühnen, Hdb. Patentverletzung, 11th Ed., Cape E, para. 346), i.e. at the earliest upon payment of the



advance on court costs. In any event, bringing an action does not preclude the infringer from "catching up" with his obligations.

dd) Contrary to the opinion of the Regional Court and the Plaintiff, pre-litigation obligations of the infringer - as well as neglected negotiation obligations of the SEP holder - can be "made good" during a pending legal dispute.

(1)

The requirements of ECJ do not exclude "catching up" in the process.

Despite the emphasis on "bringing an action", the concept of the European Court of Justice does not presuppose mandatory pre-litigation compliance with obligations and duties.

With regard to the procedural objection, the ECJ rather describes a general demarcation between abusive judicial assertion and justified assertion of a claim (see ECJ loc. cit. para. 55, 59). The "filing of an action" is thereby addressed as a starting point for the allegation of abuse of a dominant market position through abusive assertion of rights. Consequently, the case-law of ECJ does not preclude an assessment of the assertion of rights in the individual case, according to which the assertion of rights proves to be abusive only after the action has been brought, because the applications for action are upheld, although the relevant circumstances have subsequently changed - by fulfilling the obligations of the infringer after the action has been brought - or according to which the prosecution appears to be justified at the time of the decision despite the originally abusive bringing of an action, because the infringer can in the meantime no longer be regarded as willing to grant a licence or willing to negotiate in good faith. This is because the objective existence of an abuse of a dominant market position is assessed in each individual case on the basis of an overall assessment which takes due account of the legal and factual circumstances of the specific case (see ECJ loc. cit. para. 42, 56). The EJ therefore also points out that it is for the national court to determine whether the criteria laid down are met "in so far as, in the circumstances of the present case, they are relevant to the decision [...]" (cited above para. 70). The need for an overall assessment by the Court of First Instance is also emphasised by the Court of Appeal of England and Wales (UK Court of Appeal) in its decision in the case "Unwired Planet vs Huawei" (judgment of 23 October 2018, [2018] EWCA Civ 2344, para. 269 et seq.) in the reception of the case-law of the ECJ.



It should also be noted that the successful objection of abuse in the process - as explained above - presupposes a substantive breach of those obligations which the SEP holder has under antitrust law, taking into account his commitment. However, the obligation to grant a license under FRAND conditions, as well as the related negotiation obligations, exist - the Plaintiff does not assert otherwise and is, as far as is evident, also not seriously held as a view - independently of a patent infringement litigation. The first fulfilment of the SEP holder's obligations is then possible in the course of the patent infringement litigation, as is the non-fulfilment of previously suspended obligations following interim fulfilment of the infringer's obligations.

(2)

The recognition of the "catching-up ability" of duties and obligations also fits into the understanding of national procedural law and corresponds to the legal situation in the assessment of the conditions for a compulsory patent licence under Sec. 24 PatG (see Federal Court of Justice, judgment of 4 June 2019 - X ZB 2/19, para. 20 - Alirocumab). The relevant time of assessment for the existence of the conditions for a decision on the merits and the merits of an action for performance / application for a disposition - and thus the unfoundedness of objections - is in this respect solely the conclusion of the last oral hearing.

(3)

Finally, it would be contrary to the principle of proportionality, as it is also recognised as part of Union law (cf. Art. 5 TEU, Art. 6 TEU in conjunction with Art. 52 para. 1 sentence 2 GRCh), not to grant any effect whatsoever to the "catching-up" of obligations and duties during infringement proceedings with regard to the objection of abuse under antitrust law.

(a)

A restriction of the SEP holder's rights (cf. Art. 17 para. 2, Art. 47 para. 1 sentence 1 TCCR) by a fundamental refusal to allow him to make up for his obligations in infringement proceedings is not necessary in order to guarantee freedom of competition in the internal market (Art. 102 TFEU).



