



KATHER · AUGENSTEIN
RECHTSANWÄLTE

Higher Regional Court Karlsruhe

6 U 103/19

Judgement of 9 December 2020

[...]

Grounds

E.

Contrary to the view of the appeal, the enforceability of the claims for injunction, destruction and recall/removal from the distribution channels for acts of infringement until the expiry of the property right is not precluded by the antitrust compulsory licence/FRAND objection.

1. The District Court correctly assumed that the plaintiff had a dominant market position due to its ownership of the standard-essential patent in suit. The appellant's rejoinder does not argue against this.

The fact that the dominant position ceased to exist with the expiry of the property right does not change the fact that the claims for injunction, destruction and recall/removal from the distribution channels (henceforth also: claims bound by cartel law) awarded for previous infringing acts are to be assessed on the basis of the cartel law requirements resulting from the dominant position still existing at that time.

2. The plaintiff sufficiently informed the defendants of the patent infringement, whereby informing the second defendant was sufficient (cf. FCJ, GRUR 2020, 961 marginal no. 89 - "FRAND-Einwand").

a) According to the purpose of the notice to draw the infringer's attention to the facts of infringement and the possibility and necessity of taking a licence, it is sufficient that the



patent is designated and the concrete act in which the infringement consists is indicated. The latter requires the designation of the type of infringement as well as the challenged embodiments. Detailed technical or legal explanations of the allegation of infringement are not required; the infringer must only be enabled to form a picture of the justification of the allegation of patent infringement - if necessary with expert assistance or by obtaining legal advice. The presentation of the allegation of infringement on the basis of "claim charts", which is widespread in practice, is regularly sufficient, but not mandatory (see FCJ, GRUR 2020, 961 marginal no. 85 – "FRAND-Einwand").

If the patent holder offers a portfolio licence, corresponding obligations to provide information apply to the presentation of the use of the portfolio patents by the challenged embodiments (see FCJ, GRUR 2020, 961 marginal no. 98 – "FRAND-Einwand").

As the Senate has already decided, both parties can in principle still make up for their obligations in the pending legal dispute (GRUR 2020, 166 marginal no. 116 et seq. - "Datenpaketverarbeitung").

b) Accordingly, the plaintiff has sufficiently pointed out the infringement of the patent-in-suit to the defendants and has also sufficiently explained the offered portfolio.

aa) The plaintiff has indisputably pointed out the infringement of the patent in suit. The submission of a claim chart on the patent-in-suit, which the defendants missed in this respect, was not necessary for this purpose. Irrespective of this, the action, which initially only sought a declaration of the obligation to pay damages and to provide information/invoices, was in any case an infringement notification.

bb) In connection with their comments on the composition of the [...] patent pool, they complain that the brochure on the [...] pool (Annex K 10c) merely lists patent numbers of allegedly relevant patents in one column and numbers of individual sections of various



standard documents in another column, but does not compare claim features with specific features given in the standard, as is the case with a claim chart, so that it is not possible to examine an alleged standard essentiality with reasonable effort. However, the required in-depth explanation is not necessary according to the above.

3. As the Regional Court correctly found, the entire pre-judicial and judicial conduct of the defendant was designed to delay the negotiations. There are no doubts about the correctness of this finding (§ 529.1 no. 1 ZPO). In assessing their entire conduct, the Senate is convinced that the defendants 1 and 2 (hereinafter also referred to as "the defendants") are not seriously willing to take a licence, but have been trying for years to delay the legal dispute until the expiry of the patent in suit (which they did successfully) and, in addition, to postpone taking a licence to the plaintiff's patent portfolio as long as possible in order to continue to use at least parts of the portfolio without paying a licence fee for this at the same time, in order to gain economic advantages from this.

a) The Senate is guided by the following considerations when assessing whether a licence seeker's conduct expresses a willingness to take a licence or serves to delay the conclusion of a licence agreement on FRAND terms.

aa) For the licence seeker's declaration of willingness to take a licence, which is to be required depending on the SEP holder's conduct, the declaration of a general willingness to take a licence is not sufficient. Rather, the licence seeker must clearly and unambiguously declare his willingness to conclude a licence agreement on FRAND terms, whatever terms may actually be FRAND (see FCJ, GRUR 2020, 961 Rn. 83, 95 - "FRAND Einwand"). This declaration must be serious and unconditional. A lack of seriousness may result from the overall assessment of the circumstances, in particular the conduct of the licence seeker. Mere lip service is not sufficient.



The willingness to license to be demanded from the infringer is not a static attitude which would continue to exist unchanged for a certain period of time after its denial or affirmation. Rather, the licence seeker must always prove that he is willing to take a licence and purposefully participate in the licence agreement negotiations (FCJ, GRUR 2020, 166 marginal no. 83). Otherwise, the negotiations based on this would be wastepaper. Since an infringer may have an interest in delaying the conclusion of a licence agreement until the expiry of the patent in suit, it must be excluded that his conduct of the negotiations serves the purpose of delay and not the purposeful conclusion of a licence agreement. In this context, the question of how a willing licence seeker would behave is of particular importance.

A bona fide licence seeker willing to obtain a licence would not be interested in postponing obtaining a licence as long as possible in order to bridge the period until the patent-in-suit expires or to avoid paying licence fees for as long as possible. Rather, he would have an interest in obtaining a licence as quickly as possible in order to shorten the period during which he uses the patent-in-suit or the patent portfolio with the patent-in-suit without authorisation or, in any case, without paying any remuneration. He would not see the negotiating obligations of the SEP holder primarily as an effective means of defending himself against a patent infringement suit, but would insist on their fulfilment to the extent that he needs them in order to negotiate a licence agreement on FRAND terms.

Contrary to the defendant's view, this does not overstretch the requirements for the infringer beyond the extent envisaged by the ECJ in the decision *Huawei v. ZTE* (GRUR 2015, 764). Rather, the ECJ also focuses on the infringer's will to conclude a licence agreement on FRAND terms (*loc. cit.*, para. 63) and emphasises that the infringer must not pursue delaying tactics (*loc. cit.*, para. 65). Admittedly, the ECJ only explicitly mentions delaying tactics in connection with the fact that the infringer's required reaction with diligence to the SEP holder's licence offer implies that no delaying tactics



are pursued. However, the requirement not to pursue delaying tactics is not limited to this, but applies throughout to the infringer who uses the patent without authorisation, in any case without consideration, until the conclusion of a licence agreement. Only in this case is it justified to suspend the injunctive relief of the patent proprietor, who has no claim against the infringer for the conclusion of a licence agreement. In this sense, even below the threshold of being obliged to make a counter-offer, the licence seeker is in principle obliged to participate in licence agreement negotiations in a targeted manner.

