KATHER AUGENSTEIN

Higher Regional Court Düsseldorf

2 U 31/16

Decision dated 22. March 2019

Operative part

A.

On appeal, the judgement of the 4b Civil Chamber of the Regional Court Düsseldorf delivered on 19 January 2016 is partially amended – with the further appeal being dismissed – and restated as follows:

I. The Defendants are sentenced,

   1. to provide the Plaintiff with information in the form of an organised list [...]

II. It is established that the Defendants are obliged to compensate the Plaintiff for all damages, [...]

III. The action is dismissed by way of a partial judgment to the extent that the Plaintiff has requested information on the prime costs broken down by the individual cost factors and the profit generated for the period up to 28 June 2017.

IV. In all other respects, the action is dismissed, namely with regard to the claim for information concerning "the search engines and other marketing tools with the aid of which the websites concerned were registered individually or jointly" as final and otherwise as currently unfounded.

B.

The court costs and the extrajudicial costs [...]

C.

The judgement and the ruling of the Regional Court are provisionally enforceable.

[...]

D.

The appeal is authorised.

E.

The amount in dispute for the appeal proceedings is set at EUR 800,000.

Reasons

I.

The plaintiff is suing the defendants for infringement of the German part of the European patent EP 1 230 XXX (Annex EIP C1, submitted in German translation as Annex EIP C1a; hereinafter referred to as "the patent in suit"): patent-in-suit) for information and rendering of accounts as well as a declaration of liability for damages. [...]

The intervener owns one of the strongest portfolios of essential patents in the telecommunications industry. On 10 January 2013, it concluded the so-called F ("F") with C(C), D ("D"), its subsidiaries C1 ("C1") and C2 ("C2") and E ("E"), which relates to the further exploitation of some of its patents. A patent portfolio comprising over 2000 patents was affected. With regard to the provisions of the F in detail, reference is made to the excerpts of the contract text submitted by the parties for the file.

The intervener D1 is a company incorporated under Swedish law. C, D, D Sub 1 and C2 are all companies incorporated under the law of State I1. E was incorporated under the law of G. The Plaintiff was incorporated under H law. It belongs to the Unwired Planet Group and is involved in the management and licensing of patents. It has subsequently joined the F.

Clause 6.14 of the F contains, among other things, the provision that E assumes the FRAND obligation of the intervener and will submit its own FRAND declaration to I within a reasonable period of time after the conclusion of the agreement. E fulfilled this obligation with a declaration dated 14 June 2013. In a further agreement dated 13 February 2013 (K - "K"), clause 5.4 contains the obligation of E to ensure that the FRAND obligation is assumed in the event of a transfer of patents to third parties. This was implemented when the patent in suit was transferred to the Plaintiff and the Plaintiff issued its own FRAND commitment to I on 6 March 2014. In implementation of the F, its contracting parties subsequently concluded three transfer agreements, the validity of which is in dispute between the parties.

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The Defendants belong to the L-Group, which is active in the telecommunications sector both in the market for network technology and for mobile phones. Defendant 2) advertises and distributes in M mobile phones such as the "N" (attacked embodiment), which are compatible with the 2G and 3G standard.

Defendant 1) is the owner of the website L, on which the website of the L Group is located. Visitors to this site can use the term "Worldwide" to open the website partly in M translation under L/en. Furthermore, via the section "Products & Solutions" and then the section "Consumers", they can access the selection options "Telephones, Data Products, Tablets" of the L-Shop on the website www.Ldevices.de, which is maintained by the Defendant 2). This website offers, inter alia, mobile phones that are compatible with the 2G and 3G standard, including the attacked embodiment. 2G and 3G refer to 2nd and 3rd generation mobile phone standards, which are also referred to as XXY and XXZ standards.

XXY (XXY) is a mobile telephony standard created by the I. The technical specification of the standard relevant to the present legal dispute is TS 145 XXB from version 5.2.22. The XXY standard describes the process of the digital cellular telecommunications system and radio subsystem link control. The challenged embodiment fulfils the requirements of this technical specification. XXZ (XXZ) is also an I mobile radio standard. The XXZ standard specification TS 125 XXC, version 5.17.0, is of interest for the present proceedings.

In an email dated 9 July 2013, Mr O, an employee of the investment banking advisor P, informed Mr Q, an employee at L, on behalf of R about the acquisition of standard-essential patents from A. Following a reminder on 30 July 2013, Mr Q referred to the responsibility of Mr S, who declared to Mr O on 22 August 2013 that there was no interest in the A patents.

In the period from September to December 2013, the Plaintiff attempted to hold licensing talks with the Defendants. Mr T, head of the patent department for the Defendants, pointed out in an email dated 27 November 2013 that L generally accepted intellectual property rights. In January 2014, Mr U, an employee of the patent department at L, asked Mr V, the managing director of the Plaintiff, for some claim charts for patents that had been taken over by the Plaintiff. Mr V then sent Mr U a draft confidentiality agreement on 16 January 2014 and pointed out that signing this agreement was a prerequisite for sending the requested claim charts. Mr U sent Mr V an amended version of the confidentiality agreement, to which Mr V replied on 29 January 2014 that this would be reconsidered.

The present action was brought on 10 March 2014, at the same time as actions in W. Mr V informed the Defendants of this on the same day. Mr X then stated that they would remain in contact in order to negotiate reasonable licence conditions.

On 22 April 2014, the Plaintiff's English legal representatives sent the Defendants a PowerPoint presentation on the possible conditions of a licence ("Licence Proposal"). This provided for a licence fee of USD 0.75 per mobile device and was addressed equally to all patent users. The Defendants refused to conclude a contract on the basis of this presentation, pointing out that the proposed licence fee of USD 0.75 per D1dy sold was far too high.

At first instance, the Plaintiff claimed that the intervener had transferred part of its patent portfolio - including the patent in suit - to C by way of a transfer agreement dated 11 February 2013 (hereinafter ÜV I). On 13 February 2013, C further transferred the patents obtained by the intervener - including the patent in suit - to E (hereinafter ÜV II). On 27 February 2014, E further transferred the patents - including the patent in suit - to the Plaintiff (hereinafter: ÜV III), which was entered in the patent register as the patent proprietor on 7 March 2014 (publication date: 3 July 2014).

In the Plaintiff's opinion, the offer and sale of the accused embodiment in M constitutes an infringement of the patent in suit, as the accused embodiment makes direct use of the technical teaching of the patent in suit. Following a partial withdrawal of the action at first instance, the Plaintiff finally filed a claim against the Defendants for the rendering of accounts and the provision of information as well as a declaration of liability for damages for the period from 1 January 2013.

The Defendants, who asked for the action to be dismissed or, alternatively, for a stay, criticised the lack of local and international jurisdiction of the Düsseldorf Regional Court in the first instance and disputed the Plaintiff's legitimacy to sue. In addition, the Plaintiff disputed the validity of the transfer agreements under the applicable foreign legal systems, the authenticity of the copies submitted for the file, the power of representation of the third parties and the effective assignment of claims arising in the past to the Plaintiff.

With regard to any antitrust concerns about the validity of the transfer agreements, the Defendants here have, in the alternative, adopted the Defendants' arguments in the parallel proceedings 4b O 120/14 as their own in the first instance. In these proceedings, the Defendant (Y) is of the opinion that the intervener violated both the provisions of merger control (Sections 35-42 ARC) and the prohibition of restrictions of competition (Articles 101, 102 TFEU) when implementing the F.

Furthermore, at first instance, the Defendants denied both an infringement of the patent in suit and its legal validity. In particular, no conversion of XXZ downlink measured values into downlink measured values for the XXY communication system takes place in the challenged embodiment. Apart from this, the challenged embodiment also lacks a means for comparing the converted measured values with a (predetermined) threshold measured value.

Moreover, the Defendant 1) does not have passive legitimacy either. It neither markets nor offers the attacked designs in Germany. The maintenance of the website by the Defendant 1) and the accessibility of the subpage L.com/en via the defendant 1) does not constitute an offering. All offers are made available via the website www.Ldevices.de operated by the defendant 2).

Moreover, the enforcement of the claims pursued by the action is precluded by the licence objection under Art. 102 TFEU. The Defendants were willing to take a licence. It was the Plaintiff who refused to provide further information in the context of the licence agreements and instead filed an action.

In its final judgement of 19 January 2016, the Düsseldorf Regional Court granted the claim, which was still pending at the time of the final judgement, and ruled as follows:

The Defendants are sentenced,

to provide the Plaintiff with information in the form of an organised list [...].

II. it is established that the Defendants are obliged to compensate the Plaintiff for all damages which [...].

The Regional Court essentially stated the reasons for this:

The Regional Court of Düsseldorf had international and local jurisdiction for the admissible action pursuant to Article 5 No. 3 Lugano Convention in conjunction with § 143 (2) PatG in conjunction with the Ordinance on the Assignment of Community Trademark, Community Design, Patent, Plant Variety Protection, Utility Model Litigation and Topography Protection Matters of 30 August 2011. The Plaintiff had conclusively asserted that the Defendant 1) offered and marketed the contested embodiment through its (also) German-language website in Germany. Thus, the place of success is in Germany. Since the challenged embodiment is also offered in North Rhine-Westphalia in this respect, the Düsseldorf Regional Court has local jurisdiction.

Furthermore, the action is also well-founded. The Plaintiff is authorised to assert the claims for damages and invoicing pursued in the present action. It has been the substantive owner of the patent in suit since 27 February 2014. This is supported by the presumption established by its entry in the patent register, which was confirmed by the taking of evidence. The fact that an intermediate acquirer, Cluster LLC, is not entered in the patent register does not contradict the indicative effect of the patent register. In the present case, the details submitted by the plaintiff regarding the chain of transfer with regard to the unregistered intermediate acquisition of C were in any case not sufficient to shake the presumption of the patent register. According to the Plaintiff's submission, the chain of transfer had been agreed between all parties from the outset and C had been the substantive owner of the patent in suit for just two days. The entry of Cin in the patent register was a mere formality. The presumption established by the patent register regarding the Plaintiff's ownership of the patent in suit was confirmed by the documents submitted by the Plaintiff and the witnesses heard by the Board. Accordingly, the Chamber is convinced that the intervener transferred the patent in suit to C by patent transfer agreement of 11 February 2013 (hereinafter: transfer I), which then transferred it to E by transfer agreement of 13 February 2013 (hereinafter: transfer II), which finally transferred it to the plaintiff by agreement of 27 February 2014 (hereinafter: transfer III).

