



LG Munich I

21 O 11522/21

Judgement of 5 August 2022

(...)

Grounds

(...)

Plaintiff is therefore entitled to the claims asserted.

The claim for an injunction follows from Art. 64 (1) EPC, Sec. 139(1) Patent Act. The danger of repetition is indicated by the established unlawful acts of use.

A per se prohibition is justified regarding claim number I.1. The attacked devices can only be used in a technically and commercially reasonable manner in a way that infringes the patent. Offering and supplying smartphones advertised as 4G/5G-compatible only with 2G-compatibility by means of a software update is generally out of the question. This also applies as far as the smartphones can be used as a camera in any case. A user who buys a smartphone does not want to use it only as a camera, even if it is of high quality. Likewise, they will generally not use a smartphone only as a mini-computer without up-to-date standard compatibility.

The injunctive relief is not excluded on grounds of disproportionality, Sec. 139 (1) 3 Patent Act. It is proportionate, Sec. 139 (1) 3 Patent Act.

Defendant argues that a full prohibition would be disproportionate, since Plaintiff's interests primarily lay in the monetization of the patent in suit, not in the marketing of its technical achievements, and would have to run behind Defendants' interests. A full prohibition would have economic consequences for Defendant that would be completely disproportionate to the share of the patent in suit in the technically complex products of the attacked devices. This applied in particular due to the fact that Defendants' products are complex products and



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the patent in suit concerned only a negligible part of the overall product, but at the same time, due to its - assumed - standard essentiality, an injunction would mean a de facto stop in the distribution of the attacked devices.

Plaintiff emphasizes that it was not a patent exploiter but a research company and network supplier as well as an indirect participant in the smartphone market as a trademark licensor.

Against this background, there is no disproportionality.

Pursuant to Sec. 139 (1) 3 Patent Act, the injunctive relief is excluded if, due to the particular circumstances of the individual case and the requirements of good faith, the claim would lead to disproportionate hardship for the infringer or third parties which was not justified by the exclusive right.

The objection of disproportionality under Sec. 139 (1) 3 Patent Act is limited to special exceptional cases. This takes account of the fact that the injunctive relief is the logical consequence of the exclusive right. The grant of the patent gives rise to absolute rights in the patented invention which, in addition to their function of attributing the invention to the inventor, have a function to exclude others, so that the owner of the right can in principle exclude anyone from using the patented teaching. Thus, they allow in particular - within the framework of the other legal requirements, in particular those of patent and antitrust law - the exclusion of third parties from the use of the patented teaching. In order to enforce his exclusive right, the patentee generally has to rely on injunctive relief.

In the official justification to the Second Patent Modernization Act, the legislator clarified that a restriction of the injunctive relief can only be considered in special exceptional cases. The injunctive relief is the regular sanction under patent law for patent infringement. The burden of proof for disproportionality lies with Defendant. A restriction of the right to injunctive relief can only be considered in particularly exceptional cases (BT-Drs. 19/25821, p. 53).

If the patent infringer presents special circumstances which may constitute unjustified hardship in the individual case, it may exceptionally be relevant within the framework of an overall assessment of all circumstances of the individual case and a careful weighing of all circumstances, taking into account the requirement of good faith and the fundamentally



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overriding interests of the infringed party in the enforcement of its injunctive relief, whether the infringed party itself manufactures products or components that compete with the infringing product or whether the patentee's primary objective is to monetize its rights (BT-Drs. 19/25821, S. 53). Furthermore, economic effects of the injunction, the complexity of products, subjective points of view on both sides and third-party interests may have to be taken into account. For example, a lack of willingness to take a license can be seen to the detriment of the obligated party (BT-Drs. 19/25821, p. 54).

Applying these standards, the objection of disproportionality raised by Defendant is not valid. Taking into account all the circumstances of the legal dispute between the parties and their relevant interests, Defendant has not demonstrated that the injunctive relief is disproportionate.

To the extent that Defendant argues that Plaintiff is a pure patent exploiter, this is not relevant in itself.