In order to guarantee freedom of competition, the (first-time) fulfilment of the negotiation obligations after bringing an action merely requires that fair licence negotiations are made possible to the same extent as with the fulfilment of these obligations before bringing an action. In this respect, it must be taken into account that the concept of the ECJ is also shaped by the idea that licence negotiations between the SEP holder and the infringer as licence seeker are not conducted under the pressure of an impending court judgement in order to avoid the infringer agreeing to unfavourable licence conditions influenced by this pressure (so-called patent hold-up; cf. Advocate General Wathelet's Opinion of 29 November 2014 -C-170/13, paragraph 102; UK Court of Appeal, Judgment of 23 October 2018, [2018] EWCA Civ 2344, para. 272 - "On the other hand, a SEP owner which is holding-up should not be able to use the threat of an injunction to coerce an alleged infringer which is prepared to take a licence on FRAND terms into paying exorbitant licence fees"). Accordingly, the effective fulfilment of the SEP holder's obligations after bringing an action requires that the SEP holder, by making up for his obligations, e.g. the licence offer or the information provided in this respect, seeks to bring about a situation which enables licence negotiations free of direct pressure from the pending court proceedings. In German procedural law, this negotiation situation, which is exempted from the direct threat of court orders, corresponds to the procedural situation during rest and suspension of proceedings in which the expiry of time limits is stopped (Sec. 249 (1) ZPO) and procedural acts undertaken by one party against the other in respect of the main action have no effect (Sec. 249 (2) ZPO). A "moderation" by the infringement court, on the other hand, cannot guarantee a corresponding pressure-free negotiation situation (other opinion: Kühnen, Hdb. Patentverletzung, 11th ed., Kap E para. 361). Accordingly, the Plaintiff in the patent infringement litigation is regularly required to work towards such a litigation situation for the effective fulfilment of the SEP holder's obligations by requesting the suspension of the infringement proceedings pursuant to Sec. 251 s. 1 ZPO (cf. in this respect already Regional Court Mannheim, GRUR-RR 2018, 273 para. 87) or, if necessary, by suggesting an amicable suspension of the litigation pursuant to Sec. 148 ZPO with regard to a pending legal validity proceedings. The infringer wishing to obtain a license as the Defendant will join such an application or suggestion and thus bring about



a legal situation in which license negotiations can be conducted free of the pressure of an infringement lawsuit.

(b)

Similarly, the effective enforcement of the SEP holder's rights does not require the limitation of the patent user's right to obtain a licence by fundamentally refusing to make up for his obligations in infringement proceedings.

The fact is that allowing the infringer to fulfil his obligations after bringing an action does not give him the opportunity to prevent the fair enforcement of the claim or to delay the infringement proceedings. On the one hand, the first fulfilment of the infringer's obligations after the filing of an action does not necessarily mean that at the time of the conclusion of the oral hearing a violation of the SEP holder's obligations and subsequently an objective abuse of the judicial assertion of patent infringement claims would always have to be established. Rather, the infringer bears the risk of late fulfilment of his obligations when, for example, in the case of a request for a licence shortly before the conclusion of the oral hearing, the SEP holder could no longer reasonably be expected to submit a FRAND licence offer by that time (see BGH, judgment of 4 June 2019 - X ZB 2/19, para. 20 - Alirocumab: "during the proceedings, as it were, 'at the last minute'"). On the other hand, the infringer cannot unilaterally bring the proceedings to a standstill by "catching up" with his obligations after filing an action. The Plaintiff SEP holder is regularly required to bring the proceedings to a standstill in order to effectively make up for its own obligations by submitting a request for suspension or suspension, which the Defendant will join in confirming its willingness to license. In the opposite case, however, in which it can be ruled out that the late fulfilment of the infringer's obligations is an expression of delaying tactics, the SEP holder does not have to agree without further ado to any suspension of the infringement proceedings proposed by the Defendant.

ee)

After all this, the judgement of the regional court with its supporting justification that the obligations of the infringer cannot be made good in the proceedings cannot be sustained. Rather, it must be taken into account that [A.] not only expressed its willingness to license in the form of a request for licensing at the latest at the beginning of the legal dispute, but



also underlined and maintained this by submitting a counter-offer and corresponding continuous information about the scope of the previous patent use as well as depositing corresponding security.

b)

On the assumption that the Defendant (or the [A.]) is in principle willing to license at the end of the oral hearing before the Regional Court but also before the Senate, it must be stated that the Plaintiff has not yet fully complied with its obligations to negotiate.

In any event, until the end of the hearing before the Court of Appeal, the Plaintiff did not fulfil its information obligations in respect of the licence offer which it submitted. Therefore, in the case at hand, it is not necessary to decide whether the licence offer submitted by the Plaintiff is actually FRAND-compliant with regard to its conditions and which standard is to be applied in this respect. Since the assessment of the FRAND conformity of the licence offer is not decisive in the case at hand, the Senate has no reason to decide on the Defendant's applications for referral pursuant to Sec. 142, 131 ZPO and Sec. 421, 422 ZPO.

aa)

The SEP holder is obliged to explain and provide information in relation to the FRAND licence offer submitted by him as part of his negotiation obligations.