The validity of the assignments of the patent in suit submitted by the Plaintiff and the claims for accounting and damages relating thereto were not precluded by any antitrust aspects. The F and the subsequent patent assignments neither violate merger control regulations (§§ 35-43 GWB) nor can the patent assignments be assumed to be ineffective as a result of an intervention in competition prohibited by antitrust law within the meaning of Art. 101, 102 TFEU.

Defendants 1) and 2) also have passive legitimacy. [...].

(...)

Finally, the Defendants would counter the Plaintiff's claim with the objection of their (alleged) willingness to licence without success. Neither the Plaintiff's FRAND self-commitment declaration nor Articles 101 and 102 TFEU would prevent the enforcement of the claims for damages and invoicing asserted in the present action in whole or in part.

The Defendants filed an appeal against this judgement, which was served on their legal representatives on 25 January 2016, in a statement dated 24 February 2016, in which they continue to pursue their unsuccessful claim for dismissal before the Regional Court.

They repeat and supplement their submissions at first instance and essentially assert the following:

[...]

Apart from that, the Regional Court did not sufficiently take into account that such a transfer is in any case contrary to antitrust law. The transfer of a patent portfolio without passing on the FRAND obligation with the aim of generating licence fees in excess of FRAND violates antitrust law principles and is therefore invalid under both Art. 101 TFEU and Art. 102 TFEU.

Moreover, the Regional Court did not sufficiently take into account the compulsory licence objection under antitrust law (here: on the basis of the FRAND declaration). The Plaintiff had submitted its own FRAND declaration to I on 6 March 2014. March 2014, the Plaintiff submitted its own FRAND declaration to I. By breaking off the talks without a concrete licence offer and immediately bringing an action, it had violated the rules on the proper conduct of licence negotiations under FRAND terms established by the ECJ in the Huawei v. ZTE decision and confirmed by the courts of lower instance. Even if the aforementioned decision initially relates to the judicial assertion of injunctive relief and recall claims, it must also be observed in the present, extensive assertion of information and accounting claims.

Furthermore, the Regional Court incorrectly assumed a literal realisation of the technical teaching of the patent in suit.

(...)

Moreover, the parties to the proceedings in the parallel English proceedings had declared their willingness and had accordingly been obliged by the High Court by court order to behave as if the first-instance decision were valid and effective for the period until the decision on the appeal (there). For this purpose, the High Court had drawn up a licence agreement, the clauses of which would constitute a FRAND licence. Following a court order based on declarations of consent by the parties, L provided information in 2017 and since then on an ongoing basis to calculate the worldwide licence fee and paid the licence fee awarded (against security provided by the Defendant). The Defendant therefore fulfilled all obligations under the licence agreement determined by the High Court. The information provided and the licence fees paid also included the patent in suit here and the sales in M, which is why the asserted claim for the provision of information and payment of a licence fee had expired through fulfilment.

Finally, the infringement proceedings had to be suspended in the alternative due to the sufficient probability of the destruction of the patent in suit both from the point of view of the inadmissible extension and the lack of practicability as well as with regard to the lack of novelty and inventive step.

The Defendants request,

set aside the judgement of the Düsseldorf Regional Court of 19 January 2016, case no. 4b O 49/14, and dismiss the action;

in the alternative,

to stay the proceedings until the invalidity proceedings pending against the patent in suit have been finalised.

further in the alternative,

stay the proceedings pending the UK Supreme Court's decision on the Defendant's further appeal in the infringement proceedings there.

Finally, the Plaintiff applied for the withdrawal of the action after the Defendants did not agree to provide information on the production costs broken down by the individual cost factors and the profit generated for the period prior to 29 June 2017 and the plaintiff then waived the claims in this regard,

Dismiss the Defendant's appeal against the judgement of the Düsseldorf Regional Court (case no.: 4b O 49/14) of 19 January 2016, subject to the proviso that section I of the operative part of the Regional Court's judgement is now replaced by the following:

I. The Defendants are ordered to provide the Plaintiff with information in the form of an organised list [...]:

The transfer of the patent in suit does not violate either Art. 101 TFEU or Art. 102 TFEU.

(...)

Since the Federal Patent Court had upheld the patent in suit in the version now at issue, there was no reason for a stay from the outset.

Reference is made to the contents of the court files and the annexes for further details of the facts and the dispute.

II.

The Defendant's appeal is admissible, but is only successful in the tenor of the case.

The Regional Court rightly considered the offer and sale of the contested embodiment in M to be a literal use of claim 6 of the patent in suit and ordered the Defendant to provide information and pay damages for direct patent infringement. The Plaintiff is entitled to corresponding claims to the extent tenorised under Art. 64 (1) EPC in conjunction with. §§ 139 (2), 140b (1) and (3) PatG in conjunction with §§ 242, 252 BGB. §§ 242, 259 BGB. The merely limited maintenance of the patent in suit by the Federal Patent Court does not lead to a different result.

The appeal is essentially only successful to the extent that it is directed against the Defendant being ordered to provide information on the prime costs broken down according to the individual cost factors and the profit realised. In this respect, the action was to be dismissed not only by way of the partial waiver judgement for the period prior to 29 June 2017, but also in other respects by way of a contested judgement.

In detail:

1.

The Senate does not consider itself prevented from making a decision because, according to the Defendant's submission, the action pending in the United Kingdom is aimed at worldwide information and a worldwide licence fee for all of the Plaintiff's SEPs. Pursuant to Art. 27 (1) of the old version of the Brussels I Regulation (Regulation EC/44/2001), which continues to apply to the present case pursuant to Art. 66 (2) of the new version of the Brussels I Regulation (Regulation EC/1215/2012), the court second seised must stay the proceedings of its own motion until the jurisdiction of the court first seised has been established. The Senate is unable to establish that these requirements are met here. It is neither sufficiently argued nor apparent at what point in time the claims at issue in the present case - disclosure and damages relating to the M area - were brought in the proceedings conducted in the United Kingdom.

e)

The patent transfers are also unobjectionable from an antitrust perspective. They do not violate either Art. 102 TFEU [hereinafter under aa)] or Art. 101 TFEU [hereinafter under bb)].

aa)

The objection that the - multiple - transfer of the patent in suit was made in each case without the simultaneous transfer of the obligations arising from the FRAND declaration irrevocably submitted by the intervener, which leads to the invalidity of the acts of transfer due to abuse of a dominant market position, is already legally invalid because the acquirer of an SEP - even without an express or implied declaration - is directly and unconditionally bound by the FRAND commitment of its legal predecessor.

(1)

1 It is in the nature of things that standardization prevents technological competition, because any competing technical solution that is not included in the standard has no prospect of success in the product market due to a lack of compatibility. The voluntary willingness of all SEP holders privileged by standard setting to enable competition by granting a licence to use the standard-essential technology on FRAND terms to anyone interested in it is therefore a cornerstone of technical standard setting and its legal admissibility. This is because it compensates for the unavoidable exclusion of competition at the technology level by opening up free competition within the technical standard and in its commercial utilisation. The FRAND declaration also creates a legitimate expectation among the purchasers of the standardized technology that the standard-essential patents will be voluntarily licensed on FRAND terms in the future in accordance with the commitment given with the FRAND declaration (ECJ, GRUR 2015, 764 - L Technologies/ZTE). From the SEP holders perspective, the licensing commitment limits their inherently comprehensive monopoly and prohibition rights, in that they are no longer entitled to an unconditionally enforceable exclusive right against all, but their powers are limited due to the FRAND declaration, because they must allow anyone to use the

SEP upon request, participating in the standard on equal FRAND terms. This concession is of considerable importance because one of the defining characteristics of the monopoly rights associated with a patent is that the owner of the property right can freely decide not to grant a licence and thus categorically exclude any third party from using his patent. The SEP holder sacrifices the freedom not to licence, which is an essential consequence of the statutory exclusive rights under the patent, for the sake of including the technical teaching of his patent in the technical standard. Because the FRAND commitment limits and defines the rights under the patent in the manner described above - irrevocably and thus "in rem", as it were - the patent can necessarily only be transferred to the acquirer in precisely this limited form, modified in terms of content by the FRAND commitment. This is because nobody can acquire more rights through a transfer transaction than their legal predecessor was entitled to at the time of the sale.

(2)

In this context, legal concerns do not arise from the fact that, due to the state act of granting the patent and the legal form of the monopoly right associated with it, that it may be beyond the legal power of the owner of the property right to substantially change the monopoly right granted to him through his license promise. Even if this is the case, he has in any case the legal power to refrain from exercising his exclusive rights in a certain way by not exercising his right not to licence the invention. In this legal sense, the obligation assumed with the FRAND commitment to grant any interested party a licence to use its SEP on FRAND terms is legally effective and relevant.

(3)

Only such a result (sic.: automatic transfer of the FRAND obligation with the acquisition of the patent) is also appropriate in terms of the legal consequences. The fundamental content of the patentee's property guarantee is his authorisation to sell the property right granted to him at his discretion. Fundamental law protects not only the transferability of the property right as such, but also the person acquiring the property right, who can be freely chosen by the seller. The special situation resulting from the setting of standards does not require or justify any restrictions in this respect, because the rights associated with the SEP are not changed by the person of its owner, but are completely independent of it. They are primarily determined by the content of the property right, i.e. its valid patent claims, the patent description and the patent drawings (Art. 69 EPC). In addition to the content of the patent specification, it is also essential that the obligations (limitations) of the original patent proprietor from his FRAND declaration are not lost with the transfer of the patent, but rather bind the acquirer in the same way as his legal predecessor. If this is guaranteed - as a result of the automatic transfer of the FRAND obligation with the transferred patent for which the FRAND declaration was made - there is no reason to prevent or limit a patent transfer. This is because the objective that is to be achieved with the FRAND commitment is easily realised with the automatic transfer of the FRAND obligation to the patent acquirer.