This is because according to the previous legal situation (cf. Werner in: Busse/Keukenschrijver, Patent Act, 9th ed. 2020, Sec. 139 marginal no. 92 with further references), with which the official justification to the Second Patent Modernization Act agrees (see above), the mere fact that a patent exploiter asserts a claim for injunctive relief is not in itself suitable for classifying it as disproportionate. Irrespective of this, Plaintiff is indisputably active on the network equipment market with its own products and indirectly on the smartphone market as a trademark licensor, albeit not in direct competition with Defendant in the smartphone sector.

It is also irrelevant that Plaintiff is interested in concluding a license agreement. It is true that the aspect of a primary interest in the monetization of patents can be taken into account as an aspect in the weighing of interests, as explained above. This aspect is related to the own market participation (or lack thereof) of patentees. Since Plaintiff is obliged on the basis of its FRAND declaration and for reasons of antitrust law to enable the licensing of the patent in suit and to enter into licensing negotiations for this purpose as well as to conduct these in a targeted manner, as explained under C., it may not be held against Plaintiff in the context of the proportionality test that it complies with precisely these contractual and antitrust obligations. Nor is it required to refrain from initiating legal proceedings until the license



negotiations have been concluded in order to avoid the accusation of disproportionality. In that case, the rule-exception relationship established by Sec. 139 (1) 3 Patent Act would be turned into its opposite and the legislative objective would be misunderstood.

Also, the fact that the attacked devices are complex products does not lead to disproportionality.

At least in the case of the assertion of standard-essential patents, disproportionality is generally out of the question. This is because the user of an SEP is in principle entitled to conclude a license agreement on FRAND terms. The fact that the license agreement has not yet been concluded is - as will be shown under C. below - to be blamed on Defendant. As explained above, unwillingness to take a license can also be taken into account when weighing interests. A different result does not follow from Defendants' argument that the FRAND Einwand and the disproportionality objection are based on different dogmatic foundations. The fact that Defendant received several offers from Plaintiff - which were not absolutely unacceptable, see above - and did not accept them because it was unwilling to take a license (see C.) cannot limit Plaintiff's rights due to the complexity of the infringing product. This is because Defendants' group of companies had and has the possibility to legitimize its patent-infringing actions. However, it has not (so far) made use of this possibility. It is then a logical consequence that Plaintiff must enforce its patent rights against a patent infringer who is unwilling to take a license and is dependent on legal proceedings for this purpose. Within the framework of the required overall consideration, this does not justify any disproportionate nature of the injunctive relief.

This result is also in line with the prevailing opinion in legal literature: if the patentee complies with its FRAND obligations, Sec. 139 (1) 3 Patent Act does not open up an additional defense possibility for the patent infringer in the absence of further circumstances justifying disproportionality (cf. Ohly, GRUR 2021, 1229, 1236).

The economic effects on Defendants' side also do not lead to a different result. It has been using Plaintiff's patent in suit for a year without payment of royalties and has the possibility of concluding a license agreement that would conflict with the injunctive relief. Defendant has not presented any particular hardships caused by the injunctive relief that would lead to disproportionality in view of these circumstances.



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Even an overall view of the aspects raised against proportionality does not result in a different assessment.

The claims for injunctive relief are therefore not precluded by the asserted disproportionality. In view of this, Plaintiff is not entitled to appropriate monetary compensation under Sec. 139 (1) 4 Patent Act.

The claim for information and rendering account follows from Art. 64 (1) EPC, Sec. 140b (1), (3) Patent Act, Secs. 242, 259 German Civil Code.

Insofar as Defendant claims that it does not manufacture the attacked smartphones in Germany, the claim for information and rendering account can go beyond the infringing acts identified in order to enable Plaintiff to check the plausibility of the information provided by the parties, also in themselves. If Defendant did not manufacture any infringing items in Germany, it can state this by means of "zero declaration".