These explanatory or information obligations are a direct expression of the fairness criterion of the commitment. In this respect, the ECJ has clarified that the SEP holder must not only submit a licence offer under FRAND conditions, but must also state "in particular the licence fee and the method of its calculation" (see ECJ loc. cit. para. 63). In particular, this means not only an explanation of the licence amount and the modalities of the calculation, but also precisely those circumstances which prove the contractual remuneration factors to be free of discrimination and exploitation (= FRAND) (cf. Kühnen, Hdb. Patentverletzung, 11th Ed., Kap E para. 335). This includes an explanation of the objective circumstances enabling the licence seeker to understand that the offer submitted by the SEP holder meets FRAND criteria. Only in the knowledge of these circumstances is it possible for the licence seeker to make a meaningful assessment of the licence offer (cf. Kühnen, GRUR 2019, 665, 668) and a corresponding counteroffer can



be submitted (cf. European Commission loc. cit. p. 12). This is also the only way to increase the chance that the parties can enter into discussions with each other and discuss constructively the question of the licence amount and individual questions concerning the form of the licence agreement (see Mannheim Regional Court, judgment of 28 September 2018 - 7 O 165/16 para. 66).

The scope and extent of the substantiation of these explanations and information depends on the licensing situation in the individual case (cf. Kühnen, Hdb. Patent infringement, 11th ed., Chapter E, para. 336; European Commission loc. cit. p. 12). To the extent that the SEP holder has already granted licenses to third parties, statements on the SEP holder's licensing practice and thus on the license agreements concluded with third parties are required with regard to the FRAND criterion of non-discrimination. If the license offer corresponds to a standard license program exclusively lived in the SEP holder's contractual practice and accepted by third parties, it will be sufficient on a regular basis to execute the license program to enforce it and to refer to the license offer's conformity with the standard license agreement. If, on the other hand, the SEP holder has concluded third-party license agreements with different license terms, he will regularly have to present and explain at least the content of the essential license agreement terms of those agreements to a sufficiently robust degree so that the license seeker can ascertain whether, to what extent, if any, and for what substantive reasons he is exposed to economically unequal terms. Should the SEP holder see himself prevented from making such substantive statements for legitimate reasons of confidentiality, he will have to demonstrate such interests with substance and - as is not unusual in negotiation practice (cf. Hinojal/Mohsler, GRUR 2019, 674) - make it possible to conclude a confidentiality agreement, as a result of which further information can then be provided. If, on the other hand, it is argued that the SEP holder must declare itself in respect of the complete content of all licenses granted, namely by submitting the license agreements (cf. Kühnen, Hdb. Patentverletzung, 11. Ed., Ch. E para. 451 with further reference), the Senate is generally unable to see a sufficient basis for this. The minimum degree of transparency of the licence offer, which can be derived from the FRAND criterion of "fairness" by explanation and information, serves to guarantee FRAND licence



negotiations in good faith (see European Commission loc. cit. p. 9, 12). The complete disclosure of third-party contracts is - as far as can be seen - not generally customary in the negotiation practice of FRAND licence agreements; no other claims have been made in the case at hand.

Whether and to what extent a legal dispute regarding the assertion that the licence conditions demanded by the licence seeker are discriminatory can give rise to and form the basis for a court order for submission does not need to be discussed in this context. It may also be left open here how the procedural burden of proof and presentation is distributed with regard to any actual discrimination against the licence seeker. Insofar as the Plaintiff contests the view of the Düsseldorf Higher Regional Court (see OLG Düsseldorf loc. cit. para. 177 - Mobiles Kommunikationssystem) that - the original prohibition of discrimination under antitrust law pursuant to Article 102(1), (2) lit. c TFEU - the SEP holder is subject to a secondary burden of proof with regard to equal treatment of license seekers and the (primary) burden of proof and presentation for a sufficient objective reason of unequal treatment, but without this having to be conclusively decided here, it cannot be ignored that the antitrust obligations are overlapped by the commitment to ETSI. This, however, provides for a valid choice of law in favour of French law in accordance with Art. 3 of the Rome I Regulation, according to which the commitment is a contract in favour of a third party as defined by Art. 1205 Civil Code (cf. McGuire, GRUR 2018, 128, 135), with which the fulfilment of that obligation, in particular by claiming non-discriminatory conditions, according to Art. 1353 para. 2 Civil Code could in principle be proved by the declarant as the debtor. The above questions raised by the parties do not need to be answered in case at hand because the Senate does not currently have to decide whether the SEP holder's license offer satisfies FRAND criteria in terms of content. According to the above, the SEP holder's information obligations as part of its negotiation obligations are in addition to the obligation to submit a licence offer that satisfies the FRAND conditions in terms of content. Contrary to what the Plaintiff probably thinks, the fulfilment of the information duties cannot therefore be denied with the argument that there is no unequal treatment under antitrust law.