However, hesitant cooperation on the part of the licence seeker cannot, without exception, lead to the conclusion that the licence seeker is not seriously prepared to conclude a licence agreement on FRAND terms. Rather, such behaviour may be justified in individual cases as a still permissible reaction to the behaviour of the SEP holder, who for his part evades purposeful cooperation. However, it must be taken into account that the licence seeker is sufficiently protected against a delayed fulfilment of the obligations by the patent proprietor by the suspension of the claims bound by antitrust law for the period of the delay and the period of time needed for him to react appropriately, whereas the patent proprietor, who is not entitled to conclude a licence agreement, has no other option than to have the use of the patent-in-suit prohibited by the assertion of the said claims by a licence seeker who delays the conclusion of the licence negotiations with a view to the limited term of the IP rights by using delaying tactics. Therefore, the licence seeker must regularly react promptly to a delayed fulfilment of the obligations by the SEP holder. Furthermore, he must inform the SEP holder of any objections at an early stage and may not save them for later use in a legal dispute.

bb) In the opinion of the Senate, the following principles are decisive for assessing whether a licence agreement offer complies with FRAND terms and which obligations of a licence seeker apply with regard to a licence agreement offer of the patent proprietor.

(1) The Senate follows the - as far as can be seen - clearly predominant view that FRAND



compliance exists in principle for a certain range of licence terms and not only for a single selective outcome, FRAND thus concerns a "corridor" (of licence amount and licence terms) which - in particular with the indeterminate concepts of fairness and reasonableness - leaves room for manoeuvre which is not to be examined under a rigid approach. In particular, the FRAND content is usually specified taking into account the specific circumstances of the individual case in the context of bilateral negotiations between patent proprietors and patent users, which are conducted according to the principle of good faith, especially since the parties to an SEP licence agreement negotiating in good faith are most likely to be in a position to determine the most appropriate FRAND terms for their respective situation (see Senate, GRUR 2020, 166 marginal no. 106 et seq. - "Datenpaketverarbeitung").

(2) In order to fulfil the obligation to make a licence offer to the willing alleged infringer that complies with FRAND conditions, it is usually sufficient for the SEP holder to make an offer that generally complies with FRAND requirements, i.e. that is not unreasonable or exploitative (fair and reasonable) for the average licensee and is not discriminatory. The patent proprietor complies with its obligation to explain the offer if it explains the offer in a way that enables the actual licence seeker to understand on which comprehensible considerations the amount of the licence fee and the further conditions are based and why the SEP proprietor considers the licence fee and the further conditions to be non-exploitative and non-discriminatory.

The obligation of an SEP holder who has committed himself to the standardisation organisation to grant licences on FRAND terms to make a licence offer that complies with FRAND terms and to explain it follows from the fact that he can be expected to make such an offer because he is regularly in a better position than the licence seeker to assess and explain what complies with FRAND terms. This obligation of the SEP holder may at the same time avoid that the licence seeker, who inevitably depends on the use of the IP right (unlike in areas without standardisation), would have to make his own licence



agreement offer on an insufficient information basis in order to demand the obligation of the SEP holder to conclude a licence agreement on FRAND terms, as promised in the FRAND commitment and required under antitrust law. Otherwise, there may also be the risk that this offer by the licence seeker may turn out to be too unfavourable to the detriment of the licence seeker due to the insufficient information basis and the endeavour to ensure market access and not to take any risk in this respect. It may also be conceivable that the licence seeker misjudges the FRAND requirements due to insufficient information and initially submits an offer that is too low, but then submits an offer that is too high after a claim for injunctive relief. The dangers described may be suitable to cause a distortion of the prices for licences of an SEP.

The ECJ considers an initial offer by the SEP holder to be necessary precisely when neither a standard licence agreement nor licence agreements already concluded with other competitors have been published (see ECJ, GRUR 2015, 764 para. 64 - Huawei Technologies / ZTE). Accordingly, it must be sufficient if the patent proprietor does not publish such a standard licence agreement, but offers it to a licence seeker and explains it to him in the sense described above. This serves the purpose of enabling the licence seeker to check whether the licence offer generally complies with FRAND conditions and whether a different arrangement is required in his case, because any special features to be observed in his case lead to a licence offer that is generally not objectionable having the effect of being exploitative or discriminatory in his case. This puts the individual licence seeker in a position to make his own counter-offer on an informed basis, which takes into account any considerable peculiarities existing on his side. There is no need for further protection of the licence seeker. In particular, the licence seeker cannot expect the patent proprietor, on the basis of the patent proprietor's FRAND commitment, to individually adapt his licence offer, which is intended to initiate negotiations and enable the licence seeker to negotiate on a sufficiently informed basis, to the particularities existing in each licence seeker's individual case, although the licence seeker is easily able, on the basis of the information received, to propose necessary changes himself in



the form of a counter-offer if he is of the opinion that the licence agreement offered is not appropriate to his particular situation.

(3) The obligation of the licence seeker, if he does not accept the offer of the patent proprietor, to submit a counter-offer to the latter that complies with FRAND conditions already exists in any case if the licence offer of the patent proprietor is not clearly and unambiguously contrary to FRAND and the patent proprietor, by explaining his offer and the FRAND compliance of the conditions claimed by him, has enabled the licence seeker for his part to submit a counter-offer on FRAND conditions.

The Senate (NZKart 2016, 334 [juris para. 36]; order of 8 September 2016 - 6 U 58/16, juris para. 53, 57) has so far left this question unanswered in the context of orders under Sections 707, 719 Civil Procedure Code. However, it has assumed that the infringement court, should this be relevant, may not limit itself to a summary examination (in the sense of a negative prima facie check) when assessing whether an offer of the patent proprietor complies with FRAND conditions (NZKart 2016, 334 [juris para. 30 ff]; order of 8 September 2016 - 6 U 58/16, juris para. 49 ff). The Higher Regional Court Düsseldorf, which also rejects such a prima facie check, has furthermore ruled that only a FRAND-compliant offer by the patent proprietor triggers the further obligations of the licence seeker following the offer (HRC Düsseldorf, NZKart 2016, 139 [juris marginal no. 21 et seq.]; decision of 17.11.2016 - I-15 U 66/15, juris marginal no. 13 et seq.).

In the opinion of the Senate, the obligations of the parties to negotiate developed by the Court of Justice of the European Union (ECJ) (see ECJ, GRUR 2015, 764 - Huawei Technologies / ZTE) are not an end in themselves, but are intended to encourage the parties to reach an agreement on the terms of the licensing by negotiation. Moreover, as mentioned above, they may protect the licence seeker from having to make his own offer on the basis of insufficient information.