In contrast, the possible alternative legal solution would have completely inappropriate consequences. It would be to judge a patent transfer in the context of which the FRAND commitment of the transferor has not been passed on to the transferee (under the law of obligations) as contrary to antitrust law (Art. 102 TFEU), which would invalidate the patent transfer as a whole. However, there is no reason for such a far-reaching consequence, because it is not the transferability and/or the transfer of an SEP that can be problematic in any way, but rather precautions must be taken solely to ensure that, as a result of the transfer of the property right, the FRAND commitment required for reasons of antitrust law (Art. 101 TFEU) is permanently maintained in the enforcement of the SEP. This objective is fully met by the automatic (and indispensable) transfer of the FRAND commitment together with the SEP. Moreover, objections would have to be raised against a transfer of the FRAND commitment under the law of obligations even if it had been duly agreed between the seller and the acquirer. This is because special legal constructions such as the legal concept of a third-party beneficiary contract (which may not be available in all Member States and whose viability can hardly be reliably assessed in advance) would be required to ensure that the licence seeker (= patent user) who is not involved in the transfer transaction at all can successfully invoke the acquirer's commitment, made only to the transferor, to licence the SEP in accordance with FRAND rules. If, on the other hand, the FRAND commitment is understood as a substantive self-restriction of the exclusive (exercise) rights under the SEP, no such application difficulties arise and there is the necessary legal clarity for all parties.

(4)

The patent acquirer is bound to the FRAND commitment of its legal predecessor not only "in principle", i.e. insofar as the obligation to grant a FRAND licence is concerned, but also "in amount and content", namely insofar as the acquirer is bound to the licensing practice that goes back to its legal predecessor as part of its obligation to fair, reasonable and non-discriminatory licensing. This is because the FRAND-related restriction of exclusive rights from the SEP is concretised in the licensing practice, which must therefore also be observed by the acquirer following a patent transfer. That this must be the case follows from the fact that the licence relationships existing at the time of the patent acquisition do not cease to exist or are otherwise impaired by the patent transfer. They remain in force to the same extent and with the same content and continue to have effect towards the acquirer (Section 15 (3) PatG), who consequently cannot prohibit the licensee from using the invention. Even if the acquirer - which may differ from one Member State to another - does not automatically enter into the licence agreements existing at the time of the change of ownership as a party to the contract in place of the seller, but instead requires a special tripartite legal transaction involving the seller, the acquirer and the licensee, the conditions of use remain the same for the existing licensees; the obligations do not change and the contractual claims (e.g. to invoicing and royalties) remain the same. The SEP acquirer is regularly also entitled to the contractual claims (e.g. to invoicing and licence remuneration) because, in case of doubt, the patent transfer is to be seen as an implied assignment of the said licence agreement claims to the SEP acquirer. Irrespective of the exact dogmatic legal construction, which may vary, one thing remains to be said in any case: The transfer of an already licensed SEP with a FRAND declaration does not eliminate existing licence relationships. The rights of use for the licensee remain just as unchanged as his licence agreement obligations, in particular with regard to licence payments, they remain the same. From a purely economic point of view, it can therefore be stated that the licences granted by the seller are transferred to the acquirer, so that the previous licensees of the seller are henceforth the SEP acquirer's own licensees and, as a result, necessarily also define the licensing framework against which discrimination is prohibited. For each licence granted by him, the acquirer must therefore not only keep in mind those licensees to whom he himself has granted a right of use during his ownership, but he must also take into account those licensee relationships that have been transferred to him as a result of the acquisition of the patent from his legal predecessor.

Of course, only those licence agreements that are (already and still) in force at the time of the legally required licence offer are relevant, while licence agreements that have already expired at this time must be disregarded because they cannot have any effect on the competitive situation of competitors. If the claim for injunctive relief is at issue, the time of the last oral negotiation is decisive, which is why the licence agreements active at that time are relevant; if the claim for damages and accounting is at issue, the period for which the plaintiff is seeking full damages and comprehensive accounting must be considered.

Any other approach, which refrains from being bound to the licensing practice of the legal predecessor, would have the consequence that the SEP holder could, at will, evade his obligations, in particular regarding the non-discriminatory licensing of all interested parties, by transferring his patent to a third party in order to remove the licensing restrictions resulting from licences already granted. This would not only contradict the fact that the obligation to grant licences in a fair and non-discriminatory manner is not tied to a specific person, but to the SEP for which a FRAND declaration has been made and whose technical teaching should be able to be used by any interested party, but would also run counter to the meaning and purpose of the FRAND commitment, which is that every prospective licensee is not only able to use the SEP at all, but also receives a right to use the SEP on financial terms in particular, which do not discriminate against him compared to other users. This is because every licence fee that has to be paid for a standard essential property right represents a cost factor that is included in the pricing on the downstream product market and can therefore potentially impair the provider's competitive position. If, as a result of the patent transfer, the acquirer of an SEP were able to abandon the previous licensing practice of its legal predecessor, very different licensing conditions would apply to licence seekers - depending on the possibly purely coincidental timing of their taking out a licence. This would not ensure non-discriminatory participation in the standard because the amount of the licence fees and the associated pricing costs for the licensee could vary depending on the patent holder from whom the licence was taken. Different groups of licensees would compete on the product market, namely those who have acquired their right of use from the original SEP holder at comparatively favourable conditions and who can calculate their prices accordingly with favourable licence costs, with those who have only concluded a licence agreement with the patent acquirer and who have to include higher licence fees in their pricing even though the licensing situation remains unchanged in principle. Such unequal treatment of the same circumstances is incompatible with the economic objectives of the FRAND declaration.

(5)

Because the licence offer of the acquirer must fit into the licensing practice of its legal predecessor in a non-discriminatory manner and the SEP acquirer must, as part of its duty to make an offer to a licence seeker, specify those circumstances that identify the licence conditions offered by it as FRAND, its licence offer must relate to all previous licence grants, insofar as they are relevant in terms of time, including those of the legal predecessor. In order to be able to do this, the SEP acquirer is dependent on being informed about those licence agreements that the seller has concluded during his ownership. A duty to provide information in this respect is imposed on the seller directly by his confidence-building promise to licence his SEP without discrimination. As long as he himself is the holder of the property right, the obligation is expressed in the fact that he must refrain from any discrimination when granting his own licence; as soon as he has transferred the SEP, the promise to grant a non-discriminatory licence is expressed in the obligation to enable the acquirer who has taken his place as licensor to comply with the promise of non-discriminatory licensing made for the transferred SEP by informing him accordingly. In order to make the acquired SEP enforceable, it is therefore in the SEP acquirer's best interest to make provisions in the transfer agreement for a transfer of knowledge with regard to licences already granted and their content. They are also quite common in practice because the acquirer of the patent simultaneously takes over the licences granted to it, which for reasons of economic rationality makes it imperative to obtain a clear overview of the licensees and the conditions of the rights of use granted to them. Otherwise, the acquirer will neither have an overview of his contractual obligations towards the licensees he has taken over, nor will he be able to enforce his contractual rights and claims against them. Furthermore, the acquirer - which is also a direct consequence of the FRAND commitment made by the seller for the SEP - must ensure that the legal predecessor cooperates in ensuring that the licences granted by it can be disclosed if necessary (e.g. in a legal dispute) in order to permit a FRAND examination (in particular in court).

(a)

Against the background described above, it is irrelevant whether the intervener's admission that it did not provide the Plaintiff with any details of the existing licence agreements in the course of acquiring the patent is credible. In any case, the objection that the intervener is prevented from disclosing the contents of the contracts due to contractual confidentiality agreements with its licensees, also with regard to necessary explanations in a legal dispute concerning the licensed property right, could be legally relevant. In order to be able to assert such a claim, the Plaintiff (and/or its intervener) would have had to disclose the content of the alleged confidentiality clauses in detail (i.e. with the exact wording and stating all circumstances relevant to interpretation), because only in this way is the relevant factual submission capable of being admitted by the opposing party and accessible to a judicial examination as to whether the confidentiality agreements actually go as far as the Plaintiff claims. However, the Plaintiff has not made a corresponding factual submission. It is therefore unclear whether the confidentiality clauses are not open to a reasonable interpretation, because they are objectively in the interests of the parties, to the effect that the intervener is permitted to disclose the licence content to the extent that it is subject to a legally unavoidable obligation to do so (from the FRAND commitment for the licence protection right). Moreover, an impossibility could only be assumed if the obstacle to performance could not be removed by the Plaintiff, which in the present context requires that the intervener and, above all, its licensees are ultimately not prepared to waive compliance with the confidentiality agreement within the framework of and for the purposes of the present legal dispute, despite insistent requests. The Plaintiff and its intervener do not comment on this either. Ultimately, however, the aforementioned concerns can even be disregarded and the Plaintiff's - insufficiently substantiated - assertions regarding the intervener's duty of confidentiality can be assumed in its favour. In this case, it should be noted that the intervener has culpably made it impossible for itself to fulfil its antitrust obligation under the FRAND commitment with a comprehensive confidentiality agreement, which is why it can no longer be heard with its objection of lack of ability to present evidence in the proceedings. Anyone who destroys or otherwise thwarts their own evidence as the party obliged to provide evidence is recognised as being unable to provide evidence and must bear the resulting consequences of the proceedings. The same applies to the burden of presentation that precedes the burden of proof; anyone who culpably fails to make the necessary submissions in court remains unable to present evidence and loses the legal dispute if the facts that must be presented justify the claim being sued for. Since the patent acquirer cannot be in a better legal position than the seller of the right, the Plaintiff necessarily shares the procedural fate of its intervener.