bb)



In the case at hand, it cannot be established that the Plaintiff has so far complied with its information obligations regarding the licence offer submitted, as understood in this way. A sufficient explanation of the essential license agreement conditions of the license agreements already concluded with third parties by the Plaintiff did not take place until to the conclusion of the oral hearing, not even in the context of the private expert statements of Prof. [G.]. Thus, the Plaintiff refuses to provide the Defendant or [A.] with at least any clarification of the objective circumstances of the lump-sum compensation for past and future acts of use granted in the license agreement with [Y.] - as such undisputed - in the form of a one-off payment. The Plaintiff has neither stated whether the specific one-off payment is merely a different method of payment which is economically equivalent to the continuous unit licence otherwise predominantly required, in particular because it is based on the same or a comparable unit licence rate and certain sales forecasts which are realistic at the time of conclusion of the contract, nor has it explained that, although the flat-rate payment corresponds to a considerably more favourable comparative licence rate, there are objectively justifiable circumstances for licence fee claims which are subsequently economically unequal.

Furthermore, no aspects are demonstrated or otherwise discernible which make explanations of the licence agreement with [Y.] dispensable, since the licence seeker does not need this information, in particular for the meaningful assessment of the FRAND conformity of the licence offer. A dispensability of corresponding explanations and information may arise from the fact that discrimination is obviously excluded from the outset. However, nothing is apparent for this. The different market sizes of the undertakings concerned alone cannot be a relevant factor. This does not argue against the similarity of the undertakings concerned as manufacturers and distributors on the downstream market for LTE-enabled mobile telephones, nor does the size of the market in itself justify unequal treatment.

Finally, the Plaintiff has not identified any concrete and significant obstacles to a more detailed explanation of the flat-rate payment in question. In particular, it has not shown any specific secrecy interests with regard to a simple explanation to the extent described above, apart from the fact that it has not yet entered into a confidentiality agreement that



is not unusual in contractual negotiations, although the [A.]-group does not exclude itself from a promise of secrecy subject to contractual penalties.

4.

Since the Plaintiff has so far not fully complied with its obligations to negotiate, but has instead undermined a purposeful negotiation of the terms of the licence agreement by breaching its duty to provide information, the judicial enforcement of the claims for injunctive relief, recall/removal and destruction must currently be regarded as objectively abusive, taking into account the circumstances of the present case, with the result that the action must therefore be dismissed as currently unfounded.

E.

The Regional Court rightly determined the Defendant's obligation to pay damages and ordered the Defendant to provide information and accounting as well as to submit supporting documents to the extent requested.

1.

On the basis of the culpable infringement of the Plaintiff's patent, at least due to negligence, the Plaintiff is entitled to a claim for damages under Art. 64 (3) EPC in conjunction with Sec. 139 (2) PatG, the determination of which the Plaintiff can claim under Sec. 256 (1) ZPO. The Defendant is also obliged to provide the Plaintiff with information and accounting to the extent requested and granted pursuant to Art. 64 (3) EPC in conjunction with Sec. 140b (1), (3) PatG and an application of Sec. 242 ZPO which has been strengthened into customary law, whereby the Plaintiff may demand the submission of supporting documents pursuant to Sec. 259 Civil Code (cf. regarding the supporting documents: Senate, InstGE 1, 15 - SMD-Widerstand).

2.

The enforceability of the designated claims is not precluded by the prohibition under Union law of the abuse of a dominant market position under Article 102 TFEU, because the assertion of these claims - in the absence of direct effects on the supply of products manufactured according to the standard on the market - cannot be regarded as abusive



(see ECJ loc. cit. para. 74 et seq.; Higher Regional Court Düsseldorf loc. cit. para. 226 - Mobile communications system).

3.