It is in the nature of things that the parties' ideas about what FRAND terms are often differ. It would bring negotiations to a standstill if the licence seeker did not have to respond to a licence offer by the patent proprietor only because it did not comply with the FRAND conditions, even though the patent proprietor had provided the licence seeker with sufficient information to enable him to make a FRAND offer. In this case, the information deficit on the part of the licence seeker is compensated, which justifies imposing the obligation on the SEP holder to make and explain the first offer on FRAND terms. At most, if the patent proprietor's offer clearly and unambiguously deviates from FRAND terms, the licence seeker can conclude from this that further efforts to obtain a FRAND licence are not promising, but that the patent proprietor, by virtue of its dominant position, is seeking to enforce non-FRAND terms contrary to its FRAND commitment.

The Senate sees this understanding confirmed by the statements of the ECJ in para. 66 of its decision *Huawei v. ZTE* (GRUR 2015, 764), according to which the alleged infringer, if he does not accept the offer made to him, can only invoke the abusive character of an action for an injunction or an action for a recall if he makes the proprietor of the SEP in question a concrete counter-offer in writing within a short period of time that complies with the FRAND conditions. The Court attaches this obligation solely to the rejection of the offer, without making it further dependent on the patent proprietor's offer satisfying FRAND conditions. The argument against reading in such a condition is that the licence seeker can only invoke the abusive nature of an injunction or action for recall in the event of a counter-offer. This includes the case where an abusive character arises from the lack of FRAND compliance of the patent proprietor's licence offer (see RC Mannheim, judgement of 21.08.2020 - 2 O 136/18, juris para. 178).

(4) Irrespective of whether an offer of a licence agreement on the part of the SEP holder triggers an obligation on the part of the licence seeker to submit a counter-offer, the licence seeker is regularly required to at least deal with an offer by the SEP holder without



delay and at least to set down his objections, his queries and his need for information possibly resulting from the offer promptly to the SEP holder.

Under no circumstances may he save his points of criticism in order to turn them against the SEP holder later in the infringement dispute. This applies in any case if the SEP holder's offer of a licence agreement does not prove to be non-FRAND to such an extent that it can be concluded that the SEP holder fundamentally and definitively refuses to licence on FRAND terms, so that an effort to obtain a FRAND licence and any consideration of the offer is pointless.

As explained above, a bona fide licence seeker willing to obtain a licence would be interested in obtaining a licence as quickly as possible and would therefore deal with a licence agreement offer of the kind described without delay. He would not see the SEP holder's negotiating obligations primarily as an effective means of defending himself against a patent infringement action, but as a means of enforcing the SEP holder's promised obligation to conclude a licence agreement with him on FRAND terms.

As mentioned above, the SEP holder's obligation to make a licence offer that complies with FRAND terms and to explain the way in which the licence fee is calculated and the circumstances on the basis of which he assumes that an offer is made on FRAND terms may also protect the licence seeker from having to make his own offer on an insufficient basis of information in order to demand the promise of licensing on FRAND terms. If the SEP holder violates his obligations, however, a suspension of other obligations to cooperate on the part of the licence seeker other than the submission of a counter-offer is regularly neither necessary nor appropriate from this point of view.

b) Nach diesen Maßgaben sind die Beklagten nicht lizenzwillig, sondern versuchen, durch eine Verzögerung der Lizenzvertragsverhandlungen den Abschluss einer Lizenzvereinbarung möglichst lange hinauszuschieben.



aa) It is already noticeable that the defendants have primarily used events in the infringement dispute as an opportunity to engage in significant activities in the licence agreement negotiations. In contrast, a licence seeker willing to take a licence would seek a licence irrespective of the initiation of legal steps and irrespective of the course of the litigation. In other respects, too, the course of events suggests that the defendants were at least primarily concerned with delaying the negotiation.

(1) Thus, the defendant's counter-offer of 11.11.2016 (Annex [...] B 7) already correlates conspicuously with the expansion of the action (initially only) directed against the first defendant by claims for injunction, destruction and recall/removal from the distribution channels in the written pleading of 04.10.2016.

(2) By written statement of 16 February 2017, the defendant then informed the court a few days before the hearing at first instance on 20 February 2017 that it had provided information in accordance with its counter-offer and had provided security in the amount of € [...] by filing an application for deposit with the Regional Court Mannheim on 15 February 2017 (Annex [...] B 14). According to the findings of the Regional Court, which are not contested, the defendant did not provide any further information pursuant to the counter-offer before the conclusion of the oral proceedings at first instance on 7 June 2019, nor did it pay any further amounts for its ongoing use of the patented technology. It can be left open whether the defendants were already under an obligation at that time to submit a counter-offer, to provide security and to provide information. A licence seeker willing to take a licence would not have waited until shortly before the oral proceedings if he undertook such measures with serious intentions and not merely for tactical reasons. A willing licensee, who is not solely concerned with tactical behaviour, would also have continuously updated the information once it had been provided and adjusted the security. It was only after the last oral hearing at first instance that the defendants updated the information (Exhibit [...] B 50) and supplemented it with information about all of the defendants' sales that have taken place in Germany up to and including 30 June



2019 (Exhibit [...] B 50a). Apparently, this was done under the impression of the oral proceedings and to avoid a conviction.

(3) The defendants initially also did not respond to the improved offer of 08.11.2017 (Exhibit [...] B 28), but undisputedly only after the plaintiff's reminder of 09.02.2018 (Exhibit K 10) with the threat to consider the second defendant as unwilling to take a licence and the negotiations as failed, the defendants contacted the plaintiff by e-mail of 16.02.2018, according to the plaintiff's uncontradicted submission, with the demand for further claim charts and the announcement that they needed more time.

Again, it is irrelevant whether it would have been incumbent on the defendants to respond to the amended offer with a counter-offer. In any case, a willing licensee would have come forward earlier and of his own accord.

Furthermore, the demand for more claim charts also points to a delaying tactic.

(4) It is also undisputed that the defendants did not respond promptly to the [...] offer of 26 June 2018 (Annex K 10b), but only by email of 15 October 2018 (Annex K 10f), after the plaintiff had sent another reminder, namely by letter of 14 September 2018 (Annex K 10e), in which it offered an arbitral clarification of the licence rate in the event of rejection of the offer and expressed its expectation of a response by 15 October 2019 at the latest. In the email of 15.10.2018, the defendants referred to their earlier counter-offer of 11.11.2006 and proposed a meeting in November. They did not submit a new counter-offer until 05.07.2019 after the hearing at first instance. This too, like the further provision of information, apparently took place under the impression of the oral proceedings in order to avert a threatened conviction.

Again, it is irrelevant whether the defendants would have been obliged to respond to the [...] offer with a counter-offer. A willing licensee would not have waited so long before



reacting in any way whatsoever and would at least have communicated the reasons for the impediment in a timely manner. The defendants first expressed reasons for obstruction, namely an alleged shortage of staff, in a different context, namely for the follow-up to the meeting in [...] on 15.11.2018, were voiced in an email dated 10.01.2019 (Exhibit K 10I). According to the unobjected findings of the Regional Court, with the exception of the aforementioned email, the defendants did not provide a reason for the initial lack of reaction to the [...] offer until the written statement of 5 July 2019.

