



KATHER · AUGENSTEIN  
RECHTSANWÄLTE

Regional Court Mannheim (2nd Civil Chamber)

2 O 131/19

Judgement of 02.03.2021

### Reasons

[...]

D.

The claims resulting from the infringement are enforceable. This is not precluded by the dilatory objection of the prohibition of abuse of a dominant position under Union law pursuant to Article 102 TFEU (see I.). The defendant's objection of abuse is unfounded (see II.).

I.

The action of a dominant patent holder who has undertaken vis-à-vis a standardisation organisation to grant licences on FRAND terms may constitute an abuse of its dominant position if and to the extent that it is capable of preventing products complying with the standard from entering the market or remaining available on the market (ECJ, Judgment of. 16.07.2015, C-170/13, GRUR 2015, 764, 766 f. - Huawei/ZTE; Federal Supreme Court, judgement of 05.05.2020, KZR 36/17 para. 68 - FRAND Einwand; Federal Supreme Court, judgement of 06.05.2009, KZR 39/06 para. 22 ff, BGHZ 180, 312 - Orange-Book-Standard). Accordingly, claims for injunctive relief, recall and removal of products from the distribution channels or destruction may be abusive (Federal Supreme Court, judgement of 05.05.2020, KZR 36/17 para. 68 - FRAND-Einwand; OREGIONAL COURT Karlsruhe, judgement of 30.10.2019, 6 U 183/16 para. 87, GRUR 2020, 166 - Datenpaketverarbeitung; OREGIONAL COURT Düsseldorf, judgement of 30.03.2017, I-15 U 66/15 para. 220, GRUR 2017, 1219 - Mobiles Kommunikationssystem).



However, even the owner of a standard-essential patent is not per se prohibited from enforcing his patent by asserting injunctive and other claims on the product market (ECJ, loc. cit. para.s. 46, 53, 58 - Huawei/ZTE; Federal Supreme Court, judgement of 05.05.2020, KZR 36/17 para.. 69 - FRAND Einwand). This is because the standard essentiality does not change the fact that the patent proprietor must only tolerate the use of his patent if he has either allowed the person who makes use of its technical teaching to do so or, in any case, must allow him to do so while observing his obligation not to abuse his market power.

An abusive enforcement of the claims in the aforementioned sense does not exist if the patent proprietor, on the one hand, has informed the alleged infringer of the patent infringement of which he is accused before filing the action and has thereby designated the patent in question and indicated in what way it is alleged to have been infringed and, on the other hand, after the alleged infringer has expressed his will to conclude a licence agreement on FRAND terms, has made a specific written offer of a licence on those terms, specifying in particular the royalty and the manner in which it is to be calculated, and the infringer, while continuing to use the patent in question, fails to respond to that offer with diligence, in accordance with accepted commercial practice in the field concerned and in good faith, which must be determined on the basis of objective considerations and implies, inter alia, that there has been no delay in responding to the offer. implies, inter alia, that no delaying tactic is being pursued (ECJ, loc. cit. para.. 71 - Huawei/ZTE). If the alleged infringer does not accept the offer made to him, he can only invoke the abusive character of an action for an injunction or a recall if he makes a concrete counter-offer in writing to the owner of the SEP in question within a short period of time that complies with the FRAND conditions (ECJ, loc. cit. para.. 66 - Huawei/ZTE).

The obligation programme presupposes that the person who wants to use the patent or is already using it and has already put patent-compliant products on the market, although he does not have a licence, is willing to take a licence to this patent on reasonable and non-discriminatory terms (Federal Supreme Court, judgement of



05.05.2020, KZR 36/17 para. 70 - FRAND Einwand). This is because the patent proprietor with market power does not have to force anyone to take a licence and does not have any legal means to do so, since although the potential licensee can demand that he conclude a licence agreement, the patent proprietor does not have such a claim, but is rather obliged to enforce claims for patent infringement against anyone who wants to use the teaching of the invention but does not want to conclude a licence agreement.