(b)

The obligation to disclose the licence agreements concluded does not infringe Article 101 TFEU. The intervener's view to the contrary is largely based on the premise that the comments explaining the licence offer on previous licensing practice force the SEP holder and its legal predecessor to disclose business secrets to potential competitors, which is contrary to the principles of antitrust law. Even the initial hypothesis is wrong. This is because it is recognised in the case law of the Senate that measures to protect trade secrets are indeed possible within infringement proceedings in connection with the FRAND discussion. In addition to the court orders concerning the public provided for in the GVG, it is primarily a matter of confidentiality agreements that can be demanded of the party to whom a trade secret is to be disclosed. The condition for this is, of course, that the party claiming protective measures for itself must not only identify the confidential information, but must also specifically demonstrate that and why the information in question constitutes a trade or business secret to be protected in the requested manner, which requires a substantive submission on the measures that have so far ensured its confidentiality, and also requires equally substantive verifiable information on exactly what disadvantages are threatened by the disclosure of the information in question and with what degree of probability (Senate, order of 25 April 2018, Ref.04.2018, Ref.: I-2 W 8/18, BeckRS 2018, 7036). If this is successful and the opponent refuses to enter into a necessary and reasonable security agreement for the protection of secrets, the SEP holder can limit the justification of his licence offer to general, suggestive statements that protect his trade secrets; they are to be considered procedurally sufficient and the opponent's dispute relating to this is to be considered irrelevant (Senate, decision of 25 April 2018, case no.: I-2 W 8/18, BeckRS 2018, 7036). Instead of going to the trouble of explaining, with regard to the licence agreements relevant to the present action (because they were active in the relevant period), to what extent the explanations required to justify the non-discriminatory nature of the licence offer submitted to the Defendants would reveal trade secrets of the intervener worthy of protection and, insofar as this should be the case, to explain the licensing concept underlying the relevant licence agreements in an at least suggestive submission, the factual submission of the Plaintiff and its intervener is exhausted in largely theoretical discussions about which regulatory content in any licence agreements concluded by it is alleged to contain trade secrets, whereby even this is not explained in the required manner.

(6)

Insofar as the plaintiff and its intervener (both of whom are referred to below in case of doubt) point out that it is in fact impossible for the seller of a part of its licensed portfolio to fulfil the obligations arising from the above statements, this does not justify a different assessment that dispenses with compliance with the prohibition of discrimination.

(a)

Since the plaintiff and its intervener - apart from the confidentiality agreements already discussed with the licensees of the intervener and the number of property rights in the intervener's overall portfolio (more than 40,000) - do not refer to specific circumstances within their contractual relationships and do not attempt to comply with the legal requirements of the applicable prohibition of discrimination, but instead rely on arguing with the general situation that exists when a sub-portfolio is sold, only the general transfer situation will be examined below.

Of course, it is possible to construct factual constellations (especially in the case of multiple, successive transfers of property rights) in which the required explanations for compliance with the prohibition of discrimination become increasingly difficult and time-consuming. However, legal relevance can only be attributed to this if the constellations of a repeated further splitting of the acquired portfolio in the course of subsequent sales and their licensing, possibly with the additional inclusion of further property rights acquired elsewhere, were not merely theoretical mind games, but facts with serious practical relevance. The Plaintiff's submissions provide no evidence of this. Apart from this, it remains in any case the free decision of the patent seller whether he wishes to accept the stricter requirements associated with the non-discrimination of his licence offer with a further patent transfer carried out under already complicated circumstances. The fact that the efforts to be made increase with the complexity of the transfer and licensing circumstances is an inevitable consequence of the facts to be legally assessed and their specific nature, but neither inadmissibly restricts the fundamental freedom to transfer patents nor does the possibly considerable effort involved in a FRAND licence offer provide any justification. nor does the considerable effort involved in FRAND licensing provide a sufficient reason to exempt the patent acquirer from complying with the statutory prohibition of discrimination; rather, the explanations to be provided in this respect represent the "price" that must be paid in the event of a (further) transfer of property rights in the given factual and legal situation. Demanding this is all the less objectionable as - and this is the correct solution to the problem - the standard of presentation must take appropriate account of the actual difficulties that arise in the individual case from the simple, but possibly also particularly complicated transfer and licensing sequence.

(b)

2 If the subject matter of the licence granted by the predecessor in title - as in this case - was a comprehensive portfolio of property rights, a (larger) part of which it held in its own possession (or sold elsewhere) and (smaller) parts of which were transferred to the Plaintiff acquirer, so that the previously licensed patent portfolio was split up among several owners, the standard of discrimination is not determined by the mere number of property rights in the sub-portfolios, but rather it must be determined in an evaluative consideration what fraction of the licence fee agreed for the previous overall package of property rights is to be allocated to the sub-portfolios of property rights in relation to each other. The decisive factor for the allocation to be made is the technical significance of the patents contained in the respective sub-portfolio for the standard and the significance for the downstream product market and the sales prospects of the respective intellectual property rights. .It goes without saying that this cannot be done with mathematical precision, but ultimately amounts to a mere rough estimate, which is familiar to the law in many ways (e.g. § 254 BGB, § 287 ZPO, determination of the causal share of the infringer's profit) and which can therefore also form the legal standard here.

Since the Plaintiff and its intervener do not claim otherwise themselves in this respect, it is obvious from general experience that a transferred property right portfolio is not composed arbitrarily and purely by chance, but that its composition follows certain, comprehensible rules, such as the consideration of which technology (embodied in certain property rights and property right families) should remain in the seller's hand and which technology (embodied in certain property rights and property right families) should be transferred to the acquirer. The intrinsic value of one (retained) and the other (surrendered) property right portfolio will play a significant role in the selection and allocation; in connection with the patent sale, every reasonable seller will have a concrete idea of the consideration to be claimed for the transfer of property rights.

If the sale - as here - is not to a manufacturing company, but to a purchaser whose business activities are limited to patent exploitation through the granting of licences, the price expectations of both parties will be sensibly oriented towards the earnings expectations that the purchaser can be expected to obtain from the portfolio sold. In turn, two factors play a decisive role here, namely the significance of the IP rights intended for transfer for the technical standard on the one hand and for the competitiveness of the sales product on the downstream market of standardised products on the other, as both are important for the revenue and profit expectations of those licence seekers who are to be addressed and acquired as (licence) customers by the patent acquirer. The decisive factors for the pricing of the patent transfer are therefore precisely those factors that are to be used for the allocation of the previous licence for the overall portfolio to the sub-portfolios resulting from the sale of the property right. Because this is the case, the valuation criteria are objective circumstances that will typically already have been considered in connection with the sale of the property right, which can accordingly be named as such, discussed by the parties and subjected to a judicial plausibility check and which therefore represent a factual submission that is not only suitable but can also be made by the Plaintiff without further ado.

(c)

The described examination, valuation and apportionment standard is also suitable, applied severally , if the patent acquirer does not want to licence the acquired portfolio unchanged (in isolation), but in such a way that further SEPs from other acquisitions or own holdings are added to the acquired portfolio. If they were also the subject of a previous portfolio licensing of the seller or acquirer, the licence fee share attributable to the SEPs transferred or held in the own portfolio is to be determined in the same evaluative manner as just discussed for the partial portfolio transfer and can then be added to the partial licence value for the first partial portfolio.

(d)

Insofar as the Plaintiff refers to complications resulting from licensing or agreements on other monetary considerations which do not come into question in the person of the licence seeker who is to be treated in a non-discriminatory manner (e.g. because he does not have any industrial property rights that can be licensed or because the licensor has no interest in taking a licence due to the lack of a manufacturing business), this is already wrong from the outset. The heterogeneous performance of the licence aspirants is a problem that can arise in any licence grant and which therefore confronts the patent proprietor with the task of complying with the prohibition of discrimination not only in transfer cases, but also if all property rights remain in his hand. If the intervener had not sold parts of its portfolio to the Plaintiff, but had kept them in its own possession, the intervener would necessarily have had to consider how it intended to behave in a non-discriminatory manner towards a licence seeker who either also had IP rights of interest or did not have such rights. The same applies to the fact that the portfolio of IP rights to be licensed changes over time (e.g. due to expiry of IP rights or new licences) or the importance of individual technical features for the product market shifts. Such events also occur independently of a patent transfer and must be managed in a non-discriminatory manner by every patent holder bound by a FRAND declaration. It is expedient for this to happen in such a way that the licensing practice follows a previously considered licensing concept, which considers from the outset which appropriate "licence fee discount" should be granted to those licence seekers who can offer, for example, licences - to a lesser or greater extent. Within such a licensing concept, the non-discrimination of a current licence offer will primarily be determined in relation to the group of licensees who were in the same initial situation. With regard to a licence seeker without its own property rights portfolio, it is therefore not licensing agreements that are of significance, but rather those licences in which rights of use have only been granted in relation to the infringer and the licence fee is determined exclusively in monetary terms. It is neither apparent nor asserted that such contracts (comparable to the circumstances of the case in dispute) do not exist for the intervener. Any complications that could arise from concluded licences can therefore be ruled out in the present case.

bb)

The patent transfers are not associated with a violation of Art. 101 TFEU.

The provision prohibits agreements between undertakings which are capable of affecting trade between Member States and which either have as their object or effect the appreciable prevention, restriction or distortion of competition within the common market. Exchange agreements (as they are here regarding the transfer of the intervener's patent portfolio for consideration) do not as such fall within the scope of Art. 101 TFEU (BGH, NZKart 2016, 280). They are aimed at an exchange of services between the companies involved in the agreement and, with this content, are not per se capable of having anti-competitive effects. In order to open up the scope of application of the ban on cartels, an ancillary agreement - at least objectively - restricting competition is therefore required within the exchange agreement, which in itself is neutral under cartel law, whereby the ancillary agreement must go beyond what is necessary to realise the main purpose of the exchange agreement. The decisive factor here is whether the agreed restriction of competition is objectively necessary and limited in terms of time, territory and subject matter to achieving the purpose pursued by the exchange agreement (BGH, NZKart 2016, 280). If this is the case, a violation of Art. 101 TFEU cannot be considered, even with regard to the ancillary agreement; unless the competition clause goes beyond what is necessary, a restriction of competition in violation of antitrust law is conceivable, although in cases of mere temporal excess, a reduction to preserve the validity of the agreement is permissible.

Neither the M1 Agreement nor the patent transfer agreements contain any ancillary agreement that restricts or distorts competition and could open up the scope of application of Art. 101 TFEU.

(1)

Insofar as the Defendant refers to the intervener's admission that the transfer of its patent portfolio was made for the purpose and in the expectation of achieving higher licence income than it (the intervener) would have been able to achieve even in negotiations with patent users, this is a mere motivation for the patent transfers, but not a clause regulating the contractual rights and obligations (= ancillary agreement), which would be required as a connecting factor for the prohibition of cartels.