The Regional Court correctly stated that the obstacles cited there, namely the [...] summer holidays and an alleged shortage of staff, did not justify the delay, especially since it is not apparent why at that time there was not even a brief reaction referring to alleged difficulties. The fact that impediments, as the Regional Court apparently found without objection with regard to the email of 10.01.2019 (Annex K 10I) already discussed, were only raised more than half a year later also makes them appear to be pretextual. In any case, a licence seeker who was willing to take a licence and who was not interested in gaining time would have communicated any obstacles immediately.

(5) The fact that, according to the unchallenged findings of the Regional Court, the defendants commented on the [...] offer in their submission of 5 July 2019 for the first time and set out their points of criticism does not correspond to the conduct of a licensee who is willing to obtain a licence and for whom delay is not important.

Insofar as the defendants take the position that they did not have to raise their points of criticism in writing as long as the plaintiff had not procedurally relied on the [...] offer, they fail to recognise - irrespective of the fact that they bear the procedural burden of presentation and proof for the FRAND objection - that in serious licence agreement negotiations it is not a question of who has to present which circumstance in court at which point in time, but rather of introducing any points of criticism into the negotiations without delaying tactics.



(6) The same applies to the fact that after the meeting on 15 November 2018 in [...] the defendants let the thread of the conversation break again and, according to the correct findings of the Regional Court, did not respond to the NDA proposed by the plaintiff despite several requests by the plaintiff in the months of November 2018 to January 2019, and in particular did not inform the plaintiff why they could not sign the proposed NDA. According to the findings of the Regional Court, any background reasons against signing the NDA were first vaguely hinted at in the course of the oral proceedings (cf. minutes of the oral proceedings) and then only specifically set out in the written submission of 5 July 2019. The defendants do not claim that they had already raised their points of criticism in sufficient detail in writing or by e-mail out of court in response to the plaintiff's enquiries.

It is irrelevant whether individual criticisms of the proposed NDA were already voiced during the meeting on 15 November 2018. A licence seeker willing to take a licence, who is not interested in delaying negotiations and tactics, would have been expected to raise any criticisms of the proposed NDA quickly, at the latest after the demands, in writing or by email and not save them for the oral hearing in the infringement dispute more than half a year later in order to turn them against the plaintiff.

(7) The lack of willingness to take a licence is further manifested in the fact that the 1st and 2nd defendants attempted to obstruct the enforcement of the contested judgment, which they also partially succeeded in doing (see special volume ZV I+II). In order to at least delay the enforcement, the first and second defendant signed a power of attorney on 22 July 2019, i.e. after the oral proceedings at first instance, which expressly excludes a power of representation to conclude contracts of surety and an authority to receive deeds of surety (see Special Volume ZV I+II, Annex AG 4). The fact that the power of attorney, which was limited in this way, was not immediately disclosed to the plaintiff during the proceedings or otherwise, but was only disclosed to the bailiff who had been commissioned by the plaintiff to serve the enforcement proceedings and the writ of



guarantee, only allowed the conclusion that it was not a matter of discussing the legal question of whether a power of attorney can be effectively limited as it was, but solely a matter of thwarting a first attempt at enforcement at the very moment of service, so that the plaintiff no longer had any possibility of reacting in this respect. (8) Auch der Umstand, dass die Beklagtenseite nach dem unwidersprochenen Vortrag der Klägerin das Angebot eines Gerichts in Den Haag, zu Vergleichsverhandlungen zusammenzukommen, nicht angenommen hat, unterstreicht die fehlende Lizenzbereitschaft. Selbst wenn - was die Klägerin bestreitet - parallel bereits ernsthafte Gespräche zwischen den Parteien gelaufen sein sollten, erklärt das nicht, weshalb gerichtliche Unterstützung nicht angenommen wird, zumal wenn sich die Verhandlungen bereits seit Jahren hinziehen.

bb) Further, the fact that the defendants did not view the anonymised third party licence agreements made available to them in an electronic data room as of 02.09.2019 underlines that they were only concerned with delaying the negotiations.

If the defendants have had a serious interest in the third party licence agreements, they would not have waited so long to conclude an NDA agreement. As explained, a serious licence seeker would have raised its criticisms of the proposed NDA agreement immediately in writing or by email and not have hinted at them months later and solely as a legal defence at the oral hearing and elaborated on them in a pleading that had not been postponed in this respect. Moreover, a licence seeker who is willing to seek a licence and who is interested in the progress of the licence agreement negotiations would have immediately submitted a counter-proposal for an NDA that takes account of his concerns. If the points of criticism are not raised in writing or by e-mail, but only later in the infringement dispute in the written pleadings, it is generally assumed that this is done purely for tactical reasons.



It is irrelevant whether the applicant already refused to disclose non-anonymised third-party licence agreements at the meeting on 15 November 2018. This would not have prevented a licence seeker interested in the progress of the negotiations from negotiating an NDA agreement in order to at least obtain further information on the contracts.

Without it being relevant in this context, the Regional Court was right not to grant any relief with regard to the NDA because the defendant's side, which is burdened with presenting and proving the FRAND objection under antitrust law, had reason to present its case earlier. It is also obvious that the plaintiff and, if applicable, its licensees have an interest in secrecy with regard to the licence agreements.

The assumption that the demand for further disclosure of third party licence agreements was only pretextual is further confirmed by the fact that the defendant's side undisputedly did not view a single licence agreement from the electronic data room, but limited itself to setting up the account offered to it. Admittedly, the third-party licence agreements made available electronically continue to be anonymised. Nevertheless, a licence seeker with a serious interest in these contracts would have looked at the contracts and the attached explanations and not ignored them as the defendants did. The lack of importance, or at best only slight importance, that the defendants attached to the third party licence agreements is further demonstrated by the fact that they indisputably did not even consider it necessary to inform their legal representative clearly and unambiguously about the possibility of accessing the third party licence agreements in an electronic data room. Therefore, it is obvious that the demand for the third party licence agreements, like the earlier demand for further claim charts, was merely a tried and tested formal means to delay the negotiations.

None of the alleged failures of the plaintiff cited by the defendants leads to a different assessment of the defendants' conduct. In particular, it is irrelevant whether the plaintiff



fulfilled its negotiation obligations in connection with the submission and explanation of a licence agreement offer on FRAND terms, because such obligations did not exist due to the defendants' lack of serious willingness to license. Irrespective of this, the defendant's criticism is not justified in many cases and in no way justifies the delaying tactics pursued by the defendant's side.

(1) It can be left open whether, in order to explain the way in which the licence fee was calculated, it is sufficient to place the licence fee demanded in the spectrum of licence fees demanded by other licensing programmes and to compare it with these, as the plaintiff only did at first.