On the other hand, the patent proprietor must make sufficient efforts to meet the special responsibility associated with the dominant position and to make it possible for an infringer who is in principle willing to conclude a licence agreement on reasonable terms (Federal Supreme Court, judgement of 05.05.2020, KZR 36/17 para. 72 - FRAND Einwand). Among other things, the dominant patentee may be prohibited from claiming an injunction from the infringer who has been informed of the infringement of the patent in suit if the infringer has declared that he wishes to take a licence to the patent in suit but is not, or at least not readily, in a position to formulate on his own initiative the conditions that the patentee must grant him in compliance with the prohibition of discrimination and hindrance that applies to him (Federal Supreme Court, judgement of 5 May 2020, KZR/17, para. 72 - FRAND Einwand).

II.

In the present case, after the plaintiff has pointed out the patent infringement (see 1.), the defendants are not entitled to a FRAND objection for lack of willingness to take a licence (see 2.). In contrast, the plaintiff has fulfilled any negotiation obligations (see 3.).

1.

The plaintiff already notified the defendants of the infringement on 29.03.2016 - but at the latest by letter dated 06.03.2018.

a)



The infringement notice is intended to draw the infringer's attention to the infringing act and the possibility and necessity of taking a licence (on this and the following Federal Supreme Court, judgement of 5 May 2020, KZR 36/17 para. 85 - FRAND Einwand). It is sufficient that the patent is designated and that it is stated in which specific act the infringement is to consist. The latter requires the designation of the type of infringing act as well as the attacked embodiments. Detailed technical or legal explanations of the infringement allegation are not required; the infringer must only be enabled to form a picture of the justification of the patent infringement allegation - 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.

b)

The plaintiff informed the defendants already in a letter dated 29.03.2016 (Annex WKS KAR 3.1) - in any case in a letter dated 06.03.2018 (Annex WKS KAR 1, to which, inter alia, Annex WKS KAR 3.1 was attached) - sufficiently in terms of content about the alleged patent infringement by designating the patent-in-suit and stating in what way it is alleged to have been infringed.

The plaintiff correctly approached the parent company by letter to T. Ltd. dated 29.03.2016, which corresponds to the usual negotiating practices (OREGIONAL COURT Karlsruhe, Urt. v. 30.10.2019, 6 U 183/166 GRUR 2020, 166 para. 100 - Datenpaketverarbeitung). Likewise, the letter of 6 March 2018, which was sent to the first defendant - as well as to other group companies - after the parent company failed to react, constitutes a sufficient infringement notice to the T. group. Insofar as the 2nd and 3rd defendants dispute the correspondence with ignorance, this is inadmissible due to the group-wide duty to inquire.



The fact that the patent-in-suit was only listed with the EP application number is harmless. The designation of the application number enabled the defendants to find out about the patent in suit. If they had checked the patent numbers communicated to them, for example in the EPO register, they would have found that the patent-in-suit had been granted and published. In view of the above, the plaintiff is not obliged to continuously update the patent lists for the patent portfolio. There is no concrete evidence that the defendants were not capable of independently verifying the allegation of infringement on the basis of the information provided.

2.

In response to the infringement notice, T. was not willing to take a licence (see a), as the group did not purposefully participate in the negotiations (see b), even though the plaintiff made FRAND-compliant offers (see c).

a)

According to the infringement notice, it is not sufficient to establish further obligations of the dominant patentee if the infringer merely shows willingness to consider concluding a licence agreement or to enter into negotiations as to whether and under what conditions a conclusion of an agreement would be possible for him. Rather, the infringer must clearly and unambiguously as well as seriously and unconditionally declare its willingness to enter into a licence agreement with the patent proprietor on reasonable and non-discriminatory terms and must also subsequently participate in the licence agreement negotiations in a targeted manner (Federal Supreme Court, judgment of 05.05.2020, KZR 36/17 para. 83 - FRAND objection; Federal Supreme Court, judgment of 24.11.2020, KZR 35/17 para. 57 - FRAND-Einwand II; OREGIONAL COURT Karlsruhe, judgment of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067; OREGIONAL COURT Karlsruhe, judgment of 15.11.2020, 6 U 104/18 (unv.); a.A. REGIONAL COURT Düsseldorf, order of 26.11.2020, 4c O 17/19, GRUR-RS 2020, 32508).