The provision of information in electronic form is common practice, so that the right to information and rendering account extends to this (see Zigann in: Haedicke/Timmann, Handbook of Patent Law, 2 Ed. 2020, § 15 marginal no. 163).

The claim for recall and destruction follows from Art. 64 (1) EPC, Sec. 140 b (1), (3) Patent Act. The claim for recall also exists against an obligor domiciled abroad (FCJ, GRUR 2017, 785, 787, marginal no. 33 – Abdichtsystem). Therefore, Plaintiff here has this claim against Defendant. Similarly, Plaintiff can claim destructions: although Defendants' registered office is abroad, it indisputably delivers attacked devices to Germany and therefore has (indirect) possession in Germany in any case. As far as Defendant emphasizes that a delivery to the domestic market does not give any information about ownership and possession, it has not demonstrated a pure direct delivery to end customers. However, Defendant has not specifically shown how a delivery to customers is to be made without at least an existing indirect ownership relationship.

The claim is also not disproportionate, Sec. 140a (4) Patent Act. The objection of disproportionality under Sec. 140a (4) Patent Act is also limited to narrow exceptions (for the



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destruction claim see BeckOK PatR/Rinken PatG Sec. 140a marginal no. 28, for the recall claim BeckOK PatR/Rinken PatG Sec. 140a marginal no. 46). What has been said under VI.1.b) applies here accordingly.

The claim for damages follows from Art. 64 (1) EPC, Sec. 139 (2) Patent Act. Defendant and the otherwise prosecuted party are jointly and severally liable under Section 840 (1) German Civil Code.

The antitrust objection of compulsory license does not impede the enforcement of Plaintiff's claims for injunctive relief, destruction, recall and removal. It does not apply due to the lack of willingness to take license on the part of Defendants' group of companies. It can be assumed in its favor that Plaintiff has a dominant position on the relevant market, so that it is the norm addressee of Article 102 TFEU.

Plaintiff has sufficiently fulfilled the duties and obligations resulting from this special position. In particular, it has informed Defendants' group of companies of the infringement of the patent in suit. Contrary to Defendants' assumption, however, there is no abuse of the dominant position. According to the circumstances of the specific case, Defendants' group of companies was not (sufficiently) willing to take a license.

A patentee who has undertaken vis-à-vis a standardization organization to grant licenses to a standard-essential patent (SEP) on FRAND terms may abuse its dominant position conferred by the standard-essential patent by bringing an infringement action if and to the extent that it is suitable to prevent products complying with the standard from entering or remaining available on the market (cf. ECJ GRUR 2015, 764 - Huawei Technologies/ZTE; FCJ GRUR 2020, 961 marginal no. 68 - FRAND-Einwand I). In this respect, claims for injunctive relief, recall and removal of products or destruction can generally be considered abusive (see FCJ GRUR 2020, 961 marginal no. 68 - FRAND-Einwand I with further references).

The Court of Justice of the European Union has ruled on the FRAND license that the owner of a standard-essential patent standardized by a standardization organization, who has irrevocably committed himself to that organization to grant a license to any third party on FRAND terms, does not abuse his dominant position by, by bringing a patent infringement action for injunctive relief against infringement of its patent or for recall of the products in the



manufacture of which that patent has been used, if he has, first, before bringing the action, indicated to the alleged infringer the patent infringement of which it is accused, identifying and specifying the patent in question, in which way it is alleged to have been infringed, and secondly, after the alleged infringer has expressed his will to enter into a license agreement on FRAND terms, he has submitted to the infringer a specific written license offer on these terms, indicating in particular the royalty and the way it is to be calculated, and this infringer, while continuing to use the patent in question, does not respond to that offer with diligence, in accordance with accepted commercial practices in the field concerned and in good faith, which must be determined on the basis of objective considerations and implies, inter alia, that no delaying tactic is being pursued (cf. ECJ loc. cit.). Further, the Court of Justice of the European Union has ruled that the owner of a standard-essential patent with a FRAND declaration is in principle not prohibited from bringing an infringement action against the infringer of his patent for rendering account on past acts of use in relation to the patent or for damages based on these acts (ECJ loc. cit.).