For the explanation of the method of calculation, it was sufficient, at least in the case in dispute, that the plaintiff in its statement of claim (p. 74 et seq.), addressed the calculation factors which it considered to be incorrect and compared the licence fee demanded at that time with the fee from its own top-down example calculation with (partially) corrected calculation factors (maximum exposure limit for LTE 20%, total number of LTE patents of 5,000, its own share of this amounting to [...] %, average net sales price of a mobile phone of € [...]). Whether a calculation is correct in the result is not important for the purposes of the explanation.

Even if the explanations of the manner should not have been sufficient, this did not justify the delaying behaviour of the defendant. Even after the plaintiff, at the latest in the presentation for the meeting on 15.11.2018 (Exhibit K 10i, p. 10 et seq.) and again in the pleading of 17.05.2019 (p. 19, 68 et seq.) motivated its licence rates from the [...] offer in more detail with a top-down calculation and contrasted it with the defendant's own top-down calculation, the defendant's side did not derive anything from this but, as explained, did not get in touch for months, at least not with any significant contributions, despite several enquiries from the plaintiff. This shows that the demands for an explanation were only pretextual in order to delay the negotiations and the proceedings.



This is further strengthened by the fact that the defendant's side did not address the [...] offer in its next pleading of 08.04.2019 and later took the misguided position that as long as the plaintiff had not relied on the [...] offer in the proceedings, it did not have to address it.

In no case did the plaintiff owe the demanded cost-based calculation of a licence fee. As explained, the Regional Court rightly decided that the strict standards for water suppliers are not transferable to an SEP holder. The demand for a cost-based calculation is obviously just another means to delay negotiations.

(2) The fact that there may not have been a pressure-free negotiation situation during the proceedings does not lead to a different assessment.

First of all, the Senate shares the opinion of the Regional Court that it is sufficient for the creation of a pressure-free negotiation situation during a pending infringement dispute that the proceedings are suspended with regard to a pending case on the existence of rights. As a result of the stay, there is no immediate threat of an order to cease and desist, destroy or recall/final removal from the distribution channels. This is sufficient in any case if, as in the case in dispute, the Patent Owner requests a stay before he has received a notice in the portfolio proceedings with a preliminary assessment unfavourable to him by the Patent Court or the Patent Office dealing with the portfolio, because then he has to indicate that he is prepared to create a pressure-free negotiating situation.

Admittedly, the pressure-free negotiation situation may already have ended with the patent court decision in the invalidity proceedings or its notification by the plaintiff even before the meeting in [...] on 15.11.2018 and not only with the availability or submission of the grounds for the patent court decision. However, this does not suspend the defendant's obligation to constructively participate in the licence agreement negotiations without delaying tactics.



A non-pressure-free negotiating situation characterised by the fact that the infringer is threatened with the loss of market access leads at most to the fact that he cannot be ordered to cease and desist, to destroy or to recall/remove from the distribution channels if he does not accept the SEP holder's offer and also does not submit a counteroffer of his own. However, the requirement of a pressure-free negotiating situation is not an end in itself, but is only intended to protect the infringer from entering into a licence agreement with unfavourable terms or from having to make a counter-offer under pressure which he would not otherwise have made in this way, because otherwise he risks losing market access. Furthermore, it should enable the parties to conduct balanced licence agreement negotiations. Furthermore, a non-pressure-free negotiation situation does not relieve the infringer of any other obligations to cooperate. Thus, the infringer is not released from the obligation to receive information offered and to take advantage of information opportunities offered, nor from the obligation to analyse offers made and, if necessary, to give notice of the need for further clarification at an early stage. There is no interest worth protecting in refraining from these cooperations, especially since the infringer is sufficiently protected from an obstruction of its market access by the suspension of the claims bound by cartel law. If the infringer fails to cooperate or is reluctant to do so in view of the suspended antitrust claims, this does not exclude the conclusion that he is unwilling to license.

(3) The defendants were not excused from participating in the licence agreement negotiations because the plaintiff's licence offers were not FRAND-compliant.

All of the plaintiff's licence offers submitted in the proceedings (offer of 23 June 2016 (Exhibit K 4b), improved offer of 8 November 2017 with regard to the licence fee (Exhibit [...] B 28), [...] offer of 26 June 2018 (Exhibit K 10b)) were, as the Regional Court also took as a basis, in any event by no means non-FRAND to an extent that would have released the defendants from purposeful participation in the licence agreement negotiations and from conducting negotiations expeditiously. None of the contractual terms complained



of by the defendants exceeds the aforementioned measure, either individually or when considered as a whole. Moreover, at least the [...] offer is not clearly and unambiguously non-FRAND, so that the first and second defendant, as the Regional Court correctly assumed, were not released from the obligation to at least respond to this with a counter-offer. This assessment is not based on a summary examination, but on a comprehensive assessment of the offer and the interests involved.

(a) Contrary to the defendant's view, the fact that the plaintiff's offers leave open the start of the contract and the amount of the licence fees for the past does not prevent them from being FRAND-compliant. The former is in the nature of things, because it is not certain when the licence agreement will come into existence, the latter is already harmless because the SEP holder is obliged to conclude a licence agreement on FRAND terms, but not to regulate the consequences of past acts of use already in such a licence agreement. Admittedly, the Federal Court of Justice has only stated that the SEP proprietor is not obliged to retroactively legitimise the infringing acts for the period after the expiry of the patent in suit (FCJ, GRUR 2020, 961 marginal no. 100 – "FRAND - Einwand"). But even before that, no other standards can apply.

(b) At any rate, at least the licence fee demanded with the [...] offer does not clearly deviate from FRAND terms. The plaintiff has motivated the licence fee in several ways that are independent of each other.

On the one hand, the company relied on licence agreements already concluded for the [...] and the predecessor programmes under these or worse conditions. According to the findings of the Regional Court, the [...] licence programme as of 17 May 2019 comprised [...] licensees, the LTE licence programme [...] licensees. Admittedly, the defendant disputed the number of licensees. However, after the licence agreements had been made available to it in anonymised form, a more concrete denial would have been required. It is irrelevant whether the [...] programme can be described as established. In any case, the



licence agreements concluded are an indication that the licence fee is not clearly non-FRAND. For the reasons given below in connection with the counterclaim, there is no discrimination against the so-called licensee x5 from the said judgement of the Higher Regional Court of Düsseldorf.