A lack of seriousness may result from the overall assessment of the circumstances, in particular the conduct of the licence seeker, without which a conclusion of a licence agreement cannot be achieved.

Thus, the licence seeker's conduct on the merits must be examined to see whether it reasonably furthers the negotiations. Therefore, as a rule, a non-FRAND-compliant counter-offer marginalindicates that the infringer, who is sufficiently informed after the infringement notice and receipt of an explained plaintiff's offer, is not aiming at reasonable and non-discriminatory terms (see Regional Court Mannheim, judgement of 18.08.2020, 2 O 34/19 - juris para. 168). The same can apply if the infringer insists on its own counter-offer and states that it is not prepared to improve the offer (see BGH, judgment of 5 May 2020, KZR 36/17 para. 98 - FRAND Einwand). Furthermore, a serious licence seeker can be expected to inform the SEP holder of any objections to the offer at an early stage and to discuss them instead of saving them for later use in a legal dispute ( Higher Regional Court Karlsruhe, judgement of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067 para. 255).

In addition, the timing of the negotiations must be taken into account, as delaying tactics serve the infringer, who uses the patent without consideration and under suspension of the claims bound by antitrust law. Therefore, the licence seeker is regularly required to react swiftly, even to a delayed fulfilment of the obligations by the SEP holder (Higher Regional Court Karlsruhe, judgement of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067 para. 255). If the infringer has failed to declare his interest in FRAND terms for a longer period of time, he must be expected to make additional efforts ( Federal Court of Justice, judgement of 24.11.2020, KZR 35/17 para.s 62, 83 - FRAND objection II).

However, hesitant cooperation by the infringer may be justified in individual cases as a still permissible reaction to the SEP holder's conduct if the latter - e.g. by failing to provide information on licensing practice - evades targeted cooperation, which must be assessed in the individual case (cf. Higher Regional Court Karlsruhe, judgment of 09.12.2020, 6 U



103/19, GRUR-RS 2020, 41067 para.. 255; cf. on the provision of information by the SEP holder, for example Higher Regional Court Mannheim, judgment of. 18.08.2020, 2 O 34/19 - juris para.. 200 et seq.; cf. on an obviously FRAND-infringing offer by the patent proprietor BGH, Urt. v. 24.11.2020, KZR 35/17 para.. 71 - FRAND Einwand II). However, even below the threshold at which the infringer is obliged to submit a counter-offer, the infringer is generally obliged to purposefully participate in licence agreement negotiations, e.g. by submitting objections at an early stage (cf. Higher Regional Court Karlsruhe, judgement of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067 para.. 254; cf. on the reaction to an obviously FRAND-infringing offer of the patent proprietor BGH, judgement of. 24.11.2020, KZR 35/17 para.. 71 - FRAND Einwand II).

b)

According to these standards, the T. group did not sufficiently participate in the negotiations. The T. group's alleged willingness to not only negotiate but also conclude a FRAND licence, which was first declared on 6 November 2020 (see Annex B 5), appears to be mere lip service in the overall circumstances.

T. submitted a counter-offer to the plaintiff that was contrary to FRAND (see aa) and also otherwise did not promote the licence negotiations in a proper or speedy manner (see bb).

aa)

The defendant's counter-offer is not FRAND, as it excludes the economically significant question of exhaustion based on the Q. licence, which is in dispute between the parties, and defers it to subsequent negotiations or court proceedings.