The assertion of the claims for injunction, recall and removal as well as destruction by the patentee by way of an action may constitute an abuse if the infringer has not (yet) declared his willingness to conclude a license agreement under certain reasonable conditions, but the patentee is to be blamed for not having made sufficient efforts to meet the special responsibility associated with the dominant position and to enable an infringer who is in principle willing to take a license to conclude a license agreement (FCJ - FRAND-Einwand I loc.cit.). The abuse of market power follows from the refusal of a demanded access to the invention per se or from unreasonable conditions for a demanded access from which the patentee is not willing to deviate even at the end of negotiations, i.e. the refusal to offer the licensee seeking the conclusion of an agreement on FRAND terms, as a result of a negotiation process, those fair, reasonable and non-discriminatory conditions which the licensee can claim and at which he is for his part willing to conclude with the patentee (cf. FCJ loc. cit. para. 59 - FRAND Einwand II). An offer that does not comply with FRAND conditions as such does not constitute an abuse of the patentee's dominant position: An abuse only lies in refusing to allow the patent infringer to negotiate and conclude a FRAND license agreement that is in line with the interests articulated in the negotiation process, or in making such an agreement impossible, and instead enforcing the patent or one of the patents to be licensed by taking legal action (FCJ loc. cit., marginal no. 78 - FRAND Einwand II).



The person who wants to use the patent or has already used it and has brought products onto the market that comply with the patent, although he does not have a license, must be prepared to take a license to this patent on reasonable and non-discriminatory terms (FCJ loc. cit. para. 70 – FRAND Einwand I). This is because even the patentee with market power cannot impose the taking of a license on anyone; although the potential licensee can demand that he concludes a license agreement, the patentee is dependent on enforcing claims for patent infringement against anyone who wants to use the patented teaching but does not want to conclude a license agreement in this respect (see FCJ loc. cit. marginal no. 82 – FRAND Einwand I). The infringer must therefore clearly and unambiguously declare his willingness to conclude a license agreement with the patentee on reasonable and non-discriminatory terms, and must also subsequently participate in the license agreement negotiations in a targeted manner, because "a willing licensee must be one willing to take a FRAND license on whatever terms are in fact FRAND" (FCJ loc. cit. marginal no. 83 – FRAND Einwand I). Under which circumstances a lack of willingness to take a license on the part of the patent infringer exists is a question of the individual case (FCJ loc. cit. marginal no. 78 – FRAND Einwand II).

An abusive refusal by the dominant patentee necessarily presupposes a continuing demand by the infringer for the conclusion of an agreement on FRAND terms and his willingness to cooperate in the conclusion of such an agreement, without which a "refusal" by the patentee would come to nothing (FCJ loc. cit. para. 66 - FRAND Einwand II). The willingness to take a license is indispensable because an appropriate result balancing the opposing mutual interests can usually only be grasped as the result of a negotiation process in which these interests are articulated and discussed in order to arrive at a fair and appropriate balance of interests desired by both parties. The requirements for the conduct of the patentee and the conduct of the user of the invention are mutually dependent. The standard of review is what a reasonable party interested in the successful conclusion of the negotiations in a manner that is in the interests of both parties would do to promote this goal at a certain stage of the negotiations (FCJ loc. cit., para. 59 - FRAND Einwand II). An objective willingness to conclude a FRAND license agreement is regularly demonstrated by the active promotion of the negotiations oriented towards the common goal of a successful conclusion. In this context, the negotiation steps of parties interested in concluding an agreement build on each other. A duty to promote the negotiations therefore always exists if and to the extent that the



next negotiating step is to be expected in accordance with business practice and the principles of good faith (FCJ loc.cit. para. 68 – FRAND Einwand II).