3 Apart from that, the patent purchasers - as explained - are bound to the FRAND commitment in the same way as the intervener was and would be, both in terms of reason and amount,

which means that the Defendant's accusation that the patent transfers are suitable for obtaining licence fees which are UN-FRAND due to their unreasonable amount also lacks a factual basis. Equally meaningless from a competition point of view is the argument that the Plaintiff is not itself operationally active on the downstream product market for standard-using products, which is why it does not have to take into account the possibility of being attacked by a patent user from its own SEP portfolio in the context of its licence agreements with a patent user. Whether the licence offer of the Plaintiff property right holder satisfies FRAND criteria and, in particular, whether the amount of the usage fee demanded with the licence offer is reasonable and non-discriminatory, is subject to unrestricted judicial review in patent infringement proceedings (OLG Düsseldorf, Mitt 2016, 85), whereby it is already incumbent on the patent proprietor, in the preliminary stages of this examination, to provide the licensee with comprehensible reasons as to why the set of rules submitted with the license offer as a whole, and in particular the license fee provided therein, should be fair, reasonable and non-discriminatory (= FRAND). (OLG Düsseldorf, GRUR 2017, 1219 - Mobiles Kommunikationssystem). Only if this substantive justification has been provided and the FRAND conformity of the license offer in favour of the property right holder has been clarified, a conviction comes into consideration, which would encroach further on the legal position of the infringer than is entailed by the duty incumbent on every SEP user to compensate for the use of the third-party intellectual property by means of a FRAND license fee and a subsequent accounting. However, a tightening of liability is also fully justified under the circumstances mentioned, because the conviction for patent infringement is solely due to the infringer having unjustifiably rejected the SEP holder's license offer, which would have been sufficient under FRAND conditions – even taking into account the licenses granted by the legal predecessor – and which the infringer should have accepted. Furthermore, it follows from the court's right of review that a restriction of competition cannot be deemed to exist merely because the SEP holder asserts (unauthorized) license claims that do not comply with the FRAND principles in the event of a patent acquisition.

(2)

For the same reasons, it is irrelevant under antitrust law that the intervener held part of the standard-essential patent portfolio in its possession. Irrespective of the fact that no contractual clause restricting competition is recognisable in this respect either, the intervener is of course free to demand licence fees for the use of the SEP portfolio remaining in its possession. Since it is subject to the formal (sic.: obligation to make a licence offer) and factual (sic.: FRAND conformity of the licence offer) restrictions from its licensing commitment, users of the entire portfolio do not run the risk of being obliged to pay a licence fee that is not legally owed because it is unreasonably high. Because of the FRAND commitment of both the Plaintiff and the intervener, the FRAND criteria also set the upper limit for any financial or other licence burden on an SEP user for the use of the complete SEP portfolio. The fact that it was not possible for the intervener to exploit the legally permissible scope of a FRAND licence fee in contractual agreements with infringers due to the given framework conditions, even for factual reasons, may be, but has no significance under antitrust law. This is because antitrust law does not serve to protect a patent infringer from being required to pay licence fees for the use of third-party intellectual property to the extent permitted by law. Insofar as the intervener has already granted licences that are economically inadequate to its own detriment, the Plaintiff as legal successor is also bound by the prohibition of discrimination to the licensing practice of the intervener that it has practised to date and from which it itself - and consequently also its legal successor - can only deviate if and to the extent that factual differences in the licensing facts justify this.

(3)

Insofar as the Defendant complains about the procedural costs of its claim for patent infringement in several countries, the Defendant is referring to purely factual behaviour that is completely irrelevant under antitrust law. In a state governed by the rule of law, it is the right of every patent proprietor to enforce its alleged claims in court. Even if, in the course of the patent transfer, the intervener had insisted that the Plaintiff assert claims against the Defendant for patent infringement - for which there is no evidence in the facts - nothing follows from this under antitrust law. Precisely because the intervener participates in the licence fees obtained by the patent acquirer via a percentage share, it is - on the contrary - a completely legitimate business interest that the acquirer should, if necessary, also take precautions by means of an infringement action to ensure that the Defendant does not evade its obligation to pay FRAND licence fees. Due to the cost reimbursement principle applicable in Germany, the Defendant does not run the risk of being burdened with financial disadvantages in this context if it wins the case. Insofar as different cost regulations exist elsewhere, nothing else applies.

In such a legal situation, it is the express intention of the legislator and can therefore not be regarded as a circumstance relevant to antitrust law that a litigant has to bear the costs of its legal prosecution or defence itself despite winning the legal dispute.

(4)

Whether the legal situation could be assessed differently if an extensive SEP portfolio is downright "atomised" by splitting the overall package into an unmanageable number of individual owners, with all of whom the licence seeker must deal in his licence negotiations, does not need to be decided in the case in dispute, because such a situation is not even remotely present in the case in dispute.

(5)

At the same time, it follows from the above that the fee regulation in Section 3.4 of the M1 Agreement cannot be accused of violating antitrust law either.

Firstly, as regards the provision that the intervener is entitled to 70% of the licence income generated by the acquirer of the patent portfolio under certain conditions, this is of no significance from the outset. Even if the licence share were to be assessed as unreasonably high, this would at best constitute an abuse of exploitation at the expense of the patent acquirer, which could not give rise to any concern on the part of the Defendant within the meaning of the prohibition of cartels under Art. 101 TFEU.

Equally unobjectionable is the agreement that, in certain factual constellations, the basis of assessment for the licence fee share to be paid to the intervener is not the licence income actually generated by the purchaser of the portfolio, but instead a so-called "applicable royalty rate". It represents an agreed minimum licence amount which, as a calculation figure, ensures that the intervener receives appropriate remuneration for its transferred intellectual property in the event that the purchaser does not succeed in generating sufficient licence income. There is nothing to be said against this type of remuneration agreement under the principle of private autonomy. This also applies in view of the fact that the "Applicable Royalty Rate" may indirectly provide an incentive for the acquirer not to agree lower licence fees if at all possible, because he would otherwise have to contribute part of the licence share owed to the intervener from his own financial resources. However, the situation is no different than it would be if a fixed purchase price had been agreed for the portfolio acquisition - which would have been completely unobjectionable from an antitrust point of view - which, the higher the agreed purchase price, would also have made it economically necessary for the acquirer to conclude the most lucrative licence agreements possible. In addition, the incentive for a certain minimum licence fee within the FRAND framework would affect all prospective licensees equally, so that it is not apparent to what extent the remuneration provision in the M1 Agreement could lead to a restriction of competition for buyers on the licensing market.

5.

The Regional Court rightly and with correct reasoning considered the offer and sale of the attacked embodiment in M to be a literal use of patent claim 6 of the patent in suit and ordered the Defendants to provide information and render accounts as well as pay damages due to direct patent infringement. Even considering the merely limited maintenance of the patent-in-suit by the Federal Patent Court, the Plaintiff is entitled to corresponding claims under Art. 64 (1) EPC in conjunction with §§ 139 (2), 140 (1) EPC. §§139 (2), 140b (1) and (3) PatG in conjunction with §§ 242, 252 BGB. §§ 242, 259 BGB.

(...)

(1)

Offering is not only a preparatory act preceding manufacture, placing on the market, use, importation or possession, but an independent type of use in addition to these acts, which must be assessed independently and is in itself grounds for a claim (cf. BGH, GRUR 2003, 1031 - Kopplung für optische Geräte; GRUR 2006, 927, 928 - Kunststoffbügel; GRUR 2007, 221, 222 - Simvastin; OLG Düsseldorf, GRUR 2004, 417, 419 - Cholesterinspiegelsenker; Urt. v. 20 December 2012, Ref.: I-2 U 89/07, BeckRS 2013, 11856; Judgement v. 30.10.2014, Ref. I-2 U 3/14, BeckRS 2014, 21755; judgement of 06.10.2016, Ref.: I-2 U 19/16, BeckRS 2016, 21218; judgement of 05.07.2018, Ref.: I-2 U 41/17, BeckRS 2018, 23974). The term "offering" is to be understood in purely economic terms. It includes any act of offering committed in Germany which, according to its objective explanatory value, makes the object of demand available in an externally perceptible manner for the purchase of power (BGH, GRUR 2006, 927 -

Kunststoffbügel; OLG Düsseldorf, Urt. v. 13 February 2014, Ref. I-2 U 42/13 = BeckRS 2014, 05732; judgement of 27.03.2014, Ref.: I-15 U 19/14 = BeckRS 2014, 16067; judgement v. 30 October 2014, case reference: I-2 U 3/14 = BeckRS 2014, 21755; judgement of 6 October 2016, case reference: I-2 U 19/16, BeckRS 2016, 21218; judgement of 5 July 2018, case reference: I-2 U 41/17, BeckRS 2018, 23974; OLG Karlsruhe, GRUR 2014, 59; Kühnen, Handbuch der Patentverletzung, 11th ed, Section A, para. 266; Schulte/Rinken/Kühnen, Patentgesetz, 10th edition, Section 9 para. 61). It is therefore irrelevant whether the offering party manufactures the object itself or obtains it from a third party (BGH, GRUR 2006, 927, 928 - Kunststoffbügel; Schulte/Rinken/Kühnen, loc. cit., Section 9 para. 64). Under current law, the prerequisite for an offer is also not the actual existence of a readiness to manufacture and/or supply (BGH, GRUR 2003, 1031, 1032 - Kopplung für elektrische Geräte; OLG Düsseldorf, InstGE 2, 125, 128 f. - Kamerakopplung II; Urt. v. 20 December 2012, Ref.: I-2 U 89/07 - Elektronenstrahl-Therapiergerät; judgement of 6 October 2016, Ref.: I-2 U 19/16, BeckRS 2016, 21218; judgement of 5 July 2018, Ref.: I-2 U 41/17, BeckRS 2018, 23974; OLG Karlsruhe, GRUR 2014, 59 - MP2-Geräte). Similarly, it does not matter for a patent infringement whether the offer is successful, i.e. whether it is subsequently placed on the market (OLG Düsseldorf, GRUR 2004, 417, 418 - Cholesterinspiegelsenker; Schulte/Rinken/Kühnen, loc. cit.).