(1)



As a rule, there is not exactly one single contractual arrangement that satisfies the FRAND criteria. Rather, there is regularly a multitude of possible contractual arrangements and licence rates that are fair, reasonable or appropriate and non-discriminatory (cf. BGH, Judgment of 05.05.2020, KZR 36/17 para.. 81 - FRAND-Einwand; Higher Regional Court Karlsruhe, Judgment of. 30.10.2019, 6 U 183/16 para.. 95, GRUR 2020, 166 - Datenpaketverarbeitung; UK Court of Appeal, Urt. v. 23.10.2018, [2018] EWCA Civ 2344 para.. 121 - Unwired Planet v Huawei). What can be considered fair and reasonable varies in particular from sector to sector and over time (EU Commission, Communication v. 29.11.2017, COM(2017) 712 final, p. 8). In particular, the FRAND content is usually concretised 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 (see Higher Regional Court Karlsruhe, GRUR 2020, 166 para.. 106 mwN - Datenpaketverarbeitung; Higher Regional Court Karlsruhe Urt. v. 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067 para.. 257).

However, a counter-offer in which the infringer leaves an issue under discussion between the parties in abeyance is usually inappropriate if this issue has a significant impact on the amount of the licence fee. Such a counter-offer may constitute a reservation by the infringer who wishes to postpone these disputes to later negotiations or (court) proceedings. In this way, the infringer would obtain a legal basis for his acts of use with the help of a licence agreement, although at the same time he could withhold parts of the royalties with reference to the unresolved dispute. In this case, the infringer is no longer threatened with an injunction. Therefore, the ECJ requires a "concrete counter-offer" from the patent user (ECJ loc. cit. para.. 66 - Huawei/ZTE), which - with the para.. of promoting out-of-court contract negotiations by parties willing to take a licence - implies a licence fee defined in the contract or at least determined in due time (cf. Regional Court Düsseldorf, Judg. v. 31.03.2016 - 4a O 126/14 para.. 286 f. - juris; Regional Court Düsseldorf, final judgement of. 31.03.2016, 4a O 73/14 para.. 231 f. - juris).



Such a counter-offer is comparable to an offer providing for the determination of the licence fee by the SEP holder with the possibility of a subsequent judicial review pursuant to Section 315 of the German Civil Code (BGB), which is generally equally insufficient (Regional Court Mannheim, Urt. v. 18.08.2020, 2 O 34/19, GRUR-RS 2020, 20358 para. 167 et seq.). This is because even such an (unspecified) counter-offer contains a reservation by which the infringer merely defers a substantive dispute between the parties about the amount of the licence fee to later proceedings, in which case he may refuse to make payments and at the same time is no longer exposed to the injunctive relief.

(2)

With clause 4.3 in the counter-offer, the defendants reserve the right not to pay a licence fee for end devices with Q. chipsets. T. can use this clause after the conclusion of the licence agreement to raise the question of whether exhaustion has occurred, which is in dispute between the parties, by refusing to pay.

The fact that the counter-offer does not contain a solution for the Q. chipsets has, in view of the Q. licence existing until the end of 2018, a considerable impact on the Release Payment pursuant to Clause 4.1. The absolute amount of the Release Payment is not quantified, but the Defendants have merely proposed an abstract mechanism for calculating it on the basis of the net sales prices, although at the same time they have provided an account of their sales. It is clear from the defendants' accounts that the net sales prices are fed to a substantial extent by sales with Q. chipsets (Annex B 13 a.E.): (...)

According to this, T's obligation to pay a Release Payment would be reduced by around ... % in 2016, by around ... % in 2017 and by around ... % in 2018 if the terminals with Q. chipsets were excluded.

In addition, the defendants referred in the oral proceedings - as far as can be seen for the first time - to an alleged further, unspecified licence agreement between Q. and the



plaintiff, which in the view of the defendants could possibly further reduce the past and future payment obligations.