On the other hand, the applicant motivated its licence fees with a top-down approach (cf. KS of 17.05.2019, p. 68 et seq.; likewise presentation of 15.11.2018 from Annex K10i, p. 10 et seq.). The calculation factors used here (average sales price of a mobile phone of € [...] as the assessment basis, total licence burden (2G, 3G, LTE) of 15%, 4,388 patent families as the total number of relevant SEPs (2G, 3G, LTE)) and the resulting per-unit licence rate of € [...] per SEP are in any case not clear and clearly not FRAND. As the applicant has explained, the number of patent families and the total licence burden are in the range that has already been the subject of court decisions (cf. Annex K 10a, p. 18 et seq.). The defendants do not substantially dispute that the court decisions have the cited content. After the plaintiff, with reference to the presentation by Pohlmann enclosed in the cover letter to the [...] offer (Annex K 10a, p. 18 et seq.), presented the evaluated court decisions (KS of 17.05.2019, p. 68 et seq.), the defendants' sweeping denial that the plaintiff had also compared its licence fees with the licence fees adjudicated by courts was no longer sufficient. Insofar as they claim a total number of approximately 17,600 patent families and more with reference to the presentation from Annex [...] B 4/4a and the evaluation from Annex [...] B 5, they have not shown that this number of standard-essential patents does not also include such patents that are only relevant for the network side, as the plaintiff has claimed with reference to a Dutch court decision. As far as the decision Huawei v. ZTE (ECJ, GRUR 2015, 764 para. 40) mentions that the LTE standard comprises 4,700 standard-essential patents, this does not cast doubt on the number of patent families either, because it is again not apparent that this only refers to the SEPs relevant for mobile phones, which are the only ones that matter in the dispute.

Finally, the applicant has placed its royalties within the range of other programmes.



It is irrelevant for the assessment of the licence fees whether there is a disproportion to the prime costs and other costs. The principles of the decisions "Wasserpreise" Calw I and II of the Federal Court of Justice (NJW 2012, 3243 and FCJZ 206, 229 = NJW 2015, 3643, respectively) are, as the Regional Court correctly decided, not transferable to the licensing of an SEP. The costs incurred for the creation of an invention are generally not suitable for measuring its value. Such a cost-based approach does not take into account that a decisive factor for the creation of an invention is often not the costs incurred, but the creative act of the inventor. This does not change even if an SEP is acquired by purchase, because the purchase price spent does not thereby become the prime cost for the creation of the invention - just as little as, for example, the purchase price paid by a buyer for the acquisition of a waterworks would henceforth become the sole decisive cost factor with which the cost control of a water price would be carried out.

It is harmless that the defendant's group of companies allegedly only has a need for a licence in Europe. This does not prevent a licence fee for a worldwide patent portfolio from being FRAND because, as explained, it only matters that the SEP holder's offer is FRAND for the average licence seeker. In the field of mobile terminals, there are regularly globally active companies that regularly have a need for a worldwide licence. Irrespective of this, the plaintiff has shown without contradiction that the defendants do not manufacture in Europe and that, according to its own information, its group of companies sells in more than 30 countries in Europe, Africa, the Middle East, Asia and, since May 2019, also in the USA (Annexes K 16, K 17), so that a licence limited to Europe is not sufficient for the defendants' group of companies either.

(c) With the Regional Court, an abusive composition of the patent portfolio offered for licensing cannot be assumed merely because - which is in dispute between the parties - five patents cited by the defendant, allegedly selected at random, may not be standard-essential.



For the purposes of licence agreement negotiations and the conclusion of a licence agreement, it is not necessary to conclusively clarify whether each portfolio patent is standard essential. This is also the assumption of the ECJ (GRUR 2015, 764 marginal no. 69 - Huawei ./ ZTE), because the alleged infringer may challenge the validity of the patents declared to be standard essential and/or their essential character for the standard to which they belong and/or their actual use during the contract negotiations or reserve the possibility to do so later, i.e. after conclusion of a licence agreement. These principles, which apply even to contract negotiations for the licensing of a single SEP, are especially valid when a licence to a patent portfolio is at issue. Whether something else applies if an offered portfolio obviously contains a substantial number of non-standard essential patents, so that the suspicion arises that the SEP holder wants to abuse his ownership of standard essential patents to obtain a licence for non-standard essential patents and thereby obtain an excessive licence fee, does not need to be decided in the dispute, because the five patents cited, assuming their lack of standard essentiality, are not sufficient for this. In view of the plaintiff's counter-arguments, it is also not obvious that the five patents cited are not standard essential.

(d) The Regional Court does not object to the fact that the licensee, pursuant to section 2.2 in conjunction with 2.5 of the [...] offer, bears the burden of proof that the patent rights to the acquired goods have already been exhausted - which is governed by the law of the respective country of protection - and that the goods concerned are therefore not subject to payment under the licence agreement, because this provision corresponds to the traditional distribution of the burden of proof in Germany and it has not been specifically shown that a different distribution applies to other countries.

As the Regional Court correctly pointed out, the licensee is in a position to trace the chain of rights through its suppliers. There are no unreasonable difficulties of proof for him. For example, the licensee can make the conclusion of a business transaction with his supplier dependent on the supplier proving to him that the plaintiff's patent rights to the



offered goods have been exhausted or agree with him that he will provide such proof upon request.

However, to the extent that the clause 2.2 in conjunction with 2.5 of the [...] offer (Annex K 10b) extends the obligation to pay royalties to goods in respect of which the patent rights have already been exhausted in the event that the conditions set out in the contested clause are not met, in particular that the licensed upstream supplier has not paid its royalty or has not paid it on time, this may give rise to joint liability for arrears of other licensees. Furthermore, this may entail the risk of double payment of royalties, because it is not clear how it is ensured that the licensee will get back the royalty paid if the initially defaulting upstream supplier pays later. However, the licensee can avoid both by obtaining a certificate that the upstream supplier has paid the royalties prior to purchase or receipt. Admittedly, this involves effort. However, this does not make the clause clearly non-FRAND.

(e) It is irrelevant whether the absence of an adjustment clause in the plaintiff's offers in the event of the lapse of portfolio patents is in line with FRAND. Such a lapse occurs when a portfolio patent expires or lapses as a result of a successful legal attack, but also when it is judicially determined in relation to the licensee that it is not standard essential.

Whether the reservations against such a contractual arrangement can be countered by the fact that, conversely, a judicial confirmation of the legal existence or use of a patent by the standard does not lead to an increase in the licence fee - just as little as the strengthening of an application for an IP right or the inclusion of new SEPs in the pool - is not unjustifiably doubted by the defendants. An obligation on the part of the plaintiff to ensure that the pool is at least not substantially reduced by purchasing further patents is not shown by the plaintiff and is also not otherwise apparent. The possibility for the alleged infringer to reserve the right in the licence agreement to challenge the validity or use of a licensed patent would be meaningless, at least in the case of a portfolio licence,



if even several successful challenges would have no effect on the amount of the licence fees. Whether these concerns lead to the fact that the absence of an adjustment clause providing for an adjustment at least in case of substantial changes of the portfolio stock is anti-FRAND or whether the possibilities of Section 313 of the German Civil Code (BGB) together with the anyway limited term of the offered licence agreement, which allows for a reassessment thereafter, sufficiently dispel the concerns, does not require a final assessment, because the absence of an adjustment clause does not render the licence offer clearly and unambiguously anti-FRAND, at least in the case in dispute, where the licence agreement may have to be renegotiated after 5 years.