The purpose of § 9 PatG is, on one hand, to secure the patent proprietor all economic advantages that may arise from the use of the patented invention and, on the other hand, to grant him effective legal protection. It is therefore not necessary for the offer to fulfil the requirements of a legally effective and binding contractual offer within the meaning of § 145 BGB. Furthermore, it does not matter whether the offering party intends to conclude its own or third-party transactions and whether, in the case of an offer in favour of a third party, it is commissioned or authorised by the third party at all (BGH, GRUR 2006, 927 - Kunststoffbügel). Rather, the only decisive factor is whether the service in question actually arouses a demand for infringing goods which the offer promises to satisfy (OLG Düsseldorf, judgement of. 13 February 2014, Ref.: I-2 U 42/13 = BeckRS 2014, 05732; Judgement of 11 June 2015, case reference: I-2 U 64/14 = GRUR-RS 2015, 18679 - Verbindungsstück; judgement of 6 October 2016, case reference: I-2 U 19/16, BeckRS 2016, 21218; judgement of 5 July 2018, case reference: I-2 U 41/17, BeckRS 2018, 23974).

On this basis, an "offer" within the meaning of § 9 PatG also includes, in particular, preparatory disclosures which are intended to facilitate or promote the conclusion of a subsequent transaction concerning an object protected by the patent which includes the use of this object. Therefore, disclosures that are regarded under contract law as a mere invitation to submit offers are also sufficient (BGH, GRUR 2003, 1031 - Kopplung für optische Geräte; OLG Düsseldorf, Urt. v. 27.03.2014, Ref.: I-15 U 19/14 = BeckRS 2014, 16067; judgement v. 30.10.2014, Ref.: I-2 U 3/14, BeckRS 2014, 21755), without the need for readiness or ability to deliver (OLG Düsseldorf, Urt. v. 11.06.2015, Ref.: I-2 U 64/14 = GRUR-RS 2015, 18679 - Verbindungsstück; judgement of 06.10.2016, Ref.: I-2 U 19/16, BeckRS 2016, 21218). In order to ensure effective legal protection, it is therefore only relevant whether the service in question actually creates a demand for an infringing item that the offer promises to satisfy (OLG Düsseldorf, judgement of 11 June 2015, ref. 11.06.2015, Ref.: I-2 U 64/14 = GRUR-RS 2015, 18679 - Verbindungsstück; judgement of 06.10.2016, Ref.: I-2 U 19/16, BeckRS 2016, 21218; judgement of 05.07.2018, Ref.: I-2 U 41/17, BeckRS 2018, 23974).

(2)

This is the case here. Maintaining a website with links that - as in this case - refer to the websites of the subsidiaries about the group's products does not constitute a general exhibition of services, but company-related information and advertising at the same time. Whether a patent-compliant product is offered in such a case must be examined on the basis of the objective circumstances of the case in dispute. Neither the understanding of the advertiser nor that of individual recipients of the advertising or certain groups of persons to whom the advertising material is addressed is a useful measurement. The decisive factor is whether, when objectively considering the circumstances present in the disputed case, it must be assumed that the product offered by means of the advertising corresponds to the subject matter of the patent. If the circumstances to be objectively assessed permit this determination, it does not matter whether the realisation of the patent-compliant features is (also) directly apparent from the offer or the means used. The use of the invention within the meaning of § 9 PatG is not dependent on this. It only depends on the circumstances that can be determined objectively, i.e. whether the content of the offer is based on a product that corresponds to the subject matter of the patent and whether this product is offered as such or as a component of another product (BGH, GRUR 2003, 1031 - Kopplung für optische Geräte; GRUR 2005, 665 - Radschützer; OLG Düsseldorf, GRUR-RR 2007, 259, 262 - Thermocylcer).

Based on these principles, the internet presence of the Defendant 1) complained of constitutes a patent infringing "offering" in Germany. It is undisputed that Defendant 1) operates the website "http://L" (see also Exhibit EIP Chu 44). The fact that this website is in English by default does not a priori preclude an infringement of property rights in Germany. It is true that Internet offers do not infringe property rights simply because they can be accessed in Germany. Rather, what is required is an economically relevant connection to Germany resulting from the overall assessment of all circumstances (on trademark law: BGH, GRUR 2005, 431 - Hotel Maritime; BGH, GRUR 2014, 601 - English-language press release; OLG Düsseldorf, OLG-Report 2008, 672; Kühnen, Handdbuch der Patentverletzung, 11th edition, section A, para. 296). However, this can be assumed in any case if, as in the case in dispute, the website can be switched to German via the language settings, whereupon a partial translation is provided.

On the website operated by the Defendant 1), the user is directed via the item "Products & Solutions" under "Consumers" to the selection option "Telephony, Data Products, Tablets" directly to the website "http://www.Ldevices. de/", via which the disputed designs in M can undisputedly be ordered (cf. Annex EIP Chu 45). The user searches in vain for a reference to the fact that this page, which can be reached via the link, is - indisputably - not operated by the Defendant 1), but by the Defendant 2); only the imprint provides information on this. A user who accesses the internet shop operated under the domain "http://www.Ldevices.de" via the website of the Defendant 1) therefore has no reason to doubt that this is also operated by the Defendant 1). For him, this shop presents itself as an offer of the Defendant 1). There is no dispute between the parties that the products available for purchase there also include the contested design. Whether, on the other hand, the Defendant 1) can itself provide potential purchasers with the power of disposal over the products offered, as it denies, is irrelevant for the existence of a patent-infringing offer. It is sufficient if - as here - products are advertised which are under the control of a third party with whom the advertiser (supplier) co-operates (see OLG Düsseldorf, GRUR-RR 2007, 259, 262 - Thermocyler). It is also irrelevant for a patent infringement whether the offer is successful, i.e. whether it is subsequently placed on the market (OLG Düsseldorf, GRUR 2004, 417, 418 - Cholesterinspiegelsenker; judgement of 6 April 2017, Ref.: I-2 U 51/16, BeckRS 2017, 109833).

bb)

There is also nothing to be said against the conviction of the Defendant 1) with regard to the placing on the market, importation and possession.

4 However, findings on the offer of the attacked embodiment alone are not sufficient for this. As a rule, it is sufficient to establish the obligation to pay damages under § 139 (2) PatG and to order the Defendant to provide information and render accounts if it is proven that the Defendant committed any culpably unlawful acts of infringement during the term of protection of the patent in suit (see BGH, GRUR 1956, 265, 269 - Rheinmetall-Borsig I; GRUR 1960, 423, 424 - bodenventilsäcke). If the dispute, as is often the case in patent infringement proceedings, is about whether the goods manufactured or sold by the Defendant make use of the doctrine of the patent in suit, and if, in addition, it is not in dispute between the parties as to how the defendant has infringed the patent, i.e. by one of the types of use mentioned in § 9 (PatG), then in general – provided that the respective types of use are at all possible given the orientation of the Defendant company - there are no objections to extending the corresponding claim for damages and the accounting order to all types of use mentioned in Section 9 no. 1, even if no specific submission and/or evidence has been given (see BGH, GRUR 1960, 423, 424 - bodenventilsäcke; Benkard/Grabinski/Zülch, PatG, 11th ed, § Section 139 para. 32). However, something different applies if it is undisputed that the attacked embodiment falls within the scope of protection of the patent in suit and the parties' dispute is only and precisely about whether what the Defendant is alleged to have done in relation to this embodiment falls within one of the types of use reserved solely for the patentee under § 9 PatG (BGH, GRUR 1960, 423, 424 - bodenventilsäcke; Benkard/Grabinski/Zülch, loc. cit., Section 139 para. 32). The same applies if the parties are in dispute, - as in this case - both about whether the attacked embodiment makes use of the teaching of the patent in suit, and additionally, about whether the Defendant has carried out a form of use alleged against him, which the Defendant denies plausibly. Even in such a case, a finding of liability for damages and an order for the Defendant to render accounts can only be considered for those types of use under § 9 PatG for which

the Plaintiff can prove infringement (Higher Regional Court Düsseldorf, judgement of 5 July 2018, case reference: I-2 U 41/17, BeckRS 2018, 23974).

In the second instance, the Plaintiff, in support of its infringement allegation in the context of the alleged lack of the Defendant's export license, for the first time asserted that mobile telephones could be purchased in German retail stores (see Bl. 2007 GA VIII) that bear the company name and full address of the Defendant. This submission remains undisputed. Undisputed facts must always be considered in the appeal instance (BGHZ 76, 133 = NJW 1980, 945; OLG Düsseldorf, judgement of 5 July 2018, Ref.: I-2 U 51/17, BeckRS 2018, 23974; Zöller/Heßler, ZPO, 32nd edition, Section 531 para. 9). The Defendants were also unable to explain in the oral hearing before the Senate why mobile phones labelled in this way are available in M, despite being expressly asked. Considering this, it is justified to order the Defendant 1) not only under the aspect of a patent infringing offer, but also comprehensively to provide information and render accounts as well as to pay damages.

cc)

Insofar as infringing internet advertising by the Defendant is at issue, the Plaintiff is not entitled to be informed of "the search engines and other marketing tools by means of which the websites concerned were registered individually or collectively". It is not apparent and has not been specifically explained by the Plaintiff that and why the data in question is necessary in order to enable the Plaintiff to calculate its claims for patent infringement or to check the other information provided by the Defendant, which would not already be sufficiently guaranteed with the help of the other information recognised.

dd)

The claims directed against the Defendant (1) for the provision of information and invoicing have not expired due to the zero-information provided in the first instance in the statement of 16 October 2015 (p. 1070 GA V) through fulfilment (Section 362 BGB).

It is true that such a negative declaration can also be seen as fulfilment of the right to information and/or accounting (BGH, GRUR 1958, 149, 150 - Bleicherde; BGHZ 148, 26 = GRUR 2001, 841 - Entfernung der Herstellungsnummer II; OLG Düsseldorf, GRUR-RR 2012, 406 -

Nullauskunft). However, the Defendant has not yet provided any complete and correct information on the basis of the correct understanding of the scope of the infringement claim as described above, so that the zero or negative information provided by the Defendant on an "incorrect factual basis" could not have led to the expiry of the claims to which the Plaintiff is entitled for the provision of information and invoicing. On the contrary, the Defendant 1) is still obliged to provide information and render accounts (cf: OLG Düsseldorf, judgement v. 16 November 2006, Ref.: I-2 U 76/05, BeckRS 2008, 5815).

ee)

The Senate is unable to recognise from the documents submitted by the Defendants (cf. Annexes ZVB 10 and B 16) that the Defendants, prompted by a court order issued in the British parallel proceedings, would have provided comprehensive information to the extent evident from the operative part and in particular also stating all individual details and separately identified for the M area. Apart from this, such a disclosure of information would also have no significance for the present proceedings and, in particular, would not lead to the request for information having to be declared partially settled. If the debtor provides information to avert enforcement of a judgement that is only provisionally enforceable, this does not constitute fulfilment (Section 362 BGB) or discharge, unless the debtor expressly declares otherwise. Rather, the aforementioned effects only occur when the information title becomes legally binding, so that only at this moment is there cause for a declaration of discharge by the creditor (OLG Düsseldorf, judgement of 23 November 2017, case reference: I-2 U 81/16). The situation in the case in dispute is directly comparable to this because the information provided by the Defendant was not provided entirely voluntarily, but under the pressure of a court order.