The fact that the Q. question is of considerable economic relevance for the negotiations is shown, for example, by the fact that the payment obligations according to the counter-offer - including the turnover with Q. chipsets - are in total higher than those according to the plaintiff's offer E (taking into account the offered ... % discount for the past). Based on the plaintiff's calculation in WKS KAR 12. (According to the explanations of the plaintiff's representative, in the Excel sheet, in the presentation of the counter-offer, line "...", column "rate" for the years 2021 - 2023, instead of ... %, ... % should be correctly entered. Furthermore, a discount of ... % is still taken into account in the overview.), which is based on the defendant's accounting, the aggregate payment obligations under the last plaintiff's offer were expected to be approximately ... million USD and under the counter-offer (with Q. chipsets) approximately ... million USD.

The central importance of the exhaustion issue for the entire conclusion of the contract means that in this case not only the future payment obligations, but also the release payment - which is economically inseparable from the release payment - may be taken into account for the assessment of the adequacy of the counter-offer, even if the SEP holder is generally not obliged to retroactively legitimise infringing acts in FRAND negotiations (cf. on the principle Higher Regional Court Karlsruhe judgment of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067 para.. 303).

Overall, on the basis of the counter-offer, the plaintiff is left in the dark as to whether or not the defendants are prepared to pay royalties including the end devices with Q. chipsets. As a result, contrary to the defendants' opinion, Clause 4.3 in the specific case is not merely a general clause to prevent double dipping. Against the background of the state of negotiations reached between the parties, the clause rather has the described effect in this specific case that the defendants' obligation to perform cannot be quantified concretely enough.



bb)

The defendant's unwillingness to seriously and purposefully promote FRAND negotiations is also evident in its other negotiating behaviour.

(1)

Thus, it is not apparent that the T. Group has sought to resolve the issue of exhaustion in Q. chipsets by way of negotiation.

The Q. licence was first made the subject of the negotiations in June 2020, without T. subsequently returning to it (cf. for example Annex WKS KAR 9, para.. 5).

On the contrary, the defendants introduced the discussion in writing in the rejoinder of 20.11.2020 - and thus almost simultaneously with the submission of the counter-offer - in the present legal proceedings. Subsequently, the plaintiff offered the T. further discussions and explanations on the issue on several occasions (see, for example, Annex WKS KAR 9 (para.. 5, 6), WKS KAR 10). The plaintiff also pointed out that it had not concluded any other relevant licence agreements with chipset manufacturers, but that it would be quite prepared to develop an alternative clause to point 4.3 (cf. annex WKS KAR 9). T. did not respond to these offers and stated that it was preferable that the issue at stake be dealt with in these legal proceedings (cf. WKS KAR 10 "We also pointed out - again - that T.'s argument regarding the alleged Q. pass through rights under Kl.'s patents is wholly groundless and suggested that we walk you through the substance of the agreement between Q. and Kl. ... However, you declined our offer ...").

Furthermore, the defendants mentioned an alleged further licence agreement between Q. and the plaintiff at the oral hearing, which, as far as can be seen, has not played any role in the negotiations so far and was also not introduced in these proceedings.



Thus, the defendants saved up negotiating material without discussing the factual issue early and transparently, and this despite the fact that the wording of the Q. licence introduced into the proceedings does not support T.'s position in any way (see B. III. 1. above).

(2)

Particularly against this background, T's reaction to E's offer in the telephone calls of 28.12.2020 and 08.01.2021, for example, is not comprehensible, even if one bases the latter on the defendant's submission.

On the one hand, in the telephone conversation of 28 December 2020, T. said that the licence fees under Offer E appeared acceptable for the future, but led to a one-off charge that was too high for the past, incidentally without addressing the deletion of clause 4.3 in Offer E against the background of the Q. question. In addition, the plaintiff was informed in the telephone conversation of 8 January 2021, according to the defendant's submission, that Offer E could not be accepted at the present time due to T's current financial situation, although the group still fully stood by the counter-offer.