(f) The limitation of the contract term to five years and the termination options in the [...] offer (clause 4) are not objectionable, as the Regional Court rightly decided in the result.

It can be left open whether a licence offer is FRAND only if it is irrevocable in accordance with the ETSI Rules, because the aforementioned contractual conditions do not result in the [...] offer being or amounting to a revocable licence.

Irrevocability is intended to prevent the licensee from refraining from exercising his rights because he must expect at any time that the licensor will take this as a reason to revoke the licence agreement. In addition, the licensee should receive planning security. The ETSI rule therefore excludes a free right of revocation for the licensor.

However, according to its meaning and purpose, the rule does not prevent a licence agreement from being limited in time, at least if the limitation is not so short that it is equivalent to revocability, because the licensee has to seek a licence again and again at short intervals. This is not the case with a term of five years. There is sufficient time to negotiate a follow-on licence agreement and the licensee is sufficiently protected by the SEP holder's obligation to conclude such an agreement on FRAND terms and by the accompanying negotiation obligations.



Nor does the exclusion of (free) revocability prohibit the provision of objectively justified termination options linked to specific grounds. The grounds for termination provided for in Sections 4.3 and 4.4 in the event of a material breach of licence or in the event of default on reporting obligations, support obligations or payment obligations are objectively justified. They depend on conduct by the licensee, which is within the licensee's control, are intended to encourage the licensee to fulfil his obligations and, in the case of default under section 4.4, generally grant the licensee a period of time to remedy the situation before the right of termination arises. Insofar as it is provided that in the case of repeated default the assumption of a material breach of contract may be considered with the consequence that a remedy is no longer possible, this is not unreasonable and thus not objectionable.

(g) The required bank guarantee (point 6 of the [...] offer) is also not objectionable, at least not clearly and unambiguously not FRAND.

It is justified by the understandable need of the plaintiff, who is making advance payments for the licensing, to obtain security for the payments owed to it. Contrary to the defendant's opinion, the plaintiff does not have to be referred to the possibility of terminating the licence agreement in case of default in payment in order to avoid an accumulation of outstanding debts, especially since it is not guaranteed that the defaulting licensee will stop using the patent portfolio after a termination.

(h) Finally, it is not objectionable that the [...] offer (point 1.20) does not include a licence for use within the scope of the 5G standard.

The defendants already do not argue that they currently use the 5G standard and therefore need a licence. Should such a need arise, they are sufficiently protected by the fact that the supplementary licence to be negotiated then must also be FRAND.



(i) The contractual terms discussed above are also ambiguous and clearly not FRAND when considered as a whole.

(j) Whether the further contractual terms objected to by the defendants from the plaintiff's offers of 23.06.2016 (Annex K 4b) and 08.11.2017 (Annex [...] B 28), which are no longer included in the [...] offer, as well as the higher licence fees demanded in these offers lead to a different assessment can be left open. In particular, it can be left open whether the defendant's offer of 08.11.2017 (Annex [...] B 28) triggered an obligation to submit a counter-offer. In any case, it was not to an extent non-FRAND that would have justified the defendant's hesitant feedback in this regard.

dd) Finally, a willingness to take a licence on FRAND terms is not expressed in the defendant's counter-offers.

(1) In their counter-offer of 11.11.2016 (Exhibit [...] B 7), the defendants used a total number of 17,600 patent families and a total licensing burden of a mobile device of 20% as a basis, thus arriving at a percentage licensing rate of [...] % per SEP family (cf. Statement of Defence of 11.11.2016, p. 63).

According to the calculation model of the plaintiff in the pleading of 17 May 2019 (p. 68), which has remained unchallenged, the economic significance of this counter-offer can be represented by applying an average sales price of € [...] for the defendant's product range and applying the aforementioned percentage licence rate to this, resulting in an average licence charge of € [...] per SEP family. This figure deviates considerably from licence fees found in previous court decisions (Exhibit K 10a, p. 18 et seq.) and can therefore not be interpreted, even without an expert opinion, as an expression of a willingness to conclude a licence agreement on FRAND terms, whatever they may be. The defendants have also not explained why the total licensing burden of 20% for all



patents used by them is appropriate for determining the share of mobile technology (2G, 3G, LTE) as a value-creating factor in their products, especially in view of the low sales prices of their mobile devices, which were included in the calculation with an average price of € [...]. Moreover, as explained, the defendants have not shown with regard to the patent families 17,600 used by them that these do not also include patents relevant only for the network side.

In their improved counter-offer of 5 July 2019 (Annex [...] B 49), the defendants, according to their submission, increased the licence fee for LTE telephones from [...] % to [...] % and for 3G telephones from [...] % to [...] %, whereby the initial figures result from a multiplication of the above-mentioned percentage licence rate for an SEP family with the (partly corrected) number of corresponding patent families in the plaintiff's portfolio (cf. still on the [...] portfolio Statement of defence, p. 63 f.).

However, the approximate quadrupling or tripling cannot compensate for the undervaluation, which is based on the combination of the high number of SEPs and the low sales prices. This applies all the more as it cannot be assumed that the defendants' product range reaches an average sales price of € [...] at all, so that the defendants' approach with a percentage licence fee leads to an even lower licence fee per unit than assumed in the plaintiff's calculations of the defendants' licence model with an average sales price of € [...]. The defendants themselves claim that they sold a large part of their mobile phones in Germany for below € [...], many even in the range of € [...]. This is consistent with their statements in their further (partial) information of 05.07.2019 (Annex [...] B 50a). According to this, their average annual sales prices achieved for Germany for 3G-capable devices have been below € [...] since 2015 and for 4G-capable devices since 2018, with a downward trend. Accordingly, most recently (i.e. in the first two quarters of 2019), the average annual sales price for 3G-capable devices, which has been declining since 2014, amounts to € [...] and the average annual sales price for 3G-capable devices, which has been declining since 2015, amounts to € [...]. The first and



second defendant do not argue that they sold their phones particularly cheaply in Germany compared to the rest of Europe.

The defendants do not explain the counter-offer of 03.08.2020 for an amount of USD [...] million in more detail. However, it can be inferred from their statements in the pleading of 23.11.2020 that it is only a repetition of a counter-offer already made previously. Therefore, it cannot be assumed that this (repeated) counter-offer entails better conditions for the plaintiff than the offer of 05.07.2019.