In particular, the infringer may not delay the negotiations (FCJ loc. cit. para. 66, 71). This is because, unlike in the case of contractual negotiations, which a company willing to take a license seeks prior to the commencement of use, the infringer's interest may also be - solely or at least primarily - to stall the patentee as far as possible until the expiry of the term of protection of the patent in suit, because he is then no longer threatened with an order to cease and desist (FCJ loc. cit. para. 82 - FRAND Einwand I). A delaying tactic typically consists in not simply rejecting a license agreement on FRAND terms, but in ostensibly striving for it, but in pushing back the finding of an appropriate solution in detail or at least postponing it as long as possible (FCJ loc. cit. marginal no. 67 - FRAND Einwand II). The assessment of whether a delaying tactic is being pursued, which is to be made on the basis of objective aspects, is also to take into account the further conduct of the infringer in response to a notice of infringement or an offer by the patentee (FCJ loc. cit. marginal no. 77 - FRAND Einwand II).

If the patent infringer is not willing to take a license, it can be left open according to the case law of the Federal Court of Justice whether the patentee's offer (in terms of content) complies with FRAND conditions (FCJ loc. cit., paras. 82, 101). The only case in which the license seeker is completely released from the obligation to respond and therefore also from the obligation to state all objections at the same time is if an offer is contrary to FRAND to such an extent that it appears to be utterly unacceptable when assessed objectively, is therefore to be assessed as not being seriously meant and in fact represents a refusal to conclude a license agreement on FRAND terms according to the objective recipient's horizon (cf. FCJ loc. cit., para. 71 - FRAND Einwand II).

According to these standards, Defendants' group of companies is not sufficiently willing to grant a license, taking into account all the circumstances of the individual case and the relevant overall conduct of the parties, in particular in view of Plaintiff's purposeful negotiation.

The offers submitted by Plaintiff, in particular the offer from ... and from ..., are not absolutely unacceptable. Chamber considers these offers to be serious and aimed at concluding the



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negotiations in a way that is in the parties' interests. In substance, they do not imply a refusal to conclude a license agreement on FRAND terms with Defendants' group of companies. Above all, the two main objections raised by Defendants against Plaintiff do not hold water.

If Defendants state ..., although ... this does not result in an absolutely unacceptable offer to which Defendants' group of companies would not have had to respond.

It is clear from the parties' negotiation history, to Chamber's conviction, that Plaintiff has

In this respect, Chamber is convinced that the initially ...there has been a misunderstanding between the parties. In response to Plaintiff's offer to that effect, Defendants' group of companies submitted Plaintiff replied that this understanding was not correct: ... Plaintiff later clarified this understanding by the changed formulation in the offer of

The fact that Plaintiff does not explain in detail the way in which the required royalty is calculated and, in particular ... does not cause its offer to be absolutely unacceptable. Defendants may be annoyed that Plaintiff..., but this does not cause Plaintiff's offer to be unreasonable.

Contrary to Defendants' view, no detailed explanation of the method of calculation is required in individual cases. As a rule, the decisive factor is what the royalty "adds up to". Reasonable parties are not concerned with the underlying calculation or with dividing the final amount into partial sums or services. The way to the bottom line is also subordinate, at least in the present case, because Defendants' group of companies, knowing the content of Plaintiff's further license agreements with other companies, rightly does not raise the objection that its direct competitors received more favorable conditions than they did. Even if Defendants plead ignorance with respect to ..., ... and assert ... this argument does not result in discrimination against Defendants.

Defendants do not claim that this concerns their direct competitors. Rather, they plead - in this respect ineffectively - with ignorance that Nor is there any compelling inference from the aforementioned unit licenses to the licenses mentioned here (see above).



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Thus, contrary to Defendants' view, it is also not necessary to negotiate with Plaintiff about the value of his patents. For what is decisive in the relationship between the parties is not ... but the total sum which Plaintiff demands for his patent portfolio and which is to be paid by Defendants' group of companies.

That ... does not justify a different result either. In any case, Defendants' group of companies has not presented any specific evidence that would invalidate this assumption.