However, with regard to the release payment - including the end devices with Q. chipsets - the counter-offer hardly differs from offer E, which takes into account the ...% discount for the past offered at the time. The difference between the respective payment obligations for the past amounts to approximately ... USD (cf. Annex WKS KAR 12).

As a result of the modification of Offer E to a ...% discount offered by the plaintiff at the oral hearing, the difference between the release payments even tips in favour of the defendant. This is because the release payment according to the modified offer E is lower than that of the counter-offer. If T's statement in the telephone conversation of 28 December 2020 is correct that the defendant's main concerns are linked to the Release Payment, there is no apparent reason not to accept the Modified Offer E.



(3)

Overall, the conduct of the negotiations by the T. group is characterised several times by changing statements without factual discussion of the plaintiff's submissions, which in this specific case indicates delaying tactics.

In particular, after submitting their counter-offer - in which they, in a departure from previous negotiation results, e.g. provided for an ongoing licence fee instead of a one-off payment - the defendants stated that they were instead interested in a lump-sum licence (ultimately, according to the above, probably significantly lower than their own counter-offer). In doing so, they mentioned a payment of ... million USD as well as cross-licensing without being able to submit concrete proposals (cf. Annex WKS KAR 10, p. 1: "..."). In this way, the defendants reacted to the plaintiff's offer D without, as far as can be seen, dealing with it on the merits.

(4)

The fact that the T. group repeatedly aligned its negotiations with events in the lawsuit also speaks for the pursuit of delaying tactics. It was only after the action had been filed that T. entered into negotiations from January 2020, although the plaintiff's infringement notice already dated from 2016. The defendants made the counter-offer from November 2020 in temporal connection with their rejoinder and shortly before the date for the oral hearing originally set for December 2020. Due to the new subject matter of the hearing, the date was rescheduled with the plaintiff's consent.

(5)

All in all, T. often reacted hesitantly, although the group would have been all the more obliged to actively push the negotiations forward after the start of the negotiations had been delayed by several years. Already the conclusion of a confidentiality agreement took about four months after the plaintiff had submitted a draft, whereby the plaintiff



frequently asked for feedback (Annex WKS KAR 4). The counter-offer from November 2020 followed several months after offers A to C and clearly after the time frame specifically advised by T. from July 2020.

(6)

According to all this, it can remain open whether the amount of the security provided by T. was insufficient, since it was limited to acts of use in Germany, although the parties were negotiating a worldwide licence agreement (Regional Court Mannheim, judgement of 4 September 2019, 7 O 115/16 (unv.); also Kühnen, Handbuch der Patentverletzung, 13th ed. 2021, ch. E, para. 450). Likewise, it remains open whether the security deposit from January 2021 was late because the plaintiff had already rejected the defendant's counteroffer by letter of 25 November 2020 (Annex WKS KAR 9).

c)

The plaintiff is not responsible for the lack of willingness to take a licence, as it fulfilled all possible negotiation obligations by submitting and sufficiently explaining several FRAND-compliant licence offers, which should have prompted the defendants to cooperate further in the licence agreement negotiations. The plaintiff reacted flexibly in the negotiations and adjusted its offers several times in favour of the defendants.

In particular, the last offer E - not least taking into account the ...% discount for the Release Payment - is FRAND-compliant. None of the contractual terms complained of by the defendants exceeds the FRAND corridor, either individually or when considered as a whole.

aa)



In this context, it must be taken into account in the starting point that the conditions for the licence rate most recently proposed by the plaintiff are moderate overall according to the Board's experience in the mobile communications sector.