(2) Even if the defendant's counter-offer of 5 July 2019 were to comply with FRAND conditions in terms of content, it would not be considered an expression of willingness to take a licence, because a bona fide licence seeker willing to take a licence would not have submitted this counter-offer around one year later and only after and under the impression of the oral negotiations at first instance. Due to the delayed submission, it also does not constitute a timely counter-offer according to the standards of the Huawei /ZTE decision (ECJ, GRUR 2015, 764 para. 66), as the Regional Court correctly decided. According to these principles, if the alleged infringer does not accept the offer made to it, it can only invoke the abusive character of an action for an injunction or a recall if it makes a specific counter-offer in writing to the owner of the SEP in question within a short period of time that complies with the FRAND conditions. As explained, such an obligation of the alleged infringer exists even if the SEP holder's offer does not comply with FRAND conditions, as long as - as in the case in dispute - the offer is not clearly and unambiguously anti-FRAND and the patent proprietor, by explaining its offer and the alleged compliance of the terms with FRAND, has enabled the licence seeker to make a counter-offer on FRAND terms.

ee) Taking into account all the circumstances of the individual case, the Senate therefore comes to the conclusion that the first and second defendant are not willing to take a licence but would like to delay the conclusion of a licence agreement for as long as possible.



[...]

G.

The counterclaim is admissible, but unfounded for several independent reasons.

1. The international jurisdiction to decide on the counterclaim follows from Art. 7 No. 2, 8 No. 3 Brussels Ia Regulation. It is connected to the antitrust abuse objection raised as a defence against the action and therefore has a factual connection within the meaning of § 33 (1) of the Code of Civil Procedure. Furthermore, the admission of the counterclaim, which can be based on facts that are to form the basis of the decision anyway pursuant to section 529 of the Code of Civil Procedure (section 533 no. 2 of the Code of Civil Procedure), is in any case to be considered relevant in the appeal proceedings (section 533 no. 1 of the Code of Civil Procedure), because this avoids new proceedings and, moreover, the case is ready for decision (Senate, GRUR 2020, 166 marginal no. 145 - "Datenpaketverarbeitung").

2. The Senate has already ruled that a claim for the submission of third party licence agreements does not exist under any legal aspect (cf. Senate, GRUR 2020, 166 marginal no. 146 et seq. - "Datenpaketverarbeitung"). The bases for claims cited by the second defendant under § 33g (1) or (10) in conjunction with sections 33a para. 1, 33 para. 1 in conjunction with sections 18 (1) no. 1, 19 (2) no. 1 and no. 2 ARC and under section 33g (1) or (10) ARC in conjunction with sections 33a para. 1, 33 para. 1 GWB in conjunction with article 102 sentence 2 lit. a and lit. c TFEU do not change this. They also do not justify a claim for information on the profit/loss and cost calculation and a claim for presentation of the profit and loss account of the [...] pool.

Firstly, the Senate does not consider it plausible that the plaintiff would have treated the second defendant unequally without a justifiable reason. Such unequal treatment cannot



be assumed without further ado on the basis of the more favourable licence rates granted by the plaintiff to the licensee x5 so named in the judgment of the Higher Regional Court Düsseldorf (Sisvel. v. Haier) (cf. FCJ, GRUR 2020, 961 marginal no. 101 et seq. - "FRAND-Einwand"). Moreover, it can only arise from third party licence agreements that are still in force, so that an obligation to provide information only relates to this (Kühnen, Handbuch der Patentverletzung, 12th ed., Chap E marginal no. 494). The licence agreement with the so-called licensee x5 expired in December 2018, according to the applicant's uncontradicted submission.

Furthermore, the second defendant does not specifically show why discrimination should result from the licence agreements made available in anonymised form in a data room. Nor does it explain why the third-party licence agreements made available in anonymised form in the electronic data room with the explanations on the licensees were not sufficient. It can be left open whether the obligation to provide information on the essential content of licence agreements already concluded also extends to those of the legal predecessors (see Higher Regional Court Düsseldorf, judgment of 22 March 2019 - Case No. 2 U 31/16, juris para. 174 - Improving Handover). This is supported by the fact that these agreements also shape the licensing practice against which the non-discriminatory nature of the licence offer to be assessed is to be measured. If it were to lapse with the transfer of the patent, the patent owner would be able to dispense with it. In the present case, however, the patents of different legal predecessors were combined to form the portfolio. Due to the formation of the portfolio, earlier individual licence agreements as well as any pool licence agreements of predecessors in title may lose their significance. Therefore, the portfolio holder is not automatically obliged to provide information on all individual licence agreements or pool licence agreements of his legal predecessors.

Insofar as the plaintiff allegedly demands excessive licence fees in the licence offers or the licence offers are discriminatory, damage due to excessive or discriminatory licence



fees has not occurred because the second defendant has not concluded such a licence agreement and has not yet made any corresponding payments. It is also not apparent that it has oriented a security deposit to the plaintiff's contested offer. Insofar as the second defendant believes that it has suffered damage as a result of the enforcement of the first instance judgment, this enforcement (as well as the underlying conviction) and thus the alleged damage is not based on the plaintiff's request for the conclusion of a licence agreement on terms, which are allegedly discriminatory or exploitative, in particular leading to excessive fees, but on the fact that the defendants have shown themselves unwilling to license and, with regard to the fine imposed, moreover on the fact that the second defendant has not complied with the injunction.

Insofar as the second defendant is also concerned not to have to rely on the correctness of the plaintiff's statements but wants to verify them, the Senate has already ruled that such a wish cannot in itself justify a claim for information as an auxiliary claim to the claim for the conclusion of a licence agreement on FRAND terms (see Senate, GRUR 2020, 166 marginal 153 - "Datenpaketverarbeitung").

Finally, the assertion of the counterclaim claims would be an abuse of rights because the second defendant has no real interest in the information sought, but is pursuing extraneous purposes with the request, in particular further delaying the licence negotiations and hassling the plaintiff. If the defendant side had a genuine interest in further information, it would have first looked at the anonymised third-party licence agreements made available in the electronic data room.

H.

1. It can be left open whether section 148 of the Code of Civil Procedure (ZPO) allows a stay of proceedings due to circumstances that occurred after the conclusion of the oral proceedings, which the plaintiff doubts with reference to the wording of the provision. In any case, a stay of the proceedings here would be within the Senate's discretion in view



of the referral decision of the Regional Court Düsseldorf to the ECJ of 26.11.2020 (4c O 17/19), which the Senate exercises to the effect of not staying the proceedings. It is true that the patent in suit has expired, so that a stay would not be to the detriment of the claim for injunctive relief, which is only limited in time. However, the Senate considers it unlikely that the ECJ would establish criteria in the submitted proceedings that would lead to the enforcement of claims bound by cartel law being abusive in factual constellations such as the present one, in which the infringer engages in delaying tactics.

The Senate, which is not obliged to do so because the judgement can be challenged on appeal, refrains from a referral to the ECJ for the reasons stated.

[...]