If Defendants' group of companies also complains ... no absolutely unacceptable offer follows from this likewise.

It may be true that Plaintiff initially ... and ... was missing in the respective offers. However, it does not follow from this that Plaintiff merely made an offer to Defendants' group of companies which was not meant seriously and which in substance meant a refusal to conclude a license agreement with Defendants' group of companies on FRAND terms. Incidentally, Plaintiff still ... before the last oral hearing ... (Exhibit K60/K 60a in the proceedings 21 O 8890/21).

The rules of antitrust law to be taken into account in the context of the compulsory license objection do not result in an obligation on the part of Plaintiff to offer Defendants ... even if other competitors had received agreements with this clause. Defendants do not have such a claim to the offer ... in the specific individual case.

Thus, there is already no antitrust obligation of Plaintiff to resolve all conflicts with Defendants' group of companies regarding This applies all the more against the background of the specific dispute of the parties, in which Plaintiff has brought patent infringement actions against Defendants' group of companies Both types of proceedings are pending before Chamber. In addition, the offer of a portfolio license agreement by a market-dominating owner of a standard-essential patent is in principle unobjectionable under antitrust law, at least to this extent, ... (FCJ loc. cit. marginal no. 78 - FRAND Einwand I).

The objection of Defendants' group of companies that Plaintiff offered competitors ... and it had become part of the license agreements, does not result in a discrimination in violation of antitrust law. This objection essentially relates to concluded license agreements. However,



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the parties in the present dispute are (currently) far from having concluded a license agreement, so that the negotiations on the license agreement have not yet been concluded and it is therefore also not excluded that Plaintiff could also offer Defendants' group of companies Under the given circumstances - the parties are in dispute in particular not only about ... but also about further clauses and conditions - an offer by Plaintiff is not possible without...

... in any case, not an absolutely unacceptable offer.

If Defendants claim that these offers differ from ... in the absence of such a clause to decide to their disadvantage, this objection is factually correct, but does not make Plaintiff's offer appear to be absolutely unacceptable. Because the asserted objection has its origin ... so that in this respect at most (post-) contractual, but in any case no antitrust claims could be affected.

Incidentally, Plaintiff submitted to Defendants even before the last oral hearing ... (Exhibit K60/K 60a in proceedings 21 O 8890/21), which Defendants nevertheless did not accept.

Nor does it follow from Defendants' further objections that Plaintiff's license offer was absolutely unacceptable.

These objections (see below) already weigh less heavily than Defendants' two main objections ... and are therefore all the more incapable of substantiating the unsuitability of Plaintiff's offers.

Defendants' unwillingness to take a license arises from its reluctance to negotiate the terms of the license and from the fact that it did not conduct the negotiations in a goal-oriented manner to conclude the license agreement allegedly sought. Defendants' group of companies has not been sufficiently willing to take a license during the protracted negotiations. In Chamber's opinion, the overall behavior of Defendants' group of companies shows its lack of interest in reaching a renewed conclusion of the license agreement with Plaintiff in an expeditious manner. Defendants' group of companies did not formulate its objections to Plaintiff's offers sufficiently early and did not communicate numerous reasons against the fulfillment of the FRAND conditions until the legal proceedings. Chamber is convinced that Defendants' group of companies is pursuing the goal of enforcing its own



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(financial) license conditions against Plaintiff. It is using delaying tactics for this purpose. Thus, as a means of exerting pressure, it is prepared to use the patent in suit (and other patents from Plaintiff's portfolio) for as long as possible without authorization and without paying Plaintiff. Its unwillingness to take a license also results from the fact that Defendants' group of companies did not take the next step in the negotiations with Plaintiff, although objectively it would have been time. Nor do the further objections raised by Defendants' group of companies constitute an abuse of its dominant position on legal grounds. On the other hand, Chamber is convinced that Plaintiff neither refused to allow Defendants' group of companies to negotiate and conclude a FRAND license agreement that was appropriate in view of the interests articulated, nor did it make this impossible.