6. a)

6 Whether the Plaintiff has complied with its FRAND commitment and the resulting obligations has no significance for the Defendants' liability for damages, which is to be determined in court (i.e. on the merits). This is because the Defendants are guilty of unlawful and culpable patent infringement solely because they have started to use the patent in suit without a licence agreement legitimising the use of the patent having been concluded between them and the Plaintiff (or their legal predecessors). Even if the amount of damages to be paid (for certain periods of time) were to be limited to a FRAND licence fee because the Defendants did what

was necessary on their part to enable the conclusion of a licence agreement on FRAND terms, the financial compensation owed for the use of the patent in suit would nevertheless be the payment of damages. The Defendant's obligation to do so must therefore be determined irrespective of whether the Plaintiff is only entitled to a (FRAND) licence fee as compensation for the damage or whether the damage can also be liquidated according to other calculation methods. In view of the request for a declaratory judgement, which merely requires the probability of any damage occurring, none of this is currently up for decision, but is only to be clarified in the subsequent amount proceedings. Insofar as the Defendants refer to problems of res judicata resulting from the fact that their defence that they alone owe a FRAND licence fee is cut off in the amount proceedings once their liability for damages has been established, this is not the case. Difficulties of this kind can only arise if the question of a breach of duty under antitrust law were part of the grounds for liability for damages due to patent infringement, which - as explained - is not the case. A further consideration also speaks in favour of this. The refusal of the market-dominant patent proprietor to submit a FRAND-compliant licence offer to the patent user seeking a licence in breach of its duties constitutes a breach of its duties under Art. 102 TFEU, which is committed at least negligently and which in turn obliges the patent proprietor to pay damages to the licence seeker (Sections 33 (1), 33a (1) ARC). The damage to be liquidated in this legal relationship consists in being held liable for a FRAND license fee that is higher than the license fees that would have been due if the patentee had acted lawfully (i.e., the full damages) when using the patent-in-suit. For this reason, the license seeker's claim for restitution in kind is to indemnify him against such claims for damages that exceed a FRAND license fee. This independent counterclaim of the infringing Defendant has by no means been decided with legal force in the context of the determination of damages.

b)

For the same reasons, the Defendants' claim to the granting of a FRAND licence does not change the fact that they must provide information for the past in accordance with § 140b PatG due to their unlawful use without this licence.

c)

The situation is different for accounting claims.

aa)

7 This is because the Plaintiff can only demand from the Defendants information regarding their costs and profits for those periods of use for which the Plaintiff is not limited to claiming a FRAND license fee (for which the said cost and profit information is not required) because the Plaintiff and its legal predecessors fulfilled their obligation to cooperate in licensing the Patent-in-suit on FRAND terms, but the Defendants did not (OLG Düsseldorf, GRUR 2017, 1219 - Mobiles Kommunikationssystem). Since the limited duty to render accounts is a consequence of the patent proprietor's infringement of its obligations under antitrust law, it is clearly not the case that the patent proprietor is being denied the legal protection to which it is entitled under the provisions of the Directive on the Enforcement of Intellectual Property and that the infringer is being virtually invited to delay the licensing process. Rather, the situation is exactly the opposite, because the patent proprietor has the opportunity, following a licence request by the infringer, to secure its full claim for damages and invoicing by means of a promptly submitted and formally and substantively correct licence offer. The obligation to take the initiative for a FRAND-compliant license offer remains – no different than in the case of injunctive relief – on the part of the patent proprietor, who, through his FRAND commitment, has not only established a legitimate expectation in the course of business that the SEP proprietor is voluntarily willing to license, but who is also alone in knowing about the license agreements that have already been concluded, and discrimination against them is to be avoided. In view of both circumstances, it makes no difference justifying a divergent legal assessment whether a procedural obstacle to enforcement blocking the claim is to be derived from the same FRAND commitment (as with the injunctive relief claim) or (as with the accounting and damages claim) a restriction of the substantive content of the claim. It is also irrelevant that the action for infringement was brought by the Plaintiff before the decision of the ECJ (GRUR 2015, 764 - L Technologies/ZTE) was published. The interpretation of EU law by the Court of Justice is purely declaratory and must therefore also be applied by the courts of the Member States to legal relationships that were established before the preliminary ruling was issued (BVerfG, NJW 2010, 3422). Because the obstacle of a completely missing or insufficient FRAND licence offer can be removed, the action must be dismissed - as it was - "as currently unfounded". In connection with the accounting information, this means that the Plaintiff's claim for information on costs and profits is (finally) dismissed for all those use transactions that were carried out at a time when a FRAND offer was not submitted in breach

of duty. If - as here - the entire legal dispute remained without such an offer, the dismissal is made accordingly for the period up to the last oral hearing or up to the deadline granted to the Plaintiff for the submission of written pleadings.

Insofar as the Mannheim Regional Court (GRUR-RR 2018, 273 - Funkstation) wants to award cost and profit information "due to the special FRAND situation" even if ultimately only a FRAND licence fee is to be paid, the Senate does not follow this. Apart from the fact that the "special features" relevant to the claim are not specified in more detail and are also not apparent to the Senate, it corresponds to a general principle that only those individual data on which the infringed party is dependent for its calculation of damages are required to provide information. In this respect, nothing special applies to patent infringements in connection with an SEP. Here too, the obligation to provide information in accordance with the principles of good faith (§ 242 BGB) is justified by three interlinked aspects, namely the authorised party's lack of knowledge of the data to be provided through no fault of his own, his dependence on the information in question for the pursuit of his claims and the possibility for the obligated party to easily provide the infringed party with the knowledge he needs. Where certain business data (on costs and profits) are objectively not required because they are not necessary for the sole purpose of calculating damages in accordance with FRAND rules, there can be no claim to their disclosure. The fact that the patent use liable for damages took place in connection with a technical standard does not change this.

8 However, all other data that is usually awarded for the calculation of a (compensation or indemnity) licence fee must be disclosed. In this respect, the FRAND licence is not fundamentally different from an ordinary licence owed as damages or compensation; as with the latter, the licence seeker in a FRAND situation must also account for all those business data which allow the patent proprietor to understand the UFtz figures communicated to him - strictly speaking only relevant to the licence - and to check their correctness in terms of content, which necessarily requires detailed information on the individual delivery transactions and their actors, the offers and the advertising undertaken. Insofar as the Defendant claims for the first time in its statement of 06.03.2019 that such information is completely unusual in (freely negotiated) licence agreements, this is not only a new, unexcused submission that is no longer admissible for procedural reasons alone, but also merely a general factual submission that is not convincing for this reason alone, because licensors naturally have a vital interest in

being able to verify the sales figures provided to them by the licensee and it is not apparent in what other way the possibility of verification could be opened up other than through sales figures subject to a fee. The Defendant does not comment on this either.

bb)

The Plaintiff has not fulfilled its obligations under the FRAND declaration made for the patent in suit, which is why the Defendants are right to take the view that - for this very reason - they are currently only obliged to render accounts with regard to the payment of a FRAND licence fee and not to pay any further damages together with preparatory accounting. Since the Plaintiff has limited its accounting claim relating to the Defendant's profits and costs in the appeal proceedings to the period since 29 June 2017, it is irrelevant whether the Plaintiff has already fulfilled its obligation to notify the infringement before the court and whether the Defendants have applied for a FRAND licence. In any case, both obligations have been fulfilled with regard to the statement of claim and its response and the Plaintiff's breach of antitrust law obligations for the relevant period from 29 June 2017 follows in any case from the fact that it did not submit a licence offer that met FRAND requirements following the Defendants' request for a licence.

However, the Plaintiff's statement at the hearing on 21 February 2019 that it does not wish to submit a new licence offer taking into account the licence agreements concluded by the intervener during its ownership of the patent in suit does not justify dismissal of the action for the future either. On a reasonable understanding, the Plaintiff's comment merely expresses that it adheres to its view that it is not bound by the licensing practice of its legal predecessor, which is its right. Accordingly, the background to the statement was also the Senate's question as to whether an adjournment was necessary in order to enable the Plaintiff to improve its licence offer within the appeal instance, taking into account the Senate's legal opinion. The Plaintiff has denied this alone, which of course does not rule out the possibility that, should the Federal Court of Justice approve the Senate's assessment, it will bow to this and, of necessity, be prepared to offer the Defendant a licence after all, taking into account the relevant Ericsson licences, in view of the now finally clarified framework conditions.

(1)

In the contested judgment, the Regional Court found without objection that the Plaintiff (and its legal predecessors) had a dominant position on the market for the granting of licences for the patent in suit because, without the use of its technical teaching, no product could be obtained which could compete effectively on the downstream product market with devices using the invention. This does not indicate an error of law, and the parties do not object to this. The notice of infringement owed by the Plaintiff also lies in the filing of the action at the latest and in the statement of defence (p. 9 et seq.; GA IV), with which the Defendants have asserted a claim for the granting of a FRAND licence for themselves, the request for the granting of a licence.

(2)

According to the interplay of mutual obligations provided for by the ECJ, under the circumstances described, it was now incumbent on the Plaintiff to submit a licence offer to the Defendants for the patent in suit on FRAND terms. It had to be in writing and specific, specify the licence fee and the way in which it was calculated, and it had to be free of discrimination and exploitation in terms of its content (ECJ, GRUR 2015, 764 - L Technologies/ZTE). Only a licence offer that is flawless in every respect triggers duties of disclosure on the part of the patent user, from the disregard of which the infringer can derive rights for itself. However, the Plaintiff has not submitted a sufficient licence offer.