The assumed total licence burden of ...% does not exhaust the range usually accepted in mobile telephony practice (see, for example, High Court of England and Wales, Judgment of 05.04.2017, [2017] EWHC 711 (Council) para. 807 - Unwired Planet v Huawei [8.8%]; cf. Regional Court Mannheim, Judgment of. 18.08.2020, 2 O 34/19, GRUR-RS 2020, 20358 para. 155 with reference to a study with values up to 13.3%). The plaintiff's SEP share of ... % is conservative, as various studies arrive at an average share of LTE SEPs of the plaintiff of approx. ... % (Annex WKS KAR 6, p. 2); there is no obligation to rely on the study with the lowest SEP share (cf. Higher Regional Court Karlsruhe, Judgment of. 15.11.2020, 6 U 104/18 (unv.)).

Moreover, the plaintiff has concluded two licence agreements, each of which is based on the licence fee offered to the defendant under Offer A, behind which its Offer E is likely to fall in the result. Even if these concluded licence agreements do not yet form an established standard licensing programme, concluded licence agreements are usually at least an indication that the licence offered is not obviously contrary to FRAND (see Higher Regional Court Karlsruhe, judgment of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067 para. 305).

bb)

After all this, it is not objectionable that in Offer E for ... a licence rate of ... % is used instead of the ... % proposed in the counter-offer. The small difference does not lead out of the FRAND corridor, at the latest when considering the conditions as a whole, which were further reduced by a regional discount.

cc)



Ebensowenig ist zu beanstanden, dass die Klägerin in ihrem Angebot E die von der Beklagten eingefügte Klausel Ziffer 4.3 gestrichen hat.

As explained, in the present case this is not merely a general contractual provision intended to prevent double dipping by the SEP holder. Rather, as a result of the parties' dispute about exhaustion under Q. licences, the clause leads to ambiguities about the amount of royalties (see above D. II. 2. b) aa)).

In the specific case, an actual risk of multiple licence payments is not apparent. The plaintiff has stated that it has not concluded any other relevant licence agreements with chipset manufacturers, whereby it would be quite prepared to develop an alternative clause to clause 4.3 (cf. Annex WKS KAR 9). Therefore, in the present case, the deletion of the clause in no way implies that the plaintiff intends to receive multiple licences.

At the latest, the plaintiff compensated for the deletion of the clause in the oral proceedings by increasing the discount for the release payment - in particular with regard to the exhaustion dispute concerning clause 4.3 - from ... % to ... %. From an economic point of view, this compensates the defendant for any economic risks (albeit based on the payment obligations for the past) that exhaustion may have occurred for individual products. Compensation for the deletion of the clause can also be seen against the background that the wording of the Q. licence submitted in the proceedings in no way supports T.'s position on exhaustion (see B. III. 1. above). Finally, the compensatory effect is also apparent in comparison to the counter-offer, where the total sum of the payment obligations, including the sales of Q. chipsets, is higher than those according to the plaintiff's last offer (see above D. II. 2. b) aa). (2)).

3.

Even if one were to affirm the defendant's willingness to license, the FRAND objection would be unsuccessful because of the FRAND compliance of the plaintiff's offer, which is countered by a counteroffer that is contrary to FRAND.



This is because after the infringer's declaration of willingness to license and after the patent proprietor has submitted and explained a licence offer, the counter-offer to be submitted by the defendant must be examined for compliance with FRAND criteria, without it being relevant for the defendant's obligation to submit such a counter-offer whether the plaintiff's licence offer is actually FRAND (cf. on the obligation to react, at least if the licence offer is not obviously contrary to FRAND Federal Court of Justice, judgement of. 24.11.2020, KZR 35/17 para. 71, 72 - FRAND-Einwand II; also Higher Regional Court Karlsruhe, judgment of 09.12.2020, 6 U 103/19, GRUR-RS 2020, 41067; cf. furthermore Higher Regional Court Mannheim, judgment of. 21.08.2020, 2 O 136/18 GRUR-RS 2020, 26457). Similarly, the defendant's FRAND objection would not be successful in the present case if a counter-offer by the infringer was only required after a comprehensive FRAND-compliant offer, since in the present case, in any case, the plaintiff's offer E - as explained above - satisfied FRAND requirements.