The unwillingness to take a license results objectively essentially from the hesitant and not sufficiently conducive behavior of Defendants' group of companies during the negotiations with Plaintiff, as described below.

After the parties signed a worldwide license agreement on ... until ... on Plaintiff's cellular portfolio, Plaintiff approached Defendants' group of companies ... more than in time before the expiration of the agreement. Plaintiff proposed on ...

... took place between the former contracting parties ... took place. Subsequently, they exchanged ...

Defendants' group of companies declared in a conversation with Plaintiff on ... its willingness to take a license.

On ... following this, ...took place...By email of ... Defendants' group of companies declared (again) its willingness to take a license. Defendants ... in an e-mail dated

On , Plaintiff submitted

...

Following ...

On ...



On ...

In the ...

On ...

On ...

On ...

On ...

This behavior of Defendants' group of companies contradicts its repeatedly declared willingness to take a license and, to Chamber's conviction, proves its unwillingness to take a license.

From this behavior of Defendants' group of companies, Chamber cannot infer - despite the (alleged) willingness to take a license expressed on several occasions - that it was Rather, Defendants' group of companies was concerned with asserting its interests - especially with regard to This included leaving the negotiations in abeyance for as long as possible and thus depriving Plaintiff of license income.

It is true that Defendants' group of companies negotiated with Plaintiff and exchanged various offers with it. However, Chamber is convinced that this did not serve the purpose of working out reasonable, appropriate and interest-appropriate terms of an intended license agreement with Plaintiff, but was primarily designed to delay the negotiations on the basis of objective aspects. This is because delaying tactics typically consist of not simply rejecting a license agreement on FRAND terms, but of ostensibly striving for it, while at the same time pushing back the details of finding an appropriate solution or at least postponing it as long as possible. In particular, Defendants' group of companies did not communicate its interests and doubts regarding Plaintiff's offers to Plaintiff without delay and in a sufficiently concrete manner. While in the (pre-trial) negotiation process of the parties in particular ... was disputed, Defendants' objections during the court proceedings also shifted to the fact that Plaintiff's license offers were FRAND-infringing because



This unwillingness to take a license on the part of Defendants' group of companies also results from the fact that Defendants' group of companies did not take the next step in the negotiations, although it would have been the time to do so.

After the ... as well as taking into account the almost ... it would have been time according to the business practices and principles of good faith not only to negotiate and to formulate interests (i.e. to hold talks and exchange e-mails), but not only to seek the conclusion of the - allegedly sought - agreement, but to undertake everything to also successfully conclude the license agreement. This conduct follows from the obligation that the license seeker must not only purposefully participate in the license agreement negotiations, but must also carry out the next negotiating step in accordance with business practice and the principles of good faith (cf. FCJ loc. cit. para. 68 - FRAND Einwand II).

According to these standards, it would have been up to Defendants' group of companies in the negotiations in the present case to avoid the evidently non-constructive back and forth... and, based on Plaintiff's proposal, to communicate immediately, specifically and comprehensively which of the proposed conditions Defendants' group of companies has been prepared to accept and which it rejects and for what reasons. In order to reach a consensus, a reasonable party interested in the successful and interest-oriented conclusion of the negotiations would at this stage submit specific proposals as to how, despite the different ideas of the parties at individual points, their efforts could result in a reasonable solution that is in line with the interests of the parties and appropriate. For this purpose, however, it is in any case not sufficient to improve one's own offer step by step, but a specific approach to the patentee is required at this stage of the negotiations. After all, the patent infringer needs the conclusion of the license agreement in order to justify his, as a rule, now intentional and unlawful (patent infringing) actions. Only then, when the patentee, abusing its dominant position, denies the conclusion of a fair and equitable agreement, the patent infringer is discharged from this debt. This is because Plaintiff's alleged abusive denial D necessarily presupposes Defendants' continuing demand for the conclusion of an agreement on FRAND terms and its willingness to cooperate in the conclusion of such an agreement.