(a)

With the very first licence transaction, the SEP holder must decide on a certain licensing concept that will legally bind him (and his legal successors) in the future, because a departure from the model once practised is only possible if and to the extent that this does not result in any inadmissible discrimination (less favourable treatment) of later or earlier licensees. The requirement to licence "fairly" and "reasonably" is therefore at the forefront of the initial award, while the question of discrimination (compared to what else?) does not arise in the absence of a reference agreement. If the licence conditions chosen for the initial award consider the requirements for non-exploitative content, the prohibition of discrimination becomes the focus of consideration for all subsequent licences. It prohibits and prevents - provided there are no correspondingly different licensing circumstances - any deviation upwards or downwards from the licence level stipulated by the initial licensing in a manner relevant to competition, and thus decisively outlines the scope for negotiation that remains for the SEP holder in subsequent licence agreements. The prohibition of objectively unjustified unequal remuneration applies here without any exception and consequently also if the FRAND fee framework that was possible in itself was not exhausted - possibly even significantly - during the initial licensing and the later change in licensing practice aims to bring the licence fee (which would initially have been possible) into the upper range of what is legally permissible from an exploitation point of view. This is because the SEP holder's purely subjective failure to negotiate or deliberate yielding in the initial licensing cannot be recognised as a factual reason for subsequent licence seekers having to accept financially worse conditions of use in competition.

At most, compelling economic reasons for an increase in the licence fee could be considered, whereby it would be necessary for all licence agreements to be amended accordingly. This in turn presupposes that the existing, favourable contracts contain corresponding opening clauses or that there are legal possibilities for a subsequent increase in the licence fees (e.g. due to the cessation of the business basis) and that the licensor actually makes use of them. Licence agreements are also irrelevant for the future from a discrimination perspective if and as soon as they are effectively terminated.

Court-imposed licensing conditions do not constitute a situation that the SEP holder can be accused of discriminatory behaviour because there is no (free) entrepreneurial decision in this respect (BGH, WRP 2004, 374 - Depotkosmetik im Internet; OLG Düsseldorf, NZKart 2014, 35 - Frankiermaschinen II; OLG Düsseldorf, NZKart 2018, 235 - Mitbenutzung von Kabelkanalanlagen). However, if the court's requirements contradict a previous licensing practice, they also do not justify contradicting this with subsequent licences that follow the ruling. Rather, the licensing practice that the SEP holder and its legal predecessors have implemented under their own entrepreneurial responsibility remains decisive for the accusation of discrimination, while the deviating conditions brought about by the court do not in themselves justify an accusation of discrimination because there was an objective reason to agree to them in view of the court proceedings.

9 Even if the equal or unequal treatment of licensees is based on a purely competitive approach, the prohibition of discrimination often means that the initially preferred licence model can no

longer be subsequently changed in favour of another model. Because with the calculation concept, the fundamental rules for determining the remuneration change, which means that in case of doubt it is unforeseeable whether the other remuneration model would lead - which would be acceptable - to a merely marginal or - which would be objectionable from the point of view of discrimination - to a more far-reaching, more than insignificant advantage/deterioration in the burden of the new licensee.

(b)

10 The relationships described above have direct consequences for the SEP holder's burden of presentation, who, according to ECJ case law (GRUR 2015, 764 - L Technologies/ZTE), is obliged to explain the "method of calculation" of the licence fee claimed by him in connection with his licence offer. Because the license offer - at least as a matter of priority - has to regulate future acts of use whose scope and intensity is not foreseeable and for which, therefore, no fixed remuneration can reasonably be set in advance, the information on the “manner of the license fee calculation” is necessarily means something different, namely an explanation of the circumstances that identify the contractually, e.g. according to reference value and license rate, designated remuneration factors as non-discriminatory and non-exploitative (= FRAND). (Higher Regional Court Düsseldorf, decision of 17 November 2016, case reference: I-15 U 65/15; Higher Regional Court Düsseldorf, GRUR 2017, 1219 - Mobiles Kommunikationssystem). The patent proprietor must therefore specifically explain why it believes that the remuneration parameters included in its offer (reference value, licence rate) and the resulting licence fee result in a non-discriminatory and non-exploitative user fee for the licence seeker compared to others. This information is required not least because the licence seeker can only meaningfully discuss the licence offer submitted to it with regard to its FRAND compliance if it is aware of the circumstances relating to previous licensing practice.

If the patent proprietor or its legal predecessor has already granted licences, it must be made clear to the opponent that the licence offer either treats him equally or why it treats him unequally and in what respect. In connection with the licence offer, it must therefore be disclosed - which the licence seeker naturally cannot know - whether there are other licensees and, if so, what the contents of the licence agreements concluded with them are, in particular which uniform licensing concept (if any) the agreements follow. This is because the aforementioned active contract contents set the legal standard for the SEP holder's prohibition of discrimination in the granting of licences. If divergent licence agreement contents have been agreed over time, the question of unobjective and thus unlawful unequal treatment of the specific licence seeker generally arises in relation to each of the divergent licence agreements, unless a particular agreement is already invalid due to abuse of exploitation. In addition, the SEP holder is obliged to provide a comprehensible and sufficiently substantiated justification as to why the licence fee applied by him - namely with the first licence - is FRAND, i.e. reasonable ("fair, reasonable"). As far as the granting of licences by the Plaintiff's legal predecessors is concerned, there is precisely such a duty of disclosure with regard to their licensing behaviour, because the SEP acquirer - as explained above - enters into the licensing practice of his legal predecessor(s) and, in the course of the patent transfer, has the legal opportunity to gain insight into existing or former licence agreements.

11 For the future, licence agreements are also irrelevant from a discrimination point of view if and as soon as they are effectively terminated, whereby it is not the date of the notice of termination but the date on which the termination takes effect (= expiry of the notice period/end of the fixed contract term) that matters. Contract terminations can therefore give the SEP holder new scope for negotiation when granting licences. If the patent holder succeeds in terminating all licence agreements at a certain point in time in a legally permissible manner (in particular under antitrust law), he or his legal successor can switch to a new licensing concept that is different from the previous one - solely in compliance with the prohibition of exploitation - and which only binds him from then on within the framework of the prohibition of discrimination. The decisive factor is the date of the licence offer specified by the claim in question. An expiry of the licence agreements can be ensured, for example, by keeping a fixed end date in mind from the outset by agreeing the said end date for the first licence agreement and this date marking the end of the agreement for all subsequently concluded licence agreements. The fact that, as a result, all licensees following the first only benefit from a license term that is shortened due to their delay in concluding the contract is legally unobjectionable because the licensor can also freely reorganize its business policy and the patent holder's interest to re-explore the license conditions after a certain period of time within the scope of the FRAND leeway represents an objectively justified reason, whereby the coordinated durations ensure that each licensee must at all times be able operate with identical license conditions as its competitors. This alone is decisive from a discrimination point of view,

and not the fact that the subsequent licensee can expect the same number of years with certain licence conditions applicable at the time the agreement is concluded. However, if the new licences provide for significantly higher royalties, it is necessary - in view of the more lenient licensing conditions practised in the past - for the patent proprietor to explain in more detail why the increased royalties are (also) "fair" and "reasonable".

It may be that, particularly in the case of extensive portfolios, a termination date that is the same for all licences can only be implemented with considerable logistical effort. However, if this is the case, this does not mean that it is inappropriate for the legal successor to be bound by the licensing practice of its legal predecessor and that this should not take place, but rather - conversely - only highlights the particular importance of carefully sounding out the licence conditions in accordance with the prohibition of exploitation. The SEP holder will therefore have to weigh up the conditions of his first licence all the more carefully if he is bound to it in the long term from a discrimination perspective.

(c)

In its pleadings, the Plaintiff deals with licences granted for the patent in suit that were active at the relevant times only to the extent that it is concerned with rights of use granted by itself during its ownership. According to the above, this clearly falls short because the SEP acquirer must accept the licensing practice of its legal predecessors in the context of the prohibition of discrimination. In the case in dispute, this aspect is all the more important because the intervener openly admits that the transfer of its patent portfolio to the Unwired Planet group served to achieve higher licence income than it (the intervener) itself was able to achieve in the past. Because of the relevance of all licence agreements in assessing the question of whether the Defendants are discriminated against by the licence conditions submitted to them, it is - as stated - relevant to each and therefore also and in particular to those licence(s) which were concluded by the intervener at the time of its SEP ownership and which were still in force at the time of the legally required licence offer. The fact that such contracts exist which define the standard of discrimination to be observed by the Plaintiff, was admitted by the Plaintiff upon request. In order to justify the non-discriminatory nature of its licence offers to the Defendants, it would therefore have been up to the Plaintiff to disclose all licence grants relating to or including the patent in suit and to argue whether the Defendants are offered either economically identical terms or, if this is not the case, why a different treatment of the Defendants in certain respects compared to licensees of the intervener who were entitled earlier should be objectively justified. The Plaintiff does not respond to all of this in the required manner. Rather, at the hearing on 21 February 2019, it categorically refused to disclose the intervener's licences. This has not changed as a result of the subsequent pleadings of the Plaintiff and its intervener. The blanket reference to the description of the intervener's licensing practice, which was submitted in another legal dispute by other legal representatives, does not reveal any specific reference to those facts that could be relevant to the present proceedings; it is also not explained by the Plaintiff and its intervener. Equally irrelevant are the comments on what the UK infringement court did when determining the FRAND licence in the foreign parallel proceedings. Since the Senate itself must be convinced of the non-discriminatory nature of the licence offers at issue, the relevant facts must be presented to the Senate in detail, which has not been done and which, according to the Plaintiff's unchanged statement of intent, there is no willingness to do. As a result, the licence offers addressed to the Defendants do not reveal the licence fee and the way in which it is calculated in the required manner, which means that the privileged status of the Defendants to the effect that they do not owe more than a FRAND licence fee for the use of the patent in suit continues to exist.

7.

There is no reason to suspend the hearing, § 148 ZPO.

[...]

III The decision on costs follows from [...].

The orders for provisional enforceability result from [...].

The appeal was admissible pursuant to § 543 (2) ZPO because [...].

[...]