The fact that the Plaintiff has not yet properly complied with its antitrust position overridden by its commitment, does not lead to a limitation of the content of the claims asserted in the infringement proceedings.

a)

With regard to the claims relating to an unlawful (and culpable) patent infringement, to the determination of the liability for damages on the merits and to information on the distribution channels, it is irrelevant from the outset whether a violation of the SEP holder's antitrust obligations results in a limitation of the amount of the claim for damages for patent infringement (see also OLG Düsseldorf, judgment of 22 March 2019 - 2 U 31/16 para. 227 - Improving Handover).

b)

But also with regard to the accounting claim, in case constellations such as in the case of a dispute the following arises

no content limitation. In spite of its failures, the Plaintiff may also demand information on costs and profits beyond the scope of Sec. 140b (3) PatG.

The claim to accounting, which is subject to the principle of good faith in terms of content and scope and is recognised under customary law, is an accessory auxiliary claim. As such, its scope is limited to the information necessary to enforce the main claim, which the creditor himself cannot obtain otherwise and the granting of which is not difficult and reasonable for the debtor (see BGH, judgment of 26 March 2019 - X ZR 109/16, GRUR 2019, 496 para. 12 - Spannungsversorgungsvorrichtung).

In this sense, the information on costs and profits is necessary for the enforcement of the claim for damages and also reasonable for the infringer. A limitation of the information does not follow from a limitation of the amount of the claim for damages under Sec. 139

(2)

Patent Law to a FRAND licence fee.



The refusal to grant a license under FRAND conditions to the infringer who is willing to enter into a contract in this respect - in violation of both the commitment and Art. 102 TFEU - can be relied upon as an obstacle to the claim for damages under patent law (see BGH, judgement of 13 July 2004 - KZR 40/02, GRUR 2004, 966, 969 - Standard-Spundfass) and limit the damages to the amount of the FRAND license fee. However, the violation of negotiation obligations does not in itself imply a refusal to grant a licence that meets FRAND criteria in terms of content. Nor is it yet established in this respect that the licence seeker would have licensed at all on FRAND terms. On the contrary, a FRAND licence agreement cannot be concluded after "late" fulfilment of the negotiation obligations, because the licence seeker is ultimately not prepared to take a licence under the FRAND conditions resulting from fair negotiations. If a FRAND licence agreement is concluded, however, the licence seeker will have to be placed by way of in rem restitution as he would have been if the SEP holder had duly complied with his negotiating obligations following the request for licensing. In the opinion of the Senate, a limitation in the amount of the claim for damages under patent law is therefore not currently certain - even for the period between the request for licensing and the conclusion of the oral hearing; the SEP holder therefore does not already lose the "full" claim for damages and therefore the "full accounting claim" (other opinion: OLG Düsseldorf, judgement of 22 March 2019 - 2 U 31/16 para. 230 - Improving Handover).

In contrast to the patent infringement claims leading to exclusion from the downstream market, the accounting claim cannot be rejected as currently unfounded. Even if the claim for damages under Sec. 139 (2) PatG should in future prove to be limited to the amount of the FRAND licence fee in terms of content, in this constellation cost and profit data are in principle to be regarded as necessary and reasonable (other opinion.: OLG Düsseldorf, judgement of 22 March 2019 - 2 U 31/16 para. 231 - Improving Handover). The Senate does not disregard the fact that, at least as a rule, these details are not required for the objective determination of damages in accordance with the principles of license analogy and can therefore not be required in principle (see BGH, judgement of 11 April 1989 - X ZR 26/87, GRUR 1989, 411, 414 - Offenend-Spinnmaschine; BGH, judgement of 20 May 2008 - X ZR 180/05, GRUR Int 2008, 960 para. 33 - Tintenpatrone). However, a general



exclusion of such information in connection with the determination of damages according to the principles of license analogy does not result from the supreme court's jurisdiction. Since the usual return on sales can be included in the determination of a claim for damages by way of license analogy (see on trademark law: BGH, judgement of 29 July 2009 - I ZR 169/07, GRUR 2010, 239, 243 para. 50 - BTK), the Regional Court Mannheim correctly points this out (GRUR-RR 2018, 273 para. 76) that in the case constellation in which the details of the amount of the FRAND licence fee are highly controversial, information on the profit generated by the infringer can, contrary to the principle, also become relevant for the preparation of an amount trial in the event of a liquidation of damages according to the method of licence analogy and can be demanded accordingly. Therefore, according to the view expressed here, it is not true that business data on costs and profits are not objectively required (other opinion: OLG Düsseldorf, judgment of 22 March 2019 - 2 U 31/16 para. 232 - Improving Handover).