Nothing to the contrary results from ... of Defendants' side.



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This is because from the stage of negotiations reached here, it is not a matter of writing an offer, but rather everything must be done that a reasonable party would do in the private autonomous sphere in order to be able to agree objectively on FRAND conditions. For this, in particular, the actual willingness of Defendants to accept conditions on "whatever it takes" must become apparent. For the reasons explained, this was not the case here.

That ... does not in itself constitute sufficient willingness to take a license, but concerns a minimum requirement for a successful defense with the compulsory license objection under antitrust law.

Defendants' objection is also not valid, Parallel to it In any case, this does not show sufficient willingness to license.

Instead, this objection supports Chamber's findings.

Defendants' group of companies is not sufficiently willing to take a license. Otherwise, Instead, by not aiming for a solution ... the finding of a speedy negotiated solution is being hindered and, in any case ... delayed. In principle, a solution could have been achieved through negotiations between the parties. From Chamber's point of view, ... seems particularly suitable for this. The many years of experience of two members of Chamber, ..., show that in principle and as a rule a mutually agreeable, interest-oriented and reasonable solution to the conflict of parties can be found reliably and quickly if the parties actually strive for such a solution.

On the other hand, a ... does not appear to be unobjectionable. Parties interested in a consensual resolution of the conflict by negotiation would as a rule not choose such a procedure because the other side would inevitably have reservations against it and would raise them, which would in any case delay the resolution of the conflict.

Insofar as Defendants' group of companies raises further objections to Plaintiff's negotiation and contract offer, they do not paint a different picture.

If Defendants' group of companies states ... without any justifying reasons being presented or otherwise evident for this, this complaint is not valid.



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This is because Plaintiff has presented reasons that Chamber is convinced are plausible in the first instance as to why he Thus, Plaintiff has stated that In addition, the overall turnover had increased significantly. Furthermore, Plaintiff has relied on the fact that ...

Whether the above-mentioned reasons can actually justify the additional price is not a matter for Chamber to assess in accordance with the standards of supreme court case law mentioned at the beginning. This is because, according to the parties' arguments, this does not result in a hindrance to access, but at most a price abuse would be at issue. However, an abuse of price cannot be established here by means of the objection of compulsory licensing under antitrust law.

Such is not the case. The price deviation from a previous agreement existing between the parties is not per se suitable to prove inappropriateness. Inappropriateness could initially only arise in case of deviation from a reference agreement if the party wishing to deviate from the content of this agreement had not provided any justification for this. However, since Plaintiff for its part has explained why ... see above, the criticism of Defendants' group of companies cannot be accepted. This is because it is essentially exhausted in the fact that Plaintiff's reasons are not plausible and would in any case not justify the desired change, but rather the conditions from ... would have to remain decisive because this is the relevant settlement license agreement anyway. In addition, inappropriateness could arise if there were discrimination. However, Defendants' group of companies does not rely on this. In particular, it does not claim, as the Chamber is aware from other proceedings, that its direct competitors were offered more favorable conditions than it, see above.

Likewise, the objection of Defendants' group of companies is not valid,

This is because this is again about pricing and not about the accusation of thwarting a demanded (and allegedly wanted, see above) access.

The same applies to the objection of Defendants' group of companies, ... because this is primarily about details of the price issue and not about access problems.

Similarly, Defendants' objection that



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In the opinion of the Chamber, this objection is not relevant to the decision in these proceedings.

It already does not follow from this for the purposes of these proceedings that Plaintiff for his part would not be sufficiently willing to obtain a license. Chamber is convinced that the parties, according to their declared will and against the background of ... an overall solution is therefore neither appropriate in the context of the present action, nor does it lead to an agreement between the parties. Instead, this demand by Defendants' group of companies would only further delay the actual negotiations on and postpone the conclusion of a license agreement even further.

Chamber does not have to deal with the pre-trial objection that Defendant is already licensed under French law. Defendant rightly did not refer to this in its written pleadings during the proceedings.

(...)

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