[...]

G.

The admissible counterclaim is unfounded.

[...]

(2)

A right to the submission of third-party licence agreements does not, however, exist from any legal point of view, irrespective of the question of legitimacy.

a)

An independent claim for submission in respect of the license agreements as documents is not apparent.

Insofar as the Defendant refers to German law alone, namely Sec. 809, 810 BGB, it may remain to be seen how these claims are to be qualified and whether German law is to be applied at all in the case at hand. The fact is that the material scope of these submission



claims is not open. The Defendant does not claim that, within the meaning of Sec. 809 BGB to be able to have a claim with regard to the documents themselves. Contrary to Sec. 810 BGB, the deeds were not drawn up in the interest of the Defendant, nor did they certify a legal relationship between the Defendant and the Plaintiff.

b)

The ETSI-FRAND declaration of commitment does not entitle the licensee to present the licence agreements.

The assessment of such a claim is subject to French substantive law (Art. 3 para. 1 sentence 1, Art. 12 para. 1 lit. a Rome I Regulation) due to the choice of law (cf. McGuire, GRUR 2018, 128, 135). In this respect, however, the Defendant has not already shown that an obligation to refer - going beyond the assumptions of the Court of Justice of the European Union to explain the licence offer - can be derived expressly or by way of interpretation subject to French law from the declaration of obligation or results from complementary legal provisions of French law of obligations.

c)

Finally, there is no entitlement to a submission in connection with the entitlement to the grant of a licence which can be directly derived from Art. 102 TFEU.

In this respect, too, a submission obligation does not originally arise as part of the right to be granted a licence under FRAND conditions. As mentioned above with regard to the SEP holder's information obligations as an expression of the SEP holder's antitrust obligations superimposed by the commitment, such an obligation is not implied in the concept of the European Court of Justice and it cannot be established that a submission would correspond to the customary nature of licence negotiations.

After all, a claim for submission does not follow as a dependent claim for assistance in addition to the antitrust claim for the granting of a license. Under Article 6 (3) (a) of the Rome II Regulation, since the Plaintiff's conduct relevant to antitrust law (also) affects the German market, the Defendant may rely on German substantive law with regard to any supplementary questions under Article 102 TFEU. Although Sec. 242 BGB may in individual cases give rise to a specific right to information as an auxiliary claim for the preparation of a claim to the granting of a licence based on antitrust law, as such this does



not in principle include the submission of documents, the content of which may require secrecy. At most in the "special exceptional case", in particular if the provision of information is not suitable in terms of the substance to provide the person entitled with the necessary clarity, a claim for submission could be derived from Sec. 242 BGB (see BGH, judgement of 31 March 1971 - VIII ZR 198/69, juris para. 10). The mere desire not to have to rely on the accuracy of information provided by a party, but to want to verify it, turns out to be an investigation which is outside the scope of special regulations - such as the accounting claims which are not relevant in the context of license contract negotiations (e.g., the right to claim damages for the loss of a patent, the right to a refund for the loss of a patent, etc.)). according to Sec. 666 BGB), submission according to Sec. 810 BGB or on audit (e.g. according to Sec. 87c Para. 4 German Commercial Code (HGB)) - does not justify, from the point of view of good faith, granting a submission of documents (see BGH, judgment of 31 March 1971 - VIII ZR 198/69, juris para. 12).

H.

[...]

3.

The revision shall be permitted in accordance with Sec. 543 (2) ZPO.

On the one hand, the dispute is of fundamental importance. This is because legal questions are raised which are relevant to the decision, in need of clarification and capable of clarification, which can arise beyond the individual case in an indefinite number of cases and are therefore of special importance for the general public. Thus, the decision concerns individual questions of the correct implementation of the principles established by the Union Court of Justice in the "Huawei/ZTE" case, including the question of the "catching-up" of the obligations of the SEP patent holder formulated by the Union Court and the obligations of the patent user as well as the question of the existence and



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scope of information obligations of the SEP patent holder when submitting a FRAND-compliant license offer.

Furthermore, the approval of an appeal is necessary to ensure uniform jurisdiction, because the Senate - unlike the Düsseldorf Higher Regional Court in its judgment of 22 March 2019, Case No. 2 U 31/16 ("Improving Handover"), para. 229-232 - sees no basis for rejecting the accounting application with its focus on costs and profits in the situation in which the SEP holder has not yet fully complied with its obligations in connection with its own FRAND licence offer.

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